S T A T E O F T E N N E S S E E
OFFICE OF THE
ATTORNEY GENERAL
PO BOX 20207
NASHVILLE, TENNESSEE 37202

May 18, 2009

Opinion No. 09-89

"Self-Help" Seizure of Intellectual Property

QUESTIONS

1. Does Tennessee law authorize owners of intellectual property to seize media, without the possessor's consent, which they believe to be counterfeit, pirated, bootleg [1] or stolen?

2. Does Tennessee law authorize owners of intellectual property to demand that a person or business who they believe is selling counterfeit, pirated, bootleg, or stolen media immediately turn over that property or face prosecution?

OPINIONS

1. No. There is no statutory authorization for private individuals to seize media which they believe to contain counterfeit, pirated, or bootleg intellectual property.

2. Threatening prosecution against another person in order to obtain property in their possession could constitute criminal extortion under Tenn. Code Ann. § 39-14-112. A person who does make such a threat could rely upon, at their own peril, the affirmative defense established in Tenn. Code Ann. § 39-14-112(b) which creates an exception when that person was making a reasonable and appropriate claim for restitution, indemnification, or compensation.

ANALYSIS

1. The only statutes that specifically address the sale and possession of stolen media that were found are Tenn. Code Ann. §§ 39-14-139 and 39-14-140. Tenn. Code Ann. § 39-14-139 prohibits the production, possession and sale of pirated and counterfeit media.[2] Tenn. Code Ann. § 39-14-140 states that media that were produced, possessed or sold in violation of Tenn. Code Ann. § 39-14-139 are subject to forfeiture under the same procedures that govern the forfeiture of conveyances under title 40, chapter 33. Neither of those statutes authorizes a private citizen to seize, without the possessor's consent, any media that he believes to be stolen

[1] For the purposes of this opinion, counterfeit media is the unauthorized duplication of a sound or video recording and the original artwork, labels and packaging. Pirated media is the unauthorized duplication of legitimate recordings. Bootleg media is the unauthorized recording of a live performance or from a radio or television broadcast.

[2] Violations of Tenn. Code Ann. § 39-14-139 are punished in the same manner as theft. Tenn. Code Ann. § 39-14-139(e).

or counterfeited.[3] No other statutes have been found that expressly authorize owners of intellectual property to use such self-help measures to recover what they believe to be counterfeit or stolen media.[4]

Under established rules of statutory construction, the express mention of one thing implies the exclusion of things that are not expressly mentioned. *Wells v. Tenn. Bd. Of Regents,* 231 S.W.3d 912 (Tenn. 2007). The fact that Tenn. Code Ann. § 39-14-140 provides a procedure for seizing media suspected to have been produced, possessed or sold in violation of Tenn. Code Ann. § 39-14-139 and requires the obtaining of legal process and the use of law enforcement officers, but does not authorize the use of private "self-help" seizure, indicates that the legislature did not intend to authorize private citizens to resort to such remedies to recover stolen or counterfeit media.[5]

2. For the reasons discussed above, a person in possession of media that an intellectual property owner suspects is pirated, bootleg, counterfeit, or stolen would never be under a legal obligation to turn the property over absent a lawful seizure by law enforcement or through some other lawful process as directed by a court of competent jurisdiction.

Your question asks whether it would be legal for an intellectual property owner to go into a merchant's shop or to a booth or other display where a merchant has items for sale to the general public, and demand that the merchant immediately turn over suspect media or face criminal prosecution. A legal determination of this issue would be highly dependent on the specific facts and circumstances of a given case. However, such an action could expose the intellectual property owner to a prosecution for extortion.

Extortion occurs when a person "uses coercion upon another person with the intent to: (1) obtain property, services, any advantage or immunity; or (2) [r]estrict unlawfully another's freedom of action." Tenn. Code Ann. § 39-14-112(a). The same statute does however provide an affirmative defense to this charge. A person would not be guilty of extortion if he could prove that he "reasonably claimed: (1) [a]ppropriate restitution or appropriate indemnification for harm done; or (2) [a]ppropriate compensation for property or lawful services." Tenn. Code Ann. § 39-14-112(b). For this affirmative defense to prevail, a person charged with extortion would have to prove the elements of the defense by a preponderance of the evidence. Tenn.

[3] The forfeiture procedures set forth in title 40, chapter 33, require the use of law enforcement officers and the issuance of judicial and administrative process. A seizure under this chapter must be made by an authorized Tennessee Bureau of Investigation employee, sheriff, deputy sheriff, municipal law enforcement officer, campus police officer, or constable either acting upon process issued by a circuit or criminal court, or incident to an arrest. Tenn. Code Ann. § 40-33-102. If the seizure is made incident to an arrest, a forfeiture warrant must be obtained from a court of competent jurisdiction. Tenn. Code Ann. § 40-33-204. Any person who has an ownership interest in the property is entitled to notice and a hearing before the property can be forfeited. Tenn. Code Ann. § 40-33-107.

[4] Although there are no measures that expressly authorize the seizure of the media that may be counterfeited or stolen, Tenn. Code Ann. § 40-7-109 authorizes a citizen to make an arrest under certain circumstances.

[5] Tenn. Code Ann. § 40-7-116 (merchants may detain suspected shoplifters) and Tenn. Code Ann. §§ 47-2A-525 and 47-9-609 (secured creditors and lessors may take possession of collateral or goods if the debtor or lessee is in default so long as they do not commit a "breach of the peace") provide further evidence that the legislature has not authorized self-help seizure as a remedy for the possible theft of intellectual property. Those statutes expressly authorize self-help in specific situations and demonstrate that, when the General Assembly intends to authorize self-help remedies in particular contexts, it knows how to do so.

Code Ann. § 39-11-204(a). A prosecutor is "not required to negate the existence of an affirmative defense in the charge alleging commission of the offense." Tenn. Code Ann. § 39-11-204(b). In this instance, an intellectual property owner who threatens prosecution if the merchant does not turn over suspect media could be found guilty of extortion unless he or she were able to prove, by a preponderance of the evidence, that the demand was "reasonable" and "appropriate."

ROBERT E. COOPER, JR.
Attorney General and Reporter

MICHAEL E. MOORE
Solicitor General

BENJAMIN A. WHITEHOUSE
Assistant Attorney General

Requested by:

The Honorable Dewayne Bunch
State Senator
9th Senatorial District
9 Legislative Plaza
Nashville, TN 37243