

No. _____

In the
Supreme Court of the United States

CHRISTIAN K. NARKIEWICZ-LAINE,
Petitioner,
v.

KEVIN C. DOYLE, *et al.*,
Respondents.

**On Petition for Writ of Certiorari to the
United States Court of Appeals
for the Seventh Circuit**

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

Is a plaintiff prevented from collecting statutory damages under the Visual Artists Rights Act as well as under state common-law for damages to the same artworks? Does a civil plaintiff have a right not to be prejudiced by evidence of a prior criminal conviction?

LIST OF DIRECTLY RELATED PROCEEDINGS

There are no proceedings that are directly related to this case.

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PETITION FOR WRIT OF CERTIORARI
OPINIONS BELOW

The opinion of the Seventh Circuit Court of Appeals is reported as *Narkiewicz-Laine v. Doyle, et al*, 930 F.3d 897 (7th Cir. 2019). The District Court opinion is not reported.

JURISDICTION

The Seventh Circuit denied the petition for rehearing on August 14, 2019. This petition for writ of certiorari is filed within ninety (90) days of the decision, in accordance with Supreme Court Rule 13. This Honorable Court has jurisdiction pursuant to 28 U.S.C. § 2101(c).

**RELEVANT STATUTORY AND RULE
PROVISIONS INVOLVED**

The Visual Artists Rights Act (17 U.S.C. § 106A) (“VARA”) protects the rights of the author of a work of visual art to, *inter alia*, prevent the intentional distortion, mutilation or modification of that work, or to prevent the destruction of a work of recognized stature. Ownership of these rights is distinct from any ownership of that work, or of a copyright or any exclusive right under a copyright in that work. Damages under VARA are awarded in accordance with 17 U.S.C. § 504, which allows a plaintiff to recover either actual or statutory damages for violations.

Federal Rule of Evidence 609(b) states that if more than ten (10) years have passed since a witness’ criminal conviction, evidence of the conviction is only

admissible if its probative value, supported by specific facts and circumstances, substantially outweighs its probative effect, and the proponent gives an adverse party reasonable written notice of its intent to use it, so that the party has fair opportunity to contest its use.

STATEMENT

Petitioner Christian Narkiewicz-Laine (“Petitioner”) is an internationally renowned artist, and the head of the Chicago Athanaeum, a private art museum. Petitioner stored artwork in a space he rented from Respondents in Galena, Illinois. Several years into the lease, even though Petitioner had paid his rent and was not in violation of any other terms of the lease, Respondents emptied the storage unit and converted or destroyed the artwork stored within.

Petitioner filed suit in the United States District Court for the Northern District of Illinois App.1-2, alleging violation of the Visual Artists Rights Act (17 U.S.C. §106A(a)(3)(b)), and common-law negligence, trespass, and conversion. The jury awarded \$120,000 damages for the VARA violations, and \$300,000 for the other counts. In an order dated December 12, 2017, the trial court reduced Petitioner’s common-law damages from \$300,000 to \$180,000, reducing his total damages to \$300,000. App.36. The Seventh Circuit Court of Appeals affirmed the trial court’s decision on July 19, 2019. App. 1-2.

REASONS FOR GRANTING THE PETITION

I. The Seventh Circuit Rejected the Ninth Circuit’s Holding in *Nintendo*.

The Seventh Circuit’s decision to affirm the trial court’s reduction of damages directly conflicts with the Ninth Circuit’s explicit holding in *Nintendo of America, Inc., v. Dragon Pacific, Intern.*, 40 F.3d 1007 (9th Cir. 1994). In that case, the defendant sold counterfeit video cartridges that were compatible with Nintendo’s game system. *Id.* at 1009. The counterfeit cartridges each contained multiple games, including Nintendo copyrighted games, without license to use Nintendo’s intellectual property. *Id.* In addition to infringing on Nintendo’s copyrights, the defendant also represented that his cartridges were Nintendo products and marketed them as such, violating Nintendo’s trademark rights. *Id.* The trial court awarded Nintendo statutory damages of \$65,000 under the Copyright Act (17 U.S.C.A. § 504(a)) for the thirteen copyright infringements, and \$62,000 in damages under the Lanham Act (15 U.S.C.A. § 1117) for the trademark infringements. *Id.*

Defendant appealed, arguing that the award of both statutory damages under the Copyright Act and damages for trademark infringement under the Lanham Act constituted “double recovery.” *Id.* at 1010. The court first examined each damage award separately, and found them both within the trial court’s discretion. *Id.* at 1010. The court then turned to Defendant’s claim that the awards of damages under each act individually constituted an improper double recovery. *Id.*

The court agreed with Defendant that, a plaintiff may not recover actual damages in addition to statutory damages under the Copyright Act. *Id.* The court also held that the recovery of both lost profits and disgorgement of defendant's profits is generally considered a double recovery under the Lanham Act. *Id.* However, the court found that recovery under two statutes did not constitute double recovery, for two reasons. *Id.*

First, Nintendo's claims were not based on the same wrongful act. *Id.* The defendant could have sold the counterfeit cartridges without representing them as Nintendo products, or he could have represented them as Nintendo products without including Nintendo's intellectual property. *Id.* at 1010-11. Defendant committed two separate acts of copyright infringement and trademark infringement. *Id.* "Put together, selling the cartridges may have been one act, but it was two wrongs." *Id.* Congress created two separate statutory schemes, and in order to effectuate the purposes of both statutes, damages may be awarded under both. *Id.*

Second, Nintendo did not collect the same type of damages under both acts. *Id.* A plaintiff may elect either actual damages or statutory damages under the Copyright Act. *Id.* Actual damages are designed to compensate the plaintiff and to prevent unjust enrichment. *Id.* Statutory damages have different purposes, such as to penalize the infringer and deter future violations. *Id.* As a result, when a defendant violates the Copyright and the Lanham Act, an award of both types of damages is appropriate. *Id.*

The instant case falls under the holding of *Nintendo* because Petitioner's claims were not based on the same wrongful act. Respondent breached the lease and committed trespass and conversion, which made him liable under the common law. In addition, Respondent intentionally destroyed works of recognized stature, in violation of VARA.

In assessing whether the jury's award would have afforded a double recovery, the Seventh Circuit examined Section 504 of the Copyright Act, which forces a plaintiff to elect either actual or statutory damages, but not both. App. 9. The Seventh Circuit correctly held that Petitioner could not recover actual damages and statutory damages for the same works. *Id.* However, the Seventh Circuit held that Petitioner is not entitled to damages under *two* separate authorities-VARA and the state common-law. In doing so, the Seventh Circuit created a split between its decision and the Ninth Circuit's holding in *Nintendo*.

II. The Existence of a Circuit Split Merits Review.

It is axiomatic that the Supreme Court can grant a petition for a writ of certiorari as to virtually any issue in a case it wishes to review, and decide cases on any ground it feels is appropriate. *United States v. Pineda-Mateo*, 905 F.3d 13, 20 (1st Cir. 2018). A principal purpose for which the Supreme Court uses certiorari jurisdiction is to resolve conflicts among the United States courts of appeals concerning the meaning of provisions of federal law. *Braxton v. U.S.*, 500 U.S. 344, 347, 111 S. Ct. 1854, 114 L.Ed. 2d 385 (1991).

In this case, there is a conflict among the courts of appeals caused by the Seventh Circuit's rejection of the key holding of *Nintendo*, that a plaintiff may collect damages under the Copyright Act in addition to damages under another legal authority.

III. Evidence of Petitioner's Prior Conviction was Improperly Prejudicial.

Petitioner had a prior conviction, from 2003, for making false statements to an FBI agent. Federal Rule of Evidence 609(b) allows a trial court to admit evidence of a conviction more than ten years old only if its probative value, supported by specific facts and circumstances, substantially outweighs its prejudicial effect. Fed. R. Evid. 609(b). The purpose of Rule 609(b) is to ensure that convictions over 10 years old will be admitted very rarely and only in exceptional circumstances. *U.S. v. Reddit*, 381 F.3d 597, 601 (7th Cir. 2004). The Seventh Circuit has articulated a five-part test to guide the district court in the exercise of its discretion in determining whether the probative value of a conviction outweighs its prejudicial effect: (1) the impeachment value of the prior crime; (2) the point in time of the conviction and the witness' subsequent history; (3) the similarity between the past crime and the charged crime; (4) the importance of the defendant's testimony; and (5) the centrality of the credibility issue. *U.S. v. Hernandez*, 106 F.3d 737, 739-40, (7th Cir. 1997). The Seventh Circuit will uphold a district court's decision to admit a conviction over ten years old as long as the record shows that the district court thoughtfully analyzed the facts and properly

weighed the probative value of the evidence against its prejudicial effect. *Reddit*, 381 F.3d at 601.

The court below erred in upholding the district court's decision to admit evidence of the prior conviction. The trial record shows that the district court's decision caused a cascade of prejudicial events. Defendants' counsel mentioned the conviction in his opening statement. From that point on, every piece of Petitioner's evidence and every word of testimony he presented was shrouded by this prejudice. On cross-examination of the Petitioner, Defendants' counsel not only reiterated the fact which both sides had already stated several times, Defendants' counsel read Petitioner's plea agreement to the jury, including reading aloud five paragraphs addressing charges that had been dismissed. Defendants' counsel was also allowed to mention the conviction in his cross-examination of Petitioner's expert, even though the expert had little direct knowledge of the events, and had not been implicated. At the deposition and at trial, Defendants' counsel had repeatedly and falsely referred to Petitioner as an "art felon", despite the fact that he was not convicted of art forgery. The trial court allowed this prejudice to permeate the entire trial.

The prejudicial effect of the prior conviction unquestionably outweighed any probative value it may have had. The Seventh Circuit failed to follow its own *Hernandez* guidelines. While the impeachment value was high, the other factors: the time since conviction, lack of similarity between the conviction and the subject of the civil suit, the importance of Petitioner's testimony, and the centrality of his credibility, all

reveal that evidence of Petitioner's conviction bore little probative value, and prejudiced his chance for a fair trial.

CONCLUSION

This Honorable Court should grant the petition for certiorari. The Seventh Circuit Court of Appeals has created a significant rift with the Ninth Circuit's holding in *Nintendo*. Plaintiffs often combine VARA claims with claims under other statutory or common-law authorities. Violations of VARA often run simultaneously with violations of other intellectual property protections, such as the Lanham Act, in addition to other intentional torts.

The Seventh Circuit's holding in the case below is likely to cause confusion among litigants and trial courts. The Ninth Circuit held unequivocally that recovery under VARA does not preclude recovery under another statute. The Seventh Circuit repudiated that holding, finding that a plaintiff could not simultaneously recover under VARA and common law. To allow this split to go unaddressed would cause confusion spawning more litigation. The knowledge that damages are limited would encourage more violations of VARA, contradicting Congress' purpose in enacting the statute.

In addition, the Seventh Circuit erred in upholding the trial court's admission of the evidence of Petitioner's conviction. This admission irredeemably prejudiced the trial. Since Petitioner's testimony was at the heart of his case, this prejudice denied Petitioner the right to a fair hearing of his claims. Therefore, this

Honorable Court should grant review, and allow Petitioner to present these issues of law.

Respectfully submitted,

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