

**J-162A-B-2008]**  
**IN THE SUPREME COURT OF PENNSYLVANIA**  
**MIDDLE DISTRICT**

**CASTILLE, C.J., SAYLOR, EAKIN, BAER, TODD, McCAFFERY, GREENSPAN, JJ.**

COMMONWEALTH OF PENNSYLVANIA, : No. 116 MAP 2007  
: :  
Appellant : Appeal from the Order of the Court of  
: Common Pleas of Centre County dated  
v. : November 15, 2007 at No. CP-14-CR-  
: 0001200-2007 Dismissing Count 1 as  
OMAR A. OMAR, : Unconstitutional and Quashing the  
: Criminal Information.  
Appellee :  
: SUBMITTED: December 2, 2008

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COMMONWEALTH OF PENNSYLVANIA, : No. 20 MAP 2008  
: :  
Appellant : Appeal from the Order of the Centre  
: County Court of Common Pleas, Civil  
v. : Division, dated January 25, 2008 at No.  
: CP-14-CR-2020-2007.  
DANIEL J. O'CONNOR, :  
: :  
Appellee : ARGUED: December 2, 2008

**OPINION**

**JUSTICE BAER**

**DECIDED: October 5, 2009**

In these consolidated cases, the Centre County Court of Common Pleas dismissed charges filed by the Commonwealth for violations of the Trademark Counterfeiting Statute, 18 Pa.C.S. § 4119, based on the trial court's prior decision striking the statute as unconstitutionally vague and overbroad. Accordingly, the Commonwealth has filed direct appeals to this Court, which has exclusive jurisdiction over appeals from final orders of the

court of common pleas declaring laws of the Commonwealth unconstitutional. 42 Pa.C.S. § 722(7). We conclude that because the statute criminalizes speech protected by the First Amendment to the United States Constitution, it is unconstitutionally overbroad. Accordingly, we affirm the decisions of the Court of Common Pleas of Centre County.

We cannot consider the cases currently under review without first addressing the prior decisions of the Centre County Court of Common Pleas, striking the Trademark Counterfeiting Statute as unconstitutional. In Commonwealth v. Garrity, Centre County Crim. No. 1999-2264 (March 27, 2000), the Pennsylvania State University Police arrested James P. Garrity, Jr., for selling t-shirts with the words “Ninety-Eight Degrees” and “Penn State University” on the Penn State Campus during a concert by the band “Ninety-Eight Degrees.” The district attorney charged Garrity with violating the Trademark Counterfeiting Statute because “Penn State” was a registered federal trademark. Garrity challenged the constitutionality of the statute claiming it was unconstitutionally vague and overbroad.

After observing that statutes are presumed to be constitutional, the trial court noted that a statute is potentially unconstitutionally overbroad if it punishes constitutionally protected speech. See DePaul v. Commonwealth, 969 A.2d 536, 553 (Pa. 2009) (“[T]he U.S. Supreme Court and this Court have recognized that the overbreadth doctrine permits the facial invalidation of laws that inhibit the exercise of First Amendment rights if the impermissible applications of the law are substantial when judged in relation to the statute’s plainly legitimate sweep.”)(internal quotation marks omitted). The trial court stated that the Trademark Counterfeiting Statute defines the crime as “Any person who knowingly manufactures, uses, displays, advertises, distributes, offers for sale, sells or possesses with intent to sell or distribute any items or services bearing or identified by a counterfeit mark shall be guilty of the crime of trademark counterfeiting.” 18 Pa.C.S. § 4119(a).<sup>1</sup> A

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<sup>1</sup> In relevant part, the Trademark Counterfeiting Statute provides:  
(continued...)

counterfeit mark is defined by the statute as either “(1) [a]ny unauthorized reproduction or copy of intellectual property” or “(2) [i]ntellectual property affixed to any item knowingly sold, offered for sale, manufactured or distributed or identifying services offered or rendered, without the authority of the owner of the intellectual property.” 18 Pa.C.S. § 4119(i). Combining subsections (a) and (i)(1), the court noted, “this statute makes it unlawful to reproduce any trademark for any use, without the express permission of the owner of the intellectual property.” Garrity Slip Op. at 5 (emphasis in original). The court observed that this prohibition would apply to constitutionally protected activity such as “[w]rit[ing] the words ‘Penn State’ on a political placard or sign, such as, ‘Penn State students for the

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(...continued)

(a) Offense defined.-- Any person who knowingly manufactures, uses, displays, advertises, distributes, offers for sale, sells or possesses with intent to sell or distribute any items or services bearing or identified by a counterfeit mark shall be guilty of the crime of trademark counterfeiting.

\* \* \* \* \*

(i) Definitions.-- As used in this section, the following words and phrases shall have the meanings given to them in this subsection:

“Counterfeit mark.” Any of the following:

(1) Any unauthorized reproduction or copy of intellectual property.

(2) Intellectual property affixed to any item knowingly sold, offered for sale, manufactured or distributed or identifying services offered or rendered, without the authority of the owner of the intellectual property.

“Intellectual property.” Any trademark, service mark, trade name, label, term, device, design or word adopted or used by a person to identify that person's goods or services.

18 Pa.C.S. § 4119.

Constitution.”<sup>2</sup> Id. The court therefore held that the Trademark Counterfeiting Statute is unconstitutionally overbroad and dismissed the charge filed against Garrity for violating the then-unconstitutional statute. Although the Commonwealth initially appealed the March 2000 decision in Garrity, it abandoned the appeal, leaving Garrity as controlling law in Centre County.

Similarly, in Commonwealth v. Price, Centre County No. CP-14-CR-2211-2006 (November 15, 2007), the trial court, with the same trial judge presiding, dismissed charges filed against a defendant under the Trademark Counterfeiting Statute. The court rejected the Commonwealth’s argument that other states have upheld similar counterfeit trademark statutes, observing that those statutes did not criminalize the “use” of the trademark.

Currently before this Court is the case of Omar A. Omar. On May 16, 2007, a police officer stopped Appellee Omar for exceeding the speed limit on Route 80 in Centre County. Upon seeing a number of boxes of what appeared to be counterfeit Nike sneakers, the officer arrested Appellee Omar for violation of the Trademark Counterfeiting Statute. Although Appellee Omar challenged the legality of the search and seizure in a motion to suppress, the trial court determined that consideration of the legality of the search was unnecessary given its decision in Garrity, followed in Price, that the statute was unconstitutional. The court observed that “an unconstitutional statute is ineffective for any purpose; it is as if it were never enacted.” Tr. Ct. Slip Op. at 2, quoting Glen-Gery Corp. v. Zoning Hearing Bd. of Dover Tp., 907 A.2d 1033, 1043 (Pa. 2006). Accordingly, finding a defect on the face of the criminal information that prevented prosecution, the court quashed the information and dismissed the charges against Appellee Omar.

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<sup>2</sup> Although our focus is upon the criminalization of political speech, the trial court observed that the statute would also criminalize children painting “Penn State” on their tree house, football fans painting “Penn State” on their faces, a gardener spelling out “Penn State” with flowers, and concert promoters printing t-shirts with Penn State to denote the location of a concert. Id.

In the other case consolidated for appeal before this Court, Appellee Daniel J. O'Connor was arrested for selling hats bearing the Penn State logo outside Beaver Stadium on the Penn State campus. Appellee O'Connor was charged with violating the Trademark Counterfeiting Statute because he did not have the appropriate approval to use the Penn State name and logo on the hats. Appellant O'Connor filed a motion to quash the information based upon the trial court's prior determination that the statute was unconstitutional. As in Appellee Omar's case, the trial court dismissed the charges.

The Commonwealth now appeals the decisions dismissing the charges based upon the trial court's conclusion that the statute is unconstitutionally vague and overbroad.<sup>3</sup> Given the trial court's holding of unconstitutionality, this Court noted probable jurisdiction and consolidated the Commonwealth's appeals relating to Appellees Omar and O'Connor.

The Commonwealth asserts that the trial court erred when it concluded that the Trademark Counterfeiting Statute was unconstitutional. The Commonwealth observes that courts must presume that statutes are constitutional, and strike them as unconstitutional only if the statute clearly, palpably, and plainly violates the Constitution. See Commonwealth v. Davidson, 938 A.2d 198, 207 (Pa. 2007). Accordingly, the Commonwealth emphasizes the heavy burden of proof placed upon those challenging the constitutionality of a statute. The Commonwealth correctly notes that a statute is unconstitutionally overbroad only if the statute criminalizes a substantial amount of constitutionally protected speech. See DePaul, 969 A.2d at 553.

The Commonwealth asserts that the Trademark Counterfeiting Statute is not unconstitutionally overbroad, claiming that it is limited to those persons with the intent to sell or distribute items with counterfeit trademarks, and thus that the statute does not reach

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<sup>3</sup> Given that we determine that the statute is unconstitutionally overbroad, we need not address the secondary holding that the statute is also unconstitutionally vague.

a substantial amount of constitutionally protected speech. The Commonwealth observes that the trial court’s analysis of unconstitutionality centered on the inclusion of the word “use” in the definition of the offense of trademark counterfeiting. The Commonwealth, however, asserts that the statute only applies when the counterfeit trademark is used “with intent to sell or distribute.” Implicitly, the Commonwealth is contending that the phrase “with intent to sell or distribute” applies not only to the word “possess,” which immediately proceeds the phrase in subsection (a), but also to the entire list of verbs in subsection (a), including “use.” To support its argument that the breadth of the statute is limited by intent, the Commonwealth relies upon the Superior Court’s decision in Commonwealth v. George, 878 A.2d 881, 886 (Pa. Super. 2005), in which the court emphasized the defendant’s intent to sell.<sup>4</sup> In George, the court rejected the defendant’s sufficiency of the evidence argument where the defendant claimed that the statute required possession of twenty-five counterfeit items with the intent to sell. Instead, the court observed that the statute merely provided that the intent to sell could be presumed from the possession of twenty-five items.<sup>5</sup>

Moving beyond the words of the currently enacted statute, the Commonwealth relies on a proposed amendment to the statute, statutes from our sister states, and additional provisions in the Crimes Code. The proposed amendment overtly incorporates the concept

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<sup>4</sup> The Commonwealth mistakenly credits this Court with the decision in George. Indeed, the Commonwealth asserts, “The Supreme Court of Pennsylvania has twice reviewed the Counterfeiting statute, in George and Sow], 860 A.2d 154 (Pa. Super. 2004),] and not once did the court question the constitutionality of the statute.” Brief of Commonwealth in O’Conner at 9. We respectfully note that the Superior Court, rather than this Court, issued the cited decisions, and appropriately did not raise any issues of constitutionality *sua sponte*.

<sup>5</sup> The statute provides for the following presumption: “A person having possession, custody or control of more than 25 items bearing a counterfeit mark may be presumed to possess said items with intent to sell or distribute.” 18 Pa.C.S. § 4119(b).

of intent to deceive into the definition of a counterfeit mark.<sup>6</sup> As detailed below, the Commonwealth directs our attention to cases in other states applying similar trademark counterfeiting statutes. Additionally, the Commonwealth relies upon the default *mens rea* provided in the Crimes Code, 18 Pa.C.S. § 302(c), which provides, “When the culpability sufficient to establish a material element of an offense is not prescribed by law, such element is established if a person acts intentionally, knowingly or recklessly with respect thereto.” It therefore contends that the statute only applies to those intending to sell items with counterfeit marks. Finally, the Commonwealth asserts that even if protected behavior might be prohibited by the statute, we should overlook the unconstitutionality based upon the provision in the Crimes Code allowing courts to dismiss charges where the conduct is

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<sup>6</sup> The proposed amendment substitutes the following definition of “counterfeit mark,” thus eliminating the need for the problematic definition of “intellectual property” in the current statute:

A spurious mark that meets all of the following:

- (1) Is applied to, used or intended to be used in connection with an item or service.
- (2) Is identical with or substantially indistinguishable from a mark registered and in use in this Commonwealth, any other state or on the principal register in the United States Patent and Trademark Office, whether or not the person knew the mark was registered.
- (3) The application of which is either:
  - (i) likely to cause confusion, to cause mistake or to deceive; or
  - (ii) otherwise intended to be used on or in connection with the item or service for which the mark is registered.

Pennsylvania Senate Bill No. 895 of 2007. The proposed amendment was referred to the Judiciary Committee on June 6, 2007. As of July 31, 2009, the website of the General Assembly does not indicate any further action on the amendment.

*de minimis* or does not involve the behavior that the statute intends to prevent. See 18 Pa.C.S. § 312.<sup>7</sup>

Echoing the trial court, Appellees argue that “[b]y criminalizing the mere ‘use, display . . . [or] distribute[ion]’ of items bearing a counterfeit mark, and defining ‘counterfeit mark’ broadly to include ‘any term or word,’ the Trademark Counterfeiting statute is easily applied to a broad array of constitutionally protected activity.” Brief for O’Connor at 4. Appellees note that the use of the word “Nike” on a sign at a protest rally, such as “Nike uses sweatshop labor” would fall within the reach of the Trademark Counterfeiting Statute because the activity would involve the unauthorized use of a word or term used by another to identify goods or services. Indeed, Appellees contend that the brief they submitted in this case violated the Trademark Counterfeiting Statute because they distributed (to the Court and the parties) an item containing an unauthorized reproduction of words, such as Nike and Penn State, that are used by other entities to identify goods or services.

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<sup>7</sup> The De minimis infractions statute provides in relevant part:

(a) General rule. - The court shall dismiss a prosecution if, having regard to the nature of the conduct charged to constitute an offense and the nature of the attendant circumstances, it finds that the conduct of the defendant:

(1) was within a customary license or tolerance, neither expressly negated by the person whose interest was infringed nor inconsistent with the purpose of the law defining the offense;

(2) did not actually cause or threaten the harm or evil sought to be prevented by the law defining the offense or did so only to an extent too trivial to warrant the condemnation of conviction; or

(3) presents such other extenuations that it cannot reasonably be regarded as envisaged by the General Assembly or other authority in forbidding the offense.

18 Pa.C.S. § 312.

Appellees also rebut the argument that the inclusion of the phrase “with intent to sell or distribute” applies to all the verbs in the subsection (a) of the statute including “use” and “display.” Appellees contend that the phrase only applies to the verb “possess,” which immediately precedes the phrase, in accordance with the standards of statutory construction, citing Commonwealth v. Packer, 798 A.2d 192, 198 (Pa. 2002) (observing “the well established cannon of construction that courts should generally apply qualifying words or phrases to the words immediately preceding them”). They further note that applying the phrase to all the verbs would lead to the absurd result that the statute would prohibit individuals from selling with intent to sell and from distributing with intent to distribute.

As the constitutionality of a statute is a pure question of law, our standard of review is de novo and our scope of review is plenary. See Davidson, 938 A.2d at 203. Moreover, we presume that statutes are constitutional and require those challenging the constitutionality of a statute to demonstrate that it clearly, plainly, and palpably violates the constitution. DePaul, 969 A.2d at 545-46. Although we must presume that the legislature does not intend to violate the Constitution, we do not invoke that presumption where the language is clear. 1 Pa.C.S. §§ 1921, 1922. Cf. Commonwealth ex rel. Mac Callum v. Acke, 162 A. 159, 160 (Pa. 1932) (“Where the Constitution has expressed its purpose in clear and explicit language, a court cannot delimit the meaning of the words used by reference to a supposed intent which might be evoked from it, or from the debates before the constitutional convention.”). Our rules of statutory construction provide, “[w]hen the words of a statute are clear and free from all ambiguity, the letter of it is not to be disregarded under the pretext of pursuing its spirit.” 1 Pa. C.S. § 1921(b). Moreover, “[w]ords and phrases shall be construed according to rules of grammar.” 1 Pa. C.S. § 1903.

An overbreadth challenge is generally limited to issues falling under the First Amendment of the United States Constitution, protecting the right to free speech. See Davidson, 938 A.2d at 208. We have recognized that “the Constitution provides significant protection from overbroad laws that chill speech within the First Amendment’s vast and privileged sphere.” Id. (internal quotations omitted). When protected expression, such as political speech, is at issue, “both the U.S. Supreme Court and this Court have recognized that the overbreadth doctrine permits the facial invalidation of laws that inhibit the exercise of First Amendment rights if the impermissible applications of the law are substantial when judged in relation to the statute’s plainly legitimate sweep.” DePaul, 969 A.2d at 553 (internal quotation marks omitted). “[I]t has been the judgment of this Court that the possible harm to society in permitting some unprotected speech to go unpunished is outweighed by the possibility that protected speech of others may be muted and perceived grievances left to fester because of the possible inhibitory effects of overly broad statutes.” Commonwealth v. DeFrancesco, 393 A.2d 321, 329 (Pa. 1978). Accordingly, a litigant asserting an overbreadth challenge is not required to demonstrate that the statute violated his own protected speech, but instead may prove a statute’s unconstitutionality by demonstrating that “the statute’s very existence may cause others not before the court to refrain from constitutionally protected speech or expression.” Davidson, 938 A.2d at 208.

The standard for determining whether a statute is overbroad is well established:

A statute is unconstitutionally overbroad only if it punishes lawful constitutionally protected activity as well as illegal activity. Thus, in determining whether a statute is unconstitutional due to overbreadth, a court’s first task is to determine whether the enactment reaches a substantial amount of constitutionally protected conduct. The overbreadth of a statute must not only be real, but substantial as well, judged in relation to the statute’s plainly legitimate sweep. Consequently, if a statute’s overbreadth is substantial, it may not be enforced against anyone until it is narrowed to reach only unprotected activity.

Id. at 208 (internal citations and quotation marks omitted).

We agree with the Commonwealth that the likely legislative intent behind the Trademark Counterfeiting Statute was to prohibit the deceptive, unauthorized use of a trademark for profit, and that it was not intended to prohibit the use of trademarked words in constitutionally protected speech. Although the statute has a laudable and constitutional purpose, the plain language of the statute as written prohibits a much broader range of uses of trademarks, many of which involve constitutionally protected speech.

In relevant part, the statute provides:

§ 4119. Trademark counterfeiting

(a) Offense defined.--Any person who knowingly manufactures, uses, displays, advertises, distributes, offers for sale, sells or possesses with intent to sell or distribute any items or services bearing or identified by a counterfeit mark shall be guilty of the crime of trademark counterfeiting.

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(i) Definitions.--As used in this section, the following words and phrases shall have the meanings given to them in this subsection:

“Counterfeit mark.” Any of the following:

(1) Any unauthorized reproduction or copy of intellectual property.

(2) Intellectual property affixed to any item knowingly sold, offered for sale, manufactured or distributed or identifying services offered or rendered, without the authority of the owner of the intellectual property.

“Intellectual property.” Any trademark, service mark, trade name, label, term, device, design or word adopted or used by a person to identify that person's goods or services.

18 Pa.C.S. § 4119.

Although the Commonwealth argues that the statute only prohibits the use of “counterfeit marks” when the user intends to sell or distribute the product deceptively, the

statute defines “counterfeit mark” broadly to include “[a]ny unauthorized reproduction or copy of intellectual property,” where “intellectual property” is defined by the statute to include “[a]ny trademark, service mark, trade name, label, term, device, design or word adopted or used by a person to identify that person's goods or services.” 18 Pa.C.S. § 4119(i) (emphasis added). Therefore, any unauthorized use of a “term” or “word” that is engaged by another person to identify that person’s goods or services is a “counterfeit mark.” Accordingly, the definition of intellectual property criminalizes not only the use of the trademark, which would include the stylized logo or name but also the mere word, without regard to font or color. When the relevant definitions are inserted into the definition of the offense, the statute criminalizes the use of any items bearing an unauthorized reproduction of terms or words used by a person to identify that person’s goods or services. 18 Pa.C.S. § 4119(a), (i). As highlighted by the trial court, the statute, therefore, unconstitutionally prohibits protected speech, including the use of words on a sign praising or protesting any entity with a trademarked name, including Penn State. Taken to the extreme, even our use of the words “Nike” and “Penn State” in this opinion without the permission of the company or the university would fall under the current definition of a counterfeit mark. Clearly, the statute prohibits a substantial amount of protected speech. Davidson, 938 A.2d at 208.

We must decline the Commonwealth’s attempt to apply the limiting phrase “with intent to sell or distribute” to the entire list of verbs in the definition of the offense in subsection (a), which would properly limit the reach of the statute to unprotected activity. The offense, again, is defined as “Any person who knowingly manufactures, uses, displays, advertises, distributes, offers for sale, sells or possesses with intent to sell or distribute any items or services bearing or identified by a counterfeit mark shall be guilty of the crime of trademark counterfeiting.” 18 Pa.C.S. § 4119(a) (emphasis added). Applying the “last antecedent” rule of grammar, the phrase “with intent to sell and distribute,” applies solely to the verb “possesses,” which immediately precedes that clause, such that the statute

prohibits the possession of a counterfeit trademark item with the intent to sell or distribute that item. Packer, 798 A.2d at 198 (observing “the well established canon of construction that courts should generally apply qualifying words or phrases to the words immediately preceding them”). Although the last antecedent rule is not absolute, it “generally may be applied in absence of evidence of some contrary purpose.” Pennsylvania Dept. of Banking v. NCAS of Delaware, LLC, 948 A.2d 752, 760 - 761 (Pa. 2008). Here, the structure of the sentence demonstrates that the rule should apply because otherwise the statute would prohibit the selling of items with the intent to sell and the distribution of items with the intent to distribute, which results in grammatically absurd redundancy. Therefore, we cannot construe the statute to be constitutional without doing violence to the sentence as written by the legislature.

We conclude that the Commonwealth’s other arguments also cannot save the statute by allowing us to incorporate the intent to sell or distribute into the definition of the offense. A review of the Superior Court’s decision in George, relied upon by the Commonwealth to support the significance of the intent to sell or distribute, reveals that that case did not consider the constitutionality of the statute, and only considered the intent of the defendant in regard to whether there was sufficient evidence of “possession with intent to sell or distribute,” in a case involving possession, not use. George, 878 A.2d 881. Additionally, while the proposed amendment cited by the Commonwealth would narrow the reach of the Trademark Counterfeiting Statute, we cannot consider the constitutionality of the proposed amendatory language until it is enacted into law. While we acknowledge that the Crimes Code provides a default mens rea in 18 Pa.C.S. § 302(c), the default provision does not speak to what conduct a person must commit intentionally, knowingly, or recklessly, and in no way mentions the intent to sell or deceive. Finally, we find no comfort in the existence of 18 Pa.C.S. § 312, providing for the dismissal of de minimis infractions, as the concern of our overbreadth jurisprudence is not directed only at the risk of

prosecution under overly broad statutes but also at the chilling of speech in fear of prosecution. Davidson, 938 A.2d at 208. Our citizens are provided no guarantee that a court will find that the de minimis statute applies to their use of “counterfeit marks.”

We additionally can find no balm for the unconstitutionality of Pennsylvania’s Trademark Counterfeiting Statute in the statutes of our sister states cited by the Commonwealth. The Commonwealth looks to the Florida statute, but fails to note that the statute has since been repealed, effective October 1, 2008. Fla. Stat. § 831.05.<sup>8</sup> The Commonwealth also relies upon the Oregon trademark counterfeiting statute, but fails to observe that the plain language of that statute limits the reach of the criminalization to those incidents where the person acts “knowingly and with intent to sell or distribute.”<sup>9</sup> The

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<sup>8</sup> The Florida Statute provided:

Whoever knowingly sells or offers for sale, or knowingly purchases and keeps or has in his or her possession, with intent that the same shall be sold or disposed, or vends any goods having thereon a forged or counterfeit trademark, or who knowingly sells or offers for sale any service which service is sold in conjunction with a forged or counterfeit service mark, of any person, entity, or association, knowing the same to be forged or counterfeited, shall be guilty of the crime of selling or offering for sale counterfeit goods or services.

Fla. Stat. § 831.05 (emphasis added). Moreover, we note that this statute unequivocally applies only to items intended for sale, where as the Pennsylvania statute does not make that clear through the plain language of the statute.

<sup>9</sup> The Oregon statute provides:

A person commits trademark counterfeiting if the person knowingly and with the intent to sell or distribute and without the consent of the registrant uses, displays, advertises, distributes, offers for sale, sells or possesses any item that bears a counterfeit of a mark or any service that is identified by a counterfeit of a mark registered under this chapter or registered under this chapter or registered under 15 U.S.C. 1052 with knowledge that the mark is counterfeit.

(continued...)

Commonwealth additionally compares Pennsylvania's statute to that of Texas<sup>10</sup> and Colorado,<sup>11</sup> but fails to indicate that the cases cited as applying those statutes did not speak to the constitutionality of the statutes. It additionally observes that the District of Columbia and Maryland have trademark counterfeiting statutes that have not been challenged on constitutional grounds.<sup>12</sup> Moreover, the statutes cited by the Commonwealth

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Or. Rev. Stat. § 647.135 (emphasis added).

<sup>10</sup> Texas criminalizes the following behavior:

A person commits an offense if the person intentionally manufactures, displays, advertises, distributes, offers for sale, sells, or possesses with intent to sell or distribute a counterfeit mark or an item or service that:

(1) bears or is identified by a counterfeit mark; or

(2) the person knows or should have known bears or is identified by a counterfeit mark.

Tex. Penal Code § 32.23(b).

<sup>11</sup> The Colorado statute criminalizes the following behavior:

A person commits trademark counterfeiting if such person intentionally manufactures, displays, advertises, distributes, offers for sale, sells, or possesses with intent to sell or distribute marks, goods, or services that the person knows are, bear, or are identified by one or more counterfeit marks and has possession, custody, or control of more than twenty-five items bearing a counterfeit mark.

Colo. Rev. Stat. § 18-5-110.5.

<sup>12</sup> The District of Columbia statute provides:

A person commits the offense of counterfeiting if such person willfully manufactures, advertises, distributes, offers for sale, sells, or possesses with

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do not criminalize the “use” of items with counterfeit trademarks, which was the primary constitutional flaw as determined by the trial judge, given that “use” would encompass the use of the counterfeit trademark on a protest sign or other protected activity.<sup>13</sup>

Although we have no doubt that that General Assembly did not intend to criminalize the use of terms or words absent intent to profit from the sale of counterfeit goods, we are bound by the language as enacted, which criminalizes a substantial amount of protected speech.<sup>14</sup> Davidson, 938 A.2d at 208. Accordingly, we affirm the decision of the Centre County Court of Common Pleas striking 18 Pa.C.S. § 4119 as unconstitutionally overbroad.

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intent to sell or distribute any items, or services bearing or identified by a counterfeit mark. There shall be a rebuttable presumption that a person having possession, custody, or control of more than 15 items bearing a counterfeit mark possesses said items with the intent to sell or distribute.

D.C. Code § 22-902. The Maryland statute provides:

A person may not willfully manufacture, produce, display, advertise, distribute, offer for sale, sell, or possess with the intent to sell or distribute goods or services that the person knows are bearing or are identified by a counterfeit mark.

MD Code, Criminal Law, § 8-611.

<sup>13</sup> We acknowledge that the Oregon statute does criminalize the “use” of an item with a counterfeit mark. However, unlike Pennsylvania’s statute, the Oregon statute plainly limits its reach to those persons who use the counterfeit trademark knowingly and with intent to sell. See *supra* at 14 n.9.

<sup>14</sup> With all due respect to the dissenting justices, we fail to see the relevance of our finding of ambiguity in Malt Beverages Distribs. Ass’n v. Pa. Liquor Control Bd, \_\_\_ A.2d \_\_\_, 2009 WL 1652854 (Pa. June 15, 2000), given the different statutory language and grammatical structures in that case compared to the language and structures at issue in this case. For the reasons set forth in this decision and eloquently expressed in the Chief Justice’s concurring opinion, we find the plain language of the Trademark Counterfeiting Statute to violate the First Amendment. It is not the role of this Court to redraft clear (continued...)

Mr. Chief Justice Castille, Madame Justice Todd and Mr. Justice McCaffery join the opinion.

Mr. Chief Justice Castille files a concurring opinion.

Mr. Justice Eakin files a dissenting opinion.

Madame Justice Greenspan files a dissenting opinion.

Mr. Justice Saylor dissents.

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language even with the salutary purpose of correcting an unconstitutional criminal provision.