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ARTICLES

NOTES

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Many judicial systems utilize a process, often known as a referral process, in which one court has the ability to call upon another court, particularly a superior court, for definitive interpretations of law. This referral process is perhaps most widely known from its use in the European Court of Justice (ECJ), which has long thrived on receiving referrals (known as preliminary references) from national courts within the European Union. Yet, the ECJ's preliminary reference process is itself derived from the constitutional referral processes previously adopted in several national judiciaries of the EU member states, notably Germany and Italy. This Article examines the constitutional referral process at the national level, using data from the German Constitutional Court and interviews with constitutional court and lower court judges to examine why lower ordinary courts refer cases to their national constitutional courts. There currently is a lack of theory and data examining why lower ordinary courts choose to refer certain cases to the national or federal constitutional court. This Article, then, is among the first to examine the factors—including policy issues, legal doctrine, and lower court characteristics—that might influence constitutional referrals.

Recently, the proliferation of fake news online has raised significant alarm globally, prompting numerous governments to take legal action to address the issue. In 2018 and 2021, Malaysia enacted two distinct laws to address the issue of fake news: the Anti-Fake News Act 2018 and the Emergency (Essential Powers) (No. 2) Ordinance 2021. These two laws have garnered significant attention and criticism, particularly regarding their negative impact on freedom of speech. This Article employs the standards of freedom of expression outlined in the International Covenant on Civil and Political Rights to assess Malaysia's fake news laws regarding legality, necessity, and legitimacy. This Article examines several aspects of the two laws, such as the legal definition of fake news, the legislative processes, and the objective of speech restrictions. This Article argues that Malaysia's fake news laws have multiple issues and do not conform to international human rights standards. As more and more governments consider implementing legal measures to address the issue of fake news in recent years, Malaysia's fake news laws serve as a worrisome precedent to be mindful of.

In the 1990s, due to a surge in nonmarital births and the related increase in child support assistance, Congress passed laws making federal aid to states contingent on accessible and standardized paternity establishment processes. This led to in-hospital voluntary paternity acknowledgments (VAPs), which made establishing paternity for child support easier. Federal funding required strict VAP processes, including a sixty-day rescission period and limited grounds for post-rescission challenges.

Voluntary parentage acknowledgments have since expanded to include non-genetic parents, like spouses and intended parents through assisted reproduction. Illinois' Parentage Act of 2015 regulates these acknowledgments. However, the Illinois Appellate Court case, *Illinois Department of Healthcare and Family Services ex rel. Hull v. Robinson*, revealed complexities with VAPs, particularly when a non-genetic father signed an Iowa VAP, leading to a child support reimbursement challenge from the actual genetic father in Illinois.

This Article critiques Illinois laws on voluntary paternity acknowledgments, proposing critical reforms. It starts with the *Robinson* case, exploring both explicit and implicit VAP issues. It then delves into Illinois' broader parentage acknowledgment framework, considering acknowledgments for children born from consensual sex and from nonsurrogacy and surrogacy assisted reproduction. The Article extends its analysis to the 2000 and 2017 Uniform Parentage Acts (UPAs) and other states' laws, providing a context for Illinois lawmakers. The Article posits reforms of Illinois laws on both paternity and maternity acknowledgments (i.e., those with relevant genetic ties) and on other parentage acknowledgments (i.e., those with no genetic ties), though recognizing a need for differentiating between the two types of acknowledgments.

This Article examines the evidence of original intent behind the Second Amendment, which Justice Antonin Scalia ignored in *District of Columbia v. Heller*. It suggests that the adoption of the Second Amendment was motivated by states' concerns about federal control over state and local militias. Thus, it was intended as a state's rights amendment before Justice Scalia disregarded the opening clause. The Article then examines the results of Justice Scalia's opinion in terms of a widespread increasing homicide rate in a nation with more firearms in circulation than the total population. Finally, it compares current homicide rates in the United States with those of other nations, particularly those with more restrictive gun laws, where homicide rates are considerably lower.

NOTES

Though tattoos have traditionally been viewed negatively, in the last decade, tattoos have become a popular form of self-expression. Thus, the increasing prevalence of athletes adorned with body art has sparked legal debate on tattoo ownership, protection, and commercialization. This Note briefly outlines tattooing and copyright law histories and provides an overview of copyright law today. As copyright claims by tattoo artists have, until recently, been widely settled out of court, this Note will provide an analysis of the only case to proceed to a jury trial. Based on the above, this Note asserts that tattoos are copyrightable. It further argues that an implied license is created once a tattoo is applied to the client's skin. Finally, this Note provides contractual solutions to protect the interests of the artist, the client, and the businesses that want to utilize the client's likeness.

The current landscape of copyright law fails to adequately address the ever-evolving rise of Artificial Intelligence (AI). If left untouched, the legal framework risks falling behind the swift advancements in AI technology and will forever be left in a perpetual state. To address this challenge, copyright law should be amended to grant limited rights to the inventor/commissioner of the work of an AI system to reward them for the fruits of their labor. Alternative approaches, such as assigning rights to the AI itself or placing the work directly into the public domain, present their own shortcomings. Nevertheless, these methods fail to adhere to the principles of copyright law, as AI can never meet the current standards to establish rights under the current formalities, and placing works into the public domain fails to adequately reward a programmer for their efforts. This Note seeks to explain and address these complexities and propose a viable solution to reconcile them.

REFERRALS TO NATIONAL CONSTITUTIONAL COURTS: A PRELIMINARY EXAMINATION

Benjamin Bricker*

I. INTRODUCTION

Though relatively uncommon—and thus relatively unknown—in the United States legal system, many judicial systems around the world utilize a process known as a "referral," in which one court has the ability to call upon another court, particularly a superior court, for definitive interpretations of law.[1] In fact, the constitutional judicial systems in many European countries are built in no small measure through the ability—and necessity—of ordinary court judges to refer constitutional questions to their national constitutional court.[2] Yet, apart from the preliminary reference process used in the Court of Justice of the European Union (ECJ), very little has been written about the referral process.[3] This Article serves as a starting point to better understand and explain the process of referrals at the national level and their importance in the legal world, using Germany as a representative example. Because there is little written about the topic (apart from the ECJ preliminary reference process), there is also little to no extant data examining the process of referrals.[4] This Article also incorporates two different sources of data on the process of referrals—both a series of interviews with German constitutional and regular court judges and a novel dataset of referral outcomes from the German Constitutional Court—to better understand the factors that may lead to referrals and that may contribute to successful referrals.

A referral can be defined as a "request from one court to another court for a definitive interpretation of law prior to the ultimate ruling in the case."[5] Referral processes exist in different forms and under different names in various countries.[6] Though the names may be different, what unites them is

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1 *See* Herbert Hausmaninger, *Judicial Referral of Constitutional Questions in Austria, Germany, and Russia*, 12 TUL. EUR. & CIV. L. F. 25 (1997).

2 *See id*.

3 Existing work is fleeting. *See, e.g.*, *id.*, for one example.

4 *See id*.

5 Benjamin Bricker et al., *Referrals*, in THE OXFORD HANDBOOK OF COMPARATIVE JUDICIAL BEHAVIOR (Lee Epstein et al. eds) (forthcoming 2024) (manuscript at 3) (on file with author).

6 *Id*.

the existence of a common set of procedures in which "an existing case is interrupted to obtain a legal answer from another court."[7] Thus, there are two common elements that unite the referral process: one, interrupting an existing case to request a legal answer, and two, breaking the traditional concept in which only final rulings from one court can be heard by another court.[8] Though uncommon, referrals are, in fact, not unknown in the U.S. legal system.[9] The "certification" process that exists today in at least forty-seven states, the District of Columbia, and Puerto Rico allows federal courts to ask a state high court specific questions relating to the interpretation of state law.[10] Many states also have a separate certification process in which lower state courts can certify questions of state law to their state supreme court.[11] The interlocutory appeal process in federal courts also permits federal district courts a limited right to ask federal appellate courts for answers on controlling issues of civil law that are central to the case and about which substantial grounds for disagreement exist.[12]

Still, the referral process is perhaps most widely known from its use in the European Court of Justice, which has long thrived on receiving referrals (known as a "preliminary reference") from national courts within the European Union (EU).[13] The preliminary reference process is perhaps the most important tool the ECJ has to hear cases on matters of EU law and thus has become the primary way to implement EU law and expand the power of the EU legal order.[14] Through the preliminary reference, the ECJ has become an essential institutional actor in the creation and maintenance of the

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7 *Id*.

8 *See* Robert Martineau, *Defining Finality and Appealability by Court Rule: Right Problem, Wrong Solution*, 54 U. PITT. L. REV. 717, 770-71 (1993); *see* Note, *Appellate Jurisdiction—Final Judgment Rule—Class Certification Orders—Microsoft Corp. v. Baker*, 131 HARV. L. REV. 323, 325 (2017); *see* 28 U.S.C. § 1291 (2012) (Appellate courts have jurisdiction over "all final decisions of the district courts.").

9 *See, e.g.*, Rebecca Cochran, *Federal Court Certification of Questions of State Law to State Courts: A Theoretical and Empirical Study*, 29 J. LEGIS. 157, 203 (2013).

10 *Id*. at 159.

11 *See, e.g.*, *id*.

12 Bryan Lammon, *Finality, Appealability, and the Scope of Interlocutory Review*, 93 WASH. L. REV. 1809, 1812-14 (2018); 28 U.S.C. § 1292(b) (2012). It is important to note that appellate courts retain discretion on whether to answer interlocutory appeals or not. *Id*.

13 *See generally* KAREN ALTER, THE EUROPEAN COURT'S POLITICAL POWER (2009). It is important to note here that, as some have noted, the ECJ is not necessarily a "superior" court in the preliminary reference relationship. *See* Arthur Dyevre et al., *Chilling or Learning? The Effect of Negative Feedback on Inter-judicial Cooperation in Non-hierarchical Referral Regimes*, 10 J. LAW & CTS. 87 (2021). Instead, it is a supranational court with jurisdiction over questions of EU law. *Id.* However, the ECJ is the only court with the power to give final interpretations on matters of European Union law, which makes its power effectively similar to other courts that are courts of final appeal. *Id.* And, the ECJ's relationship with national courts is at the very least functionally similar to that of the U.S. Supreme Court's relationship with lower federal courts and state courts. *Id*.

14 *See generally* Arthur Dyevre et al., *Chilling or Learning? The Effect of Negative Feedback on Inter-judicial Cooperation in Non-hierarchical Referral Regimes*, 10 J. LAW & CTS. 87 (2021).

European Union project.[15] With recognition of the importance of the reference process to ECJ and EU power, a vast literature has developed to examine the preliminary reference process at the ECJ, including questions of which courts refer, which countries or regions refer, and whether the ECJ itself seeks out specific cases and why.[16]

Yet, the ECJ's preliminary reference process is, in fact, derived from the judicial referral processes adopted after World War II in several national judiciaries of the EU member states, particularly Italy and (West) Germany.[17] In the aftermath of World War II, the new political leadership in Italy and West Germany (with American prodding) sought to create a new type of constitutional system to prevent democratic backsliding and ensure a slate of basic human and civil rights to all citizens.[18] One of the primary deficiencies of the previous constitutional orders in those countries was the inability of individual citizens to go to court and assert that laws passed by parliament violated their constitutional rights.[19] Judges in the continental civil law system had long been disqualified from exercising judicial review.[20] The traditional view had been that rights protection in a parliamentary democracy was a matter for the democratically-elected legislature to determine, not unelected judges.[21] The terrors of the Nazi regime in Germany had plainly exposed the problem of not providing a check on legislative and governmental abuses of power.[22] Yet, many in the post-World War II political world still harbored a distrust of the judiciary and a reluctance to extend judicial review powers to the judiciary.[23] The solution was the creation of a separate stand-alone court, known as the constitutional court, that would be empowered to hear and decide cases involving constitutional rights or constitutional powers.[24] This court could exercise judicial review

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15 *See generally* KAREN ALTER, THE EUROPEAN COURT'S POLITICAL POWER (2009); Bricker, *supra* note 5, at 3.

16 *See* Anne-Marie Burley & Walter Mattli, *Europe before the Court: A Political Theory of Legal Integration*, 41 INT'L ORG. 47 (1993); Karen Alter, *The European Court's Political Power*, 19 W. EUR. POL. 458 (1996); *see* Clifford Carrubba & Lacey Murrah, *Legal Integration and Use of the Preliminary Ruling Process in the European Union*, 59 INT'L ORG. 399 (2005); R. Daniel Kelemen & Tommaso Pavone, *Mapping European Law*, 23 J. EUR. PUB. POL'Y 1118 (2016); *see* Arthur Dyevre et al., *Who Refers Most? Institutional Incentives and Judicial Participation in the Preliminary Ruling System*, 27 J. EUR. PUB. POL'Y 912 (2019).

17 TOMMASO PAVONE, THE GHOSTWRITERS: LAWYERS AND THE POLITICS BEHIND THE JUDICIAL CONSTRUCTION OF EUROPE (2022); Hausmaninger, *supra* note 1, at 25.

18 ALEC STONE SWEET, GOVERNING WITH JUDGES: CONSTITUTIONAL POLITICS IN EUROPE 40 (2000).

19 *Id*.

20 TOM GINSBURG, JUDICIAL REVIEW IN NEW DEMOCRACIES 1-3 (2003).

21 *Id*.

22 *See* Jeffery Herf, *Emergency powers helped Hitler's rise. Germany has avoided them ever since*, WASH. POST. (Feb. 19, 2019), https://www.washingtonpost.com/outlook/2019/02/19/emergency-powers-helped-hitlers-rise-germany-has-avoided-them-ever-since/.

23 SWEET, *supra* note 18, at 40-41.

24 Hausmaninger, *supra* note 1, at 25.

and would be empowered to overturn acts of the legislature and government that contravened the constitution.[25] Judges in the regular judicial system would still be precluded from deciding matters of constitutional rights or policy.[26] But, if a constitutional claim arose in an ordinary court case, those regular judges would be empowered to pause that case and send, or *refer*, the constitutional issue to the constitutional court for a resolution.[27]

This Article examines the constitutional referral process at the national level, using the German Constitutional Court as a representative example to examine different ideas of why regular court judges refer cases to their national constitutional courts and how the constitutional courts respond to judicial referrals. There are important reasons to examine this question. First, despite the large growth in the literature examining the preliminary reference procedure at the ECJ, there is still relatively little work examining the referral process within national judicial systems.[28] Second, the literature that has been developed for the ECJ's reference process may be of limited value in explaining non-ECJ judicial processes and outcomes.[29] The ECJ's preliminary reference literature is by now quite comprehensive, with many interesting answers to equally interesting questions of referral dynamics.[30] However, the ECJ is an international court, not a domestic court, and the pathways to the entry of a case on the ECJ's docket are often quite distinct from those seen in the national court systems.[31]

Further, the reasons why the ECJ's reference docket has grown have much to do with transnational activity, particularly national and international economic trade, as well as national levels of openness to Europeanization and the EU itself as an institution.[32] These factors may have little to no theoretical or practical relevance at the national level. Finally, the ECJ is, in the end, *not* empowered to overturn national laws—it provides a legal interpretation of EU law and allows the national court to rule in ways that overturn national laws (or not).[33] Yet, potentially overturning laws is precisely the job of

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25 *Id.* at 26.

26 *Id.* at 30.

27 *Id*.

28 *See id*., for one exception.

29 *See generally* KAREN J. ALTER, THE EUROPEAN COURT'S POLITICAL POWER (2009) (analyzing the ECJ process and integration into the European legal system).

30 TOMMASO PAVONE, THE GHOSTWRITERS: LAWYERS AND THE POLITICS BEHIND THE JUDICIAL CONSTRUCTION OF EUROPE (2022); Hausmaninger, *supra* note 1, at 25.

31 *See generally* CLIFFORD J. CARRUBBA & MATTHEW J. GABEL, INTERNATIONAL COURTS AND THE PERFORMANCE OF INTERNATIONAL AGREEMENTS (2014) (analyzing the ECJ and its role in effectuating international agreements and contrasting it with the domestic political and judicial processes).

32 Tommaso Pavone, *Revisiting Judicial Empowerment in the European Union: Limits of Empowerment, Logics of Resistance*, 6 J. L. & CTS. 303 (2018); Clifford Carrubba & Lacey Murrah, *Legal Integration and Use of the Preliminary Ruling Process in the European Union*, 59 INT'L ORG. 399 (2005).

33 *See generally* ALTER, *supra* note 29.

national constitutional court referrals.[34] Thus, it seems apparent that we cannot rely simply on reference to the work done on the ECJ's preliminary references and will need new theories and new pathways to explain referral activity at the level of the national judiciary. This Article reflects an attempt to do just that—examine the relationship between the national courts and the constitutional court in these instances of concrete judicial review. Specifically, this study examines when and why constitutional courts will act to affirm or reject the constitutional reference made by the national court.

II. BACKGROUND: THE REFERRAL PROCESS

The procedural rules of the German Constitutional Court are quite different from those of common law courts, and notably those of the U.S. Supreme Court.[35] The constitutional court's rules of procedure allow several distinct pathways for cases to enter the court's docket.[36] First, some institutional actors are provided the opportunity to send constitutional questions directly to the constitutional court for resolution in a process known as abstract review.[37] Notably, this process does *not* require the party initiating the case be injured in any direct or concrete way.[38] The federal government, Land (state) governments, and groups of members of parliament (MPs) in the Bundestag—the lower house of the federal legislature—can send cases to the court in the abstract.[39] This means that political actors have a direct pathway to using the legal system to challenge the constitutionality of laws.[40] Separately, federal governmental institutions can send questions regarding the proper constitutional boundary line between the federal powers, and Land and federal government actors can send federalism disputes to the court directly as well.[41] In a second avenue, private individuals can submit constitutional complaints to the constitutional court after they have exhausted all of their other legal remedies in the ordinary court

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34 Hausmaninger, *supra* note 1, at 26.

35 *See generally* Bundesverfassungsgerichtsgesetz [BVerfGG] [Federal Constitutional Court Act], Aug. 11, 1993, Bundesgesetzblatt [BGBl I] at 1473, last amended by Gesetz [G], Nov. 20, 2019, (Ger.), https://www.gesetze-im-internet.de/englisch_bverfgg/englisch_bverfgg.html.

36 *Id*. at 1724, §§ 13, 80-82.

37 *Id*. § 13.

38 *See id.* This is converse to the standard justiciability requirements in common law courts. The U.S. Supreme Court has, at least since *Lujan v. Defenders of Wildlife*, 504 U.S. 555, 560 (1992), noted that plaintiffs must show at least a concrete and particularized injury-in-fact from the law challenged to meet standing and related justiciability requirements.

39 SWEET, *supra* note 18, at 45.

40 *Id*.

41 *See* Bundesverfassungsgerichtsgesetz [BverfGG] [Federal Constitutional Court Act], Aug. 11, 1993, Bundesgesetzblatt [BGBl I] at 1473, last amended by Gesetz [G], Nov. 20, 2019, BGBl I at 1724, § 13 (Ger.), https://www.gesetze-im-internet.de/englisch_bverfgg/englisch_bverfgg.html.

system.[42] Functionally, this second path is the way most cases get on the German Constitutional Court's docket.[43]

A third pathway comes from judicial referrals from the regular courts.[44] As noted above, the German system, like nearly all continental European legal systems, does not permit judges in the regular court system to overturn laws of parliament on their own.[45] Instead, Article 100 of the German Basic Law empowers regular court judges to submit referrals to the constitutional court when they believe a statute at issue in their case may be unconstitutional.[46] The referral process, also known as "concrete" judicial review or "specific" judicial review,[47] is initiated by the ordinary judiciary in the course of pending litigation.[48] When, in the course of that litigation, the judge overseeing the case—or a majority of judges in the case of multi-judge judicial panels—concludes that a law vital to the ongoing case is unconstitutional, the court is then obligated to refer the issue to the constitutional court for a resolution.[49]

Despite the importance of the referral process to the judicial order, research on constitutional referrals in European court systems has been lacking.[50] Perhaps because the abstract review process directly brings political actors and political debates to the court, most research and theory on constitutional court decision making have tended to focus on the abstract review docket.[51] There is some reason for the emphasis: It is likely true that the concrete docket is less "politically provocative" than abstract cases.[52] The most direct confrontations between major political actors, including cases pitting the parliamentary majority against opposition parties or the president, are contained in the abstract review docket.[53] It is certainly true that the referral (or concrete review) process is a longer and likely much costlier process than abstract review and often arises in cases pitting two private

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42 *Id*. at § 90.

43 BUNDESVERFASSUNGSGERICHT [FEDERAL CONSTITUTIONAL COURT], ANNUAL REPORT (Eng.) 50-51 (2022), available at https://www.bundesverfassungsgericht.de/SharedDocs/Downloads/EN/Jahresbericht/jahresbericht_2022.pdf [hereinafter BUNDESVERFASSUNGSGERICHT].

44 Grundgesetz [GG] [Basic Law], translation at https://www.gesetze-im-internet.de/englisch_gg/englisch_gg.html, art. 100 (Ger).

45 *See, e.g*., MATHIAS SIEMS, COMPARATIVE LAW (2014).

46 Grundgesetz [GG] [Basic Law], translation at https://www.gesetze-im-internet.de/englisch_gg/englisch_gg.html, art. 100 (Ger).

47 *See, e.g*., BUNDESVERFASSUNGSGERICHT, *supra* note 43, at 50-51.

48 *See, e.g*., *id*.

49 DONALD KOMMERS & RUSSELL MILLER, THE CONSTITUTIONAL JURISPRUDENCE OF THE FEDERAL REPUBLIC OF GERMANY 13 (3d ed. 2012).

50 *See* Christoph Hönnige, *The Electoral Connection: How the Pivotal Judge Affects Oppositional Success at European Constitutional Courts*, 32 W. EUR. POL. 963 (2009).

51 *See, e.g*., BENJAMIN BRICKER, VISIONS OF JUDICIAL REVIEW: A COMPARATIVE EXAMINATION OF COURTS AND POLICY IN DEMOCRACIES (2016); *Id*. at 963.

52 SWEET, *supra* note 18, at 51.

53 *See id*.

parties against one another—or a private individual against the state in criminal and administrative matters.[54] Each case that gets referred to the constitutional court must be stayed—essentially put on hold—while the case is lodged and, if accepted, a final decision gets made.[55] This adds cost to parties seeking a resolution to their legal issue.[56]

In many European constitutional courts, the abstract review docket, broadly conceived, is a relatively large part of the overall work of the court.[57] However, in Germany the abstract docket is relatively small when compared to the number of constitutional complaints and judicial referrals, and it has been for years.[58] From 2015 to 2021, the German Constitutional Court resolved an average of just over one abstract review case per year.[59] During the same time period, the court resolved an average of eighteen referrals per year (See Figure 1).[60] Thus, despite its relative lack of glamour, judicial referrals represent a significant part of the German Constitutional Court's work.[61] A study performed by Wendel found that judicial referrals are the second most common type of proceeding at the constitutional court, comprising one-quarter of the published decisions in the court's official report series.[62] And with referrals representing a relatively large proportion of the court's overall work, examining the outcomes from the court's judicial referral docket is important to understand the larger work of the constitutional courts.[63]

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54 *See id*.

55 BUNDESVERFASSUNGSGERICHT, *Constitutional complaints*, https://www.bundesverfassungsgericht.de/EN/Verfahren/Wichtige-Verfahrensarten/Verfassungsbeschwerde/verfassungsbeschwerde_node.html (last visited Feb. 9, 2024).

56 *See* SWEET, *supra* note 18.

57 *See, e.g*., BUNDESVERFASSUNGSGERICHT, *supra* note 43, at 46-47.

58 KOMMERS & MILLER, *supra* note 48, at 11.

59 BUNDESVERFASSUNGSGERICHT, *supra* note 43, at 46-47.

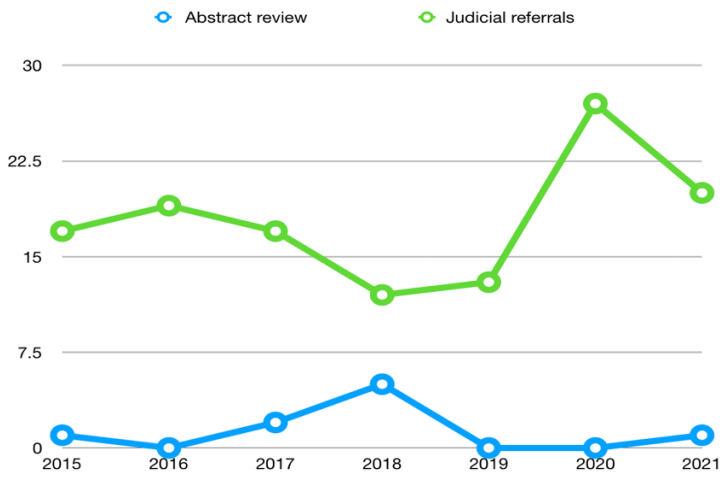
60 *See id*.

61 Constitutional complaints from individuals comprise the bulk of the court's cases and docket. *See id*.

62 Luisa Wendel et al., *From Modeled Topics to Areas of Law: A Comparative Analysis of Types of Proceedings in the German Federal Constitutional Court*, 23 GER. L.J. 493, 495 (2022).

63 *Id*.

Figure 1: Number of cases resolved: abstract review and judicial referrals.



III. WHY COURTS AND JUDGES MIGHT REFER

In Germany, the referral process is governed by the Basic Law (Germany's constitutional document) as well as the Law on the Constitutional Court and its related rules of procedure.[64] As noted earlier, Article 100 of the Basic Law states that when ordinary courts believe that a law on whose validity their decision depends is unconstitutional, that court should stay proceedings and send the question to the Federal Constitutional Court.[65] The policy applies to both federal and Land laws that might violate the federal constitution, as well as Land laws that might be incompatible with federal laws.[66] However, as Germany is a federal system, each state (Land) in Germany also has its own constitution and its own state constitutional court to examine state laws that might violate the state constitution.[67] Interviews conducted with state constitutional court judges in several courts indicate that state constitutional courts are quite cognizant of their role as

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64 Grundgesetz [GG] [Basic Law], translation at https://www.gesetze-im-internet.de/englisch_gg/englisch_gg.html; Bundesverfassungsgerichtsgesetz [BverfGG] [Federal Constitutional Court Act] Aug. 11, 1993, BGBl. I at 1473, last amended by the Act of Nov. 20, 2019, BGBl. I at 1724, § 27(a) (Ger).

65 Grundgesetz [GG] [Basic Law], translation at https://www.gesetze-im-internet.de/englisch_gg/englisch_gg.html], art. 100 (Ger).

66 *Id*. at arts. 93, 100.

67 *Id*. at art. 28.

guardians of state constitutional order and of ensuring that they are the entity responsible for non-federal (i.e., state) constitutional questions.[68]

The directions in the Basic Law seem straightforward. Still, within those directions, there is considerable latitude that ordinary court judges have when making the determination to send or not send a referral.[69] Why might ordinary courts decide to send a referral to the constitutional court? The more robust literature on ECJ preliminary references shows us that a variety of legal and non-legal factors contribute to the calculus judges make about whether they feel a referral is warranted and whether a referral will be made.[70] Certain issues are particularly likely to be sent by national judges to the ECJ for a preliminary ruling.[71] Trade issues are often the subject of references to the ECJ—which may not be too surprising given the trade-based history of the EU.[72] Courts located in regions with high amounts of industry and trade will often make trade-based references to the ECJ.[73] Similarly, research on the German Constitutional Court's outcomes has found that judicial referrals are more likely with certain issues, particularly tax law, criminal law, and social law issues.[74]

Referrals to national constitutional courts are also similar to ECJ preliminary references in one more respect. The process is dependent on the determination by the ordinary court judge of two things: one, that the law is likely unconstitutional, and two, that the outcome of their case "depends" on the validity of the law.[75] As Wind and her colleagues have noted with regard to ECJ preliminary references, it is almost always possible for judges to conclude that the outcome of their case does *not* depend on the EU-national law conflict.[76] Similarly, it should almost always be possible for an ordinary court judge to come to the conclusion that recourse to a constitutional referral is not necessary because the case does not "depend" on the answer to the referred question.

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68 Interview with Hessian Const. Ct. Judge, in Hessen, Ger. (June 2018); Interview with Bavarian Const. Ct. Judge, in Bavaria, Ger. (June 2018).

69 *See* Grundgesetz [GG] [Basic Law], translation at http://www.gesetze -im-internet.de/englisch_gg/index.html, art. 100 (Ger).

70 Clifford Carrubba & Lacey Murrah, *Legal Integration and Use of the Preliminary Ruling Process in the European Union*, 59 INT'L ORG. 399 (2005).

71 *Id*.

72 *Id*.

73 R. Daniel Kelemen & Tommaso Pavone, *The Political Geography of Legal Integration: Visualizing Institutional Change in the European Union*, 70 WORLD POL. 358 (2018).

74 Wendel et al., *supra* note 62, at 517.

75 Grundgesetz [GG] [Basic Law], translation at http://www.gesetze -im-internet.de/englisch_gg/index.html, art. 100 (Ger).

76 Marlene Wind et al., *The Uneven Legal Push for Europe: Questioning Variation When National Courts Go to Europe*, 10 EUR. UNION POL. 63 (2009).

At the same time, the court that receives the referral request makes its own choices about accepting referrals.[77] Simply put, the German Constitutional Court does not need to accept every case it receives as a referral.[78] In Germany, the constitutional court's rules state that the chambers or Senates[79] may determine that referrals are inadmissible.[80] And for many years, the court was quite stringent in its application of jurisdictional rules, rejecting over fifty percent of the referral cases lodged in the court.[81]

However, as one German Constitutional Court judge stated in an interview with the author, the informal rules for accepting referral cases have changed over recent years.[82] Until around 2017, the informal rules for accepting referrals were quite strict, and the constitutional court rejected most applications.[83] Yet, this proved to be an unideal rule for encouraging referral claims. The same German Constitutional Court judge noted in the same interview that the constitutional court eventually realized that if they started to treat the regular courts with more respect for their judgment on referrals, the court might receive more and better referrals.[84] Subsequently, the court has received more referrals since the 2017 change.[85] The judge's statement on referral activity does, in fact, comport well with the established literature on ECJ preliminary references, which has found that the more comfortable national judges feel about EU law and the ECJ as an institution, the more likely they are to believe they could or should refer a question.[86]

In the end, ordinary court judges face their own decision calculus on when and whether to refer cases to the German Constitutional Court in judicial referrals.[87] Given that each referral begins with the determination by the referring judge that the law is likely unconstitutional, are there factors

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77 Grundgesetz [GG] [Basic Law], translation at http://www.gesetze -im-internet.de/englisch_gg/index.html, art. 100 (Ger).

78 *Id*.

79 The German Constitutional Court is divided into two chambers, known as Senates. Each Senate has eight judges, and each Senate hears matters independently of the other Senate. Most of the work of the constitutional court is done within the two Senates, though for some major cases the full plenum of sixteen judges is required to decide a case. *See* BUNDESVERFASSUNGSGERICHT, *supra* note 43.

80 Bundesverfassungsgerichtsgesetz – [BVerfGG] [Federal Constitutional Court Act], August 11, 1993 (BGBl. I at 1473), as last amended by the Act of 20 November 2019 (BGBl. I at 1724), § 80, available at chrome-extension://efaidnbmnnnibpcajpcglclefindmkaj/https://www.bundesverfassungsgericht.de/SharedDocs/Downloads/EN/Gesetze/BVerfGG.pdf?__blob=publicationFile&v=1.

81 Interview with German Const. Ct. Judge, in Ger. (March 2022).

82 *Id*.

83 *Id*.

84 *Id*.

85 *Id*.

86 Juan A. Mayoral et al., *Creating EU Law Judges: The Role of Generational Differences, Legal Education sand Judicial Career Paths in National Judges' Assessment Regarding EU Law Knowledge*, 21 J. EUR. PUB. POL'Y 1120, 1123 (2014); Tommaso Pavone, *Revisiting Judicial Empowerment in the European Union: Limits of Empowerment, Logics of Resistance*, 6 J. L. & CTS. 303 (2018).

87 Interview with German Const. Ct. Judge, in Ger. (March 2022).

that might lead the constitutional court to agree with that determination, and if so, what are they?

A. The Relationship Between the Type of Referring Court and Referral Outcomes

The German legal system is based on continental civil law principles.[88] The civil code is the reference point for nearly all decisions, with what we call "case law" or precedent not formally recognized as a source of law.[89] Notwithstanding the lack of formal recognition for precedent, the reality of civil law decision making is that past cases are still important, if not essential, to the proper functioning of the judicial system and are used informally to create coherence and structure to judicial decisions.[90] Though the German legal system is organized similarly to other civil law systems, there are some unique aspects.[91] It is a decentralized system, with regular courts at the trial and appellate court levels that rule on many civil and criminal matters.[92] However, parallel to the regular court system is a system of specialized courts—notably labor courts, tax and finance courts, social courts, patent courts, and administrative courts—that have jurisdiction over specific subject matters.[93] As Hanjo Hamann has noted, these courts are "regionally dispersed, but centralized in their respective subject matter authority."[94] The legal system is also organized hierarchically, with the regular court system operating through local courts (Amtsgerichte), regional courts (Landgerichte), higher regional courts (Oberlandesgerichte), and high courts, notably the Federal Court of Justice.[95] The specialized courts in the German legal system (labor, tax, social, patent, administrative) generally only have a lower court system along with the high courts for each of the specialized court systems (i.e., there generally are no appellate specialized courts).[96] In keeping with the decentralization, lower courts are operated at a Land (or

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88 *See generally* Grundgesetz [GG] [Basic Law], translation at http://www.gesetze -im-internet.de/englisch_gg/index.html.

89 JOHN MERRYMAN & ROGELIO PÉREZ-PERDOMO, THE CIVIL LAW TRADITION 50-54 (4th ed. 2019).

90 *See generally* MITCHEL DE S.-O.-L'E. LASSER, JUDICIAL DELIBERATIONS (2008) (offering a major comparative study of the judicial reasoning and interpretive processes of civil and common law systems and the European Court of Justice).

91 *See* Hanjo Hamann, *The German Federal Courts Dataset 1950–2019: From Paper Archives to Linked Open Data*, 16 J. EMPIRICAL L. STUD. 671, 672 (2019).

92 *Id*.

93 *Id*. at 673.

94 *Id*. at 672.

95 William T. Sweigert, *The Legal System of the Federal Republic of Germany*, 11 HASTINGS L.J. 7, 10 (1959).

96 Each of the specialized courts also has a high court: the Bundesfinanzhof is the highest court for the tax and finance court system, for example. These peak courts are operated at the federal level. *See, e.g.*, Manfred Dauster, *The German Court System in Combating State Security Matters, in Particular Terrorism*, 42 S. ILL. U. L.J. 31 (2017).

state) level, and lower court judges are employed by the Land that operates the court.[97] As noted earlier, the Federal Constitutional Court is empowered as the sole body to hear constitutional questions on any federal matters.[98]

Thus, in the German legal system, some courts operate as specialized courts hearing specific, even technical, legal questions on distinct areas of law, while others operate more like general courts—the ordinary courts that hear many criminal and civil claims.[99] And within this difference might lie one important factor for understanding references to constitutional courts. The judges on the constitutional court might be more willing to accept and overturn laws sent to them by the courts with specialized jurisdiction, like tax courts, administrative courts, and social courts.[100] The basic logic focuses on the very specialization these courts and judges have. When a generalist judge suspects a law is unconstitutional, it might be viewed with greater skepticism than when a specialist judge with special training and knowledge of that area of law is similarly suspect of a law.[101] Put another way, the constitutional court might be more likely to view referrals from specialist judges with greater respect for that judge's judgment on a law's constitutionality and its possible fit (or lack of fit) within the larger network of laws and constitutional arrangements.[102] The very specialization of these latter judges means that they are likely to have greater knowledge of the specific laws they are reviewing, as well as a greater practical understanding of the law's application and potential conflicts. So, when a case arises in the area of tax or finance that a judge (or a panel of judges) in the tax court believes is unconstitutional, it should be treated with greater deference than the referrals from other, general courts. Recent research has already demonstrated that certain issues generally arising from the specialized courts, including tax and social issues, are more likely to be referred to the court.[103] These cases should also be the cases most likely to be overturned, as well.

This insight is also corroborated by discussions with judges on the Federal Constitutional Court.[104] In an interview with the author, one German Constitutional Court judge noted that there are some issues, notably tax issues and some medical issues, where constitutional judges are more likely to need help understanding the complexities—and even the ethics—in the law.[105] These feelings could also lead to greater deference toward a court or judge who specializes in adjudicating those legal issues. Ultimately, one

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97 Sweigert, *supra* note 95, at 10.
98 Hausmaninger, *supra* note 1, at 26, 30.
99 Sweigert, *supra* note 95, at 10.
100 *See id*. at 11.
101 *See id*. at 19.
102 *See id*.
103 *See* Wendel et al., *supra* note 62, at 517.
104 Interview with German Const. Ct. Judge, in Ger. (March 2022).
105 *Id*.

likely path that might lead constitutional courts to accept a referral and overturn the law in question comes from when courts of specialized jurisdiction submit referrals.

Similarly, referrals from peak federal courts[106] in the German system could be treated more favorably by the Federal Constitutional Court than other courts in the regular court system. Given that a prelude to referral activity is a belief by the referring court that the law is likely unconstitutional, it is certainly possible that the judges on the constitutional court will take more seriously the judgments of peak courts about the possible unconstitutionality of the law. Conversely, the referrals made by lower regular courts, the Amtsgerichte, could be the least likely to see the constitutional court overturn.

It should be noted that there is a well-established literature on references to the European Court of Justice (ECJ), and the theoretical outline described above—that the high courts are more likely and the lower courts less likely to gain traction with the constitutional court—does not necessarily match much of the early and established literature on referral activity at the ECJ.[107] In fact, many early theoretical studies of the ECJ's preliminary reference process began with the assumption that lower regular courts would see the most to gain—in terms of their own institutional power and standing—from referring cases, and so they would be the most likely to use the referral process.[108] These lower regular court judges, after all, lack the power of judicial review and thus would naturally see the preliminary reference process as one that could, in practice, expand their scope of power.[109] Further, the lower trial court judges—those with the least policy-making power in the judicial system—would see the most to gain (at least in terms of power) through the use of the preliminary reference.[110] Seeking their own power, the judges on the ECJ would have their own interest in helping lower national courts submit references. Later studies have shown that superior courts have come to predominate the reference process.[111]

Yet, even with the knowledge from these later studies, it is unlikely the "judicial empowerment" theories described above would ever have applied with equal force in the national context. For one, the empowerment logic would not go as far in the domestic setting: Ordinary judges refer questions

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106 *See* Sweigert, *supra* note 95, at 19. Though most lower courts are operated by Land governments, the peak courts in the regular and specialized court systems are operated by the federal government. *Id.*

107 Anne-Marie Burley & Walter Mattli, *Europe before the Court: A Political Theory of Legal Integration*, 41 INT'L ORG. 47 (1993).

108 *Id*.

109 Sweigert, *supra* note 95, at 10.

110 ALTER, *supra* note 29 (interpreting the political influence of the ECJ).

111 Arthur Dyevre et al., *Who Refers Most? Institutional Incentives and Judicial Participation in the Preliminary Ruling System*, 27 J. EUR. PUB. POL'Y 912 (2019).

to the national constitutional court, which then rules on the constitutionality of the law in question.[112] Simply put, there is no "empowering" of the lower courts in the national context—it is the constitutional court that determines the critical matter of the constitutionality of legislation.[113]

A second reason why judicial empowerment theories would not apply at the national level (one that also undercuts the theory in a general sense) focuses on workload and the rational labor interests of judges.[114] Judges take on many roles (inquisitor, manager, writer, among others) but also are likely to be driven by desires similar to other workers in the labor market—namely, to maximize their workload efficiency and carve out free time for themselves.[115] In this labor market theory of judicial decision making, judges are already busy individuals and have little interest (like all other workers) in acquiring too much work.[116] The labor market theory would undercut any theoretical interest that constitutional court judges might have in seeking out the difficult work of constitutional referrals. At the same time, many lower court judges also do not want the added workload pressures that come with a referred case.[117] In interviews conducted by the author with several German ordinary court judges, those judges all noted the ever-present need to rule on cases in an efficient manner that keeps their judicial senates from seeing a backlog of cases.[118] Referrals stop a case in its tracks until the constitutional court rules on the issue,[119] a process that can take well over a year.[120] This prevents cases from being disposed of efficiently, so the referral process is unlikely to be overused by lower courts.

Despite the lack of traditional and established incentives for judicial referrals in the domestic court environment, there is one group for whom the referral process may see concrete benefits. Peak courts, particularly, do not have the same type of time pressures that lower courts have.[121] These courts are most likely to see the benefits of referrals, and because of the importance of those courts in the legal system, the constitutional court should be more likely to both take those referrals seriously and agree with those peak courts on the possible unconstitutionality of the referred law.[122] This should remain true even when considering the ingrained skepticism many national peak

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112 Sweigert, *supra* note 95, at 18.

113 *Id*.

114 LEE EPSTEIN ET AL., THE BEHAVIOR OF FEDERAL JUDGES 7 (2013).

115 *Id*.

116 *Id*.

117 *See, e.g.*, Interviews with Six Ger. Higher Reg'l Ct. Judges, in Ger. (June 2018).

118 *Id*.

119 *Specific judicial review of statutes*, BUNDESVERFASSUNGSGERICHT, https://www.bundesverfassungsgericht.de/EN/Verfahren/Wichtige-Verfahrensarten/Konkrete-Normenkontrolle/konkrete-normenkontrolle_node.html (last visited Feb. 9, 2024).

120 Interviews with Six Ger. Higher Reg'l Ct. Judges, in Ger. (June 2018).

121 *Id*.

122 *Id*.

courts had for the (relatively) newer constitutional courts.[123] Because of the specialized organization of the German system, there are several such peak courts: the Bundesgerichtshof (Federal Supreme Court),[124] which hears final appeals from the ordinary regular courts; the Bundesfinanzhof (Federal Fiscal Court),[125] which hears final appeals from the specialized finance courts; the Bundessozialgericht (Federal Social Court),[126] which hears final appeals on social insurance and pension laws from the specialized social courts; and the Bundesverwaltungsgericht (Federal Administrative Court),[127] which hears appeals on administrative law from the specialized administrative courts, as well as the Federal Patent Court and the Federal Labor Court.[128] Laws referred from these peak courts should be more likely to be overturned by the constitutional court, while laws referred from lower ordinary courts are less likely to be overturned by the constitutional court.

Once cases are referred to the German Constitutional Court and accepted by the court, the case becomes part of the court's workload.[129] The case will generally be assigned to a judge based on the subject matter of the dispute—cases generally are assigned to judges based on the subject matter expertise of that judge.[130] That judge then becomes the rapporteur, or reporting judge, responsible for writing the court's final decision.[131] In keeping with the civil law tradition of the judge as a case manager or supervisor,[132] the reporting judge is empowered to ask third parties to submit written briefs that might help assist in providing a resolution to the case.[133] Thus, unlike the U.S. Supreme Court, outside briefs in the German Constitutional Court are mostly initiated at the discretion of the court itself and the judges deciding the case.[134] In an interview, one German Constitutional Court judge provided some details on the process of obtaining

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123 *See* VITTORIA BARSOTTI ET AL., ITALIAN CONSTITUTIONAL JUSTICE IN GLOBAL CONTEXT 36 (2017).

124 Sweigert, *supra* note 95, at 10.

125 *Id*. at 19.

126 *Id*.

127 *Id*.

128 *Id*. at 20.

129 *Court and constitutional organ*, BUNDESVERFASSUNGSGERICHT, https://www.bundesverfassungsgericht.de/EN/Das-Gericht/Gericht-und-Verfassungsorgan/gericht-und-verfassungsorgan_node.html (last visited March 24, 2024) (The Federal Constitutional Court receives more than 6,000 constitutional complaints each year.); Sweigert, *supra* note 95, at 18-19.

130 KOMMERS & MILLER, *supra* note 48, at 28.

131 *Id*. at 27.

132 *See* John Langbein, *The German Advantage in Civil Procedure*, 52 U. CHI. L. REV. 823 (1985).

133 Bundesverfassungsgerichtsgesetz [BVerfGG] [Federal Constitutional Court Act] Aug. 11, 1993, BGBl. I at 1473, last amended by the Act of Nov. 20, 2019, BGBl. I at 1724, § 27(a) (Ger.); *see also* Benjamin Bricker, *Breaking the Principle of Secrecy: An Examination of Judicial Dissent in the European Constitutional Courts*, 39 LAW & POL'Y 170, 183 (2017).

134 Bundesverfassungsgerichtsgesetz [BVerfGG] [Federal Constitutional Court Act] Aug. 11, 1993, BGBl. I at 1473, last amended by the Act of Nov. 20, 2019, BGBl. I at 1724, § 27(a) (Ger.).

third-party briefs.[135] The reporting judge for each case is responsible for creating a list of outside actors that will be asked to submit written briefs.[136] Once that list is created, it is then distributed to the other judges in the Senate, who then sign off on it.[137] In almost all instances, the other judges on the panel assent to the list in its entirety.[138] But, why might third-party briefs be needed in the first place, and could the type of referring court matter to these decisions?

In fact, it is certainly possible that some referrals could necessitate the constitutional court to seek more outside third-party briefs. First, it could be necessary for the judges on the constitutional court to ask for more outside briefs when the referral is either poorly drafted or leaves out important information.[139] In a perhaps less negative frame, the court might also need to ask for more outside actors to submit their views when the referring court is not a "repeat player"—that is, when the judge submitting the referral does not sit on a court that refers many cases to the constitutional court.[140] Instead of being poorly drafted, the referral may just be the product of an inexperienced judge who either rarely or never submits referrals to the constitutional court. Any judge, and any court, may lack previous experience with submitting a judicial referral. However, it is most likely that judges in the lower ordinary courts would lack this experience.[141] This could make it more likely that the court will need to ask for outside briefs to be submitted when it accepts referrals from the lower ordinary courts and less likely to ask for outside briefs when a peak court has sent the referral.

There are related alternative reasons that involve the composition of courts at different levels in the German legal system. More briefs may be needed when the referring judge does not have a large support staff to assist with research and documentation, which is more likely to be the case when the referring judge comes from the lower courts.[142] In an interview, one German Constitutional Court judge noted that there is "more work put into the federal [peak] court requests" than those from the Amtsgerichte and other lower courts, which helps the court tremendously in reviewing the case.[143] Separately, the constitutional court may be less likely to need outside briefing when the court is comprised entirely of professional career judges. At the higher regional court level and above, panels are comprised entirely of

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135 Interview with Ger. Const. Ct. Judge, in Ger. (Mar. 2022).
136 *Id*.
137 *Id*.
138 *Id*.
139 *Id*.
140 *Id*.
141 Interview with Ger. Const. Ct. Judge, in Ger. (Mar. 2022).
142 *Id*.
143 *Id*.

professional judges.[144] At lower levels, lay judges often also participate and sit in panels as judges along with professional judges.[145] Thus, higher level referrals *may* bring with them greater assurance of quality in analysis. Given that professional judges sit on the lower court panels as well, this alternative reason may not hold true in the analysis. Overall, then, we may expect that constitutional referrals from lower ordinary courts will see more outside briefs requested by the constitutional court and that referrals from higher regional courts and peak courts will see fewer outside briefs requested by the constitutional court.

IV. EXAMINING THE OUTCOMES OF GERMAN CONSTITUTIONAL COURT CASES

To examine the factors that might contribute to constitutional court referrals, I use a dataset of all final decisions by the German Constitutional Court from 1992 to 2014, narrowing the data to only those final decisions made by the German court on referrals—that is, concrete or specific judicial review cases sent to the constitutional court by another court in the German court system.[146] Cases from the court's abstract review docket and individual constitutional complaints are excluded. The dataset used here comprises 125 cases in total.[147] Because the dataset is limited to final decisions, this analysis cannot address questions surrounding why the court accepts some cases and not others.[148] Still, the data here should provide a good look at the trends and the continued development of the use and outcomes of judicial referrals.

There are many good reasons to focus specifically on the outcomes from judicial referrals. First, this is an area that has not received much scholarly attention.[149] Though studies on referrals are commonplace in the ECJ literature, there are almost no studies that focus on the factors that drive the referral process at the national court and constitutional court level.[150] To some extent, the lack of focus on this subject could be a product of the constitutional court's own practices with regard to referrals. In Germany, for example, past practice has resulted in nearly half of referrals being rejected

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144 Dauster, *supra* note 96, at 31.

145 *Id*.

146 The data used originates from Jay Krehbiel's 2016 dataset of German Constitutional Court cases. *See generally* Jay Krehbiel, *The Politics of Judicial Procedures: The Role of Public Oral Hearings in the German Constitutional Court*, 60 AM. J. POL. SCI. 990 (2016). I use all referral cases in the Krehbiel dataset, adding new information on the type of originating court, the number of outside briefs received, and other information.

147 *See generally id*.

148 B. GUY PETERS, COMPARATIVE POLITICS: THEORY AND METHODS, 1-25 (1998).

149 *See, e.g.*, BENJAMIN BRICKER, VISIONS OF JUDICIAL REVIEW: A COMPARATIVE EXAMINATION OF COURTS AND POLICY IN DEMOCRACIES (2016); Hönnige, *supra* note 50.

150 *See, e.g.*, *id*.

for inadmissibility.[151] In other words, the constitutional court itself, for many years, did not seek to elevate or emphasize referrals and the concrete review docket.[152]

A second reason to focus on the referral process comes from the insight we can gain on court decision-making practices. With constitutional referrals, we should be able to see a wide range of possible issues within constitutional law.[153] As a theoretical matter, there is no reason why judges would be hesitant to send up specific areas of law, nor are there any structural reasons why the courts would not want to have the constitutional court resolve certain issues. Though the German Constitutional Court has handled referrals stringently for many years, this should not systematically affect the types of issues or cases that are accepted or rejected.[154] And with many aspects of the decision-making practices of non-U.S. peak courts still vastly understudied,[155] any additional insights on the factors that contribute to decisional outcomes on these courts should be welcomed.

There also are good reasons to focus on the German Constitutional Court. It is a well-established, deeply legitimate institution in German government and society.[156] Its decision-making process is respected around the world, and particularly in Europe, where the court has been a model that newer constitutional courts have tried to emulate.[157] And with a high degree of judicial independence, the outcomes from the constitutional court do not generally suffer from outside pressures or other pernicious constraints on decision making.[158]

The German ordinary court system is also known as a highly professional and legitimate institution.[159] Unlike many other European countries, the German court system today is primarily a decentralized, Land-based (state-based) judicial organization.[160] Hiring and promotion is

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151 Wendel et al., *supra* note 62, at 495; *see also* Rüdiger Zuck, *Die Wissenschaftlichen Mitarbeiter Des Bundesverfassungsgerichts* [The Research Staff of the Federal Constitutional Court], in DAS BUNDESVERFASSUNGSGERICHT IM POLITISCHEN SYSTEM [THE FEDERAL CONSTITUTIONAL COURT IN THE POLITICAL SYSTEM] 290 (Robert C. Van Ooyen & Martin H.W. Möllers eds. 2006).

152 *Id*.

153 Wendel et al., *supra* note 62, at 495.

154 *Id*.

155 *See, e.g.*, Sebastian Sternberg et al., *The Legitimacy-Conferring Capacity of Constitutional Courts: Evidence from a Comparative Survey Experiment*, 61 EUR. J. POL. RES. 973, 975 (2022).

156 GEORG VANBERG, THE POLITICS OF CONSTITUTIONAL REVIEW IN GERMANY (2005); Hönnige, *supra* note 50, at 963.

157 *See, e.g.*, Lech Garlicki, *Cooperation of Courts: The Role of Supranational Jurisdictions in Europe*, 6 INT'L J. CONST. L. 509 (2008).

158 Julio Ríos-Figueroa & Jeffrey K. Staton, *An Evaluation of Cross-National Measures of Judicial Independence*, 30 J. L. ECON. & ORG. 104 (2014).

159 *See* Hans-Ernst Bottcher, *The Role of the Judiciary in Germany*, 5 GER. L. J. 1317, 1318, 1323 (2004).

160 *See id*.

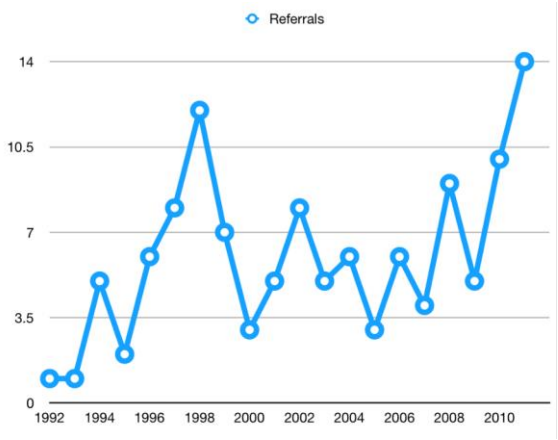
generally the province of the Land government.[161] Thus, it should be harder than typical for the central government to exert pressures, both hidden and seen, on the outputs of judges working within the national judiciary.

Logical testing in social science requires the proper identification of the outcome of interest.[162] Given that the main focus of this study is the point of decision within the constitutional court, the main outcome I will be examining below is whether the constitutional court agrees with the referring court or not. With a referral only made when the referring judge believes the law is likely unconstitutional, the outcome of interest I will be examining is the question of whether the constitutional court rules the law under review as unconstitutional or not. Separately, I also ask whether the type of referring court will influence whether the constitutional court may feel the need to request more outside briefs. The outcome I will be examining for that supposition will be a count of the number of outside briefs requested.

A. What the Data Shows

Figure 1 shows the overall rate of referrals to the German Constitutional Court over the twenty-three-year time period of this study.[163] Overall, the trend of referrals appears to be on an upward climb in the period from 1992 to 2014, showing a steady but somewhat uneven climb in the number of referrals sent to the German Constitutional Court during the period (see Figure 1), with a notable upward tick in the 2010s.[164]

Figure 2. Number of Referrals, by Year.



161 *See id*. at 1322.
162 PETERS, *supra* note 148, at 80-86.
163 *See* Sweigert, *supra* note 95, at 19.
164 *See id.*

Looking more specifically at the rate of referral by individual courts, several outcomes are notable. First, there are specific courts in the German judiciary that have sent more referrals than others.[165] Perhaps not surprisingly, several peak courts of the German system—the Bundesfinanzhof (Federal Finance and Tax Court) in Munich, the Bundessozialgericht (Federal Social Court) in Kassel, and the Bundesverwaltungsgericht (Federal Administrative Court) in Leipzig—all submitted eight or more referrals during this period.[166] All are the peak courts for the specialized finance, social, and administrative court systems.[167] The Bundesgerichtshof (Federal Supreme Court) in Karlsruhe submitted three referrals during this period—a comparatively smaller amount than the other peak Federal courts.[168] And two peak courts, the Federal Labour Court and the Federal Patent Court, did not submit any referrals during this time period.[169] Table 1 shows the overall numbers of referrals by court.[170] Also included in the Table is a line noting how many referred cases resulted in the constitutional court striking the law referred (what are noted in the Table as "successful" referrals). The Bundesfinanzhof was the most successful in having the constitutional court agree with their supposition that the law in question was unconstitutional.[171]

Conversely, the Bundesgerichtshof, the peak court least likely to refer in the first place, did not have a successful referral during this time period.[172] Overall, peak courts in the German system made thirty-seven of the 125 accepted constitutional referrals from 1992 to 2014.[173] Considering that these are but six of the thousands of courts in the German legal system, it is certainly the case that peak courts are dominant actors in the constitutional referrals system—though, given their importance in the German legal system, that may not be too surprising.

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165 *See infra* Table 1.

166 *See id.*

167 *See* Sweigert, *supra* note 95, at 19.

168 *See infra* Table 1.

169 *See infra* Table 1.

170 *See infra* Table 1. As noted earlier, the Federal Labor Court and the Federal Patent Court did not submit a single referral during this time period.

171 *See infra* Table 1.

172 *See infra* Table 1; *see generally* Sweigert, *supra* note 95, at 10.

173 *See infra* Table 1.

Table 1. Number of references, by referring peak court

	Bundesfinanzhof (peak tax court)	**Bundessozialgericht (peak social court)**	**Bundesverwaltungsgericht (peak admin. court)**	**Bundesgerichtshof (Supreme Court)**
Total referrals	12 references	14 references	8 references	3 references
Successful referrals	6	6	3	0

Looking at the non-peak courts, two specific lower courts are also high referrers of constitutional issues. The Verwaltungsgerichts (lower Administrative Court) in Hannover and the Finanzgerichts (lower tax and finance court) in Münster submitted five and four references, respectively, during this time period, making them the most common lower courts to use the constitutional referral procedure.[174] In fact, the judges within these two lower courts made more referrals than half of the six peak courts in the German legal system.[175] Among all of the lower courts, the Administrative courts made the most references to the constitutional court (twenty-six overall), followed by the Tax courts.[176] The Tax courts were also proportionally the most successful, with ten of their thirteen references resulting in the constitutional court ruling the law in question unconstitutional.[177] All of the Tax courts referrals involved specific issues of tax and finance, while the Administrative courts mainly referred issues of social insurance (eight referred cases), education (six referred cases), and tax or budget issues (five referred cases).[178] Table 2 shows the number of references to the German Constitutional Court broken down by the referring court.[179] The numbers in Table 2 exclude all referrals made by peak courts, so the figures below represent only referrals from the lower (non-peak) courts. Again, "successful" referrals are those in which the constitutional court rules the law referred unconstitutional.

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174 *See infra* Table 2.
175 *Compare infra* Table 2 with *supra* Table 1.
176 *See infra* Table 2.
177 *See infra* Table 2.
178 Krehbiel, *supra* note 146, at 990.
179 *See infra* Table 2.

Table 2. Number of references, by type of referring court (*excluding* peak courts).

	Verwaltungsgerichts (administrative court)	**Finanzgerichts (tax court)**	**Sozialgerichts (social court)**	**Amtsgerichts (local courts)**	**Arbeitsgerichts (labor court)**
Total referrals	26 references	13 references	10 references	7 references	6 references
Successful referrals	14	10	6	2	1

What factors might contribute to the possible success of a referral—that is, the constitutional court agreeing with the referring court that the law under review is unconstitutional? One basic supposition presented earlier is the idea that constitutional court judges could be more likely to accept cases from specialized courts and agree with that court's suggestion that the referred law might be unconstitutional. Again, the basic logic is that the very specialization of the judges in these specialized courts gives them a higher degree of respect and professional deference when compared to the judges in the generalist court branches.[180]

Table 3 shows the results when we examine whether the constitutional court is more likely to agree with referrals from the specialized courts.[181] The figures show a mixed result,[182] but with some relatively clear conclusions that can be drawn. There is a clear association in which the referrals from the tax courts (at all levels, but particularly the lower-level court) lead to the referred laws being struck down.[183] The social courts and the administrative courts also see a strong association between a referral and subsequent striking of the law in question, but when the peak courts are added in, the association is less than what we see in Table 2.[184] Conversely, the specialized labor courts and

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180 *See, e.g.*, Diane P. Wood, *Generalist Judges in a Specialized World*, 50 SMU L. REV. 1755, 1765 (1997) (explaining that administrative law judges hold a dominant presence in Article I tribunals and that the appellate review of their cases is deferential).

181 *See infra* Table 3; *cf.* Hausmaninger, *supra* note 1, at 36 ("Judicial referral of constitutional questions to specialized Constitutional Courts is an *important part of European systems of constitutional review*.").

182 *See infra* Table 3.

183 *See infra* Table 3.

184 *Compare infra* Table 3 *with supra* Table 2.

the generalist courts are less successful.[185] Given the specialized, complicated nature of many tax issues, the result seen for the tax courts does suggest the constitutional court relies on the specialized expertise of those judges as a key factor in whether to overturn the law in question. Similarly, the German social courts hear cases that arise from the complex, multifaceted area of social security insurance, pensions, and occupational accident law.[186]

Table 3. Success of references, by type of referring court (*including* peak courts).

	Verwaltungsgericht (administrative courts)	**Finanzgericht (tax courts)**	**Sozialgericht (social courts)**	**Arbeitsgericht (labor courts)**	**Regular courts**
Total referrals	34 references	25 references	24 references	6 references	27 references
Successful referrals	17	16	12	1	12

Are laws referred by the lower courts less likely to be overturned by the constitutional court than laws referred by the peak courts? Table 4 shows the results of a simple test examining whether the law referred to the constitutional court is overturned or not.[187] Lower-level courts referred the most cases to the constitutional court over the time period of this study.[188] Though the earlier theory predicted that peak courts, due to their expertise and prestige in the judicial system, would be more likely to see referred laws overturned by the constitutional court, peak courts are, in fact, the least likely group to see their referred laws overturned, while the local and lower-level courts and appellate courts are both more likely than not to have their constitutional referrals lead to a law being struck.[189]

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185 *See infra* Table 3.

186 *See The Federal Social Court and social jurisdiction*, BUNDESSOZIALGERICHT, https://www.bsg.bund.de/EN/Home/home_node.html (last visited Feb. 6, 2024) (indicating that the social courts are responsible for adjudicating in several areas that involve "social security matters," such as long-term care insurance and basic income for job seekers).

187 *See infra* Table 4.

188 *See infra* Table 4.

189 *See infra* Table 4.

Table 4. Successful referrals, by referring court.

	Peak courts	**Appellate courts**	**Lower-Level Courts**
Referrals	37 referrals	11 referrals	77 referrals
Law overturned	15	7	42

The final consideration from the earlier theoretical discussion focused on whether referrals from lower-level courts would require more outside briefs requested by the constitutional court, and, conversely, whether referrals from appellate/higher regional courts and peak courts would see fewer outside briefs requested by the constitutional court. The basic logic is that, unlike in common law courts, it is not outside actors that drive the amicus curiae process in the German system, but rather the judges on the constitutional court that direct outside actors to submit briefs.[190] And, for various reasons, the constitutional court judges may need more outside information and more additional context from the lower court cases, whether because of the fewer clerks and staff available to lower court judges, the overall quality and merit of the request, the fact that the record will likely be less developed at the trial court level, or some other reason.

Table 5 shows that more briefs are requested, on average, when the referral comes from lower-level courts (specialized or general) and that fewer are requested by the court when a peak court refers a case.[191] These figures appear to corroborate the idea that the judges of the constitutional court need more information to resolve constitutional referrals from the lower courts.

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190 *See* Bundesverfassungsgerichtsgesetz [BVERFGG] [Act on the Federal Constitutional Court], Aug. 11, 1993, BUNDESGESETZBLATT, Teil I [BGBL. I] at 1724, § 27(a), translation available at https://www.gesetze-im-Internet.de/englisch_bverfgg/englisch_bverfgg.html#p0408 [https://perma.cc/FCH6-4PPZ].

191 *See infra* Table 5.

Table 5. Number of briefs requested by the constitutional court, by referring court.

	Peak courts	**Appellate courts**	**Lower-Level Courts**
Referrals	37 referrals	11 referrals	77 referrals
Average number of outside briefs	3.7 per case	4.2* per case	4.7 per case

* Two constitutional referrals from appellate courts had an unusually high number of outside briefs requested (17 and 13) and were excluded as outliers from the average listed above. If those two cases are included, the average for appellate courts rises to 6.2 per case.

V. CONCLUSION

This study represents a preliminary attempt to examine the question of referrals from national courts to their national constitutional court. The literature on referrals has developed exponentially over the past two decades, though nearly all of the theory and data examines referrals from national courts to the European Court of Justice.[192] There is good reason to study the ECJ—it is one of the most consequential courts in the world, and its rulings have helped to shape the modern EU and modern Europe.[193] However, the reasons why ordinary courts would refer a question to the ECJ are likely not the reasons why those same courts would refer (or not refer) a question to their national constitutional courts. The interactions are different and thus require different theoretical expectations. Similarly, the reasons why the ECJ would accept a case and create a specific ruling are not the same reasons that would explain why a national constitutional court would accept a case and rule to overturn or not overturn the referred law. Thus, again, different theoretical expectations are required.

One prominent finding from this study is the connection between referrals from the specialized tax courts and the decision to overturn the referred legislation. The constitutional court is highly likely to agree with the tax courts when they question the constitutionality of legislation.[194] One probable explanation for this phenomenon comes from the specialized understanding these judges have of the tax laws under their purview. Though this specialization might lead to tunnel vision in other regards, in the area of

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192 *See* ALTER, *supra* note 29, at 98-99 ("Other national high courts have sent relatively few referrals to the European Court compared to the number of referrals coming from lower courts.").

193 *See* Arjen Boin & Susanne K. Schmidt, *The European Court of Justice: Guardian of European Integration*, *in* GUARDIANS OF PUBLIC VALUES 135, 150 (Arjen Boin et al. eds., 2021).

194 *See supra* Table 3.

referrals, the specialization of legal knowledge seems to lead to greater trust in the referring court. At the same time, it is worth noting that there is not a similarly strong association between referrals from several other specialized courts and the decision of the constitutional court to overturn the referred legislation. Thus, the results here could show special deference toward the tax courts—both peak and non-peak—and their expertise.

Second, referrals from the lower courts see more outside briefs submitted to the court. Given that (unlike the U.S. Supreme Court) most outside briefs are submitted at the request of the court itself, this result seems to show the constitutional court in greater need of outside information when lower courts refer cases.[195] Reasons for this association are somewhat speculative: This result could indicate lower quality of the written text of the referral itself, though it could also indicate something more benign. Perhaps when a peak court submits a referral, its larger support staff can include additional evidence and background that a lower court, with more modest staff and larger caseloads, simply cannot do.

Going forward, it will be important to expand the time period of study to see if trends seen here still remain over more recent years. Overall, however, the results here are an important step toward understanding the process of referrals to national constitutional courts. Currently, most theory and data on judicial referral activity focus on the national court-ECJ preliminary reference process.[196] This is certainly an important relationship, yet the world of referrals is much broader and more varied than one court. As seen above, different concepts need to be examined when examining referrals at the national level. Though they generally are not as politically important as the abstract review docket, judicial referrals are an important aspect of the work of constitutional courts, and examination of these concrete review cases will only add to our understanding of constitutional courts and how they interact with their national courts.

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195 *See supra* Table 5.

196 *See, e.g.*, BENJAMIN BRICKER, VISIONS OF JUDICIAL REVIEW: A COMPARATIVE EXAMINATION OF COURTS AND POLICY IN DEMOCRACIES (2016); Hönnige, *supra* note 50, at 963.

EVALUATING MALAYSIA'S FAKE NEWS LAWS THROUGH THE LENS OF INTERNATIONAL HUMAN RIGHTS STANDARDS

Bevis Hsin-Yu Chen[1]

I. INTRODUCTION

In recent years, the prevalence of fake news on the Internet has become a widespread concern, pushing many governments, particularly in Southeast Asia, to enact legislative and administrative measures to address the problem.[2] In 2018, Malaysia became the first country in Southeast Asia to pass a law explicitly targeting fake news—the Anti-Fake News Act (AFNA) 2018.[3] The Act, making it an offense to create, publish, or disseminate any fake news, has been widely condemned for stifling free speech and violating international human rights.[4] Due to a change in government, the AFNA was officially repealed in December 2019 by the Malaysian Parliament.[5] However, during the COVID-19 pandemic, the Malaysian government issued the Emergency (Essential Powers) (No. 2) Ordinance 2021[6] in March 2021, targeting pandemic-related fake news.[7] Some describe the Emergency Ordinance as the AFNA's rebirth because it is an aggravated version of the

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[2] *See generally* Robert B. Smith et al., *"Fake News" in ASEAN: Legislative Responses*, 9 J. OF ASEAN STUD. 117, 128 (2021) (showing that among the eleven Southeast Asian countries, almost every nation has legal regulations and punishments for addressing issue of fake news).

[3] SUSAN LEONG & TERENCE LEE, GLOBAL INTERNET GOVERNANCE: INFLUENCES FROM MALAYSIA AND SINGAPORE 51 (2021).

[4] Jessie Yeung, *Malaysia repeals controversial fake news law*, CNN (Aug. 17, 2018, 7:03 AM), https://www.cnn.com/2018/08/17/asia/malaysia-fake-news-law-repeal-intl/index.html.

[5] *Anti-fake news Act in Malaysia scrapped*, STRAITS TIMES (Dec. 20, 2019, 9:26 AM), https://www.straitstimes.com/asia/se-asia/anti-fake-news-act-in-malaysia-scrapped.

[6] *Emergency (Essential Powers) (No. 2) Ordinance 2021*, FED. GOV'T GAZETTE 1, 19-20 (2021), available at https://web.archive.org/web/20210325061310/http://www.federalgazette.agc.gov.my/outputp/pua_20210311_PUA110_2021.pdf [hereinafter *Emergency (Essential Powers) (No. 2) Ordinance 2021*].

[7] Joseph Sipalan, *Malaysia defends coronavirus fake news law amid outcry*, REUTERS (Mar. 12, 2021, 2:06 PM), https://www.reuters.com/business/media-telecom/malaysia-defends-coronavirus-fake-news-law-amid-outcry-2021-03-12/.

AFNA.[8] The Malaysian Parliament ultimately annulled all emergency ordinances in July 2021.[9]

As the first Southeast Asian country to enact laws against fake news, the Malaysian government's legal approach has sparked numerous debates regarding the balance between the principle of freedom of expression and the perceived need to regulate fake news.[10] For example, what is the appropriate definition of fake news? How ought fake news to be regulated? Are the Malaysian government's laws effectively achieving the regulatory aims (i.e., curbing the dissemination of fake news)? Do the speech restrictions adopted by the Malaysian government conform with international human rights standards? By discussing these questions, this Article aims to refine a deeper understanding of speech restriction in the context of fake news.

Part I of this Article introduces the research background. Part II chronicles significant events related to Malaysia's government passing the two fake news laws. Part III reviews and summarizes international standards for defining fake news and protecting freedom of expression. Part IV examines Malaysia's two fake news laws using the international human rights principles discussed in Part III. Part V concludes by summarizing the controversial aspects of Malaysia's fake news laws and providing recommendations for governments and policymakers.

II. CHRONOLOGY OF MALAYSIA'S ANTI-FAKE NEWS LEGISLATIONS

The Malaysian government has passed two significant anti-fake news legislations recently: the Anti-Fake News Act (AFNA) in 2018[11] and the Emergency (Essential Powers) (No. 2) Ordinance (the "Emergency Ordinance") in 2021.[12] In fact, as early as 2017, the Malaysian authorities had already expressed concern about the phenomenon of online fake news.[13]

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8 Lasse Schuldt, *The rebirth of Malaysia's fake news law – and what the NetzDG has to do with it*, VERFASSUNGSBLOG (Apr. 13, 2021, 12:33 AM), https://verfassungsblog.de/malaysia-fake-news/.

9 Eileen Ng, *Malaysia's Parliament opens after 7 months, emergency to end*, AP (July 26, 2021, 6:35 AM), https://apnews.com/article/business-health-coronavirus-pandemic-malaysia-083e7446d51c90933cb1a0714bbc1aa7.

10 *See* Raphael Kok Chi Ren, SUPPRESSING FAKE NEWS OR CHILLING FREE SPEECH: ARE THE REGULATORY REGIMES OF MALAYSIA AND SINGAPORE COMPATIBLE WITH INTERNATIONAL LAW?, 47 J. OF MALAYSIAN & COMPAR. L. 25, 26 (2020).

11 Anti-Fake News Act, Act 803, pt. II, §§ 4-6 (Apr. 9, 2018) (Malay) [hereinafter AFNA 2018].

12 *Minister Says Anti-Fake News Emergency Ordinance To Uphold Rule of Law*, MINISTRY OF COMM. (June 3, 2021), https://www.kkd.gov.my/en/public/news/19108-minister-says-anti-fake-news-emergency-ordinance-to-uphold-rule-of-law; *Emergency (Essential Powers) (No. 2) Ordinance 2021*, *supra* note 6, at 19-20.

13 *PM Najib and wife Rosmah say they were victims of fake news*, STRAITS TIMES (Oct. 22, 2017, 4:56 PM), https://www.straitstimes.com/asia/se-asia/pm-najib-and-wife-rosmah-say-they-were-victims-of-fake-news.

Facing accusations of a corruption scandal, former Malaysian Prime Minister Najib Razak asserted that he had become a victim of fake news on social media.[14] He claimed that fake news poses an urgent threat to the nation and needs to be addressed by law.[15] In April 2018, Najib Razak's political party—the Barisan Nasional (BN) coalition—rushed through the AFNA, officially criminalizing fake news.[16] Following the passing of the AFNA by the Parliament, Malaysia held a general election on May 9, 2018, and a new government came into power.[17] Due to the change of government, the AFNA was repealed in December 2019 by the new government.[18] However, the repeal of the legislation does not signify its demise.

In January 2021, due to the dissemination of COVID-19, Malaysia's king declared a state of emergency and suspended the Parliament until August 1, 2021.[19] On March 11, 2021, the Malaysian government enacted an emergency law—the Emergency (Essential Powers) (No. 2) Ordinance 2021—imposing hefty fines and prison sentences for the spread of COVID-19-related fake news.[20] The Emergency Ordinance is controversial for several reasons. First, the legislation is almost the same as the revoked AFNA 2018, except that the definition of fake news is COVID-19-specific.[21] Second, the Emergency Ordinance was issued without any public consultation.[22] Third, the legislative processes for the AFNA and the Emergency Ordinance differ.[23] Unlike the AFNA, passed by the Malaysian Parliament, the Emergency Ordinance was directly issued and implemented

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14 Mark Landler, *Trump Welcomes Najib Razak, the Malaysian Leader, as President, and Owner of a Fine Hotel*, N.Y. TIMES (Sept. 12, 2017), https://www.nytimes.com/2017/09/12/world/asia/trump-najib-razak-malaysia-white-house.html.

15 *See* Ric Neo, *The Failed Construction of Fake News as a Security Threat in Malaysia*, 27 CONTEMP. POL. 316, 323 (2021).

16 Dani Deahl, *First person convicted under Malaysia's fake news law gets month in jail*, VERGE (Apr. 30, 2018, 1:33 PM), https://www.theverge.com/2018/4/30/17302954/malaysia-anti-fake-news-act-youtube.

17 Hannah Ellis-Petersen, *Malaysia election: Mahathir sworn in as prime minister after hours of uncertainty*, GUARDIAN (May 10, 2018, 10:19 AM), https://www.theguardian.com/world/2018/may/10/malaysia-election-confusion-as-rival-questions-mahathirs-right-to-be-sworn-in.

18 *See* Chi Ren, *supra* note 10, at 26.

19 Rozanna Latiff & Joseph Sipalan, *Malaysia declares emergency to curb virus, shoring up government*, REUTERS (Jan. 12, 2021, 5:26 AM), https://www.reuters.com/article/us-health-coronavirus-malaysia-idUSKBN29H06G.

20 *Malaysia imposes emergency law to clamp down on COVID fake news*, REUTERS (Mar. 11, 2021, 6:46 AM), https://www.reuters.com/article/malaysia-politics-idUSL4N2L92ZH.

21 Robert Smith & Mark Perry, *Fake News and the Pandemic in Southeast Asia*, 22 AUSTL. J. OF ASIAN L. 131, 140 (2022).

22 *Malaysia: Emergency Fake News Ordinance has severe ramifications for freedom of expression*, ARTICLE 19 (June 23, 2021), https://www.article19.org/resources/malaysia-fake-news-ordinance-severe-ramifications-freedom-expression/.

23 *Id.*

by the government under emergency powers.[24] Under Article 150(2) of the Malaysian Federal Constitution, during a state of emergency, the Yang di-Pertuan Agong (king of Malaysia) has the authority to promulgate emergency ordinances as circumstances require, and the ordinances have the same force and effect as laws passed by Parliament.[25] About two weeks before the end of the emergency state, Malaysian Prime Minister Takiyuddin Hassan officially announced the termination of the Emergency Ordinances, which took effect on July 21, 2021.[26] The legislative processes of the two laws and relevant events are presented in the table below.

Table 1. The AFNA and the Emergency Ordinance: Enactment and Repeal

Date	**Event**
Jan. 30, 2018	Former Prime Minister Najib Razak appointed a special committee to study new laws to act against fake news.[27]
Mar. 12, 2018	Malaysian authorities, including Minister Azalina Othman Said and the Malaysian Communication and Multimedia Commission (MCMC), met social media platform companies to discuss the anti-fake news bill.[28]
Apr. 4, 2018	The Malaysian Parliament passed the AFNA.[29]

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24 Zsombor Peter, *Malaysia Uses Emergency Powers to Impose 'Fake News' Law*, VOA (Mar. 13, 2021, 9:59 AM), https://www.voanews.com/a/press-freedom_malaysia-uses-emergency-powers-impose-fake-news-law/6203266.html.

25 CONSTITUTION OF MALAYSIA 1957, art. 150(2).

26 A. Ananthalakshmi, *Malaysia will not extend state of emergency, says law minister*, REUTERS (July 25, 2021, 11:58 PM), https://www.reuters.com/world/asia-pacific/malaysia-will-not-extend-state-emergency-bernama-2021-07-26/.

27 *Malaysia Would Use "Fake News" Law To Crush Media Freedom*, RSF (May 3, 2018), https://rsf.org/en/malaysia-would-use-fake-news-law-crush-media-freedom.

28 Adam Aziz, *Social media providers share input on fake news bill, says minister*, EDGE MALAY (Mar. 13, 2018, 7:55 PM), https://www.theedgemarkets.com/article/social-media-providers-share-input-fake-news-bill-says-minister.

29 David Brunnstrom & Praveen Menon, *U.S. State Department concerned by Malaysia's 'fake news' bill*, REUTERS (Apr. 3, 2018, 1:35 PM), https://www.reuters.com/article/us-malaysia-election-fakenews-usa-idUSKCN1HA27D; Kelly Buchanan, *Malaysia: Anti-Fake News Act Comes into Force*, LIBR. OF CONG. (Apr. 19, 2018), https://www.loc.gov/item/global-legal-monitor/2018-04-19/malaysia-anti-fake-news-act-comes-into-force/.

Apr. 11, 2018	The AFNA came into force officially.[30]
Apr. 30, 2018	The first conviction under the AFNA (A Danish citizen charged with spreading false news accusing Malaysian police of late response to a shooting via YouTube).[31]
May 9, 2018	The 2018 Malaysian general elections were held.[32] The Pakatan Harapan (PH) coalition won the elections and became the new government.[33] The ruling Barisan Nasional (BN) party was removed from authority following more than six decades of authoritarian governance.[34]
Aug. 17, 2018	The lower house of Parliament, which the PH controlled, proposed the first bill to repeal the AFNA.[35]
Sep. 12, 2018	The upper house of Parliament, which the BN controlled, rejected the first bill to repeal the AFNA.[36]
Apr. 9, 2019	Former Prime Minister Mahathir Mohamad confirmed the government's intention to repeal the AFNA.[37]
Oct. 9, 2019	The lower house of Parliament passed the second

30 Hidir Reduan & Luqman Arif Abdul Karim, *Anti-Fake News Bill is now law (NSTTV)*, NEW STRAITS TIMES (Apr. 11, 2018, 7:46 AM), https://www.nst.com.my/news/nation/2018/04/356083/anti-fake-news-bill-now-law-nsttv.

31 Yantoultra Ngui, *Malaysia Wields Law Against 'Fake News' for First Time*, WALL ST. J. (Apr. 30, 2018, 7:27 AM), https://www.wsj.com/articles/malaysia-wields-law-against-fake-news-for-first-time-1525087631.

32 Hannah Ellis-Petersen, *Malaysia Election: Mahathir sworn in as prime minister after hours of uncertainty*, GUARDIAN (May 10, 2018, 10:19 AM), https://www.theguardian.com/world/2018/may/10/malaysia-election-confusion-as-rival-questions-mahathirs-right-to-be-sworn-in.

33 *Id*.

34 *Id*.

35 Sheith Khidhir, *Combating fake news: A balancing act*, ASEAN POST (Aug. 21, 2018), https://theaseanpost.com/article/combating-fake-news-balancing-act.

36 Bernama, *Dewan Negara rejects Bill to repeal Anti-Fake News Act*, STAR (Sept. 12, 2018, 7:06 AM), https://www.thestar.com.my/news/nation/2018/09/12/dewan-negara-rejects-bill-to-repeal-anti-fake-news-act.

37 Hashini Kavishtri Kannan & Ahmad, *PM: Malaysia will repeal Anti-Fake News Act*, NEW STRAITS TIMES (Apr. 9, 2019, 6:36 AM), https://www.nst.com.my/news/nation/2019/04/477778/pm-malaysia-will-repeal-anti-fake-news-act.

	bill to repeal the AFNA.[38]
Dec. 19, 2019	The upper house of Parliament passed the second bill to repeal the AFNA. The AFNA was repealed officially.[39]
Jan. 12, 2021	The king of Malaysia declared a state of emergency due to the COVID-19 pandemic.[40]
Mar. 11, 2021	The Emergency (Essential Powers) (No. 2) Ordinance was issued on March 11 and came into force on March 12 without public consultation.[41] The law targeted COVID-19-related fake news.[42]
July 21, 2021	All emergency ordinances were annulled.[43]
Aug. 1, 2021	The state of emergency ended.[44]

38 Azril Annuar, *Anti-Fake News Act repealed by Dewan Rakyat again*, MALAY MAIL (Oct. 9, 2019, 6:11 PM), https://www.malaymail.com/news/malaysia/2019/10/09/anti-fake-news-act-repealed-by-dewan-rakyat-again/1798721.

39 *Finally, Dewan Negara approves repeal of Anti-Fake News Act*, STAR (Dec. 19, 2019, 5:56 PM), https://www.thestar.com.my/news/nation/2019/12/19/finally-dewan-negara-approves-repeal-of-anti-fake-news-act.

40 Rebecca Ratcliffe, *Malaysia declares Covid state of emergency amid political turmoil*, GUARDIAN (Jan. 12, 2021, 12:54 AM), https://www.theguardian.com/world/2021/jan/12/malaysia-declares-covid-state-of-emergency-amid-political-turmoil.

41 *Malaysia imposes emergency law to clamp down on COVID fake news*, REUTERS (Mar. 11, 2021, 6:46 AM), https://www.reuters.com/article/malaysia-politics-idUSL4N2L92ZH.

42 *Id*.

43 Eileen Ng, *Malaysia's Parliament opens after 7 Months, emergency to end*, AP (July 26, 2021, 6:35 AM), https://apnews.com/article/business-health-coronavirus-pandemic-malaysia-083e7446d51c90933cb1a0714bbc1aa7.

44 *Malaysia will not extend state of emergency, says law minister*, REUTERS (July 25, 2021, 11:58 PM), https://www.reuters.com/world/asia-pacific/malaysia-will-not-extend-state-emergency-bernama-2021-07-26/.

III. INTERNATIONAL STANDARDS FOR FREEDOM OF EXPRESSION

A. Defining Fake News

Since the 2016 U.S. Presidential Election, the fake news phenomenon has received broad attention from governments globally.[45] Many Southeast Asian governments, including Malaysia, have attempted to define and regulate the fake news problem through legal approaches.[46] Although there is a rich literature on the definitional problems of fake news, there is still no universally agreed-upon definition of fake news.[47] Some scholars consider defining fake news to be quite challenging because the umbrella term includes various types of messages, such as hoaxes, satire, propaganda, trolling, and commentary.[48] Furthermore, verifying the accuracy or intent behind a piece of information is difficult.[49] Other scholars argue that the definition of fake news is less than useful because the term is being loosely bandied about.[50] In light of this, this Article aims to explore the use of appropriate standards for conceptualizing fake news properly rather than proposing a new definition.

The term "fake news" is controversial because politicians frequently use it to label news sources that do not support their positions as unreliable or fake news.[51] Given this, some scholars and fact-checking organizations suggest avoiding using the term "fake news" because its meaning is polarized and not objective.[52] A handbook for journalism education and training published by the United Nations Educational, Scientific and Cultural Organization (UNESCO) also contends that "fake news" is often misused to describe reporting with which the claimant disagrees.[53] Instead, UNESCO's handbook suggests using the terms "disinformation" and "misinformation" to clarify and better understand the concept of fake news.[54] According to the

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45 Ric Neo, *The International Discourses and Governance of Fake News*, 12 GLOB. POL'Y 214, 214 (2021).

46 *See* Smith et al., *supra* note 2, at 128.

47 Donato Vese, *Governing Fake News: The Regulation of Social Media and the Right to Freedom of Expression in the Era of Emergency*, 13 EUR. J. OF RISK REGUL. 477, 479 (2021).

48 Mark Verstraete et al., *Identifying and Countering Fake News*, 73 HASTINGS L. J. 821, 826 (2022).

49 *Id*. at 835.

50 Ahran Park & Kyu Ho Youm, *Fake News from a Legal Perspective: The United States and South Korea Compared*, 25 SW. J. INT'L L. 100, 102 (2019).

51 *See* Soroush Vosoughi et al., *The Spread of True and False News Online*, 359 SCI. 1146, 1146 (2018).

52 *See, e.g.*, Étienne Brown, *"Fake News" and Conceptual Ethics*, 16 J. OF ETHICS & SOC. PHIL. 144, 145 (2019).

53 CHERILYN IRETON & JULIE POSETTI, JOURNALISM, 'FAKE NEWS' AND DISINFORMATION: A HANDBOOK FOR JOURNALISM EDUCATION AND TRAINING 43 (2018).

54 *Id*.

handbook, disinformation refers to dishonest information attempting to confuse or manipulate people, while misinformation generally refers to misleading information created or disseminated without malicious intent.[55] Therefore, intent provides a way to distinguish different types of fake news.[56]

In addition to UNESCO's definition, the European Commission has also put forth three crucial criteria for defining fake news: (1) the intent and the apparent objective pursued by fake news; (2) the sources of such news; and (3) the actual content of the news.[57] First, intent refers to whether fake news is deliberately created and distributed to mislead others and influence their thoughts and behavior.[58] Second, the sources of information are important.[59] News based on anonymous sources or a single, unverified source with limited context and an absence of alternative viewpoints may be considered fake and a violation of journalism standards.[60] Third, fake news refers to false content, such as manipulated facts or purposefully incorrect interpretations of events.[61] Therefore, it is essential to examine the actual content of the information.[62] In conclusion, both UNESCO and the European Union (EU) have offered clear guidelines for discerning fake news, including the intent, sources, and actual content of the information.[63] This Article argues that governments should consider these suggestions while utilizing legal approaches to address the fake news problem. Specifically, governments should avoid using the term "fake news" in legal descriptions and provide clear guidelines for identifying false information.

Regulating fake news is another challenging issue because it usually triggers public concerns about censorship and limits freedom of expression.[64] When evaluating speech restrictions executed by government authorities, it is crucial to consider whether the measures affect human rights because freedom of expression is one of the most salient human rights.[65] The following section introduces a cornerstone treaty within the United Nations (UN) human rights framework, namely the International Covenant on Civil and Political Rights (ICCPR).[66] This international treaty, broadly referenced

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55 *Id*.

56 *See id*.

57 EUR. COMM'N, SYNOPSIS REPORT OF THE PUBLIC CONSULTATION ON FAKE NEWS AND ONLINE DISINFORMATION (2018), available at https://ec.europa.eu/newsroom/dae/redirection/document/51810.

58 *Id*.

59 *Id.*

60 *Id*.

61 *Id*.

62 IRETON & POSETTI, *supra* note 53, at 43; EUR. COMM'N, *supra* note 57.

63 EUR. COMM'N, *supra* note 57.

64 Vese, *supra* note 47, at 479.

65 Evelyn M. Aswad, *In a World of "Fake News," What's a Social Media Platform to do?*, 4 UTAH L. REV. 1009, 1012-13 (2020).

66 International Covenant on Civil and Political Rights art. 19, Dec. 16, 1966, 999 U.N.T.S 171.

in numerous studies, provides foundational and critical standards for protecting freedom of expression.[67]

B. Article 19 of ICCPR

The International Covenant on Civil and Political Rights (ICCPR) is a critical international treaty adopted by the United Nations in 1966.[68] It safeguards fundamental human rights and provides international standards for protecting freedom of expression.[69] According to Article 19(1) of the ICCPR, "[e]veryone shall have the right to hold opinions without interference,"[70] which is an absolute human right.[71] Article 19(2) further describes that "[e]veryone shall have the right to freedom of expression; this right shall include freedom to seek, receive and impart information and ideas of all kinds, regardless of frontiers, either orally, in writing or in print, in the form of art, or through any other media of his choice."[72] Articles 19(1) and (2) provide foundational and broad protection for free expression.[73] In specific situations, however, freedom of expression may be subject to certain restrictions.[74] Article 19(3) indicates that any speech restrictions must meet the three well-established conditions: (1) must be provided by law; (2) must be necessary; and (3) must be used to protect the rights or reputations of others, national security, public order, and public health or morals.[75] The above three requirements are known as (1) legality, (2) necessity,[76] and (3) legitimacy.[77]

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67 Aswad, *supra* note 65, at 1013-14.

68 International Covenant on Civil and Political Rights art. 19, Dec. 16, 1966, 999 U.N.T.S 171.

69 *FAQ: The Covenant on Civil & Political Rights (ICCPR)*, ACLU (July 11, 2018), https://www.aclu.org/documents/faq-covenant-civil-political-rights-iccpr#:~:text=The%20ICCPR%20obligates%20countries%20thattreatment%2C%20and%20arbitrary%20detention%3B%20gender.

70 International Covenant on Civil and Political Rights art. 19, Dec. 16, 1966, 999 U.N.T.S 171.

71 William Magnuson, *The Responsibility to Protect and the Decline of Sovereignty: Free Speech Protection Under International Law*, 43 VAND. J. TRANSNAT'L L. 255, 279 (2010).

72 International Covenant on Civil and Political Rights art. 19(2), Dec. 16, 1966, 999 U.N.T.S 171.

73 *Id*.

74 Kevin Francis, *Time, Place and Manner Restrictions*, FREE SPEECH CTR. (Feb. 18, 2024), https://firstamendment.mtsu.edu/article/time-place-and-manner-restrictions/.

75 International Covenant on Civil and Political Rights art. 19(2), ¶ 3, Dec. 16, 1966, 999 U.N.T.S 171.

76 U.N. officials and scholars often use this term interchangeably with "proportionality." *See* Nadine Strossen, *United Nations Free Speech Standards as the Global Benchmark for Online Platforms' Hate Speech Policies*, 29 MICH. ST. INT'L REV. 307, 343-44 (2021).

77 *Id*. at 342-43.

1. Legality

Legality refers to the premise that speech restrictions must be "provided by law,"[78] and the law must be adopted by "regular legal processes."[79] The regular legal process means the court should comprehensively investigate individual claims within reasonable timeframes.[80] Also, the legislative processes should be transparent and accessible to the public;[81] secretly adopted speech restrictions will fail this fundamental requirement.[82] Additionally, the law should be written with sufficient precision,[83] meaning it should be written narrowly and tailored to avoid vagueness.[84] The "sufficient precision" requirement is critical because it enables individuals to distinguish lawful and unlawful expressions.[85] For instance, when enacting a fake news law, the government regulator must provide a clear, narrow definition of fake news to enable ordinary people to discern its scope.[86] In short, laws that infringe on the right to freedom of speech must be drafted precisely and narrowly.[87] Additionally, legality assurance should generally involve the oversight of independent judicial authorities.[88] In summary, legality rests on the above requirements that safeguard freedom of expression and restrict government arbitrariness.[89]

2. Necessity

Article 19(3) of the ICCPR requires that the adoption of speech restrictions must be "necessary" to achieve the public interest objective.[90]

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78 *Id*. at 343.

79 DAVID KAYE (SPECIAL RAPPORTEUR), REPORT OF THE SPECIAL RAPPORTEUR ON THE PROMOTION AND PROTECTION OF THE RIGHT TO FREEDOM OF OPINION AND EXPRESSION U.N. Doc. A/HRC/38/35, 4 (HUM. RTS. COUNCIL, THIRTY-EIGHTH SESSION 2018); Strossen, *supra* note 76, at 343.

80 *See* Demet Çelik Ulusoy, *A Comparative Study of the Freedom of Expression in Turkey and EU*, 43 TURK. Y.B. OF INT'L REL. 51, 136-37 (2013); *see also* Luan Hasneziri, *The Adversarial Proceedings Principle in the Civil Process*, 4 EUR. J. MKTG. & ECON. 88, 93 (2021).

81 Chi Ren, *supra* note 10, at 42.

82 DAVID KAYE (SPECIAL RAPPORTEUR), REPORT OF THE SPECIAL RAPPORTEUR ON THE PROMOTION AND PROTECTION OF THE RIGHT TO FREEDOM OF OPINION AND EXPRESSION U.N. Doc. A/HRC/38/35, 4 (HUM. RTS. COUNCIL, THIRTY-EIGHTH SESSION 2018).

83 *Id*. at art. 7.

84 Strossen, *supra* note 76, at 344.

85 *See id*.

86 *See* Amy Shepherd, *Extremism, Free Speech and the Rule of Law: Evaluating the Compliance of Legislation Restricting Extremist Expressions with Article 19 ICCPR*, 33 UTRECHT J. INT'L & EUR. L. 62, 66-67 (2017).

87 *See id*. ("[L]egislation restricting extremist speech needs to refer to a definition of extremism which targets with precision an identified harm.").

88 KAYE, *supra* note 82, at ¶ 7.

89 *See* Strossen, *supra* note 76, at 343.

90 International Covenant on Civil and Political Rights art. 19(3), Dec. 16, 1966, 999 U.N.T.S 171.

More specifically, speech restrictions to the right of freedom of expression should be directly related to the need they claim to serve.[91] Before implementing speech restrictions, states should demonstrate the precise nature of the threat to legitimate interests.[92] In the context of fake news, states should clearly explain how fake news threatens public interests (e.g., public order).[93] While restricting speech, states must use the least intrusive means.[94] More importantly, states may not merely assert the necessity of speech restrictions but must demonstrate it.[95] To prove the necessity of speech restrictions, a legal scholar proposed that a "three-part inquiry" should be undertaken by governments.[96] The first step for a state is to assess whether it can attain its public interest goals without limiting freedom of speech.[97] The second step involves evaluating whether the state has adopted the least intrusive measure when good governance measures are deemed insufficient to achieve the objective.[98] Finally, a state must determine if the implemented speech restrictions actually contribute to achieving the public interest goals.[99] Ultimately, the three steps help states assess the necessity of the enforced speech restrictions.[100]

3. Legitimacy

Legitimacy refers to whether the objective of speech restrictions is legitimate or not.[101] According to Article 19(3) of the ICCPR, speech restrictions must meet the following requirements: (1) for respect of the rights or reputations of others and (2) for the protection of national security or of public order or public health or morals.[102] Other purposes, including protecting the ruling party's interests, are not legitimate reasons for speech restrictions.[103] While Article 19(3) of the ICCPR provides reasons for restricting free expression, it is essential to ascertain how the overarching reasons, such as national security and public order, are defined under international human rights laws.[104]

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91 Shepherd, *supra* note 86, at 76.

92 Rebecca K. Helm & Hitoshi Nasu, *Regulatory Responses to 'Fake News' and Freedom of Expression: Normative and Empirical Evaluation*, 21 HUM. RTS. L. REV. 302, 311 (2021).

93 *Id*.

94 KAYE, *supra* note 82, at ¶ 7.

95 *Id*.

96 Aswad, *supra* note 65, at 1016.

97 *Id*.

98 *Id*.

99 *Id*. at 1017.

100 *Id*. at 1016-17.

101 KAYE, *supra* note 82, at ¶ 7.

102 International Covenant on Civil and Political Rights art. 19(3), Dec. 16, 1966, 999 U.N.T.S 171.

103 Aswad, *supra* note 65, at 1017.

104 Shepherd, *supra* note 86, at 71.

In fact, the term "national security" is not clearly defined in ICCPR and lacks international definition.[105] Some scholars suggest that the Johannesburg Principles provide a more specific description of national security.[106] According to the Johannesburg Principles, the punishment of expression as a threat to national security is contingent upon a government's ability to show that it is intended to incite imminent violence.[107] Also, a government must demonstrate a "direct and immediate connection" between the expression and the likelihood or occurrence of such violence.[108] In the context of fake news, a government should prove that the spread of fake news could directly lead to imminent violence, thus posing a threat to national security. "Public order" is ordinarily used to mean the absence of public disorder.[109] More specifically, public order can be understood as the rules that ensure society's functioning or the fundamental principles on which society is founded.[110] That is to say, if a government attempts to restrict information labeled as fake news or takes punitive measures against those who publish or spread such content, the government must explain how the information could disturb or harm public order.[111] In summary, governments must provide compelling reasons and evidence to justify the imposition of speech restrictions and the targeted legitimate objectives.[112]

IV. TEST THE FAKE NEWS LAWS BY ICCPR STANDARDS

As of February 2023, there are 173 parties to the ICCPR, with Malaysia being an exception, which means that the ICCPR is currently not applicable in Malaysia.[113] In fact, in 2013 and 2021, Malaysia's Deputy Foreign Minister expressed the federal government's intention not to sign the ICCPR: "Malaysia will sign ICCPR only if it is beneficial to the nation."[114] Although

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105 *Id*.

106 *See id*. at 72.

107 ARTICLE 6, THE JOHANNESBURG PRINCIPLES ON NATIONAL SECURITY, FREEDOM OF EXPRESSION AND ACCESS TO INFORMATION (1996), available at https://www.article19.org/wp-content/uploads/2018/02/joburg-principles.pdf [hereinafter Johannesburg Principles].

108 *Id*.

109 Elizabeth K. Cassidy, *Restricting Rights? The Public Order and Public Morality Limitations on Free Speech and Religious Liberty in Un Human Rights Institutions*, 13 REV. FAITH & INT'L AFFS. 5, 7 (2015).

110 *Id*. at 8.

111 *See generally id*. at 7-8.

112 *See generally id*.

113 *See UN Human Rights Committee to Review Egypt, Turkmenistan, Zambia, Peru, Sri Lanka and Panama*, U.N. HUM. RTS. OFF. HIGH COMM'R (Feb. 23, 2023), https://www.ohchr.org/en/press-releases/2023/02/un-human-rights-committee-review-egypt-turkmenistan-zambia-peru-sri-lanka.

114 Martin Carvalho, *Deputy Minister: Malaysia will sign ICCPR only if beneficial to nation*, STAR (Dec. 3, 2013, 11:59 AM), https://www.thestar.com.my/news/nation/2013/12/03/malaysia-iccpr-signatory/; *see also* Kenneth Tee, *Saifuddin: Putrajaya not looking to ratify UN's International Covenant on Civil and Political Rights yet*, MALAY MAIL (Nov. 10, 2021, 8:10 PM),

Malaysia has neither signed nor ratified the international treaty, some scholars argue that the Malaysian government still has an obligation to uphold human rights, including freedom of expression, by following the ICCPR.[115] In the following sections, I will apply ICCPR's three necessary standards—legality, necessity, and legitimacy—to assess whether Malaysia's fake news laws comply with international human rights law.

A. The Legality Test

As previously summarized, the legality standard includes several requirements. First, any speech restrictions must be "provided by law."[116] Second, the law must be adopted by "regular legal processes."[117] Third, the law should be written with "sufficient precision."[118] Fourth, legality assurance should generally involve the oversight of independent judicial authorities.[119] This section examines whether Malaysia's fake news laws fulfill the above requirements.

First, it is crucial to examine the legal definitions of fake news as stipulated in Malaysia's laws. Under Section 2 of the AFNA, "'[F]ake news' includes any news, information, data, and reports, which is or are wholly or partly false, whether in the form of features, visuals or audio recordings or in any other form capable of suggesting words or ideas."[120] Meanwhile, Section 2 of the Emergency Ordinance defined fake news as follows: "'[F]ake news' includes any news, information, data, and reports, which is or are wholly or partly false relating to COVID-19 or the proclamation of emergency, whether in the forms of features, visuals or audio recordings or in any other form capable of suggesting words or ideas.[121]

The only difference in the legal definition between the two laws is that, in the Emergency Ordinance, the definition of fake news is specific to COVID-19.[122] According to the definitions in the two laws, fake news refers to information that is "wholly or partly false."[123] However, both laws fail to clearly explain what qualifies as false or the criteria that can be used to

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https://www.malaymail.com/news/malaysia/2021/11/10/saifuddin-putrajaya-not-looking-to-ratify-uns-international-covenant-on-civ/2019931.

115 *See, e.g.*, Chi Ren, *supra* note 10, at 41.

116 *Id*. at 42; *see also* Strossen, *supra* note 76, at 344-45.

117 Chi Ren, *supra* note 10, at 42.

118 *Id*.

119 *See id*.

120 AFNA 2018, *supra* note 11, at pt. I, § 2.

121 *Emergency (Essential Powers) (No. 2) Ordinance 2021*, *supra* note 6, at 19-20.

122 *See id*. at 19.

123 *See id*. at 19-20.

identify falsity.[124] Furthermore, it is concerning that people can be accused of violating the laws merely because their statements are partly false.[125] The loose and unclear definition of fake news triggered public concerns, and scholars worried that the law (AFNA) could reinforce Malaysia as an authoritarian state.[126] Lawyers also warned that a vague definition of fake news might lead to inconsistent enforcement because it allows authorities to abuse the law.[127] Obviously, the legal definitions of Malaysia's fake news laws did not meet the "sufficient precision" requirement.[128] This Article argues that the Malaysian government should have addressed the issue by adopting the guidelines for defining fake news as suggested by the UN and the EU. For instance, in legal terminology, the government should avoid using the term "fake news" and instead use "misinformation" or "disinformation." In addition, the Malaysian government should have added specific criteria for identifying fake news in the two legislations, such as the intent, sources, and actual content of the information.

It is also crucial to examine the legislative processes of the two legislations. As previously mentioned, the legislative processes of the AFNA and the Emergency Ordinance are different.[129] The Malaysian Parliament passed the AFNA bill on April 3, 2018, an official legislative process.[130] However, the Emergency Ordinance was not passed by Parliament because

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124 Chi Ren, *supra* note 10, at 43; *see also Malaysia: Revoke 'Fake News' Ordinance*, HUM. RTS. WATCH (Mar. 13, 2021, 2:50 PM), https://www.hrw.org/news/2021/03/13/malaysia-revoke-fake-news-ordinance.

125 *See generally Emergency (Essential Powers) (No. 2) Ordinance 2021*, *supra* note 6, at 19-20; AFNA 2018, supra note 11, at pt. I, § 2; *see also Malaysia: Revoke 'Fake News' Ordinance*, HUM. RTS. WATCH (Mar. 13, 2021, 2:50 PM), https://www.hrw.org/news/2021/03/13/malaysia-revoke-fake-news-ordinance.

126 Moonyati Mohd Yatid, *Truth Tampering Through Social Media: Malaysia's Approach in Fighting Disinformation & Misinformation*, 2 INDON. J. SE. ASIAN STUD. 203, 220 (2019).

127 Zakiah Koya, *Vague definition of fake news may lead to inconsistent enforcement, warns Lawyers for Liberty*, STAR (Mar. 12, 2021, 1:59 PM), https://www.thestar.com.my/news/nation/2021/03/12/vague-definition-of-fake-news-may-lead-to-inconsistent-enforcement-warns-lawyers-for-liberty; *see also Malaysia: Revoke 'Fake News' Ordinance*, HUM. RTS. WATCH (Mar. 13, 2021, 2:50 PM), https://www.hrw.org/news/2021/03/13/malaysia-revoke-fake-news-ordinance; *Lawyers slam hypocrisy in govt's defence of media control*, MALAY. NOW (Sept. 2, 2023, 11:09 PM), https://www.malaysianow.com/news/2023/09/03/lawyers-slam-hypocrisy-in-govts-defence-of-media-control.

128 *See generally* Chi Ren, *supra* note 10, at 43; *see also Malaysia: Revoke 'Fake News' Ordinance*, HUM. RTS. WATCH (Mar. 13, 2021, 2:50 PM), https://www.hrw.org/news/2021/03/13/malaysia-revoke-fake-news-ordinance.

129 *See Malaysia imposes emergency law to clamp down on COVID fake news*, REUTERS (Mar. 11, 2021, 6:46 AM), https://www.reuters.com/article/idUSKBN2B31P6/; *U.S. State Department concerned by Malaysia's 'fake news' bill*, REUTERS (Apr. 3, 2018, 1:35 PM), https://www.reuters.com/article/us-malaysia-election-fakenews-usa-idUSKCN1HA27D/.

130 *U.S. State Department Concerned by Malaysia's 'Fake News' Bill*, REUTERS (Apr. 3, 2018, 1:35 PM), https://www.reuters.com/article/us-malaysia-election-fakenews-usa-idUSKCN1HA27D/.

Malaysia's king suspended it due to the COVID-19 pandemic.[131] Instead, the Emergency Ordinance was issued based on Article 150 (2B) of the Federal Constitution of Malaysia.[132] According to Article 150 (2B) of the Federal Constitution, if a proclamation of emergency is in operation, the king of Malaysia can promulgate ordinances in response to the emergency.[133] Given that the king of Malaysia declared a state of emergency on January 12, 2021,[134] the king's issuance of the Emergency Ordinances (No. 2) on March 11, 2021, was legal.[135]

While the legislative processes of the two laws appeared to comply with legal requirements, some people raised concerns about their problematic nature. Regarding the AFNA's legislative processes, some criticized the legislation as having been passed hastily and without proper public consultation.[136] Just over a month before the May 9, 2018, general elections, an international human rights organization, known as Article 19, claimed that the AFNA was rushed through Parliament without any serious public participation.[137] Why did the Malaysian government rush to pass the law? Some suggest that Parliament hurriedly passed and enacted the law before the 2018 general election because former Prime Minister Najib Razak wanted to use the law to tackle political dissenters.[138]

Prior to the enactment of the AFNA, Malaysian authorities, including the former Minister in the Prime Minister's Department, Azalina Othman Said, and the MCMC, extended invitations to digital platform companies.[139] Representatives from major platforms such as Google, Facebook, YouTube,

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131 Joseph Sipalan, *Malaysia defends coronavirus fake news law amid outcry*, REUTERS (Mar. 12, 2021, 2:06 PM), https://www.reuters.com/business/media-telecom/malaysia-defends-coronavirus-fake-news-law-amid-outcry-2021-03-12/.

132 Harsh Mahaseth, *Malaysia, Covid-19, And The New Fake News Ordinance: Is There A Reason To Be Apprehensive?*, MOD. DIPL. (July 2, 2021), https://moderndiplomacy.eu/2021/07/02/malaysia-covid-19-and-the-new-fake-news-ordinance-is-there-a-reason-to-be-apprehensive/.

133 CONSTITUTION OF MALAYSIA 1957, art. 150(2).

134 Rebecca Ratcliffe, *Malaysia Declares Covid State of Emergency Amid Political Turmoil*, GUARDIAN (Jan. 12, 2021, 00:54), https://www.theguardian.com/world/2021/jan/12/malaysia-declares-covid-state-of-emergency-amid-political-turmoil.

135 *See* CONSTITUTION OF MALAYSIA 1957, art. 150(2) ("A Proclamation of Emergency under Clause (1) may be issued before the actual occurrence of the event which threatens the security, or the economic life, or public order in the Federation or any part thereof if the Yang di-Pertuan Agong is satisfied that there is imminent danger of the occurrence of such event.").

136 *See, e.g.*, Chi Ren, *supra* note 10, at 43.

137 *Malaysia: Anti-Fake News Act Should Be Repealed in Its Entirety*, ARTICLE 19 (Apr. 24, 2018), https://www.article19.org/resources/malaysia-anti-fake-news-act-repealed-entirety/.

138 Bhavan Jaipragas, *Why is Najib pushing fake news laws before Malaysia election?*, S. CHINA MORNING POST (Mar. 11, 2018, 7:00 AM), https://www.scmp.com/week-asia/politics/article/2136601/why-najib-pushing-fake-news-laws-malaysia-election?module=perpetual_scroll_0&pgtype=article&campaign=2136601.

139 *See* Adam Aziz, *Social media providers share input on fake news bill, says minister*, EDGE MALAY. (Mar. 13, 2018, 7:55 PM), https://theedgemalaysia.com/article/social-media-providers-share-input-fake-news-bill-says-minister.

and Twitter were included in these discussions.[140] The primary goal was to engage in dialogue about the forthcoming bill, specifically crafted to tackle the issue of fake news.[141] However, the responses from digital platform companies regarding the AFNA were not made public.[142] News articles only reported that Malaysian authorities received positive feedback from internet giants, and authorities believed that platforms and the government should work together to resolve the fake news problem.[143] It might be worrisome if platform companies attended the meeting but did not express their concerns about the law's impact. Even if internet giants did not express their concerns, the legal regulations of the AFNA were controversial.[144] They received much criticism, such as the vague definition of fake news and fear of media censorship.[145]

Similarly, the legislative processes of the Emergency Ordinance in 2021 were also controversial.[146] Authorized by the Federal Constitution, the declaration of a state of emergency gives the government extraordinary powers, such as introducing and suspending laws without Parliament's approval,[147] as illustrated by the Emergency Ordinance. Human rights organizations criticize the enactment of the Emergency Ordinance as being hasty and without any effective public consultation or legislative oversight.[148] Instead of rushing to pass and enact the legislation, this Article argues that the Malaysian government should have communicated openly with the public and suspended the legislation.

Lastly, assessing whether the laws were adopted through regular legal processes is crucial. Under Section 9 of the AFNA, "[c]ourt may order for removal of the publication containing fake news by police officer or authorized officer."[149] This section gave the court sweeping powers to request authorities to remove publications containing information deemed fake news without transparency or clear processes.[150] Under Section 17 of

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140 *Id*.

141 *Id*.

142 *Id*.

143 *Malaysia Meets Social Media Giants Facebook, Twitter and Google to Discuss Fake News Law*, STRAITS TIMES (Mar. 13, 2018, 2:26 PM), https://www.straitstimes.com/asia/se-asia/malaysia-meets-social-media-giants-facebook-twitter-and-google-to-discuss-fake-news-law.

144 Marc Lourdes, *Malaysia's anti-fake news law raises media censorship fears*, CNN (Apr. 3, 2018, 11:54 PM), https://www.cnn.com/2018/03/30/asia/malaysia-anti-fake-news-bill-intl/index.html.

145 *Id*.

146 *Why A State of Emergency Raises Concerns In Malaysia*, REUTERS (Jan. 12, 2021, 6:21 AM), https://www.reuters.com/article/us-healthcare-coronavirus-malaysia-emerg-idUSKBN29H1HE.

147 *Id*.

148 *See, e.g., Malaysia: Emergency Fake News Ordinance has severe ramifications for freedom of expression*, ARTICLE 19 (June 23, 2021), https://www.article19.org/resources/malaysia-fake-news-ordinance-severe-ramifications-freedom-expression/.

149 AFNA 2018, *supra* note 11, at pt. III § 9.

150 *Malaysia: Anti-Fake News Act*, ARTICLE 19 (Apr. 24, 2018), https://www.article19.org/resources/malaysia-anti-fake-news-act/.

the Emergency Ordinance, "[a] police officer or an authorized officer may arrest any person whom he reasonably believes has committed or is attempting to commit an offense under this Ordinance."[151] It granted police officers broad powers to arrest individuals under the law without a warrant.[152] Likewise, judicial independence is likely another issue. In Malaysia, executive control has historically compromised judicial independence, resulting in courts frequently issuing arbitrary or politically biased decisions.[153] Human rights organizations contend that the Malaysian government's content blocking and removal requests are generally nontransparent and lack judicial oversight.[154]

In conclusion, this Article argues that the AFNA and the Emergency Ordinance did not fulfill ICCPR's legality principles for the following reasons. First, these two laws did not clearly define fake news sufficiently, making it difficult for ordinary people to distinguish lawful and unlawful expression based on vague legal definitions.[155] Second, the legislative processes of the two laws were problematic, with human rights organizations criticizing their rushed nature and lack of accessibility to the public.[156] Third, the two laws were not implemented through regular legal processes.[157] As earlier discussed, the independence of Malaysia's judiciary is often subject to government interference.[158] Also, the Emergency Ordinance empowered authorities to arrest individuals deemed to be spreading false information without a court's warrant.[159] Considering the reasons mentioned above, this Article argues that Malaysia's legal approaches to fake news did not meet the legality standards set by the ICCPR. The next section will examine whether the two laws fulfill the necessity principles.

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151 *Emergency (Essential Powers) (No. 2) Ordinance 2021*, *supra* note 6, at 25.

152 *Malaysia: Emergency Fake News Ordinance has severe ramifications for freedom of expression*, ARTICLE 19 (June 23, 2021), https://www.article19.org/resources/malaysia-fake-news-ordinance-severe-ramifications-freedom-expression/.

153 *Freedom in the World 2023-Malaysia*, FREEDOM HOUSE, https://freedomhouse.org/country/malaysia/freedom-world/2023 (last visited Mar. 29, 2024).

154 *Id*.

155 Strossen, *supra* note 76, at 338.

156 Chi Ren, *supra* note 10, at 42.

157 Zsombor Peter, *Malaysia Uses Emergency Powers to Impose 'Fake News' Law*, VOA (Mar. 13, 2021, 9:59 AM), https://www.voanews.com/a/press-freedom_malaysia-uses-emergency-powers-impose-fake-news-law/6203266.html.

158 *Freedom in the World 2023-Malaysia*, FREEDOM HOUSE, https://freedomhouse.org/country/malaysia/freedom-world/2023 (last visited Mar. 29, 2024).

159 *Malaysia: Emergency Fake News Ordinance has severe ramifications for freedom of expression*, ARTICLE 19 (June 23, 2021), https://www.article19.org/resources/malaysia-fake-news-ordinance-severe-ramifications-freedom-expression/.

B. The Necessity Test

Necessity is another essential criterion that any speech restrictions should meet according to ICCPR's standards.[160] As previously discussed, the necessity principle includes several aspects.[161] First, governments must demonstrate the precise nature of the threat that particular speech poses to legitimate interests.[162] Second, speech restrictions must be "necessary" to promote legitimate purposes.[163] Third, speech restrictions must be the least intrusive alternative.[164] To assess whether Malaysia's legal approaches meet the above standards, this Article first examines whether the Malaysian government provided sufficient evidence to demonstrate that fake news threatens public interests. Then, this Article summarizes the speech restrictions and penalties included in the AFNA and the Emergency Ordinance and analyzes the necessity of these restrictions.

In Malaysia, the discourse of fake news as a threat to national security may be traced back to 2017.[165] In March 2017, Malaysia's former Prime Minister, Najib Razak, declared that fake news jeopardized Malaysia's economic growth and should be regulated by law.[166] Prime Minister Najib Razak was referring to reports regarding the 1Malaysia Development Berhad (1MDB) scandal.[167] 1MDB is a government-run company set up to develop new industries and make investments.[168] In 2015, reports on the 1MDB scandal revealed that more than $700 million was deposited into Malaysian Prime Minister Najib Razak's bank account.[169] Since then, Prime Minister Najib Razak and the Malaysian government asserted that the relevant reports were fake news, initiating measures to suppress coverage of the issue.[170] Experts from academia, the legal field, and the media contend that the Malaysian government has not adequately demonstrated how fake news poses a specific threat to legitimate interests.[171] An empirical study found that

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160 Aswad, *supra* note 65, at 1016-17.

161 *Id*. at 1016.

162 Helm & Nasu, *supra* note 92, at 311.

163 Strossen, *supra* note 76, at 343.

164 Aswad, *supra* note 65, at 1016.

165 *Id*. at 1010-11.

166 Neo, *supra* note 15, at 317.

167 *See id*.

168 *Id*. at 325.

169 Tom Wright & Simon Clark, *Investigators Believe Money Flowed to Malaysian Leader Najib's Accounts Amid 1MDB Probe*, WALL ST. J. (July 2, 2015, 4:42 PM), https://www.wsj.com/articles/malaysian-investigators-probe-points-to-deposits-into-prime-ministers-accounts-1435866107.

170 Neo, *supra* note 15, at 325-26.

171 *See id*. at 316; *see also* Harsh Mahaseth & Gursimran, *Malaysia, Covid-19, And The New Fake News Ordinance: Is There A Reason To Be Apprehensive*?, MOD. DIPL. (July 2, 2021), https://moderndiplomacy.eu/2021/07/02/malaysia-covid-19-and-the-new-fake-news-ordinance-is-there-a-reason-to-be-apprehensive/.

most people do not believe the government will fairly implement the fake news law (AFNA).[172] Instead, they believe the AFNA had a more personal purpose, such as protecting Prime Minister Najib Razak's reputation and suppressing political dissent.[173] It appears that the government failed to convincingly illustrate the specific threat posed by fake news to legitimate interests.[174] As a result, the fake news laws did not garner support from civil society.[175] The following table further examines the restrictions and penalties of the two fake news laws.

Table 2. Offenses and Penalties Under the AFNA and the Emergency Ordinance

Offense	Maximum Sentence	
	AFNA 2018	**The Emergency Ordinance 2021**
Creating, offering, or publishing fake news[176]	● Imprisonment for 6 years ● Fine of RM500,000 ($115,000); a further fine of RM3,000 ($690) for every day that the offense continues	● Imprisonment for 3 years ● Fine of RM100,000 ($23,000); a further fine of RM1,000 ($230) for every day that the offense continues
Financial assistance for committing or facilitating the creation, offering, or publication of	● Imprisonment for 6 years ● Fine of RM500,000 ($115,000)	● Imprisonment for 6 years ● Fine of RM500,000 ($115,000)

172 Neo, *supra* note 15, at 328.

173 *Id*. at 327.

174 *See id.* at 316; *see also* Harsh Mahaseth & Gursimran, *Malaysia, Covid-19, And The New Fake News Ordinance: Is There A Reason To Be Apprehensive?*, MOD. DIPL. (July 2, 2021), https://moderndiplomacy.eu/2021/07/02/malaysia-covid-19-and-the-new-fake-news-ordinance-is-there-a-reason-to-be-apprehensive/.

175 Neo, *supra* note 15, at 328.

176 AFNA 2018, *supra* note 11, at pt. II, § 4(1); *Emergency (Essential Powers) (No. 2) Ordinance 2021*, *supra* note 6, at 21.

fake news[177]		
Failure to remove fake news[178]	• Fine of RM100,000 ($23,000); a further fine of RM3,000 ($690) for every day that the offense continues	• A person is liable for removing fake news within 24 hours of receiving notification • Fine of RM100,000 ($23,000); a further fine of RM3,000 ($690) for every day that the offense continues
Non-compliance with a court order to remove fake news[179]	• Fine of RM100,000 ($23,000)	

Table 2 summarizes the offenses, penalties, and restrictions included in the AFNA and the Emergency Ordinance.[180] These restrictions primarily targeted individuals, as the laws repeatedly use the term "any person" to specify the subject of the restrictions.[181] However, these restrictions could also be applied to internet service providers.[182] The international human rights organization, Article 19, contends that the Emergency Ordinance can also hold internet intermediaries accountable for the problem of fake news.[183] For instance, under Section 20(1) of the Emergency Ordinance, "the police

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177 AFNA 2018, *supra* note 11, at pt. II, § 5(1); *Emergency (Essential Powers) (No. 2) Ordinance 2021*, *supra* note 6, at 22.

178 AFNA 2018, *supra* note 11, at pt. II, § 6; *Emergency (Essential Powers) (No. 2) Ordinance 2021*, *supra* note 6, at 22 (explaining that the Ordinance required individuals to remove fake news within 24 hours after receiving notifications from a police officer or authorized officer, while the AFNA did not have the timeframe requirement).

179 AFNA 2018, supra note 11, at pt. III, § 7; *Emergency (Essential Powers) (No. 2) Ordinance 2021*, *supra* note 6, at 22-23.

180 *See supra* Table 2.

181 Anti-Fake News Act, Act 803 (Apr. 9, 2018) (Malay); *Emergency (Essential Powers) (No. 2) Ordinance 2021*, *supra* note 6, at 21-23.

182 Samantha Holmes, *Legal Analysis - Malaysia: Emergency (Essential Powers) (No. 2) Ordinance 2021 (Fake News Ordinance)*, ARTICLE 19 (June 23, 2021), https://www.article19.org/wp-content/uploads/2021/06/ARTICLE-19-Analysis-Malaysia-Emergency-Fake-News-Ordinance.pdf.

183 *Id*.

officer or authorized officer may, by a written notice, require a person who is in control of the communications system to disclose such traffic data in the manner specified in the written notice."[184] Additionally, Section 20(3) of the Emergency Ordinance stipulates that any person, including those in control of the communication system, may be fined or imprisoned for violating the legal provisions.[185]

Overall, Malaysia's legal approaches to fake news can be grouped into two categories: content removal and criminal sanction.[186] Regarding content removal, the two fake news laws authorized the court to order anyone, including individual internet users, internet intermediaries, and authorities (e.g., police officers), to remove, take down, or block content deemed fake news.[187] Statistics suggest that the Malaysian government often utilizes legal power to ask internet intermediaries to restrict online content.[188] For example, in recent years, the Malaysian government has requested social media platform companies, such as Facebook and Twitter (renamed as X in 2023), to restrict online content deemed violating local laws.[189] The following table presents data statistics regarding Facebook and Twitter's cooperation with the Malaysian government's requests to restrict online content.[190]

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184 *Emergency (Essential Powers) (No. 2) Ordinance 2021*, *supra* note 6, at 26.

185 *Id*. at 27.

186 AFNA 2018, *supra* note 11, at pt. II, §§ 4-6, pt. III, §§ 7-9; *id.* at 21-24.

187 AFNA 2018, *supra* note 11, at pt. III, §§ 7-9; *Emergency (Essential Powers) (No. 2) Ordinance 2021*, *supra* note 6, at 24.

188 *See, e.g.*, *Content Restrictions Based on Local Law – Malaysia*, META TRANSPARENCY CTR., https://transparency.fb.com/reports/content-restrictions/country/MY/ (last visited Jan. 30, 2024); *Removal Requests – Malaysia*, X TRANSPARENCY, https://transparency.twitter.com/en/reports/countries/my.html (last visited Jan. 30, 2024).

189 *Id*.

190 *Content Restrictions Based on Local Law - Malaysia*, META TRANSPARENCY CTR., https://transparency.fb.com/reports/content-restrictions/country/MY/ (last visited Jan. 30, 2024). The transparency report only provides information about the amount of content restricted in Malaysia by Facebook; it does not disclose the total number of legal demands from the Malaysian government for content removal that Facebook has received. According to the report, there are various reasons for the removal of the online content, including illegal hate speech, defamation, bullying, privacy violations, misinformation, etc. The transparency report does not provide further statistical data regarding the reasons for content removal. *Removal Requests - Malaysia*, X TRANSPARENCY, https://transparency.twitter.com/en/reports/countries/my.html (last visited Jan. 30, 2024). The transparency report only provides information about the total number of legal demands from the Malaysian government for content removal; it does not disclose the exact amount of content removed by Twitter. According to the report, removal encompasses two aspects: the removal of content and the removal of accounts. The transparency report is only updated with the latest data up to the year 2021. *Id.*

Table 3. Content Restrictions by Twitter and Facebook

Year	2018	2019	2020	2021
Amount of content restricted by Facebook from Malaysia[191]	26	255	386	245
Removal requests received by Twitter from Malaysia[192]	20	38	194	221

From 2018 to 2021, the Malaysian government requested Facebook and Twitter to restrict over one thousand pieces of illegal online content.[193] Freedom House, a US-based non-governmental organization that advocates for democracy, argues that content blocking and removal requests from the Malaysian government are generally nontransparent and lack judicial oversight or effective avenues for appeal.[194] For example, the MCMC, a regulatory authority in Malaysia responsible for overseeing the communications and media industries, periodically instructs individual users and internet intermediaries to remove content deemed illegal.[195] However, the criteria and processes for content removal are usually unclear, leading to concerns about arbitrary decisions.[196] It is also worth mentioning that apart from the AFNA and the Emergency Ordinance, the Malaysian government utilizes other existing laws for content moderation, such as the Penal Code, the Defamation Act, and the Communications and Multimedia Act.[197] Opponents from the legal fraternity argued against implementing fake news laws because the existing laws already have sufficient provisions enabling the Malaysian government to address fake news.[198]

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191 *Id*.

192 *Removal Requests – Malaysia*, X TRANSPARENCY, https://transparency.twitter.com/en/reports/countries/my.html (last visited Jan. 30, 2024). The transparency report only provides information about the total number of legal demands from the Malaysian government for content removal; it does not disclose the exact amount of content removed by Twitter. According to the report, removal encompasses two aspects: the removal of content and the removal of accounts. The transparency report is only updated with the latest data up to the year 2021. *Id.*

193 *Content Restrictions Based on Local Law – Malaysia*, META TRANSPARENCY CTR., https://transparency.fb.com/reports/content-restrictions/country/MY/ (last visited Jan. 30, 2024); *id*.

194 *Freedom on the Net 2022 - Malaysia*, FREEDOM HOUSE, https://freedomhouse.org/country/malaysia/freedom-net/2022 (last visited Jan. 30, 2024).

195 *Id*.

196 *See Malaysia: Civil society calls on new government to reform laws restricting freedom of expression and access to information*, ARTICLE 19 (May 22, 2018), https://www.article19.org/resources/malaysia-civil-society-calls-on-new-government-to-reform-laws-restricting-freedom-of-expression-and-access-to-information/.

197 Smith & Perry, *supra* note 21, at 138.

198 *See* Neo, *supra* note 15, at 328.

Generally, there are three common nation-level regulatory responses to information disorder: information correction, content removal, and criminal sanction.[199] The least intrusive form of speech restriction is information correction.[200] Social media platforms such as Facebook and Twitter use the label correction method to inform users when they identify a post that may contain false information.[201] Some governments, such as Singapore, also employ the information correction approach to address the issue of fake news online.[202] Content removal is more intrusive than information correction because it directly interferes with misleading or false information.[203] Criminal sanction is, undoubtedly, the most intrusive approach to speech restrictions.[204] Laws that contemplate criminal punishments rarely constitute the least intrusive means to achieve public interest objectives.[205] In general, criminal penalties should only be utilized when all other options have been exhausted and only in the most severe instances.[206] Scholars also argue fines and imprisonment are only used for more serious violations.[207]

After examining the legal provisions of the AFNA and the Emergency Ordinance, this Article argues that Malaysia's fake news laws do not adhere to the necessity principle, as they have not adopted the least intrusive approaches. Specifically, both laws rely on content removal approaches and criminal sanctions to tackle the fake news problem.[208] The laws did not employ information correction or other less intrusive alternative approaches, such as media literacy education and fact-checking.[209] If the Malaysian government explores alternative, less intrusive methods that may not effectively address fake news, it should present evidence demonstrating why these less intrusive approaches are ineffective. Furthermore, the government must justify why content removal and criminal penalties are necessary and adequate.[210] Scholars argue that no specific empirical study demonstrates that the threat of criminal sanctions can eliminate the creation or dissemination of fake news.[211] However, under Malaysia's fake news laws, offenders can face fines of up to RM 500,000 ($115,000) and imprisonment for up to six

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199 Helm & Nasu, *supra* note 92, at 315.
200 *Id*.
201 *Id*.
202 Aswad, *supra* note 65, at 1027.
203 Helm & Nasu, *supra* note 92, at 315.
204 *See generally id*. at 322.
205 Aswad, *supra* note 65, at 1021.
206 Helm & Nasu, *supra* note 92, at 322.
207 *Id*.
208 *See* ANFA 2018, *supra* note 11; *Emergency (Essential Powers) (No. 2) Ordinance 2021*, *supra* note 6, at 22.
209 *See id.*
210 *See generally* Cassidy, *supra* note 109, at 7-8.
211 Helm & Nasu, *supra* note 92, at 322-23.

years.[212] The government has not provided adequate justification for imposing such hefty fines and imprisonment, not to mention the inappropriateness of these restrictions.

In conclusion, this Article argues that Malaysia's legal approaches did not meet ICCPR's necessity requirement for three reasons. First, the Malaysian government did not demonstrate the precise nature of the threat posed by fake news.[213] Second, the two fake news laws do not employ the least intrusive means to address the fake news issue.[214] Third, the government has not provided convincing reasons to justify the necessity of the implemented restrictions, namely, content removal and criminal punishments.[215] The following section will examine whether the two fake news laws meet ICCPR's legitimacy requirements.

C. The Legitimacy Test

Legitimacy means any speech restrictions must protect only the interests enumerated in Article 19(3) of the ICCPR: the rights or reputations of others, national security or public order, or public health or morals.[216] Governments must provide compelling reasons to justify that the adopted speech restrictions are designed to promote one or more of the above legitimate objectives.[217] In the context of regulating fake news, potential legitimate interests include protecting the rights of others (e.g., the right to receive information) and maintaining public order (e.g., in cases where fake news threatens social stability).[218] One legal scholar suggests that legitimacy can be assessed from two aspects: the legislation itself and the actual measures taken under the legislation.[219] This Article applies the above standards to assess the legitimacy of Malaysia's fake news laws.

According to Section 8(3) of the AFNA and Section 8(3) of the Emergency Ordinance, the laws frame fake news as a threat to "national security" and "public order," justifying crackdowns.[220] The objectives seem

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212 *Id*. at 323.

213 Chi Ren, *supra* note 10, at 43; *see also* Zakiah Koya, *Vague definition of fake news may lead to inconsistent enforcement, warns Lawyers for Liberty*, STAR (Mar. 12, 2021, 11:59 PM), https://www.thestar.com.my/news/nation/2021/03/12/vague-definition-of-fake-news-may-lead-to-inconsistent-enforcement-warns-lawyers-for-liberty; *see also Malaysia: Revoke 'Fake News' Ordinance*, HUM. RTS. WATCH (Mar. 13, 2021, 2:50 PM), https://www.hrw.org/news/2021/03/13/malaysia-revoke-fake-news-ordinance.

214 *See* AFNA 2018, *supra* note 11; *Emergency (Essential Powers) (No. 2) Ordinance 2021*, *supra* note 6, at 22.

215 *See generally* Cassidy, *supra* note 109, at 7-8.

216 International Covenant on Civil and Political Rights art. 19(3), Dec. 16, 1966, 999 U.N.T.S 171.

217 *See* Strossen, *supra* note 76, at 343.

218 Aswad, *supra* note 65, at 1017.

219 Chi Ren, *supra* note 10, at 49.

220 AFNA 2018, *supra* note 11, at pt. II, § 4(1).

to align with ICCPR's legitimacy standards.[221] However, examining how the government defines "national security" and "public order" in the context of fake news is vital. States should not employ national security and public order as pretexts for imposing unclear and arbitrary restrictions on freedom of speech.[222]

The legislative purposes of the AFNA and the Emergency Ordinance are somewhat different. As previously mentioned, the enactment of the AFNA was primarily pushed by Prime Minister Najib Razak's aim to use the law to counteract relevant reports and public discussions surrounding the 1MDB scandal.[223] Malaysian government officials contend that some 1MDB-related reports are fake news, threatening the country's political stability and economic growth (i.e., national security).[224] However, there is a widespread belief that the AFNA was crafted to suppress political dissent, as Najib Razak faced public criticism regarding his involvement in the scandal.[225] Clearly, stifling public criticism does not constitute a legitimate objective for speech restrictions.[226] Conversely, the Emergency Ordinance was enacted during the COVID-19 pandemic, aiming to curb fake news related to COVID-19.[227] According to a Malaysian government official, "the ordinance is imperative to ensure that the people get authentic information from the right sources while maintaining national security and public order."[228] The government official did not further illustrate what constitutes national security and public order in the context of the pandemic.[229]

While the ICCPR does not precisely define "national security" and "public order," other international human rights standards, such as the Johannesburg Principles, emphasize the need for governments to demonstrate a "direct and immediate connection" between the expression and the likelihood or occurrence of violence.[230] However, under Section 4(1) of the Emergency Ordinance, any person "who is likely to cause fear or alarm

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221 *See* International Covenant on Civil and Political Rights art. 19, Dec. 16, 1966, 999 U.N.T.S 171; AFNA 2018, *supra* note 11, at pt. II, § 4(1).

222 *See* Shepherd, *supra* note 86, at 72.

223 Neo, *supra* note 15, at 6.

224 *Id*. at 12-13.

225 Imran Shamsunahar, *Malaysia's emergency ordinance and the clampdown on public discourse*, IDEAS (June 11, 2021), https://www.ideas.org.my/malaysias-emergency-ordinance-and-the-clampdown-on-public-discourse/.

226 International Covenant on Civil and Political Rights art. 19(3), Dec. 16, 1966, 999 U.N.T.S 171; *see* Strossen, *supra* note 76, at 343; Aswad, *supra* note 65, at 1017.

227 Imran Shamsunahar, *Malaysia's emergency ordinance and the clampdown on public discourse,* IDEAS (June 11, 2021), https://www.ideas.org.my/malaysias-emergency-ordinance-and-the-clampdown-on-public-discourse/.

228 *Emergency Ordinance only focuses on tackling fake news on Covid-19, Emergency Proclamation*, THE SUN (Dec. 3, 2021, 9:42 PM), https://thesun.my/local_news/emergency-ordinance-only-focuses-on-tackling-fake-news-on-covid-19-emergency-proclamation-updated-EY7203363.

229 *Id*.

230 Johannesburg Principles, *supra* note 107.

to the public" by creating, publishing, or disseminating fake news or information containing fake news can be considered in violation of the law.[231] Specifically, the Emergency Ordinance does not require any intent for a particular harm (e.g., incitement to imminent violence) caused by expression.[232] Human rights organizations criticize the loose and vague descriptions for failing to meet legitimacy standards.[233] Overall, enforcing the Emergency Ordinance has raised public concerns, with critics arguing that it is actually intended to suppress public discourse about the government's mismanagement of the public health crisis.[234]

Next, this Article will examine how the fake news laws were implemented. On April 30, 2018, a Danish citizen, the first person to be prosecuted under the AFNA, was accused by a Malaysian court of maliciously publishing a fake news video on YouTube.[235] In the video, the Danish citizen claimed that he encountered a gunfight and made countless calls to the Malaysian police, who arrived at the scene fifty minutes later.[236] However, police refuted these allegations, stating they reached the scene in less than ten minutes.[237] The Danish citizen was accused of publishing fake news, sentenced to a week in jail, and fined RM10,000.[238] Deputy Public Prosecutor Noor Jazilah Mohd Yushaa urged the court to set a strong sentence on the Danish citizen accused of disseminating fake news.[239] The prosecutor stated, "The accused's action did not only injure the image of the Police and our country but also hurt the feelings of the victim's family members."[240]

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231 AFNA 2018, *supra* note 11, at pt. II, § 4(1); *Emergency (Essential Powers) (No. 2) Ordinance 2021*, *supra* note 6, at 21.

232 *Emergency (Essential Powers) (No. 2) Ordinance 2021*, *supra* note 6, at 21.

233 *See, e.g.*, Samantha Holmes, *Legal Analysis - Malaysia: Emergency (Essential Powers) (No. 2) Ordinance 2021 (Fake News Ordinance)*, ARTICLE 19 (June 23, 2021), https://www.article19.org/wp-content/uploads/2021/06/ARTICLE-19-Analysis-Malaysia-Emergency-Fake-News-Ordinance.pdf.

234 Imran Shamsunahar, *Malaysia's emergency ordinance and the clampdown on public discourse,* IDEAS (June 11, 2021), https://www.ideas.org.my/malaysias-emergency-ordinance-and-the-clampdown-on-public-discourse/.

235 Camila Domonoske, *Danish Man Is First Person Sentenced Under Malaysia's Anti-Fake-News Law*, NPR (Apr. 30, 2018, 1:55 PM), https://www.npr.org/sections/thetwo-way/2018/04/30/607068241/danish-man-is-first-person-convicted-under-malaysias-anti-fake-news-law.

236 *Id*.

237 Jessica Lin, *Danish national to be first person charged under Malaysia's Anti-Fake News Act*, S. CHINA MORNING POST (Apr. 30, 2018, 12:31 PM), https://www.scmp.com/news/asia/southeast-asia/article/2143985/danish-national-be-first-person-charged-under-malaysias.

238 *Danish citizen is first person convicted under Malaysian anti-fake news law, jailed 1 week, fined RM10,000*, STRAITS TIMES (Apr. 30, 2018, 5:40 PM), https://www.straitstimes.com/asia/se-asia/foreigner-to-be-first-person-charged-under-malaysias-new-anti-fake-news-law.

239 Khairah N. Karim, *Danish Man First Person to be Charged, Convicted Under Anti-Fake News Act*, NEW STRAITS TIMES (Apr. 30, 2018, 4:18 AM), https://www.nst.com.my/news/crime-courts/2018/04/363835/danish-man-first-person-be-charged-convicted-under-anti-fake-news#google_vignette.

240 *Id*.

In this case, the Danish citizen faced charges of damaging the reputation of Malaysia's police and the nation through the spread of fake news.[241] Nevertheless, to what extent has the reputation of the police and the nation's image truly sustained damage? How might criminal punishments contribute to restoring the police's reputation and the nation's image? The Malaysian authorities did not offer specific explanations.[242] The Malaysian court's judgment raises questions about what exactly the AFNA aims to protect in terms of public interests.[243] The Emergency Ordinance also presents similar issues.[244] The MCMC claimed that the Ordinance protects individuals and organizations from falling victim to fake news.[245] Nevertheless, human rights organizations and scholars argue that the Malaysian government used the Emergency Ordinance to stifle free speech and suppress public discussions about its handling of the COVID-19 pandemic.[246] These cases illustrate that Malaysia's fake news laws do not fully meet the legitimacy standards of the ICCPR.[247]

V. CONCLUSION

As the first Southeast Asian country to pass the "fake news" law in 2018, Malaysia's legal approaches to fake news have garnered significant attention and criticism.[248] The dilemma between speech restrictions and freedom of speech has sparked numerous debates and scholarly interest.[249]

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241 *Id*.

242 Camila Domonoske, *Danish Man Is First Person Sentenced Under Malaysia's Anti-Fake-News Law*, NPR (Apr. 30, 2018, 1:55 PM), https://www.npr.org/sections/thetwo-way/2018/04/30/607068241/danish-man-is-first-person-convicted-under-malaysias-anti-fake-news-law.

243 *Id*.

244 AFNA 2018, *supra* note 11, at pt. III, § 6; *Emergency (Essential Powers) (No. 2) Ordinance 2021*, *supra* note 6.

245 *MCMC: Emergency Ordinance not to restrict freedom of speech, but to protect individuals and organizations from 'fake news*,' MALAY MAIL (Mar. 20, 2021, 8:05 AM), https://www.malaymail.com/news/malaysia/2021/03/20/mcmc-emergency-ordinance-not-to-restrict-freedom-of-speech-but-to-protect-i/1959368.

246 Samantha Holmes, *Legal Analysis – Malayasia.: Emergency (Essential Powers) (No. 2) Ordinance 2021 (Fake News Ordinance)*, ARTICLE 19 (June 23, 2021), https://www.article19.org/wp-content/uploads/2021/06/ARTICLE-19-Analysis-Malaysia-Emergency-Fake-News-Ordinance.pdf.; *see also* Smith & Perry, *supra* note 21, at 147.

247 Camila Domonoske, *Danish Man Is First Person Sentenced Under Malaysia's Anti-Fake-News Law*, NPR (Apr. 30, 2018, 1:55 PM), https://www.npr.org/sections/thetwo-way/2018/04/30/607068241/danish-man-is-first-person-convicted-under-malaysias-anti-fake-news-law.

248 *See* Khairah N. Karim, *Danish Man First Person to be Charged, Convicted Under Anti-Fake News Act*, NEW STRAITS TIMES (Apr. 30, 2018, 4:18 AM), https://www.nst.com.my/news/crime-courts/2018/04/363835/danish-man-first-person-be-charged-convicted-under-anti-fake-news#google_vignette; *see also MCMC: Emergency Ordinance not to restrict freedom of speech, but to protect individuals and organizations from 'fake news*,' MALAY MAIL (Mar. 20, 2021, 8:05 AM), https://www.malaymail.com/news/malaysia/2021/03/20/mcmc-emergency-ordinance-not-to-restrict-freedom-of-speech-but-to-protect-i/1959368.

249 *Id*.

This Article primarily utilizes ICCPR's three principles—legality, necessity, and legitimacy—to assess whether Malaysia's fake news laws align with international human rights standards on freedom of expression.[250] The main objectives of this Article are to evaluate Malaysia's speech restrictions and provide recommendations for governments and policymakers.

This Article first examines the legal definitions of fake news in two Malaysian laws—the AFNA 2018 and the Emergency Ordinance 2021 and analyzes the legality of the implemented speech restrictions.[251] This Article contends that the legal definitions of fake news are problematic for several reasons, and the restrictions do not meet the legality requirements. First, the legal definitions of fake news are too broad and vague, which cannot help ordinary people distinguish lawful and unlawful speech.[252] Thus, the Malaysian government should consider UNESCO and the EU's criteria for identifying and defining fake news.[253] Second, the legislative processes for the AFNA and the Emergency Ordinance lack transparency and accessibility to the public.[254] Third, the two fake news laws were not enacted through regular legal procedures.[255] These are significant reasons why Malaysia's fake news laws did not comply with the principles of legality.[256]

Next, for three major reasons, Malaysia's speech restrictions do not fulfill the necessity principles.[257] First, the Malaysian government did not demonstrate the precise nature of the threat posed to public interests by fake news.[258] Second, the adopted regulations were not the least intrusive means.[259] Malaysia's laws primarily used fines and imprisonment to regulate

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250 International Covenant on Civil and Political Rights art. 19, Dec. 16, 1966, 999 U.N.T.S 171.

251 AFNA 2018, *supra* note 11, at pt. III, § 6; *Emergency (Essential Powers) (No. 2) Ordinance 2021*, *supra* note 6; Strossen, *supra* note 76, at 343.

252 Marc Lourdes, *Malaysia's anti-fake news law raises media censorship fears*, CNN (Apr. 3, 2018, 11:54 PM), https://www.cnn.com/2018/03/30/asia/malaysia-anti-fake-news-bill-intl/index.html.

253 EUR. COMM'N, *supra* note 57.

254 *Freedom on the Net 2019-Malaysia*, FREEDOM HOUSE, https://freedomhouse.org/country/malaysia/freedom-net/2019 (last visited Feb. 17, 2024).

255 Zsombor Peter, *Malaysia Uses Emergency Powers to Impose 'Fake News' Law*, VOA (Mar. 13, 2021, 9:59 AM), https://www.voanews.com/a/press-freedom_malaysia-uses-emergency-powers-impose-fake-news-law/6203266.html.

256 EUR. COMM'N, *supra* note 57; *Freedom on the Net 2019-Malaysia*, FREEDOM HOUSE, https://freedomhouse.org/country/malaysia/freedom-net/2019 (last visited Feb. 17, 2024); Zsombor Peter, *Malaysia Uses Emergency Powers to Impose 'Fake News' Law*, VOA (Mar. 13, 2021, 9:59 AM), https://www.voanews.com/a/press-freedom_malaysia-uses-emergency-powers-impose-fake-news-law/6203266.html.

257 *See* Neo, *supra* note 15, at 316; *see also* Harsh Mahaseth & Gursimran, *Malaysia, Covid-19, And The New Fake News Ordinance: Is There A Reason To Be Apprehensive?*, MOD. DIPL. (July 2, 2021), https://moderndiplomacy.eu/2021/07/02/malaysia-covid-19-and-the-new-fake-news-ordinance-is-there-a-reason-to-be-apprehensive/.

258 *See id*.

259 Aswad, *supra* note 65, at 1021 (arguing that because both AFNA and the Ordinance rely on content removal approaches and criminal sanctions to talk fake news they have not adopted the least intrusive means to combat the issue).

individuals and internet intermediaries in order to reduce the dissemination of fake news.[260] Besides criminal sanction, the government frequently requested individuals and internet intermediaries to restrict content deemed false, which directly interferes with freedom of expression.[261] Third, the government has not provided convincing reasons to justify the necessity of the implemented restrictions.[262] Specifically, the authorities did not justify how content removal and criminal punishments can effectively address fake news.[263]

Lastly, the fake news laws did not fully meet the legitimacy principles because the government did not clarify the legitimate objectives.[264] Although the Malaysian government claimed that fake news threatens public order and national security, it failed to prove how public order and national security are actually impacted by fake news.[265] Instead, experts from different fields, such as lawyers and scholars, have raised concerns that the Malaysian government used public order and national security as pretexts to restrict freedom of speech.[266] This Article contends that the Malaysian government must clearly articulate the essence of public order and national security when regulating speech to address the issue of fake news. For instance, the government may consider adopting the Johannesburg Principles, which suggest that only expression capable of inciting immediate and imminent violence can be regulated or punished.[267] The government is also responsible for demonstrating that a particular expression poses a clear and direct threat to public interests.[268]

In conclusion, this Article contends that Malaysia's controversial fake news laws can offer valuable insights for many democratic governments. As an increasing number of governments contemplate adopting legal measures

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260 AFNA 2018, *supra* note 11.

261 *Id*.

262 *See* Neo, *supra* note 15, at 316; *see also* Harsh Mahaseth & Gursimran, *Malaysia, Covid-19, And The New Fake News Ordinance: Is There A Reason To Be Apprehensive?*, MOD. DIPL. (July 2, 2021), https://moderndiplomacy.eu/2021/07/02/malaysia-covid-19-and-the-new-fake-news-ordinance-is-there-a-reason-to-be-apprehensive/.

263 *See generally* Cassidy, *supra* note 109, at 7-8.

264 *See, e.g.*, Samantha Holmes, *Legal Analysis - Malaysia: Emergency (Essential Powers) (No. 2) Ordinance 2021 (Fake News Ordinance)*, ARTICLE 19 (June 23, 2021), https://www.article19.org/wp-content/uploads/2021/06/ARTICLE-19-Analysis-Malaysia-Emergency-Fake-News-Ordinance.pdf.

265 *MCMC: Emergency Ordinance not to restrict freedom of speech, but to protect individuals and organizations from 'fake news*,' MALAY MAIL (Mar. 20, 2021, 8:05 AM), https://www.malaymail.com/news/malaysia/2021/03/20/mcmc-emergency-ordinance-not-to-restrict-freedom-of-speech-but-to-protect-i/1959368.

266 *Id*.

267 Johannesburg Principles, *supra* note 107.

268 *Id*.

to tackle the issue of fake news in recent years,[269] the conflict and balance between speech restrictions and freedom of expression have garnered more attention.[270] By utilizing the ICCPR's legality, necessity, and legitimacy standards,[271] this Article has found that Malaysia's fake news laws exhibit numerous issues and do not adhere to international human rights standards. These issues may serve as valuable lessons for governments considering adopting legislation to tackle the problem of fake news.

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269 *See* Rostam J. Neuwirth, *The Global Regulation of "Fake News" in the Time of Oxymora: Facts and Fictions about the Covid-19 Pandemic as Coincidences or Predictive Programming?*, 35 INT'L J. SEMIOT L. 831, 834 (2022).

270 *See id.* at 832.

271 International Covenant on Civil and Political Rights art. 19, Dec. 16, 1966, 999 U.N.T.S 171.

REFORMING ILLINOIS PATERNITY/MATERNITY/ PARENTAGE ACKNOWLEDGMENT LAWS

Jeffrey A. Parness*

TABLE OF CONTENTS

I. INTRODUCTION

Not that long ago, most children born in the United States were conceived by consensual sex involving a husband and wife.[1] After nonmarital births and related governmental child support assistance steadily increased,[2] Congress enacted laws in the 1990s that gave federal aid to states providing such support under so-called IV-D programs contingent upon easy,

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1 *See* Gretchen Livingston, *The Changing Profile of Unmarried Parents*, PEW RSCH. CTR. (Apr. 25, 2018), https://www.pewresearch.org/social-trends/2018/04/25/the-changing-profile-of-unmarried-parents/. "One-in-four parents living with a child in the United States today are unmarried." *Id.* "Driven by declines in marriage overall, as well as increases in births outside of marriage, this marks a dramatic change from a half-century ago, when fewer than one-in-ten parents living with their children were unmarried (7%)." *Id.* Data on nonmarital families is reviewed in Clare Huntington, *Postmarital Family Law: A Legal Structure for Nonmarital Families*, 67 STAN. L. REV. 167, 186-91 (2015), and Jane Mauldon, Symposium, *Family Change and Welfare Reform*, 36 SANTA CLARA L. REV. 325, 326-33 (1996) (reviewing births from 1973-1993).

2 *See* MICHELLE J.K. OSTERMAN, NAT'L VITAL STAT. REP., BIRTHS: FINAL DATA FOR 2021 5 (2023) ("The birth rate for unmarried women was 37.8 births per 1,000 unmarried women aged 15-44 in 2021," with "the peak of 51.8 in 2007 and 2008.").

inexpensive, and fairly immutable paternity establishment laws, which governments could then use for financial aid reimbursements.[3] These laws largely encompassed in-hospital voluntary acknowledgments of paternity (VAPs).[4] Continuing federal subsidies were dependent upon certain paternity acknowledgment processes as well as effective enforcement.[5]

The federally-mandated VAP processes encompassed the requirement for signatures from both the birth mother and the "putative father."[6] Additionally, these processes mandated a sixty-day recission period, during which either signatory could retract their acknowledgment.[7] However, any challenges to VAPs after the sixty-day period were required to be grounded in claims of fraud, duress, or material mistake of fact.[8] Furthermore, the legislation imposed an obligation on states to recognize properly executed VAPs in other states.[9]

The availability of voluntary parentage acknowledgments beyond traditional VAPs has exploded in recent years.[10] This expansion offers opportunities for both men and women who lack genetic ties with children born from sexual intercourse to formally acknowledge parentage.[11] Further, voluntary parentage acknowledgments, including VAPs, are increasingly available beyond births arising from nonmarital sex.[12] In certain cases,

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3 *See* Omnibus Budget Reconciliation Act of 1993, Pub. L. No. 103-66, § 13721, 107 Stat. 312, 658–60 (1993); *see also* Personal Responsibility and Work Opportunity Reconciliation Act of 1996, Pub. L. No. 104-193, §§ 331–33, 110 Stat. 2105, 2227–31 (1996). These laws, and the earlier federal laws on state child support enforcement, are reviewed in several law review articles. *See generally* Linda D. Elrod, *Child Support Reassessed: Federalization of Enforcement Nears Completion*, 1997 U. ILL. L. REV. 695 (1997) (reviewing the history behind the Personal Responsibility and Work Opportunity Reconciliation Act (PRWORA) before explaining how PRWORA will increase federal enforcement of child support); Paul K. Legler, *The Coming Revolution in Child Support Policy: Implications of the 1996 Welfare Act*, 30 FAM. L.Q. 519 (1996) (explaining the PRWORA and examining the forthcoming changes resulting from it); Jane Mauldon, Symposium, *Family Change and Welfare Reform*, 36 SANTA CLARA L. REV. 325 (1996) (outlining the likely consequences of proposals that "reform" Aid to Families with Dependent Children while reviewing other policy strategies for assisting families with children).

4 *See* 42 U.S.C. § 666(a)(5)(C).

5 *See id*. at § 654(20). A state plan for child support should "have in effect all of the laws to improve child support effectiveness," which must include, per 42 U.S.C. § 666(a), procedures concerning paternity establishment. *Id*. at § 654(20)(A); *see also id.* at § 666(a)(5).

6 *Id*. at § 666(a)(5)(C)(i).

7 *Id*. at § 666(a)(5)(D)(ii).

8 42 U.S.C. § 666(a)(5)(D)(iii).

9 *Id*. at § 666(a)(5)(C)(iv).

10 *See* Gregg Strauss, *Parentage Agreements Are Not Contracts*, 90 FORDHAM L. REV. 2645, 2646–57 (2022) (noting how parentage agreements are proliferating to where there are various mechanisms for enabling adults to declare who will be a child's legal parent).

11 *See id*.

12 *See* Leslie J. Harris, *Voluntary Acknowledgments of Parentage for Same-Sex Couples*, 20 AM. U. J. GENDER SOC. POL'Y & L. 467, 475–76 (2012) (noting how voluntary acknowledgements of paternity "have become an exceptionally important way of establishing legal paternity" over children of unmarried women).

husbands who lack genetic ties may choose to execute parentage acknowledgments with their wives who have given birth.[13] Moreover, intended parents of children conceived through nonsurrogacy assisted reproduction can now sometimes employ parentage acknowledgments.[14]

In Illinois, parentage acknowledgments are primarily guided by the Illinois Parentage Act of 2015,[15] which took effect in January 2016.[16] Some important VAP issues under the Act arose in the recent Appellate Court case of *Illinois Department of Healthcare and Family Services ex rel. Hull v. Robinson*.[17] There, an Iowa VAP signed by a man who was not the genetic father was subject to challenge in Illinois when Illinois child support reimbursement was sought from the genetic father.[18]

This Article critically examines and urges reforms of the current Illinois VAP and other parentage acknowledgment laws. It first reviews the *Robinson* ruling, including both the raised VAP issues and some unstated VAP issues. It then examines the current availability of voluntary parentage acknowledgments in Illinois, beyond the VAPs, for children born of consensual sex and children born of nonsurrogacy or surrogacy assisted reproduction.

After that, this Article explores the 2000[19] and 2017 Uniform Parentage Acts[20] (UPAs) on parentage acknowledgments and state parentage acknowledgment laws outside of Illinois. This inquiry should aid Illinois lawmakers in reform efforts, including expanded parentage acknowledgment opportunities involving current and future parenthood. The Article posits reforms of Illinois laws on both paternity and maternity acknowledgments (i.e., those involving relevant genetic ties) and other parentage acknowledgments (i.e., those without genetic ties[21]), though recognizing a need for differentiating between these two types of acknowledgments.

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13 *See* Strauss, *supra* note 10, at 2651 ("Many courts have held that an acknowledgment of paternity binds its signatories, even if the parties knew the male signatory was not the genetic father.").

14 *See id*. at 2650 (explaining the steps for entering into a preconception agreement, which only applies if a female conceives through assisted reproductive technology and intends to parent the child).

15 750 ILL. COMP. STAT. 46/101 et seq. Of course, judicial precedents regulate when statutory terms are needy of interpretation, as with the "fraud, duress, and material mistake of fact" norms. *See id*. at 46/309(a).

16 *Id*. at 46/101 et seq., per P.A. 99-85 (eff. 1-1-16). Effective January 1, 2017, the Illinois Parentage Act, once found in *Id*. at 40/1 et seq., was repealed per P.A. 99-763. *Id.* at 40/15. The Illinois Parentage Act of 1984 was repealed as of January 1, 2016, per P.A. 99-85. *Id*. at 46/977.

17 Ill. Dept. Healthcare & Fam. Servs. *ex rel.* Hull v. Robinson, No. 4-22-1025, 2023 WL 5815829, at *4 (Ill. App. Ct. Sept. 8, 2023).

18 *Id*. (stating that notarized denial of paternity, in April 2017, was signed by Hull and Robinson).

19 UNIF. PARENTAGE ACT (UNIF. L. COMM'N 2000).

20 UNIF. PARENTAGE ACT (UNIF. L. COMM'N 2017).

21 The paper recognizes there can be biological, but not genetic, ties in the person giving birth, as with a gestational surrogate. The U.S. Supreme Court recognizes parental opportunity interests in sperm providers where nonmarital children are born of consensual sex. *See* Lehr v. Robertson, 463 U.S. 248, 262 (1983). It recognizes custodial parental interests in those who give birth to children born

II. THE CASE OF MARIO ROBINSON

In January 2015, Sara Hull delivered A.R. in an Iowa hospital.[22] Mario Robinson completed a VAP at the hospital the next day, acknowledging that he was "the biological father" and granting permission for birth certificate recognition.[23] In March 2015, this VAP was filed in the Iowa Vital Records Office.[24] Eventually, Hull, Robinson, and A.R. "ended up in Illinois—A.R. living with Hull" and Robinson "living elsewhere with apparently little to no contact with Hull and A.R."[25]

In March 2022, the Illinois Department of Healthcare and Family Services sued Robinson in Illinois for child support.[26] Robinson sought dismissal, claiming the Iowa VAP was signed "based upon the misrepresentation of Sara Hull,"[27] referencing "a notarized denial of paternity," dated April 4, 2017, and signed by Hull and Robinson.[28] Robinson also presented a 2019 DNA test indicating he was not A.R.'s biological father.[29] A month later, Robinson sued the Department in Illinois to "confirm nonpaternity."[30]

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of consensual sex. *See* Tuan Anh Nguyen v. I.N.S., 533 U.S. 53, 64–65 (2001) (explaining that "proof of motherhood" is inherent "in birth itself," wherein the mother, but not the biological father, had "an opportunity . . . to develop a real, meaningful relationship" before birth). The Supreme Court, to date, has not explicitly included those giving birth to children via pre-embryo implants containing only the genetic material of others. The recognition of biological, but not genetic ties, in a gestational parent can be confusing. *See, e.g.*, 750 ILL. COMP. STAT. 50/1(T-5) (indicating the terms "biological parent," "birth parent," and "natural parent" are "interchangeable," while indicating such parentage involves "a person who is biologically or genetically related" to a child). Confusion arises, inter alia, because biological ties alone, without genetic ties, can prompt different parentage norms than can biological and genetic ties. *See, e.g.*, Anca Gheaus, *Biological Parenthood: Gestational, Not Genetic*, 96 AUSTRALASIAN J. PHIL. 225, 226–39 (distinguishing genetic linkage and gestational linkage before arguing that the latter can better justify a right to rear). Consider the suggested and actual differences between gestational surrogates (biological ties) and genetic surrogates (both biological and genetic ties). Thus, genetic surrogates, but not gestational surrogates, can back out of surrogacy pacts post birth. *See, e.g.*, UNIF. PARENTAGE ACT § 808(a) (UNIF. L. COMM'N 2017) (allowing termination of gestational surrogacy contract "before an embryo transfer"), *followed in* VT. STAT. tit. 15C, § 806(a) (allowing the same "prior to any embryo transfer or implantation"); UNIF. PARENTAGE ACT § 814(a)(2) (UNIF. L. COMM'N 2017) (providing that genetic surrogate "may withdraw consent . . . any time before 72 hours after the birth"), *substantially followed in* WASH. REV. CODE §26.26A.765(1)(b) (providing that genetic surrogate "may withdraw consent" any time before 48 hours after the birth).

22 Ill. Dep't Healthcare & Fam. Serv. *ex rel*. Hull v. Robinson, 2023 WL 5815829, at *1, * 1 (Ill. App. Ct. Sept. 8, 2023).

23 *Id*.

24 *Id*.

25 *Id*.

26 *Id*.

27 *Id*.

28 Ill. Dep't Healthcare & Fam. Serv. *ex rel*. Hull v. Robinson, 2023 WL 5815829, at *1, * 1 (Ill. App. Ct. Sept. 8, 2023).

29 *Id*.

30 *Id*. at *1, * 2.

In a trial court hearing on Robinson's motion to dismiss the child support action, Hull, who was "not under oath," asserted that "she did not misrepresent anything"[31] and claimed that Robinson "knew he was not A.R.'s father" when he signed the Iowa VAP.[32] The court "rejected the VAP as a binding adjudication because it had not resulted from an adversarial proceeding before a tribunal."[33] It then dismissed the child support action with prejudice.[34]

On the Department's appeal, the appellate court reversed and remanded with directions to allow the state to "pursue legal action for child support."[35] Beyond noting lingering procedural law issues,[36] the court supplied some "guidance" upon remand.[37] Specifically, regarding any inquiry into "fraud, duress, or material mistake of fact," the court deemed Robinson's success "improbable," as VAP challenges can only be made on "narrow grounds," similar to "equitable grounds" used in rescinding contracts.[38] Additionally, the court cited an earlier Illinois Supreme Court case and an appellate court case on VAP challenges, generally finding they did not allow a VAP to be undone by a DNA test.[39]

In *Robinson*, the 2004 Illinois Supreme Court precedent, *People ex rel. Department of Public Aid v. Smith*, was cited for the proposition that "a man who signs a voluntary acknowledgment of paternity can[not] later seek to undo the acknowledgment on the basis of DNA test results."[40] In the *Smith* case, which predated the Illinois Parentage Act of 2015, the court looked to the acknowledgment form, which said that those signing a VAP "are waiving" the "right to have genetic testing."[41] The form also urged the signors to "have a genetic test if you are not sure who is the biological

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31 *Id*.

32 *Id*. She also asserted that nothing "was falsely given." Brief of Petitioner-Appellant at 10, Ill. Dep't Healthcare & Fam. Serv. *ex rel*. Hull v. Robinson, 2023 WL 5815829 (22FA8).

33 Ill. Dep't Healthcare & Fam. Serv. *ex rel*. Hull v. Robinson, 2023 WL 5815829, at *1, *2 (Ill. App. Ct. Sept. 8, 2023). The trial court also found Hull's statements did not "change genetics," were "irrelevant," and muddied up the water. Brief of Petitioner-Appellant at 10, Ill. Dep't Healthcare & Fam. Serv. *ex rel*. Hull v. Robinson, 2023 WL 5815829 (22FA8).

34 Ill. Dep't Healthcare & Fam. Serv. *ex rel.* Hull v. Robinson, 2023 WL 5815829, at *1, *2-3 (Ill. App. Ct. Sept. 8, 2023). A motion by the Department seeking reconsideration of the order was denied. *Id.*

35 *Id*. at *1, *6.

36 *Id*. at *1, *5. For example, the court found the dismissal motion, founded on a bar by "affirmative matter avoiding the legal effect of or defeating the claim," was deficient in that it and its attachments contained "nothing to support" Robinson's "misrepresentation claim." *Id*.

37 *Id*.

38 Ill. Dep't Healthcare & Fam. Serv. *ex rel*. Hull v. Robinson, 2023 WL 5815829, at *1, *5 (Ill. App. Ct. Sept. 8, 2023).

39 People *ex rel*. Dep't of Pub. Aid v. Smith, 818 N.E.2d 1204, 1205 (2004); *In re* Parentage of G.E.M., 890 N.E.2d 944, 955 (Ill. App. Ct. 2008).

40 *ll. Dep't Healthcare & Fam. Serv. ex rel. Hull*, 2023 WL 5815829, at ¶20.

41 *People ex rel. Dep't of Pub. Aid*, 818 N.E.2d at 1205.

father."[42] However, the *Smith* court recognized that a VAP could be challenged after sixty days "on grounds of fraud, duress, or material mistake of fact."[43] Critically, unlike in *Robinson*, the sperm provider's challenge in *Smith* to the VAP involving a nonmarital child born of sex did not include an allegation as to fraud, duress, or material mistake of fact.[44]

In re Parentage of G.E.M., a legal precedent set by the Illinois Appellate Court in 2008, involved a petition initiated by Renee, the mother, in 2001 against Louis in Will County, Illinois.[45] The purpose of the petition was "to determine the existence of a father/child relationship."[46] At the time of the child's birth in 1995, Renee and her "close friend" Richard had "voluntarily acknowledged paternity of the child at the hospital and the child's birth certificate named him the father and gave the child Richard's surname."[47] Richard was also declared the "natural father" upon agreement in a 1996 Illinois circuit court ruling in DuPage County, Illinois, wherein Renee had pursued a parentage order against Richard.[48] In May 2000, during a parentage action in DuPage County, Renee filed a pro se petition to terminate an existing child support order due to DNA testing showing Richard "is not the father."[49] Subsequently, the court terminated the child support in an August 2000 order, which declared Richard "not to be the father."[50]

When the child was six years old, Renee sued Louis for paternity in Will County.[51] Louis argued the 2000 DuPage County order, undoing Richard as the VAP father, was void.[52] Subsequently, Louis appealed a February 2005 Will County judgment that confirmed his paternity.[53]

The Illinois Appellate Court was tasked with interpreting the Illinois Parentage Act of 1984 "in order to determine the person responsible for this child's support" beyond the mother.[54] Regarding Richard's earlier VAP, the

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42 *Id*. at 1206.

43 *Id*. at 1207 (relying on the former provisions in 750 ILCS 45/6(d) as of 2002). The Smith court recognized that these grounds were not germane when presumed spousal parentage was sought to be rebutted by spouse of the birth mother. *Id*. at 1210.

44 *Id*. at 1208.

45 *In re* Parentage of G.E.M., 890 N.E.2d 944, 949 (Ill. App. Ct. 2008).

46 *Id*.

47 *Id*.

48 *Id*. at 950.

49 *Id*.

50 *Id*. at 951-52 (child support arrearages were reduced to zero and the child's name was changed from G.E.C. to G.E.M., reflecting the mother's surname).

51 *In re* Parentage of G.E.M., 890 N.E.2d 944, 952 (Ill. App. Ct. 2008).

52 *Id*.

53 *Id*. (noting there was also an October, 2006 order setting forth Louis' "financial obligations toward his child").

54 *Id*. at 953. Precedents under the 1984 Act are reviewed in Kelly M. Greco & Stephanie R. Hammer, *"Challenging Voluntary Acknowledgments of Paternity,"* 102 ILL. B.J. 432, 452 (2014) (concluding

court found that under the Act, consent to the VAP "is as legally binding on a parent as a DNA determination" if there is an "unconditional acceptance of the role of parent," unless rescinded or invalidated by a judicial determination of "duress, fraud, or mistake of fact."[55] The VAP was found under the Act to operate "as conclusively as a judicial determination based on evidence or a judgment establishing paternity."[56] Its operation, the court noted, was "not challenged" by Richard.[57]

In seeking to undo the VAP, Renee urged for Richard to be released from financial obligations while transferring those responsibilities to Louis, leaving "matters of the heart" "unaffected."[58] She argued that such relief was dictated by "equity and the best interests of the child."[59] However, the court stated that it had "no inherent powers to deviate from the statute" on parentage, which necessitates proof of fraud, duress, or material mistake of fact for any challenge to a VAP made beyond sixty days.[60] As this challenge occurred more than two years after the effective judgment, it would need to be pursued under the statute on relief from judgments.[61]

The Illinois Appellate Court sustained Louis's standing to challenge the earlier DuPage County judgment in Will County through collateral attack.[62] It found that the earlier order in DuPage County "was void from inception as he had argued."[63] Further, the court noted Renee "waived DNA testing with a contemporaneous understanding that DNA could disclose Richard was not the natural father," both in regards to the VAP and to obtaining the 1996 child support order.[64] Thus, the court found Renee had no standing to attack the child support order.[65] As noted, there was no challenge by Richard, as he presumedly wished that "matters of the heart" not be affected.[66]

Renee also urged that the VAP be undone because there was "fraud, duress, or material mistake of fact" involving Richard.[67] The court determined that only Richard could assert such a challenge, which he had

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"there is uncertainty in the Act and its application" after reviewing "prescribed limitations periods and standing requirements").

55 *In re* Parentage of G.E.M., 890 N.E.2d 944, 954 (Ill. App. Ct. 2008).

56 *Id*. at 954-55.

57 *Id*. at 955.

58 *Id*. at 956.

59 *Id*. at 953.

60 *Id*. at 956-57.

61 *In re* Parentage of G.E.M., 890 N.E.2d 944, 957 (Ill. App. Ct. 2008) (citing to 735 ILL. COMP. STAT. 5/2-1401).

62 *Id*. at 959.

63 *Id*.

See also id. at 964 ("The DuPage County order vacating Richard's parentage of G.E.M. was void for lack of subject matter jurisdiction.").

64 *Id*. at 959.

65 *Id*.

66 *In re* Parentage of G.E.M., 890 N.E.2d 944, 956 (Ill. App. Ct. 2008).

67 *Id*. at 960.

never done.[68] Relatedly, the court opined that if Renee pursued a VAP challenge by reopening the DuPage County case under the statute on relief from a judgment, Renee would not likely succeed because she admitted that "she had doubts regarding Richard's biological paternity from the day her son was born."[69]

III. STATED AND UNSTATED VAP ISSUES IN ROBINSON

Several significant issues on VAPs arise in *Robinson*.[70] Only some were recognized.[71] First, there are unstated choice of law issues involving the applicable standards for undoing a foreign VAP.[72] While the VAP was signed and filed in Iowa in 2015, the court employed Illinois VAP challenge laws since Mario brought a VAP challenge in an Illinois circuit court.[73] It cited VAP challenge provisions in the Illinois Parentage Act of 2015, which first took effect in 2016 and was amended and made effective in 2017.[74] However, the circumstances surrounding the Iowa VAP occurred in 2015, when VAPs in Illinois were governed by the Parentage Act of 1984.[75] The choice to use the 2015 Act perhaps is appropriate, at least for employing procedural (not substantive) provisions.[76]

However, VAP challenge laws seemingly include procedural and substantive law elements.[77] The *Robinson* court could have employed Illinois procedural law norms and Iowa substantive law norms, though the substance/procedure dichotomy is sometimes challenging.[78] As noted, one procedural norm involves choosing between conflicting state substantive laws.[79] The *Robinson* court used Illinois VAP challenge laws to find that Mario failed in his challenge.[80] However, the court acknowledged that Mario

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68 *Id*. at 959 (Richard "has not indicated that he no longer wishes to serve in the capacity as parent.").

69 *Id*. at 964.

70 Ill. Dept. Healthcare & Fam. Servs. *ex rel*. Hull v. Robinson, No. 4-22-1025, 2023 WL 5815829 (Ill. App. Ct. Sept. 8, 2023).

71 *See id*. at ¶9.

72 *Id*.

73 *Id*. at ¶5.

74 *Id*. at ¶9.

75 *Id*. at *4 (citing 750 ILL. COMP. STAT. 46/305(b), 46/307).

76 *See, e.g.*, Perry v. Dept. Fin. & Pro. Regul., 106 N.E.3d 1016, 1027 (Ill. 2018) ("[P]rocedural changes to statutes will be applied retroactively, while substantive changes are prospective only."), applied in Clanton v. United States, 943 F.3d 319, 324 (7th Cir. 2019) (discussing the effects of repeals of special remedial statutes, which seem more substantive than procedural, but are not applicable after repeal).

77 *See, e.g.*, IOWA CODE ANN. § 252A.3A (2023); 750 ILL. COMP. STAT. 46/301 (2017).

78 *See* Jeffrey A. Parness, *Faithful Parents: Choice of Childcare Parentage Laws*, 70 MERCER L. REV. 325, 370 (2019) [hereinafter Parness, *Faithful Parents*].

79 *See id*. at 327-29.

80 Ill. Dept. Healthcare & Fam. Servs. *ex rel*. Hull v. Robinson, No. 4-22-1025, 2023 WL 5815829, at *4 (Ill. App. Ct. Sept. 8, 2023).

might have had an opportunity to challenge the VAP in Iowa, hinting at least some substantive VAP norms could still be raised.[81]

Such tricky questions on choices of parentage laws in multistate cases could be avoided if an Illinois law demanded that any VAP set aside be determined by a tribunal in the state where the VAP, an effective judgment, was executed. In California, when a foreign state VAP—considered a judgment[82]—is challenged, a California court cannot set aside or vacate the VAP.[83]

In Iowa, as in Illinois, a VAP can be challenged after sixty days due to "fraud, duress, or material mistake of fact."[84] While these elements are demanded by a federal statute involving participating IV-D states, including Illinois and Iowa, they are not further defined by federal lawmakers and have been subject to varying state law meanings.[85]

As noted, the choice of Illinois law on VAP challenges in *Robinson* could have been based on the Illinois Parentage Act of 2015, as it applies "to determination of parentage in this State,"[86] meaning the Act applies to cases involving the adjudication of "the parent-child relationship," and that Illinois law can operate at times regardless of "the past or present residence of the child" or "the place of birth of the child."[87] However, the Act may not compel the choice to employ Illinois VAP challenge laws.[88] The Act simply says the choice of law cannot "depend" on the place of residence or birth.[89] It does not foreclose the use of these places in an interest analysis—a test regularly employed in choosing between conflicting substantive state laws.[90] Applying

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81 Estoppel issues went unnoted. *Id*.

82 CAL. FAM. CODE § 7573 (2020) ("[A] completed voluntary declaration of parentage . . . is equivalent to a judgment of parentage . . . .").

83 CAL. FAM. CODE § 7648.3 (2005) ("A court may not [set aside or vacate] a judgment [that] was made or entered by a tribunal of another state, even if the enforcement of that judgment is sought in this state.").

84 IOWA CODE ANN. 600B.41A(3)(f)(2) (2023); 750 ILL. COMP. STAT. 45/6(d) (repealed 2016); 750 ILL. COMP. STAT. 46/309(a) (2017).

85 Jeffrey A. Parness & David A. Saxe, *Reforming the Processes for Challenging Voluntary Acknowledgments of Paternity*, 92 CHI.-KENT L. REV. 177, 194-96 (2017).

86 750 ILL. COMP. STAT. 46/104(a) (2016).

87 *Id*. at 46/104.These norms appear in both the 2000 and 2017 Uniform Parentage Act. UNIF. PARENTAGE ACT § 103 (UNIF. L. COMM'N 2000); UNIF. PARENTAGE ACT § 105 (UNIF. L. COMM'N 2017). In declaring that the "applicable law does not depend on" birthplace or residence, the Illinois Parentage Act of 2015 rejects the use of a *lex loci* approach. 750 ILL. COMP. STAT. 46/104 (2016); *see, e.g*., Barbara's Sales, Inc. v. Intel Corp., 879 N.E.2d 910, 919-20 (Ill. 2007) (recognizing the jettison of the *lex loci* delicti rule (i.e., "place of injury rule") in a deceptive business practice case).

88 *See* 750 ILL. COMP. STAT. 46/104 (2016).

89 *Id*.

90 The 1996 Uniform Interstate Family Support Act (UIFSA) did suggest that in determining the parentage of an out-of-state resident for child support purposes, a court shall "apply the procedural and substantive law, including the rules on choice of law" that generally apply to similar proceedings. But the phrase on the choice of law rules was stricken in the 2001 UIFSA and did not

an interest analysis to Robinson at least strongly suggests that the use of Iowa law is compelled by federal Full Faith and Credit principles since all relevant facts on the VAP establishment occurred in Iowa.[91]

A separate procedural law norm, only applicable to in-state law choices, answers the question of which version of a VAP challenge law operates when the law changes during the activities relevant to a VAP proceeding.[92] Such activities seemingly include the child's date of birth; the date of the VAP execution; the date(s) of alleged fraud, duress, or material mistake of fact; the date of the initial objection to the VAP; and the date the VAP was formally challenged.[93] In *Robinson*, the VAP was signed in Iowa in 2015 but was first challenged in a 2022 Illinois child support case.[94] The VAP norms in Illinois changed on January 1, 2016, when the Illinois Parentage Act of 2015 took effect.[95]

Yet another procedural law norm involves the timing of a VAP challenge: The time limits on pursuing a VAP challenge after sixty days.[96] While federal law authorizes post-sixty-day challenges,[97] state VAP laws vary on the time limits for presenting such challenges.[98] The *Robinson* court did not consider whether Mario's claim of nonpaternity, including the challenge to the earlier VAP, was timely as it deemed a successful challenge was "improbable."[99] In Illinois, a VAP "signatory" can now only petition to challenge the VAP after sixty days on "fraud, duress or material mistake of fact" grounds, which must be undertaken within two years of the VAP's

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appear in the two later UPAs. Parness, *Faithful Parents*, *supra* note 78, at 328-30 (reviewing the UIFSA and UPA provisions).

91 Interest analyses are often used in Illinois cases involving a choice between competing state substantive laws. *See, e.g.*, *Barbara's Sales, Inc.,* 879 N.E.2d at 919-20 (employing multifactor test under the Restatement (Second) of Conflict of Laws). In Robinson, there was the unstated issue of Full Faith and Credit obligations of Illinois courts when an Illinois forum has no "significant contact or significant aggregation of contacts" to the "claims asserted," especially where there is an "expectation of the parties" that non-Illinois law will apply to certain issues. *See, e.g.*, Phillips Petroleum Co. v. Shutts, 472 U.S. 797, 821-22 (1985).

92 *See generally* UNIF. PARENTAGE ACT § 103 (UNIF. L. COMM'N 2000); UNIF. PARENTAGE ACT § 105 (UNIF. L. COMM'N 2017) (showing that the Uniform Parentage Act has been amended since its enactment. This presents the question of which version controls when different versions exist at different times).

93 *See generally id*.

94 Ill. Dept. Healthcare & Fam. Servs. *ex rel*. Hull v. Robinson, No. 4-22-1025, 2023 WL 5815829, at *1 (Ill. App. Ct. Sept. 8, 2023).

95 750 ILL. COMP. STAT. 46/104 (2016).

96 *See* Parness & Saxe, *supra* note 85, at 194.

97 42 U.S.C.A. § 666(a)(5)(D)(iii) (2012).

98 Parness & Saxe, *supra* note 85, at 194.

99 *Ill. Dept. Healthcare & Fam. Servs. ex rel. Hull*, No. 4-22-1025 at *5.

effectiveness.[100] In Iowa, the time period for challenges and the circumstances for tolling the running of time may differ.[101]

Substantively, *Robinson* has issues with the meaning of fraud, duress, and material mistake of fact, with proof of at least one of them a necessary element, per federal statute, in any successful VAP challenge.[102] The elements covered in Iowa and Illinois statutes are generally similar because the federal Social Security Act requirements for IV-D states guide them.[103] However, the definitions of fraud, duress, and material mistake of fact are currently determined by each state.[104] Across the country, state laws differ on the meanings of fraud, duress, and material mistake of fact in VAP challenges.[105]

IV. ILLINOIS VAP ISSUES BEYOND ROBINSON

In addressing the aforesaid issues, there should be simultaneous legislative and judicial consideration of several important unstated VAP challenge issues. Reforms could follow suggested UPA provisions or differing state laws. Before looking to UPA suggestions and state laws elsewhere, a brief survey of some VAP issues in Illinois going beyond *Robinson* is in order, including a review of possible parentage acknowledgments beyond paternity.

Childcare, child support, and other parentage norms are necessary for children who are not born of sex.[106] As demonstrated below, such parentage can now be prompted by state acknowledgment laws that operate beyond VAPs; however, these acknowledgment laws may employ different processes (on parentage establishments and later parentage challenges) than are used with VAPs.[107]

Of the two VAP Illinois precedents cited in *Robinson*, the Illinois Supreme Court ruling in the *Smith* case provides no insights into VAP

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100 750 ILL. COMP. STAT. 46/308, 46/309 (2017).

101 *See* IOWA CODE. ANN. §§ 600B.41A.(3)(f), 252A.3A (failing to mention post sixty-day challenge); *see generally* Smith v. Widmyer, No. 01-0863, 2002 WL 575794 (Iowa Ct. App. Mar. 13, 2002) (discussing a 1996 VAP challenged for mistake in 1999). The Department argued in a motion for reconsideration that the VAP was initially valid under Iowa law, whose statutes would deem Robinson's challenge "did not meet" the requirements for rescission. Ill. Dept. Healthcare and Fam. Servs. *ex rel*. Hull v. Robinson, No. 4-22-1025, 2023 WL 5815829, at *3 (Ill. App. Ct. Sept. 8, 2023).

102 42 U.S.C.A. § 666(a)(5)(D)(iii) (2012).

103 Parness & Saxe, *supra* note 85, at 181-83.

104 *Id*. at 194.

105 *Id*. at 196-99.

106 *See* Jeffrey A. Parness, *The Constitutional Limits on Custodial and Support Parentage by Consent*, 56 IDAHO L. REV. 421, 452 (2020) [hereinafter Parness, *The Constitutional Limits on Custodial and Support Parentage by Consent*].

107 *See* 750 ILL. COMP. STAT. 46/703 (2017); 750 ILL. COMP. STAT. 46/709 (2023).

laws.[108] This is because the statutes were simply recited with a finding that the post-sixty-day challenge by the sperm provider did not allege fraud, duress, or material mistake of fact.[109]

By contrast, VAP issues beyond those discussed in *Robinson* arose in the 2008 *G.E.M.* decision, which was cited in *Robinson*.[110] One such issue revolved around whether a VAP parent, such as Richard, could be relieved of financial responsibilities for a child where he and the child's mother wished for his nonfinancial, parental responsibility interests to continue.[111] This would potentially designate Louis as a child support parent but not necessarily a childcare parent.[112] Seemingly, under the U.S. Supreme Court precedent in *Lehr v. Robertson*, Louis—as the sperm provider—had not seized his parental childcare opportunity interest.[113] Yet, such a seizure does not necessarily remove his child support duties.[114] Louis' support duty would benefit Renee, her child, Richard, and the State (especially if it provided IV-D financial aid).[115] This seemingly raises the question: Would allowing a child support order against Louis for a child cared for by Renee and Richard run contrary to the Illinois policy on only two parents?

Another issue beyond *Robinson* involves who is eligible to undertake a post-sixty-day VAP challenge and whether comparable standards apply to the birth mother, the signing alleged "biological father," and any other challenger.[116] As to standing to challenge a VAP, the court in *G.E.M.* hinted that only Richard could challenge.[117] However, it also indicated that any challenge by Renee, if recognized, would fail due to the absence of fraud, duress, or material mistake of fact.[118] With each signatory having some standing to challenge a VAP, judicial approaches to factfinding on fraud, duress, and mistake should vary by challenger, as often only the birth mother knows whether a VAP child may have been or was conceived via sex with a nonsignatory.[119]

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108 Smith v. Widmyer, No. 01-0863, 2002 WL 575794, at *1 (Iowa Ct. App. Mar. 13, 2002).
109 *Id*.
110 *See In re* Parentage of G.E.M., 890 N.E.2d 944 (Ill. App. Ct. 2008).
111 *Id*. at 951-52.
112 *Id*.
113 *Id*. at 950.
114 Parness, *The Constitutional Limits on Custodial and Support Parentage by Consent*, *supra* note 106, at 452-54.
115 *See In re* Parentage of G.E.M., 890 N.E.2d 944, 1112 (Ill. App. Ct. 2008).
116 *See generally* 410 ILL. COMP. STAT. 535/12(4) (2017).
117 *In re* Parentage of G.E.M., 890 N.E.2d 944, 960 (Ill. App. Ct. 2008).
118 *Id*. at 959-60.
119 750 ILL. COMP. STAT. 46/308 (2017).

The Illinois Parentage Act of 2015 presents a seeming contradiction regarding challenges to VAPs.[120] On one hand, it declares "a signatory" of a VAP "may commence a proceeding to challenge" a VAP.[121] However, elsewhere in the Act, it states that where a child has an acknowledged parent, "an individual, other than the child," who is not a signatory, can seek an adjudication of parentage "not later than 2 years after the effective date of the acknowledgment."[122] Here, an alleged genetic parent seemingly has an opportunity to challenge the acknowledgment, assuming they have not previously forfeited their childcare rights or interests.[123]

However, can the State, rather than an "individual," also have standing to challenge a VAP? If no direct challenge is allowed, could the State challenge a VAP by utilizing the standing of a signing birth mother, a signing alleged biological father, or a child, as where reimbursement for state financial aid is to be ultimately sought from the actual biological father?[124] If so, the State may be foreclosed where a signatory is foreclosed, even when there is no fraud, duress, or material mistake of fact.[125] However, if the State committed no fraud or the like, should it lose reimbursement opportunities?

In addition, which individuals, apart from signatories and the child, possess the ability to challenge? Should a presumed parent of the child, through the spousal parent presumption, where no earlier spousal denial of parentage was filed as mandated, and the VAP solely lists the birth mother and a genetic parent, have the right to challenge?[126] What about an alleged genetically tied grandparent, aunt, uncle, sibling, or other relative of the child? A child seemingly can pursue "a complaint to adjudicate parentage"

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120 *Id*. Before the 2015 Parentage Act, 750 ILCS 45/7(b) repealed by P.A. 99-85, eff. 1-1-2016, a child (and the child's guardian ad litem) could challenge a VAP. *See, e.g., In re* A.A., 2015 IL 118605, ¶¶ 24-25.

121 *Id*.

122 750 ILL. COMP. STAT. 46/609(b) (2016) (A "child" is not limited in time to challenging a VAP, as challenge limits operate only for a VAP signatory and "an individual, other than the child.").

123 *Id*.

124 *See In re* M.B., 2022 IL App (5th) 220245, ¶16. (noting that in a spousal parent rebuttal case, the State had no standing to undo a husband's presumed parenthood as the Parentage Act of 2015, 750 ILL. COMP. STAT. 46/204(a) (2017) recognizes an action to declare the non-existence of a parent-child relationship may be brought by the "child, the birth mother, or a person presumed (i.e., a spouse) to be a parent," while also recognizing that under 750 ILL. COMP. STAT. 46/608(a) (2016) an "alleged father" may "commence an action to establish a parent-child relationship for a child having a presumed (i.e., spousal) parent).

125 750 ILL. COMP. STAT. 46/309(a) (2017) (noting the State may be foreclosed from challenging, via the birth mother's standing, the presumptive parentage of the birth mother's spouse where more than two years have passed since the birth mother "knew or should have known" there were no genetic ties in the spouse where a child is born of sex); *id*. at 46/205(b); 750 ILL. COMP. STAT. 46/608(a) (2016); *In re* M.B., 2022 IL App (5th) 220245, ¶¶13-15.

126 *See* 750 ILL. COMP. STAT. 46/302 (2017) (explaining a presumed parent must sign a denial in order for another to execute a VAP); 410 ILL. COMP. STAT. 535/12(4) (2017) (noting the presumed parent may be a sperm provider via consensual sex or assisted reproduction or an egg provider via assisted reproduction (fertilized egg implant)).

in Illinois against someone other than the alleged genetic father who signed a VAP.[127]

V. PARENTAGE ACKNOWLEDGMENTS IN ILLINOIS BEYOND VAPS?

The *Robinson* case involved a voluntary paternity acknowledgment.[128] In Illinois, such a VAP is typically undertaken through a form prescribed by the Illinois Department of Healthcare and Family Services.[129] The form prompts the establishment of legal parenthood through the signing of the birth mother and the signing of the "biological father" of a child born of sex.[130] Where the birth mother is married to someone who is not the genetic parent of a child born of sex, a VAP can be employed by that genetic parent and birth mother to establish parentage,[131] even though the spouse is considered a presumed parent.[132]

However, it is important to note that current Illinois statutes do not explicitly recognize voluntary paternity/maternity/parentage acknowledgments for children born of assisted reproduction.[133] While an "intended" parent who does not give birth can secure "legal" parenthood if a valid nonsurrogacy assisted reproduction "agreement" is "entered into prior to any insemination or embryo transfer,"[134] questions arise regarding the inclusion of sperm donors as intended parents in pursuing a VAP. Specifically, should a sperm donor, as an intended parent together with the gestational parent, be able to pursue a VAP? The current VAP form in Illinois requires "biological father and biological mother" to certify their

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127 750 ILL. COMP. STAT. 46/205(a) (2017). A case preceding the 2015 Parentage Act is A.A. *In re* A.A., 2015 IL 118605, ¶¶ 24-25.

128 Ill. Dept. Healthcare & Fam. Servs. *ex rel*. Hull v. Robinson, No. 4-22-1025, 2023 WL 5815829, at *4 (Ill. App. Ct. Sept. 8, 2023).

129 750 ILL. COMP. STAT. 46/312(a) (2017).

130 *Id*. at 46/301 (pointing, in part, to 410 ILL. COMP. STAT. 535/12(5) (2017)); *see also* 305 ILL. COMP. STAT. 5/10-17.7 (2016) (explaining "paternity" determinations). The Illinois form, HFS 34168 (R-10-21), indicates signatures are required from unwed "biological mother" and "biological father," with a "denial of parentage" also needed from a "presumed parent" (i.e., the spouse of the biological mother). ILLINOIS VOLUNTARY ACKNOWLEDGMENT OF PATERNITY, STATE OF ILLINOIS 1 (n.d.).

131 410 ILL. COMP. STAT. 535/12(4) (2017) (noting that where the birth mother was married to a person who was not the genetic father, to be effective the VAP must include "a denial of parentage" in the spouse, signed by the birth mother and the spouse; similarly, where the birth mother was married to another woman who had genetic ties to a child born of assisted reproduction, a denial of parentage by the spouse seemingly is needed for the egg provider to be a parent).

132 750 ILL. COMP. STAT. 46/204(a)(1) (2017) (explaining that presumed parentage in a spouse if "child is born to the mother during the marriage"); *id*. at 46/302(c) ("[A] presumed father may sign or otherwise authenticate a voluntary acknowledgment.").

133 *See id*. at 46/701 et seq. (covering children born of assisted reproduction, including births to gestational surrogates; § 701 declares the article "does not apply to the birth of a child conceived by means of sexual intercourse").

134 *Id*. at 46/703(a).

acknowledgments of biological ties, failing to accommodate modern family structures.[135] This raises the question: If a woman can be a genetic parent of a child born to another woman, who will serve as a childcare parent? Should the egg donor be able to pursue a voluntary maternity acknowledgment?

Legal parenthood can be established for a child born of assisted reproduction to a "gestational" surrogate[136] if there is a "valid gestational surrogacy agreement" in place.[137] Such an agreement must be accompanied by specific certifications by a licensed physician and attorneys for the intended parents and the gestational surrogate.[138] However, discussions should explore whether intended parents should have the option to pursue voluntary acknowledgments of parentage in these situations. Additionally, the inclusion of sperm donors as intended parents within existing VAP laws warrants examination.

Illinois legislators and judges need to recognize the urgency of updating parentage laws to reflect the realities of modern family dynamics. Illinois lawmakers and judiciary should also consider extending voluntary acknowledgments of parentage to cover maternity-related circumstances. A female gametes donor (fertilized egg implant) may even have a constitutionally protected parentage opportunity interest.[139] Extending voluntary acknowledgments of parentage to encompass maternity-related circumstances is not only equitable but also conforms to constitutional principles and safeguards the parental intentions of all involved parties.

VI. UNIFORM ACTS AND OTHER STATE LAWS ON PARENTAGE ACKNOWLEDGMENTS

Before delving into potential revisions of Illinois parentage acknowledgment laws, brief reviews of the three Uniform Parentage Acts and some varied state laws on VAPs are in order. They provide alternative

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135 ILLINOIS VOLUNTARY ACKNOWLEDGMENT OF PATERNITY, STATE OF ILLINOIS 1 (n.d.). Yet the Illinois Supreme Court may be reluctant to recognize such VAPs given the lack of explicit statutory language. *See, e.g.*, *In re* Scarlett Z.D., 2015 IL 117904, ¶ 68 (holding that a legal change in a complex area of childcare parenthood, here an allegation of equitable adoption parent for a child formally adopted by an intimate partner, must be left to "policy debate" within General Assembly). *See generally* Jeffrey A. Parness, *State Lawmaking on Federal Constitutional Childcare Parents: More Principled Allocations of Power and More Rational Distinctions*, 50 CREIGHTON L. REV. 479 (2017) (discussing issues of separation of powers in childcare parentage cases).

136 750 ILL. COMP. STAT. 46/709(a)(1) (2023) (explaining that gestational surrogate certifies she did not provide "a gamete").

137 *Id*. at 46/709(a)(5).

138 *Id*. at 46/709(a)(4), (5).

139 Lehr v. Robertson, 463 U.S. 248, 262 (1983) (covering case brought on behalf of egg donor whose same sex partner gave birth in D.M.T. v. T.M.H., 129 So.3d 320, 327, 335-38 (Fla. 2013)).

approaches to acknowledgment issues, which, in some instances, are superior to current Illinois laws.[140]

The three proposed Uniform Parentage Acts[141] recognize childcare parentage in those who have undertaken voluntary paternity or parentage acknowledgments.[142] Through these acknowledgments, there is actual consent to parentage by either expecting or existing legal parents, as well as individuals who were previously not considered parents.[143] These nonparents may have no actual genetic ties to the acknowledged children.[144] Increasingly, acknowledgment signors need not even believe such ties exist.[145]

The 1973 UPA sets forth circumstances in which paternity is presumed.[146] It recognizes "a man is presumed to be the natural father of a child," thus prompting childcare parentage, if "he acknowledges his paternity in a writing" filed with the state which is not disputed by the birth mother "within a reasonable time after being informed."[147] The rebuttal of this presumption requires proof of "no biological ties" and paternity establishment by another man.[148] Actual beliefs about "natural" bonds seem quite important, even if mistaken.

The 2000 UPA, as amended in 2002, recognizes no childcare parentage presumption for a paternity or parentage acknowledgment signature.[149] However, it does allow the birth mother and "a man claiming to be the genetic father of the child [to] sign an acknowledgment of paternity with intent to establish the man's paternity."[150] Genetic bonds seem quite important, even when beliefs are mistaken.

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140 UNIF. PARENTAGE ACT § 4(a)(5) (UNIF. L. COMM'N 1973); UNIF. PARENTAGE ACT § 204(a) (UNIF. L. COMM'N 2000); UNIF. PARENTAGE ACT § 201(5) (UNIF. L. COMM'N 2017).

141 The UPAs were promulgated by The National Conference of Commissioners on Uniform State Laws, also known as the Uniform Law Commission. It has operated since 1892. The acts were adopted in 1970, 2000 (but amended in 2002) and 2017. UNIFORM LAW COMMISSION, www.uniformlaws.org/aboutulc/overview (last visited Jan. 28, 2024).

142 UNIF. PARENTAGE ACT § 4(a)(5) (UNIF. L. COMM'N 1973); UNIF. PARENTAGE ACT § 204(a) (UNIF. L. COMM'N 2000); UNIF. PARENTAGE ACT § 201(5) (UNIF. L. COMM'N 2017).

143 UNIF. PARENTAGE ACT § 204(a)(1) (UNIF. L. COMM'N 2017).

144 *Id*. at § 301.

145 In contrast to VAPs, where sometimes presumed spousal parents deny parentage due to lack of biological ties so that biological parents may undertake VAPs, at times presumed spousal parents can deny parentage without any accompanying new VAP undertaking. Parness & Saxe, *supra* note 85, at 194-96; *see also* Mackley v. Openshaw, 2019 UT 74, ¶3 (Utah 2019) (holding that husband could not challenge his earlier denial because any mistake involved legal, not factual, matters).

146 UNIF. PARENTAGE ACT § 4(a)(5) (UNIF. L. COMM'N 1973).

147 *Id*.

148 Rebuttal of such a presumption also occurs only with "clear and convincing evidence of no biological ties," together with "a court decree establishing paternity of the child by another man." *Id*. at § 4(b).

149 UNIF. PARENTAGE ACT § 204(a) (UNIF. L. COMM'N 2000).

150 *Id*. at § 301. The accompanying Comment indicates that "a sworn assertion of genetic parentage of the child" is needed though not "explicitly" required by federal welfare subsidy statutes that often

The 2017 UPA recognizes that a voluntary acknowledgment of parentage can prompt childcare parentage without a presumption.[151] But it is revolutionary in that it recognizes "parentage" acknowledgments can be undertaken by an expanded field of signatories, including not only those who claim to be "an alleged genetic father" of a child born of sex[152] but also those who do not allege genetic ties, including a presumed parent (man or woman) due to an alleged or actual marriage;[153] a presumed parent due to a holding out of the child as one's own while residing in the same household with the child "for the first two years of the life of the child;"[154] and an intended parent (man or woman) in a nonsurrogacy assisted reproduction setting.[155]

Acknowledgments under the 2017 UPA may be undertaken "before or after the birth of the child."[156] Beliefs in genetic ties need not always exist, and the lack of genetic ties cannot always undo acknowledged parentage.[157] In recognizing acknowledgments by those with no genetic ties to acknowledged children, the 2017 UPA allows circumvention of formal adoption laws and the safeguards they provide for children, including background checks and findings of a child's best interest.[158] One Comment to the 2000 UPA laments that the federal statutes guiding state paternity acknowledgment laws did not expressly "require that a man acknowledging paternity must assert genetic paternity."[159] A related Comment indicates that the 2000 UPA was "designed to prevent circumvention of adoption laws by

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prompt state VAP laws, a federal statutory "omission" that is corrected in the 2000 UPA. The Comment also recognizes a male sperm donor may undertake a VAP in an assisted reproduction setting where his "partner" is the birth mother. *Id.*

The 2000 UPA declares a VAP can be rescinded within sixty days of its effective date by a "signatory," *Id*. at § 307; thereafter, a signatory can commence a court case to "challenge" the VAP, but only on "the basis of fraud, duress, or material mistake of fact" within two years of the VAP filing, *Id*. at §308(a).

151 UNIF. PARENTAGE ACT § 201(5) (UNIF. L. COMM'N 2017). Some marital parentage presumptions, including marriages occurring after birth, can be prompted by parentage assertions in records filed with the state. *Id*. at § 204(a)(C)(i).

152 *Id*. at § 301.

153 *Id*. at §§ 301, 204(a)(1)(A)(C).

154 *Id*.

155 *Id*. at §§ 301 703.

156 UNIF. PARENTAGE ACT § 304(c) (UNIF. L. COMM'N 2017).

157 As with the 2000 UPA, signatories may rescind within sixty days. *Id*. at § 308(a)(I). Challenges may proceed thereafter, "but no later than two years after the effective date" and "only on the basis of fraud, duress or material mistake of fact." *Id*. at § 309(a).While nonsignatory VAP challenges may be pursued within "two years after the effective date of the acknowledgement," such challenges usually will only be sustained when a judge finds the child's "best interest" are served. *Id*. at §§ 309(b), 610(b)(1), (2). Nonsignatory challengers are limited. Those with standing include the child; a parent under the 2017 UPA; "an individual whose parentage is to be adjudicated;" an adoption agency; and a child support, or other authorized, governmental agency. *Id*. at §§ 610(b), 602. Thus, the parents or siblings of an alleged sperm provider of a child born of consensual sex seemingly cannot challenge a VAP. *Id.*

158 UNIF. PARENTAGE ACT § 201(5) (UNIF. L. COMM'N 2017).

159 UNIF. PARENTAGE ACT, Comment to Article 3 (UNIF. L. COMM'N 2000).

requiring a sworn statement of genetic parentage of the child."[160] Thus, in 2017, the UPA policies on parentage acknowledgments changed dramatically.[161]

Current state laws in the United States reflect the varying UPA approaches.[162] Only a limited number of states to date, as with the 2017 UPA, have extended acknowledgments to married female same-sex couples where a child is born of consensual sex.[163] Parentage acknowledgment opportunities are not, and clearly could not be, extended to apply to a male same-sex couple where one of the men naturally (and adulterously) conceived a child born of consensual sex.[164] There, the birth mother is an existing legal parent.[165] Current state laws generally fail to recognize three childcare parents.[166]

Acknowledgment statutes are most often employed by those giving birth who pursue or assist in establishing legal paternity.[167] VAPs are typically distinguished from birth certificate recognitions of male childcare parents, encompassing those married to birth mothers, who frequently are presumed parents but who never undertake VAPs.[168] VAP parentage is also distinguished from presumptive spousal parentage, as the latter is more easily

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160 *Id*.

161 *See generally* UNIF. PARENTAGE ACT § 201(5) (UNIF. L. COMM'N 2017).

162 *See* Jeffery A. Parness, *Unconstitutional Parenthood*, 104 MARQUETTE L. REV. 183, 205-2011 (2020); *compare* GA. CODE § 19-7-20(a) (2022) (Child "born in wedlock or within the usual period of gestation thereafter."), *with* HAW. REV. STAT. § 584- 4(a)(1) (2022) ("[C]hild is born during the marriage."), and ALA. CODE § 26-17- 204(a)(1) (2022) (Spousal parentage if "child is born during the marriage."), and 750 ILL. COMP. STAT. 46/204(a)(1) (2022) (A "person" married to one who gives birth "during marriage" or "substantially similar legal relationship.").

163 *See, e.g.*, VT. STAT. ANN. tit. 15c § 301(a)(4) and 401(a)(1) (2023) (noting a person married to birth mother at time child is born can undertake voluntary parentage acknowledgment); WASH. REV. CODE. § 26.26A.200 (2023) (noting a birth mother and "presumed parent" may sign acknowledgment; presumed parent includes the spouse of birth mother under 26.26A.115(1)(a)(i)). On the need for allowing VAPs for same-sex female couples, *see, e.g.*, Jessica Feinberg, *A Logical Step Forward: Extending Voluntary Acknowledgments of Parentage to Female Same-Sex Couples*, 30 YALE J. L. & FEMINISM 99, 99 (2018) (urging federal government to undertake reforms). On the problems with two women VAPs for children born of consensual sex, *see* Jeffrey A. Parness *Unnatural Voluntary Acknowledgments Under the 2017 Uniform Parentage Act*, 50 UNIV. OF TOLEDO L. REV. 25 (2018).

164 *See, e.g.*, Quillon v. Wolcott, 434 U.S. 246, 256 (1978) (distinguishing sperm providers); Tuan Anh Nguyen v. I.N.S., 533 U.S. 53, 64, 65 (2001) (explaining that by giving birth one always has at least an opportunity to develop "a real, meaningful relationship" with the child).

165 *See, e.g., id*.

166 In California there can be three parents under law. CAL. FAMILY CODE § 7612(c) (Deering 2023); *but see* CAL. FAMILY CODE § 7612(c), 7611 (Deering 2023) (stating voluntary parentage acknowledgment does not prompt presumed parentage).

167 *But see In re* Adoption of Sebastian, 879 N.Y.S.2d 677 (N.Y. 2009) (suggesting woman whose ova was used by her partner to bear a child born of assisted reproduction might employ the voluntary acknowledgment process).

168 *See, e.g.*, Castillo v. Lazo, 386 P.3d 839 (Ariz. Ct. App. 2016) (birth certificate naming husband is not "equivalent" to a VAP).

refuted.[169] Further, acknowledged parents who reside and hold out children as their own thus differ from residency or hold-out parents who never undertake acknowledgments.[170]

State parentage acknowledgment laws beyond VAPs (typically limited to nonmarital children born of sex) do exist and do vary significantly.[171] In New York, the "Acknowledgment of Parentage" form, as of April 2021, requires the "birth parent" to sign with the "other parent," who is said to be the "genetic or intended parent" of the named child.[172] In California, there is a form for "Acknowledgment of Paternity/Parentage,"[173] which can be employed by an unmarried birth mother and "another person who is a genetic parent"[174] or by a birth mother and a "parent . . . of a child conceived through assisted reproduction."[175] In Maine, an "Acknowledgment of Parentage" can be employed by a "parent" who "resided in the same household with the child and openly held out the child as that person's own from the time the child was born or adopted and for a period of at least 2 years thereafter and assumed personal, financial, or custodial responsibilities for the child."[176] Finally, in Massachusetts, a "Voluntary Acknowledgment of Parentage" can be employed by a parent who obtained a pre-birth court order establishing that he or she is "the parent of the child" delivered by a gestational surrogate.[177]

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169 *Compare* UNIF. PARENTAGE ACT § 308 (UNIF. L. COMM'N 2000) (allowing VAP challenge after sixty days only "on basis of fraud, duress or material mistake of fact"), *with* UNIF. PARENTAGE ACT § 607 (NAT'L CONF. OF COMM'N OF UNIF. STATE L. 2000) (allowing presumed parent to seek to disprove parent-child relationship within two years of birth).

170 *See, e.g.*, VT. STAT. ANN. tit. 15C, §§ 301(a)(4), 401(a)(4) (2017) (acknowledging a presumed hold out/residency parent may, but need not, sign a VAP).

171 Jeffrey A. Parness & Zachary Townsend, "*For Those Not John Edwards: More and Better Paternity Acknowledgments at Birth*," 40 UNIV. OF BALTIMORE L. REV. 53, 63 (2010); Jayna Morse Cacioppo, Note, *Voluntary Acknowledgments of Paternity: Should Biology Play a Role in Determining Who Can Be a Legal Father?*, 38 IND. L. REV. 479, 486 (2005) (reviewing State voluntary acknowledgment statutes on parentage establishments). Also, state VAP laws vary in their disestablishment standards. Due to federal welfare subsidy mandates, states must conform to the federal Social Security Act. Personal Responsibility and Work Opportunity Reconciliation Act of 1996, Pub. L. No. 104-93, 110 Stat. 2105 (codified in scattered sections of 42 U.S.C.). Disestablishment (i.e., rescissions and challenges) norms are reviewed in Truth and Consequences. Part I, at 44-53 and Appendix B at 82-90 (2003) (including table citing all statutes).

172 *Acknowledgment of Parentage*, LDSS-5171 (N.Y. State Off. of Temp. & Disability Assistance & N.Y. State Dep't of Health, Rev. 04/21) (explaining that an intended parent is defined as "an individual who intends to be legally bound as the parent of a child resulting from assisted reproduction").

173 *APPLICATION TO AMEND A BIRTH RECORD—ACKNOWLEDGEMENT OF PATERNITY/PARENTAGE*, VS22 (Cal. Dep't of Pub. Health, Rev. 04/20).

174 CAL. FAM. CODE § 7573(a)(1) (2020).

175 *Id*. at § 7573(a)(2) (referencing CAL. FAM. CODE § 7613).

176 *Acknowledgment of Parentage (AOP)*, (Me. Dep't of Health and Hum. Serv. 12/21).

177 *VOLUNTARY ACKNOWLEDGMENT OF PARENTAGE*, (Commonwealth of Mass. 07/18).

In some states, VAPs can be filed prior to birth.[178] In certain states, individuals are required to submit information about completed genetic testing.[179] Moreover, residents seemingly can use their own state forms for births that occur out of state.[180] Witness or notary signatures are necessary in some cases.[181] Additionally, parental or guardian consent is mandatory if the birth mother is underage.[182]

There are significant differences in current VAP challenge laws.[183] As noted, under federal statutes, paternity acknowledgments in child support settings in participating IV-D states may only be challenged on the grounds of fraud, duress, or material mistake of fact.[184] Congress does not define these grounds further, and states implement them differently.[185]

There are also varied time limits on post-sixty-day VAP challenges.[186] The challenges to parentage acknowledgments must be initiated within a year in Massachusetts,[187] within two years in Delaware,[188] and four years in Texas.[189] Moreover, in Utah, statutory challenges may be made on the grounds of fraud or duress "at any time," but VAP challenges based on a material mistake of fact are limited to four years.[190] Where there are no written time limits, trial courts have broad discretion.[191] Further, states with written time limits can vary on whether the time for a VAP challenge can be tolled—that is, stayed—due to lack of or incorrect knowledge about genetic ties.[192]

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178 *See, e.g.*, TEX. FAM. CODE § 160.304(b) (2015) (stating that paternity acknowledgment "may be signed before the birth of the child");VT. STAT. ANN. tit. 15C § 304(b) (2017).

179 CAL. FAM. CODE § 7573(a)(1) (2020).

180 *Id*.

181 *See, e.g.*, TEX. FAM. CODE § 160.304(b) (2015).

182 *See, e.g.*, *id*.

183 Parness & Saxe, *supra* note 85, at 185-203.

184 42 U.S.C. 666(a)(D)(iii).

185 *See, e.g.*, Parness & Saxe, *supra* note 85, at 185-203. The grounds are required for the states receiving federal welfare IV-D funds for reimbursement. *Id*. at 179.

186 *Cf.* MASS. GEN. LAWS ch. 209C, § 11(a) (2008); TEX. FAM. CODE § 160.308(1) (2015).

187 MASS. GEN. LAWS ch. 209C, § 11(a) (2008); *see also* State v. Smith, 392 P.3d 68 (Kan. 2017) (holding that a one-year (after birth) limit on signatory challenges applied though there were found technical violations (e.g., no proper notarizations) of the statute).

188 DEL. CODE ANN. tit. 13, § 7-308(a)(2); *see also* VT. STAT. ANN. tit. 15C § 308(a) (2017); Paul v. Williamson, 322 P. 3d 1070 (Okl. Civ. App. 2014) (employing Oklahoma two-year limit against alleged biological father per 10 OKL. STAT. 7700-609(B)). *Cf.* LA. STAT. ANN. § 9:406 (2016) (establishing a two-year prescriptive period previously imposed for revocation of authentic acts of acknowledgement was repealed in 2016).

189 TEX. FAM. CODE § 160.308(1) (2015).

190 UTAH CODE ANN § 78B-15-307 (2008).

191 *See, e.g*., Matter of Neal, 184 A.3d 90 (N.H. 2018) (holding that a sustainable exercise of trial court discretion where a 2009 VAP was challenged by male signatory in 2015 after a 2012 paternity test revealed that he was not the biological father; challenge brought in November 2015, after child contact was cut off in March 2014).

192 *Compare* VT. STAT. ANN. tit. 15C § 308(b) (2017) (establishing that a VAP challenge by nonsignatory must be commenced within two years after effective date "unless the person did not

Even where there are time limits on post-sixty-day VAP challenges, there can (and perhaps must) be available to alleged genetic parents a common law parentage claim that extends beyond those limits.[193] In Massachusetts, for example, such a common law claim has been found to avoid the constitutional issues involving an alleged genetic parent's asserted childcare parentage under the law by requiring that the common law parent "demonstrate a substantial parent-child relationship by clear and convincing evidence."[194] Finally, interstate differences exist on whether a successfully challenged VAP eliminates past child support arrearages.[195]

VII. REFORMING PATERNITY/MATERNITY/PARENTAGE ACKNOWLEDGMENT LAWS IN ILLINOIS

More expansive paternity, maternity, and parentage acknowledgment laws than exist in Illinois have been suggested and adopted outside of Illinois.[196] Broader acknowledgment (or intended parent contract, parental registry,[197] or similar laws) could support parentage for intended parents wherein legal parenthood immediately vests upon an acknowledgment after birth or wherein legal parenthood vests upon the later birth of a child where an acknowledgment was executed before birth.[198] Illinois laws now recognize both immediate legal parenthood for a child born of sex via a VAP and contingent legal parenthood for a child born of assisted reproduction based on future childcare parent intentions.[199] Thus, Illinois laws promptly recognize parenthood upon a VAP for signatories vis-à-vis nonsignatories who may later challenge the VAP.[200] Illinois laws also recognize legal parentage in intended parents of children born of assisted reproduction

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know and could not reasonably have known of the person's parentage due to a material misrepresentation or concealment," with commencement then required within two years "after discovery"); *with* ME. REV. STAT. ANN. tit. 19-a § 1868(2) (2021) (establishing similar requirements); WASH. REV. CODE § 26.26A.445(2)(b) (2019) (allowing nonsignatory, "other than the child," can challenge a VAP "only if the court finds permitting the proceeding is in the best interest of the child"); OHIO REV. CODE § 3111.28 (2000) (allowing a nonsignatory can challenge within one year of VAP finality, with no mention of tolling).

193 *See* VT. STAT. ANN. tit. 15C § 308(b) (2017).

194 J.M. v. C.G., 212 N.E.3d 776, 783 (Mass. 2023).

195 *See, e.g.*, Adler v. Dormio, 872 N.W.2d 721 (Mich. Ct. App. 2015) (reviewing Michigan laws on when responsibility for arrearages may be eliminated).

196 *See* Jeffery A. Parness, *Unconstitutional Parenthood*, 104 MARQUETTE L. REV. 183, 205-211 (2020).

197 *See, e.g.*, Jeffrey A. Parness, *Expanding State Parent Registry Laws*, 101 NEB. L. REV. 684, 730 (2023) (stating parental registry opportunities "should be expanded to reflect the legal changes recognizing increased parenthood opportunities and parenthood for those with no biological, marital, or formal adoptive ties").

198 *See, e.g.*, *id*.

199 750 ILL. COMP. STAT. 46/201 (2023); *id*. at 46/703.

200 *See, e.g.*, *id*. at 46/301 (covering voluntary paternity acknowledgment).

through private agreements unaccompanied by "acknowledgments" that are filed with the state[201] but depend upon live birth.[202]

New forms of acknowledgments should be recognized in Illinois, perhaps following a UPA suggestion or some sister state law. Some new VAP forms and processes seem required by constitutional demands, such as through equal protection or due process interests.[203]

Given current constitutional precedents, legislators and judges considering new parentage acknowledgment laws in Illinois should sometimes differentiate between genetic and nongenetic parent acknowledgments. Some genetic parents, whether actual or alleged, have constitutional interests in establishing[204] or maintaining parent-child relationships with their offspring.[205] Those acting as parents who have no genetic ties to children generally have no similar interests until legal parentage is formally recognized, as through adoptions,[206] or until legal parentage is clearly present, as in at least some spouses of those who give birth[207] or in those who meet state residency/hold out parent norms.[208]

Two reviews of Illinois's possible new genetic and nongenetic parent acknowledgment laws follow. They focus on possible changes involving both children born of sex and children born of assisted reproduction.

Some possible laws—such as acknowledgments made available to residency and hold-out or de facto parents[209]—must await Illinois state law's

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201 *See, e.g.*, *id*. at 46/709 (defining "intended parent" for child born of gestational surrogacy pact).

202 *See, e.g.*, *id*. at 46/703(a) ("An intended parent . . . is the legal parent of any resulting child" born of nonsurrogacy assisted reproduction).

203 On equality demands attending VAP laws, *see, e.g.*, Leslie Joan Harris, *Voluntary Acknowledgements of Parentage for Same Sex Couples*, 20 AM. U. J. OF GENDER, SOC. POL'Y & L. 467, 487 (2012) (urging that instead of equality, state laws should be amended to accommodate same sex couples). On due process demands attending VAP laws, *see, e.g.*, Jeffrey A. Parness, *Federalizing Birth Certificate Procedures*, 42 BRANDEIS L.J. 105, 108 (2003) (arguing Congress should further nationalize birth certificate laws by enacting new procedures for both locating and educating the natural father of children born to unwed mothers" regarding their constitutionally protected parental opportunity interests).

204 Lehr v. Robertson, 463 U.S. 248, 256 (1983) (discussing paternity opportunity interest for genetic fathers of children born of consensual sex to unwed mothers).

205 Troxel v. Granville, 530 U.S. 57, 65 (2000) (recognizing "liberty interest" of parents in "the care, custody and control of their children") and *id*. at 77 (Souter, J., concurring, observing the Court has "long recognized" this interest).

206 *Id*. at 67 (recognizing fundamental parental right applies to birth mother "and her family," which, in the case, includes an adoptive father).

207 Michael H. v. Gerald D., 491 U.S. 110, 157 (1989) (White, J., dissenting) (recognizing that a natural father only sometimes has a constitutional interest in a child born of sex to one who is married to another).

208 *See, e.g.*, UNIF. PARENTAGE ACT § 204(A)(2) (UNIF. L. COMM'N 2017) (covering presumed parentage in residency/hold out parent), and *id*. at § 201(2) (noting such parentage can be "overcome in a judicial proceeding), followed in ME. REV. STAT. tit. 19-A, § 1881 (2023) (covering presumed parents) *id*. at § 1883 (adjudicating parentage when 2 or more conflicting parentage presumptions).

209 To date, the Illinois General Assembly has not recognized either form of childcare parentage. 750 ILL. COMP. STAT. 46/201 (2023). The Illinois Supreme Court has refrained from developing

recognition of these forms of legal parentage. Such recognitions, for now, have been left by the Illinois Supreme Court to the Illinois General Assembly.[210]

A. New Genetic Parent Acknowledgments

Current Illinois VAP statutes anticipate parentage acknowledgments by a "mother" and "father."[211] The implementation of this statutory limit is found in the Illinois VAP form, prescribed by the Illinois Department of Healthcare and Family Services pursuant to statutory authority; it also addresses only parentage for mothers and fathers.[212]

Yet in nonsurrogacy assisted reproduction births, there might be two mothers, the gestational parent and the egg provider (via fertilized egg implant), that is, a nongenetic but biological mother and a genetic mother.[213] Here, voluntary parentage acknowledgments should be available (and encouraged) where the egg provider and the gestational parent are intended parents (at least at the outset). The egg provider may even have a constitutionally protected parental opportunity interest where she is an intended parent with the assent of the projected gestational parent.[214] The

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common law parentage precedents due to concerns over separation of powers. Generally, on issues of separation of powers in childcare parentage cases, *see* Jeffrey A. Parness, *State Lawmaking on Federal Constitutional Childcare Parents: More Principled Allocations of Power and More Rational Distinctions*, 50 CREIGHTON L. REV. 479 (2017). Yet in probate cases, there is common law precedent on "equitable adoption." DeHart v. DeHart, 2013 IL 114137, *reviewed by*, *In re* Parentage of Scarlett Z.-D., 2015 IL 117904, ¶ 52 (recognizing this precedent is inapplicable "to proceedings for parentage, custody and visitation").

210 *In re* Parentage of Scarlett Z.-D., 2015 IL 117904, ¶ 68 (examining legal change in complex area of childcare parenthood, here an allegation of equitable adoption parent for a child formally adopted by an intimate partner, must be left to "policy debate" within General Assembly). Elsewhere, judicial reluctance to expand common law parentage norms in deference to legislative judgment has been overcome, at least where important social policies have gone unaddressed, resulting to significant injustice. *See, e.g.*, Jeffrey A. Parness, *State Lawmaking on Federal Constitutional Childcare Parents: More Principled Allocations of Powers and More Rational Distinctions*, 50 CREIGHTON L. REV. 479, 496-501 (2017) (reviewing state cases wherein legislative inaction prompted judicial precedents on childcare parents in order to remedy perceived social injustices).

211 750 ILL. COMP. STAT. 46/301 (2023) (referencing Section 12 of the Vital Records Act, 410 ILL. COMP. STAT. 535/12(5)(a) (2023), which speaks of a child's mother and father).

212 *Id*. at 46/312 (delegating authority to the Department), leading to the form on Illinois Voluntary Acknowledgment of Paternity, HFS 34 16B (R-10-21) (copy on file with author) [Illinois VAP form].

213 *Surrogacy*, YALE MED., https://www.yalemedicine.org/conditions/gestational-surrogacy (last visited Feb. 1, 2024).

214 Lehr v. Robertson, 463 U.S. 248, 256 (1983) (examining paternity opportunity interests of genetic fathers), applied to egg providers in *In re* Parentage of S.D.S., 371 Or. 573, 615 (Or. 2023) (Linder, J., dissenting) and D.M.T. v. T.M.H., 129 So.2d 320, 339 (Fla. 2013) ("It would indeed be anomalous if, under Florida law, an unwed biological father would have more constitutionally protected rights to parent a child after a one night stand than an unwed biological mother who, with a committed partner and as part of a loving relationship, planned for the birth of a child and remains committed to supporting and raising her own daughter."). *See also* Leslie J. Harris, *Voluntary*

existing limit on voluntary parentage acknowledgments in Illinois raises concerns, especially considering the state's public policies that prioritize the parental intentions of gamete providers in certain assisted reproduction births.[215] However, the statutes regarding assisted reproduction births outside of surrogacy arrangements are unclear and could potentially undermine the intentions of individuals attempting assisted reproduction without professional assistance.[216]

In gestational surrogacy assisted reproduction births in Illinois,[217] seemingly there can also be two mothers, the gestational parent and the egg provider (via fertilized egg implant), where an alleged surrogacy pact fails to meet the statutory requirements.[218] When the egg provider challenges the parentage of the gestational parent while asserting her parentage, a statute requires a court of competent jurisdiction to "determine parentage based on evidence of the parties' intent."[219] Judicial undertakings of such intent would be greatly facilitated if voluntary parentage acknowledgments and surrenders were available via state-developed forms for those undertaking parentage via gestational surrogacy, including opportunities for explicit denials of any parentage opportunities for the egg providers.

B. New Nongenetic Parent Acknowledgments

The Illinois VAP form,[220] developed by the Illinois Department of Healthcare and Family Services per a statutory directive,[221] speaks only to a biological mother, a biological father, and the mother's spouse, if there is one.[222] This limit is troublesome, given the federal constitutional parental interests of gamete providers in assisted reproduction births where the egg provider is not the person giving birth, especially where the provider is also an intended parent from the outset with the consent of the prospective gestational parent.[223]

Acknowledgments of Parentage for Same-Sex Couples, 20 AM. U. J. GENDER SOC. POL'Y & L. 467, 487 (2012) (discussing equal protection demands availability of parentage acknowledgments for some egg donors, though state nonconstitutional law reforms are preferred).

215 750 ILL. COMP. STAT. 46/312(a) (2017).

216 *Id*.

217 The legal guidelines appear in the Gestational Surrogacy Act, *Id.* at 47/1. In Illinois, there are no laws facilitating genetic surrogacy pacts. Special norms for such pacts are suggested in UNIF. PARENTAGE ACT § (813-818) (UNIF. L. COMM'N 2017).

218 750 ILL. COMP. STAT. 47/25(b) (2023) (requiring an agreement in writing, execution before implantation, and representation by separate counsel).

219 *Id*. at 47/25(e).

220 750 ILL. COMP. STAT. 46/312 (2017).

221 *Id*. at 46/312(a).

222 *Id*. at 46/312.

223 *Id*. at 46/312(a).

Are there reasons to consider extending voluntary parent acknowledgment opportunities in Illinois to those without genetic ties? Elsewhere, such voluntary acknowledgments have been authorized for nongenetic residency and hold-out parents.[224] In Illinois, however, such nongenetic parents have yet to be recognized.[225]

Illinois legislators have good reasons to authorize new forms of voluntary parentage acknowledgments for some (would-be) nongenetic parents. Such forms would encompass intended parents contemplating assisted reproduction births, both in nonsurrogacy and surrogacy settings. Unlike VAPs, such acknowledgments might only indicate an intent to parent rather than immediately prompt legal parenthood. Intent to parent in anticipation of later birth is important in assessing alleged legal parentage of nongenetic parents in both nonsurrogacy and surrogacy settings.[226] Voluntary parentage acknowledgments by those not genetically tied to children would help determine parentage in settings where the statutory requirements on nonsurrogacy or surrogacy assisted reproduction pacts are not met but where their policies on recognizing intended parentage would be furthered (as in do-it-yourself artificial insemination cases). In Illinois, the intention to parent children conceived through sex, whether anticipated or already born, has had minimal significance in determining legal parenthood thus far.[227]

VIII. CONCLUSION

The recent case of Mario Robinson, coupled with recent changes in both the Uniform Parentage Act and in state laws on voluntary parentage acknowledgments, should prompt Illinois legislators and judges to take a fresh look at Illinois VAP laws and to consider adding voluntary parentage acknowledgments opportunities going beyond paternity establishments. New laws could recognize that voluntary parentage acknowledgments can immediately prompt childcare parentage or simply declare childcare parent intentions. New acknowledgment forms would be needed.[228] While genetic,

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224 On residency/hold out parents undertaking voluntary parentage acknowledgments, *see* UNFI. PARENTAGE ACT § 204(a)(2) (UNIF. L. COMM'N 2017) (allowing presumed parentage for an individual "who resided in the same household with the child for the first two years of the life of the child . . . and openly held out the child as the individual's child"); *id*. at § 301 ("[P]resumed parent may sign an acknowledgment of parentage to establish the parentage of the child."), followed in 26 WASH. REV. CODE §§ 26.26A.115(1)(b), 26.26A.200.

225 *In re* Parentage of Scarlett Z.-D., 2015 IL 117904, ¶¶ 33-56.

226 750 ILL. COMP. STAT. 46/703(a) (2023).

227 *In re* Parentage of Scarlett Z.-D., 2015 IL 117904, ¶¶ 65-67 (finding common law precedents, including claims of breach of contract and promissory estoppel, on parentage for childcare and/or child support purposes are "expressly limited to cases involving children born by means of artificial insemination").

228 Otherwise, intended parents may attempt to use VAP forms where paternity is not at issue or to be faulted by a court for not employing a VAP form where paternity is not at issue. *See, e.g.*, Gatsby

marital, and formal adoptive ties to children should remain important when determining childcare parenthood, there is a need for broader recognition of nongenetic, non-spousal, and nonadoptive childcare parentage through parentage acknowledgments.[229] This recognition is necessary to honor parental intentions, to further equality principles, and to preserve healthy parent-child relationships that serve the best interests of the child.[230]

v. Gatsby, 495 P.3d 996, 1007 (Idaho 2021) (while not addressing applicability of VAP laws to same sex female couples, noting the court below found against the non-gestational parent due to her failure to file a VAP).

229 Changes in the forms of childcare parentage in Illinois certainly will impact many, if not all, forms of parentage outside of childcare settings. *See, e.g.*, Jeffrey A. Parness, *Who Is a Parent? Intrastate and Interstate Differences*, 34 J. AM. ACAD. OF MATRIM. LAW. 455 (2022).

230 *Id*.

IS THE SECOND AMENDMENT OUTDATED OR MISINTERPRETED?

William J. Carney*

I. INTRODUCTION

This Article addresses the problem of rising homicide rates in the United States. The centerpiece of the legal issue is Justice Scalia's opinion in *District of Columbia v. Heller*, which declared that the Second Amendment's right to bear arms is not limited by the qualifying language that a "well regulated Militia . . . [is] necessary to the security of a free State."[1] Instead, he declared that it enshrines the right of every citizen to bear arms for personal self-defense.[2] This approach was followed in *N.Y. State Rifle & Pistol Ass'n v. Bruen*, where Justice Thomas' opinion struck down a law requiring a permit to carry a gun upon showing "good moral character" and "proper cause."[3] Justice Thomas, unlike Justice Scalia, looked to the practices common at the time of adoption, believing those gun regulations were understood to be permissible.[4]

This Article does what Justice Scalia did not do in *Heller*.[5] It examines the history of organized militias, which were organized and controlled by state and local governments to protect sovereign states from being disarmed by a standing army of the federal government.[6] In essence, it demonstrates that the original understanding of the Second Amendment was to protect states, not individual citizens.

It then proceeds to examine the possible results of a laboratory of the states in dealing with rising crime and homicide rates, exploring both local studies and the experience of other nations. For example, drastic remedies, such as the death penalty, are shown to reduce homicides overall.[7]

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1 District of Columbia v. Heller, 554 U.S. 570, 576 (2008).

2 *Id*. at 614.

3 N.Y. State Rifle & Pistol Ass'n v. Bruen, 142 S. Ct. 2111, 2122 (2022).

4 *Id*. at 2126 ("[T]he government must demonstrate that the regulation is consistent with this Nation's historical tradition of firearm regulation.").

5 *See generally Heller*, 554 U.S. at 570.

6 *See Historical Background on Second Amendment*, LEGAL INFO. INST., https://www.law.cornell.edu/constitution-conan/amendment-2/historical-background-on-second-amendment (last visited Mar. 18, 2024).

7 Hashen Dezhbakhsh et al., *Does Capital Punishment Have a Deterrent Effect? New Evidence from Post moratorium Panel Data*, 5 AM. L. & ECON. REV. 344, 369 (2003); *contra Study: International Date Shows Declining Murder Rates After Abolition of Death Penalty*, DEATH PENALTY INFO. CTR.

II. THE FATAL PROBLEM

A recent fatal shooting of an Atlanta Subway sandwich shop employee by a customer who thought there was too much mayonnaise on a sandwich is just the exclamation point in an era of insane gun violence.[8] Mass shootings in the United States have become an increasing problem in recent years.[9] Since 2015, the number of mass shootings and the number of people shot during the course of the shootings have steadily increased, reaching a high of 686 mass shooting incidents in 2021.[10] As of July 2022, the Washington Post reported that there were already more than 300 mass shootings during 2022 in the United States.[11] Included in that number is the Fourth of July shooting in Highland Park, Illinois, which left six people dead,[12] and the Uvalde, Texas, shooting that left twenty-one dead, including nineteen children.[13] Other statistics show that, on average, there is a mass shooting every day where four or more people (not including the shooter) are injured or killed.[14] Going beyond averages, in 2022, up until July, there were at least four mass shootings every week.[15]

All of these shootings were dwarfed by the 2017 massacre in Las Vegas, where a gunman opened fire on the crowd attending the Route 91 Harvest music festival.[16] During the mass shooting, the gunman killed fifty-eight outdoor concertgoers and injured approximately 800 more during a relatively short but highly intense shooting spree on October 1, 2017.[17] The Las Vegas

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(DPIC) (Jan. 3, 2019), https://deathpenaltyinfo.org/news/study-international-data-shows-declining-murder-rates-after-abolition-of-death-penalty.

8 Chelsea Prince, *Suspect arrested after mayo dispute at Atlanta Subway leaves worker dead*, THE ATLANTA J.-CONST. (June 27, 2022), https://www.ajc.com/news/crime/senseless-argument-over-mayo-leaves-1-worker-dead-1-hurt-at-atlanta-sub-shop/J2SY4BQCMVDNZECD5FZAAJG77Q/.

9 *Mass Shootings in the United States*, EVERYTOWN (Mar. 2023), https://everytownresearch.org/mass-shootings-in-america/.

10 *Id*.

11 Julia Ledur & Kate Rabinowitz, *There have been more than 600 mass shootings since January 2022*, WASH. POST (Jan. 23, 2023, 6:27 PM), https://www.washingtonpost.com/nation/2022/06/02/mass-shootings-in-2022/.

12 Jake Sheridan et al., *Highland Park shooting: 6 dead and 2 dozen others shot at parade; suspect arrested*, CHI. TRIB. (July 4, 2022, 11:01 PM), https://www.chicagotribune.com/2022/07/05/highland-park-shooting-6-dead-and-2-dozen-others-shot-at-parade-suspect-arrested/.

13 Jazmine Ulloa et al., *Deadliest U.S. School Shooting in Decade Shakes Rural Texas Town*, N.Y. TIMES (May 25, 2022), https://www.nytimes.com/2022/05/25/us/the-deadliest-us-school-shooting-in-a-decade-shakes-a-rural-texas-city.html.

14 *Mass Shootings in the United States*, EVERYTOWN (Mar. 2023), https://everytownresearch.org/mass-shootings-in-america/.

15 Julia Ledur & Kate Rabinowitz, *There have been more than 600 mass shootings since January 2022*, WASH. POST (Jan. 23, 2023, 6:27 PM), https://www.washingtonpost.com/nation/2022/06/02/mass-shootings-in-2022/.

16 Amanda Onion et al., *Gunman opens fire on Las Vegas concert crowd, wounding hundreds and killing 58*, HIST. (Sept. 29, 2020), https://www.history.com/this-day-in-history/2017-las-vegas-shooting.

17 *Id*.

shooting has been ranked as the single most violent mass shooting in modern American history.[18]

In recent years, murder rates have been skyrocketing in the United States, and the possession of firearms has risen accordingly.[19] Federal Bureau of Investigations (FBI) data shows that the volume of murder and nonnegligent manslaughter offenses increased by 29.4% from 2019 to 2020,[20] which was the most significant single-year increase ever recorded.[21] In 2020, the FBI's Uniform Crime Report recorded about 21,570 murders.[22] Moreover, the United States has 120.5 guns per 100 people, which is the highest total and per capita number in the world.[23] With 393 million firearms already circulating,[24] it is a trivial move by Congress to regulate gun dealers, require screening of persons under twenty-one years old, and provide severe penalties for illegal gun trafficking.[25] It is also illusory that we can

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18 Leila Fadel, *'You Can Get Through It': Las Vegas Shooting Survivors Rebuild Their Lives,* NPR (Sept. 23, 2018, 7:53 AM), https://www.npr.org/2018/09/23/649264345/one-year-after-the-las-vegas-shooting-2-survivors-remember.

19 Rachel Treisman, *Many midterm races focus on rising crime. Here's what the data does and doesn't show*, NPR (Oct. 28, 2022, 6:14 AM), https://www.npr.org/2022/10/27/1131825858/us-crime-data-midterm-elections#:~:text=There's%20been%20a%20dramatic%20uptick,ever%20recorded%20in%20the%20U.S.

20 *FBI Releases 2020 Crime Statistics*, FBI NAT'L PRESS OFF. (Sept. 27, 2021), https://www.fbi.gov/news/press-releases/press-releases/fbi-releases-2020-crime-statistics.

21 Rachel Treisman, *Many midterm races focus on rising crime. Here's what the data does and doesn't show*, NPR (Oct. 28, 2022, 6:14 AM), https://www.npr.org/2022/10/27/1131825858/us-crime-data-midterm-elections#:~:text=There's%20been%20a%20dramatic%20uptick,ever%20recorded%20in%20the%20U.S; *compare* Zusha Elinson, *Murders in U.S. Increased at Slower Pace in 2021, FBI Data Show*, WALL ST. J. (Oct. 6, 2022, 10:00 AM), https://www.wsj.com/articles/murders-in-u-s-increased-at-slower-pace-in-2021-fbi-data-show-11664940045 (In 2021, homicides only increased 4%—but still another increase on a higher base).

22 Jacqueline Howard, *US records highest increase in nation's homicide rate in modern history, CDC says*, CNN (Oct. 6, 2021, 8:13 AM), https://www.cnn.com/2021/10/06/health/us-homicide-rate-increase-nchs-study/index.html; *but see* Feliz Solomon, *Pace of Executions in Singapore Stirs Debate Over Death Penalty for Drug Crimes*, WALL ST. J. (Aug. 2, 2022, 12:26 AM), https://www.wsj.com/articles/pace-of-excutions-in-singapore-stirs-debate-over-death-penalty-for-drug-crimes-11659414366 (Singapore has introduced a mandatory death penalty for drug trafficking crimes, thus equating it to homicide).

23 *Pro and Con: Gun Control*, BRITANNICA (Aug. 7, 2020), https://www.britannica.com/story/pro-and-con-gun-control.

24 Christopher Ingraham, *There are more guns than people in the United States, according to a new study of global firearm ownership*, WASH. POST (June 19, 2018, 10:31 AM), https://www.washingtonpost.com/news/wonk/wp/2018/06/19/there-are-more-guns-than-people-in-the-united-states-according-to-a-new-study-of-global-firearm-ownership/.

25 Perry Stein, *ATF proposes rules that expand who must conduct gun background checks*, WASH. POST (Aug. 31, 2023, 2:56 PM), https://www.washingtonpost.com/national-security/2023/08/31/atf-gun-show-rules-ffls/; Bipartisan Safer Communities Act, Pub. L. No. 117-159, § 12001, 136 Stat. 1313, 1322-24 (2022) (The Safer Communities Act aims to combat gun violence and includes provisions that will improve access to mental health care and help equip schools with the resources necessary to keep schools safe and add penalties for illegal gun trafficking).

predict who will use them dangerously.[26] Things have changed since revolutionary times.[27] The Supreme Court's ruling, in *District of Columbia v. Heller*, that everyone has a right to carry arms is either erroneous or obsolete and currently disastrous.[28] This seemingly raises the question: What can be done to prevent these heinous acts in the future?

III. GUN HISTORY IN THE UNITED STATES

A. Eighteenth Century

The militia played an important role in the War for Independence.[29] In revolutionary times, it was common for men to own guns to hunt game for food, to eliminate varmints destroying flocks or crops, and to defend against hostile natives.[30] Because England was stretched thin elsewhere, England authorized the Royal Provinces (later the colonies) to organize for their own defense.[31] All along the East Coast, men were ordered to muster at predesignated times, and training days were held.[32] The colonies established the militia based on the British system of appointing a lieutenant as the commanding officer, who administered the militia within a set area.[33] Without a standing army, on June 14, 1775, the Continental Congress created one after the beginning of the American Revolutionary War.[34] Until then, it was quite natural for the states to look to the colonies to raise a "well

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26 *See generally* JONAS B. ROBITSCHER, THE POWERS OF PSYCHIATRY (1980).

27 Patrick J. Charles, *A History of Gun Rights in America*, AM. HERITAGE (Sept./Oct. 2019), https://www.americanheritage.com/history-gun-rights-america.

28 *A Closer Look At Heller v District of Columbia (2008)*, A SECOND AMEND. FOR 21ST CENTURY AM., https://asecondamendmentfor21stcenturyamerica.org/a-look-at-heller-v-district-of-columbia (last visited Mar. 27, 2024) (The Second Amendment provides, "A well regulated Militia, being necessary to the Security of a free State, the right of the people to keep and bear Arms, shall not be infringed." President Theodore Roosevelt is quoted as saying, "Our militia law is absolute and totally worthless. The organization and armament of the National Guard of the several States . . . should be made identical with those provided for the regular forces. The obligations and duties of the Guard in times of war should be carefully defined.").

29 Andrew Ronemus, *Minutemen*, U.S. HIST., https://www.ushistory.org/people/minutemen.htm (last visited Sep. 2, 2023).

30 *See generally* Ann E. Tweedy, *"Hostile Indian Tribes . . . Outlaws, Wolves, . . . Bears . . . Grizzlies and Things Like That?" How the Second Amendment and Supreme Court Precedent Target Tribal Self-Defense*, 13 U. PA. J. CONST. L. 687, 693 (2011); Adam Crepelle, *Shooting Down Oliphant: Self-Defense as an Answer to Crime in Indian Country*, 22 LEWIS & CLARK L. REV. 1283, 1287 (2018).

31 Harry Schenawolf, *History of Early Colonial Militias in America*, REVOLUTIONARY WAR J. (Jan. 19, 2015), https://www.revolutionarywarjournal.com/militias-in-colonial-america.

32 *Id*.

33 *Id*.

34 *Ten Facts: The Continental Army*, AM. BATTLEFIELD TR. (Jan. 23, 2024), https://www.battlefields.org/learn/articles/ten-facts-continental-army#:~:text=1.,army%20for%20common%20defensive%20purposes.

organized militia."[35] The American Revolution was fought by such combatants.[36] The Colonists were able to fight on their own ground, which put them at an advantage since they knew the areas and had widespread acquaintance with firearms.[37] Moreover, they had superior rifles with more range and accuracy than the British.[38]

During the Revolutionary War, the American forces were divided into two primary groups.[39] The first was the militia, which was made up of about 145,000 citizens from the colonies.[40] Before the Revolutionary War erupted, these militias often found themselves on the front lines, defending against Indian war parties and thwarting bandit raids during times of emergency.[41] The militia was made up of men between the ages of sixteen and sixty-five who were only trained a few times a year.[42] In contrast, the second group, the Continental Army, presented a more structured and disciplined force.[43] The Continental Army was comprised of paid soldiers who served for periods of time between one and three years.[44] Unlike the militias, who trained

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35 *See generally* Harry Schenawolf, *History of Early Colonial Militias in America*, REVOLUTIONARY WAR J. (Jan. 19, 2015), https://www.revolutionarywarjournal.com/militias-in-colonial-america.

36 *See generally id*.

37 *See generally id*.

38 British troops primarily relied on muskets, which were not very accurate, while many Americans had acquired American Long Rifles, which much greater accuracy. David Johnson, *Revolutionary War Weapons: The American Long Rifle*, WARFARE HIST. NETWORK, April 2005, at 22.

39 *See generally* Rob Orrison, *Militia, Minutemen, and Continentals: The American Military Force in the American Revolution*, AM. BATTLEFIELD TR. (April 30, 2021), https://www.battlefields.org/learn/articles/militia-minutemen-and-continentals-american-military-force-american-revolution#:~:text=Rev%20War%20%7C%20Article-,Militia%2C%20Minutemen%2C%20and%20Continentals%3A%20The%20American%20Military,Force%20in%20the%20American%20Revolution&text=As%20war%20broke%20out%20between,and%20evolve%20their%20military%20establishments.

40 *See American Revolution Facts*, AM. BATTLEFIELD TR., https://www.battlefields.org/learn/articles/american-revolution-faqs (last visited Sep. 18, 2023).

41 *See generally* Rob Orrison, *Militia, Minutemen, and Continentals: The American Military Force in the American Revolution*, AM. BATTLEFIELD TR. (April 30, 2021), https://www.battlefields.org/learn/articles/militia-minutemen-and-continentals-american-military-force-american-revolution#:~:text=Rev%20War%20%7C%20Article-,Militia%2C%20Minutemen%2C%20and%20Continentals%3A%20The%20American%20Military,Force%20in%20the%20American%20Revolution&text=As%20war%20broke%20out%20between,and%20evolve%20their%20military%20establishments.

42 *See* Lesley Kennedy, *The US National Guard's 400-Year History*, HIST. (Jan. 19, 2021), https://www.history.com/news/us-national-guard.

43 *See generally* Rob Orrison, *Militia, Minutemen, and Continentals: The American Military Force in the American Revolution*, AM. BATTLEFIELD TR. (April 30, 2021), https://www.battlefields.org/learn/articles/militia-minutemen-and-continentals-american-military-force-american-revolution#:~:text=Rev%20War%20%7C%20Article-,Militia%2C%20Minutemen%2C%20and%20Continentals%3A%20The%20American%20Military,Force%20in%20the%20American%20Revolution&text=As%20war%20broke%20out%20between,and%20evolve%20their%20military%20establishments.

44 Mike Matheny, *"The Predicament We Are In": How Paperwork Saved the Continental Army*, J. AM. REVOLUTION (May 3, 2021), https://allthingsliberty.com/2021/05/the-predicament-we-are-in-how-paperwork-saved-the-continental-army/.

intermittently, the Continental Army maintained a rigorous and continuous training regimen.[45] At its peak, the Continental Army numbered 48,000 soldiers, with a total of 230,000 soldiers serving throughout the war.[46]

In the modern day, the importance of the early militias is evidenced in Justice Stephens' dissent in *Heller*, which cites several states' "Declaration of Rights" before the Bill of Rights was ratified.[47] For example, Virginia's Declaration of Rights included:

> That a well regulated Militia, composed of the body of the people, trained to arms, is the proper, natural, and safe defense of a free State; that Standing Armies, in time of peace, should be avoided, as dangerous to liberty; and that, in all cases, the military should be under strict subordination to, and governed by, the civil power.[48]

In comparison to the many Declarations of Rights brought forth by the states, Justice Scalia noted in *Heller* that in Virginia, a Second Amendment analog, which aimed to guarantee the right of individuals to bear arms within their own property, was proposed unsuccessfully by Thomas Jefferson.[49] Jefferson's proposal stated: "No freeman shall ever be debarred the use of arms [within his own lands or tenements]."[50] In rejecting the proposal, the Virginia committee instead adopted the provision drafted by George Mason as referenced above.[51]

George Mason, arguing against a standing army and funding of the militias by the federal government, stated that "[t]he militia may be here destroyed by that method which has been practised [sic] in other parts of the world before; that is, by rendering them useless—by disarming them."[52] Mason reasoned that if Congress had complete control of a militia, Congress could refuse to fund or discipline the militia because it would have the exclusive right to do so.[53] Yet, Justice Scalia rejected the importance of protecting armed militias as a throw-away preface to the Second Amendment.[54] As we shall see, this was a departure from a long tradition of

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45 *American Revolution Fact*, AM. BATTLEFIELD TR., https://www.battlefields.org/learn/articles/american-revolution-faqs#:~:text=Over%20the%20course%20of%20the,numbered%20upwards%20of%20145%2C000%20men (last visited Sept. 18, 2023).

46 *Id*.

47 VA. DECL. OF RTS., § 13.

48 *Id*.

49 District of Columbia v. Heller, 554 U.S. 570, 602 (2008).

50 *Id*. at 601.

51 *Id*. at 659 (Stevens, J., dissenting).

52 *Id*. at 655.

53 *Id*.

54 Antonin Scalia, *Originalism: The Lesser Evil*, 57 U. CIN. L. REV. 849, 856-57 (1989) (conceding that in Scalia's view that "[i]ts greatest defect . . . is the difficulty of applying it correctly . . . . [I]t is often exceedingly difficult to plumb the original understanding of an ancient text. Properly done, the task requires the consideration of an enormous mass of

judicial decisions attaching importance to the original understanding of this language.[55] Instead, Justice Scalia noted that while most colonial declarations were silent on the right to bear arms, "the most likely reading of all four of these pre-Second Amendment state constitutional provisions is that they secured an individual right to bear arms for defensive purposes."[56] Justice Scalia points to other instances which, in his view, demonstrate the Second Amendment is an individualized right.[57] One such occasion is when Catholics were not allowed to keep and bear arms when they failed to attend church service.[58]

In reaching his conclusion in *Heller*, Justice Scalia ignored many grammatical distinctions within the Bill of Rights.[59] The first instance is the term "people," which is a collective noun carrying significant weight.[60] It is notably used in the Constitution's preamble, "We the People," and recurs in several amendments, including the First, Second, Fourth, Ninth, Tenth, and Seventeenth.[61] Conversely, in Article I, Section 2, the term "person" is used to denote individuals.[62] Similarly, "person" is also used to denote individuals in the Fourth Amendment[63] and the Fifth Amendment.[64]

In his dissent, Justice Stevens argues that while the majority opinion suggests the language "the people" means the same as it does in the First and Fourth Amendments, the majority deviates from that reading by creating a subset that is "significantly narrower than the class of persons protected by the First and Fourth Amendments."[65] Stevens argues that the majority's reading of "the people" under the Second Amendment limits it to "law-

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material—in the case of the Constitution and its Amendments, for example, to mention only one element, the records of the ratifying debates in all the states."). Ironically, that is exactly what dissenters Justice Stevens and Bryer undertook. *See, e.g.*, District of Columbia v. Heller, 554 U.S. 570, 655 (2008) (Stevens, J., dissenting).

55 Antonin Scalia, *Originalism: The Lesser Evil*, 57 U. CIN. L. REV. 849, 856-57 (1989) (conceding that in Scalia's view that "[i]ts greatest defect . . . is the difficulty of applying it correctly . . . . [I]t is often exceedingly difficult to plumb the original understanding of an ancient text. Properly done, the task requires the consideration of an enormous mass of material—in the case of the Constitution and its Amendments, for example, to mention only one element, the records of the ratifying debates in all the states.").

56 *Heller*, 554 U.S. at 602.

57 *See generally id*. at 594-95.

58 *Id*. at 652.

59 *See generally id*.

60 *See generally* U.S. CONST. amends. I, II, IV, IX, & X; *see generally* Jack Caulfield, *What is a collective Noun? Examples and Definitions*, SCRIBBR (April 18, 2023), https://www.scribbr.com/nouns-and-pronouns/collective-nouns/.

61 U.S. CONST. amends. I, II, IV, IX, X, & XVII.

62 U.S. CONST. art. I § 2 ("No Person shall be a Representative . . ." and "No Person shall be a Senator . . . ").

63 U.S. CONST. amend. IV ("The right of the people to be secure in their persons . . .").

64 U.S. CONST. amend. V ("No person shall be held to answer for a capital, or otherwise infamous crime . . .").

65 District of Columbia v. Heller, 554 U.S. 570, 689 (2008) (Stevens, J., dissenting).

abiding, responsible citizens."[66] Thus, "only law-abiding, responsible citizens" have a right to "keep and bear arms."[67] This interpretation, Stevens asserts, diverges from that of the First and Fourth Amendments, where "the people" encompasses all persons, including felons and other citizens deemed irresponsible, as they do not forfeit such protections merely for lacking the status of "law-abiding, responsible citizens."[68]

Justice Scalia also ignored the historical setting that inspired State declarations and the Second Amendment. During the adoption of the Constitution, individual states were relinquishing a portion of their sovereignty.[69] The Ninth and Tenth Amendments emphasized that the federal government was one of limited powers.[70] For example, Rhode Island abstained from sending delegates to the Constitutional Convention due to apprehensions regarding the necessity of a robust federal government that might be dominated by larger states.[71] This sentiment was exemplified on May 18, 1790, when the United States Senate approved a bill proposing a complete trade embargo against Rhode Island, effectively isolating the small state from the Union.[72] Faced with this ultimatum, Rhode Island succumbed within a mere eleven days and ratified the Constitution on May 29, 1790.[73] It was not until 1791 that the Bill of Rights was formally adopted.[74]

B. Nineteenth Century

Early data on homicide rates in the United States is sparse and likely not entirely reliable.[75] After the American Revolution, white-on-white homicide rates remained low in the well-settled areas of the Northeast and Midwest.[76] In contrast, homicide rates remained high in the South into the West due to a lack of modern justice systems and understaffed law enforcement.[77] There were at least fifty-one notable Old West gangs and forty

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66 *Id*. at 652.

67 *See id*. at 689.

68 *See generally id*.

69 *See id*. at 645.

70 U.S. CONST. amends. XI, X.

71 *US Constitution*, R.I. DEP'T OF STATE, https://www.sos.ri.gov/divisions/civics-and-education/for-educators/themed-collections/ri-and-us-constitution (last visited Mar. 27, 2024).

72 Jessie Kratz, *"Rogue Island": The last state to ratify the Constitution,* NAT'L ARCHIVE: PIECES OF HIST. (May 15, 2015), https://prologue.blogs.archives.gov/2015/05/18/rogue-island-the-last-state-to-ratify-the-constitution.

73 *Id*.

74 CATO INSTITUTE, THE DECLARATION OF INDEPENDENCE AND THE CONSTITUTION OF THE UNITED STATES OF AMERICA, 43 (1998).

75 Douglas Lee Eckberg, *Estimates of Early Twentieth-Century U.S. Homicide Rates: an Econometric Forecasting Approach*, 32 DEMOGRAPHY, no. 1, Feb., 1995, at 1-2; Roger Lane, *Murder in America: A Historian's Perspective,* 25 CRIME & JUST. 191, 193 (1999).

76 Roger Lane, *Murder in America: A Historian's Perspective,* 25 CRIME & JUST. 191, 198 (1999).

77 *Id*. at 199.

famous gunfights.[78] Films of the Old West typically showed every man carrying a weapon.[79] In California, homicide rates were much higher than the earlier rates in New England but dropped dramatically between 1850 and 1900.[80] As the latter half of the nineteenth century progressed, both the number of police officers and prison populations in cities increased.[81] New York City showed a spike around the time of the Civil War but returned to lower numbers thereafter.[82]

Concerns over gun violence are not new to the United States.[83] In 1837, the Georgia Legislature enacted "An Act to Guard and Protect the Citizens of this State, Against the Unwarrantable and too Prevalent use of Deadly Weapons."[84] In a remarkable decision in 1846, the Georgia Supreme Court held that the Second Amendment was not limited to the federal government and applied it to invalidate state law.[85] This was well before the adoption of the Fourteenth Amendment, which incorporated most of the Bill of Rights.[86]

Thirty years later, in *United States v. Cruikshank*, the United States Supreme Court explicitly ruled that the Second Amendment applied solely to the federal government.[87] This ruling followed the adoption of the Fourteenth Amendment and presumably survived until *Heller*.[88] Justice Stevens criticized the majority opinion in *Heller* as "not accurate," contending that the majority misinterpreted *Cruickshank* by "describ[ing] the right protected by the Second Amendment as 'bearing arms for a lawful purpose . . . .'"[89] The language cited in the preceding footnote supports Justice Stevens' dissent because the Court in *Cruickshank* interpreted the

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78 Kathy Alexander, *Outlaw Gangs*, LEGENDS OF AM. (last updated Dec. 2021), https://www.legendsofamerica.com/outlaw-gangs/.

79 Matt Jancer, *Gun Control is as Old as the Old West*, SMITHSONIAN MAG. (Feb. 5, 2018), https://www.smithsonianmag.com/history/gun-control-old-west-180968013/.

80 *Homicide Rates in the U.S., 1900-2006*, NAT'L ACADEMIES, https://sites.nationalacademies.org/cs/groups/dbassesite/documents/webpage/dbasse_083892.pdf (last visited Sept. 18, 2023).

81 *See generally* Roger Lane, *Urban Police and Crime in Nineteenth-Century America*, 15 CRIME & JUST. 1 (1992).

82 *Homicide Rates in the U.S., 1900-2006*, NAT'L ACADEMIES, https://sites.nationalacademies.org/cs/groups/dbassesite/documents/webpage/dbasse_083892.pdf (last visited Sept. 18, 2023).

83 Lane, *supra* note 77, at 218.

84 1837 Ga. Laws 90.

85 Nunn v. State, 1 Ga. 243, 251 (1846); *contra* State v. Newsom, 27 N.C. 250 (1844). In his *Heller* dissent Justice Bryer characterized this opinion as erroneous. District of Columbia v. Heller, 554 U.S. 570, 688 (2008).

86 Gideon v. Wainwright, 372 U.S. 335 (1963).

87 United States v. Cruikshank, 92 U.S 452, 553 (1875).

88 *Id*. ("The second amendment declares that it shall not be infringed; but this, as has been seen, means no more than that it shall not be infringed by Congress. This is one of the amendments that has no other effect than to restrict the powers of the national government, leaving the people to look for their protection against any violation by their fellow-citizens of the rights it recognizes, to what is called, in The City of New York v. Miln, 11 Pet. 139, the 'powers which relate to merely municipal legislation, or what was, perhaps, more properly called internal police,' 'not surrendered or restrained' by the Constitution of the United States.").

89 *Heller*, 554 U.S. at 673 (Stevens, J., dissenting) (criticizing *Cruikshank*, 92 U.S at 553).

Second Amendment solely as a constraint on the federal government.[90] In a subsequent case, *Robertson v. Baldwin*, the Court affirmed that "the right of the people to keep and bear arms (art. 2) is not infringed by laws prohibiting the carrying of concealed weapons . . . ."[91]

Numerous cases during the nineteenth century have held that the Second Amendment was intended to protect the right of states to organize a militia—not an individual right, guaranteeing individuals the unrestricted possession of firearms in all situations.[92] Likewise, numerous state decisions after the adoption of the Fourteenth Amendment in 1868 concluded that laws regulating firearm possession did not infringe upon the Second Amendment.[93]

C. Twentieth Century

Throughout the twentieth century, homicide rates in the United States consistently surpassed those in Australia, Canada, England, and Wales.[94] Notably, there was a significant decline from the 1940s until the mid-1960s, followed by a resurgence to higher levels during the mid-1960s.[95] Subsequently, rates declined again toward the end of the century. [96] The trend of decreasing homicide rates persisted until 2014 when they began rising somewhat dramatically through 2020.[97]

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90 *Cruikshank*, 92 U.S at 553 ("The second amendment declares that it shall not be infringed; but this, as has been seen, means no more than that it shall not be infringed by Congress. This is one of the amendments that has no other effect than to restrict the powers of the national government, leaving the people to look for their protection against any violation by their fellow-citizens of the rights it recognizes, to what is called, in The City of New York v. Miln, 11 Pet. 139, the 'powers which relate to merely municipal legislation, or what was, perhaps, more properly called internal police,' 'not surrendered or restrained' by the Constitution of the United States.").

91 Robertson v. Baldwin, 165 U.S. 275, 281-82 (1897).

92 *See, e.g.*, Fife v. State, 31 Ark. 455, 461 (1876); State v. Buzzard, 4 Ark. 18, 28 (1842).

93 English v. State, 35 Tex. 473 (1872); State v. Shelby, 2 S.W. 468, 469 (1886) (citing United States v. Cruikshank, 92 U.S 452, 553 (1875) that the Second Amendment was not a restriction on states); State v. Wilforth, 74 Mo. 528 (1881); State v. Workman, 14 S.E. 9 (1891); Andrews v. State, 50 Tenn. 165 (1871); State v. Smith, 11 La. Ann. 633 (1856).

94 *See U.S. Murder/Homicide Rate 1990-2023*, MACROTRENDS, https://www.macrotrends.net/countries/USA/united-states/murder-homicide-rate (last visited Sept. 5, 2023); *see also The Pattern of 20th Century Homicide: Data Problems*, NAT. ACAD., https://sites.nationalacademies.org/cs/groups/dbassesite/documents/webpage/dbasse_083892.pdf (last visited Mar. 27, 2024) (showing homicide rates in the United States well above 8 per 100,000 in the early 20th Century, dropping from the 1940s until the 1960s, rising to approximately 10 per 100,000 by the 1970s, and falling until about 2014, when they began the current dramatic increase); *Rate Remains Elevated as New Crime Reporting System Begins*, N.Y. TIMES (March 16, 2021), https://www.nytimes.com/2021/03/16/upshot/murder-rate-usa.html.

95 *See id.*

96 *See id.*

97 Jeff Asher, *Rate Remains Elevated as New Crime Reporting System Begins*, N.Y. TIMES (Sep. 22, 2021), https://www.nytimes.com/2021/03/16/upshot/murder-rate-usa.html.

In response to the increased homicide rates, numerous gun control laws were passed by Congress during the twentieth century.[98] In 1934, Congress passed the National Firearms Act, which, among other things, regulated the sale, possession, and registration of fully automatic firearms and sawed-off shotguns.[99] A Second Amendment challenge followed in *United States v. Miller*.[100] Justice McReynolds, writing for the Court, stated:

> In the absence of any evidence tending to show that possession or use of a "shotgun having a barrel of less than eighteen inches in length" at this time has some reasonable relationship to the preservation or efficiency of a well regulated militia, we cannot say that the Second Amendment guarantees the right to keep and bear such an instrument. Certainly, it is not within judicial notice that this weapon is any part of the ordinary military equipment or that its use could contribute to the common defense.[101]

Justice McReynolds went on to reference the significance of the militia and what it means in its historical context.[102] He emphasized that the militia, which is "a body of citizens enrolled for military discipline," would be "expected to appear bearing arms supplied by themselves and of the kind in common use at the time."[103]

Following the assassinations of President John F. Kennedy, Robert F. Kennedy, and civil rights leader Martin Luther King Jr., the United States enacted the Gun Control Act in 1968.[104] The Act repealed the Federal Firearms Act and updated provisions for the importation of guns and ownership requirements.[105]

Congress also enacted the Brady Handgun Violence Prevention Act of 1993, often referred to as the Brady Act or the Brady Bill.[106] The Brady Act required a waiting period for a criminal background check to prevent criminals from purchasing handguns.[107] In 1993, the Supreme Court, in *Printz v. United States*, declared the background check requirements in violation of, not the Second Amendment, but of dual sovereignty because

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98 *See* Sarah Gray, *Here's a Timeline of the Major Gun Control Laws in America,* TIME (Apr. 30, 2019), https://time.com/5169210/us-gun-control-laws-history-timeline/.

99 National Firearms Act, 26 U.S.C.A. § 5841.

100 United States v. Miller, 307 U.S. 174, 178 (1939).

101 *Id*. at 178.

102 *Id*. at 178-80.

103 *Id*. at 179.

104 *History of Federal Firearms Laws In The United States*, U.S. DEP'T OF JUST., https://www.justice.gov/archive/opd/AppendixC.htm#:~:text=Following%20the%20assassinations%20of%20President,the%20federal%20regulation%20of%20firearms (last visited Mar. 27, 2024).

105 Brady Handgun Violence Prevention Act, 18 U.S.C. § 922(g) (1968).

106 *Id*.

107 *Id*.

they compelled states to administer a federal regulatory scheme.[108] Interestingly, *Printz* was written by Justice Scalia.[109]

By analyzing recent actions in the twentieth century, it is safe to conclude that the danger or threat of the federal government from disarming the states has passed.[110] Rather than relying on the protection of the Second Amendment, which was designed to protect state militias from federal disarmament,[111] the federal government now controls state action through the Supremacy Clause[112] and its extensive powers of taxation, debt financing, and spending to control state action.[113]

IV. DETERRENCE: THEORY AND EVIDENCE

Heller cut off the ability of states to try different approaches to control the violence epidemic.[114] If federal prohibitions were eliminated, the states would be free to experiment to determine optimal crime deterrence in the manner described by Mr. Justice Brandeis as "one of the happy incidents of the federal system that a single courageous State may, if its citizens choose, serve as a laboratory; and try novel social and economic experiments without risk to the rest of the country."[115] Unfortunately, the current interpretation of the Second Amendment prevents states from implementing sensible solutions. However, overruling or repealing it would not lead to a total ban on guns throughout the United States. Rather, individual states would have to decide what constitutes reasonable regulations. It seems obvious that a ban on assault weapons would likely be the first of its type, as evidenced by recent movements in Illinois.[116] Some states with numerous hunters might permit hunting rifles and shotguns, while others might not. One can only speculate about political solutions, but any attempts at gun control would likely save lives.[117]

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108 Printz v. United States, 518 U.S. 1003 (1996).

109 *Id*.

110 *See* District of Columbia v. Heller, 554 U.S. 570, 591 (2008).

111 Legal Information Institute, *Second Amendment: Doctrine and Practice*, CORNELL L. SCH., https://www.law.cornell.edu/constitution-conan/amendment-2/second-amendment-doctrine-and-practice (last visited Sept. 4, 2023).

112 Legal Information Institute, *Supremacy Clause: Current Doctrine*, CORNELL L. SCH., https://www.law.cornell.edu/constitution-conan/article-6/clause-2/supremacy-clause-current-doctrine (last visited Sept. 5, 2023).

113 *Id*.

114 *Heller*, 554 U.S. at 614.

115 New State Ice Co. v. Liebmann, 285 U.S. 262, 311 (1932) (Brandeis, J., dissenting).

116 Wilson v. Cook Cnty., 937 F.3d 1028 (7th Cir. 2019) (sustaining ban on assault rifles and large capacity magazines), *cert. denied* 141 S.Ct. 110 (2020).

117 Aylin Woodward & Erin Snodgrass, *Gun control really works. Science has shown time and again that it can prevent mass shootings and save lives.*, INSIDER (last updated July 5, 2022), https://www.businessinsider.com/gun-control-research-how-policies-can-reduce-deaths-2019-8#in-2017-39773-people-in-the-us-died-from-firearms-according-to-the-centers-for-disease-

Nobel laureate Gary S. Becker set the theoretical model for the deterrence of criminal activity.[118] Potential criminals are deterred by the probability of apprehension, conviction, and the size of punishment.[119] He observed that differences in the reactions of potential criminals depend, to some extent, on differing elasticities of response to different levels of enforcement:

> For example, crimes of passion, like murder or rape, or crimes of youth, like auto theft are often said to be less responsive to changes in [the probability of apprehension and conviction, and the size of punishments] than are more calculating crimes by adults, like embezzlement, antitrust violation, or bank robbery.[120]

The purchase and possession of a gun would be a calculated crime because, unlike the crimes of passion or crimes of youth, there are no external motives simply for buying and possessing a firearm.[121]

Numerous empirical studies have examined Becker's work.[122] One study concluded, "[D]espite the rich history of econometric modeling spanning over 40 years, there is arguably no consensus on whether there is a strong deterrent effect of law enforcement policies on crime activity."[123] "Empirical studies provide mixed evidence that is insufficient to draw clear conclusions."[124] A study at the Sentencing Project criticized economists' use of a rational choice model, noting that "half of all state prisoners were under the influence of drugs or alcohol at the time of their offense."[125] Therefore, "it is unlikely that such persons are deterred by either the certainty or severity of punishment . . . ."[126] However, gun acquisition and possession are presumably rational acts, whereas use against another may not be as rational.[127]

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control-and-prevention-cdc-1 (showing multiple studies have linked various gun control methods to lower rates of mass shootings and gun-related deaths).

118 Gary S. Becker, *Crime and Punishment: An Economic Approach*, 76 J. POL. ECON. 169 (1968).

119 *Id*. at 204.

120 *Id*. at 205.

121 *Id*.

122 *See generally* Maurice J. G. Bun et al., *Crime, Deterrence and Punishment Revisited*, 59 EMPIRICAL ECON. 2303 (2019).

123 *Id*. at 2305.

124 *Id*.

125 Valerie Wright, *Deterrence in Criminal Justice*, THE SENTENCING PROJECT 1, 2 (Nov. 2010), available at http://www.antoniocasella.eu/nume/Wright_2010.pdf (citing Christopher Mumola, *Substance Abuse and Treatment, State and Federal Prisoners*, 1997, Bureau of Justice Statistics Special Report, 1999).

126 *Id*.

127 *See generally Exploring the Disagreement Among Gun Policy Experts*, RAND (Mar. 7, 2022), https://www.rand.org/pubs/articles/2022/exploring-the-disagreement-among-gun-policy-experts.html.

In the Sentencing Project study, the authors failed to cite a 2003 article that explains why earlier efforts were inconclusive and provides a more tailored empirical study.[128] The study focuses on the deterrent effect of execution.[129] The article contradicts a different study's findings that "criminal activity is highly responsive to the prospect of arrest and conviction, but much less responsive to the prospect or severity of imprisonment, if at all."[130] Various studies conducted in the United States may encounter challenges due to numerous variables affecting sentencing outcomes with each criminal charge.[131] These factors contribute to heightened uncertainty regarding the imposition of sufficiently deterrent sentences.[132] Examples of such variables include plea bargaining (often when testifying against a co-defendant), a lengthy potential appeal process to challenge the validity of a conviction, broad judicial discretion about the severity of sentences, and the probability of early parole.[133] Congressional reforms in the Sentencing Reform Act of 1984, which sought to establish mandatory minimum sentences for various categories of crimes, were overruled by the Supreme Court.[134] The Court held that these mandatory sentencing guidelines violated the Sixth Amendment right to trial by jury.[135] Despite this, similar guidelines were adopted locally in some urban counties and states.[136]

The 2003 article by Dezhbakhsh et al. begins with an important study of methodology that calls into question much of earlier work (and much that followed dealing with these same issues), which found little or no deterrent effect in capital punishment.[137] The authors use county-by-county data,

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128 Hashen Dezhbakhsh et al., *Does Capital Punishment Have a Deterrent Effect? New Evidence from Postmoratorium Panel Data*, 5 AM. LAW & ECON. REV. 344 (2003).

129 *Id*.

130 Bun et al., *supra* note 123, at 2305.

131 Dezhbakhsh et al., *supra* note 129, at 344.

132 *Id*.

133 *See, e.g.*, Katherine J. Strandburg, *Deterrence and the Conviction of Innocents*, 35 CONN. L. REV. 1321, 1338 (concluding from model-based analysis that plea bargaining may increase or decrease deterrence, depending on other circumstances).

134 United States v. Booker, 543 U.S. 220, 226–27 (2005).

135 *Id*.

136 The first sentencing guidelines jurisdictions were county-wide, particularly in Denver, Newark, Chicago and Philadelphia. Arthur M. Gelman & Jack M. Kress, *How Chaotic Is Sentencing in Your Jurisdiction*, 17 JUDGES J. 35, 35–36 (1978). Statewide guidelines systems were next established in Utah, Minnesota, Pennsylvania, Maryland, Michigan, Washington, and Delaware, before the federal sentencing guidelines were formally adopted in 1987. Richard S. Frase, *State Sentencing Guidelines: Diversity, Consensus, and Unresolved Policy Issues*, 105 COLUM. L. REV. 1190, 1196 (2005). Given that the vast majority of criminal sentencing is done at the state level, the American Law Institute and the American Bar Association have each recommended such systems for all the states, and nearly half the states presently have such systems, although significant variations exist among them. Richard S. Frase, *Forty Years of American Sentencing Guidelines: What Have We Learned?*, 48 CRIME & JUST. 79, 80 (2019).

137 Dezhbakhsh et al., *supra* note 129, at 345 (citing Isaac Ehrlich, *The Deterrent Effect of Capital Punishment: A Question of Life and Death*, 65 AM. ECON. REV. 397 (1975), as the first important contradiction of the earlier consensus).

disaggregating data previously used in the literature.[138] This approach allowed them to address the issue of whether executions in one location have a deterrent effect in another and instead focus on testing for local characteristics.[139] In other words, they avoid the issue of whether multiple executions in Seattle will have any deterrent effect in Miami and allow testing for local characteristics.[140] That study found that both the probability of arrest and a death sentence were highly significant.[141] Further, each execution in the study resulted in an average of eighteen fewer murders or at least eight fewer murders.[142] Still, there are other laboratories to be examined, such as other nations.[143]

Singapore has provided one answer.[144] Upon arrival at the hotel from the Singapore airport, the author and his wife were informed by their driver that they were in the safest city in the world. Although they did not seek clarification at the time, they subsequently learned of Singapore's stringent laws, where murder carries a mandatory death sentence, as does the use of firearms with intent to injure.[145] Singapore was a violent and lawless city-state, with large criminal gangs, kidnappings, and shootouts with the police.[146] Guns were readily available in department stores as well as from smugglers before strict new penalties were imposed.[147] Other factors

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138 *Id*. at 346.

139 *Id*. at 359.

140 *Id*. Their formulation is consistent with the argument that criminals form perceptions based on observation of friends and acquaintances. *Id*. at 364.

141 *Id*. at 369.

141 *See Study: International Data Shows Declining Murder Rates After Abolition of Death Penalty*, DEATH PENALTY INFOR. CTR. (Jan. 3, 2019), https://deathpenaltyinfo.org/news/study-international-data-shows-declining-murder-rates-after-abolition-of-death-penalty; *see also What Happens to Murder Rates when the Death Penalty is Scrapped? A Look at Eleven Countries Might Surprise You*, ABDORRAHMAN BOROUMAND CTR. (Dec. 13, 2018), https://www.iranrights.org/library/document/3501.

142 Dezhbakhsh et al., *supra* note 129, at 369.

143 *See Study: International Data Shows Declining Murder Rates After Abolition of Death Penalty*, DEATH PENALTY INFOR. CTR. (Jan. 3, 2019), https://deathpenaltyinfo.org/news/study-international-data-shows-declining-murder-rates-after-abolition-of-death-penalty; *see also What Happens to Murder Rates when the Death Penalty is Scrapped? A Look at Eleven Countries Might Surprise You*, ABDORRAHMAN BOROUMAND CTR. (Dec. 13, 2018), https://www.iranrights.org/library/document/3501.

144 *See Perceptions on the effectiveness of capital punishment as a deterrent for major crimes in Singapore as of May 2021*, STATISTA RSCH. DEP'T (May 22, 2023), https://www.statista.com/statistics/1368262/singapore-views-on-effectiveness-of-capital-punishment-to-deter-crimes/ ("[T]he majority of respondents were of the opinion that capital punishment is an effective deterrent for drug trafficking, murder, and firearm offences.").

145 Under the Arms Offences Bill enacted in 1974, anyone attempting to use firearms with intent to cause physical injury would face the death penalty, as would accomplices, and illegal possession of a firearm also led to long prison sentences. *See At Gunpoint: Wiping Our Illegal Firearms in Singapore*, BIBLIOSA (Oct. 1, 2020), https://biblioasia.nlb.gov.sg/vol-16/issue-3/oct-dec-2020/gunpoint/.

146 *Id*.

147 *Id*.

contributed to the decline in violent crime.[148] Applicants for a gun owner's license in Singapore are required to establish a genuine reason to possess a firearm, such as sport and self-protection.[149] Illegal possession of a firearm also led to lengthy prison sentences.[150]

Along with increased punishments, policing was improved, including the use of gun-sniffing dogs at points of entry and regional police cooperation to prevent gun smuggling.[151] In 2020, Singapore had a murder rate of 0.17 per 100,000,[152] while the United States had a rate of 7.8 per 100,000,[153] making it thirty-one times higher than Singapore's rate.[154] During the period from January to July 2022, Atlanta's murder rate stood at 17 per 100,000, surpassing Chicago's rate.[155] Atlanta's rate was approximately 3.2 times higher than the United States' rate in 2020 and approximately 100 times higher than Singapore's rate.[156]

In 2018, Japan experienced a homicide rate of 0.3 per 100,000 citizens, according to data from the World Bank.[157] However, the number of gun-related deaths in Japan is extremely low, with only nine firearm deaths recorded in 2018.[158] At the close of World War II, Japan experienced a move to pacifism, which led to a total ban on firearms and a 1958 law that "no

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148 *Id*.

149 *Id*.

150 *Id*.

151 *Id*.; *Singapore-Gun Facts, Figures and the Law*, GUNPOLICY, https://www.gunpolicy.org/firearms/region/singapore (last visited Sep. 2, 2023) (In Singapore, all guns must be purchased through a licensed dealer. The maximum penalty for unlawful possession of a firearm is up to 10 years in prison and six strokes of the cane).

152 *Singapore Murder/Homicide Rate 1990-2023*, MACROTRENDS, https://www.macrotrends.net/countries/SGP/singapore/murder-homicide-rate#:~:text=Singapore%20murder%2Fhomicide%20rate%20for%202020%20was%200.17,a%2017.3%25%20decline%20from%202019 (last visited Sept. 7, 2023).

153 *See* John Gramlich, *What we know about the increase in U.S. murders in 2020*, PEW RSCH. CTR. (Oct. 27, 2021), https://www.pewresearch.org/short-reads/2021/10/27/what-we-know-about-the-increase-in-u-s-murders-in-2020/#:~:text=There%20were%207.8%20homicides%20for,the%20terrorist%20attacks%20of%20Sept.

154 *See generally At Gunpoint: Wiping Our Illegal Firearms in Singapore*, BIBLIOSA (Oct. 1, 2020), https://biblioasia.nlb.gov.sg/vol-16/issue-3/oct-dec-2020/gunpoint/.

155 Hope Ford, *Atlanta's crime rate is worse than Chicago–for certain crimes*, ALIVE (July 28, 2022, 5:30 PM), https://www.11alive.com/article/news/crime/atlanta-chicago-crime-rates/85-1a13cc4a-bdef-43d6-a213-69ced3835b48.

156 *Id*.

157 *World Development Indicators*, THE WORLD BANK, https://databank.worldbank.org/reports.aspx?source=2&series=VC.IHR.PSRC.P5&country=JPN (last visited Sept. 4, 2023).

158 Brian Bushard, *Here's How Japan's Low Gun Death Rate Compares To The U.S. and Other Countries*, FORBES (July 8, 2022, 11:15 AM), https://www.forbes.com/sites/brianbushard/2022/07/08/heres-how-japans-low-gun-death-rate-compares-to-the-us-and-other-countries/.

person shall possess a firearm or firearms or a sword or swords."[159] The law has since been loosened:

> If Japanese people want to own a gun, they must attend an all-day class, pass a written test, and achieve at least 95% accuracy during a shooting range test. Then they have to pass a mental-health evaluation, which takes place at a hospital, and pass a background check, in which the government digs into their criminal record and interviews friends and family. They can only buy shotguns and air rifles—no handguns—and every three years they must retake the class and initial exam.[160]

In the wake of *Bruen*, New York has adopted a model similar to Japan's, which requires a person to be of good moral character, pass training and tests, and submit to background checks in order to carry concealed firearms.[161] Its validity remains to be determined, although a lower court has invalidated some of its restrictions.[162] This approach has been followed in several other decisions, relying on Justice Thomas's caution that the only permitted regulations are those customary in the Revolutionary Era.[163] The frightening increase in homicides by firearm vividly demonstrates the obsolescence of that interpretation.[164]

One might criticize such penalties as cruel and unusual, but consider the results. Once citizens are aware of such laws and that they are seriously enforced, the number of deaths from shootings may drop to virtually zero. Not only may innocent people's lives be saved in this manner, but so may the lives of incipient murderers. If Japan's rate of 0.3 per 100,000 were applied to the United States 2020 population of 331 million, rather than the U.S. rate of 5.3, deaths could have been drastically reduced.

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159 Chris Weller et al., *Japan has almost completely eliminated gun deaths-here's how,* YAHOO! NEWS (April 20, 2023), https://news.yahoo.com/japan-almost-completely-eliminated-gun-003604787.html.

160 *Id*.

161 Alison Durkee, *New Gun Laws Take Effect After Supreme Court Struck Down New York's Last Attempt — Here's What To Know*, FORBES (Sept. 1, 2022 10:37 AM), https://www.forbes.com/sites/alisondurkee/2022/09/01/new-gun-laws-take-effect-after-supreme-court-struck-down-new-yorks-last-attempt---heres-what-to-know/?sh=4117de757363. *See* Justice Thomas's description of these laws in N.Y. State Rifle & Pistol Ass'n v. Bruen, 142 S. Ct. 2111, 2122-23 (2022).

162 Alison Durkee, *New Gun Laws Take Effect After Supreme Court Struck Down New York's Last Attempt – Here's What To Know*, FORBES (Sept. 1, 2022 10:37 AM), https://www.forbes.com/sites/alisondurkee/2022/09/01/new-gun-laws-take-effect-after-supreme-court-struck-down-new-yorks-last-attempt---heres-what-to-know/?sh=4117de757363.

163 Jacob Gershman, *Judges Across U.S. Expand Gun Rights, Taking Cues From Supreme Court Courts are placing more emphasis on historical traditions, presenting new challenges for defending gun regulations*, WALL ST. J. L. BLOG (Oct. 10, 2022, 4:58 PM), https://www.wsj.com/articles/judges-across-u-s-expand-gun-rights-taking-cues-from-supreme-court-11665432175#:~:text=Under%20the%20new%20guidance%2C%20judges,."%20Thus%2C%20a%20firearm%20restriction.

164 *Id*.

Other countries that may be considered similar to the United States, such as England and Wales, only have a homicide rate of 1.2.[165] Canada has a homicide rate of 2.1 per 100,000, and Australia and New Zealand have a rate of 0.7 per 100,000.[166] Part of the reason Australia has a lower homicide rate is because it adopted gun control measures after a decade of gun violence, culminating with the Port Arthur massacre in 1996, in which thirty-five people were killed and twenty-three others were wounded.[167] Australia's gun control measures included banning rapid-fire rifles and shotguns, creating uniform licensing and gun regulations across the country, and sponsoring a gun buyback program.[168] Following the implementation of these gun control measures, gun deaths in the following ten years fell by more than 50%.[169] A 2010 study found that the buyback program led to an average drop of 74% in the suicide rate.[170]

On the other hand, many other nations in the Americas have much higher homicide rates than the United States—17.2 per 100,000 in 2017.[171] Notable among those were Anguilla (28.3), Belize (31.2), Brazil (22.4), El Salvador (18.2), Honduras (38.2), Jamaica (52.1), Venezuela (19.3), and the U.S. Virgin Islands (49.6).[172]

V. CONCLUSION

Since federal gun control regulations have been weak and ineffective, perhaps because of legislative deadlock and polarized parties, there is little reason to expect effective federal action even if *Heller*[173] were overruled or the Second Amendment repealed. However, it should be feasible to overrule a recent decision with weak historical support that ignores key language of the Second Amendment, especially where the mistakes are so obvious. For example, the Supreme Court's ability to overturn *Roe v. Wade* in *Dobbs v. Jackson Women's Health Organization* highlights this possibility.[174] It is also important to note that the current Supreme Court appears open to

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165 *Victims of intentional homicide, 1990-2018*, UNITED NATIONS, https://dataunodc.un.org/content/data/homicide/homicide-rate (last visited Sept. 17, 2023).

166 *Id*.

167 Kara Fox et al., *How US gun culture stacks up with the world*, CNN WORLD (Apr. 10, 2023, 10:40 AM), https://www.cnn.com/2021/11/26/world/us-gun-culture-world-comparison-intl-cmd/index html#:~:text=A%202010%20study%20found%20the,after%20changing%20their%20gun%20laws.

168 *Id*.

169 *Id*.

170 *Id*.

171 *Victims of intentional homicide, 1990-2018*, UNITED NATIONS, https://dataunodc.un.org/content/data/homicide/homicide-rate (last visited Sept. 17, 2023).

172 *Id*.

173 District of Columbia v. Heller, 554 U.S. 570 (2008).

174 *See generally* Dobbs v. Jackson Women's Health Org., 142 S. Ct. 2228 (2022).

reconsidering established legal precedents.[175] The ruling in *Dobbs* suggests a willingness within the Court to revisit past judgments, potentially leading to significant shifts in legal interpretations.[176]

Likewise, the process of repeal involves a constitutional amendment, which could be initiated by Congress upon approval of two-thirds vote in both houses of Congress—an unlikely prospect—or upon a convention called by two-thirds of the states, and an amendment approved by the legislatures of three-fourths of the states.[177] Such an amendment could also permit mandatory sentencing in at least some circumstances, such as homicide. As of this writing, nineteen states have approved the Convention of States Action's efforts to convene a convention to restrict federal power and implement term limits.[178] This suggests that a convention is a possible albeit difficult route to be pursued, much like overturning precedent established in Second Amendment decisions.

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175 *See generally id*.

176 *See generally id*.

177 U.S. CONST. art.V.

178 *Progress Map: States that have passed the Convention of States Article V* application, CONVENTION OF STATES ACTION, https://conventionofstates.com/states-that-have-passed-the-convention-of-states-article-v-application (last visited Mar. 10, 2024).

WALKING BILLBOARDS: THE COPYRIGHT LANDSCAPE OF TATTOOS IN PROFESSIONAL ATHLETICS

Taylor Ingram[1]

I. INTRODUCTION

> "Blank skin is merely a canvas for a story." Chris Rainier[2]
>
> "I am a canvas of my experiences, my story is etched in lines and shading, and you can read it on my arms, my legs, my shoulders, and my stomach." Kat Von D[3]

A professional athlete and a tattoo artist walk into a tattoo parlor. That might sound like the setup to a joke, but what they are about to do is quite serious. The athlete has likely spent considerable time meeting with the tattoo artist to create custom artwork to apply to their skin via a tattoo gun. The amount of time the athlete spends in the chair depends on the intricacy of the artwork and the artist's experience level.[4] The athlete could spend hours sitting in a chair if the artwork is intricate or if the artist applies multiple

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[1] J.D. Candidate, Southern Illinois University School of Law, Class of 2024. I want to extend my heartfelt appreciation to my faculty advisor, Professor Zvi Rosen, for his invaluable support and guidance, for always making time to discuss my Note, including answering countless questions, and for pushing me to step past my boundaries. In addition, thank you to Professor Lorelei Ritchie for reviewing my contractual recommendations and discussing them with me. I want to express my deepest gratitude to my mother, Dana, for being a willing ear even when it felt like I was speaking in a different language; it was a testament to your love and patience. To my father, Lane, and stepmother, Cindy, for not raising too high of a brow and for keeping a straight face while I rambled on about the legal intricacies of tattoos. I would like to thank my partner, Tony Schuering, for his patience, understanding, and unwavering belief in me and for refraining from suggesting ink-related puns despite the temptation. Your restraint was commendable, and I am profoundly grateful for your support. To all listed above, thank you for sitting through endless rambles that often became rants. To my older brother, Gabe, for being one of my first and best teachers, from riding a bike to mathematics, you inspired me to question everything and come to my own conclusions. To my little brother, Lane, for teaching me the value of staying true to yourself. And, to the both of you, for no longer ganging up on me like you used to (I get it, you needed to "bond" or whatever, but ow!); I don't know what my life would look like without you.

[2] Abigail Tucker, *Looking at the World's Tattoos*, SMITHSONIAN MAG. (Oct. 2010), https://www.smithsonianmag.com/arts-culture/looking-at-the-worlds-tattoos-60545660/.

[3] Dr. Helen Ofosu, *Dressing the Part . . . Does this Include Body Art?*, I/O ADVISORY: BLOG (Feb. 6, 2017), https://ioadvisory.com/dress-the-part-body-art/.

[4] *See* Jodie Michalak, *How Long Does Getting a Tattoo Really Take?*, BYRDIE (June 26, 2021, 1:05 AM), https://www.byrdie.com/how-long-does-a-tattoo-take-3189034 ("The more intricate your piece, the longer the design will take to complete.").

tattoos during the same session.[5] As tattoos are pretty permanent, the athlete has probably researched the tattoo artist or has been referred to this specific artist by someone the athlete trusts. They have likely spent considerable time choosing the color, size, and placement of their tattoo. The athlete probably thinks that they have thought everything through. What they might not have considered, however, are the legal ramifications.

Tattoos, once seen as taboo, are now becoming a popular form of self-expression.[6] This rising popularity brings legal debate related to the artist's and client's intellectual property (IP) and name, image, and likeness (NIL) rights.[7] Although it seems evident that a tattoo on a client becomes part of their image and likeness, minds differ on whether that includes a right to license recreations of that tattoo.[8] Case law varies regarding the artist's and client's legal rights.[9] At one end of the spectrum, courts have found that clients have an implied license to tattoos on their bodies, or the use has been so small as to be *de minimis*.[10] At the other end of the spectrum, at least one court has determined that clients do not have an immediate implied license in their tattoos.[11] This inconsistency has been problematic in the Entertainment & Sports industries.[12] Few tattoo artists have brought lawsuits against athletes and business entities utilizing the athlete's likeness in marketing and media.[13] However, as courts continue to address these issues, tattoo copyright lawsuits could become common.

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5 *See id.*

6 James Ricci, *The Point Is Self-Expression, Say Tattoo Enthusiasts*, L.A. TIMES (Jan. 4, 2004, 12:00 AM), https://www.latimes.com/archives/la-xpm-2004-jan-04-me-tattoo4-story.html.

7 Daniel Rozansky & Michael Bernet, *WWE 'Smacked Down' in First-Ever Tattoo Copyright Trial. Sort of.*, FORBES (Oct. 12, 2022, 2:31 PM), https://www.forbes.com/sites/legalentertainment/2022/10/12/wwe-smacked-down-in-first-ever-tattoo-copyright-trial-sort-of/?sh=725f390b6352.

8 Michael J. Hoisington, *Celebrities Sue Over Unauthorized Use of Identity*, HIGGS, FLETCHER, & MACK: BLOG (Aug. 20, 2022), https://higgslaw.com/celebrities-sue-over-unauthorized-use-of-identity/.

9 *See, e.g.*, Solid Oak Sketches LLC v. 2K Games, Inc., 449 F. Supp. 3d 333 (S.D.N.Y. 2020); *but see* Alexander v. Take-Two Interactive Software, Inc., No. 3:18-cv-00966-SMY (S.D. Ill. Sept. 30, 2022).

10 *See, e.g.*, *Solid Oak Sketches LLC*, 449 F. Supp. 3d at 333.

11 *See, e.g.*, *Alexander*, No. 3:18-cv-00966-SMY.

12 Melissa Bergmann, *Tattoos in Sports Video Games Present Copyright Ownership Questions*, BELMONT UNIV.: BELMONT ENT. L.J. BLOG (Mar. 28, 2022), https://www.belmontentertainmentlaw.com/2022/03/28/tattoos-in-sports-video-games-present-copyright-ownership-questions/; Aaron Moss, *Tattoo Artist's Trial Win is a Loss for Bodily Autonomy, Free Speech*, COPYRIGHT LATELY (2022), https://copyrightlately.com/tattoo-artist-trial-victory-copyright-lawsuit/.

13 *See* Reed v. Nike, Inc. et al., CV 05 198, 2005 WL 1182840 (D. Or. Oct. 7, 2005); Complaint, Whitmill v. Warner Bros. Ent. Inc., No. 4:11-CV-00752 (E.D. Mo. Apr. 28, 2011), 2011 WL 2038149; Complaint, Allen v. Elec. Arts, Inc., No. 5:12-CV-3172 (W.D. La. Dec. 31, 2012), 2012 WL 6852208; Hayden v. 2K Games, Inc., 2022 WL 4356211 (N.D. Ohio 2022) (Jury Trial is set for June 14, 2023, at 9:00 AM in Cleveland, OH); *Solid Oak Sketches, LLC*, 449 F. Supp. 3d at 333; *Alexander*, No. 3:18-cv-00966-SMY.

Decisions on the interplay between tattoos, copyrights, and NIL have profound implications for artists and athletes (and, likely, for any other celebrity or public figure). This Note will analyze how the courts have grappled with issues related to rights associated with tattoos. Specifically, it will provide an in-depth analysis of the only tattoo case that has made it through a jury trial, *Alexander v. Take-Two*, as well as cases proceeding to the jury after *Alexander*.[14] It will argue that implicit in the tattooing process is an unspoken understanding, called an implied license, that grants the client some rights in the artwork. This Note will explore how agreements are utilized in the tattoo, entertainment, and sports industries. It will argue that licensing agreements can bridge the legal intricacies of copyright law and tattoos and provide a framework for protecting all parties' rights. Finally, it will suggest sample agreements to clarify the rights of the artist and the client.

II. BACKGROUND

A. A Brief History of Tattooing

Tattoo parlors are filled with an omnipresent buzzing noise—a buzz that the uninitiated would relate to a dentist's office but which induces an entirely different reaction to the person about to receive a tattoo.[15] While this buzz is commonplace in the tattoo parlors of today and one that represents the modern application of ink to skin, it is not a sound that the early tattoo artists would recognize.[16] The art of tattooing can be traced back to the Neolithic period, some 5,200 years ago.[17]

The oldest-known mechanism of applying a tattoo involved the use of a "sharp point set in a wooden handle . . . ."[18] The oldest tattoo was found on a mummy, nicknamed "Otzi," discovered in 1991 under a glacier on the Italian-Austrian border.[19] While Otzi was estimated to have walked the earth approximately 5,200 years before his body was discovered, one fact about

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14 *Alexander*, No. 3:18-cv-00966-SMY.

15 *See generally How Tattoo Machines Work*, INK & WATER TATTOO, https://www.inkandwatertattoo.ca/how-tattoo-machines-work (last visited Feb. 18, 2022) (describing how the tattoo gun mechanisms work to make a buzz sound).

16 The earliest known tattoo on a human body is on "the Iceman from the area of the Italian-Austrian border [found] in 1991 . . . [who] was carbon-dated at around 5,200 years old." *See* Cate Lineberry, *Tattoos: The Ancient and Mysterious History*, SMITHSONIAN MAG. (Jan. 1, 2007), https://www.smithsonianmag.com/history/tattoos-144038580/. In discussing tattoos on ancient Egyptian women, the author notes that these tattoos were applied using "a sharp point set in a wooden handle, dated to c. 3000 B.C." *Id*.

17 *See, e.g.*, Marilyn Scallan, *Ancient Ink: Iceman Otzi has the World's Oldest Tattoos*, SMITHSONIAN (Dec. 9, 2015), https://www.si.edu/stories/ancient-ink-iceman-otzi-has-worlds-oldest-tattoos.

18 *Id*.

19 *Id*.

Otzi is indisputable—Otzi was "inked up."[20] Otzi had no less than sixty-one tattoos spanning his body.[21] From Otzi to Cher[22] and everyone in between, tattoos have had specific meanings, both to the society in which they live and to the recipient of the tattoo.[23] Some cultures used tattoos in religious practices, for health, and for "social and anti-social purposes."[24] For example, researchers have surmised that the tattoos found on Otzi indicate tattoos used as therapy for joint pain.[25]

In ancient Egypt, it was assumed for decades that the tattooed female mummies uncovered in tombs had been "prostitutes" or "concubines."[26] However, at least one of the mummies believed to be a "royal concubine" was determined to be a "high-status priestess named Amunet, as revealed by her funerary inscriptions."[27] The "Scythian Pazyryk of the Altai Mountain region" most likely used tattoos to indicate nobility.[28] The ancient Greeks and Romans also used tattoos to distinguish individuals as belonging to "sects."[29] The Maori used individualized tattoos to display their "status, rank, and abilities."[30] Some cultures, including the Maori, even used tattoos to indicate what family they originated from.[31] In Europe, the popularity of tattooing decreased during the "rise of Christianity."[32] However, it experienced a resurgence when British aristocrats, including "King George V and later Edward VII were tattooed."[33] Additionally, it became common for seamen to receive tattoos.[34] Moreover, in different areas of India, tattoos

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20 "Inked up" is a slang phrase used to denote the presence of many tattoos on a person's body. *See Inked Up*, RAP DICTIONARY, https://rapdictionary.com/meaning/inked-up (last visited Feb. 18, 2024).

21 Marilyn Scallan, *Ancient Ink: Iceman Otzi has the World's Oldest Tattoos*, SMITHSONIAN (Dec. 9, 2015), https://www.si.edu/stories/ancient-ink-iceman-otzi-has-worlds-oldest-tattoos.

22 As of 1996, Cher had six tattoos; she got her first tattoo in 1972. Jim Sullivan, *Cher Thinks the Unthinkable*, BALT. SUN (June 1, 1996, 12:00 AM), https://www.baltimoresun.com/news/bs-xpm-1996-06-02-1996154167-story.html.

23 *See* Cate Lineberry, *Tattoos: The Ancient and Mysterious History*, SMITHSONIAN MAG. (Jan. 1, 2007), https://www.smithsonianmag.com/history/tattoos-144038580/.

24 WILFRID DYSON HAMBLY, THE HISTORY OF TATTOOING 25, 109, 171 (Dover ed. 2009).

25 *See id*.

26 *See id*.

27 *See id*.

28 *See id*.

29 *See id*. (suggesting tattoos in Rome and Greece had been "been largely used as a means to mark someone as 'belonging' either to a religious sect or to an owner in the case of slaves or even as a punitive measure to mark them as criminals").

30 Cate Lineberry, *Tattoos: The Ancient and Mysterious History*, SMITHSONIAN MAG. (Jan. 1, 2007), https://www.smithsonianmag.com/history/tattoos-144038580/.

31 *What is The History of Tattoos?*, MCGILL UNIV. (Mar. 20, 2017), https://www.mcgill.ca/oss/article/history-you-asked/what-history-tattoos ("The Danes, Norse and Saxons are known to have tattooed family crests onto their bodies.").

32 Alexa Stevenson, *Probing Question: What is the History of Tattooing?*, PENN STATE: RSCH. (June 19, 2008), https://www.psu.edu/news/research/story/probing-question-what-history-tattooing/.

33 *Id*.

34 *Id*.

have been used to show status, family, community, or even as a "marker for the afterlife."[35] Some were also used strictly for decorative purposes.[36]

In the United States, tattooing has long been integral to Native American culture.[37] Tattoos meant and were used differently tribe-to-tribe, but across the board, they were "considered a sacred and spiritual ritual."[38] Some tribes, like those in the Northwest, used tattoos to indicate "a sign of social status, lineage and relationships to natural and supernatural events."[39] The Han Gwich'in in Alaska use tattooing as a rite of passage, with men receiving tattoos on "their joints and wrists" and women receiving tattoos, called Yidįįłtoo, on the face.[40]

This was traditionally done through a stick-and-poke technique by Gwich'in tattoo artists.[41] The Yupik, also located in Alaska, uses thread to stitch tattoos.[42] The process is typically completed by "threading fine strands of reindeer or whale sinew through a bone or steel needle, then passing the thread through pigment and stitching designs into the top layer of skin."[43] The Yupik often tattooed "the joints of pallbearers after funerals and of hunters after they made their first kill" to prevent the "disembodied spirits of the recently deceased from entering the bodies of the living."[44] Like other

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35 Shamani Joshi, *This Artist is Trying to Preserve Ancient Tattoo Traditions that are Dying Out*, VICE (Nov. 1, 2021, 4:49 AM), https://www.vice.com/en/article/z3ne44/tattoo-traditions-history-stick-and-poke-indigenous-tribes-india (describing how an artist, Shomil Shah, is developing an archive of detailing the meaning behind different tattoo styles in India).

36 *Id*.

37 *United States' Evolving Tattoo Culture*, MAD RABBIT: BLOG (June 15, 2022), https://www.madrabbit.com/blogs/forever-brighter/tattoo-culture.

38 *Understanding the Native American Tattoo*, FAUST GALLERY (July 22, 2019), https://www.faustgallery.com/understanding-the-native-americantattoo/#:~:text=What%20 did%20tattoos%20symbolize% 20in,protection%20and%20guardian%20spirit%20emblems.

39 Cecily Hilleary, *Native Americans Revitalize Ancient Tattoo Traditions*, VOA (Oct. 30, 2022), https://www.voanews.com/a/6808363.html#:~:text=Tattoos%20often%20marked%20milestones %20and,he%20wore%2C%E2%80%9D%20Krutak%20said.

40 *Id*.

41 *Id*. Please note that, though Gwich'in women are taking up the tradition today, they noted that the "last Gwich'in tattoo artists had passed away." ("For years, Potts-Joseph wanted to have her chin marked, but the last Gwich'in tattoo artists had passed away. . . . After two years of praying on it, Potts-Joseph relented. Using a large ink-dipped sewing needle, she gave her daughter what are called Yidiiltoo—lines at her eyes and on her chin."); *See also* Christian Allaire, *In Alaska, Indigenous Women Are Reclaiming Traditional Face Tattoos*, VOGUE (Mar. 8, 2022), https://www.vogue.com/article/in-alaska-indigenous-women-are-reclaiming-traditional-face-tattoos.

42 Cecily Hilleary, *Native Americans Revitalize Ancient Tattoo Traditions*, VOA (Oct. 30, 2022), https://www.voanews.com/a/6808363.html#:~:text=Tattoos%20often%20marked%20milestones %20and,he%20wore%2C%E2%80%9D%20Krutak%20said.

43 *Id*. (citing research completed by Lars Krutak, author of "Tattoos Traditions of Native North America" and graduate of University of Alaska—Fairbanks).

44 Joshua Rapp Learn, *A New Generation Is Reviving Indigenous Tattooing*, ANTHROPOLOGY MAG. (Mar. 13, 2019), https://www.sapiens.org/biology/native-american-tattoos/ ("The St. Lawrence Yupik believe that joints are vulnerable points in which malevolent spirits can enter and cause injury or arthritis to different body parts.").

societies around the world, this tribe also uses tattoos as therapies to aid with joint pain.[45] Those are only a couple of the tribes in Alaska practicing traditional tattooing.[46]

Men of the Omaha tribe often received "honor marks" to indicate their rank.[47] These were tattooed using "flint points bound to rattlesnake rattles."[48] These are only a few examples of the differences in display, application, and meaning from only a few different tribes. Once a common practice in many tribes throughout the United States, tattooing is making its way back to Native American tribes, allowing them to "heal[] from the historical trauma that occurred."[49] Ironically, tattooing in America was not popular after Native American tribes were forbidden from practicing their traditions[50] until sailors traveled to the other side of the world.[51] The home of the modern tattoo is considered to be in New York.[52] However, Native American tattoos seem to have influenced the art form.[53] When Social Security numbers came into being, people often got them tattooed.[54] Cultures worldwide still occasionally use tattoos as they have in the past.[55] For example, Chris Rainier, a photographer who documents the meaning behind tattoos in different cultures by traveling and interviewing individuals, found that tattoos are still used to indicate lineage, religious belief, and community affiliations.[56]

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45 *Id*.

46 *See, e.g., id*. (outlining a traditional tattoo of the Inupiat that consists of "three solid lines that spread downward from underneath the middle of [the] lower lip to [the] chin," and noting that traditional Inupiate tattoos on women usually indicated different milestones).

47 Cecily Hilleary, *Native Americans Revitalize Ancient Tattoo Traditions*, VOA (Oct. 30, 2022), https://www.voanews.com/a/6808363.html#:~:text=Tattoos%20often%20marked%20milestones%20and,he%20wore%2C%E2%80%9D%20Krutak%20said.

48 *Id*.

49 Joshua Rapp Learn, *A New Generation Is Reviving Indigenous Tattooing*, ANTHROPOLOGY MAG. (Mar. 13, 2019), https://www.sapiens.org/biology/native-american-tattoos/ (quoting Marjorie Kunaq Tahbone, Nome, Alaskan native, commenting upon the reemergence of traditional Inupiat tattoo and her personal experience).

50 *See* Christian Allaire, *In Alaska, Indigenous Women Are Reclaiming Traditional Face Tattoos*, VOGUE (Mar. 8, 2022), https://www.vogue.com/article/in-alaska-indigenous-women-are-reclaiming-traditional-face-tattoos.

51 Olivia B. Waxman, *Tattoo History in the United States – How They Became a Thing*, TIME (Mar. 1, 2017, 9:42 AM), https://time.com/4645964/tattoo-history/.

52 *Id*.

53 Leeanne Root, *How Native American Tattoos Influenced the Body Art Industry*, ICT (Sep. 13, 2018), https://ictnews.org/archive/native-american-tattoos-influenced-body-art-industry.

54 Olivia B. Waxman, *Tattoo History in the United States – How They Became a Thing*, TIME (Mar. 1, 2017, 9:42 AM), https://time.com/4645964/tattoo-history/.

55 Abigail Tucker, *Looking at the World's Tattoos*, SMITHSONIAN MAG. (Oct. 2010), https://www.smithsonianmag.com/arts-culture/looking-at-the-worlds-tattoos-60545660/.

56 *Id*.

1. Modern Tattooing

Tattoos have evolved into a modern form of art where skilled artists attain celebrity status and find their appointments booked out months in advance.[57] It has become a thriving artistic industry across the globe.[58] Today, more than twenty percent of adults have more than one tattoo,[59] and most people who have tattoos decided to do so as a form of self-expression.[60]

People interested in becoming licensed tattoo artists tend to follow similar paths when pursuing the profession.[61] Becoming a tattoo artist usually requires creative skill, artistic talent, technical proficiency, and a deep understanding of the craft.[62] Tattoo artists generally start as apprentices.[63] However, before they reach that point, they must focus on improving their drawing, illustrating techniques, and developing a portfolio.[64] Although not necessarily required, this development can be accomplished through an art degree.[65]

Once an aspiring tattoo artist has developed a well-rounded skillset and created a portfolio, they can attempt to become an apprentice at an established tattoo shop.[66] Typically, an apprentice assists an experienced

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57 *Tattoo Artist*, ART CAREER PROJECT (Mar. 30, 2023), https://theartcareerproject.com/careers/tattoo-art/.

58 *See generally* Abigail Tucker, *Looking at the World's Tattoos*, SMITHSONIAN MAG. (Oct. 2010), https://www.smithsonianmag.com/arts-culture/looking-at-the-worlds-tattoos-60545660/.

59 Note: Tattoos are still perceived as relating to "negative personality characteristics, lower levels of inhibition, competence, and sociability, and higher levels of promiscuity." Vinita Mehta, *Are People with Tattoos Stigmatized?*, PSYCH. TODAY (Sep. 18, 2018), https://www.psychologytoday.com/us/blog/head-games/201809/are-people-tattoos-stigmatized; *Nearly Half of Americans Under 40 Have Tattoos*, RASMUSSEN REPS. (2022), https://www.rasmussenreports.com/public_content/lifestyle/general_lifestyle/january_2022/nearly_half_of_americans_under_40_have_tattoos.

60 *See* Karen J. Leader, *Occupy your Body: Activating 21st-Century Tattoo Culture*, 3 J. SOMAESTHETICS 44 (2017); *see also* Olivia Sanders, *Tattoos in Society: A Progression of Acceptance*, UNSUSTAINABLE MAG. (Feb. 27, 2022), https://www.unsustainablemagazine.com/acceptance-of-tattoos-in-society/; Liz Kierstein & Kari C. Kjelskau, *Tattoo as Art, the Drivers Behind the Fascination and the Decision to Become Tattooed*, 48 TATTOOED SKIN & HEALTH 37 (2015), available at https://www.karger.com/Article/Pdf/369180; Abigail Tucker, *Looking at the World's Tattoos*, SMITHSONIAN MAG. (Oct. 2010), https://www.smithsonianmag.com/arts-culture/looking-at-the-worlds-tattoos-60545660/ ("[T]attoos express an indelible identity.").

61 *See generally Tattoo Artist*, ART CAREER PROJECT (Mar. 30, 2023), https://theartcareerproject.com/careers/tattoo-art/.

62 *See id*.

63 *See* Arielle Pardes et al., *21 Things to Know About How to Become a Tattoo Artist*, COSMOPOLITAN (Jan. 27, 2022), https://www.cosmopolitan.com/career/a57826/things-i-wish-i-knew-tattoo-artist-career/.

64 *Tattoo Artist*, ART CAREER PROJECT (Mar. 30, 2023), https://theartcareerproject.com/careers/tattoo-art/.

65 *Id*. ("[T]o become a well-rounded artists . . . [i]t's important to be realistic about your financial situation and to assess your skills as an artist so you can make a decision about whether to pursue a traditional art degree, training at a master tattoo institute, classes at a community college, or the self-taught route.").

66 *Id*.

tattoo artist, often without pay, while gaining valuable knowledge and skills from them.[67] For example, Catherine Alexander, the Plaintiff in *Alexander v. Take-Two et al.*, has been a tattoo artist for over twenty years.[68] She went in for her first tattoo at eighteen and made an impression on the artist who tattooed her, Chris Lewis, who hired her as an apprentice.[69] Alexander then spent the next several years watching and learning from Lewis before she became a full-fledged tattoo artist.[70] Once licensed, tattoo artists can accept paying clients.[71]

Generally, the process of obtaining a tattoo is a collaborative event.[72] First, a client that comes into a tattoo shop has usually thought long and hard about the artwork they would like to have inked and, in cases of custom tattoos, has worked with their carefully chosen tattoo artist to perfect the artwork.[73] Often, this involves an iterative process, where the tattooer and the tattooee revise variations of sketches created by the artist.[74] Considering that this is a permanent decision for most, people (understandably) take their time in deciding what they want the tattoo to look like, where it should located, and who should apply it.[75] The tattoo artist's role in this process is substantial, as they generally create the art and fix it onto the client's body.[76] However, the client's self-identity, shown through custom artwork, has not changed.[77]

A tattoo serves as the tattoo artist's business card, and their business grows primarily through word-of-mouth referrals, making it essential that their work is well executed, reflects the customer's wishes, and garners

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67 *See* Arielle Pardes et al., *21 Things to Know About How to Become a Tattoo Artist*, COSMOPOLITAN (Jan. 27, 2022), https://www.cosmopolitan.com/career/a57826/things-i-wish-i-knew-tattoo-artist-career/.

68 Telephone Interview with Catherine Alexander, Plaintiff, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-cv-966-SMY (S.D. Ill. Sept. 30, 2022) (Jan. 19, 2023, 2:00 PM) (stating Alexander clarified that at the time that she began her tattooing career, she could not be an actual apprentice because of the negative view of female tattoo artists); Transcript of Jury Trial Proceedings Day 2 of 5 at 111, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-cv-00966-SMY (S.D. Ill. Sept. 27, 2022), ECF No. 306.

69 *Id*.

70 Transcript of Jury Trial Proceedings Day 2 of 5 at 111, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-cv-966-SMY (S.D. Ill. Sept. 27, 2022), ECF No. 306 [hereinafter Transcript of Jury Trial Proceedings].

71 *Tattoo Artist*, ART CAREER PROJECT (Mar. 30, 2023), https://theartcareerproject.com/careers/tattoo-art/.

72 *See id*.

73 Crimson Hilt Tattoo, *The Custom Tattoo Process vs. Walk in Flash tattoos*, CRIMSON HILT TATTOO (Dec. 4, 2017), https://crimsonhilttattoo.com/custom-tattoo-process-vs-walk-flash-tattoos/#:~:text=The%20artist%20will%20take%20a,to%20the%20individual%20wearer's%20vision.

74 *Id*.

75 Tess Catlett, *What You Need to Know Before Getting a Tattoo*, HEALTHLINE (Dec. 19, 2017), https://www.healthline.com/health/getting-a-tattoo-guide-what-to-expect.

76 *Id*.

77 Abigail Tucker, *Looking at the World's Tattoos*, SMITHSONIAN MAG. (Oct. 2010), https://www.smithsonianmag.com/arts-culture/looking-at-the-worlds-tattoos-60545660/.

respect.[78] "[C]lients select a special tattoo artist in the same way one would choose an architect or a [traditional] artist."[79] Artists tend to specialize; based on those specializations and word-of-mouth, they gain clients.[80] Clients are "walking billboards" advertising a tattoo artist's work.[81] For that reason, tattoo artists should be concerned with the intricacies of copyright law.

B. Copyrights

Copyrights pop up all over the United States, especially with the rise of "widely available technologies."[82] A report (the "Report") prepared by two Senior Directors at Secretariat Economists,[83] Robert Stoner and Jessica Dutra, and published by the International Intellectual Property Alliance (IIPA) found that copyrights accounted for 12.52% of the entire United States economy in 2021.[84] In the digital economy, the Report found that copyrights "represent[ed] 64.87% of the digital economy value."[85] The Report concluded that copyrights are a "key engine for growth" in the United States' economy.[86] Therefore, it is imperative attorneys and society at large understand copyrights.

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78 Kara Pool Snyder, *Behind the needle: Professor explores the world of tattoo artists*, ILL. STATE UNIV. (Sept. 15, 2021), https://news.illinoisstate.edu/2021/09/behind-the-needle-professor-explores-the-world-of-tattoo-artists/.

79 Liz Kierstein & Kari C. Kjelskau, *Tattoo as Art, the Drivers Behind the Fascination and the Decision to Become Tattooed*, 48 TATTOOED SKIN & HEALTH 37, 38 (2015), available at https://karger.com/books/book/174/chapter/5110162/Tattoo-as-Art-the-Drivers-Behind-the-Fascination.

80 *Id*. at 37.

81 Dan Hunter, *Tattoo Artist Loyalty: Is it Okay to Try Elsewhere?*, AUTH. TATTOO (Oct. 8, 2023), https://authoritytattoo.com/tattoo-artist-loyalty/.

82 Lesley Ellen Harris, *Understanding Copyright - A Life Skill*, WIPO MAG. (Apr. 2012), https://www.wipo.int/wipo_magazine/en/2012/02/article_0002.html; *see generally* ROBERT STONER & JÉSSICA DUTRA, COPYRIGHT INDUSTRIES IN THE U.S. ECONOMY: THE 2022 REPORT 29 (2022), available at https://www.iipa.org/files/uploads/2022/12/IIPA-Report-2022_Interactive_12-12-2022-1.pdf; *see also* Kevin Rosenbaum, *IIPA Report Shows Copyright Industries' Strong Contributions to the U.S. Economy*, COPYRIGHT ALL. (Jan. 24, 2023), https://copyrightalliance.org/iipa-report-copyright-industries/.

83 "Secretariat Economists is a premier economic consulting firm in the fields of law and economics, public policy, and business strategy." *About Secretariat Economists*, SECRETARIAT ECONOMISTS, https://ei.com/company-overview/ (last visited Feb. 9, 2024).

84 ROBERT STONER & JÉSSICA DUTRA, COPYRIGHT INDUSTRIES IN THE U.S. ECONOMY: THE 2022 REPORT 29 (2022), available at https://www.iipa.org/files/uploads/2022/12/IIPA-Report-2022_Interactive_12-12-2022-1.pdf (providing that this percentage amounted to $2,919.15 billion); *see also* Kevin Rosenbaum, *IIPA Report Shows Copyright Industries' Strong Contributions to the U.S. Economy*, COPYRIGHT ALL. (Jan. 24, 2023), https://copyrightalliance.org/iipa-report-copyright-industries/.

85 ROBERT STONER & JÉSSICA DUTRA, COPYRIGHT INDUSTRIES IN THE U.S. ECONOMY: THE 2022 REPORT 29 (2022), available at https://www.iipa.org/files/uploads/2022/12/IIPA-Report-2022_Interactive_12-12-2022-1.pdf.

86 *Id*.

Copyright is a form of protection granted to the creator of original works of authorship upon creation in a tangible form of expression.[87] Copyright has been in the United States since the nation's founding and can be found explicitly in Article 1, Section 8 of the United States Constitution.[88] Today, Title 17 of the Uniform Commercial Code, commonly called the Copyright Act (the "Act"), provides the legal framework for copyright law.[89] Since the first federal copyright law was enacted in 1790, copyright law has experienced immense growth, which has led to some clarity but also more confusion.[90]

1. Historical Overview

> The Congress shall have Power . . . [t]o promote the Progress of Science and useful Arts by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.[91]

The Intellectual Property (IP) Clause of the U.S. Constitution provides incentives for the promotion of creativity that aids society at large.[92] The IP Clause has ultimately been enacted through multiple versions of copyright law.[93] The first law, enacted in 1790 (the "Act of 1790"), allotted fourteen years of protection to authors; this protection was expanded to twenty-eight years in 1831.[94] At that point, the law only protected "books, maps, and charts."[95] At this time, the Library of Congress and the United States Copyright Office (USCO) did not exist; therefore, works were registered through U.S. District Courts.[96] The USCO was initially integrated within the Library of Congress in 1870; however, it was not established as a separate department within the Library of Congress until February 19, 1897.[97] The

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87 Copy Right Act of 1976, 17 U.S.C. § 102(a).

88 U.S. CONST. art. I § 8, cl. 8.

89 17 U.S.C. §§ 101-1511.

90 *See generally* Steven Weinburg, *COPYRIGHT LAW IS MORE COMPLICATED THAN EVER*, HOLMES WEINBURG PC (Dec. 18, 2017), https://holmesweinberg.com/copyright-law-is-more-complicated-than-ever/.

91 U.S. CONST. art. I § 8, cl. 8 ("To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.").

92 *Copyright basics*, USPTO, https://www.uspto.gov/ip-policy/copyright-policy/copyright-basics#:~:text=Under%20the%20Copyright%20Act%2C%20a%20copyright%20owner%20has%20the%20exclusive,of%20a%20digital%20audio%20transmission (last visited Feb. 9, 2024) ("[E]conomic incentives for creativity that ultimately promote the public welfare.").

93 *See generally id*.

94 *Timeline: The 18th Century*, COPYRIGHT.GOV, https://www.copyright.gov/timeline/timeline_18th_century.html (last visited Feb. 9, 2024).

95 *Id*.

96 *Id*.

97 *Id*.

purpose of the USCO is to "promote[] creativity and free expression by administering the nation's copyright laws and by providing impartial, expert advice on copyright law and policy for the benefit of all."[98] The USCO registers copyrights, retains information related to registered copyrights, and aids the public and Congress with copyright issues.[99]

Through various amendments to the Act of 1790, copyrights were extended to cover "visual art," the main category of discussion throughout this analysis, among other categories.[100] On July 30, 1947, copyright protections were codified as Title 17 of the United States Code.[101] In 1976, the Copyright Act was amended to protect "all works, both published and unpublished, once they [were] fixed in a tangible medium."[102] The term for protection was then extended to cover the life of the author plus fifty years.[103] Finally, thanks to the Sonny Bono Copyright Term Extension Act, the term for protection was updated once more to cover the author's life plus seventy years.[104]

2. Current State of the Copyright Act

Today, the Copyright Act of 1976 (the "Copyright Act" or the "Act"), with its various amendments, is the controlling authority.[105] To register a copyright, an author must show that it is an "original work[] of authorship fixed in *any* tangible medium of expression."[106] This original work must be the product of "independent creation" and contain "a modicum of creativity."[107] Section 102 of Title 17 enumerates eight categories of accepted works of authorship: "literary works; musical works, including any accompanying words; dramatic works, including any accompanying music; pantomimes and choreographic works; pictorial, graphic, and sculptural works; motion pictures and other audiovisual works; sound recordings; and architectural works."[108] These are protected upon fixation, meaning the

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98 *About: Overview*, COPYRIGHT.GOV, https://www.copyright.gov/about/#:~:text=The%20U.S.%20Copyright%20Office%20promotes,for%20the%20benefit%20of%20all (last visited Feb. 9, 2024).

99 *Id*.

100 *Timeline: The 18th Century*, COPYRIGHT.GOV, https://www.copyright.gov/timeline/timeline_18th_century.html (last visited Feb. 9, 2024).

101 *Id*.

102 *Id*.

103 *Id*.

104 *Id*.

105 17 U.S.C. §§ 101-1511.

106 *Id*. at § 102(a) (emphasis added).

107 *See* Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 346 (1991) (determining that compiled list of customer facts in list format were not subject to copyright protection due to a lack of a "modicum of creativity").

108 17 U.S.C. § 106(1)-(6).

protection is enacted upon the creation of the work.[109] Registration of the copyrighted work is not required to receive protection; however, if the owner intends to file suit, they would need to register the copyright.[110]

The Act does not, however, protect "any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work."[111] This includes titles, names, short phrases, fonts, typeface, lettering, designs, layout, blank forms, and familiar designs/symbols.[112]

Copyright is essentially a fancy term for ownership of a creative work.[113] It provides certain rights to the creative work, including "rights to reproduce the copyrighted work, to prepare derivative works, and . . . to display the copyrighted work publicly."[114] Ownership in copyright is "vest[ed] initially in the author or authors of the work."[115] The author is the person who "actually creates the work."[116] When the work is created by more than one author, this is a "joint work" if all of the authors had the "intention that their contributions [would] be merged into inseparable or interdependent parts of a unitary whole."[117] In this case, the Act considers all authors "coowners" of the copyright.[118]

The Copyright Act of 1909 recognized that employers were entitled to the ownership of the work created by their "employee[s] within the scope of [their] employment."[119] However, works made for hire were not defined until 1976.[120] Before the 1976 amendment, the courts had interpreted this theory to allow employers "a default ownership in work for which they paid."[121] As

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109 *Id*. at § 102(a)(1)-(8). The full list of exclusive rights is included in the statute. *See also* Bradley C. Rosen, *Proof of Facts Establishing Damages and Other Relief Under the Federal Copyright Act*, 92 AM. JUR. 3D PROOF EVIDENCE 249 (2023) ("'Fixation' is the creation of a physical or tangible product.").

110 17 U.S.C. § 411.

111 *Id*. at § 102(b).

112 USCO, *Circular 33: Works Not Protected by Copyright*, COPYRIGHT.GOV (2021), https://www.copyright.gov/circs/circ33.pdf.

113 Andy Warhol Found. Visual Arts, Inc. v. Goldsmith, 598 U.S. 508, 526 (2023).

114 *Id*.

115 17 U.S.C. § 201(a).

116 Cmty. for Creative Non-Violence v. Reid, 490 U.S. 730, 737 (1989).

117 17 U.S.C. § 101.

118 *Id*. at § 201(a).

119 Anne Marie Hill, *Work for Hire Definition in the Copyright Act of 1976: Conflict Over Specially Ordered or Commissioned Works*, 74 CORNELL L. REV. 559, 559 (1989).

120 *Id*.; *see also* Shannon M. Nolley, *The Work for Hire Doctrine and the Second Circuit's Decision in* Carter v. Helmsley-Spear, 7 DEPAUL J. ART, TECH., & INTELL. PROP. L. 103, 105 (1996) (explaining that the 1909 Act did not provide a specific section dedicated to works made for hire and merely noted that "the work 'author' included an employer in the case of 'works made for hire'") (quoting Maury Tepper, *Works Made for Hire and the Copyright Act of 1976 - We're Finally Back Where We Started: Community for Creative Non-Violence v. Reid, 109 S. Ct. 2166 (1989)*, 59 U. CINCINNATI L. REV. 299, 302 (1990) (citing 17 U.S.C. § 26 (1909 repealed 1976))).

121 Shannon M. Nolley, *The Work for Hire Doctrine and the Second Circuit's Decision in* Carter v. Helmsley-Spear, 7 DEPAUL J. ART, TECH., & INTELL. PROP. L. 103, 104 (1996).

stated above, under the Act today, the initial ownership of a copyright belongs to the author of the protected work.[122] However, now the Act contains provisions for work considered "made for hire" and copyrights in collective work.[123]

The copyright owner is not the original author of a work made for hire.[124] Instead, the owner is the employer or person/entity that commissioned the work.[125] Under § 101 of the Act, a work made for hire occurs where an employee created the work "within the scope of his or her employment" or when someone was specifically commissioned to create custom work and where a written agreement has stipulated as such.[126] When the author has been commissioned according to a written agreement that classifies it as a work made for hire, it is only considered to be a work made for hire if it falls within one of the following categories: "use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas."[127] When a work is considered a work made for hire, the Act sets out separate rules regarding "initial ownership of its copyright, . . . the copyright's duration, . . . the owners' renewal rights, . . . termination rights, . . . and right to import certain goods bearing the copyright."[128] Tattoos would be unlikely to fall within one of the enumerated categories above for commissioned works as they are likely considered "pictorial [or] graphic works."[129] Under § 101(1), the author would be considered an employee, whereas under § 101(2), they would be considered an independent contractor.[130]

Therefore, the threshold question is whether the author is an employee under the Act.[131] The United States Supreme Court (the "Supreme Court") detailed the analysis necessary to answer this question in *Community for Creative Non-Violence v. Reid*.[132] In this case, James Earl Reid was hired by Mitch Snyder, member and trustee of Community for Creative Non-Violence (CCNV), to create a sculpture for the nonprofit.[133] The Court determined that

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122 17 U.S.C. § 201(a); Cmty. for Creative Non-Violence v. Reid, 490 U.S. 730, 737 (1989).

123 17 U.S.C. § 201((b)-(c).

124 *Id*. at § 201(b).

125 *Id*.

126 *Id*. at § 101.

127 *Id*.

128 Cmty. for Creative Non-Violence v. Reid, 490 U.S. 730, 737 (1989) (citing *id*. at §§ 302(c), 304(a), 203(a), 601(b)(1)).

129 *Are Tattoos Protected by Copyright?*, COPYRIGHT ALL.: FAQ, https://copyrightalliance.org/faqs/tattoos-copyright/ (last visited Feb. 9, 2024).

130 Scott K. Zesch, Annotation, *Application of "Works for Hire" doctrine under Copyright Act of 1976, 17 U.S.C.A. §§ 101 et seq.*, 132 A.L.R. Fed. 301 (1996).

131 *See generally Cmty. for Creative Non-Violence*, 490 U.S. at 730.

132 *Id*. at 751-53.

133 *Id*. at 733.

agency law applied to the context of works made for hire; therefore, it needed to "consider the hiring party's right to control the manner and means by which the product is accomplished."[134] It further determined that the following elements were important in this analysis:

> [T]he skill required; the source of the instrumentalities and tools; the location of the work; the duration of the relationship between the parties; whether the hiring party has the right to assign additional projects to the hired party; the extent of the hired party's discretion over when and how long to work; the method of payment; the hired party's role in hiring and paying assistants; whether the work is part of the regular business of the hiring party; whether the hiring party is in business; the provision of employee benefits; and the tax treatment of the hired party.[135]

After considering the factors above, the Court held that Reid was not an employee but rather an independent contractor.[136] Although CCNV exerted enough control over Reid to dictate the specifications for the project, "all the other circumstances weigh[ed] heavily against finding an employment relationship."[137] The following facts were dispositive: Reid was a skilled sculptor; he used his tools rather than any supplied by CCNV; the work was entirely completed in his studio; and, during the two months he was creating the sculpture, he had complete control over his hours and whether he required any assistants.[138] Moreover, CCNV could not give him any other projects, and payment was a lump sum upon completion.[139] Finally, the entity itself was not considered a business as it "did not pay payroll or Social Security."[140] Therefore, CCNV did not own the copyright to the sculpture through a work made-for-hire theory.[141]

The other form of initial ownership covered under the Act is that in a collective work.[142] The Act defines a collective work as one in "which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole."[143] The individual works have individual copyrights separate from the whole owned by the individual.[144] However, the collection of those works has a separate copyright

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134 *Id*. at 751.
135 *Id*.
136 *Id*. at 752.
137 Cmty. for Creative Non-Violence v. Reid, 490 U.S. 730, 752 (1989).
138 *Id*. at 752-53.
139 *Id*. at 735.
140 *Id*. at 751.
141 *Id*. at 753.
142 17 U.S.C. § 201(c).
143 *Id*. at § 101 (providing "a periodical issue, anthology, and encyclopedia" as some examples).
144 *Id*. at § 201(c).

that is owned by the individual who "select[ed], coordinat[ed], and arrange[d] . . . the independent works included in the collective work."[145]

In sum, the general rule is that all owners of copyrights have exclusive rights to their works.[146] This means the owner can make copies of the work, distribute them, create derivatives, and publicly display or perform their work.[147] Since the owner has all of the aforementioned rights, they can subsequently authorize another to act in their place or transfer all or some of those rights to another.[148] Owners commonly license works or portions of works to others to create derivatives.[149]

The Act defines derivative works (often called "adaptation right[s]"[150]) as those "work[s] based upon one or more preexisting works."[151] Examples of derivative works include translations, movie adaptations, musical remixes, and art reproductions.[152] The Act notes that a work is derivative if it "consist[s] of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship."[153] This commonly refers to "new editions" of works.[154] For a derivative work to receive copyright protection, it must be a new work of authorship, including the requisite modicum of creativity, fixed in a tangible medium that "incorporate[s] some or all of a preexisting 'work.'"[155] This new work of authorship must fall within one of the categories provided in § 102 of the Act.[156] The copyright in the derivative work is independent of the original work's copyright.[157] This copyright only extends to the new work of authorship and does not include any rights to the original work.[158] This can get messy when someone other than the copyright owner creates a derivative work.[159]

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145 U.S. COPYRIGHT OFF., CIRCULAR 34, MULTIPLE WORKS 2 (Mar. 2021), available at https://www.copyright.gov/circs/circ34.pdf; 17 U.S.C. § 201(c).

146 *See* 92 AM. JUR. 3D PROOF OF FACTS § 2 (2006).

147 17 U.S.C. § 106(1)-(6).

148 *Id*.

149 *See generally* Jay T. Westermeier, *Understanding the Importance of Derivative Works*, FINNEGAN (Mar. 2009), https://www.finnegan.com/en/insights/articles/understanding-the-importance-of-derivative-works.html.

150 U.S. COPYRIGHT OFF., CIRCULAR 14, COPYRIGHT IN DERIVATIVE WORKS AND COMPILATIONS 1 (July 2020), available at https://www.copyright.gov/circs/circ14.pdf.

151 17 U.S.C. § 101.

152 *Id*.

153 *Id*.

154 U.S. COPYRIGHT OFF., CIRCULAR 14, *supra* note 150, at 1.

155 *Id*.; *see also* 17 U.S.C. § 103(b).

156 *See* 17 U.S.C. § 103(a); H.R. Rep. No. 94-1476, at 57 (1976).

157 *See* 17 U.S.C. § 103(b).

158 *Id*.

159 *See* U.S. COPYRIGHT OFF., CIRCULAR 14, *supra* note 150, at 2 ("In any case where a copyrighted work is used without the permission of the copyright owner, copyright protection will not extend to any part of the work in which such material has been used unlawfully."); *id*. at § 103(a).

The right to create a derivative work lies with the owner of the copyrighted work.[160] Therefore, for someone other than the owner to create a derivative work, (1) the owner has transferred or licensed some or all of their derivative rights to another person, or (2) the person creating the derivative work has potentially infringed on the owner's copyright.[161] An owner may transfer all or some of their copyright "by any means of conveyance or by operation of law."[162] Under the Act, transferring ownership in copyright is through an "assignment, mortgage, exclusive license, or any other conveyance, alienation, or hypothecation," which grants an exclusive right(s) in the copyright.[163]

This does not include nonexclusive licenses, which would not be a transfer of the exclusive right(s) in the copyright.[164] A nonexclusive license allows a licensee to use the copyright for limited purposes and does not give them an exclusive right to any part of the copyright.[165] Therefore, the copyright owner retains full exclusive rights to the work in a nonexclusive license.[166] This is usually accomplished through a licensing agreement, though it does not need to be in writing.[167] A typical licensing agreement will describe the rights to be licensed, the number of uses, the extent of the use, and the period the license is effective.[168] Copyright law also recognizes implied licenses, which means the license is inferred because the parties' conduct has indicated an intent to grant a nonexclusive license.[169] This is commonly used to defend against claims of infringement.[170]

Some sections of the Act require a work be registered with the USCO to enforce the owner's rights in court.[171] Therefore, registering the work as

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160 U.S. COPYRIGHT OFF., CIRCULAR 14, *supra* note 150, at 2.

161 *See id.*

162 17 U.S.C. § 201(d)(1).

163 *Id*. at § 101.

164 *Id*.

165 *See* Justin R. Muehlmeyer, *Exclusive or Non-Exclusive? Understanding the Best License for Your Business*, PEACOCK L. P.C., https://peacocklaw.com/understanding-the-best-license-for-your-business/#:~:text=Non%2Dexclusive%20licenses%20grant%20the,face%20competition%20from%20other%20licensees (last visited Feb. 10, 2024).

166 *See id.*

167 *Copyright Licensing Under the Law*, JUSTIA, https://www.justia.com/intellectual-property/copyright/copyright-licensing/ (last visited Feb. 10, 2024).

168 *Id*.

169 *See* Jacqui Lipton, *Implied Licenses in Copyright Law*, AUTHORS ALL. (May 27, 2020), https://www.authorsalliance.org/2020/05/27/implied-licenses-in-copyright-law/ ("Copyright law has adopted a similar approach [to the one used in contract law] in terms of [implied] licenses to use a copyright work if it seems like the parties would have created a license under the circumstances.").

170 *See id.* (stating that the implied license doctrine is another defense to copyright infringement claims).

171 *See, e.g.*, 17 U.S.C. § 411(a) (requiring registration of a work before filing any civil suit). Note that merely placing a "copyright notice on a work is not a substitute for registration." U.S. COPYRIGHT

soon as possible is necessary to gain the full protections provided to owners. To register a work with the USCO, the owner must deliver a deposit of the work "together with [a complete] application and fee."[172] The application must be completed by a partial or full author of the work or an authorized agent of an author.[173] It must contain the author's name and address, the work's title, the year the work was completed, and any additional information the USCO requests.[174] Depending on the status or type of the work (i.e., published work, compilation, derivative, etc.), the application may require further information specific to that kind of work.[175] Per § 408(b), the deposit for most works must contain "one complete copy or phonorecord" of the work.[176] The only exception is for published work, which requires "two complete copies or phonorecords of the best edition."[177] These copies do not have to be in the same medium as the original work as long as they can be recognized.[178] Once the completed application, deposit, and fee are delivered to the USCO, it will determine whether to register the work and issue a certificate of registration.[179]

3. Copyright Owner's Remedies

While copyright protection is enacted upon creating the work and not upon registration, usually, the copyright owner must register their work with the USCO to sue for copyright infringement.[180] The Supreme Court has described this requirement as an "administrative exhaustion requirement that the owner must satisfy before suing to enforce ownership rights."[181] Until recently, it was unclear at which exact point a copyright has been registered. Some argued it was as soon as the author applied for registration, while others claimed it was only once the USCO had officially registered the work.[182] In

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OFF., CIRCULAR 1, COPYRIGHT BASICS 4 (Sept. 2021), available at https://www.copyright.gov/circs/circ01.pdf.

172 17 U.S.C. § 408(a).

173 *See* U.S. COPYRIGHT OFF., CIRCULAR 1, COPYRIGHT BASICS 5 (Sept. 2021), available at https://www.copyright.gov/circs/circ01.pdf.

174 17 U.S.C. § 409(1), (6)–(7), (10).

175 *See id*. at § 409(4)–(5), (8)–(9).

176 *Id*. at § 408(b)(1), (3)–(4).

177 *Id*. at § 408(b)(2).

178 *See* Midway Mfg. Co. v. Artic Int'l, Inc., 547 F. Supp. 999, 1006-07 (N.D. Ill. 1982), *aff'd*, 704 F.2d 1009 (7th Cir. 1983) (determining that a "copy may be made in any medium whatsoever, so long as the work can be perceived from it").

179 17 U.S.C. §§ 408(a), 410(a).

180 *Id*. at § 411(a) ("[N]o civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made . . . .").

181 Fourth Est. Pub. Benefit Corp. v. Wall-Street.com, LLC, 139 S. Ct. 881, 887 (2019).

182 The Eleventh Circuit determined registration happened upon issuance of the copyright by the USCO. *See* Fourth Est. Pub. Benefit Corp. v. Wall-Street.com, LLC, 856 F.3d 1338, 1341 (11th Cir. 2017) (adopting the "registration approach" based on an analysis of the text of § 411(a) and

2019, the Supreme Court settled the debate.[183] The Supreme Court has held that "registration occurs, and a copyright claimant may commence an infringement suit, when the [USCO] registers a copyright" as opposed to "as soon as the claimant [has] deliver[ed] the required application."[184]

Once registered, a copyright holder can seek relief for conduct that happened before and after registration was obtained.[185] The owner can seek multiple remedies for copyright infringement under the Act.[186] These remedies include injunctions,[187] impounding and disposition of infringing articles,[188] damages and profits,[189] as well as costs and attorney's fees.[190] Any action for the civil remedies above must be brought "within three years after the claim accrued," and the work infringed must be registered with the USCO before filing suit for some remedies.[191] Granting or denying such remedies is at the discretion of the court.[192]

Frustratingly, the Act does not define or explain what "accrual" means or when it begins. The Supreme Court has defined "accrual of a claim" as "the event that triggers the running of a statute of limitations" (SOL) like the one provided under § 507(b).[193] Therefore, the timing of accrual under the Act is either at the time of the infringing conduct—the "injury rule"—or when the copyright owner has "discover[ed] or should have discovered" the infringement—the "discovery rule."[194] The Supreme Court, in *Petrella v. Metro-Goldwyn-Mayer, Inc.*, settled this debate by concluding that the appropriate method to determine whether a copyright claim had met the three-year SOL was the "incident of injury rule."[195] It further noted that each

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clarifying that "[f]iling an application does not amount to registration"). The Ninth Circuit, however, determined that registration occurred upon delivery of the application to the USCO. *See* Cosm. Ideas, Inc. v. IAC/Interactivecorp, 606 F.3d 612, 620–21 (9th Cir. 2010) ("Only the application approach fully protects litigants from any disadvantage caused by this timelag [sic]."); Claudia G. Catalano, Annotation, *Actual Registration or Application as Constituting Condition Precedent to Copyright Infringement Action Under § 411(a) of Copyright Act, 17 U.S.C.A. § 411(a)*, 30 A.L.R. Fed. 3d 4 (2022) (acknowledging that there is a split of authority as to what is meant by registration under § 411(a)).

183 *See Fourth Est. Pub. Benefit Corp*., 139 S. Ct. at 886.

184 *Id*.

185 *Id*. at 886-87.

186 *See* 17 U.S.C. §§ 502–505.

187 *Id*. at § 502.

188 *Id*. at § 503.

189 *Id*. at § 504.

190 *Id*. at § 505.

191 *Id*. at § 507(b).

192 *See* 17 U.S.C. § 502(a) (providing that the court may "grant temporary and final injunctions on such terms as it may deem reasonable to prevent or restrain infringement of a copyright").

193 *See* SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC, 580 U.S. 328, 337 (2017).

194 *Id*.; *see also* D'Pergo Custom Guitars, Inc. v. Sweetwater Sound, Inc., 516 F. Supp. 3d 121, 132 (D.N.H. 2021) (citing 6 WILLIAM F. PATRY, PATRY ON COPYRIGHT §§ 20:17, 20:18 (2021)).

195 Petrella v. Metro-Goldwyn-Mayer, Inc., 572 U.S. 663, 670 (2014) (citing 17 U.S.C. § 507(b)) (determining that "[a] copyright claim thus arises or 'accrue[s]' when an infringing act occurs"); *but see Petrella*, 572 U.S. at 670 n.4 (quoting William A. Graham Co. v. Haughey, 568 F.3d 425, 433

instance of infringement starts a new accrual date for the SOL.[196] The SOL—together with the "separate-accrual rule"—prevents a burden on the plaintiff to "sue soon, or forever hold [their] peace."[197] However, the claim may be subject to estoppel if a defendant relies on a plaintiff's assertions that they will not sue.[198]

Under § 502, the owner may seek a temporary or permanent injunction to cease or prevent infringing conduct.[199] Courts may grant either injunction "as it may deem reasonable to prevent or restrain infringement of [the] copyright."[200] A copyright owner is not automatically entitled to an injunction when there has been infringing conduct.[201] Like injunctive remedies in other civil lawsuits, the party seeking an injunction must show the following:

> (1) that it has suffered an irreparable injury; (2) that remedies available at law, such as monetary damages, are inadequate to compensate for that injury; (3) that, considering the balance of hardships between the plaintiff and defendant, a remedy in equity is warranted; and (4) that the public interest would not be disserved by a permanent injunction.[202]

A copyright owner can recover actual damages and profits as an additional award related to the infringement of the author's work under § 504(b).[203] However, profits are not recoverable if included in the actual damages amount.[204] The recovery of profits is meant to "provide just compensation for the wrong, not to impose a penalty by giving to the copyright proprietor profits which are not attributable to the infringement."[205] This requires the original owner of the copyrighted work only to present

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(3d Cir. 2009)) (recognizing that "nine Courts of Appeals have adopted, as an alternative to the incident of injury rule, a 'discovery rule,' which starts the limitations period when 'the plaintiff discovers, or with due diligence should have discovered, the injury that forms the basis for the claim'"); 6 WILLIAM F. PATRY, PATRY ON COPYRIGHT §§ 20:17, 20:18 (2023).

196 *See Petrella*, 572 U.S. at 671 (citing Stone v. Williams, 970 F.2d 1043, 1049 (2d Cir. 1992)) ("It is widely recognized that the separate-accrual rule attends the copyright statute of limitations.").

197 *Id*. at 682.

198 *Id*. at 684-85 (explaining that the estoppel doctrine could bar a plaintiff's request for relief as, "delay . . . is not an element for the defense").

199 17 U.S.C. § 502; 28 U.S.C. § 1498; *see also* H.R. REP NO. 94-1476 (noting for 17 U.S.C. § 502 that an owner would not be able to request an injunction against the federal government).

200 17 U.S.C § 502(a).

201 *See* eBay Inc. v. MercExchange, LLC, 547 U.S. 388, 392-93 (2006) (citing N.Y. Times Co. v. Tasini, 533 U.S. 483, 505 (2001) ("[T]his Court has consistently rejected invitations to replace traditional equitable considerations with a rule that an injunction automatically follows a determination that a copyright has been infringed.").

202 *Id*. at 391; *see also* TD Bank N.A. v. Hill, 928 F.3d 259, 265 (3rd Cir. 2019) (applying *eBay Inc.* to copyright infringement cases).

203 17 U.S.C. § 504.

204 *Id*.

205 Richmond Homes Mgmt., Inc. v. Raintree, Inc., 862 F. Supp. 1517, 1528 (W.D. Va. 1994).

proof of the "infringer's gross revenue."[206] Then, the infringer must show the elements of its activity that produced that gross revenue and how much of the gross revenue is attributable to the infringement.[207] When causation is insufficiently shown for actual damages, the plaintiff may "nonetheless [be] entitled to recover the profits of the infringer if the profits are established with sufficient evidence."[208]

Though not necessary for recovery, if actual damages or profits cannot be shown, § 504(c) provides the plaintiff the option to recover statutory damages.[209] Since actual damages and profits directly attributable to the infringement are often difficult to discern, these damages tend to be tempting.[210] Statutory damages are only available to plaintiffs for "unpublished works registered with the USCO prior to the infringement, and published works registered within three months of the first publication of the work."[211] These damages are "designed to discourage wrongful conduct."[212] However, maliciousness is not required.[213] An award for statutory damages is not based on whether the plaintiff can show any actual damages.[214] Because of this, statutory damages are also designed to "give the owner of a copyright some recompense for injury done him, in a case where the rules of law render difficult or impossible proof of damages or discovery of profits."[215]

Before an entry of final judgment, a plaintiff can choose to receive any amount between $700 to $30,000 in statutory damages for all infringing conduct.[216] Courts are not required to follow any specific formula to calculate the amount of such damages.[217] An award of statutory damages is at the discretion of the court and is "guided . . . by such underlying policies as (1)

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206 17 U.S.C. § 504(b).

207 *Id*.; Sheldon v. Metro-Goldwyn Pictures Corp., 309 U.S. 390, 299 (1940); *see also Richmond Homes Mgmt, Inc*., 862 F. Supp. at 1528 (citing *Sheldon*, 309 U.S. at 399 (noting that damages under § 504(b) are "premised on a theory of restitution and unjust enrichment, not punishment").

208 *Richmond Homes Mgmt., Inc*., 862 F. Supp. at 1528 (citing Walker v. Forbes, Inc., No. 93-1273, slip op. at 5, 1994 WL 287173 (4th Cir. June 30, 1992)).

209 17 U.S.C. § 504(c).

210 *See Richmond Homes Mgmt, Inc*., 862 F. Supp. at 1528 (explaining that actual damages requires specific evidence of causation).

211 17 U.S.C. § 412; *see also* Unicolors, Inc. v. H&M Hennes & Mauritz, LP, 595 U.S. 178, 181 (2022).

212 Yellow Pages Photos, Inc. v. Ziplocal, LP, 795 F.3d 1255, 1271 (11th Cir. 2015).

213 *Id*. (citing Cable/Home Commc'n Corp. v. Network Prods., Inc., 902 F.2d 829, 851 (11th Cir. 1990)).

214 *See* 17 U.S.C. § 504(b)-(c); *see also* Sony BMG Music Ent. v. Tenenbaum, 660 F.3d 487, 507 (1st Cir. 2011) (citing 17 U.S.C. § 504) ("Congress drew a plain distinction between actual and statutory damages, making it clear that the availability of statutory damages is not contingent on the demonstration of actual damages.").

215 *Sony BMG Music Ent*., 660 F.3d at 502 (quoting Douglas v. Cunningham, 294 U.S. 207, 209 (1935)).

216 17 U.S.C. § 504(c)(1).

217 Alois Valerian Gross, J.D., Annotation, *Measure of statutory damages to which copyright owner is entitled under 17 U.S.C.A. § 504(c)*, 105 A.L.R. FED. 345 § 2(a) (Orig. published 1991) (citing Kinsey v. Jambow, Ltd., 76 F. Supp. 3d 708 (N.D. Ill. 2014)).

restitution of wrongfully acquired gains to prevent unjust enrichment of the infringer; (2) reparation for injury done to the copyright owner; and (3) deterrence of further wrongful conduct by the infringer and others."[218] The number of statutory damages awarded in a given case is based "not on [the] number of separate infringements, but rather on (1) [the] number of individual works infringed and (2) [the] number of separate infringers."[219]

If willful infringement is shown, the court could increase this amount to "no more than $150,000" if it is a case in which the copyright holder has the burden of proof.[220] Willfulness under the Act has been interpreted to mean the infringer was aware that their conduct was infringing or they "recklessly disregarded the possibility that it was infringing."[221] Conversely, if the infringer holds this burden and the court finds innocent infringement, the damages can be reduced to "no less than $200."[222] Therefore, an infringer's intent can be dispositive to the amount of statutory damages awarded.[223] Statutory damages allow for clear expectations and set monetary amounts to be awarded in copyright cases, which can cause less confusion.[224] District courts may "award a reasonable attorney's fee to the prevailing party."[225] However, there is a caveat about whether a party can seek this kind of award.[226] As noted above, for statutory damages, a prevailing party must meet the conditions outlined in § 412 regarding timeliness of registration.[227] For example, in *Alexander v. Take-Two infra*, Alexander could not move for attorney's fees as she had not registered her art pieces in the timeframe outlined in § 412.[228] The video games at issue were released in 2016, 2017, and 2018.[229] Alexander did not apply for registrations of the tattoos until 2018 when the lawsuit began.[230] The court may also use discretion to award any party in a civil action total costs of suit (unless against the United States or one of its officers).[231]

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218 *Id*.

219 *Id*. (citing Desire, LLC v. Manna Textiles, Inc., 986 F.3d 1253 (9th Cir. 2021)).

220 17 U.S.C. § 504(c)(2).

221 Yellow Pages Photos, Inc. v. Ziplocal, LP, 795 F.3d 1255, 1271 (11th Cir. 2015) (citing Cable/Home Commc'n Corp. v. Network Prods., Inc., 902 F.2d 829, 851 (11th Cir. 1990)); Graper v. Mid-Continent Cas. Co., 756 F.3d 288, 394-95 & n. 7 (5th Cir. 1988).

222 17 U.S.C. § 504(c)(2).

223 *See* Alois Valerian Gross, *supra* note 217, at § 15(b) (citing Kohus v. Graco Children's Prods. Inc., 13 F. Supp. 3d 829 (S.D. Ohio 2014)).

224 17 U.S.C. § 504; H.R. REP. NO. 94-1476 (1976).

225 17 U.S.C. § 505.

226 17 U.S.S. § 412.

227 *Id*.

228 Alexander v. Take-Two Interactive Software, Inc., et al., No. 18-cv-966-SMY (S.D. Ill. Sept. 30, 2022).

229 *Id*.

230 *Id*.

231 17 U.S.C. § 505.

4. Limitations to Exclusive Rights

While the Copyright Act appears to be facially limitless in terms of protections afforded to creators, there are, in fact, limits to the exclusive rights awarded under the Copyright Act.[232] A non-exhaustive list includes the doctrine of fair use, equitable defenses to copyright infringement, statutory limits on exclusive rights, innocent infringement, and a so-called "safe harbor" under the DMCA.[233]

a. Fair Use

> "Fair use in America simply means the right to hire a lawyer . . . ." Lawrence Lessig[234]

> "Fair use is always going to be a gray area, and it should be. We need to allow for things we can't see yet." Robin Gross[235]

Nearly everyone has experienced work that constituted fair use. For example, parody "has been a part of media and entertainment in American culture for centuries . . . ."[236] Most people have listened to a Weird Al Yankovic song, watched Saturday Night Live, or read an article on the Onion.[237] The U.S. Supreme Court has noted that the "heart of any parodist's claim to quote from existing material, is the use of some elements of a prior author's composition to create a new one that, at least in part, comments on that author's works."[238] For a limited, transformative purpose, a person who would otherwise be an infringer of a copyright can copy a work without permission.[239] Although this applies only to limited circumstances, it is one

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232 *Id*. at § 107-112 (providing limitations to exclusive rights of the author).

233 Lynn B. Bayard, *Copyright Infringement Claims, Remedies, and Defenses*, THOMSON REUTERS: PRAC. L., https://1.next.westlaw.com/Document/Ibb0a1266ef0511e28578f7ccc38dcbee/View/FullText.html?transitionType=Default&contextData=(sc.Default)&firstPage=true&oWSessionId=a34659f8f0d24e8f94cc548f5f99540a&fromAnonymous=true&bhcp=1 (last visited Jan. 11, 2024).

234 LAWRENCE LESSIG, FREE CULTURE: THE NATURE AND FUTURE OF CREATIVITY 187 (2004).

235 *Robin Gross Quotes*, BRAINYQUOTE, https://www.brainyquote.com/authors/robin-gross-quotes#:~:text=The%20copyright%20bargain%3A%20a%20balance,and%20rights%20for%20the%20consumer.&text=Fair%20use%20is%20always%20going,we%20can't%20see%20yet (last visited Jan. 11, 2024).

236 Russell Dickerson, *Parody: Legal, Ethical and Organizational Communication in Landmark Court Cases*, RHDICKERSON.COM (July 19, 2017), https://www.rhdickerson.com/2017/07/legal-ethical-organizational-communication-landmark-court-cases/#:~:text=Parody%20has%20been%20a%20part%20of%20media%20and%20entertainment%20in,causing%20distress%20to%20public%20figures.

237 Dr. Sean, *Examples of Parody in Popular Culture*, DR. SEAN'S BLOG (Sep. 25, 2023), https://seanmiller.us/blog/examples-of-parody-in-popular-culture/.

238 Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 580 (1994).

239 *Id*. at 579.

of the most common defenses asserted by copyright infringement defendants.[240] To reconcile copyrights with the First Amendment, the fair use doctrine allows "one to use and build upon prior works in a manner that does not unfairly deprive prior copyright owners of the right to control and benefit from their works."[241] This is an ever-evolving doctrine that is "murky" by design.[242] This has led to much criticism, especially after adopting the transformative use factor to the fair use test.[243]

Under the fair use doctrine, the copying of creative work is not infringement if the copying is done to comment, criticize, news report, conduct scholarship, teach, or conduct research, among other uses.[244] As with any legal analysis, some factors must be considered to determine if fair use is present.[245] Courts consider four factors in determining whether the copying at issue constituted fair use: the reason for the copying, what the copyrighted work entails, how much copying occurred, and how the copying could affect the copyright holder or market.[246] This list is not exhaustive nor determinative of the existence of fair use.[247] The U.S. Supreme Court in *Google LLC v. Oracle America, Inc.* stated these factors merely "set forth general principles, the application of which requires judicial balancing, depending upon relevant circumstances."[248]

Courts generally focus on whether the infringing work is "transformative" when looking at why the work was copied and how, including whether it was done for an educational or commercial purpose.[249] The U.S. Supreme Court has explained that the first factor in the fair use analysis—transformativeness—"focuses on whether an allegedly infringing use has a further purpose or different character, which is a matter of degree, and the degree of difference must be weighed against other considerations,

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240 *Innocent Infringer Defense*, LUBIN AUSTERMUELE, https://www.thebusinesslitigators.com/innocent-infringer-defense.html (last visited Mar. 22, 2024).

241 Off. Gen. Couns., *Copyright and Fair Use: A Guide for the Harvard Community*, HARV. (July 11, 2023), https://ogc.harvard.edu/pages/copyright-and-fair-use#:~:text=Fair%20use%20is%20the%20right,law%20is%20designed%20to%20foster.

242 Bruce E. Boyden, *The Surprisingly Confused History of Fair Use: Is it a Limit or a Defense or Both?*, MARQ. L.: BLOG (Oct. 9, 2022), https://law.marquette.edu/facultyblog/2022/10/the-surprisingly-confused-history-of-fair-use-is-it-a-limit-or-a-defense-or-both/.

243 *See* Jane C. Ginsburg, *Fair Use in the United States: Transformed, Deformed, Reformed?*, 2020 SING. J. LEGAL STUD. 265, 265 (2020) ("Many lay the credit—some, the blame—for the recent expansion of fair use to favour increasingly parasitic new works and aggressively copyright-dependent new business models on the US Supreme Court's 1994 adoption of 'transformative use' as a criterion for evaluating the first statutory fair use factor.").

244 17 U.S.C. § 107.

245 *Id*.

246 *Id*. at § 107(1)-(4); *see also* Google LLC v. Oracle America, Inc., 141 S. Ct. 1183 (2021).

247 *Google LLC*, 141 S. Ct. at 1197.

248 *Id*.

249 17 U.S.C. § 107(1)-(4).

like commercialism."[250] Further, the Court emphasized that the main focus of this factor is "whether the new work merely 'supersede[s] the objects' of the original creation, or instead adds something new, with a further purpose or different character."[251] This transformation "of an original must go beyond that required to qualify as a derivative."[252]

In *Campbell v. Acuff-Rose Music, Inc.*, the U.S. Supreme Court, in determining if parody constituted fair use, analyzed how 2 Live Crew transformed the song "Pretty Woman" by Roy Orbison and William Dees into a parody.[253] The Court noted that transformative use is not always needed to find fair use, but transformative use does help "promote science and the arts."[254] Ultimately, the *Campbell* Court found that the appellate court had erred in determining that the parody was an unfair use of the copyrighted work and reversed the decision.[255] Transformative use generally requires more than copying and pasting the copyrighted work into a different medium.[256]

On May 18, 2023, the U.S. Supreme Court weighed in on transformative use again in *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith*.[257] Andy Warhol is known as the father of "pop art" and is considered "one of the most famous and important artists of the twentieth century."[258] This well-known artist's style was mostly comprised of the appropriated works of others.[259] In this case, the appropriated work was Lynn Goldsmith's 1981 portrait of Prince, which she had been commissioned to create by Newsweek when Prince was still an "'up and coming' musician."[260]

Once Prince became famous, Lynn Goldsmith granted Vanity Fair a one-time limited license for $400 to use her portrait, intended for Warhol's

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250 Andy Warhol Found. Visual Arts, Inc. v. Goldsmith, 589 U.S. 508, 525 (2023) (citing Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 579 (1994)).

251 *Campbell*, 510 U.S. at 579.

252 *Andy Warhol Found. Visual Arts, Inc*., 598 U.S. at 529.

253 *Campbell*, 510 U.S. at 569.

254 *Id*. at 579 (citing Sony Corp. of Am. V. Universal City Studios, Inc., 464 U.S. 417 (1984)).

255 *Id*. at 594.

256 Alexander v. Take-Two Interactive Software, Inc., No. 3:18-CV-00966-SMY (S.D. Ill. Sept. 30, 2022).

257 Andy Warhol Found. Visual Arts, Inc. v. Goldsmith, 598 U.S. 508 (2023).

258 *Andy Warhol: Biography*, NAT'L GALLERY ART, https://www.nga.gov/collection/artist-info.1966.html#:~:text=Fascinated%20by%20consumer%20culture%2C%20the,artists%20of%20the%20twentieth%20century (last visited Feb. 3, 2024); *Andy Warhol Found. Visual Arts, Inc.*, 598 U.S. at 514-15 ("His images of products like Campbell's soup cans and of celebrities like Marilyn Monroe appear in museums around the world. Warhol's contribution to contemporary art is undeniable.").

259 *See* Kate Donohue, *Andy the Appropriator: The Copyright Battles You Won't Hear About at the Whitney's Warhol Exhibit*, COLUM. J. L. & ARTS (Aug. 9, 2019), https://journals.library.columbia.edu/index.php/lawandarts/announcement/view/112 ("Although some of Warhol's work was commissioned by individuals or companies, much of it was appropriated from other artists, photographers, and brands.").

260 *Andy Warhol Found. Visual Arts, Inc*., 598 U.S. at 508.

use as an “artist reference for an illustration" that was to be published alongside an article.[261] The agreement limited the license to the appearance of the portrait to a "one time full page and one time under one quarter page. No other usage right granted."'[262] Vanity Fair credited the photo, "a purple silkscreen portrait of Prince," to Goldsmith.[263] Warhol thereafter created a series of Prince portraits using Goldsmith's original photo, including one deemed *Orange Prince*.[264] Goldsmith was unaware of this series until 2016 when Conde Nast (parent company to Vanity Fair) purchased a license from the Andy Warhol Foundation for the Visual Arts (AWF) to use *Orange Prince* on the cover of its magazine.[265] After Goldsmith told AWF it had infringed on her copyright of the original Prince portrait, AWF preemptively sued her for a "declaratory judgment of noninfringement or, in the alternative, fair use."[266] If this motion had been granted, it would have ended any infringement lawsuit by Goldsmith before it could begin, thereby saving both parties thousands in legal fees.[267] Goldsmith subsequently countersued for copyright infringement.[268] After analyzing the four elements of fair use, the trial court ultimately considered a Motion for Summary Judgment and found in favor of AWF.[269] It found that “the works were ‘transformative’ because, looking at them and the photograph ‘side-by-side,’ they ‘ha[d] a different character, g[a]ve Goldsmith’s photograph a new expression, and employ[ed] new aesthetics with creative and communicative results distinct from Goldsmith’s.’”[270]

The U.S. Supreme Court focused solely on the transformative factor of the fair use analysis.[271] To qualify as a transformative use, the work must be considered more than just a derivative of the original.[272] Since *Campbell*, it has been evident that if a new work does not substantially comment on the original composition, other factors, like commercial use, may be more influential in determining whether the infringement constitutes fair use.[273] The Court reiterated that the transformative factor considers multiple aspects of the new work, including the purpose (specifically whether it is the same and to what extent) and the justification of the use.[274] "If an original work

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261 *Id*.
262 *Id*. at 517.
263 *Id*. at 508.
264 *Id*.
265 *Id*.
266 Andy Warhol Found. Visual Arts, Inc. v. Goldsmith, 598 U.S. 508, 508 (2023).
267 *See generally id*.
268 *Id*.
269 *Id*. at 522.
270 *Id*. at 422-23.
271 *Id*. at 508-09.
272 Andy Warhol Found. Visual Arts, Inc. v. Goldsmith, 598 U.S. 508, 529 (2023).
273 *Id*. at 530-31.
274 *Id*. at 528-32.

and a secondary use share the same or highly similar purposes, and the secondary use is of a commercial nature, the first factor is likely to weigh against fair use, absent some other justification for copying."[275]

The Court noted that Warhol's "Orange Prince crops, flattens, traces, and colors the photo but otherwise does not alter it."[276] However, it was the subsequent licensing of that print by AWF that constituted the alleged infringement.[277] The Court held that the photo licensed by AWF to Conde Nast and the original photo by Goldsmith had the same purpose and the licensing of that portrait was "of a commercial nature."[278] Those two components suggested to the Court that the fair use analysis was leaning in favor of Goldsmith.[279] The Court determined that, because of the commercial nature of the infringement and its shared purpose with Goldsmith's original (to showcase a celebrity next to an article about them), AWF had to offer a "particularly compelling [independent] justification," which it failed to do.[280] It, therefore, affirmed the Appellate Court's decision in favor of Goldsmith.[281]

b. Implied Licenses

The existence of an implied license is an affirmative defense to copyright infringement.[282] Implied licenses are only found to be existing in narrow circumstances.[283] To determine whether an alleged infringer had an implied license, courts often turn to the length of the transactional relationship, the existence of a written contract, and whether the conduct of the creator suggested an intent to form an implied license.[284] When asserting an implied license, the alleged infringer must show that they requested the work be created, the work's author does so and delivers it to them, and that the author intended for the alleged infringer to "copy and distribute" the work.[285] An implied license can be oral or can be implied through conduct.[286]

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275 *Id*. at 532-33.

276 *Id*. at 522 (providing the Court includes the photo taken by Goldsmith side-by-side with Warhol's Orange Prince to emphasis its point in the opinion).

277 *Id*. at 533.

278 Andy Warhol Found. Visual Arts, Inc. v. Goldsmith, 598 U.S. 508, 535-37 (2023).

279 *Id*. at 538.

280 *Id*. at 547.

281 *Id*. at 551.

282 Muhammad-Ali v. Final Call, Inc., 832 F.3d 755, 761 (7th Cir. 2016).

283 Malla Pollack, *Proof of Implied Copyright License*, 193 AM. JUR. 3D PROOF FACTS 1 (2021).

284 Nelson-Salabes, Inc. v. Morningside Dev., LLC, 284 F.3d 505, 516 (4th Cir. 2002) (explaining where an "Architectural firm which had been retained to provide assistance in design of assisted care facility by facility's original developer brought copyright infringement suit against affiliated corporations which, respectively, owned and developed facility, and corporations' principal.").

285 *Muhammad-Ali*, 832 F.3d at 762.

286 Foad Consulting Grp., Inc. v. Azzalino, 270 F.3d 821, 826 (9th Cir. 2001).

As the word "implied" suggests, this type of license does not have to be in writing and, therefore, cannot be an exclusive license.[287] Notably, an implied license does not transfer ownership of the exclusive rights held by the original author—such a transfer must be in writing.[288] This makes an implied license nonexclusive, as the rights licensed by the original author are limited to what the original author intended.[289] "[A] defendant's subjective belief that an implied license has been granted is insufficient to create either a license or a defense to copyright infringement."[290]

c. De Minimis Use

De minimis use means that, even if copying of a copyrighted work occurred, the copying was so insignificant that the "infringing work" is not "substantially similar" to the original copyrighted work, which would indicate the infringing did not occur.[291] If copying a work is "trivial," then there would be no infringement.[292] For example, taking a picture of someone else's artwork and hanging that picture on your kitchen fridge would likely constitute *de minimis* use.[293] However, when the copying is exact, it is usually unlikely that the *de minimis* use defense will prevail.[294] This is because an exact copy of an entire copyrighted work is an infringement.[295] Often, a *de minimis* argument is introduced with a fair use defense to discuss the amount of copyrighted work copied as it relates to the new work.[296]

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287 *Id*. at 825.

288 Muhammad-Ali v. Final Call, Inc., 832 F.3d 755, 762 (7th Cir. 2016).

289 *See* Alexander v. Take-Two Interactive Software, Inc., 489 F. Supp. 3d 812, 820 (S.D. Ill. 2020) (citing *Muhammad-Ali*, 832 F.3d at 762).

290 Pollack, *supra* note 283, at 1.

291 Jodi Benassi, *De Minimis Defense Doesn't Protect Minimal Use of Concededly Infringing Material*, 10 NAT'L L. REV. 1 (2021).

292 James Juo, *Copyright Infringement but for De Minimis Doctrine*, THOMAS P. HOWARD LLC: BLOG (June 14, 2021), https://thowardlaw.com/2021/06/copyright-infringement-but-for-de-minimis-doctrine/.

293 Jeremy Scott Sykes, *Copyright—the De Minimis Defense in Copyright Infringement Actions Involving Music Sampling*, 36 U. MEM. L. REV. 749, 760 (2006) (using the example of "photocop[ying] a cartoon from a newspaper or magazine to post it on . . . [a] refrigerator").

294 James Juo, *Copyright Infringement but for De Minimis Doctrine*, THOMAS P. HOWARD LLC: BLOG (June 14, 2021), https://thowardlaw.com/2021/06/copyright-infringement-but-for-de-minimis-doctrine/.

295 *Id*.

296 Sykes, *supra* note 293, at 760.

III. TATTOOS AND COPYRIGHTS

In 2014, tattoo artist Matthew Reed sued Rasheed Wallace and Nike for a commercial that depicted a tattoo that Reed designed.[297] This was the first case dealing with recreating tattoos on a professional athlete.[298] Numerous suits followed, including: *Whitmill v. Warner Brothers Entertainment Inc.*; *Crispin v. Christian Audigier, Inc.*; *Solid Oak Sketches, LLC v. 2K Games & Take-Two Interactive Software, Inc.*; *Tattoo Art, Inc. v. TAT International, LLC*; *Gonzales v. Kid Zone, Ltd.*; *Hardy Life, LLC v. Nervous Tattoo, Inc.*; *Miller v. Original Media Publishing, LLC*; and *Sedlik v. Drachenberg*.[299] However, minimal cases deal with whether copying tattoos in video games constitutes fair use, *de minimis* use, or if tattoos inherently have implied licenses.[300]

Only two cases have gone to trial.[301] This Note will analyze only those related to tattoos recreated in video games.[302] As discussed in Part II, *Alexander v. Take-Two*, currently being litigated in the Southern District of Illinois, deals with tattoo artist Catherine Alexander's custom artwork on Randy Orton, a professional wrestler, who licensed his likeness for use by entertainment companies in video games.[303] This clash between the rights of a tattoo artist and the licensing of one's likeness seems to be most problematic when the tattoo client is a celebrity.[304] Defendants routinely

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297 John Paul McCarty, *Skin in the Game: Tattoos, Copyright, and Professional Athletes*, 4 MISS. SPORTS L. REV. 95, 97 (2014).

298 *Id*. at 96.

299 Verified Compl. Inj. & Other Relief, Whitmill v. Warner Bros. Ent. Inc., No. 4:11-CV-00752 (E.D. Mo. Apr. 8, 2011); Crispin v. Christian Audigier, Inc., 839 F. Supp. 2d 1086 (C.D. Cal. 2011); Solid Oak Sketches, LLC v. 2K Games, Inc., 449 F. Supp. 3d 333 (S.D. N.Y. 2020); Tattoo Art Inc. v. TAT Int'l LLC, 498 Fed. Appx. 341 (4th Cir. 2012); Gonzales v. Kid Zone, Ltd., No. 00 C 3969, 2001 WL 930791 (N.D. Ill. Aug. 15, 2001); Hardy Life, LLC v. Nervous Tattoo, Inc., No. CV 08-3524 PA, 2008 WL 11338698 (C.D. Cal. Aug. 4, 2008); Miller v. Original Media Publ'g LLC, No. A-12-CV-1147-JRN, 2013 WL 12109027 (W.D. Tex. Sept. 13, 2013); Sedlik v. Von Drachenberg, No. 2:21-cv-01102 (C.D. Cal. Jan. 30, 2024) (jury found in favor of defendant finding no substantial similarity between the original portrait by plaintiff and tattoo by defendant).

300 *See* Hayden v. 2K Games, Inc., No. 1:17CV2635, 2022 WL 4356211 (N.D. Ohio Sept. 20, 2022); *Solid Oak Sketches, LLC*, 449 F. Supp. 3d at 333; Alexander v. Take-Two, No. 3:18-cv-00966-SMY (S.D. Ill. Sep. 30, 2022).

301 *Alexander*, No. 3:18-CV-00966-SMY; *Sedlik*, No. 2:21-cv-01102 (jury found in favor of defendant finding no substantial similarity between the original portrait by plaintiff and tattoo by defendant). All of the other cases have been settled out of court or disposed of before trial. *See* Verified Compl. Inj. & Other Relief, *Whitmill*, No. 4:11-CV-00752; *Crispin*, 839 F. Supp. 2d at 1086; *Solid Oak Sketches, LLC*, No. 16-CV-724-LTS-SDA; *Tattoo Art Inc*., Fed. Appx. at 341; *Gonzales*, No. 00 C 3969; *Hardy Life, LLC*, No. CV 08-3524 PA; *Original Media Publ'g LLC*, No. A-12-CV-1147-JRN.

302 *Alexander*, No. 3:18-CV-00966-SMY; *Hayden*, No. 1:17CV2635.

303 *Alexander*, No. 3:18-CV-00966-SMY (noting litigation in this case is ongoing).

304 Susan Kayser & Terrance Roberts, *Who Owns an Athlete's Tattoos? The Player? The Tattoo Artist? A Licensor?*, K&L GATES: IP L. WATCH (Apr. 8, 2020), https://www.iplawwatch.com/2020/04/who-owns-an-athletes-tattoos-the-player-the-tattoo-artist-a-licensor/.

claim fair use and implied licensing as defenses to infringement and *de minimis* use as a limit to liability.[305] The judge in *Alexander* found that implied licensing and *de minimis* use were not viable concerning copying tattoos in the three video games at issue.[306]

A. Jury Trial's Decision to Award a Tattoo Artist Damages for Copyright Infringement

People usually love an underdog.[307] This case seemed to fit the bill. Small-town tattoo artist takes on big entertainment businesses to assert her artistic rights and wins.[308] It reads like a film description. However, the outcome of this federal district court case resulted in mixed reviews.[309]

1. Background

Alexander has been a professional tattoo artist for over twenty years, currently established at Diablo Ink in High Ridge, Missouri.[310] She began as a quasi-apprentice to Lewis when she was eighteen after gifting herself her first tattoo.[311] At the time, women were not allowed to complete formal tattoo apprenticeships, so Lewis took her under his wing informally.[312] Formal

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305 *Id*.

306 Alexander v. Take-Two Interactive Software, Inc., No. 3:18-CV-00966-SMY (S.D. Ill. Sept. 30, 2022).

307 *See* Matt Johnson Ph.D., *Why Do We Love Underdog Stories? Psychology Weighs In*, PSYCH. TODAY (Jan. 28, 2021), https://www.psychologytoday.com/us/blog/mind-brain-and-value/202101/why-do-we-love-underdog-stories-psychology-weighs-in ("The underdog story is one of the most classic storylines with a universal appeal, reliably driving feelings of empathy."); Peyton Hamel, Opinion, *Hamel: We Love Underdogs, Don't We? Psychology Fooled You*, IOWA ST. DAILY (May 26, 2021), https://iowastatedaily.com/249723/opinion/hamel-we-love-underdogs-dont-we-psychology-fooled-you/ (opining that people "only root for certain underdogs").

308 *See generally Alexander*, No. 3:18-CV-00966-SMY.

309 *See generally* Adrienne Kendrick, *This Year is Poised to Be a Landmark One for Tattoo Copyright Litigation*, IPWATCHDOG (Jan. 7, 2023), https://ipwatchdog.com/2023/01/07/year-poised-landmark-one-tattoo-copyright-litigation/id=154955/.

310 Telephone Interview with Catherine Alexander, Plaintiff, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-CV-00966-SMY (S.D. Ill. Sept. 30, 2022) (January 18, 2023, 2:00 PM); Transcript of Trial at 199, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-CV-00966-SMY (S.D. Ill. Sept. 27, 2022), ECF No. 306.

311 Telephone Interview with Catherine Alexander, Plaintiff, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-CV-00966-SMY (S.D. Ill. Sept. 30, 2022) (February 21, 2023, 6:00 PM); Transcript of Trial at 199, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-CV-00966-SMY (S.D. Ill. Sept. 27, 2022), ECF 306.

312 Telephone Interview with Catherine Alexander, Plaintiff, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-CV-00966-SMY (S.D. Ill. Sept. 30, 2022) (February 21, 2023, 6:00 PM) (Remembered that Lewis told her "we don't teach women here' so he couldn't take her on formally."); *see generally* Transcript of Trial at 199, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-CV-00966-SMY (S.D. Ill. Sept. 27, 2022), ECF 306 (describing how she "observed and helped . . . Chris Lewis" for many years to learn).

apprentices usually work without pay, depending on the mentor, to learn about the history and process of tattooing.[313] They usually perform grunt work, also commonly referred to as "shop work," and tend to be at the beck and call of the mentor.[314] For many years, Alexander "sat and watched him, asked him questions, [and] help[ed] him out" in his tattoo shop.[315] After a period of observing, Alexander started at a "low-level shop" independent from Lewis.[316] There, she was able to hone her skills by offering discounted re-outlining and re-coloring services for existing tattoos, allowing her to practice her technique on real skin.[317]

When Alexander began her tattooing career, beginners needed to practice their technique to eventually be able to tattoo "whatever style [that] walked through the door [or else they would not] be worth much."[318] Though Alexander learned to offer tattooing in any style requested, she prefers tattooing "artistically-styled realis[t]" designs containing "animals, nature, [and] organic" elements.[319] Like most tattoo artists, Alexander does not invest in traditional advertising but relies on word-of-mouth to gain clients.[320] She considers this a "huge compliment" and the "most respected type of referral."[321]

Alexander met professional wrestler Randy Orton in 2002 when he walked into Goldenland Tattoo looking for an artist to change and add to an existing piece of artwork on his back.[322] At this time, Orton had completed wrestling school, but he had not yet achieved the level of fame he holds as a wrestler today.[323] In addition to applying a custom addition, Alexander made Orton's existing tribal tattoo "more graceful" by extending some of the linework and adding shading.[324]

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313 *How To Get a Tattoo Apprenticeship To Start Your Career*, INDEED (July 31, 2023), https://www.indeed.com/career-advice/finding-a-job/how-to-get-tattoo-apprenticeship.

314 Telephone Interview with Catherine Alexander, Plaintiff, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-CV-00966-SMY (S.D. Ill. Sept. 30, 2022) (Feb. 21, 2023, 6:00 PM).

315 *Id*.; Transcript of Jury Trial Proceedings, *supra* note 70, at 200.

316 *Id*.

317 Telephone Interview with Catherine Alexander, *supra* note 314 (discussing how and when apprentices begin offering tattooing services to the public).

318 *Id*.

319 *Id*.

320 *Id*.

321 *Id*.; Transcript of Trial at 267-68, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-CV-00966-SMY (S.D. Ill. Sept. 27, 2022), ECF 306.

322 Transcript of Jury Trial Proceedings, *supra* note 70, at 11-12, 201-02.

323 *Id*. at 11-12, 202 (quoting Catherine Alexander "I wouldn't say famous in his own right. Now, St. Louis knows the Orton name. But he, himself, had just began his journey in wrestling.").

324 Transcript of Jury Trial Proceedings, *supra* note 70, at 205 (statement of Catherine Alexander).

Alexander applied six custom tattoos on Orton between 2002 and 2008, though only five (the "Tattoos") were at issue in this case.[325] It took "more than five tattoo sessions to ink th[e] large tattoos."[326] When she began tattooing Orton, she was aware that he was attending school to pursue a career as a professional wrestler and knew he would become successful at some point.[327] She knew it was likely that he would appear in various forms of media, as they had discussed how to use the Tattoos to "accent his muscle structure" and appear well on television.[328] Still, she did not realize his likeness would be, and was, used in video games.[329] In 2009, a friend or acquaintance of Alexander commented on how the Tattoos were supposedly going to be used on fake sleeves.[330]

Upon learning that the Tattoos might be used in products for World Wrestling Entertainment (WWE), Alexander called the legal department to inquire if it was true and to let them know that they could not use the Tattoos.[331] WWE reportedly indicated that it did not intend to get a licensing agreement but eventually offered Alexander $450 for the exclusive use of all the tattoos she had designed.[332] Alexander also alleged that the representative was rude regarding her questions about the rumored products and about Alexander asserting her rights.[333] According to Alexander, WWE stated there would be no proof of the call.[334] Alexander did not take action, as she did not know her artwork was being used on products.[335] Until the defendants' opening statements on September 26, 2023, she had not seen or heard of Orton's likeness appearing in video games from 2002 through 2010.[336] However, when an acquaintance of Alexander commented on the realistic depiction of Orton and the Tattoos in a WWE video game released in 2016,

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325 *Id*. at 203-04. The sixth tattoo of a Bible verse did not receive approval from the USCO as it "lacked the authorship necessary to support a copyright claim." Memorandum & Order at 10, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-CV-00966-SMY (S.D. Ill. Mar. 18, 2020).

326 Transcript of Jury Trial Proceedings, *supra* note 70, at 227.

327 *Id*. at 228.

328 *Id*. at 229.

329 *See generally id*.

330 *Id*. at 221.

331 Amended Complaint, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-cv-00966-SMY (S.D. Ill. Oct. 2, 2018), ECF No. 76; Transcript of Trial at 221-22, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-CV-00966-SMY (S.D. Ill. Sept. 27, 2022), ECF No. 306.

332 Amended Complaint, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-CV-00966-SMY (S.D. Ill. Oct. 2, 2018), ECF No. 76; Transcript of Trial at 259, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-CV-00966-SMY (S.D. Ill. Sept. 27, 2022), ECF No. 306.

333 Telephone Interview with Catherine Alexander, *supra* note 314, at Jan. 19, 2023, 2:00 PM; Transcript of Jury Trial Proceedings, *supra* note 70, at 222.

334 Telephone Interview with Catherine Alexander, *supra* note 314, at Jan. 19, 2023, 2:00 PM.

335 *Id*.; Transcript of Jury Trial Proceedings, *supra* note 70.

336 Transcript of Trial at 213-15, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-CV-00966-SMY (S.D. Ill. Sept. 27, 2023), ECF No. 306 (statement of Catherine Alexander) [hereinafter Transcript of Trial].

Alexander decided to file a lawsuit.[337] However, Alexander was unable to proceed immediately due to a "bi-level spinal fusion in early 2017, with some complications, and also, a car accident following that, in 2018."[338]

Alexander registered the Tattoos, as it was necessary to proceed to litigation,[339] with the USCO on March 6, 2018, which approved five on March 13, 2018.[340] These were registered under "[v]isual [m]aterial."[341] Photos of the Tattoos on Orton's skin were provided with Alexander's application as proof of artwork published in a tangible medium.[342] Then, Alexander filed a copyright infringement claim against WWE and the video game makers for direct infringement on April 17, 2018.[343]

On November 8, 2019, Alexander filed a Motion for Partial Summary Judgment ("Plaintiff's MSJ") regarding the issue of copying.[344] She asserted that there was no issue of material fact as to copying because the defendants readily admitted to it.[345] In their response, the defendants asserted that Alexander was required to prove "legally actionable copying."[346] The court disagreed, noting that Alexander, having already established the existence of copyright registration, had "only need[ed] to show that [d]efendants used her property."[347] Since the evidence showed that the defendants admitted to copying the Tattoos, the answer was simple for the court.[348] The court granted Alexander's motion on September 26, 2020.[349]

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337 Telephone Interview with Catherine Alexander, *supra* note 314, at Jan. 19, 2023, 2:00 PM; Transcript of Jury Trial Proceedings, *supra* note 70.

338 Transcript of Jury Trial Proceedings, *supra* note 70, at 225.

339 *Id*. at 226.

340 Copyright Application Form; Registration #s: "Skulls" #VAu001345112; "Tribal Design" #VAu001345100; "Dove" #VAu001345102; "Rose" #VAu001345109; and "Tribal Addition Design" #VAu001345106 (2018).

341 Registration #s: "Skulls" #VAu001345112; "Tribal Design" #VAu001345100; "Dove" #VAu001345102; "Rose" #VAu001345109; and "Tribal Addition Design" #VAu001345106 (2018).

342 Application Exhibits attached to Plaintiff's Memorandum in Opposition re 49 Motion to Dismiss Plaintiff's Complaint, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-CV-00966-SMY (7th Cir. Sept. 30, 2022).

343 First Amended Complaint, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-CV-00966-SMY (7th Cir. Sept. 30, 2022).

344 Plaintiff Catherine Alexander's Memorandum of Law in Support of Motion for Partial Summary Judgment at 3-5, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-CV-00966-SMY (S.D. Ill. Nov. 8, 2019), ECF No. 140.

345 *See id*.

346 Memorandum and Order at 5, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-CV-00966-SMY (S.D. Ill. Sept. 26, 2020), ECF No. 228.

347 *Id*.

348 *Id*.

349 *Id*.

The defendants filed a Motion for Summary Judgment ("Defendants' MSJ") on the same day as Alexander.[350] They first argued that any copying was authorized by an implied license.[351] As described in Part II.B, an implied license is established when someone requests another to make something, that person does so and gives it to the requestor, and the creator meant for the requestor to subsequently "copy and distribute" that work.[352]

The defendants believed that the first two prongs were met since Orton had requested Alexander create and place the Tattoos on specific areas of his skin.[353] As to the third prong, relying on the Seventh Circuit's decision in *I.A.E., Inc. v. Shaver*, the defendants noted that "[a] key fact showing that an implied license exists is 'the delivery of the copyrighted material without warning that its further use would constitute copyright infringement.'"[354] They also noted that the tattoo industry practice supported the conclusion of an implied license as it was a common understanding that tattoos become part of the person.[355] Specifically, they asserted that "when a client is tattooed, the understanding of both tattooist and client is that the client can go about his business with the tattoo being seen or depicted as just another part of his body."[356] According to the defendants, an implied license was created because Alexander never *told* Orton—despite being aware Orton appeared on television and in other media—that subsequent use of the Tattoos would be an infringement.[357]

They also argued that the copying constituted fair use, or in the alternative, was *de minimis*, even if no implied license was found.[358] In analyzing fair use, courts look at the reason for the copying (the "Transformative Prong"), what the copyrighted work entails (the "Nature Prong"), how much copying occurred (the "Reasonableness Prong"), and

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350 *See* Defendants Take-Two Interactive Software, Inc., 2K Games, Inc., 2K Sports, Inc., and Visual Concepts Ent.'s Motion for Summary Judgment, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-CV-00966-SMY (S.D. Ill. Nov. 8, 2019), ECF No. 141.

351 Memorandum of Law in Support of Defendants Take-Two Interactive Software, Inc., 2K Games, Inc., 2K Sports, Inc., and Visual Concepts Ent.'s Motion for Summary Judgment at 7, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-CV-00966-SMY (S.D. Ill. Nov. 8, 2019), ECF No. 142.

352 *See* discussion *supra* Part II.B; *see also id.* at 8 (quoting I.A.E., Inc. v. Shaver, 74 F.3d 768, 776 (7th Cir. 1996)).

353 *See* Memorandum of Law in Support of Defendants Motion for Summary Judgment, *supra* note 351, at 7 ("As to the first and second prongs, each Tattoo was created at Mr. Orton's request.").

354 *Id*. at 8.

355 *Id*. (quoting Expert Report & Declaration Nina Jablonski, PH.D. at ¶ 30, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-CV-00966-SMY (S.D. Ill. Nov. 8, 2019), ECF No. 142-8).

356 *Id*. (quoting Declaration Gary Glastein at ¶ 11, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-CV-00966-SMY (S.D. Ill. Nov. 8, 2019), ECF No. 142-6).

357 *Id*. (quoting *I.A.E., Inc*., 74 F.3d at 776) ("A key fact showing that an implied license exists is 'the delivery of the copyrighted material without warning that its further use would constitute copyright infringement.'").

358 *Id*. at 9, 18.

how the copying could affect the copyright holder or market (the "Public Interest Prong").[359] Under each prong, courts consider multiple factors and perform a balancing test.[360]

Under the Transformative Prong, the central inquiry is whether the alleged infringing work has a purpose that is distinctly different than the original.[361] "[S]pecifically, courts consider, '[W]hether the new work merely supersedes the original work, or instead adds something new with a further purpose or of a different character.'"[362] The defendants urged that using the Tattoos in video games was transformative since they "serve[d] a far different purpose . . . than that for which they were originally created . . . ."[363] They alleged that the purpose of creating the Tattoos was to represent Orton's "personal expression," whereas the defendants' use of the Tattoos for the purpose of creating a realistic depiction of Orton.[364] Further, they argued that, since the Tattoos in the game were smaller than in real life, only a fraction of the game, part of a virtual world with many other elements, and not the reason people bought the games, the scale tipped in favor of the defendants.[365]

The Nature Prong generally deals with whether the work is creative or factual.[366] The defendants argued that no creativity went into copying the Tattoos as it was merely an exercise to make the avatar look as much like Orton as possible.[367] They further stated that Alexander admitted that the games were "more realistic because [they] include[d] the Tattoos."[368]

The Reasonableness Prong analyzes the infringed work to determine whether the amount of copying is "reasonable in relation to the purpose of the copying."[369] Nearly working in tandem with the Reasonableness Prong,

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359 *See* discussion *supra* Part II.A; 17 U.S.C. § 107(1)-(4); Google LLC v. Oracle America, Inc., 141 S. Ct. 1183 (2021).

360 *See generally Google LLC*, 141 S. Ct. at 1183; Campbell v. Acuff-Rose Music, Inc., 510 U.S. 659, 579 (1994).

361 *See Campbell*, 510 U.S. at 579 (detailing the key question necessary for the first prong of the fair use analysis); *see also* Memorandum of Law in Support of Defendants Motion for Summary Judgment, *supra* note 351, at 9 (first quoting Brownmark Films, LLC, 682 F.3d 687, 693 (7th Cir. 2012); then citing Leveyfilm, Inc. v. Fox Sports Interactive Media, LLC, No. 13 Civ. 4664, 2014 WL 3368893, at *9 (N.D. Ill. Jul. 8, 2014)).

362 Memorandum of Law in Support of Defendants Motion for Summary Judgment, *supra* note 351, at 9 (first quoting *Brownmark Films, LLC*, 682 F.3d at 693; then citing *Leveyfilm, Inc*., 2014 WL 3368893, at *9).

363 *Id*.

364 *Id*. at 10.

365 *See id*. at 10-13.

366 Campbell v. Acuff-Rose Music, Inc., 510 U.S. 659, 586 (1994).

367 *See* Memorandum of Law in Support of Defendants Motion for Summary Judgment, *supra* note 351, at 14 (first citing Consumers Union of U.S. v Gen. Signal Corp., 724 F.2d 1044, 1049 (2d Cir. 1983); then citing Bouchat v. Baltimore Ravens Ltd. Partnership, 737 F.3d 932 (4th Cir. 2013)).

368 *Id*.

369 *Campbell*, 510 U.S. at 586; *see also* Memorandum of Law in Support of Defendants Motion for Summary Judgment, *supra* note 351, at 14 (quoting Red Label Music Publ'g, Inc. v. Chila Prods., 388 F. Supp. 3d 975, 984-85 (N.D. Ill. 2019)).

the Public Interest Prong deals with the likelihood of the infringing work serving "as a market substitute for the original . . . ."[370] The defendants argued that the Tattoos, copied to provide a realistic portrayal of Orton, were only a small part of the game.[371] Further, they asserted that there was ample precedent to support that, since their objective was to accurately portray real life, utilizing the entirety of the Tattoos was permissible because using less would not have fulfilled the defendants' "purpose of making WWE 2K realistic."[372] They insisted that video games could not be a market substitute for the Tattoos because there was no market to disrupt.[373] Alexander conceded that she was not in competition with the defendants and had not shown an actual "market for licensing the Tattoos."[374]

Finally, the defendants argued that any copying was *de minimis*.[375] This occurs when the copying is so insignificant that the "infringing work" is not "substantially similar" to the original copyrighted work, indicating the infringement did not occur.[376] They contended that the Tattoos in the games were "about 14.35%-15.58% the size they appear in real life."[377] Further, the Tattoos only accounted for "0.008% of . . . [the] game data."[378] However, the court denied the Defendants' MSJ on September 26, 2020, as there were "issues of material fact" as to fair use and implied license.[379] The court threw out the defendants' *de minimis* argument, definitively taking it off the table for the defendants at trial.[380]

2. Trial

During the trial, the defendants had the burden of proof since the court, in granting Alexander's Motion for Partial Summary Judgment, had

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370 Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 587 (1994).

371 Memorandum in Support of Defendants Motion for Summary Judgment *supra* note 351, at 15.

372 *Id*. (first citing Neri v. Monroe, No. 11-cv-429-slc, 2014 WL 793336, at *7 (W.D. Wis. Feb. 26, 2014), *aff'd*, 567 F.App'x 465 (7th Cir. 2014); then citing Galvin v. Ill. Republican Party, 130 F. Supp. 3d 1187, 1195 (N.D. Ill. 2015); Denizon v. Larkin, 64 F. Supp. 3d 1127, 1134-35 (N.D. Ill. 2014)).

373 *Id*. at 15-17.

374 *Id*. at 16 (citing Videotaped Deposition Catherine Alexander at 176:2-8, 176:24-5, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-cv-00966-SMY (S.D. Ill. Nov. 8, 2019), ECF No. 142-17).

375 *Id*. at 18-19.

376 Jodi Benassi, *De Minimis Defense Doesn't Protect Minimal Use of Concededly Infringing Material*, JDSUPRA (Sept. 23, 2021), https://www.jdsupra.com/legalnews/de-minimis-defense-doesn-t-protect-4590993/.

377 Memorandum in Support of Defendants Motion for Summary Judgment, *supra* note 351, at 19.

378 *Id*.

379 Memorandum & Order, *supra* note 346, at 6-13.

380 *See id*. at 2, 5 ("Therefore, the Court amends and clarifies its Order to reflect that, as a matter of law, the de minimis defense is not viable in this case and Defendants cannot assert the defense at trial.").

concluded that they had, as a matter of law, copied the Tattoos.[381] Therefore, the defendants were required to put forth evidence to prove that one of their remaining affirmative defenses applied.[382]

On September 27, 2022, Alexander called expert witness Jose Zagal to testify about the video game industry.[383] He expressed the importance realism has on consumer satisfaction and sales, specifically for the 2K games.[384] Even one character could wreak havoc on the success of a game depending on how significant that wrestler is "to the brand, to the franchise, and how many fans . . . they have."[385] In this case, Zagal opined that Orton was an important character in the games at issue.[386] As an integral part of Orton's persona, the Tattoos seemed to "get a lot of attention from both fans" and even the defendants themselves.[387] In an article published by one of the defendants, Orton was listed in the number five spot of the best tattoos on their wrestlers, which, to Zagal, suggested the Tattoos were important to the defendants.[388] Therefore, Zagal believed that the "Take-Two video game[s] would be perceived as less authentic if [Orton] appeared in the games without [the] Tattoos."[389] However, on cross-examination, the defense was quick to clarify that it was not the specific Tattoos at issue in this case but any tattoo Orton has or may have.[390]

In a walk-through of the game, where Zagal handled the controls of 2K16, the jury was introduced to a "Custom Superstar" feature where players could customize the avatar they wanted to be while playing.[391] This feature allowed players to take a "mannequin" and customize its features as well as its "body art."[392] Zagal demonstrated that any player could alter the character by putting the Tattoos on different body parts (individually).[393] To perfect the character, players could zoom in on the Tattoos to show more detail.[394] Finally, Zagal testified that putting the Tattoos in the video games at issue

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381 *See id*. at 5.

382 *See id*. at 6.

383 Transcript of Jury Trial Proceedings, *supra* note 70, at Day 2 of 5.

384 *Id*. at Day 1 of 5 at 78-80.

385 *Id*. at 80-81.

386 *Id*. at 81-84 (relying on Orton's social media presence as opposed to other wrestlers, had been in several of the games, and videos of fans analyzing the Orton avatar's appearance in the games).

387 *Id*. at Day 2 of 5 at 99.

388 *Id*. at Day 2 of 5 at 101-02.

389 Transcript of Jury Trial Proceedings, *supra* note 70, Day 2 of 5 at 102 (statement of Jose Zagal) ("I think the fans would notice . . . if the video game character had different tattoos. . . . Or if he had no tattoos, the fans would also notice that.").

390 *Id*. at 136-37.

391 *Id*. at 108-110.

392 *Id*. at 110 (statement of Jose Zagal).

393 *Id*.

394 *Id*.

was a conscious design choice.[395] All of this was undertaken to demonstrate to the jury that the defendants made a conscious, commercially based decision to copy the Tattoos and to show just how much detail users can witness of them.[396] After a couple of corporate witness testimony via recorded evidence depositions, Alexander took the stand.[397]

Moving slowly with the help of a cane due to a past spinal fusion and vehicle accident, she took the stand mid-way through the afternoon session on September 27, 2022.[398] She painted a picture of big corporate America taking advantage of the small business, complete with rude, condescending interactions.[399] Alexander testified that she and Orton discussed ownership of the Tattoos at least once.[400] She relayed that Orton told her that the designs were hers and she could tattoo them on any client who requested one.[401] Specifically, Orton allegedly stated, "Do what you want with them, you made them, you can do what you want."[402] However, no discussions occurred relating to the Tattoos' portrayal in video games or Orton's interest in sublicensing the Tattoos.[403] Missouri does not require tattoo artists to provide any disclaimers related to Intellectual Property in any form.[404] They are only required to have clients review and sign a health waiver.[405] She had not heard of or seen Orton's likeness used in any video game from 2002-2015.[406] Alexander only heard that the Tattoos may be used on WWE products in 2009, when she heard a rumor about them appearing on "faux nylon sleeves."[407] At that time, she called the WWE legal department and told them they did not have permission to use the Tattoos.[408] Allegedly, that representative told her, their contract was with Orton, who had granted them full authority to use his image.[409] Following this, the representative made a lowball offer of $450 for exclusive ownership of the Tattoos.[410]

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395 Transcript of Jury Trial Proceedings, *supra* note 70, Day 2 of 5 at 123-25 (statement of Jose Zagal) ("[G]ame companies are very deliberate . . . in terms of what should add, what should they not add, what should they remove.").

396 *Id*. at 211.

397 *Id*.

398 Taylor Ingram, *Private Notes: Alexander v. Take-Two Trial* (Sept. 27, 2022).

399 Transcript of Jury Trial Proceedings, *supra* note 70, at Day 2 of 5.

400 *Id*.

401 *Id*. (statement of Catherine Alexander) ("He said I created the designs and if someone were to ask for me to tattoo them on their body . . . .").

402 *Id*. (statement of Catherine Alexander).

403 *Id*. at 211-12.

404 *Id*. at 236.

405 Transcript of Jury Trial Proceedings, *supra* note 70, Day 2 of 5 at 236.

406 *Id*. at 213-16.

407 *Id*. at 258-59.

408 *Id*. at 258, 272.

409 *Id*. at 258-59.

410 *Id*. at 259.

Alexander did not object to Orton showing off the Tattoos in media, capturing his real-life persona.[411] She testified that Orton did not require her permission to be videotaped, photographed, or display his body in public.[412] In other words, Orton did not need her permission to do what he wanted with his body.[413] Alexander had never told one of her clients that there were limits to what they could do with the tattoos she placed on them because none needed her authorization "[t]o show their tattoos on their physical body."[414] However, Alexander did assert that there was a difference between appearing on television or in a picture and a recreation of the person in a video game.[415]

Alexander remained composed on the stand under a steady barrage of cross-examination by the defense, even when their tone hinted at a bit of condescension.[416] Defendants asserted that there was not really a difference between a picture of someone and a video game recreation of them.[417] This line of examination was almost offensive. Technically, in both instances, the actual person is not physically in the same room as the audience; however, arguing that an image of a person and a recreation of that person in a video game is the same was ludicrous.[418]

During one line of questioning, the defense repeatedly attempted, despite several interruptions from the court, to compel Alexander to admit that she had been aware of the video games featuring Orton as early as 2014.[419] It began as an appropriate attempt to impeach Alexander through her deposition testimony, which indicated that Alexander might have known about the games "more than four years" before being deposed.[420]

The defense read directly from the transcript of Alexander's deposition, as Alexander could not recall what she testified to.[421] However, the court ultimately determined that the defendants' method did not constitute impeachment but rather an inappropriate attempt to refresh her recollection of the events.[422] In a sidebar with the court, the defense tried to explain that since she answered affirmatively in her deposition to the question—"Was it more than four years ago?"—she had to have known of the games in 2014.[423]

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411 Transcript of Jury Trial Proceedings, *supra* note 70, Day 2 of 5 at 216-17.

412 *Id*.

413 *Id*. at 16.

414 *Id*. at 231-32.

415 *Id*. at 238.

416 Taylor Ingram, *supra* note 398; *see generally id*. at 231-32.

417 Transcript of Jury Trial Proceedings, *supra* note 70, Day 2 of 5 at 238.

418 *Id*. at 243.

419 *See id*. at 243-54 ("Ms. Alexander, isn't it true that, in approximately 2014, more than four years before I took your deposition in January of 2019, is when this person told you that Randy Orton appears in the WWE 3K video games?"); *see also* Taylor Ingram, *supra* note 398.

420 *See* Transcript of Jury Trial Proceedings, *supra* note 70, Day 2 of 5 at 245-46.

421 *See id*. at 246.

422 *See id*. at 246-47.

423 *Id*. at 249.

However, the court ruled that Alexander's testimony on the stand was not inconsistent with her prior testimony—making impeachment was improper—and instructed the defense to move on.[424] The jury was instructed to disregard the recitation of the deposition testimony.[425] Nevertheless, the defense persisted in their endeavor to elicit this response from Alexander by framing questions in a way that suggested she had seen the games in 2014 rather than 2016 until the court eventually intervened and directed the defense to pursue a different line of questioning.[426] The obsession with getting Alexander to admit to that date came off as very condescending.[427]

Upon the conclusion of Alexander's case-in-chief, the defendants moved for judgment as a matter of law, arguing that Alexander had not presented "sufficient evidence of entitlement to actual damages for profits."[428] Alexander argued that she had presented evidence related to the defendants' "actual gross revenues and profits," "financial aspects of licensing agreements" by the defendants for IP, and testimony that "without the [T]attoos . . . WWE would not have approved the release of the video game and Take-Two would not have been able to sell any of the video games."[429] The court denied the defendants' motion for judgment as a matter of law because Alexander was not required to put a dollar amount on any of the evidence as that was the role of the jury, assuming there was enough evidence, which the court deemed was present.[430]

The defendants started their case-in-chief off strong by calling Orton to the stand first.[431] The court quickly advised Orton to answer only the question asked and not to add anything additional irrelevant information in his answer.[432] He signed a professional wrestling contract in January 2000 and was first in an "on-air match" in 2001.[433] The defendants then walked Orton down memory lane through examples of all the different promotional media he had participated in throughout his career.[434] Orton testified that, at the time he met Alexander and started using her as a tattoo artist, he was already a professional wrestler appearing on television and other media.[435] He stated

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424 *See id*.
425 *See id*. at 246.
426 *See* Transcript of Jury Trial Proceedings, *supra* note 70, Day 2 of 5 at 246.
427 Taylor Ingram, *supra* note 398.
428 Transcript of Jury Trial Proceedings, *supra* note 70, Day 3 of 5 at 313-14.
429 *Id*. at 326-27.
430 *Id*. at 327-30.
431 *Id*. at 331.
432 *Id*. at 334.
433 *Id*. at 335.
434 Transcript of Jury Trial Proceedings, *supra* note 70, Day 3 of 5 at 334-44 (showing the jury promotional media such as posters and apparel).
435 *Id*. at 354.

that they had never discussed his rights related to the Tattoos, and he assumed she knew he would appear in the media because of his job.[436]

After lunch recess on the third day of trial, the court declared, as a matter of law, there was "no legal basis to support the affirmative defense of estoppel."[437] The defendants were unable to offer any further evidence that would be introduced subsequently to support the defense other than more evidence of Alexander's silence.[438] The court held that more than silence needed to be shown to support that "misled the defendants to continue the conduct . . . alleged to be infringing."[439] The court further limited the defenses by removing the waiver since this defense also required more than evidence of Alexander's silence to show she intended "to relinquish her . . . known right in her copyright."[440] Therefore, at that period, only implied license and fair use were left.[441]

At the close of evidence, Alexander moved for judgment as a matter of law regarding the defendants' implied license defense.[442] The only evidence submitted by the defendants of the regular practice within the tattoo industry was Nina Jablonski, "a professor at Penn State University and . . . an anthropologist."[443] However, the defendants failed to lay the proper foundation to establish Jablonski as an expert on the industry custom and practice of tattooing.[444] Therefore, the defendants were barred from using her testimony for implied license.[445] Because the defendants did not establish any evidence that Alexander intended an implied license for any of the Tattoos, the court granted Alexander's motion as to the implied license defense.[446]

The court then only instructed the jury to decide whether or not the defendants' use of the Tattoos constituted fair use.[447] However, the defendants filed a motion for judgment as a matter of law regarding the decision to allow the jury to decide the legal question of fair use.[448] In the alternative, the defendants requested that, if Alexander requests a new trial upon granting of the motion, they be able to argue all of the defenses they originally asserted.[449] Alexander filed a response in opposition on November

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436 *Id*. at 336-37.
437 *Id*. at 399-400.
438 *Id*. at 399.
439 *Id*. at 397-400.
440 Transcript of Jury Trial Proceedings, *supra* note 70, Day 3 of 5 at 400-01.
441 *Id*. at 402.
442 *See id.* at Day 4 of 5 at 705.
443 *See id.* at 707, 483-84.
444 *Id*. at Day 3 of 5 at 451.
445 *Id*.
446 Transcript of Jury Trial Proceedings, *supra* note 70, Day 4 of 5 at 715.
447 *Id*. at Day 1 of 5.
448 Defendant's Motion for Judgment as a Matter of Law, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-CV-00966 (7th Cir. Sept. 30, 2022).
449 *Id*.

30, 2022.[450] The response noted that the defense was attempting to assert fair use after a jury had decided none existed, to "relitigate already settled issues," and "reverse damages" already awarded to the plaintiff.[451]

In certain unrelated cases, the plaintiffs were noted to have strong claims for damages related to copyright infringement, or there was already an expectation between the parties regarding licensing.[452] For example, in *Whitmill v. Warner Bros. Entertainment*, Whitmill required Tyson to be a party to a release that made it clear that Whitmill owned the rights to the artwork.[453] The court in that case also found a valid copyright in the work and that it was likely that the fair use defense was not applicable in that case.[454] The case was settled outside of court.[455] In *Solid Oaks Sketches, LLC v. Take-Two*, a case very similar to *Alexander*, an artist sued Take-Two for using his custom artwork on the avatars of NBA players in a video game.[456] In that case, the defendant asserted *de minimis* use and fair use.[457]

The cases that did not make it to a jury trial, like *Whitmill* and *Solid Oak*, but did not settle outside of court, ended in summary judgment in favor of the defendants due to fair use, implied licenses, and *de minimis* use.[458] In *Alexander*, it seems like the biggest difference in the use of the artwork was the ability of players to customize their avatars by adding individual tattoos copied from Alexander's artwork.[459] This included the ability to change the color of the tattoos and to apply individual tattoos onto custom characters on any body part.[460]

Alexander shows just how little a plaintiff could receive on an infringement conducted by a major business.[461] The video games that infringed on Alexander's copyrights resulted in gross revenue of $418,692,526.[462] However, Alexander was only awarded $3,750 for actual

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450 Plaintiff's Response in Opposition of a Judgment as a Matter of Law, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-CV-00966 (7th Cir. Nov. 30, 2022).

451 *Id*.

452 *See, e.g.* Redacted - Hearing on Motion for Preliminary Injunction at 3, Whitmill v. Warner Bros. Ent. Inc., 2011 WL 11819138 (E.D. Mo. 2011) (No. 4:11-CV-752).

453 Jennifer Hicks Sagarduy, *Tattoos Inking Their Way onto Copyright Jurisprudence*, UNIV. OF MIAMI L. REV.: BLOG (Mar. 27, 2019), https://lawreview.law.miami.edu/tattoos-inking-copyright-jurisprudence/; Plaintiff's Memorandum in Support of his Motion for Preliminary Injunction at 2, Whitmill v. Warner Bros. Ent. Inc., 2011 WL 12893042 (E.D. Mo. 2011) (No. 4:11-cv-752).

454 Jennifer Hicks Sagarduy, *Tattoos Inking Their Way Onto Copyright Jurisprudence*, UNIV. OF MIAMI L. REV.: BLOG (Mar. 27, 2019), https://lawreview.law.miami.edu/tattoos-inking-copyright-jurisprudence/.

455 *Id*.

456 Solid Oak Sketches, LLC v. 2K Games, Inc., 449 F. Supp. 3d 333, 339 (S.D. N.Y., 2020).

457 *Id*.

458 *See, e.g*. *id*.

459 Transcript of Jury Trial Proceedings, *supra* note 70, Day 1 of 5 at 17.

460 *Id*.

461 *See generally id*. at Day 2 of 5, at 286.

462 *Id*.

losses and was not awarded any amount of the profits the Defendants made on the video games.[463] In this case, Catherine Alexander wanted to fight for the little guy, so while a larger amount of damages would have been nice, she was satisfied, having shown that the big business cannot take advantage of the small business.[464]

B. Brief Overview of the Status of *Hayden v. 2K Games, Inc.*

James Hayden, a tattoo artist from Ohio,[465] has created and applied artwork to many athletes, including NBA players Danny Green, LeBron James, and Tristan Thompson.[466] Of the several tattoos Hayden created and applied to the three players from 2007 through 2012, he alleged copyright infringement on six after discovering Take-Two was copying them for use in the "NBA 2K video games."[467] Hayden holds copyright registrations for all six.[468] They include the following: *Stars*, *Gloria*, and *Lion* on James; *Fire* and *Scroll* on Green; and *Brother's Keeper* on Thompson.[469] The "operative Fourth Amended Complaint was filed on August 19, 2019."[470]

On September 20, 2022, the court granted in part Hayden's partial motion for summary judgment to the "extent that he owns *presumptively valid, protectable copyrights* in the tattoos pursuant to 17 U.S.C. § 410," noting that this presumption was rebuttable.[471] It denied the defendants' partial motion for summary judgment.[472]

On October 31, 2023, the defendants filed a motion for partial summary judgment on four of the six tattoos.[473] The defendants claimed that four of

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463 Jury verdict form, Alexander v. Take-Two Interactive Software, Inc., No. 3:18-CV-00966 (7th Cir. Sept. 30, 2022).

464 Telephone Interview with Catherine Alexander, *supra* note 314, at Jan. 19, 2023, 2:00 PM.

465 Adam Ferrise, *The King's ink: Judge rules in favor of 'NBA 2K' video-game maker in lawsuit over LeBron James' tattoos*, CLEVELAND.COM (Jan. 25, 2024, 10:58 AM), https://www.cleveland.com/court-justice/2024/01/the-kings-ink-judge-rules-in-favor-of-nba-2k-video-game-maker-in-lawsuit-over-lebron-james-tattoos.html.

466 Brief in Support of Plaintiff's Motion for Partial Summary Judgment, at 2, Hayden v. 2K Games, Inc., No. 1:17CV2635 (N.D. Ohio Oct. 25, 2021), ECF No. 94-1; Plaintiff's Opposition to Defendants' Motion for Partial Summary Judgment, at 4, Hayden v. 2K Games, Inc., No. 1:17CV2635 (N.D. Ohio Nov. 30, 2023), ECF No. 249.

467 Plaintiff's Opposition to Defendants' Motion for Partial Summary Judgment, at 4, Hayden v. 2K Games, Inc., No. 1:17CV2635 (N.D. Ohio Nov. 30, 2023), ECF No. 249.

468 Brief in Support of Plaintiff's Motion for Partial Summary Judgment, at 2, Hayden v. 2K Games, Inc., No. 1:17CV2635 (N.D. Ohio Oct. 25, 2021), ECF No. 94-1.

469 *Id*. at 2-3.

470 Opinion & Order, at 2, Hayden v. 2K Games, Inc., No. 1:17CV2635 (N.D. Ohio Jan. 24, 2024), ECF No. 251.

471 *Id*. at 3.

472 *Id*.

473 Defendants 2K Games, Inc. and Take-Two Interactive Software, Inc.'s Motion for Partial Summary Judgment, at 1, Hayden v. 2K Games, Inc., No. 1:17CV2635 (N.D. Ohio Oct. 31, 2023), ECF No. 248; Opinion & Order, *supra* note 470, at 5.

the tattoos at issue were not actionable pursuant to 17 U.S.C. § 41(a) because they failed the "pre-suit registration requirement."[474] However, Hayden countered that the defendant's argument had to fail because they could only speculate on whether he knew that his registration applications were non-compliant.[475] After the defendants asserted Hayden knowingly defrauded the Copyright Office in his applications to register the *Lion*, *Fire*, *Scroll*, and *Brother's Keeper* tattoos, an affirmative defense, the court referred questions on that issue to the Copyright Office.[476] The Register of Copyrights responded with the following:

> [B]ased on the legal standards and examining practices . . . , the Office would not have registered the tattoo designs if it had known that the designs included an "appreciable amount" of public domain material or material owned by a third party that the applicant did not exclude in his application for registration.[477]

Ultimately, the court determined that all four of the tattoos the defendants challenged were "invalid and unenforceable."[478] The *Scroll* and *Fire* tattoos included the work of other tattoo artists, which Hayden failed to disclose in his applications.[479] Hayden conceded this in his 2019 Supplemental Registrations but asserted he did not know he was required to disclose existing artwork near the tattoos.[480] The court deduced that Hayden knew of the inaccurate information when he filed his registrations in 2017 based on his declaration, which stated his "intention to register only the works [he] created," and on the original application, which "specifically exclude[d] the photograph of . . . Green's arm and limit[ed] his claim to his 2-D artwork."[481] Although the original registrations were granted in 2017, the Supplemental Registrations were not filed until 2019.[482]

Regarding the *Lion* and *Brother's Keeper* tattoos, Hayden derived inspiration for *Lion* from a "Venetian Resort playing card" that James brought into the shop, while *Brother's Keeper* the hands depicted in Michelangelo's *Creation of Adam*.[483] However, he failed to disclose any existing works in his applications for registration, though his declaration "show[ed] that he knew that the card and the hand design were not his own

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474 Opinion & Order, *supra* note 470, at 5.
475 *Id*.
476 *Id*. at 3.
477 *Id*. at 4.
478 *Id*. at 9.
479 *Id*.
480 Opinion & Order, *supra* note 470, at 9.
481 *Id*. at 10.
482 *Id*.
483 *Id*. at 11-12.

original creations."[484] Hayden believed that artwork within the public domain did not require disclosure within applications for copyright registration.[485] However, in its response, the Register of Copyrights included a footnote stating that Hayden's belief was "incorrect."[486] Applications must include disclosure of "any preexisting work or works" that a work to be registered "is based on or incorporates," as provided within a section of the Copyright Act which Hayden cited himself.[487]

Therefore, the court dismissed without prejudice the claims related to the *Lion*, *Fire*, *Scroll*, and *Brother's Keeper* tattoos, finding Hayden knowingly filed inaccurate information in his original applications, making all four "invalid and unenforceable."[488] Further, although amended pursuant to proper procedure and found copyrightable by the Register of Copyright without the existing art, it held that the Supplemental Registrations for the *Scroll* and *Fire* tattoos, effective July 30, 2019, "failed to satisfy the pre-suit registration requirements."[489] It did not feel the need to address the claims of fraud based on the decision above.[490] The jury trial, then, will only be as to the remaining two tattoos.[491]

IV. TATTOOS ARE COPYRIGHTABLE

> "Of course tattoos can be copyrighted. I don't think there is any reasonable dispute about that."[492]

Although the Copyright Office has granted copyright registration to tattoos and provided an opinion stating that tattoos are copyrightable,[493] there is still debate. As stated above, a copyright protects "original works of authorship fixed in any tangible medium of expression."[494] Custom tattoos

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484 *Id*. at 12.

485 *Id*.

486 Opinion & Order, *supra* note 470, at 12.

487 17 U.S.C. § 409(9); Opinion & Order, *supra* note 470, at 11-12.

488 *Id*. at 10.

489 *Id*.

490 *Id*. at 15.

491 *See generally* Waen Vejjajiva, *Courts Offer Further Insight on Video Games, Tattoos, and Copyright Infringement*, JD SUPRA (Feb. 2, 2024), https://www.jdsupra.com/legalnews/courts-offer-further-insight-on-video-8687670/#:~:text=In%20late%20January%202024%2C%20an,video%20game%2C%20NBA%202K%20series.

492 Redacted - Hearing on Motion for Preliminary Injunction at 3, Whitmill v. Warner Bros. Ent. Inc., 2011 WL 11819138 (E.D. Mo. 2011) (No. 4:11-CV-752).

493 Response of the Register of Copyrights to Request Pursuant to 17 U.S.C. § 411(b)(2), at 2, Hayden v. 2K Games, Inc., No. 1:17CV0635 (N.D. Ohio Aug. 8, 2023), ECF No. 231-1.

494 17 U.S.C. § 102(a).

are original forms of artwork designed by a tattoo artist.[495] These original pieces of artwork generally contain a "modicum of creativity" or "intellectual production, of thought, and conception" as they are drawings by the individual artist.[496] Clearly, those pieces of artwork are more than likely copyrightable, assuming they meet that creativity element, right?

At the center of the debate is not the art but the medium.[497] A work is "fixed in any tangible medium" when it "is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration."[498] These original pieces of artwork are applied to the client's skin.[499] Many argue that the skin cannot qualify as a "fixed . . . tangible medium" because it "ages and changes."[500] This theory is flawed because the aging of a medium does not mean that it exists for only a "transitory duration."[501]

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495 Shanty Town Design, *The Custom Tattoo Process vs. Walk in Flash Tattoos*, CRIMSON HILT TATTOO (Dec. 4, 2017), https://crimsonhilttattoo.com/custom-tattoo-process-vs-walk-flash-tattoos/.

496 Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 340, 347 (1991).

497 *See, e.g.* Shreya Sampathkumar, *A U. S. Perspective on Copyrightability of Tattoos*, IP MATTERS (Feb. 25, 2022), https://www.theipmatters.com/post/a-u-s-perspective-on-copyrightability-of-tattoos#:~:text=The%20very%20fact%20that%20human,the%20necessary%20degree%20of%20originality (opining, based on a plain reading of the Copyright Act, that the "human body certainly qualifies as a means of artistic expression"); Chandel Boozer, Comment, *When the Ink Dries, Whose Tatt Is it Anyway? The Copyrightability of Tattoos of Tattoos*, 25 JEFFREY S. MOORAD SPORTS L.J. 275, 281 (2018) ("An argument supporting why contemporaneously placed and preliminarily-sketched tattoos meet the fixed requirement is that the work in which the medium is fixed is unessential to the analysis of fixation because the Copyright Act's language intended to cover an extensive range of mediums."); *Tattoos, Copyright Law, and the Doctrine of Fair Use, Milgrom & Daskam*: Blog, MILGROM & DASKAM (June 13, 2021), https://www.milgromlaw.com/blog/tattoos-copyright-law-and-the-doctrine-of-fair-use/ ("Under this statute, tattoos are copyrightable works. Tattoos certainly fall under original works of authorship, specifically pictorial works. And, as my grandmother will tell you, tattoos are permanent marks on a body and therefore 'fixed' in a tangible medium."); *but see* Rute Franco, *Copyright for tattoo artists: Protecting artistic expression*, INVENTA (Nov. 3, 2023), https://inventa.com/en/news/article/919/copyright-for-tattoo-artists-protecting-artistic-expression ("While tattoos are certainly original creations, they are often seen as applied directly to the body, making them a transient and inherently difficult medium to protect under traditional copyright law."); John Mixon, *Fixation on Flesh: Why Tattoos Should Not Garner Copyright Protection*, 30 N.Y. ST. BAR ASS'N ENT., ARTS & SPORTS L.J. 25, 27 (2019) ("[W]hen a tattooist's original work of authorship is subsequently transferred onto human flesh, it fails to satisfy the requirement that the work be 'fixed in a tangible medium,' and thus tattoos are not copyrightable."); Emilie Smith, *Game On—Copyrighted Tattoos in Video Games as Fair Use*, 106 MARQ. L. REV. 1015, 1026-27 (2023) (noting that "[t]he only arguable point of contention is whether tattoos are indeed fixed in a tangible medium of expression, the argument being that, as skin ages and changes, the tattoo alters along with it.").

498 17 U.S.C. § 101.

499 Aaron K. Perzanowski, *Tattoos & IP Norms*, 98 MINN. L. REV. 9511, 525 (2012).

500 Emilie Smith, *Game On—Copyrighted Tattoos in Video Games as Fair Use*, 106 MARQ. L. REV. 1015, 1026-27 (2023).

501 17 U.S.C. § 101; Mayo Clinic Staff, *Tattoos: Understand Risks and Precautions*, MAYO CLINIC (Feb. 25, 2022), https://www.mayoclinic.org/healthy-lifestyle/adult-health/in-depth/tattoos-and-piercings/art-20045067#:~:text=A%20tattoo%20is%20a%20permanent,needles%20piercing%20the%20skin%20repeatedly; *see also* Perzanowski, *supra* note 499, at 525 ("A tattoo, like any other

The skin is a "tangible medium" because it is a "permanent mark" affixed to the client and allows for the art to be seen by people for as long as the person is alive and after.[502] Therefore, a tattoo would be subject to copyright protections as it meets the requirements set out in 17 U.S.C. § 102.[503]

V. TATTOO ARTISTS GRANT IMPLIED LICENSES WHEN TATTOOS ARE APPLIED TO THE SKIN OF A CLIENT

As stated in Part II.B, an implied license is created when "(1) a person (the licensee) requests the creation of a work, (2) the creator (the licensor) makes that particular work and delivers it to the licensee who requested it, and (3) the licensor intends that the licensee-requestor copy and distribute his work."[504] Unlike an exclusive license, a non-exclusive license can be implied by the parties' conduct.[505] When an individual requests a tattoo, it is either flash or custom.[506] When the request is for flash, the tattooist copies an image onto stencil paper, transfers it onto the client's skin, and then traces the lines.[507] This artwork is typically not designed by the tattooist who is inking the client's skin.[508] However, it is entirely different when a client wants a custom tattoo.

Usually, when clients want a custom tattoo, they request a tattoo artist to design the artwork and apply it to their skin.[509] This is often a collaborative event.[510] The client will tell the tattoo artist what they are looking for and sometimes provide inspirational photos so the tattoo artist understands the style they are seeking.[511] Therefore, element one is met once the client has requested the tattoo design from the tattoo artist.[512] Once the client has approved the tattoo design, the tattoo artist uses a tattoo gun to apply the

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original work fixed in a tangible medium, is protected by copyright law."); *but see* Declaration of David Nimmer at 4, Whitmill v. Warner Bros. Ent., Inc., 2011 WL 10744102 (May 20, 2011) (No. 411-cv-752) ("I concluded that a body, even as augmented, simply is not subject to copyright protection.").

502 *Id*.

503 17 U.S.C. § 102.

504 I.A.E., Inc. v. Shaver, 74 F.3d 768, 776 (7th Cir. 1996).

505 *Id*. at 775.

506 *See generally* Shanty Town Design, *The Custom Tattoo Process vs. Walk in Flash Tattoos*, CRIMSON HILT TATTOO (Dec. 4, 2017), https://crimsonhilttattoo.com/custom-tattoo-process-vs-walk-flash-tattoos/.

507 *See id*.

508 *Id*.

509 *Id*.

510 *See generally id*.

511 *See id*.

512 I.A.E., Inc. v. Shaver, 74 F.3d 768, 776 (7th Cir. 1996).

artwork to the client's skin in the location that they have requested.[513] This process would constitute delivery of the "particular work" described in element two.[514]

Where it gets murky is the third element.[515] The court in *Alexander* noted that one of the ways the intent of the tattoo artist could "be proven [was] by objective evidence . . . through evidence of industry standard and custom."[516] Rarely do tattoo artists and their clients discuss the scope of the rights the client has in the tattoo after it has been affixed to their skin.[517] Because an implied license can be oral or implied, it can sometimes be challenging to determine the intent of the tattoo artist.[518] It is unclear how often tattoo artists discuss their copyright interests in the tattoos they design and apply with the clients who wear their work.[519] It seems that most of the time, the conversation regarding rights and licenses only pops up when an already well-known celebrity is receiving a tattoo.[520]

Alexander, the tattoo artist and plaintiff in the *Alexander v. Take-Two* case mentioned earlier, noted that it was common sense that a client would leave the shop, exposing their tattoos public view.[521] She also noted that it would be common for any client to appear in photographs and film or television as themselves with the tattoos showing.[522] However, what crossed the line for her was the recreation of Randy Orton, complete with the Tattoos, as an avatar in a video game.[523] Victor Whitmill, Mike Tyson's tattoo artist who created his famous face tattoo, had Tyson sign a document acknowledging that all of the rights belonged to Whitmill.[524]

However, some tattoo artists are generally fine with their work appearing in all sorts of media.[525] The tattoo artists who designed and applied the tattoos at issue in *Solid Oak Sketches, LLC v. 2K Games, Inc.* knew that

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513 Shanty Town Design, *The Custom Tattoo Process vs. Walk in Flash Tattoos*, CRIMSON HILT TATTOO (Dec. 4, 2017), https://crimsonhilttattoo.com/custom-tattoo-process-vs-walk-flash-tattoos/.

514 *I.A.E., Inc*., 74 F.3d at 776.

515 Transcript of Jury Trial Proceedings, *supra* note 70, Day 4 of 5 at 17.

516 *Id*.

517 *See* Perzanowski, *supra* note 499, at 525.

518 Transcript of Jury Trial Proceedings, *supra* note 70, Day 4 of 5 at 180.

519 *Id*. at 17 (expert witnesses survey of eight tattoo artists not enough to determine industry custom).

520 *See, e.g.* Whitmill v. Warner Bros. Ent. Inc., No. 4:11-cv-00752 (2011) (finding that Whitmill had Mike Tyson sign a waiver releasing rights to famous face tattoo).

521 Telephone Interview with Catherine Alexander, *supra* note 314, at January 19, 2023, 2:00 PM; Transcript of Jury Trial Proceedings, *supra* note 70, Day 2 of 5 at 127.

522 Telephone Interview with Catherine Alexander, *supra* note 314, at January 19, 2023, 2:00 PM; Transcript of Jury Trial Proceedings, *supra* note 70, Day 2 of 5 at 140.

523 Transcript of Jury Trial Proceedings, *supra* note 70, Day 2 of 5 at 142.

524 Matthew Belloni, *Mike Tyson Tattoo Artist Sues Warner Bros. to Stop Release of 'Hangover 2'*, HOLLYWOOD REP. (Apr. 29, 2011, 11:42 AM), https://www.hollywoodreporter.com/business/business-news/mike-tyson-tattoo-artist-sues-183716/.

525 Solid Oak Sketches, LLC v. 2K Games, Inc., 449 F. Supp. 3d 333, 340-41 (S.D.N.Y. 2020).

the NBA athletes would appear in different forms of media and were fine with that.[526] Justin Wright, the tattoo artist who designed the "Child Portrait" tattoo and applied it to Lebron James, said he intended to have the tattoo become part of Lebron's likeness.[527] Deshawn Morris and Shawn Rome indicated the same intentions, with their respective tattoos applied to Lebron James.[528] Similar statements were noted by Ray Cornett in *Solid Oaks* regarding tattoos he applied to Kenyon Martin and Eric Bledsoe.[529]

Although there is not a clear industry standard specifically regarding the athlete's likeness, tattoos, and implied licenses to grant to third parties a license to use the athlete's likeness, Aaron K. Perzanowski, an Associate Professor at Case Western, noted that "[b]oth during and after the design process, tattooers consistently demonstrate a respect for client autonomy."[530] One of Perzanowski's interview subjects even declared that they rarely see the custom tattoos they work on as their artwork since they are almost always commissioned to design what the client wants.[531] Most research done on the views of the tattoo artist indicates that the artist is respectful of the client's bodily autonomy and design preferences and allows the client to have the last say on the artwork.[532] Therefore, it can be argued that there is nearly always an implied license in a tattoo with authorized uses relating to the client's likeness and ability to license that likeness.[533]

VI. RECOMMENDED SOLUTION

In the previously discussed cases, there are differences in the outcomes due to extenuating circumstances, such as pieces of evidence that are not present in other cases,[534] as well as the procedural posture of the case.[535] Put simply, issues regarding how much of the tattoo can be seen in the game and how detailed the copying is tend to decide the case.[536] One way to avoid such

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526 *Id*.

527 *Id*. at 340.

528 *Id*. at 340-41.

529 *Id*. at 341.

530 Perzanowski, *supra* note 499, at 532.

531 *Id*. at 535.

532 *See, e.g. id*.

533 Aaron Moss, *Tattoo Artist's Trial Win is a Loss for Bodily Autonomy, Free Speech*, COPYRIGHT LATELY (Oct. 2, 2022), https://copyrightlately.com/tattoo-artist-trial-victory-copyright-lawsuit/.

534 *See* Solid Oak Sketches, LLC v. 2K Games, Inc., 449 F. Supp. 3d 333 (S.D.N.Y. 2020) (explaining that the infringing work was so small that users were unlikely to see or notice it); *but see* Alexander v. Take-Two Interactive Software, Inc., No. 3:18-CV-00966 (7th Cir. Sep. 30, 2022) (noting that the infringing work showed close-ups of the Tattoos and even included a feature allowing the user to apply the Tattoos onto avatars that were not the Orton avatar).

535 *See, e.g.*, *Solid Oak Sketches, LLC*, 449 F. Supp. 3d at 333 (granting summary judgment in favor of the defendants); *Alexander*, No. 3:18-CV-00966 (jury finding in favor of the plaintiff); Whitmill v. Warner Bros. Ent. Inc., No. 4:11-CV-00752 (E.D. Mo. Apr. 28, 2011) (parties settled out of court).

536 *See generally Solid Oak Sketches, LLC*, 449 F. Supp. 3d at 333.

an uncertain outcome is to standardize contractual obligations for all parties that set reasonable expectations for licensing.[537] This seems to be the most logical resolution to this problem. However, there may also be some general standards that can be inserted into the tattooing community and entertainment industry to set specific and clear expectations regarding inked artwork so that artists can protect themselves from the copyrights of other artists when they copy artwork from different media.[538] If these solutions do not work, Title 17 may need an additional category or section to address creative works that interfere with an individual's ability to license their likeness.

Standardized contractual obligations are not a new invention; indeed, many different industries have employed standardized language within agreements, and even standardized agreements, to properly set expectations for the parties to the agreements.[539] On the tattooing issue specifically, at least one college athlete—Mississippi State Wide Receiver Jordan Mosley—utilized a contractual agreement for his tattoos that was beneficial to both the athlete and the tattoo artist.[540] Although this student believes that this would be something unique to college sports, that is an unnecessary limitation.[541] As tattoos become more popular, the copyrights within the works of authorship must be protected.[542] However, not all tattoos that an artist applies to the human skin will qualify.[543] Tattoo artists must know about their rights and how to protect their work if they wish to avail themselves of those protections.[544] Standardized contracts and clauses would contain specific language explaining the artist's rights regarding the creative work.[545] The language would also delineate the tattoo recipients' rights regarding their

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537 *See generally* Johnathan Roffe, *What to Consider When Negotiating License Agreements*, CLARK HILL (Aug. 15, 2023), https://www.clarkhill.com/news-events/news/what-to-consider-when-negotiating-license-agreements/.

538 *See, e.g.*, Sedlik v. Drachenberg, 2022 WL 2784818, at *7-*11 (C.D. Cal. May 31, 2022).

539 *See generally* Electra Japonas, *Why we Should be Using Standardized Contracts*, CONT. NERDS (Sept. 29, 2021), https://contractnerds.com/standardized-contracts/.

540 *See* Crissy Froyd, *Mississippi State WR Jordan Mosley Strikes NIL Deal with Tattoo Artist*, SPORTS ILLUSTRATED (Aug. 15, 2022, 9:44 AM), https://www.si.com/college/mississippistate/football/mississippi-state-wr-jordan-mosley-strikes-nil-deal-with-tattoo-company; Amanda Christovich, *Mississippi State WR Reportedly 1st to Ink NIL Deal with Tattoo Artist*, FRONT OFF. SPORTS (Feb. 20, 2023, 12:38 AM), https://frontofficesports.com/mississippi-state-wr-reportedly-1st-to-ink-nil-deal-with-tattoo-artist/.

541 *See* Crissy Froyd, *Mississippi State WR Jordan Mosley Strikes NIL Deal with Tattoo Artist*, SPORTS ILLUSTRATED (Aug. 15, 2022, 9:44 AM), https://www.si.com/college/mississippistate/football/mississippi-state-wr-jordan-mosley-strikes-nil-deal-with-tattoo-company.

542 *Are tattoos protected by copyright*?, COPYRIGHT ALL., https://copyrightalliance.org/education/qa-headlines/tattoos-copyright/#:~:text=Yes%2C%20tattoos%20can%20be%20protected,physical%20object%20and%20display%20originality (last visited Feb. 9, 2024).

543 *See* 17 U.S.C. § 102.

544 Telephone Interview with Catherine Alexander, *supra* note 314, at Jan. 19, 2023, 2:00 PM.

545 *Dos and Donts of License Agreements*, WAR IP L. PLLC, https://wariplaw.com/dos-and-donts-when-it-comes-to-licensing-agreements/ (last visited Feb. 9, 2024).

likeness, as well as what artwork a tattoo artist can ink on their client's skin without being liable for copyright infringement.[546]

The tattoo industry itself, much like Ms. Alexander, may need to become more assertive in protecting their works. Tattoo artists, as discussed above, are a part of their communities that have their informal customs regarding each other's work.[547] It is not common practice to utilize full-on written agreements in a tattoo shop.[548] The tattoo shop typically provides the client with a waiver that asks about their medical history, which the client must sign.[549] This is a requirement for all tattoo shops.[550] Tattoo shops also take photocopies of the client's driver's license to prove the client is at (or above) the age of maturity.[551] This is for liability purposes to protect the tattoo artist and the shop they are employed by.[552] For the same reason, it makes sense to add an agreement regarding intellectual property rights—limitation of liability.[553] An agreement between the client and the tattoo artist would provide clear expectations between both parties regarding ownership of the artwork.[554]

Waivers are already used by some entertainment companies in the United States, so it would not be a problem to add one more.[555] It would only be a small portion of a larger company's day-to-day expenses to incorporate a standard waiver stating specific kinds of uses for media and publicity in which an artist's work can be used.[556] In the case of a more prominent company interested in utilizing a tattoo artist's work, strong-arming a small

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546 *See generally* Sedlik v. Drachenberg, 2022 WL 2784818 (C.D. Cal. May 31, 2022).

547 Telephone Interview with Catherine Alexander, *supra* note 314, at Jan. 19, 2023, 2:00 PM.

548 *Id*.

549 *Id*.

550 *Id*.

551 *Id*.

552 *Id*.

553 Telephone Interview with Catherine Alexander, *supra* note 314, at Jan. 19, 2023, 2:00 PM.

554 *See, e.g. Copyright and Intellectual Property Toolkit*, UNIV. PITTSBURGH LIBR. SYS. (Sept. 13, 2023, 1:00 PM), https://pitt.libguides.com/copyright/authorrights (detailing what is usually included in a licensing agreement).

555 *See generally 2021 Waiver for Influencer-Produced Sponsored Content*, SAG AFTRA, https://www.sagaftra.org/files/SAG-AFTRA2021WaiverforInfluencer-ProducedSponsoredContent.pdf (last visited Feb. 9, 2024); *Business Liability Waiver 101—All You Need to Know to Protect Your Business*, NEXT INS. (Nov. 22, 2019), https://www.nextinsurance.com/blog/business-liability-waiver/ ("Entertainment and event companies may use a standard business waiver for participation in an event or activity as a condition of allowing admission to or participation in any activity that could result in an injury. Athletic events, paintball tournaments, and some sports leagues require this type of liability waiver form.").

556 *See, e.g., Business Liability Waiver 101—All You Need to Know to Protect Your Business*, NEXT INS. (Nov. 22, 2019), https://www.nextinsurance.com/blog/business-liability-waiver/ ("General liability insurance covers losses due to bodily injury, personal and advertising injury, and property damage. A signed liability waiver form shifts the legal responsibility away from a business owner or company, but it doesn't completely remove that responsibility.").

business owner will not gain any favor with the community at large.[557] These waivers could contain similar clauses to the ones set out above for the artists.

There have already been some instances where an artist has insisted on a celebrity signing a waiver that acknowledges that the tattoo artist has exclusive rights in the design of the tattoo.[558] Victor Whitmill had Mike Tyson sign a waiver acknowledging the rights in the famous face tattoo at issue in *Whitmill v. Warner Bros. Entertainment LLC* belonged to Whitmill.[559] The waiver that Whitmill had Mike Tyson sign likely would have protected the artist's exclusive right in the artwork tattooed onto Tyson had the case proceeded to trial.[560] The court in *Whitmill* mentioned, "[T]here was a strong likelihood . . . [the] studio could be liable for copyright infringement in its recreation of Tyson's tattoo without first obtaining Whitmill's permission or consent."[561] Tattoo artists should take note of this. Such language could resemble the following:

A. [SAMPLE] Custom Tattoo Licensing Agreement

[SAMPLE] Custom Artwork Agreement[562]

This CUSTOM ARTWORK AGREEMENT (the "Agreement"), effective on [DATE] (the "Effective Date"), is made by and between [TATTOO ARTIST NAME] ("Artist") and _____ [NAME OF CLIENT(S)] ("Client(s)").

WHEREAS, Artist is the sole owner of _____ [NAME OF TATTOO] (the "Tattoo") (as described below) and wishes to grant Client(s) a non-exclusive, non-transferable license to the Tattoo, and Client(s) wish to obtain a non-exclusive, non-transferable license to the Tattoo for uses described herein, subject to the terms and conditions set forth herein.

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557 Telephone Interview with Catherine Alexander, *supra* note 314, at Jan. 19, 2023, 2:00 PM.

558 Complaint at 1, Whitmill v. Warner Bros. Ent. Inc., No. 4:11-cv-00752 (2011), available at http://blog.legalsolutions.thomsonreuters.com/wp-content/uploads/2011/05/Complaint-Whitmill-v-Warner-Bros.pdf.

559 *Id*.*; see also* Mark Litwak, *The Hangover II: Tyson Tattoo Copyright Infringement Suit*, MARK LITWAK & ASSOCS., https://www.marklitwak.com/the-hangover-ii-tyson-tattoo-copyright-infringement-suit.html (last visited Feb. 9, 2024).

560 Mark Litwak, *The Hangover II: Tyson Tattoo Copyright Infringement Suit*, MARK LITWAK & ASSOCS., https://www.marklitwak.com/the-hangover-ii-tyson-tattoo-copyright-infringement-suit.html (last visited Feb. 9, 2024).

561 *Id*.

562 Modeled after template licensing agreement found at: *Copyright License Agreement (Pro-Licensor*), WESTLAW PRACTICAL LAW, https://1.next.westlaw.com/Document/I9d2bcd9a311411e798dc8b09b4f043e0/View/FullText.html?originationContext=document&transitionType=DocumentItem&ppcid=fa063a81ce1d4ebe9600ca77870a1626&contextData=(sc.Search)&view=hidealldraftingnotes (last visited Feb. 9, 2024).

Client(s) understand that use of the Tattoo is limited to the following, and can be revoked at any time by Artist:

I. Use of Client(s)'s likeness in:
   1. Photographs of Client(s) with the Tattoo visible taken for any purpose;
   2. Appearance of Client(s) with the Tattoo visible in television and/or film;
   3. Recreation of Client(s)'s likeness for use in [CHECK ALL BOXES THAT APPLY]:
      - ☐ Artwork
      - ☐ Video Games
      - ☐ Television
      - ☐ Films
      - ☐ Internet

Client(s) understand that any unauthorized derivative use of the Tattoo is subject to legal action by Artist.

I, _____ [PRINTED NAME OF CLIENT(S)], the undersigned, agree to the terms set out above.

SIGNATURE(S):

_____

Client Date

B. [SAMPLE] Assignment and Waiver of Rights

[SAMPLE] Assignment Agreement[563]

This ASSIGNMENT AGREEMENT (the "Agreement"), effective on _____ [DATE] (the "Effective Date"), is made by and between _____ [NAME OF TATTOO ARTIST] ("Tattoo Artist") and _____ [NAME OF CLIENT(S)] ("Client").

WHEREAS, Tattoo Artist and Client willingly enter into an Assignment Agreement ("Agreement") per the terms detailed below regarding the [NAME OF TATTOO(S)] (the "Tattoo(s)"), tattooed upon Client located on _____ [LOCATION OF TATTOO(S)].

Tattoo Artist hereby irrevocably conveys, transfers, and assigns to Client all of Tattoo Artist's rights, title, and interest in and to the Tattoos.

This Assignment shall be binding upon any and all successors and assigns.

Tattoo Artist understands that any unauthorized use of the Tattoos after the Execution Date is subject to legal action by Client.

I, _____ [PRINTED NAME OF TATTOO ARTIST], the undersigned, agree to the terms set out above.

SIGNATURE(S):

_____ _____
Client Date

_____ _____
Tattoo Artist Date

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563 *See generally Intellectual Property Assignment Agreement (Short Form),* WESTLAW PRACTICAL LAW, https://1.next.westlaw.com/Document/I0f9fbf11ef0811e28578f7ccc38dcbee/View/FullText.html?navigationPath=Search%2Fv1%2Fresults%2Fnavigation%2Fi0ad74037000001867043e165223cc714%3Fppcid%3D522c10ae95c2480694c9ed58564ba620%26Nav%3DKNOWHOW%26fragmentIdentifier%3DI0f9fbf11ef0811e28578f7ccc38dcbee%26parentRank%3D0%26startIndex%3D1%26contextData%3D%2528sc.Search%2529%26transitionType%3DSearchItem&listSource=Search&listPageSource=44c6aaf074a4ecd42ed9b1e2a40b577e&list=KNOWHOW&rank=3&sessionScopeId=ae97a8f19333602c50328fa2f6431c42c3b1420340e29389f00937095014ef07&ppcid=522c10ae95c2480694c9ed58564ba620&originationContext=Search%20Result&transitionType=SearchItem&contextData=(sc.Search)&navId=D91F814ADC63D66731A69FD647F9AB92&view=hidealldraftingnotes (last visited Feb. 9, 2024).

VII. CONCLUSION

As tattoos become more mainstream, legal issues regarding the intellectual property rights associated with the underlying artwork will arise more frequently and will become more hotly litigated.[564] For that reason, it will be necessary for some tattoo industry customs to change. Tattoos create a unique legal intersection between an individual's right to bodily autonomy and the artist's copyrights.[565] There seems to be a simple solution to this growing problem. Waivers and licensing agreements between tattoo artists, clients, or entertainment companies would help clarify rights and reduce litigation risk—something beneficial to all sides. These waivers and agreements can be standardized to the point that the paperwork a client fills out before receiving a tattoo includes a form detailing everyone's rights to the artwork. Some rights seem to be given to a tattoo client through an implied license, which is arguably common in the tattoo industry.[566] Tattoo artists surely are aware that all tattoo clients, be they celebrities or not, will have their pictures taken. Tattoo artists generally cannot have a problem with this, as they must realize that the artwork essentially becomes tied to the client's identity; however, standardized agreements between all parties can help clarify these expectations and provide order in a manner that reduces litigation risk and expense to all parties involved.[567]

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564 *See generally* Aaron Moss, *Tattoo Artist's Trial Win is a Loss for Bodily Autonomy, Free Speech*, COPYRIGHT LATELY (Oct. 2, 2022), https://copyrightlately.com/tattoo-artist-trial-victory-copyright-lawsuit/.

565 *See generally* Perzanowski, *supra* note 499, at 511.

566 *See generally* David Sussman & Kara Brandeisky, *Implied Copyright License Defense Shapes Up In Tattoo Cases*, L. 360 (Mar. 12, 2021, 4:09 PM), https://www.jenner.com/a/web/4mxSM4Ju5RjEHiB8tYDbth/4HRMZQ/Sussman%2520Brandeisky%2520Law360%2520March%252012%25202021.pdf?1615913388.

567 *See generally* Johnathan Roffe, *What to Consider When Negotiating License Agreements*, CLARK HILL (Aug. 15, 2023), https://www.clarkhill.com/news-events/news/what-to-consider-when-negotiating-license-agreements/.

DEEPFAKES UNDER COPYRIGHT LAW—A NECESSARY LEGAL INNOVATION

Scott Lu[1]

I. INTRODUCTION

From de-aging Mark Hamil into a younger Luke Skywalker in *The Mandalorian* to allowing David Beckham to spread his message across nine different languages in his Malaria No More Campaign video, a form of artificial intelligence (AI) known as "deepfakes" are continually revolutionizing the way technology is used in society today.[2] The best AI models can create realistic deepfake portraits of people who do not exist or even replicate public figures doing fictional things.[3] For instance, the Dalí Museum in St Petersburg, Florida, used a deepfake to "bring back to life" artist Salvador Dalí in an interactive exhibit.[4] The exhibit used the deepfake of Dalí to recite quotes, and it could even take selfies with visitors.[5]

Deepfake technology is a ground-breaking development with limitless possibilities and beneficial uses. Its unique placement in the health sector is used to train artificial intelligence to detect tumors[6] and has brought art "to life" in the cultural and entertainment industry.[7] While its many uses have advanced society, deepfakes have also been a bedrock for litigation because the technology can be used maliciously to merge celebrities' likenesses for pornography[8] or for fraudulent purposes, such as impersonating a CEO to wire money.[9] Under current legislation, deepfakes pose a complicated legal

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[2] Kelsey Warner, *How Deepfakes Are Blurring the Lines in Art and Film*, NATIONAL US: WEEKEND (June 24, 2022), https://www.thenationalnews.com/weekend/2022/06/24/how-deepfakes-are-blurring-the-lines-in-art-and-film/.

[3] *Id*.

[4] Rima Sabina Aouf, *Museum Creates Deepfake Salvador Dalí to Greet Visitors*, DEZEEN (May 24, 2019), https://www.dezeen.com/2019/05/24/salvador-dali-deepfake-dali-musuem-florida/.

[5] *Id*.

[6] Jackie Snow, *Deepfakes for Hood: Why Researchers Are Using AI to Fake Health Data*, FAST COMPANY (Sept. 24, 2018), https://www.fastcompany.com/90240746/deepfakes-for-good-why-researchers-are-using-ai-forsynthetic-health-data.

[7] Dawson Camilleri, *Combining Art with AI*, MEDIUM (Apr. 8, 2022), https://medium.com/new-writers-welcome/combining-art-with-ai-66f758e311b3.

[8] Mika Westerlund, *The Emergence of Deepfake Technology: A Review*, 9 TECH. INNOVATION MGMT. REV. 39, 43 (2019).

[9] Rik Ferguson, *Weaponized Deepfakes Are Getting Closer to Reality*, TREND MICRO (Apr. 28, 2021), https://www.trendmicro.com/en_us/research/21/d/deepfakes-are-getting-closer-to-reality.html.

issue: There is not a perfect vehicle for deepfakes to be classified under. However, scholars contend that its most appropriate placement is within copyright law.[10] Yet, the current landscape of United States copyright law is riddled with uncertainty.[11] Copyright law in the United States is ripe for reform that specifically amends the Copyright Act of 1976 to include rights for operators of artificial intelligence, such as deepfakes, especially considering the recent proliferation of AI.[12] Part II of this Note offers background on the development of deepfake software and the current issues revolving around the Black Box Problem. Part III highlights the potential conflicts that this technology creates under current copyright law. Finally, in Part IV, this Note argues that the best way to address the current issues is to grant the copyright to the individual who uses the AI to create the work.

II. WHAT IS DEEPFAKE SOFTWARE?

This section will examine and briefly explain what AI entails. Following a discussion on the use of AI in machine-learning algorithms, this Note will discuss the Black Box Problem, how it poses an issue for the future of AI, and how it fits into the law.

A. Artificial Intelligence

In their most basic nature, deepfakes use artificial intelligence to create images, videos, and audio.[13] This innovative and exciting technology begins with the use of generative adversarial networks (GANs).[14] This developmental process requires two networks: a generator and a discriminator.[15] The generator creates new synthesized data from a domain

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10 Umberto Bacchi, *Performing Artists Push for Copyright Protection for AI Deepfakes*, REUTERS (May 18, 2022, 2:26 PM), https://www.reuters.com/legal/litigation/performing-artists-push-copyright-protection-ai-deepfakes-2022-05-18/.

11 Neeraja Seshadri, *Implications of Deepfakes on Copyright Law*, WIPO (July 22, 2020), https://www.wipo.int/export/sites/www/about-ip/en/artificial_intelligence/conversation_ip_ai/pdf/ind_seshadri.pdf.

12 *See generally* Riddhi Setty, *Copyright Office Sets Sights on Artificial Intelligence in 2023*, BL (Dec. 29, 2022, 4:00 AM), https://news.bloomberglaw.com/ip-law/copyright-office-sets-sights-on-artificial-intelligence-in-2023 ("The US Copyright Office over the next year will focus on addressing legal gray areas that surround copyright protections and artificial intelligence, amid increasing concerns that IP policy is lagging behind technology.").

13 Kelsey Warner, *How Deepfakes Are Blurring the Lines in Art and Film*, NATIONAL US: WEEKEND (June 24, 2022), https://www.thenationalnews.com/weekend/2022/06/24/how-deepfakes-are-blurring-the-lines-in-art-and-film/.

14 Chris V. Nicholson, *A Beginner's Guide to Generative AI*, PATHMIND, https://wiki.pathmind.com/generative-adversarial-network-gan (last visited Mar. 30, 2024).

15 Jason Brownlee, *A Gentle Introduction to Generative Adversarial Networks (GANs)*, MACH. LEARNING MASTERY (July 19, 2019), https://machinelearningmastery.com/what-are-generative-adversarial-networks-gans/.

while the discriminator attempts to separate the domain data from the newly created synthesized data.[16] For example, the system might take photographs, input the data through an encoder that detects similarities between two distinct images, and then compress those shared features.[17] A decoder then takes these compressions and reconstructs the desired features onto the image selected.[18]

At its core, deepfake software is a machine learning artificial intelligence system.[19] Artificial intelligence are a class of computer programs designed to solve problems.[20] It does so by making inferences for uncertain or incomplete information based on existing knowledge.[21] Its determinations are made through various forms of perception and learning and application to problems, such as control, prediction, classification, and optimization.[22] These AI systems exhibit broad ranges of autonomy, intelligence, and dynamic ability to solve problems.[23] A good example of AI's flexibility can be shown in the game of chess. The main concept of AI involves moving beyond pre-programmed rules for computers, instead aiming to mimic human intelligence by analyzing data sets and learning from them.[24] An inflexible AI would evaluate possible moves and then select the best move based on a scoring formula—a predetermined set of values that collectively determine the "best play."[25] This approach relies on a rigid numerical value based on the limited data set of the individual game being played.[26] On the other hand, a flexible AI would examine countless other chess games to determine a move based on common patterns found in those games.[27] Unlike

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16 *Id*. ("[T]he generator model that we train to generate new examples, and the discriminator model that tries to classify examples as either real (from the domain) or fake (generated).").

17 Ian Sample, *What Are Deepfakes – and How Can You Spot Them?*, THE GUARDIAN (Jan. 13, 2020), https://www.theguardian.com/technology/2020/jan/13/what-are-deepfakes-and-how-can-you-spot-them.

18 *Id*.

19 Westerlund, *supra* note 8, at 40.

20 TOSHINORI MUNAKATA, FUNDAMENTALS OF THE NEW ARTIFICIAL INTELLIGENCE 1–2 (2d ed. 2008).

21 *Id*.

22 *Id*. (discussing that the difference between intelligent and non-intelligent computer programming requires more than solving a simple mechanical question, such as 2 + 2, but instead states that problems that require inferences based on missing information would constitute an "intelligent" system, such as $\sin^2 x\, e^{-x}$).

23 Yavar Bathaee, *The Artificial Intelligence Black Box and the Failure of Intent and Causation*, 31 HAR. J. L. & TECH. 889, 898 (2018).

24 *See generally* Atilla Kasap, *Copyright and Creative Artificial Intelligence (AI) Systems: A Twenty-First Century Approach to Authorship of AI-Generated Works in the United States*, 19 WAKE FOREST J. BUS. & INTELL. PROP. L. 335, 340 (2019) (describing AI that can perform tasks that usually require human intelligence); *id*. (describing the end goal for flexible AI).

25 *See generally id*.

26 *See generally id*.

27 *See* Dave Gershgorn, *Artificial Intelligence is Taking Computer Chess Beyond Brute Force*, POPULAR SCI. (Sept. 16, 2015, 1:07 PM), https://perma.cc/PYR4-7DW2 (showing the process of how an AI system selects the best move based on games played by masters' level, chess players).

inflexible AI, it possesses an extensive database of chess games it can scan to determine the best play.[28]

B. Machine-Learning Algorithms and the Black Box Problem

The type of AI relevant to deepfake software is one that is reliant on machine-learning algorithms.[29] Machine-learning algorithms, commonly referred to as "machine learning," have historically been used for statistical analysis in the physical and social sciences.[30] As such, these algorithms commonly make predictions through the categorization of data.[31] There are two major forms of machine learning: supervised and unsupervised.[32] Supervised machine learning takes known sets of data (input) and known responses of data (output) to generate reasonable predictions on new data.[33] For instance, this method is commonly employed to classify emails as either spam or genuine, or to distinguish between cancerous or benign tumors.[34]

In contrast, unsupervised machine learning detects hidden patterns or structures within data to draw inferences.[35] As an example, imagine a scenario where a cell phone company seeks to identify the most optimal locations for building cell towers to optimize signal strength for their customers. Because cell phones can only communicate with one cell phone tower at a time, AI programmers can combine data sets of their customers and "cluster" them together to determine the optimal tower triangulation.[36] Typically, one would want to use a supervised learning model to make simple predictions on continuous variables like stock price and temperature.[37] Conversely, unsupervised learning is preferable when training a model to separate data in the absence of a simple linear pattern.[38]

Relevant to the discussion on copyright is the Black Box Problem (BBP). BBP is integral to understand because in order for a work to be

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28 *See generally* Atilla Kasap, *Copyright and Creative Artificial Intelligence (AI) Systems: A Twenty-First Century Approach to Authorship of AI-Generated Works in the United States*, 19 WAKE FOREST J. BUS. & INTELL. PROP. L. 335, 340 (2019); Bathaee, *supra* note 23, at 898.

29 Westerlund, *supra* note 8, at 40.

30 Bathaee, *supra* note 23, at 899.

31 *Id*. at 900.

32 *What Is Machine Learning?*, MATHWORKS, https://www.mathworks.com/discovery/machine-learning.html#:~:text=Machine%20learning%20algorithms%20use%20computational,specialized%20form%20of%20machine%20learning (last visited Mar. 30, 2024).

33 *Id*.

34 *Id*.

35 *Id*.

36 *Id*.

37 *See generally id*.

38 *See generally What Is Machine Learning?*, MATHWORKS, https://www.mathworks.com/discovery/machine-learning.html#:~:text=Machine%20learning%20algorithms%20use%20computational,specialized%20form%20of%20machine%20learning (last visited Mar. 30, 2024).

copyrightable, it must be an original work of authorship[39] with a minimum level of creativity.[40] BBP is defined as the inability to fully understand and predict an AI's decision-making process, decisions, and inputs.[41] Essentially, programmers are able to read an AI's input and output but cannot directly inspect the internal algorithm to understand the process it uses to transform the input into the output.[42] For instance, the programmer can input a photo into a deepfake database and acquire an intended result but with no actual way to view or replicate how the AI created it.[43]

Examining the AI is integral to understanding copyright law because understanding the AI's decision-making process could potentially reveal any intent, if present, behind the machine's actions. However, "[b]lack-box models are models that are not easy to understand because their mathematical expression is neither straightforward nor easily representable in an understandable manner."[44] As such, under current copyright law, AI-created work is not copyrightable.

Artificial neural networks are the primary source of machine learning in AI systems.[45] Modeled after the human brain, artificial neural networks use hidden layers of nodes that process a given input and pass their output to other layers of nodes.[46] Neural networks consist of a myriad of nodes ranging from thousands or even millions.[47] Each node has a number assigned to it called a "weight."[48] When the network is active and processes a given input, no data will be passed on to the next node if the number is below a certain threshold value.[49] Simultaneously, if the number exceeds the threshold value, the node "fires" and gets sent to all the ongoing connections.[50] When training, the weights and thresholds are initially set to random values.[51] The data is then transmitted along to the bottom layer and progresses through further

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39 17 U.S.C.A. § 102(a).

40 Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., Inc., 499 U.S. 340, 362 (1991).

41 Bathaee, *supra* note 23, at 905.

42 Jose Maria Lopez & Minh Le, *Ever Heard of the AI Black Box Problem?*, WORDLINE (Jan. 1, 2021), https://worldline.com/en/home/knowledgehub/blog/2021/january/ever-heard-of-the-aI-black-box-problem.html.

43 *See generally id*. (describing the challenges of BBP in AI).

44 Alexandre de Streel et al., *Explaining the Black Box When Law Controls AI*, CERRE (2020), https://cerre.eu/wp-content/uploads/2020/03/issue_paper_explaining_the_black_box_when_law_controls_ai.pdf.

45 *See generally* Kassidy Kelly & Benjamin St. George, *Solving the AI black box problem through transparency*, TECHTARGET (Aug. 16, 2021), https://www.techtarget.com/searchenterpriseai/feature/How-to-solve-the-black-box-AI-problem-through-transparency ("Currently, most AI tools are underpinned by neural networks, which are hard to decipher.").

46 Larry Hardesty, *Explained: Neural networks*, MIT: NEWS (Apr. 14, 2017), https://news.mit.edu/2017/explained-neural-networks-deep-learning-0414.

47 *Id*.

48 *Id*.

49 *Id*.

50 *Id*.

51 *Id*.

layers, multiplying in complex ways until it arrives at the output layer.[52] Through this process, AI learns on its own by processing data that allows it to recognize certain patterns.[53] The issue arises not only because the process is infinitely complicated when more nodes are used, but also because programmers can only observe the final result and are unable to view the output between the layers.[54] This makes it increasingly difficult to comprehend the AI's decision-making, which affects the copyrightability of the work.

Even if the programmer were able to reverse engineer the AI in order to read the code, the programmer is unlikely to understand the code itself.[55] Rather, it is easy to understand the mechanics behind how the hardware of a computing system is constructed, the actual software can still be unintelligible.[56] Consider the philosophical theory proposed by Gilbert Ryle in his paper titled *Knowing How and Knowing That*.[57] Ryle's theory proposes that there is a clear distinction between learning how to do something as opposed to simply knowing how.[58] For example, one can describe the process of riding a bike, even one riddled with descriptive and detailed steps; however, this is unlikely to assist another in balancing the wheels.[59] In contrast, one learns to ride a bike by developing an intuitive understanding through trial and error.[60] Essentially, the programmer can easily understand the input and output.[61] However, because of the complexity of the neural networks, simple trial and error will never be able to generate or replicate the process AI used to achieve its intended result.[62] This is true even if the programmer understands the process of machine learning.[63]

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52 Larry Hardesty, *Explained: Neural networks*, MIT: NEWS (Apr. 14, 2017), https://news.mit.edu/2017/explained-neural-networks-deep-learning-0414.

53 *Id*.

54 *See generally* Kassidy Kelly & Benjamin George, *Solving the AI black box problem through transparency*, TECHTARGET (Aug. 16, 2021), https://www.techtarget.com/searchenterpriseai/feature/How-to-solve-the-black-box-AI-problem-through-transparency ("The process inside the box, however, is mostly self-directed and is generally difficult for data scientists, programmers and users to interpret.").

55 *See* Bathaee, *supra* note 23, at 902 ("Strong black boxes . . . cannot even be analyzed ex post by reverse engineering the AI's outputs.").

56 Carlos Zednik, *Solving the Black Box Problem: A Normative Framework for Explainable Artificial Intelligence*, 34 PHIL. & TECH. 265, 268 (2021).

57 Stefan Brandt, *Ryle on knowing how: Some clarifications and corrections*, 29 EUR. J. PHILOS. 152, 153 (2021).

58 *See generally id*. at 156 ("[F]or Ryle[,] the distinction between knowing how to do something and knowing that something is the case is a distinction between two different types of ability and not between an ability, on the one hand, and some other kind of mental state on the other.").

59 Bathaee, *supra* note 23, at 902.

60 *Id*.

61 *See generally id*.

62 *See generally id*.

63 *See generally id*.

III. DEEPFAKES UNDER COPYRIGHT LAW

Before delving into the connection between deepfakes and copyright, it is imperative to establish a clear definition of copyright and delineate its qualifying criteria. Copyright is a form of intellectual property governed by the Copyright Act of 1976 (the "1976 Act") that gives the owner certain exclusive rights in their original, creative work.[64] These include, but are not limited to, the right to reproduce it, prepare derivative works, distribute it, and perform or display it publicly.[65] Copyright protects "original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device."[66] This means three requirements must be met to copyright a work: (1) the work must be fixed, (2) protected under the statute, and (3) qualify as a work of authorship.[67] The following sections of this Note will discuss how deepfakes, in their current state, relate to each element required to qualify for a copyright under the Copyright Act.

A. Fixation

Under the 1976 Act, a work is "fixed" if it is "sufficiently permanent or stable to permit it to be perceived, reproduced, or other communicated for a period of more than transitory duration.[68] Congress stated that it intended to include all forms of fixation: numbers, words, notes, pictures, sounds, graphics, or symbolic indicia, "whether embodied in a physical object in written, printed, photographic, sculptural, punched, magnetic, or any other stable form."[69] Deepfakes, as a form of software program, are copyrightable under the 1976 Act as a "literary work."[70] In addition, screen displays generated with computer programs are separately copyrightable as audiovisual works.[71] The fact that an individual needs a machine in order to view the work does not invalidate the fixation requirement.[72]

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64 17 U.S.C.A. § 102(a).
65 *Id*. at §§ 106(1)-(6).
66 *Id*. at § 102(a).
67 *Id*.
68 *Id*. at § 101.
69 H.R. REP. NO. 94-1476, at 52 (1976), *as reprinted in* 1976 U.S.C.C.A.N. 5659, 5665.
70 17 U.S.C.A. § 102(a)(1); *see also* Apple Computer, Inc. v. Franklin Computer Corp., 714 F. 2d 1240, 1248 (3d Cir. 1983) (citing Midway Mfg. Co. v. Strohon, 564 F. Supp. 741, 750-51 (N.D. Ill. 1983)) ("Thus a computer program, whether in object code or source code, is a 'literary work' and is protected from unauthorized copying, whether from its object or source code version.").
71 *See, e.g.*, Stern Elecs., Inc. v. Kaufman, 669 F. 2d 852, 855-56 (2d Cir. 1982).
72 *See id*.

The United States District Court for the District of Nebraska in *Midway Manufacturing Co. v. Dirkschneider* reasoned that, because the plaintiff's work was "fixed in printed circuit boards," the boards themselves were tangible objects, and the audiovisual works could be perceived for more than a transitory duration.[73] Following this approach, AI-generated works meet the fixation requirement since the works can be stored in a computer's memory, which can then be accessed and read using a computer.[74] Similarly, since deepfakes are created by AI systems—a computer program—the element of fixation is satisfied.[75] Furthermore, AI can create works that are similarly fixed in a tangible mediums of expression like a videos or photos, as set out under the 1976 Act.[76] Thus, either approach would satisfy the fixation requirement under the statute.[77]

B. Works of Authorship

Section 102 of the 1976 Act grants copyright protection to "original works of authorship."[78] However, the Act provides no definition for authorship.[79] To account for this discrepancy, the Supreme Court has carved out general rules pertaining to non-human works.[80] Generally, a work created by a non-human is not copyrightable because only humans can have "creative powers of the mind."[81] In addition, in *The Trade-Mark Cases*, the Court stated that only writings which "are the fruits of intellectual labor" that hinge upon some "work of the brain" are covered by copyright protection.[82]

Recently, in an attempt to resolve this issue, the Copyright Office established a human authorship requirement.[83] This requirement only extends to "original intellectual conceptions of the author."[84] Furthermore, the Copyright Office has stated that it will not register a copyright "for the works of a machine . . . that operates without any creative input or intervention from a human author."[85]

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73 Midway Mfg. Co. v. Dirkschneider, 543 F. Supp. 466, 480 (D. Neb. 1981).

74 Victor M. Palace, Note, *What if Artificial Intelligence Wrote This? Artificial Intelligence and Copyright Law*, 71 FLA. L. REV. 217, 233 (2019).

75 *See id.*

76 *See generally* 17 U.S.C.A. § 102(a).

77 *See id.*

78 *Id*.

79 Palace, *supra* note 74, at 227.

80 *See generally id*.

81 *In re* Trade-Mark Cases, 100 U.S. 82, 94 (1879); *see also* Naruto v. Slater, 888 F.3d 418, 426 (9th Cir. 2018).

82 *In re Trade-Mark Cases*, 100 U.S. at 94.

83 Palace, *supra* note 74, at 227.

84 Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 58 (1884).

85 U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 313.2 (3d ed. 2021), available at https://www.copyright.gov/comp3/docs/compendium.pdf.

However, the Copyright Office's current human authorship requirement states nothing about AI or, at the very least, the examples given are too broad or are currently in the works of being revised.[86] For instance, the Copyright Office will not register a copyright for a work that is the result of "a mechanical weaving progress that randomly produces irregular shapes in fabric without any discernible pattern."[87] As previously mentioned, deepfake software uses pattern recognition to create a work, but it is more than a random generation of shapes without a discernible pattern.[88]

Furthermore, the founding principles that the requirement relies upon state that copyright law is limited to the original contributions of the author and that the Copyright Office will refuse to register a claim if a human being did not create the work.[89] The Copyright Office's statement quotes language taken from two cases that are more than a century old.[90] The precedent relied upon these two cases predate the advent of computers and, as such, AI.[91] These cases provide little to no guidance on how the law applies to works created by AI and should not be relied upon as a foundation for the human authorship requirement.

On the other hand, the Copyright Office affords copyright protection to works created by humans with the assistance of computers, such as AI-powered word processors or templated creation of works, much like how non-fungible tokens (NFTs) are created.[92] In order for a work to be protected, it must be one of human authorship, with the machine merely existing as an "assisting instrument."[93] In other words, the individual or programmer must be the one to conceive and execute the work.[94] Nevertheless, with the increasing reliance and integration of AI, the line drawn between machine-created and human-created begins to blur.[95] Certainly, if a statistical analyst inputs numbers within an automated spreadsheet or an editor uses spell check

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86 *See generally* Palace, *supra* note 74, at 231.

87 U.S. COPYRIGHT OFFICE, *supra* note 85, at § 313.2.

88 *See generally* Catherine Bernaciak & Dominic A. Roxx, *How Easy Is It to Make and Detect a Deepfake?*, SOFTWARE ENG'G INST. (Mar. 14, 2022), https://insights.sei.cmu.edu/blog/how-easy-is-it-to-make-and-detect-a-deepfake/ (describing how deepfakes are created).

89 U.S. COPYRIGHT OFFICE, *supra* note 85, at § 306.

90 *Id*.

91 Palace, *supra* note 74, at 231.

92 Franklin Graves, *Sorry, Your NFT Is Worthless: The Copyright and Generative Art Problem for NFT Collections*, IPWATCHDOG (Feb. 20, 2022, 12:15 PM), https://ipwatchdog.com/2022/02/20/sorry-nft-worthless-copyright-generative-art-problem-nft-collections/id=146163/ (explaining that NFTs are often generated by an artist creating a base frame or outline and then layering attributes such as backgrounds, colors, or outfits, and then the computer software will combine the layers to create a larger collection of works autonomously).

93 Robert C. Denicola, *Ex Machina: Copyright Protection for Computer-Generated Works*, 69 RUTGERS U.L. REV. 251, 264-65 (2016) (citing U.S. COPYRIGHT OFFICE, SIXTY-EIGHTH ANNUAL REPORT OF THE REGISTER OF COPYRIGHTS FOR THE FISCAL YEAR ENDING JUNE 30, 1965 5 (1966)).

94 *See id*.

95 *See generally id*. at 269.

software for an original work, these would be protected under the current regime.[96] Two main concerns stem from deep learning machine algorithms, like deepfakes: (1) they are much more complicated than the simplified machinations of the past, and (2) some artificially created works are already indistinguishable from works of human authorship.[97]

C. Caselaw Support for the Human Authorship Requirement

A substantial amount of jurisprudence touches upon the foundations of copyright law, yet one recent case in particular touches upon the copyrightability of AI.[98] For example, in the *Trade-Mark Cases*, three trademark infringers challenged the constitutionality of the trademark statutes.[99] The U.S. Supreme Court ruled that the trademarks were not "writings" under the Patent and Copyright Clause or Commerce Clause.[100] The Court went on to further explain that "writings . . . are to be protected as the fruits of intellectual labor, embodied in . . . books [and] prints" and not protected under trademarks.[101] Essentially, the Court stated that providing trademark protections for written works was inappropriate because they were already covered by copyright.[102] The precedent, in the *Trade-Mark Cases*, serves little to no purpose as a foundation for the human authorship requirement.[103] Viewed in another light, a core component of the case revolved around originality for writings.[104] Applied to AI-created works, if the work passes the originality requirement as a book or print, then the work would be copyrightable.[105] Thus, the precedent set out in the *Trade-Mark Cases* is unsound.

The main proposition set out in *Burrow-Giles Lithographic Co. v. Sarony* was that copyright law was limited to "original intellectual conceptions of the author."[106] In that case, photographer Sarony sued lithographic company Burrow-Giles, alleging copyright infringement over

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96 *See generally id*.

97 *See generally* Annemarie Bridy, *Coding Creativity: Copyright and the Artificially Intelligent Author*, 5 STAN. TECH. L. REV. 1, 3 (2012).

98 *See generally* Complaint at 2, Thaler v. Perlmutter, No. 1:22-cv-01564, 2023 WL 5333236 (D.D.C. June 2, 2022).

99 *In re* Trade-Mark Cases, 100 U.S. 82, 94 (1879).

100 *Id*.

101 *Id*.

102 *See generally* Palace, *supra* note 74, at 229.

103 *See generally id*. at 231.

104 *See In re Trade-Mark Cases*, 100 U.S. at 93 ("And while the word writings may be liberally construed, as it has been, to include original designs for engravings, prints, &c., it is only such as are original, and are founded in the creative powers of the mind.").

105 *See generally id*.

106 Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 58 (1884).

Sarony's photograph of Oscar Wilde.[107] Burrow-Giles argued that because photographs merely reproduced people and objects, they were not "writings" nor created by an "author."[108] The U.S. Supreme Court rejected this notion and stated, "[W]ritings in that clause . . . meant the literary productions of those authors, and Congress very properly . . . declared these to include all forms of writing, printing, engravings, etchings, etc., by which the ideas in the mind of the author are given visible expression."[109] The Court further noted that the "Constitution is broad enough to cover an act authorizing copyright of photographs, so far as they are representatives of original intellectual conceptions of the author."[110]

One of the takeaways from *Burrow-Giles* regarding the copyrightability of an AI-created work is that the technology the Court deemed copyrightable was not expressly listed in the statute because it did not exist at the time the statute was created.[111] The Court determined that photographs could be distinguished from what was copyrightable at the time, like maps and charts, and were copyrightable.[112] The Court instructed that "writings" be interpreted in light of current technologies and practices.[113] Therefore, AI was not included in the 1976 Act simply because the technology did not exist at that time.[114] Thus, like the photographs in *Burrow-Giles*, works created by AI should be copyrightable as a current and evolving technology.[115]

While AI-created work should be copyrightable regardless of its absence under the non-exhaustive list provided under Section 102,[116] courts might be reluctant to uphold it. However, whether authorship applies to deepfake technology is arguable. On one hand, a deepfake is created by a machine, which might be unable to satisfy the authorship requirement.[117] Indeed, following *Naruto v. Slater* and *Trade-Mark Cases*, a deepfake would undoubtedly fail to qualify for a copyright, as a machine would be incapable of having a "creative power of the mind."[118] On the other hand, while the

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107 *Id*. at 54.

108 *Id*. at 56.

109 *Id*. at 58.

110 *Id*.

111 *Id*. ("The *only reason* why photographs were not included in the extended list in the act of 1802 is, probably, that they did not exist, as photography, as an art, was then unknown, and the scientific principle on which it rests, and the chemicals and machinery by which it is operated, have all been discovered long since that statute was enacted.").

112 Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 57 (1884); *see generally* Palace, *supra* note 74, at 230.

113 *See Burrow-Giles Lithographic Co*., 111 U.S. at 57; Fortnightly Corp. v. United Artists Television, Inc., 392 U.S. 390, 399 (1968).

114 *Burrow-Giles Lithographic Co*., 111 U.S. at 58.

115 Palace, *supra* note 74, at 231.

116 *See generally* 17 U.S.C.A. § 102(a).

117 *See* Naruto v. Slater, 888 F.3d 418, 426 (9th Cir. 2018) (determining that non-human authors do not have standing to bring copyright infringement claims).

118 *See id*.; *see also In re* Trade-Mark Cases, 100 U.S. 82, 94 (1879).

work is created by the machine itself, it is not without human intervention.[119] Once again, at the heart of deepfake technology is a software program that a human must create and code.[120] In addition, like deep faking a photograph, the human running the machine has creative input—a new photograph made from two distinct works.[121] Simply put, while the creation of the work is done by a machine, there must be an input or command by a human to reach that designation.[122]

Furthermore, copyright law has traditionally kept pace with other technological advancements.[123] For example, musical compositions and photographs were initially excluded under the 1976 Act, later added by amendment.[124] Deepfake technology and, more broadly, AI-created works vastly differ from current protected works under copyright law but should be granted protection like those technological advancements before them. The question then becomes whether AI can qualify as an "author."[125]

D. How the Black Box Affects Authorship

Consequently, it is imperative to keep BBP in mind. Arguably, there must be human input in order to create a deepfake, as in the previous example. However, there is a dispute about how much human input is enough.[126] For instance, the underlying AI systems are unpredictable and can act in ways the programmers could never foresee.[127] A programmer can understand the code to create the AI but cannot comprehend the AI's methods to reach the desired input.[128] Without a way to comprehend the AI's processes, the individual could not assert authorship simply because he

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119 *See Naruto*, 888 F.3d at 426.

120 *See generally* Kelsey Warner, *How deepfakes are blurring the lines of art and film*, NATIONAL US: WEEKEND (June 24, 2022), https://www.thenationalnews.com/weekend/2022/06/24/how-deepfakes-are-blurring-the-lines-in-art-and-film/.

121 Dawson Camilleri, *Combining Art with AI*, MEDIUM, https://medium.com/new-writers-welcome/combining-art-with-ai-66f758e311b3 (last visited Feb. 13, 2024).

122 *See generally* Ashraf A. Abu-Ein et al., *Analysis of the current state of deepfake techniques-creation and detection methods*, 28 INDONESIAN J. OF ELEC. ENG'G & COMPUT. SCI. 1659, 1661 (2022).

123 Madeleine de Cock Buning, *Autonomous Intelligent Systems as Creative Agents Under the EU Framework for Intellectual Property*, 7 EUR. J. RISK REG. 310, 319 (2016).

124 *See generally* Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 56 (1884).

125 17 U.S.C.A. § 201(a).

126 *See* Franklin Graves, *U.S. Copyright Office Backtracks on Registration of Partially AI-Generated Work*, IPWATCHDOG (Nov. 1, 2022), https://ipwatchdog.com/2022/11/01/us-copyright-office-backtracks-registration-partially-ai-generated-work/id=152451 ("This action from the USCO may serve as an early warning that anyone filing works that contain any portions generated by artificial intelligence must disclose such portions and be prepared to support their registration and prove a degree of human authorship.").

127 Bathaee, *supra* note 23, at 907.

128 *See generally* Jose Maria Lopez & Minh Le, *Ever heard of the AI black box problem?*, WORDLINE (Jan. 1, 2021), https://worldline.com/en/home/knowledgehub/blog/2021/january/ever-heard-of-the-aI-black-box-problem.html.

would not be able to replicate or describe the process when filing for the copyright.[129]

In addition, the individual would be unable to show the Copyright Office that the work was created with the input or intervention of a human author.[130] While AI-created work should be copyrightable, it would be difficult to assign a copyright to the individual who used the AI under the current statute.[131] Therefore, the current statute should be amended to include copyright protection either for works created by AI or for individuals who utilize AI.

E. Recent AI Conflicts

In the past year, the Copyright Office has resolved two conflicts involving AI conflicts.[132] The ramifications of these disputes are tremendous as this was the first time the Copyright Office has ruled on these issues.[133] One notable case is *Thaler v. Perlmutter*, wherein the plaintiff, Dr. Thaler, sought copyright protection for a work of art generated by an AI.[134] Dr. Thaler's AI created a work of art titled *A Recent Entrance to Paradise*.[135] The Copyright Office denied his application on the grounds that the work lacked the human authorship necessary to support a claim.[136] The Copyright Office added that because Dr. Thaler failed to produce evidence that he creatively contributed to the work, the product is not an original work with any human authorship.[137] Dr. Thaler then took his case to the United States Federal District Court for the District of Columbia, which granted summary

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129 *See generally* Tabrez Y. Ebrahim, *Data-Centric Technologies: Patent and Copyright Doctrinal Disruptions*, 43 NOVA L. REV. 287, 306 (2019).

130 U.S. COPYRIGHT OFFICE, *supra* note 85, at § 313.2.

131 *See generally* Bathaee, *supra* note 23, at 907.

132 *See* Complaint, Thaler v. Perlmutter, No. 1:22-cv-01564, 2023 WL 5333236 (D.D.C. June 2, 2022); Franklin Graves, *U.S. Copyright Office Backtracks on Registration of Partially AI-Generated Work*, IPWATCHDOG (Nov. 1, 2022), https://ipwatchdog.com/2022/11/01/us-copyright-office-backtracks-registration-partially-ai-generated-work/id=152451/. At the time of this Note's publication, there is currently one ongoing case against the Copyright Office.

133 *See generally* Blake Brittain, *Computer scientist says AI 'artist' deserves its own copyrights*, REUTERS (Jan. 11, 2023), https://www.reuters.com/legal/litigation/computer-scientist-says-ai-artist-deserves-its-own-copyrights-2023-01-11/.

134 *See generally* Complaint at 2, Thaler v. Perlmutter, No. 1:22-cv-01564, 2023 WL 5333236 (D.D.C. June 2, 2022).

135 Complaint at 3, Thaler v. Perlmutter, No. 1:22-cv-01564, 2023 WL 5333236 (D.D.C. Feb. 2023). At the time of this note's potential publication, the case is still ongoing and has yet to reach a holding; the latest update was a motion for summary judgment.

136 Complaint at 4, Thaler v. Perlmutter, No. 1:22-cv-01564, 2023 WL 5333236 (D.D.C. June 2, 2022).

137 *See generally* Franklin Graves, *Thaler Loses AI-Authorship Fight at U.S. Copyright Office*, IPWATCHDOG (Feb. 23, 2022), https://ipwatchdog.com/2022/02/23/thaler-loses-ai-authorship-fight-u-s-copyright-office/id=146253/; *see also* Memorandum Decision, Thaler v. Perlmutter, No. 1:22-cv-01564, 2023 WL 5333236 (D.D.C. Aug. 18, 2023).

judgment in favor of the Copyright Office.[138] In support of its decision, the court observed that "human authorship is a bedrock requirement of copyright," the only question to be decided was whether or not the Copyright Office was correct in denying Thaler's application.[139]

In another case, the Copyright Office refused to extend copyright protection to works partially created with the assistance of AI.[140] Kristina Kashtanova—an artist, AI consultant, and researcher—sought copyright registration for her partially AI-generated graphic novel, *Zarya of The Dawn*, after it had been republished and shared several times on Twitter without credit.[141] Kashtanova used an AI bot called "Midjourney" to generate images based on textual inputs.[142] While the Copyright Office initially granted copyright protection on September 15, 2022, its registration became at risk for cancellation after being "widely publicized as the first known instance of a[] [successfully registered] AI-generated work."[143] Although the Copyright Office stated human authorship was required for registration, they did not explicitly state that works created partially with the assistance of AI would be precluded from copyright.[144]

In February 2022, the Copyright Office clarified that certain elements of the work were protectable, including "the text of the graphic novel 'as well as the selection, coordination, and arrangement of the Work's written and visual elements.'"[145] The Copyright Office ultimately canceled the existing registration and granted a new, limited registration for the work "explicitly exclud[ing] 'artwork generated by [AI].'"[146] It further noted that elements created with the help of AI need further clarification because filtering out the AI-assisted elements is increasingly difficult as technology evolves.[147] In

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138 *See* Memorandum & Order at 1, Thaler v. Perlmutter, No. 1:22-cv-01564, 2023 WL 5333236 (D.D.C. Aug. 18, 2023).

139 *See* Memorandum Decision at 8, Thaler v. Perlmutter, No. 1:22-cv-01564, 2023 WL 5333236 (D.D.C. Aug. 18, 2023).

140 Franklin Graves, *U.S. Copyright Office Backtracks on Registration of Partially AI-Generated Work*, IPWATCHDOG (Nov. 1, 2022, 12:15 PM), https://ipwatchdog.com/2022/11/01/us-copyright-office-backtracks-registration-partially-ai-generated-work/id=152451/.

141 *Id*.

142 *Id*.

143 *Id*.

144 *See id*.

145 *Id*. (citing Letter from Robert J. Kasunic, Assoc. Reg. of Copyrights & Dir. of the Off. of Registration Pol'y & Prac., U.S. Copyright Office, to Van Lindberg, Att'y, Taylor English Duma LLP (Feb. 21, 2023), available at chrome-extension://efaidnbmnnnibpcajpcglclefindmkaj/ https://www.copyright.gov/docs/zarya-of-the-dawn.pdf.

146 Letter from Robert J. Kasunic, Assoc. Reg. of Copyrights & Dir. of the Off. of Registration Pol'y & Prac., U.S. Copyright Office, to Van Lindberg, Att'y, Taylor English Duma LLP (Feb. 21, 2023), available at https://www.copyright.gov/ docs/zarya-of-the-dawn.pdf.

147 *See generally* Franklin Graves, *U.S. Copyright Office Clarifies Limits of Copyright for AI-Generated Works*, IPWATCHDOG (Feb. 23, 2023, 1:07 PM), https://ipwatchdog.com/2023/02/23/u-s-copyright-office-clarifies-limits-copyright-ai-generated-works/id=157023/.

response, the Copyright Office is developing new registration guidance for works created in part with the assistance of AI.[148]

With these two cases in mind, it is unlikely that the Copyright Office will afford authorship to works created by or with the assistance of AI anytime soon, and the new guidelines will likely adhere to the human authorship requirement in particular.[149]

IV. DEEPFAKES ARE ORIGINAL AND SHOULD BE PROTECTED UNDER THE COPYRIGHT ACT

In contrast to authorship, the bar set for originality is minimal.[150] As the Supreme Court sets out in *Feist Publications, Inc. v. Rural Telephone Service Co.*, "it is not difficult to satisfy the originality requirement; an author need only independently create the work and imbue it with 'some minimum level of creativity,' a 'creative spark.'"[151] The Court added that the "requisite level of creativity is [so] extremely low; even a slight amount will suffice . . . 'no matter how crude, humble, or obvious' it might be."[152] In addition, the 1976 Act protects new technological developments if it qualifies as a tangible medium of expression.[153] There are currently no resolved cases that address the issue of originality in regard to AI-created works.[154]

A. Wireframe Models: *Meshwerks*

In the absence of these case resolutions, possible solutions to the originality requirement might be found by considering copyright protection for digital programs. *Meshwerks v. Toyota* depicts an analogous situation in which Meshwerks created three-dimensional wireframe models of Toyota vehicles using a digital software program.[155] The court stated that Meshwerks

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148 *See id.*

149 *See generally id.*

150 *See* Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340 (1991) (establishing that information alone without a minimum of original creativity cannot be protected by copyright).

151 SHL Imaging, Inc. v. Artisan House, Inc., 117 F. Supp. 2d 301, 309 (S.D.N.Y. 2000) (quoting *Feist Publ'ns, Inc.,* 499 U.S. at 340).

152 *Feist Publ'ns, Inc*., 499 U.S. at 345.

153 *See* 17 U.S.C. § 102(a) (explaining that the Copyright Act of 1976 encompasses a broad array of works and specifically protects "any tangible medium of expression, *now known or later developed*.").

154 *But see* Blake Brittain, *AI-generated art cannot receive copyrights, US court says*, REUTERS (Aug. 21, 2023, 1:29 PM), https://www.reuters.com/legal/ai-generated-art-cannot-receive-copyrights-us-court-says-2023-08-21/ (explaining that a U.S. Court in Washington, D.C., has ruled that a "work of law created by artificial intelligence without any human input cannot be copyrighted under U.S. law").

155 Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc., 528 F.3d 1258, 1261 (10th Cir. 2008).

only transcribed the current Toyota vehicles into a digital model.[156] In this case, the Tenth Circuit ruled, as a matter of law, that Meshwerks' Digital Models were not protected by copyright because "they resembled the Toyota vehicles which they depict."[157] Essentially, the court found that Meshworks' models lacked originality because the origins of those designs were owed to Toyota.[158]

While the dicta from the case went against the originality prong for AI-created works, the court highlighted the possible ramifications of new technology.[159] The court examined the difficulty of distinguishing an independent creation from a copy, especially in the age of "virtual worlds and digital media that seek to mimic the 'real' world."[160] Specifically, the court found that it did not doubt that the wireframe models, in this case, could be employed to create "vivid new expressions fully protectable in copyright"—just like photography before it.[161] This statement reinforces the notion that not only can works of a similar nature to Meshwerks' models satisfy the originality requirement for copyright under different facts, but also that the caselaw should be interpreted in light of modern technology and practices.[162]

In many instances, deepfakes are perhaps transcriptions or compilations of media.[163] However, there are many ways that deepfakes should be distinguished from *Meshwerks*.[164] First, deepfakes are more than a transcription of assets.[165] While the same media is used from input to output, the result is a created work that differs from the original.[166] In addition, *Meshwerks* dealt with transcribing real-world assets into the digital space.[167] While deepfakes are generated from photos or videos depicting real people or objects, the process involves converting digital assets from one digital

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156 *Id*. at 1266 ("Meshwerks thus played a narrow, if pivotal, role in the process by simply, if effectively, copying Toyota's vehicles into a digital medium so they could be expressively manipulated by others.").

157 Petition for Writ of Certiorari at 8, Meshwerks, Inc. v. Toyota Motor Sales, U.S.A., Inc., 555 U.S. 1138 (2009) (No. 08-638), 2008 WL 4906101, at *8.

158 *Meshwerks, Inc*., 528 F.3d at 1264.

159 *Id*. at 1269–70.

160 *Id*. at 1263.

161 *Id*. at 1264–65.

162 *See id*.

163 Alex Hughes, *What is a deepfake and should you be worried about them?*, SCIENCE FOCUS (Aug. 5, 2022, 10:00 PM), https://www.sciencefocus.com/future-technology/deepfakes/.

164 Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc., 528 F.3d 1258 (10th Cir. 2008).

165 *See generally* Alex Hughes, *What is a deepfake and should you be worried about them?*, SCIENCE FOCUS (Aug. 5, 2022, 10:00 PM), https://www.sciencefocus.com/future-technology/deepfakes/ (explaining what a deepfake is and where this technology originated from).

166 *See generally* Catherine Bernaciak & Dominic A. Ross, *How Easy Is It to Make and Detect a Deepfake?*, CARNEGIE MELLON UNIV.: SEI BLOG (Mar. 14, 2022), https://insights.sei.cmu.edu/blog/how-easy-is-it-to-make-and-detect-a-deepfake/ (explaining how a deepfake works).

167 *See Meshwerks, Inc*., 528 F.3d at 1260.

form to another.[168] For example, if one wanted to create a deepfake of President Biden talking about tanks, all it would take is an upload of audio samples from Biden's speeches.[169] Then, the work would be created by transcribing one digital media to another.[170] While deepfakes are analogous to the wireframe models in *Meshwerks*, deepfakes are new creations as opposed to a mere transcription of assets and, thus, should satisfy the originality requirement.[171]

Regardless of the work's purpose, the creator of a deepfake has a goal in mind, be it fraud[172] or parody.[173] It is also exceedingly difficult to determine and filter out how much assistance AI can give to an author before it crosses the line.[174] If an individual simply inputs a prompt into an AI software to create a new work with a compiled library of images, the individual arguably has done very little as the AI is essentially doing most, if not all, of the work.[175] In addition, copyright is the only real way to protect digital files from misappropriation, given that they can be copied and widely disseminated with a few computer keystrokes.[176] However, the originality requirement is only met if the copyright is granted to the individual who commissions the AI instead of the AI itself.[177] An issue arises if the AI is granted a copyright over the work.[178]

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168 *See generally* Catherine Bernaciak & Dominic A. Ross, *How Easy Is It to Make and Detect a Deepfake?*, CARNEGIE MELLON UNIV.: SEI BLOG (Mar. 14, 2022), https://insights.sei.cmu.edu/blog/how-easy-is-it-to-make-and-detect-a-deepfake/ (explaining how a deepfake works).

169 Arijeta Lajka, *Artificial intelligence makes voice cloning easy and 'the monster is already on the loose'*, FORTUNE (Feb. 11, 2023, 9:26 AM), https://fortune.com/2023/02/11/artificial-intelligence-makes-voice-cloning-easy-and-the-monster-is-already-on-the-loose/.

170 *See generally* Catherine Bernaciak & Dominic A. Ross, *How Easy Is It to Make and Detect a Deepfake?*, CARNEGIE MELLON UNIV.: SEI BLOG (Mar. 14, 2022), https://insights.sei.cmu.edu/blog/how-easy-is-it-to-make-and-detect-a-deepfake/ (explaining how a deepfake works).

171 *See generally* Neeraja Seshadri, *Implications of Deepfakes on Copyright Law*, WIPO (July 22, 2020), https://www.wipo.int/export/sites/www/about-ip/en/artificial_intelligence/conversation_ip_ai/pdf/ind_seshadri.pdf (explaining the relationship between copyright law and the regulation of deepfakes).

172 *See* Meredith Somers, *Deepfakes, explained*, MIT SLOAN (July 21, 2020), https://mitsloan.mit.edu/ideas-made-to-matter/deepfakes-explained (providing some tips for business leaders to protect their companies and employees from deepfakes).

173 Vejay Lalla et al., *Artificial intelligence: deepfakes in the entertainment industry*, WIPO MAG. (June 2020), https://www.wipo.int/wipo_magazine/en/2022/02/article_0003.html.

174 *See generally* Michael D. Murray, *Generative and AI Authored Artworks and Copyright Law*, 45 HASTINGS COMMC'NS & ENT. L.J. 27 (2023) (explaining what generative art linked to non-fungible tokens is before arguing why generative art fails in the copyrightability analysis).

175 *Id*. at 32.

176 Petition for Writ of Certiorari at 8, Meshwerks, Inc. v. Toyota Motor Sales, U.S.A., Inc., 555 U.S. 1138 (2009) (No. 08-638), 2008 WL 4906101, at *8.

177 Meshwerks, Inc. v. Toyota Motor Sales U.S.A., 528 F.3d 1258, 1266 (10th Cir. 2008) (citing Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 345 (1991)).

178 *See generally* Atilla Kasap, *Copyright and Creative Artificial Intelligence (AI) Systems: A Twenty-First Century Approach to Authorship of AI-Generated Works in the United States*, 19 WAKE FOREST J. BUS. & INTELL. PROP. L. 335 (2019).

B. AI Cannot Meet the Creativity Standard

Even if an AI-created work passes the low threshold for originality under the statute, computers lack creativity, or at the very least, computational creativity differs from human creativity.[179] Creativity can be defined as something that is novel and possesses value.[180] Some scholars argue that computers can reach the level of creativity that humans possess, stating that there are examples of artificially intelligent inventions and creations that already exist, such as a silicon clip created by a machine and an antenna created by software, which were both granted patents.[181] Others contend that computers can never truly be creative because they only follow programming and lack consciousness, unlike humans.[182]

Determining whether computers are truly creative is more of a scientific question than a legal one, lacking a definite answer.[183] However, it is difficult to state that AI meets the requisite level of creativity to satisfy originality under the statute.[184] An objective approach has been introduced that takes the work itself into consideration.[185] Under this approach, a work is considered "artistic" if it "cannot be differentiated from the work of a human" and the "work's aesthetic value could be judged equal to the work of a similar nature created by a human."[186]

In addition, the AI is just a machine, incapable of creative input as the creative input comes from the designer or user of the AI.[187] Essentially, AI is just a "tool" that allows the user to express his creative ideas,[188] analogous to *Burrow-Giles*.[189] The AI itself does not have any creative contributions because all the creative contributions belong to the designer or user of the AI.[190] While there can be arguments to be made in support of authorship

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179 *Id*. at 344.

180 Dean Keith Simonton, *Defining Creativity: Don't We Also Need to Define What Is Not Creative?*, J. CREATIVE BEHAV. 1, 2 (2016).

181 Margaret A. Boden, *Computer Models of Creativity*, 30 AI MAG. 23, 24 (2009).

182 Selmer Bringsjord et al., *Creativity, the Turing Test, and the (Better) Lovelace Test*, 11 MINDS & MACHS. 3, 3-4 (2011).

183 *See generally* Jane C. Ginsburg & Luke Ali Budiardjo, *Authors and Machines*, 34 BERKELEY TECH. L.J. 343, 405 (2019).

184 *See generally id*.

185 *See generally* Margaret A. Boden, *The Turing Test and Artistic Creativity*, 39 KYBERNETES 409, 412 (2010).

186 *Id*.

187 *See generally* Ginsburg & Ali Budiardjo, *supra* note 183, at 405.

188 *See generally id*.

189 Burrow-Giles deals with a copyright over a photograph, in which the Court ruled that the creative aspects of choosing where to shoot the photo, the lighting, and the equipment (among other things) qualified the work for a copyright. *See* Burrow-Giles Lithographic Co. v Sarony, 111 U.S. 53 (1884).

190 *See generally* Kasap, *supra* note 178, at 365.

rights granted to AI, it cannot meet the level of creativity under the current statute.[191]

C. Artificial Intelligence as the Copyright Holder

Notwithstanding the issues of originality and authorship that have already been discussed, it would be difficult to award authorship to AI, as it is not a legal person or entity.[192] Courts and legislative authorities' recognition of legal personality generally depends on social and political changes.[193] It is uncertain if this recognition will be accorded AI.[194] Even if AI were recognized as legal persons, there would still be issues of consciousness and free will, as discussed in the originality section.[195] Furthermore, *Slater* poses a significant issue as legislative bodies reject non-human entities for authorship.[196]

Yet, scholars have pointed to an alternative copyright model that AI-created works could fall under: "work-for-hire."[197] Work prepared for an employer or other entity is not owned by the employee or agent but instead by the organization or entity that commissioned the work.[198] There are two ways a work can qualify as a work for hire: (1) the work was created by an employee in the "scope of his or her employment," or (2) it was specially ordered or commissioned, which falls under an exhaustive list.[199] The U.S. Supreme Court has interpreted the meaning of "employee" under agency law and defined it as a "hired party in a conventional employment relationship."[200] While AI-created works could fall under this model, plaintiffs, like the one in *Thaler v. Perlmutter*,[201] face the issue of satisfying the legal personality requirement under agency law.[202]

In his complaint, the plaintiff argued, in the alternative, that if his AI-created work was not afforded copyright protection, then, as its programmer, the plaintiff should receive such rights under the work-for-hire doctrine.[203]

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191 *Id*. at 343 (citing Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 345 (1991)).

192 *See generally id*. at 365.

193 SAMIR CHOPRA & LAURENCE F. WHITE, A LEGAL THEORY OF AUTONOMOUS ARTIFICIAL AGENTS 155 (2011).

194 *Id*.

195 *See generally* Ginsburg & Ali Budiardjo, *supra* note 183, at 405.

196 *See* Naruto v. Slater, 888 F.3d 418, 426 (9th Cir. 2018).

197 Kasap, *supra* note 178, at 366.

198 17 U.S.C.§ 201(b).

199 *Id*. at §101.

200 *See generally* Cmty. for Creative Non-Violence v. Reid, 490 U.S. 730, 739-43 (1989).

201 Complaint at 3, Thaler v. Perlmutter, No. 1:22-cv-01564, 2023 WL 5333236 (D.D.C. Aug. 18, 2023).

202 AI would have issues qualifying as a legal personality under the traditional definitions of agency law because it does not fit into the recognized categories. Kasap, *supra* note 178, at 367.

203 Complaint at 15, Thaler v. Perlmutter, No. 1:22-cv-01564, 2023 WL 5333236 (D.D.C. Aug. 18, 2023).

More specifically, he argued that since he built, controlled, and created the AI that created the work, the work only existed because of his involvement.[204] Courts consider several factors when assessing the existence of an employment relationship, including the employer's control over the work, control over the employee, and the status and conduct of the employee.[205] The plaintiff emphasized that the AI was controlled by the plaintiff, operated only at his direction, and was his property.[206]

Regarding work-for-hire cases, there is an inherent concern about the employees' legal rights; they might get exploited by one-sided employment contracts, or the copyrights in question were never contemplated.[207] However, in this case, the employee is a machine devoid of any legal rights.[208] Simply put, the work-for-hire doctrine should apply to such cases when the programmer owns the AI. As such, under the limited scope, it is difficult to assign copyright rights to the AI system.[209] In many cases, AI-created work is rarely performed by the machine's owner.[210]

D. The Programmer or Individual as the Copyright Holder

As a major contributor to the creative input in the AI system, the programmer or user is another candidate to vest the copyright.[211] This approach would reward users and programmers for the fruits of their labor.[212] Furthermore, it would incentivize these individuals to disclose any contribution from the AI in the creative process because they would not fear rejection from the Copyright Office.[213] From a logical perspective, the

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204 Complaint at 15, Thaler v. Perlmutter, No. 1:22-cv-01564, 2023 WL 5333236 (D.D.C. June 2, 2022).

205 *See Cmty. for Creative Non-Violence*, 490 U.S. at 739-43.

206 Complaint at 15, Thaler v. Perlmutter, No. 1:22-cv-01564, 2023 WL 5333236 (D.D.C. June 2, 2022).

207 Anne Marie Hill, *Work for Hire Definition in the Copyright Act of 1976: Conflict Over Specially Ordered or Commissioned Works*, 74 CORNELL L. REV. 559, 569 (1989).

208 Complaint at 16, Thaler v. Perlmutter, No. 1:22-cv-01564, 2023 WL 5333236 (D.D.C. June 2, 2022).

209 *See generally* Denicola, *supra* note 93, at 251.

210 This assumption is based heavily on the widespread dissemination of such works being created by users of open-source software. To read an article on the typical purposes of creating deepfakes, read the following: *See generally* Kaeli Britt, *How are deepfakes dangerous?*, NEV. TODAY (Mar. 31, 2023), https://www.unr.edu/nevada-today/news/2023/atp-deepfakes. An example of typical terms of service agreements are cited. *See generally Terms of Service*, HUGGING FACE, https://huggingface.co/terms-of-service (last visited Feb. 10, 2024); *see also Terms of Use*, OPENAI, https://openai.com/policies/terms-of-use (last visited Feb. 10, 2024); *Digital.ai Website Terms of Use*, DIGITAL. AI, https://digital.ai/terms-of-use/ (last visited Feb. 10, 2024).

211 Denicola, *supra* note 93, at 276-78.

212 Palace, *supra* note 74, at 236; Pamela Samuelson, *Allocating Ownership Rights in Computer-Generated Works*, 47 UNIV. PITT. L. REV. 1185, 1207 (1986).

213 Palace, *supra* note 74, at 236.

programmer who invests skill and labor in designing an AI system would be a better candidate than others to hold a copyright.[214]

However, under this approach, if a programmer could benefit from the work their AI system creates without their input, they "would be rewarded despite not contributing to the intellectual conception of the work."[215] Simply put, the programmer has to put less work into creating new works because the AI "self-creat[es]" works.[216] In a sense, this conclusion would over-reward the programmer.[217] Concerning entities, employers would retain the copyright, which could lead to market inequality.[218] The programmers working for the employers would not be granted full rights for creating their work—notwithstanding the works-for-hire doctrine.[219] This sharply contrasts with one of the purposes of AI systems: to improve the abilities and efficiency of those with access to them.[220] Furthermore, prohibiting protections for collaborations between humans and AI may deter many others from seeking creative endeavors with this technology, which would run afoul of the purpose of the Copyright Act to "promote the progress of science and useful arts."[221] As such, while granting copyright protection to the programmer makes the most sense, it comes at a cost, but one that might be necessary to incentivize creativity.[222]

Currently, users who create works using certain types of AI are granted a thin copyright—protection only against actual copying, without the other exclusive rights typically granted.[223] These open-source AI bots are open to the public,[224] and the service agreements can differ from one another but typically contain similar terminology.[225] Within the terms of service, the

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214 *See generally* Kasap, *supra* note 178, at 369; Bryant Smith, *Legal Personality*, 37 YALE L. J. 283 (1928).

215 *See generally* Palace, *supra* note 74, at 236.

216 A counterargument to be made is that the AI is just a machine and historically, there should be nothing wrong with granting all of these rights to the creator to benefit from the "fruits of their labor." *See generally* Ginsburg & Ali Budiardjo, *supra* note 183, at 405.

217 *See generally* Palace, *supra* note 74, at 236.

218 *Id*.

219 *Id*.

220 *See* PETER STONE ET AL., STANFORD UNIV., ARTIFICIAL INTELLIGENCE AND LIFE IN 2030: ONE HUNDRED YEAR STUDY ON ARTIFICIAL INTELLIGENCE 43 (2016), available at https://ai100.stanford.edu/sites/g/files/sbiybj18871/files/media/file/AI100Report_MT_10.pdf.

221 Tianna Garbett & James G. Gatto, *Generative AI and Copyright – Some Recent Denials and Unanswered Questions*, NAT. L. REV. (Oct. 4, 2023), https://www.natlawreview.com/article/generative-ai-and-copyright-some-recent-denials-and-unanswered-questions; U.S. CONST. art. I, § 8, cl. 8.

222 *See generally* Palace, *supra* note 74, at 236.

223 *See generally* Feist Publ'ns, Inc., v. Rural Tel. Serv. Co., 499 U.S. 340 (1991).

224 Franklin Graves, *U.S. Copyright Office Backtracks on Registration of Partially AI-Generated Work*, IPWATCHDOG (Nov. 1, 2022), https://ipwatchdog.com/2022/11/01/us-copyright-office-backtracks-registration-partially-ai-generated-work/id=152451/.

225 At least in terms of reviewing the terms of service for many other open-source AI programs.

programmer grants the user a license to use the software.[226] The user's content is owned by the user if the works are used privately.[227] However, while the programmer will not sell the user's content, they hold the right to publish, distribute, and make derivative works of such content.[228] Furthermore, suppose the user publicly displays the works. In that case, they agree that those works are only protected by thin copyright, granting the exclusive rights listed above to anyone who wants to use them.[229]

These types of service agreements are typical when using open-source software.[230] The main reasoning behind granting thin copyright protection over open-source use is to promote technological development by ensuring equal accessibility to all.[231] An argument in favor of this approach suggests that without this type of system, it disproportionally benefits large intelligence companies with substantial resources, which could instead be more equitably distributed among everyone.[232] However, other service agreements might withhold all the rights from non-paying members.[233] In doing so, the programmer retains ownership of any of the assets created by its users.[234] In terms of paying corporate members, those members are granted ownership of the assets that they create.[235]

E. Entrance into the Public Domain

The final alternative is for all AI-generated works to enter the public domain immediately.[236] If the work was entered into the public domain, no copyright would be granted, and everyone would be free to use the AI-created work.[237] Some suggest that sending these works straight into the public domain maximizes the benefit of society as a whole, as everyone will have

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226 *See generally Terms of Service*, HUGGING FACE, https://huggingface.co/terms-of-service (last visited Jan. 16, 2024); *Terms of Use*, OPENAI, https://openai.com/policies/terms-of-use (last visited Feb. 10, 2024); *Digital.ai Website Terms of Use*, DIGITAL.AI, https://digital.ai/terms-of-use/ (last visited Feb. 10, 2024).

227 *See generally id.*

228 *See generally id.*

229 *See generally id.*

230 At least in terms of reviewing the terms of service for many other open-source AI programs. *See generally* Palace, *supra* note 74, at 242.

231 *See generally id*.

232 *Id*.

233 Franklin Graves, *U.S. Copyright Office Backtracks on Registration of Partially AI-Generated Work*, IPWATCHDOG (Nov. 1, 2022), https://ipwatchdog.com/2022/11/01/us-copyright-office-backtracks-registration-partially-ai-generated-work/id=152451/.

234 *Id*.

235 *Id*.

236 Palace, *supra* note 74, at 238.

237 *Id*.

equal access to the work without worrying about legal conflicts.[238] At first glance, this approach seems to undermine rewarding programmers for developing AI, as they would not be rewarded for their work.[239] However, there are other incentives that programmers receive when developing AI.[240] There are inherent advantages in being the first to develop technological advancements—especially in AI—as innovations are often incremental and less costly to develop.[241] Without copyright protection, it is unlikely that programmers and software entities will suffer much loss.[242]

Even if this is the simplest and most straightforward solution among the available options, there are still a multitude of issues. While programmers and software entities do not suffer much loss if the AI-created work enters the public domain, they still have incentives by being rewarded for the AI they created.[243]

V. IF THE DEEPFAKE INFRINGES ON A COPYRIGHT

Even if deepfakes can be granted copyright protection, there are other copyright issues that come into question.[244] While infringement is unlikely to come into question when the user, such as a corporate entity, owns the input materials (like the licensing or overall rights), this could become an issue if deepfakes are created by individual members of the public.[245] If the deepfake infringes on a copyright, scholars have stated that deepfake technology is likely protected under the doctrine of fair use.[246] Under 17 U.S.C. §107, fair use precludes a finding of copyright infringement when certain elements are met, including the purpose and character of the use, the work's commercial nature, its impact on the potential market, and the substantiality of the copying.[247] One of the most important elements in the fair use analysis is the transformative nature of the work under the purpose and character test.[248] The U.S. Supreme Court stated in *Campbell v. Acuff-Rose Music Inc.* that even if

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238 Mark Perry & Thomas Margoni, *From Music Tracks to Google Maps: Who Owns Computer Generated Works?* 26 COMPUT. L. & SEC. REV. 621, 625 (2010), available at https://papers.ssrn.com/sol3/Delivery.cfm/SSRN_ID1753242_code1383303.pdf?abstractid=1647584&mirid=1.

239 Palace, *supra* note 74, at 240.

240 *See* Kasap, *supra* note 178, at 368-69.

241 *See* Ryan Abbott, *Hal the Inventor: Big Data and Its Use by Artificial Intelligence*, *in* BIG DATA IS NOT A MONOLITH 187, 195 (Cassidy R. Sugimoto et al. ed., 2016).

242 Palace, *supra* note 74, at 238.

243 Kasap, *supra* note 178, at 374.

244 *See* Neeraja Seshadri, *Implications of Deepfakes on Copyright Law*, WIPO (July 22, 2020), https://www.wipo.int/export/sites/www/about-ip/en/artificial_intelligence/conversation_ip_ai/pdf/ind_seshadri.pdf.

245 *See id*.

246 *Id*.

247 17 U.S.C. § 107.

248 *See* Campbell v. Acuff-Rose Music Inc., 510 U.S. 569, 579 (1994).

a substantial amount of the work is copied from the copyrighted work, as long as there is a new meaning or expression, fair use can extend to protect the work.[249] In addition, the potential effect on the market is also a significant factor in evaluating transformative use.[250]

Generally speaking, deepfakes are commonly created by those without rights to the copyrighted material.[251] The actors or individuals depicted in deepfakes are generally not the copyright owners.[252] With that in mind, copyright protection is the best avenue to ensure that entities can enforce their rights against infringers of works, such as materials in the public domain and those created by movie makers and photographers.[253] In these cases, the deepfake created is for a vastly different purpose than the material's original use. For instance, a deepfake depicting Tom Cruise performing industrial clean-up services is most certainly used for a different purpose than creating an action film.[254]

Another argument creators can use is the moral rights argument. Moral rights protect the creator's reputation, entitling them to attribution.[255] However, moral rights only apply to visual arts.[256] Still, they can be extended when the copyrighted work is modified in such a manner that is prejudicial to the interest of the creator of the copyrighted work.[257] While the moral rights defense is limited, it could possibly be extended to works created with visual art assets.[258] These doctrines must be applied case-by-case because deepfakes have numerous uses and factors that could change the infringement analysis.[259] With the widespread use of social media,

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249 Neeraja Seshadri, *Implications of Deepfakes on Copyright Law*, WIPO (July 22, 2020), https://www.wipo.int/export/sites/www/about-ip/en/artificial_intelligence/conversation_ip_ai/pdf/ind_seshadri.pdf; *Campbell*, 510 U.S. at 579.

250 Rogers v. Koons, 960 F.2d 301 (2d Cir. 1992).

251 Carlton Daniel & Ailin O'Flaherty, *The Rise of the "Deepfake" Demands Urgent Legal Reform in the UK*, SQUIRE PATTON BOGGS (Mar. 23, 2021), https://www.iptechblog.com/2021/03/the-rise-of-the-deepfake-demands-urgent-legal-reform-in-the-uk/.

252 *See generally* Audrey M. Dunkley, *Copyright Law on Paparazzi: Do Celebrities Own Their Image?*, VIVID IP (July 15, 2019), https://www.vividip.com/news-notes/newlocation-6g3zg.

253 Carlton Daniel & Ailin O'Flaherty, *The Rise of the "Deepfake" Demands Urgent Legal Reform in the UK*, SQUIRE PATTON BOGGS (Mar. 23, 2021), https://www.iptechblog.com/2021/03/the-rise-of-the-deepfake-demands-urgent-legal-reform-in-the-uk/.

254 Vejay Lalla et al., *Artificial Intelligence: Deepfakes in the Entertainment Industry*, WIPO (June 2022), https://www.wipo.int/wipo_magazine/en/2022/02/article_0003.html.

255 Betsy Rosenblatt, *Moral Rights Basics*, HARV. L. SCH. (Jul. 23, 2020), https://cyber.harvard.edu/property/library/moralprimer.html#:~:text=In%20the%20United%20States%2C%20the,of%20who%20owns%20the%20work.

256 17 U.S.C. § 106A.

257 *Id*.

258 Neeraja Seshadri, *Implications of Deepfakes on Copyright Law*, WIPO (July 22, 2020), https://www.wipo.int/export/sites/www/about-ip/en/artificial_intelligence/conversation_ip_ai/pdf/ind_seshadri.pdf.

259 *See generally* Lutz Finger, *Overview of How To Create Deepfakes - It's Scarily Simple*, FORBES (Sep. 8, 2022, 8:00 AM), https://www.forbes.com/sites/lutzfinger/2022/09/08/overview-of-how-to-create-deepfakesits-scarily-simple/?sh=7b79c4762bf1.

dissemination of these deepfakes is likely, and fair use and moral rights will become a common topic of discussion.[260]

VI. RIGHT TO PUBLICITY

Scholars have referenced the right to publicity as another means of controlling deepfakes.[261] The right to publicity is an intellectual property right that states that every human being has the right to control the commercial use of his or her identity.[262] Unlike rights in copyright, a right codified within a federal statute, the right to publicity is recognized in state statutes or through common law.[263] In fact, in 2021, New York adopted a "post-mortem right of publicity" specifically to deter against the use of deepfakes.[264] The statute made the use of a deceased person's likeness for a commercial purpose illegal.[265] With this type of law, deepfakes created with a celebrity's likeness used for a commercial purpose would be targeted, and that celebrity would have a cause of action against the creator of the deepfake.[266]

While this approach might alleviate some of the issues that deepfakes and other AI-created works pose, the right to publicity statutes is very limited in application: works created for commercial purposes.[267] Works created that qualify under fair use do not abridge the right to publicity; indeed, this is what is reflected in the New York statute.[268] Furthermore, there can be other inherent difficulties in bringing a cause of action based on the right to publicity. For instance, it can be difficult to identify the owner who created

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260 Neeraja Seshadri, *Implications of Deepfakes on Copyright Law*, WIPO (July 22, 2020), https://www.wipo.int/export/sites/www/about-ip/en/artificial_intelligence/conversation_ip_ai/pdf/ind_seshadri.pdf.

261 Jesse Lempel, *Combatting Deepfakes Through the Right of Publicity*, LAWFARE (Mar. 30, 2018), https://www.lawfareblog.com/combatting-deepfakes-through-right-publicity; Kavyasri Nagumotu, *Deepfakes Are Taking Over Social Media: Can the Law Keep Up?* 62 IDEA 102, 128 (2022).

262 Jesse Lempel, *Combatting Deepfakes through the Right of Publicity*, LAWFARE (Mar. 30, 2018), https://www.lawfareblog.com/combatting-deepfakes-through-right-publicity.

263 *Id*.

264 Chloe Sucato, *New York Gives Life to Post-Mortem Right of Publicity and Deters Deepfakes*, BROOKLYN SPORTS & ENT. L. BLOG (June 10, 2021), https://sports-entertainment.brooklaw.edu/film-tv/new-york-gives-life-to-post-mortem-right-of-publicity-and-deters-deepfakes/.

265 *Id*.

266 Jesse Lempel, *Combatting Deepfakes through the Right of Publicity*, LAWFARE (Mar. 30, 2018), https://www.lawfaremedia.org/article/combatting-deepfakes-through-right-publicity#:~:text=Ultimately%2C%20any%20viable%20legal%20solution,way%20that%20protects%20free%20speech.

267 *Id*.

268 Chloe Sucato, *New York Gives Life to Post-Mortem Right of Publicity and Deters Deepfakes*, BROOKLYN SPORTS & ENTM'T L. BLOG (June 10, 2021), https://sports-entertainment.brooklaw.edu/film-tv/new-york-gives-life-to-post-mortem-right-of-publicity-and-deters-deepfakes/.

the work in question.[269] Even if the owner can be identified, the First Amendment protections on free speech might protect the work.[270] The U.S. Supreme Court held in *New York Times v. Sullivan* that First Amendment protections are not provided for speech against public figures made with actual malice—a reckless disregard for whether the statement was false.[271] This would restrict the instances in which an individual could file a cause of action based on his right to publicity.[272] Simply put, the right to publicity could only be used as a solution for deepfakes created using the likeness of a public figure that does not qualify under fair use, is not used for commercial purposes, or when the work is made with a reckless disregard for the truth.[273] The right to publicity is simply too limited to regulate AI-created works properly; a better vehicle for control is copyright law.[274]

VII. CONCLUSION

With the increasing use of deepfakes in the digital world, the question of the copyrightability of AI-created works is unavoidable.[275] The Copyright Office continues to hold firm on the human authorship requirement, and Congress has yet to amend the Copyright Act of 1976.[276] Between the possible alternatives, the best choice would be to grant copyright protection to the programmer or individual who commissions AI-created work.[277]

This approach makes the most logical sense. Granting the copyright to the AI system would lead to a web of legal issues yet to be resolved, while granting the copyright to the programmer would reward them for the fruits of their labor.[278] Putting the work straight into the public domain might lead to greater developments in AI because of equal access but would undermine and deter programmers from being the "first" to innovate in the field.[279] In addition, the Black Box Problem has yet to be resolved, further supporting

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269 Kavyasri Nagumotu, *Deepfakes Are Taking Over Social Media: Can the Law Keep Up?* 62 IDEA 102, 128 (2022).

270 Carolyn Pepper et al., *Reputation Management and the Growing Threat of Deepfakes*, BL (July 9, 2021), https://news.bloomberglaw.com/us-law-week/reputation-management-and-the-growing-threat-of-deepfakes.

271 New York Times Co. v. Sullivan, 376 U.S. 254, 300–01 (1964).

272 *Id*.

273 *See generally* Nagumotu, *supra* note 269, at 128.

274 *See generally id*.

275 *Id*.; Carolyn Pepper et al., *Reputation Management and the Growing Threat of Deepfakes*, BL (July 9, 2021), https://news.bloomberglaw.com/us-law-week/reputation-management-and-the-growing-threat-of-deepfakes.

276 *See generally* Riddhi Setty, *Copyright Office Sets Sights on Artificial Intelligence in 2023*, BLOOMBERG L. (Dec. 29, 2022, 4:00 AM), https://news.bloomberglaw.com/ip-law/copyright-office-sets-sights-on-artificial-intelligence-in-2023.

277 *See generally id*.

278 *See generally id*.

279 *See generally id*.

the grant of copyright protection to the programmer.[280] *Thaler* shows that the Copyright Office adheres to the legal pillars of copyright protection by denying AI-created works.[281] Moving forward, the issue that plagues the Copyright Office is how the new guidelines will address works that seem indistinguishable from human-created works.[282]

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280 Bathaee, *supra* note 23, at 898.

281 *See generally* Complaint at 1, Thaler v. Perlmutter, No. 1:22-cv-01564, 2023 WL 5333236 (D.D.C. June 2, 2022).

282 Nagumotu, *supra* note 269, at 128.