

**UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLUMBIA**

**REBECCA TUSHNET,**

Plaintiff,

v.

**UNITED STATES IMMIGRATION AND  
CUSTOMS ENFORCEMENT,**

Defendant.

Case No. 1:15-cv-00907 (CRC)

**MEMORANDUM OPINION**

Does a t-shirt with “Yankees Suck” emblazoned over the team’s iconic logo violate federal trademark law? An Immigration and Customs Enforcement (“ICE”) spokesman appeared to suggest so in a press conference touting the agency’s crackdown on counterfeit sports apparel before the 2015 Super Bowl. Begging to differ, Harvard Law School professor Rebecca Tushnet explained to ICE that an irreverent parody of a recognized trademark does not infringe because it creates no confusion over the item’s provenance. See, e.g., Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252, 269 (4th Cir. 2007) (holding “Chewy Vuiton” dog toys not to infringe on the venerable handbag maker’s trademark). And when ICE’s response failed to satisfy her that the agency was not confiscating lawful parody merchandise, Tushnet lodged a FOIA request seeking descriptions and photographs of seized apparel as well as documents instructing ICE agents on how to distinguish authentic goods from knock-offs.

Tushnet brought this action in June 2015 challenging ICE’s failure to release records in response to her request.<sup>1</sup> Since then, ICE has reviewed and released approximately 3,197

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<sup>1</sup> Tushnet was a professor at Georgetown University Law Center when she filed suit and was assisted by staff and students of the school’s Institute for Public Representation.

photographs and 1,475 pages of responsive records. With production complete as of June 2016, both parties now move for summary judgment. The motions present two remaining issues: (1) the adequacy of ICE's search for records, and (2) the applicability of FOIA's law-enforcement exemption to certain material redacted from the released records. The Court heard oral argument on the motions on December 21, 2016. For the reasons explained below, the Court cannot conclude that ICE's original search was adequate because it failed to justify its decision not to search one of its internal records systems and to support the scope of its searches across the agency's 26 field offices. The Court will therefore deny ICE's motion for summary judgment and reserve judgment on Tushnet's motion with respect to the adequacy of ICE's search. As for ICE's reliance on FOIA's law-enforcement exemption, Tushnet has raised colorable but unresolved questions concerning the appropriateness of the challenged redactions. As a result, the Court will deny both motions for summary judgment on this issue and order ICE to review the redactions in light of this ruling.

## **I. Background**

### **A. The FOIA Request**

Prior to the 2015 Super Bowl, ICE held a press conference to publicize its efforts to seize counterfeit sports-related apparel. Pl.'s Statement of Material Facts ("SMF") ¶ 1; *id.*, Ex. 1 (ICE's January 29, 2015 Press Release). As reported in the *Boston Globe*, ICE spokesman Daniel Modricker announced that any item that "debas[es] a mascot—and really anything that denigrates a team—is guaranteed to be contraband." *Id.*, Ex. 2 (Nestor Ramos, U.S. Agents Tackle Fake Super Bowl Items, *Boston Globe*, Jan. 31, 2015). The *Globe* article highlighted a "Yankees Suck" t-shirt as an example of a piece of clothing that likely constituted trademark infringement and therefore could be lawfully seized by ICE agents. See id. After reading the article, Professor Tushnet immediately wrote to Modricker seeking clarification of ICE's position on parody merchandise.

Pl.’s Mem. Supp. Cross-Mot. Summ. J. (“Cross-MSJ”) 3; see also id., Ex. 3. Modricker doubled down in his reply: “if one logo [disparages] another logo than it would be infringement.” Id.

When pressed further on ICE’s legal basis for seizing parody items, Modricker looped in attorney Joseph Liberta, Chief of the agency’s Criminal Law section. Id., Ex. 6 (email chain between Modricker, Tushnet, and Liberta). And in a February 18, 2015 email, Liberta attempted to assuage Tushnet’s concerns by noting that ICE, in consultation with agency and Department of Justice attorneys, relies on “potential fair use provisions and federal circuit-specific case law” when determining whether probable cause supports a seizure. Id., Ex. 7. He invited Tushnet to submit a FOIA request to obtain more information about the number of counterfeit seizures ICE had made in recent history. Id. Two weeks later, Tushnet took him up on his offer, submitting a request for:

- (1) Images or descriptions of clothing seized by ICE as counterfeit from 2012 until present;
- (2) Training or guidance ICE agents receive on how to distinguish counterfeit goods, including explanations of legal doctrine and trademark-infringement defenses;
- (3) Records containing the words “disparagement,” “parody,” “distortion” or “tarnishment,” in connection with trademark rights holders’ requests;
- (4) Records indicating an item was seized because it disparaged, parodied, distorted or tarnished a trademark;
- (5) Documents used in connection with the news conference ICE held in January 2015; and
- (6) Records referencing spokesperson Modricker’s statements about contraband items.

See id., Ex. 8 (“FOIA Request”).<sup>2</sup>

#### B. ICE’s Search for Responsive Records

In a series of declarations, Fernando Pineiro, the ICE official responsible for handling all FOIA requests submitted to the agency, detailed ICE’s search for responsive records. See Jan. 14, 2016 Decl. of Fernando Pineiro (“First Pineiro Decl.”) ¶¶ 1–3; Feb. 15, 2016 Decl. of Fernando Pineiro (“Second Pineiro Decl.”) ¶ 1; April 29, 2016 Decl. of Fernando Pineiro (“Third Pineiro

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<sup>2</sup> The Court will use this numbering when referring to the different components of Tushnet’s request. In the original request, item 2 was further divided into five sub-parts (numbered (a)-(e)), which are summarized here for simplicity’s sake. See FOIA Request.

Decl.”) ¶ 1; June 30, 2016 Decl. of Fernando Pineiro (“Fourth Pineiro Decl.”) ¶ 1. For the portion of request 1 related to descriptions of seized counterfeit items, ICE’s FOIA office delegated the search to the agency’s Office of Homeland Security Investigations (“HSI”), which it determined was most likely to have responsive records. First Pineiro Decl. ¶ 14. HSI in turn focused its search on the Seized Asset and Case Tracking System (“SEACATS”), a database that tracks all property seized by ICE from the time of the initial seizure. Id. at ¶¶ 17–18. Within SEACATS, every “seizure incident”—which could include multiple seized items—is assigned a unique identifier and a property category. The database also contains a summary of the circumstances surrounding the seizure and a brief (under 40 character) description of the seized items. Id. at ¶¶ 19–21, 31. HSI queried SEACATS and produced a 511-page table of all clothing seized by ICE as counterfeit goods between 2012 and March 2015. Id. at ¶¶ 25, 27. This summary reveals approximately 5,564 seizure incidents within that time period. Id. at ¶ 31. And these incidents correspond to approximately 1,085 investigative case files created by ICE agents. These case files are maintained in a separate case management system, called TECS, which is used to store investigation reports and other investigative records. Second Pineiro Decl. ¶¶ 11–13.<sup>3</sup> Because ICE apparently has no way of estimating how many pages of records are contained in these 1,085 TECS case files and is incapable of isolating records that contain item descriptions, it decided not to manually review the files to determine if they contained additional descriptions of seized items beyond those found in the SEACATS database. Id. at ¶ 13.

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<sup>3</sup> TECS, which stood for the Treasury Enforcement Communication System, was originally managed by U.S. Customs and Border Protection. It has since migrated to the Department of Homeland Security and is no longer considered an acronym but is simply known as TECS. Second Pineiro Decl. at 4 n.1.

For the remaining parts of Tushnet’s request, ICE identified several internal offices—including the Office of Training and Development, the Office of the Principal Legal Advisor, the Office of Public Affairs, and HIS—as likely locations of responsive records and tasked these offices with conducting searches “based on their knowledge of the manner in which they routinely keep records[.]” Third Pineiro Decl. ¶ 21. An ICE training office official searched shared computer files and email records using the terms “disparagement,” “distortion,” “tarnishment,” “parody,” “dist,” “dip,” “tarn,” and “Modricker.” *Id.* at ¶ 30. He also manually reviewed paper files for any relevant documents. *Id.* The Chief of the Criminal Law section conducted a similar search, using the search terms “Superbowl,” “trademark seizures,” “OPA,” “Modricker,” “Boston Globe,” and “Tushnet.” *Id.* at ¶¶ 34–35. The Public Affairs office searched computer files and email records using the terms “counterfeit,” “trademarks,” “distortion,” “disparagement,” “parody,” and “Daniel Modricker.” *Id.* at ¶ 38. Lastly, an HSI unit chief searched hard drives, shared network drives, and emails using the terms “Tushnet,” “Modricker,” and “counterfeit guides.” *Id.* at ¶ 40. In addition to conducting these central-office searches, HSI provided Tushnet’s FOIA request to its twenty-six regional field offices, which oversee sub-offices and supervise investigations into intellectual-property-rights violations, so that they could craft searches based on their documentation practices and local databases. Each field office employed its own search methods, with some offices using just one or two search terms and others up to twenty four. *See* Fourth Pineiro Decl. ¶¶ 11–12.<sup>4</sup>

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<sup>4</sup> For example, the Boston field office only used the search terms “counterfeit” and “IPR,” whereas the Houston office performed a broader search using the following terms: “jerseys,” “NFL,” “shamrock,” “Baltimore,” “pong,” “hoodies,” “Steelers,” “trademark,” “sucks,” “hat,” “soccer,” “jersey,” “disparagement,” “parody,” “tarnishment,” “distortion,” “Rockets,” “Texans,” “ball caps,” “Nike,” “Adidas,” “sports,” “counterfeit,” and “IPR.”

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