Dodging Left and Right: The Emerging Use of a Qualified Associational Privilege

By Jeremy J. Beck

By upholding the right of the NAACP to shield its membership rolls from the State of Alabama in 1958 in *NAACP v. Alabama ex rel. Patterson*, the U.S. Supreme Court first underscored the availability of a qualified associational privilege in civil discovery.[1] The heart of Justice Harlan's opinion in *Patterson* declares that where (1) an order of production would create "the likelihood of a substantial restraint" upon the right to freedom of association by a party's members, and (2) compelled disclosure of a party's membership would likely have an adverse effect on "the ability of [the party] and its members to pursue their collective effort to foster [their] beliefs . . . in that it may induce members to withdraw from the [group] and dissuade others from joining it because of fear of exposure of their beliefs shown through their associations and of the consequences of this exposure," then such an order of production will not be enforced.[2]

The *Patterson* decision highlights the Supreme Court's continuing concern that compelled disclosure in this area carries with it a potential chilling effect on freedom of association.[3] Thus, in the Supreme Court's associational privacy decisions, the party seeking disclosure must demonstrate an "overriding and compelling" interest bearing "a substantial relation [to] the information sought[.]"[4]

Moreover, even if the inquiring party meets its burden and shows such a compelling need, a court should engage in a balancing test to "measure the degree of relevance required in light of both the private needs of the parties and the public concerns implicated."[5] In addition, the inquiring party should be limited to the most narrowly tailored request that will satisfy its demonstrated need.[6]

Although claims of this particular work-product privilege tend to be found in cases like *Patterson* (and are thus focused primarily on First Amendment concerns regarding the rights of freedom of speech and free association), its continuing and effective use in such cases has led some commentators to note an increased need for, and potential application of, this privilege in a broader civil context.[7] More specifically and most recently, the privilege and the foregoing applicable standards have been invoked successfully in the realm of intellectual property litigation.

Moving Left: Copyright Infringement

In *Beinin v. Center for Study of Popular Culture*,[8] a liberal plaintiff brought claims of copyright infringement against a conservative defendant and defeated the defendant's motion to compel with an effective use of a qualified associational privilege. The defendant—a nonprofit organization that promoted conservative positions on matters of domestic and foreign policy—had published a political pamphlet entitled "Campus Support for Terrorism," which was critical of certain academics and campus organizations. One of the pamphlet's articles, "Terror's Faculty Sympathizers," specifically criticized the plaintiff while the cover of the pamphlet included copyright-protected photographs of four individual professors, including the plaintiff. Among other claims, the plaintiff alleged copyright infringement of his photograph, the rights to which had been assigned to him by the photographer for the express purpose of filing the infringement claim.

In response, the defendant asserted, in part, the affirmative defenses of copyright misuse and unclean hands.[9] To support these assertions, the defendant sought discovery of the plaintiff's relevant email correspondence. A discovery dispute arose, in part, because the plaintiff had redacted the names and email addresses of many of his email correspondents. The magistrate judge denied the defendant's motion to compel. The district court judge upheld the magistrate judge's findings that "the communications in dispute are between and among people who share political views and goals, including specifically a desire to support [the plaintiff] in his disputes with the [defendant] (including, but not limited to this action)."[10] In addition, the court found that "some of the emails suggest making efforts to create a 'defense fund' or otherwise organize in support of [the plaintiff's] efforts. As such, the interests that underlie the associational privilege are fully implicated notwithstanding the fact that there is no formal organization *per se*."[11]

In overruling the defendant's objections to the magistrate judge's order denying the defendant's motion to compel, the court cited *Patterson* and then noted that "[s]upport of litigation is a form of expression and association protected by the First Amendment."[12] The court observed that compelled disclosure of the redacted names and addresses in the plaintiff's email correspondence could have a chilling effect upon such support; specifically, that "[h]ad Plaintiff's email correspondents realized that privately supporting his litigation would potentially subject them to intrusive depositions or other discovery, they may have chosen to refrain from speaking."[13]

Moreover, because the defendant was unable to demonstrate a compelling interest sufficient to overcome the privilege,[14] the court also upheld the magistrate judge's conclusion that disclosure of the plaintiff's supporters' identities would be merely cumulative as to the defendant's allegations of copyright misuse and unclean hands. In short, the court ruled that a qualified associational privilege would protect the information the plaintiff had redacted and withheld from discovery by the defendant.

Moving Right: Trademark Dilution and Infringement

At the other end of the political spectrum, in *Klayman v. Freedom's Watch, Inc.*,[15] a conservative defendant successfully used the privilege as a shield against a libertarian plaintiff's motion to compel. In *Klayman*, the plaintiff was an antiwar activist who alleged he was the owner of the trademark "Freedom Watch" and that the corporate defendant's use of the name "Freedom's Watch" violated his common-law and statutory trademark rights. The defendant, a nonprofit foundation,

was "established to support the current war in Iraq and increase support for the President's troop surge policy in Iraq."[16]

Given that the defendant's express purpose stood in direct opposition to that of the plaintiff, in relevant part, the plaintiff claimed as follows:

> [The] unlawful infringement and use of the Freedom Watch name in conjunction with the promotion and furtherance of the Iraq war destroys the real Freedom Watch trademark[,] as Klayman and his Freedom Watch, while supportive of removing Saddam Hussein, stand for the position that the Iraq war does not promote freedom but in fact damages it as the Iraqi people are incapable of and are in fact opposed to democracy. . . . Thus, Defendants are not in any way affiliated or associated with Klayman or the real Freedom Watch and they have absolutely no legal right or authority to use, market, advertise, damage and destroy the Freedom Watch mark.[17]

During the course of discovery, the plaintiff requested extensive information concerning the conservative political mission, political and policy discussions, objectives, sponsorship, and donors of the defendant. The defendant then sought an emergency protective order and opposed the plaintiff's motion to compel, arguing the plaintiff was using his lawsuit to explore "a political conspiracy theory" in an effort to show that "the Bush Administration [was] using Defendant Freedom's Watch for the purpose of unlawfully evading the statutory restrictions on the use of soft money contributions to such organizations" and that therefore "numerous discovery requests [were] directed to this purpose and [were] not relevant" to the trademark dilution and infringement claims forming the basis of the lawsuit.[18] In addition, the defendant sought protection from disclosure of its "internal operations, planning process and future plans, as well as donor lists[,]" relying, in part, "upon the qualified privilege recognized under the First Amendment right of free association[.]"[19]

The *Klayman* court initially noted in its analysis that "information regarding whether the name 'Freedom's Watch' was adopted with the intention of capitalizing on Plaintiff's reputation or goodwill, or on any confusion, is relevant and discoverable."[20] However, citing *Patterson* among other authorities, the court then agreed with the defendant's asserted position, namely, that under the facts of the case, "the allowable scope of discovery must also be viewed in the context of the qualified associational privilege under the First Amendment."[21] Finding the privilege to be applicable, the court issued an order protecting certain matters from discovery.[22]

Intellectual Property Matters and the Politics of Today

The 2007 cases of *Beinin* and *Klayman* show that courts in their analysis of the qualified associational privilege still look to the seminal case of *Patterson* in support of the applicable standards. Furthermore, both cases demonstrate that intellectual property matters and the politics of today may intersect in unexpected and unforeseen ways.[23] Thus, wherever a party may fall on the political spectrum, as such intersections continue to emerge, a qualified associational privilege may well provide an effective defense for either plaintiffs or defendants against overreaching discovery in intellectual property litigation. ●

Jeremy J. Beck is an associate at Ackerson & Yann, PLLC, Louisville, Kentucky. He may be reached at jbeck@ackersonlegal.com.

Endnotes

1. NAACP v. Alabama *ex rel.* Patterson, 357 U.S. 449 (1958).
2. *Id.* at 462–63, 466.
3. *See, e.g.*, Buckley v. Valeo, 424 U.S. 1, 68–74 (1976).
4. Gibson v. Fla. Legislative Investigation Comm., 372 U.S. 539, 546 (1963).
5. Herbert v. Lando, 441 U.S. 153, 179 (1977) (Powell, J., concurring).
6. *See, e.g.*, Savola v. Webster, 644 F.2d 743, 746–47 (8th Cir. 1981).
7. *See, e.g.*, Joan Steinman, *Privacy of Association: A Burgeoning Privilege in Civil Discovery*, 17 HARV. C.R.-C.L. L. REV. 355 (1982).
8. Beinin v. Center for Study of Popular Culture, No. C 06-02298 JW., 2007 WL 1795693 (N.D. Cal. June 20, 2007) (slip op.).
9. The affirmative defense of copyright misuse precludes a copyright holder from using a valid copyright outside the scope of rights granted to the holder under copyright law. In other words, "[t]he misuse defense prevents copyright holders from leveraging their limited monopoly to allow them control of areas outside the monopoly." A&M Records, Inc. v. Napster, Inc., 239 F.3d 1004, 1026 (9th Cir. 2001).
10. *Beinin*, at *2 (parentheses in original).
11. *Id.* (brackets, quotation marks, and italics in original).
12. *Id.* at *3 (citation omitted).
13. *Id.* at *4 (citation omitted).
14. "A 'compelling interest' is one that 'is crucial to the party's case,' goes to the 'heart of the claims,' or is 'directly relevant to the [party's] claim.'" *Id.* at *3 (citations omitted; quotations and brackets in original).
15. Klayman v. Freedom's Watch, Inc., No. 07-22433-CIV., 2007 WL 3343079 (S.D. Fla. Nov. 12, 2007) (slip op.).
16. *Id.* at *1.
17. *Id.* (quoting the plaintiff's Complaint).
18. *Id.* at *2.
19. *Id.*
20. *Id.* at *4.
21. *Id.* at *5 (other citations omitted).
22. *Id.* (e.g., "Plaintiff is not entitled to discovery with respect to the internal decision-making process which led to the selection of various markets and methods of advertisements, or other internal discussions such as the motive in forming Defendant Freedom's Watch.").
23. For further reading on this topic, see, for example, Graeme W. Austin, *Intellectual Property Politics and the Private International Law of Copyright Ownership*, 30 BROOK. J. INT'L. L. 899 (2005) (discussing, in part, "the tension between efficient international protection of copyright . . . and respect for territorial sovereignty, or comity").