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Plaintiffs David Rudovsky, Esquire (“Rudovsky”) and Leonard Sosnov, Esquire (“Sosnov”), by and through their undersigned counsel, respectfully submit this memorandum of law in opposition to defendants’ motion for summary judgment.

I. INTRODUCTION AND SUMMARY OF ARGUMENT

For the most part, defendants’ motion for summary judgment merely recycles arguments that the Court has already considered and rejected. And, while defendants claim that “discovery has now confirmed” their arguments, defendants cannot point to *anything* in the record that breathes new life into their already-discredited arguments, and, in fact, defendants took only one deposition during discovery (that of plaintiff Sosnov). Rather, discovery has served only to confirm the strength of the plaintiffs’ claims, and the egregiousness of the defendants’ misconduct.

Defendants argue that plaintiffs’ claims are all barred by the terms of a 2000 contract between the parties. Defendants first made this argument in their response to plaintiffs’ motion for a preliminary injunction, and then for a second time in their motion to dismiss. The argument is no more persuasive now, in its third iteration, than it was the first two times around. Nothing in the 2000 agreement gave the defendants the right to defame the plaintiffs, the right to violate the Lanham Act, the right to invade the plaintiffs’ privacy, or the right to misappropriate the plaintiffs’ good names. Moreover, the 2000 agreement was expressly superseded by a 2007 agreement between the plaintiffs and West – and, thus, does not apply to the 2008-09 pocket part at issue in this case. Finally, to the extent that there is any ambiguity created by the conflict between the 2000 and 2007 agreements, such ambiguity is a question for the jury, and cannot be resolved on a motion for summary judgment. Indeed, the jury will be required to construe the

agreements against West, because West drafted both agreements. Accordingly, the 2000 agreement provides no support for defendants' motion for summary judgment.

West's other arguments also fail as a matter of law. For example, West argues that it is entitled to summary judgment on plaintiffs' defamation claim because plaintiffs have stipulated that they do not intend to introduce evidence of "special damages," *i.e.*, out-of-pocket pecuniary harm. However, Pennsylvania law allows "general damages" for defamation, including damages for harm to reputation and personal, adverse emotional reactions. Both plaintiffs have testified that they were angry and outraged by the defamatory statements, and that evidence is more than sufficient to support an award of general damages. Pennsylvania law also allows for presumed damages in cases of defamation *per se*, such as this case. In addition, Pennsylvania law allows recovery of punitive damages, even in the absence of compensatory damages. Finally, defendants simply ignore the fact that plaintiffs also seek *injunctive* relief, in addition to damages. West's only other argument on defamation – *i.e.*, that the statements at issue were "true or substantially true" – is utterly frivolous.

West's arguments about plaintiffs' Lanham Act claims also lack merit. West's reliance on *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 123 S. Ct. 2041 (2003), is misplaced, as that case deals only with false designation of origin claims. It does not deal with claims for false endorsement or false advertising, which are the claims made by plaintiffs in this case. West's "standing" argument is based on case law refusing to extend Lanham Act standing to consumers or to persons with remote, indirect injuries. Those cases are inapposite here, because the plaintiffs are clearly the persons most aggrieved and injured by West's Lanham Act violations. And, West's claim that it did not make any false statements is utterly belied by the facts of record.

Finally, West's arguments about plaintiffs' claims for misappropriation of names and invasion of privacy merely rehash the arguments made earlier in West's brief – and fail for the same reasons.

II. FACTS

A. The Plaintiffs

The plaintiffs in this case, David Rudovsky and Leonard Sosnov, are distinguished and long-standing members of the Bar of the Commonwealth of Pennsylvania, each residing in the Eastern District of Pennsylvania. Their careers have each encompassed the practice of law, particularly, criminal law and constitutional law; teaching as faculty at law schools; and authoring legal books and articles. Mr. Rudovsky has also practiced actively in civil rights law. Mr. Rudovsky and Mr. Sosnov both enjoy excellent reputations in the legal and academic communities.

B. Plaintiffs Author the Treatise for West

In 1988 Plaintiffs authored a book entitled “CRIMINAL PROCEDURE Law Commentary and Forms.” The book was published by West as part of West's “Pennsylvania Practice” Series.¹ A second edition was prepared by Plaintiffs and published by West in 2001. From 1988 to 2007, except for the year of the second edition, Plaintiffs prepared a pocket part for this book which was published by West. (The book, including the second edition and pocket parts for use through 2007-2008, is hereafter referred to as “the Treatise”).

Subscribers to the Treatise had individual written agreements with West under which they received each year's pocket part unless the contract was cancelled by the subscriber. Those agreements remain operative. The Treatise has averaged approximately 500 subscribers.

¹ Plaintiffs' use of the term “West” in this Memorandum refers individually and collectively to the defendants in this case.

In their preparation of the pocket part for the book each year, Plaintiffs reviewed all of the Pennsylvania appellate opinions on criminal law and procedure in the Pennsylvania courts, and all changes to the Pennsylvania Rules of Criminal Procedure, Rules of Appellate Procedure, and Juvenile Court Rules. In addition, plaintiffs reviewed all U.S. Supreme Court cases, and some selected Federal Circuit Court cases on criminal procedure. Plaintiffs included in each pocket part approximately 100 to 150 new cases decided in the year following the previous pocket part, as well as rule changes and other legal developments. Plaintiffs *each* expended at least 150 hours over the course of the year in the preparation of the pocket parts, in order to assure that their treatment of the topics in the Treatise was up-to-date and current, and could be relied upon as such by the Bar and by the Courts. Their manuscripts for the pocket parts were accepted each year without substantive change. See Deposition of Karen Earley (“Early Dep.”) at 21:11-22 (attached as Exhibit A to the Declaration of Noah H. Charlson submitted in support of this motion).²

In early 2008, the individuals responsible for the Treatise at West - Karen Earley, Sarah Redzic, and Catherine Smith - held a series of meetings about the future of the Treatise. Ms. Earley, who was West’s Attorney Editor for the Treatise, and Ms. Smith, who was the Team Coordinator for West’s State Practice Group (and Ms. Earley’s boss), recommended terminating publication of the Treatise. See Ex. B (Smith Dep.) at 31:13-32:2; Exhibit C (2/11/08 Email from C. Smith to T. Kruk). Rather than terminate the publication, however, West instead offered to pay plaintiffs half of their prior compensation (i.e., to cut their payment from \$5,000 each to \$2,500 each) to prepare a Pocket Part Supplement for 2008-2009. Ex. A (Earley Dep.) at 58:19-59:9. Plaintiffs declined this offer.

² All references to Exhibits in this memorandum will refer to the Charlson Declaration unless otherwise stated.

C. West Decides to Terminate Publication of the Treatise in 2009, But First Assigns an Inexperienced and Unqualified Employee to Prepare a Supplement, in Order to Meet West's Internal Revenue Projections for 2008

After the plaintiffs declined to accept an offer that cut their compensation in half for doing the same amount of work, West took no action with respect to the Treatise for several months. Ms. Earley assigned responsibility for the Treatise from herself to Ms. Sarah Redzic, a newly-hired Attorney Editor trainee. Ex. A (Earley Dep.) at 60:20-61:1-7. Ms. Redzic, who had graduated from law school in May 2007, had been employed as an Attorney Editor at West since only October 2007. Ex. D Deposition of Sarah Redzic ("Redzic Dep.") at 8:12-14.

West took no steps with respect to the Treatise for much of the year, until early November 2008, when a number of West employees, representing a variety of West departments including Print Strategy, State Practice, New Product Development, Sales, Marketing, and others, met to discuss the future of the Treatise. Ex. B (Smith Dep.) at 20:2 - 20:16. Ms. Redzic suggested terminating publication of the Treatise, and Ms. Smith, as well as West's Director of Print Strategy John Levine, agreed with her recommendation. *Id.* Although all in attendance at the meeting, and all those whose approval was needed to terminate the Treatise, had agreed that West should stop publishing the Treatise, the decision was not executed during 2008 because "it was close to the end of the year" and West did not have enough time to obtain all the necessary formal approvals to terminate the publication. (*Id.* at 21:17-22:18; 25:6-17). Accordingly, West's decision to terminate the Treatise would not be implemented until 2009. *Id.* at 25:24-26:3.

That decision put Ms. Redzic and Ms. Smith in between a rock and a hard place: because the Treatise would not be terminated during 2008, their business unit was expected to produce a

Supplement to the Treatise for 2009, because the Supplement was part of their unit's "Publishing Plan" for 2008-2009, and therefore they had made an internal "commitment" to West to publish one by year's end. Ex. B (Smith Dep.) at 26:8-16. But by the time the decision was made to defer termination into 2009, the State Practice Unit's deadline for producing a manuscript for the 2008-2009 Supplement had already passed, and the manuscript was therefore "overdue." Ex. D (Redzic Dep.) at 29:14-23. Ms. Smith believed that it was necessary to publish a Supplement, even though West had decided to terminate the Treatise, because the revenue from the sale of the Treatise to the paying subscribers was included within her unit's revenue projections for 2008. Ex. B (Smith Dep.) at 47:1-48:24. Accordingly, if Ms. Smith and Ms. Redzic failed to produce a "2009 Supplement" to be sent to paying subscribers, Ms. Smith's State Practice Unit would not meet its revenue target.

Ms. Redzic initially attempted to locate a third-party contract author to prepare the supplement, and made several phone calls to contract authors, but no one called her back. Ex. D (Redzic Dep.) at 34:7-35:11. Instead, Ms. Redzic agreed to prepare a manuscript for the Supplement herself. *Id.* at 35:12-24; 38:5-10.

At this time, Ms. Redzic had been employed by West for a little more than a year as an Attorney Editor. She testified that she was trained for that position primarily by "shadowing" Karen Earley. Ex. D (Redzic Dep.) at 16:10-17:6. Ms. Earley, however, testified that Ms. Redzic *did not* shadow her, and that she was not responsible for training Ms. Redzic. Ex. A (Earley Dep.) at 37:11-22. Although Ms. Earley believed that a woman named Andrea Nadel, who was technically assigned as Ms. Redzic's "mentor," had trained her, (*Id.* at 37:16-22), Ms. Redzic testified that Ms. Earley had "more of a role in her training than Ms. Nadel did," and that she could not remember any training provided by Ms. Nadel. Ex. D (Redzic Dep.) at 20:10-21:4.

Given the directly contradictory testimony of the two West witnesses, it is not clear whether anyone at West actually trained Ms. Redzic on the job of being an Attorney Editor.

Nevertheless, Ms. Redzic was assigned the task of preparing the Supplement, although she had never prepared a supplement before. Ex. B (Smith Dep.) at 42:4-15. At the time she started the assignment, Ms. Redzic had less than a month to prepare the manuscript, in addition to all of her other tasks as an Attorney Editor responsible for between 60-70 West publications. Ex. B (Smith Dep.) at 42:16-43:1; Ex. D (Redzic Dep.) at 70:18-73:9. Moreover, the end of the year was “crunch time” at West, due to all of the year-end pocket parts and supplements that were required to be produced (including most of Ms. Redzic’s 60-70 titles). Ex. B (Smith Dep.) at 38:22-24; Ex. D (Redzic Dep.) at 70:18-73:9. According to the time records produced in this litigation, Ms. Redzic spent no more than 10.5 hours over the course of nine days working on the 2008-09 Supplement. See West Time Records, (Exhibit M); see also Ex. D (Redzic Dep.) at 100:14 - 109:14.³

Moreover, despite the fact Ms. Redzic had not authored any manuscript on her own at this point, and had virtually no background in or knowledge of criminal law (much less Pennsylvania criminal law or procedure) Ex. D (Redzic Dep.) at 66:19-67:13, no one at West -- not Ms. Smith, not Ms. Earley, not Ms. Nadel nor anyone else -- provided her with *any* input on how to update a supplement on her own. *Id.* at 66:1-18; Ex. B (Smith Dep.) at 43:2-44:15. Even more incredibly, once Ms. Redzic completed her manuscript, *no one at West ever reviewed it to determine whether it was worthy of publication!* Ex. B (Smith Dep.) at 49:16 - 51:4; Ex. D

³ West witnesses have attempted to dispute the plain import of Ms. Redzic’s time records by testifying that at the time in question, West employees were only required to record time up to 40 hours per week, and that any time spent beyond 40 hours was not recorded. However, although these witnesses testified that the policy has since changed, West has produced no documents to demonstrate that such a policy ever existed. In any event, on summary judgment, all inferences are to be drawn against West, and this is therefore a fact issue for resolution by a jury.

(Redzic Dep.) at 74:1-8. Instead, Redzic’s manuscript went directly to West’s production department, where it was packaged as the 2008-2009 Supplement to the Treatise, and was sent to each of approximately 400 subscribers to the Treatise, each of whom was charged \$46.50 for it. Ex. D (Redzic Dep.) at 74:1-8.

D. The 2008-09 Supplement Was a Sham: It Was Virtually Unchanged from the Prior Supplement Prepared by Plaintiffs and Failed to Include Any Relevant Changes in the Law of Pennsylvania Criminal Procedure

West’s 2008-09 Supplement to the Treatise (hereafter the “Redzic Supplement”) was not a bona fide revision or update; it contained only three previously uncited cases, none of which was of any consequence, it failed to address negative history in cases, it failed to identify relevant rule changes, and generally failed to update or account for changes in law. For example, while the prior pocket parts that Rudovsky and Sosnov had prepared typically included citations to between 100 and 150 new cases decided since the prior version was published, the “2008-2009 Pocket Part” contained only three (3) new cases that were not cited in the 2007-08 Pocket Part. See Ex. F [Hearing Tr. (Rudovsky) at 10:3-12:5].

Moreover, the “2008-2009 Pocket Part” failed to include a number of cases in which the Pennsylvania Supreme Court reversed or vacated lower courts, including at least the following:

- *Commonwealth v. Mallory*, 888 A.2d 854 (Pa. Super. 2005), *vacated by* 596 Pa. 172, 941 A.2d 686 (2008), *cert. denied*, 129 S. Ct. 257 (2008);
- *Commonwealth v. Brown*, 853 A.2d 1029 (Pa. Super. 2004), *rev'd by* 592 Pa. 376, 925 A.2d 147 (2007);
- *Commonwealth v. West*, 868 A.2d 1267 (Pa. Super. 2005), *rev'd by* 595 Pa. 483, 938 A.2d 1034 (2007);
- *Commonwealth v. Wilson*, 866 A.2d 1131 (Pa. Super. 2004), *rev'd by* 594 Pa. 106, 934 A.2d 1191 (2007);

- *Commonwealth v. Bennett*, 842 A.2d 953 (Pa. Super. 2004), *vacated by* 593 Pa. 382, 930 A.2d 1264 (2007);
- *Commonwealth v. Gravely*, 918 A.2d 761 (Pa. Super. 2007), *allowance of appeal granted*, --- A.2d ----, 2008 WL 878654 (Pa. Apr 02, 2008); and
- *Commonwealth v. Lee*, 594 Pa. 266, 935 A.2d 865 (2007).

The “2008-2009 Pocket Part” also failed to reflect relevant changes to pertinent rules. For example, the “2008-09 Pocket Part” failed to include any reference to the amendment to Pa. R. App. P. 2111, which added new section (a)(7), providing that an appellant’s brief must include a “[s]tatement of the reasons to allow an appeal to challenge the discretionary aspects of a sentence, if applicable.” Pa. R. App. P. 2111 (a)(7). Although Rule 2111 was amended on June 5, 2008, the amendment was not mentioned in the Pocket Part. Moreover, no fewer than three new Juvenile Rules were excluded from the “2008-09 Pocket Part” (Rules 140, 630 and 632), and revisions to the Pa. Rules of Juvenile Court Procedure were not included, including Rules 120, 123, 124, 150, 360, 364, 631 and 800. In sum, the “2008-2009 Pocket Part,” in being represented as an update to the Treatise, was a sham, which West falsely attributed to Rudovsky and Sosnov.

Other than the addition of three new case cites,⁴ the only revisions that West made to the 2008-2009 Supplement were to change the phrasing of the “instruction lines” (the italicized instructions to the reader that explain the logistics of how the material in the Supplement modifies the text of the main treatise). The revised instruction lines in the 2008-09 Pocket Part

⁴ Section 9.0 of the 2008-09 Pocket Part cites to *Commonwealth v. Hanford*, 937 A.2d 1094 (Pa. Super. 2007), *appeal denied*, 956 A.2d 432 (Pa. 2008), while Section 4.0 cites to *Commonwealth v. Floyd*, 937 A.2d 494 (Pa. Super. 2007), and Section 11.0 cites to *Commonwealth v. Jones*, 593 Pa. 295, 929 A.2d 2005 (2007). Of the three, only *Hanford* is even discussed substantively (albeit via parenthetical), while *Jones* is merely a “see also” cite and the *Floyd* citation does no more than quote from an earlier decision, *Commonwealth v. Monica*, 597 A.2d. 600 (Pa. 1991), which was discussed in the main edition of the Treatise at Section 4.0, p. 44.

appear to conform to West's internal guidelines for Instruction Lines. See Ex. E. Although Ms. Redzic could not recall if she changed all of the instruction lines during her approximately 10.5 hours working on the Pocket Part, she clearly testified that no one else would have done it. See Ex. D (Redzic Dep.) at 83:1-18. Since even a cursory comparison of the 2007-08 Supplement with the Redzic Supplement shows that the instruction lines were changed throughout the 218 pages of text in the Supplement, there can be no doubt that the bulk of Ms. Redzic's 10.5 hours spent revising the manuscript for the 2008-09 Supplement were devoted to changing the instruction lines, rather than updating the law of Criminal Procedure.

Despite the fact that Rudovsky and Sosnov did not have any involvement in preparing the 2008-2009 Supplement, however, the cover page continued to identify the Supplement as being "By DAVID RUDOVSKY [and] LEONARD SOSNOV", modified only by the innocuous qualifier "and THE PUBLISHER'S STAFF". See Ex. E. Nothing on the Supplement, or mailed with it to the subscribers, informed subscribers or readers that Rudovsky and Sosnov had not prepared the Supplement. Accordingly, subscribers and recipients were left with the unmistakable impression that the entirely inadequate, sham Supplement was authored by Rudovsky and Sosnov.

The "2008-2009 Pocket Part" was sent by West to all of the subscribers for the Treatise, along with an invoice for payment (Plaintiffs believe in the amount of \$46.50). Prior to submitting payment for the "2008-09 Pocket Part," subscribers had an opportunity to view its cover, including the prominent misrepresentation that Rudovsky and Sosnov were authors of the document. Upon seeing the "2008-09 Pocket Part," subscribers were likely to believe that it was an update of the Treatise authored and prepared by Rudovsky and Sosnov, and purchased it on that basis. West did not disclose that Rudovsky and Sosnov had nothing to do with the

preparation of the document (beyond their work on prior pocket parts), and West did not disclose that the pocket part was not a revision or an update, that it was not current, that it could not be relied upon, or that it added essentially nothing to the prior year's pocket part.

The same deficiencies identified above also appeared in West's popular "Westlaw" electronic database version of the Treatise. Moreover, nothing in the Westlaw version of the Treatise even reflected the "Publisher's Staff" proviso purportedly qualifying Rudovsky and Sosnov's authorship.

E. Rudovsky and Sosnov Were Stunned and Upset When They Saw the Redzic Supplement and Realized that It Was Harmful to their Reputations

When Rudovsky received the Redzic Supplement in the mail sometime after the New Year in January 2009, he was "stunned" by the fact that it was a virtual copy of the prior version and he found it "very upsetting." Ex. F [Hearing Tr. (4/14/09)(Rudovsky)] at 12:5 and 23:19-21. Sosnov, for his part, "was really, angry . . . very, very angry" and "pretty upset." Ex. G (Sosnov Dep.) at 40:16-20; 53:24-54:12.

The reason for their anger and concern was plain: the Redzic Supplement was an utter sham, yet West took no steps whatsoever to inform subscribers and readers that Rudovsky and Sosnov had no role in the preparation of the sham Redzic Supplement. Thus, any person who used the Redzic Supplement and recognized that it failed to include even the most basic changes in the law, was virtually certain to believe that Rudovsky and Sosnov had authored the useless Redzic Supplement.

F. West Scrambles to Replace the 2008-2009 Pocket Part After this Litigation Is Filed

Upon learning that West had published the so-called "2008-2009 Pocket Part," plaintiffs communicated with West, by letter by undersigned counsel dated February 3, 2009. A copy is

attached as Exhibit H. In this letter, plaintiffs set forth the facts, as alleged in the Complaint, and demanded remedial action. Although plaintiffs asked West to provide information, if any, contrary to the factual assertions in the letter, defendants refused to provide any such information.

Plaintiffs filed the Complaint in this case on February 19, 2009, along with a motion for preliminary injunction on March 24, 2009. Only after this action was filed did West finally agree to send a letter to subscribers informing them that the 2008-09 Supplement was deficient. See Exhibit I.

At about the same time, West also began the process of preparing a new version of the Supplement, with the intent of mailing it, before the preliminary injunction hearing. West engaged a former West employee named Chris Gimeno, who now works as a contract author for West, to update the Supplement. See Ex. B (Smith Dep.) at 58:2-23. A copy of West's Contract with Ms. Gimeno is attached as Exhibit J.⁵ Notably, Ms. Gimeno's contract with West is executed by Ms. Gimeno some time in April (the date is impossible to read and West has refused to disclose the date on which Ms. Gimeno executed the Agreement), but required delivery of the manuscript by March 31, 2009. See Ex. K at Pages 1, 4. Therefore, we cannot know how long Ms. Gimeno spent on the 2009 Supplement, but we do know that the final Supplement was delivered by West to the U.S. Post Office on April 13, 2009 (the day before the Preliminary Injunction hearing) for mailing to consumers. See Exhibit L.

⁵ The Gimeno Contract was not used at the deposition of any West witnesses because West had refused to produce it until after West witnesses testified about it. Accordingly, plaintiffs have been prejudiced in their ability to use the document with West witnesses. West also refused to produce any correspondence with Ms. Gimeno, and did not do so until 7:13 p.m. on Friday night, May 7, 2010 (10 days prior to trial). These documents are significant -- they show that West was panicked about getting a Supplement published before the preliminary injunction hearing held in this matter on April 14, 2009. See Ex. K. These documents also refer to other correspondence between West and Ms. Gimeno, which West still has not produced.

The April 2009 Supplement (hereafter the “Gimeno Supplement”), however, was an improvement only by comparison to the Redzic Supplement. Although the Gimeno Supplement contained more new case law and rule changes than the sham Redzic Supplement did, it nevertheless failed to incorporate numerous changes in the law, including (amazingly) several that were specifically identified by plaintiffs prior to, or at, the preliminary injunction hearing! See Ex. F [Hearing Transcript (Rudovsky) at 15:2-17:2].

Moreover, as Rudovsky testified at the hearing, even after the Gimeno Supplement was mailed to subscribers, readers were unlikely to realize that plaintiffs were not associated with it, because users typically do not look at the front page of a Supplement. Ex. F [Hearing Transcript (Rudovsky) at 34:23 - 35:9].

III. ARGUMENT

A. Summary Judgment Standard

Rule 56(c) of the Federal Rules of Civil Procedure provides that summary judgment is appropriate if “the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law.” Fed.R.Civ.P. 56(c). The party moving for summary judgment bears the burden of demonstrating the basis for its motion, and identifying those portions of the “pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits if any,” which demonstrate the absence of a genuine issue of material fact. *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986).

In determining whether the dispute is genuine, the Court's function is not to weigh the evidence or to determine the truth of the matter, but only to determine whether the evidence of record “is such that a reasonable jury could return a verdict for the non-moving party.”

Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248-49 (1986). “The evidence of the non-movant is to be believed.” *Id.* at 255.

All inferences must be drawn in the light most favorable to the non-moving party. *American Eagle Outfitters v. Lyle & Scott Ltd.*, 584 F.3d 575, 581 (3d Cir. 2009). “[W]hen there is a disagreement about the facts or the proper inferences to be drawn from them, a trial is required to resolve the conflicting versions of the parties.” *Id.*, quoting *Peterson v. Lehigh Valley Dist. Council*, 676 F.2d 81, 84 (3d Cir.1982). “Summary judgment may not be granted ... if there is a disagreement over what inferences can be reasonably drawn from the facts even if the facts are undisputed.” *Ideal Dairy Farms, Inc. v. John Labatt, Ltd.*, 90 F.3d 737, 744 (3d Cir. 1996).

B. The 2000 Agreement Does Not Bar Any of the Plaintiffs’ Claims

West argues, for the third time, that the plaintiffs’ claims are barred by the terms of a 2000 agreement. Again, West’s arguments fail as a matter of law. First, even if the 2000 Agreement did apply to the 2008-09 Pocket Part, that Agreement does not give defendants *carte blanche* to use plaintiffs’ names in connection with a sham publication that plaintiffs did not author, and which harms their good reputations. Second, the 2000 agreement was expressly superseded by a 2007 agreement between the plaintiffs and West – and, thus, does not apply to the 2008-09 pocket part at issue in this case. Finally, to the extent that there is any ambiguity created by the conflict between the 2000 and 2007 agreements, such ambiguity must be resolved by the jury, construing the documents against West because West drafted both agreements. Thus, the 2000 agreement provides no support for West’s motion for summary judgment.

West argues that the 2000 Agreement immunizes it from liability, because it gave West “the contractual right” to defame the plaintiffs by falsely attributing the sham “2008-09 Pocket Part” to the plaintiffs. As the defendants state in their memorandum of law:

Plaintiffs’ defamation claim for defamation is deficient because it is based upon the allegation that the 2008-09 Pocket Part “constitutes a false statement that the Plaintiffs authored the publication.” Am. Compl. ¶ 87. However, West possessed the express contractual right to use “Authors’ names in connection with the Work and upkeep of the Work” even if Plaintiffs did *not* participate in its upkeep.

Def. Mem., p. 17 (emphasis in original).

The Court aptly summarized the gist of the defendants’ argument at the April 14, 2009 hearing on the plaintiffs’ motion for a preliminary injunction:

THE COURT: What does the 2000 agreement say that helps you?

MR. RITTINGER: Well, the 2000 agreement, first of all, it says that we can use their name or likeness.

THE COURT: It gives you license to falsely attribute something to them?

MR RITTINGER: No, it gives us the right to use their name on a supplement, even one that they don’t prepare themselves, the actual supplement and I can read the language on that, your Honor.

THE COURT: Well, you mean that it authorizes you to say that they prepared the supplement, when they didn’t?

See Ex. F [Hearing Tr. (4/14/09) at 12-13].

As the Court recognized at the preliminary injunction hearing, the 2000 Agreement did not give the defendants “license to falsely attribute” the sham 2008-09 pocket part to the plaintiffs. *Id.* at 12. The 2000 Agreement did not authorize the defendants “to say [the plaintiffs] prepared the supplement when they didn’t.” *Id.*, p. 13. And, the 2000 Agreement also

did not give the defendants the right to misappropriate the plaintiffs' names, to defame the plaintiffs, or to commit any of the other wrongs set forth in the amended complaint.

As the Court recognized, the language of the 2000 Agreement simply does not support the defendants' arguments. The 2000 Agreement did not authorize West to falsely attribute authorship of the sham pocket part to the plaintiffs, and it surely did not authorize West to use the plaintiffs' names to facilitate the sale of a fraudulent product.⁶

Even if the 2000 Agreement had the extraordinary effect urged by the defendants – and, not surprisingly, it does not – the defendants' argument fails as a matter of law because the 2000 Agreement does not apply to this case. The 2000 Agreement does not apply to the purported 2008-2009 pocket part because, even assuming that it otherwise applied, it was superseded by a June 2007 agreement (the “2007 Agreement”) between the plaintiffs and West. (A copy of the 2007 Agreement is attached hereto as Exhibit N).

The 2007 Agreement, paragraph 9H, provides in relevant part as follows:

This is the entire agreement of the parties. All prior negotiations and representations are merged into this Agreement. This Agreement supersedes all previous agreements concerning the Work.

The first sentence of this integration clause states that the 2007 Agreement is now controlling for all purposes, *i.e.*, that it “is the entire agreement of the parties.” The second sentence encompasses *all* prior negotiations and representations, regardless of whether those negotiations and representations led to the 2007 Agreement or to the 2000 Agreement.

⁶ In addition, the only evidence in the record directly contradicts the defendants' interpretation. Mr. Rudovsky testified at the April 14 hearing that he never believed that the 2000 Agreement authorized West to falsely attribute the 2008-09 pocket part to the plaintiffs. By contrast, there is no evidence supporting West's interpretation.

With respect to the third sentence of the integration clause, “the Work,” as defined in the 2007 Agreement, is the “Pennsylvania Practice Criminal Procedure 2007 Supplement.” See 2007 Agreement, attached as Exhibit F, ¶ 1. According to defendants, the 2000 Agreement applied to all pocket parts, which would include the “2007 Supplement.” Therefore, since the 2000 Agreement would otherwise apply to “the Work,” it was superseded.

Defendants apparently contend that the 2007 Agreement supersedes the 2000 Agreement only as to “the Work,” and nothing else. But the words “concerning the Work” come directly after, and therefore apply to, “previous agreements,” so that it is the previous agreements which are superseded if they would otherwise apply to the Work. Had the defendants wished to achieve the result they now argue for, they could have easily so provided. For example, they could have drafted a provision with the following language: “With respect to the Work, this Agreement supersedes all previous agreements.” This, however, is not what is provided by the language which Defendants chose.

Moreover, if one were to assume that the language used by the defendants is ambiguous (defendants’ best case), the interpretation of an ambiguous contract is a question of fact that must be resolved by the jury (and which, therefore, cannot be resolved on a motion for summary judgment). Moreover, any ambiguity should be resolved against defendants because they authored both the 2000 Agreement and the 2007 Agreement. *See, e.g., American Eagle Outfitters v. Lyle & Scott Ltd.*, 584 F.3d 575, 587 (3d Cir. 2009) (“In circumstances where the language chosen by the parties is ambiguous, deciding the intent of the parties becomes a question of fact for a jury”); *Dardovitch v. Haltzman*, 190 F.3d 125, 141 (3d Cir. 1999) (“It cannot be doubted that ‘in choosing among the reasonable meanings of a promise or agreement or a term thereof, that meaning is generally preferred which operates against the party who

supplies the words or from whom a writing otherwise proceeds.”) (quoting Restatement (Second) of Contracts, § 206); *Pines Plaza Bowling, Inc. v. Rossview, Inc.*, 394 Pa. 124, 145 A.2d 672, 676 (1958) (“It is true that if the terms of a contract are ambiguous, any doubt or ambiguity must be construed against the party who wrote it and the true meaning decided by the jury and not the court”).

C. Defendants Are Not Entitled to Summary Judgment on Plaintiffs’ Defamation Claims

West makes four arguments in support of its motion for summary judgment on plaintiffs’ defamation claims: (1) the statements at issue were not defamatory *per se*, and plaintiffs have not suffered any special damages; (2) even if the statements were defamatory *per se*, plaintiffs suffered no general damages; (3) plaintiffs supposedly gave their “consent” to the defamation; and (4) the statements were “true or substantially true.” Each of West’s arguments fails as a matter of law.

1. The Statements Here Were Defamatory Per Se

West concedes, as it must, that a plaintiff need not prove “special damages” in cases of defamation *per se*. Def. Mem., p. 9.⁷ West further concedes that a statement is defamatory *per se* if it “ascribes to another conduct, characteristics or a condition that would adversely affect his fitness for the proper conduct of his lawful business.” *Id.*, p. 10, quoting *Syngy, Inc. v. Scott-Levin, Inc.*, 51 F. Supp. 2d 570, 580 (E.D. Pa. 1999), *aff’d*, 229 F.3d 1139 (3d Cir. 2000). “[A] statement may be *per se* defamatory although it does not explicitly charge the subject with a failure of business or professional performance.” *Clemente v. Espinosa*, 749 F. Supp. 672, 678 (E.D. Pa. 1990). *See also* *Altoona Clay Prods., Inc. v. Dun & Bradstreet, Inc.*, 367 F.2d 625,

⁷ “The term ‘special damages’ or ‘special harm’ is defined by the courts of Pennsylvania to include such actual and concrete damages capable of being estimated in money. Evidence of special damages is required where the defamation does not amount to slander *per se*.” *Clemente v. Espinosa*, 749 F. Supp. 672, 680 (E.D. Pa. 1990) (quotations and citations omitted).

628 (3d Cir. 1996) (“publication of slanderous statements concerning one’s business, trade or profession are made actionable *per se*”); *id.* at 629 (“Pennsylvania treats slanderous words injurious to one’s business or profession as actionable *per se*.”).

It is indisputable that the statements at issue here were defamatory *per se*. The plaintiffs are esteemed lawyers, law professors, and legal writers. They were the authors of both editions of the Treatise, and twenty years’ worth of pocket parts updating the Treatise. Courts, lawyers, prisoners, and other users of the Treatise rely upon the plaintiffs’ work as an authoritative resource on Pennsylvania criminal law and procedure. And, the subscribers to and users of the Treatise rely on the pocket parts to provide them with up-to-date citations and analysis of appellate cases and rule changes in Pennsylvania.

The statements at issue here are defamatory *per se* because they are precisely the sort that would “adversely affect [plaintiffs’] fitness for the proper conduct of [their] lawful business.” West falsely identified the plaintiffs as the authors of the sham “2008-09 Pocket Part,” sent that Pocket Part to all subscribers to and new purchasers of the Treatise, and required the subscribers and purchasers to pay for the Pocket Part. Defendants falsely attributed to plaintiffs the sham 2008-09 Pocket Part, which was an abysmally incompetent work that, among other deficiencies:

- contained almost no substantive information that was not in the 2007-2008 pocket part;
- contained no reference to or discussion of substantial new developments in criminal law and/or criminal procedure in Pennsylvania;
- cited no cases decided in 2008, and cited only three cases decided in 2007 after the preparation of the 2007-2008 pocket part;

- did not include negative history of any cases during the year following the preparation of the pocket part for 2007-2008;
- did not contain any subsequent history with respect to other actions by the Pennsylvania Supreme Court in the period following preparation of the 2007-2008 pocket part; and
- did not include a number of pertinent rules changes which were announced in the period between preparation of the 2007-2008 pocket part and the time at which a manuscript for a 2008-09 pocket part would have been submitted to West.

See generally, pp. 8-10, *supra*.

Any reasonably competent legal author would have included reference to, and discussion of, new developments in an annual pocket part to the Treatise, and the legal community would have expected, and did expect, such developments to be addressed in the 2008-09 Pocket Part. Indeed, it is precisely the point of a pocket part to update the readers of the Treatise on relevant legal developments since the publication of the prior pocket part.

Both plaintiffs testified about the effect that West's defamatory statements were likely to have on readers of the sham 2008-09 Pocket Part. For example, Mr. Rudovsky testified that:

People use this on discrete research problems. I have a problem with post-conviction, I want to see if there's case law on it, I want to see what the rule says, I'd go to that section.

My understanding – and certainly it's true with what I've done – if somebody went to that section, did it and – and as you suggested Shepardizes it as they should – and found that we did not include – or you did not include – a case that was highly relevant, I wouldn't expect them to call me and complain.

I would expect them to think, Rudovsky and Sosnov aren't up to snuff.

Ex. F (Hearing Tr. (4/14/09) at 60] (emphasis added).

Likewise, Mr. Sosnov testified that:

Besides the fact that it is an incompetent effort there is still a harm to me and Mr. Rudovsky, the fact that many users are not going to know that this wasn't prepared by us when they use this volume, and, therefore, **we can be associated with this incompetent effort of a pocket part.**

Ex. G (Sosnov Dep.) at 17 (emphasis added).

West's defamatory statements attributed authorship of the fraudulent, sham 2008-09 Pocket Part to the plaintiffs. West's defamatory statements went to the core of plaintiffs' professional reputations as lawyers, law professors, legal writers, and authorities on Pennsylvania criminal law and procedure. The statements were, therefore, defamatory *per se*.

“Statements relating to attorneys impute business misconduct and are slanderous *per se* where they tend to ‘show a lack of character or a total disregard of professional ethics.... Or [where they] accuse an attorney of unprofessional conduct.’” *Clemente*, 749 F. Supp. at 678, quoting *Wachs v. Winter*, 569 F. Supp. 1438, 1443 (E.D.N.Y. 1983). Moreover, a finding of defamation *per se* is appropriate where “the particular quality disparaged ... is peculiarly valuable in the plaintiff's business and profession.” *Id.*, quoting Restatement (Second) of Torts, § 573, comment e (1977).

Indeed, Pennsylvania state and federal courts have found statements about a person's fitness for business defamatory *per se* in a wide variety of contexts, including statements far less troubling than the ones at issue here. In *Agriss v. Roadway Express, Inc.*, 334 Pa. Super. 295, 483 A.2d 456 (1984), for example, the Pennsylvania Superior Court found that an employer's accusation against an employee of “opening company mail” was capable of being understood as a charge of unfitness for business. 334 Pa. Super. at 323, 483 A.2d at 471. *See also Clemente*,

749 F. Supp. at 677 (statements that plaintiff attorney was “connected with the Mafia,” had “connections with the Mafia,” was “wired,” and was an “informant for the government” held defamatory *per se* as accusations of business misconduct).

2. The Evidence in the Record Supports an Award of General Damages, Presumed Damages, and Punitive Damages, as Well as Injunctive Relief

a. General Damages

As defendants note in their brief, plaintiffs have stipulated that they are not making any claim for special damages, *i.e.*, “any lost opportunity, revenue as a result of lost opportunity, lost jobs, [or] lost teaching assignments.” See Sosnov Dep., p. 123 (Exhibit G). However, that stipulation in no way affects plaintiffs’ right to seek and recover general damages. See *Clemente*, 749 F. Supp. at 680 (“Nor does plaintiffs’ unilateral Stipulation not to offer proof of special damages preclude this Court from considering evidence of generalized harm.”).

Although “special damages” are required in a slander case when the slanderous statements are not defamatory *per se*, special damages are not required in any libel case, regardless of whether or not the statements are defamatory *per se*. In *Walker v. Grand Central Sanitation, Inc.*, 430 Pa. Super. 236, 242, 634 A.2d 237, 246 (1993), *appeal denied*, 539 Pa. 652, 651 A.2d 539 (1993), the Pennsylvania Superior Court stated that “all libels ... are actionable without proof of special damages.” See also *Altoona Clay Prods.*, 367 F.2d at 628 (“For obvious reasons, the presumption that words are defamatory arises much more readily in cases of libel than in cases of slander”) (quoting *Collins v. Dispatch Publishing Co.*, 152 Pa. 187, 25 A. 546, 547 (1893)); *Sprague v. American Bar Association*, 276 F. Supp. 2d 365, 369 (E.D. Pa. 2003) (“Pennsylvania caselaw unambiguously holds that general damages are sufficient in libel cases”); Restatement (Second) of Torts § 569 (“One who falsely publishes matter defamatory of another in such a manner as to make the publication a libel is subject to liability to the other

although no special harm results from the publication.”). “Recognizing the sufficiency of general damages [in libel cases] reflects the reality that ‘[b]y its very nature, injury to reputation does not work its greatest mischief in the form of monetary loss.’” *Sprague*, 276 F. Supp. 2d at 369, quoting *Agriss*, 334 Pa. Super. 295, 483 A.2d at 470.

“General damages” for defamation “include harm to reputation and standing in the community, personal humiliation and mental pain and suffering.” *Clemente*, 749 F. Supp. at 680. “Such harm may be temporary in nature.” *Id.*, citing *Pino v. Prudential Ins. Co. of America*, 689 F. Supp. 1358, 1366 (E.D. Pa. 1988). *See also Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 349-50 (1974) (general damages include compensation for “personal humiliation, and mental anguish and suffering”); *Walker*, 430 Pa. Super. at 242, 634 A.2d at 246 (defining general damages as “proof that one’s reputation was actually affected by the slander, or that she suffered personal humiliation, or both”); *Sprague*, 276 F. Supp. 2d at 369 (“general damages refer to typical damages suffered from defamation, including reputational harm and emotional suffering”); Restatement (Second) of Torts §§ 621, 623 (“One who is liable for a defamatory communication is liable for the proved, actual harm caused to the reputation of the person defamed ... [and] is liable also for emotional distress ... that is proved to have been caused by the defamatory communication.”).

While defendants make the bold assertion that “it is undisputed that plaintiffs suffered no general damages” (Def. Mem., p. 11), nothing could be further from the truth. To the contrary, both plaintiffs testified about the adverse emotional reactions that they suffered as a result of West’s defamatory statements. Mr. Rudovsky testified at the preliminary injunction hearing that it was “unsettling” (April 14, 2009 Transcript, p. 10) (Exhibit F) and “very upsetting” (*id.*, p. 12), that he was “stunned” (*id.*, p. 23) and “concerned” (*id.*, p. 24), and that he “couldn’t believe it.”

*Id.*⁸ Likewise, Mr. Sosnov testified at his deposition that he was “angry” (Sosnov Dep., pp. 40, 155) (Exhibit G), “upset” (*id.*, p. 54), and “outraged” (*id.*, p. 155), and that Mr. Rudovsky was also “very upset.” *Id.*, p. 40.

This testimony constitutes evidence of general damages, and is sufficient in and of itself to support an award of general damages for defamation. In *Marcone v. Penthouse Int’l Magazine for Men*, 754 F.2d 1072, 1080 (3d Cir.), *cert. denied*, 474 U.S. 864 (1985), the United States Court of Appeals for the Third Circuit held that the plaintiff’s testimony that he was “frustrated, distraught, upset, and distressed” constituted sufficient evidence of actual harm. “Under Pennsylvania law Marcone was entitled to recover for injury to his reputation as well as for personal humiliation and mental anguish as long as he presented competent evidence of such harm.” *Id.*

In *Brinich v. Jencka*, 757 A.2d 388 (Pa. Super. 2000), *appeal denied*, 565 Pa. 634, 771 A.2d 1276 (2001), a general contractor brought a defamation action based on the defendant homeowners’ insinuations that he had been using funds from a construction loan to support an illegal drug habit. At trial, the jury returned a \$33,000 verdict in favor of the plaintiff on the defamation claim. The Superior Court affirmed, finding that the damages award was supported by the plaintiff’s testimony that he became “angry” when he learned of the statements:

Mr. Jencka argues that Brinich’s testimony that he was “momentarily angered” is insufficient to prove damages. We

⁸ Defendants make much of the fact that Mr. Rudovsky testified in response to the Court’s question at the hearing that he wouldn’t “categorize it as emotional distress . . . at this point.” [Hearing Tr. (4/14/09 - Rudovsky) at 24:18-23]. However, Mr. Rudovsky’s comments can be understood, at best, as a statement that he was not making a separate claim for intentional infliction of emotional distress. Given that the context of that hearing was a preliminary injunction, not a damages hearing, Mr. Rudovsky’s testimony in no way can be construed as a waiver of his right to seek general damages for personal humiliation and emotional pain and suffering.

disagree. Brinich testified that when he learned of the comments he became so angry that he confronted Mr. Jencka. In addition, Brinich's subcontractor testified that, although he did not believe Brinich used drugs, he considered the possibility. **We find this testimony sufficient to prove damages as a result of Mr. Jencka's slanderous comments.**

757 A.2d at 398 (emphasis added).

The defendants in *Sprague*, like the defendants in this case, moved for summary judgment on a defamation claim, emphasizing that "all of the witnesses presented by plaintiff concede that their estimations of plaintiff did not falter as a result of" the defamatory statements.

276 F. Supp. 2d at 370. The Court rejected the defendants' argument, stating:

Although defendant is correct that numerous witnesses state that their opinion of plaintiff was not adversely affected, the reason given by these witnesses as to why their opinions were not changed yields a rational inference that supports a finding of actual harm to plaintiff. Plaintiff's witnesses testified that their positive opinions of him were not negatively affected simply because they knew him personally and thus did not believe the defamatory accusation; instead, they were outraged. A rationale [sic] inference from this evidence would be that those who read the article without personal knowledge of plaintiff would have no reason to disbelieve the alleged defamation, which would possibly result in plaintiff's reputational loss.

Id. at 370. The Court further held that the plaintiff's testimony that he was "outraged," "furious," "angry," "embarrassed," "humiliated," and "internally upset" constituted sufficient evidence of general damages. *Id.* at 370-72. Accordingly, the Court denied the defendants' motion for summary judgment.

Likewise, in *Clemente*, the Court awarded general damages after a bench trial on the basis of the plaintiff's testimony that he suffered anxiety, embarrassment, and humiliation, and a sense of being shunned. 749 F. Supp. at 680-81.

In fact, even the cases cited by the defendants – which denied recovery to plaintiffs who were unable to prove injury – make it clear that the result would have been different if, as in this case, there was evidence that the plaintiffs suffered adverse emotional reactions to the defamation. *See Walker*, 430 Pa. Super. at 252, 634 A.2d at 245 (stressing that “Walker did not testify that she suffered any adverse emotional reaction” to the defamation); *Synygy*, 51 F. Supp. 2d at 582 (stressing that there was “no evidence that plaintiff suffered humiliation”); *SNA, Inc. v. Array*, 51 F. Supp. 2d 554, 565 (E.D. Pa. 1999) (“Plaintiffs have not made the required demonstration, because there is no credible evidence⁹ of reputational damage and no credible evidence of personal humiliation from the statements.”), *aff’d*, 259 F.3d 717 (3d Cir. 2001).¹⁰

As the Court has already stated, “[o]n the basis of the evidence thus far available, it seems clear plaintiffs have established a right to some form of remedy – damages to reputation come to mind.” April 23, 2009 Memorandum, p. 2. (A copy of the Court’s April 23, 2009 Memorandum is attached as Exhibit O hereto).

b. Presumed Damages

Pennsylvania has a long history of allowing presumed damages in cases of (1) libel and (2) slander *per se*. In *Corabi v. Curtis Publishing Co.*, 441 Pa. 432, 273 A.2d 899 (1971), the

⁹ The *SNA* opinion includes the Court’s findings of fact and conclusions of law following a bench trial. In this case, of course, the credibility of the witnesses is not at issue at the summary judgment stage.

¹⁰ West cites *Kryeski v. Schott Glass Technologies, Inc.*, 426 Pa. Super. 105, 626 A.2d 595 (1993), *appeal denied*, 536 Pa. 643, 639 A.2d 29 (1994), for the proposition that “statements which are ‘merely annoying or embarrassing’ are not actionable.” Def. Mem. at 12. However, the issue in *Kryeski* was whether the statement at issue in that case was capable of a defamatory meaning – not whether plaintiffs were damaged. *See* 426 Pa. Super. at 116, 626 A.2d at 600 (“Appellants next contend that the trial court erred in finding that the statement forming the basis of appellant’s defamation count is incapable of bearing a defamatory meaning.”). In this case, by contrast, West does not even dispute that its statements were capable of a defamatory meaning. *Kryeski* has nothing whatsoever to do with what damages are recoverable in a defamation case.

Pennsylvania Supreme Court expressly adopted several provisions of the Restatement, including one that approved presumed damages. 441 Pa. at 473, 273 A.2d at 919-20; Restatement (First) of Torts § 621 (1938) (“One who is liable for a libel or for a slander actionable per se is liable for harm caused thereby to the reputation of the person defamed or in the absence of proof of such harm, for the harm which normally results from such a defamation.”). In *Frisk v. News Co.*, 361 Pa. Super. 536, 523 A.2d 347 (1986), *appeal denied*, 515 Pa. 614, 530 A.2d 867 (1987), the Superior Court approved of a jury instruction which mirrored the Pennsylvania Suggested Standard Civil Jury Instructions on presumed damages in defamation cases:

If you find that the defendant acted either intentionally or recklessly in publishing the false and defamatory communication *you may presume that the plaintiff suffered both injury to his reputation and the emotional distress, mental anguish and humiliation such as would result from such a communication.* This means you need not have proof that the plaintiff suffered emotional distress, mental anguish and humiliation in order to award him damages for *such harm because such harm is presumed by the law when a defendant publishes a false and defamatory communication with the knowledge that is false or in reckless disregard of whether it is true or false.*

361 Pa. Super. at 550, 523 A.2d at 354, quoting Pa. S.S.J.I. (Civ) 13.10(B) (emphasis added).

The doctrine [of presumed damages] has been defended on the grounds that those forms of defamation that are actionable per se are virtually certain to cause serious injury to reputation, and that this kind of injury is extremely difficult to prove. Moreover, statements that are defamatory per se by their very nature are likely to cause mental and emotional distress, as well as injury to reputation, so there arguably is little reason to require proof of this kind of injury either.

Carey v. Piphus, 435 U.S. 247, 262 (1978) (internal citations and quotation omitted). *See also Dun & Bradstreet, Inc. v. Greenmoss Builders, Inc.*, 472 U.S. 749, 760 (1985) (“proof of actual damage will be impossible in a great many cases where, from the character of the defamatory

words and the circumstances of publication, it is all but certain that serious harm has resulted in fact”), quoting W. Prosser, Law of Torts § 112, p. 765 (4th ed. 1971).

West argues in its brief that “[i]n cases of defamation per se, a plaintiff cannot rely on presumed damages but must prove ‘general damage, i.e., proof of reputational harm.’” Def. Mem., p. 11, quoting *Syngy*, 51 F. Supp. 2d at 581 (emphasis added by defendants). Ironically, defendants’ argument is refuted not only by *Corabi* and *Frisk*, but also by a case that defendants cite just one page earlier in their brief.

In *Clemente*, (cited on pp. 9-10 of defendants’ brief), Judge DuBois wrote that “[g]eneralized damage to reputation and business is **presumed** as a natural consequence of slander per se.” 749 F. Supp. at 680 (emphasis added). Later in the opinion, he reiterated that:

Under the common law of defamation, a plaintiff who proves that statements made about him were slander per se may recover even substantial sums without evidence of actual loss. ***The existence of an injury is presumed from the fact of publication.***

Id. at 681 (emphasis added), citing *Agriss*, 334 Pa. Super. 295, 483 A.2d at 470, and Restatement (Second) Torts § 570 (1977).

Likewise, West’s own treatise on Pennsylvania law, Standard Pennsylvania Practice, recognizes that “[g]eneralized damage to reputation and business is presumed as a natural result of slander per se [and] may include impairment of reputation and standing in the community, personal humiliation, and mental anguish and suffering.” 4 Standard Pennsylvania Practice 2d § 23:132 (emphasis added).¹¹

¹¹ On its website, West touts Standard Pennsylvania Practice as a “‘how to’ comprehensive discussion of criminal and civil practice and procedures.” See <http://west.thomson.com/productdetail/1647/14100972/productdetail.aspx>.

The United States Supreme Court has held that the First Amendment does not restrict the ability of states to allow presumed damages in defamation cases where, as here, the plaintiffs are private figures and the defamatory statements do not involve any issue of public concern. In *Dun & Bradstreet*, Justice Powell wrote for the plurality that:

Courts for centuries have allowed juries to presume that some damage occurred from many defamatory utterances and publications This rule furthers the state’s interest in providing remedies for defamation by insuring that those remedies are effective. In light of the reduced constitutional value of speech involving no matters of public concern, we hold that the state interest adequately supports awards of presumed and punitive damages – even absent a showing of ‘actual malice.’

472 U.S. at 760-61.

In their brief, defendants cite *Synogy* and *Pyle v. Meritor Savings Bank*, 1996 WL 115048 (E.D. Pa. Mar. 13, 1996), for the proposition that presumed damages are not available, even in cases of defamation *per se*. However, both of those District Court decisions predate the Court of Appeals’ decisions in *Beverly Enterprises, Inc. v. Trump*, 182 F.3d 183, 188 n.2 (3d Cir. 1999)¹², *cert. denied*, 528 U.S. 1078 (2000), and *Moore v. Vislosky*, 240 Fed. Appx. 457 (3d Cir. 2007), both of which make it clear that presumed damages *are* recoverable in defamation actions. Thus, *Synogy* and *Pyle* are no longer good law.¹³

¹² *Synogy* was decided on June 4, 1999; *Beverly* was decided on June 28, 1999.

¹³ Defendants also cite *McNulty v. Citadel Broadcasting Co.*, 58 Fed. Appx. 556 (3d Cir. 2003). However, the *McNulty* Court designated that its opinion was “Not for Publication.” Under the Court’s Internal Operating Procedures, such opinions do not have precedential value. United States Court of Appeals for the Third Circuit, Local Appellate Rules, Appendix I, Internal Operating Procedure 5.7. Notably, no court has ever cited *McNulty* for the proposition that presumed damages are not recoverable in cases of defamation *per se*. While *Moore* is also an unpublished opinion, Federal Rule of Appellate Procedure 32.1 permits citations to opinions designated “not for publication” if the opinions were (like *Moore*, but unlike *McNulty*) issued on or after January 1, 2007.

In *Beverly*, the Third Circuit stated that “[u]nder Pennsylvania law, where a defendant acts with actual malice, there is no need to prove actual damages.”¹⁴ 182 F.3d at 189 n.2.

In *Moore*, the Court quoted and reaffirmed that language from *Beverly*. The defendant in *Moore* appealed a jury verdict in favor of a defamation plaintiff, arguing that the District Court had erred in instructing the jury on presumed damages. *See* 240 Fed. Appx. at 472 (“Vislosky argues that she should be granted a new trial because the District Court erroneously instructed the jury that Moore was entitled to presumed damages under Pennsylvania law.”). The Court of Appeals flatly rejected the defendant’s argument, holding that:

Following *Beverly Enterprises, Inc. v. Trump*, we conclude that the District Court was correct to instruct the jury that, under Pennsylvania law, it may presume damages upon a finding that Moore had proven actual malice. 182 F.3d at 188 n. 2.

Id. at 472-73.

Beverly and *Moore* confirm that presumed damages are still available under Pennsylvania law. *See also Sprague v. American Bar Ass’n*, 2001 WL 1450606 (E.D. Pa. Nov. 14, 2001) (“Damages are assumed where there is injury to one’s professional reputation”). Thus, West’s

¹⁴ While *Dun & Bradstreet* states that there is no Constitutional requirement that actual malice be proven to support an award of presumed damages, *Beverly* states that Pennsylvania law does impose such a requirement. *See also* 2 Pennsylvania Suggested Standard Civil Jury Instruction § 13.10 (Civ.) (2d ed. 2003) (“If you find that defendant acted (with actual malice), you may presume that the plaintiff suffered” damages). A statement is made with “actual malice” when it is made with “knowledge that it was false or with *reckless disregard* of whether it was false or not.” *New York Times Co. v. Sullivan*, 376 U.S. 254, 280 (1964)(emphasis added). In this case, it is clear that West knew that its statements were false or, at the very least, acted with reckless disregard. Thus, there is abundant evidence of “actual malice.” At the very best for West, actual malice is a fact question that must be decided by the jury. *See, e.g., Fineman v. Armstrong World Industries, Inc.*, 980 F.2d 171, 197 (3d Cir. 1992) (holding that district court erred in taking actual malice determination from jury), *cert. denied*, 507 U.S. 921 (1993); *Schiavone Constr. Co. v. Time, Inc.*, 847 F.2d 1069, 1093 (3d Cir. 1988) (affirming denial of defendants’ motion for summary judgment on actual malice issue).

argument about presumed damages is clearly wrong, and West's motion for summary judgment should be denied.

c. Punitive Damages

As detailed above, there is ample evidence in the record to support an award of general damages to the plaintiffs, and plaintiffs also are entitled to presumed damages. However, even if plaintiffs could not establish entitlement to either general damages or presumed damages, they nonetheless would be entitled to recover punitive damages.

Under Pennsylvania law, once plaintiffs establish liability, they may recover punitive damages even in the absence of compensatory damages. The Pennsylvania Superior Court has held that:

the Restatement view has been adopted in Pennsylvania. Under that view, “[i]t is essential ... that facts be established that, apart from punitive damages, are sufficient to maintain *a cause of action*.” Restatement 2d § 908, comment c (Emphasis added). Accordingly, the trial court did not err when it instructed the jury that it could award punitive damages to the plaintiffs, appellees in this case, even if no compensatory damages were awarded since the court also told the jury that it first must “find in favor of the plaintiff and against the defendant on the *question of liability*.”

Rhoads v. Heberling, 306 Pa. Super. 35, 44, 451 A.2d 1378, 1383 (1982) (emphasis in original; footnote omitted). *See also Laniecki v. Polish Army Veterans Ass'n of Lucyan Chwalkowski*, 331 Pa. Super. 413, 480 A.2d 1101 (1984) (affirming award of punitive damages, despite absence of any compensatory damages); *Daley v. John Wanamaker, Inc.*, 317 Pa. Super. 348, 464 A.2d 355 (1983) (“this Court has upheld an award of punitive damages when there was no award for compensatory damages”) (citing *Rhoads*).

In *Kirkbride v. Lisbon Contractors, Inc.*, 521 Pa. 97, 555 A.2d 800 (1989), the Supreme Court of Pennsylvania approved the Superior Court's holdings in *Rhoads* and *Laniecki*:

In *Rhoads*, Superior Court affirmed a punitive damage award to two injured parties notwithstanding that neither party received any compensatory damages for personal injuries. In doing so, the Superior Court distinguished between an independent and a derivative action for punitive damages. If no cause of action exists, then no independent action exists for a claim of punitive damage since punitive damages is only an element of damages. To this extent, punitive damages must, by necessity, be related to the injury-producing cause of action. This does not mean, however, that specific compensatory damages must be awarded to sustain a punitive damage award. . . .

Likewise, in *Laniecki*, the Superior Court affirmed a judgment of only punitive damages in a libel action. The jury had returned a verdict for the plaintiff and had awarded only punitive damages believing that the plaintiff's reputation had been satisfactorily reinstated, thereby negating any compensatory damages. In affirming the award, the Superior Court reviewed the record and concluded that the plaintiff sustained a cause of action for compensatory damages even though he did not receive a monetary award for them. However, once a cause of action was proven, the jury was permitted to award punitive damages as an element of damages incident to the cause of action. Even though compensatory damages had not been awarded, punitive damages could be appropriate, the critical factor being the establishment of sufficient evidence to sustain the cause of action.

521 Pa. at 101-02, 555 A.2d at 802-03.

Various Federal Courts of Appeals have held that defamation plaintiffs may recover punitive damages even if only nominal compensatory damages are awarded. *Schiavone Constr. Co. v. Time, Inc.*, 847 F.2d 1069, 1081-82 (3d Cir. 1988) (“New Jersey would permit a punitive damage award even where the plaintiff could only recover nominal damages for libel.”); *Buckley v. Littell*, 539 F.2d 882, 897 (2d Cir.), *cert. denied*, 429 U.S. 1062 (1977) (allowing punitive damage award where plaintiffs received only nominal compensatory damages); *Davis v. Schuchat*, 510 F.2d 731, 737-38 (D.C. Cir. 1975) (same).

There is abundant evidence in the record establishing defendants' liability for defamation. Moreover, there is abundant evidence that West's conduct was extreme and outrageous, including, at least, the following:

- West rushed the Supplement to press, even though it had reached a decision to Terminate the publication, because it was required to do so to meet its revenue projections for the year.
- West entrusted the preparation of the Supplement to a recent trainee, who had never prepared a Supplement on her own, and who had no experience in, or knowledge of, Pennsylvania criminal procedure, and none of her superiors provided her with any guidance, supervision, or advice in how to prepare the supplement.
- The Supplement was prepared in approximately 10.5 hours of work time by Ms. Redzic.
- Despite Ms. Redzic's inexperience, no one at West reviewed her manuscript before it was published.
- The Supplement included virtually no new law, reflected no changes in the law or amendments to relevant statutes or rules, but re-worded virtually every single "instruction line" in the entire Supplement.
- Despite all of the shortcomings reflected above, West charged each of its subscribers \$46.50 for this Supplement, in order to meet its internal revenue projections for 2008.
- West only acted to prepare a replacement Supplement when this litigation was filed, and rushed through another supplement (the Gimeno Supplement) in an all-out effort to have it sent out before the preliminary injunction hearing in this case.
- Even though plaintiffs had specifically identified numerous deficiencies in the Redzic Supplement, the Gimeno Supplement was still materially deficient and continued to reflect poorly on plaintiffs.
- West has withheld critical communications between West and Ms. Gimeno (the author of the 2009 Supplement), which should allow the jury to draw an adverse inference about the content of those communications.

See generally pp. 5-13, *supra*.

Thus, even if the plaintiffs were not entitled to general and presumed damages, they nonetheless would have a valid claim for punitive damages to present to the jury. Accordingly, defendants' motion for summary judgment must be denied.

d. Injunctive Relief

Finally, defendants' arguments about damages simply ignore the fact that plaintiffs also are seeking injunctive relief as part of their defamation claim. Although more than a year has passed since the preliminary injunction hearing, West has still not remedied many of the shortcomings of the 2008-09 Pocket Part.

In its Memorandum denying preliminary injunctive relief, the Court acknowledged that injunctive relief might be appropriate after trial:

[I]f plaintiffs do require further injunctive relief in order to complete their remedy, such relief would be just as effective after final hearing.

Plaintiffs argue, for example, that the defendant should be required to disclose more prominently and with greater clarity and emphasis that plaintiffs were not involved in the preparation of the offending pocket part. Plaintiffs also argue that the defendants should be required to extend to all subscribers an offer to refund the cost of the offending pocket part. But I am not persuaded that plaintiffs' entitlement to this kind of relief is so clear that it would be appropriate to order it preliminarily.

In short, I am inclined to believe that the likelihood of further irreparable harm pending final outcome of this litigation has not been established with sufficient clarity.

I recognize that reasonable minds might well differ as to whether the corrective measures taken by the defendants were adequate. And it may well be that the defendants may, in their own self-interest, decide that further interim corrective measures should be taken, in order to minimize plaintiffs' claim for damages.

April 23, 2009 Memorandum, p. 3 (Exhibit O).

The major deficiencies in the Gimeno Supplement, as reflected in the testimony by David Rudovsky at the preliminary injunction hearing, and as will be developed more fully at trial, require injunctive relief. In the absence of any further updates, the inadequacies of the Gimeno

Supplement will be perpetuated indefinitely. Accordingly, a sticker should be sent to subscribers so that all users of the Treatise will be aware of the deficiencies in that pocket part, and made more clearly aware of the fact that plaintiffs had no involvement in preparing that supplement. In addition, subscribers should be offered a refund for their payment for the 2008-2009 Pocket Part. The absence of appropriate updates and corrections in the Westlaw database is a further matter for injunctive relief.

In light of plaintiffs' demands for injunctive relief, no argument about damages could warrant summary judgment in favor of the defendants on plaintiffs' defamation claim.

3. Plaintiffs Did Not "Consent" to the Defamation

In pp. 13-19 of their brief, defendants argue that they are entitled to summary judgment because plaintiffs supposedly "consented" to being defamed. The entire basis of defendants' argument is the proposition that the 2000 Agreement gave West the right to say that the plaintiffs authored the 2008-09 Pocket Part, even though the plaintiffs had nothing to do with that fraudulent, sham document. The Court aptly expressed its disdain for this argument during the preliminary injunction hearing. And, plaintiffs have set forth in detail above why the 2000 Agreement provides no support whatsoever for defendants' motion for summary judgment.

Moreover, even if the 2000 Agreement did apply here, West's "consent" argument would still fail as a matter of law. Pennsylvania adheres to the Restatement's definition of "consent" in defamation actions. *See Walker*, 430 Pa. Super. at 250, 634 A.2d at 244. Under the Restatement's definition, a plaintiff "consents" to the making of defamatory statements only if the plaintiff "knows the exact language" that the defendant will use in those statements or "has reason to know that" such language "may be defamatory." Restatement (Second) of Torts § 583 (1977). In this case, there is not a shred of evidence that plaintiffs knew "the exact language" of

the 2008-09 Pocket Part before it was published, or that plaintiffs had any reason to know that they would be defamed. Accordingly, West’s “consent” defense has no basis in fact or law.¹⁵

4. Defendants Are Not Entitled to Summary Judgment Based on the Supposed “Truth” of the Defamatory Statements

Finally, defendants argue that they are entitled to summary judgment on plaintiffs’ defamation claim because the defamatory statements were “true” or “substantially true.” Def. Mem., pp. 19-20. The sole basis for this argument is Mr. Sosnov’s deposition testimony that plaintiffs were the authors of the overwhelming majority of the content contained in the 2008-09 Pocket Part. According to defendants, that testimony establishes that “the complained of statements about the 2008-2009 Pocket Part – that it was ‘by David Rudovsky and Leonard Sosnov’ and ‘The Publisher’s Staff’ – are true or substantially true.” Def. Mem., p. 20.

This argument is particularly shameless, even by West’s standards.

a. The Statements Were Not True

First, and most obviously, defendants’ defamatory statements were **not** true. West represented that plaintiffs authored the 2008-09 Pocket Part when, in fact, plaintiffs had nothing

¹⁵ The cases cited by West in this section of its brief do not support West’s argument. In *Sharman v. C. Schmidt & Sons*, 216 F. Supp. 401 (E.D. Pa. 1963), Boston Celtics basketball player Bill Sharman sold the unconditional right to use his picture, then sued when the defendant used the picture in a beer advertisement. Following a bench trial, the Court issued findings of fact and conclusions of law, ruling that defendant’s use of the picture was “reasonable.” *Id.* at 408. *Baker v. Lafayette College*, 350 Pa. Super. 68, 504 A.2d 247 (1986), *aff’d*, 516 Pa. 291, 532 A.2d 399 (1987), and *Sobel v. Wingard*, 366 Pa. Super. 482, 531 A.2d 520 (1987), both involved privileges accorded to employers in conducting employee evaluations. Moreover, in *Baker*, the Superior Court majority held that there were factual questions as to whether the defendant had exceeded the scope of the consent given by the plaintiff, but that the statement at issue was not capable of a defamatory meaning. 350 Pa. Super. at 77, 504 A.2d at 251. The Pennsylvania Supreme Court (in an opinion that West fails to cite) affirmed on the basis that the statements were not defamatory. *See* 516 Pa. at 297-99, 532 A.2d at 402-03. The *Sobel* Court likewise held that the statements at issue in that case were not capable of a defamatory meaning. *See* 366 Pa. Super. at 487, 531 A.2d at 522.

to do with the preparation of that publication. At the preliminary injunction hearing, the Court recognized that West's statement was utterly false:

THE COURT: It [the 2000 Agreement] gives you license to falsely attribute something to them?

MR RITTINGER: No, it gives us the right to use their name on a supplement, even one that they don't prepare themselves, the actual supplement and I can read the language on that, your Honor.

THE COURT: Well, you mean that it authorizes you to say that they prepared the supplement, when they didn't?

See April 14, 2009 transcript, pp. 12-13. (A copy of the transcript of excerpts from the April 14, 2009 hearing is attached as Exhibit F hereto).

For a "truth" defense to defamation to succeed, "the truth must be as broad as the defamatory imputation or 'sting' of the statement." *Shiavone Constr.*, 847 F.2d at 1084.

It is completely irrelevant that plaintiffs were the authors of "the overwhelming majority of the content" of the 2008-09 Pocket Part. The test for determining the truth or falsity of a defamatory statement is "whether the [alleged] libel as published would have a different effect on the mind of the reader from that which the pleaded truth would have produced." *Dunlap v. Philadelphia Newspapers, Inc.*, 448 A.2d 6, 15 (Pa. Super. 1982). See also Robert D. Sack, I Sack on Defamation § 3.7 (3d Cir. 1999).

In this case, the libel as published was that plaintiffs were the authors of the fraudulent, sham Pocket Part. It is perfectly obvious that the truth – i.e., that the plaintiffs had nothing whatsoever to do with the preparation of the Pocket Part – would have had "a different effect on the mind of the reader." Accordingly, defendants' defamatory statements clearly were not "true or substantially true."

b. At Best for Defendants, the Truth or Falsity of the Defamatory Statements Is a Question of Fact that Must Be Resolved by the Jury

Plaintiffs respectfully submit that the defamatory statements at issue in this case are indisputably false. At best for the defendants, the truth or falsity of those statements is a question of fact that must be resolved by the jury. See *Shiavone Constr.*, 847 F.2d at 1085 (reversing entry of summary judgment on truth defense); *McDowell v. Paiewonsky*, 769 F.2d 942, 947 (3d Cir. 1985) (“Whether or not [an alleged defamatory statement] is substantially true is a question for the jury”); *Krochalis v. Ins. Co. of North America*, 629 F. Supp. 1360, 1366 (E.D. Pa. 1985) (denying defendant’s motion for summary judgment in defamation action; “[t]ruth is typically an issue resolved by the jury in a defamation action”) (citing Restatement (Second) of Torts § 617(b)). Accordingly, the Court should deny defendants’ motion for summary judgment.

D. Defendants Are Not Entitled to Summary Judgment on Plaintiffs’ Lanham Act Claims

1. Dastar Has No Bearing on Plaintiffs’ Claims

Plaintiffs allege that West has violated the Lanham Act in two ways: first, by falsely implying that Plaintiffs endorse or sponsor the “2008-09 Pocket Part,” and, second, by falsely representing that the “2008-09 Pocket Part” is a bona fide supplement or update of the Treatise and the 2007-08 Pocket Part.

Section 43(a) of the Lanham Act prohibits, *inter alia*, false endorsement and false advertising by imposing liability upon:

Any person who, on or in connection with any goods or services, uses in commerce any word, term, name, . . . , or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities

15 U.S.C. § 1125(a)(1).

West argues that plaintiffs' Lanham Act claims are barred by *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 123 S. Ct. 2041 (2003). In *Dastar*, the Supreme Court held that claims of false attribution of authorship could not support a claim for false designation of origin under Section 43(a)(1)(A) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(A). *Dastar*, 539 U.S. at 37, 123 S. Ct. at 2050. The decision in *Dastar*, however, was limited to claims for false designation of origin under Section 43(a)(1)(A), and did not address claims for false advertising under Section 43(a)(1)(B), or false endorsement claims under Section 43(a)(1)(A). Indeed, *Dastar* specifically left open the possibility of false advertising claims under that section for misrepresenting the "nature, characteristics, [or] qualities" of the work. *Id.* (citing 15 U.S.C. § 1125(a)(1)(B)). *Accord*, *Zyla v. Wadsworth, Div. of Thomson Corp.*, 360 F.3d 243, 252 n. 8 (1st Cir. 2004) ("The Court in *Dastar* left open the possibility that some false authorship claims could be vindicated under the auspices of § 43(a)(1)(B)'s prohibition on false advertising"); *Clauson v. Eslinger*, 455 F. Supp. 2d 256, 261 (S.D.N.Y. 2006) ("The *Dastar* Court explicitly left open the possibility that some false authorship claims could be vindicated under the auspices of this section's prohibition on false advertising.") *See generally* 5 McCarthy on Trademarks & Unfair Competition, § 27:77.1 (4th ed.). Since *Dastar* does not apply to plaintiffs' claims of false endorsement and false advertising, it provides no support for defendants' motion for summary judgment.

2. Plaintiffs Have a Valid Claim for False Endorsement Under the Lanham Act

The “2008-09 Pocket Part” falsely represented that plaintiffs Rudovsky and Sosnov endorse, sponsor, or are otherwise associated with the sham “2008-09 Pocket Part.” Messages falsely implying that a person endorses or sponsors a particular product are actionable under the Lanham Act. *See, e.g., Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1019-20 (3d Cir. 2008); see generally 5 J. Thomas McCarthy, *The Rights of Publicity and Privacy*, § 5:31 (2009) (hereafter “McCarthy, *Publicity*”).¹⁶ Moreover, a non-celebrity may assert a false endorsement claim, particularly if that non-celebrity is known in the relevant market. *See McCarthy, Publicity*, § 5:33. *See also Doe v. Friendfinder Network, Inc.*, 540 F. Supp. 2d 288, 306 (D.N.H. 2008).

To prove a false endorsement claim under Section 43(a)(1)(A) of the Lanham Act, “a plaintiff must show that: (1) its mark is legally protectable; (2) it owns the mark; and (3) the defendant’s use of the mark to identify its goods or services is likely to create confusion concerning the plaintiff’s sponsorship or approval of those goods or services.” *Facenda*, 542 F.3d at 1014. Here, plaintiffs’ personal names (their mark) are entitled to legal protection because they have acquired secondary meaning by virtue of their association with a high level of scholarship and expertise in the area of Pennsylvania criminal law and practice, and as providers of high quality legal services and legal scholarship in those areas, and because lawyers, judges, and other practitioners involved in the field of Pennsylvania criminal law and practice have come to associate the Treatise with plaintiffs. *See, e.g., Yarmuth-Dion, Inc. v. D’ion Furs, Inc.*, 835

¹⁶ False endorsement claims are not precluded by *Dastar*. *See MDM Group Associates, Inc. v. Resort Quest Int’l, Inc.*, 2007 WL 2909408, at * 7 (D. Colo. Oct. 1, 2007) (holding that false sponsorship allegations “are . . . separate from plaintiff’s false designation of origin claims and are not governed by *Dastar*”).

F.2d 990 (2d Cir. 1987); *Dresser Industries, Inc. v. Heraeus Engelhard Vacuum, Inc.*, 267 F. Supp. 963, 968 (W.D. Pa. 1967), *judgment aff'd*, 395 F.2d 457 (3d Cir.), *cert. denied*, 393 U.S. 934 (1968).¹⁷ Plaintiffs obviously own their names.

In connection with the third false endorsement factor, in order to determine whether plaintiff has established a likelihood of confusion in a false endorsement claim, the Court should consider the following factors:

1. the level of recognition that the plaintiff has among the segment of the society for whom the defendant's product is intended;
2. the relatedness of the fame or success of the plaintiff to the defendant's product;
3. the similarity of the likeness used by the defendant to the actual plaintiff;
4. evidence of actual confusion;
5. marketing channels used;
6. likely degree of purchaser care;
7. defendant's intent [in] selecting the plaintiff; and
8. likelihood of expansion of the product lines.

Facenda, 542 F.3d at 1019.

Although the Court may consider all of these factors, “they are not necessarily of equal importance, nor do they necessarily apply to every case.” *Id.* at 1020. Here, there is little doubt about factors one through three, and there can be little doubt that a reader would wrongly conclude that Rudovsky and Sosnov endorsed the “2008-09 Pocket Part.” The remaining factors

¹⁷ These facts were further established by the testimony at the preliminary injunction hearing. Mr. Frenkel testified that he wanted Mr. Rudovsky to write the original Treatise because Mr. Rudovsky was *the* person to use to assure quality and market acceptance. Likewise, Mr. Yatvin testified that he subscribed to the Treatise largely because of how greatly respected Messrs. Rudovsky and Sosnov are in the field of Pennsylvania criminal law and procedure.

also favor plaintiffs: the Pocket Part is marketed directly to subscribers who had purchased the Treatise for years when it was authored by Rudovsky and Sosnov, and therefore they would assume that plaintiffs continued to be associated with it and would be unlikely to investigate any further beyond the plaintiffs' names. Finally, West plainly intended to use plaintiffs' names; indeed, West had unsuccessfully attempted to convince plaintiffs to author the "2008-09 Pocket Part." The eighth factor, likelihood of expansion of product lines, does not appear to apply in this case.

3. Plaintiffs Have Standing to Bring Their False Advertising Claims

a. The Conte Factors

The core of plaintiffs' false advertising claim is that defendants misrepresented the nature, characteristics, and/or qualities of the "2008-09 Pocket Part" by falsely representing that it constitutes a supplement, update, revision, improvement and/or amplification of the Treatise and/or the "2007-08 Pocket Part". See Am. Compl., ¶¶ 63-64. Section 43(a) "provides a strict liability tort cause of action" for false advertising. *Vector Prods., Inc. v. Hartford Fire Ins. Co.*, 397 F.3d 1316, 1319 (11th Cir. 2005) ("It is well-settled that no proof of intent or willfulness is required to establish a violation of Lanham Act § 43(a) for false advertising."). "Liability for false advertising under the Lanham Act arises if the commercial message or statement is either (1) literally false or (2) literally true or ambiguous, but has the tendency to deceive consumers." *Tillery v. Leonard & Sciolla, LLP*, 437 F. Supp. 2d 312, 328 (E.D. Pa. 2006), citing *Novartis Consumer Health, Inc. v. Johnson & Johnson-Merck Consumer Pharms.*, 290 F.3d 578, 586 (3d Cir. 2002).

West argues that it is entitled to summary judgment on plaintiffs' false advertising claim because plaintiffs lack standing to bring that claim. West is wrong. In *Conte Bros. Automotive, Inc. v. Quaker State-Slick 50, Inc.*, 165 F.3d 221 (3d Cir. 1998), the Court of Appeals set forth

the following factors to be considered in determining whether a plaintiff has standing to bring a false advertising claim under the Lanham Act:

- (1) The nature of the plaintiffs' alleged injury: Is the injury of a type that Congress sought to redress in providing a private remedy for violations of the [Lanham Act]?
- (2) The directness or indirectness of the asserted injury.
- (3) The proximity or remoteness of the party to the alleged injurious conduct.
- (4) The speculativeness of the damages claim.
- (5) The risk of duplicative damages or complexity in apportioning damages.

Id. at 233.

In adopting this five-factor test, the Court expressly declined to limit standing to “direct competitors or their surrogates,” finding that standing extends to those with a “reasonable interest to be protected against false advertising.” *Id.* at 232, citing *Serbin v. Ziebart Int’l Corp., Inc.*, 11 F.3d 1163, 1176-77 (3d Cir. 1993). *See also Thorn v. Reliance Van Co. Inc.*, 736 F.2d 929, 933 (3d Cir. 1984) (fact that plaintiff is not a competitor of the defendant does not preclude standing under the Lanham Act).¹⁸

¹⁸ The *Conte* Court also cited decisions from the First and Second Circuits extending standing to plaintiffs who were not in direct competition with the defendant. 165 F.3d at 231-32, citing *PPX Enters., Inc. v. Audiofidelity, Inc.*, 746 F.2d 120 (2d Cir. 1984) (owner of royalty streams from musical recording had standing to sue distributor of falsely labeled recordings); and *Camel Hair & Cashmere Inst., Inc. v. Associated Dry Goods Corp.*, 799 F.2d 6 (1st Cir. 1986) (trade association of manufacturers of cashmere fibers and fabrics, but not finished coats, had standing to sue retailers of coats falsely labeled as having more cashmere than they had). *See also Phoenix of Broward, Inc. v. McDonald’s Corp.*, 489 F.3d 1156, 1167 (11th Cir. 2007) (“parties who are *not* in ‘direct’ or ‘actual’ competition may nonetheless have prudential standing to bring false advertising claims under the Lanham Act.”) (emphasis in original), *cert. denied*, 552 U.S. 1275 (2008); 4 Thomas J. McCarthy, *McCarthy on Trademarks and Unfair Competition* § 27:32 at 27-51 (“the courts have held that the plaintiff and defendant need not be in direct competition for plaintiff to have standing to sue ... under § 43(a).”).

b. Application of the *Conte* Factors to This Case

(1) Type of Injury

The first of the five *Conte* factors is whether the injury alleged is the type of injury that the Lanham Act was designed to redress – i.e., harm to the plaintiff’s “ability to compete” in the marketplace and erosion of the plaintiff’s “good will and reputation” caused by the defendant’s false advertising. *Conte*, 165 F.3d at 234-36. The focus of Section 43(a) of the Lanham Act is on protecting “commercial interests [that] have been harmed by a competitor’s false advertising and in secur[ing] to the business community the advantages of reputation and good will by preventing their diversion from those who have created them to those who have not.” *Id.* at 234 (alterations in original).

The injuries alleged in this case are precisely the sort that the Lanham Act is designed to redress. Plaintiffs have alleged that West’s false advertising harmed plaintiffs’ commercial interests, and their reputations. Thus, consideration of the first factor *Conte* factor supports the conclusion that plaintiffs have standing to pursue their claims.

(2) Directness of the Injury

The second *Conte* factor focuses on the “directness” with which the defendants’ conduct affected the plaintiffs. Consideration of this factor also supports the conclusion that plaintiffs have standing under the Lanham Act. Indeed, plaintiffs are the individuals most affected by defendants’ false advertising.

(3) Proximity of the Injury to Defendants’ Conduct

The third *Conte* factor requires an examination of the proximity of the plaintiffs to the defendants’ harmful conduct. The purpose of this factor is to determine whether there is an “identifiable class” of persons “whose self-interest would normally motivate them to vindicate the public interest” by bringing suit. *Conte*, 165 F.3d at 234. “The existence of such a class

diminishes the justification for allowing a more remote party ... to perform the office of a private attorney general.” *Joint Stock Soc’y v. UDV N. Am., Inc.*, 266 F.3d 164, 182 (3d Cir. 2001) (internal quotation marks omitted).

Courts have invoked this factor to deny standing where there are individuals or entities who would be more appropriate plaintiffs than those who have brought suit. *See Conte*, 165 F.3d at 235 (motor oil manufacturers had more concrete interest in preserving reputation of motor oil than the plaintiffs, who were retailers of engine additives); *Joint Stock Soc’y*, 266 F.3d at 182 (Russian vodka manufacturers that exported vodka to the United States were better suited to bring a false advertising claim against the defendant and “were more proximate to the claimed injury” than the plaintiff manufacturer, which did not export its vodka to the United States).

Consideration of this factor further supports the conclusion that plaintiffs have standing. Plaintiffs, as the individuals most directly and egregiously harmed by defendants’ false advertising, have a powerful motive to seek redress. There is no other “identifiable class” that has more motivation than the plaintiffs to pursue these claims. Indeed, the users of the Treatise and the Pocket Part lack standing under the Lanham Act. *See Conte*, 165 F.3d at 231 (“consumers lack standing to bring false advertising claims under the Lanham Act”); *Made in the USA Found. v. Phillips Foods, Inc.*, 365 F.3d 278, 281 (4th Cir.) (“the several circuits that have dealt with the question are uniform in their categorical denial of Lanham Act standing to consumers.”), *cert. denied*, 543 U.S. 872 (2004); *Barrus v. Sylvania*, 55 F.3d 468, 470 (9th Cir. 1995) (consumers lack standing under Lanham Act because they cannot allege commercial or competitive injury).

(4) **Speculative Nature of the Damages**

The fourth *Conte* factor looks to the speculative nature of the plaintiffs' injury. As detailed in the defamation section, above, there is abundant evidence in the record of the damages suffered by plaintiffs.

Moreover, this factor requires consideration of the "avoidability" of the claimed damages. *AFL Philadelphia, LLC v. Krause*, 639 F. Supp. 2d 512, 525 (E.D. Pa. 2009); *Knit With v. Knitting Fever, Inc.*, 2008 WL 5381349, at * 16 (E.D. Pa. Dec. 18, 2008). In *Conte*, for example, the Court of Appeals found that the plaintiff retailers could have avoided their alleged injuries by simply stocking the product marketed by the defendants. *See* 165 F.3d at 235. In this case, by contrast, plaintiffs had no way to avoid the injuries that they suffered.

Accordingly, the fourth factor also weighs in favor of plaintiffs' standing.

(5) **Risk of Duplicative Damages**

The fifth and final *Conte* factor requires the Court to assess the risk of duplicative damages and the complexity of apportioning damages. Courts applying this factor have considered "the number of potential claimants in the same position in the distribution chain as the plaintiffs and/or in the same market as the plaintiff." *Phoenix of Broward Inc. v. McDonald's Corp.*, 489 F.3d 1156, 1172 (11th Cir. 2007). Thus, in *Joint Stock Soc'y*, the Third Circuit declined to accord standing to the plaintiffs because doing so would mean that every other vodka manufacturer in the United States market – and all manufacturers who, like the plaintiff, had not entered the United States market, but had taken minimal preparatory steps to enter the market – would *also* have standing. 266 F.3d at 184-85. *See also Procter & Gamble Co. v. Amway Corp.*, 242 F.3d 539 (5th Cir.), cert. denied, 534 U.S. 945 (2001) (fifth *Conte*

factor counseled against standing because “every competitor in the market could sue” the defendant if Procter & Gamble were accorded standing).

By contrast, courts have upheld the standing of plaintiffs who, like the plaintiffs in this case, are uniquely situated vis-à-vis the defendants. *See Logan v. Burgers Ozark Country Cured Hams, Inc.*, 263 F.3d 447, 461 (5th Cir. 2001) (fifth *Conte* factor weighed in favor of standing because “Logan appear[ed] to be the only plaintiff who would bring a Lanham Act false advertising claim against [the defendant] based on” the challenged advertisements). Thus, the fifth *Conte* factor further weighs in favor of standing in this case.

The standing analysis in this case mirrors the analysis in *AFL Philadelphia, LLC v. Krause*, 639 F. Supp. 2d 512 (E.D. Pa. 2009). In that case, the owners of the Philadelphia Soul Arena Football League team sued Krause, the team’s former sales director. Krause asserted counterclaims under the Lanham Act, based on the owners’ e-mail message to fans informing them of the cancellation of the league’s 2009 season. Although the message indicated that it had been sent from Krause’s e-mail address, in fact Krause had nothing to do with the message, and did not authorize the defendants to use his name or e-mail address. Krause asserted that “the nature of his injury was his loss of reputation and goodwill.” *Id.* at 523.

The owners, like West in this case, argued that Krause lacked standing under the Lanham Act. The Court, applying the *Conte* factors, rejected the owners’ argument. With respect to the first factor, the Court found that “harm to one’s commercial reputation and goodwill are protected by the Lanham Act.” *Id.* at 525. The second factor also weighed in favor of standing, as plaintiff alleged that he suffered “reputational harm and emotional harm” as a direct result of the e-mail. *Id.* at 524. With respect to the third factor, Krause was “the most clearly identifiable party to bring this enforcement action” and was “not only the most proximate, but the only, party

to be able to bring such an enforcement action.” *Id.* at 525. The Court found that the fourth factor was neutral, since the plaintiffs’ damages were somewhat speculative but could not have been avoided. Finally, the Court found that the fifth factor weighed in favor of standing; “[s]ince [Krause] is the only person harmed by the falsely designated email from his account, there is no risk of duplicative damages.” *Id.*

In this case, as detailed above, each and every one of the *Conte* factor weighs in favor of plaintiffs here having standing to pursue their Lanham Act false advertising claims. Accordingly, defendants’ motion for summary judgment should be denied.

4. West Did Not Have the “Contractual Right” to Violate the Lanham Act

Defendants again resort to their refrain that defendants “possessed the right to use Plaintiffs’ names “generally in connection with the advertising and promotion of the Work.” (Def. Mem. at 24, quoting 2000 Agreement, § 7[4] (emphasis added by defendants)). For the reasons stated above, this argument must be denied. Whatever rights defendants do have with respect to plaintiffs’ names, they clearly do not include the right to falsely represent to the public that plaintiffs sponsor a sham pocket part. Moreover, the 2000 agreement was expressly superseded by the 2007 agreement. And, to the extent that there is any ambiguity between the two agreements, such ambiguity is a question of fact for the jury, which must construe the agreements against West, the drafter of both agreements.

5. West’s Statements Were Not True

Plaintiffs’ false advertising claim under Section 43(a)(1)(B) of the Lanham Act is based on defendants’ misrepresentation that the “2008-09 Pocket Part” was a supplement to the Treatise and the prior 2007-08 Pocket Part. This representation was both literally and deceptive and misleading. It is literally false because a “pocket part” is an up-to-date supplement to a

treatise, whereas the “2008-09 Pocket Part” is no more than a regurgitation of the 2007-08 Pocket Part. It is deceptive and misleading because any reader of the Treatise is likely to understand that the “2008-09 Pocket Part” includes relevant updates and revisions to caselaw, statutes, and court rules since the 2007-08 Pocket Part. As set forth above, and as Plaintiffs will prove at trial, the “2008-09 Pocket Part” did not include those elements, and therefore West’s statement misrepresents the “nature, quality, and characteristics” of the 2008-09 Pocket Part in violation of Section 43(a)(1)(B) of the Lanham Act. Moreover, defendants sent literature to subscribers with the “2008-09 Pocket Part” which charged subscribers for the full cost of the pocket part, and, at the very least, contained the implied message that the enclosed publication, which was being offered for sale, was a *bona fide* supplement. See Invoice for 2008-09 Supplement, attached hereto as Exhibit P.

Because defendants’ statements were literally false, deception is presumed. See, e.g., *Facenda v. NFL Films*, 542 F.3d 1007, 1021 (3d Cir. 2008) (citing *Fisons Horticulture, Inc. v. Vigoro Indus., Inc.*, 30 F.3d 466, 472 n. 8 (3d Cir. 1994)). Even if the statements were only misleading, however, readers, users, and subscribers were likely to believe that the “2008-09 Pocket Part” was a thorough and up-to-date supplement to the Treatise. The misrepresentation was material, because subscribers would find it material to know that the pocket part they were purchasing was not in fact an update of the Treatise.

E. Defendants Are Not Entitled to Summary Judgment on Plaintiffs’ Misappropriation of Name Claims

1. Section 8316

Pennsylvania has enacted an express statutory cause of action for plaintiffs whose names have been misappropriated in the manner that occurred here:

Any natural person whose name or likeness has commercial value and is used for any commercial or advertising purpose without the written consent of such natural person . . . may bring an action to enjoin such unauthorized use and to recover damages for any loss or injury sustained by such use.

42 Pa. C.S. § 8316(a) (“Section 8316”). Similarly, Pennsylvania’s common law invasion of privacy tort, which has not been abrogated by the above statute, also prohibits the unauthorized use of one’s name or likeness.

Section 8316 applies to any person whose name or likeness has “commercial value,” which is defined in the statute as a “[v]aluable interest . . . that is developed through the investment of time, effort and money.” 42 Pa. C.S. § 8316(e). In *Lewis v. Marriott Int’l, Inc.*, 527 F. Supp. 2d 422 (E.D. Pa. 2007), plaintiff Lewis – the former executive chef at a Marriott hotel – started his own catering business. After his departure from the hotel, Marriott continued to use his name in materials used to sell wedding packages. With regard to the plaintiff’s Section 8316 claim, the court concluded as follows:

The allegations discussed above plead commercial value in the name “Carl Lewis.” Lewis details with particularity the investment of time from the early 1980s onward that he made in creating a reputation in the industry. Further, Lewis describes the investment of effort and money in promoting and selling his wedding packages through Marriott. The revenue figures alleged by Lewis further support the claim that his investment of effort has paid off, as evidenced by the commercial success of his wedding packages.

Id. at 428.

In this case, the Plaintiffs are attorneys well known for their scholarship and expertise in the field of Pennsylvania criminal law and procedure. They have achieved acclaim through a substantial investment of time, effort and money. West has recognized the commercial value of

Plaintiffs' names by West's use of their names, even when there was no basis to use their names. There can be no question that Plaintiffs' names have commercial value.

Any unauthorized use of a person's name or likeness may violate Section 8316. *Facenda*, 542 F.3d at 1025 (holding that defendants' use of plaintiff's voice for 13 seconds of a 22-minute video violated the statute "on its face"). West's unauthorized uses of the Plaintiffs' names was more than fleeting – they were conspicuous and prominent both on the so-called 2008-2009 Pocket Part and on the information platforms controlled by West. In fact, West was so confident of the commercial value of the Plaintiffs' names that it put its own name ("The Publisher's Staff") in substantially smaller print on the cover page of the said "pocket part," and did not even refer to the "Publisher's Staff" on Westlaw. *See Follett v. New American Library, Inc.*, 497 F. Supp. 304, 312 (S.D.N.Y. 1980) (holding that use of larger typeface for plaintiff's name falsely suggested primary authorship).

2. Common Law

The Pennsylvania courts have long recognized a cause of action for "invasion of privacy" by "appropriation of name or likeness." *See, e.g., Vogel v. W.T. Grant Co.*, 327 A.2d 133, 136 (Pa. 1974). This tort is "grounded in the property right of an individual in the exclusive use of his own identity; the so-called 'right of publicity.'" *Fanelle v. LoJack Corp.*, 79 F. Supp. 2d 558, 564 (E.D. Pa. 2000).

In *Facenda*, 542 F.3d at 1013 n.2, the Third Circuit noted the district court's conclusion that the common law action had been "subsumed," but further noted that this was not an issue on appeal. More relevant is the *Lewis* case, where the district court examined the first *Facenda* decision and expressly held there was nothing in the text of Section 8316 or its legislative history

“suggesting that it was intended as an exclusive remedy.” *Lewis*, 527 F. Supp. 2d at 429. Therefore, the court held that a common law invasion of privacy claim could proceed. *Id.*

Pennsylvania’s common law misappropriation claim is based on § 652E of the Restatement (Second) of Torts, which provides:

One who gives publicity to a matter concerning another that places the other before the public in a false light is subject to liability to the other for invasion of his privacy, if

(a) the false light in which the other was placed would be highly offensive to a reasonable person, and

(b) the actor had knowledge of or acted in reckless disregard as to the falsity of the publicized matter and the false light in which the other would be placed.

See Curran v. Children’s Service Center of Wyoming County, Inc., 396 Pa. Super. 29, 38, 39, 578 A.2d 8, 12 (1990), appeal denied, 526 Pa. 648, 585 A.2d 468 (1991).

In *AFL Philadelphia*, *supra*, the Court found that Krause had stated valid claims under both Section 8316 and the common law, where defendants had sent an email falsely purporting to be from Krause’s e-mail address. As detailed in the Lanham Act false advertising section, above, *AFL Philadelphia* is closely analogous to this case.

West’s only argument on these claims is that the 2000 Agreement gave West the right to misappropriate the plaintiffs’ names and that, therefore, its actions were not “unauthorized.” As detailed above, however, the 2000 Agreement provides no support whatsoever for West’s arguments. Accordingly, West’s motion for summary judgment on plaintiffs’ misappropriation claims should be denied.

F. Defendants Are Not Entitled to Summary Judgment on Plaintiffs' Claims for Invasion of Privacy

Under Pennsylvania law, “false light” is one of four distinct causes of action under the broader tort of “invasion of privacy.” A publication is actionable for false light “if it is not true, is highly offensive to a reasonable person and is publicized with knowledge or in reckless disregard of its falsity. . . . caus[ing] mental suffering, shame or humiliation to a person of ordinary sensibilities.” *Larsen v. Phila. Newspapers, Inc.*, 375 Pa. Super. 66, 81-82, 543 A.2d 1181, 1189, *appeal denied*, 520 Pa. 597, 552 A.2d 251 (1988) (internal quotation marks omitted); *see also* *Rush v. Phila. Newspapers, Inc.*, 732 A.2d 648, 654 (Pa. Super. 1999) (cause of action exists “where a major misrepresentation of a person’s character, history, activities or beliefs is made that could reasonably be expected to cause a reasonable man to take serious offense.”).

First, as explained above, West’s representations in the 2008-09 Pocket Part were false. Second, the publication was highly offensive because it constituted a major misrepresentation of the plaintiffs’ activities with respect to their involvement with the 2008-09 Pocket Part, when in fact they had *no* involvement. The 2008-09 Pocket Part also constituted a material misrepresentation of the plaintiffs’ beliefs, because West’s publication represents that plaintiffs approve of the publication as updated and revised so that it is current for use in 2008-2009, when in fact they do not. Once again, the notice to subscribers does not cure the ongoing harm.

West makes three arguments in support of its motion for summary judgment on this claim: (1) plaintiffs have suffered no general damages; (2) the claim is barred by the 2000 Agreement; and (3) West’s statements were true. Thus, West merely rehashes the same untenable arguments that it makes with respect to plaintiffs’ defamation claims. Plaintiffs have

detailed above why each of West's arguments fails as a matter of law. West's motion for summary judgment on plaintiffs' "false light" invasion of privacy claim should be denied.

G. Defendants Are Not Entitled to Summary Judgment on Plaintiffs' Claims for Punitive Damages

There is ample evidence in this case by which the jury could reasonably conclude that West acted in an extreme, outrageous, and egregious manner. See pp. 33-34, *supra*. Because there is abundant evidence of actual malice in the record, plaintiffs have a viable claim for punitive damages that must be decided by the jury. See *Sprague*, 276 F. Supp. 2d at 375-77 (denying defendants' motion for summary judgment on defamation plaintiff's claim for punitive damages; "there is evidence from which a reasonable juror could infer the requisite recklessness. Thus, there is a genuine issue of material fact for jury consideration.").

H. Defendants Are Not Entitled to Summary Judgment on Plaintiffs' Claims for Attorneys' Fees

Finally, West moves for summary judgment on plaintiffs' claim for attorneys' fees. West makes two arguments, both of which fail as a matter of law.

First, West states that plaintiffs' request for attorneys' fees should be denied "given that the Court should award summary judgment in favor of West on all of Plaintiffs' claims." Def. Mem., p. 31. However, as detailed above, there is no basis for granting West summary judgment on any of the plaintiffs' claims, much less all of their claims. Thus, West's first argument has no merit.

Second, West asserts that "none of plaintiffs' causes of action permit an award of attorneys' fees under the facts alleged here." *Id.* In fact, however – and as defendants acknowledge in the very next paragraph of their brief – the Lanham Act expressly provides that

“the court in exceptional cases may award attorney fees to the prevailing party.” 15 U.S.C. § 1117(a).

This is precisely the sort of “exceptional case” that justifies an award of attorneys’ fees under the Lanham Act. While the Act does not define the term “exceptional,” the Court of Appeals has held that an award of attorneys’ fees is appropriate where the defendants’ violation of the Lanham Act was malicious, fraudulent, deliberate, or willful. *Securacomm Consulting, Inc. v. Securacom, Inc.*, 224 F.3d 273, 280-81 (3d Cir. 2000).

As detailed above, West’s actions were undoubtedly deliberate, willful, and fraudulent. The courts have not hesitated to award attorneys’ fees for such violations of the Lanham Act. *See, e.g., Louis Vuitton Malletier and Oakley, Inc. v. Veit*, 211 F. Supp. 2d 567, 585 (E.D. Pa. 2002) (awarding plaintiffs full amount of their attorneys’ fees based on finding of willful violations of the Act).

The Court of Appeals has also made it clear that attorneys’ fees may be awarded pursuant to § 1117(a) based on an adverse party’s misconduct in discovery. In *Urban Outfitters Inc. v. BCBG Max Azria Group, Inc.*, 318 Fed. Appx. 146, 148-49 & n.3 (3d Cir. 2009) the Court remanded for further consideration of whether to award attorneys’ fees based on, *inter alia*, defendants’ failure to produce documents in a timely manner. On remand, Judge Baylson found that the defendants’ discovery misconduct did in fact warrant an award of attorneys’ fees to the plaintiffs. *Urban Outfitters, Inc. v. BCBG Max Azria Group, Inc.*, 2010 WL 742654 (E.D. Pa. Mar. 2, 2010).

In this case, West’s failure to produce the Gimeno documents provides an additional basis for an award of attorneys’ fees to the plaintiffs. Accordingly, defendants’ motion for summary judgment on plaintiffs’ claim for attorneys’ fees should be denied.

IV. CONCLUSION

For all the foregoing reasons, defendants' motion for summary judgment should be denied.

Respectfully submitted,

s/Noah H. Charlson

Richard L. Bazelon, Esquire (I.D. No. 02505)
Noah H. Charlson, Esquire (I.D. No. 89210)
Michael F.R. Harris, Esquire (I.D. No. 56948)
BAZELON LESS & FELDMAN, P.C.
1515 Market Street, Suite 700
Philadelphia, PA 19102
(215) 568-1155
Email: ncharlson@bazless.com

Attorneys for Plaintiffs,
David Rudovsky and Leonard Sosnov

Dated: May 12, 2010

CERTIFICATE OF SERVICE

I hereby certify that on this 12th day of May, 2010, I served a true and correct copy of the foregoing Plaintiffs' Memorandum of Law in Opposition to Defendants' Motion for Summary Judgment upon the following counsel for defendants, as follows:

via the Court's Electronic Case Filing system:

Matthew J. Borger, Esquire
Klehr, Harrison, Harvey, Branzburg & Ellers LLP
260 South Broad Street
Philadelphia, PA 19102

via electronic mail:

James Rittinger, Esquire
Aaron Zeisler, Esquire
Satterlee Stephens Burke & Burke LLP
230 Park Avenue, Suite 1130
New York, NY 10169

s/Noah H. Charlson
Noah H. Charlson, Esquire