GUIDE TO RIGHTS CLEARANCE & PERMISSIONS

IN SCHOLARLY, EDUCATIONAL, AND TRADE PUBLISHING

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TAA

Guide to Rights Clearance and Permissions in Scholarly, Educational, and Trade Publishing

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INTRODUCTION

In the United States, the First Amendment provides us, as authors and publishers, with great freedom in the formulation and presentation of our message. Nonetheless, there are meaningful constraints on what we can say and how we can say it, including the following:

- the law of defamation obliges us to be careful with the facts
- the law of privacy limits our ability to seek and disclose highly personal information without the subject's consent
- the right of publicity restrains us from unauthorized exploitation of a person's name, likeness, or persona to sell an unrelated product or service
- copyright law places limits on what we can copy or adapt from pre-existing works
- trademark law precludes us from using the brands of another in a way that confuses the public about source, affiliation, or endorsement
- contract law holds us to the promises we sometimes make in the course of obtaining access to information or content

What follows is some background information about these areas of law together with information and advice for avoiding or managing the risk of a claim against you or securing permission if avoidance is unworkable.

Although this discussion focuses principally on U.S. law, similar concerns may arise under the laws of other nations. These issues can arise any time a publication crosses national boundaries, whether in a traditional format, such as a printed magazine, or in a newer medium, such as electronic publication or content made available via social media or a website.

In the chapters that follow, we'll turn our attention first to copyright matters, the central issue that will drive the majority of rights clearance and permissions needs you will confront. We'll look at copyright basics. We'll examine fair use, the principal exception to the monopoly rights vested in copyright owners. And we'll look at techniques for circumventing the need to get copyright permissions.

We'll turn next to defamation and privacy matters, the right of publicity, and trademarks. Not every potential publication risk can be addressed by securing permission. Some risks arise simply from what you say or disclose about your subject. A business case may include information or descriptions that are unflattering or even offensive to the executive or business being profiled. Sometimes this risk can be abated with a depiction release. More often, you just have to be careful about what you write.

In Chapters 1 through 3 we pay special attention to the unique issues that confront those writing scholarly and scientific works—considerations like attributing text and ideas borrowed from others; fair use; dealing with authorship credit; variations in rights-clearing strategies from field to field; the upside-down business model of open access journal writing; the non-exclusive rights reserved by some universities to the writings of their faculty; whether self-publishing affects the potential to publish traditionally in the future; and the variability in licensing models for open educational resources.

We'll take a closer look at special cases—photographs, music, and art—where it is useful to understand the unique business models and licensing norms (and even specialized terminology) that have evolved over time.

But even before we get to the long list of possible claims and how they might be addressed, you may want to consider whose job this is (or ought to be)—should the author take the lead? Should the publisher do it? Or should it be a shared obligation? Regardless of which role you're in, if you are about to sign a publishing contract, read Chapter 13 first.

We'll look at strategies for dealing with risk, including the use of releases and permission requests, as well as insurance and reserves. We'll address a strategy for requesting permission, when you should do this, how best to go about it, what to do if you don't get it, and how to respond if you get a letter from someone complaining.

We'll provide you with a list of resources for more in-depth information on the topics we present here. And finally, we'll equip you with some templates for commonly used forms, letters, and agreements to get you started.

1 COPYRIGHT PRIMER

THE PROBLEMS YOU WILL MOST COMMONLY CONFRONT in clearing the rights necessary to publish your book, journal article, or multi-media work will be copyright problems. What is covered by copyright? Who owns those rights. How long do they last? Are there ever exceptions? All of these questions are addressed in the pages that follow. Pay close attention. No area of law is as widely misunderstood by folks who ought to know better than is copyright law.

"BUT HONESTLY, MONICA..."

With these three words, the publisher of *Cooks Source* magazine launched an impatient email response to a writer's infringement complaint.

Then she continued: "... the web is considered 'public domain' and you should be happy we just didn't 'lift' your whole article and put someone else's name on it!"

Unfortunately for her magazine, she couldn't have been more wrong about the copyright implications of Web posting. And although her misconception is all too commonly shared, her error—compounded no doubt by her condescending tone—ignited an Internet firestorm. The email went instantly viral; the publisher's email and voicemail accounts were stuffed overnight with scathing messages; the magazine's Facebook page was assaulted by "fans" posting mocking comments; Twitter buzzed with 140-character taunts tagged #buthonestlymonica; satirical videos popped up on YouTube; and advertisers fled, forcing the magazine to close within weeks.

Every copyright mistake is not so instantly and irrevocably fatal, but a persistent supply of copyright mistakes and misconceptions seems to be working mischief in two directions—in some cases causing publishers and writers to take what they should be asking for; and in other cases, causing them to shy away from uses that are probably fair.

FIRST THINGS FIRST: PARSING COPYRIGHT PROTECTION

Copyrights provide protection for works of original expression, including things such as text, photographs, illustrations, music, and other artistic and aesthetic works.

Protection is automatic and instantaneous just as soon as a copyrightable work is fixed in a tangible medium of expression. Although a copyright owner who wants to take advantage of the full range of protections available under U.S. law can make use of a copyright notice and registration of their copyright claim with the U.S. Copyright Office, neither is required. (But see *Reasons to Register* at the end of this chapter.)

The copyright rights vest in the author upon fixation, with or without them.

BREACH OF IMPLIED CONTRACT

Altogether apart from the potential for a copyright claim as described above, there is also under certain circumstances the potential for a claim not dependent upon the unauthorized appropriation of protected expression. Where you obtained access to the subject work under circumstances that might create a reasonable expectation in the minds of the parties that the subject work would only be exploited by the recipient in exchange for compensation, there may be a breach of implied contract claim. Accepting and reviewing a query or proposal, whether solicited or unsolicited, may give rise to such an expectation. These "submission-of-idea" claims are creatures of state law, the elements of which vary from state to state. Some states require that the submitted idea be absolutely novel (i.e., not previously known to anyone other than the discloser). Some require only that it was not already known to the recipient.

PRACTICAL POINTERS AND GUIDELINES

Recognizing, as we noted at the start of this chapter, that most creative work is inspired by the earlier work of others, there are some best practices that you can adopt yourself that will put you in a position to deflect or defend against claims that your work borrows impermissibly from the earlier works of others.

1) Consult a number of sources, not one, and keep a list of the works you consult. Someone said it: Copying from one source is infringement; copying from multiple sources is research. It's not literally true, of course. It is certainly possible to infringe multiple works in one project. But to the extent that you have a record of having consulted multiple works and to the extent that the cited similarities between your work and an accuser's work are also present in some or all of the other works you consulted, it will be less likely that those similarities will support an inference that you copied impermissibly from any one of them.
2) Take skeletal notes… just the facts and abstract ideas, and keep these notes. Working through this intermediate step will make it less likely for you to pick up protected expression from a source work inadvertently. It is not uncommon for a writer to take detailed notes from source materials, set them aside for other projects, and return to them months or years later, having lost track of where they came from or how closely they were copied or paraphrased. Also, to support your memory, if you are doing scholarly work, record the source (author and publication) for each concept or finding in your notes for attribution later.
3) Set the source works aside and work from your notes. This will help you avoid inadvertent appropriation of protected expression.
4) Keep a contemporaneous log of your writing activities and how much time you spend developing your manuscript (the less time it takes you, the more likely it is that you took inappropriate short cuts). The contemporaneous notes are business records admissible as evidence in support of your recollections about how your work was created. And evidence that you took these precautions and that you did not generate your manuscript in an unreasonably short period of time will help you defeat an inference that your work was the result of impermissible copying.
5) Keep your interim drafts, for the same reason.

8 TRADEMARK PRIMER

If you are not a brand, you are a commodity.
—Philip Kotler, Professor of International Marketing,
Kellogg School of Management

A TRADEMARK IS A BRAND. TRADEMARKS ARE SHORTHAND signals used to signify that a particular product or service comes from or is endorsed by a particular company, association, or individual. Trademarks come in a number of different varieties—virtually anything that can serve to identify the source of goods or services and to distinguish that source from others can serve as a trademark. Brand names are perhaps the most common trademarks, but trademarks can also consist of logos, slogans, sounds, colors, a consistent "look" for a series of products, and the total image, appearance or even shape of a product or product packaging.

Trademark rights in the United States can arise simply by virtue of use of the mark in the stream of commerce. The formality of registration is not required to establish protected rights, although registration does provide added benefits. In other jurisdictions, however, trademark rights can arise from registration alone. Because trademark rights are territorial in nature, it is

Examples of different Types of Trademarks	
Word Marks (including common terms, coined words, and names)	GENERAL ELECTRIC KODAK MCDONALD'S
Slogans and Phrases	DON'T LEAVE HOME WITHOUT IT CAN YOU HEAR ME NOW? JUST DO IT
Symbols and Logos	CBS Eye Penguin Books logo
Sounds	NBC Chimes Homer Simpson's "D'oh!"
Color	Owens Corning pink UPS brown
Trade Dress (including the look, shape or overall appearance of products and packaging)	*Time* magazine cover design (red border) Shape of the Coca-Cola bottle

Table 8.1

possible that a mark owner may have rights in one country but not in another. Publishers whose works cross national borders must therefore be sensitive to the various trade-mark rights that may apply wherever their material is published.

Trademark law plays two roles in publishing. It places constraints on how an author or publisher can use the mark of another. And in some cases, it can provide protection for series titles and character names.

successful in preventing other publishers of guide books from using "collector's guide" in their house name. Likewise, if you called your house "Computer Publishing," you would find yourself in a crowded field with nearly forty other live regis-trations for marks including the term "Computer" for use in connection with books. Such a weak mark is entitled to only a narrow scope of protection.

AVAILABILITY

"Availability" is a determination of whether you are or will be the first to use the chosen mark on or in association with your goods or services. This usually starts with a preliminary, or "knock-out," search of the U.S. federal and state registers. How far the search continues will depend on individual circumstances. This is a critical issue on which you should consult a competent trademark attorney. You don't want to invest in building a reputation and goodwill for your brand only to discover down the road that an earlier adopter of a confusingly similar mark is in a position to force you to change it.

Searching will be more difficult and more expensive if your proposed mark is comprised of ordinary English language words for the simple reason that the search will be more likely to turn up more hits that require evaluation. Searches for proposed marks that are fanciful, because they are non-words, are more likely to come back clear. Of course, fanciful marks do not come packaged with the instant meaning and recognition that accompanies a suggestive mark, so they are less effective, at least initially, in communicating to your market. One compromise is to adopt a mark that, though not an English language word, is comprised of syllables from adjectives or nouns that convey features of or positive attributes about your books. "Microsoft" is a pretty good example of this.

REGISTRABILITY

Evaluation of a mark strictly for the purpose of registrability is limited to those marks registered or pending on the *Federal Trademark Register*. The U.S. Trademark Office does not search or consider state registrations, foreign registrations, or prior common law use during initial examination (though prior use by others may be raised in an opposition or cancellation proceeding).

The Trademark Office may refuse registration on the basis that the mark is generic, merely descriptive, primarily merely a surname, scandalous or immoral, or likely to be confused with another registered or pending mark. If the refusal is based on another pending application, your application may be "suspended" until the other application issues or is abandoned. This is one of the reasons why a thorough search must be as up-to-date as possible and include pending applications.

For a clearance search to be comprehensive and thorough, it should include a search for prior common law use of potentially conflicting marks. In many cases, your own knowledge of the industry is the best source. Also, trade journals, advertising media and news articles can be excellent sources for investigating common law use. Trademark lawyers typically use professional search companies to conduct these searches. Those companies maintain large, proprietary databases of business, product, and service names and logos.

REGISTRATION

Registration of your mark in the United States is not required; it is optional. Enforceable rights under state and federal laws are created by *use* of the mark, not by registration. There are many good reasons, however, for registering your mark. Registration offers the following advantages:

- Providing constructive notice of your claim to ownership of the mark.

sources, like stock photo houses and trade magazine publishers. Most established textbook publishers recognize this fact of life and will, if pressed, agree to handle the job of clearing permissions. Such a provision might look like this:

Third-Party Permissions. *The Author shall clearly identify to the Publisher all materials for the Work and related materials that were not created by the Author, or are otherwise subject to legal rights of others. The Publisher shall be solely responsible for obtaining, at the Author's expense (the cost in each instance being subject to the Author's prior approval), permissions, releases, and other necessary authorizations, in form satisfactory to the Publisher, for the use of such materials in the Work and related materials in all media and all languages throughout the world.*

They may also agree to cover some, or occasionally all, of the cost… or at least to advance the rights payments and recover them out of royalties. Such a provision might look like this:

Third-Party Permissions. *The Author shall clearly identify to the Publisher all materials for the Work and related materials that were not created by the Author, or are otherwise subject to legal rights of others. The Publisher shall be solely responsible for obtaining, at the Publisher's expense, permissions, releases, and other necessary authorizations, in form satisfactory to the Publisher, for the use of such materials in the Work and related materials in all media and all languages throughout the world.*

More difficult, but still worth trying, is to get them to agree to take and pay for less than rights in all languages and all media throughout the world, the latter being more convenient for them but rarely necessary for most textbooks.

In instances where the author will ultimately be called upon to cover the final cost of permissions, up front or out of royalties, it is important for the author to retain a final veto power once the cost of any third-party piece is established against the possibility that it isn't worth what it will cost.

YOUR REPRESENTATIONS AND WARRANTIES

The publishing contract, whether it's a book contract or a journal contract, will also include language requiring you to make certain promises about the manuscript submitted for publication—that it's an original work, that it doesn't infringe the intellectual property rights of any third party, that it isn't libelous, and so on. Such a commitment from the author is both appropriate and absolutely necessary because only the author is in a position to know whether the things promised are true—there is no database a publisher can search, no amount of diligent, independent, research it can do that will disclose for certain whether the author's work is original and claim-free. If you have not handled the rights clearance and permissions matters successfully, one or more of these representations and warranties will be breached and you will likely be responsible for dealing with the consequences.

But although most publishing contracts have such provisions, with a certain core content common among them, in the course of my practice I have encountered many variations, some of which suggest that the risks to be addressed are not always well understood. Let's examine some of the common elements first, then some of the less typical variations, and finally the indemnity language that puts the teeth in these provisions.

THE INTRODUCTION

The Author represents and warrants to the Publisher that:
Lawyers say "represents ***and*** warrants" not to be redundant (though we are sometimes just that). Strictly speaking, a representation is a promise that the fact asserted ***is*** true at the time the contract is entered. A warranty, on the other hand, is a promise that the thing asserted ***will be*** true or ***will happen*** (or not happen, as the case may be) in the future. What typically follows this phrase in most publishing contracts is a mix of some

REQUEST FOR PERMISSION TO REPRINT TEXT

[Adam Author Letterhead]

[Date]

[Copyright owner's address]

Re: Request for Permission to Reprint

Dear [Name]:

I am preparing for publication by the American Literature Press a book of collected readings on the subject of Civil War-inspired poetry tentatively entitled *Battles in Iambic Pentameter* and scheduled for publication in 2020. The American Literature Press is a well-regarded academic publisher focusing on its namesake subject and publishing scholarly books written by some of the leading scholars of our time. As an academic publisher of some reputation, they can afford to focus on titles like this one that, although promising an important contribution to the literature, are nonetheless targeted at a relatively small market.

In researching the subject, I have discovered your insightful article on the subject of [specify] entitled [specify] and published in [specify] and have found it to be uniquely [tell them their work is important and that it will be included with extracts from the work of other notables, etc.]

May I have permission to include in my book in printed and digital form and in revisions, reprints, internet editions, electronically stored or delivered copies of all or portions thereof and adaptations for video or other media the article described below:

[List]

The American Literature Press is not able to provide me with a budget for reprint rights. Accordingly, I ask that you grant this permission without charge [consider offering a comp copy].

If you do not control these rights in their entirety, would you please supply the name(s) and address(es) of anyone else to whom this request should be directed.

Unless you otherwise specify, we will use a standard credit line and will indicate that the material is being reproduced with your permission.

Very truly yours,

Adam Author

Permission Granted:

By: _____

Name: _____

Title: _____

Date: _____

REQUEST FOR PERMISSION TO REPRINT TEXT (ALTERNATE FORM)

[Letterhead]

To: [Permissions Editor]

[Address]

[name of publisher] is preparing a [book, periodical or journal article, web site, etc.] tentatively entitled [title] on the subject of [specify] tentatively scheduled for publication on or about [date]. [Describe any educational or public service motivation behind your project, if appropriate, or any ancillary benefit that the addressee may realize by virtue of the exposure your publication will provide.]

In researching the subject, I discovered your work on [specify] and found it to be a uniquely insightful comment/contribution to the literature [flatter them, stroke their ego, tell them their work will be included with that of other notables…you get the idea].

May I have permission to include in my work, in print and eBook form, [and in revisions, reprints, internet editions, electronically stored/delivered copies of all portions thereof, and adaptations for video or other media] the following material (a copy of which is attached hereto):

Author/Editor: _____
Title/Edition/Volume Number: _____
Article/Chapter Title: _____
ISBN/ISSN: _____
Copyright Date: _____
Page/Illustration/Table Number: _____

The budget for my project is very limited and, accordingly, I ask that you grant this permission without charge [consider offering a comp copy].

If you do not control these rights in their entirety, would you please supply the name(s) and address(es) or anyone else to whom this request should be directed.

Unless otherwise indicated, the credit line will include title, author, copyright line as it appears in the book/journal, publisher and an indication that the material is being reproduced with permission.

If you have any questions about this request, please contact the undersigned at (_____).

Thank you,

[Signature]

Permission Granted:

By: _____

Name: _____

Title: _____

Date: _____

[Leslie Author Letterhead]

Colloquialism. A literary device in which the writer employs a word or phrase that is not formal or literary, but which is more commonly used in ordinary or familiar conversation, often regionally.

Commercial use. This is a term that has significantly different meanings depending upon the context. When used in connection with publicity rights it means use to advertise or promote a product or service not connected with or endorsed by the person depicted (a for-profit motive is not sufficient to make a use commercial for this purpose). In photography, a commercial use is in contradistinction to an editorial use. When used in connection with video permitting, conversely, it means recording by any technology for an entity for a market audience with the intent of generating income (a for-profit motive would be sufficient to make a use commercial for this purpose).

Commissioned. A work is commissioned when its creation to described specifications has been specially ordered by the commissioning party in contrast to speculative work or work done on speculation where the person creating the work does so without having an order or contract in hand. In connection with photography, commissioned work is the most expensive type of work because it is staged or shot just for the commissioning party and so the photographer's price will have to cover 100% of the value/cost of producing that work.

Consideration. This term has a special meaning in the context of contract law. One of the essential requirements for the creation of a legally enforceable contract is that the promises of each party be supported by a return promise, or consideration, from the other party.

Copyright. A bundle of rights in a work of original expression that belong exclusively to the copyright owner, including the right to make copies, the right to distribute copies, the right to make derivative works, the public display right, the public performance right, and (for sound recordings only) the digital transmission right.

Copyright infringement. The exercise of any one or more of the monopoly rights of the copyright owner by some other without authorization or a legally recognized excuse or exception.

Creative Commons. An open copyright licensing protocol that includes four basic forms of royalty free licenses (and some combinations of them): Attribution, ShareAlike, NonCom-mercial, and NoDerivatives.

Defamation. An umbrella term that encompasses both libel and slander—essentially false allegations that damage a person's reputation.

Depiction release. An agreement obtained from a person who will be identifiably described or incorporated in text, photographs, or video clips intended for public distribution in which the subject waives the right to assert claims that might follow if his/her image were publicized without his/her permission, most notably privacy rights.

Descriptive mark. A type of trademark comprised of a word or words that describe some attribute of the goods or services with which the mark is used. An example would be American Airlines.

Digital transmission license. A copyright license that pertains only to sound recordings and that permits those sound recordings to be digitally transmitted to the public. It is an analog to the public performance license that concerns the musical composition (as distinct from the sound recording).

Disclaimer. A statement that denies something, most commonly intent or responsibility. The use of a disclaimer is not always effective to accomplish its legal objective.

Right of publicity. One of the four forms of privacy right, wherein the subject enjoys a right not to have his/her name, likeness, or persona used to promote goods or services with which the subject is not associated without his/her permission.

Rights managed. Used in reference to photography licenses, Rights Managed images are selectively licensed for a limited exclusive use, by market, by length of time, by geographic territory, by medium, and so on).

Royalty-free. Used in reference to photography licenses, royalty Free doesn't mean free. Instead it is a term used to describe a license that provides for an up front, one-time payment in return for which the licensee get relatively broad, non-exclusive usage rights.

Self-Published Work. A non-traditional manner of publishing in which the role of the traditional publisher in converting a raw manuscript to a published book which is then promoted and sold by the publisher, is supplanted by one or more vendors who provide those services at the expense of the author.

Slander. Defamation that is in oral or otherwise transitory, unrecorded form.

Suggestive mark. A type of trademark comprised of a word or words that call to mind a desired association between the word or symbol and the product or service in the customer's mind. Harlequin is a suggestive mark for romance novels.

Synchronization license. Used in connection with music licensing, a synchronization (or "sync") license authorizes the recording in timed relation to a motion picture or moving images, of the licensee's performance of a musical composition. If, instead of one's own recorded performance, one wishes to use an existing sound recording, a master recording license will also be required.

Synecdoche. A literary device by which the writer uses a part to represent the whole (such as fifty sail for fifty ships), uses the whole to represent a part (such as humanity for a person), uses the species for the genus (such as person for humanity), uses the genus for the species (such as a creature for a person), or uses the name of the material for the thing made (such as boards for stage).

Trademark. Any word, phrase, logo, slogan, sound, color, consistent "look" for a series of products, and the total image, appearance or even shape of a product or product packaging that serves to identify a good or service as having come from a particular source.

ABOUT THE AUTHOR

Stephen E. Gillen is a partner at Wood Herron & Evans, a 150-year-old Cincinnati law firm focused on intellectual property, where he focuses his practice on publishing, media, and copyright matters. He worked for nearly 20 years in publishing before entering private practice in the middle 1990's. He also teaches Electronic Media Law at the University of Cincinnati College Conservatory of Music, and is the author of *Guide to Textbook Publishing Contracts* and co-author of *Writing and Developing Your College Textbook: A Comprehensive Guide*. Gillen is a long-time member of the TAA Council and a regular speaker at TAA conferences.

"Wood Herron & Evans is excited to celebrate our sesquicentennial anniversary this year. Established in 1868 in Cincinnati, Ohio, the birthplace of considerable innovation, industry and creativity, our firm has been a steadfast partner to inventors, innovators, and business leaders in Cincinnati and beyond in protecting such creations.

We look forward to a future of offering the same high quality and effective legal services, with the same focus, dedication, and integrity exemplified by our firm's founders, that our name has represented during the last 150 years.

> The future is bright—and while the nature of the practice has changed greatly, we have adapted to these changes in the past and will continue to do so in the future."
>
> —Truman A. Herron, 1973

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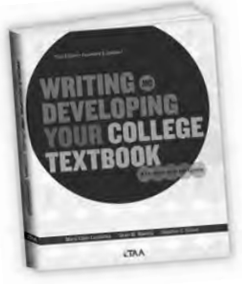

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