

## **Answers to Questions from Senator Tillis for Lisa Ramsey**

### **U.S. Senate Committee on the Judiciary Subcommittee on Intellectual Property April 30, 2024 Hearing on “The NO FAKES Act: Protecting Americans from Unauthorized Digital Replicas”**

**May 21, 2024**

**Lisa P. Ramsey  
Professor of Law  
University of San Diego School of Law**

Chair Coons, Ranking Member Tillis, and other Members of the Subcommittee: Thank you for the opportunity to answer the following Questions from Senator Tillis for the Record.

#### **Question 1: Regarding the NO FAKES Act, which is currently a strict liability bill, should there be a notice and takedown provision? If so, why?**

I do not recommend enacting a strict liability rule in the No FAKES Act if such a rule would apply to companies, organizations, or human beings that do not intentionally or knowingly create or disseminate an unauthorized “digital replica” of an individual.<sup>1</sup> Imposing strict liability in these circumstances will stifle innovation and chill expression protected by the First Amendment. Below I provide some background information about the legal doctrines of direct and indirect liability, as this relates to the current strict liability rule in the Act and your question of whether online service providers should implement a notice and takedown provision. I also recommend that Congress include a safe harbor defense in the Act for companies that implement an effective notice and takedown system with a counter notice provision, as this will protect online service providers from liability for their users’ wrongful actions regarding unauthorized digital replicas.

#### **Direct and indirect liability rules in the No FAKES Act**

**Potential defendants under the No FAKES Act.** The proposed No FAKES Act currently applies to any “person” (including companies, organizations, and human beings) that engages in certain activities relating to unauthorized digital replicas of the image, voice, or visual likeness of an individual which are newly created and computer generated. The activities set forth in Section 2(c)(2) include “(A) [t]he production of a digital replica without consent of the applicable

---

<sup>1</sup> Section 2(a) of the October 11, 2023 discussion draft of the No FAKES contains the following definition of a “digital replica”: “The term ‘digital replica’ means a newly-created, computer generated, electronic representation of the image, voice, or visual likeness of an individual that—(A) is [nearly indistinguishable] from the actual image, voice, or visual likeness of that individual; and (B) is fixed in a sound recording or audiovisual work in which that individual did not actually perform or appear.” (brackets in original). Section 2(b) (“Digital Replication Right”) explains that individuals have the right to authorize use of their image, voice, or visual likeness in a digital replica and may license or transfer their digital replica right to others in certain circumstances. For the sake of clarity and to avoid repetition, in this document I use the phrase “individual” when discussing the person depicted in the digital replica and “human being” to refer to a person that uses that individual’s digital replica, as phrases like “when an individual uses an individual’s voice” may be unclear.

individual or rights holder” and “(B) [t]he publication, distribution, or transmission of, or otherwise making available to the public, an unauthorized digital replica, if the person engaging in the activity has knowledge that the digital replica was not authorized by the applicable individual or rights holder.” Section 2(c)(2)(A) is a strict liability provision, while Section 2(c)(2)(B) only applies if the defendant has knowledge this is an unauthorized digital replica. Both provisions impose liability even if the defendant has no intent to harm the individual.

My understanding is that this language in Section 2(c)(2) of the proposed No FAKES Act covers (or could be interpreted to cover) the following potential defendants:

- (1) **human creators of unauthorized digital replicas:** human beings that engage in conduct that directly results in the production of an unauthorized digital replica of an individual, such as by asking an artificially-intelligent computer program in one or more prompts to generate a new electronic representation of the image, voice, or visual likeness of that individual without consent of the individual or rights holder;
- (2) **entity creators of unauthorized digital replicas:** technology companies and others that sell or provide goods or services that enable human creators to produce unauthorized digital replicas of an individual;<sup>2</sup>
- (3) **online service providers that host or disseminate unauthorized digital replicas:** online service providers that did not create the unauthorized digital replica but that—with knowledge that the digital replica created by another is unauthorized—sell or provide services that allow users to upload the unauthorized digital replica to their platform (such as a website or app), and then publicly display or perform, distribute, transmit, or otherwise make available to the public that unauthorized digital replica;
- (4) **humans that host or disseminate unauthorized digital replicas:** human beings who—with knowledge the digital replica created by them or by another is unauthorized—upload or repost that unauthorized digital replica, and then publicly display or perform, distribute, transmit, or otherwise make available to the public that unauthorized digital replica (such as through a personal website, texts, emails, social media posts, or other activities on an online platform); and
- (5) **employers of humans who violate the No FAKES Act:** an employer of human beings who create, host, or disseminate the unauthorized digital replica in a way which violates the Act if those employees are engaging in those activities within the scope of their employment.

Some of these defendants are strictly and directly liable under the Act for creating or disseminating the unauthorized digital replicas, while other defendants are indirectly liable for the wrongful conduct of others in certain circumstances if they have knowledge that the digital replica was not authorized by the applicable individual or rights holder.

---

<sup>2</sup> Note that human beings could—like entities—personally sell or provide goods or services that enable other human creators to produce unauthorized digital replicas of an individual. To distinguish these human beings from the human creators that engage in conduct that directly results in the production of the unauthorized digital replica and to simplify the discussion below, I use the term “entity creators” for this category of potential defendants that include these human beings who are not themselves asking the artificially intelligent computer program to create a particular digital replica of an individual.

**The legal doctrines of direct liability and indirect liability.** The proposed No FAKES Act contains a strict liability provision that imposes direct liability on a human being or entity that produces an unauthorized digital replica regardless of their mental state. Section 2(c)(A), which applies to “[t]he production of a digital replica without consent of the applicable individual or rights holder,” does not require an intent to cause harm, knowledge that a certain sound recording, image, or audiovisual work actually contains a “digital replica” of an individual as that term is defined in the Act, or knowledge that this digital replica is unauthorized. (Most human creators of unauthorized digital replicas likely know this song, picture, or video contains a “digital replica” and that they produced it without the consent of the individual or rights holder, but some may not.) This is a direct liability provision because it imposes liability on defendants that intentionally engage in the conduct which violates the law—here, the production of a digital replica without consent.

Indirect liability provisions hold an entity or human being who did not directly or intentionally engage in wrongful conduct liable for the unlawful actions of others in certain circumstances.<sup>3</sup> For example, employers may be vicariously liable for violations of the law by their employees if the employees were acting within the scope of their employment when they directly engaged in the wrongful activity. The employer may be indirectly liable even if it did not know its employees were violating the law if the employer financially benefited from this conduct and had the ability to control it. In addition, companies, organizations, and human beings may also be indirectly liable for contributing to another’s direct violation of a law by intentionally inducing or encouraging that unlawful conduct, or by continuing to supply their goods or services to bad actors after learning about specific instances of their illegal activity.<sup>4</sup> Knowledge of the direct infringer’s unlawful conduct is required for these types of indirect liability claims. One reason for this rule is that it is impossible to deter behavior that is not done knowingly.

**Entity creators of unauthorized digital replicas.** Like human creators, entity creators of digital replicas may be directly liable under Section 2(c)(A) if their goods or services are used by human creators to produce an unauthorized digital replica regardless of whether that entity knew that bad actors were using their products to violate the Act. Moreover, Section 2(d)(3)(B) states that “[i]t shall not be a defense in a civil action brought under this subsection that the defendant . . .

---

<sup>3</sup> Note indirect liability is also called “secondary liability” or “intermediary liability” when online service providers host or disseminate harmful content uploaded or created by their users. The distinction between strict liability for direct infringement and requiring intentional acts or knowledge for indirect infringement is universal across intellectual property laws. Patent, copyright, and trademark infringement are each strict liability offenses; one can directly infringe without intent or knowledge. On the other hand, inducing or contributing to patent, copyright, or trademark infringement can only be accomplished with intentional conduct and/or knowledge of another’s wrongful behavior, respectively.

<sup>4</sup> For example, compare the direct liability provision in federal patent law, 35 U.S.C. § 271(a) (patent infringement), with the indirect liability provisions in 35 U.S.C. § 271(b) (inducement of infringement) and 35 U.S.C. § 271(c) (contributory infringement). The federal copyright and trademark statutes do not have separate provisions covering indirect liability, but these doctrines have been developed by the Supreme Court in the common law. *See Metro-Goldwyn-Mayer Studios Inc. v. Gorkster*, 545 U.S. 913 (2005) (applying inducement theory in a copyright dispute); *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417 (1984) (borrowing standards from the patent statute for contributory infringement liability in copyright law); *Inwood Lab., Inc. v. Ives Lab., Inc.*, 456 U.S. 844 (1982) (discussing contributory infringement in trademark law); *Tiffany (NJ) Inc. v. eBay, Inc.*, 600 F.3d 93 (2d Cir. 2010) (same).

did not participate in the creation, development, distribution, or dissemination of the applicable digital replica.” The technology company may not know that its users are entering prompts that result in their computer program producing unauthorized digital replicas that violate the law. They may not want their users to engage in this wrongful conduct. On the other hand, some entity creators may actively encourage violations of the law and/or knowingly participate in the creation or development of an unauthorized digital replica.

Congress should consider revising the No FAKES Act so that a technology company is not directly liable for the wrongful conduct of its users when that entity did not intentionally induce human creators to produce unauthorized digital replicas and the goods or services of the entity creator can be used in ways that do not violate the Act. Examples include use of the company’s computer program to create authorized digital replicas, or to produce unauthorized digital replicas that are displayed or performed in nondeceptive ways in news reporting, a documentary, parody, or criticism.<sup>5</sup> In patent and copyright law, courts consider whether a defendant’s product has substantial noninfringing uses when determining indirect liability, so a similar approach makes sense here. The sponsors of the No FAKES Act should revise the draft bill so that entity creators of digital replicas are not strictly or directly liable under the Act when they did not intentionally or knowingly produce unauthorized digital replicas. This will make the bill (if passed) less likely to chill innovation in the digital technology field.

The bill should instead provide that technology companies and other entity creators can be sued under a theory of indirect liability. Thus, if that company actively encouraged human creators to produce unauthorized digital replicas that violate the Act, the Act could allow that entity to be held indirectly liable for intentional inducement of this unlawful conduct if it had knowledge its users were producing unauthorized digital replicas.

**Hosting or disseminating unauthorized digital replicas.**<sup>6</sup> For defendants that engage in the “publication, distribution, or transmission of, or otherwise making available to the public, an unauthorized digital replica,” Section 2(c)(2)(B) only imposes liability if the defendant has “knowledge that the digital replica was not authorized by the applicable individual or rights holder.” This is a direct liability provision for entities and human beings that knowingly engage

---

<sup>5</sup> Section 2(c)(3) of the proposed No FAKES Act contains a list of specific exclusions for the applicable digital replica’s

- (A) use as part of a news, public affairs, or sports broadcast or report;
- (B) use in documentaries, docudramas, or historical or biographical works that depict the applicable individual as that individual;
- (C) use for purposes of comment, criticism, scholarship, satire, or parody;
- (D) use in an advertisement or commercial announcement for the purposes described in (A), (B), or (C); or
- (E) use in ways that are de minimis or incidental.

These exclusions can apply regardless of the degree of dramatization. As discussed in my written testimony, it is critical to include these types of specific exclusions to liability in the Act to increase clarity and predictability in the law for potential defendants and online service providers who receive notice and takedown requests that may be frivolous. Please see that testimony for some suggested revisions to the Act relating to these exclusions.

<sup>6</sup> For useful information about the United States’ legal framework governing online service providers that publish third-party content and how Section 230 of the Communications Decency Act protects free speech on the Internet, see Eric Goldman, *The United States’ Approach to ‘Platform’ Regulation*, Santa Clara Univ. Legal Studies Research Paper (2023), [https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=4404374](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=4404374).

in this unlawful activity, and an indirect liability provision when applied to online service providers whose platforms are knowingly used by others who are directly engaging in wrongful conduct. Once an online service provider is informed via a valid notice and takedown request that its user added an unauthorized digital replica of an individual to its website or app, it may be liable for contributing to another person’s violation of the Act if the entity refuses to remove that unlawful sound recording, image, or audiovisual work in a timely manner. In addition, if an online service provider actively encouraged others to publish or disseminate unauthorized digital replicas on its platform, it may be held indirectly liable for intentional inducement if its users engage in these activities and it knows about them.

**No liability without actual and specific knowledge this is an unauthorized digital replica.**

Including a knowledge requirement for liability in Section 2(c)(2) of the Act will promote technological innovation and better protect freedom of expression, but only if Congress clarifies that defendants can only be liable under the Act if they had actual and specific knowledge that a particular sound recording, image, or audiovisual work contains an unauthorized digital replica of an individual.<sup>7</sup> General knowledge of some wrongful conduct by a user on the platform should not be sufficient for liability under the Act. Online service providers that host or disseminate songs, pictures, or videos uploaded and/or produced by their users may not know whether this digital replica is authorized or not, or whether it is a “digital replica” as that phrase is defined in the Act, until the holder of the digital replica right files a notice and takedown complaint asking the company to remove the unauthorized digital replica and provides evidence to support the allegations of unlawful conduct by the platform user.

Online service providers should not automatically take down all digital replicas uploaded to their platforms, as some digital replicas are authorized. Artists like FKA Twigs create and disseminate digital replicas of their own voice, image, or visual likeness. Advances in technology may eventually make it easier and inexpensive for online service providers to determine whether most or all uses of them are—or are not—authorized, but my understanding is this is not currently possible.

It may also be difficult and costly for an online service provider to determine whether a certain sound recording, image, or audiovisual work uploaded to its website or app contains a “digital replica” of an individual that is covered by the No FAKES Act. Certain unauthorized uses of a person’s name, image, voice, or likeness (“NIVL”) will not be “a newly-created, computer-generated, electronic representation of the image, voice, or visual likeness of an individual” that qualifies as a “digital replica” under the narrow definition in the Act. A song, picture, or video may sound or look like a certain celebrity or regular person, but not actually constitute a digital replica that is “nearly indistinguishable” from the actual voice, image, or visual likeness of that individual. It is not uncommon for one person to sound or look like another person. It is also unclear how the online service provider will determine whether the “individual did not actually perform or appear” in the song, picture, or video without considering evidence provided by the complaining party or the platform user.

---

<sup>7</sup> In (admittedly) rare circumstances, human creators may not intend to create a digital replica that is nearly indistinguishable from a real person, but may instead accidentally produce an unauthorized digital replica of an individual due to the sound recordings, images, or audiovisual works used to train the artificially intelligent computer program that created that digital replica.

For all of these reasons it is critical that Congress clarify that online service providers must have actual and specific knowledge of another's violation of the Act on their platforms to be contributorily liable under the Act for failure to remove the unauthorized digital replica. This is the best way to balance an individual's digital replica rights against the right to freedom of expression. Imposing liability on a strict liability basis is problematic because online service providers cannot determine on their own what activities of their users violate the Act. Congress should immunize online service providers from liability if they implement an effective notice and takedown system in this context, as discussed next.

### **Notice and takedown system**

Congress should consider adding a safe harbor defense to the No FAKES Act that is similar to Section 512 of the Digital Millennium Copyright Act (DMCA), which permits an online service provider to avoid liability if it adopts a notice and takedown system. This will provide public figures and regular people a way to enforce their digital replica rights protected by the Act in a fast and inexpensive way. Once the individual or rights holder files a complaint under the notice and takedown procedure which identifies a specific unauthorized digital replica of that individual that is published or disseminated on the platform, that online service provider could be liable for contributory infringement under the Act unless it removes the sound recording, image, or audiovisual work that contains this digital replica from its platform in a timely manner.

Complaining parties should have to declare, under penalty of perjury, that they are the individual depicted in the digital replica or are explicitly authorized to act on that person's behalf. One potential problem with a notice and takedown system in the context of the No FAKES Act is that the complaining party may not be the individual depicted in the digital replica or another legitimate holder of the digital replica right. It may instead be a bad actor trying to suppress the speech of the individual or someone else who has published or disseminated this digital replica with authorization.

In copyright and trademark disputes, online service providers typically require the complaining party to include a registration number or other evidence which shows that they actually own the intellectual property that is the subject of the complaint, or the platform rules require them to declare under penalty of perjury they are the intellectual property owner. For the No FAKES Act, it is not clear how individuals or rights holders will prove they own the digital replica right, or how the online service provider will determine the true identity of the complaining party and the responding party in a dispute involving a digital replica. If the platform requires human parties to upload a copy of their driver's license or passport to prove their identity, this could create serious privacy concerns. Also this alleged proof of a person's identity could be fake. The platform could require an entity rights holder to upload a copy of the agreement which gives them the ability to enforce the digital replica right that they own or have licensed (such as a will or license agreement), but such a document could also be fake. Unlike with copyright and trademark registrations, there is no government database that can be independently checked to confirm the authenticity of such a document.

As I discussed in my written and oral testimony on April 30, 2024, online service providers should also accept and respond to counter notices filed by platform users in connection with this

notice and takedown system. They should also be immunized from liability when they replace material in response to a valid counter notice. Platform users need a way to respond when they are falsely accused of wrongful conduct, and online service providers should be able to immediately put the material back up (and not wait 10 days), if bad actors file abusive complaints to suppress speech and/or the complaint is frivolous because this is not an unauthorized digital replica or the Act's specific exceptions to liability apply in the dispute. It is also important that the notice and takedown system allow the online service provider to remove the material again if the digital rights holder files a lawsuit, and require platform users to agree to personal jurisdiction in a certain U.S. court when they file the counter notice. If the counter notice is frivolous and the digital replica right holder files a complaint with a trial court that now has personal jurisdiction over the platform user, the online service provider can protect the interests of the plaintiff and the public (who may be confused by a deceptive digital replica) by removing the unauthorized digital replica and keeping it down unless the lawsuit is resolved in favor of the defendant.

Online service providers should educate their users about these rules, and make sure they are aware of the option to file a counter notice once the platform receives a notice and takedown request. These rules will make the system less likely to suppress and chill expression allowed by the Act and/or protected by the First Amendment, but only if the online service provider reinstates the creative or informational work containing the digital replica on the platform in a timely manner after receiving the counter notice and determining there is no violation of the Act.

Furthermore, Congress should consider adopting rules that require complaining and responding parties in the notice and takedown process to only submit statements to the online service provider that are truthful and made in good faith based on a reasonable factual investigation and reasonable understanding of the law. Among other things, the Act could require the complaining or responding party to declare under penalty of perjury that they have a reasonable good faith belief in the accuracy of the substantive claims in the takedown notice or defenses in the counter notice. If the complaining or responding party is engaging in abusive behavior or making false allegations in bad faith during the process, Congress could allow the opposing party and the online service provider to recover actual or statutory damages and attorney's fees from them.

**Advantages.** Litigation can be expensive and take a long time, so the notice and takedown system is better if the digital right holder's goal is to get the digital replica immediately removed from the platform. Filing a lawsuit in court may also be difficult because the complaining party may not be able to identify the name and/or address of the person(s) who produced the unauthorized digital replica or who directly engaged in other violations of the Act. A trial court in the United States may also not have personal jurisdiction over foreign person(s) that produced the unauthorized digital replica, published it on the platform, and/or disseminated it to others using the website or app of the online service provider. Owners of copyright and trademark rights can request that online service providers remove infringing materials from their platforms, so it seems fair to also allow individuals who are being impersonated online in a deceptive manner via an unauthorized digital replica to request removal of sound recordings, images, or audiovisual works that violate the No FAKES Act.

**Potential disadvantages.** Individuals and rights holders may prefer strict liability under the Act because of what has been called the “whack a mole” problem. It takes time and money to monitor websites or apps for violations of the law and then send a notice and takedown request to platforms that are hosting this unlawful expression. Every time a complaint is filed under a notice and takedown system against someone violating the law and the content is removed, numerous other platform users (or the same user) may continue to publish or disseminate the unauthorized digital replica elsewhere on the platform. This may be true, but holding online service providers strictly liable in this context is inconsistent with other intellectual property laws and could stifle technological innovation and freedom of expression on the platform. The liability rules in the No FAKES Act should be different for accidental or unknowing creation or dissemination of unauthorized digital replicas.

There are also disadvantages of a notice and takedown system from the perspective of free speech advocates and online service providers.<sup>8</sup> Current technology does not make it easy or inexpensive to determine whether a digital replica is authorized or otherwise violates the No FAKES Act. Thus, online service providers may automatically remove a digital replica once someone files a notice and takedown request without considering whether it is authorized, an exception to liability applies, or if this expression is protected by the First Amendment. As the Act currently allows plaintiffs to obtain \$5,000 in statutory damages for each violation of the Act, smaller online service providers may be unable to take the risk of leaving up protected expression that is clearly allowed by the law. Moreover, start-up companies and smaller platforms with limited resources may not be able to afford to hire sufficient human employees or pay for certain types of technology that helps them to detect, filter, or remove unauthorized digital replicas within a short timeframe. If individuals and rights holders file complaints solely using automated technology (without human review of whether the use is unauthorized or is a digital replica), trolls file abusive complaints, or if a first-time complaining party does not properly understand the requirements for a violation of the Act or the exceptions to liability, the takedown request may be frivolous. Requiring all of the parties to act reasonably and in good faith is essential in the notice and take down process.

For all of these reasons, Congress should encourage—rather than require—online service providers to adopt a notice and takedown system by creating a safe harbor defense. If Congress requires online service providers to adopt a notice and takedown system with monetary damages for noncompliance within a certain timeframe, this may encourage bad actors or “trolls” to file numerous complaints that cannot be handled in a timely manner by a smaller or medium size platform. Such damages awards could drive that online service provider out of business, harm competition, and entrench dominant platforms with more resources.

---

<sup>8</sup> For an informative discussion of the advantages and disadvantages of the notice and takedown regime created by Section 512 of the Digital Millennium Copyright Act, see Jennifer M. Urban, Joe Karaganis & Brianna L. Schofield, NOTICE AND TAKEDOWN IN EVERYDAY PRACTICE (American Assembly 2016).



**Question 2: Regarding the NO FAKES Act, do you agree that individuals should only have the right to license out their digital likeness if they are represented by counsel or a member of a union? If so, why?**

Individuals should have the right to license use of digital representations of their voice, image, or visual likeness in writing without being required to hire an attorney or be a member of a union. Still, it is critical to have informed written consent when individuals agree to license their digital replica right and require these types of provisions to be reasonable, separately negotiated, and focused on use of the person's digital replica for a specific purpose. If they are not, courts should deem that license agreement to be unenforceable. If digital replica right licenses are not limited in significant ways, this will undermine the objectives of the NO FAKES Act, which include preventing public deception and protecting the ability of people to control uses of their identity.

There is more likely to be informed consent to a reasonable agreement if the individual was represented by an attorney with expertise in this area of the law and the parties separately negotiated the agreement. Moreover, licenses should be limited to specific uses of the digital replica, such as use only in connection with a particular song/album, television series, or film/film series. If the license extends over a long period of time, there must be additional informed and specific consent for each use. If uses of the digital replica are not enumerated (or restricted), an individual could accidentally grant the licensee the ability to use her digital replica in a sexually explicit film or in another unexpected manner on the first day of the license. If exclusive licenses are allowed under the Act, they should not prevent the individual who licensed the digital replica right from personally performing, as this is inconsistent with the Act's goal of protecting that person's right of performance. To protect children under 18 whose digital replica rights are licensed by their parents and inexperienced individuals who enter into license agreements with unreasonable terms, the Act could allow revocation (and renegotiation) of a license agreement relating to the digital replica right after a certain period of time (such as 1 year) to protect the personality rights of these individuals to control their identity.

If the digital replica provision is one of many terms in a long contract relating to the performance of a musical artist or actor, or it is listed within the numerous terms and conditions of a form contract whose main focus is not the license of an individual's digital replica right, this digital replica right provision might be missed or not fully understood by an individual who is not experienced in reviewing or interpreting contract terms. Also some people may not fully understand that a broad license agreement allowing any use of their digital replica for a significant amount of money could result in the licensee creating and disseminating sexually explicit uses or other uses of the digital replica which could harm that individual's dignity and reputation (such as by programming the digital replica to make racist or sexist comments). Book authors license their copyright in a specific book or series of books to a publisher—not their copyright in all the creative works they will write within a certain time period—so it is reasonable to limit digital replica right licenses to specific negotiated uses of a person's identity.

Importantly, having an attorney review a contract will not guarantee that the agreement is reasonable and fair, especially if the attorney does not have expertise in this area of the law and the individual has little bargaining power. New musicians, actors, and student athletes often have weak bargaining power, so the attorney may advise such performers or athletes that their options

are to simply walk away or agree to a broad and lengthy digital replica right license because the provisions in this take-it or leave-it contract cannot be reasonably negotiated. Moreover, many individuals are not union members, and some licensees may not be parties to a collective bargaining agreement. Even if they are, the union may not have negotiated contract terms with the licensee that benefit this particular individual given their unique circumstances. A more personalized approach is best when a contract licenses use of a digital replica of a person's voice, image, or visual likeness that is nearly indistinguishable from that individual.

Public policy concerns here counsel in favor of explicit statutory limitations on the types of terms that are allowed in a contract covering digital replica rights to protect an individual's dignity, reputation, and other personality rights.<sup>9</sup> Rather than require individuals to hire an attorney or join a union before they can license their digital replica right, it is better to let the person with that voice, image, or visual likeness decide on a case-by-case basis how their digital replica right will be used with guardrails to preserve their ongoing control over their identity and with protections to prevent the public from being deceived by performances that were not specifically authorized or approved. The Act can allow various entities other than the individual to enforce digital replica rights without giving these entities the ability to own another person's digital identity. Such limits are essential to prevent an individual's digital replica from being controlled by others and forced to do and say things they never did (and would never do) in violation of their constitutional rights of liberty and freedom of speech.

### **Question 3: Regarding the NO FAKES Act, should there be a preemption clause in cases of conflict with state laws? If so, why?**

Yes, the No FAKES Act should preempt state laws targeting wrongful uses of digital replicas to increase clarity and predictability in the law. We live in a global marketplace and community. It is costly and inefficient for individual owners of digital replica rights, their licensees, and users of unauthorized digital replicas to determine the content of the various state statutes and common law doctrines in the United States that protect these rights. These variations in state laws can make it difficult for parties to draft licensing agreements that are consistent with the relevant state laws, and for online service providers and their users to decide what can and cannot be published or disseminated on Internet platforms.

Moreover, some state laws may not properly balance the digital replica right against the right to freedom of expression protected by the First Amendment. A single state's restrictive digital replica law could lead to online service providers like YouTube removing content from their platform that is prohibited in that state but allowed in every other state. Another benefit of federal preemption is that it eliminates the need for courts to spend time resolving choice of law issues, as it may be unclear which state law applies in a dispute about an alleged violation of a

---

<sup>9</sup> Note that federal copyright law protect authors in certain ways when they enter into contracts with others, including with the requirement that transfers of copyright ownership must be in a signed writing, and the inalienable (non-waivable) right of authors or their heirs to terminate the exclusive or nonexclusive grant of a transfer or license of copyright in a work under certain circumstances. See Justin Hughes & Robert Merges, *Copyright and Distributive Justice*, 92 NOTRE DAME L. REV. 513, 561-563 (2016).

digital replica right. Scholarship relating to copyright preemption of state right of publicity laws may provide some guidance to Congress on how to draft preemption language that furthers the goals of the No FAKES Act and which better protects expressive values than a system with federal and state laws that cover the same wrongful conduct.<sup>10</sup>

#### **Question 4: Regarding the NO FAKES Act, what unintended consequences do you foresee, if any?**

**Increased attempts to chill expression on the Internet by “trolls” or others.** Congress should do what it can to discourage abusive behavior by people who may try to invoke the Act to suppress speech protected by the First Amendment or extract settlements from innocent parties by falsely claiming the digital replica right is violated. These bad actors may send frivolous cease and desist letters that encourage self-censorship of expression and payment of money by the recipient who is informed by this letter that the Act allows awards of actual and statutory damages, punitive damages, and attorney’s fees if the complaining party prevails. Trolls acting in bad faith may also file notice and takedown complaints with online service providers when the challenged expression is authorized, not a “digital replica” under the Act, or allowed by one of the specific exceptions in the Act. A notice and takedown system is better than imposing strict liability in the Act, but it still encourages private censorship by online service providers who will usually immediately remove songs, pictures, or videos alleged to violate the digital replica right. A counter notice provision can help in these circumstances. Finally, the owner of a digital replica right may file a “Schedule A” complaint in a U.S. district court alleging online violations of the Act by numerous defendants in circumstances where the court does not have personal jurisdiction over all the defendants and they are not properly joined together in a single lawsuit.<sup>11</sup>

**Complications regarding Section 230 of the Communications Decency Act.** The current version of the Act provides in Section 2(f) that “[t]his section shall be considered to be a law pertaining to intellectual property for the purposes of section 230(e)(2) of the Communications Act of 1934 2 (47 U.S.C. 230(e)(2)).” One potential unintended consequence is that courts will determine that state right of publicity laws are also intellectual property laws for purposes of that law. If this occurs, there may be numerous lawsuits filed against online service providers not just for violations of the No FAKES Act, but also for violations of state statute and common law

---

<sup>10</sup> See JENNIFER E. ROTHMAN, THE RIGHT OF PUBLICITY: PRIVACY REIMAGINED FOR A PUBLIC WORLD 160–179 (Harvard Univ. Press 2018); Jennifer E. Rothman, *Copyright Preemption and the Right of Publicity*, 36 U.C. DAVIS L. REV. 199 (2002); Guy Rub, *A Less Formalistic Copyright Preemption*, 24 J. INTELL. PROP. L. 327 (2018); Rebecca Tushnet, *A Mask Eats into the Face: Images and the Right of Publicity*, 38 COLUMBIA J. L. & ARTS 1 (2015); see also Jennifer E. Rothman, *Navigating the Identity Thicket: Trademark’s Lost Theory of Personality, the Right of Publicity, and Preemption*, 135 HARVARD L. REV. 1271 (2022); Jennifer E. Rothman, *The Other Side of Garcia: The Right of Publicity and Copyright Preemption*, 39 COLUMBIA J. L. & ARTS 441 (2016).

<sup>11</sup> For information about the system of mass-defendant intellectual property litigation called the “Schedule A Defendants Scheme” which capitalizes on weak spots in the Federal Rules of Civil Procedure, judicial deference to intellectual property owners, and online marketplace’s liability exposure, see Eric Goldman, *A SAD Scheme of Abusive Intellectual Property Litigation*, 123 COLUMBIA L. REV. 183 (2023).

provisions that protect an individual's name, voice, image, or likeness (NVIL).<sup>12</sup> Unlike in copyright and trademark law, there is no government registry of NVIL rights so it may be difficult for online service providers to determine whether the complaining party or responding party actually owns the NVIL right. Thus Congress should consider simply saying that section 230 of the Communications Decency Act does not immunize online service providers from liability for violations of the No FAKES Act without saying that the law is an intellectual property law, especially since the Act and state right of publicity laws protect an individual's human dignity, right to privacy, and other personality rights.

**The lack of narrow tailoring of the law to further the Act's goals will cause confusion.** If Congress does not separate the No FAKES Act into different causes of action that target its diverse goals and include different requirements for liability and tailored defenses, this could create problems. For example, the "Exclusions" provision in Section 2(c)(3) of the Act provides that there is no violation of the law if "the applicable digital replica is used as part of a news, public affairs, or sports broadcast or report." Thus, I assume that news organizations, reporters, bloggers, and similar types of commentators are not liable if their news reporting or commentary discusses the harm caused by another's creation or dissemination of an unauthorized digital replica. This rule protects expressive values. One issue for Congress to consider, however, is whether the exemption will be read more broadly than Congress intends. For example, I assume Congress did not intend to exempt from liability the creation of an unauthorized digital replica of a news reporter who is currently living (such as Christiane Amanpour) or deceased (such as Walter Cronkite), or a person who plays sports (such as LeBron James or Cristiano Ronaldo), and have that unauthorized digital replica report on the news or provide commentary in connection with a professional sports event. The current language in the No FAKES Act may allow this type of use, but I doubt that Congress intended these types of uses of an unauthorized digital replica to be exempted from liability under the law, especially if they are deceptive.

**Litigation about international issues.** As the Internet is global, the online dissemination of unauthorized digital replicas easily crosses borders and can harm anyone in any country. The title of the April 30 hearing focused on protecting "Americans" but it appears from the hearing and the language of the Act that citizens of a foreign country, including the UK-based musical artist and actor FKA Twigs, could file a lawsuit alleging violations of the Act that occur in the United States. Moreover, as I discussed in footnote 22 of my written testimony, the Act does not clearly state that the law applies to the creation or dissemination of unauthorized digital replicas outside the borders of the United States. If a lawsuit targets only foreign conduct by the defendant, the accused party may argue the law does not apply because of the presumption against extraterritorial application of the law, especially if the accused party is not a U.S. citizen.

---

<sup>12</sup> Courts disagree on whether the exemption from liability in Section 230 of the Communication Decency Act applies to state right of publicity claims. See Jennifer E. Rothman, *Third Circuit Holds that Newscaster's Right of Publicity Claim can Proceed against Facebook*, ROTHMAN'S ROADMAP TO THE RIGHT OF PUBLICITY (Sept. 28, 2021), [https://rightofpublicityroadmap.com/news\\_commentary/third-circuit-holds-that-newscasters-right-of-publicity-claim-can-proceed-against-facebook/](https://rightofpublicityroadmap.com/news_commentary/third-circuit-holds-that-newscasters-right-of-publicity-claim-can-proceed-against-facebook/). See also Brian L. Frye & Jess Miers, *Combating Internet Trolls: The Right of Publicity and Section 230*, LANDSLIDE (September/October 2020), available at [https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=3693418](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3693418).

On the other hand, Section 2(c)(2)(B) applies to “making available to the public” an unauthorized digital replica. The digital right holder may argue this language suggests a lawsuit can be filed in any jurisdiction in the United States once the replica is intentionally posted on the Internet in a manner that is accessible to people within the United States. This rule could apply regardless of whether the defendant posted or disseminated the unauthorized digital replica from within the United States, or if the file was actually distributed to someone in the United States.

**Litigation about inconsistent language.** The scope of rights listed in Section (d)(3)(B) of the No FAKES Act is different than the rights listed in Section (c)(2)(A) and (B), so this may lead to litigation about the reason for the difference. In Section 2(d)(3)(B) the proposed law includes the words “creation, development, distribution, or dissemination of the applicable digital replica” while Section 2(c)(2) includes the language “production” in (A) and “publication, distribution, or transmission of, or otherwise making available to the public” in (B). Congress should consider using similar language in both parts of the law because this different language may cause confusion. Lawyers may disagree about whether “creation” is synonymous with “production”, the meaning of the term “development”, and whether the phrase “dissemination” covers “transmission” and other ways an accused party may make available the unauthorized digital replica to the public. Also Section (c)(2)(B)’s language “publication . . . or transmission of, or otherwise making available to the public” is different than words used by Congress in Section 106 of the U.S. Copyright Act, like public “display” (*e.g.*, of an image or hologram) or public “performance” (*e.g.*, of a sound recording or audiovisual work). If this language is intended to provide broader digital replica rights than the exclusive copyright rights of public display and performance set forth in Section 106, Congress may want to clarify this.

**Litigation about the digital replica definition.** There is currently some disagreement about whether the definition of “digital replica” in the Act only applies to digital representations or deepfakes created by artificially intelligent (AI) computer programs, or to any new electronic representation of the image, voice, or visual likeness of an individual that is created using computer technology and which satisfies the requirements in (A) and (B) of Section 2(a)(1). An example would be a sexually explicit photorealistic deepfake where the human creator used a computer program to add the face of a female celebrity to the body of another woman who is nude, but this change was done without the use of an AI computer program. Another example would be a photorealistic drawing or painting that was created by hand using a digital tablet (such as an iPad) in place of physical ink or paint. As this issue is critical to determining whether the Act applies, Congress may want to revise the language to clarify this.

**Litigation about the statutory damages provision.** In the Remedies part of the proposed law, Section (d)(4), the Act allows the plaintiff to opt for a statutory damages recovery of “\$5,000 per violation.” Congress should clarify what is a “violation” under the law. For example, if there is only a single song, picture, or video that contains the unauthorized digital replica, does that mean there is just one violation of the law, or is there a violation of the law every time the creative or informational work is published, distributed, transmitted, or made available to the public? If a teenager posted an unauthorized sexually explicit deepfake video he created of a classmate on Instagram, his friends repost it, and this video goes viral and is viewed thousands or millions of times, it is not clear how many violations of the Act occurred in that situation.

Is the teenager liable for one violation of the Act since there is one digital replica (\$5,000), two violations of the Act since he produced the digital replica and published it on social media (\$10,000), or \$5,000 times the total number of posts, reposts, and/or views of that digital replica by him, his friends, and random people, plus one (the violation for his production of the digital replica)? It is also unclear whether an online service provider would be liable for single or multiple violations of the Act in this circumstance if it did not remove the digital replica in a timely manner upon receiving knowledge it was unauthorized and was unlawful under the No FAKES Act. When a defendant is only indirectly liable under the Act, Congress should consider letting courts depart from the \$5,000 per violation statutory damages award if its infringement is not intentional, the online service provider had a good faith belief its user was not violating the Act, and the defendant has limited financial resources and/or responded to the removal request in a reasonable time given the size and sophistication of the company.

**Question 5: The NO FAKES Act currently does not have federal preemption. What are your thoughts on this? And what should the bill preempt: only state digital replica bills or all state rights of publicity?**

As I discussed in my answer to Question 3, I think the Act should preempt state law but the scope of this preemption should vary depending on the final version of the Act. If the Act only applies to wrongful use of unauthorized digital replicas, it should only preempt state laws focused on protecting an individual's digital replica right. If Congress decides to adopt a broad federal right of publicity law that protects the name, voice, image, or likeness of individuals, then that federal law should preempt all state right of publicity statutes. This type of preemption is called field preemption and is similar to the approach in federal patent law. Congress should also consider whether to draft the Act in such a way that it leaves in place the common law of states relating to appropriation or the right of publicity, and the precedents in those states relating to these judge-made laws, and only preempt these state common law rights when there is a conflict.

**Question 6: Trademark law deals mostly with “likelihood of consumer confusion” over the source of a product. Someone’s voice and likeness aren’t just source identifiers, though – for professional artists, they are also the product. While the NO FAKES Act doesn’t fall directly in the trademark space, what are your thoughts on this?**

I agree that an individual's voice, image, and visual likeness can identify that human being as the source of a performance and that these characteristics of a person's identity are also the product desired by consumers. Importantly, many unauthorized uses of a digital replica of a well-known performer will violate the federal Lanham Act and state trademark and unfair competition laws that regulate trademark infringement and false endorsement.

Notably, the merger of source identifier and product is not unique to people. This is true in trademark law today. For example, it is not uncommon for fans of a particular brand of clothing or sports team to pay more money for a shirt or hat that has the logo of a company (Nike) or

team (UCLA) prominently displayed on the front or back of the merchandise. Trademark law also protects the trade dress of a product if it is distinctive and not functional. An example is the three-dimensional shape and design of LEGO Group's minifigure toy. In this context, the subject matter that is protected by the law—the toy's shape and design—is serving as a source identifier for the toy and it is also the product desired by consumers.

Some attorneys and academics believe that trademark law should only target uses of another's mark that cause source confusion. One reason is that false and misleading commercial speech are outside the scope of the First Amendment's protections, and source-confusing uses of another's mark in commercial and noncommercial speech can cause significant harm to consumers and the trademark owner. Current federal trademark infringement law, however, does not just regulate source-confusing uses of trademarks. It protects distinctive trademarks against unauthorized uses that cause confusion about the trademark owner's sponsorship or approval of this use, or the parties' affiliation or connection, among other things. False endorsement claims can also be brought by celebrities who claim consumers are likely to be confused about whether they endorse certain products regardless of whether they own trademark rights in certain aspects of their identity. Finally, trademark dilution law applies outside the context of source confusion, as it protects famous marks against uses that are likely to dilute the distinctiveness of the mark or harm its reputation regardless of whether this use is likely to cause confusion. Like the No FAKES Act, state right of publicity laws do not require evidence this use of someone's voice, image, or visual likeness is likely to cause confusion, so these laws are more like trademark dilution law than trademark infringement law when the use is not deceptive.

**Question 7: (a) Can you explain why, thus far, we only have seen state level publicity rights? (b) And how does this intersect with the First Amendment?**

As I discussed in my written testimony and above, the Lanham Act does protect the right of publicity in federal law through false endorsement claims, at least for those with commercial personalities. It is true, however, that there is no overarching right of publicity law at the federal level that mirrors the state right of publicity framework, which originated with state common law and the right of privacy. I do not know for sure why similar laws have not been passed in federal legislation, but my understanding is that such laws have been proposed a number of times before in and to Congress. I have some ideas about why a state regime has dominated this space.

First, the U.S. Constitution explicitly allows Congress to protect patent and copyright rights, but there is not a provision that specifically gives the federal legislature the power to protect an individual's right of publicity. Moreover, right of publicity violations are torts that implicate a person's privacy rights and other dignitary interests. States usually are the government bodies that protect members of the public from another's harm to these types of interests. Now that the Commerce Clause is currently interpreted in a broad manner to give Congress the power to regulate trademarks, it is not surprising that Congress finds its power to regulate the digital replica right in this clause of the Constitution. Section 2(c)(1) of the No FAKES Act provides that the Act applies to "[a]ny person that, in a manner affecting interstate or foreign commerce (or using any means or facility of interstate or foreign commerce), engages in an activity described in paragraph (2) . . . ." While the U.S. Constitution also protects property rights and

some people refer to the digital replica right as a “property” right, it is more fitting to characterize this as a “personality” right since the Act protects aspects of a person’s identity from uses that may harm their human dignity and reputation. The digital replica right, like the rights of publicity and privacy, is different in kind than property like a house or car.

The First Amendment applies to federal and state laws regulating digital replicas and the right of publicity.<sup>13</sup> As I discussed in my written testimony, the U.S. Supreme Court held in *Zacchini* that Ohio’s state misappropriation law did not conflict with the First Amendment in a case involving a news station’s broadcast of the entire act of a human cannonball artist’s performance. Outside this narrow context of a broadcast of an individual’s entire act that substituted for his performance, the Court has not clarified how to balance the right of publicity against the free speech right in the First Amendment when the expression is not deceptive.

The No FAKES Act currently applies to uses of digital replicas that are not false or misleading, so there is a chance that the Supreme Court will find this law invalid under the First Amendment if Congress does not make the speech-protective revisions to the law that I discussed in my written and oral testimony. The Court could also find state right of publicity laws to be inconsistent with the First Amendment when they are applied in contexts different than the *Zacchini* case. I commend Congress for including several specific exceptions to liability in the Act, and think that these limitations should apply when use of a digital replica is not deceptive. If state legislatures do not include similar limits on the right of publicity in their states, this increases the chance the Court will find these state laws unconstitutional.

---

<sup>13</sup> For a helpful discussion of how courts have applied the First Amendment in the right of publicity context, see Robert C. Post & Jennifer E. Rothman, *The First Amendment and the Right(s) of Publicity*, 130 YALE L.J. 86 (2020). Congress may also want to consider enacting a federal law that targets Strategic Lawsuits Against Public Participation, or SLAPP suits, that attempt to suppress expression protected by the First Amendment. See, e.g., Daniel A. Horwitz, *The Need for a Federal Anti-SLAPP Law*, N.Y.U. J. OF LEGIS. & PUB. POL’Y QUORUM (2020), <https://nyujlpp.org/quorum/the-need-for-a-federal-anti-slapp-law/>.