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Opinion No. 09-32

Constitutionality of House Bill 927

QUESTION

Is House Bill 927, the Tennessee Defense of Heroes Act of 2009, constitutional?

OPINION

House Bill 927 would likely be found to be facially constitutional. However, it may be unconstitutional as applied in certain situations involving free speech and federal copyright law. In cases involving a copyright issue, the bill would be subject to constitutional attack under the Supremacy Clause of the United States Constitution and preempted by federal law. In cases implicating free speech, the bill may be subject to attack under the First Amendment to the United States Constitution and Article 1, Section 19 of the Tennessee Constitution.

ANALYSIS

You have asked whether House Bill 927, which criminalizes the unauthorized use of the name, picture, or portrait of a soldier who is killed while on active duty in the military, is constitutional. To the extent the bill criminalizes conduct that is authorized by federal copyright law, the bill is unconstitutional under the Supremacy Clause and is explicitly preempted by 17 U.S.C. § 301. In addition, the bill may also impinge on freedom of speech and be subject to attack under both the United States and Tennessee Constitutions.

House Bill 927 would make it a criminal offense for any person to knowingly use the name, portrait, or picture of a soldier who is killed while on active duty with the Army, Navy, Marines, Air Force, or Coast Guard[1] for any commercial purpose without the authorization of the soldier's representative. The bill defines representative as the deceased soldier's legal representative; if there is no legal representative, the soldier's surviving spouse; if no surviving

[1]In the bill's present form it is unclear to what extent it would apply to state military personnel. The bill currently references military duty under an order of the Governor "issued pursuant to parts 1, 2, and 4-6 of chapter 58." No such statutory cite exists in the Tennessee code. If the reference is corrected to cite to Title 58, Chapter 2, Parts 1, 2, and 4-6, of the Tennessee Code, the bill's provisions would apply to active state military personnel activated by the Governor pursuant to those sections, as well.

spouse, the soldier's parents; or if there are no parents, the soldier's children. The bill further defines a commercial purpose as any use for economic gain or any use where money is exchanged regardless of whether the activity produces economic gain. The bill excludes from the definition of commercial purpose "any use by federal, state or local government; any use by bona fide news organizations; any use by bona fide veterans' organizations; or, any use for bona fide artistic, educational or religious purposes." Finally, the bill provides that any personal property used in violation of the bill's provisions is subject to forfeiture.

A statute may be unconstitutional either on its face or as applied to the facts of a particular situation. In order to show that a statute is facially unconstitutional, a party must demonstrate that there is no set of circumstances under which the statute can be validly applied. *Davis-Kidd Booksellers, Inc. v. McWherter*, 866 S.W.2d 520, 525 (Tenn. 1993). Because there are cases in which this law can be validly applied, we believe a court would find the statute to be facially constitutional. However, the bill may be unconstitutional as applied under the Supremacy Clause of the United States Constitution, and therefore preempted, in situations involving federal copyright law. The bill also implicates free speech issues and may be subject to constitutional attack under the First Amendment of the United States Constitution and Article I, Section 19 of the Tennessee Constitution.

Under some circumstances, enforcement of House Bill 927 would implicate federal copyright law and be preempted by federal law. The Supremacy Clause provides that the laws of the United States "shall be the supreme Law of the Land; and the Judges in every State shall be bound thereby, any Thing in the Constitution or Laws of any State to the Contrary notwithstanding." U.S. Const. art. 6, cl. 2. Congressional intent determines whether a federal statute preempts state law. *Wadlington v. Miles, Inc., et al.*, 922 S.W.2d 520, 522 (Tenn. Ct. App. 1996). The Supremacy Clause results in federal preemption of state law when: (1) Congress expressly preempts state law; (2) Congress has completely supplanted state law in that field; (3) adherence to federal and state law is impossible; or (4) the state law impedes the achievements of the objectives of Congress. *Wadlington*, 922 S.W.2d at 522.

In the Copyright Act, Congress has expressed its intent to preempt state law:

> On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.

17 U.S.C. § 301 (a).

When determining whether federal copyright law preempts a state claim, courts employ a two-part test. First, they determine whether the subject matter of the state claim falls within the subject matter of copyright as specified in 17 U.S.C. §§ 102 and 103. *Daboub v. Gibbons*, 42 F.3d 285, 289 (5th Cir. 1995); *Corporate Catering, Inc. v. Corporate Catering, Etc., LLC*, 2001 WL 266041, *4 (Tenn. Ct. App. March 20, 2001). Any picture or portrait clearly falls within the ambit of copyright law. *Rogers v. Koon*, 960 F.3d 301, 306 (2nd Cir. 1992); 17 U.S.C. § 101 (defining "pictorial, graphic, and sculptural works" to include two- and three-dimensional works of fine, graphic, and applied art, photographs, prints, art reproductions, etc.). Pictorial works are expressly given federal copyright protection. 17 U.S.C. § 102 (a)(5). Thus, the action criminalized by House Bill 927 – the sale of a picture or portrait without authorization of the deceased soldier's representative – clearly falls within the subject matter of 17 U.S.C. § 102.

Second, courts must determine whether the state law affects rights equivalent to any of the exclusive rights protected by federal copyright law. *Daboub*, 42 F.3d at 289; *Corporate Catering, Inc.*, 2001 WL 266041, at *4. Federal copyright law gives exclusive rights to the copyright holder, often the photographer or creator of the portrait, to: (1) reproduce the copyrighted work; (2) prepare derivative works based on the copyrighted work; (3) distribute copies of the copyrighted work to the public by sale, other transfer of ownership, rent, lease, or lending; (4) perform the copyrighted work publicly; (5) display the copyrighted work publicly; and (6) perform the copyrighted work publicly by means of digital audio transmission, for sound recordings. 17 U.S.C. § 106.

Most cases discussing the "equivalency" prong of the copyright preemption analysis focus on state statutes which seek to protect similar interests. *Alcatel USA, Inc. v. DGI Technologies, Inc.*, 166 F.3d 772, 789 (5th Cir. 1999). Here, House Bill 927 criminalizes conduct that is allowed, in fact protected by, federal copyright law, which is a somewhat different situation than most of the cases analyzing copyright preemption. However, the analysis is the same. Because the state law would restrict a right "equivalent" to the exclusive rights contained in the Copyright Act, in some circumstances, namely where the copyright holder is not the soldier's representative, House Bill 927 could not be enforced against a copyright holder without infringing on federal copyright law. When adherence to both the state law and the federal law is impossible, the state law is preempted. *Wadlington*, 922 S.W.2d at 522. Accordingly, insofar as House Bill 927 restricts rights "equivalent" to the exclusive rights contained in the Copyright Act, the bill would be preempted by federal law.

Therefore, in situations where House Bill 927 would criminalize a valid copyright holder's distribution of a picture or portrait of a deceased soldier for a commercial purpose without authorization of the soldier's representative, the state law would run afoul of the Supremacy Clause of the United States Constitution and would be preempted.[2]

House Bill 927 also implicates free speech issues. Both the Constitution of the United States and the Constitution of Tennessee reflect this country's "profound national commitment to the principle that debate on public issues should be uninhibited, robust, and wide-open." *Lewis*

[2]An individual's name is not subject to copyright protection, and, therefore, a case involving only a soldier's name would not be preempted. 17 U.S.C. § 102; *Brown v. Ames*, 201 F.3d 654, 658 (5th Cir. 2000).

v. News Channel 5 Network, L.P., 238 S.W.3d 270, 287 (Tenn. Ct. App. 2007) (quoting *New York Times Co. v. Sullivan*, 376 U.S. 254, 270 (1964)). The First Amendment of the United States Constitution proscribes laws "abridging the freedom of speech, or of the press." Article 1, Section 19 of the Tennessee Constitution provides:

> the printing presses shall be free to every person to examine the proceedings of the Legislature; or of any branch or officer of the government, and no law shall ever be made to restrain the right thereof. The free communication of thoughts and opinions, is one of the invaluable rights of man, and every citizen may freely speak, write, and print on any subject, being responsible for the abuse of that liberty.

The Tennessee Supreme Court has held that the freedoms of speech and the press under the Tennessee Constitution are "substantially stronger" than the First Amendment because Tennessee's Constitution "is clear and certain, leaving nothing to conjecture and requiring no interpretation, construction or clarification." *Press, Inc. v. Verran*, 569 S.W.2d 435, 442 (Tenn. 1978).

The protection of the freedom of speech is not limited to written or spoken words, but extends to other mediums, including music, pictures, films, photographs, paintings, drawings, and sculptures. *ETW Corporation v. Jireh Publishing, Inc.*, 332 F.3d 915, 924 (6th Cir. 2003). The fact that expressive materials are sold does not diminish the protection to which they are due under the First Amendment. *ETW Corporation*, 332 F.3d at 925. Various types of speech are accorded differing levels of First Amendment protection, from commercial speech (that "related solely to the economic interests of the speaker and its audience"), which is accorded less protection, *Central Hudson Gas & Electric Corporation v. Public Service Commission of New York*, 447 U.S. 557, 563 (1980), to artistic expression and political speech, which receive the greatest levels of protection, *New York Times*, 376 U.S. at 269-270; *ETW Corporation*, 332 F.3d at 937.

House Bill 927, by criminalizing the unauthorized use of a deceased soldier's name, picture, or portrait, seeks to protect another constitutionally-recognized right – that of the soldier's and his family's right to privacy. The right to privacy in Tennessee has been recognized as constitutionally protected by the Tennessee Supreme Court, *Davis v. Davis*, 842 S.W.2d 588 (Tenn. 1992), and previously codified to allow a civil action for unauthorized use of an individual's name, picture or portrait. Tenn. Code Ann. § 47-25-1105. Inherent tension exists in the simultaneous protection of the freedom of speech and an individual's right to privacy. Because such cases are necessarily fact-specific and have not been addressed by Tennessee courts to date, it is difficult to lay out specific parameters that a court might use to analyze such a case. However, most cases dealing with the right of privacy and the closely related right of publicity have determined that the freedom of speech outweighs an individual's privacy interests. *See, e.g, Doe v. Roe*, 638 So.2d. 826 (Ala. 1994) (refusing to enjoin publication of fictionalized account of murder of biological mother of plaintiff's adopted children under Alabama constitutional right to freedom of speech); *ETW Corporation*, 332 F.3d at 938 (finding that artist's freedom of

expression in print commemorating Tiger Woods' victory at the Masters of Augusta outweighed Mr. Woods' right of publicity); *Rodgers v. Grimaldi*, 875 F.2d 994 (2nd Cir. 1989) (finding that First Amendment protection of movie title "Ginger and Fred" outweighed Ginger Rodger's right of publicity). Accordingly, it is clear that courts generally have favored an author's or artist's right of freedom of expression over an individual's right to privacy.

While the bill's exceptions of use by a bona fide news organization or for a bona fide artistic, educational, or religious purpose may help alleviate First Amendment concerns, it is not clear that such exceptions will avoid running afoul of the First Amendment in all situations. Therefore, the bill may be unconstitutional as applied to some situations that implicate First Amendment rights.

In sum, we believe that House Bill 927 is facially constitutional. However, the bill's application to certain situations involving federal copyright law and free speech may be unconstitutional.

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