

Associations and Copyright: Practical Tips for Success

Related Topic Area(s): Copyrights and Trademarks

Despite great potential to use intellectual property to raise non-dues revenues and better serve members, many association leaders fear that the "hassles" or "mistakes" surrounding copyright issues in the past preclude new knowledge-based product development. One lawyer's response? Do something about it.

Your association wants to launch a new online educational service. The association's staff develops a wonderful, innovative proposal. The service would hinge on taking years' worth of association-"published" materials on every aspect of your industry and reformulating it into a user-friendly, searchable database.

Or perhaps the idea is to take past articles on select topics from your magazines or newsletters, or past speaker handouts from your conferences, and repackage them into a new, more-accessible online service for members. Or maybe the concept is to create a "best practices" online library, culling sources from your association's publications, meetings, and other resources. These potential revenue-raisers might even involve another industry association.

In all of these instances, your association's ability to engage in the exciting new venture hinges on its ownership – or at least right to use – the intellectual property (i.e., copyrights) in the relevant materials. If association employees created all of the materials, the copyright issues would be simple and likely non-existent. Unfortunately, in the world of association management – where staff has no choice but to rely on the invaluable input of and content from volunteers and outside contractors – the legal analysis is far from simple.

In fact, due to a basic, straightforward, yet very misunderstood concept of our copyright law – that the paid or unpaid creator of the work is the owner of the copyright in that work (except for an employee acting within the scope of his or her employment and certain other very limited circumstances) – the realities of this law can throw a big monkey wrench into your association's well-conceived plans. Some associations are so fearful of copyright law and its implications that they shy away from even attempting what could be highly successful ventures.

All of this is terribly unfortunate – and very unnecessary. Once understood, this simple tenet of copyright law can be quickly used to the association's advantage. For instance, by obtaining brief, one-paragraph copyright "assignments" (transfers of ownership) or "licenses" (permission to use, which can be drafted broadly and perpetually) from volunteer authors, speakers, and committee members, as well as from all paid contractors and consultants, the association can ensure that it has the rights to do with "its" publications whatever it chooses, without restriction, without fear of reprisal from copyright holders, and without having to pay royalties to hundreds of "joint authors." And even if your association may not have been as proactive as it should have been over the years – you would be shocked at how many have not – all is not lost. These problems are solvable – easier at the outset than later on, to be sure – but solvable nonetheless.

In short, an even rudimentary understanding of the basics of copyright and trademark law can go a long way toward giving your association the flexibility it needs and wants to engage in the activities it desires, to launch the new ventures it conceives of, and to otherwise act in the best interests of the association rather than let intellectual property laws be the tail that wags the dog.

Below are 11 tips that will, if followed, go a long way toward protecting and maximizing your association's intellectual property and avoiding the infringement of others'. The following guidelines should provide the framework for effective association policies and practices in the copyright and trademark area:

1. **Use copyright and trademark notices.** Use copyright notices (e.g., © 2004 The Center for Association Leadership. All rights reserved.) on and in connection with all creative works published by your association and trademark notices on all trademarks, service marks, and certification marks owned and used by your association (e.g., TM for non-registered marks and ® for registered marks). While copyright and trademark notices are not required, their effective use can significantly enhance your intellectual property rights, including eliminating an "innocent infringement" defense.
2. **Register your trademarks.** Register your association's name, logos, slogans, certification marks, and all other important marks with the U.S. Patent & Trademark Office. While federal registration of your marks is not required to obtain and maintain trademark rights, it can be extremely helpful in enhancing and enforcing them. In addition, obtain domain name registrations for all available names you plan to use in the future, and try to obtain registrations from others if your association has superior rights to the domain name.
3. **Register your copyrights.** Register your association's Web site, publications, and all other important, original, creative works that are fixed in any print, electronic, audio-visual, or other tangible medium with the U.S. Copyright Office. Again, although such registration is not required to obtain and maintain a copyright in a work, it is a prerequisite to filing suit to enforce your rights, and it confers other valuable benefits. Copyright registration is a very simple, inexpensive process that can be done without the assistance of legal counsel.
4. **Police use of your intellectual property.** Police the use of your copyrights and trademarks by others and enforce your rights where necessary. Use periodic Web searches, among other means, to do so. Enforcement does not necessarily involve the filing of a lawsuit.
5. **Codify all licenses in writing.** Whenever your association lets others – such as members, chapters, affiliated entities, or endorsed vendors – use your name, logos, copyrighted works, and other intellectual property, put the terms and conditions of the license in writing. Note that an assignment (transfer of ownership) must be in writing to be valid, as must an exclusive license (permission to use). While oral or implied non-exclusive licenses can exist, they can be difficult to interpret, difficult to enforce, limiting in nature, and otherwise problematic for your association. If a copyright owner will not assign a copyright to your association, simply obtain a broad, permanent license instead. A perpetual, irrevocable, worldwide, restriction-free, royalty-free license to use a copyright holder's work in any medium – whether exclusive or non-exclusive – can be virtually as good as ownership and typically much easier to obtain.
6. **Make sure you own or have permission to use all intellectual property.** Ensure that your association owns or has appropriate permission to use all intellectual property (e.g., text, graphics, photos, video) that appears in its publications, on its Web site, and in all other media. More copyright problems arise in this area than any other. You may have conceived the idea, supervised the work's creation, and paid for it, but that does not mean you own the work. You may have only a limited license for a specific use. When you wish to use the work on another project or in another medium, you may learn that a separate fee and permission is required.
7. **Maintain agreements with contractors.** Maintain written contracts with all contractors to your association, such as software developers, lobbyists, and other outside consultants and contractors, to ensure that your association is assigned the ownership rights (or at least sufficient, irrevocable license rights) to all intellectual property created by the contractor under the agreement. Without something in writing, the basic rule in copyright law is that the person who creates the work is the one who owns it, regardless of who paid for the work to be created. This rule does not apply to employees, ownership of whose work (that is within the scope of their employment) automatically vests in the employer. If your association is a joint author with another party (e.g., association employees working side-by-side with technology consultants to write software for your association), seek to obtain an assignment from the co-author(s) to your association.

8. Negotiate agreements with authors and speakers. For the same reason stated previously, obtain a written and sufficiently broad license or assignment from all non-employed writers and speakers for your association, including members. Be sure that, for licenses, the permission is irrevocable, worldwide in scope, royalty-free (if applicable), exclusive (if applicable), covers all possible uses of the work in all media, contains a release to use the author or speaker's name and photograph, and contains appropriate representations and warranties.

9. Don't forget to collect agreements with board and committee members. Again, for the same reason, obtain a written assignment from every member of your board of directors and committees that assigns ownership of all intellectual property they create (within the scope of their service to the association) to the association. Such a form also can be used to impose confidentiality obligations on members, to require conflict-of-interest disclosure, and to impose noncompetition restrictions.

10. Protect your membership database. Since names, addresses, and other contact information contained in your membership directory, mailing labels, and membership list are generally not protected by copyright because they usually don't possess the minimum level of originality required, it is imperative for your association to use a "shrinkwrap" license, click-and-accept feature, or other form of contractual commitment to place explicit, binding limits and conditions on the use of your membership list by members, vendors, and others. Failure to do so may leave your association with little or no recourse to prevent unrestricted use of this most-valuable information by those who obtain a copy of it.

11. Rules for interactive online services. As part of your association's chat rooms, bulletin boards, e-mail exchanges, and other member-interactive online services, regularly distribute rules that prohibit the posting of any copyright-infringing materials (along with other rules). In addition, be sure to immediately remove infringing material if it comes to your association's attention.

The bottom line is that a fear of copyright infringement should not prevent association leaders from seriously considering new knowledge products as a way to better serve members, develop non-dues revenues, and forward the organization's mission. However, they should expect to devote significant time and effort to both clearing up any copyright confusion, securing all necessary copyright rights, and ensuring that intellectual property processes and policies are in place and followed.

Does Your Association Own the Work Product of Your Contractors, Authors, Speakers, Officers, Directors, and Committee Members?

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Except for employees acting within the scope of their employment and certain other limited cases, the basic rule under U.S. copyright law is that the creator of an original work is the owner of the copyright in that work (regardless of who paid for the work to be created), barring a written assignment of the copyright to another party. This widely misunderstood rule applies with equal force in the association community, and it applies not only to outside contractors such as consultants and lobbyists, but also to your association's volunteer or paid authors, speakers, officers, directors, and committee members. Failure to understand this rule can have devastating consequences for your association.

It is critical for your association to ensure that it owns, or at least has appropriate permission to use, all intellectual property (e.g., text, graphics, photos, video) that it uses in its publications, on its Web site, and in all other media. Your association's staff may have conceived the idea and supervised the work's creation – with your association paying for it – but that does not mean your association owns the work. You may have only a limited license for a specific use. When you wish to use the work on another project or in another medium, you may find the work's creator demanding a separate fee or other consideration – or you may be precluded from using it at all.

Contractors. Maintain written contracts with all contractors to your association – such as software developers, lobbyists and all other outside consultants and contractors – to ensure that your association is assigned the ownership rights (or at least sufficient, irrevocable license rights) to all intellectual property created by the contractor under the agreement. If your association is a *joint* author with another party (e.g., association employees working side-by-side with technology consultants to write software for your association), seek to obtain an assignment from the co-author(s) to your association.

Authors and Speakers. Obtain a written and sufficiently broad license or assignment from all (non-employed) writers and speakers for your association, including members. Be sure that, for licenses, the permission is irrevocable, worldwide in scope, royalty-free (if applicable), exclusive (if applicable), covers all possible uses of the work in all media, contains a release to use the author or speaker's name, photograph, and biographical information, and contains appropriate representations and warranties.

Officers, Directors and Committee Members. Obtain a written assignment from all association officers, directors and committee members assigning ownership of all intellectual property that they create (within the scope of their service to the association) to the association. Note that when a work has numerous creators (such as a set of standards or a report produced by a committee, perhaps in conjunction with association staff), each of the individual contributors (including the association) may be a joint owner of that work, each with the right to use the work and each with a proportional right to share in all proceeds from the work. Below is an abbreviated version of a sample assignment form for use with association committee members (more comprehensive versions of such forms are sometimes used):

Copyright Assignment Form for the ABC _____ Committee

As a member of the _____ Committee (the "Committee") of the ABC Association ("ABC") that assists ABC staff members and others in the development, modification and refinement of _____ and related material for its _____ (collectively, the "Intellectual Property"), I, _____, hereby completely, exclusively and irrevocably assign and agree to assign to ABC in perpetuity ownership of all of the copyrights (and all rights subsumed thereunder) in and to

all of my contributions to the Intellectual Property (the "Contributions"), both those Contributions that have been made in the past and those that will be made in the future. I hereby grant, convey, assign, and set over unto ABC, its successors and assigns, on an exclusive basis, all of my right, title and interest in and to the copyrights in the Contributions, including, without limitation, copyrights and renewals and/or extensions thereof, for all territories of the world in perpetuity. Good and valuable consideration has been provided to me for the assignment of these rights. In addition, I hereby waive any and all rights of attribution and integrity with respect to ABC's use of the Contributions.

Signature _____

Date _____