Against the Grain

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Questions and Answers-Copyright Column

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Cases of Note
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Wilson. ***Franklin Roosevelt*** *conceived of the body during WWII, began describing the Allied Powers as the "United Nations." He was determined to join the world together in a love-fest of happy-clappy democracies. Modeled on us, of course.*

I'm totally guessing. And I sure can't be bothered to delve into the Congressional record on the subject.

But I bet a lot of it had to do with not offending the symbols of foreign nations.

Strauch's *nonsense speculations aside ...*

§1052(a) has been around, used inconsistently. And the PTO has made it clear it doesn't care if the applicant is a member of the disparaged group or has good intentions.

Yet the PTO has admitted that "disparaging" is "highly subjective and, thus, general rules are difficult to postulate." ***Harjo v. Pro-Football Inc.,*** 50 USPQ 2d 1705, 1737 (TTAB 1999).

And that was before the Internet outrage mobs could get in a frenzy over a "Men Working" sign.

But incredibly, the PTO didn't survey a whole bunch of Asians to find a substantial composite. They based their ruling upon a quote from Urbandictionary.com and — wait for it — a picture of ***Miley Cyrus*** *pulling her eyes back into a slanting shape while seated next to an Asian.*

Tam was quoted in the media as saying Asians thought it all quite funny; only white people balked at it.

Well, the dogged Tam contested the denial before the examining attorney, the PTO's Trademark Trial and Appeal Board. Then he went to federal court where they chose to sit en banc to find the disparagement clause violated the First Amendment's Free Speech Clause and was unconstitutionally vague.

No kidding.

PTO filed a petition for cert which was granted.

Supreme Court

Before that august body, the PTO argued trademarks were government speech, not private speech. And the Free Speech Clause doesn't regulate gov speak. ***Pleasant Grove City v. Summum,*** 555 U.S. 460, 467 (2009).

Government can't regulate speech in ways that favor a viewpoint at the expense of others. But gov has its own viewpoints and couldn't function if it self-applied that rule.

Trademarks are created by the owner, maintained by same, and removed from the register if cancelled by the owner. It is far-fetched to call it government speech. Government would be endorsing a vast array of commercial products and services, many of them contradictory. We have registrations for both "Abolish Abortion" and "I Stand With Planned Parenthood."

What kind of govt. drivel would be put forward by "make.believe" (**Sony**), "Think different" (**Apple**), "Just Do It (**Nike**)?

Anyhow, registration does not mean approval. See *In re Old Glory Condom Corp.,* 26 USPQ 2d 1216, 1220, n.3 (TTAB 1993).

That's kind of cute, even without reading the case.

"If there's a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable." ***Texas v. Johnson,*** 491 U.S. 397, 414 (1989); ***Hustler Magazine, Inc. v. Falwell,*** 485 U.S. 46, 55-56 (1988).

Parks and monuments convey government messages, but not trademarks. And if you pushed this idea too far, a copyright would make a book into government speech.

And doubtless you're aware of the ***Washington Redskins*** *brou-ha-ha. They had their trademark cancelled, but the Tam case obliged the appeals court to vacate the decision. So don't imagine you can sell pirated* ***Redskins*** *gear.*

Questions & Answers — Copyright Column

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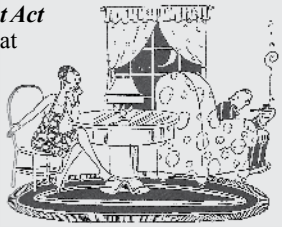
QUESTION: A prison librarian asks about placing sound recordings on a server so that individual inmates are able to listen to the recordings via the server.

ANSWER: Individual listening to sound recordings is fair use. There are a couple of caveats, however. The recording should be available to one inmate at a time or played in one living area even if multiple inmates are in the room. There should also be no ability for inmates to download the sound recording or share copies electronically.

QUESTION: An academic librarian asks why publishers object to controlled digital lending.

ANSWER: Controlled digital lending (CDL) is based on the idea that it is fair use for libraries to digitize printed books that they have legally acquired and to lend those digital copies under restrictions similar to those physical copies of books such as lending only one copy of the book at a time for a defined loan period. The **Internet Archives** has been doing this for some time, as have some other libraries even for works that are still under copyright.

Publishers and authors certainly have noticed this movement, and they claim that CDL is systematic infringement that negatively affects the incentives the ***Copyright Act*** provides them. Publishers argue that they are now making out-of-print works available digitally under license agreements and CDL interferes with exploitation of the copyright and this new source of income for them. A number of publishers' group have joined in objecting to CDL including the **Authors Guild**, the **National Writers Union**, the **Association of American Publishers**, the **International Publishers Association** and the **U.K.'s Society of Authors**.



Publishers have repeatedly questioned the **Internet Archives**, and according to the **Association of American Publishers**, the **Internet Archives** has inconsistently responded to take down notices under the ***Digital Millennium Copyright Act***. Publishers do not accept that CDL is the functional equivalent to hard copy lending. Section 109(a) of the ***Copyright Act*** is the first sale doctrine under which libraries lend physical books in their collections. It provides that once someone has legally acquired a copy of a physical work, he or she may dispose of that copy however he or she chooses. The doctrine does not authorize reproduction of the work, however.

Therefore, the first question is whether digitizing a work without permission of the copyright owner is fair use. Traditionally, the answer is no. The owner determines the format in which a work is made available and users are not permitted to reproduce it or to change that format. It is certainly understandable that librarians would be attracted to the idea that digital copies are no different from physical copies. This idea may not be supported by the ***Act***, however, or an important recent court decision. The Register of Copyrights has repeatedly opined that there is no first sale doctrine for digital works. (See *https://www.copyright.gov/reports/studies/dmca/dmca_executive.html*). In addition, in a report on orphan works, the Copyright Office concluded, "there is broad agreement that no colorable fair use claim exists [for] providing digital access to copyrighted works in their entirety."

In ***Capitol Records v. ReDigi,*** (910 F.3d 649 (2d Cir. 2018)), the court affirmed the district court's decision that finding that **ReDigi** infringed copyright through its service that allowed the resale of **iTunes** files. The court

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pretty much closed the door on the concept of a digital first sale doctrine. The case raises concerns about CDL even though **ReDigi** was a commercial enterprise and the libraries involved in CDL are nonprofit. The underlying theory of CDL is now called into question. **ReDigi** has announced that it will appeal the Second Circuit ruling to the U.S. Supreme Court, but there is no indication that the Court will even agree to hear the case.

QUESTION: A school librarian asks about the reproduction of unedited and unpublished works found on a webpage.

ANSWER: Unedited really makes no difference regardless of whether the work is published or not. Unpublished works posted on the Internet are published by the simple act of posting. The problem is that under the ***Copyright Act***, only the copyright holder has the right to publish the work or to decide that it will not be published. If the poster of the work does not have permission to post the work, he or she has infringed the copyright. If the owner posts the work on the web, then it is published and copyright attached at the time the work was created and will last for life of the author plus 70 years.

Assume that the work is unpublished. Even unpublished works are eligible for copyright protection. Determining when the work will enter the public domain is more difficult for unpublished works, however. If the work was created before January 1, 1978, but never published, it entered the public domain on 12-31-2002, or life of the author plus 70 years, whichever is greater. For works created before 1978 but which were published between 1978 and the end of 2002, it enters the public domain 70 years after the author's death or the end of 2047, whichever is greater.

QUESTION: A university librarian notes the recent announcement that the University of California system has canceled its multi-million dollar subscription with Elsevier. While academic libraries have long complained about high prices charged by Elsevier and the bundling of journals, this came as a surprise. What brought this about? What is the likely outcome?

ANSWER: The **University of California (UC)** system accounts for about 10% of U.S. scholarly output and its annual **Elsevier** subscription cost is more than $10 million. So, this cancellation is a big deal. Pressure on **Elsevier** has been increasing, and last year hundreds of German and Swedish institutions refused to sign a deal with **Elsevier** unless it changed fundamentally the way it charges institutions for the subscriptions to online journals. According to articles in the higher education press, **UC** pushed to offset the cost of open access publishing against the cost of access to subscription content. Under such a deal, all **UC** research published in **Elsevier** journals would be publicly available immediately, in other words, with no time embargo. **Elsevier** did offer to combine the cost of accessing pay walled content and publishing open access articles but at a high price. **UC** was unable or unwilling to pay that hefty amount. According to **Ivy Anderson** of **UC**, the **UC** system wanted to integrate its fees and reduce costs while **Elsevier** wanted to charge publishing fees on top of subscription fees. This made it impossible to reach an agreement and the libraries stepped away from the negotiations.

It is difficult to predict the outcome. The parties could come back to the negotiating table and reach some sort of agreement. Students and faculty in the **UC** system could simply adjust to using the pre-2019 journals to which **UC** has perpetual access and paying a per article charge for journal articles going forward. Or, students and faculty could demand reinstatement of the **Elsevier** subscriptions. Politically, this is not good for **Elsevier** but the impact on students and faculty could be negative.

Librarians do not want the big publishers to go out of business. In the era of shrinking library budgets and huge annual price increases for digital content there may now be an impasse, not only for **UC** but also for institutions. The open access movement is, in part, a response to these trends.