

Copyright & New Media Law

Making sense of complex legal issues

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The Supreme Court rules that a feature of the design of a useful article is eligible for copyright if, when identified and imagined apart from the useful article, it would qualify as a work eligible for copyright protection.

Supreme Court Ruling: New copyright eligibility test for useful articles

BY LAURA POPP-ROSENBERG, PARTNER, FROSS ZELNICK LEHRMAN & ZISSU P.C.

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2 EDITORIAL: Final Issue of Copyright & New Media Law

Digital Information Law will cease publication of Copyright & New Media Law at the end of this year. Learn more about what this means for subscribers.

5 How Copyright Law Works for YouTube

In attempting to create technological solutions to legal challenges, YouTube created an entirely new legal system.

8 A Few Secrets About Fair Use

Excerpts from the book Fair Use: The Secrets No One Tells You.

PLUS

News Updates (11)

Questions & Answers (12)

On March 22, 2017, the Supreme Court of the United States issued a decision in a highly-anticipated case concerning the copyrightability of clothing designs, concluding that designs on cheerleading uniforms could be protected by U.S. copyright law. The Supreme Court rarely takes on copyright cases, and this case has been of particular interest to the fashion industry, which has long bemoaned the scant protection available under U.S. law for clothing designs. However, the ramifications of this decision will be felt beyond the world of fashion.

Basic Legal Framework

Since clothing designs serve a function—to cover the body—they are classified under the Copyright Act as “useful articles,” which are excluded from U.S. copyright protection. As useful articles, clothing designs could achieve U.S. copyright protection only if, and only to the extent that, the design “incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”¹

¹ 17 U.S.C. § 101

continued on p.3

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Final Issue of *Copyright & New Media Law*

EDITORIAL

As you know from our November 1 email, Digital Information Law will cease publication of *Copyright & New Media Law* at the end of this year. This has been a difficult and emotional decision for us, but a combination of factors simply make it unsustainable for us any longer.

To date, negotiations with other publishers regarding possible acquisition of CNML have not been successful. We will continue to seek a new publisher for the journal, and if we are successful, we will notify all subscribers as soon as possible.



What This Means for Your Subscription:

Although this is the last issue to be published by Digital Information Law, your [access to online content](#) will remain live through March 31, 2018, including your ability to download pdf files of each issue (so if your digital archive of CNML has gaps, now is the time to fill those in!).

Note that the current license will continue to apply to your use of CNML content even after we stop publishing CNML.

If your subscription expires after February 2018, you will receive a pro-rated refund, based on our quarterly publication schedule. For example, if your subscription expires in June 2018, you would have received two issues (spring and summer) in 2018 and will thus receive a 50% refund.

Thank you!

It has been my absolute pleasure to re-work *Copyright & New Media Law* into the publication and online resource it is today and to provide it to you! I am extremely proud that it has always provided high-quality content, for which I am grateful to our authors and to Lesley Harris, the journal's founder and its editor and publisher for the first seventeen years.

Most of all, I am grateful to each of you, our subscribers and readers, for your support and your commitment to understanding the important legal issues we face in the new media world. I wish you all the best and hope to work with many of you in another context in the future.

Please do not hesitate to contact me if you have any questions regarding the above or if I may be of assistance at any point in the future. ■

Yours truly,

Gretchen McCord, Editor

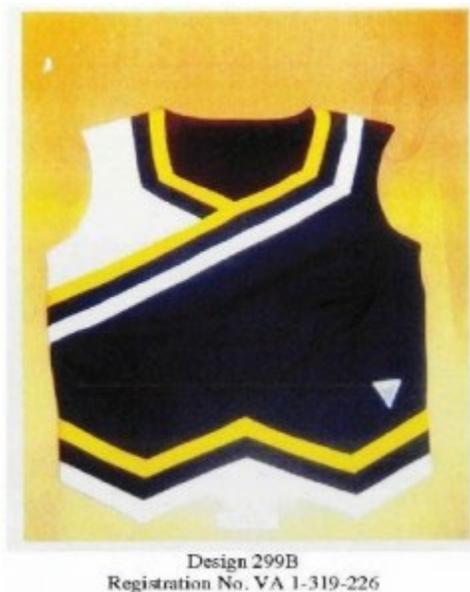


◀ SUPREME COURT . . . from p.1

Figuring out where the utilitarian aspects of clothing end and the copyrightable aspects of clothing begin has befuddled litigants and courts for decades and, by some counts, more than a dozen different and competing legal tests have been developed for determining whether the “separability” requirement of Section 101 of the Copyright Act is satisfied. Almost all relied on the legislative history of Section 101, which introduced the idea of “physical” and “conceptual” separability. With physical separability, the design features can be physically separated from the useful article while leaving the article intact; with conceptual separability, the design feature cannot be physically separated from the article but is nonetheless recognizable as distinct from the useful article (e.g., an intricate carving of leaves and vines on a chair back).

History of the Case

The case that made its way to the Supreme Court involved two companies that market and sell cheerleading uniforms: Star Athletica and Varsity Brands (“Varsity”). In 2010, Varsity sued Star Athletica alleging infringement of Varsity’s copyrights in five cheerleader uniforms bearing designs created from shapes and stripes of colored fabrics. Varsity had obtained U.S. copyright registrations for its cheerleader uniforms as “2-dimensional artwork” or “fabric design (artwork)” and had submitted as specimens sketches or photographs of the uniforms. The following is one of the works at issue:



At the trial court level, upon a motion for summary judgment filed by defendant Star Athletica, the U.S. District Court for the Western District of Tennessee held that Varsity’s designs were useful articles and thus not eligible for copyright protection.² More specifically, the District Court concluded

that the designs applied to the cheerleading uniforms were part and parcel of the function of the uniform itself and, in the words of Section 101, could not “be identified separately from” or “exist[] independently of, the utilitarian aspects of the article.”³ As the District Court reasoned, “a cheerleading uniform loses its utilitarian function as a cheerleading uniform when it lacks all design and is merely a blank canvas.”⁴ The District Court therefore granted summary judgment to defendant Star Athletica.

On appeal, the United States Court of Appeals for the Sixth Circuit disagreed with the District Court’s conclusion that the graphic designs were necessary to a cheerleading uniform’s purpose.⁵ The Sixth Circuit concluded that the only utilitarian aspects of a cheerleading uniform were to cover the body, permit free movement, and wick moisture. Since the design appearing on the face of the uniforms contributed nothing to these utilitarian aspects, the designs were separable from the utilitarian aspects and therefore eligible for copyright protection.⁶ (The Sixth Circuit Court expressly refrained from offering any opinion as to whether Varsity’s designs were sufficiently original for copyright protection.)⁷

The Supreme Court Opinion

In delivering the opinion of the Court⁸ (to which Justices Alito, Kagan, Roberts, and Sotomayor joined), Justice Thomas noted that the Supreme Court had accepted the case to resolve “widespread disagreement” on the proper test to assess separability under Section 101.⁹ Hewing closely to the language of Section 101, the Court proceeded to set forth a new two-part test, which now applies nationwide:

[A] feature incorporated into the design of a useful article is eligible for copyright protection . . . if the feature (1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic or sculptural work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated.¹⁰

In the Court’s view, “[t]he ultimate separability question . . . is whether the feature for which copyright protection is claimed would have been eligible for copyright protection as a pictorial, graphic, or sculptural work had it originally been fixed in some tangible medium other than a useful article before being applied to a useful article.”¹¹ Thus, “a feature of the design of a useful article is eligible for copyright if, when identified and imagined apart from the useful article, it would qualify as a pictorial, graphic, or sculptural work either on its own or when fixed in some other tangible medium.”¹²

³ *Id.* at *8.

⁴ *Id.*

⁵ *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468 (6th Cir. 2015).

⁶ *Id.* at 490-92.

⁷ *Id.* at 493.

⁸ *Star Athletica, L.L.C. v. Varsity Brands*, 137 S. Ct. 1002 (2017).

⁹ *Id.* at 1017.

¹⁰ *Id.*

¹¹ *Id.* at 1011.

¹² *Id.* at 1012.

² *Varsity Brands, Inc. v. Star Athletica, LLC*, No. 10-2508, 2014 WL 819422 (W.D. Tenn. March 1, 2014).

◀ SUPREME COURT . . . from p.4

In adopting this test, the Court abandoned the distinction between “physical” and “conceptual” separability. Noting that Section 101 does not require the underlying useful article to remain once the design element is separated, the Court concluded that the question is statutorily confined to conceptual separability.¹³ Relatedly, the Court pointedly rejected the question that had divided the trial and appellate courts: whether a cheerleading uniform can still be a cheerleading uniform without the design elements. The Supreme Court viewed that debate as “unnecessary,” since Section 101 requires the focus to be “on the extracted feature and not on any aspects of the useful article that remain after the imaginary extraction.”¹⁴

Applying the Court’s new test to the cheerleading uniform designs in question, the Court’s majority had no trouble finding that the designs satisfied the two-part test and thus are eligible for copyright protection:

First, one can identify the decorations as features having pictorial, graphic, or sculptural qualities. Second, if the arrangement of colors, shapes, stripes, and chevrons on the surface of the cheerleading uniforms were separated from the uniform and applied in another medium—for example, on a painter’s canvas—they would qualify as ‘two-dimensional ... works of art.’ And imaginatively removing the surface decorations from the uniforms and applying them in another medium would not replicate the uniform itself. Indeed, respondents have applied the designs in this case to other media of expression—different types of clothing—without replicating the uniform. ... The decorations are therefore separable from the uniforms and eligible for copyright protection.¹⁵

The Court was, however, quick to point out that copyright protection (if any) extended only to the designs on the cheerleading uniforms and not the uniforms themselves:

To be clear, the only feature of the cheerleading uniform eligible for a copyright in this case is the two-dimensional work of art. [Varsity] ha[s] no right to prohibit any person from manufacturing a cheerleading uniform of identical shape, cut and dimensions to the ones on which the decorations in this case appear.¹⁶

¹³ *Id.* at 1014.

¹⁴ *Id.* at 1013.

¹⁵ *Id.* at 1012.

¹⁶ *Id.* at 1013.

Further, the Court, like the Sixth Circuit before it, expressly refrained from deciding whether the designs, though separable from the useful article and thus eligible for copyright protection, are sufficiently original to qualify for copyright protection.¹⁷

Conclusion

Thus, we await the trial court’s decision on whether Varsity’s cheerleader uniform designs qualify for copyright protection now that the Supreme Court has determined that they are copyright eligible.

And we will also wait to see the extent to which the Supreme Court’s decision and the new nationwide test for separability affect copyright protection for clothing and other fashion designs going forward . ■

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¹⁷ *Id.* at 1012, n.1.



continued on p.5

How Copyright Law Works for YouTube

BY JONATHAN BAILEY, PLAGIARISM TODAY

In attempting to create technological solutions to legal challenges, YouTube created an entirely new legal system.

When Google purchased YouTube in October 2008 for \$1.65 billion, it acquired a leading video-streaming site that was struggling to keep up with growing demands. In the nine years since that purchase, YouTube has flourished into a major force in new media. With over one billion users watching over one billion hours of video every day, it is the second most popular site on the Internet, behind Google itself and just ahead of Facebook.



With so many viewers and over three hundred hours of videos being uploaded every minute, it's no surprise that YouTube has gone on to become its own ecosystem. It's Partner Program shares revenue with approved creators, many of whom have found wealth and fame on YouTube through that program. Countless more have found a steady audience and a stable career through YouTube and its audience.

But while it's no surprise that YouTube would become its own business ecosystem, it's also had to form its own legal system, in particular in the area of copyright. The simple reason is that YouTube was overwhelmed with the legal issues that came with the volume of video being uploaded. In response, it sought technological solutions to legal challenges and created an entirely new legal system along the way.

Unfortunately, though, it is a legal system that's often without the appeals and impartial hearings of our established judicial system, as well as one to which not everyone has access. It's a Frankenstein's monster of technology and the law, but it's the only thing keeping YouTube afloat.

To understand how YouTube's system operates, we first have to look at the current established legislative and judicial legal systems and try to understand why they didn't work for YouTube and how YouTube tried to fix that problem.

The Digital Millennium Copyright Act: Notice and Takedown

As a company based in the United States, the most important law influencing YouTube's copyright policy is the Digital Millennium Copyright Act ("DMCA"), in particular its safe-harbor provisions.

Passed in 1998, the DMCA safe-harbor provisions are a compromise between web hosts, such as YouTube, and copyright holders. The DMCA frees YouTube from liability when users upload infringing material without YouTube's knowledge, without requiring YouTube to actively patrol

content for infringement. In exchange, YouTube is required to remove alleged infringements when it becomes aware of them, in particular via the DMCA notice process; maintain an agent to receive such notices; and ban repeat infringers.

YouTube's Strike System

It is from the DMCA that YouTube's copyright strike system comes about. When a user is the subject of a DMCA notice, YouTube removes the video in question and issues a strike against that user's account. Though YouTube claims that a copyright strike is just a warning, even one strike can have dire consequences for an account. It can impact the user's ability to monetize their videos, restrict their ability to livestream, and even limit the length of the videos they can upload.

Currently, a copyright strike may be resolved in one of three ways:

1. **Submit a Counter-notice:** Per the DMCA, a user who is the subject of a DMCA notice can file a counter-notice in an effort to have the content restored. This doesn't guarantee the restoration of the content, however, and hosts can and often do keep content offline after receiving a counter-notice; however, the DMCA allows a host to restore the content after ten business days unless the original complainant has filed a lawsuit. YouTube generally restores content and removes copyright strikes when a counter-notice goes unchallenged.
2. **Obtain a Retraction:** If the notice was sent in error, the user can attempt to have the copyright holder retract the notice. If successful, this removes the strike and immediately causes the video to be restored.

continued on p.6

◀ HOW COPYRIGHT . . . from p.5

3. **Wait for Expiration:** If the YouTube user completes “[Copyright School](#)” and waits ninety days, the strike will expire on its own. However, the video in question will remain offline.

If a user racks up three separate copyright strikes, their account is terminated, all of their uploaded videos are removed, and they are prevented from creating a new account. This process fulfills the DMCA requirement for YouTube to have a policy banning repeat infringers.

Content ID: The Rise of the Bots

Though the DMCA is often criticized for its ripeness for abuse (an issue that has risen for YouTube in the past), the DMCA safe-harbor system provides a great deal of certainty through a very simple process. When a DMCA notice is filed with YouTube, the user involved knows exactly what will happen, namely that the video will be removed and they will be issued a strike. They also know exactly what their appeal options are and what will happen with each approach.

However, for YouTube, the process has two key problems. First, it is labor intensive. Someone has to receive the notice, evaluate it, and then act on it. While not a major problem for a handful of notices, when dealing with the volume of content YouTube handles, it becomes overly burdensome. Second, in order to grow, YouTube needs to cultivate positive relations with major rights-holders. That has been difficult, as many rights-holders complain that YouTube hides behind the DMCA to offer illegal content without liability. This accusation continues even today [as the music industry battles with YouTube over royalties](#).

In order to stem the tide of DMCA notices and improve relationships with major rights-holders, YouTube launched its [Content ID](#) program in 2007. With it, YouTube created not just a new content protection system, but a whole new legal system with which both users and rights-holders must contend.

The idea behind Content ID is fairly straightforward: Copyright holders submit copies of their works to be stored in a database against which Content ID matches new uploads. When a match is found, YouTube gives a great deal of leeway to the rights-holder regarding how they respond. Unlike the DMCA, which is purely about removing allegedly infringing material, Content ID allows rights-holders a wide range of options including the following:

- Removing the video
- Muting the video
- Monetizing the video
- Restricting the countries in which the video can be seen
- Blocking the video on certain platforms (such as limiting embeds or mobile uses)
- Doing nothing (track only)

Unlike copyright strikes, Content ID matches don't harm user accounts, and one user can rack up an infinite number of Content ID matches without worrying about their account being disabled. However, Content ID can and does have serious impact on users who monetize their videos, as it is usually impossible for an uploader to profit from a claimed video.

Users are free to dispute Content ID claims, but those claims are adjudicated by the rights-holder, not a third party. If the rights-holder decides to maintain the Content ID claim, the user may then appeal the claim to YouTube. However, YouTube imposes severe limitations on who can appeal a Content ID claim and when. Only accounts in good standing (meaning no copyright strikes) can appeal, and a user can have no more than three appeals going at one time. If YouTube decides that the claim should be released, the rights-holder can then either release the claim or file a DMCA notice, thus beginning the copyright-strike process.

This appeals process puts the user at a severe disadvantage. The first appeal, or rather dispute, isn't to YouTube but to the rights-holder. Far from an impartial judge, the rights-holder has little motivation to take the user seriously. While the second appeal is to YouTube, it comes with a high risk to the user. Even if the user wins, they could face a copyright strike if the rights-holder decides to file a DMCA notice. That strike, generally, is far worse than any Content ID claim. To make matters worse, the entire process is extremely time consuming; resolving a single claim can take weeks, during which time a video can lose most of its audience and revenue-earning opportunity.

These processes have raised major concerns regarding fair use on YouTube, for example, in the case of film or music reviewers, who often use short samples of films or songs as part of their video reviews. Though this type of use is likely completely legal, these uses are often matched by Content ID and lose monetization. This problem led to a “Where's the Fair Use” campaign of YouTubers decrying the system, [with YouTube making promises to strengthen fair use protections](#).

For rights-holders and creators, the process also has its flaws, the biggest being that most creators cannot participate in Content ID. [Though YouTube allows qualifying creators to apply to participate in Content ID](#), it only approves large scale creators, such as movie studios and record labels. Self-published musicians, for example, [have to go through large partner services to get into Content ID](#), and these services take a percentage of any revenue earned through them.

continued on p.7

◀ HOW COPYRIGHT . . . from p.6

Despite the flaws, the Content ID program is how YouTube handles more than 99% of all copyright issues on the service, and less than 1% of those claims are disputed. Content ID, for better or worse, has become the de facto means of copyright enforcement on YouTube, largely replacing the DMCA and litigation as a means of handling copyright disputes. That it is an exclusive system not available to many creators, automated with little human evaluation, and offers limited appeals, are simply issues with which all sides have to deal.

Looking Ahead

As challenged as YouTube's copyright process is, it was a system born out of necessity. With the amount of content YouTube sees every day, a traditional enforcement system was not going to work. However, YouTube's solution isn't likely to remain only on YouTube, as other sites face similar challenges. [Vimeo launched a similar system in 2014](#), and Facebook has been [developing its own Content ID-like tool since 2016](#).

As the Internet continues to grow, major sites are going to need copyright bots to help them stay on top of abuse. But while the bots themselves are a great tool, it is how they are used that poses the problem. As we've seen on YouTube, bots do not work well when they are not backed by humans. A real appeal process is needed, as well as a means to check the work of the bots.

If companies are going to use technology to create a new legal system for addressing copyright claims, they should apply what we've learned from our current system. That includes the appeals process and the ability for adjudicators to step in when necessary. This is something that YouTube hasn't truly mastered at this point, but hopefully something that others services adopting the technology will be able to embrace. ■

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Deadline Pending to Update DMCA Safe Harbor Records

Among other things, the Digital Millennium Copyright Act of 1998 created a safe harbor for online services providers ("OSPs"), shielding them from liability for certain types of copyright infringement by others, such as infringing content posted by their users ([17 U.S.C. § 512](#)). OSP is defined broadly and, for some purposes, includes a "provider of online services or network access, or the operator of facilities therefore." Thus, many readers of this journal fall under the definition.

To qualify for the safe harbor, an OSP must follow certain requirements, which include designating an agent to receive claims of copyright infringement and registering that agent with the U.S. Copyright Office. In December 2016, the formerly paper-based registration process was replaced with an online registration system as well as [new registration requirements](#).

All OSPs who designated an agent prior to December 1, 2016, must submit a new designation of agent via the online registration system no later than December 31, 2017.

Furthermore, in an effort to keep the registry current, all agent registrations must be renewed every three years.

For more information, see [DMCA Designated Agent Directory](#) on the Copyright Office website.

A Few Secrets About Fair Use

BY GRETCHEN MCCORD, J.D., M.S.I.S., ATTORNEY, LAW OFFICES OF GRETCHEN MCCORD

Excerpts from the book *Fair Use: The Secrets No One Tells You*.



In 2014, I wrote *Fair Use: The Secrets No One Tells You*. It has been a tremendous hit among librarians and educators, so for this, my final issue as editor of *Copyright & New Media Law*, I have decided to share just a few of the secrets with you.

The following provides excerpts of some of the secrets. The complete e-book can be purchased here, with a 50% discount for CNML subscribers using coupon code CNML17.

Secret #1: The key word is *use*.

Section 107 of the Copyright Act says, “the fair use of a copyrighted work . . . is not an infringement.” . . .

The key here is *use*. . . . The question is simply: What kind of *use* is fair?

In searching for an answer to this question, we too often become distracted by the context in which we are using the work, or by the technology involved, or some other particular about the situation, and we forget to look at the specifics of the *use* itself.

For example, I often get questions from people who are knowledgeable about fair use along the lines of: “Can we use videos we find on YouTube?”

Think about that for a minute. How can we analyze that question for fair *use*? We cannot, because we know nothing about the use. A video is simply a copyrighted work, and YouTube is simply the tool used to locate and access the work.

So, my answer is to the question, “Can we use videos we find on YouTube?” is: How are you *using* it? What are you *doing* with it, and *why*?

. . .

To help focus on how you are using the work as you analyze factors one, three, and four, try re-framing your questions to eliminate the word “use.” It sounds contradictory, but it’s an old trick to get around old habits, and it can be effective.

For example:

Factor 1

Instead of: Is this a commercial or non-profit educational use?

Ask: To what extent do my actions contribute to someone’s education? To what extent do they contribute to producing income?

Factor 3

Instead of: How much did I use?

Ask: Why am I [copying/distributing/performing/displaying] this particular portion and this particular amount of this particular work?

Factor 4

Instead of: How did my use affect the marketplace of the original?

Ask: How likely would it be that someone who might otherwise have paid to [own/view/perform/etc.] the original will decide, because of my actions, not to do so?

Take Away:

Be specific about what you are doing and why, rather than focusing on the format of the work, where you found the work, who your institution is, the quantity you are using, or whether the work is currently on the marketplace.

Secret #5: Fair use helps copyright owners as much as it does users of copyrighted works.

Perhaps out of a desire to simplify things, or perhaps because of the current environment in the world of digital information, both copyright owners (whether human creators or content-industry corporations like publishers) and users of copyrighted works fall into the habit of talking in “us vs. them” terms. But the truth is: That line between rights-owner and information-user is not so bright.

When we “use” a copyrighted work in a way that implicates the copyrights in the work, we are often using it to create something new, whether it be quoting someone in a classroom assignment, incorporating images into a presentation, or creating a mash-up for commercial purposes or just for fun.

. . .

. . . But just as often, creators rely on fair use.

continued on p.9

◀ A FEW SECRETS . . . from p.8

For example, biographers, historians, and documentarians often include portions of relevant pre-existing works in their own, in order to corroborate the accuracy of their own work. Two genres of music – jazz and rap – are built on the concept of borrowing from and building upon existing musical works. Similarly, the genre of appropriation art is defined by taking – “appropriating” – from existing works to create something new.

. . . If the scope of fair use were to be radically narrowed, many of these creators would be unable to create without first obtaining permission, which, if it is given at all, can be quite costly and which many could not afford.

And this would undermine the entire purpose of copyright law: to promote the creation of new works.

Take Away:

We’re all in this together. When the doctrine of fair use evolves and changes, it affects us all.

Secret #6: In application, educators and librarians often conflate fair use with other issues.

...

So, before even getting to the point of asking if the use is fair, other avenues that might allow the use have been (or should have been) exhausted. If you have permission, you certainly don’t need fair use. If your use falls under an exception in the statute to the copyright owner’s rights (such as [Section 108](#)), you don’t need fair use. And if your use is fair, you don’t have to pay for the use, because when you pay, you are paying for the permission to use a work, which you don’t need if your use is fair. And yet all of these statements reflect misunderstandings and questions I’ve heard from librarians and educators repeatedly over the years.

Here are some examples:

- Even after reading the license for this work, I am not sure whether the vendor considers the use I want to make to be a fair use.
- Showing films in a classroom is considered fair use, so long as it supports the curriculum.
- When my library is unable to find replacements for sale of a film we have on VHS, we make a preservation copy on DVD. To be sure we can rely on fair use, we do not allow anyone to take it out of the library.
- I teach my students to cite the works they use, so that the use will fall under fair use.
- Commercial uses, or profiting from using part or all of someone else’s work, is not fair use.
- So long as we use it in an educational setting and don’t

make a profit, it is fair use.

Some of these statements describe situations that simply do not implicate fair use. Others reflect misunderstandings of what fair use is or how it is applied.

The proliferation of any kind of misunderstanding about fair use is harmful. A 2007 study by the [Center for Social Media](#) at American University clearly found that, as a result of misunderstanding copyright law, educators and librarians at all levels “use less effective teaching techniques, teach and transmit erroneous copyright information, fail to share innovative instructional approaches, and do not take advantage of new digital platforms.”¹

Simply put: Misunderstanding by educators, including librarians, of copyright law weakens the quality of their teaching.

Take Away:

Before launching into a fair use line of questioning, take the time to look closely at your situation and determine whether some area of copyright law other than fair use applies. Most importantly: Take the time to learn fair use well . . . which takes time.

Secret #7: The academy and libraries fear fair use.

Of course this statement is not true across the board, as no statement this broad and sweeping could be. In fact, we have some shining examples at the opposite end of the spectrum. . . .

Nonetheless, surveys, studies, and anecdotal evidence repeatedly tell us that librarians, instructors, education administrators, and others in the education arena are *afraid* to exercise their fair use rights beyond the barest minimum.²

As an explanation for that fear, the lead author of the study cites “the rise of well-publicized file sharing litigation, prominently placed warnings in front of photocopy machines, and those FBI warning labels on DVDs . . .”³

More recently, we can add to that list lawsuits against educational institutions alleging copyright infringement based on traditional uses of material in non-traditional contexts,⁴ a slew of “take-down” notices issued by publishing giant Elsevier to academic faculty over inclusion of faculty work in institutional repositories,⁵ and even this:

[In a March 2014 hearing conducted by the U.S. Copyright Office on the topic of orphan works,] a representative from an author’s association threatened to sue libraries for digitizing collections (not posting the [works online](#) but just for digitizing the collection,

1 Renee Hobbs, et al. *The Cost of Copyright Confusion for Media Literacy*, American University School for Communication Center for Social Media (2007), p.1.

2 See, e.g., Renee Hobbs, et al. *The Cost of Copyright Confusion for Media Literacy*, American University School for Communication Center for Social Media (2007), p.15.

3 *Id.*, p. 21.

4 See, e.g., *Cambridge*, 863 F. Supp. 2d 1190.

5 Andrea, Peterson, “How one publisher is stopping academics from sharing their research,” *Washington Post*, December 19, 2013.

◀ A FEW SECRETS . . . from p.9

perhaps for preservation purposes) [despite the fact that doing so under certain conditions is clearly allowed by Section 108 of the Copyright Act] . . . “Just wait for the next lawsuit. We are on you.” . . . [L]ater, the author’s representative said it again. “I warn you, if you do it (digitization), I’m going to take you to court.”⁶

...

The response to this fear by educators and librarians is, too often, choosing to not act on their *own* rights under copyright law, thereby slighting the educational missions of their institutions and thus themselves and their students and users.

The response, in other words, is *self-censorship*.⁷

Take Away:

Our fears, based to some extent on confusion, keep us from doing our best as professionals. To move beyond that point, we must bring these secrets out in the open and begin discussing them.

Secret #8: Many lawyers don’t really “get” fair use, especially from the perspective of educators.

Every municipality, university, college, and school district has legal counsel. You may not know who yours is, but if you work in an educational institution or a library, your employer has one (or more). They may be “in house,” that is, employees of the institution; or “outside counsel” – a person or firm hired by the institution either subject to an on-going contract or on an as-needed basis.

...

Most often, the institution’s legal counsel is a “generalist;” for schools and higher education, this means he or she specializes in education law, which covers a wide range of topics. . . .

Although many of these attorneys know something about copyright law, the fact is that copyright – and especially fair use, on which educational institutions and libraries so heavily rely – is such a complex and nuanced area of law that it requires a detailed and deep level of knowledge to be able to practice it well.

...

In the absence of copyright expertise, particularly in combination with the current environment in which users of copyrighted works feel more threatened than ever, institutional counsel too often take an overly conservative approach to interpreting copyright law.

Such an approach creates restraints on all members of the

⁶ Carrie Russell, ““Safe zone” established during orphan works roundtable,” *District Dispatch*, March 12, 2014.

⁷ See Patricia Aufderheide et al, *Copyright, Permissions, and Fair Use among Visual Artists and the Academic and Museum Visual Arts Communities*, College Art Association (2014).

community (information users, faculty, students, and others) that prevent individuals from acting on their rights under the law, ultimately to the detriment of the pursuit of the institution’s educational mission.

...

It is you who can help decision-makers – sometimes including the institution’s legal counsel – understand that copyright is an unusually nuanced area of law, especially in the modern world, and even more so in the context of education; and that understanding that law and how to apply it in an educational context requires a deep level of expertise.

Too often, institutional policy, guided by institutional counsel, traps the institution into being much more conservative than necessary under the law, with the double result of handcuffing students and faculty from learning and creating as much as they would otherwise, and wasting financial resources on risk management expenses such as blanket licensing when they are not needed.

Take Away:

Think critically about your institution’s copyright policy position and procedural policies. Take part in critical discussions about whether the current policies best serve the institution’s mission. And encourage decision-makers to consult with experts in this specific, and rather narrow, field. ■

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Harvard Library Creates State Copyright Resource Center

Although the federal Copyright Act states that works created by the federal government cannot be subject to copyright (and are thus in the public domain), the same is not true for works created by state governments. Each state addresses copyright protection for state works differently, and it is often very difficult to ascertain the status of a given work in any given state.

The Harvard Library Advisor Program has partnered with [Free State Government Information](#) in creating the [State Copyright Resource Center](#) to provide “information on relevant polices, cases, and legislation” and to “assess the copyright status of government publications in each state.”

For each state, the website provides an “openness” score and a color rating of red (state documents are presumptively copyrightable), green (state documents are presumptively public domain), and various shades in between to indicate a state’s “tendency” in one direction or the other, where the law is not clear.

The site provides detailed information for each state, including citations to statutory law and attorney generals opinions; information about public records laws; examples of how the law is applied within the state; and supplementary information such as “additional things to consider” and a bibliography.

Creative Commons Librarian Certificate

Creative Commons (“CC”) recently announced the Creative Commons Librarian Certificate program. [See the CC website](#) for complete information. A summary of the program follows:

The goal of the program is to “ensure all librarians have the 21st century knowledge and skills they need to successfully perform Creative Commons related library functions and help patrons extend access to knowledge.” It is intended for “librarians seeking to acquire Creative Commons knowledge and skills in support of increasing capacity and services for library functions associated with Open Access (OA), open data, Open Educational Resources (OER), open science, and the public domain.”

The programs sounds thorough and intensive. Training will be provided by CC and its “authorized partners,” which are institutions and organizations who have gone through CC’s “train-the-trainer” program. Students will learn basic knowledge and complete learning activities by working through six online modules. Each module consists of 25-30 learning units comprised of readings and videos, each of which takes approximately thirty minutes to complete.

When online units have been completed, students must complete two days of face-to-face training with CC facilitators. For institutions with “numerous” (not defined) librarians seeking certification, facilitators will come onsite to the institution. Otherwise, students must attend the face-to-face component at open enrollment sessions scheduled throughout the year, usually in association with significant library events.

Once both the online and face-to-face components have been completed, students “will be invited to assemble and submit evidence of learning” in order to obtain their certification. “Evidence of learning” includes “a personal toolkit, community engagement, applied practice portfolio, and culminating module mastery learning outputs.” CC facilitators will review evidence of learning to confirm “successful completion of learning outcomes,” at which point the certificate will be awarded. Certified librarians will be listed publicly on the CC website.

Questions & Answers

Question: *My university has been dealing with the reuse of images from websites that specifically disallow reuse of their images on university-run blogs. It has been difficult to communicate to our faculty and students why fair use might not even come into play. If a license disallows any type of use, does that supercede privileges normally granted under fair use? Does contract law trump copyright law, and is there any gray area on this topic?*

Answer: Yes, contract law "trumps" statutory law. Think of statutory law as the default, and a contract as an agreement between private parties to exchange things to which each has a legal right (in this case, probably a copyright license in exchange for money).

If a license (or terms of use or any other type of contract) specifically states that you may not use images for a particular purpose, doing so would constitute a breach of the contract and, potentially, copyright infringement. However, a license may expressly state that it does not override fair use; in that case, you could engage in a use for which the license does not grant permission but that would be considered fair.

Most licenses do not mention fair use, which can leave some room for ambiguity as to whether you can rely on fair use of such images. This is why it is extremely important to read the entire license and be sure you understand how different provisions relate to each other. When uncertainty remains, contact your institution's legal counsel!

Question: *Can my library use the initials "NFL" for a program name? We are thinking:*

N - nurturing

F - family

L - learning

or something along those lines. Does this infringe the National Football League's trademark rights?

Answer: Basic trademark infringement is based on the likelihood that consumers will mistakenly assume a connection between you and the trademark owner. It seems highly unlikely that your intended use of "NFL" would cause anyone to think that the National Football League is sponsoring or endorsing your program, so from that perspective, simply using the letters as you've described would probably be OK.

However, for "famous" marks, the law also grants protection against "dilution." Whether a mark is "famous" is determined based on several factors, but the basic definition is a mark that is "widely recognized by the general consuming public" as being associated with the mark owner. "NFL" would certainly be considered a famous mark.

A mark is diluted when someone else uses the mark or a similar mark in a way that "weakens" the strength of the original. Not surprisingly, this is a very complex (and highly criticized) area of trademark law. We would need to know a lot more about the intended use of "NFL" to know how likely it is to be considered dilution.

You should also keep in mind the practical risk, as the National Football League is somewhat aggressive in enforcing against uses it considers to infringe its trademark rights.

It's impossible to provide a single answer to this question, because, of course, fair use depends on the specific circumstances of each use. Whether "re-writing" a poem or song in Shakespearean style constitutes fair use will differ, depending in part on the work is being used and how much of it is used.

Even more important, though, is what the institution does with these Shakespeare-tributes. Simply writing something in Shakespearean style is one thing (I could do that now as I sit at my desk and it's not a problem until I do something with it), but what will you do with them after they are submitted? Display or perform them in a public place? Post them on the institution's website? On YouTube? Each of those is a different use, and each carries a different level of risk, both legal and practical.

Instead of asking "Are these likely to be fair use," I suggest approaching this from the perspective of asking yourself what you can do to make it more likely the uses will be fair and to reduce your risk. For example, obviously the risk is increased (and the fair use assessment different) if the institution makes the entries publicly available online.