

# ICLE

## **24th Annual UNITED STATES SUPREME COURT UPDATE**

**PROGRAM MATERIALS**  
October 19, 2017  
179683

**Thursday, October 19, 2017**

**ICLE: State Bar Series**

**24<sup>th</sup> Annual**

# **UNITED STATES SUPREME COURT UPDATE**

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**6 CLE Hours, Including  
1 Trial Practice Hour**

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## FOREWORD

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### **Dear ICLE Seminar Attendee,**

Thank you for attending this seminar. We are grateful to the Chairperson(s) for organizing this program. Also, we would like to thank the volunteer speakers. Without the untiring dedication and efforts of the Chairperson(s) and speakers, this seminar would not have been possible. Their names are listed on the **AGENDA** page(s) of this book, and their contributions to the success of this seminar are immeasurable.

We would be remiss if we did not extend a special thanks to each of you who are attending this seminar and for whom the program was planned. All of us at ICLE hope your attendance will be beneficial as well as enjoyable. We think that these program materials will provide a great initial resource and reference for you.

If you discover any substantial errors within this volume, please do not hesitate to inform us. Should you have a different legal interpretation/opinion from the speaker's, the appropriate way to address this is by contacting him/her directly.

Your comments and suggestions are always welcome.

Sincerely,

**Your ICLE Staff**

*Jeffrey R. Davis*  
Executive Director, State Bar of Georgia

*Tangela S. King*  
Director, ICLE

*Rebecca A. Hall*  
Associate Director, ICLE



## AGENDA

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### Presiding:

*Kathleen M. Burch*, Program Chair, Professor, Atlanta's John Marshall Law School, Atlanta, GA

### Speakers:

*Craig L. Goodmark*, Goodmark Law Firm LLC, Decatur, GA

*Christina Iturralde Thomas*, Managing Attorney, Atlanta, GA

Kids in Need of Defense (KIND), Atlanta, GA

*Sean J. Young*, Legal Director, American Civil Liberties Union Foundation of Georgia, Atlanta, GA

*John J. Park, Jr.*, Strickland Brockington Lewis LLP, Atlanta, GA

*Aklima Khondoker*, Senior Legal Fellow, American Civil Liberties Union Foundation of Georgia, Atlanta, GA

*Professor Robert A. Schapiro*, Asa Griggs Candler Professor of Law, Emory University School of Law, Atlanta, GA

*Edward Mitchell*, Executive Director, CAIR, Atlanta, GA

*Elizabeth "Beth" Littrell*, Counsel & Racial Justice Strategist, Lambda Legal, Atlanta, GA

*Judith Barger*, Associate Dean for Academic Administration, Atlanta's John Marshall Law School, Atlanta, GA

*Katherine Moss*, Staff Attorney, Southern Center for Human Rights, Atlanta, GA

*B. Michael Mears*, Associate Professor, Atlanta's John Marshall Law School, Atlanta, GA

*Patrick M. Mulvaney*, Managing Attorney, Capital Litigation, Southern Center for Human Rights, Atlanta, GA

*Randy Beck*, Professor, University of Georgia School of Law, Athens, GA

*Francis J. Mulcahy*, Executive Director, Georgia Catholic Conference, Smyrna, GA

*Mark Aaron Goldfeder*, Senior Fellow, Center for the Study of Law and Religion, Emory Law School, Atlanta, GA

*David C. Hricik*, Professor, Mercer University School of Law, Macon, GA

## THURSDAY, OCTOBER 19, 2017

- 7:45 **REGISTRATION AND CONTINENTAL BREAKFAST**  
(All attendees must check in upon arrival. A jacket or sweater is recommended.)
- 8:25 **WELCOME AND PROGRAM OVERVIEW**  
*Kathleen M. Burch*
- 8:30 **RIGHTS AND REMEDIES UNDER THE IDEA**  
*Craig L. Goodmark*, Goodmark Law Firm LLC, Decatur, GA
- 9:15 **IMMIGRATION AND CITIZENSHIP**  
*Christina Iturralde Thomas*, Managing Attorney, Atlanta, GA  
Kids in Need of Defense (KIND), Atlanta, GA
- 10:00 **BREAK**

- 10:10 **RACIAL GERRYMANDERING AND REDISTRICTING**  
*Sean J. Young*, Legal Director, American Civil Liberties Union  
Foundation of Georgia, Atlanta, GA  
*John J. Park, Jr.*, Strickland Brockington Lewis LLP, Atlanta, GA
- 10:55 **ZIGLAR V. ABASSI**  
*Aklima Khondoker*, Senior Legal Fellow, American Civil Liberties Union  
Foundation of Georgia, Atlanta, GA  
*Professor Robert A. Schapiro*, Asa Griggs Candler Professor of Law,  
Emory University School of Law, Atlanta, GA
- 11:40 **LUNCH** (Included in registration fee)
- 12:00 **SHORT A JUSTICE: THE SUPREME COURT'S PER CURIAM DECISIONS**  
*Edward Mitchell*, Executive Director, CAIR, Atlanta, GA  
*Elizabeth "Beth" Littrell*, Counsel & Racial Justice Strategist, Lambda Legal, Atlanta, GA  
*Judith Barger*, Associate Dean for Academic Administration,  
Atlanta's John Marshall Law School, Atlanta, GA  
*Katherine Moss*, Staff Attorney, Southern Center for Human Rights, Atlanta, GA
- 12:45 **CRIMINAL LAW UPDATE**  
*B. Michael Mears*, Associate Professor, Atlanta's John Marshall Law School, Atlanta, GA  
*Patrick M. Mulvaney*, Managing Attorney, Capital Litigation,  
Southern Center for Human Rights, Atlanta, GA
- 1:30 **BREAK**
- 1:40 **TRINITY LUTHERAN CHURCH OF COLUMBIA, INC. V. COMER**  
*Randy Beck*, Professor, University of Georgia School of Law, Athens, GA  
*Francis J. Mulcahy*, Executive Director, Georgia Catholic Conference, Smyrna, GA  
*Mark Aaron Goldfeder*, Senior Fellow, Center for the Study of Law and Religion,  
Emory Law School, Atlanta, GA
- 2:25 **INTELLECTUAL PROPERTY**  
*David C. Hricik*, Professor, Mercer University School of Law, Macon, GA
- 3:00 **ADJOURN**

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# Rights and Remedies Under the Idea

**Presented By:**

*Craig L. Goodmark*  
Goodmark Law Firm LLC  
Decatur, Georgia



## RIGHTS AND REMEDIES UNDER THE IDEA

Craig Goodmark

Goodmark Law Firm

October 19, 2017

U.S. Supreme Court Update

### I. INTRODUCTION

Since 1982, the U.S. Supreme Court has granted *certiorari* for cases involving the provision of special education services fifteen times. Prior to last session, the Court heard argument on a special education case only three times in sixteen years. Thus, it was significant that the Court granted cert for two separate IDEA matters in 2017. The *Fry* and *Endrew F.* decisions marked the most significant involvement in special education jurisprudence from the highest court since 1982 – the year *Bd. of Education v. Rowley* was decided and cases that will immediately impact litigants rights and ability to pursue those rights into court to gain adequate remedies.

### II. IDEA AND SUPREME COURT TIMELINE

Eliminating the separation of people with differences in the education context has a rich history in the U.S. Supreme Court. To that end, below is a timeline of the relevant U.S. Supreme Court jurisprudence regarding the provision of special education services in public schools in this country.

#### **Pre-1970 – The Foundation of Civil Rights Jurisprudence**

- *Brown v. Bd of Education*, 347 U. S. 483 (1954). In this landmark decision, the Supreme Court found that segregated public schools are inherently unequal; decision is relevant to children in segregated special education placements.

#### **1970-1980 – Evolution of the modern Special Education Law**

- *Pennsylvania Association for Retarded Children (PARC) v. Commonwealth of Pennsylvania*, 343 Fed. Supp. 279, (1972); *Mills v. Board of Education of District of Columbia*, 348 F. Supp. 866 (1972) – Court ordered consent decrees that required the integration of students with disabilities into public school.

### **1980-1990 – Individuals with Disabilities Education Act Interpreted**

- *Board of Ed. of Hendrick Hudson Central School Dist. v. Rowley* 458 U.S. 176 (1982). First decision in a special education case by the U. S. Supreme Court; defined "free appropriate public education."
- *Irving Independent Sch. Dist. v. Tatro* 468 U.S. 883 (1984) – Establishing the line between medical and educational services under the definition of related services. The Supreme Court found that catheterization is a related service to be provided by schools.
- *Burlington Sch. Committee v. Mass. Bd. of Ed.*, 471 U. S. 359 (1985). Second landmark special education decision from the Court. This decision primarily explains the procedures for tuition reimbursement by schools to parents that remove their children to private placements. The decision also addresses the child's placement during dispute about FAPE
- *Honig v. Doe*, 484 U.S. 305 (1988). In the context of school discipline of students with disabilities, the Court held that schools could not exclude disabled students from the classroom during the pendency of proceedings and a suspension greater than 10 days constituted a "change in placement" triggering IDEA procedural protections.
- *Dellmuth v. Muth* ; 491 U.S. 223 (1989). States' Eleventh Amendment immunity from suit in the federal courts was not abrogated by EHA.

### **1990-2000 – IDEA Evolves**

- *Zobrest v. Catalina Foothills Sch. Dist.*; 509 U.S. 1 (1993). Schools are not prohibited by the Establishment Clause from providing deaf student with a sign language interpreter to facilitate his education at a sectarian school under IDEA.
- *Florence Co. Sch Dist Four v. Shannon Carter*, 510 U.S. 7 (1993). Reinforcing the parents right to seek reimbursement for private placements, the Court held that if FAPE is denied by the school and the child receives an appropriate education in a private placement, the parents are entitled to be reimbursed.

Importantly, the FAPE standard was not applied to the private placement.

- *Cedar Rapids v. Garret F.*, 526 U.S. 66 (1999) – Reinforcing the *Tatro* decision, the Court held that the medical services exclusion (in the definition of related services) applied only to services that must be performed by a physician. The court found that respondent's need for in-school services could be provided by a school nurse and cost was not a statutory factor.

### **2000-2010 – Refining Litigation Related Provisions of IDEA**

- *Schaffer v. Weast*, 546 U. S. 49 (2005) Supreme Court held that the burden of proof in a due process hearing that challenges an IEP is placed upon the party seeking relief unless ordered otherwise by an individual state's procedures.
- *Arlington Central Sch. Dist. Bd of Ed v. Murphy*, 548 U.S. 291 (2006) - Prevailing parents are not entitled to recover fees for services rendered by experts in IDEA actions.
- *Winkelman v. Parma City School District*, 550 U.S. 516 (2007) – Since parents have independent legal rights under IDEA they may represent their children's interests in special education cases, and are not required to hire a lawyer before going to court.
- *Forest Grove School District v. T.A.*, 557 U.S. 230 (2009) In a 6-3 decision, the Court held that IDEA allows reimbursement for private special education services, even when the child did not previously receive special education services from the public school because the child had not been enrolled or made eligible for services.

### **2010-Present – Redefining FAPE and Access to Court**

- *Fry v. Napoleon Cmty. Sch.*, 137 S. Ct. 743 (2017). 20 U.S.C.S. § 1415(l) does not require that a plaintiff exhaust the Individuals with Disabilities Education Act's (IDEA's), 20 U.S.C.S. § 1400 et seq., procedures before filing an action under the Americans with Disabilities Act, the Rehabilitation Act, or similar laws when her suit seeks relief that was not available under the IDEA.
- *Andrew F. v. Douglas Cnty. Sch. Dist. RE-1*, 137 S. Ct. 988 (2017). To meet its substantive obligation under the IDEA, a school must offer an IEP reasonably calculated to enable a child to make progress appropriate in light of the child's circumstances, a standard that is markedly more demanding than a "merely more than *de minimis*" test for educational benefit.

### III. THE 2017 DECISIONS.

In the last session, the Court heard argument on two distinct issues impacting litigants' rights and remedies in special education law. In February 2017, the Court handed down an opinion in the *Fry v. Napoleon Cmty. Sch.* addressing the exhaustion issue for litigants seeking to raise discrimination claims under the anti-discrimination statutes, the Americans with Disabilities Act and Section 504 of the Vocational Rehabilitation Act, for matters that relate to a student's educational experience in public schools. Then in March 2017, the Court returned to a foundational case in special education law, *Bd. of Ed. v. Rowley*, to update and, many will claim, overturn the standard for liability under the Individuals with Disabilities Education Act (I.D.E.A.) in *Andrew F. v. Douglas Cnty. Sch. Dist. RE-1*. Below are outlined briefing of both cases with limited analysis:

A. *Fry*, 137 S. Ct. 743 (2017) – School related claims of discrimination can be raised under several different federal civil rights laws. For persons with disabilities, the primary vehicles for claims of discrimination are Section 504, the Americans with Disabilities Act and the Individuals with Disabilities Act. For students with disabilities raising non-IDEA related claims, a question existed regarding whether such claims were subject to an administrative exhaustion requirement codified in IDEA. In a 9-0 decision, the Court held that non-IDEA related claims alleging disability discrimination in public education settings are not necessarily subject to exhaustion. *Id.* at 753. Relying on the express language of IDEA, a lawsuit that

does not seek relief for the denial of a free, appropriate public education (FAPE) does not require exhaustion. Less clear from the opinion is what such claims look like and how litigants will be required to make such distinctions when pleading their case.

**FACTS:** E. F. was a child with a severe form of cerebral palsy that obtained a trained service dog Wonder to “help[s E. F.] to live as independently as possible” by assisting her with various life activities,” including “retrieving dropped items, helping her balance when she uses her walker, opening and closing doors, turning on and off lights, helping her take off her coat, [and] helping her transfer to and from the toilet.” *Id.* at 750-51. The Family requested an accommodation under Section 504 and the ADA for Wonder to accompany E. F. to school. *Id.* The school refused noting that E.F.’s school plan called for a human aide. *Id.* While at one point, Wonder was allowed on campus, the trial period ended and the school again refused the accommodation. *Id.* The Family removed E. F. from public school and provided homeschooling.

The Family filed a complaint with the Office of Civil Rights who sided with the Family and Wonder. *Id.* OCR found a violation of both the ADA and Section 504 “even if its use of a human aide satisfied the FAPE standard.” *Id.* The Family filed a lawsuit for declaratory relief and damages in the United States District Court (as compared to an administrative hearing in a state administrative court) claiming that, the school denied, “[E. F.] equal access” by ‘refus[ing] to

reasonably accommodate’ E. F.’s use of a service animal, and otherwise ‘discriminat[ing] against [E. F.] as a person with disabilities.’” Id. at 752

**TRIAL COURT DECISION:** The District Court granted the school’s motion to dismiss for failure to exhaust administrative remedies as required by 20 U.S.C. §1415(l).

**SCOTUS DECISION:** Vacated and remanded with instructions. J. Kagan delivered the opinion of the Court with J. Alito filing an opinion concurring in judgment.

#### **QUOTED LANGUAGE FROM OPINION**

a. **SEEKS RELIEF AVAILABLE:** “We begin, as always, with the statutory language at issue, which (at risk of repetition) compels exhaustion when a plaintiff seeks “relief” that is “available” under the IDEA. The ordinary meaning of “relief” in the context of a lawsuit is the “redress[ ] or benefit” that attends a favorable judgment. Black’s Law Dictionary 1161 (5th ed. 1979). And such relief is “available,” as we recently explained, when it is “accessible or may be obtained.” *Ross v. Blake*, 578 136 S. Ct. 1850, 1858, (2016) (quoting Webster’s Third New International Dictionary 150 (1993)). So to establish the scope of §1415(l), we must identify the circumstances in which the IDEA enables a person to obtain redress (or, similarly, to access a benefit).” Id. at 753.

b. **DOES SUIT RAISE FAPE CLAIM:** “§1415(l)’s exhaustion rule hinges on whether a lawsuit seeks relief for the denial of a free appropriate public

education. If a lawsuit charges such a denial, the plaintiff cannot escape §1415(l) merely by bringing her suit under a statute other than the IDEA—as when, for example, the plaintiffs in *Smith* claimed that a school’s failure to provide a FAPE also violated the Rehabilitation Act.” Id. at 754.

c. **GRAVAMEN OF THE COMPLAINT:** “[T]o meet that statutory standard, a suit must seek relief for the denial of a FAPE, because that is the only “relief” the IDEA makes “available.” We next conclude that in determining whether a suit indeed “seeks” relief for such a denial, a court should look to the substance, or gravamen, of the plaintiff’s complaint. Id. at 753.

d. **TWO QUESTIONS - WHERE AND WHO:** “One clue to whether the gravamen of a complaint against a school concerns the denial of a FAPE, or instead addresses disability-based discrimination, can come from asking a pair of hypothetical questions. First, could the plaintiff have brought essentially the same claim if the alleged conduct had occurred at a public facility that was *not* a school—say, a public theater or library? And second, could an *adult* at the school—say, an employee or visitor—have pressed essentially the same grievance? When the answer to those questions is yes, a complaint that does not expressly allege the denial of a FAPE is also unlikely to be truly about that subject; after all, in those other situations there is no FAPE obligation and yet the same basic suit could go forward. But when the answer is no, then the complaint probably does concern a FAPE, even if it does not

explicitly say so; for the FAPE requirement is all that explains why only a child in the school setting (not an adult in that setting or a child in some other) has a viable claim.” Id. at 756.

B. *Endrew F.*, 137 S. Ct. 988 (2017) -- In a unanimous decision authored by Chief Justice Roberts, the Court rejected the existing “merely more than *de minimus*” standard for the appropriate level of educational benefit required under *Rowley* to provide a child with FAPE under the IDEA. In doing so, the Court reasoned that the IDEA’s strong procedural requirements for developing IEP are there to ensure educational benefit to child. The level of benefit required was held to be, “an IEP reasonably calculated to enable a child to make progress appropriate in light of the child’s circumstances.”

**FACTS:** Endrew F. was diagnosed with autism at age two. Endrew F. He attended public school in Douglas County School District from preschool through fourth grade. Despite being served in special education through an Individualized Education Plan (IEP), over the four years he made little educational progress. Endrew’s education was impacted by his behavior. Endrew would “scream in class, climb over furniture and other students, and occasionally run away from school.” The IEPs drafted each year contained the same basic goals and objectives and little progress was indicated. At the IEP meeting to create a plan for fifth grade, Endrew’s parents disagreed with the school’s plan, removed Endrew from public school and enrolled him at a private school that specializes in educating children with autism. After another

IEP meeting, the Family disagreed with the proposed IEP from the school district and pursued reimbursement for private placement through the due process hearing request procedures.

**TRIAL COURT DECISION:** The administrative court and U.S. District Court denied reimbursement reasoning that “Endrew’s performance under past IEPs “did not reveal immense educational growth... [b]ut it concluded that annual modifications to Endrew’s IEP objectives were ‘sufficient to show a pattern of, at the least, minimal progress.’ In the court’s view, that was all that *Rowley* demanded.”

**SCOTUS DECISION:** Vacated and Remanded. Unanimous Decision.  
Opinion delivered by J. Roberts.

**QUOTED LANGUAGE FROM DECISION:**

- a. **ON IDEA PURPOSE:** The IEP must aim to enable the child to make progress. After all, the essential function of an IEP is to set out a plan for pursuing *academic and functional* advancement. This reflects the broad purpose of the IDEA, an ‘ambitious’ piece of legislation enacted ‘in response to Congress’ perception that a majority of handicapped children in the United States ‘were either totally excluded from schools or were sitting idly in regular classrooms awaiting the time when they were old enough to ‘drop out.’” A substantive standard not focused on student progress would

do little to remedy the *pervasive and tragic academic stagnation* that prompted Congress to act.

- b. **ON IEP PROCEDURES.** . . . [T]he procedures are there for a reason, and their focus provides insight into what it means, for purposes of the FAPE definition, to ‘meet the unique needs’ of a child with a disability. When a child is fully integrated in the regular classroom, as the Act prefers, what that *typically* means is providing a level of instruction reasonably calculated to permit advancement through the general curriculum.
- c. **ON FAPE:** *Rowley* had no need to provide concrete guidance with respect to a child who is not fully integrated in the regular classroom and not able to achieve on a grade level. That case concerned a young girl who was progressing smoothly through the regular curriculum. If that is not a reasonable prospect for a child, his IEP need not aim for grade-level advancement. But his educational program must be appropriately ambitious in light of his circumstances, just as advancement from grade to grade is appropriately ambitious for most children in the regular classroom. The goals may differ, but every child should have the chance to meet challenging objectives.

When all is said and done, a student offered an educational program providing ‘merely more than *de minimus*’ progress from

year to year can hardly be said to have been offered an education at all. For children with disabilities, receiving instruction that aims so low would be tantamount to ‘sitting idly . . . awaiting the time when they were old enough to drop out.’ The IDEA demands more. It requires an educational program reasonably calculated to enable a child to make progress appropriate in light of the child’s circumstances.

#### IV. CONCLUSION

For the Court to address two independent special education related issues in one term is significant. In *Fry* and *Andrew F.*, the Court has directly impacted the substantive jurisprudence of public education with immediate and important implications for practitioners. In *Fry*, the Court has removed an unnecessary administrative hurdle for those claiming discrimination to file their original complaints in federal court on non-IDEA claims. In *Andrew F.*, the Court has reinterpreted one element of the legal standard for liability and reasserted the stated purpose of IDEA of ensuring those students with disabilities are not excluded from educational opportunity or suffer the less obvious, but equally vicious, discrimination of lowered expectations.





# Immigration and Citizenship

**Presented By:**

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Atlanta, Georgia





# Racial Gerrymandering and Redistricting

## **Presented By:**

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Atlanta, Georgia

*John J. Park, Jr.*

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Atlanta, Georgia



## Racial Gerrymandering and Redistricting

by

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The Supreme Court's latest turn at sorting out racial gerrymandering law really began with its 2015 decision in *Alabama Legislative Black Caucus v. Alabama* ("ALBC"). This term, the Court addressed the issue in three cases, *Bethune-Hill v. Virginia State Board of Elections*, 137 S. Ct. 788 (2017); *Cooper v. Harris*, 137 S. Ct. 1455 (2017); and the per curiam decision in *North Carolina v. Covington*, 137 S. Ct. 1624 (2017).

Before turning to a discussion of these cases, we would like to make three overarching points.

First, these decisions, as well as the anticipated ruling in the political gerrymandering case this term, will guide the States in the next round of redistricting which will follow the 2020 Census.

Second, by way of context, we are deep in the 2010 redistricting cycle. The States got their Census results in 2011, and congressional redistricting had to follow quickly so that elections could take place in 2012. If a State had legislative elections coming up in 2012, those plans had to be in place quickly as well. For the 2020 Census cycle, the same timing considerations will be at work.

Third, for the purpose of these case, in the Southern States, legislative and congressional plans were still subject to Section 5 review by the United States Department of Justice, the federal district court in

Washington, D.C., or both. Alabama argued that its plan was tailored to DOJ's Guidance, which, in pertinent part, identified a "comparison of the census population of districts in the benchmark and proposed plans" as "the important starting point of any Section 5 analysis." *Guidance Concerning Redistricting Under Section 5 of the Voting Rights Act*, 76 Fed. Reg. 7470, 7471 (Feb. 9, 2011). The plaintiffs disagreed, but in any event, the point remains: Alabama had to have its plans precleared before they could be enforced. So did Virginia with its congressional plan, the subject of *Bethune-Hill*, and the North Carolina congressional and legislative plans addressed in *Cooper v. Harris* and *North Carolina v. Covington*.

That will not be the case in 2020, unless Congress reauthorizes Section 5 of the Voting Rights Act or one or more of the States is placed back into coverage.

*Bethune-Hill v. Virginia State Board of Elections*

This case involved a racial gerrymandering challenge to the constitutionality of 12 black-majority districts in the Virginia House of Delegates. The State, perhaps with the agreement of certain members of the African-American leadership, tried to bring those districts in at 55% Black Voting-Age Population ("BVAP"). The district court held that race did not predominate in the drawing of 11 of the 12 districts in part because the shapes of the districts revealed that non-racial districting criteria (e.g., compactness, contiguity, etc.) prevailed over racial criteria. As for HD 75, the district court held that while race did predominate in the drawing of HD 75, that district satisfied strict scrutiny, because the legislature had a strong basis to believe that a 55% BVAP floor was required to comply with Section 5 of the Voting Rights Act (that is, to avoid retrogression in the position of racial minorities in that district), which applied at that time. (The parties did not dispute that compliance with Section 5 is a compelling state interest; the Court has yet to decide that question.)

The Court first reviewed the legal backdrop governing racial gerrymandering cases. “The Equal Protection Clause prohibits a State, without sufficient justification, from ‘separat[ing] its citizens into different voting districts on the basis of race.’ The harms that flow from racial sorting ‘include being personally subjected to a racial classification as well as being represented by a legislator who believes his primary obligation is to represent only the members of a particular racial group.’” *Bethune-Hill*, 137 S. Ct. at 797 (citations omitted). However, “redistricting differs from other kinds of state decisionmaking in that the legislature always is aware of race when it draws district lines, just as it is aware of ... a variety of other demographic factors.” *Id.* (citation omitted). Thus, the plaintiff alleging racial gerrymandering bears the burden of showing that race was the “predominant factor motivating the legislature’s decision to place a significant number of voters within or without a particular district.” *Id.* (citation omitted). If a court finds that race predominated, then the plan is subject to strict scrutiny: it must be narrowly tailored to satisfy a compelling state interest.

The Supreme Court then affirmed the district court’s decision as to HD 75, but reversed as to the other 11. It remanded the case for consideration of, among other things, whether the 11 districts satisfied strict scrutiny.

The Court held that challengers to an adopted plan need not show that the districts drawn were inconsistent with traditional redistricting criteria in order to prevail: “[A] conflict or inconsistency between the enacted plan and traditional redistricting criteria is not a threshold requirement or a mandatory precondition in order for a challenger to establish a claim of racial gerrymandering.” 137 S. Ct. at 799. It acknowledged, though, that “in many cases, perhaps most cases,” such a showing would be needed. *Id.* Instead, the Court held that the question concerned the “racial purpose of state action, not its stark manifestation. The Equal Protection Clause does not prohibit

misshapen districts. It prohibits unjustified racial classifications." *Id.* (citation omitted).

The Court also held that the scope of the lower court's analysis should be the district as a whole. It explained, "[E]ven where a challenger alleges a conflict, or succeeds in showing one, the court should not confine its analysis to the conflicting portions of the lines." *Id.* at 799-800. Rather, the court should consider "all of the lines of the district at issue; any explanation for a particular portion of the lines, moreover, must take account of the district-wide context." *Id.* at 800.

Justice Alito concurred in part and concurred in the judgment. He would have held that race did predominate in the drawing of the 11 districts subject to the remand, instead of remanding for the district court to make that determination in the first instance. Virginia would then have to show that those 11 districts satisfied strict scrutiny.

Justice Thomas concurred in the judgment in part and dissented in part. Like Justice Alito, he believed that the 11 districts at issue had to satisfy strict scrutiny. He explained that the drawing of black-majority districts "mandates strict scrutiny as to each district." *Id.* at 803 (Thomas, J., concurring in the judgment in part and dissenting in part).

Justice Thomas also dissented from the Court's decision on HD 75, explaining that the State "neither asserted a compelling state interest nor narrowly tailored its use of race." *Id.* at 804. He disagreed with the view that compliance with Section 5 of the Voting Rights Act was a compelling state interest: "Because, in my view, § 5 is unconstitutional, I would hold that a State does not have a compelling interest in complying with it." *Id.* In addition, Justice Thomas noted that the State's efforts to defend the use of the 55% BVAP figure "fell far short of establishing that a 55% black voting-age population bears a more exact connection to the State's interest than any alternative percentage." *Id.* at 806 (internal quotation omitted).

Justice Thomas concluded by “recogniz[ing] that this Court is at least as responsible as the state legislature for these racially gerrymandered districts.” *Id.* He observed that the Court has “repeatedly failed to decide whether compliance with the Voting Rights Act is a compelling governmental interest.” *Id.* at 806-07. And, with respect to § 5, he pointed out that compliance with it required that a State “necessarily make a deliberate and precise effort to sort its citizens on the basis of their race.” *Id.* at 807.

*Cooper v. Harris*

This case involved a racial gerrymandering challenge to two North Carolina congressional districts: CD 1 and CD 12, both of which were the subject of numerous prior rounds of litigation. *See Shaw v. Reno*, 509 U.S. 630 (1993); *Shaw v. Hunt*, 517 U.S. 899 (1996); *Hunt v. Cromartie*, 526 U.S. 541 (1999); *Easley v. Cromartie*, 532 U.S. 234 (2001).

According to the Court, neither CD 1 nor CD 12 was a black-majority district when drawn in 2001. They were both black-plurality and consistently elected African-American representatives. The State noted, though, that CD 1 was majority-black in total population, and plurality black in voting-age population when drawn. It also noted that, when the 2010 Census data was loaded into the 2001 districts, CD 1 was plurality-black in total and voting-age population.

The State turned CD 1 into a black-majority district, reasoning that *Bartlett v. Strickland*, 556 U.S. 1 (2009), meant that it had to draw it as a black-majority district. It noted the *Bartlett* plurality's view that States need not draw crossover districts under Section 2 of the Voting Rights Act (i.e., districts where a minority group can elect its candidate of choice but only with help from other voters who are members of the majority; for instance, when the minority group is shy of the majority). The State reasoned that since *Bartlett* held that Section 2 does not require drawing crossover districts, then Section 2 also cannot be

satisfied by crossover districts, and thus Section 2 requires drawing a majority-minority district when a State can do so. *Cooper*, 137 S. Ct. at 1472. According to the State, it added African-Americans to CD12 in order to make the district a more Democratic one; according to the plaintiffs, the State was predominantly motivated by race, not party. The three-judge court found both districts to be the product of unconstitutional racial gerrymandering.

The Supreme Court, applying a clear error standard of review to the district court's factual findings, agreed. It agreed that turning the district into a black-majority district required the use of a racial target (of 50%)—thus making race a predominant factor in the decision. It also agreed that the State could not satisfy strict scrutiny, because it did not have a strong basis for believing that it needed a majority-minority district in order to avoid liability under Section 2 of the Voting Rights Act. In particular, the Court observed that, because the African-American candidates had generated larger majorities than the African-American population alone could provide, the *Gingles* precondition of racially polarized voting was not met.

With respect to CD 12, the Court observed that the district court had to choose between two competing explanations and did so. It concluded that the district court's findings were not clearly erroneous.

Justice Thomas concurred, noting with respect to CD 12 that he has dissented in *Easley v. Cromartie*, which had allowed a prior iteration of CD 12 to stand after overturning the district court's factual findings as clearly erroneous. He explained, "The Court reached the contrary conclusion in *Cromartie II* only by misapplying our deferential standard for reviewing factual findings." *Id.*, 137 S. Ct. at 1486 (Thomas, J., concurring) (citing *Easley*, 534 U.S. at 259-62 (Thomas, J., dissenting)).

Justice Alito, joined by Chief Justice Roberts and Justice Kennedy dissented. He criticized the majority for treating *Easley v. Cromartie*

“like a disposable household item—say, a paper plate or napkin—to be used once and then tossed in the trash.” *Id.* at 1486. More substantively, he noted the strong correlation between racial identity and political affiliation. *Id.* at 1488. While the Court solved that problem in *Easley v. Cromartie* by requiring the challenger to “submit an alternative redistricting map demonstrating that the legislature could have achieved its political goals without the racial effects giving rise to the racial gerrymandering allegation,” *id.* at 1489, Justice Alito criticized the majority for dispensing with the need for an alternative map in this case. He observed that the alternative map requirement gave the courts a way to respect the work of the state legislatures.

Finally, Justice Alito would have reversed the district court’s finding that race predominated in the drawing of CD 12. He observed, “[S]o long as the legislature chose to retain the basic shape of District 12 and to increase the number of Democrats in the district, it was inevitable that the Democrats brought in would be disproportionately black.” *Id.* at 1494.

#### *North Carolina v. Covington*

This case involves the remedial powers of the federal district courts, including the three-judge federal district courts convened to resolve redistricting disputes. In *Upham v. Seamon*, 456 U.S. 37 (1982), the Court held, “[I]n the absence of any finding of a constitutional or statutory violation with respect to [the challenged] districts, a court must defer to the legislative judgments the plans reflect, even under circumstances in which a court order is required to effect an interim legislative apportionment plan.” *Id.* at 40-41. The court is not free to “substitute[] its own reapportionment preferences for those of the state legislature.” *Id.* at 40.

*Seamon* does not directly answer the question in *Covington*, where the district court found 28 black-majority state legislative districts in the North Carolina General Assembly plan unconstitutionally racially

gerrymandered. The court allowed the 2016 elections to proceed under the unconstitutional plan, but, after the election, it shortened the terms of those elected from two years to one and ordered special elections under a new plan in the fall of 2017.

The Court vacated the district court's remedial order, holding that its balancing of the equities was flawed. The Court explained,

[I]n the context of deciding whether to truncate existing legislators' terms and order a special election, there is much for a court to weigh. Although this Court has never addressed whether or when a special election may be a proper remedy for a racial gerrymander, obvious considerations include the severity and nature of the particular constitutional violation, the extent of the likely disruption to the ordinary processes of governance if early elections are imposed, and the need to act with proper judicial restraint when intruding on state sovereignty.

*Id.*, 137 S. Ct. at 1625-26. The district court's " cursory " reasoning " would appear to justify a special election in every racial-gerrymandering case—a result clearly at odds with our demand for careful case-specific analysis." *Id.* at 1626.

#### What Have We Learned?

1. What do we do in 2020 with underpopulated black-majority or black-plurality districts in light of the States' obligation to comply with Section 2 of the Voting Rights Act and the Constitution's "one person, one vote" requirements? *Cooper v. Harris* and *ALBC* suggest that putting enough of a racial minority into a district in order for them to maintain the majority can constitute racial gerrymandering, i.e., that putting more than you need for the racial minority to elect the candidate of their choice is packing. And preserving any fixed racial percentage (whether above or below 50%) in amber, some argue, would require an extraordinary amount of racial (and political) sorting.

We will run into this again, because black-majority districts have tended to come into redistricting cycles underpopulated. That may reflect the fact that, as Abigail Thernstrom suggested, African Americans migrate and integrate into surrounding traditionally-white jurisdictions, making it more difficult to draw a majority-minority district. Some argue that this presents a significant challenge for the States, because they have to add population to those underpopulated districts, and that population can either preserve an existing majority or bleach the district. If voting is racially polarized, adding white Republicans to a less than majority-black district may flip the district, potentially satisfying the *Gingles* criteria resulting in a Section 2 violation.

2. In *League of United Latin American Citizens v. Perry*, 548 U.S. 399, 517 (2006) (Scalia, J., concurring in judgment in part and dissenting in part), Justice Scalia wrote, “[W]hen a legislature intentionally creates a majority-minority district, race is necessarily its predominant motivation and strict scrutiny is therefore triggered.” *Id.* In *Cooper*, the majority found that the predominant intent was obvious because the legislators repeatedly stated that a “majority-minority” district was required to comply with Section 2. *Cooper*, 137 S. Ct. at 1468. In *Bethune-Hill*, in the face of similar evidence, the majority remanded for the district court to determine predominance under the correct legal standard in the first instance.

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Justice Alito and Justice Thomas echoed Justice Scalia’s point about the drawing of a majority-minority district. *See* 137 S. Ct. at 803 (Alito, J., concurring in part and concurring in the judgment); *id.* (Thomas, J., concurring in the judgment in part and dissenting in part). That helps to explain why each of them felt that the predominance question was easily answered.

*Thornburg v. Gingles*, 478 U.S. 30 (1986), calls for the creation of minority-majority districts when three conditions are met: 1) that the minority group is sufficiently large and geographically compact to

constitute a majority in a reasonably configured district; 2) that the minority group must be politically cohesive; and 3) that the white majority must vote sufficiently as a bloc to usually defeat the minority's preferred candidate. Does the creation of a minority-majority district that satisfies the *Gingles* criteria *ipso facto* satisfy strict scrutiny?



# Ziglar V. Abassi

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*ZIGLAR v. ABBASI:*

How the Supreme Court denied relief to victims of civil and human rights violations using pleading standards, statutory construction and qualified immunity to deny relief to victims of civil and human rights violations from the 9/11 round-up.

by

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### *Overview*

The Supreme Court's decision in *Ziglar v. Abbasi*, 582 U.S. \_\_\_\_ (2017), denied relief to federal detainees who sought money damages for civil and human rights violations under the backdrop of 9/11 investigations. After the 9/11 attacks, then Attorney General John Ashcroft, FBI Director (now Special Counsel) Robert Mueller, and Commissioner of the Immigration and Naturalization Service James Ziglar implemented a nationwide policy that called for the FBI to detain Arab or Muslim men who were not in the U.S. legally, until those men were not considered a threat. Until that time, these men were detained in solitary confinement for 23 hours a day, forced to strip search continuously, denied sleep and use of the telephone, were not allowed to pray or have a Koran and were beaten by correction officers. Some of these men filed a lawsuit in 2002, alleging that the top federal officials ordered that they be racially profiled and be held in the cruelest conditions possible. In order to vindicate the violations of their Fourth and Fifth amendment rights, these Arab and Muslim men brought an action against these federal officials under *Bivens* and 42 U.S.C. § 1985(3).

### *Constitutional rights of detained immigrants*

Immigrant detainees in the United States have been granted constitutional rights since the late 1800's. *Yick Wo v. Hopkins*, 118 U.S. 356 (1886). In *Yick Wo v. Hopkins*, the Supreme Court of the United States reasoned that "The Fourteenth amendment to the constitution is not confined to the protection of citizens... These provisions are universal in their application to all persons within the territorial jurisdiction, without regard to any differences of race, of color or nationality; and the equal protection of the laws is a pledge of the protection of equal laws." *Id.* at 369. Likewise, in *Zadvydas v. Davis*, the Supreme Court held that "once an alien enters the country, the legal circumstance changes, for the due process clause [of the Fifth and Fourteenth Amendments] applies to all persons within the United States." *Zadvydas v. Davis*, 533 U.S., 678, 690 (2001).

Constitutional rights further extend to undocumented immigrants. *See Buck v. Stankovic*, 485 F. Supp. 2d 576, 582 (M.D.P.A. 2007) citing *Theck v. Warden, I.N.S.*, 22 F.Supp.2d 1117, 1122 (C.D.Cal.1998) ("[a]s a general matter, persons within the jurisdiction of the United States should be considered to be protected by the Constitution, unless it has been expressly held otherwise"). *See also Plyler v. Doe*, 457 U.S. 202, 210, 223, 102 S.Ct. 2382, 72 L.Ed.2d 786 (1982) (declining to treat undocumented aliens as a suspect class because "their presence in this country in violation of federal law is not a "constitutional irrelevancy," but nevertheless holding that "[a]liens, even aliens whose presence in this country is unlawful, have long been recognized as 'persons' guaranteed due process of law by the Fifth and Fourteenth Amendments").

*Bivens* actions provide an avenue for a remedy against federal officials for violating a Constitutional right under the color of federal authority. The plaintiff must show that a constitutionally protected right has been violated by the federal officers. However, *Bivens* actions have only been applied in limited circumstances and the Court's ruling in *Ziglar* has significantly limited the application of *Bivens*—even when the conditions provide a clear path to relief.

*Bivens v. Six Unknown Named Agents*, 403 U.S. 388 (1971)

*Bivens* established that the victims of a constitutional violation by a federal official may have a right to recover damages against the official in federal court despite the absence of any statute conferring such a right.<sup>1</sup> In *Bivens*, the plaintiff was arrested, detained and stripped searched by agents of the Federal Bureau of Narcotics without a warrant. The drug charges against plaintiff were dismissed. The plaintiff brought an action against agents of the Federal Bureau of Narcotics (“FBN”) alleging the violation of his Fourth Amendment freedom from unreasonable search and seizure. The FBN claimed that the plaintiff could only seek relief under a state law claim because Congress did not create a cause of action for the plaintiff to seek relief from federal officials; therefore plaintiff's claim should be dismissed. The Supreme Court held that it will imply a damages remedy under the Constitution when there is no federal remedy for the vindication of a constitutional right under certain conditions. The Court reasoned that a plaintiff may recover when there is a violation of a Constitutional right under any civil action so long as Congress has not denied the right or when some “special factors counseling hesitation” exists. Therefore, under a *Bivens* claim, a plaintiff may seek monetary damages for the violation of a constitutional right against a federal official that is acting under color of federal authority.

A *Bivens* claim is appropriate when the Court has previously granted a remedy, i.e., similar facts and similar constitutional violation. However, when a new context is presented to the court, limitations may bar relief under *Bivens*. The Court has declined to recognize the availability of a *Bivens* cause of action where relief is available by other means established by Congress, or in the presence of “special factors counseling hesitation.”

#### *Limitations of Bivens claims*

A *Bivens* claim is appropriate whenever the court has previously granted a remedy under similar facts and similar constitutional violations. When deciding whether to apply *Bivens*, the Court first considers whether the context is new or similar to a previous case. Prior to *Abbasi*, new context referred to the constitutional rights asserted. If the rights were similar to the rights asserted in other *Bivens* actions<sup>2</sup> then the remedy would be available. This framework changed

<sup>1</sup> *Carlson v. Green*, 446 U.S. 14, 17 (1980).

<sup>2</sup> The constitutional violations that the Court approved in the past: Fourth amendment claim against FBI agents for arresting a suspect in his home without a warrant (*Bivens*, 403 U.S. 388); Fifth amendment claim for sex discrimination against a U.S. Congressman (*Davis v. Passman*,

under *Abbasi*. Under *Abbasi*, the proper test for determining whether a case is “new context” is whether the case is different in a meaningful way from the previous *Bivens* cases decided by the Supreme Court. Meaningful differences include: the rank of the officer involved; the constitutional right at issue; the generality or specificity of the official action; the extent of judicial guidance on how the official should respond; statutory or legal mandates; the risk of judicial disruption into other branches; or the presence of special factors that previous *Bivens* cases did not consider. *Bivens* is unavailable when special factors counseling hesitation exist. “Special factors” as defined by the Court in *Abbasi*, “must cause a court to hesitate before answering that question in the affirmative.” specifically, if the implied right to damages would intrude into the policy-making prerogative of Congress, then the Court will not apply *Bivens*. (“[e]ven when a branch does not arrogate power to itself...the separation-of-powers doctrine requires that a branch not impair another in the performance of its constitutional duties”) (*Abbasi*, quoting *Loving v. United States*, 517 U.S. 748, 757 (1996)). Thus, now, for *Bivens* to apply, there must not be any alternative remedies available and the facts of the case must mirror previous *Bivens* cases, otherwise, if the facts differ in a meaningful way, a la special factors, then the Court will be reluctant to apply *Bivens* to avoid a separation of powers issue.

#### *Bivens limitations applied to Abbasi*

The *Abbasi* Court declined to extend damages relief because Plaintiffs were applying *Bivens* to a new context and there were special factors that counsel against extending *Bivens* in this context. The Court reasoned that similar constitutional violations does not mean similar context, therefore cases like *Chappell* (successful damages claim against police officers under Eighth amendment when officers refused medical treatment to inmate) and *Bivens* (successful damages claim against FBI agents under Fourth amendment when agents detained plaintiff without a warrant) should not be the litmus for this action. Instead, because the context of *Abbasi* concerned the detention policies “pursuant to a high-level executive policy created in the wake of a major terrorist attack on American soil” *Abbasi* differed in a meaningful way from those claims in *Chappell*, *Bivens*, and *Davis*, thus special factors must be considered before a *Bivens* action could be approved.

However, the special factors that must be considered are the providence of Congress because it is within the powers of the Congress and President to decide national security protocol during a congress, not the courts. The Court held that “...whether a damages action should be allowed is a decision for the Congress to make, not the courts.” Because the detention policies were created as a national policy against terrorism and issues of national security are the prerogative of the Congress and President, the Court pivoted away from weighing the special

442 U.S. 228 (1979)); and Eighth amendment claim for refusing medical care in a prison against prison officials (*Chappell v. Wallace*, 462 U.S. 296 (1983)).

factors against the civil liberties violations suffered. Instead, *Abbasi* declined *Bivens* damages for six reasons:

1. *Bivens* should discourage illegal acts by federal officers and does not apply to federal policies;
2. This action would distract high-level executive officials from their duties;
3. This action would threaten the confidentiality of Executive branch discussions;
4. It is the prerogative of Congress to create *Bivens* remedies for acts manifested during national security crises;
5. Congress has known about such policies and has not enacted legislation to create a cause of action against the violations; and
6. Plaintiffs had injunctive and habeas relief available as alternative remedies.

These special factors outweigh the benefit of holding federal officials accountable for violating the Constitution.

#### *Procedural devices used to block Bivens in Abbasi*

The decision in *Abbasi* constituted the second time this particular suit had reached the United States Supreme Court. In *Ashcroft v. Iqbal*, 556 U.S. 662 (2009) the Court had dismissed the case because the allegations in the complaint had failed to meet the “plausibility” standard initially fashioned by the Court in *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544 (2007). In *Iqbal*, the Court held that some of the allegations of wrongdoing were merely conclusory and that other allegations did not sufficiently dispel alternative explanations for the conduct. The Court noted that plaintiffs relied in part on a theory that the defendants had acted with a discriminatory purpose. However, the Court concluded that the complaint did not contain “any factual allegation sufficient to plausibly suggest petitioners’ discriminatory state of mind.”<sup>3</sup> As the Court put it, “Taken as true, these allegations are consistent with petitioners’ purposefully designating detainees ‘of high interest’ because of their race, religion, or national origin. But given more likely explanations, they do not plausibly establish this purpose.”<sup>4</sup>

*Iqbal* imposed a high hurdle on cases alleging discriminatory motives. Direct evidence of a defendant’s state of mind can be difficult to find. After remand, the plaintiffs files a fourth amended complaint. The United States Court of Appeals for the Second Circuit held that the allegations in the complaint met the *Iqbal* standard. The suit then returned to the Supreme Court. The suit has now resulted in the Court’s both adopting stricter pleading standards under Rule 8 in *Iqbal* and narrowing the availability of *Bivens* actions in *Abbasi*.

The national security background to the case and its seeking to invoke a judicial forum to review the actions of senior government officials in the wake of the 9/11 attacks seemed to figure

<sup>3</sup> *Iqbal*, 556 U.S. at 683.

<sup>4</sup> *Iqbal*, 556 U.S. at 681.

prominently in the Court's reluctance to allow the case to proceed. In his dissent, Justice Breyer argued that the Court's resistance to intruding into national security measures had led it to limit unduly the *Bivens* remedy. Justice Breyer believed that other safeguards were available to avoid inappropriate judicial intervention in matters of national security. As he phrased the point, "If you are cold, put on a sweater, perhaps an overcoat, perhaps also turn up the heat, but do not set fire to the house."<sup>5</sup> In addition, it might be noted that the decision in *Abbasi* was by an unusual 4-2 majority. The case was argued before Justice Gorsuch was nominated, and Justices Kagan and Sotomayor recused themselves, presumably based on prior involvement with the case, either as an official in the Justice Department or as a judge on the Second Circuit. However, the significance of the case extends beyond the particular facts and the particular majority.

The underlying theory of the *Bivens* case was that, absent unusual circumstances, plaintiffs should have judicial remedies when their rights are violated by federal officials. The Court in *Bivens* asked whether there was some special reason to deny the remedy. The question for the *Bivens* court was whether Congress had affirmatively blocked a suit and offered instead an alternative remedy. Speaking for the Court in *Bivens*, Justice Brennan wrote, "[W]e have here no explicit congressional declaration that persons injured by a federal officer's violation of the Fourth Amendment may not recover money damages from the agents, but must instead be remitted to another remedy, equally effective in the view of Congress."<sup>6</sup> The Court has moved decisively away from this framework and has sought to restrict the reach of *Bivens* remedies. *Abbasi* represents the most recent and the probably the most stringent limitation. As emphasized by Justice Breyer's dissent, the basic claim of abusive treatment during confinement seems almost identical to claims previously recognized.<sup>7</sup> In his separate opinion in *Abbasi* Justice Thomas reiterated his desire to limit *Bivens* to the greatest extent possible. He explained, "I have thus declined to "extend *Bivens* even [where] its reasoning logically applied," thereby limiting "*Bivens* and its progeny . . . to the precise circumstances that they involved."<sup>8</sup> In this case, the majority came close to adopting a similarly narrow view.

Another theme of the *Bivens* case was the importance of providing some remedy for the violation of a federal right. The plaintiff in *Bivens* was not in custody. A damages remedy seemed the only possible avenue for redress. The majority in *Abbasi* explicitly distinguished *Bivens* on those grounds. The Court stated, "It is of central importance, too, that this is not a case like *Bivens* or *Davis* in which 'it is damages or nothing.' *Bivens, supra*, at 410 (Harlan, J., concurring in judgment). . . ." The *Abbasi* court noted that injunctive relief might have been available and that the plaintiffs could possibly have challenged their confinement by means of a petition for a writ of habeas corpus. However, given the restrictive framework established by the

<sup>5</sup> See 582 U.S. at \_\_\_ - \_\_\_ (Breyer, J., dissenting).

<sup>6</sup> *Bivens*, 403 U.S. at 397.

<sup>7</sup> See 582 U.S. at \_\_\_ - \_\_\_ (Breyer, J., dissenting).

<sup>8</sup> 582 U.S. at \_\_\_ (Thomas, J., concurring in part and concurring in the judgment) (quoting *Wilkie v. Robbins*, 551 U. S. 537, 568 (2007)).

Court, it is not clear whether in a future case the absence of an alternative remedy would be sufficient to sustain a *Bivens* remedy.





# Short A Justice: The Supreme Court's Per Curiam Decisions

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## **TRUMP V. INTERNATIONAL REFUGEE ASSISTANCE PROJECT & TRUMP V. HAWAII**

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## Executive Order 13780 The Second "Travel Ban"

- Signed on March 6th, 2017, replacing Executive Order 13769, the first "travel ban"
- Stated that conditions in six Muslim majority countries (Iran, Libya, Somalia, Sudan, Syria, and Yemen) "continue to present heightened risks to the security of the United States" and "some... have proved to be threats to our national security"
- Suspended entry of nationals from these six Muslim-majority countries for 90 days
- Suspended decisions on applications for refugee status, as well as on travel of refugees into the United States, for 120 days
- Imposes an entry limit of 50,000 refugees per year

## Executive Orders Compared

### **Executive Order 13769**

#### **The First "Travel Ban"**

- Suspended entry from 7 Muslim majority countries (Iran, Iraq, Libya, Somalia, Sudan, Syria and Yemen)
- Effective immediately
- Placed a 120 day hold on all refugee entry; exemption for religious minorities
- Banned Syrian refugees indefinitely
- Placed a 50,000 person cap on refugees
- Initially impacted lawful permanent residents

### **Executive Order 13780**

#### **The Second "Travel Ban"**

- Suspends entry from 6 Muslim majority countries (exempting Iraq)
- Effective 10 days after being signed
- Places a 120-day hold on all refugee entry; no exemption for religious minorities
- Places a 50,000 annual cap on refugees
- No impact on lawful permanent residents, other foreign nationals already legally present in the U.S., or foreign nationals who have already obtained valid entry documents

## Challenges to the Second Travel Ban

- International Refugee Assistance Project v. Donald J. Trump
  - On the behalf of John Doe #1, a lawful permanent resident whose Iranian wife is seeking entry to the United States
  - Violation of the First Amendment Establishment Clause
- State of Hawaii. v. Donald J. Trump
  - The State of Hawaii, on the behalf of Dr. Ismail Elshikh, an American citizen and imam whose Syrian mother-in-law is seeking entry to the United States
  - Violation of First Amendment Establishment Clause
  - Exceeded authority granted by the Immigration and Naturalization Act (INA)

## Key Issues Facing Supreme Court

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- **Does the Administration have the statutory authority to bar the issuance of travel visas to foreign nationals of specific nations by executive order?**
  - In other words: as a matter of law, can the government do this?
- **If the Administration has the statutory authority to issue the executive order, is the motivation behind the order relevant to constitutional analysis?**
  - In other words: can the Supreme Court examine the purpose behind the order?
- **If so, was the order motivated by legitimate concerns about security, religious bigotry or both?**
  - In other words: what's the real purpose behind the order?
- **Would implementation of the order result in religious discrimination in violation of the Constitution?**
  - In other words: if the order does not actually result in illegal discrimination, does a discriminatory purpose nevertheless render it unconstitutional?

## Government's Response

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- Respondents lack standing
- Establishment Clause claims fail on the merits
- President Trump's campaign trail comments should not be used to discern meaning or purpose
- 9<sup>th</sup> Circuit court is engaging in "impermissible judicial second guessing" of the President's judgment on a matter of national security
- Injunctions are too broad

## Procedural History

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- Federal District Court for the Fourth Circuit entered a nationwide preliminary injunction barring the Government from suspending entry from the six Muslim majority countries
- Federal District Court for the Ninth Circuit entered a nationwide preliminary injunction barring the government from enforcing the suspension of entry, suspension of refugee admissions, the reduction in the refugee cap and the provisions pertaining to internal executive review
- Appeals Court for both circuits upheld the injunctions BUT the 9<sup>th</sup> Circuit Court of Appeals narrowed the injunction so that it would not bar the Government from undertaking the internal executive review.

## Supreme Court Ruling on Temporary Injunction

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- Executive order "may not be enforced against foreign nationals who have a credible claim of a ***bona fide relationship*** with a person or entity in the United States. All other foreign nationals are subject to the provisions of the Executive Order."
- Ruling addresses the need to temporarily balance the equities and potential harms to each party, but does not address key substantive issues such as the Establishment Clause claim.
- The Justice Department has declined to appeal a subsequent appeals court ruling broadening the definition of a "*bona fide relationship*" to include grandparents and other relatives.
- The Justice Department successfully appealed a ruling that would have permitted entry by refugees previously promised entry by American refugee resettlement agencies.

## Where the Executive Order Stood After Per Curiam Ruling

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- Oral arguments initially scheduled for Oct. 18, 2017
- Government permitted to perform the (previously blocked) executive review of safety and security measures related to the issuance of visas
- Government CAN temporarily bar foreign nationals (from the six targeted nations) if they lack a bona fide connection to U.S. persons, including but not limited to:
  - New tourists
  - New refugees
- Government CANNOT temporarily bar foreign nationals (from the six targeted nations) with a bona fide connection to U.S. persons, including but not limited to:
  - Close family members of U.S. persons (including spouses, fiancés, children, grandparents)
  - Students admitted to attend American universities

## New Developments

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- After completing security review, the Department of Homeland Security issues a third travel ban: new, indefinite travel restrictions tailored to, and varying among, eight different nations.
- Impacted nations are Chad, Iran, Libya, North Korea, Somalia, Venezuela, and Yemen.
- Most restrictions scheduled to take effect on Oct. 18, 2017.
- Supreme Court cancels oral arguments scheduled for Oct. 10, 2017, pending submission of briefs on whether the travel ban case is moot.

## Impact of Third Travel Ban (1 of 2)

	IMMIGRANT VISAS SUSPENDED	NON- IMMIGRANT VISAS SUSPENDED	*EFFECTIVE DATE	
			NO BFR	BFR
SYRIA	ALL	ALL	9/24	10/18
NORTH KOREA	ALL	ALL	10/18	10/18
SOMALIA	ALL	NONE	9/24	10/18
LIBYA	ALL	ONLY B1/B2	9/24	10/18

## Impact of Third Travel Ban (2 of 2)

	IMMIGRANT VISAS SUSPENDED	NON- IMMIGRANT VISAS SUSPENDED	*EFFECTIVE DATE	
			NO BFR	BFR
YEMEN	ALL	ONLY B1/B2	9/24	10/18
CHAD	ALL	ONLY B1/B2	10/18	10/18
VENEZUELA	NONE	ONLY B1/B2 FOR SOME GOVERNMENT OFFICIALS AND IMMEDIATE FAMILY	10/18	10/18
IRAN	ALL	ALL EXCEPT STUDENT (F,J,M) VISAS	9/24	10/18

\*BFR = Bona Fide Relationship with a U.S. person or entity. On October 18, 2017 the entire new Ban takes full effect and the "Bona Fide Relationship" exception expires.

# U.S. Supreme Court Update

October 19, 2017  
State Bar of Georgia  
Atlanta, Georgia

## Short a Justice: The Supreme Court's Per Curiam Decisions

*Hernandez v. Mesa*, 137 S.Ct. 2003 (June 26, 2017)

Presented by:  
Judith M. Barger  
Associate Dean of Academic Administration  
Atlanta's John Marshall Law School

*Hernandez v. Mesa*, involves a tragic cross-border incident in which a United States Border Patrol agent standing on United States soil shot and killed a Mexican national standing on Mexican soil. The three questions presented in the case concern (1) whether the parents of the victim of that shooting may assert claims for damages against the agent under *Bivens*; (2) whether the shooting violated the victim's Fourth Amendment rights; and (3) whether the agent is entitled to qualified immunity on a claim that the shooting violated the victim's Fifth Amendment rights.

**Relevant Background:** Hernandez's parents (the Petitioners) brought claims against Agent Mesa for damages under *Bivens*, alleging that Mesa violated Hernandez's rights under the Fourth and Fifth Amendments. On a rehearing en banc, the Fifth Circuit Court of Appeals unanimously affirmed the District Court's dismissal of petitioners' claims against Mesa. The court first held that petitioners had failed to state a claim for a violation of the Fourth Amendment because Hernandez was a "Mexican citizen who had no 'significant voluntary connection' to the United States" and "was on Mexican soil at the time he was shot." As to petitioners' claim under the Fifth Amendment, the en banc Court of Appeals was "somewhat divided on the question of whether Agent Mesa's conduct violated the Fifth Amendment," but was "unanimous" in concluding that Mesa was entitled to qualified immunity. The en banc Court of Appeals explained that "[n]o case law in 2010, when this episode occurred, reasonably warned Agent Mesa" that "the general prohibition of excessive force applies where the person injured by a U.S. official standing on U.S. soil is an alien who had no significant voluntary

connection to, and was not in, the United States when the incident occurred.” Because the en banc Court of Appeals resolved petitioners’ claims on other grounds, it “did not consider whether, even if a constitutional claim had been stated, a tort remedy should be crafted under *Bivens*.” [citations omitted]

**Holding:** The U.S. Supreme Court vacated the judgment of the Fifth Circuit and remanded for the Court of Appeals to address the *Bivens* claim in light of the Supreme Court’s then-recent decision in *Ziglar v. Abbasi*, 137 S.Ct. 1843 (June 19, 2017), clarifying part of the *Bivens* analysis. In *Bivens*, the Supreme Court “recognized for the first time an implied right of action for damages against federal officers alleged to have violated a citizen’s constitutional rights.” A *Bivens* remedy is not available, however, where there are “special factors counseling hesitation in the absence of affirmative action by Congress.” In *Ziglar*, the Court clarified what constitutes a “special factor counseling hesitation.” Because the Court of Appeals did not have the opportunity to consider how the reasoning and analysis in *Abbasi* might bear on the case, the Supreme Court remanded the case to the Court of Appeals to address the *Bivens* issue in the first instance.

The Supreme Court declined to decide the Fourth Amendment question because it found that the issue was “sensitive and may have consequences that are far reaching” and its consideration might be unnecessary to resolve the case in light of the Court of Appeals’ reconsideration of the *Bivens* issue.

Finally, the Supreme Court held that the Court of Appeals erred in granting Agent Mesa qualified immunity with respect to the *Bivens* claim. The Court of Appeals relied on the fact that Hernandez was “an alien who had no significant voluntary connection to . . . the United States.” However, the Supreme Court found that because Hernandez’s nationality and the extent of his ties to the United States were unknown to Mesa at the time of the shooting, it was error to grant him qualified immunity based on those facts.

### **Dissenting Opinions:**

Justice Thomas filed a dissenting opinion stating that he would have decided the *Bivens* claim, in light of the fact that the parties were asked to fully brief the issue. Given that the case arose in circumstances that were meaningfully different from those in *Bivens*, Justice Thomas would have declined to extend *Bivens* and affirmed the judgment of the Court of Appeals.

Justice Breyer filed a dissenting opinion (in which Justice Ginsburg joined), arguing that the Court should find that the Fourth Amendment applied to Hernandez, and remand the case for consideration of the *Bivens* and qualified immunity questions.

Cite as: 582 U. S. \_\_\_\_ (2017)

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Per Curiam

## SUPREME COURT OF THE UNITED STATES

VIRGINIA, ET AL. v. DENNIS LEBLANC

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED  
STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

No. 16–1177. Decided June 12, 2017

PER CURIAM.

Under the Antiterrorism and Effective Death Penalty Act of 1996 (AEDPA), a state prisoner is eligible for federal habeas relief if the underlying state court merits ruling was “contrary to, or involved an unreasonable application of, clearly established Federal law” as determined by this Court. 28 U. S. C. §2254(d)(1). In this case, the Court of Appeals for the Fourth Circuit held that this demanding standard was met by a Virginia court’s application of *Graham v. Florida*, 560 U. S. 48 (2010). The question presented is whether the Court of Appeals erred in concluding that the state court’s ruling involved an unreasonable application of this Court’s holding.

I

On July 6, 1999, respondent Dennis LeBlanc raped a 62-year-old woman. He was 16 at the time. In 2003, a state trial court sentenced him to life in prison for his crimes. In the 1990’s, Virginia had, for felony offenders, abolished parole that followed a traditional framework. See Va. Code Ann. §53.1–165.1 (2013). As a form of replacement, Virginia enacted its so-called “geriatric release” program, which allows older inmates to receive conditional release under some circumstances. *LeBlanc v. Mathena*, 841 F. 3d 256, 261 (CA4 2016) (citing Va. Code Ann. §53.1–40.01).

Seven years after respondent was sentenced, this Court decided *Graham v. Florida*. *Graham* established that the Eighth Amendment prohibits juvenile offenders convicted of nonhomicide offenses from being sentenced to life with-

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out parole. While a “State is not required to guarantee eventual freedom to a juvenile offender convicted of a nonhomicide crime,” the Court held, it must “give defendants like Graham some meaningful opportunity to obtain release based on demonstrated maturity and rehabilitation.” 540 U. S., at 75. The Court in *Graham* left it to the States, “in the first instance, to explore the means and mechanisms for compliance” with the *Graham* rule. *Ibid*.

Respondent later filed a motion in state trial court—the Virginia Beach Circuit Court—seeking to vacate his sentence in light of *Graham*. The trial court denied the motion. In so doing, it relied on the Supreme Court of Virginia’s decision in *Angel v. Commonwealth*, 281 Va. 248, 704 S. E. 2d 386 (2011). The *Angel* court held that Virginia’s geriatric release program satisfies *Graham*’s requirement of parole for juvenile offenders. The statute establishing the program provides:

“Any person serving a sentence imposed upon a conviction for a felony offense . . . (i) who has reached the age of sixty-five or older and who has served at least five years of the sentence imposed or (ii) who has reached the age of sixty or older and who has served at least ten years of the sentence imposed may petition the Parole Board for conditional release.” §53.1–40.01.

The *Angel* court explained that “[t]he regulations for conditional release under this statute provide that if the prisoner meets the qualifications for consideration contained in the statute, the factors used in the normal parole consideration process apply to conditional release decisions under this statute.” 281 Va., at 275, 704 S. E. 2d, at 402. The geriatric release program thus complied with *Graham*, the *Angel* court held, because it provided “the meaningful opportunity to obtain release based on demonstrated maturity and rehabilitation required by the Eighth

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Amendment.” 281 Va., at 275, 704 S. E. 2d, at 402 (internal quotation marks omitted).

The Virginia Supreme Court, in reviewing the trial court’s ruling in the instant case, summarily denied respondent’s requests for appeal and for rehearing.

In 2012, respondent filed a federal habeas petition in the Eastern District of Virginia pursuant to 28 U. S. C. §2254. A Magistrate Judge recommended dismissing the petition, but the District Court disagreed and granted the writ. The District Court explained that “there is no possibility that fairminded jurists could disagree that the state court’s decision conflicts wit[h] the dictates of *Graham*.” *LeBlanc v. Mathena*, 2015 WL 4042175, \*18 (July 1, 2015).

A divided panel of the Court of Appeals for the Fourth Circuit affirmed, holding that the state trial court’s ruling was an unreasonable application of *Graham*. 841 F. 3d, at 259–260. In the panel majority’s view, Virginia’s geriatric release program did not provide a meaningful opportunity for juvenile nonhomicide offenders to obtain release based on demonstrated maturity and rehabilitation.

Judge Niemeyer dissented. He criticized the majority for “fail[ing] to respect, in any meaningful way, the deference Congress requires federal courts to give state court decisions on postconviction review.” *Id.*, at 275.

The Commonwealth of Virginia petitioned for certiorari. The petition is now granted, and the judgment is reversed: The Virginia trial court did not unreasonably apply the *Graham* rule.

## II

In order for a state court’s decision to be an unreasonable application of this Court’s case law, the ruling must be “objectively unreasonable, not merely wrong; even clear error will not suffice.” *Woods v. Donald*, 575 U. S. \_\_\_\_, \_\_\_\_ (2015) (*per curiam*) (slip op., at 4) (internal quotation marks omitted). In other words, a litigant must “show

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that the state court's ruling . . . was so lacking in justification that there was an error well understood and comprehended in existing law beyond any possibility for fair-minded disagreement." *Ibid.* (internal quotation marks omitted). This is "meant to be" a difficult standard to meet. *Harrington v. Richter*, 562 U. S. 86, 102 (2011).

The Court of Appeals for the Fourth Circuit erred by failing to accord the state court's decision the deference owed under AEDPA. *Graham* did not decide that a geriatric release program like Virginia's failed to satisfy the Eighth Amendment because that question was not presented. And it was not objectively unreasonable for the state court to conclude that, because the geriatric release program employed normal parole factors, it satisfied *Graham's* requirement that juveniles convicted of a non-homicide crime have a meaningful opportunity to receive parole. The geriatric release program instructs Virginia's Parole Board to consider factors like the "individual's history . . . and the individual's conduct . . . during incarceration," as well as the prisoner's "inter-personal relationships with staff and inmates" and "[c]hanges in attitude toward self and others." See 841 F. 3d, at 280–281 (Niemeyer, J., dissenting) (citing Virginia Parole Board Policy Manual 2–4 (Oct. 2006)). Consideration of these factors could allow the Parole Board to order a former juvenile offender's conditional release in light of his or her "demonstrated maturity and rehabilitation." *Graham*, 560 U. S., at 75. The state court thus did not diverge so far from *Graham's* dictates as to make it "so obvious that . . . there could be no 'fairminded disagreement'" about whether the state court's ruling conflicts with this Court's case law. *White v. Woodall*, 572 U. S. \_\_\_, \_\_\_ (2014) (slip op., at 11).

"Perhaps the logical next step from" *Graham* would be to hold that a geriatric release program does not satisfy the Eighth Amendment, but "perhaps not." 572 U. S., at

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\_\_\_\_ (slip op., at 11). “[T]here are reasonable arguments on both sides.” *Id.*, at \_\_\_\_–\_\_\_\_ (slip op., at 11–12). With respect to petitioners, these include the arguments discussed above. *Supra*, at 4. With regards to respondent, these include the contentions that the Parole Board’s substantial discretion to deny geriatric release deprives juvenile nonhomicide offenders a meaningful opportunity to seek parole and that juveniles cannot seek geriatric release until they have spent at least four decades in prison.

These arguments cannot be resolved on federal habeas review. Because this case arises “only in th[at] narrow context,” the Court “express[es] no view on the merits of the underlying” Eighth Amendment claim. *Woods, supra*, at \_\_\_\_ (slip op., at 7) (internal quotation marks omitted). Nor does the Court “suggest or imply that the underlying issue, if presented on direct review, would be insubstantial.” *Marshall v. Rodgers*, 569 U. S. \_\_\_\_, \_\_\_\_ (2013) (*per curiam*) (slip op., at 7); accord, *Woodall, supra*, at \_\_\_\_ (slip op., at 5). The Court today holds only that the Virginia trial court’s ruling, resting on the Virginia Supreme Court’s earlier ruling in *Angel*, was not objectively unreasonable in light of this Court’s current case law.

### III

A proper respect for AEDPA’s high bar for habeas relief avoids unnecessarily “disturb[ing] the State’s significant interest in repose for concluded litigation, den[ying] society the right to punish some admitted offenders, and intrud[ing] on state sovereignty to a degree matched by few exercises of federal judicial authority.” *Harrington, supra*, at 103 (internal quotation marks omitted). The federalism interest implicated in AEDPA cases is of central relevance in this case, for the Court of Appeals for the Fourth Circuit’s holding created the potential for significant discord in the Virginia sentencing process. Before today, Virginia

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courts were permitted to impose—and required to affirm—a sentence like respondent's, while federal courts presented with the same fact pattern were required to grant habeas relief. Reversing the Court of Appeals' decision in this case—rather than waiting until a more substantial split of authority develops—spares Virginia courts from having to confront this legal quagmire.

For these reasons, the petition for certiorari and the motion for leave to proceed *in forma pauperis* are granted, and the judgment of the Court of Appeals is reversed.

*It is so ordered.*

Cite as: 582 U. S. \_\_\_\_ (2017)

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GINSBURG, J., concurring in judgment

**SUPREME COURT OF THE UNITED STATES**

VIRGINIA, ET AL. *v.* DENNIS LEBLANC

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED  
STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

No. 16–1177. Decided June 12, 2017

JUSTICE GINSBURG, concurring in the judgment.

*Graham v. Florida*, 560 U. S. 48 (2010), as today's *per curiam* recognizes, established that a juvenile offender convicted of a nonhomicide offense must have "some meaningful opportunity to obtain release [from prison] based on demonstrated maturity and rehabilitation." *Id.*, at 75. See *ante*, at 2. I join the Court's judgment on the understanding that the Virginia Supreme Court, in *Angel v. Commonwealth*, 281 Va. 248, 704 S. E. 2d 386 (2011), interpreted Virginia law to require the parole board to provide such a meaningful opportunity under the geriatric release program. See *id.*, at 275, 704 S. E. 2d, at 402 ("the factors used in the normal parole consideration process apply to conditional release decisions under this statute"). In other words, contrary to the Fourth Circuit's interpretation of Virginia law, the parole board may not deny a juvenile offender geriatric release "for *any* reason whatsoever," 841 F. 3d 256, 269 (2016) (emphasis in original); instead, the board, when evaluating a juvenile offender for geriatric release, must consider the normal parole factors, including rehabilitation and maturity. See *ante*, at 4.



# Criminal Law Update

## **Presented By:**

### ***B. Michael Mears***

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Atlanta, Georgia



# U.S. Supreme Court Update

**October 19, 2017  
State Bar of Georgia  
Atlanta, Georgia**

## **Criminal Law Update:**

### **CRIMINAL LAW DECISIONS**

**October 2016 Term (Oct. 2016-August 2017)**

**Presented by  
Michael Mears  
Associate Professor of Law  
Atlanta's John Marshall Law School**

## **Introduction**

The Supreme Court's term for 2016 -2017<sup>1</sup> was somewhat uneventful compared to other years when the Court has established considerable case law and directions to both prosecutors and defense lawyers. Last year The Southern Center for Human Rights was at the center of one of the most important cases dealing with race and the

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<sup>1</sup> The material provided in this summary and discussion of the United States Supreme Court's 2016-2017 term has been taken from the various case syllabi, from the official opinions of the Court, and from various commentaries relating to the court decisions for this term of Court. I have also edited and used excerpts from trial transcripts made available to the public on <https://www.oyez.org/cases/2016>. The quotations inserted into the material were taken from the opinions as published by the United States Supreme Court.

death penalty in the *Foster v. Chatman*.<sup>2</sup> This year The Southern Center for Human Rights and its managing attorney were back at the center of perhaps the most significant of criminal case during this past term dealing with the issue of access to an expert mental health witness. Patrick Mulvaney will present an excellent overview of SCHR's role in the case of *McWilliams v. Dunn*.<sup>3</sup>

This brief summary of other significant U.S. Supreme Court cases for the term of court 2016-2017 will deal with only three cases. One involves the issue of the Court equating "ethnicity"<sup>4</sup> and "race,"<sup>5</sup> the other two cases noted here involve ineffective assistance of counsel claims.

## **The Supreme Court Constitutional Issues**

### **Fourteenth Amendment**

#### **(The Supreme Court and Racial Bias)**

#### ***Pena-Rodriguez v. Colorado*, 137 S.Ct. 855 (2017)**

The majority opinion in this case was written by Justice Kennedy and he was joined by Justices Ginsburg, Breyer, Sotomayor, and Kagan. Justice Thomas wrote a dissenting opinion. Justice Alito wrote a separate dissenting opinion and his dissent was joined by Justice Thomas, Justice Roberts. Justice Gorsuch did not participate in this case.

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<sup>2</sup> 136 S.Ct. 1737 (2016)

<sup>3</sup> 582 US \_ (2017)

<sup>4</sup> See, Compact Oxford English Dictionary of Current English, Third Edition, page 341. "Relating to a group of people who have a common national or cultural tradition. Referring to origin by birth rather than by present nationality. Belonging to or characteristic of a non-Western cultural tradition."

<sup>5</sup> See, Compact Oxford English Dictionary of Current English, Third Edition, page 841. "Each of the major divisions of humankind, having distinct physical characteristics. Racial origin or distinction. A group of people sharing the same culture, language, etc; an ethnic group. A group of people or things with a shared feature."

The facts of this case are important enough to report fully. As the majority noted in its opinion, "This case lies at the intersection of the Court's decisions endorsing the no-impeachment rule [of a jury verdict] and its decisions seeking to eliminate racial bias in the jury system. The two lines of precedent, however, need not conflict."

The facts of this case are based upon the prosecutors bringing criminal charges against Pena-Rodriguez. The charges were based on the allegations that in 2007, in the bathroom of a Colorado horse-racing facility, a man sexually assaulted two teenage sisters. The girls told their father and identified the man as an employee of the racetrack. The police located and arrested Pena-Rodriguez. Each girl separately identified Pena-Rodriguez as the man who had assaulted her.

Pena-Rodriguez was charged with harassment, unlawful sexual contact, and attempted sexual assault on a child. Before the jury was empaneled, members of the jury pool were repeatedly asked whether they believed that they could be fair and impartial in the case. A written questionnaire asked if there was "anything about you that you feel would make it difficult for you to be a fair juror." The trial judge repeated the question to the panel of prospective jurors and he encouraged the jurors to speak in private with the court if they had any concerns about their impartiality. Defense counsel likewise asked whether anyone felt that "this is simply not a good case" for them to be a fair juror. None of the empaneled jurors expressed any reservations based on racial or any other bias. And none asked to speak with the trial judge.

After a 3-day trial, the jury found Pena-Rodriguez guilty of unlawful sexual contact and harassment, but it failed to reach a verdict on the attempted sexual assault charge. When the jury was discharged, the court gave them this instruction, as mandated by Colorado law:

"The question may arise whether you may now discuss this case with the lawyers, defendant, or other persons. For your guidance the court instructs you that whether you talk to anyone is entirely your own decision .... If any person persists in discussing the case over your objection, or becomes critical of your service either before or after any discussion has begun, please report it to me."

Following the discharge of the jury, Pena-Rodriguez's counsel entered the jury room to discuss the trial with the jurors. As the room was emptying, two jurors remained to speak with him in private. They stated that, during deliberations, another juror had expressed anti-Hispanic bias toward petitioner and petitioner's alibi witness. The defense attorney reported this to the court and the court allowed defense counsel to obtain sworn affidavits from the two jurors.

The affidavits by the two jurors described a number of biased statements made by another juror, identified as Juror H.C. According to the two jurors, H.C. told the other jurors that he "believed the defendant was guilty because, in [H.C.'s] experience as an ex-law enforcement officer, Mexican men had a bravado that caused them to believe they could do whatever they wanted with women." The jurors reported that H.C. stated his belief that Mexican men are physically controlling of women because of their sense of entitlement, and further stated, " I think he did it because he's Mexican and Mexican men take whatever they want." According to the jurors, H.C. further explained that, in his experience, "nine times out of ten Mexican men were guilty of being aggressive toward women and young girls." Finally, the jurors recounted that Juror H.C. said that he did not find petitioner's alibi witness credible because, among other things, the witness was " an illegal." (In fact, the witness testified during trial that he was a legal resident of the United States.)

Although race seemed to be a central focus throughout the lower court opinions and the trial court's concerns, the United States Supreme Court quickly conflated race and ethnicity into one category! The Court noted that the statement exhibiting the jurors' bias was based on Pena-Rodriguez's Hispanic identity. The Court noted that in prior decisions the Court itself had referred to ethnicity and race as one issue. "Yet we have also used the language of race when discussing the relevant constitutional principles in cases involving Hispanic persons." The Court also noted that Pena-Rodriguez and the State of Colorado both referred to race, or to race and ethnicity, in this more expansive sense in their briefs to the Court." The Court then noted that its opinion refers to the nature of the bias as racial in keeping with the primary terminology employed by the parties and used in our precedents."

The Court majority began its opinion by noting that "[t]he jury is a central foundation of our justice system and our democracy. Whatever its imperfections in a

particular case, the jury is a necessary check on governmental power. The jury, over the centuries, has been an inspired, trusted, and effective instrument for resolving factual disputes and determining ultimate questions of guilt or innocence in criminal cases. Over the long course its judgments find acceptance in the community, an acceptance essential to respect for the rule of law. The jury is a tangible implementation of the principle that the law comes from the people.”

The Court then referred to the Federalist Papers in construing the continuing and evolving right to a jury trial. The Court noted that “[I]n the era of our Nation’s founding, the right to a jury trial already had existed and evolved for centuries, through and alongside the common law. The jury was considered a fundamental safeguard of individual liberty.” The majority then reminded us that “[B]y operation of the Fourteenth Amendment, it is applicable to the States citing its decision in *Duncan v. Louisiana*.

The court, leading up to its holding in this case, noted that “[L]ike all human institutions, the jury system has its flaws, yet experience shows that fair and impartial verdicts can be reached if the jury follows the court’s instructions and undertakes deliberations that are honest, candid, robust, and based on common sense. A general rule has evolved to give substantial protection to verdict finality and to assure jurors that, once their verdict has been entered, it will not later be called into question based on the comments or conclusions they expressed during deliberations. This principle, itself centuries old, is often referred to as the no-impeachment rule. The instant case presents the question whether there is an exception to the no-impeachment rule when, after the jury is discharged, a juror comes forward with compelling evidence that another juror made clear and explicit statements indicating that racial animus was a significant motivating factor in his or her vote to convict.”

The trial judge had reviewed the affidavits and even acknowledged that the comments by the jurors showed apparent bias. However, the the trial judge noted that he had to deny Pena-Rodriguez a new trial on the basis that “[t]he actual deliberations that occur among the jurors are protected from inquiry under Colorado law. In other words, the jury’s verdict could not be impeached. The trial court then sentenced Pena-Rodriguez to two years probation and ordered that he register as a sex offender.

Colorado law generally prohibits a juror from testifying as to any statement made during deliberations in a proceeding inquiring into the validity of the verdict. This is very similar to Federal Rule of Evidence 606(b). (See also, Ga. Code Ann., §24-6-606(b) which essentially mirrors the federal rule.) The Colorado Rule reads as follows:

"(b) Inquiry into validity of verdict or indictment. Upon an inquiry into the validity of a verdict or indictment, a juror may not testify as to any matter or statement occurring during the course of the jury's deliberations or to the effect of anything upon his or any other juror's mind or emotions as influencing him to assent to or dissent from the verdict or indictment or concerning his mental processes in connection therewith. But a juror may testify about (1) whether extraneous prejudicial information was improperly brought to the jurors' attention, (2) whether any outside influence was improperly brought to bear upon any juror, or (3) whether there was a mistake in entering the verdict onto the verdict form. A juror's affidavit or evidence of any statement by the juror may not be received on a matter about which the juror would be precluded from testifying." Colo. Rule Evid. 606(b) (2016).

The majority opinion then noted that "[S]ome version of the no-impeachment rule is followed in every State and the District of Columbia. Variations make classification imprecise, but, as a general matter, it appears that 42 jurisdictions follow the Federal Rule, while 9 follow the Iowa Rule. Within both classifications there is a diversity of approaches. Nine jurisdictions that follow the Federal Rule have codified exceptions other than those listed in Federal Rule 606(b)." The majority then noted that "at least 16 jurisdictions, 11 of which follow the Federal Rule, have recognized an exception to the no-impeachment bar under the circumstances the Court faces here: juror testimony that racial bias played a part in deliberations. According to the parties and amici, only one State other than Colorado has addressed this issue and declined to recognize an exception for racial bias.

The somewhat remarkable language in the majority opinion then goes on to state that it is "the heritage of our Nation to rise above racial classifications that are so

inconsistent with our commitment to the equal dignity of all persons. This imperative to purge racial prejudice from the administration of justice was given new force and direction by the ratification of the Civil War Amendments."

"[T]he central purpose of the Fourteenth Amendment was to eliminate racial discrimination emanating from official sources in the States." In the years before and after the ratification of the Fourteenth Amendment, it became clear that racial discrimination in the jury system posed a particular threat both to the promise of the Amendment and to the integrity of the jury trial. "Almost immediately after the Civil War, the South began a practice that would continue for many decades: All-white juries punished black defendants particularly harshly, while simultaneously refusing to punish violence by whites, including Ku Klux Klan members, against blacks and Republicans."

"To take one example, just in the years 1865 and 1866, all-white juries in Texas decided a total of 500 prosecutions of white defendants charged with killing African-Americans. All 500 were acquitted. The stark and unapologetic nature of race-motivated outcomes challenged the American belief that the jury was a bulwark of liberty," and prompted Congress to pass legislation to integrate the jury system and to bar persons from eligibility for jury service if they had conspired to deny the civil rights of African-Americans."

The majority, sounding like "an activist court" then held that it "[t]he duty [of the courts] to confront racial animus in the justice system is not the legislature's alone. Time and again, this Court has been called upon to enforce the Constitution's guarantee against state-sponsored racial discrimination in the jury system. Beginning in 1880, the Court interpreted the Fourteenth Amendment to prohibit the exclusion of jurors on the basis of race."

Finally after asserting the profound duty to prevent racial bias and animus in the justice system, the Court side stepped offering any procedures by which racial bias and prejudice can be ascertained and prevented. The Court held that it "need not address what procedures a trial court must follow when confronted with a motion for a new trial based on juror testimony of racial bias or the appropriate standard for determining when such evidence is sufficient to require that the verdict be set aside and a new trial be granted. Standard and existing safeguards may also help prevent racial bias in jury deliberations, including careful voir dire and a trial court's instructions to jurors about

their duty to review the evidence, deliberate together, and reach a verdict in a fair and impartial way, free from bias of any kind.”

The Court then held that “[W]hen a juror makes a clear statement indicating that he or she relied on racial stereotypes or animus to convict a criminal defendant, the Sixth Amendment requires that the no-impeachment rule give way in order to permit the trial court to consider the evidence of the juror's statement and any resulting denial of the jury trial guarantee.

## **Sixth Amendment**

### **Ineffective Assistance of Counsel**

#### **DAVILA v. DAVIS, 582 U.S. \_\_\_(2017)**

The majority opinion in this case, denying relief to a Texas death row inmate, was written by Justice Thomas and he was joined in that majority opinion by Chief Justice Roberts, and Justices Kennedy, Alito, and Gorsuch. Justice Breyer filed a dissenting opinion and was joined in that dissent by Justices Ginsburg, Sotomayor, and Kagan.

The facts of this case, in summary form, are that in 2009, Erick Daniel Davila was tried and found guilty of capital murder for the killings of Annette Stevenson and her granddaughter, Queshawn Stevenson. Based upon the finding of guilt in a capital murder, the jury sentenced Davila to death. After the denial of his statutory appeals and an exhaustion of his appeal remedies he sought relief from his death sentence by filing a state habeas which was denied at the trial and appellate levels. Davila then sought federal habeas relief and claimed, among other things, that he received ineffective assistance of trial counsel, appellate counsel, and state habeas counsel. Because Davila did not raise the ineffective assistance of appellate counsel claim in the state habeas proceedings, the federal district court held that the claim was procedurally defaulted and denied habeas relief. Davila appealed and argued that previous rulings of the Court that ineffective state habeas counsel can overcome the procedural default of an ineffective assistance of trial counsel claim should also apply to the procedural default of

claims of ineffective assistance of appellate counsel. The Supreme Court refused to extend that ability to overcome a procedural default claim to appellate counsel. Thereby denying relief to Davila.

The Court declined to extend the equitable rule announced in previous cases to claims of ineffective assistance of appellate counsel. "In Davila's case, his trial lawyer had objected to an improper jury instruction, but both his direct appeal lawyer and his state habeas lawyer failed to present the issue to the state courts. Ordinarily, a defendant's failure to have raised a claim before the state's highest court prevents him from later obtaining review of that claim in federal court. The Supreme Court has previously held, however, in *Martinez v. Ryan*,<sup>6</sup> that this procedural bar to federal review can be overcome for claims of ineffective assistance of counsel at trial if the defendant can show that his failure to raise that claim was a product of ineffective representation by his lawyer during state post-conviction proceedings. Davila asked the Supreme Court to determine whether this procedural bar also can be overcome when a state post-conviction lawyer ineffectively fails to raise a meritorious claim that direct appeal counsel had been ineffective. In other words, the issue was whether a federal habeas court is permitted to review a state prisoner's claim, never presented to the state courts, that his direct appeal lawyer had provided ineffective representation but the post-conviction lawyer's failure to raise the issue also was ineffective."

In denying Davila's request that his trial counsel's failures, the court held that the Court's previous extensions of the default claim relief does not extend to claims of appellate counsel's ineffectiveness. In holding as it did, the Court, in effect, has set up a rule that prevents federal courts from reviewing (and therefore granting relief on) a meritorious claim if appellate counsel failed to raise the claim and post-conviction counsel failed to challenge appellate counsel's ineffectiveness. Among the reasons which the Court provided was that to expand the default claims as Davila requested would put a burden "upon the system by "flood[ing] the federal courts" with such claims and the "intrus[ion] on state sovereignty" by disrupting a conviction and sentence..

Justice Breyer, in his dissent, pointing out that "[t]he fact that ... nearly a third of convictions or sentences in capital cases are overturned at some stage of review suggests

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<sup>6</sup> 566 U. S. 1. (2012)

the practical importance of the appeal right, particularly in a capital case such as this one.” The dissent, disagreeing with the majority’s concern that the federal courts would be overburdened, said that “there is no evidence before us that Martinez has produced a greater-than-expected increase in courts’ workload.” Specifically, the dissent pointed out that Texas provided empirical evidence that the Ninth Circuit (which has applied such claims to ineffective-assistance-of-appellate-counsel claims since late 2013) has had “dozens” of federal habeas case applying the new rule. But there have been 7,500 state prisoners who have filed habeas petitions during that time, and such an increase was “not significant enough” according to the dissent, “to warrant depriving a prisoner of any forum to adjudicate a substantial claim that he was deprived of his constitutional right to effective assistance of appellate counsel.” In the dissent’s view, “[t]he basic legal principle that should determine the outcome of this case is the principle that requires courts to treat like cases alike.”

## **Sixth Amendment**

### **Ineffective Assistance of Counsel**

#### **Lee v. United States, 582 US \_\_ (2017)**

The majority opinion in this case was written by Chief Justice Roberts and his opinion was joined by Justices Kennedy, Ginsburg, Breyer, Sotomayor, and Kagan. Justice Thomas wrote a dissenting opinion and that dissent was joined, in part, by Justice Alito. Justice Gorsuch took no part in the consideration or decision of the case.

In this case, the Court had to decide whether or not a decision to plead guilty could be set aside on the basis of ineffective assistance of counsel as articulated in the *Stickland v. Washington*,<sup>7</sup> which requires an application of a two prong test. In this case, the first prong being unprofessional advice and the second prong a showing that but for the unprofessional advice the results of the case would have reasonably been different.

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<sup>7</sup>466 U.S. 668 (1984)

The facts of the case are that Jae Lee came to the United States from South Korea with his family in 1982 and has lived in the United States legally ever since, though he did not become a citizen. He eventually moved to Memphis, Tennessee, where he got involved in the drug trade. In 2009, after a successful sting operation, Lee was arrested and charged with possession of ecstasy with intent to distribute. The government's case against Lee was very strong, and on the advice of his attorney, Lee pled guilty in exchange for a lighter sentence. Lee's attorney had assured him that the guilty plea would not have immigration consequences; however, Lee's guilty plea constituted a conviction of an aggravated felony, which is a deportable offense under the Immigration and Nationality Act. Lee subsequently appealed his conviction and argued that he had received ineffective assistance of counsel under the standard established in *Strickland v. Washington*, which provides for a two-pronged test: whether the attorney's counsel was deficient and whether the deficiency prejudiced the defendant. The U.S. Court of Appeals for the Sixth Circuit upheld Lee's conviction and determined that Lee could not satisfy the second prong of the *Strickland* test because there was not sufficient evidence that the outcome of Lee's case would have been substantially different had he known about the risk of deportation.

The Court held, that Lee had established that he was prejudiced by erroneous advice, demonstrating a "reasonable probability that, but for counsel's errors, he would not have pleaded guilty and would have insisted on going to trial." The Court stated that the inquiry demands a "case-by-case examination." A defendant's decision making may not turn solely on the likelihood of conviction after trial. When the inquiry is focused on what an individual defendant would have done, the possibility of even a highly improbable result may be pertinent to the extent it would have affected the defendant's decision making.

The Court reasoned that it could not say that it would be irrational for someone in Lee's position to risk additional prison time in exchange for holding on to some chance of avoiding deportation.

## Conclusion

The following criminal cases were received by the Court and decisions are pending.

### **Timothy Ivory Carpenter v. United States on appeal from the Sixth Circuit.<sup>8</sup>**

This is a case in which the Court will determine whether the warrantless seizure and search of cell phone records revealing the location and movements of a cell phone user over the course of 127 days violates the Fourth Amendment.

In April 2011, police arrested four men in connection with a series of armed robberies. One of the men confessed to the crimes and gave the FBI his cell phone number and the numbers of the other participants. The FBI used this information to apply for three orders from magistrate judges to obtain "transactional records" for each of the phone numbers, which the judges granted under the Stored Communications Act, 18 U.S.C. 2703(d). That Act provides that the government may require the disclosure of certain telecommunications records when "specific and articulable facts show[] that there are reasonable grounds to believe that the contents of a wire or electronic communication, or the records or other information sought, are relevant and material to an ongoing criminal investigation." The transactional records obtained by the government include the date and time of calls, and the approximate location where calls began and ended based on their connections to cell towers—"cell site" information.

Based on the cell-site evidence, the government charged Timothy Carpenter with, among other offenses, aiding and abetting robbery that affected interstate commerce, in violation of the Hobbs Act, 18 U.S.C. 1951. Carpenter moved to suppress the government's cell-site evidence on Fourth Amendment grounds, arguing that the FBI needed a warrant based on probable cause to obtain the records. The district court denied the motion to suppress, and the Sixth Circuit affirmed.

The case has not been argued yet.

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<sup>8</sup> Docket Number 16-424

## **Rodney Class v. United States, United States Court of Appeals for the District of Columbia Circuit<sup>9</sup>**

This is a case in which the Court will decide whether a guilty plea inherently waives a defendant's right to challenge the constitutionality of his conviction.

In May 2013, Rodney Class was arrested in the District of Columbia for possession of three firearms on United States Capitol Grounds in violation of 40 U.S.C. §5104(e). Class, representing himself, pleaded guilty in the district court. He appealed to the U.S. Court of Appeals for the District of Columbia Circuit on grounds of constitutional error and statutory error. The appellate court affirmed the judgment of the district court and found Class guilty due to his guilty plea. The appellate court explained that the its precedent in *United States v. Delgado-Garcia*--which held that, "[u]nconditional guilty pleas that are knowing and intelligent...waive the pleading defendant[s] claims of error on appeal, even constitutional claims"--is binding on this case. *Delgado* articulates two exceptions to this rule in which a defendant may appeal: (1) "the defendant's claimed right to not be haled into court at all" and (2) "that the court below lacked subject-matter jurisdiction over the case..." However, the court held that neither exception applies here.

The oral arguments have been completed in this case and an opinion is awaiting.

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<sup>9</sup> Docket Number 16-402

No. 16-5294

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IN THE  
Supreme Court of the United States

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JAMES EDMOND MCWILLIAMS, JR.,

*Petitioner,*

v.

JEFFERSON S. DUNN, COMMISSIONER, ALABAMA  
DEPARTMENT OF CORRECTIONS, *et al.*,

*Respondents.*

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**ON WRIT OF CERTIORARI TO THE UNITED STATES  
COURT OF APPEALS FOR THE ELEVENTH CIRCUIT**

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**BRIEF OF PETITIONER**

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### STATEMENT OF THE CASE

The Alabama judge who sentenced James McWilliams to death did not find a single mitigating circumstance to weigh against three aggravating circumstances. However, two days before sentencing, the parties and the court received a neuropsychologist's assessment reporting that McWilliams had "organic brain dysfunction." T. 1634.<sup>1</sup> The assessment found that McWilliams had "genuine neuropsychological problems" and an "obvious neuropsychological deficit," which included "cortical dysfunction attributable to right cerebral hemisphere dysfunction" indicative of a "right hemisphere lesion." T. 1634-36.

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1. "T." refers to the certified trial record, which can be found in Volumes 1-10 of the state court record as filed in the district court. *See* D. Ct. Doc. 12 (Dec. 17, 2004) (Resp't's Habeas Corpus Checklist). "P.C.R." refers to the clerk's record from the state post-conviction proceedings; "P.C.T." refers to the certified court reporter's transcript from the state post-conviction hearing. The clerk's record and court reporter's transcript from the state post-conviction proceedings can be found in Volumes 16-38 of the state court record as filed in the district court. *See* Doc. 12. The remaining volumes of the state court record contain appellate briefing and opinions.

The day before the judicial sentencing hearing, all parties received McWilliams's updated records from the state mental hospital. The following morning, just prior to the hearing, all parties received records from the state prison where McWilliams was being held, which showed that he was being treated with psychotropic medication. Defense counsel had subpoenaed the prison records approximately two months earlier, but did not receive them until moments before the hearing. Defense counsel repeatedly sought a continuance in order to consult with an independent defense expert about the neuropsychological assessment and the records so as to understand and interpret them and then to fashion a mitigation case based on the evidence of McWilliams's mental disorders and impairments. Consultation with an expert also would have provided defense counsel with an opportunity to rebut the testimony of the State's experts from a previous sentencing hearing before a jury that McWilliams had no real mental impairment and that he had malingered on his psychological tests. The judge denied the motions and sentenced McWilliams to death. In imposing that sentence, the judge concluded that McWilliams had faked the answers on his psychological tests and on that basis found no mitigating circumstances.

McWilliams argued on appeal that he was denied his right to independent expert assistance under *Ake v. Oklahoma*, 470 U.S. 68 (1985). Affirming the death sentence, the Alabama Court of Criminal Appeals held that *Ake* did not entitle McWilliams to anything more than the views of the psychologist who reported simultaneously to the prosecution, the defense, and the judge. J.A. 106a.

### **A. Trial and Sentencing Before the Jury**

McWilliams was charged with the rape and murder of Patricia Reynolds, which occurred during the robbery of a convenience store in Tuscaloosa, Alabama, on December 30, 1984. T. 1646-47. The trial court found him indigent and appointed counsel to represent him. T. 1440-41. Prior to trial, the defense filed a “Petition for Inquisition Upon Alleged Insane Prisoner,” T. 1526, and, in response, the court ordered that McWilliams be sent to the Taylor Hardin Secure Medical Facility, a state hospital, for examination. A “Lunacy Commission” was convened to conduct the evaluation and found that McWilliams was competent to stand trial, that he was sane at the time of the crime, and that there “seem[ed] to be no mitigating circumstances involved” in the case. T. 1544-47.

McWilliams was convicted of capital murder on August 26, 1986. T. 1292. The sentencing hearing before the jury began the following day, and testimony lasted less than three hours. T. 1294-95, 1370. The prosecution reintroduced its evidence from the guilt phase, T. 1297, and also called a police officer to testify that McWilliams had a prior conviction, T. 1299-1303.

The defense called McWilliams and his mother. Both testified about head injuries McWilliams suffered as a child and the headaches, doctor visits, and medications that followed. T. 1303-18, 1320-35. McWilliams also testified that he had been seen by several psychiatrists and psychologists both before his arrest and after it while in state custody. T. 1321-27. He then read from the report of a psychologist who had evaluated him prior to his arrest; the report stated that he had a “blatantly

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psychotic thought disorder," T. 1330, and needed inpatient treatment, T. 1331-32. When the prosecutor questioned McWilliams about the neurological effects of his head injuries, McWilliams replied, "I am not a psychiatrist." T. 1328. The prosecutor also pressed McWilliams's mother:

Q: You are not saying James is crazy, are you?

A: I am no expert: I don't know whether my son is crazy or not. All I know, that my son do need help.

\* \* \*

A: I said that I believe my son needs help, professional help: the help that I cannot give him.

T. 1317-18. Defense counsel had subpoenaed McWilliams's mental health records from Holman Prison on August 13, to be delivered by August 25, T. 1618, but the prison did not produce them, so the defense presented no additional evidence, T. 1319.

In rebuttal, the State presented the testimony of a psychiatrist and a psychologist from the state mental hospital. T. 1336-1369. The psychiatrist, Dr. Kamal Nagi, who was a member of the Lunacy Commission, testified that he found no evidence of psychosis. T. 1340. In support of that finding, he said that two Minnesota Multiphasic Personality Inventory assessments ("MMPIs") were performed on McWilliams. T. 1353. He then backtracked, saying that a second test was recommended, but he was not sure if it was given. T. 1353-55. He ultimately stated

that only one MMPI was done, but not by him, and he volunteered that “the results were faked bad.” T. 1354. He also testified that observation and interviewing are “more important than psychological testing,” T. 1355, yet he was unaware of McWilliams’s history of head trauma, T. 1351-52.

Dr. Norman Poythress, a psychologist who signed the final report issued by the Lunacy Commission, testified that the MMPI administered to McWilliams by a graduate student at the state hospital was “clinically invalid” because the test’s “validity scales” indicated that McWilliams had not been candid in his responses. T. 1361-64. Dr. Poythress testified that a second test was not given. T. 1365.

Ten jurors voted for a death sentence—the minimum required for a death recommendation under Alabama law. *See* Ala. Code § 13A-5-46(f) (1981). The other two jurors voted for a sentence of life in prison without parole. T. 1400. A judicial sentencing hearing was scheduled for October 9, 1986.

## **B. Judicial Sentencing Hearing**

Prior to the judicial sentencing hearing, which is required by Alabama law,<sup>2</sup> defense counsel filed a motion for neuropsychological testing of McWilliams, T. 1615, as well as a motion to require the Department of Corrections

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2. Because the jury’s recommendation was not binding on the judge, the court was required to hold a separate judicial sentencing proceeding and impose sentence. Ala. Code §§ 13A-5-45 to -47 (1981).

to show cause as to why it should not be held in contempt for failing to produce McWilliams's mental health records, which had been subpoenaed in August but still had not been produced, T. 1618. The court granted both motions, T. 1612-13, but McWilliams's counsel did not receive the results of the neuropsychological testing until October 7, 1986—just two days before the judicial sentencing hearing—and did not receive the prison records until the morning of the sentencing. T. 1631-32; J.A. 191a-193a.

On the afternoon of October 7, an assessment prepared by Dr. John Goff, who, like Dr. Nagi and Dr. Poythress, worked for the state's Department of Mental Health, was distributed to the court and the prosecution as well as the defense. T. 1631. According to the report, Dr. Goff found that McWilliams had "organic brain dysfunction which is localized to the right cerebral hemisphere." T. 1634. More specifically, McWilliams suffered from "cortical dysfunction attributable to right cerebral hemisphere dysfunction," which manifested in "left hand weakness, poor motor coordination of the left hand, sensory deficits including suppressions of the left hand and very poor visual search skills." T. 1636. These deficits were "suggestive of a right hemisphere lesion," T. 1635, and were "compatible with the injuries [McWilliams] says he sustained as a child," T. 1635. Accordingly, Dr. Goff concluded that McWilliams had "genuine neuropsychological problems" and an "obvious neuropsychological deficit." T. 1635.

Counsel also did not receive McWilliams's updated records from the state mental hospital until the day before sentencing, and they did not receive the Holman Prison records until they arrived to court on the morning of the sentencing hearing. J.A. 191a-193a. The prison records indicated that McWilliams was "on an assortment

of drugs that were prescribed for him by the prison authorities," J.A. 190a, including Desyrel, Librium, and the antipsychotic Mellaril. J.A. 190a-191a.

When the sentencing hearing began, McWilliams's counsel informed the judge that due to the late arrival of the report and records, he needed time to "have someone else review these findings." J.A. 193a. He stated, "[I]t is just incumbent upon me to have a second opinion as to the severity of the organic problems discovered," J.A. 196a, that is, an opinion other than the one produced by the neutral expert Dr. Goff. In support of his request, counsel explained that he could not understand and meaningfully present the information he had just received, as Dr. Goff's neuropsychological testing was sophisticated<sup>3</sup> and the records were lengthy and technical.<sup>4</sup> J.A. 190a-196a.

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3. Dr. Goff reported that he relied upon the Halstead-Reitan Neuropsychological Test Battery, which consisted of seven tests, as well as the Wechsler Adult Intelligence Scale-Revised (WAIS-R), the Halstead-Wepman Aphasia Screening Test, the Trail-Making Test, and the Wechsler Memory Scale (WMS). T. 1633. Dr. Goff also had another MMPI administered, T. 1633, but he found that "[p]ersonality assessment via the MMPI was not possible." T. 1635. He indicated that the MMPI results were invalid due to either a "cry-for-help" response set or a "fake-bad." T. 1635.

4. The receipt accompanying the delivery of the records from the state hospital to the court clerk on October 8, 1986, indicates that the records spanned 1233 pages. P.C.R. 2983. Some of those were likely duplicates of records previously disclosed, but any records pertaining to Dr. Goff's evaluation of McWilliams—which spanned at least 88 pages, P.C.R. 2897-2984—would have been new to counsel. In addition, counsel also received the Holman Prison records on the morning of sentencing. Defense counsel made clear that the two sets of documents were too voluminous to review that morning. *See* J.A. 206a ("there is no way that I can go through this material").

In response, the judge stated, “All right. Well, let’s proceed.” J.A. 197a. The prosecution presented the testimony of the probation officer who prepared a pre-sentence investigation report and introduced the report into evidence. J.A. 198a-203a. The judge made the records from the state hospital, the prison records, and Dr. Goff’s report part of the record even though Dr. Goff did not testify and no one explained his assessment or the records. J.A. 205a, 207a.<sup>5</sup> The judge recessed at approximately 10:40 a.m., indicating that defense counsel could review the records before pronouncement of sentence at 2:00 p.m. J.A. 205a-206a. In response, counsel reiterated that there was “no way” he could go through all the material in that amount of time. J.A. 206a.

During the recess, counsel filed a motion to withdraw, arguing that “the arbitrary [sic] position taken by this Court regarding the Defendant’s right to present mitigating circumstances is unconscionable resulting in this proceeding being a mockery.” T. 1644. The motion was denied. T. 1644.

When court resumed, defense counsel stated:

[W]e cannot determine ourselves from the records that we have received and the lack of receiving the test and the lack of our own expertise, whether or not such a condition

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5. Although they were admitted and made part of the record, neither the Holman Prison records nor the majority of the records from the state hospital—except for the 88 pages pertaining to Dr. Goff’s assessment—are included in the state court record that was filed in the district court and is now part of the record before this Court. *See* P.C.R. 1938.

exists; whether the reports and tests that have been run by Taylor Hardin, and the Lunacy Commission, and at Holman are tests that should be challenged in some type of way or the results should be challenged, we really need an opportunity to have the right type of experts in this field, take a look at all of those records and tell us what is happening with him. And that is why we renew the Motion for a Continuance.

J.A. 207a. The motion was denied. J.A. 207a.

The prosecutor then gave his closing argument, stating that there were “no mitigating circumstances” to weigh against the aggravating circumstances. J.A. 209a. Defense counsel followed, beginning, “I would be pleased to respond to Mr. Freeman’s remarks that there are no mitigating circumstances in this case if I were able to have time to produce any mitigating circumstances.” J.A. 210a. Moments later, defense counsel concluded, “The Court has foreclosed[,] by structuring this hearing as it has, the Defendant from presenting any evidence of mitigation in psychological--psychiatric terms.” J.A. 211a.

The trial judge stated that he had reviewed the mental health records during the break and found passages indicating that McWilliams was faking and manipulative and that there was no evidence of psychosis. J.A. 211a. Defense counsel reiterated, “I told Your Honor that my looking at those records was not of any value to me; that I needed to have somebody look at those records who understood them, who could interpret them for me. Did I not tell Your Honor that?” J.A. 211a. When the judge replied that he would have given the defense

“the opportunity to make a motion,” J.A. 212a, counsel responded, “Your Honor gave me no time in which to do that. Your Honor told me to be here at 2 o'clock this afternoon. Would Your Honor have wanted me to file a Motion for Extraordinary Expenses to get someone?” J.A. 212a. The trial judge responded, “I want you to approach with your client, please.” J.A. 212a. He then sentenced McWilliams to death. J.A. 214a.

In a written sentencing order, the judge found three aggravating circumstances<sup>6</sup> and no mitigating circumstances because “the preponderance of the evidence from these tests and reports show the defendant to be feigning, faking, and manipulative.” J.A. 188a. With regard to the records from the state hospital and prison—which were unexplained by an expert or anyone else, but indicated that McWilliams was being administered antipsychotic medication—the judge stated that McWilliams “was not and is not psychotic.” J.A. 188a.

### **C. State Appellate and Post-Conviction Proceedings**

On appeal, McWilliams argued to the Alabama Court of Criminal Appeals that he was denied his due process right to meaningful expert assistance under *Ake v. Oklahoma*, 470 U.S. 68 (1985). Appellant's Br. at 47-52 (Vol. 11, Tab #R-33). In his brief, McWilliams stated:

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6. The trial court found that McWilliams was previously convicted of another felony offense involving violence to a person, that the murder was committed during the commission of a rape and robbery, and that the offense was especially heinous, atrocious, or cruel compared to other capital cases. J.A. 182a-184a.

Defense counsel received Dr. Goff's written report less than two days before the sentencing hearing. He did not understand it, but he sensed that it was sufficiently favorable to merit further investigation. Counsel advised the Court that he lacked the expertise to interpret the highly technical report. He explained that Dr. Goff's findings appeared to conflict with the findings of the Taylor Hardin experts. Counsel literally begged the Court for an opportunity to consult with an expert who could explain the report to him. The Court refused to allow this.

Appellant's Br. at 48-49. McWilliams added that the accuracy of the sentencing proceeding would have been "'dramatically enhanced' if counsel had the assistance of an expert to help him 'translate a medical diagnosis into language' that the court would have understood." Appellant's Br. at 49 (quoting *Ake*, 470 U.S. at 80, 83). The Court of Criminal Appeals affirmed, holding that *Ake* is satisfied "when the State provides the [defendant] with a competent psychiatrist." J.A. 106a.

McWilliams sought certiorari review in the Alabama Supreme Court, arguing that *Ake* "prohibits granting neuropsychological testing but denying an expert to assist the defense with understanding and presenting the test results." Pet'r's Br. at 37 (Vol. 13, Tab #R-38). The Alabama Supreme Court affirmed without addressing the *Ake* issue. *Ex parte McWilliams*, 640 So. 2d 1015 (Ala. 1993).

McWilliams filed a petition for post-conviction relief pursuant to Rule 32 of the Alabama Rules of Criminal

Procedure, raising a number of issues. Among the witnesses who testified at a hearing on the petition was Dr. George Woods, a psychiatrist, who explained that one possibility for high scores on certain MMPI scales is, in fact, "that a person is just so pathologically disturbed that their testing brings that out, and so you see a number of elevations, you see a number of areas, where they are pathologically disturbed." P.C.T. 941. An elevated scale can also reflect that a person has exaggerated certain responses but is still mentally ill. P.C.T. 940-42. The Alabama courts denied post-conviction relief. P.C.R. 1775-1828.<sup>7</sup>

#### **D. Federal Habeas Proceedings**

McWilliams then sought relief in the federal courts pursuant to 28 U.S.C. § 2254. In the United States District Court for the Northern District of Alabama, he argued that he was denied his Fourteenth Amendment right to due process of law because he did not receive the assistance of an independent expert required by *Ake*. D. Ct. Doc. 1 at 96-99 (Oct. 6, 2004). The magistrate judge, in his report and recommendation that was later accepted by the district court, ruled that the appointment of Dr. Goff satisfied *Ake* and, as such, the decision of the Alabama Court of Criminal Appeals was not an unreasonable application of "clearly established Federal law" under 28 U.S.C. § 2254(d)(1). J.A. 90a.

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7. The denial of the post-conviction petition was affirmed on appeal, and the Alabama Supreme Court denied certiorari. *McWilliams v. State*, 897 So. 2d 437 (Ala. Crim. App. 2004).

The Court of Appeals for the Eleventh Circuit affirmed in a per curiam decision with one judge concurring and one judge dissenting. J.A. 19a-63a. The court found that McWilliams had received the constitutionally required expert assistance by being provided Dr. Goff's report two days before the judicial sentencing hearing. J.A. 33a-36a. The court also suggested that defense counsel could have contacted Dr. Goff, even though he was also available to the prosecution, and called him as a witness, even without understanding his assessment. J.A. 35a. It stated:

Nothing in the record suggests that Dr. Goff lacked the requisite expertise to examine McWilliams and generate a report. While Dr. Goff provided the report to McWilliams only a few days before the sentencing hearing, McWilliams could have called Dr. Goff as a witness or contacted him prior to the completion of the report to ask for additional assistance. McWilliams's failure to do so does not render Dr. Goff's assistance deficient. Moreover, the report was admitted into evidence and considered by the court at sentencing, demonstrating the defense utilized Dr. Goff's assistance. Thus, the State provided McWilliams access to a competent psychiatrist, and McWilliams relied on the psychiatrist's assistance.

J.A. 35a. The court held that the denial of an expert was not contrary to or an unreasonable application of "clearly established Federal law" because although some circuits "have held that the state must provide a non-neutral mental health expert to satisfy *Ake*," in other jurisdictions, "a court-appointed neutral mental health expert made available to all parties may satisfy *Ake*." J.A. 34a.

Judge Wilson dissented, finding that “the state court’s resolution of McWilliams’s *Ake* claim was an unreasonable application of *Ake* itself and this error had a substantial and injurious effect.” J.A. 63a. He explained:

Although his life was at stake and his case for mitigation was based on his mental health history, McWilliams received an inchoate psychiatric report at the twelfth hour and was denied the opportunity to utilize the assistance of a psychiatrist to develop his own evidence. As a result, McWilliams was precluded from meaningfully participating in the judicial sentencing hearing and did not receive a fair opportunity to rebut the State’s psychiatric experts. Put simply, he was denied due process.

J.A. 58a-59a. In response to the suggestion that defense counsel could have consulted with Dr. Goff, Judge Wilson observed that Dr. Goff could not possibly provide the kind of expert assistance contemplated by *Ake* because he was free to “cross the aisle and disclose to the State the future cross-examination of defense counsel.” J.A. 57a.<sup>8</sup>

This Court granted certiorari to address the question of whether *Ake* clearly established that an indigent defendant who makes a threshold showing that mental health issues will be a significant factor at trial has a right to a mental health expert who is independent of the prosecution.<sup>9</sup>

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8. McWilliams presented his *Ake* claim again in a request for rehearing. That request was denied on February 16, 2016. J.A. 17a-18a.

9. There is no question that McWilliams’s mental health was a “significant factor” in the case. *See Ake*, 470 U.S. at 83. Nearly all of



# Trinity Lutheran Church Of Columbia, Inc. V. Comer

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## Panel Discussion of Trinity Lutheran Church v. Comer (2017)

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The First Amendment forbids a “law respecting an establishment of religion, or prohibiting the free exercise thereof.” Religious establishments historically involved legal coercion to participate in or support the activities of a preferred church. Such laws burdened dissenters and adherents of non-established faiths. The two clauses were meant to work together to shield citizens from legal coercion in connection with religious matters.

The drive for disestablishment was motivated, *inter alia*, by a desire to protect those with religious objections to paying taxes to support a church or minister. Massachusetts Baptist leader Isaac Backus argued that even the law’s provision for seeking an exemption raised a point of conscience “for I cannot give the certificates they require without implicitly acknowledging that power in man which I believe belongs only to God.” Consistent with this historical background, the Supreme Court has interpreted the Establishment Clause to forbid direct government funding to support the mission of a religious group. At the same time, the Court has recognized that strict application of the no-funding rule could undermine Religion Clause values by excluding religious believers from publicly-subsidized aspects of communal life. A religious institution may not be denied generally available services like police or fire protection, for instance, even though these services might incidentally assist the institution in advancing its religious mission.

The Court has repeatedly interpreted the Constitution to prevent use of religion as a basis for excluding the faithful from generally available programs or benefits. In Widmar v. Vincent (1981) a state university could not deny use of rooms to religious groups when they were generally available to other groups. In Rosenberger v. UVA (1995) a university could not deny funding to a student magazine because of its religious content when it funded other publications addressing similar topics. In Locke v. Davey (2004), on the other hand, the Court upheld a state scholarship program that barred use of the funds to pursue a degree in devotional theology.

The Trinity Lutheran Court (7-2) decided that Missouri violated free exercise principles by barring a church-affiliated school from a program reimbursing schools that installed rubber playground surfaces made from recycled tires. The majority analogized the case to McDaniel v. Paty (1978), which held that a state could not bar clergy from public office. The state law in McDaniel burdened religious believers by requiring them to choose between ministry and certain forms of participation in public life. Similarly, the state law in Trinity Lutheran required the church to choose between continuing its religious mission and participating in the playground resurfacing program. Locke was distinguished on the ground that the scholarship program in that case did not prevent the student from attending a religious school or taking theology courses. The only restriction in Locke was on using the money to pursue a degree viewed as training for the ministry, a traditional concern of non-establishment doctrine. The dissenters in Trinity Lutheran thought the no-funding principle should be applied more broadly to bar government funding that supported a church’s mission by improving its facilities.

Trinity Lutheran Church of Columbia, Inc. vs. Carol S. Comer,  
Director, Missouri Department of Natural Resources 582 U.S.  
\_\_\_\_\_ (Decided June 26, 2017)

“How has Trinity Lutheran modified the Court’s Establishment  
Clause jurisprudence?”

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Introduction

This case brings into sharp contrast opposing views on the application of the Free Exercise Clause and the Establishment Clause of the First Amendment of the United States Constitution based on differing characterizations of the underlying facts presented to the Supreme Court. Beyond the differing characterizations of facts, the contrasting opinions of the 7-2 majority represented by Chief Justice John Roberts for the Court and the dissent of Justices Sonia Sotomayor and Ruth Bader Ginsberg show some degree of an opening door to circumstances under which government funds cannot be excluded from a religious organization. The Court does not state its decision in terms of mandating funding religious activities as suggested by Justice Sotomayor in dissent. Rather, the Court looked to those precedents which confirm that denying a generally available benefit solely on

account of religious identity imposes a penalty on the free exercise of religion.

The majority tries to limit the precedential value of the decision and the dissent likewise tries to limit the effect of the decision while expressing concern for a wider application. In sum, the dissent fears a broader mandate for payment of funds while the majority limits the payment of funds to those situations where the religious organization would be excluded from participation in benefits otherwise available to other non-profit organizations.

Particular attention should also be given to the effect on provisions in some state constitutions, including Missouri as well as Georgia, which prohibit direct or indirect payments to a public treasury to a religious or sectarian organization.

### Statement of the Case

The case arises from grant program administered by the Missouri Department of Natural Resources (herein the "Department" or "Missouri") which administers the Scrap Tire Program providing reimbursement to qualified non-profit organizations that install rubberized playground surfaces derived from recycled tires based on criteria developed by the Department. The Department, however, enforced a strict policy of refusing applications from organizations operated or controlled by a church, sect or other religious entity. Trinity Lutheran Church of Columbia, Inc.

operates a child learning center and submitted an application for reimbursement for cost of surfacing a playground on its property for use by students in its child learning center as well as by neighborhood children. The Department refused the application because the applicant was operated by a church even though, under the state's own criteria, Trinity Lutheran would have been rated fifth out of the fourteen successful applicants who received grants. The Department refused the application because it contended that awarding the grant to a church would violate Article I, Section 7 of the Missouri Constitution which provides:

“That no money shall ever be taken from the public treasury, directly or indirectly, in aid of any church, sect or denomination of religion, or in aid of any priest, preacher, minister or teacher thereof as such; and that no preference shall be given to nor any discrimination made against any church, sect, or creed of religion, or any form of religious faith or worship.”

Trinity filed suit in federal district court which upheld the Department's action and, upon appeal, a divided Eighth Circuit Court of Appeals affirmed the district court.

By a 7 – 2 decision, the Supreme Court reversed the Eighth Circuit and held that the Department's policy violated the rights of Trinity Lutheran under the Free Exercise Clause of the First Amendment by denying the Church an otherwise available public benefit on account of its religious status.

Chief Justice John Roberts delivered the opinion of the Court, except as to footnote 3. Justices Kennedy, Alito and Kagan joined that opinion in full, and Justices Thomas and Gorsuch joined except as to footnote 3. Justice Thomas filed an opinion concurring in part, in which Justice Gorsuch joined and Justice Gorsuch filed an opinion concurring in part, in which Justice Thomas joined. Justice Breyer filed an opinion concurring in the judgment. Justice Sonia Sotomayor filed a dissenting opinion, in which Justice Ruth Bader Ginsburg joined.

### Analysis by the Majority

The proposition of this seminar topic asks the question “How has Trinity Lutheran modified the Court’s Establishment Clause jurisprudence?”

On first reading of the decision, this proposition may seem somewhat anomalous since the Chief Justice goes to great pains to assert that this case was decided only under the Free Exercise Clause of the United States Constitution, not under the Establishment Clause. “The question presented is whether the Department’s policy violated the rights of Trinity Lutheran under the Free Exercise Clause of the First Amendment.” (Court slip opinion at 1.) Indeed, the Court notes that “the parties agree that the Establishment Clause does not prevent Missouri from including Trinity Lutheran in the Scrap Tire Program. (Court slip opinion at 6.) The

Court further emphasized that “we do not need to reach the Church’s claim that the policy also violates the Equal Protection Clause. (Court slip opinion at 15, Note 5.) Although Justice Sotomayor notes that the Court usually decides constitutional questions itself, she also tries to limit the scope of the decision throughout her dissent. (Dissent slip opinion at 3.)

The Chief Justice further tries to limit the scope of the opinion with Footnote 3, which states that “this case involves express discrimination based on religious identity with respect to playground resurfacing. We do not address religious uses of funding or other forms of discrimination.” (Emphasis supplied. Court slip opinion at 14.) Since Justices Neil Gorsuch and Clarence Thomas excluded themselves from this footnote, this limitation commanded only a plurality of justices. It does seem, however, that Justice Stephen Breyer, who concurred only in the judgment, and Justices Sonia Sotomayor and Ruth Bader Ginsburg, would agree with the potential limiting principle in footnote 3.

The holding in *Trinity Lutheran* reflects the notion that once the government opens up a “public benefit,” it cannot deny that benefit to a religious entity based on that entities’ religious nature. Moreover, a state cannot rely on its own state

constitution – or on any other state interest – to deny religious entities access to a public benefit.

After disclaiming the need for Establishment Clause analysis in this case, the Chief Justice immediately notes that there is a necessary interconnection, styled “play in the joints” in the application of the Free Exercise and Establishment clauses. In reality, this case is another step in the shifting tension between the Free Exercise and Establishment clauses.

The Court based its opinion on the premises that Trinity Lutheran had been denied a public benefit because of its status as a church or religious institution and that the Department’s policy cannot withstand constitutional scrutiny when it is put to the choice of applying for a public benefit or rejecting its religious character.

First, the Chief Justice lays out a summary of the Court’s Free Exercise precedents focusing on the necessity of avoiding unequal treatment because of religious affiliation:

The Free Exercise Clause “protect[s] religious observers against unequal treatment” and subjects to the strictest scrutiny laws that target the religious for “special disabilities” based on their “religious status.” *Church of Lukumi Babalu Aye, Inc. v. Hialeah*, 508 U. S. 520, 533, 542 (1993) (internal

quotation marks omitted). Applying that basic principle, this Court has repeatedly confirmed that denying a generally available benefit solely on account of religious identity imposes a penalty on the free exercise of religion that can be justified only by a state interest “of the highest order.” *McDaniel v. Paty*, 435 U. S. 618, 628 (1978) (plurality opinion) (quoting *Wisconsin v. Yoder*, 406 U. S. 205, 215 (1972)). (Court slip opinion at 6.)

In particular, *McDaniel v. Paty* articulated the impermissible discrimination based on a person’s religious status. In that case, the Court invalidated a Tennessee statute which required a minister from serving as a legislator because to do so forced him to the choice between his ministerial status and participation in the legislature.

The Court distinguished those Free Exercise cases which denied protection for practices which were prohibited by a neutral statute.

“In *Employment Division, Department of Human Resources of Oregon v. Smith*, 494 U. S. 872 (1990), we rejected a free exercise claim brought by two members of a Native American church denied unemployment benefits because they had violated Oregon’s drug laws by ingesting peyote for sacramental purposes. Along the same lines as our decision in *Lyng [v. Northwest Indian Cemetery Protective Association]*, 485 U.S. 439 ( ), we held that the Free Exercise Clause did not entitle the church members to a special dispensation from the general criminal laws on account of their religion. At the same time, we again made clear that the Free Exercise Clause *did* guard against the government’s imposition of “special disabilities on the basis of religious views or religious status.” 494 U. S., at 877 (citing *McDaniel*, 435 U. S. 618).” Court slip opinion at 8

The Court cautioned, however, that any application of a valid and neutral law of general applicability may be applied constitutionally under the Exercise Clause

subject to some exceptions, as in *Hosanna-Tabor Evangelical Lutheran Church and School v. EEOC*, 565 U. S. 171 (2012), where the Court held that the Religion Clauses required a ministerial exception to the neutral prohibition on employment retaliation contained in the Americans with Disabilities Act inasmuch as it dealt with an internal ecclesial matter, the qualifications of a minister.

The Court noted, however, that even facially neutral statutes may run afoul of Constitutional requirements when religious differentiation is intended by the government. “[I]n *Church of Lukumi Babalu Aye, Inc. v. Hialeah*, [the Court] struck down three facially neutral city ordinances that outlawed certain forms of animal slaughter. Members of the Santeria religion challenged the ordinances under the Free Exercise Clause, alleging that despite their facial neutrality, the ordinances had a discriminatory purpose easy to ferret out: prohibiting sacrificial rituals integral to Santeria but distasteful to local residents.” (Court slip opinion at 9.) Basing its analysis on its reading of the cited precedents, the Court reiterated its premise that this decision is “unremarkable in light of our previous decisions.” Further, if “a policy imposes a penalty on the free exercise of religion that triggers the most exacting scrutiny.” (Court slip opinion at 10.)

In this case, the Court held that the Department’s policy violated the rights of Trinity Lutheran under the Free Exercise Clause of the First Amendment by

denying the church an otherwise available public benefit on account of its religious status comparing *McDaniel v. Paty*, op. cit., where the Court struck down a Tennessee statute disqualifying ministers from serving as delegates to the State's constitutional convention. A plurality recognized that such a law discriminated against McDaniel by denying him a benefit solely because of his "status as a 'minister.'" *McDaniel* at 627.

In recent years, when rejecting free exercise challenges to neutral laws of general applicability, the Court has been careful to distinguish such laws from those that single out the religious for disfavored treatment. See, e.g., *Lyng v. Northwest Indian Cemetery Protective Assn.*, 485 U. S. 439 (1988); *Employment Div., Dept. of Human Resources of Ore. v. Smith*, 494 U. S. 872; and *Church of Lukumi Babalu Aye, Inc. v. Hialeah*, 508 U. S. 520. It has remained a fundamental principle of this Court's free exercise jurisprudence that laws imposing "special disabilities on the basis of . . . religious status" trigger the strictest scrutiny. (Court slip opinion at 6–9.

Since Missouri's policy expressly discriminates against otherwise eligible recipients by disqualifying them from a public benefit solely because of their religious status, the Department's policy puts Trinity Lutheran to a choice: It may

participate in an otherwise available benefit program or remain a religious institution. When the State conditions a benefit in this way, McDaniel says plainly that the State has imposed a penalty on the free exercise of religion that must withstand the most exacting scrutiny. (Court slip opinion at 10.)

The Department contended that simply declining to allocate to Trinity Lutheran a subsidy the State had no obligation to provide does not meaningfully burden the Church's free exercise rights. Absent any such burden, the argument continues, the Department is free to follow the State's antiestablishment objection to providing funds directly to a church. But, as even the Department acknowledges, the Free Exercise Clause protects against "indirect coercion or penalties on the free exercise of religion, not just outright prohibitions." *Lyng*, 485 U. S., at 450. Trinity Lutheran is not claiming any entitlement to a subsidy. It is asserting a right to participate in a government benefit program without having to disavow its religious character. The express discrimination against religious exercise here is not the denial of a grant, but rather the refusal to allow the Church—solely because it is a church—to compete with secular organizations for a grant. (Court slip opinion at 9–11.)

The Court’s analysis requires the Department’s policy to undergo strict scrutiny in justifying its discriminatory policy but the policy could not survive the “most rigorous” scrutiny that the Court applies to laws imposing special disabilities on account of religious status. *Lukumi*, 508 U. S., at 546. That standard demands a state interest “of the highest order” to justify the policy at issue. *McDaniel*, 435 U. S., at 628. Yet the Department offers nothing more than Missouri’s preference for skating as far as possible from religious establishment concerns. In the face of the clear infringement on free exercise before the Court, that interest cannot qualify as compelling. (Court slip opinion at 14–15.) The Court, thus, determined that Missouri’s overly broad interpretation of Article 1, Section 7 of its state constitution violates the Free Exercise Clause prohibiting discrimination against religious organizations and its “policy preference for skating as far as possible from religious establishment concerns” did not justify the “clear infringement on free exercise before [the Court].”

Missouri apparently provided limited evidence of its interest in excluding churches from the Scrap Tire Program application process; namely, broad concerns about religious establishment beyond federal Establishment Clause requirements as embodied in a provision of its state constitution. The Court found that the somewhat diffuse claim differs from the “historic and substantial”

state interest in *Locke v. Davey*, 540 U.S. 712 (2004) in which the Court made extensive reference to funding of clergy. For example, the Court in *Widmar v. Vincent*, 454 U.S. 263, 276 (1981), held an interest in “achieving greater separation of church and state than is already ensured under the Establishment Clause” is not sufficiently compelling. Likewise, *Locke* at 720; *McDaniel* at 628-629.

### *Locke v. Davey*

Central to its analysis, the Court extensively addressed the decision *Locke* on which the Department and the lower courts in this case had relied. In *Locke*, the State of Washington had created a scholarship program to financially assist students with certain education costs. Scholarship funds could be used at accredited religious and non-religious schools but they could not be used to pursue a devotional theology degree as determined by the school. Davey, however, pursued a devotional theology degree so that he could become a minister of his religious denomination, hence, a degree devotional in nature designed to induce religious faith. The State of Washington denied Davey the right to a scholarship. The *Locke* Court upheld the State’s policy as not violative of the Free Exercise Clause.

Cognizant of the cases which disallowed discrimination on the basis of an individual's status in religious practice, the *Locke* Court distinguished status from actions and determined that Davey was not denied a scholarship because of who he was; he was denied a scholarship because of what he proposed to do.

Distinguishing *Locke*, Chief Justice Roberts returned to his simple premise that Trinity Lutheran had been denied a grant simply because of what it is—a church. The court found impermissible infringement of religious freedom when the state policy specifically based its action on Trinity Lutheran's status as a church.

The *Trinity Lutheran* court made clear that *Locke* was not like the cases in which the Court struck down laws requiring individuals to “choose between their religious beliefs and receiving a government benefit.” *Locke* at 720–721. In *Trinity Lutheran*, however, the Court justified its decision by recognizing that Trinity Lutheran was being forced to that impermissible choice.

In *Locke*, Chief Justice Rehnquist found that “training for religious professions and training for secular professions are not fungible,” hence, there was no evidence of hostility to religion. (*Locke* at 721.) Rehnquist was particularly concerned with the history of state funding of clergy and, thus, justified the State of Washington's

policy of not allowing devotional theology students to receive state scholarship funding. *Locke* at 722.

The Court in *Locke* made much of the difference between training for clergy and for other professions in that clergy were necessarily directed toward devotional religious observance. The Court specifically cited the founding fathers who drafted the federal Constitution clearly opposing the use of tax funds for training clergy, an “essentially religious endeavor.” *Locke* at 721 -723. In Chief Justice Roberts’ analysis, the Court considered the playground-resurfacing program as materially different by having a beneficial secular purpose even though installed on church property as contrasted to the establishment concerns related to education of clergy.

The *Locke* court took into account Washington’s antiestablishment interest only after determining that the scholarship program did not “require students to choose between their religious beliefs and receiving a government benefit.” (*Locke* at 720–721.) There is no dispute in the Court’s mind that Trinity Lutheran is put to the choice between being a church and receiving a government benefit, hence, the church is subject to unconstitutional religious discrimination. (Court slip opinion at 11 -14.)

*Locke* did not validate every asserted interest in church-state separation but rather focused the “historic and substantial state interest” in avoiding public funding for training clergy which the Court emphasized as “the only interest at issue.” (*Locke* at 725, 722, note 5.)

### The Dissent

In his concurring opinion, Justice Gorsuch observes that the statement of the same facts in different ways can often suggest, if not compel, a certain conclusion. (Gorsuch concurring opinion at 1-2.) The Chief Justice’s opinion for the Court, read in contrast to Justice Sotomayor’s dissent, validates the observation. Justice Sotomayor states the gravamen of the case differently from the Court and, thus, progresses to a different conclusion. For the dissent, “Properly understood, this case is about whether Missouri can decline to fund improvements to facilities the Church uses to practice and spread its religious views.” (Dissent slip opinion at 3.) This proposition rests on the dissent’s belief that the early learning playground is part of Trinity Lutheran’s religious mission and, thus, the award of state funds for the playground constitutes direct payment to a church for religious activities. According to the application for *certiorari* as cited by the dissent, Trinity Lutheran was required to aver in its application that its mission and activities are secular

and that funds would be used only for secular purposes although it is unclear whether Trinity Lutheran made such a certification. (Dissent slip opinion at 5, n. 3.) The mission statement stated that the child learning center was “a ministry of the Church and incorporates daily religion and developmental activities into [its] program, ... teaches a Christian world view to children of members of the Church, as well as children of non-member residents. These activities represent the Church’s sincere religious belief to teach the Gospel to children of its members as well as to bring the Gospel message to non-members. ... The Church provides the playground and other ‘safe clean and attractive’ facilities ‘in conjunction with an education program structured to allow a child to grow spiritually, physically, socially and cognitively.’” Dissent slip opinion at 2.) These purposes, seen in the context of a grant for playground re-surfacing, seem far removed from the religious concerns raised by funding ministerial training or other content based concerns in other Establishment Clause cases.

Because the dissent considered the playground reimbursement a payment for religious purposes, Justice Sotomayor could distinguish the line of cases which permitted construction grants and contracts on properties of religious schools as long as the facilities paid for by the grants were used only for secular purposes, citing in particular, *Tilton v. Richardson*, 403 U.S. 672 (1971) and others. (Dissent

slip opinion at 4 – 6.) Justice Sotomayor does allow, however, that her differences with the majority opinion may be due to a disagreement as to the interpretation of the facts although she clearly does not accept that as sufficient. Rather, she sees the opinion of the Court as taking a step toward greater allowance of state funding of religious activities and, hence, a diminishment of the Establishment clause. (Slip opinion at 6 - 7.)

#### “Blaine Amendment” in the Dissent and Beyond

In her dissenting opinion, Justice Sotomayor recounts the legislative history of the language in the Missouri constitutional provision which parallels the development in other states. Even without specific reference, however, the effect on these constitutional amendments in thirty-nine states, including Georgia, may be the most significant outgrowth of the *Trinity Lutheran* court’s decision although neither the Court nor the dissent elaborate such a result.

The language of the Missouri provision at issue (and, as will be discussed in greater detail below, the comparable Georgia provision) is often referred to as a “Blaine amendment” originating in the late 1870’s as a reaction to increased immigration and as a purported restriction on Catholic schools who welcomed those immigrants. The amendments take their names from James G. Blaine, a

former speaker of the United States House of Representatives and presidential hopeful, who, in 1875, introduced an amendment to the federal Constitution which would specify:

No State shall make any law respecting an establishment of religion or prohibiting the free exercise thereof; and no money raised by taxation in any State for the support of public schools, or derived from any public fund therefore, nor any public lands devoted thereto, shall ever be under the control of any religious sect, nor shall any money so raised or lands so devoted be divided between religious sects or denominations. 4 Cong. Rec. 205 (December 14, 1875).

It was widely accepted that Blaine's purpose was an attempt to bolster his presidential aspirations for the 1876 election by appealing to nativist and anti-Catholic prejudices.

Blaine's proposed federal amendment failed to get sufficient votes in Congress and did not advance to the states for ratification. Nonetheless, a large number of states took similar language and incorporated those amendments into their state constitutions. In most cases, states broadened the operative language of the amendment to cover services in addition to education. There are a plethora of articles recounting the history of such amendments but see, for example, the history including references to nativist prejudice in: Michael S. Ariens and Robert A Destro, *Religious Liberty in a Pluralistic Society*, 2<sup>nd</sup> ed. (Carolina Academic Press, 2002) at 167 – 179; Patrick H. Ouzts, "School Choice: Constitutionality and

Possibility in Georgia.” 24 Ga. St. U. L. Rev. 587, 607 – 612 (2007). The Supreme Court has acknowledged the history of Blaine amendments and their anti-Catholic animus:

Opposition to aid to "sectarian" schools acquired prominence in the 1870's with Congress's consideration (and near passage) of the Blaine Amendment, which would have amended the Constitution to bar any aid to sectarian institutions. Consideration of the amendment arose at a time of pervasive hostility to the Catholic Church and to Catholics in general, and it was an open secret that "sectarian" was code for "Catholic." See generally Green, *The Blaine Amendment Reconsidered*, 36 Am. J. Legal Hist. 38 (1992). Notwithstanding its history, of course, "sectarian" could, on its face, describe the school of any religious sect, but the Court eliminated this possibility of confusion when, in *Hunt v. McNair*, 413 U.S., at 743, it coined the term "pervasively sectarian"-a term which, at that time, could be applied almost exclusively to Catholic parochial schools and which even today's dissent exemplifies chiefly by reference to such schools. See post, at 20-21, 39-41 (Souter, J., dissenting). *Mitchell v. Helms*, 530 U.S. 793,

Unfortunately, Sotomayor’s dissent, which goes into some detail regarding the history of state Blaine Amendments (although it does not use the word “Blaine” or discuss the federal attempt at a Constitutional amendment), fails to take into account the animus that played a major role in the passage of Blaine Amendments.

Without specifically referring to the “Blaine amendment” or its place in constitutional jurisprudence, Justice Sotomayor suggests that these constitutional

provisions found in thirty-nine states are “all but invalidated.” Such a concession, of course, is not binding and she suggests that arguments to the contrary may well appear in future cases. (Dissent slip opinion at 25.) In this case as well as in *Locke* and *Mitchell*, some *amici* vigorously argued for an opinion invalidating the Blaine amendments as reflected in thirty-nine state constitutions. The Supreme Court has so far declined to take that big step but, in *Trinity Lutheran*, it does draw into question the extent of the continued viability of such provisions.

*Trinity Lutheran* may not go so far as to expressly mandate any payment of funds to a religious organization but it does indicate that a religious organization should be accorded equality with other organizations as long the funding does not go toward to religious activities. At the same time, the Court leaves open room for “play in the joints” as to what constitutes religious activities. Under *Locke*, some funding for training clergy may be excluded but re-surfacing playgrounds (and possibly other similar facilities improvements) may not be subject to discrimination. The contours of this “play in the joints” will, thus, be continued for future cases.

## A Georgia Excursus

Georgia did not adopt Article 1, Section 2, Par. VII, its constitutional provision comparable to the Missouri constitutional provision at issue in this case until 1877.

The current Georgia Constitution contains several provisions related to the free exercise of religion in Article 1, Section 2:

Par. II. Protection to person and property; equal protection. Protection to person and property is the paramount duty of government and shall be impartial and complete. No person shall be denied the equal protection of the laws.

Par. III. Freedom of conscience. Each person has the natural and inalienable right to worship God, each according to the dictates of that person's own conscience; and no human authority should, in any case, control or interfere with such right of conscience.

Par. IV. Religious opinions; freedom of religion. No inhabitant of this state shall be molested in person or property or be prohibited from holding any public office or trust on account of religious opinions; but the right of freedom of religion shall not be so construed as to excuse acts of licentiousness or justify practices inconsistent with the peace and safety of the state.

The Georgia Supreme Court, in *Wilkerson v. City of Rome*, 152 Ga. 762, 110 S.E. 895 (Ga., 1922), recounted some of the history of religious protection clauses in

Georgia beginning with the royal English charter granted to the "Trustees for Establishing the Colony of Georgia in America," which provided that:

There shall be a liberty of conscience allowed in the worship of God, to all persons resident within the province, and that all such persons, except papists [that is, Catholics], shall have a free exercise of religion, so they be contented with the quiet and peaceable enjoyment of the same, not giving offence or scandal to the government. McElreath on the Constitution of Georgia, § 235; 1 Jones' History of Georgia, 92.

The first Constitution of Georgia, adopted after the Revolutionary War in 1777, provided:

All persons whatever shall have the free exercise of their religion; provided it be not repugnant to the peace and safety of the state; and shall not, unless by consent, support any teacher or teachers except those of their own profession." Article 56.

This provision, the *Wilkinson* court observed, did not prohibit all taxation for sectarian purposes. In the Constitution of 1789 the religious liberty provision did not in substance differ from that of 1777 and similar provisions followed in the Constitutions of 1798, 1861, 1865 and 1868.

In addition to the three paragraphs of Article 1, Section 1, the Georgia Constitution also contains a provision with similar wording to the Missouri provision, stating:

"No money shall ever be taken from the public treasury, directly or indirectly, in

aid of any church, sect, cult, or religious denomination or of any sectarian institution.” Ga. Const. of 1983, Art. I, Sec. II, Par. VII.

Unlike the religious protection provisions in Article 1, Section 1, the current Article I, Section II, Par. VII provision did not enter the Georgia Constitution until the Constitution of 1877. As indicated above, this provision was among those amendments adopted in the nativist surge after 1875 and was consistent with the biases that gave rise to Blaine amendments in other states. Furthermore, the Georgia language included the term “sectarian institution” which has been recognized as a coded reference to anti-Catholicism. See *Mitchell v. Helms*, 530 U.S. 793, ; Outz at 607 – 612.

Several cases have cited the Georgia provision that authority might need reconsideration in light of *Trinity Lutheran*. In *Bennett v. City of La Grange*, 153 Ga. 428, 112 S.E. 482 (Ga., 1922), the Court enjoined payments to the Salvation Army as a contractor for care of the city’s poor. The Court stated that “the giving of loaves and fishes is a powerful instrumentality in the successful prosecution of the work of a sectarian institution.” *Bennett* at 487. The *Bennett* court viewed the Salvation Army’s proposed service as religious work, thus, the decision might not change if that analysis stood as in *Locke*. If, however, a court considered the work

in secular terms, even though done by a religious organization, *Trinity Lutheran* could suggest a different result.

The Supreme Court later distinguished *Bennett* and permitted a public-school system to enter into an arms-length, commercial agreement with a sectarian institution to accomplish a non-sectarian purpose, that is provide classroom space for use by the school system. “The payments made by APS under that lease do not constitute the giving of monetary aid to the church and do not, therefore, violate the Establishment Clause of our Constitution.” *Taetle v. Atlanta Independent School System*, 625 S.E.2d 770, 280 Ga. 137 (Ga., 2006)

Laying aside other issues related to public services or spaces provided by religious organizations and even if *Trinity Lutheran* might not provide binding precedent because of the stated limitation in the Court’s opinion, the case certainly suggests that a public entity should take great care if it were to exclude a religious organization from bidding on a contract for services or for a lease.

Article I, Section II, Par. VII most recently came before the Georgia Supreme Court in *Gaddy v. Georgia Department of Revenue*. (Supreme Court of Georgia Case Nos. S17A0177 and S17X0178 Decided June 26, 2017)

<https://apps.fastcase.com/Research/Pages/Document.aspx?LTID=4dKRf%2b%2ffb%20sQ3P5xezqUz2eduuTj5ltSicWJNG2BDK7Fm439TPrY2yRdFKk8dTWgWlo5TaQe2Q0ntnaHGH6eXpezS9lrDVxmjwskpJfYXELe2c1gkoQ4wL5WVDVG4frkC3ToknqwqPp2SbgBltG1auamA9MeWiwgNdVA0rmB2fEw%3d> Accessed September 14, 2017.

Plaintiffs in *Gaddy* sought an injunction against the State of Georgia prohibiting further implementation of tax credit scholarship program first enacted in 2008.

The scholarship allowed Georgia taxpayers to take a credit against state income tax up to \$1,000.00 for individuals and \$2,500.00 for married couples when they contributed that amount to a qualified student scholarship organization for scholarships to private schools, either religious or otherwise. (Scholarships are further limited to a statewide annual maximum currently set at \$58 million.)

Plaintiffs based their claims on several constitutional provisions including Article I, Section II, Par. VII. In part, Plaintiffs alleged that the Program takes money from the state treasury in the form of dollar-for-dollar tax credits that would otherwise be paid to the State in taxes, and since a significant portion of the scholarships awarded by the SSOs goes to religious-based schools, the Program takes funds from the State treasury to aid religious schools in violation of Article I, Section II, Par. VII.

The Supreme Court affirmed dismissal of the complaint. The Court based its decision on Plaintiffs lack of standing to bring a suit in light of Georgia's strong adherence to sovereign immunity which would not allow the Court to overturn a statute enacted by the General Assembly unless such action were authorized in the statute. Furthermore, the Court found that, as tax credits, the funds were never in the public treasury and could not be subject to the prohibition against withdrawal of funds. With these decisions, the Court had no need of addressing the constitutionality of Article I, Section II, Par. VII. Indeed, given the limitations placed on taxpayer standing in *Gaddy*, it may be difficult to bring a challenge in a Georgia court.

As partnerships between faith-based groups and federal, state and local governments to assist the most vulnerable among us grow to meet increasing needs in our society, people of faith need to have the freedom to serve the common good without fear of being disqualified from such service simply because they are religious. All qualified organizations that currently exist are needed to address the challenges our country faces in combating poverty, providing life-affirming health care and educating the young. In a pluralistic society, the beneficiaries of such services have the freedom to choose where they obtain the

services, and government entities should not themselves discriminate between religious and non-religious service providers.

### Proposed Georgia Constitutional Amendment

Concerned with the limitations that Article 1, Section 2, Par. VII placed on contracting for public services as well as education, then-Governor Sonny Perdue initiated a constitutional amendment in the 2004 session of the Georgia General Assembly by adding the following *proviso* to the clause:

However, nothing in this Paragraph or any other provision of this Constitution shall prohibit the use of money from the public treasury to support public health, historic preservation, or social service programs for people in need which are provided without regard to any recipient's religious affiliation, belief, practice, or lack thereof by separate charitable affiliates of religious or sectarian organizations, religious denominations, or individual houses of worship, provided that no such public money shall be used for sectarian worship, instruction, or proselytization, nor shall such public money be used by entities that engage in any unlawful discrimination. Senate Resolution 1 (2004)

See Press Release at:

[http://sonnyperdue.georgia.gov/00/press/detail/0,2668,78006749\\_91290006\\_91682677,00.html](http://sonnyperdue.georgia.gov/00/press/detail/0,2668,78006749_91290006_91682677,00.html);

[http://sonnyperdue.georgia.gov/vgn/images/portal/cit\\_79369762/92324782faith\\_](http://sonnyperdue.georgia.gov/vgn/images/portal/cit_79369762/92324782faith_)

[services\\_amend.pdf](#) Accessed September 14, 2017.

While somewhat awkwardly worded, the intent of the *provisio* was to neutralize if not repeal much of the effect of the clause. As noted in the Governor's press release and as indicated by the language of the proposal, the amendment was intended to apply more broadly to services other than education. The resolution obtained the requisite two-thirds vote in the State Senate but languished without action in the House. [http://www.legis.ga.gov/Legislation/en-](http://www.legis.ga.gov/Legislation/en-US/display/20032004/SR/1)

[US/display/20032004/SR/1](#) Accessed September 13, 2017.

Since 2004, similar resolutions were periodically introduced but failed to gain traction.

In 2016, Senator Bill Heath (R-31) introduced Senate Resolution 388 and amended the *provisio* language evidencing a more limited purpose so that the complete clause would read:

Paragraph VII. *Separation of church and state.* Except as permitted or required by the United States Constitution, as amended, no money shall ever be taken from the public treasury, directly or indirectly, in aid of any church, sect, cult, or religious denomination or of any sectarian institution. Nothing in this Paragraph shall be construed to create a basis for establishing a voucher program in this state for public education purposes or to prohibit the continuation or creation of a voucher program in this state for public education purposes.

SR 388 was adopted in the Senate but was not heard in the House of Representatives. <http://www.legis.ga.gov/Legislation/en-US/display/20152016/SR/388> Accessed September 13, 2017.

In the current 2017 -2018 session of the General Assembly, Senator Heath again introduced a proposed constitutional amendment SR 105 with the same language related to education vouchers as the previous session's SR 388. SR 105 was favorably reported by the Senate Government Oversight Committee but was not considered by the full Senate. <http://www.legis.ga.gov/Legislation/en-US/display/20172018/SR/105> Under the rules of the Senate, SR 105 will still be available for consideration in the second year of the 2017 – 2018 session beginning in January 2018.

Panel Discussion of *Trinity Lutheran Church v. Comer* (2017)

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The facts in *Trinity Lutheran v. Comer*<sup>1</sup> were undisputed: The Missouri Department of Natural Resources has a grant program that provides funds for qualifying organizations to purchase recycled tires to resurface playgrounds.<sup>2</sup> Trinity Lutheran Church operates a preschool/daycare center called The Learning Center.<sup>3</sup> Trinity applied for the grant to redo the preschool playground, and was denied on the grounds that Article I Section 7 of the Missouri Constitution states that, “no money shall ever be taken from the public treasury, directly or indirectly, in aid of any church, section, or denomination of religion.”<sup>4</sup>

What makes the decision in *Trinity* worth noting is that while the facts were really clear, the justices seemed generally unable to agree on what exactly the case was about or how to frame it.

- Was it about making sure religious school children have access to the same health and safety benefits (like safer playgrounds) as children at other schools? (Justice Breyer);<sup>5</sup>
- Or was it about a church being denied funding for a specific and fully secular playground program simply because of their status? (Chief Justice Roberts, with Justices Kennedy, Alito and Kagan joining in full);<sup>6</sup>
- Was it the slightly broader story of a religious group being denied a *benefit* just because they are religious? (Justices Thomas and Gorsuch, joining Roberts in all but one narrowing footnote);<sup>7</sup>
- Or was it the government being asked to directly fund religious activity, which is constitutionally inappropriate? (Justices Sotomayor and Ginsburg, dissenting).<sup>8</sup>

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<sup>1</sup> Parts of this material come from a recent analysis of Trinity that I wrote here <http://law.emory.edu/news-center/releases/2017/07/Goldfeder-Trinity-Lutheran-Church-of-Columbia-v.-Comer.html#.WcKoNLKGOUk>, and from my work on briefs in Trinity and related cases.

<sup>2</sup> *Trinity Lutheran Church of Columbia, Inc. v. Comer*, 137 S. Ct. 2012, 2016 (2017).

<sup>3</sup> *Id.*

<sup>4</sup> *Id.* at 2018.

<sup>5</sup> *Id.* at 2026.

<sup>6</sup> *Id.* at 2017.

<sup>7</sup> *Id.* at 2025–6.

<sup>8</sup> *Id.* at 2027.

Three of those questions have fairly easy answers: Children in religious schools *should* have the same safety benefits as children in secular schools;<sup>9</sup> you *cannot* deny funding for a fully secular playground program just because of the religious status of the owners;<sup>10</sup> and no, the government should not *directly* fund religious activity.<sup>11</sup> (The disagreement between the majority and dissents was partly on the question whether or not this was really fully secular or somewhat religious in nature.) A majority of the Justices (seven, in fact) was comfortable saying that there was no direct funding of any religious activity going on in this case.

The fourth question is where it gets interesting. Footnote 3 in Chief Justice Roberts' opinion gave lower courts the ability to read this ruling narrowly. It states:

This case involves express discrimination based on religious identity with respect to playground resurfacing. We do not address religious uses of funding or other forms of discrimination.<sup>12</sup>

Justices Thomas and Gorsuch took issue with the footnote in their concurring opinions, worrying that some might mistakenly read it to suggest that only “playground resurfacing” cases, or only those with some association with children’s safety or health, or perhaps some other social good we find sufficiently worthy, are governed by the legal rules recounted in and faithfully applied by the court’s opinion.<sup>13</sup> Such a reading would be unreasonable for our cases are “governed by general principles, rather than ad hoc improvisations.”<sup>14</sup>

Of course, it is entirely possible that this ambiguity is why Roberts intentionally included the footnote, i.e. in order to sway more justices to join the main position, and it may even have helped to draw in Justices Kennedy and Kagan to the majority opinion, and Breyer in concurrence with the judgment. The footnote, however, did not get a majority and so the question of whether the government can keep religious institutions out of other types of neutral secular public benefit programs remains open. Still, I am hopeful that even a narrow reading could end up plugging what I see as another major hole in First Amendment jurisprudence, i.e. the ability for schools to hide behind the Ministerial Exemption when it comes to Child Protection laws.

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<sup>9</sup> “After describing the playground and the safety hazards posed by its current surface, the Center detailed the anticipated benefits of the proposed project: increasing access to the playground for all children, including those with disabilities, by providing a surface compliant with the Americans with Disabilities Act of 1990; providing a safe, long-lasting, and resilient surface under the play areas; and improving Missouri’s environment by putting recycled tires to positive use.” *Id.* at 2018.

<sup>10</sup> “The express discrimination against religious exercise here is not the denial of a grant, but rather the refusal to allow the Church—solely because it is a church—to compete with secular organizations for a grant.” *Id.* at 2022.

<sup>11</sup> *Id.* at 2023–4.

<sup>12</sup> *Id.* at fn.3.

<sup>13</sup> *Id.* at 2026.

<sup>14</sup> *Id.*

## The First Amendment Context

The Supreme Court has held that “cutting off church schools from . . . services, so separate and so indisputably marked off from the religious function . . . is obviously not the purpose of the First Amendment.”<sup>15</sup> When the issue is less about bestowing a benefit and more about protecting safety, (and even more so when those safety issues involve vulnerable children) Justices are even more likely to say that there is no Establishment Clause violation when the government evens the proverbial (or in *Trinity*’s case the actual) playing field. Such a nuanced reading of the First Amendment has been repeatedly stressed by Justice Breyer.<sup>16</sup>

While it is true that *Trinity* was not actually about the Establishment Clause, the very nature of the case still makes it something to consider. It is worth noting that the Religion Clauses can never be fully separated, and that the Court has “struggled to find a neutral course between [them], both of which are cast in absolute terms, and either of which, if expanded to a logical extreme, would clash with the other.”<sup>17</sup> It is this “play in the joints” that was considered when the Court took up the case in *Locke*.<sup>18</sup> While the Court did not reach this issue, *Trinity* also argued for relief under the Equal Protection Clause, which requires that “all persons similarly situated . . . be treated alike.”<sup>19</sup> Unequal treatment can violate Equal Protection even if it was enacted without the intent to harm a particular group.<sup>20</sup> The Constitution forbids even a government’s mere indifference to a group’s safety.<sup>21</sup> Regardless of the reason why a government denies a similarly situated group common benefits, it bears the burden of providing an adequate justification for doing so. That justification must be compelling when the denial affects fundamental rights—such as religious liberty.<sup>22</sup>

Especially when it comes to safety, this Court has found that private and public schoolchildren are similarly situated and deserve equal treatment with regards to generally applicable public services and protective measures.<sup>23</sup> In *Everson*, the Supreme Court noted that firemen and

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<sup>15</sup> *Everson v. Bd. of Educ. of Ewing Tp.*, 330 U.S. 1, 18 (1947).

<sup>16</sup> See *Members of Jamestown Sch. Comm. v. Schmidt*, 699 F.2d 1, 16–17 (1st Cir. 1983) (Breyer, J., concurring in result) (noting, where benefit at issue “is support for child safety rather than support for the church,” “[t]he First Amendment . . . is impartial . . . , and that impartiality implies that it not penalize parochial school students”); see also *Van Orden v. Perry*, 545 U.S. 677, 698–9 (2005) (Breyer, J., concurring) (“[A]bsolutism is not only inconsistent with our national traditions . . . but would also tend to promote the kind of social conflict the Establishment Clause seeks to avoid.”).

<sup>17</sup> *Walz v. Tax Comm’n*, 397 U.S. 664, 668–69 (1970).

<sup>18</sup> *Locke v. Davey*, 540 U.S. 712, 714 (2004) (citing *Walz*, 397 U.S. at 669.).

<sup>19</sup> *City of Cleburne v. Cleburne Living Ctr.*, 473 U.S. 432, 439 (1985).

<sup>20</sup> See James G. Dwyer, *The Children We Abandon*, 74 N.C. L. Rev. 1321 (1996).

<sup>21</sup> *Id.*

<sup>22</sup> *Clark v. Jeter*, 486 U.S. 456, 461 (1988) (holding classifications affecting fundamental rights trigger strict scrutiny).

<sup>23</sup> *Everson*, 330 U.S. at 1.

policemen act to protect the lives of children regardless of their religion.<sup>24</sup> Similarly, religion has no bearing on the provision of safety services like streets, sidewalks, and sewage facilities.<sup>25</sup> In a majority of the Court's opinion in *Trinity*, although they did not explicitly say it, it is fair to infer that the same can be said for a program helping students (and other neighborhood children) safely enjoy a school's playground facilities. A reaction to the contrary would have been an overbroad response to an unrealistic inference of governmental favoritism toward religion. As multiple previous justices on this Court have remarked:

[T]he First Amendment does not prohibit practices which by any realistic measure create none of the dangers which it is designed to prevent and which do not so directly or substantially involve the state in religious exercises or in the favoring of religion as to have meaningful and practical impact.<sup>26</sup>

Justice Breyer noted the difference between these two jurisprudential lines while concurring in a First and Fourteenth Amendment challenge to Rhode Island's statute "providing bus transportation to nonpublic school children beyond school district limits."<sup>27</sup> He looked to the spirit of *Everson* that announced that a law allowing for the transportation of children promotes "the welfare of the general public" and is not "designed to support institutions which teach religion."<sup>28</sup> He concluded that "proportionate state expenditure on school transportation is support for child safety rather than support for the church."<sup>29</sup>

### **The First Amendment Problem**

Here is one reason why the *Trinity* case, even narrowly read, might be very important going forward: Child Protection laws.

The Supreme Court in *Hosanna-Tabor* unanimously held that, "The Establishment Clause prevents the Government from appointing ministers, and the Free Exercise Clause prevents it from interfering with the freedom of religious groups to select their own."<sup>30</sup> And so for both Free Exercise and Establishment reasons, legislators and local school systems have been afraid to impose even the most basic of safety regulations on the hiring and firing of teachers in private institutions. This is absurd result needs to stop, and maybe *Trinity* can help.

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<sup>24</sup> *Id.*

<sup>25</sup> *Bd. of Educ. of Cent. Sch. Dist. No. 1 v. Allen*, 392 U.S. 236, 242 (1968).

<sup>26</sup> *Schempp*, 374 U.S. at 308 (Goldberg, J., concurring).

<sup>27</sup> *Schmidt*, 699 F.2d at 3.

<sup>28</sup> *Id.* at 13 (Breyer, J., concurring) (quoting *Everson*, 330 U.S. 1, 14 (1947)).

<sup>29</sup> *Id.* at 16 (citing *Everson*, 330 U.S. at 18).

<sup>30</sup> *Hosanna-Tabor Evangelical Lutheran Church and School v. E.E.O.C.*, 565 U.S. 171, 185 (2012).

This Court has held that “democratic society [...] rests upon the healthy, well-rounded growth of young people into full maturity as citizens.”<sup>31</sup> In other words, the Court considers the health and safety of children to be of the utmost importance. As a result, the “State always has a legitimate concern for maintaining minimum standards in all schools it allows to operate.”<sup>32</sup> Despite the importance of protecting the health and safety of children, it is estimated that ten percent of school children from kindergarten through twelfth grade are victims of educator sexual assault.<sup>33</sup>

In response to disturbing estimates of sexual abuse in schools, Congress enacted the National Child Protection Act with the intent to “encourage the States to adopt legislation requiring background checks for child care providers through the FBI criminal history records system.”<sup>34</sup> A survey released in 2003 found that 42 of the 50 states—following the intent of Congress in enacting the National Child Protection Act—require background checks of all employees in public schools. Additionally, numerous states currently require background checks and fingerprinting of employees at both public and nonpublic schools, including Alabama, California, Florida, Illinois, Louisiana, Maryland, Massachusetts, Michigan, Minnesota, Ohio, Pennsylvania, Rhode Island, and Virginia.<sup>35</sup> These states constitute over 40% of the US population.<sup>36</sup>

This Court has affirmed the right of states to regulate nonpublic education.<sup>37</sup> Although courts have consistently upheld laws deferring to individual states approval of teacher certification, core subject instruction, attendance for private schools, and other non-health-or-safety related matters, there remains enormous disparity in the application of health and safety-related regulations to public schools versus private schools.<sup>38</sup> This has led to continual frustration and recurrent litigation.<sup>39</sup> The majority of states do not mandate equal protections for private school children by requiring the same employee background checks and fingerprinting that they do for public school children.<sup>40</sup> I am hopeful that following *Trinity*, the Court will end the confusion and litigation related to state regulation of safety and security in nonpublic schools to

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<sup>31</sup> *Prince v. Massachusetts*, 321 U.S. 158, 168 (1944).

<sup>32</sup> *Lemon v. Kurtzman*, 403 U.S. 602, 613 (1971) (emphasis added).

<sup>33</sup> Charol Shakeshaft, *Educator Sexual Misconduct: A Synthesis of Existing Literature* at 20 (Hofstra Univ. and Interactive, Inc., 2004).

<sup>34</sup> Jewish Bd. of Advocates for Children, Inc., Position Paper to the New York Legislature Advocating Child Protection Laws for Nonpublic Schools at 3 (2009).

<sup>35</sup> *Id.* at 4.

<sup>36</sup> *Id.*

<sup>37</sup> See *Pierce v. Soc’y of Sisters*, 268 U.S. 510 (1925); see also Eric A. DeGroff, State Regulation of Nonpublic Schools: Does the Tie Still Bind?, 2003 BYU Educ. & L.J. 363 (2003) (discussing the Court’s history of affirming the right of states to regulate nonpublic education); Donal M. Sacken, Regulating Nonpublic Education: A Search for Just Law and Policy, 96 AM. J. EDUC. 394 (1988) (discussing the Court’s history of affirming the right of states to regulate nonpublic education).

<sup>38</sup> See James G. Dwyer, The Children We Abandon, 74 N.C. L. Rev. 1321 (1996) (footnotes omitted).

<sup>39</sup> *Sacken* at 395.

<sup>40</sup> *Id.*

ensure the equal protection of all children regardless of the type of educational institution they attend.

Federal law and policy favor school employee background checks.<sup>41</sup> In fact, The National Child Protection Act gives qualifying schools and youth groups to access the FBI national criminal history database and empowers state legislatures to require them to.<sup>42</sup> The Schools Safely Acquiring Faculty Excellence Act (contained within the Adam Walsh Child Protection and Safety Act), signed into law on July 27, 2006, provides that the U.S. Attorney General "shall, upon request of the chief executive officer of a State, conduct fingerprint-based checks of the national crime information databases . . . pursuant to a request submitted by . . . a private or public elementary school, a private or public secondary school, a local educational agency, or State educational agency in that State, on individuals employed by, under consideration for employment by, or otherwise in a position in which the individual would work with or around children in the school or agency."<sup>43</sup> Under this law, State Governors are granted the power to authorize nonpublic school background checks. The U.S. Education Department report, "Educator Sexual Misconduct: A Synthesis of Existing Literature" (June 2004), received national media attention, particularly for its finding that nearly 9.6% of American students, in their K-12 years, are victims of sexual misconduct.<sup>44</sup> The 147-page Congress-mandated report recommends fingerprint-based criminal background checks for all school personnel.<sup>45</sup>

The common thread of the background check statutes and rules is that where vulnerable populations are involved, the workers need to be screened to ensure security. Fingerprinting and background checks have screened out many dangerous persons, and have therefore prevented many crimes that would have been inflicted on children and other vulnerable people. While no harm can be absolutely eliminated, programs that require background checks can help dramatically reduce the likelihood of a child falling prey to an abuser.

In the fall of 2011, it was estimated that there were 30,861 private elementary and secondary schools in the United States, made up of 4,494,845 students and 420,880 full-time equivalent teachers.<sup>46</sup> Of those schools, 68.4% were religious private schools.<sup>47</sup> These schools represent hundreds of thousands of students around the country who are receiving unequal protection from their state government and are being placed daily into potential harm's way.

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<sup>41</sup> The National Child Protection Act, 42 U.S.C. §§. 5119a, et seq. (enacted 1993, amended 1998).

<sup>42</sup> *Id.*

<sup>43</sup> 42 U.S.C. § 16962(b)(2).

<sup>44</sup> *Id.* at 20.

<sup>45</sup> *Shakeshaft* at 47-48.

<sup>46</sup> Nat'l Ctr. For Educ. Statistics, *Characteristics of Private Schools in the United States: Results from the 2011-12 Private School Universe Survey* (U.S. Dep't of Educ., 2013), <http://www2.ed.gov/about/offices/list/oii/nonpublic/statistics.html>.

<sup>47</sup> *Id.*

Prior decisions of this Court have found that private and public school children are similarly situated and deserve equal treatment of generally applicable public services and protective measures.<sup>48</sup> In *Everson*, a township board of education authorized the reimbursement to parents of money spent on public transportation for their children to attend school.<sup>49</sup> The reimbursements went to both public and private school children. The law was challenged because public funds could not constitutionally be provided to private school children. The Court rejected those challenges, finding that private school children were similarly situated to public school children; thus, they were equally deserving of the benefits of neutral, generally applicable programs. The Court used a metaphor—one that applies perfectly in this case—of firemen and policemen who act to protect the lives of children.<sup>50</sup> Even the dissent agreed that in "matters of common right, part of the general need for safety. Certainly the fire department must not stand idly by while the church burns."<sup>51</sup> The same can be said for the provision of essential services like streets, sidewalks, and sewage facilities.<sup>52</sup> After *Trinity*, the same can be said of playground equipment, and now the same can and should be said for laws mandating fingerprinting and background checks. Religious school children are now facing harm by the Legislature's decision to exclude them from mandated child protection laws. The lack of employee fingerprinting means that registered sex offenders can more easily manage to find work in religious schools. The failure to require basic and appropriate abuse detection and prevention training for nonpublic school employees makes it more likely that private school children will be hurt.

The Court found in *Everson* that States had a historical interest in providing for the public health and welfare of all children.<sup>53</sup> Moreover, the Court held that the State must secure against dangers that may plague children in pursuit of their education.<sup>54</sup> As noted, these protective measures are what the Court has called "matters of common right, part of the general need for safety."<sup>55</sup> The Court has held that the provision of these public services to religious schools is not a violation of the Establishment Clause or the Free Exercise Clause.<sup>56</sup>

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<sup>48</sup> *Everson v. Bd. of Educ. of the Twp. of Ewing*, 330 U.S. 1 (1947).

<sup>49</sup> *Id.*

<sup>50</sup> *Id.* at 25-26.

<sup>51</sup> *Id.* at 61-62 (Rutledge, J., dissenting).

<sup>52</sup> *Bd. of Educ. of Cent. Sch. Dist.*, 392 U.S. at 242.

<sup>53</sup> *McGowan v. Maryland*, 366 U.S. 420, 444 (1961).

<sup>54</sup> *Prince*, 321 U.S. at 168.

<sup>55</sup> *Walz v. Tax Comm'n of City of New York*, 397 U.S. 644, 67 (1970).

<sup>56</sup> *Id.*

Forty-two of the fifty U.S. states require criminal-background checks and fingerprinting for teacher certification in public schools.<sup>57</sup> However, only about one third of the states mandate similar requirements for nonpublic schools.<sup>58</sup>

As of 2009, only 17 states specifically required mandatory reporting of any incidences of child abuse occurring at non-public schools.<sup>59</sup> Even now, although every state has a mandatory reporting statute, only a handful specifically require nonpublic schools to report child abuse.<sup>60</sup> The remainder use vague statutes to inadequately address this issue.<sup>61</sup> Additionally, statutes regarding mandatory reporting of child abuse in private schools only require specific staff and employees to report it as opposed to the blanket and universal requirements for reporting child abuse in public schools.<sup>62</sup> As is apparent, child safety laws discriminate among groups of children based “on an arbitrary and improper basis.”<sup>63</sup>

To the extent that the state legislatures have exempted private institutions, including private religious institutions, to avoid any questions relating to the hiring of ministers or clergy, *Hosanna-Tabor* should not be controlling. The holding in *Hosanna-Tabor* left open the question of whether the State’s compelling interest in protecting children, specifically in the instance of reporting sexual abuse or requiring background checks could supersede the First Amendment rights of religious organizations and employers.<sup>64</sup> The Court explicitly declined to address whether a state interest other than fair employment, such as child welfare and safety, would trigger a different outcome and result. This conclusion that was difficult when considering *Hosanna-Tabor* should be much easier in light of *Trinity*. The possible threat posed by child predators is so high, and the intrusion into the work of private religious institutions so low, that an exception must exist for these security issues within the accommodations made for religious institutions that work with children.

Among the circuits, there is three way split of authority on applying the ministerial exception to Title VII of the 1967 Civil Rights Act: first, the primary duties test; second, the holistic approach; third, a case-by-case analysis.<sup>65</sup> In reality, the split is far greater with divides present in all three

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<sup>57</sup> Jennifer Park, Education Week Survey, *Across The Nation*, Apr. 30, 2003, <http://www.edweek.org/legacymedia/ew/vol-22/gallery/17webtable.pdf>.

<sup>58</sup> U.S. Dep’t of Educ., State Regulation of Private Schools (2009).

<sup>59</sup> *Id.*

<sup>60</sup> *Id.*

<sup>61</sup> *Villarin v. The Rabbi Haskel Lookstein School*, 96 A.D.3d 1 (N.Y. Sup. Ct. 2012).

<sup>62</sup> Mandatory Reporting of Child Abuse and Neglect 2013 Introduced State Legislation, Nat’l Conf. of St. Legislatures, Sept. 23, 2014, <http://www.ncsl.org/research/human-services/redirect-mandatory-rprtng-of-child-abuse-and-neglect-2013.aspx>.

<sup>63</sup> *Dwyer* at 1326.

<sup>64</sup> *Hosanna-Tabor Evangelical Lutheran Church & Sch. v. E.E.O.C.*, 132 S. Ct. 694, 710 (2012).

<sup>65</sup> W. Cole Durham and Robert Smith, *Religious Organizations and the Law* § 9.9 (2d ed. 2010), Westlaw (database updated 2015).

approaches, particularly a split between qualitative and quantitative evaluation of the primary duties test. These competing approaches result in inconsistent outcomes in factually indistinguishable cases.

The circuit split here is crucially important in this case: in some of the above mentioned circuits the ministerial exception would cover all school employees, under some it would only cover some school employees, and in still others it would cover no school employees. This kind of discrepancy cannot be allowed to exist, and after *Trinity* the Supreme Court is well situated to make this important clarification.

The Due Process Clause of the Fourteenth Amendment states that “[n]o state shall . . . deprive any person of life, liberty, or property, without due process of law.”<sup>66</sup> The Court clarified that the liberty embodied in the Due Process Clause includes the liberty to “establish a home and bring up children.”<sup>67</sup>

In, the Court expanded the rights of parents raising children, when it struck down an Oregon law that compelled all students in a specified age range to attend public schools.<sup>68</sup> The Court ruled that parents have a fundamental right to send their children to private schools. This right was reaffirmed in, where the Court held that a state’s interest in universal education had to be balanced against the fundamental rights of parents with respect to the upbringing of their children.<sup>69</sup> Time and time again, decisions of this Court have consistently upheld the fundamental right of parents to direct the education of their children, specifically whether to send them to public or nonpublic schools. As a fundamental right, this “parental liberty is to be protected by the highest standard of review.”<sup>70</sup>

Whenever government burdens a fundamental right, it implicates a strict scrutiny standard of review.<sup>71</sup> Strict scrutiny requires the government to prove that the burdensome government act is narrowly tailored to achieve a compelling state interest.

Parents are forced to choose between sending their children to public schools with mandated safety measures, or to private schools where the lack of mandated fingerprinting and background checks places their children in constant peril. Additionally, the First Amendment right to the Free Exercise of religion is also severely burdened here, as thousands of parents are

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<sup>66</sup> U.S. Const. amend. XIV.

<sup>67</sup> *Meyer v. Nebraska*, 262 U.S. 390, 399 (1923).

<sup>68</sup> *Pierce*, 268 U.S. at 535.

<sup>69</sup> *Wisconsin v. Yoder*, 406 U.S. 205, 214 (1972).

<sup>70</sup> Christopher J. Klicka, *Decisions of the United States Supreme Court Uphold Parental Rights as “Fundamental”*, Home School Legal Defense Association, Oct. 27, 2003, <http://www.hslda.org/docs/nche/000000/00000075.asp#18>.

<sup>71</sup> Stephen A. Siegel, *The Origin of the Compelling State Interest Test and Strict Scrutiny*, 48 THE AM. J. OF LEGAL HIST 355 (2006).

currently faced with the dilemma of choosing between their child's safety and their "fundamental interest of parents, as contrasted with that of the state, to guide the religious future and education of their children."<sup>72</sup>

In *Trinity* the Court made it clear that the safety and security of children are important enough considerations to override overbroad concerns about government entanglement in religion. I am hopeful that they will soon go on to clarify that they are also enough to override overbroad concerns about Free Exercise and Establishment regarding safety checks for children.

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<sup>72</sup> *Yoder*, 406 U.S. at 232 (emphasis added).





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# Intellectual Property

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Professor David Hricik received his undergraduate degree *magna cum laude* and *Phi Beta Kappa* from the University of Arizona, where he majored in English. He received his law degree with honors from Northwestern University School of Law. He practiced with Baker Botts and small litigation boutiques from 1988 to 2002, litigating cases primarily involving patent infringement, legal malpractice, and general complex commercial matters.

In 2002, he joined Mercer University School of Law, where he teaches legal ethics, patent law and litigation, federal civil procedure, and other courses. In 2012-13, he served as law clerk to Chief Judge Randall R. Rader at the Federal Circuit. He rejoined Mercer and also became Of Counsel to Taylor English Duma, LLP, where he continues to represent clients in patent and complex litigation.

He was elected to the American Law Institute in 2016. He has authored the only treatise on ethical issues in patent litigation, and co-authored the only treatise on ethical issues in patent prosecution. In addition to serving leadership positions on ethics committees with the AIPLA and ABA and serving as an expert witness, he has written dozens of articles and given well over 100 presentations on issues at the intersection of ethics and patents. His articles and testimony have been adopted by both state and federal courts.

## Supreme Court Update: Intellectual Property Cases

David Hricik<sup>\*</sup>

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## 1. Trademarks: Tam and “The Slants.”

Trademark law recognizes that distinctive marks—words, names, symbols, and the like—can help distinguish a particular person’s goods or services from those of others. A trademark thus serves to designate the goods or services as coming from a particular business, and in this way, protects the owner of the mark’s “good will against the sale of another’s product as his.” *United Drug Co. v. Theodore Rectanus Co.*, 248 U. S. 90, 97 (1918). Trademark law thus helps consumers identify goods and services that they wish to acquire or use, and to identify those they want to avoid.

Federal law does not create trademarks, and trademarks do not have to be federally registered for protection. Federal registration, however, confers important legal rights and benefits. Among other things, registration (1) serves as “constructive notice of the registrant’s claim of ownership” of the mark,” (15 U. S. C. §1072); (2) is “prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner’s ownership of the mark, and of the owner’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate,” (§1057(b)); and (3) can make a mark “incontestable” once a mark has been registered for five years,” (§§1065, 1115(b)). In addition, registration authorizes the trademark owner prevent importing into the United States of articles bearing an infringing trademark. *See* 15 U. S. C. §1124.

The Lanham Act bars certain trademarks from being registered. Foremost, a trademark that is “merely descriptive or deceptively misdescriptive” of goods cannot be registered. §1052(e)(1). Likewise, a mark cannot be registered if it is so similar to an already registered trademark or trade name that it is “likely . . . to cause confusion, or to cause mistake, or to deceive.” §1052(d). Most pertinent here, a mark cannot be registered if it “disparage[s] . . . or bring[s] . . . into contemp[t] or disrepute” any “persons, living or dead.” 15 U. S. C. §1052(a).

To determine whether a mark is disparaging the USPTO applied a two-part test. First, the trademark examiner considered “the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services.” Trademark Manual of Examining Procedure §1203.03(b)(i) (Apr. 2017). “If that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols,” the examiner then moves to the second step, asking “whether that meaning may be disparaging to a substantial composite<sup>3</sup> of the referenced group.” *Id.*

If in the second step the examiner finds that a “substantial composite, although not necessarily a majority, of the referenced group would find the proposed mark . . . to be disparaging in the context of contemporary attitudes,” this establishes a prima facie case of disparagement, and the burden shifts to the person seeking to register the mark to prove that it is not disparaging. *Id.* Significantly, the USPTO had stated that “[t]he fact that an applicant may be a member of that group or has good intentions underlying its use of a term does not obviate the fact that a substantial composite of the referenced group would find the term objectionable.” *Id.*

The lead-singer of an Asian-American “dance-rock” group decided to call the band “The Slants” as a way of reclaiming the term, which of course had become a pejorative phrase. *See Matal v. Tam*, \_\_\_ U.S. \_\_\_ (June 19, 2017). Tam sought to register the mark. The USPTO refused to register the mark holding it violated the “disparagement” clause (the same clause that had been invoked regarding the NFL’s Washington Redskins mark.)

The Court first held that the disparagement clause precluded registration of marks that referred to ethnic groups, not just specific people. In pertinent part the Court stated:

Tam’s argument is refuted by the plain terms of the disparagement clause. The clause applies to marks that disparage “persons.” A mark that disparages a “substantial” percentage of the members of a racial or ethnic group, Trademark Manual §1203.03(b)(i), at 1200–150, necessarily disparages many “persons,” namely, members of that group. Tam’s argument would fail even if the clause used the singular term “person,” but Congress’ use of the plural “persons” makes the point doubly clear

*Id.*

The Court then turned to the First Amendment issue: whether the refusal to register was unconstitutional government regulation of speech. Before reaching the conclusion that it was, the Court held that, though the issue was federal registration, it was not government speech (which is not subject to First Amendment restrictions, but private speech). The government had argued that this was governmental speech and so not subject to First Amendment scrutiny. The Court was not amused with that argument::

At issue here is the content of trademarks that are registered by the PTO, an arm of the Federal Government. The Federal Government does not dream up these marks, and it does not edit marks submitted for registration. Except as required by the statute involved here, 15 U. S. C. §1052(a), an examiner may not reject a mark based on the viewpoint that it appears to express. Thus, unless that section is thought to apply, an examiner does not inquire whether any viewpoint conveyed by a mark is consistent with Government policy or whether any such viewpoint is consistent with that expressed by other marks already on the principal register. Instead, if the mark meets the Lanham Act’s viewpoint-neutral requirements, registration is mandatory. *Ibid.* (requiring that “[n]o trademark . . . shall be refused registration on the principal register on account of its nature unless” it falls within an enumerated statutory exception). And if an examiner finds that a mark is eligible for placement on the principal register, that decision is not reviewed by any higher official unless the registration is challenged. See §§1062(a), 1071; 37 CFR §41.31(a) (2016). Moreover, once a mark is registered, the PTO is not authorized to remove it from the register unless a party moves for cancellation, the registration expires, or the Federal Trade Commission initiates proceedings based on certain grounds.

In light of all this, it is far-fetched to suggest that the content of a registered mark is government speech. If the federal registration of a trademark makes the mark government speech, the Federal Government is babbling prodigiously and incoherently. It is saying many unseemly things. See App. to Brief for Pro-Football, Inc., as Amicus Curiae. It is

expressing contradictory views. It is unashamedly endorsing a vast array of commercial products and services. And it is providing Delphic advice to the consuming public. For example, if trademarks represent government speech, what does the Government have in mind when it advises Americans to “make.believe” (Sony), “Think different” (Apple), “Just do it” (Nike), or “Have it your way” (Burger King)? Was the Government warning about a coming disaster when it registered the mark “EndTime Ministries”?

The PTO has made it clear that registration does not constitute approval of a mark. See *In re Old Glory Condom Corp.*, 26 USPQ 2d 1216, 1220, n. 3 (TTAB 1993) (“[I]ssuance of a trademark registration . . . is not a gov- ernment imprimatur”). And it is unlikely that more than a tiny fraction of the public has any idea what federal registration of a trademark means...

*Id.* (footnotes omitted).

The Court also quickly rejected the government’s argument that refusal to register was not regulation of speech, but was instead the refusal to subsidize a particular view point. Again the Court was not persuaded.

The Court decided that it did not need to determine whether trademarks contain expressive speech, or if they are “merely” commercial speech and so subject to the lightest scrutiny. It held that even under the most lax commercial speech standard, the disparagement clause was unconstitutional. The Court wrote, in full:

We need not resolve this debate between the parties because the disparagement clause cannot withstand even *Central Hudson* review. Under *Central Hudson*, a restriction of speech must serve “a substantial interest,” and it must be “narrowly drawn.” This means, among other things, that “[t]he regulatory technique may extend only as far as the interest it serves.” The disparagement clause fails this requirement.

It is claimed that the disparagement clause serves two interests. The first is phrased in a variety of ways in the briefs. Echoing language in one of the opinions below, the Government asserts an interest in preventing ““underrepresented groups” from being ““bombarded with demeaning messages in commercial advertising.”” Brief for Petitioner 48 (quoting 808 F.3d, at 1364 (Dyk, J., concurring in part and dissenting in part)). An amicus supporting the Government refers to “encouraging racial tolerance and protecting the privacy and welfare of individuals.” Brief for Native American Organizations as Amici Curiae. But no matter how the point is phrased, its unmistakable thrust is this: The Government has an interest in preventing speech expressing ideas that offend. And, as we have explained, that idea strikes at the heart of the First Amendment. Speech that demeans on the basis of race, ethnicity, gender, religion, age, disability, or any other similar ground is hateful; but the proudest boast of our free speech jurisprudence is that we protect the freedom to express “the thought that we hate.” *United States v. Schwimmer*, 279 U. S. 644, 655 (1929) (Holmes, J., dissenting).

The second interest asserted is protecting the orderly flow of commerce. Commerce, we are told, is disrupted by trademarks that “involv[e] disparagement of race, gender, ethnicity, national origin, religion, sexual orientation, and similar demographic classification.” 808 F.3d, at 1380–1381 (opinion of Reyna, J.). Such trademarks are analogized to discriminatory conduct, which has been recognized to have an adverse effect on commerce.

A simple answer to this argument is that the disparagement clause is not “narrowly drawn” to drive out trademarks that support invidious discrimination. The clause reaches any trademark that disparages any person, group, or institution. It applies to trademarks like the following: “Down with racists,” “Down with sexists,” “Down with homophobes.” It is not an anti-discrimination clause; it is a happy-talk clause. In this way, it goes much further than is necessary to serve the interest asserted.

The clause is far too broad in other ways as well. The clause protects every person living or dead as well as every institution. Is it conceivable that commerce would be disrupted by a trademark saying: “James Buchanan was a disastrous president” or “Slavery is an evil institution”?

There is also a deeper problem with the argument that commercial speech may be cleansed of any expression likely to cause offense. The commercial market is well stocked with merchandise that disparages prominent figures and groups, and the line between commercial and non-commercial speech is not always clear, as this case illustrates. If affixing the commercial label permits the suppression of any speech that may lead to political or social “volatility,” free speech would be endangered.

For these reasons, we hold that the disparagement clause violates the Free Speech Clause of the First Amendment. The judgment of the Federal Circuit is affirmed.

*Id.* (citations and footnotes omitted).

Four justices (Kennedy, Sotomayor, Ginsburg, and Kagan), largely writing on the nature of speech. Justice Thomas concurred, but believed that commercial speech was not subject to a lower standard, but agreed that the disparagement clause was unconstitutional even under that standard, and so concurred. Justice Gorsuch did not participate.

## **2. Patents: The Trend Toward Weakening Patents Continued in the Most Recent Term.**

The Court in its most recent term issued several decisions which reduced the power of patents. These are part of a trend starting in 2006 and continuing through today.

### **A. The Supreme Court has Routinely Reversed Federal Circuit Decisions and in Doing So Made Patents More Difficult to Obtain, Easier to Invalidate, Harder to Infringe, and Also Limited Likely Remedies.**

A 2011 study concluded that the Supreme Court had reversed the Federal Circuit's patent law decisions 70 percent of the time, and, if anything, the reversal rate has since increased.<sup>1</sup> This Section summarizes key Supreme Court decisions from this century, organized according to which aspect of patent rights the cases affected. It shows that the Court has almost uniformly reduced the coercive power of patents by making patents easier to invalidate (and, as a consequence, harder to obtain from the USPTO), riskier to enforce, and—perhaps most fundamentally—has made it clear a patent in fact does not give its owner the general right to exclude others from infringing.<sup>2</sup> A business considering whether to apply for a patent knows that patents are harder to get, easier to lose, riskier to use, and less likely to result in being able to prevent competitors from infringing.

To be clear and at the outset, the fact that the Court weakened patent rights does not mean that any or all of its decisions were legally incorrect, that the Federal Circuit's general trend toward a stronger patent system is mandated by the Patent Act or the Constitution, or that a stronger patent system is somehow “better” in terms of innovation or other social goals.<sup>3</sup> In that regard, studies from the Federal Trade Commission (FTC) in 2003 and later from the National Academy of Sciences in 2005 pointed to excesses in the system.<sup>4</sup> The point made in this Part is not whether any or all decisions were legally correct or effectuated sound policy; the point is that patents are weaker as a result.

### **1. The Supreme Court Made Fewer Inventions Patentable, and as a Result Made More Issued Patents Invalid.**

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<sup>1</sup> Paul R. Gugliuzza, *How Much has the Supreme Court Changed Patent Law?*, 16 Chi-Kent Intell. Prop. L.J. 330, 330-31 (2017).

<sup>2</sup> The Supreme Court has decided many patent cases this century. Some patent cases decided by the Court either had no obvious impact on patenting, or likely impact a narrow range of patents or industries. *E.g.*, *Bd. Of Trustees of Stanford Univ. v. Roche Molecular Sys.*, 563 U.S. 776 (2011); *Gunn v. Minton*, 133 S.Ct. 1059 (2013); *Fed. Trade Comm'n v. Actavis, Inc.*, 133 S.Ct. 2223 (2013). Some argue that the Court has decided some patent cases to prevent the Federal Circuit from treating patent law differently from analogous areas of law, of engaging in “patent exceptionalism.” Peter Lee, *The Supreme Assimilation of Patent Law*, 114 Mich. L. Rev. 1413 (2016).

<sup>3</sup> *See generally*, Maureen K. Ohlhausen, *Patent Rights in a Climate of Intellectual Property Skepticism*, 30 Harv. J. L. & Tech. 103 (Fall 2016) (analyzing empirical data regarding the strength of patent protection and innovation); Mark A. Lemley, *IP in a World Without Scarcity*, 90 N.Y.U. L. Rev. 460 (2015); Robin Cooper Feldman, *Patent Demands & Startup Companies: The View from the Venture Capital Community*, 16 YALE J.L. & TECH. 236 (2014).

<sup>4</sup> *See* Fed. Trade Comm'n to Promote Innovation: The Proper Balance of Competition and Patent Law and Policy (2003); Comm. on Intell. Prop. Rights in the Knowledge-Based Econ., Nat'l Acad. Of Sciences, *A Patent System for the 21<sup>st</sup> Century* (81-83) Stephen A. Merrill et al, eds.) (2004).

The concept of patentability and invalidity are related but distinct. The USPTO decides patentability. During the application process, the USPTO determines whether an invention claimed in a patent application is “patentable.”<sup>5</sup> Likewise, in post-grant proceedings, the USPTO determines whether a claim in a patent that it previously issued is patentable. In litigation, courts decide whether a claim in an issued patent is “invalid.”<sup>6</sup> As a general matter, the same legal principles apply to patentability and invalidity, although as noted below there are important differences.<sup>7</sup> Thus, in deciding whether an invention is patentable, the USPTO follows case law from the Supreme Court (and the Federal Circuit) that addresses invalidity.<sup>8</sup>

Importantly, if the Supreme Court’s interpretation of what is patentable narrows after a patent issues, the courts and the USPTO apply that law retroactively. The fiction, of course, is that the law did not change but that, effectively, the USPTO had been wrong in its understanding. Thus, a patent that the USPTO properly issued—at least as it understood the law as it existed at that time—might, nonetheless, be “invalid” in later litigation. Likewise, a patent that the USPTO properly issued under the law as it understood it at the time could be found by the USPTO to be unpatentable in a post-grant proceeding.<sup>9</sup> A change in the law could mean that issued patents are no longer valid. This section shows that the Court has made patents easier to invalidate, and consequently more difficult to be patentable, in several recent cases.

### **A. The Supreme Court Made Fewer Inventions Eligible for Patenting.**

Section 101 of the Patent Act is permissive, stating only that “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and

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<sup>5</sup> Summarizing the entirety of patent law is outside the scope of this Article. Generally, however, patent law requires that for a claimed invention to be patentable: (1) the subject matter must be eligible for patenting under Section 101; (2) the claimed invention must be “new” in terms of Section 102; (3) the claimed invention must have been “nonobvious” in terms of Section 103; (4) the claim must be definite in terms of Section 112; and (5) the must patent disclose how to make and use the invention and it include the best mode for doing so. 35 U.S.C. 101, 102, 103, 112. Each is a requirement to obtain a patent: the USPTO should not issue a patent that fails to meet any of those requirements. Further, each requirement (apart from best mode), is a basis for invalidity of a patent. 35 U.S.C. 282(b).

<sup>6</sup> See generally, *Cuozzo Speed Technologies, LLC v. Lee*, 136 S. Ct. 2131 (2016).

<sup>7</sup> See notes \_\_ to \_\_ *infra* and accompanying text.

<sup>8</sup> For this reason, the USPTO generally relies on Supreme Court and Federal Circuit precedent deciding invalidity issues when determining patentability. *E.g.*, MPEP 2173 (citing *Nautilus* for indefiniteness). However, there are differences between invalidity and unpatentability, and they are critical. As shown more fully below, the burden of proof required to show invalidity is higher—clear and convincing evidence, not preponderant evidence—and the claims are interpreted more broadly by the USPTO than in litigation. See notes \_\_ to \_\_ *infra* and accompanying text. Other differences between validity and patentability exist, including the fact that the USPTO, in determining whether a claim would have been obvious, uses a burden-shifting process that likely does not apply to determine invalidity for obviousness. See *Wm. Wrigly Jr. Co. v. Cadbury Adams USA LLC*, 683 F.3d 1356 (Fed. Cir. 2012).

<sup>9</sup> On a related note, the USPTO has for years had a backlog of applications; some of those no doubt were filed at a time when the applicant reasonably believed the invention was patentable. See generally, Warren K. Mabey, Jr., *Deconstructing the Patent Application Backlog... a Story of Prolonged Pendancy, PCT Pandemonium & Patent Pending Pirates*, 92 J. Pat. & Trademark Off. Soc’y 208 (2010) (discussing backlog generally).

requirements of this title.”<sup>10</sup> Consistent with its permissive language, Section 101 had been largely ignored in patent prosecution and litigation as a requirement for patenting and basis for invalidity until 2010.<sup>11</sup>

In the last seven years, however, the Supreme Court issued a series of cases that “have significantly impacted patent eligibility law[.]”<sup>12</sup> In those cases, the Court restricted what inventions are even eligible for patenting by reversing the Federal Circuit’s holdings that each of the following inventions, even if new and nonobvious, was not even eligible for patent protection: a method for hedging risk;<sup>13</sup> a method for optimizing drug dosages;<sup>14</sup> a claim to isolate genes;<sup>15</sup> and, most recently, a claim to a computer-implemented method to mitigate settlement risk.<sup>16</sup>

The consequence of these decisions is multifaceted. First and foremost, fewer inventions are patentable now, reducing the incentives to patent. Second, patents that were issued before these decisions are more easily invalidated.<sup>17</sup> Finally, the procedural safeguards that courts afford when determining invalidity based on other bases of invalidity of the Patent Act are not afforded in applying Section 101. Specifically, patents are being found “invalid” under Section 101 at the pleading stage and without clear and convincing evidence of invalidity, explaining why although it is very rare for a court to find a patent invalid on the pleadings for any other basis of invalidity in the patent act, they find ineligibility frequently at the pleading stage.<sup>18</sup> Because Section 101 can be raised early and relatively cheaply, it reduces patent protection.

It is difficult to understate the impact of the Supreme Court’s decisions involving Section 101.<sup>19</sup> Thousands of patents likely became invalid after these decisions, essentially rendering them worthless, at best. The impact has been felt most particularly in the life sciences and computer technologies areas of innovation.<sup>20</sup> In that regard, a 2016 analysis determined that the Supreme Court had “crushed” certain secondary markets relating to computer technologies.<sup>21</sup> Plainly, because fewer inventions are eligible for patenting, there is less incentive to patent. Further, because issued patents may be “ineligible,” there is less incentive to acquire patents on the secondary market. There is less reason to file a patent application today than there was in 2010, before the Court decided these cases.

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<sup>10</sup> 35 U.S.C. 101.

<sup>11</sup> See generally, Robert R. Sachs, *Patent Invalidation Rates: The Summertime Blues Continue*, Law 360.com (Sept. 2, 2015) (showing that the “courts invalidated more patents in the 14 months since [the 2014 Supreme Court decision in *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S.Ct. 2347 (2014)] then in the five years previous to *Alice*.”).

<sup>12</sup> USPTO, Patent Eligible Subject Matter, at 7.

<sup>13</sup> *Bilski v. Kappos*, 561 U.S. 593, 599 (2010).

<sup>14</sup> *Mayo Collaborative Serv. v. Prometheus Labs., Inc.*, 566 U.S. 66 (2012).

<sup>15</sup> *Ass’n. for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S.Ct. 2107 (2013).

<sup>16</sup> *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S.Ct. 2347 (2014).

<sup>17</sup> <http://www.bilskiblog.com/blog/2017/06/alicestorm-april-update-and-the-impact-of-tc-heartland.html>

<sup>18</sup> See Saurabh Vishnubhakat, *The Antitrusting of Patentability*, Figs. 1 & 2.

<sup>19</sup> A recent analysis concluded that the Federal Circuit is, by issuing opinions only when district courts err in finding a patent ineligible, by silence the law is moving even further against patentees. Paul R. Gugliuzza & Mark A. Lemley, *Can a Court Change the Law by Saying Nothing?*, (2017 draft).

<sup>20</sup> USPTO, Patent Eligibility at 47.

<sup>21</sup> Kent Richardson, 2016 Brokered Patent Market, ROL Grp (available at <https://www.law.berkeley.edu/wp-content/uploads/2016/09/Richardson-Investment-Portfolios-Buying-Selling-Litigation.pdf>)

## **B. The Supreme Court Made it Harder to Obtain a Patent and Easier to Invalidate One.**

The requirement that an invention be “new” essentially means the invention claimed in a patent application must be different – in some way – from those inventions that had been previously disclosed to the public. If there is a difference, the invention is “new.” But beyond a literal difference, the patent laws require that the difference between the claimed invention and what was known before also would not have been obvious to a person of ordinary skill in the art. Determining whether an invention would have been obvious is a complex endeavor since the question is, without knowing of the invention, would it have been obvious to make it?<sup>22</sup>

The Federal Circuit had long held that patent could be held invalid as obvious only if the prior art explicitly taught, suggested, or otherwise provided a motivation to combine prior art references to make the claimed invention.<sup>23</sup> Essentially, there had to be written evidence in a patent or article that suggested doing or trying what was different between the claimed invention and the prior art. In *KSR v. Teleflex*, the Federal Circuit applied that test to reverse a district court finding of obviousness.<sup>24</sup>

The Supreme Court reversed and rejected the test,<sup>25</sup> calling it a “rigid and mandatory formula,” and instead held that there need not have been “published articles and the explicit content of issued patents,” but instead obviousness could be found by using “common sense, market demand, or design trend.”<sup>26</sup> *KSR* made it more difficult to obtain a patent and easier to invalidate an existing one by eliminating the need for written proof that someone would have been motivated to do what the inventor did.<sup>27</sup>

Another requirement for patentability and also a basis for invalidity is that each claim of a patent must be “definite.” Specifically, Section 112 of the Patent Act requires that a patent point out and distinctly claim the invention.<sup>28</sup> Failure to meet this requirement is called “indefiniteness.”

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<sup>22</sup> See Glynn S. Lunney, Jr, Christian T. Johnson, *Not so Obvious After All: Patent Law’s Nonobviousness Requirement, KSR, and the Fear of Hindsight Bias*, 47 Ga. L. Rev 41 (2014).

<sup>23</sup> *Id.*

<sup>24</sup> *Id.*

<sup>25</sup> *KSR Int’l. Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).

<sup>26</sup> *Id.*

<sup>27</sup> Ali Mojibi, *An Empirical Study of the Effect of KSR v. Teleflex on the Federal Circuit’s Patent Validity Jurisprudence*, 20 ALB. L.J. SCI. & TECH. 559, 572-73, 596 (2010) (Concluding that district courts were “over seven times more likely to find patents obvious as a result of *KSR*” and the Federal Circuit was also “more likely ... to find a patent obvious on review”); Jennifer Nock & Sreekar Gadde, *Raising the Bar for Nonobviousness: An Empirical Study of Federal Circuit Case Law Following KSR*, 20 Fed. Cir. B.J. 369, 407 (2011) (concluding that *KSR* had made it easier to find invalidity for obviousness); Jason Rantanen, *The Federal Circuit’s New Obviousness Jurisprudence: An Empirical Study*, 16 Stan. Tech. L. Rev. 709, 764 (2013) (“the Federal Circuit has indeed found patents and applications to be obvious at a higher rate than it did prior to *KSR* ....”).

<sup>28</sup> 35 U.S.C. 112.

The Federal Circuit had held that indefiniteness required clear and convincing evidence that the claim was “not amenable to construction” or was “insolubly ambiguous” as construed.<sup>29</sup> The Supreme Court rejected the Federal Circuit’s test as too narrow, thus making it harder to obtain patents and rendering issued patents more likely to have indefinite claims.<sup>30</sup> Specifically, the Supreme Court required a claim to provide “reasonable certainty” about its scope.<sup>31</sup> It is not clear, yet, the degree to which the case will make it easier to establish invalidity but, it makes invalidity for indefiniteness easier to prove and so, likewise, patentability more difficult to establish.<sup>32</sup>

Whatever the degree of change, patents are harder to obtain and easier to invalidate. To that extent, businesses have less reason to patent.

## **2. The Supreme Court Made Infringement More Difficult to Establish.**

A 2010 study concluded that a key reason why businesses avoided seeking patent protection was that it was difficult to prove infringement, owing to both the narrow nature of patent claims and the ability of competitors to design around them.<sup>33</sup> In a series of cases, the Supreme Court has made it even easier for competitors to avoid infringement. This took three forms.

First, the Court restricted the scope of a patentee to establish that a competitor’s product, although not literally infringing a patent, nonetheless, infringed because it was an “equivalent.” The Court made it harder for a patentee to show that a competitor “induced” a customer to infringe a patent. And, in addition, the Court made it easier for competitors to avoid infringement by combining components of a patented combination only after they were shipped abroad.

A rudimentary understanding of patent claims and prosecution is necessary to understand the first limitation. The USPTO does not determine that a patent application, as a whole, should be issued as a patent, but instead examines each claim in a patent application to determine whether it meets the requirements of the Patent Act. Among other things, the USPTO should not allow a claim to issue in a patent if it determines that the invention as described in the claim as not “new” or would have been “obvious” compared to the “prior art.” Generally speaking, this requires the USPTO to interpret the claim, and then to determine whether as interpreted what it claims is different from what was publicly known at the time the application was filed, and if so, whether those differences would have been obvious at the time of the invention.

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<sup>29</sup> *Biosig Instruments, Inc. v. Nautilus, Inc.*, 715 F.3d 891, 898 (Fed. Cir. 2013) (reversed by *Nautilus v. Biosig*, 134 S. Ct. 2120 (2014)).

<sup>30</sup> *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S.Ct. 2120 (2014).

<sup>31</sup> *Id.*

<sup>32</sup> See generally, Janet M. Smith, *Indefiniteness as an Invalidity Case*, 58 Wm. & Mary L. Rev. 1404 (2017); Norris Boothe, *Exercising a Duty of Clarity: Nautilus, Inc. v. Biosig Instruments, Inc.*, 30 Berkeley Tech. L.J. 445 (2015).

<sup>33</sup> Ted Sichelman & Stuart J.H. Graham, *Patenting by Entrepreneurs: An Empirical Study*, 17 Mich. Telecomm. & Tech. L. Rev. 111, 170 (2010).

If the USPTO allows a patent claim without ever having rejected it, that claim can be infringed if the patentee proves a single defendant<sup>34</sup> made a product literally covered by the claim or infringed the patent under the “doctrine of equivalents.” By way of simple example, if a patent claim covered “a pizza comprising dough, covered by sauce, covered by cow’s milk cheese,” an accused infringer’s cheese pizza would literally infringe that claim. If the accused infringer used a mixture of goat’s cheese and cow’s cheese, the patentee could argue that the mixture was “equivalent” to the claimed “cow’s milk cheese.”

If the USPTO determines a claimed invention is the same as what was already known in the prior art, it rejects the claim, likewise, if it determines that, although different from the prior art, the claim covers something that “would have been obvious” over the prior art, the USPTO should reject it. A patent applicant can choose to “traverse” a rejection—by arguing that the claim is narrower than the USPTO believes, or that the prior art impermissibly fails to disclose what it claims—or the applicant can amend the claim, narrowing it to no longer cover what was known or obvious in the prior art.

Amendments cost money and delay prosecution,<sup>35</sup> and they have always created the potential for any resulting narrowed claim to not have as wide a range of equivalents as an unamended claim. In a perfect world, therefore, lawyers for patent applicants would include claims that are exactly as broad as the prior art allows.

The reality is that examiners routinely reject claims for lack of novelty or for being obvious. This is not because patent lawyers routinely do bad jobs. Instead, it is because of one of the two reasons noted above—the USPTO reads the claim more broadly than did the lawyer or it reads the prior art more broadly—or a third reason: the USPTO has found prior art that the lawyer did not know of. It is common for patent claims to be amended during prosecution.

Thus, it is common for claims to be amended. Thus, judicial decisions that make it harder for a business to prove infringement of an amended claim is significant because it goes to a key reason why businesses avoid patents: the difficulty of proving infringement.

The Supreme Court did just that when it overruled Federal Circuit precedent applying what is called “prosecution history estoppel”—also known as “file wrapper estoppel.” In *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*,<sup>28</sup> the Supreme Court imposed a burden on the patentee who had amended a claim to show that the amendment did not surrender the particular equivalent in question. Put in terms of pizza, suppose that as originally filed, the claim had stated, “a pizza comprising dough, covered by sauce, covered by cheese,” but had been rejected as “old” by the examiner. In response, the applicant had amended it to avoid the prior art to state “a pizza comprising dough, covered by sauce, covered by *cow’s milk cheese*,” and, as amended, the claim issued. If the patentee then sued a pizza maker who used a mixture of goat and cow cheese, the patentee would have to show that it had not surrendered claiming it. Under

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<sup>34</sup> As discussed below, in some instances if one person infringes a patent, another person can be liable as an infringer if it contributed to or induced that infringement.

<sup>35</sup> AIPLA Economic Survey at 30 (identifying costs of preparing amendments and responses to office actions rejecting a claim).

<sup>28</sup>535 U.S. 722, 740–41 (2002).

*Festo*, the patentee can rebut the presumption, but only by showing that the equivalent had not been foreseeable at the time of the amendment, that the rationale for the amendment was no more than “tangentially related” to the alleged equivalent, or that there had been “some other reason” that the patentee could not reasonably have been expected to have described the equivalent.<sup>29</sup>

Given patent claims are routinely narrowed during prosecution, *Festo* limited the scope of many patent claims. Specifically, empirical studies show that it was far less likely for infringement to be found by equivalents after *Festo*,<sup>36</sup> and that decision curtailed the coercive rights of patent owners. Businesses avoid patenting because of the perception infringement is difficult to prove, and the Supreme Court made that even harder.

In other decisions, the Supreme Court made infringement more difficult to establish by narrowing the scope of what constitutes “induced” infringement. In addition to making a party who infringes a patent liable to the patentee, the Patent Act imposes liability on a party who, while not itself infringing, induces another person to do so.<sup>37</sup> Thus, for example, a patentee can recover from a defendant who did not itself perform every step of a patented method, but who induced another to perform the patented method.

In two of three decisions the Court narrowed the scope of inducement. In the first case narrowing inducement, *Global-Tech*,<sup>38</sup> the Court rejected the Federal Circuit’s view that inducement could occur either if the defendant knew that a patent would be infringed, or if it merely knew of a risk that infringement would occur. The Court held that inducement requires proof that the defendant knew of the patent and knew the induced acts would infringe.<sup>39</sup> In the second case, *Limelight Networks*, the Court narrowed induced infringement in another way.<sup>40</sup> The Federal Circuit had held that a defendant could induce infringement of a method claim if it “carries out some steps constituting a method patent and encourages others to carry out the remaining steps.”<sup>41</sup> The Supreme Court reversed, and held that unless one person carried out all of the steps, there was *no infringement* and, without infringement, there could be no inducement of any infringement. The Court reached its holding though recognizing its ruling would permit a competitor to evade liability by dividing performance patented method with a party it does not control.<sup>42</sup> However, in *Commil*,<sup>43</sup> the Court slightly expanded liability for inducement by narrowing available defenses. The Federal Circuit had held that a party could avoid liability for induced infringement if it had a good faith belief that either the acts it was inducing did not infringe *or* that the patent was invalid.<sup>44</sup> The Court held that a good faith belief in invalidity was

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<sup>29</sup>*Id.*

<sup>36</sup> See generally, John R. Allison & Mark A. Lemley, *The (Unnoticed) Demise of the Doctrine of Equivalents*, 59 Stan. L. Rev. 955, 966-69 (2007); Lee Petherbridge, *On the Decline of the Doctrine of Equivalents*, 31 Cardozo L. Rev. 1371, 1387, 1390, 1394-95 (2010).

<sup>37</sup> 35 U.S.C. 271(b).

<sup>38</sup> *Global-Tech Appliances, Inc. v. SEB S. A.*, 131 S.Ct. 2060 (2011).

<sup>39</sup> *Id.*

<sup>40</sup> *Limelight Networks, Inc. v. Akamai Techns., Inc.*, 134 S.Ct. 2111 (2014).

<sup>41</sup> *Id.*

<sup>42</sup> *Id.*

<sup>43</sup> *Commil USA, LLC v. Cisco Sys., Inc.*, 135 S.Ct. 1920 (2015).

<sup>44</sup> *Id.*

not a defense.<sup>45</sup>

Not only did the Court narrow the scope of infringement by equivalents and made it more difficult to prove induced infringement, the Court made it more difficult to prove infringement in cases involving acts occurring overseas. Generally, patent infringement must occur in the United States, but the Patent Act contains exceptions which create liability for extra-territorial acts. The Court narrowed the scope of extra-territorial infringement in two cases.

In the first, *Microsoft*,<sup>46</sup> the Court analyzed Section 271(f) of the Patent Act, which provides that infringement occurs when one “suppl[ies] . . . from the United States,” for “combination” abroad, a patented invention’s “components.”<sup>47</sup> The Federal Circuit had held that Microsoft was liable for infringement of an AT&T patent because AT&T had provided a copy of Microsoft’s patented software to foreign manufacturers, and those manufacturers installed the infringing software on computers sold abroad.<sup>48</sup> The Court reversed, holding that because Microsoft did not supply the actual copy of the software installed, merely a master disk from which the manufacturers made the copies, Microsoft did not supply a “component.”<sup>49</sup>

The Court also narrowed the scope of what acts occurring abroad could constitute infringement in *Life Tech. Corp. v. Promega Corp.*<sup>50</sup> In that case, the Court analyzed the provision of the Patent Act that makes it an act of infringement for someone to supply from the United States “all or a substantial portion” of the components of an invention patented in the United States while knowing that the components are to be assembled abroad in a manner which, if done in the United States, would infringe that patent.<sup>51</sup> In *Life Tech.*, the patentee asserted infringement against a defendant who had supplied one component of a multi-component patented invention.<sup>52</sup> The jury found infringement, and the Federal Circuit reversed the district court’s grant of judgment as a matter of law to the defendant, reinstating the verdict.<sup>53</sup> In doing so, the Federal Circuit held that one component could be “a substantial portion” of a multi-component patented invention if that component was sufficiently important to the invention, meaning if it was qualitatively substantial.<sup>54</sup> The Supreme Court reversed, instead holding that “substantial portion” required a quantitative assessment.<sup>55</sup> The Court further held that the supplier of one component as a matter of law could never be liable for infringement under this provision of the Patent Act.<sup>56</sup>

Thus, the Court has almost uniformly made it more difficult to establish infringement and narrowed the scope of what can infringe, albeit by different ways and, no doubt, each case did so

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<sup>45</sup> *Id.*

<sup>46</sup> *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437 (2007).

<sup>47</sup> 35 U. S. C. §271(f)(1).

<sup>48</sup> *Microsoft*, 550 U.S. at \_\_\_\_.

<sup>49</sup> *Id.*

<sup>50</sup> 137 S.Ct. 734 (2017).

<sup>51</sup> 35 U.S.C. 271(f)(1).

<sup>52</sup> *Id.*

<sup>53</sup> *Id.*

<sup>54</sup> *Id.*

<sup>55</sup> *Id.* Justice Roberts did not participate, and Justices Alito and Thomas concurred in part and in the judgment. *Id.* at 743.

<sup>56</sup> *Id.*

to a different extent. The net effect reduced the scope of patent infringement, which in turn reinforced a key reason why businesses avoided patenting.<sup>57</sup> Although the next topic, exhaustion, relates to infringement, it is somewhat distinct but the Court’s decisions on that topic likewise made it more difficult to show infringement.

### 3. The Supreme Court Expanded the Doctrine of “Exhaustion” of Patent Rights.

While, as explained above, a patentee has the right to obtain damages from someone who infringes a valid patent, the authorized sale by a patentee of a product “exhausts” the patentee’s rights in the product. To return to pizza, if the owner of a patent on pizza sells the pizza to a consumer, that consumer sell it to a third party, and the patentee cannot sue that third party. The patentee is deemed to have “exhausted” its patent rights by selling the patented product: the power of coercion ends when the rights are “exhausted” by first sale of the patented product.<sup>58</sup> In two cases, the Court made it easier for patent rights to become exhausted, narrowing the scope of patent protection.

In the first case, *Quanta*, the Federal Circuit had held that the exhaustion doctrine did not apply to method claims, at all.<sup>59</sup> The Court reversed, holding that the sale of a product that “embodies” the method.<sup>60</sup>

The second case, *Lexmark*,<sup>61</sup> addressed whether manufacturers could avoid exhaustion by inserting restrictive contractual provisions on the original purchaser’s rights, such as prohibiting any re-sale of the manufacturer’s product—i.e., “resale of this pizza is expressly prohibited.” In that case, a manufacturer of printer cartridges for laser printers, Lexmark,<sup>62</sup> by contract prohibited purchasers from re-using its cartridges and prohibited their resale.<sup>63</sup> However, other companies, called “remanufacturers,” bought the used cartridges from consumers, and then refurbished and resold them.<sup>64</sup> Lexmark sold some of the cartridges in the United States with the restriction on resale, but others were sold to foreign consumers without the restriction and then purchased by the remanufacturers who imported them into the United States.<sup>65</sup> Lexmark sued the remanufacturers for patent infringement, arguing that domestic consumers were bound

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<sup>57</sup> The Court decided other cases involving infringement. Foremost, the Court in *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 135 S.Ct. 831 (2015) reversed the Federal Circuit’s approach to reviewing interpretation of a claim *de novo*, instead holding that to the extent district courts rely upon extrinsic evidence, the Federal Circuit should review for clear error. While on its face this is a neutral decision—it does not narrow the scope of a patent claim—it does take power away from the Federal Circuit. In another case, *Merck KGaA v. Integra LifeSciences I, Ltd.*, 535 U.S. 193 (2005), the Court rejected the Federal Circuit’s view of the “safe harbor” in 35 U.S.C. § 271(e)(1), which makes certain drug testing not infringement of a patent.

<sup>58</sup> *Impression Prods., Inc. v. Lexmark Int’l, Inc.*, 137 S.Ct. 1523 (2017).

<sup>59</sup> *Quanta Computer Corp. v. LG Elec., Ltd.*, 553 U.S. 617 (2008).

<sup>60</sup> *Id.*

<sup>61</sup> *Impression Prods., Inc. v. Lexmark Int’l, Inc.*, 137 S.Ct. 1523 (2017).

<sup>62</sup> *Id.*

<sup>63</sup> *Id.*

<sup>64</sup> *Id.*

<sup>65</sup> *Id.*

not to re-sell the cartridges and that an unrestricted sale abroad did not “exhaust” domestic patent rights.<sup>66</sup>

The Federal Circuit in an *en banc* decision had held the remanufacturers’ activities both in and outside the United States infringed Lexmark’s patent. As to domestic sales, the court reasoned that because the remanufacturers knew of the restrictions, which were lawful, its sales were “without authority” of Lexmark and so constituted infringement under 35 U.S.C. § 271(a), which provides that “whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.”<sup>67</sup> With respect to products Lexmark sold abroad, but were then imported into the United States, the court reasoned that only an authorized sale in the United States exhausted United States patent rights. Thus, the Federal Circuit allowed the patentee to keep its coercive rights intact.

The Court reversed both holdings. With respect to domestic sales, it held that the sale “terminates all patent rights to that item,” and functions “automatically.”<sup>68</sup> The Court stated that, while Lexmark might have contractual remedies against domestic consumers who sold their cartridges to the remanufacturers, it had no patent rights after the sale.<sup>69</sup> The Court reached the same “straightforward” result with respect to the cartridges sold by Lexmark abroad, holding that an “authorized sale outside the United States, just as one within the United States, exhausts all rights under the Patent Act.”<sup>70</sup>

Collectively, these cases narrowed the right to exclude by narrowing what constitutes infringement. The sale of a product “embodying” a method claim no longer infringes. Nor can a patentee assert infringement based upon violation of sale or use restrictions to an original purchaser.<sup>71</sup>

#### **4. The Supreme Court Made Asserting Patents Riskier and More Difficult.**

The Court has reversed the Federal Circuit in key cases relating to both substantive and procedural patent law, each of which made patent litigation more difficult or riskier for the patent owner.<sup>72</sup> It did this in various ways.

First, the Supreme Court increased the number of potential challengers to a patent by allowing even those who took a license under a patent to challenge its validity while continuing

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<sup>66</sup> *Id.*

<sup>67</sup> 35 U.S.C. 271(a).

<sup>68</sup> *Id.*

<sup>69</sup> *Id.*

<sup>70</sup> *Id.*

<sup>71</sup> The degree to which they have done so will vary by industry. Some industries—pharmaceuticals, for example—may be able to rely upon import restrictions to prevent importation into the United States of products sold abroad.

<sup>72</sup> The Supreme Court also made patent litigation riskier when it issued *Cuozzo Speed Technologies, LLC v. Lee*, 136 S. Ct. 2131 (2016), which held that the USPTO had the power to enact regulations which make it easier to challenge issued patents.

to honor the license. In *MedImmune, Inc. v. Genentech, Inc.*, the Federal Circuit held that federal courts lacked subject matter jurisdiction to issue a declaratory judgment that a patent was invalid if the declaration was sought by a licensee who was continuing to pay a royalty for a licensed patent.<sup>73</sup> The only way a licensee could sue for a declaration of invalidity was to breach the license by stopping payment.

The Supreme Court reversed.<sup>74</sup> The Court permitted a licensee to sue for a declaratory judgment of invalidity even while continuing to pay under the license. This allowed the licensee to avoid the consequences of breaching the license, thus enabling a party to avoid breaching the license while challenging the validity of the licensed patent.<sup>75</sup> In a related case, the Court also rejected the Federal Circuit's holding that a licensee bears the burden to show infringement if he or she brings suit for a declaration that its products do not infringe, holding instead that the patentee must establish infringement of the licensed products.<sup>76</sup>

Second, in *TC Heartland*, the Court made it more difficult to enforce a patent by significantly reducing which districts could serve as proper venue for patent infringement suits. The Federal Circuit had held in 1990 that venue in a patent suit was appropriately placed in any district in which a defendant had a regular place of business.<sup>77</sup> That decision permitted patent suits against corporations in many federal district courts, therefore allowing patentees to “forum-shop.”<sup>78</sup> The Federal Circuit's interpretation allowed patentees to file suits in the Eastern District of Texas and other districts even when the suit and defendant had very little connection to the venue, and led to criticisms of those districts as having become cottage industries for abusive patent infringement suits brought by patent assertion entities.<sup>79</sup>

In *TC Heartland LLC v. Kraft Food Groups Brands LLC*,<sup>80</sup> the Supreme Court reversed the Federal Circuit's 25-year old interpretation, thus markedly reducing the proper venues to file patent infringement suits. This reduced the ability of patentees to sue in districts which they might perceive as more patentee-friendly, such as the Eastern District of Texas. To the extent that a broader range of proper venues allowed patentees to obtain greater recoveries, and in the marginal case where suit could not be economically brought in the fewer remaining proper venues, the decision in *TC Heartland* reduced the value of patents to obtain coercive relief.<sup>81</sup> Further, while it was easy for patentees to have proper venue in many venues prior to *TC Heartland*, not only are fewer venues proper, but identifying which venue is proper can be

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<sup>73</sup> E.g., *Gen-Probe, Inc. v. Visis, Inc.*, F.3d (Fed. Cir. 2004).

<sup>74</sup> *MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. 118 (2007)

<sup>75</sup> See generally, Alan D. Miller & Michal S. Gal, *Licensee Patent Challenges*, 32 Yale J. on Regulation 122 (2015) (discussing other contractual provisions that might prevent licensee challenges).

<sup>76</sup> *Medtronic, Inc. v. Mirowski Family Ventures, LLC*, 134 S.Ct. 843 (2014).

<sup>77</sup> *VE Holding Corp. v. Johnson Gas Appliance Co.*, 917 F.2d 1574 (Fed. Cir. 1990).

<sup>78</sup> Kimberly A. Moore, *Forum Shopping in Patent Cases: Does Geographic Scope Affect Innovation*, 79 N.C. L. Rev. 889, 897 (2001). Then-Professor Moore was appointed to the Federal Circuit in 2006.

<sup>79</sup> See Brian J. Love & James Yoon, *Predictably Expensive: A Critical Look at Patent Litigation in the Eastern District of Texas*, 20 Stan. Tech. L. Rev. 1 (2017); Lemley, *Resilience of the Patent System*, 95 Tex. L. Rev. at 4-6.

<sup>80</sup> *TC Heartland LLC v. Kraft Foods Groups Brands LLC*, 137 S.Ct. 1514 (2017).

<sup>81</sup> See generally, Ana Santos Rutschman, *Patent Venue Exceptionalism after TC Heartland v. Kraft*, 25 U. Miami Bus. L. Rev. 29 (2017).

expensive and, in some instances, uncertain—meaning that defendants can choose to increase enforcement costs by contesting venue.<sup>82</sup>

To understand the impact of the next few cases requires a brief overview of patent litigation costs. Patent litigation is very expensive—median costs have generally ranged from \$600,000 for cases worth less than \$1 million, to about \$2 million for cases valued in the \$10 to \$25 million range.<sup>83</sup> If the general rule is that each side must bear its own costs, then the patentee has the leverage of the cost: if the accused infringer does not settle, the worst thing that could happen to the patentee is that it will bear its own costs. The costs to non-practicing entities are lower than for businesses, and for a few reasons. First, they likely have fewer documents, witnesses, and other evidentiary burdens to bear, and second, their attorneys often work on a contingent fee basis. These asymmetrical costs allowed, some argue, for patentees to extract unfair settlements in weak cases. But if a losing patentee can be forced to bear the other side's costs, then that leverage is reduced; therefore, increasing the likelihood that a patentee will be ordered to pay the attorneys' fees of the accused infringer makes patent enforcement riskier, reducing leverage.

The Court recently did exactly that. Section 285 of the Patent Act has long permitted a district court to award fees to a prevailing party—either a prevailing patentee or infringer—in “exceptional cases.”<sup>84</sup> In 2005, the Federal Circuit held that a court could award the prevailing party attorney fees only if it showed clear and convincing evidence that loser's case was both objectively baseless and had been subjectively litigated in bad faith.<sup>85</sup> Ten years later, the Court in *Icon Health & Fitness, Inc. v. Octane Fitness, LLC* rejected that interpretation, stating that the Federal Circuit's interpretation of Section 285 was so demanding that it rendered the statute “largely superfluous.”<sup>86</sup>

Instead, the Court interpreted Section 285 to more readily permit fee shifting. According to the Court, a prevailing party could obtain fees if the district judge found by preponderant evidence that it had been merely “uncommon, rare, or not ordinary,” or if it was “simply one that stands out from the others with respect to the substantive strength of a party's litigating position (considering both the governing law and the facts of the case) or the unreasonable manner in which the case was litigated.”<sup>87</sup> A study published two years after *Octane* found that the number of requests for attorneys' fees had increased over 50%, and actual awards had increased 100%.

On its face, the impact of *Octane* on the coercive power of patents is neutral, since its same relaxed standard applies whether the patent owner or accused infringer prevailed. However, there are two points to note. First, *Octane* was decided when the Court was concerned about “patent trolls” and their ability to leverage the coercive power of patents with the costs of

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<sup>82</sup> For a discussion of the uncertainties of identify proper venue for entities under the general venue statute, see John P. Lenich, *A Simple Question that Isn't So Simple: Where to Entities Reside for Venue Purposes*, 84 Miss. L. J. 253 (2015).

<sup>83</sup> AIPLA Economic Survey.

<sup>84</sup> 35 U.S.C. 285.

<sup>85</sup> *Brooks Furn. Mfg., Inc. v. Dutailier Int'l, Inc.*, 393 F.3d 1378, 1381-82 (Fed. Cir. 2005).

<sup>86</sup> *Icon Health & Fitness, Inc. v. Octane Fitness, LLC*, 134 S.Ct. 1749 (2014)

<sup>87</sup> *Id.* at 1756.

litigation to extract “unfair” settlements.<sup>88</sup> Second, and consistent with the view that the decision was directed toward reducing the power of patentees, “*Octane* drastically increased the rate that accused infringers’ motions are being granted, while slightly decreasing the rate that patentees’ fees motions are being granted.”<sup>89</sup> Thus, “accused infringer defendants should rationally be emboldened to litigate a suit, while patentee plaintiffs will rationally be more hesitant to file suits.”<sup>90</sup> Finally, subjecting a small entity, including a typical patent enforcement entity, to the potential for paying millions of dollars in fees makes patent litigation less effective.<sup>91</sup>

The consequence of these decisions, separately and as a whole, is to make patent litigation more difficult and riskier.<sup>92</sup> runs the risk of ignoring the self-selection problem. That fact reduces the coercive power of patents, which, in turn, reduces the incentive to file for a patent as well as the value of already-issued patents in any secondary market.<sup>93</sup>

### 5. **The Supreme Court Rejected Generally Granting Successful Patentees Injunctions Against Infringement, Limited Design Patent Damages, but Increased Potential Damages in Specific Circumstances.**

The Supreme Court has issued recent opinions affecting remedies for patent infringement—the heart of the coercive patent power. While two decisions favored patentees, they are narrow in scope and have a much smaller impact than the key decision which substantially altered the fundamental property right inherent in a property—namely, the right to exclude others.

A patent is a form of property, and the *sine qua non* of property is the right of the owner to refuse to allow others to use the property—the right to exclude—and not to merely obtain damages from someone who uses the property without the owner’s consent.<sup>94</sup> Consistent with

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<sup>88</sup> See generally, Aria Soroudi, *Defeating Trolls: The Impact of Octane and Highmark on Patent Trolls*, 35 Loy. L.A. Ent. L. Rev. 319 (2015).

<sup>89</sup> Scott M. Flanz, *Octane Fitness: The Shifting of Patent Attorneys’ Fees Moves into High Gear*, 19 Stan. Tech. L. Rev. 329 (2016).

<sup>90</sup> *Id.* See also Hannah Jiam, *Fee-Shifting and Octane Fitness: An Empirical Approach Toward Understanding “Exceptional,”* 30 Berkeley Tech. L.J. 611 (2015); Lionel M. Lavenue, Seann D. Damon & R. Benjamin Cassady, *Making the Nonprevailing Party Pay: The Statistics of Exceptional Cases Two Years After Octane and Highmark*, 8 No. 6 Landslide 26 (2016).

<sup>91</sup> A case decided in the same term as *Octane*, *Highmark Inc. v. Allcare Health Mgmt. Sys., Inc.*, 134 S.Ct. 1744 (2014), reversed the Federal Circuit’s holding that a determination that a case was exceptional was reviewed de novo, holding instead that an abuse of discretion standard applies. While this is a neutral rule—giving discretion to a district judge does not on its face seem anti-patent—it does reduce the ability of the Federal Circuit to reverse district courts. Assuming the Court believes the Federal Circuit favors patentees too much, this decision deprives the Federal Circuit of the ability to reverse district judges who may not share that bias.

<sup>92</sup> The degree to which it has done so is subject to debate, since the decision is new, the data thin, and self-selection a problem. *E.g.*, Lemley, 95 Tex. L. Rev. at 25, 28-29 (arguing that selection effect could not explain why win rate has remained constant).

<sup>93</sup> Kent Richardson, 2016 Brokered Patent Market, ROL Grp (available at <https://www.law.berkeley.edu/wp-content/uploads/2016/09/Richardson-Investment-Portfolios-Buying-Selling-Litigation.pdf>) (noting that “litigation risks” were “much higher than had been reported.”)

<sup>94</sup> A property right permits an owner to refuse to permit others to use the property, while a liability rule allows the others to use the property, subject to paying damages. See generally, Ryan T. Holte & Christopher B. Seaman,

that belief, the Federal Circuit had held in *MercExchange, L.L.C. v. eBay, Inc.* that “the general rule is that a permanent injunction will issue once infringement and validity have been adjudged,” thus permitting denial only in unusual circumstances, such as “when ‘a patentee’s failure to practice the patented invention frustrates an important public need for the invention,’ such as protection of public health.”<sup>95</sup> In that case, after a jury had found that eBay infringed a valid patent owned by MercExchange, the district court denied entry of a permanent injunction, in part because MercExchange did not actually practice the invention, but instead was (what is now called) a non-practicing entity. The Federal Circuit reversed the denial of injunctive relief, instead applying its general rule.

The Supreme Court unanimously reversed the Federal Circuit.<sup>96</sup> In doing so, the Court rejected the Federal Circuit’s “general rule” that an injunction should follow a finding of infringement of a valid patent, and instead required that district courts apply the traditional four-factor test applied in equity. By rejecting the Federal Circuit’s general rule, the Court plainly made it more difficult for a patentee to obtain injunctive relief. Patentees cannot rely on the general rule to be that they have the right to exclude; they instead have the right to seek damages from those who use their property, and perhaps may obtain injunctive relief.<sup>97</sup>

The impact of *eBay* has been uneven. Studies have confirmed that district courts are less likely to grant non-practicing entities injunctive relief after *eBay*, and some commentators view district courts as having “effectively interpreted the decision to create de facto rules denying injunctive relief to certain categories of patentees like non-competitors and non-practicing entities.”<sup>98</sup> Data shows that non-practicing entities obtain injunctions against continued infringement between 7% and 16% of the time.<sup>99</sup> Although limited data suggests that the Federal Circuit is likely to reverse denials, the fact that a non-practicing entity has about a 10% chance of obtaining a permanent injunction from a district court impacts the secondary market for patents, where non-practicing entities buy patents. To that extent, the value of a patent is reduced and, further, it reduces the incentive to file for a patent in the first instance. Thus, the Court’s *eBay* decision has made patents less valuable.

The Court also adopted a less generous approach than had the Federal Circuit to determine the measure of damages for design patents. In *Samsung Electronics Co., Ltd. v. Apple*

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*Patent Injunctions on Appeal: An Empirical Study of the Federal Circuit’s Application of eBay*, 92 Wash. L. Rev. 145, 160 (2017) (“Under a property rule, an entitlement can only be taken or transferred with the owner’s consent, which the owner is free to withhold,” but a “liability rule denies the holder of the [property or right] the power to exclude others.”); Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 Duke L.J. 147 (1998) (“Our approach is therefore consistent with the traditional view that intellectual property should be protected by means of a property rule (a presumptive entitlement to injunctive relief) rather than a liability rule.”)

<sup>95</sup> *MercExchange, L.L.C. v. eBay, Inc.*, 401 F.3d 1323, 1339 (Fed. Cir. 2005).

<sup>96</sup> *eBay Inc. v. MercExchange, LLC*, 547 U.S. 388 (2006).

<sup>97</sup> When an injunction is denied, courts award damages for infringement occurring after the date of judgment. [Citation to example cases]

<sup>98</sup> Ryan T. Holte & Christopher B. Seaman, 92 Wash. L. Rev. at 190. That trend is odd, given that the Court in *eBay* rejected the approach of the district court, which had held that a non-practicing entity could *never* obtain injunctive relief. *eBay*, 547 U.S. at 393. One study suggests that the Federal Circuit may be trying to fight that trend. See Holte & Seaman at 190.

<sup>99</sup> *Id.* (citing studies).

*Inc.*, Apple sued Samsung for infringement of a design patent depicting the front face of an iPhone.<sup>100</sup> By statute, the owner of a design patent is entitled to recover the “total profit” made by the maker of an infringing “article of manufacture.”<sup>101</sup> A jury awarded Apple \$399 million—representing Samsung’s entire profit from sales of infringing phones.<sup>102</sup> The Federal Circuit affirmed, reasoning that the “article of manufacture” was the entire phone because consumers could not buy components separately.<sup>103</sup>

The Supreme Court unanimously reversed. It held that the fact that the components could not be brought separately did not control whether the infringing phone was the “article of manufacture.” However, the Court refused to “resolve whether . . . the relevant article of manufacture is the smartphone, or a particular smartphone component.”<sup>104</sup> Instead, the Court remanded, and in July 2017 the district court ordered the parties to provide briefs concerning who had the burden to identify the “article of manufacture” as well as the proper test for that identification.<sup>105</sup> By rejecting the Federal Circuit’s approach that design patent damages should be based upon the product purchased by the consumer, the Supreme Court reduced potential damages for infringement of design patents.<sup>106</sup>

But in two cases the Court increased available remedies over the Federal Circuit’s approach. In the first case, *Halo*<sup>107</sup> the Supreme Court rejected the restrictive approach of the Federal Circuit toward allowing “enhanced” damages to patentees who proved infringement. Under Section 284 of the Patent Act, a district court “may increase” actual damages up to three times. The Federal Circuit had held that damages could be increased only if the district court found by clear and convincing evidence the accused infringer “acted despite an objectively high likelihood that its actions constituted infringement of a valid patent,” without regard to the accused infringer’s state of mind.<sup>108</sup> Thus, an accused infringer could avoid paying more than actual damages by showing it was not objectively reckless.

The Supreme Court reversed, holding that the Federal Circuit had interpreted the statute too rigidly and had insulated “someone who plunders a patent—infringing it without any reason to suppose his conduct is arguably defensible—“so long as his attorney can create some colorable defense.”<sup>109</sup> Rejecting both the clear and convincing standard and the two-part test, the Court nonetheless cautioned district courts to reserve awards of enhanced damages “for egregious cases typified by willful misconduct.”<sup>110</sup> *Halo* clearly made it easier to recover

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<sup>100</sup> 137 S.Ct. 429 (2016).

<sup>101</sup> 35 U.S.C. 289.

<sup>102</sup> 137 S.Ct. at 433

<sup>103</sup> *Id.* at 435.

<sup>104</sup> *Id.* at 436.

<sup>105</sup> *Apple, Inc. v. Samsung Elec. Co. Ltd.*, 2017 WL 3232424 (N.D. Cal. July 28, 2017).

<sup>106</sup> In another decision, arising out of an appeal from the Ninth Circuit, the Court reaffirmed its holding that a patent license could not impose royalties for sales made after the expiration of a patent. *Kimble v. Marvel Entertainment, LLC*, 135 S.Ct. 2401 (2015).

<sup>107</sup> *Halo Electronics, Inc. v. Pulse Electronics, Inc.*, 136 S.Ct. 1923 (2016).

<sup>108</sup> *In re Seagate Tech., LLC*, 497 F.3d 1360 (Fed. Cir. 2007) (en banc).

<sup>109</sup> *Halo Elec.*, 136 S.Ct. at 1933.

<sup>110</sup> *Id.* at 1935.

enhanced damages upon proof of willful infringement of a valid patent and so, to that extent, expanded remedies.<sup>111</sup>

In the second case, the Court eliminated an equitable defense that otherwise barred recovery of certain damages. Under 35 U.S.C. 286 a patentee may to recover damages for infringement occurring within six years of filing the claim. However, the Federal Circuit had held *en banc* in 1992 in *A.C. Aukerman Co. v. R.L. Chaides Constr. Co.*,<sup>112</sup> that equity could prevent recovery even for damages within that six-year period if the defendant established that the patentee's undue delay had caused it prejudice. The Supreme Court rejected that approach in 2017 in *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Products, LLC*,<sup>113</sup> holding that there was no exception to the Patent Act available in equity. To that extent, the decision increases damages over the Federal Circuit's approach.

Thus, although expanding relief in two narrower ways—allowing for easier recovery of enhanced damages for willful infringement and eliminating laches as a bar to damages—the Court narrowed damages in other ways, and *eBay* fundamentally narrowed the coercive power of patents. As a result of *eBay*, patentees are less likely to be obtain coercive injunctive relief against infringement.

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<sup>111</sup> See Elieen Hintz Rumpfelt, *The Halo Effect*, 59 No. 8 DRI for Def. 75 (Aug. 2017) (suggesting that the same increases in the number of requests for fee awards, and the increase in the number of awards, after *Octane* will occur in willful infringement after *Halo*).

<sup>112</sup> 960 F.2d 1020 (Fed. Cir. 1992) (en banc).

<sup>113</sup> 137 S.Ct. 954 (2017).





# Appendix



## ICLE BOARD

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