Intellectual Property Basics

Primary types of intellectual property:

I. Copyright - original works of authorship
II. Patent - functional inventions
III. Trademarks
IV. Trade Secret

I. Copyright Basics

What is the purpose of copyright?

General Principles:

Copyright protection subsists in original works of authorship.

Author of work is owner of copyright
- no mark or notice required (U.S. signatory to Berne Convention 1989)
- must be fixed in a tangible medium of expression …. data sets and software meet this requirement and thus may be "works"

How long?

Generally, copyright extends for **life of** last surviving **author plus 70 years**

If author is employee & work created within scope of employment (i.e. "work made for hire"), employer is owner.

(works of legal entities: shorter of **95 years from publication** or 120 years from creation)

"Work for Hire" Problem Areas:

If independent contractor hired to develop software and the contract is silent on ownership, who owns?

- Contractor likely owner (Community for Creative Non-Violence v. Reid)
- Same for datasets?

Can contractor successfully claim co-authorship in a company's database that contractor has made substantial contributions to?

- Possible

Solutions:

a) Detail rights in the copyright of all parties in the written contract for employment

b) Obtain assignment of copyright before work begins
   i) Must be in writing
   ii) Ownership reverts after 35 years unless otherwise agreed upon

U.S. Copyright Law Objectives:

- encourage expression of ideas in tangible form so that **ideas become accessible** to others

- restrict the use of creative works in society as an **incentive** for authors to bring forth their knowledge, information and ideas

- protection subsists in **original works** of authorship and author is owner of the copyright **upon creation**

Protections Provided

Allows copyright holder to bar others from:
- making copies of the work
- creating derivative works
- performing, displaying, or distributing the work in a public manner

Independent creation of a substantially similar work is permitted. (Contrast with patent)

Registration of Copyright
-not required but has substantial benefits

1. Must register to bring action for infringement
2. Registration provides documentation of your creation
3. Prima facie evidence of validity of the copyright
4. To claim statutory damages and attorney's fees, registration must be within three months of publication or prior to infringement. Otherwise, only actual damages available. Three years from infringement in which to bring action.

Copyright Damages

Traditional Actual Damages

504(a)(1) Copyright Act

"the copyright owners damages and any additional profits of the infringer ..."

Statutory Damages

504(c) - copyright owner may elect instead statutory damages

1999 DMCA

- behavior unproven as "willful" - statutory damages are "not less than $750 or more than $30,000" per infringement
- behavior "willful", damages not more than $150,000 per infringement

Later: • court has discretion to reduce to to $200 if:
- D had no reason to believe acts constituted infringement OR D had reason to believe *fair use* and is nonprofit educational institution or public broadcasting

Supreme Court Decision (1998)

- amount of statutory damages now a jury issue if one of parties so requests

Registration is easy:

Send short application, fee and two copies of published work to Copyright Office, U.S. Library of Congress … or accomplish online

Limitations:

• copyright protects only **expression**, not facts

- the expression protected must be product of intellectual creativity and not merely labor, time, or money invested

- protected elements of the resulting work are precisely those that reflect creativity **and no more**

Copyright may be had in **compilations of facts** but only if "authorship" exists in the "selection, coordination, or arrangement"

- only a modicum of creativity required

- protection extends only to author's original and creative "selection, coordination, or arrangement"

- "thin protection" (although thin, does protect against wholesale copying)

Ideas, systems and principles are **not** protected by copyright.

The primary objective of copyright law is not to reward authors, but to **promote science and useful arts**.

FEIST PUBLICATIONS, INC. v. RURAL TEL. SERVICE CO., 499 U.S. 340 (1991)

Respondent Rural Telephone Service Company is a certified public utility providing telephone service to several communities in Kansas. Pursuant to state regulation, Rural publishes a typical telephone directory, consisting of white pages and yellow pages. It obtains data for the directory from subscribers, who must provide their names and addresses to obtain telephone service. Petitioner Feist Publications, Inc., is a publishing company that specializes in area-wide telephone directories covering a much larger geographic range than directories such as Rural's. When Rural refused to license its white pages listings to Feist for a directory covering 11 different telephone service areas, Feist extracted the listings it needed from Rural's directory without Rural's consent. Although Feist altered many of Rural's listings, several were identical to listings in Rural's white pages. The District Court granted summary judgment to Rural in its copyright infringement suit, holding that telephone directories are copyrightable. The Court of Appeals affirmed.

U.S. Supreme Court
FEIST PUBLICATIONS, INC. v. RURAL TEL. SERVICE CO., 499 U.S. 340 (1991)

Held:
Rural's white pages are not entitled to copyright, and therefore Feist's use of them does not constitute infringement.

Further Doctrines:

1. **Merger Doctrine under U.S. Law**

- facts not copyrightable

- if there is only one or a limited number of ways of expressing the facts, the "expression is one with the facts" and not copyrightable

- if permissible to copy indirectly, permissible to copy directly (e.g. Feist)

2. Computer Assoc. vs. Altai (p. 423 Perritt)
- software test for infringement of originality

If we were to apply test to datasets:
A. identify unprotectable elements of data set
- facts, processes, systems, etc.
- "expressions dictated by efficiency considerations or external considerations" such as making data set compatible with other data sets or software (i.e. "standard" means "unoriginal")

B. remaining elements are "golden nuggets of expression"
- were they copied?

Comports with Feist - facts expressed in standard form are quite ordinary and non-original

In the U.S. can you copy software in order to decompile to make another program interoperate with it? Yes

3. First Sale Doctrine

… once a copyright owner sells a copy of his work to another, the copyright owner relinquishes all further rights to sell or otherwise dispose of that copy
Bobbs-Merrill Co. v. Straus, 210 U.S. 339 (1908)

- relevant in a world of electronic licensing?

4. Fair Use Exceptions under Copyright Act

… the fair use of a copyrighted work …. for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research is **not** an infringement of copyright.

…factors to be considered include -
(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
(2) the nature of the copyrighted work;
(3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
(4) the effect of the use upon the potential market for or value of the copyrighted work.

- relevant in a world of electronic licensing?

Under what circumstances is it legal to copy someone else's digital film or music to use in your own new creation?

Is there a modicum of creativity? If so:

- only works for which you have explicit permission
- works affirmatively placed in the public domain
- works in which copyright has expired.

Use of a legal defense, such as fair use.

How do people get away with posting cat videos set to commercial music on YouTube?

Copyright: Federal Government Records

US copyright law expressly forbids Federal agencies from imposing copyright

- Major difference from other nations

Title 17

§ 105. Subject matter of copyright: United States Government works Copyright protection under this title is not available for any work of the United States Government, but the United States Government is not precluded from receiving and holding copyrights transferred to it by assignment, bequest, or otherwise.

Definitions: A "work of the United States Government" is a work prepared by an officer or employee of the United States Government as part of that person's official duties.

Why was this provision included in our national copyright law?

- fundamental belief that government copyright is the antithesis of "open access" whereby an informed citizenry can check official abuses
- individuals ought to be able to derive benefit from public goods - sound economics
- education is inherently good

What about state and local governments in the US?

- most state and local governments have the option of imposing copyright

- wise for them to do so?

- practical for them to do so?

Short Review

Generally:

To copy database which is property of another, need permission.

To re-publish database which is property of another, need permission.

To re-publish work in public domain, no permission required.

a. works of U.S. government
   - typically okay (Caveat: If re-publishing significant amounts of U.S. information, need to provide notice to consumers)
b. works of foreign, state, and local governments
   - may be copyrightable
c. work of third parties under federal contract
   - may be copyrightable

Caveats:

Some government works not available under FOIA or open records laws.

Even if they are available from government, private ownership interests may exist in them.

How do you know if a data set, article, book or map is in the public domain?