

COPYRIGHT AND RELATED INTELLECTUAL PROPERTY ISSUES FOR
EDUCATIONAL INSTITUTIONS

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A. What Is A Copyright?

A U.S. copyright is a right provided by U.S. federal law that protects original "works of authorship" such as literary works, musical works, dramatic works, pictorial works, graphical works, sculptural works, motion pictures, other audio visual works, architectural works, choreography, pantomimes and sound recordings. Examples of such materials which are particularly important to educational institutions are textbooks, Power Point presentations, lesson plans, curriculum guides, tests, grant proposals, photographs and journal articles.

A copyright provides the "exclusive" right for a very long period (often for 95 years or for the life of the author plus 70 years) to (a) reproduce the work; (b) prepare derivative works based on the work; (c) distribute copies of the work to the public; (d) perform the work publicly in the case of certain types of works; and (e) display the work publicly in the case of certain types of works. However, these so called "exclusive" rights are not absolute. The Copyright Act provides limitations on these rights in the form of a general "fair use" exemption, as well as specific situation exemptions.

A copyright does not entitle the owner to prevent others who independently create the same or a similar work from doing anything. Hence, if one independently creates something, one

doesn't need to search to see if anyone has done something similar, as a means of avoiding copyright infringement. It is therefore unlike a patent, which prevents even those who independently create an invention from using it.

B. What Cannot Be Copyrighted?

The following categories of materials are generally not eligible for copyright protection:

1. Ideas, procedures, methods, systems, processes, concepts, principles, or devices. These are often protected by trade secret or patent law. However, a description, explanation or illustration of any of the foregoing may well be a copyrightable work. Such a copyright would cover just the description, explanation or illustration, and not the underlying ideas to the extent they are expressed in a different way. For example, merely copyrighting WordPerfect document creation software doesn't prevent the development of Word document creation software, notwithstanding many similar functions. This distinction becomes subtle when one begins to compare works with similarities in sequence and organization.

2. Works that have not yet been fixed in a tangible form of expression. Creative works that have not yet been written down (or otherwise recorded) are generally not yet copyrightable. However, certain live performances (e.g. music concerts) have been provided with protection.

3. Works consisting entirely of public domain information arranged in essentially an old way. For example, simply by

photocopying a public domain book, the photocopy does not become copyrightable as a separate derivative work.

4. Names, titles, and other very short phrases are not copyrightable (e.g. "You're In Good Hands..."). However, these may be protectable under trademark law.

5. Works that are in the public domain by virtue of having their copyright expire, or having their copyright be forfeited.

6. Works not conceptually separable from utilitarian objects (compare the overall shape of a chair to the design of a surface ornamentation on a surface of a chair).

C. How Is A Copyright Obtained?

In most cases U.S. copyright protection automatically exists as of the date that the work is first fixed in a tangible form (e.g. written down or otherwise recorded). No publication, registration or other action is required in order to secure the basics of copyright protection. Note that this is very different from patent protection where there is no protection until a certificate is obtained (albeit once that happens under U.S. patent law protection may in some cases date back to publication of the application).

D. What Happens If A Work Was Published Without A Copyright Notice?

It depends upon when the publication occurred, where it occurred, and whether the publication was with the owner's authorization. If a work otherwise subject to copyright

protection was published in the U.S. without a proper copyright notice with the copyright owner's permission:

(1) before 1978 this may well have forfeited the copyright. However, one often can't tell from just looking at a copy of a work alone when a particular copy was published, and whether the copyright owner's permission was given for that publication;

(2) between January 1, 1978 and February 28, 1989 (with the copyright owner's permission), the omission of the copyright notice may have caused a forfeiture of the copyright, albeit there may be ways in some cases to "cure" this defect.

(3) for publications on or after March 1, 1989, the failure to use a copyright notice will not cause a forfeiture of U.S. rights.

Nevertheless, use of an appropriate copyright notice warns off potential infringers, may preserve rights in some countries outside the U.S., and even in the U.S. may maximize certain "punitive" statutory damages. Hence, use of the notice is recommended for published works (e.g. normally © [name of owner][year of first publication]). Note that one should replace the c in the circle with a P in the circle in the case of sound recordings.

E. When Should One Obtain A Copyright Registration?

A formal copyright registration does not have to be obtained unless the work is to be enforced in court (or at all for certain foreign works). Nevertheless, for those U.S. works which are very valuable, where there is likely to be an

infringement in the near future, where there is a substantial investment involved, and/or where there is a clear market for the work, one may wish to consider applying for copyright registrations before any infringement. One reason for such prompt registration is that the copyright statute authorizes certain additional remedies which are only available when the registration has been timely made (e.g. attorneys fees, penalty damages).

Still another reason for promptly filing for a registration for certain U.S. works is that prior to actually going into a court, one must have the copyright registration in hand. For U.S. origin works there may be an undesirable delay between the time one finds out about the infringement and the time one can go to court and stop it if the registration has not already been obtained.

Also, in order to fill out a copyright application, one may need certain detailed information about the creation of the work, and in some cases an assignment from outside companies who assisted in the creation of the work. It may be somewhat difficult to collect and obtain such information and documents if years have passed since the work was created. Further, promptly registering the work may establish prima facie evidence of the facts in the certificate. The copyright application fee is still relatively inexpensive (especially if one uses electronic filing).

F. Who Owns The Copyright?

As a general rule, in the absence of an agreement controlling the matter, an "employer" automatically owns all the copyrightable works that its employees create when they are creating the works as part of their jobs "within the scope of their employment". However, this is not the default rule when one goes outside a company to commission third parties, even if someone pays to have something created. Thus, written agreements spelling out who owns copyright rights are particularly desirable if an educational institution is hiring someone outside the institution to create marketing, customized software, or other significant materials.

Note that an assignment of a tangible embodiment of the work (even the original work of art) doesn't automatically transfer the copyright to the work. Thus, as you would expect, when you buy a book at Barnes & Noble you don't typically thereby acquire the right to reproduce it. Similarly even if you pay thirty million dollars to buy an original Andy Warhol painting you won't automatically acquire the right to control its reproduction unless you have separately contracted for that right.

Written agreements varying the default presumption of ownership can be created in a variety of ways. For example, employees (e.g. professors) may reach an agreement with their employer (the institution) collectively through a labor union who acts as their agent to vary the normal rules. Also, some students may, when they register for class, be asked to sign a

document as part of the registration paperwork, assigning to the institution whatever they contribute when working as a paid employee of the institution, or what they orally contribute during the class itself. Of course, some students attend institutions of higher learning when they are still 17 years old or younger. Trying to bind a minor to an assignment without involvement of a court appointed guardian may allow the minor to reject the contract, absent special care.

It should also be kept in mind that as a condition of providing grant funding a grant sponsor (e.g. NIH) may require the person or entity that is awarded the grant to agree to assign intellectual property developed under the grant to a licensing agency of the educational institution, and provide certain march-in rights to the grant sponsor. Thus, special care should be taken by educational institutions when becoming involved with grant funding agreements to be sure that they are in a position to assign the rights which result from the grant activity as required by the grant.

One particularly interesting situation with respect to educational institutions is the question of whether lecture materials developed by professors for their own lectures are created "within the scope of their employment", and hence (absent an agreement to the contrary) owned by the educational institution automatically. Courts have reached differing conclusions (absent agreement by the parties on this issue), albeit some have found ownership to reside in the professor even where the professor is a true employee of the educational

institution and first developed the materials for use in a class at the institution.

This issue, if not clarified in advance, can cause difficulties and/or hard feelings where the institution wishes to have another professor teach essentially the same class (e.g. at a night school version, at a summer school version, or the next year). If not resolved by a labor negotiation with a union, this may well be an appropriate topic to resolve in the paperwork signed by the professor at the time of hiring.

A related issue arises regarding the professor's "performance" of lecture materials. There is a separate copyright right to the performance of the lecture materials. Again, the issue of ownership of such intellectual property is best dealt with in advance. Absent an appropriate agreement a question could arise as to whether offsite broadcasting of a lecture would violate the professor's rights.

G. What About Protection In Other Countries?

Protection against the unauthorized use of copyrighted materials outside the U.S. depends upon the laws of each individual country. However, most countries of significant commercial interest now offer automatic protection under the Berne Convention without requiring formalities in each country. A few other countries offer automatic protection to foreign works under a treaty only if a copyright notice is used when the work is published. In any event, protection abroad is usually comparable to that provided to each foreign country's own

nationals, and thus may not track exactly the rights available in the U.S. in some cases.

H. Use Of Works Created By Others.

1. The "exclusive" rights provided under copyright law are so broad and varied in nature that they could suppress many desirable activities if not qualified. The copyright statute therefore provides both a general exception for "fair use", and a series of specific statutory exceptions for particularly favored activities.

With respect to the general fair use doctrine, it permits limited use of a copyrighted work of another without permission when the amount taken is reasonably correlated to the need for the intended purpose, the impact on the market for the original work is small or non-existent, and the activity is of a type that is particularly favored. Examples of particularly favored activities include research, criticism, education and news reporting. The education and research favored statuses are particularly helpful to an educational institution seeking to make uses of copyrightable works of others.

A teacher may well be permitted to spontaneously decide to copy a limited portion of another work, distribute copies thereof to pupils in that teacher's class, and use those copies as the central point of a discussion during class. However, reproducing larger portions of the original work, or doing so on a less spontaneous basis, or doing so in a way that significantly adversely affects the market for the original, may be problematic.

For example, distributing a copy of Ted Kennedy's speech at the 1980 Democratic National Convention to every member of a forensics class, and discussing its content and structure in the class, would clearly be permitted. However, if instead of buying copies of math workbook pages for everyone, the teacher buys one set, and regularly copies blank workbook assignments each day for all students to take home and use, that might well violate the law.

Similarly, a researcher at a college can usually make a copy of another's relevant article while researching a particular matter. However, if a professor regularly copies a newsletter sent to a colleague every month to avoid paying the cost of a second subscription, regardless of whether that newsletter helps the researcher in research, the activity would not be permitted if the newsletter was copyrightable.

2. College librarians are permitted to make a copy for a variety of purposes including acquiring out of print works not otherwise available, creating a backup copy only used if the original is destroyed, and making limited numbers of copies for those conducting research. However, the rules and limitations on such permitted activities are somewhat complex (e.g. some of the rights may require a warning sign next to the reproduction equipment).

3. There is a statute providing certain rights to conduct distance education over the internet or the like, and incorporate copyrightable materials into those teaching activities. The basic idea is to try to permit usage of

otherwise restricted copyrightable materials to about the same extent as is permitted for face-to-face teaching activities. There are quite a few special requirements and rules which must be complied with to enable such distance teaching exceptions to apply.

4. Depending on whether an educational institution is a governmental institution, there may also be certain additional fall back defenses provided by state law immunity in some jurisdictions, unless it has been waived.

Addendum - Patent Rights

The previous discussion relates to copyright rights. Educational institutions, particularly research institutions, often also face intellectual property questions arising under patent law. A comprehensive educational institution intellectual property policy should also consider ownership and usage of such patent rights, particularly where grant funding is involved.

1. A patent is a right granted by a government that lets the owner of the patent exclude others from making, using or selling an invention. It is granted country by country, albeit some groups of countries (e.g. in Europe) have joined together to create regional patent protection.

2. A patent does not guarantee its owner the right to make, use or sell the invention, if doing so will infringe someone else's patent on an earlier aspect of the later product. Hence, even if an invention is a patentable improvement, you might still need a license from others to practice it.

3. In the U.S. there are utility patents (e.g. technology), design patents (e.g. ornamental appearance), and plant patents (reproduction of plants). With respect to utility patents (typically the most important types of patents) these can cover processes, machines, articles of manufacture, and compositions of matter. Under current law newly filed U.S.

utility patents, upon issuance, typically last for twenty years from their first filing date, if all maintenance fees are paid.

To be patentable in the U.S. an invention must be new, useful, and unobvious. It is not enough that a creation be novel and original. The purported inventive contribution must also be something that would not have been obvious to a person of ordinary skill in the art.

One's own publications, and in the case of many foreign countries even one's own non-confidential disclosures, can abandon (or start a clock towards abandonment) of patent rights. Thus, educational institutions must balance the desirability of publishing and otherwise disclosing research results against the timing needs for filing patent applications.

Patent rights don't exist until a governmental agency grants them. The process of obtaining patent rights is considerably more expensive than obtaining copyright rights, albeit patent rights are often more valuable once obtained.

In the U.S., patent rights go to the first inventor. Hence, keeping dated and witnessed records of research is desirable.

For U.S. purposes state law governs initial ownership of inventions in the absence of a written agreement. For an educational institution this would, as a default, usually leave patent ownership rights with the individual inventor(s).

Thus, educational institutions (e.g. particularly those involved in research activities) may want to have their researchers agree in advance to assign patent rights to certain inventions (e.g. those created with external grant funding where the grant requires a transfer).