Against the Grain

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Questions and Answers-Copyright Column

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the company in a one-bedroom apartment in Venice Beach, CA. They marketed through skateboarder magazines. It quickly became a market powerhouse and partnered via images with **Snoop Dogg**, **The Notorious B.I.G.**, and **Kate Moss**. Celebrities like **Leonardo DiCaprio**, **Rihanna**, and **Hailey Baldwin** have been seen out and about in FUCT wear.

Cultural impact? If **Rihanna** doesn't convince you, in 1999, *The Face* magazine named it one of the top forty iconic labels in fashion. And ... **Cornell University Library's** Rare Book and Manuscript Collection has a collection of FUCT clothing due to its cultural significance.

As he hit the big time, **Brunetti** wanted to register his trademark.

It is not essential to register a mark. It can be used in commerce and enforced against infringers. But registration is *prima facie* evidence of validity and serves as constructive notice to infringers.

15 U.S.C. §1052(a) prohibits marks that "[c]onsist of or comprise immoral or scandalous matter." Historically, the **Patent and Trademark Office (PTO)** has asked whether a "substantial composite of the general public" would find the mark "shocking to the sense of truth, decency and propriety."

Of course, they don't actually run surveys or polls. They just pronounce. Perhaps they have in-office pow-wows.

PTO determined FUCT to be totally vulgar and unregistrable. They also did not care for images of "extreme misogyny, nihilism and violence" on the apparel.

Going to their website, I'm having trouble seeing this. Am I hardened by a coarse society to the point where I no longer recognize it? I see a \$125 t-shirt emblazoned with a skull and horned helmet. I see "Duct Tape It Can't Fix Stupid But It Can Muffle The Sound."

It is very much slacker skateboarder attire. Or maybe something you'd see on meth-heads on Breaking Bad.

Hmm. Here's "Cocaine Cool" with a crow leaning against a mound of flake. And two women wrestlers with bared breasts.

Brunetti sued, and the case made its way to the Supreme Court on certiorari.

In **Tam**, the Justices all agreed that government may not discriminate against speech based on the ideas or opinions it conveys. See **Rosenberger v. Rector and Visitors of Univ. of Va.**, 515 U.S. 819, 829-830 (1995). Being able to present ideas which offend are a bedrock First Amendment principle. Viewpoint discrimination is a no-no.

By the **PTO's** interpretation, the **Lanham Act** allows marks whose messages accord with society's sense of decency, but not when they

defy it. The **PTO** has refused to register marks expressing drug use and terrorism (positive) and religion (negative). **D.A.R.E. TO RESIST DRUGS AND VIOLENCE** (yes). **BONG HITS 4 JESUS** (no). **AGNUS DEI** for safes and **MADONNA** for wine were refused registration. Also **BABY AL QAEDA** on t-shirts.

The **PTO** knew they were on thin ice and argued the prohibition should be limited to lewd, sexually explicit or profane marks. They said the overbreadth in application by the **PTO** was not "substantial" relative to "the statute's plainly legitimate sweep."

The Court kind of shook its head at that and said the **PTO** was trying to fashion a new statute. Once viewpoint bias is found, it's all over. It would not compare permissible and impermissible applications if Congress banned "offensive" or "divisive" speech.

And the current mania about "hate speech" really takes you down a rabbit hole.

There are more immoral and scandalous ideas roaming the land than there are swearwords, and the **Lanham Act** is trying to forbid them all. So, big violation of the First Amendment.

And in celebration of their signal victory, there is an "I Fuct the Supreme Court" t-shirt. 🐰

Questions & Answers — Copyright Column

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QUESTION: *A Texas school librarian asks about a recent court decision in which the Houston Independent School District was ordered to pay \$9 million in damages for copyright infringement.*

ANSWER: In a case that was little publicized until the decision was rendered, the **Houston Independent School District (HISD)** was found liable by a federal jury and ordered to pay \$9.2 million in damages for allowing illicit copying and posting of the plaintiff **DynaStudy's** copyrighted works. **DynaStudy**, a small Texas company, repeatedly warned the school district that its actions violated copyright laws and that the company suffered lost sales and a devaluing of its work. The company produces course subjects with reference guides for various subjects and grade levels throughout the year along with study aids before unit tests and standardized assessments. Some teachers in the district had duplicated the materials and then

posted them on the web with the trademarks and copyright notices removed. **DynaStudy** presented evidence that the initial postings were reposted in various school districts across the state.

The 13-year-old company says that it provides supplemental materials that "fill the wide gap between large textbook publishers and teacher-created materials. It has sold its product **DynaNotes** to more than 650 Texas school districts and a few others outside the state.

HISD rejected four offers of settlement including one in 2016 for \$250,000 but it decided to proceed to trial. Both school districts and attorneys for districts typically issue warnings to teachers about illicit copying of materials.

HISD officials have now added training on copyright laws that is required annually for all employees of the district. It is unclear whether the district will appeal the jury verdict.

QUESTION: *A public librarian asks about copying book jackets for display or to be included in the library's calendar of monthly events. Is this permissible?*

ANSWER: Section 109(c) of the Copyright permits the display of lawfully acquired copyrighted works. So, if the library creates a display with original book jackets, there is no problem. Reproducing those book jackets is another issue since it involves making a copy of the book jacket. The artwork on the book jacket is copyrighted, and the book publisher may not own the rights to it but instead acquired only the right to use the art on book jackets. In fact, the publisher may acquire the right for reproduction on the jacket only for the hard cover book only. (Have you noticed that paperback editions of a book often have different cover art?) Making a copy of the book jacket is a reproduction for which permission is required. However, there seem to be no instances in which a copyright owner has complained about a library reproducing a book

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jacket for a display or to include in a calendar or newsletter. It is possible that publishers would consider this to be advertising for their product and not object.

QUESTION: *A university archivist reports that it owns a handwritten manuscript. If a staff member prepares a transcription, who owns the rights? Is the transcription an adaptation?*

ANSWER: A transcription of a manuscript is considered a reproduction of the work and not an adaptation. A transcription merely puts the handwritten text into typed text. If the manuscript were still under copyright, the author of the manuscript would own the copyright in the transcription, as well. If the manuscript is in the public domain, then the transcription is also in the public domain.

Assume that the work is still protected by copyright. Thus, what is done with transcription is important. If it is made available to individual researchers in lieu of the original manuscript, and, if the donor agreement permits such access, there is no problem. Making multiple copies or posting the transcription on the web would require permission of the copyright owner unless the donor agreement already permits such copying.

QUESTION: *A college librarian has*

several questions about databases. (1) Who is liable for the content in databases, the provider of the content or the distributor? (2) If the library acquires the database, what liability does it incur? (3) How is it determined what country's law is used if a dispute arises?

ANSWER: (1) It is the provider of the content in the database that is responsible for the content, not the distributor. (2) A library's access to a database is governed by a license agreement, and the license spells out any liability incurred by the library. Typically, libraries agree only to provide notice to its user community to comply with the terms of the license agreement and not to police its users. Liability tends to be one of the license terms that libraries negotiate with the database provider. (3) The license agreement usually contains a choice of law provision. Many of the database providers are located outside of the United States and will tend to name their country for choice of law. State institutions likely are bound by state law that require disputes against state entities be litigated in that state under its laws. Libraries should negotiate this license term also since trying a case in a foreign jurisdiction is difficult and expensive.

QUESTION: *An author asks how copyrights are enforced in this country and who can bring suit.*

ANSWER: In the United States, copyrights are enforced by copyright owners or by their exclusive licensees. Because the section

106 rights are divisible, many people and companies may have exclusive licenses for a particular work. For example, someone may have the performance license while someone else has a license to reproduce the work in copies.

There is no government enforcement agency. Owners or their exclusive licensees may sue in federal court for infringement of the exclusive rights protected by copyright, and federal courts have exclusive jurisdiction over copyright actions. If the action involves breach of a license agreement, that suit may be brought in state court, however, since they are contract actions as opposed to copyright.

Most copyright litigation involves civil actions in which the plaintiff is seeking monetary damages for infringing the reproduction, distribution, adaptation, performance or display rights (and for sound recordings, public performance by digital audio transmission) and/or an injunction to stop the infringing activity. Such actions typically begin with a cease and desist letter to the alleged infringer. There are also criminal actions that may be brought by the federal government at the request of the copyright owner for willful infringing activities for commercial gain such as counterfeiting or similar activity.

There is a three-year statute of limitations after the claim accrued for civil actions and five years for criminal actions.

The Scholarly Publishing Scene — Bill Begell's Legacy

Column Editor: **Myer Kutz** (President, Myer Kutz Associates, Inc.) <myerkutz@aol.com>

For the first dozen years or so after I left **Wiley** — I had been vice-president and general manager, scientific and technical publishing — I fielded annual phone calls from analysts who follow the fortunes of publishing houses. I was a source for a perpetual question: Would the **Wiley** family be amenable to selling their controlling interest in their eponymous company? My response to the question was another question: Would the family want their name attached to a long-lived and venerable institution, or would they be satisfied with taking the money and becoming very rich?

While other industry insiders I knew who were asked about the **Wiley** family's intentions responded in favor of the take-the-money-and-run option, I stuck with the legacy option. I believe that legacies are important to some people, and my interactions with family members had convinced me that they were in that category and were likely to remain there.

Now some publishing house owners may look at their legacies independently of whether they keep or sell their firms. One owner I got to know was **Bill Begell**, with whom I spent some pleasant times in the 1980s, mainly. I fondly recall a Metroliner trip from New York to Washington, during which we talked about some of **Bill's** favorite non-publishing topics. When you had the good fortune to be in **Bill's** company, from my admittedly limited

vantage point (more on this below), you invariably laughed a lot, and it's laughter that I remember from that train ride. Indeed, humor, sometimes self-deprecating, often seemed to be **Bill's** stock-in-trade. He would give a closing summary at the end of **Association of American Publishers'** Professional and Scholarly Publishing Division annual conferences that brought the house down. He liked to recall the time he'd been introduced to an audience as the chairman of something or other. A man of ample girth, **Bill** protested: "I'm not a chair, I'm a sofa." "No you're not," an audience member shouted, "you're a love seat!"

Bill owned the small, well-respected **Hemisphere Press**, which he'd founded in 1966. **Hemisphere** specialized in thermal science and heat transfer monographs, in addition to engineering and biomedical journals. **Hemisphere's** principal areas were key for me, as well, both as a **Wiley** acquisitions editor and later as a division general manager, so **Bill** and I were gentlemanly competitors, not shying away from publishing successive works by an author we both courted. (An Egyptian-American academic, who produced very fine books, comes to mind.) When **Bill** sold his firm to **Taylor & Francis** in 1988, the legacy subject didn't come up, at least not so far as I can remember. In any case, I may have been convinced at that time, as an author and editor of my own books,

that author and editor names would outlast publisher imprints

Bill's academic and professional credentials exceeded mine. While I held **MIT** and **RPI** engineering degrees and had worked in the aerospace industry before writing pulp novels and biographies until I was recruited in 1976 as a **Wiley** acquisitions editor, **Bill** earned a PhD, taught at **Columbia**, and was engineering director of the Heat Transfer Research Facility there. His publishing career actually started in 1962, when an assignment for a **U.S. Air Force** intelligence project led to his co-founding **Scripta Technica**, which specialized in translating engineering materials from foreign languages into English.

Later, we were both active in the **American Society of Mechanical Engineers**. I chaired the Publications Committee for a time in the 1980s, and **Bill** was the long-time chair of **Mechanical Engineering Magazine's** Editorial Advisory Board, where, as I recall, he managed with his affable style to make peace between the magazine's editorial staff and **ASME** members who demanded that particular viewpoints be reflected in the magazine's pages.

Our life histories differed in a most fundamental way. I was born in 1939 and grew up in the safety of a middle class Jewish family in Boston, far from the atrocities in Europe. **Bill**

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