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The Jurisprudence of the Sixth Amendment's Confrontation Clause in Massachusetts After *Crawford*, *Davis*, *Hammon*, and *Gonsalves*

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In March 2004, the United States Supreme Court's decision in *Crawford v. Washington*,¹ brought about a sea change in the Sixth Amendment's jurisprudence underlying the evidentiary admissibility in criminal trials of an unavailable declarant's extra-judicial statements — coined "testimonial hearsay."² These out-of-court statements, such as excited utterances and statements against penal interest, traditionally were admissible for the truth of the matter asserted primarily because of their inherent reliability under established, or "firmly rooted," exceptions to the hearsay rule — even when the declarant was unavailable at trial.³ Justice Antonin Scalia's opinion in *Crawford*, however, abandoned all measure of reliability as the litmus test for admissibility in favor of "testing in the crucible of cross-examination."⁴ In two key decisions issued in June 2006, *Davis v. Washington*⁵ and *Hammon v. Indiana*,⁶ the Court for the first time honed the contours of the crucial terms "testimonial" and "interrogation," which it had left conspicuously undefined in *Crawford*.⁷ This article reviews the

Crawford, *Davis* and *Hammon* decisions and their holdings, discusses how Massachusetts appellate courts have interpreted those holdings in several key decisions, and assesses the impact of those decisions on prosecutions in Massachusetts — focusing especially on the use of spontaneous utterances and 911 calls.

I. *Crawford v. Washington*: The Death-Knell of Hearsay's "Reliability" Test

Prior to March 2004, courts followed the Supreme Court's test enunciated in *Ohio v. Roberts*⁸ for determining whether a hearsay statement of a non-testifying declarant was admissible for the truth of the matter asserted.⁹ That test required that the statement either fall within a "firmly-rooted exception to the hearsay rule or bear indicia of particular trustworthiness"¹⁰ to be properly admitted and not run afoul of the Sixth Amendment's Confrontation Clause.¹¹ In March

*This article represents the opinions and legal conclusions of its authors only and not necessarily those of their respective employers.

**Attorney Lori Benavides, a former assistant district attorney with the Middlesex District Attorney's Office, contributed to a prior draft of this article.

1. 541 U.S. 36 (2004).

2. *Id.* at 51, 53. As explained below, the Court expressly refused "to spell out a comprehensive definition of 'testimonial.'" *Id.* at 68.

3. *Id.* at 40 (citing *Ohio v. Roberts*, 448 U.S. 56, 66 (1980)).

4. *Id.* at 61 (emphasis added).

5. 126 S.Ct. 2266 (2006).

6. *Hammon v. Indiana* (No. 05-5705) was decided as a companion case to *Davis v.*

Washington (No. 05-5224). See *Davis*, 126 S.Ct. at 2270, 2272.

7. *Crawford*, 541 U.S. at 68.

8. *Ohio v. Roberts*, 448 U.S. 56 (1980).

9. See, e.g., *Commonwealth v. Bergstrom*, 402 Mass. 534, 545 (1988).

10. *Roberts*, 448 U.S. at 66. See *Commonwealth v. Moquette*, 439 Mass. 697, 704-05 (2003).

11. The Sixth Amendment provides in part that "[i]n all criminal prosecutions, the accused shall enjoy the right . . . to be confronted with the witnesses against him." U.S. CONST. amend. VI. This "bedrock procedural guarantee applies to both federal and state prosecutions." *Crawford*, 541 U.S. at 42 (citing *Pointer v. Texas*, 380 U.S. 400, 406 (1965)).

2004, however, the Supreme Court's decision in *Crawford* abrogated the test announced in *Roberts* for those statements that qualify as "testimonial" hearsay.¹² Noting that "[r]eliability is an amorphous, if not entirely subjective, concept,"¹³ the Court denounced the "unpardonable vice of the *Roberts* test" as "its demonstrated capacity to admit core testimonial statements that the Confrontation Clause plainly meant to exclude."¹⁴ The Court held that the Confrontation Clause bars the admission of "testimonial" hearsay *unless* the declarant is unavailable *and* the defendant had a prior opportunity to cross-examine the declarant.¹⁵ Where "nontestimonial" hearsay is at issue, however, the Confrontation Clause is not implicated, and the states, therefore, may adopt "an approach [such as that in *Roberts*] that exempt[s] such statements from Confrontation Clause scrutiny altogether."¹⁶

In *Crawford*, the defendant was charged with assault and attempted murder.¹⁷ The defendant learned that the victim, Kenneth Lee, had allegedly tried to rape the defendant's wife, Sylvia, in an earlier incident.¹⁸ When the defendant and Sylvia confronted Lee at Lee's apartment, a fight ensued, during which the defendant stabbed Lee in the torso.¹⁹ The defendant's and Sylvia's accounts of the fight to the police differed in certain key aspects. Following his arrest on the night of the assault, the defendant told the police during his interrogation that he had seen Lee reach for and pull something out, which the defendant grabbed, cutting his hand in the process.²⁰ Sylvia gave a tape-recorded statement claiming that, although Lee reached into his pocket before he was stabbed, he fell to the ground with "open hands" after being stabbed, and she did not see him holding any weapon.²¹

At trial, the defendant claimed self-defense and invoked the State

of Washington's marital privilege to preclude Sylvia from testifying, thereby making her formally unavailable.²² To rebut the self-defense claim, the prosecution sought to introduce Sylvia's tape-recorded statement in evidence under the hearsay exception for statements against penal interest because Sylvia had facilitated the assault by admitting she led the defendant to Lee's apartment.²³ Over the defendant's Sixth Amendment right to confrontation objection, the trial judge admitted the tape-recorded statement on the ground that it was "trustworthy" (under *Roberts*).²⁴ The jury convicted the defendant of assault.²⁵

On the defendant's appeal, the Washington Court of Appeals reversed, noting several reasons why Sylvia's statement did not bear "particularized guarantees of trustworthiness."²⁶ The Washington Supreme Court, however, unanimously reinstated the conviction, finding that the statement was reliable even though it did not fall under a firmly rooted hearsay exception.²⁷ The United States Supreme Court granted certiorari to determine whether the prosecution's use of Sylvia's statement violated the Sixth Amendment's Confrontation Clause.²⁸

A. Historical Analysis

In answering that question, the Court noted that the Sixth Amendment's "text does not alone resolve th[e] case" because the phrase "confronted with the witnesses against him" could plausibly mean "those who actually testify at trial, those whose statements are offered at trial, or something in-between."²⁹ Writing for the majority, Justice Scalia began with a historical analysis of the English civil-

12. *Crawford*, 541 U.S. at 68; *United States v. Saget*, 377 F.3d 223, 225 (2d Cir. 2004), *cert. denied*, 543 U.S. 1079 (2005).

13. *Crawford*, 541 U.S. at 63.

14. *Id.*

15. *Id.* at 68; *Horton v. Allen*, 370 F.3d 75, 83 (1st Cir. 2004), *cert. denied*, 543 U.S. 1093 (2005). "The Clause does not bar admission of a statement so long as the declarant is present at trial to defend or explain it. (The Clause also does not bar the use of testimonial statements for purposes other than establishing the truth of the matter asserted.)" *Crawford*, 541 U.S. at 59 (citation omitted).

16. *Crawford*, 541 U.S. at 68 (alteration added).

17. *Id.* at 40.

18. *Id.* at 38.

19. *Id.*

20. *Id.* at 38-39. The defendant, however, equivocated — stating that he was not positive and that he tended to "remember things wrong." *Id.* at 39.

21. *Id.* at 39-40.

22. *Id.* at 40. The State of Washington's marital privilege exemption generally bars a spouse from testifying without the other spouse's consent, *see* WASH. REV. CODE §5.60.060(1) (1994), but does not preclude a spouse's out-of-court statements that are admissible under a hearsay exception. By contrast, the Massachusetts marital privilege belongs to the spouse whose testimony is sought. Mass. Gen. Laws ch. 223, §20 (2007). *See* *Commonwealth v. Stokes*, 374 Mass. 583, 595 (1978).

23. *Crawford*, 541 U.S. at 40 (citing WASH. RULE EVID. 804(b)(3) (2003)).

24. *Id.* at 40, 65-66. The prosecution played Sylvia's tape-recorded statement for

the jury and relied on it in closing, arguing that it was "damning evidence" that completely refuted the defendant's self-defense claim. *Id.* at 40-41.

25. *Id.* at 41.

26. *Id.* at 41, 65. In analyzing the admissibility of the statement, the court of appeals applied a nine-factor test. *Id.* at 41.

27. *Id.* at 41, 65-66. The Washington Supreme Court held that because Sylvia's confession was "virtually identical" to that of the defendant, it could be deemed reliable. *Id.* at 41.

28. *Id.* at 42. Notably, the state did not challenge the Washington Supreme Court's rejection of its contention that the defendant had waived his confrontation rights by invoking the marital privilege. *See id.* at 42 n.1. *See also id.* at 62 (noting rule of forfeiture by wrongdoing); *Reynolds v. United States*, 98 U.S. 145, 158 (1878) (defendant who voluntarily keeps witness from testifying cannot assert constitutional claim if evidence properly admitted on other grounds); *United States v. Houlihan*, 92 F.3d 1271, 1279 (1st Cir. 1996) (right to confrontation subject to waiver); *Commonwealth v. Flemmi*, 360 Mass. 693, 694 (1971) (confrontation privilege may be lost by consent or by misconduct). Nor did the state challenge the court of appeals' conclusion that the confrontation violation, if it occurred, was *not* harmless. *Crawford*, 541 U.S. at 42 n.1. *See* *Commonwealth v. Miles*, 420 Mass. 67, 73 (1995) (citing *Delaware v. Van Arsdall*, 475 U.S. 673, 681 (1986) (harmless error standard applies to testimony admitted in violation of defendant's confrontation rights)); *Commonwealth v. Whitney*, 63 Mass. App. Ct. 351, 360-61 (2005) ("leav[ing] the ambiguities of *Crawford* . . . to clarification by others" and finding any error in the admission of the out-of-court statement to be harmless beyond a reasonable doubt).

29. *Crawford*, 541 U.S. at 42-43 (citations omitted).

law practice of *ex parte* pretrial judicial examinations of witnesses as one of the progenitors of the Confrontation Clause,³⁰ focusing in particular on the infamous English trial in 1603 of Sir Walter Raleigh for treason against the Crown.³¹ The Court then surveyed a myriad of historical doctrines, cases, and states' declarations of rights as the genesis of the right of confrontation, which was meant to counter the abuses of civil-law *ex parte* examinations.³² From this history, the Court gleaned support for two inferences about the meaning of the Sixth Amendment's Confrontation Clause that formed the foundation for its holding: "First, the principal evil at which the Confrontation Clause was directed was the civil-law mode of criminal procedure, and particularly its use of *ex parte* examinations as evidence against the accused."³³ And second, "the Framers would not have allowed admission of testimonial statements of a witness who did not appear at trial unless he was unavailable to testify, and the defendant had had a prior opportunity for cross-examination."³⁴

B. The Sixth Amendment's Main Concern: Testimonial Hearsay

Addressing the practice of *ex parte* examinations, the Court first "reject[ed] the view that the Confrontation Clause applies of its own force only to in-court testimony, and that its application to out-of-court statements...depends upon the law of [e]vidence..."³⁵ At the same time, however, the Court noted that "not all hearsay implicates the Sixth Amendment's core concerns," especially hearsay which "bears little resemblance to the civil-law abuses the Confrontation Clause targeted."³⁶ Rather, the text of the Confrontation Clause focuses on *witnesses* against the accused, i.e., "those who bear testimony."³⁷ The Court concluded, therefore, that the "constitutional text, like the

history underlying the common-law right of confrontation, reflects an especially acute concern with a *specific type* of out-of-court statement," namely, "testimonial statements."³⁸

Astonishingly, the Court expressly declined "to spell out a comprehensive definition" of the key term *testimonial*.³⁹ Rather, the Court noted that "[v]arious formulations of this core class of testimonial statements exist,"⁴⁰ and highlighted three such formulations:

[(1)] *ex parte* in-court testimony or its functional equivalent – that is, material such as affidavits, custodial examinations, prior testimony that the defendant was unable to cross-examine, or similar pretrial statements that declarants would reasonably expect to be used prosecutorially; [(2)] extrajudicial statements . . . contained in formalized testimonial materials, such as affidavits, depositions, prior testimony, or confessions; [and (3)] statements that were made under circumstances which would lead an objective witness reasonably to believe that the statement would be available for use at a later trial.⁴¹

The Court also included within its *testimonial* rubric, "under even a narrow standard," "[s]tatements taken by police officers in the course of interrogation."⁴² Here again, however, the Court expressly declined to define "interrogation," noting only that the term is used "in its colloquial, rather than any technical, legal sense."⁴³ In sum, the Court concluded that "at a minimum," the term "testimonial" applies to "prior testimony at a preliminary hearing, before a grand jury, or at

30. *Id.* at 43-44.

31. *Id.* at 44. Lord Cobham, Raleigh's alleged accomplice, had implicated him in an *ex parte* examination before the Privy Council and in a letter, both of which were admitted in evidence at Raleigh's trial. Raleigh argued that Cobham had lied to save himself and demanded that the judges call Cobham to appear: "The Proof of the Common Law is by witness and jury. . . . Call my accuser before my face." *Id.* The judges refused, the jury convicted, and Raleigh was sentenced to death. *Id.*

32. *Id.* at 45-50.

33. *Id.* at 50.

34. *Id.* at 53-54.

35. *Id.* at 50-51 (quotation omitted). The Court reasoned that leaving the admissibility of out-of-court statements only to the law of evidence would "render the Confrontation Clause powerless" to prevent such practices, noting that "Raleigh was, after all, perfectly free to confront those who read Cobham's confession in court." *Id.* at 51.

36. *Id.* Among the apparent exceptions sprinkled throughout the opinion to the Court's amorphous formulation of "testimonial hearsay" are business records and statements in furtherance of a conspiracy — "statements that by their nature were not testimonial" — as well as dying declarations, which Justice Scalia labeled as an undisputed, general hearsay exception that is *sui generis*, even if not incorporated as an exception by the Sixth Amendment. *Id.* at 56 n.6.

37. *Id.* at 51. As the Court explained, however, "bearing testimony" is not limited to in-court testimony: "An accuser who makes a formal statement to government officers bears testimony in a sense that a person who makes a casual remark to an acquaintance does not." *Id.*

38. *Id.* (emphasis added). See *White v. Illinois*, 502 U.S. 346, 362-63 n.1 (1992) (Thomas, J., joined by Scalia, J., concurring in part and concurring in judgment) (Confrontation Clause not intended to encompass all hearsay, or even hearsay in general).

39. *Crawford*, 541 U.S. at 68. Chief Justice William Rehnquist, who concurred in the judgment (and was joined by Justice Sandra Day O'Connor) but sharply dissented from the majority's analysis and abrogation of the *Roberts* test, criticized this failure to properly define the term *testimonial*:

[T]he thousands of federal prosecutors and the tens of thousands of state prosecutors need answers as to what beyond the specific kinds of "testimony" the Court lists, is covered by the new rule. They need them now, not months or years from now. Rules of criminal evidence are applied every day in courts throughout the country, and parties should not be left in the dark in this manner.

Id. at 75-76 (Rehnquist, C.J., joined by O'Connor, J., concurring in the judgment).
40. *Id.* at 51.

41. *Id.* at 51-52 (citations omitted).

42. *Id.* at 52. Justice Scalia opined that police interrogations bear a "striking resemblance" to English *ex parte* judicial examinations. *Id.* In dictum, the Court also later alluded to another formulation: "Involvement of government officials in the production of testimony with an eye toward trial." *Id.* at 56 n.7.

43. *Id.* at 53 n.4. For one such *colloquial* definition, see AM. HERITAGE COLLEGE DICTIONARY 711 (3d ed. 2000), defining "interrogation" as "To examine by questioning formally or officially."

a former trial; and to police interrogations...[i.e.,] the modern practices with closest kinship to the abuses at which the Confrontation Clause was directed.”⁴⁴

C. The Requirement of a Prior Opportunity for Cross-Examination

Addressing the requirements of the declarant’s unavailability and a prior opportunity for cross-examination, the Court observed that the text of the Sixth Amendment “does not suggest any open-ended exceptions from the confrontation requirement to be developed by the courts,” but rather should be read as a “reference to the right of confrontation at common law, admitting only those exceptions established at the time of the founding.”⁴⁵ Because “the common law in 1791 conditioned admissibility of an absent witness’s examination on unavailability and a prior opportunity to cross-examine,” the Sixth Amendment incorporated those limitations.⁴⁶ Relying again on a variety of historical sources,⁴⁷ the Court concluded that a prior opportunity to cross-examine was a “dispositive” requirement for admissibility of testimonial statements from unavailable declarants.⁴⁸

D. The Abrogation of *Ohio v. Roberts*

Armed with this historically based two-pronged requirement of unavailability and a prior opportunity to cross-examine, Justice Scalia began the eulogy of *Roberts*’s “malleable standard” of mere “reliability” for the admissibility of testimonial hearsay.⁴⁹ Noting that the *Roberts* test is simultaneously both too broad and too narrow,⁵⁰ the Court found that the “framework is so unpredictable that it fails to provide meaningful protection from even core confrontation violations.”⁵¹ Indeed, the Court criticized this flaw as the “unpardonable vice of the *Roberts* test.”⁵² The Court explained that, while the Confrontation Clause’s “ultimate goal is to ensure reliability of evidence,...it is a procedural rather than a substantive guarantee. It commands, not that evidence be reliable, but that reliability be assessed in a particular manner: by testing in the crucible of cross-examination.”⁵³ Because the

Roberts test “allows a jury to hear evidence, untested by the adversary process, based on a mere judicial determination of reliability . . . [i]t thus replaces the constitutionally prescribed method of assessing reliability with a wholly foreign one.”⁵⁴

Finally, applying its historically based analysis and holding, the Court concluded that Sylvia’s recorded statement, knowingly given in response to structured police questioning, fell within any conceivable definition of “interrogation” and, therefore, qualified as testimonial hearsay.⁵⁵ Because the defendant had not had the opportunity to cross-examine Sylvia, the Court held that the admission of Sylvia’s statement violated the defendant’s Sixth Amendment right to confrontation and accordingly, reversed the judgment of the Washington Supreme Court.⁵⁶

II. *Commonwealth v. Gonsalves*: The Supreme Judicial Court Adopts an Expansive Interpretation of *Crawford*

In *Commonwealth v. Gonsalves*,⁵⁷ the Supreme Judicial Court (“SJC”) offered its first interpretation of the Confrontation Clause in light of *Crawford*.⁵⁸ *Gonsalves* involved an altercation between a 20-year-old complainant and her boyfriend.⁵⁹ The complainant’s mother heard an argument between the defendant and her daughter, who were in the daughter’s bedroom.⁶⁰ The argument involved screaming, yelling and crying.⁶¹ When the mother went to her daughter’s bedroom to find out what was happening, she found her daughter crying on her bed and the defendant gone.⁶² When she asked her daughter what had happened, her daughter responded that “she and the defendant had argued, that he had grabbed the front of her shirt so tight she could not breathe, and that he had hit her.”⁶³

Although neither the complainant nor her mother had telephoned the police, the police arrived about 10 to 15 minutes later in response to a dispatch for a domestic disturbance.⁶⁴ The officers found the complainant hysterical, hyperventilating, crying and pacing about the room.⁶⁵ Because the defendant already had left, the court concluded there was no longer an “active conflict.”⁶⁶ One of the responding officers asked the victim what had happened and spoke with her

44. *Crawford*, 541 U.S. at 68.

45. *Id.* at 53-54.

46. *Id.* at 54.

47. *See id.* at 54-57 & nn.5-6.

48. *Id.* at 55.

49. *Id.* at 60.

50. *Id.*

51. *Id.* at 63.

52. *Id.*

53. *Id.* at 61. “The Clause reflects a judgment, not only about the desirability of reliable evidence . . . but about how reliability can best be determined.” *Id.*

54. *Id.* at 62. Indeed, Justice Scalia quipped that “[d]ispensing with confrontation because testimony is obviously reliable is akin to dispensing with jury trial because a defendant is obviously guilty. This is not what the Sixth Amendment prescribes.”

Id.

55. *Id.* at 53 n.4, 61.

56. *Id.* at 68.

57. 445 Mass. 1 (2005), *cert. denied*, 126 S. Ct. 2980 (2006).

58. *Id.* at 3.

59. *Id.*

60. *Id.*

61. *Id.*

62. *Id.*

63. *Id.*

64. *Id.* at 4.

65. *Id.*

66. *Id.*

for five minutes or less.⁶⁷ In response to the officer's questioning, the complainant gave a physical description of the defendant and described how he had assaulted her.⁶⁸

The commonwealth charged the defendant with assault and battery and assault and battery by means of a dangerous weapon.⁶⁹ At a preliminary hearing,⁷⁰ the commonwealth's motion *in limine* to admit the complainant's out-of-court statements to the police, under the "spontaneous utterance" exception to the hearsay rule, was allowed.⁷¹ Following the issuance of the *Crawford* decision, but before trial, the defendant moved for reconsideration of the allowance of the motion *in limine* admitting the complainant's statements as excited utterances.⁷² The complainant invoked her privilege under the Fifth Amendment and therefore was "unavailable" to testify at trial.⁷³ After a non-evidentiary hearing, the trial judge vacated his prior ruling, finding that the complainant's statements "were clearly 'testimonial' and were made in response to interrogation," and concluded that the statements were inadmissible under *Crawford*.⁷⁴ The commonwealth filed an application for interlocutory review of the ruling, and the case was transferred to the SJC.⁷⁵

A. Evisceration of the Spontaneous Utterance Exception to the Hearsay Rule: The Testimonial Per Se and the Testimonial In Fact Analytical Framework

In an opinion authored by Justice Francis X. Spina, the SJC devised expansive definitions of the key terms "testimonial" and "interrogation," which the Supreme Court had left so "conspicuously"⁷⁶ undefined in *Crawford*,⁷⁷ and fashioned an analytical framework for use by Massachusetts courts in deciding whether out-of-court statements

of an unavailable declarant are admissible in light of *Crawford*.⁷⁸ The court held that "interrogation"⁷⁹ "must be understood expansively to mean *all law enforcement questioning* related to the investigation or prosecution of a crime."⁸⁰ Accordingly, *all* responses to questioning by "law enforcement agents, whether police, prosecutors, or others acting directly on their behalf"⁸¹ are considered *per se* "testimonial," and therefore inadmissible, unless the declarant is either available to testify at trial or was previously subject to cross-examination.⁸² The court allowed for only two exceptions to its *per se* rule of inadmissibility for statements that are the product of law enforcement interrogation: (1) questioning by law enforcement officials to secure a volatile scene; and (2) questioning by law enforcement officials to establish the need for or to provide medical care.⁸³ The court reasoned that such questioning is not "interrogation" as the term is colloquially understood, but rather is part of the government's "community caretaking function, 'totally divorced from the detection, investigation, or acquisition of evidence relating to the violation of a criminal statute.'"⁸⁴

With respect to statements that are *not* the product of interrogation,⁸⁵ the court further broadened its interpretation of *Crawford* and held that such statements nonetheless will run afoul of the Confrontation Clause if the statements are "testimonial in fact."⁸⁶ Adopting the approach articulated by the United States Court of Appeals for the Sixth Circuit in *United States v. Cromer*,⁸⁷ the SJC explained that statements are testimonial in fact if "a reasonable person in the declarant's position would anticipate the statements being used against the accused in investigating and prosecuting a crime."⁸⁸ If the statement is testimonial in fact, the Confrontation Clause applies, and the statement is likewise inadmissible unless the

67. *Id.*

68. *Id.*

69. *Id.*

70. The preliminary hearing took place prior to the Supreme Court's issuance of *Crawford*. See *id.*

71. *Id.* at 4-5. Although the complainant was available to testify, only the complainant's mother and one police officer testified at the preliminary hearing. *Id.*

72. *Id.* at 5.

73. *Id.*

74. *Id.* (It is unclear from the opinion whether the trial judge distinguished the complainant's statements to her mother from her statements to the police.)

75. *Id.*

76. *Id.* at 18 (Sosman, J., concurring in part). As discussed below, see *infra* Part II. A.1., Justice Martha B. Sosman wrote separately, agreeing that the case needed to be remanded to specifically address the requirements of *Crawford*, but pointedly disagreeing with the majority's interpretation of those requirements. *Id.* at 20. For example, Justice Sosman noted that "[f]ew courts have given *Crawford*'s undefined terms the extreme interpretation adopted today." *Id.* at 19.

77. See *supra* note 39.

78. Because the court's analysis was strictly based on interpretation of the Sixth Amendment's Confrontation Clause, future Supreme Court decisions clarifying *Crawford*'s key terms will affect the scope of the *Gonsalves* decision. See *infra* text accompanying note 262.

79. Although the court took into account the Supreme Court's guidance to use the

term "interrogation" "in its colloquial, rather than any technical legal, sense," the court nevertheless added that it should rely on "everyday, common understandings of the term, *both* in the general public *and* the legal community." *Gonsalves*, 445 Mass. at 7 (emphasis added). Ironically, the court seems to have strictly relied upon the technical, legal definition by incorporating a third definition of interrogation from Black's Law Dictionary of "investigatory interrogation," which includes "[r]outine, nonaccusatory questioning by the police of a person who is not in custody." *Id.* at 8-9 (citing BLACK'S LAW DICTIONARY 838 (8th ed. 2004)).

80. *Gonsalves*, 445 Mass. at 8 (emphasis added). The court reasoned that limiting testimonial statements to "formal, solemnized, recorded accounts" would lead to circumvention of the Confrontation Clause "by encouraging law enforcement personnel to take elaborate statements informally, as far from the court and the station house as possible." *Id.*

81. *Id.* at 9.

82. *Id.* See *Commonwealth v. Sena*, 441 Mass. 822, 833 (2004) (holding that as long as defendant had opportunity to cross-examine, it is irrelevant whether the prior cross-examination had covered all possible grounds for impeachment that counsel would like to have pursued at trial).

83. *Gonsalves*, 445 Mass. at 9.

84. *Id.* (quoting *Commonwealth v. Evans*, 436 Mass. 369, 372 (2002)).

85. This includes "out-of-court statements made in response to questions from people who are *not* law enforcement agents, and statements offered spontaneously, without prompting, regardless of who heard them." *Id.* at 11.

86. *Id.* at 10-11.

87. *United States v. Cromer*, 389 F.3d 662, 675 (6th Cir. 2004).

88. *Gonsalves*, 445 Mass. at 12-13.

declarant is available to testify or has previously been subject to cross-examination.⁸⁹

In light of the court's expansive definition of "testimonial statements," the court cautioned that "judges of the Commonwealth must remain engaged gatekeepers, evaluating any out-of-court statements offered without the benefit of confrontation," first determining whether the statement is *per se* testimonial, (which would end the inquiry) and, if not, then conducting a further "fact-specific inquiry" to determine if the statement is nonetheless testimonial in fact.⁹⁰

Applying this analytical framework⁹¹ to the case, the court indicated that if the record before it were complete and final,⁹² the statements made by the complainant to the police would be deemed the product of investigatory interrogation and, therefore, inadmissible as *per se* testimonial statements.⁹³ The court reasoned that neither exception applied: the defendant had left the premises so the scene was no longer volatile,⁹⁴ and the officer's questions had not been designed to establish the need for or to provide medical care.⁹⁵

Turning to the complainant's statements to her mother, however, the court deemed that the statements were not *per se* testimonial because they were not procured through law enforcement interrogation:⁹⁶ the statements were all made in response to the mother's questions before the police arrived; neither the mother nor the complainant called the police; nor were they aware that the police had even been called.⁹⁷ In evaluating the statements on a fact-specific basis to determine whether the statements were testimonial in fact, the court found that there was no reason to believe that a reasonable person in the complainant's position would have anticipated that the statements would be used against the defendant in a subsequent criminal proceeding.⁹⁸ Accordingly, the complainant's statements to her mother would be admissible at trial, subject only to the traditional rules of evidence.⁹⁹

1. Assessing the Effect of the SJC's Expansive Interpretation of *Crawford* on Prosecutions

In a partially concurring opinion, Justice Martha B. Sosman criticized the "extreme" position adopted by the court.¹⁰⁰ Justice Sosman lamented that the court's "all-encompassing definition" of "testimonial" essentially includes anything said to law enforcement or government officials pertaining to any form of criminal activity.¹⁰¹ Justice Sosman reasoned that a reasonable person would anticipate that providing information to a government official regarding criminal conduct will almost always engender at least an investigation that would lead to prosecution if substantiated.¹⁰² She aptly emphasized that the formulations alluded to in *Crawford*¹⁰³ were limited to the "historical evil" the Confrontation Clause was meant to address, namely *ex parte* examinations and "formalized testimonial material" that resembled those examinations.¹⁰⁴ Adoption of the Sixth Circuit's *Cromer* formulation, she opined, "completely disregards any element of formality, solemnity, or the like"¹⁰⁵ and "stray[s] beyond the guideposts that *Crawford* itself has provided."¹⁰⁶

Additionally, Justice Sosman criticized the two exceptions carved out by the court, (i.e., questions meant to secure a volatile scene or to establish the need for medical care),¹⁰⁷ as "arbitrary, unsupported by any language in *Crawford*, and unrelated to the purposes served by the [C]onfrontation [C]lause..."¹⁰⁸ She predicted that courts would become mired in attempting to discern when law enforcement's "community caretaking" role had evolved into the investigation of crime, since police frequently perform both roles simultaneously.¹⁰⁹ For example, she noted that questions about what injuries a victim may have sustained may be asked both to assess the need for medical care and for investigatory purposes; the admissibility of the response should not hinge on the fortuity that the crime under investigation happens to involve some aspect of the police caretaking function.¹¹⁰ In

89. *Id.* at 13.

90. *Id.*

91. A decisional flowchart that illustrates the SJC's analytical framework, originally devised by Middlesex Assistant District Attorney Michael Fabbri, chief of the Framingham Superior Court division, and since modified to reflect the Supreme Court's most recent decisions, is appended to this article.

92. *Gonsalves*, 445 Mass. at 17. The court, however, noted, that the record remained open and the parties could clarify the nature of the hearsay statements at issue through further proceedings. *Id.*

93. *Id.* at 17-18.

94. *Id.* at 16.

95. *Id.* at 17.

96. *Id.* at 17-18. The court noted that "[i]t will be rare for a statement made by one private citizen to another to be considered to be police interrogation." *Id.* at 17 (citing *Commonwealth v. Snyder*, 413 Mass. 521, 531-532 (1992) (private citizen not acting as agent of police for purposes of eliciting statements is not involved in police interrogation)).

97. *Id.* at 17.

98. *Id.* at 18. The court noted that the complainant made the statements to her mother in the complainant's own bedroom, without any knowledge that the police would become involved, and that the mother procured the statements to understand what happened, not to establish a basis for prosecution. *Id.*

99. *Id.*

100. *Id.* at 19. (Sosman, J., concurring in part).

101. *Id.* at 29.

102. *Id.*

103. *See supra* text accompanying notes 39-44.

104. *Gonsalves*, 445 Mass. at 30-31 (Sosman, J., concurring in part).

105. *Id.* at 31.

106. *Id.* at 32.

107. *See supra* text accompanying notes 83-84.

108. *Gonsalves*, 445 Mass. at 23 (Sosman, J., concurring in part).

109. *Id.* at 24.

110. *Id.* at 23-24.

contrast to the court's holding, Justice Sosman would have followed the "emerging majority view"¹¹¹ in holding that "police interrogation" does not encompass the basic, immediate, on-scene questioning of persons present in an attempt to get the gist of what is happening or has just happened, i.e., to ascertain why police were called to the scene and what steps need to be taken in response."¹¹²

Finally, Justice Sosman discussed the ramifications of the court's "overly broad definitions of 'testimonial'" on domestic violence cases, noting that the "unnecessarily expansive interpretation of *Crawford*" will hamper the ability of the criminal justice system to address these crimes, particularly because of the negative impact on the ability to admit spontaneous utterances in evidence absent a testifying victim.¹¹³

2. Applications of the *Gonsalves* Framework: *Commonwealth v. Foley*, *Commonwealth v. Rodriguez*, *Commonwealth v. Tang*, and *Commonwealth v. DeOliveira*

The same day the SJC issued the *Gonsalves* decision, it issued its opinions in two companion cases: *Commonwealth v. Foley*¹¹⁴ and *Commonwealth v. Rodriguez*.¹¹⁵ Like *Gonsalves*, *Foley* involved police officers summoned to the scene of an alleged domestic violence incident.¹¹⁶ An officer entered the defendant's home and found it in disarray.¹¹⁷ The officer observed the adult victim and four children crouched on a bed in apparent fear.¹¹⁸ The officer asked, "Where is he?" and one of the children gestured towards the bathroom, where police found the defendant hiding.¹¹⁹ Another officer then took the defendant into custody.¹²⁰ After the defendant was taken into custody, the officer asked the victim whether she needed medical care.¹²¹ The officer then remained with the victim for approximately 45 minutes, attempting to convince the victim to explain to him what had

happened.¹²² Eventually, the victim identified the defendant as her assailant and provided a detailed description of the assault.¹²³ At trial, the victim invoked her marital privilege and therefore was unavailable to testify.¹²⁴

Applying the *Gonsalves* framework, the court held that the officer's initial question to the victim, "Where is he?", was not interrogation (and therefore the victim's response was not testimonial per se) because the officer had asked the question as part of the officer's community caretaking function in securing a volatile scene.¹²⁵ The officer's question whether the victim needed an ambulance or medical attention also was not "interrogation," and the response therefore was not testimonial per se, because the question had been part of his community caretaking function in determining the need for medical care.¹²⁶ Moreover, the court held that the declarant's responses to these preliminary questions were not testimonial in fact, because a reasonable person in the declarant's position would not have anticipated that the statement would be used against the defendant in future criminal proceedings.¹²⁷ By contrast, however, the court held that the statements made by the victim, after the scene was secure and the victim had assured police that she did not want medical attention, while the officer attempted to have the victim explain what had happened, were the product of "investigatory interrogation."¹²⁸ Accordingly, those statements were testimonial per se and inadmissible under *Gonsalves*.¹²⁹

*Commonwealth v. Rodriguez*¹³⁰ involved the police response to a 911 domestic disturbance call.¹³¹ The defendant's daughter called 911 after her father physically assaulted her brother in the home.¹³² The defendant described the incident to the police on the scene as "a couple of slaps," but the defendant's daughter and son both offered extensive details about the assault, including allegations that went well beyond a couple of slaps.¹³³ The police observed only one red mark on

111. *Id.* at 25-26 (citing *Mungo v. Duncan*, 393 F.3d 327, 336 n. 9 (2d Cir. 2004), *cert. denied sub nom.* *Mungo v. Greene*, 544 U.S. 1002 (2005) (initial questioning at scene, during pursuit, and immediately after apprehension of suspects not "interrogation," but victim's statements probably became "testimonial" when officer pressed victim for additional clarification of his ambiguous identification, as that line of questioning entailed "greater formality with a view to creating a record and proving charges"); *Anderson v. State*, 111 P.3d 350, 356 (Alaska Ct.App. 2005) ("excited response to brief on-the-scene questioning by police officers" not "testimonial"); *People v. Corella*, 18 Cal.Rptr.3d 770, 776 (Cal. Ct. App. 2004) (preliminary questions at scene shortly after crime is "an unstructured interaction," not "interrogation"); *Hammon v. State*, 829 N.E.2d 444, 457 (Ind. 2005) ("responses to initial inquiries by officers arriving at a scene are typically not testimonial"); *State v. Hembertt*, 696 N.W.2d 473, 483-84 (Neb. 2005) (victim's statement to police on arrival not "testimonial," but subsequent interview of victim after suspect apprehended properly excluded as "testimonial"); *Key v. State*, 173 S.W.3d 72, 75 (Tex. App. 2005) ("initial police-victim interaction at the scene of an incident is not an interrogation").

112. *Id.* at 19.

113. *Id.* at 36-37.

114. 445 Mass. 1001 (2005) (rescript), *cert. denied*, 126 S.Ct. 2980 (2006).

115. 445 Mass. 1003 (2005) (rescript), *cert. denied*, 126 S.Ct. 2979 (2006).

116. *Foley*, 445 Mass. at 1001.

117. *Id.*

118. *Id.*

119. *Id.*

120. *Id.*

121. *Id.*

122. *Id.*

123. *Id.*

124. *Id.*

125. *Id.* at 1002.

126. *Id.*

127. *Id.*

128. *Id.*

129. *Id.*

130. 445 Mass. 1003 (2005) (rescript), *cert. denied*, 126 S.Ct. 2979 (2006).

131. Note that in *Gonsalves*, the SJC specifically left the treatment of emergency 911 telephone calls "for a future appropriate case," *Gonsalves*, 445 Mass. at 9 n.4, and rejected Justice Sosman's analysis in her partial concurrence that, based on the broad interpretation of the majority, 911 calls would certainly be swept into the ambit of testimonial in fact and would therefore "inescapably qualify as 'testimonial.'" *Id.* at 32-33 n.7.

132. *Rodriguez*, 445 Mass. at 1003.

133. *Id.*

the son and did not observe any other bruises or apparent injuries.¹³⁴ Neither the son nor the daughter testified at trial, but their on-scene statements were admitted as spontaneous utterances.¹³⁵ The court ruled that the admission of the statements violated the defendant's Sixth Amendment confrontation rights.¹³⁶ The court found that because the scene was secure when the police arrived, and the son had no apparent injuries and did not want emergency medical attention, the statements were made in response to investigatory interrogation and therefore were testimonial per se.¹³⁷

In a more recent case, the Massachusetts Appeals Court held in *Commonwealth v. Tang*¹³⁸ that the on-scene, frantic and spontaneous statements to police by a five-year-old boy, who had just witnessed his father, the defendant, twice fire a gun inside the house and engage in a bloody fight with his uncle, were neither testimonial per se nor testimonial in fact.¹³⁹ The court reasoned that the police questions to the five-year-old were posed during an emergency scenario, while the police were securing a volatile scene, and that the boy's statements implicating the defendant were not even responsive to the questions of "Who else is in the house?"¹⁴⁰ Moreover, the court held that it "is almost inconceivable that, moments after such an event, a child in [the boy's] condition — described as essentially frantic — could have spoken in contemplation of a future legal proceeding."¹⁴¹ The court's holding is noteworthy because it accounts for the age of the declarant when considering the attributes of a "reasonable person in the declarant's position."¹⁴²

In *Commonwealth v. DeOliveira*,¹⁴³ the SJC addressed the continued viability, in the wake of *Crawford*, of the hearsay exception for statements made for the purpose of medical diagnosis and treatment.¹⁴⁴ Such statements have long been admissible in Massachusetts as common-law exceptions to the hearsay rule,¹⁴⁵ and medical records containing such statements are statutorily admissible pursuant to section 79 of Massachusetts General Laws chapter 233.¹⁴⁶

DeOliveira involved the admissibility of a sexual abuse disclosure to a medical doctor by a child, who was not available to testify at trial.¹⁴⁷ A social worker went to the six-year-old victim's house to investigate alleged abuse.¹⁴⁸ The victim told the social worker in child's terms that she had been anally, vaginally and orally raped.¹⁴⁹ The social worker contacted the police, who took the victim and her mother to the emergency room for a sexual abuse assessment after the mother obtained an emergency protective order.¹⁵⁰ At the hospital, a doctor specializing in emergency pediatric medicine asked the victim what had happened to her.¹⁵¹ She told the doctor that "daddy had put his penis in . . . here, here, and here," pointing to her mouth, vagina and rectum.¹⁵² Although the doctor knew that the police had brought the victim to the emergency room in response to an alleged sexual assault, he testified that he worked "[a]bsolutely independently of the police" and that he examined the victim to determine whether she had been injured by sexual abuse and needed medical attention.¹⁵³

The commonwealth charged the defendant with forcible anal, oral and vaginal rape of a child,¹⁵⁴ but brought the defendant to trial solely on the anal rape charge, because the defendant had confessed to that charge and because his confession was corroborated both by the victim's statement to the emergency room physician and by the physician's medical observations of the victim.¹⁵⁵ The defendant moved to exclude the victim's statement to the emergency room doctor on the ground that the statement was testimonial within the meaning of *Crawford*.¹⁵⁶ The defendant argued that, notwithstanding the historical admissibility of such statements as exceptions to the hearsay rule, the victim's statement was "testimonial" in nature.¹⁵⁷ The defendant contended that, because the victim was unavailable to testify at his trial, the admission of her statement against him would violate his rights under the Sixth Amendment's Confrontation Clause as interpreted in *Crawford*.¹⁵⁸ After an evidentiary hearing, the trial judge ruled the victim's statement inadmissible testimonial hearsay because it had been made during an evaluation for sexual abuse that

134. *Id.*

135. *Id.*

136. *Id.* at 1004.

137. *Id.*

138. 66 Mass. App. Ct. 53 (2006). Benjamin Bejar, one of the article's co-authors, argued the case before the Appeals Court on behalf of the commonwealth.

139. *Id.* at 59-61.

140. *Id.* at 60.

141. *Id.* at 60-61.

142. See *Gonsalves*, 445 Mass. at 12-13. See also *supra* text at notes 87-88 and *infra* text accompanying notes 164-68.

143. 447 Mass. 56 (2006). Thomas D. Ralph, one of the article's co-authors, argued the case before the SJC on behalf of the commonwealth.

144. *Id.* at 62-65.

145. See *Commonwealth v. Comtois*, 399 Mass. 668, 675 (1987) ("It has long been the rule in the Commonwealth that physicians may testify as to statements of past pain, symptoms, and conditions made to them when they were consulted by

a declarant for purposes of diagnosis or treatment.") (citing *Barber v. Merriam*, 11 Allen 322, 324-25 (Mass. 1865)).

146. See *Commonwealth v. Lampron*, 65 Mass. App. Ct. 340, 345-46 (2005).

147. *DeOliveira*, 447 Mass. at 56-57.

148. *Id.* at 59.

149. *DeOliveira*, 447 Mass. at 56, 59. The statements to the social worker are hearsay and were not at issue on appeal. *Id.* at 60 n.3.

150. *Id.* at 59-60.

151. *Id.* at 60-61.

152. *Id.*

153. *Id.*

154. *Id.* at 61.

155. *Id.*

156. *Id.* at 57, 61.

157. *Id.* at 62.

158. *Id.* at 57.

was part of a criminal investigation, and the police were present at the hospital and had spoken with the doctor prior to his examination.¹⁵⁹

The SJC transferred the case to its docket following the grant of the commonwealth's application for interlocutory appeal.¹⁶⁰ The court observed that the analytical framework that it had created in *Gonsalves* "easily" resolved the case.¹⁶¹ It held that the victim's statement was not testimonial per se because it had not been made in response to police questioning.¹⁶² The court reasoned that "police presence at a hospital cannot turn questioning of a patient by a physician during a medical examination into interrogation by law enforcement."¹⁶³ The court also held that the statement was not testimonial in fact because a reasonable person in the six-year-old victim's position would not have anticipated that the statement could have been used against the defendant at trial.¹⁶⁴

Despite the apparent ease with which it decided the narrow question before it, the SJC struggled with the broader question of whether a statement by a child could ever be testimonial. The court noted that its "reasonable person" standard allows the court to consider all of the facts in a given situation, including the "lack of knowledge or sophistication that is attributable to age."¹⁶⁵ The court also noted that "[l]ogic informs that a six-year-old child can have little or no comprehension of a criminal prosecution in which the child's words might be introduced as evidence against another person in a court of law."¹⁶⁶

The court, however, declined to adopt a blanket exception for the admissibility of statements by an unavailable young child, opting instead to follow a "case-by-case approach" to the issue.¹⁶⁷ Whether a reasonable child in the declarant's position would have reasonably believed that the statement would be used at a later trial, therefore, must be considered in light of the totality of the circumstances.¹⁶⁸ But since the court did not indicate any way by which its "case-by-case approach" could ever lead to a different result, then absent extraordinary circumstances, it appears that statements made by young children to civilians will likely be deemed nontestimonial hearsay within the meaning of *Crawford* and, therefore, admissible even when the child is unavailable to testify.

Notably, the court expressly left open the question of whether

statements made to a medical professional by an adult would be considered testimonial in fact and therefore inadmissible pursuant to *Crawford*.¹⁶⁹ Because the testimonial-in-fact framework under *Gonsalves* depends on objective criteria of what "a reasonable person in the declarant's position"¹⁷⁰ would anticipate, the admissibility of such statements will ultimately turn on the facts and circumstances of each case. Massachusetts prosecutors and defense attorneys, therefore, may need to consider some of the following issues in motions in limine addressing the admissibility of such statements: the setting in which the statements were made; the formality of the interaction between the doctor and patient; the reason for the examination; the confidentiality of the interaction; whether a police investigation was ongoing at the time; and the temporal proximity between the making of the statements and the alleged crime.¹⁷¹

B. Limitations on the Applicability of *Crawford* and *Gonsalves*¹⁷²

Although the SJC expansively interpreted the bounds of *Crawford* in *Gonsalves*, Massachusetts appellate courts have also limited *Crawford*'s applicability in certain contexts. One such limitation is the adoption of the Supreme Court's doctrine of "forfeiture by wrongdoing."¹⁷³ In *Commonwealth v. Edwards*,¹⁷⁴ the SJC held that when a defendant engages in wrongdoing that results in a witness's failure to testify, the defendant forfeits the right to challenge on hearsay grounds the admissibility of evidence that would have been presented against the defendant by the witness.¹⁷⁵ The court laid out a three-step analysis for determining the applicability of the doctrine: (1) the witness must be unavailable; (2) the defendant must have caused or been involved in procuring the unavailability of the witness; and (3) the defendant's conduct in causing the witness's unavailability must have been intentional.¹⁷⁶ The court held that even mere collusion between the defendant and the witness suffices to trigger the applicability of the doctrine, and the defendant's conduct need not rise to the level of criminality.¹⁷⁷ This doctrine may provide the prosecution with a powerful tool to obtain the admission of hearsay statements in cases involving gang violence and domestic abuse.¹⁷⁸

159. *Id.* at 62.

160. *Id.* at 57.

161. *Id.* at 63.

162. *Id.* at 64.

163. *Id.*

164. *Id.* at 65.

165. *Id.* at 65 n.11.

166. *Id.* at 64. The court recognized that if "logic informs" that a six-year-old child cannot understand that her statements might be introduced against another person in a court of law, then every out-of-court statement made by a young child to someone other than a law enforcement officer would seem to be nontestimonial. *Id.* Compare *Tang*, 66 Mass. App. Ct. at 60-61; see *supra* text accompanying notes 138-42.

167. *DeOliveira*, 447 Mass. at 64 n.10.

168. *Id.* at 65 & n.11.

169. *Id.* at 67.

170. *Id.* at 64 (quoting *Gonsalves*, 445 Mass. at 12-13).

171. See *id.* at 64 n.11.

172. For a listing and summary of proceedings that are not affected by *Crawford*, see generally Allie Phillips, *Out of Harm's Way: Hearings that are Safe from the Impact of Crawford v. Washington (Parts 1 & 2)*, 18 UPDATE NO. 8 (American Prosecutors Research Institute 2005).

173. See cases cited *supra* note 28. The Supreme Court first adopted the doctrine in *Reynolds v. United States*, 98 U.S. 145, 158 (1878) ("The Constitution gives the accused the right to a trial at which he should be confronted with the witnesses against him; but if a witness is absent by [the defendant's] own wrongful procurement, he cannot complain if competent evidence is admitted to supply the place of that which he has kept away.").

174. 444 Mass. 526 (2005).

175. *Id.* at 541.

176. *Id.*

177. *Id.*

178. See, e.g., *United States v. Montague*, 421 F.3d 1099, 1102, 1104 (10th Cir. 2005) (notwithstanding *Crawford*, statements admitted against defendant in domestic violence case under doctrine of forfeiture by wrongdoing); *United States v. Mayhew*, 380 F. Supp.2d 961, 966 (S.D. Ohio 2005) (notwithstanding *Crawford*, statements admitted against defendant when defendant had killed witness).

In *Commonwealth v. Given*,¹⁷⁹ the SJC clarified that *Crawford* does not govern the admissibility of hearsay statements in proceedings to commit offenders as sexually dangerous persons, because such proceedings are civil in nature and therefore do not implicate the Confrontation Clause.¹⁸⁰ In *Commonwealth v. Wilcox*,¹⁸¹ the SJC followed the lead of every United States circuit court of appeals that has considered the issue,¹⁸² and held that *Crawford* is not applicable to probation revocation proceedings.¹⁸³ The SJC reasoned that *Crawford* is inapplicable because, by its own terms, it applies solely to “criminal prosecutions,” and probation revocation proceedings are not a stage of a criminal prosecution.¹⁸⁴

In *Commonwealth v. Sena*,¹⁸⁵ the SJC reiterated that *Crawford* is applicable only if the declarant is not available at the time of trial and the declarant has not previously been subject to cross-examination.¹⁸⁶ The court found it irrelevant whether the prior cross-examination had covered all possible grounds for impeachment that counsel would like to have pursued at trial.¹⁸⁷ In *Commonwealth v. Verde*,¹⁸⁸ the court held that *Crawford*'s prohibitions do not apply to certificates of chemical analysis in drug cases.¹⁸⁹ Similarly, in *Commonwealth v. Lampron*,¹⁹⁰ the Appeals Court held that hospital records containing toxicology results and admitted pursuant to section 79 of Massachusetts General Laws chapter 233 were not subject to a Confrontation Clause challenge because the statements in the records were neither the product of interrogation by government officials nor would the declarant have anticipated their being used against a defendant in the investigation and prosecution of the crime.¹⁹¹ Lastly, in *Commonwealth v. Crapps*,¹⁹² the Appeals Court held that a defendant's record of conviction, certified pursuant to section 76 of Massachusetts General Laws chapter 233, was admissible as a business record and not subject to the requirements of *Crawford*.¹⁹³

III. *Davis* and *Hammon*: The Supreme Court Hones Its “Conspicuously Undefined” Key Term of “Testimonial” in the Context of Emergency 911 Calls

In *Davis* and *Hammon*, the Supreme Court elaborated on the precise contours of the term “testimonial” that it left conspicuously

undefined in *Crawford*.¹⁹⁴ In those companion cases, Justice Scalia clarified the circumstances in which statements made to law enforcement personnel during an emergency 911 call or at a crime scene are “testimonial,” and therefore subject to the demands of the Sixth Amendment's Confrontation Clause as set forth in *Crawford*.¹⁹⁵

Davis involved an emergency 911 hang-up call.¹⁹⁶ When the 911 operator reversed the call and asked, “What's going on?,” the victim, who was hysterical and crying, responded, “He's here jumpin' on me again.”¹⁹⁷ The 911 operator then asked the victim several questions, including the identity of the assailant, whether there were any weapons involved, and the assailant's date of birth.¹⁹⁸ The victim identified her assailant as Adrian Davis and stated that Davis had beaten her with his fists and that he had “just run out the door.”¹⁹⁹ Officers arrived at the scene within four minutes of the call and observed the victim's shaken state, the fresh injuries on her forearm and face, and her frantic efforts to gather her belongings and her children so that they could leave the residence.²⁰⁰

At Davis's trial for felony violation of a no-contact order, the only witnesses called by the state were two officers who responded to the 911 call.²⁰¹ The victim did not appear at trial.²⁰² Over the defendant's Sixth Amendment objection, the trial court admitted the 911 tape recording in its entirety.²⁰³ Relying on *Ohio v. Roberts*,²⁰⁴ the Washington Court of Appeals affirmed, holding that the 911 call was properly classified as an excited utterance.²⁰⁵ While the case was on appeal to the Washington Supreme Court, the United States Supreme Court issued its decision in *Crawford*.²⁰⁶ The Washington Supreme Court, therefore, had to determine whether the victim's statements during the 911 call constituted “testimonial hearsay” under *Crawford*.²⁰⁷

The court used an analytical framework similar to that in *Gonsalves* and held that “the portion of [the victim's] 911 call that identified Davis as her assailant was nontestimonial and properly admitted” because it was part of an ongoing emergency situation and there was no evidence that she intended her statements to be used for the purposes of a later prosecution.²⁰⁸ With respect to the remaining statements made in the 911 call after Davis had fled, the

179. 441 Mass. 741 (2004).

180. *Id.* at 747 n. 9.

181. 446 Mass. 61 (2006).

182. *Id.* at 67-68.

183. *Id.*

184. *Id.*

185. 441 Mass. 822 (2004).

186. *Id.* at 832-33.

187. *Id.* at 833.

188. 444 Mass. 279 (2005).

189. *Id.* at 284.

190. 65 Mass. App. Ct. 340 (2005).

191. *Id.* at 345-46.

192. 64 Mass. App. Ct. 915 (2005) (rescript).

193. *Id.* at 916.

194. *Davis v. Washington*, 126 S.Ct. 2266 (2006).

195. *Id.* at 2270, 2273-74. Note that *Gonsalves* expressly left the treatment of

emergency 911 calls to a future appropriate case. *Gonsalves*, 445 Mass. at 9 n.4. See *supra* note 131 and text accompanying notes 130-37.

196. *Davis*, 126 S. Ct. at 2270-71.

197. *Id.* at 2271.

198. *Id.*

199. *Id.* Notably, only the victim's preliminary statements on the 911 call identifying Davis as the assailant were at issue before the Supreme Court. *Id.* at 2277.

200. *Id.* at 2271.

201. *Id.*

202. *Id.*

203. *Id.*

204. 448 U.S. 56 (1980).

205. See *State v. Davis*, 111 P.3d 844, 847 (Wash. 2005), *aff'd*, *Davis v. Washington*, 126 S. Ct. 2266 (2006).

206. *Id.*

207. *Id.* at 849.

208. *Id.* at 851.

court held their admission in evidence harmless because the victim's initial identification, the officers' observations of injuries, and the no-contact order provided overwhelming evidence in support of the jury's guilty finding.²⁰⁹

In *Hammon*, the police responded to a residence on a report of a domestic disturbance.²¹⁰ No evidence was adduced as to the time that elapsed between the making of the report and the officers' arrival at the scene.²¹¹ When the police arrived, they saw the victim sitting on a porch and appearing "somewhat frightened."²¹² In response to the officers' questions, the victim replied that "nothing was the matter."²¹³ She allowed the police to enter the house, where they observed the broken glass front of a gas heater, which was emitting flames.²¹⁴ The defendant was in the kitchen and stated, "that he and his wife had 'been in an argument' but 'everything was fine now' and the argument 'never became physical.'"²¹⁵ While one officer remained with the defendant, another went to the living room to speak with the victim and "again ask[ed] [her] what had occurred."²¹⁶ The victim told the officer that she and her husband had argued and that, during the argument, the defendant broke the glass front of the heater, threw her down, shoved her head into the broken glass and punched her in the chest twice.²¹⁷ The victim then filled out and signed an affidavit attesting to the battery.²¹⁸

At the defendant's bench trial for domestic battery, the victim did not appear even though she was subpoenaed by the state.²¹⁹ Over the defendant's objection, the trial judge allowed the officer who questioned the victim to testify to the victim's oral statements given at the scene and to authenticate the affidavit.²²⁰ The trial judge admitted the statements into evidence as excited utterances and admitted the affidavit as a present sense impression.²²¹ The trial judge found the defendant guilty of domestic battery.²²² The Indiana Court of Appeals affirmed the conviction, agreeing that the victim's oral statement was an excited utterance.²²³ After the *Crawford* decision was issued, the court of appeals reconsidered whether the victim's oral statements

were "testimonial."²²⁴ The court found that the statements were not testimonial within the meaning of *Crawford* because they lacked a formal quality and were not made in response to "interrogation."²²⁵ The court also found that the victim's affidavit was "cumulative" of her oral statements, so that any error in admitting it was harmless.²²⁶

The Indiana Supreme Court affirmed the conviction.²²⁷ In finding that the victim's statements were not "testimonial," the court interpreted *Crawford's* reference to statements made in "police interrogations" as "properly limited to attempts by police to pin down and preserve statements rather than efforts directed to determining whether an offense has occurred, protection of victims or others, or apprehension of a suspect."²²⁸ The court concluded that "responses to initial inquiries by officers arriving at a scene are typically not testimonial."²²⁹

The Supreme Court granted certiorari in *Davis* and *Hammon* to clarify when statements made to law enforcement personnel during a 911 call or at a crime scene are "testimonial" within the meaning of *Crawford* and are therefore subject to the requirements of the Sixth Amendment's Confrontation Clause.²³⁰ In *Davis*, the Court sought to more precisely set out the circumstances in which statements made to police officers constitute testimonial hearsay.²³¹ The Court held that such "statements are nontestimonial when made in the course of police interrogation under circumstances objectively indicating that the primary purpose of the interrogation is to enable police assistance to meet an ongoing emergency."²³² By contrast, the Court held that such statements are "testimonial when the circumstances objectively indicate that there is no such ongoing emergency, and that the primary purpose of the interrogation is to establish or prove past events potentially relevant to later criminal prosecution."²³³ The "primary purpose of the interrogation" as measured by the objective circumstances, therefore, is central to the Court's evaluation of whether a statement is testimonial.²³⁴ While this part of the Court's holding is partially analogous to the SJC's testimonial-per-se

209. *Id.* This portion of the court's holding was not challenged by *Davis* before the Supreme Court. *Davis*, 126 S. Ct. at 2277-78.

210. *Davis*, 126 S. Ct. at 2272.

211. *Hammon v. State*, 829 N.E.2d 444, 449 (Ind. 2005), *rev'd and remanded*, *Davis v. Washington*, 126 S. Ct. 2266 (2006).

212. *Davis*, 126 S. Ct. at 2272.

213. *Id.*

214. *Id.*

215. *Id.*

216. *Id.*

217. *Id.* at 2272-73.

218. *Id.* at 2272. The affidavit consisted of a standard form, which tracked the language of the battery statute. Under the section entitled "Describe the Acts," the victim wrote: "Broke our furnace and shoved me down on the floor into the broken glass and hit me in the chest and threw me down. Broke our lamps and phone. Tore up my van where I couldn't leave the house. Attacked my daughter." *Id.*

The victim signed the affidavit twice: once to acknowledge that the "investigating officer" was relying on her statements to establish probable cause for the defendant's arrest for battery, and once to affirm that the affidavit's statements were true, that she understood the offense of making a false statement, and that she was reporting a crime. Brief of Petitioner-Appellant at 2-3, *Hammon v. State*, 829 N.E. 2d 444 (Ind. 2005)(No. 05-5705).

219. *Davis*, 126 S. Ct. at 2272.

220. *Id.*

221. *Id.*

222. *Id.*

223. *Hammon v. State*, 809 N.E.2d 945, 949 (Ind. Ct. App. 2004), *aff'd*, 829 N.E.2d 444 (Ind. 2005), *rev'd and remanded*, *Davis v. Washington*, 126 S.Ct. 2266 (2006).

224. *Id.* at 951-52.

225. *Id.*

226. *Id.* at 948 n.1.

227. *Hammon*, 829 N.E.2d at 459.

228. *Hammon*, 829 N.E. 2d at 457.

229. *Id.* at 457.

230. *Davis*, 126 S. Ct. at 2270.

231. *Id.* at 2273.

232. *Id.*

233. *Id.* at 2273-74. The Court anticipated that trial courts, through in limine proceedings, would be able to discern when statements in response to interrogations become testimonial for Sixth Amendment purposes and accordingly, redact or exclude those portions. *Id.* at 2277.

234. *Id.* at 2273.

prong and the “securing a volatile scene” exception of the *Gonsalves* analytical framework, the holding appears to call into question the testimonial-in-fact prong of the framework, which focuses “on the declarant’s intent” in determining “whether a reasonable person in the declarant’s position would anticipate the statement’s [sic] being used against the accused” for prosecution.²³⁵ Nevertheless, in a recent opinion, the SJC declared that its “rationale in the *Gonsalves* decision is in accord with the Supreme Court’s decision in *Davis*,”²³⁶ and it applied the *Gonsalves* framework to resolve the issue before it.²³⁷

Additionally, the Supreme Court in *Davis* refined the definition of “interrogation” that it set out in *Crawford*.²³⁸ Unlike the SJC’s expansive interpretation of “interrogation” in *Gonsalves*, encompassing all law enforcement questioning related to the investigation of crime so that all responses to such questioning are testimonial *per se*,²³⁹ the Supreme Court held that the existence of interrogation is not determinative of whether statements are testimonial.²⁴⁰ In *Davis*, Justice Scalia narrowed the broad-brush approach taken in *Crawford* that “interrogations by law enforcement officers fall squarely within [the] class of testimonial hearsay”²⁴¹ by explaining that in *Crawford*, the Court:

had immediately in mind (for that was the case before us) interrogations solely directed at establishing the facts of a past crime, in order to identify (or provide evidence to convict) the perpetrator. The product of such interrogation, whether reduced to a writing signed by the declarant or embedded in the memory (and perhaps notes) of the interrogating officer, is testimonial.²⁴²

Unlike *Crawford*, *Davis* dealt with a crime occurring while the victim provided responses to the 911 operator’s questions.²⁴³ The Court noted that “a 911 call . . . is ordinarily not designed primarily to ‘establis[h] or prove[e]’ some *past* fact, but to describe *current* circumstances requiring police assistance.”²⁴⁴

In refining its definition of interrogation, the *Davis* Court highlighted four main factual differences between the interrogation

in *Crawford* and that in *Davis*.²⁴⁵ First, in *Davis*, the victim was speaking about events *as they were actually happening*, rather than “describ[ing] past events” as the declarant did in *Crawford*.²⁴⁶ Second, any reasonable listener would recognize that the victim (unlike the declarant in *Crawford*) was facing an ongoing emergency.²⁴⁷ Third, the nature of the dispatcher’s²⁴⁸ questions and the victim’s answers in *Davis* were necessary to resolve the present emergency, rather than to simply learn what happened in the past, as in *Crawford*.²⁴⁹ And fourth, the Court found the difference in the “level of formality” between the two interviews “striking”: Unlike the victim in *Davis*, whose answers were frantic and provided over the phone in a non-tranquil, unsafe environment, the declarant in *Crawford* responded calmly to a series of questions during police interrogation.²⁵⁰ The Court concluded, therefore, that the circumstances of the 911 call in *Davis* objectively indicated that its primary purpose was to enable police assistance to meet an ongoing emergency; the victim was not acting as a witness and was not “testifying.”²⁵¹ Accordingly, the Court affirmed the Washington Supreme Court’s holding that the victim’s statements to the 911 operator were not testimonial and were properly admitted.²⁵²

Hammon, however, dealt with statements made to officers responding to a domestic incident that occurred *before* the police arrived at the scene.²⁵³ The Court noted that the circumstances of the statements were not much different from those in *Crawford*.²⁵⁴ The Court found it “entirely clear” from the circumstances that the interrogation in *Hammon* was part of an investigation into possibly criminal *past* conduct; there was no emergency in progress.²⁵⁵ The Court concluded that “[o]bjectively viewed, the primary, if not indeed the sole, purpose of the interrogation was to investigate a possible crime”²⁵⁶ Accordingly, the Court found the victim’s statements to be “inherently testimonial” because the victim was actively separated from the defendant, she deliberately recounted the potentially criminal past events in response to police questioning, and she did so some time after the events described concluded.²⁵⁷ The Court rejected the Indiana Supreme Court’s reasoning that virtually any “initial inquiry” at a crime scene will not be testimonial

235. *Gonsalves*, 445 Mass. at 12-13. See *infra* note 290 and accompanying text. The *Davis* Court, however, clarified that its holding does *not* imply “that statements made in the absence of any interrogation are necessarily nontestimonial.” *Davis*, 126 S. Ct. at 2274 n.1. The Court noted that, “of course even when interrogation exists, it is in the final analysis the declarant’s statements, not the interrogator’s questions, that the Confrontation Clause requires us to evaluate.” *Id.*

236. *Commonwealth v. Burgess*, No. SJC-09473, 2008 Mass. LEXIS 10, at *1, *15 (Mass. Jan. 11, 2008).

237. *Id.* at *15-*23.

238. *Davis*, 126 S. Ct. at 2276.

239. *Gonsalves*, 445 Mass. at 8-9.

240. *Davis*, 126 S. Ct. at 2276.

241. *Crawford*, 541 U.S. at 53.

242. *Davis*, 126 S. Ct. at 2276.

243. *Id.* at 2270-71.

244. *Id.* at 2276 (emphasis added).

245. *Id.*

246. *Id.* (quoting *Lilly v. Virginia*, 527 U.S. 116, 137 (1999) (plurality opinion)).

247. *Id.*

248. Although the issue of whether 911 operators may be considered law enforcement officers for purposes of interrogation was not before the Court, the Court noted that even “if 911 operators are not themselves law enforcement officers, they may at least be agents of law enforcement when they conduct interrogations of 911 callers.” *Id.* at 2274 n.2. Without deciding the issue, the Court considered the 911 operator’s acts to be acts of the police. *Id.*

249. *Id.* at 2276. The Court found this to be true even of the operator’s effort to obtain the identity of the assailant and whether any weapons were involved so the dispatched officers would know whether they would be encountering a violent felon. *Id.*

250. *Id.* at 2276-77.

251. *Id.* at 2277.

252. *Id.*

253. *Id.* at 2272.

254. *Id.* at 2278.

255. *Id.*

256. *Id.*

257. *Id.*

and reversed the Indiana Supreme Court's holding that the victim's statements were not testimonial.²⁵⁸

IV. The Admissibility of Emergency 911 Calls in Massachusetts After *Davis* and *Hammon*: A Refinement of the *Gonsalves* Framework? ²⁵⁹

In *Gonsalves*, the SJC expressly left the treatment of emergency 911 calls "for a future appropriate case."²⁶⁰ That appropriate case was *Commonwealth v. Galicia*.²⁶¹ As previously noted, because the *Gonsalves* analytical framework was based wholly on the Sixth Amendment's Confrontation Clause as interpreted by *Crawford*, the Supreme Court's refining of the key terms "testimonial" and "interrogation" in *Davis* would likely require the SJC to reconcile its broadly encompassing definitions with those of *Davis*.²⁶² In *Galicia*, however, the SJC avoided any attempts at reconciliation and instead decided whether statements made by a victim in the course of an emergency 911 call were properly admitted under the rule announced in *Davis*.²⁶³

In *Galicia*, which was tried before the Supreme Court issued its decision in *Crawford*, the trial judge granted the commonwealth's motion in limine to admit as spontaneous utterances the victim's statements made during a 911 call and to the first police officer who spoke with her at the scene.²⁶⁴ When the 911 dispatcher asked, "What is your emergency?," the victim replied, "My husband's beating me up right now!"²⁶⁵ After verifying her address, the dispatcher asked "Where is your husband now?"²⁶⁶ Mrs. Galicia replied, "Ow!"²⁶⁷ She

then told the dispatcher that she was in the kitchen and the only other people in the house were her son and daughter.²⁶⁸ On two occasions during the call, Mrs. Galicia exclaimed, "Ow!"²⁶⁹ Police officers arrived at the scene within five minutes of the call.²⁷⁰ One officer testified that he observed multiple chairs turned over, and that Mrs. Galicia was tearful, upset, and had scratches on her face.²⁷¹ The defendant was also in the home.²⁷² The officer told Mrs. Galicia to take some deep breaths and calm down before he spoke to her.²⁷³ When he asked her what happened, she replied that her husband had accused her of being unfaithful and punched, choked and kicked her.²⁷⁴

The victim did not testify at the defendant's bench trial.²⁷⁵ The court found the defendant guilty of assault and battery.²⁷⁶ After the defendant appealed, the SJC transferred the case to its docket.²⁷⁷ The defendant argued that the admission of Mrs. Galicia's statements on the 911 call and at the scene violated his constitutional right to cross-examine his accuser.²⁷⁸ In light of the *Davis* decision, however, the defendant conceded that the victim's statements made during the 911 call were nontestimonial and therefore admissible.²⁷⁹ The commonwealth urged the court to rely on the volatile scene and medical care exceptions within the analytical framework it created in *Gonsalves*, and as further refined by the Supreme Court in *Davis*, and find that the statements to the officer at the scene were also not testimonial because they were made during an ongoing emergency while the defendant was still present.²⁸⁰ The defendant urged the court to take a narrower view of the term "ongoing emergency" and find that the victim's statements made at the scene to the officer were

258. *Id.* at 2279.

259. Although the Supreme Court denied the commonwealth's petition for writ of certiorari, see *Massachusetts v. Gonsalves*, 126 S. Ct. 2980 (2006) (mem.), it granted certiorari to three other state court cases and remanded them for further consideration in light of its holding in *Davis*. See *Anderson v. State*, 111 P.3d 350 (Alaska App. 2005), *vacated and remanded*, 126 S. Ct. 2983 (2006); *State v. Warsame*, 701 N.W.2d 305 (Minn. App. 2005), *vacated and remanded*, 126 S. Ct. 2983 (2006); *People v. Thomas*, No. A104336, 2005 WL 2093065, at *1 (Cal. App. Nov. 16, 2005), *vacated and remanded*, 126 S. Ct. 2983 (2006). In those three cases, unlike in *Gonsalves*, the state courts had found the particular declarant's statements to law enforcement agents to be nontestimonial and therefore admissible. *Anderson*, 111 P.3d at 354-55; *Warsame*, 701 N.W.2d at 311-13; *Thomas*, 2005 WL 2093065, at *5. It is well established, however, that the denial of a petition for writ of certiorari may not be read as any indication of the Supreme Court's view on the merits of a case. See *Hughes Tool Co. v. Trans World Airlines, Inc.*, 409 U.S. 363, 366 n.1 (1973) (noting that the denial of certiorari imports no view on a case's merits); *United States v. Carver*, 260 U.S. 482, 490 (1923) ("The denial of a writ of certiorari imports no expression of opinion upon the merits of the case, as the bar has been told many times."). Any implication that the Supreme Court tacitly endorsed the *Gonsalves* framework, therefore, is unwarranted.

260. *Gonsalves*, 445 Mass. at 9 n.4. See *supra* note 131.

261. 447 Mass. 737 (2006). Nicole Allain, one of the article's co-authors, prosecuted the case in district court and argued the case before the SJC on behalf of the commonwealth.

262. See *Commonwealth v. Whelton*, 428 Mass. 24, 28 (1998) ("In cases involving the hearsay rule and its exceptions, we have stated that art. 12 provides no greater protection than the Sixth Amendment.")

263. *Galicia*, 447 Mass. at 737-38. The court noted that both the commonwealth and the defendant agreed that *Davis* governed the analysis of the defendant's Sixth Amendment claims. *Id.* at 739.

264. *Id.* at 739-40. Although the commonwealth argued on appeal that the

defendant failed to preserve a Confrontation Clause objection to the admission of the statements at trial, the court found that the defendant's objection to the motion in limine sufficiently raised the constitutional issue by "using the terminology and principles that then governed confrontation clause analysis." *Id.* at 746-47.

265. *Id.* at 740.

266. *Id.*

267. *Id.*

268. *Id.*

269. *Id.*

270. *Id.*

271. *Id.* at 740-41.

272. *Id.* at 741.

273. *Id.*

274. *Id.*

275. *Id.* at 738.

276. *Id.* at 740.

277. *Id.* at 738.

278. Brief of Defendant-Appellant at 18, *Commonwealth v. Galicia*, 447 Mass. 737 (2006) (No. SJC-09537). The defendant also argued that he was not identified as the perpetrator of the crime. *Id.* at 28-33. While the appeal was pending, the Supreme Court issued the *Davis* and *Hammon* decisions. The parties filed supplemental briefs addressing the effect of the decisions on the issues before the court: Supplemental Brief of Defendant-Appellant, *Commonwealth v. Galicia*, 447 Mass. 737 (2006) (No. SJC-09537); Supplemental Brief of Appellee, *Commonwealth v. Galicia*, 447 Mass. 737 (2006) (No. SJC-09537).

279. Supplemental Brief of Defendant-Appellant at 6, *Galicia*, 447 Mass. 737 (No. SJC-09537). See *Galicia*, 447 Mass. at 745 n.15.

280. Supplemental Brief of Appellee at 5-8, *Galicia*, 447 Mass. 737 (No. SJC-09537).

testimonial because there was no ongoing emergency at the time the officers arrived.²⁸¹ Instead, he argued, the officers were investigating past criminal conduct.²⁸²

Applying *Davis*, the SJC held the 911 call admissible because it concerned an assault that was actually happening and any reasonable listener would have concluded that it constituted an ongoing emergency.²⁸³ The court found that the caller's responses were properly elicited to determine what was necessary to resolve the present emergency, including the identity and location of the caller and her alleged perpetrator.²⁸⁴ Borrowing language from *Crawford* and *Davis*, the court also found that the statements "bore no witness to any event, but identified an exigent circumstance and provided law enforcement with information necessary to assess the current level of dangerousness of the situation."²⁸⁵ By contrast, the court found that the statements made to the officers at the scene fell squarely within the purview of "testimonial" statements and, therefore, were erroneously admitted at trial.²⁸⁶ The court reasoned that the on-scene statements occurred separate and apart from the danger the victim sought to avert, both temporally and physically, because the assault had ended and the urgency had subsided.²⁸⁷

In reaching its conclusion, however, the *Galiccia* court seems to have unjustifiably shifted the focus from determining the objective "primary purpose of the interrogation," as set out in *Davis*,²⁸⁸ to the subjective "primary purpose of the statements."²⁸⁹ Statements, standing on their own, do not have a purpose; rather, it is the intent of the declarant that provides meaning to the "purpose of the statement." Necessitating an evaluation of the declarant's or interrogator's subjective intent, rather than of the objective circumstances of the interrogation, seemingly would keep viable *Gonsalves*'s testimonial-in-fact prong.²⁹⁰ But *Davis* focused on the primary purpose of the *interrogation* based on the objective facts and circumstances, not on the declarant's subjective intent in making the statements. Given this apparent shift in focus, it remains to be seen whether the SJC will

attempt to reconcile the *Gonsalves* framework with *Davis*. So far the SJC has not acknowledged the need of reconciliation. In the recent case of *Commonwealth v. Burgess*,²⁹¹ decided in January 2008, the SJC stated that its "rationale in the *Gonsalves* decision is in accord with the Supreme Court's decision in *Davis*."²⁹² In *Burgess*, the SJC applied the *Gonsalves* framework and found that all of the victim's in-person statements to the police, who responded to two separate domestic disturbance calls, were testimonial per se, except for the victim's response of "No, it's not," to the officer's initial inquiry of whether everything was okay.²⁹³ The court again looked to the declarant's intent in making the statement and found the statement not to be testimonial in fact because a reasonable person in the victim's position would not anticipate the response to be used in prosecuting a crime.²⁹⁴

Conclusion

The impact of *Crawford* on the prosecution of criminal cases was immediately felt across the nation. One op-ed article in the *New York Times* noted that while domestic violence accounts for up to 34 percent of all reported violent crimes, the refusal of victims to cooperate in prosecutions and testify against their batterers *before Crawford* may have resulted in the dismissal of as many as 70 percent of all domestic violence cases.²⁹⁵ Moreover, the article noted, after *Crawford*, 63 percent of prosecutors surveyed in three western states agreed that *Crawford* has further hampered the prosecution of domestic violence cases, with an overwhelming majority (76 percent) reporting that they are more likely now to simply drop domestic violence charges when they encounter uncooperative witnesses,²⁹⁶ thus lending credence to Justice Sosman's prediction in *Gonsalves* of the far-reaching impact the inadmissibility of spontaneous utterances would have on domestic violence prosecutions.²⁹⁷ The impact is especially hard-felt on domestic violence prosecutions, because, as Justice Ruth

281. Supplemental Brief of Defendant-Appellant at 1-6, *Galiccia*, 447 Mass. 737 (No. SJC-09537).

282. *Id.*

283. *Galiccia*, 447 Mass. at 744-45.

284. *Id.* at 745.

285. *Id.*

286. *Id.* at 745-46.

287. *Id.* at 745. The court found, however, that the erroneous admission of the on-scene statements did not constitute reversible error because those statements corroborated and were "merely cumulative" of properly admitted evidence. *Id.* at 747-48. Hence, the court concluded that the erroneously admitted evidence likely did not have an effect on the fact-finder or contribute to the verdict. *Id.* at 748.

288. *Davis*, 126 S. Ct. at 2273-74 (holding that statements are testimonial when circumstances objectively indicate there is no ongoing emergency and "primary purpose of the interrogation" is to establish or prove past events potentially relevant to later criminal prosecution).

289. See *Galiccia*, 447 Mass. at 743-44 (stating that four factors set forth in *Davis* to help determine "primary purpose of interrogation" are used to determine "primary purpose of statements"); *Id.* at 745-46 (finding that "primary purpose" of victim's statements was to enable police assistance to meet an ongoing emergency).

290. The testimonial-in-fact prong requires determining whether "a reasonable

person in the declarant's position would anticipate the statement's [sic] being used against the accused in investigating and prosecuting a crime." *Gonsalves*, 445 Mass. at 12-13.

291. *Commonwealth v. Burgess*, No. SJC-09473, 2008 WL 96572, at *1 (Mass. Jan. 11, 2008).

Burgess walked into a police station and reported that he had killed his father during a fight the night before. *Id.* at *2-*3. Police officers went to the home that Burgess shared with his father and found the victim's body in the bathtub. *Id.* at *3. At Burgess's murder trial, statements that his father had made to police officers in the months preceding the killing were admitted into evidence as spontaneous utterances. *Id.* at *4. One set of statements was made to police officers who responded to a "911 hang-up call" at the Burgess home, and the other set of statements was made to police officers dispatched to respond to an "unwanted guest" call at that address. *Id.* at *4-*5. The SJC concluded that all statements but one were testimonial per se, as they were not made in response to an ongoing emergency. *Id.* at *15-*17.

292. *Id.* at *5.

293. *Id.* at *6.

294. *Id.*

295. Michael Rips & Amy Lester, *When Words Bear Witness*, N.Y. TIMES, Mar. 20, 2006, available at <http://www.nytimes.com/2006/03/20/opinion>.

296. *Id.*

297. *Gonsalves*, 445 Mass. at 36-37 (Sosman, J., concurring in part).

Bader Ginsburg pointed out during oral arguments in *Davis*, “[t]he practical reality . . . is that many women in these situations are scared to death of what will happen to them or they’re so insecure financially that they think they have to put up with the battering.”²⁹⁸ Hence, domestic violence victims are often less likely to be willing to testify because of a myriad of issues, including battered-woman’s syndrome, financial dependence, and the fact that such victims are reasonably fearful of even further retribution by their assailants should they seek recourse with the criminal justice system.²⁹⁹ Although the *Davis* Court acknowledged that domestic violence crimes are “notoriously susceptible to intimidation or coercion of the victim” to prevent the victim from testifying at trial, the Court noted that it could not “viti[ate] constitutional guarantees [even] when they have the effect of allowing the guilty to go free.”³⁰⁰

But the *Davis* Court’s refinement of the key terms “testimonial” and “interrogation” will undoubtedly aid prosecutors in domestic violence and gang-related prosecutions. The *Davis* Court clarified that the definition of “testimonial” set forth in *Crawford* was not intended to be a complete and comprehensive definition of that term but instead was limited to the facts and circumstances of *Crawford* — custodial interrogation at a police station.³⁰¹ Similarly, the *Davis* Court clarified that an interrogation in and of itself does not make statements in response testimonial.³⁰² Rather, it depends on the totality of the objective circumstances in which the interrogation occurred: responses to questions asked during objectively evident ongoing emergency situations — even if they provide identifying information about the defendant (and not necessarily of the crime)³⁰³ — do not fall within the rubric of testimonial hearsay under *Crawford* and, therefore, are not constrained by the requirements of the Confrontation Clause.³⁰⁴ Still, something more than the mere

physical presence of the defendant in close proximity to the victim at the scene is required (such as police witnessing a physical altercation or encountering an armed suspect when they arrive) to satisfy the requirement of an ongoing volatile or non-secure scene. This is true even when it is reasonably apparent that a physical altercation immediately preceded the arrival of the police.

During the interim between the *Crawford* and *Davis* decisions, however, courts were left to devise their own interpretations of “testimonial” and “interrogation,” and some, like the SJC, established an overly broad comprehensive definition of those key terms. Although the volatile scene and medical care exceptions to the testimonial-per-se prong of the *Gonsalves* framework paralleled the *Davis* decision,³⁰⁵ it remains to be seen whether and to what extent the SJC will revise the *Gonsalves* framework’s testimonial-in-fact prong, which was seemingly called into question by the analysis in *Davis*. The *Galicia* court relied solely on the rule established in *Davis* to resolve that statements made during the victim’s 911 emergency call were not testimonial, and it apparently left the reconciliation of *Gonsalves* with *Davis* to another day. Following the *Davis* decision, judges in Massachusetts now have some guidance as to what objective factors should be considered when deciding motions in limine to admit spontaneous utterances or emergency 911 calls that they lacked in the immediate aftermath of *Crawford*. The Supreme Court at last clarified that the existence of police interrogation alone is not dispositive; rather it is the primary purpose of that interrogation, as informed by the objective circumstances in which it was conducted, that is the key to determining whether statements made in response to law enforcement personnel are testimonial and subject to the requirements of the Sixth Amendment’s Confrontation Clause.

298. Transcript of Record at 22, *Davis v. Washington*, 126 S. Ct. 2266 (2006).

299. See Tom Lininger, *Prosecuting Batterers After Crawford*, 91 VA. L. REV. 747, 768-71 (2005).

300. *Davis*, 126 S. Ct. at 2279-80. The Court again emphasized, however, the application of forfeiture by wrongdoing as a measure to combat such intimidation and coercion. See *id.* (citing, as an example, *Commonwealth v. Edwards*, 444 Mass. 526 (2005)). See also note 173 and text accompanying notes 173-78.

301. *Id.* at 2276.

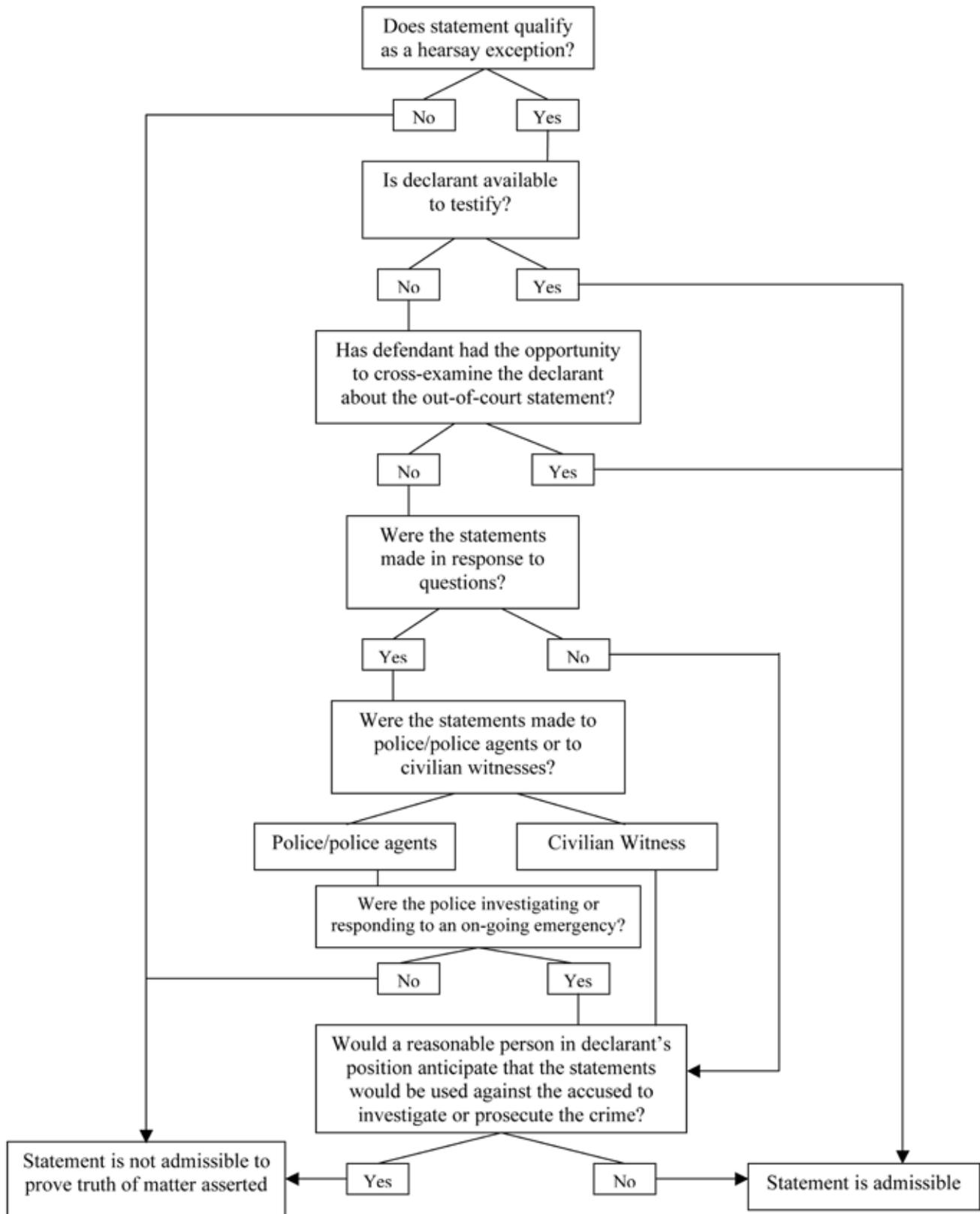
302. *Id.* at 2273. But the Court also noted that the reverse implication is not necessarily true either; that is, the absence of interrogation does not always mean the statements will be deemed nontestimonial. *Id.* at 2274 n.1.

303. *Id.* at 2273.

304. See *Crawford*, 541 U.S. at 68 (noting that where nontestimonial hearsay is at issue, the Confrontation Clause is not implicated).

305. *Gonsalves*, 445 Mass. at 9.

Crawford / Gonsalves / Davis Flowchart



The Effects of Global Priority of Trademark Rights

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Introduction

Everything is going global, even U.S. intellectual property laws. As more and more American businesses have contacts with foreign affiliates and entities (and, in turn, more and more foreign businesses establish contacts in the United States), the extraterritorial reach of U.S. intellectual property law is taking on increased importance within the global business community. Just recently, the United States Supreme Court decided a case testing the limits of the extraterritorial scope of federal patent law.¹ Similarly, the United States Court of Appeals for the Second Circuit and the Trademark Trial and Appeal Board (“TTAB”) of the U.S. Patent & Trademark Office (“USPTO”) recently struggled with issues regarding the reach of federal and foreign trademark law.²

What happens, for example, when an overseas company infringes the well-known trade name or service mark of an American-based

company in U.S. commerce or abroad? More specifically, how do the traditional methods of testing the strength of a trademark hold up in the new global economy? Can a foreign business enforce its trademark rights derived in a foreign country against a user in the United States? Would a court examining this question apply U.S. law or an international treaty? Can an American business enforce its trademark rights levied in the United States against a foreign competitor?

American courts have yet to resolve these and other pertinent questions.³ Due in part to the effect of the dynamic global marketplace, parties litigating trademark issues in federal courts increasingly advocate for the recognition and application of exceptions to the traditional principle of U.S. trademark law.⁴ Under this traditional principle, a party acquires rights only through actual use of a trademark in the United States.⁵ International law, generally and as applied to intellectual property rights including trademarks, has long

1. See generally *Microsoft Corp. v. AT&T Corp.*, 127 S.Ct. 1746 (2007) (reversing a federal circuit court decision finding infringement under 35 U.S.C. § 271(f)(2003)). In *Microsoft*, the United States Supreme Court determined that a defendant cannot be held liable for patent infringement based on its shipment of a single computer component, software code, overseas where it was later copied abroad and installed into multiple computers produced and sold overseas in an allegedly infringing computer software system. *Id.* at 1750-51.

2. See generally *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135 (2d Cir.), *cert. denied*, 128 S.Ct. 288 (2007); *First Niagara Ins. Brokers, Inc. v. First Niagara Fin. Group, Inc.*, 476 F.3d 867 (Fed. Cir. Cir. 2007), *rev'g*, 77 U.S.P.Q.2d 1334 (T.T.A.B. Oct. 21, 2005); *Diaz v. Servicios de Frangucia Pardo's S.A.C.*, Opposition No. 91159871, 2007 WL 549241, at *1, 83 U.S.P.Q.2d 1320, 1326-28. (T.T.A.B. 2007).

3. A panel of the United States Federal Court of Appeals struggled with this very

issue in *Voda v. Cordis*, 476 F.3d 887 (Fed. Cir. 2007), ultimately holding two to one that “considerations of comity, judicial economy, convenience, fairness, and other exceptional circumstances constitute compelling reasons” to decline supplemental jurisdiction under 28 U.S.C. § 1367(c) (2000) over a U.S. patent holder’s additional claims of infringement of his foreign patents under foreign law. *Id.* at 887.

4. See, e.g., *ITC Ltd.*, 482 F.3d at 142; *McBee v. Delica Co., Ltd.*, 417 F.3d 107, 110-11 (1st Cir. 2005).

5. See 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 19:1 at 25 (4th ed. 1999) (citing *Grand Canyon West Ranch, LLC v. Hualapai Tribe*, 78 USPQ 2d 1696 (T.T.A.B. 2006) (“It is clear that an applicant cannot obtain a registration under Section 1 of the Trademark Act for goods or services upon which it has not used the mark.”)).

recognized a principle of territoriality localizing such property rights, again subject to limited exceptions.⁶

This article outlines and analyzes the issues faced by American businesses given the uncertain state of the law. Part One briefly describes the basics of U.S. trademark law. Part Two examines the historical underpinnings of the principle of territoriality, the bedrock of U.S. trademark law, and explains how increasing globalization has the potential to undermine its applicability and usefulness. Part Three analyzes international agreements, such as the Paris Convention for the Protection of Intellectual Property (“Paris Convention”), the Agreement on Trade Related Aspects of Intellectual Property (“TRIPs”), and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (“Madrid Protocol”), and supplementing legislation,⁷ with regard to their effect on global trademark rights. Finally, Part Four discusses the “famous marks” (or “well known marks”) doctrine and other bases for American courts to grant relief. More specifically, Part Four examines the recent split between the United States Courts of Appeals for the Second and Ninth Circuits as to the applicability of this doctrine. The resolution of this split by the Supreme Court will ultimately determine how lower courts will analyze these issues in the future.

I. Basics of Trademark Law

At its very foundation, trademark law in the United States rests upon a “use it or lose it” policy. This principle requires a party to have *actually used* a trademark in interstate or export-import commerce of the United States in connection with a good or a service before availing itself of the benefits of federal trademark law.⁸ The territoriality doctrine of “priority” (or, the first to use the mark) is fundamental to American trademark law.⁹ The term “territoriality” also refers to the principle that, with limited exceptions, intellectual property rights are national in character and have very little extraterritorial reach.

6. See 4 McCARTHY, *supra* note 5 at § 29:1.

7. Such treaties are usually not self-executing, although there are some exceptions.

8. 3 McCARTHY, *supra* note 5 at § 19:1, at 25 (citing *Grand Canyon West Ranch, LLC v. Hualapai Tribe*, 78 USPQ 2d 1696 (T.T.A.B. 2006)).

9. See, e.g., *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 98 (1918) (“The law of trademarks rests upon territoriality.”); *ITC Ltd.*, 482 F.3d at 146 (“[O]ne of the fundamental premises underlying the registration provisions in the Lanham Act is that trademark rights flow from priority and that priority is acquired through use.”); *Sengoku Works v. RMC Int’l*, 96 F.3d 1217, 1219 (9th Cir. 1996) (“It is axiomatic in trademark law that the standard test of ownership is priority of use.”).

10. 15 U.S.C. §§ 1051-72, 1091-96, 1111-29, 1141-41n (2000 & Supp. 2005).

11. *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 98 (1918). See also *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 265 (5th Cir. 1999); *Berni v. International Gourmet Rests. of Am., Inc.*, 838 F.2d 642, 646 (2d Cir. 1988); *Weener v. Brayton*, 152 Mass. 101, 102-03 (Mass. 1980); 2 McCARTHY, *supra* note 5 at § 18:2; Graeme B. Dinwoodie, *Trademarks and Territory: Detaching Trademark Law from the Nation-State*, 41 Hous. L. Rev. 885, 888 (2004).

12. 3 McCARTHY, *supra* note 5 at § 19:1, at 25.

13. 15 U.S.C. §§ 1051-1127 (2000 & Supp. 2005).

Therefore, if an American business seeks to promote and sell its goods or services abroad under a particular trademark, it must acquire trademark rights pursuant to the laws of the foreign jurisdictions.

In the United States, at common law, and as later codified in the federal Lanham Act,¹⁰ the primary purpose of a trademark was to represent to consumers the local goodwill possessed by the mark holder through usage in a particular geographic region.¹¹ Trademarks, therefore, identify to a consumer the source of the goods and services, along with any accompanying goodwill the owner of the mark has built over time. Today, an entity acquires trademark rights in U.S. regions through the actual use of the mark in commerce.¹² A party, however, acquires trademark rights throughout the United States by statutory constructive use as prescribed by the Lanham Act.¹³ Registration systems, like that administered by the USPTO, reinforce the territorial nature of trademarks within specific markets.¹⁴

Registering a trademark on the Principal Register of the USPTO, for example, provides the trademark holder with a number of rights, including: (1) the ability to secure a nationwide injunction; (2) access to federal court without a minimum amount in controversy; (3) the ability to use the registration or ® symbol; (4) enhanced damages (such as attorney’s fees, treble damages); (5) incontestability, which can often preemptively dissuade potential infringers from hijacking a registered mark; and (6) the ability to prevent importation of infringing goods.¹⁵ If a company uses a mark without registering it with the USPTO, that company will only have exclusive rights to use the mark within its established trading area; it will not be afforded nationwide rights (i.e., rights outside of its area of established areas of use) — a principal benefit bestowed upon the holder of a federal trademark registration. Federal jurisdiction and some federal law remedies, however, are available to protect unregistered trade identity.¹⁶

In order to acquire federal trademark rights, a party must use the mark “in commerce.” The meaning of this phrase is the same as given

14. *Id.*

15. See generally 15 U.S.C. §§ 1116, 1121 & 1124 (2000 & Supp. 2005). Criminal penalties, including fines of up to \$2,000,000 for individual offenders and imprisonment of up to ten years, are also available to prevent trafficking in counterfeit goods and services. See 18 U.S.C. § 2320 (2000 & Supp. 2005). Moreover, the Anti-Counterfeiting Consumer Protection Act amended the Racketeer Influenced and Corrupt Organizations Act (RICO) to include criminal infringement of copyright and trafficking in goods or services bearing counterfeit marks and increased the power of state and local officials and the U.S. Customs Service to combat counterfeiting. See 15 U.S.C. § 1116(d)(9)(2002); 18 U.S.C. § 1961 (2000 & Supp. 2005). The U.S. Customs Service also may impose civil fines on anyone who aids or abets the importation of counterfeit goods and may destroy merchandise bearing counterfeit trademarks. See 19 U.S.C. § 1526 (2000 & Supp. 2005). On an international scale, Interpol works with governmental law enforcement agencies to stem intellectual property crimes worldwide. See *Interpol*, <http://www.interpol.int/public/icpo/default.asp> (last visited Nov. 20, 2007).

16. See, e.g., 15 U.S.C. § 1125 (2000); 28 U.S.C. § 1338(a)(2000). Common-law and state statutory remedies are also available. See, e.g., MASS. GEN. LAWS ch. 93A §§ 2, 11 (2006); & MASS. CONST. Pt. I, T. XV, Ch. 110(h) (2006).

in the Commerce Clause of the United States Constitution, which refers to the sale or transportation of goods bearing the trademark in or affecting interstate commerce, commerce with other nations, or commerce with American Indian tribes.¹⁷ According to section 45 of the Lanham Act, a use in commerce must be a “*bona fide* use in the ordinary course of trade and not made merely to reserve a right in a mark.”¹⁸ A mark is used in commerce on goods when a company affixes the mark to the goods and the goods are sold or transported in commerce.¹⁹ Similarly, a party can establish use in commerce on services

when [the mark] is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one state or the U.S. and a foreign country and the person rendering the services is engaged in commerce in connection with the services.²⁰

While use is a foundational requirement of American-based trademark rights, limited statutory exceptions exist. The first,

created by the Trademark Law Revision Act of 1988 (“TLRA”)²¹, is the “intent-to-use” trademark application system. As of November 1988, an applicant for a U.S. trademark registration could secure nationwide priority rights in a subject mark *before* it is actually used in commerce, assuming, of course, that the applicant intends to use the mark in commerce in the future.²² The date of filing of the intent-to-use application, therefore, constitutes the date of the constructive (though not actual) use of the mark.²³ To limit the potential for abuse of the intent-to-use system (i.e., attempting to monopolize a vast number of potential marks and block others from adopting them), the statute requires that the intent to use be *bona fide* under an objective good-faith test.²⁴ Moreover, before a federal registration can issue, the applicant must file a verified statement, along with proof, that actual use of the trademark in commerce has in fact begun.²⁵ Such a statement must be filed within 36 months (or within six sequential six-month extension periods) from the date of notice from the USPTO that the application can proceed to registration.²⁶ Thus, although the intent-to-use application system creates an exception to the requirement of use in commerce, the exception’s applicability is short-lived. A party still may not receive a registration absent evidence

17. 15 U.S.C. § 1125(a)(1)(2000) (“Any person who, on or in connection with any goods or services, ... uses in commerce any word, term, name, symbol or device ... which (A) is likely to cause confusion”); *International Bancorp, LLC v. Societe des Bains de Met et du Cercle des Etrangers Monaco*, 329 F.3d 359, 364 (4th Cir. 2003), *cert. denied*, 540 U.S. 1106 (2004).

18. 15 U.S.C. § 1127 (2000).

19. *See id.*; *see also Societe Anonyme des Parfums Le Galion v. Jean Patou, Inc.*, 495 F.2d 1265, 1265 (2d Cir. 1974) (holding that trademark rights are not created by sporadic, casual and nominal shipments of goods bearing a mark, but rather there must be a trade in the goods sold under the mark or at least an active and public attempt to establish such trade). The use “in commerce” requirement was addressed recently by the Federal Circuit in reviewing the TTAB’s decision in *First Niagara Ins. Brokers, Inc. v. First Niagara Fin. Group, Inc.*, 476 F.3d 867 (Fed. Cir. 2007), *rev’g*, 77 U.S.P.Q.2d 1334, 2005 WL 2865169 (T.T.A.B. Oct. 21, 2005). In that case, the TTAB denied a Canadian insurance brokerage service provider’s opposition to registration of certain marks by a U.S.-based insurance brokerage agency based on the absence of evidence that the Canadian opposer used the asserted trademark “in commerce.” *First Niagara Ins. Brokers, Inc.*, 2005 WL 2865169, at *11-12. Although the Canadian opposer produced evidence of some use of the marks in the United States, such as in “spillover advertising” from Canada, the TTAB found such “use” *de minimis*. *Id.* at *11. Applying the use doctrine, the TTAB noted that “[i]t is well established that prior use in a foreign country does not entitle its owner to claim exclusive rights in the U.S. as against one who used a similar mark in the U.S. prior to entry of the foreigner into the U.S. market.” *Id.* The Federal Circuit reversed, finding that the TTAB had applied the incorrect legal test. *First Niagara (Canada)* based its opposition to the trademark application of *First Niagara (U.S.)* upon Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d)(2000), which merely requires use in the United States, not in interstate commerce. *First Niagara Ins. Brokers, Inc.*, 476 F.3d at 871. In light of “plain language of the statute,” the Federal Circuit found

that the TTAB erred in its assumption that an “opposer’s claim of prior use can succeed only if it has proved use of its marks in connection with services rendered in commerce lawfully regulated by Congress, as required under Section 45 of the Trademark Act, 15 U.S.C. [sec] (2000) 1127.” *Id.* The Federal Circuit stated that a “foreign user can present its opposition on the merits by showing use of its mark in the United States” *Id.* Having found that *First Niagara (Canada)* produced ample evidence of use of its marks in the United States (although perhaps not in interstate commerce), the Federal Circuit reversed the TTAB’s decision and remanded the case for further proceedings. *Id.*

20. *See Societe Anonyme*, 495 F.2d at 1272. *Compare* *Larry Harmon Pictures Corp. v. Williams Rest. Corp.*, 929 F.2d 662, 666 (Fed. Cir. 1991) (holding that usage of mark in one state in connection with services rendered to customers traveling across state boundaries constitutes “use in commerce”), *with Buti v. Impresa Perosa, S.R.L.*, 139 F.3d 98, 105 (2d Cir.), *cert. denied*, 525 U.S. 826 (1998) (holding that the mere advertising or promotion of a mark in the United States is insufficient to constitute use of the mark in commerce where the advertising or promotion is unaccompanied by any actual rendering of services in connection with usage of the mark in U.S. commerce which is lawfully regulated by Congress).

21. Pub. L. 100-667, 102 Stat. 3935, codified at 15 U.S.C. § 1051(b) (2000).

22. *Id.*

23. 15 U.S.C. § 1057(c) (2000). *See generally* *Lucent Info. Mgmt., Inc. v. Lucent Tech., Inc.*, 986 F. Supp. 253, 45 U.S.P.Q.2d 1019 (D. Del. 1997); *Dyneer Corp. v. Auto. Prod. plc*, 37 U.S.P.Q.2d 1251 (T.T.A.B. 1995); *Zirco Corp. v. American Tel. & Tel. Co.*, 21 U.S.P.Q. 2d 1542 (T.T.A.B. 1991).

24. 15 U.S.C. § 1051 (b)(1)(2000).

25. 15 U.S.C. § 1051(d)(1)(2000 & Supp. 2005).

26. *Id.*

of actual use.

The second statutory exception to the “use in commerce” requirement is the special registration benefits given to foreign trademark holders who are nationals of a country that: (1) is a signatory to a trademark treaty to which the United States is a party or (2) confers reciprocal rights to American citizens.²⁷ Under section 44 of the Lanham Act, these foreign nationals may obtain a federal trademark registration absent a showing of use in interstate commerce prior to registration based solely on a corresponding registration in a foreign country and the applicant’s *bona fide* intention to use the mark in commerce in the United States.²⁸ The USPTO will treat the application as if it was filed on the same date as the foreign application, so long as it is filed within six months of the original application and conforms to the requirements of the Lanham Act.²⁹ A foreign applicant, therefore, will have priority rights in the subject mark in the United States from the date of the home country application and will obtain protection against another who previously used the mark in commerce in the United States prior to the foreign applicant’s first use in the United States.³⁰ A right of “priority” can become critically important if a mark is later used or challenged by a competing user because of the “first use” policy whereby a senior user’s rights in a trademark can trump those of a junior user.³¹ Thus, section 44 of the Lanham Act essentially allows a foreign party to benefit from an earlier priority date (or, date of first use) even though the mark was not actually used in commerce in the United States at the time of filing of the foreign application. Both of these statutory exceptions provide avenues for a party to secure rights in a trademark under American law even though the party never used the mark in interstate

commerce in the United States.

As trademarks cross borders in a new era of global trade and marketing, foreign marks will increasingly become known (and perhaps even become “famous”) in the United States prior to their actual “use in [American] commerce.” And, thanks in large part to technology like the Internet, U.S. marks are increasingly becoming “famous” abroad in foreign countries before any goods or services bearing those marks reach foreign shores. As a result, federal courts have increasingly needed to weigh in on priority contests between those who used a trademark in the United States versus those who acquired rights to a trademark in a foreign territory. As the United States Court of Appeals for the Second Circuit’s recent decision in *ITC Ltd. v. Punchgini, Inc.*³² (discussed in detail in Part Four herein) demonstrates, courts in the United States will undoubtedly be asked to decide several issues: (1) when *and if* the “famous marks” doctrine should be applied; (2) if it is to be applied, which factors within the “famous marks” doctrine are determinative; and (3) whether they should grant rights to a foreign owner a “famous mark” pursuant to international agreements, such as the Paris Convention and TRIPs,³³ particularly where there is no use by the foreign entity within the United States.

II. The Principle of Territoriality of Trademark Rights and Other Intellectual Property Rights

As discussed in Part One, trademark rights in the United States traditionally rest upon use of the trademark in this country.³⁴ Accordingly, prior use of a trademark in a foreign country typically

27. 15 U.S.C. § 1126(b) (2000). There are currently 171 contracting party countries to the Paris Convention. See Contracting Parties to Paris Convention, World Intellectual Property Organization, http://www.wipo.int/treaties/en/ShowResults.jsp?treaty_id=2 (last visited Nov. 20, 2007). The signatories to the Paris Convention and other treaties and bilateral agreements (see discussion *infra* Part III) typically afford reciprocal rights to trademark holders in the U.S.

28. 15 U.S.C. § 1126(e)(2000 & Supp. 2005).

29. 15 U.S.C. § 1126(d)(2000).

30. See *SCM Corp. v. Langis Foods Ltd.*, 539 F.2d 196, 199 (D.C. Cir. 1976). The General Inter-American Convention for Trademark and Commercial Protection (Pan-American Convention, 46 Stat. 2907) provides in its Article 7 for priority based on use in a treaty party country. This principal was recently approved by the U.S. Trademark Trial & Appeal Board in *Diaz v. Servicios de Frangucia Pardo’s S.A.C.*, 2007 WL 549241 (T.T.A.B. Feb. 16, 2007). See also *British-American Tobacco Co. v. Phillip Morris, Inc.*, 55 U.S.P.Q. 2d 1585 (T.T.A.B. 2000).

31. While this article focuses mainly on how U.S. courts have addressed priority contests between American and foreign users of a trademark, it is worth noting that foreign countries, in general, grant protections to “famous” marks originating from the United States that are equal to or exceed the protections given in the United States to “famous” marks originating in foreign countries. In priority contests between a U.S. user and a foreign user in a foreign jurisdiction, the holder of any trademark or trade name rights must enforce its rights under the laws of the foreign jurisdiction. The treaties discussed in Part III of this article, e.g., the Paris Convention, TRIPs, and the Madrid Protocol, will be given the judicial respect that the individual countries generally afford them. In the U.S., these treaties are treated with little deference (see *infra* Part III), and, likewise, each country enforces them with varied levels of vigor. For example, both

the Paris Convention and TRIPs contain provisions addressing protections for “geographic origin designations” or “geographical indications”, which typically identify that a product has been produced in a particular location (e.g., Parma Ham, Manchego Cheese, Champagne). See, e.g., Paris Convention, Art. 1(2) & 10; TRIPs Arts. 22-24. These provisions, as well as the enforcement mechanism under domestic and foreign law, have not been enforced in the United States, although they are strenuously enforced in Europe. See, e.g., *Germany & Denmark v. Commission of European Communities*, Cases C-465/02 & C-466/02, Grand Chamber of EJC (Oct. 25, 2005) (enforcing geographical indication of “Prosciutto di Parma” under the European Union Geographical Indications system). *But see also* WTO European Communities Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs, DS 174 & DS 290 (Mar. 15, 2005) (upholding challenge to EU Geographical Indications system by U.S. and Australia). The lack of universal application and enforcement of treaty provisions is a primary argument for the harmonization of global trademark laws through international agreements. This topic, however, is beyond the scope of this article.

32. 482 F.3d 135 (2d Cir.), *cert. denied*, 128 S.Ct. 288 (2007).

33. See, e.g., Agreement on Trade Related Aspects of Intellectual Property (Apr. 15, 1994); Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (1989), and incorporated into U.S. law through the Madrid Protocol Implementation Act of 2002.

34. See, e.g., *Barcelona.com, Inc. v. Excelentísimo Ayuntamiento de Barcelona*, 330 F.3d 617, 628 (4th Cir. 2003) (recognizing the territoriality principle as a fundamental doctrine and stating that “U.S. courts do not entertain actions seeking to enforce trademark rights that exist only under foreign law.”); *Person’s Co., Ltd. v. Christman*, 900 F.2d 1565, 1568-69 (Fed. Cir. 1990) (stating that “the concept of territoriality is basic to trademark law; trademark rights exist in each country solely according to that country’s statutory scheme”). See also 4 McCARTHY *supra* note 5 at § 29:1, at 1.

does not give a foreign user the right to claim “first use” in the United States and, thus, provides no exclusivity in the United States against a party who utilized the same or similar mark in American commerce prior to the foreign party’s actual use of the mark in the United States.³⁵ In other words, it is a rule of thumb that the first party to use or register a trademark in the United States is the senior user, even if another party initially used the mark in another country.

Several federal circuit courts, as well as the TTAB, the administrative appeal board established to resolve trademark disputes arising in the USPTO, repeatedly emphasize this rule.³⁶ Because “use” is paramount in American trademark law, courts frequently dismiss claims of a foreign party seeking to assert trademark rights without evidence of use of the mark in U.S. commerce. For example, in *Buti v. Impresa Perosa, S.R.L.*,³⁷ the Second Circuit held that advertising or promotion of a foreign mark in the United States alone is insufficient to constitute “use” of the mark “in commerce,” within the meaning of the Lanham Act, especially where the advertising is unaccompanied by any actual rendering of services in the United States or in commerce regulated by Congress.³⁸ In another leading case decided by the TTAB, prior use and advertising of a mark in connection with goods or services marketed in a foreign country created *no* priority rights in the United States against one who, in good faith, adopted the same or similar mark for the same or similar goods or services in the United States prior to the foreigner’s first use of the mark on goods or services in the United States.³⁹

Even evidence that a party *knew* of the foreign party’s prior use of a mark abroad before adopting it in the United States will often not affect the priority claim of the domestic party, unless adoption and use of the mark in the United States was done in bad faith.⁴⁰ Knowledge of prior foreign use does not preclude good-faith adoption

and use of the same or a similar mark in the United States unless the evidence shows that: (1) the use is a nominal one made solely to block the prior foreign user’s expansion into the U.S. market, or (2) the foreign mark is “famous” in the United States. As discussed in Part Four, significant ambiguity exists in the law as to the degree of fame necessary to overcome the priority of domestic use (i.e., use in the United States).⁴¹

Since trademark rights are territorial, the trademark laws of one country generally do not apply within the borders of another. But the Supreme Court’s 1952 decision in *Steele v. Bulova Watch Co.*,⁴² held that U.S. laws, including the Lanham Act, and the jurisdiction of American courts may reach into foreign countries when the alleged infringer’s conduct affects U.S. commerce and foreign law does not preclude application of U.S. law.⁴³ At the time of the underlying litigation, the Bulova Watch Company was one of the largest watch manufacturers in the world.⁴⁴ It was prevented from expanding into Mexico by Sidney Steele, who had begun marketing watches under the BULOVA trademark in Mexico before Bulova entered that market. In addition, Steele had registered the BULOVA trademark in Mexico. Although the case largely involved conduct that occurred within Mexico,⁴⁵ the Supreme Court deemed U.S. trademark law, namely, the Lanham Act, applicable to the dispute.⁴⁶ The Supreme Court based its decision in part on its finding that the Lanham Act reaches all commerce that can be regulated by Congress under the Commerce Clause, which may include commercial activities outside of U.S. borders.⁴⁷ Moreover, the Supreme Court agreed that Steele’s conduct had “effects” on commerce in the United States as a result of his inferior goods entering this country and reflecting poorly on Bulova’s reputation in the trade.⁴⁸ Importantly, by the time the dispute reached the Supreme Court, Steele’s trademark registrations in Mexico

35. See *Fuji Photo Film Co. v. Shinohara Shoji Kaisha*, 754 F.2d 591, 599 (5th Cir. 1985) (holding that “it is well settled that foreign use is ineffectual to create trademark rights in the U.S.”).

36. See *Gen. Healthcare Ltd. v. Qashat*, 364 F.3d 332, 335 (1st Cir. 2004); *Morningside Group Ltd. v. Morningside Capital Group LLC*, 182 F.3d 133, 51 U.S.P.Q.2d 1183 (2d Cir. 1999); *Buti*, 139 F.3d at 105; *Person’s Co., Ltd.*, 900 F.2d at 1565; *Mother’s Rest., Inc. v. Mother’s Other Kitchen, Inc.*, 218 U.S.P.Q. 1046 (T.T.A.B. 1983); *Techex, Ltd. v. Dvorkovitz*, 220 U.S.P.Q. 81, 83 (T.T.A.B. 1983).

37. 139 F.3d 98 (2d Cir.), *cert. denied*, 525 U.S. 826 (1998).

38. *Id.* at 105.

39. *Mother’s Rest.*, 218 U.S.P.Q. at 1046.

40. *Person’s Co., Ltd.*, 900 F.2d at 1572 (finding that U.S.-based defendant’s knowledge of the Japanese company’s trademark did not taint his priority rights in the United States because his adoption and use of the mark was not done in bad faith). See also *Buti*, 139 F.3d at 105 (holding that it is irrelevant whether plaintiff knew of defendant’s prior use of the mark in Italy); *Maison Prunier v. Prunier’s Rest. & Caf *, 288 N.Y.S. 529, 536 (N.Y. Sup. Ct. 1936) (holding that the territoriality rule is not applicable where a defendant is guilty of bad faith).

41. *Person’s Co., Ltd.*, 900 F.2d at 1570.

42. 344 U.S. 280 (1952).

43. *Id.* (affirming grant of request to specifically enjoin defendant’s infringing activity in Mexico). See also *Voda v. Cordis*, 476 F.3d 887, 906 (Fed. Cir. 2007) (Newman, J., dissenting) (“My colleagues hold that the district court abused its discretion in exercising supplemental jurisdiction of the foreign patent issues, indeed holding that the district court has no discretion to accept this amended complaint because it involves foreign patents. I cannot agree.... Precedent illustrates myriad situations in which the courts have determined and applied foreign law, and also illustrates those few situations in which a court has declined to resolve a specific foreign-based issue.”).

44. *Bulova*, 344 U.S. at 284.

45. Steele conducted some activities in the U.S., including the operation of an office in San Antonio through which he purchased some watch parts from within the United States. The Supreme Court deemed these activities “essential steps in the course of business consummated abroad.” *Id.* at 286.

46. *Id.* at 285.

47. *Id.* at 286.

48. *Id.*

had been cancelled as a result of simultaneous litigation between Steele and Bulova in that country.⁴⁹ Thus, the Supreme Court noted that foreign law did not preclude the exercise of jurisdiction by an American court.⁵⁰

Since *Bulova*, the circuit courts have adopted varying tests to determine when and under what circumstances extraterritorial application of the Lanham Act is appropriate. One test, set forth in the Second Circuit's decision in *Vanity Fair Mills, Inc. v. T. Eaton, Co.*,⁵¹ extracted three factors considered by the Supreme Court in *Bulova*: (1) whether the defendant is an American citizen; (2) whether the defendant's actions have a substantial effect on U.S. commerce; and (3) whether relief would create a conflict with foreign law.⁵² In weighing these factors, the Second Circuit noted that the absence of one factor may be "determinative" and the absence of two factors would be "fatal."⁵³ In *Vanity Fair*, which involved claims brought by the U.S. owner of the VANITY FAIR mark against a Canadian corporation (with an office in New York) that used the mark in Canada, the Second Circuit found that only the first factor was satisfied.⁵⁴ Therefore, it refused to extend the Lanham Act extraterritorially.⁵⁵

More recently, in 2005, the United States Court of Appeals for the First Circuit rejected the *Vanity Fair* test in *McBee v. Delica Co., Ltd.*⁵⁶ The plaintiff, Cecil McBee, is a "well-known" American jazz musician who had both toured and sold recordings under his own name in Japan.⁵⁷ McBee asserted false endorsement and dilution claims against the defendant, Delica, for its line of "clothing and accessories primarily marketed to teenage girls" under the mark CECIL MCBEE via a website accessible in the United States.⁵⁸ The website, www.cecilmcbee.net, was created and hosted in Japan, and featured text that was almost entirely in Japanese.⁵⁹ Notably, unlike in *Bulova*, McBee sought invalidation of Delica's CECIL MCBEE trademark in Japan, and the Japanese Patent Office ultimately upheld the validity of the Japanese mark.⁶⁰

The First Circuit took issue with two of the three *Vanity Fair* factors. As to the first, whether the defendant is an American citizen,

the First Circuit noted:

that inquiry is different because a separate constitutional basis for jurisdiction exists for control of activities, even foreign activities, of an American citizen. Further, when the Lanham Act plaintiff seeks to enjoin sales in the United States, there is no question of extraterritorial application; the court has subject matter jurisdiction.⁶¹

As to the third *Vanity Fair* factor, the existence of a conflict with foreign law, the First Circuit stated: "[W]e do not understand why the scope of Congressional power to create jurisdiction under the Lanham Act should turn on the existence and meaning of foreign law."⁶² Comity considerations, such as potential conflicts with foreign trademark law, the court stated, are "properly treated as questions of whether a court should, in its discretion, decline to exercise subject matter jurisdiction that it already possesses."⁶³ Thus, it is not a factor in determining whether subject matter jurisdiction exists; rather, it is a consideration in deciding whether to exercise that jurisdiction.

The First Circuit proceeded to hold that "the Lanham Act grants subject matter jurisdiction over extraterritorial conduct by foreign defendants only where the conduct has a substantial effect on U.S. commerce."⁶⁴ In so doing, the First Circuit reasoned that "Congress has little reason to assert jurisdiction over foreign defendants who are engaging in activities that have no substantial effect on the U.S., and courts, absent an express statement from Congress, have no good reason to go further in such situations."⁶⁵ Thus, the court first examines whether the defendant is a U.S. citizen. If so, the court may exercise the "separate constitutional basis" for exerting jurisdiction over the defendant. If the defendant is not a U.S. citizen, then the court applies the "substantial effects" test as the "sole touchstone" to determine jurisdiction. If satisfied, the court will then consider comity principles.⁶⁶

Applying its new test to the case at hand, the First Circuit rejected McBee's claim that the district court had subject matter

49. *Id.* at 285.

50. *Id.* at 289.

51. 234 F. 2d 633 (2^d Cir. 1956).

52. *Id.* at 642.

53. *Id.* at 643.

54. *Id.*

55. *Id.*

56. 417 F.3d 107 (1st Cir. 2005).

57. *Id.* at 112.

58. *Id.* at 111-12.

59. *Id.* at 124.

60. *Id.* at 107.

61. *Id.* at 111.

62. *Id.* at 121.

63. *Id.* at 111.

64. *Id.* at 120.

65. *Id.*

66. *Id.* at 121.

jurisdiction over Delica's internet website and Japanese sales.⁶⁷ The court determined that a foreign language website hosted in a foreign country was insufficient to satisfy the "substantial effects" test, noting that "something more is necessary, such as interactive features which allow the successful online ordering of the defendant's products."⁶⁸ Moreover, given the absence of evidence that American consumers were encountering Delica's products, the court determined that McBee failed to establish that Delica's Japanese sales had a "substantial effect" on U.S. commerce.⁶⁹

Other circuit courts have relied upon the Supreme Court's decision in *Bulova* to apply the Lanham Act in infringement cases brought by foreign trademark owners against U.S. parties who adopted or used the same or a similar mark in the United States.⁷⁰ For example, in *International Bancorp, LLC v. Societe des Bains de Mer et Du Cercle des Etrangers a Monaco*,⁷¹ the United States Court of Appeals for the Fourth Circuit held that the owner of a foreign trademark that had not been registered in the United States could bring an infringement action under the Lanham Act based on substantial advertising to American citizens in the United States and the rendering of services abroad to American citizens, which was found to constitute "use in commerce."⁷² The *Monaco* case established that the sale of services abroad to U.S. citizens by a foreign trademark owner, combined with substantial advertising in the United States, could, under certain circumstances, constitute "use in commerce."⁷³

Incidental "spill-over" of advertising from one nation into another may also constitute infringement, but courts require that the spill-over be significant and substantial before a user will be enjoined for infringement.⁷⁴ This is important because the outcome will normally rest on an intensive fact-based inquiry. The language of the Lanham Act requires that the use "substantially" affect commerce.⁷⁵ A court will also examine the intent of the advertising to determine whether

the foreign user was attempting to cause confusion among consumers regarding the actual source of the mark. These factors, as well as the mechanisms of treaties and foreign law discussed below, will dictate the scope of protection for trademark holders in the United States and abroad.

III. Treaties Affecting Territoriality of Trademarks

Given the increasingly global nature of intellectual property, several treaties affecting trademarks seek to ensure the protection of rights, as well as the harmonization of laws and procedures for multilateral filing of trademarks. A number of treaties, including the Paris Convention, the oldest major treaty concerning the protection of intellectual property, incorporate the territoriality principle. Specifically, Article 6.3 of the Paris Convention recognizes the principle of territoriality and provides that trademark rights are independent in each country.⁷⁶ In addition, Article 6.1 of the treaty recognizes that trademarks may be subject to domestic registration requirements.⁷⁷

Notably for present purposes, the Paris Convention also recognizes an exception to the territoriality principle for "famous" trademarks. Article 6bis of the treaty protects famous marks even if they are unregistered, recognizing the inherent function of trademarks, especially famous ones, as source indicators. Importantly, the owner of a famous foreign mark who is a national of a signatory nation to the Paris Convention and who does not own a federal registration in the United States can bring an unfair competition action in federal court based on the incorporation of the "famous marks" doctrine of the Paris Convention into the federal Lanham Act.⁷⁸ One prominent trademark law commentator even opined that application of the famous marks doctrine is *required* by the Paris Convention.⁷⁹

Several U.S. courts, however, have taken a different view, finding

67. *Id.* at 123.

68. *McBee*, 417 F.3d at 124-25. In addition to the Second and the First Circuits, other circuit courts have developed their own tests in determining whether to give the Lanham Act extraterritorial effect. Unlike the First Circuit, most other circuit courts that have addressed this issue have opted to consider more, not less, factors than those set forth in *Vanity Fair*. See, e.g., *Reebok Int'l Ltd. v. Marnatech Enter.*, 970 F.2d 554-57 (9th Cir. 1992) (analyzing a number of factors in addition to those articulated in *Vanity Fair*); *American Rice, Inc. v. Arkansas Rice Growers Co-op Ass'n*, 701 F.2d 408, 414 (5th Cir. 1983) (applying a "balancing analysis" using the three *Vanity Fair* factors as the primary factors).

69. *McBee*, 417 F.3d at 126.

70. *Int'l Bancorp, LLC*, 329 F. 3d at 364.

71. 329 F.3d 359 (4th Cir. 2003), cert. denied, 540 U.S. 1106 (2004).

72. *Id.* at 383. Commentator J. Thomas McCarthy agreed with the result in this case, but believed that the facts should have been analyzed under the "famous marks" doctrine. 4 McCARTHY *supra* note 5 at § 29:2.

73. *Int'l Bancorp, LLC*, 329 F. 3d at 383.

74. See *Sterling Drug, Inc. v. Bayer AG*, 14 F.3d 733, 743-44, 747 (2d Cir. 1994) (holding that German owner of BAYER aspirin mark could have some advertisements in the United States because not every activity of a foreign corporation with any tendency to create some confusion among American

consumers can be prohibited by the extraterritorial reach of a U.S. district court injunction). Other notable "spill-over" cases include: *First Niagara Ins. Brokers, Inc. v. First Niagara Fin. Group, Inc.*, 476 F.3d 867 (Fed. Cir. Cir. 2007); *Hilton Intern. Co., Inc. v. Hilton Hotels Corp.*, 888 F. Supp. 520 (S.D.N.Y. 1995); *Koffler Stores, Ltd. v. Shoppers Drug Mart, Inc.*, 434 F. Supp. 697, 193 U.S.P.Q. 165 (E.D. Mich. 1967).

75. See *Vanity Fair Mills Inc. v. T. Eaton, Co.*, 234 F. 2d 633, 640 (2d Cir. 1956).

76. "A mark duly registered in a country of the Union shall be regarded as independent of marks registered in the other countries of the Union, including the country of origin." Paris Convention for the Protection of Intellectual Property, Mar. 20, 1883, as last revised at Stockholm on July 14, 1967, 21. U.S.T. 1629, Art. 6(2). See also *Vanity Fair Mills*, 234 F. 2d at 640 ("The [Paris] Convention is not premised upon the idea that the trade-mark and related laws of each member nation shall be given extraterritorial application, but on exactly the converse principle that each nation's law shall have only territorial application.").

77. "The conditions for the filing and registration of trademarks shall be determined in each country of the Union by its domestic legislation." Paris Convention, Art. 6(1).

78. 4 McCARTHY, *supra* note 5 at § 29:4, at 29-3. Article 6bis is incorporated in U.S. law through Sections 43(a), 43(b), and 44(h) of the Lanham Act.

79. 4 McCARTHY, *supra* note 5 at § 29:61.

that the provisions of the Paris Convention do not exceed the rights conferred by the Lanham Act.⁸⁰ Most recently, and as described in more detail in Part Four, the Second Circuit enunciated its doubt in *ITC Ltd.*, questioning the intellectual honesty of the analytical framework underlying the famous marks doctrine.⁸¹

Setting aside for a moment the circuit split surrounding the applicability of the famous marks doctrine in U.S. jurisprudence, the Paris Convention makes clear that the owners of “famous” marks have an obligation to protect the distinctiveness of their marks, just as is required under the Lanham Act. The benefits conferred by the Paris Convention requires the owners of famous marks to diligently monitor and, if necessary, enforce those marks to prohibit the use of any mark that is confusingly similar to their famous mark.⁸² A party must request cancellation or prohibition of use of an infringing mark within at least five years from the date of the registration of the infringing mark.⁸³ Where an infringer registered or used the mark in bad faith, however, there is no time limit to request cancellation or prohibition of use.⁸⁴ Lastly, a party who filed a trademark application in one of the signatory nations has the right to claim that filing date for priority purposes for trademark applications filed within six months in other signatory countries.⁸⁵

The Agreement on Trade Related Aspects of Intellectual Property (“TRIPs”), administered by the World Trade Organization, also recognizes the principle of territoriality. TRIPs acknowledges domestic registration as a requirement for mark protection, but only for non-famous marks.⁸⁶ TRIPs also recognizes the “famous mark” doctrine and supplements the protection of famous marks conferred by Article 6bis of the Paris Convention (which it incorporates by reference) through a multi-level approach: First, TRIPs extends the protection of the “famous mark” doctrine of Article 6bis to service marks.⁸⁷ Second, TRIPs requires that, in determining whether a mark is famous, the knowledge of the trademark in the relevant public sector acquired as a result of promotion of the mark be taken into account.⁸⁸ Lastly, TRIPs entitles the owner of a famous mark to prevent use or

registration of the mark not only for the same or similar goods or services but also for *dissimilar* goods or services, “provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interest of the owner of the registered trademark are likely to be damaged by such use.”⁸⁹ Thus, TRIPs extends the protections afforded by the Paris Convention for well known or famous trademarks.

The Madrid Protocol is another treaty recognizing and expanding global trademark rights by establishing an international trademark registration system. As of 2007, there were 74 signatory nations to the Madrid Protocol, including the U.S. (2003) and the European Union (2004).⁹⁰ The Madrid Protocol allows trademark owners to obtain protection in any member country by filing a single international application.⁹¹ Any person who has a real and effective industrial or commercial establishment or a domicile in, or who is a national of, one of the countries of the Madrid Protocol may file an international application.⁹²

From the date of the international registration, the protection of the mark in each of the designated countries is the same as if the mark had been the subject of an application filed directly with the appropriate office of that country. If, during the first five years following the international registration, the national application or registration is cancelled, abandoned or otherwise restricted, the international registration is cancelled. In such a case, the trademark owner has the option of converting the international registration into a national application without losing the original filing date or priority date. In the United States, Madrid Protocol applications are filed with the USPTO. In 2005, the United States climbed from sixth to third place on the “most international applications filed” list, but the number of U.S. international applications is still below expectations.⁹³

While both the Paris Convention and TRIPs recognize the territoriality principle, both create potentially significant exceptions

80. See, e.g., *Barcelona.com, Inc. v. Excelentísimo Ayuntamiento De Barcelona*, 330 F.3d 617, 628 (4th Cir. 2003); *Maruti.com v. Maruti Udyog Ltd.*, 447 F.Supp.2d 494, 501 (D. Md. 2006).

81. *ITC Ltd. v. Punchgini, Inc.*, 482 F. 3d 135 (2d Cir.), cert. denied, 128 S.Ct. 288 (2007). See also *supra*, note 2 & *infra* Part Four.

82. The countries of the Union undertake, ex officio if their legislation so permits, or at the

request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

Paris Convention, Art. 6bis.

83. Paris Convention, Art. 6bis (2).

84. Paris Convention, Art. 6bis (3).

85. Paris Convention, Art. 4(A) (1) & (C) (1).

86. “The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner’s consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion.” TRIPs, Art. 16.1, 33 I.L.M. 81.

87. “Article 6bis of the Paris Convention (1967) shall apply, mutatis mutandis, to services.” TRIPs, Art. 16(2).

88. TRIPs, Art. 16.2.

89. TRIPs, Art. 16.3.

90. See Madrid System for the International Registration of Marks, World Intellectual Property Organization, <http://www.wipo.int/madrid/en/> (last visited Feb. 10, 2008).

91. *Id.*

92. *Id.*

93. Anne Urda, Germany Tops Madrid Protocol List, U.S. Lands 3rd, I.P. LAW 360, Feb. 9, 2006.

to the doctrine for famous marks. For example, both doctrines contemplate a scenario where a foreign, non-U.S.-based user is given priority rights to a mark, regardless of the level (or absence) of use in the United States. To date, however, there is scant case law in which a U.S. court discussed or applied the provisions of any treaty to a trademark dispute, and it is unclear how much weight U.S. judges will accord to foreign treaties and protocols unless the Supreme Court provides guidance.⁹⁴ Several courts that addressed the issue have expressly declined to apply the treaty provisions.⁹⁵ In so doing, U.S. courts overlooked the longstanding principle established in *Murray v. Schooner Charming Betsy* (“*Charming Betsy*”),⁹⁶ that “an act of Congress ought never to be construed to violate the law of nations if any other possible construction remains.”⁹⁷ What remains clear, however, is that international agreements, like TRIPs and the Paris Convention, have the potential to allow a foreign user of a trademark to leverage its foreign use against a U.S.-based user of the same or similar trademark, even for dissimilar goods or services.

IV. Exceptions to the Principle of Territoriality: “Well Known” or the “Famous” Mark Doctrine

Although most U.S. courts characterize the principle of territoriality as basic to trademark law, some US. courts — along with the treaties outlined above — have discussed (although few have applied) a potential exception to this general rule: the “well known” or “famous” mark doctrine.

The “well known” or “famous” mark doctrine provides protection for well known or famous foreign marks that, although not used or registered in the United States, are so famous that they have established a reputation in the United States. The doctrine seeks to avoid the danger of a junior user using a mark in the United States that is confusingly similar to a famous foreign mark causing confusion among American consumers as to the source of the goods or services offered under the mark in the United States.⁹⁸ One court reasoned that “[r]ecognition of the famous marks doctrine is particularly desirable in a world where international travel is commonplace and where the Internet and other media facilitate the rapid creation of business goodwill that transcends borders.”⁹⁹ In effect, application of the famous marks doctrine would provide a defense to the owners of famous foreign marks to prevent usurpation of trademarks by “trademark pirates who rush to register a famous mark on goods on which it has not been registered in a nation by the legitimate foreign user.”¹⁰⁰

Despite the policy rationale for application of the famous marks doctrine, several U.S. courts that have addressed it have characterized it as a “controversial common law exception” with “uncertain” viability.¹⁰¹ Most U.S. courts have been reluctant to apply it in a trademark case to trump the rights of a U.S.-based junior user.¹⁰² Most recently, the Second Circuit joined several district courts declining to apply this doctrine given the particular facts of the case, or expressly rejected its intellectual foundation as not a part of federal law and contrary to the Supreme Court’s recognition of the territoriality

94. *See, e.g.*, *In re Rath*, 402 F.3d 1207, 1209 (Fed. Cir. 2005) (refusing to apply the Paris Convention, finding that it is not self-executing and requires congressional implementation); *Empresa Cubana del Tabaco v. Culbro Corp.*, 399 F.3d 462, 481 (2d Cir. 2005), *cert. denied*, 126 S.Ct. 2887 (2006) (“[L]egislative acts trump treaty-made international law’ when those acts are passed subsequent to ratification of the treaty and clearly contradict treaty obligations.”); *Grupo Gigante SA De CV v. Dallo & Co.*, 391 F.3d 1088, 1098 (9th Cir. 2004) (finding that Paris Convention created neither federal cause of action of additional substantive rights not found in Lanham Act).

95. *See, e.g.*, *In re Rath*, 402 F. 3d at 1209 (refusing to apply the Paris Convention, finding that it is not self-executing and requires congressional implementation); *Grupo Gigante SA De CV*, 391 F. 3d at 1098 (finding that Paris Convention created neither federal cause of action of additional substantive rights not found in Lanham Act); *see also ITC Ltd.*, 482 F. 3d at 164-66; *Empresa Cubana del Tabaco*, 399 F. 3d at 481; *Maruti.com*, 447 F.Supp. 2d at 501.

96. 6 U.S. (2 Cranch) 64 (1804).

97. *Id.* at 118.

98. *See, e.g.*, *Vaudable v. Montmartre, Inc.*, 123 U.S.P.Q. 357, 357 (1959) (the Parisian restaurant MAXIM was sufficiently famous in the United States to enjoin the defendant’s use of the mark for his New York restaurant); *Empresa Cubana del Tabaco*, 399 F. 3d at 481 (examining the district court finding that the COHIBA trademark for Cuban-manufactured cigars was sufficiently famous

in the United States such that the Cuban manufacturer possessed rights senior to the U.S. user of the same mark for cigars); *Grupo Gigante SA De CV*, 391 F. 3d at 1098 (holding that the mark GIGANTE for a large chain of grocery stores in Mexico was well known enough in Southern California to grant the Mexican company seniority over defendant’s use of the mark in San Diego); *Maison Prunier v. Prunier’s Rest. & Café*, 288 N.Y.S. 529, 538 (N.Y. Sup. Ct. 1936) (plaintiff’s internationally famous restaurant was well known in the United States and warranted enjoinder of defendant’s use of the name in the United States).

99. *De Beers LV Trademark Ltd. v. DeBeers Diamond Syndicate Inc.* (“*De Beers I*”), No. 04 Civ. 4099 (DLC), 2005 WL 1164073, at *8 (S.D.N.Y. May 15, 2005).

100. *Id.* (quoting 4 McCARTHY, *supra* note 5 at § 29:61).

101. *De Beers I*, 2005 WL 1164073, at *7 (referring to the doctrine as “controversial”); *ITC Ltd. v. Punchgini, Inc.*, 373 F. Supp. 2d 275, 286 (S.D.N.Y. 2005), *aff’d*, 482 F. 3d 135 (2d Cir.), *cert. denied*, 128 S.Ct. 288 (2007) (same); *see also Int’l Bancorp. LLC*, 329 F. 3d at 364; *Maruti.com v. Maruti Udyog Ltd.*, 447 F.Supp.2d 494, 500 (D. Md. 2006); *De Beers LV Trademark Ltd. v. DeBeers Diamond Syndicate Inc.* (“*De Beers II*”), 440 F.Supp.2d 249, 269 (S.D.N.Y. 2006); *Almacenes Exito S.A. v. El Gallo Meat Market, Inc.*, 381 F.Supp.2d 324 (S.D.N.Y. 2005).

102. *See, e.g.*, *Int’l Bancorp. LLC*, 329 F. 3d at 364; *Maruti.com*, 447 F. Supp. at 500; *De Beers II*, 440 F.Supp.2d at 249; *Almacenes Exito S.A.*, 381 F.Supp.2d at 324; *De Beers I*, 2005 WL 1164073, at *7; *ITC Ltd.*, 373 F. Supp. 2d at 275.

principle.¹⁰³ Other courts have yet to reach the issue of the “famous mark” doctrine, simply holding that the marks in question were not famous enough to warrant application of the doctrine.¹⁰⁴

The United States Court of Appeals for the Ninth Circuit is the only federal circuit court to date that has clearly recognized the applicability of the famous marks doctrine.¹⁰⁵ In *Grupo Gigante SA De CV v. Dallo & Co., Inc.*,¹⁰⁶ the Ninth Circuit set forth the following two-prong “famous mark” test: (1) the mark must have acquired secondary meaning in the later user’s market; and (2) a “substantial percentage” of consumers in the relevant U.S. market must be familiar with the mark.¹⁰⁷ Although these factors are not necessarily determinative, the court stated that they nonetheless bear heavily on the risks of consumer confusion and fraud -- the very reasons for having a famous mark exception in the first place. Factors to consider in the “famous” mark analysis also include whether the defendant intentionally copied the foreign mark, and whether U.S. customers are likely to be confused into thinking that they are buying products or services from or affiliated or connected with the foreign owner of the mark.¹⁰⁸

In 2005, the Second Circuit appeared likely to follow the Ninth Circuit’s lead but, for separate reasons, expressly declined to do so. In *Empresa Cubana del Tabaco v. Culbro Corp.*,¹⁰⁹ the district court held that the Cuban COHIBA cigar brand was “famous” and deserved protection in the United States pursuant to the Lanham Act despite evidence that the COHIBA trademark had never been used in the United States.¹¹⁰ The Second Circuit subsequently overturned this decision,¹¹¹ discussing but ultimately sidestepping the “famous marks” doctrine and holding that the Cuban embargo prevented Cubatabaco, the Cuban trademark holder, from acquiring any property rights in the United States, including trademark rights.¹¹² Thus, the Second Circuit stopped short of recognizing that federal law and the Lanham Act contemplate the famous marks doctrine as a narrow exception to the territoriality principle.¹¹³ In dicta, the court stated that the

level of fame required to trigger the famous marks doctrine was the same as that required for the acquisition of secondary meaning, plus a finding that significant confusion was likely.¹¹⁴ The Supreme Court subsequently denied certiorari in *Empresa*.¹¹⁵

Only two years after the *Empresa* decision, however, the Second Circuit had another opportunity to review the applicability of the famous marks doctrine. In *ITC Ltd. v. Punchgini, Inc.*,¹¹⁶ ITC, an Indian corporation and owner of a U.S. trademark registration for BUKHARA restaurant services, sued several of its former employees who opened two New York restaurants under the name BUKHARA GRILL II.¹¹⁷ ITC owned and operated a five-star hotel in New Delhi, India, which featured a restaurant known as “BUKHARA.”¹¹⁸ The record reflected that this restaurant, operated continuously since 1977, developed international renown and was named one of the world’s 50 best restaurants by London-based “*Restaurant*” magazine in 2002 and 2003.¹¹⁹ Over a thirty-year period, ITC either operated directly or franchised BUKHARA restaurants in several cities, such as New York, Chicago, Montreal, Hong Kong and Bangkok.¹²⁰ As of May 2004, however, the only remaining ITC-owned or authorized BUKHARA restaurants were located in New Delhi, Singapore, Kathmandu, and Ajman.¹²¹

ITC closed all of its U.S.-based restaurants by 1997, but the company re-entered the U.S. market in 2001 through the sale of packaged food products featuring the BUKHARA and DAL BUKHARA trademarks.¹²² At the inception of its new U.S. initiative, ITC filed a trademark application with the USPTO for DAL BUKHARA for packaged food products and subsequently obtained a trademark registration.¹²³ In May 2003, ITC sold packaged food products under the DAL BUKHARA mark to two U.S. food distributors in California and New Jersey.¹²⁴ In addition, ITC displayed its DAL BUKHARA items at the June 2003 International Fancy Foods Show in New York City.¹²⁵

ITC asserted trademark infringement, unfair competition,

103. See, e.g., *De Beers II*, 440 F. Supp. at 269; *De Beers I*, 2005 WL at *7; *ITC Ltd.*, 373 F.Supp.2d at 275.

104. See, e.g., *Buti*, 139 F. 3d at 14; *Person’s Co., Ltd.*, 900 F. 2d at 1565; *ITC Ltd.*, 373 F. Supp. 2d at 286.

105. *Grupo Gigante SA De CV v. Dallo & Co.*, 391 F.3d 1088, 1098 (9th Cir. 2004). The Ninth Circuit, however, did not issue a ruling on the application of the famous marks doctrine to the particular facts of the case in *Grupo Gigante*. Rather, it remanded the case to the district court to further determination on the fame issue. *Id.*

106. 391 F.3d 1088 (9th Cir. 2004).

107. *Id.*

108. *Id.*

109. 97 Civ. 8399 (RWS), 2004 WL 602295, at *1 (S.D.N.Y. 2004), *rev’d*, 399 F.3d 462 (2d Cir. 2005), *cert. denied*, 126 S.Ct. 2887 (2006).

110. *Id.* at *30-*39, *52.

111. 399 F.3d 462 (2d Cir. 2005), *cert. denied*, 126 S.Ct. 2887 (2006).

112. *Id.* at 476.

113. *Id.* at 465.

114. *Id.* at 469-70.

115. *Empresa Cubana del Tabaco v. General Cigar Co., Inc.*, 126 S. Ct. 2887 (2006).

116. 482 F.3d 135 (2d Cir.), *cert. denied*, 128 S.Ct. 288 (2007).

117. *Id.* at 144-45.

118. *Id.*

119. *Id.* at 143 n.4.

120. *Id.* at 143.

121. *Id.*

122. *Id.*

123. *Id.*

124. *Id.*

125. *Id.* at 144-45.

and false advertising claims against Punchgini.¹²⁶ In addition, and as primarily relevant for purposes of this article, ITC asserted that the Second Circuit should allow suit against Punchgini for unfair competition pursuant to the famous marks doctrine.¹²⁷

In its defense, Punchgini argued that ITC abandoned its trademark rights to the BUKHARA mark when the company closed all affiliated restaurants in the United States.¹²⁸ In order to establish abandonment of the BUKHARA mark for restaurant services, Punchgini had to demonstrate that: (a) ITC did not currently use the mark; and (b) ITC did not intend to resume use of the mark in the “reasonably foreseeable future.”¹²⁹ While ITC conceded that it did not currently use the mark in the United States, it nonetheless argued that it intended to resume use.¹³⁰ As evidence of its intent to resume, ITC stressed “(1) the reasonable grounds for its suspension of use of the mark, (2) its efforts to develop and mark a DAL BUKHARA line of packaged food, (3) its attempts to identify potential U.S. restaurant franchisees, and (4) its continued use of the BUKHARA mark for restaurants outside the U.S.”¹³¹

In reviewing the district court’s determination that ITC abandoned the BUKHARA mark, the Second Circuit focused on the definition of abandonment provided in the Lanham Act: “[n]onuse (of a mark) for 3 consecutive years shall be prima facie evidence of abandonment.”¹³² In this case, the three-year period extended from August 28, 1997 (i.e., the time when ITC’s last U.S. restaurant closed) to August 28, 2000.¹³³ Thus, the statutory presumption applied in this case.¹³⁴ In determining whether it overcame this presumption, the court examined the evidence submitted by ITC concerning this time-period.¹³⁵ After so doing, the Second Circuit found that: (1) Indian regulations pertaining to the return of profits earned abroad

did not justify ITC’s failure to use the BUKHARA mark in the United States during the three-year period;¹³⁶ (2) the mere mention of using the name BUKHARA in association with packaged foods (in a July 27, 2000 corporate management committee meeting in India) was insufficient to demonstrate ITC’s plan to resume use in the United States;¹³⁷ (3) a few facsimiles, e-mails, and letters from entrepreneurs requesting franchise information did not evidence that ITC was actively looking to open new U.S. restaurants;¹³⁸ and (4) the continued operation of BUKHARA restaurants abroad between 1997 and 2000 did not evidence an intent to resume use in the United States.¹³⁹ Thus, the Second Circuit held that ITC had abandoned its trademark rights in the BUKHARA mark for restaurant services in the United States.¹⁴⁰ As a result, having no U.S.-based trademark rights to assert against Punchgini, the Second Circuit affirmed the district court grant of summary judgment in favor the defendants on ITC’s trademark infringement claims.¹⁴¹

The court then turned to ITC’s only remaining argument: its reliance on the famous marks doctrine to support its unfair competition claim. In so doing, the Second Circuit rejected this doctrine and eviscerated its analytical foundation.¹⁴² The court acknowledged that the Ninth Circuit’s recognition of the famous marks doctrine was a “matter of sound policy: ‘[a]n absolute territoriality rule without a famous marks exception would promote customer confusion and fraud’.”¹⁴³ The Second Circuit, however, deconstructed the Ninth Circuit’s reasoning, pointing out that the famous marks doctrine was found nowhere in the Lanham Act or any other federal law.¹⁴⁴ Moreover, without citing the *Charming Betsy* doctrine, the court determined that neither the Paris Convention nor any other treaty “creates substantive U.S. rights beyond those independently provided

126. *Id.* at 145. ITC also asserted an unfair competition claim under New York common law. The Second Circuit certified questions to the New York Court of Appeals of whether New York common-law recognizes the famous marks doctrine and, if so, the degree of fame necessary to trigger application. *Id.* at 135. New York’s highest court recently decided these issues, ruling that state law recognizes common-law unfair competition claims, but not the “famous” or “well known” marks doctrine. *ITC, Ltd. v. Punchgini, Inc.*, No. 09813, 2007 WL 4334177, at *6 (N.Y. Dec. 13, 2007). The court reasoned that “when a business, through renown in New York, possesses goodwill constituting property or commercial advantage in this State, that goodwill is protected from misappropriation under New York unfair competition law[,]” regardless of whether the business is foreign or domestic. *Id.* Application of New York’s unfair competition law is premised upon a foreign user’s ability to establish the existence of goodwill in New York. *Id.* The court did not provide an exhaustive list of factors relevant to such an inquiry, but noted that the following factors would be relevant: (1) the defendant’s intent to associate its goods with the foreign plaintiff; (2) direct evidence, such as of consumer surveys; and (3) evidence of actual overlap between the New York defendant’s consumers and the foreign plaintiff. *Id.* Finally, the court said that, to succeed on a common-law unfair competition claim, the plaintiff must show that: (1) the defendant’s copying of plaintiff’s mark was deliberate; and (2) the relevant consumer market for plaintiff’s goods or services associates defendant’s goods or services with the foreign business. *Id.* Thus, a foreign mark with renown in New York can be protected the misappropriation prong of New York’s unfair competition law even though the foreign mark has not been actually used in New York. *Id.*

127. *ITC Ltd.*, 482 F.3d at 145.

128. *Id.* at 144-45.

129. *Id.* at 147.

130. *Id.*

131. *Id.* at 151.

132. *Id.* at 147 (citing 15 U.S.C. § 1127 (2002)).

133. *Id.* at 149.

134. *Id.* at 148-49.

135. *Id.* at 151-53.

136. *Id.* at 151-52.

137. *Id.* at 152.

138. *Id.* at 152-53.

139. *Id.* at 153.

140. *Id.*

141. *Id.*

142. *Id.*

143. *Id.* at 160 (quoting *Grupo Gigante*, 391 F.3d at 1094). The Second Circuit also attempted to justify its prior positions on the famous marks doctrine: “This court has twice referenced the famous marks doctrine, but on neither occasion were we required to decide whether it does, in fact, provide a legal basis for acquiring priority rights in the U.S. for a foreign mark not used in this country.” *Id.* (citing *Buti*, 139 F.3d at 104 n.2 and *Empresa Cubana del Tabaco*, 399 F.3d at 481).

144. *Id.* at 162-63.

in the Lanham Act[.]”¹⁴⁵ especially given Congress’ propensity to amend the Act when appropriate.¹⁴⁶ Despite the well-intentioned policy decision of the Ninth Circuit in *Grupo Gigante*, the Second Circuit concluded:

The fact that a doctrine may promote sound policy... is not sufficient ground for its judicial recognition, particularly in an area regulated by statute. In light of the comprehensive and frequently modified federal statutory scheme for trademark protection set forth in the Lanham Act, we conclude that any policy arguments in favor of the famous marks doctrine must be submitted to Congress for it to determine whether and under what circumstances to accord federal recognition to such an exception to the basic principle of territoriality. Absent such Congressional recognition, we must decline [the] invitation to grant judicial recognition to the famous marks doctrine simply as a matter of sound policy.¹⁴⁷

Although ITC petitioned for review of the Second Circuit’s ruling by the Supreme Court, the nation’s highest court once again declined to weigh in on whether U.S. law recognizes the famous marks doctrine.¹⁴⁸ Legal practitioners are therefore left to parse through the jurisprudence of two respected federal circuit courts and, assuming the doctrine is even accepted (as is called into doubt by the Second Circuit), distinguish two different legal rules that are both characterized as the “famous marks” doctrine.

The first is the legal concept discussed above, i.e., a trademark is protected within a nation if it is well known in that nation even though it is not actually used or registered. The second legal rule arises in the context of anti-dilution laws of various states and, since 1996, in federal law.¹⁴⁹ In the anti-dilution realm, a mark must be very strong and widely recognized because the law subsequently provides extraordinary exclusivity rights.¹⁵⁰

The Federal Trademark Dilution Act (“FTDA”) prohibits the unauthorized use in commerce of a “famous and distinctive mark” that “causes dilution of the distinctive quality of the mark,” regardless

of whether or not such use causes a likelihood of confusion.¹⁵¹ The eight-factor test to determine whether the mark is distinctive or famous includes: (1) the degree of inherent or acquired distinctiveness of the mark; (2) the duration and extent of use of the mark in connection with the goods or services with which the mark is used; (3) the duration and extent of advertising and publicity of the mark; (4) the geographical extent of the trading area in which the mark is used; (5) the channels of trade for the goods or services with which the mark is used; (6) the degree of recognition of the mark in the trading areas and channels of trade used by the mark’s owner and the person against whom the injunction is sought; (7) the nature and extent of use of the same or similar marks by third parties; and (8) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the Principal Register. The owner of the famous mark can get civil remedies and an injunction if the other trademark dilutes his or her mark.

While affording judicial direction, the FTDA’s eight-factor test resulted in problems of statutory interpretation. For instance, the FTDA’s preamble proclaims that an evaluation of the eight factors would resolve “whether a mark is distinctive and famous.”¹⁵² This statement prompted questions of whether distinctiveness was a separate requirement from “famous” and, if so, “which factors in the list are relevant to fame, which are relevant to distinctiveness, and which may be relevant to both.”¹⁵³

In 2003, the Supreme Court limited enforcement of the FTDA to cases where the plaintiff could demonstrate “actual” dilution.¹⁵⁴ In response, Congress passed, and President Bush signed, the Trademark Dilution Revision Act (“TDRA”) in 2006. Under this act, a plaintiff is entitled to enjoin use of a trade name or mark “that is *likely* to cause dilution . . . regardless of the presence or absence of actual or likely confusion, or competition, or of actual economic injury.”¹⁵⁵ A plaintiff is now only required to show a *likelihood* of dilution, not actual dilution, as had been required by the Supreme Court, in order to obtain an injunction.

The TDRA also provides an important definition of “famous” that was absent from the FTDA. It states that a famous mark is one that is “widely recognized by the general consuming public of the U.S.”¹⁵⁶

145. *Id.* at 164-65.

146. *Id.* at 164 (“Congress’s specificity in dealing with registered marks cautions against reading a famous marks exception into [the Lanham Act], which nowhere references the doctrine, much less the circumstances under which it would appropriately apply despite the fact that the foreign mark was not used in this country. We are mindful that Congress has not hesitated to amend the Lanham Act to effect its intent with respect to trademark protection, having done so almost thirty times since the statute took effect in 1947. . . . In light of these legislative efforts, the absence of any statutory provision expressly incorporating the famous marks doctrine or Articles 6bis and 16(2) is all the more significant. Before we construe the Lanham Act to include such a significant departure from the principle of territoriality, we will wait for Congress to express its intent more clearly.”) (citations and footnotes omitted).

147. *Id.* at 165 (internal citations omitted).

148. *ITC Ltd. v. Punchgini, Inc.*, 128 S.Ct. 288 (2007) (denying *certiorari*).

149. See Federal Trademark Dilution Act of 1995, Pub. L. 104-98, Jan. 16, 1996, 109 Stat. 985, codified at 15 U.S.C. § 1125(c) (2000); 4 McCARTHY, *supra* note 5 at § 29:61; *ITC Ltd.*, 482 F. 3d at 142 n. 2.

150. *ITC Ltd.*, 482 F. 3d at 142 n. 2.

151. *Id.*

152. See William G. Barber, The Trademark Dilution Revision Act Of 2005: Breathing Life Back Into The Federal Dilution Statute, 16 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1113, 1117 (2006).

153. See *id.*

154. *Moseley v. Secret Catalogue*, 537 U.S. 418, 433 (2003).

155. 15 U.S.C. § 1125(c)(1)(2000)(emphasis added).

156. 15 U.S.C. § 1125(c)(2)(A) (2000).

The TDRA replaced the FTDA's eight non-exclusive factor test with four non-exclusive factors to be considered in assessing the fame of the mark and in determining whether a mark or trade name is likely to cause dilution by blurring.¹⁵⁷ The factors for determining the fame of the mark or trade name include: (1) the duration and extent of advertising and publicity of the mark; (2) the amount, volume and geographic extent of sales of goods offered under the mark; (3) the extent of actual recognition of the mark; and (4) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.¹⁵⁸ The six-factor test to determine whether the mark is likely to cause dilution by blurring includes: (1) the degree of similarity between the mark or trade name and the famous mark; (2) the degree of inherent or acquired distinctiveness of the famous mark; (3) the extent to which the owner of the famous mark engages in substantial exclusive use of the mark; (4) degree of recognition of the famous mark; (5) whether there was intent to create an association with the famous mark; and (6) any actual association between the mark or trade name and the famous mark.¹⁵⁹

The TDRA bestows upon trademark owners a number of remedies upon a showing that: (1) the defendant commenced use of the dilutive mark after October 6, 2006 (the date of enactment of the Revision Act); and (2) by reason of dilution by blurring, the defendant willfully intended to trade on the recognition of the famous mark, or by reason of dilution by tarnishment, the defendant willfully intended to harm the reputation of the famous mark.¹⁶⁰ Dilution by blurring will be found when the use of the defendant's mark results in the loss of the ability for plaintiff's mark to serve as a unique identifier of the plaintiff's product, causing the public to no longer associate the plaintiff's famous mark with its goods or services.¹⁶¹ Dilution by tarnishment, on the other hand, occurs when the defendant's use of a mark degrades or tarnishes the positive associations of the mark and dilutes the distinctive quality of the mark.¹⁶² Upon either showing, a plaintiff is subsequently entitled to recover: (1) the defendant's profits; (2) any damages and costs sustained by the plaintiff; and (3) the costs of the action.¹⁶³ In exceptional cases, reasonable attorney fees may be awarded to a successful plaintiff, and the plaintiff may also be entitled to destruction of any infringing articles that contain the mark or feature in question.¹⁶⁴

Only a handful of cases recognize the recently enacted TDRA,

and none have found that the plaintiff met its burden of proving dilution.¹⁶⁵ Even with the lesser required showing of a *likelihood* — as opposed to *actual* — dilution under the TDRA, it appears that plaintiffs will continue to bear a heavy burden of establishing that the subject mark is sufficiently “famous” to satisfy the dilution statute. That plaintiffs continue to bear, at least according to recent decisions, a “heavy burden” is due the TDRA's definition of “famous.” As the United States District Court for the Southern District of New York recently recognized:

[t]he FTDA did not contain the phrase “widely recognized by the general consuming public of the U.S.” in its definition of ‘famous.’ Its inclusion in the TDRA was intended to reject dilution claims based on ‘niche’ fame, i.e., “fame limited to a particular channel of trade, segment of industry or service, or geographic region.”¹⁶⁶

The United States District Court for the Northern District of California gave similar recognition to the TDRA's rejection of niche fame in its May 2007 decision in *Jarritos, Inc. v. Los Jarritos*,¹⁶⁷ stressing how the plaintiff's evidence “does not address the volume of Plaintiff's sales, the breadth of Plaintiff's advertisements, or consumers' recognition of the mark.”¹⁶⁸ Thus, while the TDRA lowered the burden of proof to the showing of a likelihood of dilution, it required fame on a national level, thereby seeming to limit dilution claims to only those marks that have become household names.

In addition to the dilution context, the level of fame of a trademark may also assist a trademark owner in recapturing a domain name lost to a cybersquatter or a registrant or user unrelated to the trademark owner. Fame of a trademark is a relevant consideration in disputes arising under both the Uniform Domain Name Dispute Resolution Policy (“UDRP”) and the Anticybersquatting Consumer Protection Act (“ACPA”). The UDRP, which was adopted by the Internet Corporation for Assigned Names and Numbers (“ICANN”) in 1999, allows the owner of a trademark to dispute registration of a domain name incorporating that trademark by one not authorized to use the mark.¹⁶⁹ Thus, a domain name will be transferred to the rightful trademark holder upon a showing that: (1) the domain name

157. 15 U.S.C. § 1125(c)(2000).

158. *Id.*

159. *Id.*

160. *Id.* § 1125(c)(5).

161. See *World Wrestling Fed'n Entm't, Inc. v. Big Dog Holdings, Inc.*, 280 F.Supp.2d 413, 441 (W.D. Pa. 2003).

162. See *id.* at 442.

163. 15 U.S.C. § 1117(a) (2000 & Supp. 2005).

164. 15 U.S.C. §§1117(a), 1118 (2000 & Supp. 2005).

165. See, e.g., *Century 21 Real Estate LLC v. Century Ins. Group*, No. Civ. 03-0053 (PHX-SMM), 2007 LEXIS 9720, at *49 (D. Ariz. Feb. 8, 2007); *Autozone, Inc. v. Strick*, 466 F.Supp.2d 1034, 1045 (N.D. Ill. 2006).

166. *Dan-Foam A/S v. Brand Named Beds, LLC*, 2007 WL 1346609, 6 (S.D.N.Y. 2007) (citing *Christopher D. Smithers Found., Inc. v. St. Luke's-Roosevelt Hosp. Ctr.*, No. 00 Civ. 5502, 2003 WL 115234, at *5 (S.D.N.Y. Jan.13, 2003).

167. No. C 05-02380 JSW, 2007 WL 1302506, at *1 (N.D. Cal. 2007).

168. *Id.* at *17-18.

169. Rules for Uniform Domain Name Dispute Resolution Policy, ICANN, <http://www.icann.org/dndr/udrp/uniform-rules.htm> (last visited Nov. 20, 2007).

is identical or confusingly similar to a trademark or service mark in which the complainant has rights; (2) the respondent has no rights or legitimate interests in the domain name; and (3) the domain name has been registered and is being used in bad faith.¹⁷⁰ The degree of fame (including international fame) of the trademark has been central to a determination of whether the domain name holder has any legitimate rights to the domain and in deciding whether the domain name holder acted in bad faith.¹⁷¹ The UDRP typically provides the owners of famous trademarks or service marks with fast-track resolution of domain name disputes, as the rules provide a short timetable for briefing and decision.¹⁷² The remedies, however, are limited, providing only for the cancellation or transfer of a domain.

Monetary damages, in addition to the transfer or cancellation of a domain name, are available to the owners of famous or distinctive trademarks and service marks pursuant to the ACPA. The ACPA, which took effect on November 29, 1999, is aimed at stemming “cybersquatting,” or the registration of domain names in “bad faith” that are identical, confusingly similar to, or in the case of a famous mark, dilutive of, their trademarks or service marks. A cybersquatter is one who knowingly reserves Internet domain names similar to another’s trademark in order to sell the domain name to the trademark owner or to benefit from the goodwill associated with the mark.¹⁷³ Under the ACPA, a trademark owner must demonstrate: (1) that the domain name holder has a bad faith intent to profit from the trademark; and (2) “registers, traffics in, or uses a domain name that,” as relevant here, “is famous at the time of registration of the domain name, is identical or confusingly similar to or dilutive of that mark[.]”¹⁷⁴ In determining “bad faith intent,” U.S. courts can consider, among other things, the extent to which the mark incorporated in the person’s domain name registration is or is not distinctive and famous within the meaning of the TDRA.¹⁷⁵ The ACPA authorizes the courts to order forfeiture or cancellation of the disputed domain name or the transfer the domain to the trademark owner. The ACPA also empowers the courts to award statutory damages of not less than \$1,000 and not more than \$100,000 per domain.¹⁷⁶ Thus, the ACPA provides another avenue for relief for the owners of famous trademarks.¹⁷⁷

While U.S. courts have been reluctant to bestow trademark rights on the owners of famous foreign trademarks in priority contests in the United States, it is clear that several remedies exist pursuant to which the owners of famous trademarks can protect their marks from

misuse in domain names. The process of protecting one’s mark from infringement or misuse in domain names is aided if the subject mark is famous.

Conclusion

Potential erosion of the territoriality principle in the global marketplace is most obviously enhanced by the increased use of the Internet as a selling channel. Since this channel goes beyond traditional physical boundaries and obstacles, mark holders are increasingly confronting issues that, relatively recently, would have been unheard of for all but the largest corporations. As a result, mark holders must be vigilant in monitoring their territory to ensure that their goodwill is not diluted or infringed. However, this is a complicated endeavor and businesses are not well equipped for this task because they are more likely focused on selling their products in increasingly competitive markets. Likewise, businesses must now extend their protective vision not only to their competitors down the street, but their competitors across the oceans.

The Madrid Protocol has attempted to streamline these procedures through a simplified international registration system; however, current statistics indicate that it is being underutilized, particularly in the United States.¹⁷⁸ As trademark filings increase, the burden on local registration systems will necessitate additional participation in the Madrid Protocol. The consequences will hopefully be a streamlined process where a centralized office has the power to grant (and enforce) worldwide trademark rights.

The future of the famous marks doctrine is similarly unclear. While the Paris Convention explicitly recognizes the importance of protecting famous marks, the rationale behind it further diminishes the territoriality principle by emphasizing source indication. The justification that a famous mark is protected because of the source it represents cannot be limited by national boundaries. The reach of global marketing and advertising that creates a famous mark continues to extend to a wider audience. Whether American courts will increasingly apply the famous marks doctrine, thereby creating a larger exception to the territoriality rule, is an open question. But it is a question that will take on increasing importance as technology causes the world to continually grow smaller.

170. UDRP Rules, ¶ 4(a).

171. *See, e.g.,* Volvo Trademark Holding AB v. Unasi, Inc., D2005-0556 (WIPO Jul. 29, 2005) (“The Panel shares the view[] . . . that the trademark VOLVO is certainly to be considered a famous trademark in view of the extensive and worldwide use by Complainant. . . .”); Diageo Ireland, Arthur Guinness Son & Co. (Dublin) Limited v. The Director, D2003-0885 (WIPO Dec. 23, 2003) (“Complainant’s mark GUINNESS is undoubtedly famous, and it is inconceivable that the Respondent was not aware of the mark and the Complainant’s ownership of the mark at all times relevant to the dispute.”); Victoria’s Secret v. Asdak, FA 96542 (Nat. Arb. Forum Feb. 28, 2001) (finding sufficient proof that respondent was not commonly known by a domain name confusingly similar to complainant’s VICTORIA’S SECRET mark because of complainant’s well-established use of the mark); Nike, Inc. v. B.B. de Boer, D2000-1397 (WIPO Dec. 21, 2000) (finding no rights or legitimate interests where one “would be hard pressed to find a person who may show a right or legitimate interest” in a domain

name containing complainant’s distinct and famous NIKE trademark).

172. UDRP Rules, ¶¶ 5-6, 15 (providing a 20-day period for response to a complaint and the resulting decision within 14 days following appointment of the panel or panelists).

173. *See, e.g.,* H.R. Rep. No. 106412, at 5-7; S. Rep. No. 106-140, at 4-7 (1999).

174. 15 U.S.C. §1125(d)(1)(A)(i-ii) (2000).

175. 15 U.S.C. §1125(d)(1)(B)(ix)(2000).

176. 15 U.S.C. § 1117(d)(1)(C) (2000).

177. *See, e.g.,* Virtual Works, Inc. v. Volkswagen of America, Inc., 238 F.3d 264 (4th Cir. 2001) (upholding violation of ACPA for registration of “vw.net” and subsequent offer to sell domain name to defendant).

178. Jesse Greenspan, *Germany Tops International Trademark List*, I.P. LAW 360, Mar. 16, 2007.

Case & Statute Comments

Corporate Law—Shareholder Breach of Fiduciary Duty in Close Corporations

Brodie v. Jordan, 447 Mass. 866 (2006)

Introduction

The Supreme Judicial Court (“SJC”) recently caught the attention of corporate lawyers and litigators alike with its decision in *Brodie v. Jordan*.¹ The decision represents a retreat from the SJC’s seminal, 1975 decision in *Donahue v. Rodd Electrotype Co. of New England, Inc.*,² which recognized a direct right of action between shareholders of a close corporation, and broad equitable relief, for breach of the fiduciary duty of utmost good faith and loyalty (“freeze-out” claims)³. Freeze-outs are characterized by a controlling shareholder’s oppressive conduct, aimed at depriving a minority owner of the benefits of stock ownership.⁴ The *Donahue* court employed its broad equitable power to remedy a freeze-out by ordering that the minority’s shares be purchased on terms as favorable as those which the controlling shareholders offered to another shareholder.⁵

Since *Donahue*, Massachusetts courts have employed equitable remedies on behalf of minority shareholders who have fallen victim to a freeze-out.⁶ As has been observed, “[n]owhere has Massachusetts’ time-honored equity practice been more creatively employed, and nowhere does it enjoy greater continued vitality, than in the area of internecine disputes, in closely held corporations.”⁷ *Brodie v. Jordan*, however, seems to have put an end to such creative equity. Even though the SJC adopted lower courts’ findings that controlling, majority shareholders had breached a fiduciary duty to Mary Brodie, a minority shareholder of a close corporation, the SJC found that she was not entitled to a forced buyout of her shares as ordered by the trial court and affirmed by the Appeals Court.⁸ Extending the “reasonable expectations” analysis previously used to determine a majority owner’s liability for breach of fiduciary duty, the SJC relied on Mary Brodie’s “reasonable expectations” to undo the buyout remedy ordered by the lower courts.⁹ In rejecting the buyout, the SJC concluded that Brodie had no reasonable expectation that the company would purchase her shares and, in the absence of any such expectation, found that the

buyout granted to Brodie a windfall by creating an “artificial market” for her shares.¹⁰

By adopting a “reasonable expectation” standard for both assessing liability and determining the scope of equitable relief available in freeze-out disputes, the SJC is arguably in line with the current trend in other jurisdictions.¹¹ This standard offers some doctrinal clarity in an area of law typified by varied and occasionally inconsistent remedies. It also has an undeniable logical appeal, purporting to ensure that remedies for freeze-out behavior will be “proportional to the breach.”¹² One must ask, however, whether such limits on the courts’ equity power will deprive them of the capacity to implement practical remedies that truly make an aggrieved shareholder whole, and whether it will end corporate battles which might otherwise continue for years. Under *Brodie*, courts will no longer have broad equitable discretion to extricate shareholders from untenable, mutually destructive corporate relationships, even when, as appeared to be the case in *Brodie*, to do so represents the most practical and fair approach to resolving a freeze-out dispute. On the other hand, parties who no longer can rely on the courts to resolve such disputes with finality may, and should, take more care to protect themselves when investing in a close corporation. This comment explores the evolution of the reasonable expectation standard announced in *Brodie* and considers its practical impact in freeze-out cases.

I. *Brodie v. Jordan*

Malden Centerless Grinding Inc. was organized in 1973 by Walter Brodie, the plaintiff’s late husband, David Barbuto, a defendant, and Guy Agri.¹³ The company is a closely-held corporation, meaning that: it has “(1) a small number of stockholders; (2) no ready market for the corporate stock; and (3) substantial majority stockholder participation in the management, direction and operations of the corporation.”¹⁴ Robert Jordan, a co-defendant, was hired in 1975.¹⁵

1. 447 Mass. 866 (2006).

2. 367 Mass. 578 (1975).

3. *Id.* at 593.

4. *Id.* at 588.

5. *Id.* at 603.

6. *See, e.g.*, Hallahan v. Haltom Corp., 7 Mass. App. Ct. 68 (1979).

7. Thomas P. Billings, *Remedies for the Aggrieved Shareholder in a Close Corporation*, 81 MASS. L. REV. 3, 3 (1996).

8. *Brodie v. Jordan*, 447 Mass. 866, 867 (2006).

9. *Id.* at 870-71.

10. *Id.* at 872.

11. 2 F. HODGE O’NEAL & ROBERT B. THOMPSON, O’NEAL AND THOMPSON’S CLOSE CORPORATIONS AND LLCs: LAW AND PRACTICE § 9:29 (3d ed. 1996).

12. *See Brodie*, 447 Mass. at 873.

13. *Brodie v. Jordan*, 66 Mass. App. Ct. 371, 372 (2006).

14. *Brodie*, 447 Mass. at 868-69 (citing *Donahue v. Rodd Electrotype Co. of New England, Inc.*, 367 Mass. 578, 586 (1975)).

15. *Brodie*, 66 Mass. App. Ct. at 372.

In 1979, Agri resigned and sold his shares to the company.¹⁶ Upon Agri's resignation, Walter Brodie became president.¹⁷ From 1979 until 1984, Brodie and Barbuto were the company's sole shareholders.¹⁸ In 1984, Jordan became a shareholder, resulting in Barbuto, Walter Brodie and Jordan each owning 400 shares.¹⁹

Sometime prior to 1989, Walter Brodie became largely inactive, and in 1989, he attempted to sell his shares to the company through the presentation of a draft purchase agreement, proposing a price of \$145,000, which Jordan refused.²⁰ Intermittently, Walter Brodie made other requests for the company to purchase his shares, all of which were rejected.²¹

As a result of ongoing friction between Walter Brodie and Jordan, Jordan and Barbuto voted to remove Brodie as an officer and director in 1992.²² From then until his death in 1997, Walter Brodie had only limited involvement with the company: he received notices of annual meetings, but did not attend;²³ he held no offices, and other than consultant's fees that he was paid in 1994 and 1995, he received no payments from the company;²⁴ he met with Jordan and Barbuto two or three times a year.²⁵

After Walter Brodie's death, his wife, Mary Brodie, inherited his 400 shares and became executrix of his estate.²⁶ Soon after, Brodie nominated herself for election as a director, to fill the seat left vacant by her husband, but her effort was defeated by Jordan and Barbuto.²⁷ She also requested financial information about the company, including a request for a valuation of her shares.²⁸ Jordan and Barbuto failed to honor those requests as well.²⁹

In February 1998, having not received the financial information she requested, Mary Brodie filed a complaint in superior court alleging, *inter alia*, the defendants' breach of fiduciary duty to her.³⁰ Eight months later, in October of 1998, Brodie notified the corporation that she wished to sell her shares, requesting \$205,000 and invoking the valuation process set forth in the articles of organization (a process the defendants abandoned after an unsuccessful attempt at mediation).³¹

Finding that the majority owners had breached their fiduciary

duties by freezing Brodie out of the company, and for the purpose of placing "the plaintiff in the position she would have been in if there had been no wrongdoing," the trial court ordered the defendants to purchase her shares.³² When the parties could not agree on a price, the trial court awarded Brodie damages in the amount of \$94,500.³³ Defendants appealed.

The Appeals Court affirmed both the trial court's finding that the plaintiff had been wrongfully frozen out and its order requiring purchase of the plaintiff's shares.³⁴ The Appeals Court also found that Barbuto and Jordan's receipt of numerous financial and operational benefits from their ownership interests, while denying any such benefits to Mary Brodie, further demonstrated a freeze-out.³⁵ Finally, the Appeals Court agreed that the defendants had hindered the plaintiff's ability to sell her shares to a third party by their refusal to participate in the mandatory valuation process set forth in the articles of organization.³⁶ As a result of defendants' refusal to participate in a stock valuation, and in recognition of the already questionable marketability of Brodie's shares, the Appeals Court concluded that the plaintiff had wrongfully been denied "a true opportunity to dispose of her shares."³⁷ Affirming the court-ordered buyout, the Appeals Court rejected the defendants' argument that the remedy created a windfall for the plaintiff, stating that anything less would have merely returned the plaintiff "to the isolated position she found herself in before ... without corporate office and promised only annual, unaudited financial statements."³⁸ This, of course, is where the SJC disagreed.³⁹

In reviewing the Appeals Court's ruling, the SJC drew upon the "reasonable expectations" standard it had employed 30 years earlier to determine liability for a freeze-out in *Wilkes v. Springside Nursing Home, Inc.*⁴⁰ Extending the reasonable expectation standard to the question of remedy, the *Brodie* court stated:

Because the wrongdoing in a freeze-out is the denial by the majority of the minority's reasonable expectations of benefit, it follows that the remedy should, to the

16. Agri first offered his shares to the corporation for the price of \$50,000; the parties negotiated a final price of \$25,000. *Id.* at 384 n.18.

17. *Id.* at 372.

18. *Id.*

19. *Id.* at 372 n.4.

20. *Id.* at 372.

21. *Id.* at 372, 384 n.18.

22. *Id.* at 373.

23. *Id.*

24. *Brodie v. Jordan*, 447 Mass. 866, 868 (2006).

25. *Id.* at 867; *Brodie*, 66 Mass. App. Ct. at 373.

26. *Brodie*, 66 Mass. App. Ct. at 373.

27. *Id.*

28. *Id.*

29. *Id.*; *see Brodie*, 447 Mass. at 870 n.4.

30. *Brodie*, 66 Mass. App. Ct. at 373.

31. *Id.*

32. *Id.* at 384. The defendants' refusal to accept the plaintiff's self-nomination as a director, refusal to provide plaintiff with requested financial information, and refusal to either purchase plaintiff's shares or participate in a valuation of her shares, thereby preventing her from offering them for sale to a third party, all contributed to the court's conclusions concerning liability. *Id.* at 376-83.

33. *Id.* at 374.

34. *Id.* at 388.

35. *Id.* at 379 n.12. Jordan received a salary from the corporation, participated in a profit-sharing plan, and had use of a company car. Barbuto received director's fees until 1998, was paid rent by the corporation for a building he owned and rented to the corporation, and enjoyed an open line of credit for another, independently-owned business that was a customer of the company. *Brodie v. Jordan*, 447 Mass. 866, 868 (2006).

36. *Brodie*, 66 Mass. App. Ct. at 383-84.

37. *Id.* at 382.

38. *Id.* at 385.

39. *Brodie*, 447 Mass. at 871-72.

40. 370 Mass. 842 (1976).

extent possible, restore to the minority shareholder those benefits which she reasonably expected, but has not received because of the fiduciary breach.⁴¹

The court then concluded that Mary Brodie had no reasonable expectation that her shares would be purchased by the corporation, and that the buyout remedy, by creating an “artificial market” for her shares, placed her in a better position than she would have enjoyed absent the wrongdoing.⁴² In support of its finding, the court stated: “[t]here is nothing in the background law, the governing rules of this particular close corporation, or any other circumstance that could have given the plaintiff a reasonable expectation of having her shares bought out.”⁴³ Although the court never said so explicitly, it apparently concluded that under these circumstances, the buyout constituted an abuse of the trial court’s discretion, which is the standard of review for equitable remedies.⁴⁴

The SJC remanded the case for a further determination of the plaintiff’s reasonable expectations, whether they were frustrated, and if so, how those interests could be vindicated.⁴⁵ The court instructed that money damages would be the appropriate remedy for quantifiable deprivations and that injunctive relief may be appropriate “to ensure that the plaintiff is allowed to participate in company governance, and to enjoy financial or other benefits from the business, to the extent that her ownership interest justifies.”⁴⁶ While on remand, the case was settled and dismissed by the parties.

II. The Reasonable Expectation Standard

A. Evolution in Massachusetts

Brodie’s reasonable expectation standard for determining a remedy is the traditional basis for judicial analysis of *liability* in freeze-out cases. The seeds of the reasonable expectation standard were planted in *Donahue*, although the more groundbreaking aspects of the decision have until now overshadowed this fact. The plaintiff in *Donahue* was a non-family member shareholder in a largely family-owned corporation.⁴⁷ In an effort to convince their father to retire, the sibling-shareholders, who collectively owned a controlling interest in the company, negotiated an agreement for the corporation to purchase their father’s shares for \$800 per share.⁴⁸ The plaintiff was unaware of this transaction until she was asked to vote to ratify

it at the following annual meeting.⁴⁹ She refused, and soon thereafter offered her shares to the corporation for the same price paid to the father.⁵⁰ The corporation, in turn, refused her offer, and the plaintiff sued, claiming an unlawful distribution of corporate assets.⁵¹

Recognizing the duty of “utmost good faith and loyalty” by majority to minority shareholders of close corporations⁵², the *Donahue* court concluded:

[I]f the stockholder whose shares were purchased was a member of the controlling group, the controlling stockholders must cause the corporation to offer each stockholder an equal opportunity to sell a ratable number of his shares to the corporation at an identical priceThe controlling group may not, consistent with its strict duty [of utmost good faith and loyalty] to the minority, utilize its control of the corporation to obtain special advantages and disproportionate benefit from its share ownership.⁵³

This conclusion, however, came with a caveat. Such unequal treatment of stockholders in stock purchases would be acceptable when “all other stockholders give advance consent to the stock purchase arrangements through acceptance of an appropriate provision in the articles of organization, the corporate by-laws or a stockholder’s agreement.”⁵⁴ The *Donahue* holding suggested early on that a minority shareholder may enforce only those expectations that are defined by the parties’ intentions and agreements, as evidenced by the majority’s conduct, the parties’ course of dealings and governing corporate documents.

The *Donahue* court remanded for entry of an order that either the plaintiff be given the equal opportunity to sell her shares to the corporation under the same terms granted to the favored shareholder, or that the favored shareholder reimburse the corporation for the purchase price of his shares, with interest.⁵⁵ Although it is unknown which of the two remedies were imposed on remand, *Donahue* has since stood for the proposition that it is within the court’s equitable powers to order a corporation to purchase a minority shareholder’s ownership interest.⁵⁶

A year later, in *Wilkes v. Springside Nursing Home, Inc.*,⁵⁷ the SJC explicitly made the connection between a minority shareholder’s expectations of benefit from stock ownership and the majority’s

41. *Brodie*, 447 Mass. at 870-71.

42. *Id.* at 871-72. The court readily distinguished the facts in this case from those in *Donahue v. Rodd Electrotype Co. of New England, Inc.* *Id.* at 872 n.5.

43. *Id.* at 872.

44. *Demoulas v. Demoulas*, 428 Mass. 555, 589 (1998) (citing *Bodio v. Ellis*, 401 Mass. 1, 10 (1987)).

45. *Brodie*, 447 Mass. at 873.

46. *Id.* at 873-74.

47. *Donahue v. Rodd Electrotype Co. of New England, Inc.*, 367 Mass. 578, 581-84 (1975).

48. *Id.* at 583.

49. *Id.* at 584.

50. *Id.*

51. *Id.* at 584-85.

52. *Id.* at 593.

53. *Id.* at 598.

54. *Id.* at 599 n.24 (citing *Brown v. Little Brown & Co.*, 269 Mass. 102 (1929)).

55. *Id.* at 603-04. Note that it was the latter option which plaintiff requested in her complaint. *Id.* at 603.

56. *See, e.g.*, *Brodie v. Jordan*, 66 Mass. App. Ct. 371, 385 (2006); *Keating v. Keating*, Nos. 00749, 00748, 2003 WL 23213143, at *18 (Mass. Super. Ct. Oct. 3, 2003).

57. 370 Mass. 842 (1976).

liability for acting to frustrate those expectations:

At a minimum, the duty of utmost good faith and loyalty would demand that the majority consider that their action [in terminating the minority's employment] was in disregard of a long-standing policy of the stockholders that each would be a director of the corporation and that employment with the corporation would go hand in hand with stock ownership.⁵⁸

The court further observed that Wilkes, the minority shareholder, had "invested his capital and time for more than 15 years *with the expectation* that he would continue to participate in corporate decisions."⁵⁹ This reference to the minority shareholder's expectations, together with the court's earlier analysis in *Donahue*, began to frame the standard that was expressly articulated some 30 years later, in *Brodie*.

Since *Donahue* and *Wilkes*, the courts have had numerous occasions to employ their broad equitable powers to fashion remedies in freeze-out disputes. A review of these cases reveals that generally, though not always, the courts have anchored their analyses in the notion that liability and, to a lesser extent, remedy, should be defined by the minority's reasonable expectations of benefit from stock ownership.⁶⁰ The best-known example in recent history is the superior court's decision in *Demoulas v. Demoulas*.⁶¹

The *Demoulas* litigation included a direct action by the widow and children of George Demoulas, who owned shares in a closely held family corporation. The action was brought against his surviving brother, Telemachus Demoulas, his children and the corporation.⁶² The jury found that Telemachus Demoulas, through a number of actions, had violated his fiduciary duties to the plaintiffs so as to increase his control in the corporation from 50 percent to 92 percent.⁶³

Following the jury's finding, a superior court judge rescinded certain fraudulent stock transfers by Telemachus Demoulas, divested the defendants of ownership interests in another company to restore the balance of control that had existed before the deceased brother's death, and removed Telemachus Demoulas from the board of

directors of the family corporation.⁶⁴ The court stated: "[r]escission is the only remedy that accomplishes equity's mission of fairness while fulfilling plaintiffs' *reasonable expectations*. The court recognizes the meaningful expectations that plaintiffs have in their ownership rights in [the company], and the right to participate in its management."⁶⁵ The SJC affirmed on direct appellate review.⁶⁶

Likewise, in *Bodio v. Ellis*,⁶⁷ the court looked to the understanding and intentions of the parties, as evidenced by their stock purchase agreement and prior conduct, to conclude that the minority had a reasonable expectation that he and another shareholder would be on equal footing in terms of ownership interest, employment and control of the corporation.⁶⁸ The court, therefore, ordered the majority to relinquish that portion of his shares that would leave him with an ownership interest equal to the minority's position.⁶⁹

The plaintiff's reasonable expectations were explicitly discussed for the first time in *Merola v. Exergen Corp.*⁷⁰ As in *Wilkes*, the plaintiff in *Merola* was a minority shareholder terminated from his employment in the corporation.⁷¹ The employment relationship began in conjunction with a private stock offering, which the plaintiff accepted.⁷² The plaintiff was told that if he invested in the corporation and accepted its offer of employment, "he would have the opportunity to become a major stockholder in the corporation and to have continuing employment with the corporation."⁷³ These promises, the court concluded, established "reasonable expectations that [the plaintiff] would receive a return in his investments with continued employment and with opportunities to become a major shareholder of [the company]."⁷⁴

In the more recent case of *Leslie v. Boston Software Collaborative*,⁷⁵ a freeze-out in which the controlling shareholders removed the minority shareholder from the board of directors and terminated his employment (based upon the exceedingly hostile and disruptive conduct by the minority owner), the superior court followed the "reasonable expectations" approach to crafting a remedy without describing it as such. Although finding that the majority's conduct was unlawful and that the parties' relationships were "broken beyond repair,"⁷⁶ the court declined to order a buyout of the minority's shares, finding that, unlike *Donahue*, no other stockholders had received monetary benefit from the sale of their shares.⁷⁷ To order

58. *Id.* at 852-53.

59. *Id.* at 853 (emphasis added).

60. See, e.g., *Bodio v. Ellis*, 401 Mass. 1 (1987); *Hallahan v. Haltom Corp.*, 7 Mass. App. Ct. 68 (1979); *Leslie v. Boston Software Collaborative, Inc.*, No. 010268BLS, 2002 WL 532605 (Mass. Super. Ct. Feb. 12, 2002); *Demoulas v. Demoulas*, No. 90-2344, 1996 WL 511519, at *4 (Mass. Super. Ct. Aug. 20, 1996) (amended Oct. 1, 1996), *aff'd in part, vacated in part and remanded*, 428 Mass. 555 (1998).

61. *Demoulas*, 1996 WL 511519 at *9-10.

62. *Demoulas* 428 Mass. at 557.

63. *Id.*

64. *Demoulas*, 1996 WL 511519, at *9-10.

65. *Id.* at *5 (emphasis added).

66. *Demoulas*, 428 Mass. at 591-92.

67. *Bodio v. Ellis*, 401 Mass. 1 (1987).

68. *Id.* at 8-9.

69. *Id.* at 10.

70. *Merola v. Exergen Corp.*, 38 Mass. App. Ct. 462, 468 (1995).

71. *Id.* at 462-63.

72. *Id.* at 467-68.

73. *Id.* at 468.

74. *Id.*

75. *Leslie v. Boston Software Collaborative, Inc.*, No. 010268BLS, 2002 WL 532605 (Mass. Super. Ct. Feb. 12, 2002).

76. *Id.* at *9.

77. *Id.* at *8.

a buyout, the court concluded, would not be “a proper equitable resolution,”⁷⁸ presumably because nothing in the parties’ prior course of dealings allowed the conclusion that the plaintiff might expect his shares to be bought. Ultimately, in addition to money damages designed to make the plaintiff whole for his loss of employment, the corporation was ordered to reinstate the plaintiff as a director to allow him to participate in the corporation’s management, despite a history of bellicose behavior which one might have expected to warrant permanent separation from his co-owners.⁷⁹

B. Application of the Reasonable Expectation Standard

Although the SJC’s opinion in *Brodie* suggests that governing corporate documents, past conduct on the part of controlling shareholders, and the parties’ course of dealings can offer clues to the minority’s expectations of benefit from stock ownership,⁸⁰ many questions remain to be answered about how such expectations are to be proved and what evidence renders them deserving of judicial protection. For example, in finding that Mary Brodie possessed no expectation that her shares would be purchased by the corporation, the court seems to have ignored the fact that the company had previously purchased the shares of Agri, another co-founder, when he resigned.⁸¹ The court offered no rationale for why this fact did not give rise to some expectation on the part of both Mary Brodie and her husband that when he left the company’s employment, his interests would likewise be purchased by the corporation.

Some guidance on the definition of “reasonable expectations” in the freeze-out context can be gleaned from other jurisdictions, including the oft-cited case *In re Kemp & Beatley, Inc.*,⁸² in which the court held that “oppression should be deemed to arise only when the majority conduct substantially defeats expectations that, objectively viewed, were both reasonable under the circumstances and were central to the petitioner’s decision to join the venture.”⁸³ This definition, however, leaves open the question of whether a remedy fairly can be determined by applying the same standard. It also leaves unanswered how such intentions can be divined after the death of the original shareholder, and whether one’s reasonable expectations pertaining to stock ownership might develop over time, as the relationship evolves.

Mary Brodie, for example, came into her ownership as an inheritance. She never worked at the company or had the least involvement in its affairs, save any information her husband chose to share with her during their marriage. By limiting Brodie’s relief

to her expectations of benefit from her ownership interest, the SJC seems to be assuming a relationship, or at the very least, some mutual understanding, that never existed. One must question how, in such circumstances, a theoretical framework based on the minority’s “reasonable expectations” can fairly redress indisputably unlawful and oppressive conduct, particularly when visited upon those who succeed to stock ownership by death, divorce, foreclosure of a lien or a gift.

C. Reasonable Expectations Versus Practicality and Fairness

Ever since *Donahue*, the courts have struggled with the tension between the need for broad equitable relief to stop oppressive conduct by those controlling a close corporation and the potential that such relief will overextend judicial oversight of private corporate conduct and “unduly hamper [the corporation’s] effectiveness in managing the corporation in the best interests of all concerned.”⁸⁴ The reasonable expectation standard announced in *Brodie* appears intended to limit a court’s involvement in those affairs in a manner tailored to the corporation’s own established practices. These limits, however, inevitably come at some cost.

The decision in *Keating v. Keating*⁸⁵ illustrates a fundamental problem in limiting freeze-out remedies, especially that of the buyout, to those for which the minority shareholder can demonstrate some reasonable expectation. *Keating* involved a family dispute in which a father, the majority owner of the company, terminated his minority owner son’s employment after a series of episodes in which the son found himself increasingly at odds with his father and sister, another employee.⁸⁶ Although recognizing that the minority owner, by virtue of his ownership interest, possessed a reasonable expectation of continued employment,⁸⁷ the court made no findings about his expectations concerning the redemption of his shares upon his departure from the company.⁸⁸ In fact, the evidence recited by the court suggested the contrary, that the parties had no such expectations.⁸⁹ Nevertheless, the court reasoned, “[i]n many situations the only fair and practical remedy is a court-ordered buyout of the minority shares by the majority.”⁹⁰

Deciding that reinstating the minority shareholder to his former employment and to the board of directors would be ineffective, owing both to the parties’ inability to tolerate one another and to the fact that the minority shareholder had begun another business venture, the court ordered the majority owner to purchase the minority’s shares.⁹¹ This remedy appeared to have been the only practical and fair means

78. *Id.*

79. *Id.* at *9.

80. *Brodie v. Jordan*, 447 Mass. 866, 872 (2006).

81. *Brodie v. Jordan*, 66 Mass. App. Ct. 371, 372 (2006).

82. *In re Kemp & Beatley, Inc.*, 473 N.E.2d 1173 (N.Y. 1984).

83. *Id.* at 1179.

84. *Wilkes v. Springside Nursing Home, Inc.*, 370 Mass. 842, 850-851 (1976) (“the controlling group . . . must have some room to maneuver in establishing the business policy of the corporation”); *see also* *Goode v. Ryan*, 397 Mass. 85, 92 (1986) (“It is not the proper function of this court to reallocate the risks inherent

in the ownership of corporate stock in the absence of corporate or majority shareholder misconduct.”).

85. *Keating v. Keating*, Nos. 00749, 00748, 2003 WL 23213143 (Mass. Super. Ct. Oct. 3, 2003).

86. *Id.* at *13.

87. *Id.* at *15.

88. *Id.* at *18.

89. *Id.*

90. *Id.*

91. *Id.*

of adequately compensating the minority owner for his ownership interest while bringing to a close the parties' dispute. There appears little doubt, however, that such a remedy, in these circumstances, would not be upheld under the *Brodie* standard, because nothing in the parties' past dealings or the corporation's governing documents established a policy or practice of purchasing a departing shareholder's stock.

As was observed some years before the *Brodie* decision, "[i]n a shareholder oppression context, this equitable parting [a buyout] may be necessary for an effective resolution of the dispute. Alternative remedies ... are often inadequate in a shareholder oppression context."⁹² Because a close corporation, by definition, involves a small number of shareholders involved in its management and operations, it is inevitable that when conflicts arise involving breaches of fiduciary duty, relationships may be damaged beyond repair. In this context, it is naïve to impose a remedy that requires embittered parties to continue to deal with one another. "To put it bluntly, it ... is futile to expect a closely held corporation to operate smoothly when a shareholder has been frozen out, litigation has ensued, and the court has compelled the shareholder's return."⁹³ In *Brodie*, for example, the court suggested that the lower court, on remand, consider ordering the payment of dividends as a remedy.⁹⁴ This recommendation fails to take into account the likelihood that the parties will continue to spar over the timing and amount of dividends, requiring continued judicial intervention and oversight.⁹⁵

After the SJC remanded *Brodie*, the parties were compelled to expend substantial additional resources to determine whether, and to what extent, the defendants had wrongfully diverted to themselves corporate profits, necessitating the initiation of another evidentiary hearing, including the use of experts, and further proposed findings of fact and conclusions of law.⁹⁶ Because corporate dividends are contingent upon a company's ongoing financial performance, it is not improbable that a court might be called upon unendingly to referee such disputes. If the problem sought to be prevented by the court's decision in *Brodie* is excessive judicial involvement in corporate affairs, then this cannot have been the outcome the court intended.⁹⁷

Neither can monetary damages be counted upon in every instance to "restore to the minority shareholder those benefits which she reasonably expected, but has not received because of the fiduciary

breach."⁹⁸ As Douglas K. Moll has observed:

[A]ssume that the [minority] shareholder's expectation of employment was the only expectation that was frustrated by the majority's actions. From a damages standpoint, a court could award conventional wrongful termination damages such as back pay and, in appropriate cases, front pay.... Given the track record of oppressive majority behavior, however, the damage award is arguably inadequate, as it leaves the other aspects of the shareholder's investment bargain (e.g. management role, dividends) subject to the majority's control.⁹⁹

This appeared to be the shortcoming in the relief awarded in the 2002 decision of *Leslie v. Boston Software Collaborative, Inc.*, in which the court stated the minority's "participation as an employee is, like the fallen egg, broken beyond repair."¹⁰⁰ Given the absence of evidence that the minority could reasonably expect to have his shares purchased, the court declined to order a buyout.¹⁰¹ Accordingly, the corporation was ordered to pay damages to the minority to compensate him for his lost salary.¹⁰² Inexplicably, however, the court also ordered the minority's reinstatement to the board of directors, purportedly to allow him to participate in the corporation's management.¹⁰³ The futility of such an order, given the court's own findings about the parties' relationship, leads one to wonder why, if the aim of remedies for oppressive shareholder conduct is to make the plaintiff whole and to resolve the underlying dispute, a buyout was not regarded to be the only fair and practical remedy available under the circumstances.

Conclusion

Proper assessment of a shareholder's reasonable expectations in fashioning remedies in freeze-out disputes appears to ensure that courts do not overextend themselves in corporate management and decision making. The *Brodie* case does not guarantee that result. Also, limiting the equitable discretion of trial courts in such cases may not secure a just outcome.

Ordering the purchase of the minority's shares, where the controlling shareholder or group has unlawfully deprived the minority

92. Douglas K. Moll, *Reasonable Expectations v. Implied-In-Fact Contracts: Is the Shareholder Oppression Doctrine Needed?*, 42 B.C. L. REV. 989, 1019 (2001).

93. *Id.* (internal quotation omitted).

94. *Brodie v. Jordan*, 447 Mass. 866, 874 (2006).

95. It is curious that the court contemplated the payment of dividends in light of the fact that the corporation had never before declared dividends, nor did the corporate documents require it to do so. Mary Brodie could not have reasonably expected to receive dividends any more than she could have expected to have her shares purchased.

96. *Brodie v. Malden Centerless Grinding, Inc.* (Middlesex Superior Court, Docket No. MICV1998-00518).

97. A further wrinkle here is that declaration of dividends is within the province of the corporation, and is not a remedy that historically has been available against individual shareholders. See *Crowley v. Commc'ns. For Hosps., Inc.*, 30 Mass. App. Ct. 751, 767 (1990).

98. *Brodie*, 447 Mass. at 871.

99. Moll, *supra* note 92, at 1020-21.

100. *Leslie v. Boston Software Collaborative, Inc.*, No. 010268BLS, 2002 WL 532605, at *9 (Mass. Super. Ct. Feb. 12, 2002).

101. *Id.* at *8.

102. *Id.* at *10.

103. *Id.* at *11.

of the benefits of ownership, is often the only fair and practical means of resolving such disputes.

The facts of *Brodie v. Jordan* confronted the court with an added complication: How can the reasonable expectations of a party who inherited shares in a close corporation be determined? In many close corporations, the original investor makes decisions as to corporate involvement based on that person's knowledge, expertise, employment needs and personal relationships. It is unlikely that a successor by death, gift, divorce or any non-negotiated event is privy to the original owner's understandings and expectations. In such circumstances, the reasonable expectation standard seems an effort to fit a square peg into a round hole.

In light of *Brodie*, owners of close corporations must take steps to prepare for the death of shareholders and other events (such as deadlock over management) that can more efficiently and less

disruptively be resolved without broad judicial intervention. Options include purchasing key man life insurance policies designed to buy out a deceased shareholder, including repurchase provisions within governing corporate documents and drafting employment agreements or other agreements that contemplate the departure of shareholders from the company.¹⁰⁴ Through careful preparation, the parties can avoid some of the disentanglement problems raised by *Brodie*.

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104. For further discussion of reasonable expectations upon transfer of shares and/or changed expectations, see Douglas K. Moll, *Shareholder Oppression*

and Reasonable Expectations: of Change, Gifts, and Inheritances in Close Corporation Disputes, 86 MINN. L. REV. 17 (2002).

Criminal Law — Placing Criminal Convictions on File

Commonwealth v. Simmons, 448 Mass. 687 (2007)

Introduction

In *Commonwealth v. Simmons*,¹ the Supreme Judicial Court (“SJC”) turned its attention to Massachusetts’ unusual practice of placing criminal convictions “on file.” *Simmons* began its appellate journey in the Appeals Court,² and made its way to the SJC via the commonwealth’s application for further appellate review. While the SJC ultimately ordered essentially the same relief as the Appeals Court, it claims to have reached that result “for different reasons.”³ In fact, the analysis applied by the SJC mirrors the approach taken by the Appeals Court in many cardinal respects. However, the opinions differ on at least one crucial point: whereas the Appeals Court proposed specific principles to govern filing procedures in future cases, the SJC left the future of filing practices decidedly uncertain.

I. History of Filing Procedures

The filing of criminal convictions, a procedural device apparently unique to Massachusetts, has existed as a common law custom dating back to the earliest days of the commonwealth. The SJC described the filing process in *Commonwealth v. John Dowdican's Bail*⁴:

It has long been a common practice in this Commonwealth, after verdict of guilty in a criminal case, when the court is satisfied that, by reason of extenuating circumstances, or by the pendency of a question of law in a like case before a higher court, or other sufficient cause, public justice does not require an immediate sentence, to order, with the consent of the defendant and of the attorney for the Commonwealth...that the indictment be laid on file.... Such an order is not equivalent to a final judgment... but is a mere suspending of active proceedings in the case....

Although a number of current statutes refer to the practice of filing in various contexts⁵, none provides express authority for the procedure, and none establishes any precise rules governing the manner in which

filing should occur.

As a practical matter, placing a conviction on file has typically amounted to an indefinite and unconditional deferral of sentencing.

Though theoretically it may be possible... to take [a] case from the files and make a final disposition of it, if we take account of the ordinary modes of the procedure in the local courts it must be concluded that there is every probability that once a case is placed on file, it will remain in that status undisturbed and probably forgotten.⁶

It is precisely because of the typical finality of filed convictions that the procedure has rarely come under appellate scrutiny; a defendant has little motivation to challenge what is effectively a post-conviction dismissal of a criminal charge. Indeed, *Simmons* appears to be the first broad challenge to the lawfulness of the filing regime.

II. Procedural History

On September 22, 1981, the defendant pled guilty to a total of 13 indictments. He received committed sentences on six, with the remaining convictions “placed on file.” That is to say, sentencing with respect to these latter seven convictions was suspended indefinitely. There was a notation on the back of the indictment form relating to one of the filed convictions, #81-1918, alleging armed assault with the intent to rob,⁷ indicating that the defendant “consented” to this arrangement, as required by law.⁸ Further, to the extent that all of these 1981 convictions were obtained on the basis of guilty pleas, and consistent with an affidavit filed by the original trial judge (Steele, J.) in cognate proceedings, it appeared that the defendant had been advised of the potential sentencing ranges associated with the crimes alleged in each of the indictments. However, there was nothing in the record to indicate whether or to what extent the judge explained the exact implications of placing convictions on file, including what might happen in the event the commonwealth moved for sentencing on these convictions at a later date.⁹

More than five years later, shortly after he was released from prison,

and constitutional rights a defendant sacrifices where a conviction is placed on file – namely the right to a prompt and final resolution of any charges laid against him, including reduction of any convictions to certain judgments, as well as the right of appeal, which is deferred so long as a conviction remains on file.

9. In fact, as the Appeals Court observed in its disposition of a prior appeal by the same defendant, there is significant doubt about precisely what occurred at the defendant’s sentencing hearing. See interlocutory order in A.C. No. 94-P-2068. In the end, on the basis of *Commonwealth v. Quinones*, the court decided to credit the trial judge’s affidavit setting out his standard practice during plea colloquies instead of an affidavit from an eyewitness who, as a friend of the defendant, may have harbored significant bias. *Commonwealth v. Quinones*, 414 Mass. 423, 430-31 (1993).

1. 448 Mass. 687 (2007).

2. *Commonwealth v. Simmons*, 65 Mass. App. Ct. 274 (2005).

3. *Simmons*, 448 Mass. at 688.

4. 115 Mass. 133, 136 (1874).

5. See e.g. MASS. GEN. LAWS c.6, §178H (2006); *id.* c.56, §58; *id.* c.90 §8.

6. *United States v. Hines*, 802 F. Supp. 559, 572 (D. Mass.1992) (quoting *Pino v. Nicolls*, 119 F. Supp. 122 (D. Mass. 1954)).

7. MASS. GEN. LAWS c.265, §18 (2006).

8. See *Commonwealth v. Delgado*, 367 Mass. 432, 438 (2001) (a conviction may not be placed on file without a defendant’s consent). Presumably, this requirement was imposed in recognition of the various statutory, common law,

the defendant was charged with a subsequent unrelated offense. The commonwealth immediately moved for sentencing with respect to the filed conviction obtained on indictment #81-1918. After a sentencing hearing, a committed sentence of 18 to 20 years was imposed. Shortly thereafter the defendant was convicted of the subsequent charge, namely armed robbery,¹⁰ and received a committed sentence of 20 to 30 years, to be served *from and after* the 18 to 20 year sentence he had received on the basis of the revived armed assault conviction. Pursuant to Massachusetts Rule of Criminal Procedure 30(a), the defendant filed a motion to "vacate sentence, dismiss indictment, and credit defendant for time served under an erroneous sentence" with respect to the 18-20 year term imposed on the previously filed conviction. That motion was denied (Ford, J.), and it was from that order that the defendant appealed.

III. The Appeals Court Decision

On direct review, the Appeals Court reversed the order denying the defendant's motion to vacate. The court concluded that filed convictions could be revived only in two narrowly-drawn situations: "[1] when a related conviction was reversed on appeal, and [2] upon a breach of explicit conditions imposed in connection with the filing," neither of which applied in *Simmons*. With respect to the first exception, the court appears merely to have acknowledged a trial judge's authority, as previously delineated in *Commonwealth v. Bianco*,¹¹ to revive filed convictions upon re-sentencing after a successful appeal. Where some convictions are eliminated on appeal, a judge may need to revive filed convictions in order to preserve "the original sentencing scheme contemplated by the trial judge."¹²

In arguing for affirmance in *Simmons*, the commonwealth relied heavily on *Bianco*, urging that the decision, in fact, applied broadly to all cases involving filed convictions. In *Bianco*, the defendant was convicted of manslaughter and assault and battery, the latter either as a lesser included offense or on the basis of separate act (the record in *Bianco* is unclear). He received a committed sentence on the manslaughter conviction, while the assault and battery conviction was placed on file. On appeal, the SJC reversed the manslaughter conviction, and ordered judgment to enter for the defendant on that charge. The SJC further stated that, on remand, "the judge in the Superior Court is permitted, but not required, to sentence the defendant on [the assault and battery conviction]."¹³ The original trial judge subsequently imposed a committed sentence

for that offense, which action the SJC approved in *Bianco*. In *Simmons*, the government argued that the holding in *Bianco* justified reviving the filed conviction, the differences between the two cases notwithstanding.

The Appeals Court disagreed, concluding that there were good reasons to distinguish between the situations in *Simmons* and *Bianco*, and to limit *Bianco* strictly to cases where revivals occur on remand. In *Bianco*, "by virtue of the defendant's successful appeal of the manslaughter convictions, the trial judge's sentencing scheme was fundamentally altered."¹⁴ The original decision to place the assault and battery conviction on file "was informed, at least in part, by the fact that a committed sentence was imposed on the manslaughter conviction."¹⁵ Massachusetts courts have frequently observed that, in cases involving multiple convictions, sentences are often inter-related.¹⁶ Once the manslaughter conviction sentence was vacated, the judge was free, consistent with due process principles, to enter a sentence with respect to the filed charge. In such circumstances, there was no reason to infer that such action was motivated by improper considerations.¹⁷ Stated differently, had the defendant in *Bianco* originally been convicted only of assault and battery, there is no basis for inferring that the conviction would have been placed on file.

By contrast, the Appeals Court concluded that the sentence imposed on the filed conviction in *Simmons* was not embraced by the original sentencing scheme, but rather was an impermissible additional penalty aimed at punishing the defendant for his subsequent conduct. This raised serious due process concerns. As the Appeals Court observed in *Simmons*:

A practice that permits a prosecutor to seek sentencing a decade or more after [a conviction is filed] on the basis of subsequent events or information deemed by the prosecutor to warrant revival but unconnected to the filed conviction, invites not only arbitrary and capricious conduct, but raises the concern that conduct triggering the revival will unduly influence the sentence on the filed conviction.¹⁸

Under due process protections embedded in the Massachusetts constitution — protections which may exceed their federal cognates — "a sentencing judge may not undertake to punish [a] defendant for any conduct other than that for which the defendant stands convicted in the particular case."¹⁹ While "reliable evidence of [other]

10. MASS. GEN. LAWS c.265, §17 (2006).

11. 390 Mass. 254, 255-59 (1983).

12. *Simmons*, 65 Mass. App. Ct. at 281.

13. *Bianco*, 390 Mass. at 255.

14. *Simmons*, 65 Mass. App. Ct. at 281.

15. *Id.*

16. *See Commonwealth v. Williams*, 23 Mass. App. Ct. 716, 720 (1987). *See also Delgado*, 367 Mass. at 439-40.

17. *See North Carolina v. Pearce*, 395 U.S. 711, 725-26 (1969).

18. *Simmons*, 65 Mass. App. Ct. at 282.

19. *Commonwealth v. Goodwin*, 414 Mass. 88, 93 (1993) (quoting *Commonwealth v. LeBlanc*, 370 Mass. 217, 220-21 (1976)).

misconduct may be considered [in determining an appropriate individualized sentence, a] defendant may not be punished for that other misconduct.”²⁰

There was nothing about the defendant’s original sentencing hearing in *Simmons* to suggest that the trial judge contemplated that the conviction at issue would ever be brought forward for sentencing. In view of that, and considering the timing of the commonwealth’s motion vis-à-vis the defendant’s subsequent offense, as well as the severity of the sentence imposed on the basis of the filed conviction, there is a solid basis for inferring that the contested sentence in *Simmons* was, in fact, intended as punishment for that subsequent misconduct. Indeed, the commonwealth conceded in its brief that “[i]t was the defendant’s commission of the 1986 crime that caused... the indictment [to be brought] forward.”²¹ In these circumstances, the Appeals Court concluded that the defendant’s due process rights had been violated. To avoid such abuses in future cases, the Appeals Court determined that *Bianco* must be limited to its original context, applying only where a revival occurs on remand after a successful appeal. *Simmons* manifestly did not present that situation.

Although largely irrelevant to the actual situation in *Simmons*, the Appeals Court also acknowledged that, apart from the small number of revivals that may occur on remand after a successful appeal (i.e. the *Bianco* situation), a filed conviction also may be revived where it was made subject, at the time of filing, to “definite conditions” that persist for a “reasonable time,” and where the defendant is informed of and consents to the filing of a conviction on that basis.²² This second exception seemed like an attempt on the part of the Appeals Court to create the possibility for some significant continued use of the filing procedure, but one that strikes within constitutional limits; specifically, a procedure that comports with the due process requirements already discussed as well as double jeopardy rules. Double jeopardy concerns arise when a filed conviction is revived on the basis of a subsequent offense that itself later ripens into a conviction, and where sentences are then imposed with respect to both convictions. Such sentences might be deemed to constitute multiple punishments for the same act. If so characterized, and if imposed in consecutive proceedings, the multiple sentences would violate double jeopardy protections.²³

An analogous double jeopardy problem has arisen in the context

of probation revocation proceedings. In *Commonwealth v. Odoardi*,²⁴ for example, the SJC concluded that there was no double jeopardy impediment to revoking the defendant’s probation on grounds that he had committed a subsequent robbery, and then obtaining a conviction and committed sentence in connection with the same robbery charge. Ordinarily, under the Massachusetts common law double jeopardy rule (even if not under the cognate federal standard), multiple punishments based on the same acts and imposed in serial proceedings are not permitted.²⁵ However, the court in *Odoardi* escaped the reach of this proscription by adverting to the unique nature of a probation revocation proceeding: “We [do not] view [any sentence imposed upon revocation] as punishment for the act or acts that prompted revocation of probation. Rather, the probationer is being punished for the underlying offense for which a probationary sentence originally was imposed.”²⁶ The SJC reiterated this principle in slightly modified terms in *Commonwealth v. Holmgren*:²⁷ “revocation of probation is not punishment for any subsequent crime charged, but rather is a remedial sanction arising from the sentence imposed for the earlier offense; no double jeopardy issue is presented by having a revocation hearing involving the same alleged wrongdoing.”²⁸ A filed conviction, however, is not the precise equivalent of a probationary sentence.

In the case of probation, an actual sentence is imposed which expressly contemplates the imposition of a committed sentence (or other penal consequences) in the event that a defendant fails to comply with agreed-upon conditions of release.²⁹ By contrast, a filed conviction is expressly not a sentence under Massachusetts law; rather, it is the act of deferring sentencing.³⁰ However, under the regime contemplated by the Appeals Court in *Simmons*, a filed conviction would have resembled probation very closely. Where a filed conviction is subject to precise conditions and with a fixed duration, a defendant is on notice that if he engages in further misconduct, the earlier conviction will be revived, and brought forward for sentencing. A sentence imposed in such circumstances might plausibly be characterized as a lawful “remedial sanction arising from the sentence imposed for the earlier offense.”³¹ In this way, double jeopardy concerns would be avoided.

Where filing is made the rough equivalent of probation, as the

20. *Commonwealth v. Henriquez*, 440 Mass. 1015, 1016 (2003). See *Commonwealth v. White*, 48 Mass. App. Ct. 658, 663 (2000); see also *Texas v. McCullough*, 475 U.S. 134, 141-42 (1985) (It is well established that, consistent with principles of procedural due process under the state and federal constitutions, a judge may consider ancillary conduct – i.e. conduct unrelated to the crime with which a defendant is charged in a particular proceeding – when imposing sentence.); *Commonwealth v. Lewis*, 41 Mass. App. Ct. 910, 911 (1996). (A fine line separates this permissible practice from unlawful punishment for unrelated acts.).

21. Brief of the Commonwealth Appellee/ Plaintiff at 17, *Commonwealth v. Simmons*, No. 2004 P. 0550 (Mass. App. Ct. January 19, 2005) (The commonwealth moved for sentencing on the filed conviction on December 9, 1986 and sentence was imposed pursuant to that motion on January 2, 1987.).

22. *Simmons*, 65 Mass. App. Ct. at 284.

23. *Commonwealth v. Arriaga*, 44 Mass. App. Ct. 382, 384 (1998).

24. 397 Mass. 28, 30 (1986).

25. See *Arriaga*, 44 Mass. App. Ct. at 391; see also *Commonwealth v. Crocker*, 384 Mass. 353, 359 (1981).

26. *Odoardi*, 397 Mass. at 30 (emphasis added).

27. *Commonwealth v. Holmgren*, 421 Mass. 224, 227 n.1 (1995).

28. See *Commonwealth v. Forte*, 423 Mass. 672, 675 (1996) (emphasis added).

29. *Holmgren*, 421 Mass. at 228.

30. See *Marks v. Wentworth*, 199 Mass. 44, 45 (1908).

31. *Holmgren*, 421 Mass. at 227 n. 1.

Appeals Court decision would have required, the due process concerns discussed above would largely be avoided. While a sentencing judge still would have to be careful about the manner in which he or she factored subsequent conduct into the sentencing calculus with respect to a revived conviction, where the earlier conviction had been filed subject to specific conditions, there is a far weaker basis for inferring that a defendant is being improperly punished for unrelated acts; rather, as in the case of probation, it would be clear that the deferred punishment related back to the offenses underlying the filed conviction. In sum, the second exception created by the Appeals Court's decision in *Simmons* — i.e. permitting filed charges to be revived where subject to specified conditions and for a fixed term, would have avoided many of the most serious defects, including constitutional defects, of the earlier practice. In this way, the Appeals Court opinion offered a comprehensive approach to filing practices that harmonized the procedure with modern concepts of due process, while at the same time retaining the sentencing flexibility and other salutary features of the filing regime. But it was not to be — at least not yet.

IV. The SJC's Decision on Further Appellate Review

The SJC began its review of *Simmons* by retracing the ancient provenance of the practice of placing criminal convictions on file, from *Dowdican's Bail to Delgado*. As the court observed: "Few aspects of our criminal justice system can claim the tenure of indictments 'laid on file' in the courts of the Commonwealth."³² The court then went on to acknowledge that filed convictions typically remain filed "barring either of the two scenarios identified by the Appeals Court"; that is, "where a defendant either successfully appealed...or violated some express condition of the filing..."³³ However, despite agreeing with the Appeals Court about the settled practice surrounding filing procedures or, more specifically, surrounding the resurrection of filed convictions, the SJC rejected the notion of limiting the revival of filed claims to these two situations, and so departed from the approach adopted by the Appeals Court in a significant respect. The SJC concluded instead that filed convictions could be revived at any time, and for any reason, upon motion of the commonwealth.

In support of its view, the SJC purported to rely on multiple considerations. First, the court observed that a rule permitting essentially unlimited revival of filed convictions would not violate "substantive due process rights," insofar as such a system was not sufficiently egregious as to "shock the conscience."³⁴ It is difficult to

know what to make of this argument. The defendant in *Simmons* was patently not asserting a substantive due process claim as to which the "shock the conscience" standard might be applicable; rather, the defendant was asserting a procedural due process claim. Specifically, the defendant was, as the Appeals Court observed, arguing that the contested sentence was being imposed on the basis of a crime other than the crime for which he stood convicted.³⁵ While ancillary conduct may be considered in imposing a sentence, procedural due process principles impose important limits on this practice.³⁶ The importation of concepts associated with substantive due process seemingly does nothing but confuse the analysis of this important issue in the SJC's opinion. More important, the court failed altogether to consider what limits, if any, procedural due process protections (as set out in *Henriquez*, *Goodwin*, and *LeBlanc*) might impose on the revival of filed claims — a serious omission.

The SJC also claimed to find affirmative authority for unlimited revival in a "common law rule, unaltered since its creation, that the court retains the ability, at any time, to remove the indictment from the file."³⁷ Just a few lines later, however, the court observed (as noted above) that "[the commonwealth's] appellate jurisprudence on the practice of removing a case from the file has typically included only instances where a defendant either successfully appealed from a parallel conviction or violated some express condition of the filing..."³⁸ If permitting revival only in these narrowly drawn situations is the actual longstanding and unbroken practice of the courts, it is somewhat difficult to discern the source of any "common law rule, unaltered since its creation." The settled practice of the courts is, by definition, the common law rule.

Despite disagreeing with the Appeals Court, and concluding that there are no express formal limits on the authority of the commonwealth to revive criminal convictions, the SJC nevertheless agreed with the Appeals Court that the revival of the contested conviction in *Simmons* was improper. Unfortunately, the rationale for the court's holding is difficult to discern. By way of explanation of its disposition, the SJC stated that while "[i]t is true that once removed from the file the sentencing judge retains the same discretion in punishment as that afforded by the original trial judge...[t]his discretion...cannot be exercised in a vacuum."³⁹ Instead, the sentencing judge "must consider the over-all scheme of punishment employed by the trial judge."⁴⁰ The court then concluded that the 18 to 20 year sentence imposed on the revived conviction in *Simmons*, was "discord[ant]" with the concurrent eight to twelve year terms originally imposed in connection with the defendant's other convictions.⁴¹ By "failing

32. *Simmons*, 448 Mass. at 693.

33. *Id.* at 696.

34. See *Rochin v. California*, 342 U.S. 165, 172 (1952) (police actions, including forcibly inducing a prisoner to vomit for the purpose of recovering evidence, were so egregious as to amount to substantive due process violation).

35. See *Alabama v. Shelton*, 535 U.S. 654, 665 (2002).

36. See *Apprendi v. New Jersey*, 530 U.S. 466, 562-63 (2000) (Breyer, J.

dissenting).

37. *Simmons*, 448 Mass. at 696.

38. *Id.*

39. *Simmons*, 448 Mass. at 699.

40. *Id.*

41. *Id.*

to consider the original sentencing scheme,” the judge who imposed sentence on the revived conviction “creat[ed] a substantial risk of a miscarriage of justice.”⁴² The court then ordered re-sentencing on the filed conviction, but did not provide any specific guideposts for determining a lawful sentence.

It is difficult, to say the least, to identify the precise basis for the SJC’s holding in *Simmons*, and the court provides no case authority whatsoever for its disposition. The reference to preserving “the original sentencing scheme” appears to be drawn from the Appeals Court’s discussion of *Bianco* in *Simmons*⁴³, where the court opined that the revival of filed convictions after a successful appeal was permissible where “the original decision to place... convictions on file... was informed, at least in part, by the fact that committed sentences were imposed on the [reversed] convictions.”⁴⁴ In such cases, the reversal “fundamentally altered” the original sentencing scheme⁴⁵ and so sentencing on the filed convictions was necessary to place the parties in the same position they would have occupied had the defendant originally been acquitted of the reversed convictions. This concept, however, patently has no application to the situation in *Simmons*.

The “original sentencing scheme” in *Simmons* is clear: the original trial judge elected to place the defendant’s conviction for armed assault on file; i.e., he chose not to impose a committed sentence with respect to that charge. Any sentence now imposed with respect to that offense will “fundamentally alter” the “original sentencing scheme.” Thus, if preserving the “original sentencing scheme” is the touchstone for determining a lawful sentence in this context — as the SJC states — it is difficult to see what sentence might be imposed on remand consistent with the SJC’s decision. At the same time, if the sentencing judge retains the same discretion as the original trial judge — again, as the SJC states — it is unclear why the 18 to 20 year sentence imposed was improper. Certainly such a sentence would, by no means, have exceeded the authority of the original trial judge. In the end, it seems most plausible that the SJC simply viewed the 18 to 20 year term at issue in *Simmons* as too harsh a penalty by some purely subjective measure, at least as compared to the relatively modest 8 to 12 year concurrent terms originally imposed on the defendant’s other, related convictions. However, such an interpretation of *Simmons*, while suggesting some form of rationale for the case, does nothing to resolve the legal contradictions inherent in the decision. More important, it does nothing to address the procedural due process concerns identified by the Appeals Court.

Perhaps in recognition of the awkward state in which its opinion leaves the common law, the SJC took the extraordinary step of

“referring the future of placing indictments on file, including the necessity of colloquy [sic] confirming consent and enunciating express expectations of good behavior, to the rules committee of this court.”⁴⁶ By suggesting that the rules committee should make filing contingent on “express expectations of good behavior,” the court appears to be headed in the precise direction proposed by the Appeals Court. As that court said in its own opinion:

Before a conviction maybe placed on file...the defendant must ...be informed of such condition [upon which the conviction may be revived], and the definite, and reasonable, time frame within which it is to remain in effect...and give his voluntary and informed consent thereto.⁴⁷

For whatever reason, the SJC seems to prefer to enact this policy through a procedural change rather than a common law rule. In any event, the SJC appears to end up in the same place as the Appeals Court, despite its suggestions to the contrary.

V. Further Considerations

Apart from the omissions already identified, the SJC’s decision in *Simmons* is silent on a number of other important questions. For example, the court did not address one of the most common situations in which the filing procedure is used: as a means of disposing of duplicative convictions. Further, while the SJC considered the concept of informed consent with respect to filed convictions, it proposed no precise procedures for obtaining such consent. Finally, the court made no attempt to resolve potential conflicts between filing procedures with the codified statutory sentencing regime. Each of these issues is considered in turn.

A. Filing Duplicative Convictions

The filing procedure is commonly used to dispose of duplicative convictions,⁴⁸ as to which clearly-established double jeopardy principles bar multiple sentences, even where imposed concurrently.⁴⁹ In the typical case, a judge simply imposes a sentence on the greater charge, while filing the conviction on the lesser offense. From the defendant’s perspective, there is little risk that the filed conviction might someday be reduced to a judgment; as noted, that would constitute a double jeopardy violation, at least so long as the judgment on the greater

42. *Id.*

43. *Simmons*, 65 Mass. App. Ct. at 281.

44. *Id.*

45. *Id.*

46. *Simmons*, 448 Mass. at 700.

47. *Simmons*, 65 Mass. App. Ct. at 284.

48. See e.g. *Commonwealth v. Owens*, 414 Mass. 595, 596 (1993); *Commonwealth v. Chappee*, 397 Mass. 508, 509-10 (1986); *Commonwealth v. Courtney*, 7 Mass. App. Ct. 4, 8 (1979).

49. See *Commonwealth v. Berry*, 420 Mass. 95, 113 (1995).

charge remains intact.

Notwithstanding the low risk that filed duplicative convictions might some day ripen into judgments, a defendant nonetheless may be prejudiced by the filing of a duplicative conviction. In *Commonwealth v. Jones*,⁵⁰ the SJC ended the longstanding practice of permitting duplicative convictions to stand, provided only concurrent sentences were imposed with respect to any lesser-included charges. In so doing, the court observed that:

To continue to distinguish between consecutive and concurrent sentences is to assume that only the fact of imprisonment, and not the fact of conviction, is the harm resulting from the erroneous allowance of duplicative convictions. Yet, adverse collateral consequences of convictions do exist, even when only concurrent sentences are involved. Among the collateral consequences acknowledged by the Supreme Court and other courts in various double jeopardy contexts are the harsher treatment that may be accorded the defendant under the habitual offender statutes of some States; the possible impeachment by prior convictions, if the defendant ever becomes a witness in future cases; and, in some jurisdictions, less favorable parole opportunities. . . . Moreover. . . . “even if no other disabilities were incurred, there is always the extra stigma imposed upon one’s reputation” by the fact of an additional conviction.⁵¹

To the extent that a filed conviction is treated as a lawful conviction for all purposes, the same potential harms identified in *Jones* in relation to duplicative convictions in general apply with equal force to filed duplicative convictions; filing a duplicative conviction, therefore, may well constitute a double jeopardy violation. Admittedly, double jeopardy protection, like many substantive and procedural rights may be waived. And, as noted already, a conviction may not be placed on file without a defendant’s express consent. Such consent might reasonably be deemed to amount to a waiver. However, to the extent that the SJC has expressly prohibited duplicative convictions in any form, even where they have no practical impact on a defendant’s sentence, there appears to be no lawful basis for even seeking a defendant’s consent to place a duplicative conviction on file. Doing so would implicate the same double jeopardy concerns articulated in *Jones*, while conferring no concomitant benefit on the defendant whatsoever. Courts should not be permitted to encourage unlawful

convictions, with or without a defendant’s consent.

This view is entirely consistent with recent practice both in the Appeals Court and in the SJC. In *Commonwealth v. Cabral*,⁵² for example, the Appeals Court vacated, sua sponte, a filed duplicative conviction, despite the fact that it apparently had been placed on file with the defendant’s consent. Relying on *Jones*, the court indicated that under the commonwealth’s common law double jeopardy rule, duplicative convictions in any form cannot be tolerated.⁵³ Likewise, in *Commonwealth v. Owens*,⁵⁴ the SJC vacated a duplicative conviction, notwithstanding the fact that the conviction had been properly filed, and so ordinarily would not be subject to appellate scrutiny.⁵⁵ A rule prohibiting the filing of duplicative convictions would avoid the necessity of resorting to extraordinary measures to correct such errors on appeal.

B. Procedures For Obtaining Consent

As noted, the Appeals Court in *Simmons* indicated that the revival of filed convictions would be permitted where the filing was made subject to specific conditions and for a “definite, and reasonable, time frame,” provided a defendant “give[s] his voluntary and informed consent thereto.”⁵⁶ The SJC, for its part, suggested that a similar regime might be established through a rules change.⁵⁷ However, insofar as the precise procedure for placing a case on file has been neither codified, nor fully articulated in the decisional law (including *Simmons*), the exact contours of the consent required to permit the lawful filing of a conviction have never been delineated. Fortunately, there is an apt analogy for guidance.

Placing a conviction on file is a close procedural cousin to so-called straight probation described in General Laws chapter 276, section 87.⁵⁸ As in the case of a filed conviction, a defendant made subject to straight probation does not receive a determinate sentence at the time of his conviction; rather, he is placed on probation “for such time and upon such conditions as [the court] deems proper.” Under General Laws chapter 279, section 3,⁵⁹ if a defendant violates the terms of his straight probation, the court may revoke the probation order, and impose any other sentence permitted by law on the basis of the original offense.⁶⁰ If the procedural changes suggested by the SJC in *Simmons* are enacted, there would then be no significant differences between straight probation and filing. As a result, a defendant arguably should receive the benefit of the same safeguards in connection with a filed conviction as with straight probation.

Recently, in *Commonwealth v. Rodriguez*,⁶¹ the Appeals Court

50. 382 Mass. 387, 396 (1981).

51. *Id.*

52. 46 Mass. App. Ct. 917, 918-19 (1999).

53. *See id.* at 919.

54. 414 Mass. 595, 608 (1993).

55. *See Commonwealth v. Torres*, 424 Mass. 153, 155 (1997).

56. *Simmons*, 65 Mass. App. Ct. at 284 (footnote omitted).

57. *Simmons*, 448 Mass. at 699-700.

58. MASS. GEN. LAWS c. 276, §87 (2006).

59. *Id.* c. 279, §3.

60. *See Commonwealth v. Bruzzese*, 437 Mass. 606, 617 (2002).

61. 52 Mass. App. Ct. 572, 576 (2001).

considered the content of the plea colloquy required where a defendant is placed on straight probation. In *Rodriguez*, the court determined that, before imposing a sentence of straight probation, a judge must advise a defendant "of the maximum and minimum mandatory sentence for which he is at risk if he violates the terms of his probation at some future date."⁶² This requirement was imposed, in large part, in recognition of the fact that straight probation embodies "an aspect of continuing . . . jeopardy."⁶³ Similarly, where a conviction is placed on file, a defendant faces, at least according to the SJC, an ongoing risk that the inchoate judgment might later mature into a committed sentence. The two situations, therefore, are sufficiently similar to mandate similar treatment. Accordingly, before obtaining his consent to place a conviction on file, a defendant presumably should receive essentially the same warnings as required where a straight probation sentence is imposed; that is, a defendant must be advised of the circumstances under which the filed conviction might subsequently be brought forward for sentencing and the range of the lawful sentence that might be imposed upon the filed conviction. In addition, as with a plea colloquy conducted prior to the imposition of straight probation, a defendant must be informed of the impact of the disposition on his appellate rights.

The foregoing requirements are by no means burdensome or time-consuming. Yet, without such explanations, any consent required as an essential basis for a filed conviction would amount to a hollow gesture. Moreover, such a minimal colloquy is almost certainly required as a matter of due process.

C. Statutory Conflicts

In the 19th century, the practice of filing convictions was expressly recognized by statute.⁶⁴ Those provisions, however, have long been repealed or, perhaps more accurately, have evolved into the current probation regime. In any event, the rules relating to filed convictions set out by the SJC in *Simmons* appear to conflict with important aspects of current sentencing statutes. General Laws chapter 279, section 3A,⁶⁵ for example, requires that sentences be imposed in all cases not later than seven days after conviction. While General Laws chapter 276, section 87⁶⁶ provides an exception to this rule where straight probation is imposed, it nonetheless mandates imposition of a *specified* inchoate sentence which, pursuant to chapter 279, section 4,⁶⁷ is subject to appeal. By contrast, no sentencing determination is made in connection with a filed conviction. Moreover, since a filed conviction is not a final judgment, in the absence of any statutory exception, no appeal is possible from the finding — judgment or verdict — underlying the filed conviction. These aspects of the filing procedure defy both the letter and policy bases of chapter 279, sections 3A and 4.

In view of these conflicts, it may be time to consider abandoning

the questionable benefits of the current system of placing convictions on file in favor of the modern forms that have largely replaced it. The Appeals Court observed in *Simmons* that "[t]here may be some basis to conclude that the practice of filing has been supplanted by a comprehensive statutory scheme of probation,"⁶⁸ but did not take up the question "in the absence of argument on the issue."⁶⁹ In cases where it is intended that filing be a final disposition — as is often the case — a disposition like dismissal of the indictment that honestly reflects that intention might better conform to the interests of justice. Where it is intended instead that a conviction should remain open as a normative instrument, straight probation affords that opportunity, but within a framework of carefully delineated procedural safeguards.

Rather than amounting to a break with current and historical procedure, such an approach might readily be viewed as a restoration of original practice. The earliest cases concerning the procedures for placing conviction on file describe a system that closely resembles the modern concept of probation. Indeed, in *Commonwealth v. Maloney*,⁷⁰ the SJC described "the general power of putting a prisoner convicted before them *on probation* by indefinitely holding the conviction over him, as is done in higher courts *by putting an indictment on file*."⁷¹ If the filing procedure were absorbed into the statutory probation system, either through the action of the rules committee as suggested by the SJC in *Simmons* or through some other mechanism, it would certainly provide much needed clarity to this area. Presumably the issue will resolve itself in due course. However, along these lines, it is at least worth noting that the SJC, in *Commonwealth v. Sebastian S.*,⁷² significantly reduced a judge's authority to impose "pretrial probation," "a dispositional form not unlike filing," on the ground that it was "contrary to the Legislature's intent in enacting [sentencing laws] by which it codified, regularized, and placed limits on a disposition practice that had previously been one of judicial creation."⁷³ Whether the SJC ultimately takes the same approach to filing remains to be seen.

Conclusion

The SJC's holding *Simmons* leaves open a number of important questions including, in particular, whether the practice of placing criminal convictions on file should be subject to greater procedural protections. At a more basic level, it begs the question of whether the practice of filing should be abandoned altogether in favor of equivalent devices provided by existing statutory regimes like straight probation. Further developments must await consideration by the rules committee. In the meantime, the question of what limits, if any, restrict the imposition of sentences imposed on the basis of revived convictions, previously laid on file, is altogether unclear.

62. *Id.* at 577.

63. *Id.* at 576 (quoting *McHoul v. Commonwealth*, 365 Mass. at 465, 469 (1974)).

64. *See* St. 1865, c.223; St. 1869, c.415, §60.

65. MASS. GEN. LAWS c. 279, §3A (2006).

66. *Id.* c. 276, §87.

67. *Id.* c. 279, §4.

68. 65 Mass. App. at 283 n. 13.

69. *Id.* at 284 n. 13.

70. 145 Mass.205, 211 (1887).

71. *Id.* (emphasis added.)

72. 444 Mass. 306, 312-13 (2005).

73. *Id.* at 312.

Book Review

Storming the Court: How a Band of Law Students Fought the President and Won, by Brandt Goldstein (Scribner, 2006), 375 pages.

In the aftermath of the 1991 coup that overthrew democratically elected Haitian President Jean Bertrand Aristide, many of his supporters were tortured, terrorized or killed. Thousands of these people fled the impoverished island in crowded makeshift boats headed toward the United States with the hope of finding sanctuary there. Few reached their goal. Some were lost at sea. Most, however, were intercepted by U.S. Coast Guard cutters and summarily returned home to face an uncertain fate in Haiti.

At first glance, the forced repatriation of these asylum seekers, without due process of law or the right to counsel, appears to violate basic principles of international law. However, in 1981, the Reagan administration made an unusual pact with then-Haitian dictator Jean-Claude “Baby Doc” Duvalier, agreeing to repatriate immediately any Haitian national who attempted to enter the United States without permission, unless the migrant could establish that he faced political persecution if he returned to Haiti.¹ This exception was grounded in a basic precept of international law formulated after the Holocaust known as “non-return” or “non-refoulement.”²

However, despite this express exception for legitimate asylum seekers, in the 10-year period between 1981 and 1991, only 28 out of some 23,000 Haitians who sought refugee status were admitted to the United States.³ By contrast, hundreds of thousands of refugees were permitted to enter the United States from such places as Cuba, the Soviet Union, Cambodia, Ethiopia, Vietnam, Afghanistan and Iran on grounds that they faced political persecution in their respective homelands.⁴ Indeed, the Reagan administration had been sharply critical of Southeast Asian countries that had elected to return fleeing “boat people” to Vietnam. Some members of the immigration bar attributed the manifestly disparate treatment of Haitian migrants to an entrenched culture of racism. Regardless of the policy’s origin, exhausted Haitians were routinely plucked from the sea by Coast Guard cutters, asked a few perfunctory questions by INS officials, summarily declared unlawful economic migrants and then returned home.

In response to U.S. policy, immigration lawyers from Miami filed a lawsuit, *Haitian Refugee Center v. Baker*⁵, and succeeded in obtaining a temporary restraining order blocking forced repatriations of Haitian refugees intercepted on the high seas. President George H.W. Bush,

wanting to avoid admitting to the United States some 6,000 Haitian refugees then being held aboard Coast Guard vessels, ordered the migrants to be taken to the U.S. naval base at Guantanamo Bay at the southern tip of Cuba. There the Haitian refugees were forced to live behind barbed wire in 20 person tents, under the blazing sun, amid sand fleas and banana rats.

And then things got worse. Within months, an appellate court dissolved the restraining order created by the *Baker* case.⁶ The court sided with the Justice Department and held that American law did not apply to foreigners outside of American territory. As a result, the INS did not have to follow standard domestic immigration law in processing the Haitian asylum seekers. Under this ruling, almost all Haitian migrants, including those held at Guantanamo, would be forcibly returned to face probable torture and death at the hands of the Haitian dictatorship.

Into this breach stepped a gifted, but untested Yale Law School professor, Harold Koh. “Does everyone understand how extreme the Eleventh Circuit decision is?” he asked his class. “The court said these people have no rights...[t]hey don’t get a lawyer...[i]t’s like *Gideon v. Wainwright*, right?”⁷ Thus began an odyssey that took a group of law students, without funds or resources, and pitted them against the “litigation machine” of the Justice Department with its thousands of lawyers, unlimited money, and a reputation for never giving an inch. *Storming the Court: How a Band of Law Students Fought the President — and Won*, by Brandt Goldstein, is the story of a draining and exhilarating roller coaster ride of defeats and victories, back and forth, through numerous actions in lower courts, courts of appeal and the Supreme Court. Unusual for a legal treatise of this type, *Storming the Court* has such a strong — almost cinematic — narrative flow that it reads like a suspense thriller.

Koh, along with seasoned human rights lawyer Michael Ratner, who had signed up to assist, knew the first burden the team faced would be to overcome the traditional reluctance of the courts to second-guess the president on matters relating to foreign policy. Koh took the position that this deference was ill-considered and had led in the past to incidents like the bombing of Cambodia and the Iran-Contra scandal.⁸ However, convincing a court to adopt Koh’s view would be an uphill battle.

Second, Koh’s team had to overcome the doctrine of *res judicata* — just because they were disappointed with the Supreme Court’s decision in *Baker*, they could not simply ask for a “do-over” of a

1. Exec. Order No. 12,324, 46 Fed. Reg. 48,109 (Sept. 29, 1981).

2. The origins of the non-refoulement principle date back to the post-World War I era. GUY S. GOODWIN-GILL, *THE REFUGEE IN INTERNATIONAL LAW* 118 (Oxford University Press 1998) (1996).

3. BRANDT GOLDSTEIN, *STORMING THE COURT: HOW A BAND OF LAW STUDENTS FOUGHT THE PRESIDENT AND WON* 18 (2006).

4. DEPARTMENT OF JUSTICE, IMMIGRATION AND NATURALIZATION SERVICE, 1991

STATISTICAL YEARBOOK OF THE IMMIGRATION AND NATURALIZATION SERVICE, 81, 84 (Washington, D.C.: U.S. Government Printing Office, 1992).

5. *Haitian Refugee Center v. Baker*, No. 91-2635-CIV-Atkins (S.D.Fla.1991).

6. *Haitian Refugee Center v. Baker*, 949 F.2d 1109 (11th Cir. 1991), *cert. denied*, 502 U.S. 1122 (1992).

7. GOLDSTEIN, *supra* note 3, at 24.

8. *Id.* at 24.

dispute that already had been heard and decided. To avoid the preclusive effect of the court's earlier decision, Koh decided to come at the problem from a new angle. Rather than bringing a suit on behalf of the Haitians migrants, Koh purported to act on behalf of the attorneys representing the migrants whose free speech rights were being violated by not being permitted to meet and communicate with their clients.⁹ Additionally, Koh challenged a new procedure permitting the INS to conduct final asylum hearings on a military base, a policy that had not yet been reviewed by any court.¹⁰

In what was an eye-opening lesson for the Yale students in the practical realities of the practice of law, Koh's team then went forum-shopping, looking for a court that, based on past practice, might be inclined to rule against the Bush administration. Due to the nature of the case, Koh could bring suit in any federal district court in the country, and he intended to make the most of this opportunity. Koh's team settled upon the United States District Court for the Eastern District of New York.¹¹ Located in Brooklyn, the court was only a couple of hours travel from the Yale campus in New Haven and, more important, had a reputation for political independence. It was there that *Haitian Centers Council v. Sale*, a case that would take Koh and his students all the way to the Supreme Court, began its journey.

Although the team had selected the district, the case could be assigned to any judge in that district. In every federal court, judges are assigned cases through a random process. In Brooklyn, an old hand-cranked wooden wheel was used. But Koh had a plan. In a seemingly ingenious strategy, he started out by filing not a complaint, but a motion for a temporary restraining order to obtain access to the Guantanamo detainees. Since TROs were heard by a judge assigned to the motion session and whose name was known in advance, Koh hoped, in effect, to select his judge, as well.¹² Unfortunately for Koh and his team, this transparent attempt at "judge shopping" was thwarted, and they were sent back to the wooden wheel.

The students were initially wary of the judge assigned to their case. Sterling Johnson, a very recent Bush appointee, was an unknown quantity. But, from the outset, Johnson seemed unswayed by the government's argument that the detainee's had no right to counsel because "Guantanamo is a military base in a foreign country... [i]t is not United States territory."¹³ He seemed incredulous that, even though the naval base was under the "complete control and jurisdiction" of the United States government, and the government derived its authority from the Constitution, that a U.S. court did not have the authority to protect the rights of persons held there.¹⁴

In a startling initial victory, Judge Johnson granted Koh and his law students the right to pass within the razor wire of Guantanamo to interview the detainees, at least for the purpose of discovery.¹⁵ Koh's

team wanted to see the conditions at the camp and learn about the process underway for screening refugees for asylum without lawyers. There were reports that INS procedures on the island had descended into chaos,¹⁶ with lost records, screen-in rates that varied drastically from one INS officer to the next, a continuing mystery surrounding why some refugees were being interviewed multiple times, and a reported official policy aimed at ensuring that the maximum number of detainees would be returned to Haiti.

The Yale law school team was given five days to track down Creole translators, travel to Guantanamo, obtain interview transcripts and other documents, write a brief, prepare witnesses, and depose INS officials (in Washington, D.C. and Miami) before appearing once again in court.¹⁷ One of this book's strengths lies in its vivid depictions of the exhausting schedule endured by the Yale students who worked around the clock, sacrificing their personal lives, while serving tirelessly as volunteers on the case. Koh and his minions also had to endure threats of millions of dollars in sanctions under Rule 11 from government lawyers who asserted their suit was frivolous.¹⁸

Although the price was high, Koh's students learned things about the practice of law that could never be taught in a classroom. They learned, first and foremost, about tough litigation tactics. Despite the fact that Koh's team had precious little time with the detainees, the government lawyers delayed them at every turn, frequently making them wait for hours to meet with particular detainees.¹⁹ They also learned to contend with what they claimed were outright misrepresentations in the government's pleadings. They soon came to realize that the practice of law is by no means always a refined intellectual battle between collegial adversaries.

Another eye-opener in the students' practical legal education occurred during a meeting between a group of detainees and one of the most zealous student advocates, Lisa Daugaard. After spending many months in the deplorable conditions at Guantanamo Bay, the frustrated Haitians were so distrustful of everyone that they greeted Daugaard with insults. "Why should we believe anything you say... You're just doing this for yourself... You're doing this to get rich... You're not getting paid? You must be terrible lawyers if you can't make money! No wonder we're still here!"²⁰ When Daugaard, exhausted and overwrought, fled the meeting in tears, the Haitians were suddenly impressed with her sincerity. They realized that if she did not care, she would not be so upset. Suddenly they were cooperative — and appreciative. Another lesson in the craft of lawyering—the importance of client relations—was underscored.

Back in court after their whirlwind trip to Guantanamo, a hearing before Judge Johnson resulted in the team's next victory — the granting of a restraining order halting the asylum process

9. *Id.* at 37-38.

10. *Id.* at 37-39.

11. *Id.* at 25, 47.

12. *Id.* at 47-48.

13. *Id.* at 77.

14. *Id.*

15. *Id.* at 88.

16. *Id.* at 93.

17. *Id.* at 89.

18. *Id.* at 81-88.

19. *Id.* at 94-96.

20. *Id.* at 164-65.

and barring the government from returning any of the screened Guantanamo detainees to Haiti until the ultimate issues could be heard at trial. Johnson ruled that, in the meantime, the Yale team had an absolute First Amendment right to continue to meet with the Haitian migrants. Johnson declared that, since the government had already let priests, doctors, journalists and other civilians meet with the refugees, lawyers alone could not be barred from the base. The judge also rejected the government's contention that the due process clause did not extend to Guantanamo since it was beyond U.S. borders. He reasoned that the plaintiffs were being held on territory within the "complete jurisdiction and control" of the United States. He concluded that the Fifth Amendment barred the government from depriving any "person" of "life, liberty or property, without due process of law." Though not American citizens, the Haitians were most certainly "persons."²¹

The government went to the Second Circuit Court of Appeals to seek a stay of Judge Johnson's ruling, but was rebuffed.²² Determined to have its way, the Bush administration changed tacks: Since the district court had ruled that lawyers could meet with the refugees only in connection with the asylum hearing process, the government decreed that it would eliminate those hearings altogether.²³ Further, President Bush announced that, henceforth, all Haitian refugees picked up on the high seas would be returned home immediately, without INS involvement of any kind. Bush urged those Haitians seeking asylum from political persecution to go to the American consulate in Port-au-Prince. What he did not say was that human rights monitors had already reported that Haitian thugs and soldiers of the dictatorship surrounded the consulate, and it was nearly impossible for most potential applicants to get through.²⁴ In the meantime, the Haitians held at Guantanamo Bay languished in legal limbo.

The government then focused all of its attention on trying to get the Supreme Court to overturn the Second Circuit ruling. With dizzying speed, the case ricocheted back and forth among the trial court, Second Circuit, and Supreme Court. It had to be pointed out to the Yale law students that their case was an anomaly. Most federal cases take years to get to trial and only a tiny fraction go all the way to the Supreme Court. *Haitian Centers Council v. Sale*²⁵ had a pace and rhythm all its own.

Goldstein, an attorney/journalist and himself a Yale Law School graduate, deftly weaves his way as best he can through the complicated and circuitous path of this Herculean legal effort. But the battle he

depicts was being waged on so many jurisdictional fronts that there is a potential for the reader to get lost in the occasionally confusing legal interplay. Perhaps this is less the fault of the author and more a reflection of the enormity of the task of taking on a determined government with unlimited resources set on using every delaying tactic at every level.

To his credit, Goldstein does not reveal his own sympathies; he simply tells the tale and offers no commentary on the underlying events. However, the facts are laid out from the point of view of the Yale law students and, while making no editorial comment at all, the facts, as recounted by Goldstein, are ultimately sympathetic to the students.

Eventually, the demands of the case exceeded the resources of Koh's team. In an extraordinary coup, one of the Yale students convinced the prestigious New York firm of Simpson, Thacher and Bartlett to take on the case pro bono. Incrementally, the Yale students ceded more and more control to the professional attorneys who worked alongside them.

However, in spite of the introduction of new legal talent, the Koh team's strategy did not change. Throughout many hearings in the various courts, the Yale team's chief argument was that the United States government was in violation of two laws: The Refugee Act of 1980,²⁶ and Article 33 of the United Nations Refugee Convention, to which the United States was a signatory.²⁷ In essence, both of these provisions barred the United States from returning refugees to countries where they faced political persecution.

Vindication of this basic tenet of international human rights law was a personal matter for members of Koh's team. Koh's own father had sought asylum in the United States decades earlier after the democratic government he supported in Korea fell to a dictatorship. Ratner's father had fled Jewish pogroms in Russia and, years later, hired Holocaust survivors in his Cleveland family business. Ratner made a connection between how the United States was treating the Haitians and the fate of the steamship *St. Louis*, which carried Jews escaping Hitler to the shores of Miami in 1939 before being ordered to return to Europe where many of the passengers perished in concentration camps.²⁸

In the end, Koh's team was victorious in the district court trial,²⁹ and the Haitian refugees held at Guantanamo were permitted to migrate to the United States. The victory, however, was short-lived. Not long after, the Supreme Court ruled that, as to future cases, the bar against returning refugees to their home countries, even

21. *Id.* at 110-12.

22. *Id.* at 114.

23. *Id.* at 121.

24. *Id.* at 129.

25. *Sale v. Haitian Centers Council*, 509 U.S. 155 (1993). (The lawsuit filed by the Yale law students had originally been captioned *Haitian Centers Council v. McNary*, 969 F.2d 1326 (2d Cir. 1992). However, in early 1993, when Gene McNary stepped down as commissioner of the INS, and Chris Sale became acting

commissioner, the case name changed.)

26. Refugee Act of 1980, Pub. L. 96-212, 94 Stat. 102 (amending the Immigration and Nationality Act [INA] of 1952) (codified as amended in scattered sections of 8 U.S.C.)

27. United Nations Convention Relating to the Status of Refugees, art. 33, July 28, 1951, 19 U.S.T. 6259, 189 U.N.T.S. 137.

28. GORDON THOMAS & MAX MORGAN WITTS, *VOYAGE OF THE DAMNED* (1974).

29. GOLDSTEIN, *supra* note 3, at 286-87.

if they legitimately feared persecution, did not apply to persons intercepted outside U.S. borders. But, even Justice John Paul Stevens, who wrote the majority opinion, acknowledged that the court was probably violating the spirit of the Refugee Act and Article 33 of the United Nation's Refugee Convention in its decision.³⁰ Koh opined, in an article written shortly thereafter that the decision represented "the Rehnquist Court's disturbing pattern of reflexive deference to presidential power in foreign affairs and hostility toward both aliens and international law."³¹ The practice of direct returns did not end until the early years of the Clinton administration.³²

Nonetheless, by any standard, the Yale law students achieved a great victory. They won a hard-fought case against considerable odds and a powerful adversary. In addition, nearly a decade after their epic battle, they saw the Supreme Court largely adopt their legal position in the landmark decision of *Rasul v. Bush*.³³ In that case, the court

ruled that the detention of suspected 9/11 terrorists at Guantanamo Bay, indefinitely and without counsel or communication with the outside world, violated the Constitution's due process protections. Koh and a new crop of Yale law students, who authored an amicus brief for *Rasul*, viewed the decision as a vindication of their original assertion in *Haitian Centers Council v. Sale* that Guantanamo Bay is a land governed by the laws of the United States of America, and subject to the protection of our courts. In the end, a determined group of students helped vindicate the proposition that anyone, even the weak or reviled, who falls under the control of the United States is entitled to basic due process of law — and that courts are always empowered to guarantee this fundamental protection.

Peter T. Elikann

30. *Sale*, 509 U.S. at 188.

31. Harold Koh, *Reflections on Refoulement and Haitian Centers Council*, 35 HARV. INT'L L.J. 1, 2 (1994).

32. GOLDSTEIN, *supra* note 3, at 301.

33. *Rasul v. Bush*, 542 U.S. 466 (2004).

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