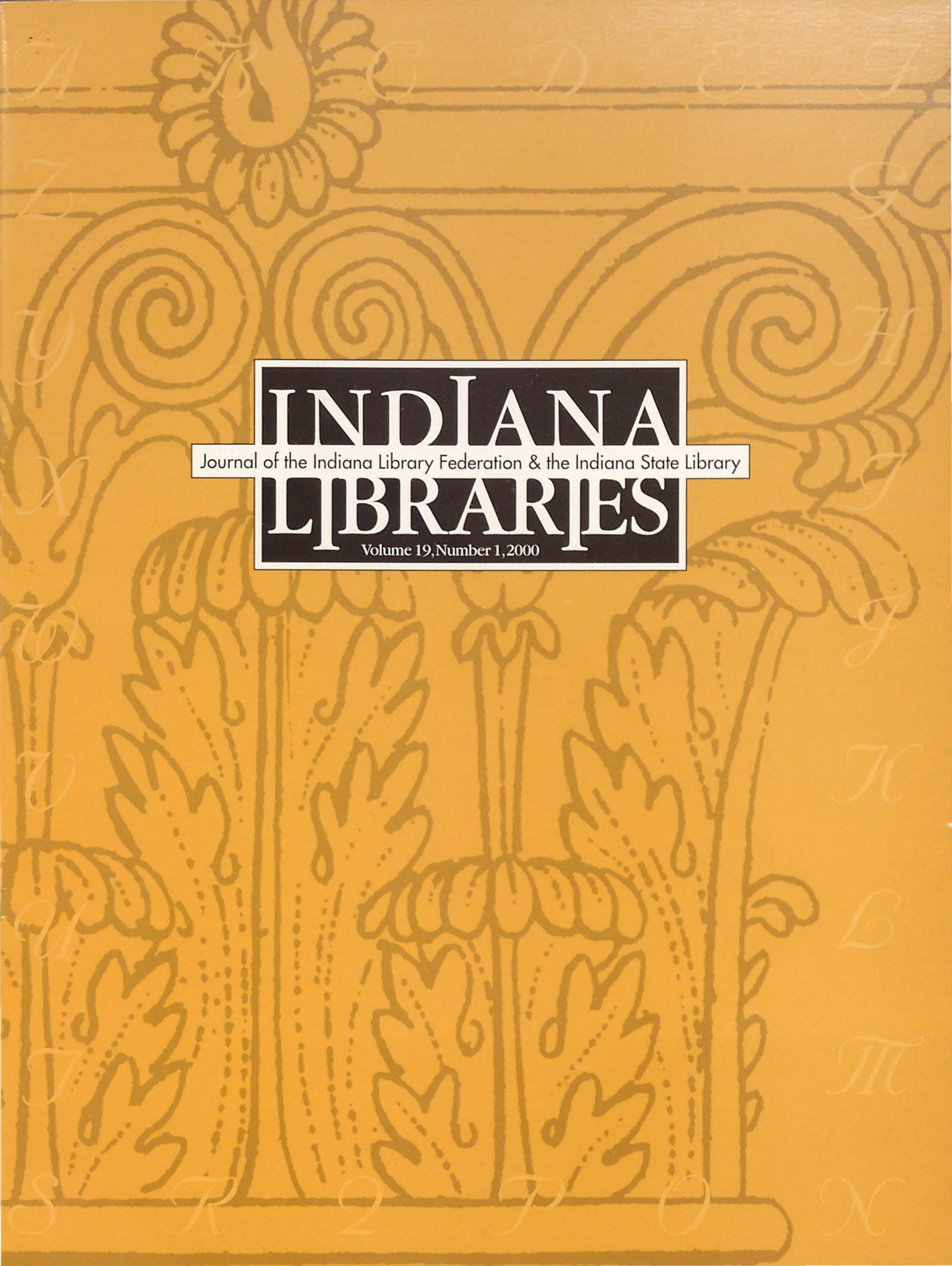

INDIANA LIBRARIES

Journal of the Indiana Library Federation & the Indiana State Library

Volume 19, Number 1, 2000

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C O N T E N T S

INDIANA LIBRARIES

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Editor:
Sara Anne Hook, Associate Dean of the Faculties and Professor of Dental Informatics, IUPUI

Managing Editor:
Patricia Tallman, Indiana Library Federation

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Advertising and Subscription Offices:
Indiana Library Federation
6408 Carrollton Avenue
Indianapolis, Indiana 46220
Phone: (317) 257-2040
Fax: (317) 257-1389
Web Page: www.ilfonline.org
E-Mail: ilf@indy.net

INTRODUCTION

by Sara Anne Hook,
Associate Dean of the Faculties and
Professor of Dental Informatics, IUPUI

Guest Editor

This issue originated with a "call" for Guest Editors that appeared in *Focus on Indiana Libraries*. One of my primary areas of research is intellectual property law. Initially, I hesitated in even preparing a proposal, wondering whether this topic would be of interest to the Indiana library community. A meeting with the ILF Publications Committee proved that this concern was unfounded and that there was strong support for an issue that would highlight the impact of copyright, trademark, and patent law on library services and operations.

My premise for the issue is that all librarians need to know something about intellectual property law. Copyright law has moved to the forefront of library management, with the Internet and other technologies impacting a variety of library operations, including interlibrary loan, web site creation, collection development, electronic reserves, and database access. However, there are other reasons for librarians to be aware of intellectual property law. Support for technology transfer will be an important role of academic librarians in the future. According to a recent press release from the Association of University Technology Managers (AUTM), "more than $33.5 billion in economic activity and 280,000 jobs are directly attributable to the commercialization of academic research in 1998." [1] Public librarians may be asked questions about searching and applying for trademarks and patents, as public libraries become even more crucial resources for entrepreneurs and small businesses. Special librarians, particularly those in the corporate arena, must always stay current on intellectual property law matters. School librarians, academic librarians, and media specialists must be aware of changes in copyright law, particularly as their institutions become more involved in the development of multimedia, web-based curricula, and distance learning. Teachers, faculty members, and administrators may turn to the librarian in these settings for the latest in copyright information. Librarians in all types of libraries have the unique opportunity to educate their users about intellectual property law, particularly copyright. Through this education, librarians may be helping their organizations to avoid litigation, dispelling myths that everything on the Internet is public domain and that proper citation is enough to satisfy copyright law.

For this issue, I first invited librarians from around the state with expertise in intellectual property matters to contribute articles. A "call for papers" appeared in *Focus*. This methodology generated interesting and practical articles on e-reserves, copyright in collection development, patent searching, and trademark searching. Kenneth Crews graciously contributed an article on the history of the Copyright Management Center at IUPUI. Then the direction for the issue became more expansive. I attended the Midwestern Intellectual Property Law Symposium in August and heard a number of outstanding presentations on the development of automated systems for better processing of patent, trademark, and copyright applications, as well as on the Digital Millennium Copyright Act. Even though the timeframe was short, Fred Cate, Indiana University School of Law – Bloomington, Craig Morris, U.S. Patent and Trademark Office, and Mary Levering, U.S. Copyright Office, readily agreed to provide articles based on their presentations from the Symposium.

I hope this issue helps you to better understand the intricacies of intellectual property law and how they affect our services and our patrons.

NOTE

1. Academic Research Drives U.S. Economy. Press Release, Association of University Technology Managers (AUTM). December 2, 1999.

U.S. COPYRIGHT OFFICE -- CORDS ELECTRONIC COPYRIGHT REGISTRATION AND DEPOSIT

by Mary Levering
Associate Register for National Copyright Programs
U.S. Copyright Office
Library of Congress
Washington, DC 20540

INTRODUCTION

What do all of the following have in common?

- Michael Cunningham's Pulitzer Prize award winning book, *The Hours*
- The screenplay for *Star Wars: The Phantom Menace*
- Episodes of the TV show, *Judging Amy*
- Volume 340 of the *New England Journal of Medicine*
- *The Greatest Generation* by Tom Brokaw
- Recent illustrations in the popular Harry Potter series of children's books
- 2-dimensional artwork and text for *Pokemon* cards and toys
- Choreographic works by Merce Cunningham
- *The Endurance: Shackleton's Legendary Antarctic Expedition* by Caroline Alexander
- Songs by the group Santana from the acclaimed album, *Supernatural*
- Volume of 129 of *Chemical Abstracts* from the American Chemical Society
- Microsoft's *Access 2000* computer program

One answer is that they were all submitted during 1999 with copyright claims to the U.S. Copyright Office for copyright registration and deposit.

MISSION OF THE U.S. COPYRIGHT OFFICE

The U.S. Copyright Office's mission is to promote creativity in society by administering the U.S. copyright law. One of the many ways the Office fulfills its statutory mandate is to create and maintain public records of copyrighted works through registering claims to copyright and recording documents relating to copyright.

In fulfilling its mission, the Office's vision is to advance creativity and widespread dissemination of copyrighted works in society by creating and maintaining the copyright records of the United States as the most useful, timely and accurate copyright records system in the world. In addition to fulfilling its primary mission, the Office's copyright registration and deposit process also contributes valuable works to the comprehensive collections of the Library of Congress for the benefit of all researchers who rely on the riches and treasures in the Library's preeminent research collections, a great national resource that is widely recognized as the largest accumulation of knowledge in human history.

BENEFITS OF COPYRIGHT REGISTRATION

When a writer creates an original work of authorship, it is automatically protected under U.S. copyright law. Although registration of copyrighted works is not mandatory, there are strong statutory incentives and significant benefits that result for authors and copyright owners who do register their claims to copyright with the U.S. Copyright Office and deposit a copy (or copies) of the work. Registration establishes a national public record of the copyright claims and also helps users to locate owners or agents to request permission for subsequent uses. The resulting copyright records are also incorporated into the Copyright Office's national database of copyright registration records, which have been available online since 1978 and over the Internet since 1993.

Furthermore, before an infringement suit may be filed in U.S. courts, registration is essential for works of U.S. origin. If the registration takes place within five years of first publication of a work or while the work is unpublished, the *Registration Certificate* that the Copyright Office issues carries many valuable benefits. The certificate is *prima facie* evidence in a U.S. court of the copyrightability of a work, as well as of the facts stated in the certificate of registration, such as the author's name, the name of the owner of the work, and the date of publication.

Additionally, if the registration is made before the work is infringed or within three months of first publication, then registrants have even more powerful tools available to enforce their rights, since they may seek statutory damages and attorney's fees in successful infringement suits. (Otherwise, only actual damages and the infringer's profits are available to the copyright owner, to the extent that damages and profits can be

proven.) The Copyright Office also certifies copies of registered works; this certification states that the copy is an exact reproduction of the work that was registered.

COPYRIGHT REGISTRATION AND DEPOSIT

Each year the Copyright Office registers almost 600,000 copyright claims for about 1,000,000 works of authorship submitted by creators and publishers from all over the world (*594,501 registrations in FY '99*). These include a dazzling array of books, serials, musical works and sound recordings, graphic images and photographs, multimedia works and motion pictures, television broadcasts, computer programs and more, representing both scholarly research and popular culture. The Office also records copyright-related documents pertaining to transfers of copyright ownership, including assignments, licenses, security interests and others.

As part of its commitment to promote creativity, the Office aims to make copyright registration easy and affordable to all by keeping filing fees as low as possible, making forms and instructions easily accessible, and simplifying the process as much as is feasible. The Office provides a wide variety of informational materials, including circulars such as *Circular 1, Copyright Basics*, copyright application forms, fact sheets, and other publications, along with public information and reference services concerning copyrights, freely available from its Public Information Office. The Copyright Office website <www.loc.gov/copyright> also offers informational circulars and many other sources, as well as online, fill-in versions of most copyright registration forms and the Document Cover Sheet (which should be used when submitting copyright-related documents for recordation). Applicants for copyright registration or recordation of copyright-related documents may select the proper form online and key the information directly onto the form instead of having to print the blank form first and then complete it by hand or typewriter. After the form has been filled in, the applicant should then print it and mail it to the Copyright Office, together with the deposit of the work and the filing fees. The basic filing fee for copyright registration claims is currently $30 per claim, as of July 1, 1999.

The Copyright Office also maintains a system of Deposit Accounts for the convenience of those who frequently use its services. Individuals or firms may establish Deposit Accounts and make advance deposits of funds into their accounts for payment of services requested in the future. Information about how to open and maintain a deposit account with the Copyright Office is contained in *Circular 5*. For more information on Copyright Office services and fees, check the Copyright Office website or call the Copyright Public Information Office at 202-707-3000.

Today increasing numbers of copyrighted works are being made available online in electronic form. Global communication networks offer authors and publishers instantaneous delivery of their works to all parts of the world. These same technological marvels also offer unprecedented opportunities for infringement and unauthorized exploitation. Copyright registration is one of the valuable tools available to help creators and owners protect their online works and benefit from their creations.

REGISTERING ONLINE WORKS

Currently, all copyright claimants can register online works using the Office's traditional paper/hardcopy-based registration procedures by following the instructions in *Circular 66, Copyright Registration for Online Works,* which explains how to register online works. Claimants can access this *Circular*, as well as dozens of other informational circulars addressing specific copyright topics, on the Copyright Office website.

Online works represent various types of authorship, similar to other types of authorship registered by the Office, including graphic arts, text, and audiovisual material. The Office examines these, using the same standards of copyrightability and looking for clear facts of authorship, ownership and the extent of the claim. But there are significant differences in online works that frequently have dynamic features, often changing every few minutes. Traditional works submitted for copyright registration are usually static and the physical deposit copy clearly defines what the work is. With many online works, however, there is no tangible copy produced and it is often a challenge to fit some online works, such as websites and multimedia productions, into traditional categories. Furthermore, using the Office's traditional procedures to submit claims in online works means that the claimant must submit the completed application form on paper, together with the work in some physical format, such as a disk or print-outs of the work, and send these to the Copyright Office by postal mail or other delivery means.

The Office's innovative new system — CORDS — will permit fully electronic submissions of claims and deposits of works in the future.

CORDS

Since 1993 the U.S. Copyright Office has been developing **CORDS**, ***(*the *Copyright Office Electronic Registration, Recordation and Deposit System)***, a fully automated system for electronic copyright registration and deposit. Copyright claims can be filed through CORDS by sending applications and deposits in electronic form and charging fees to active Deposit Accounts with the Copyright Office. The CORDS system

facilitates full electronic processing, both front-end preparation by claimants and back-end processing by the Copyright Office. The Corporation for National Research Initiatives (CNRI) has developed and successfully tested the CORDS prototype system under agreement with the Copyright Office, the Library of Congress and the Defense Advanced Research Projects Agency (DARPA), as part of DARPA's digital library initiatives. CNRI is a not-for-profit organization formed in 1986 to foster research and development for the National Information Infrastructure. Its goals include a program of research to identify and nurture infrastructure technologies and services that unlock the potential of information and knowledge, along with technology itself, in collaborative activities with universities, private organizations and government agencies, such as the U.S. Copyright Office and the Library of Congress.

The CORDS system, developed by CNRI, now accepts electronic filings from cooperating CORDS test partners for copyright claims and deposits in a number of widely accepted file formats (including HTML, ASCII and PDF files) for several different types of literary works, including electronic journals, technical reports, training manuals, computer programs, and eBooks, as well as musical works with MP3 files as deposits. CORDS development and expansion is continuing for other types of works in digital form as well.

The overall goal of CORDS is to implement a fully automated system, available to the public as well as to the copyright industries, for electronic copyright registration with copyright applications, copies of works, and copyright-related documents transmitted in digital form over communications networks such as the Internet. CORDS also enables the Copyright Office to process and store these submissions electronically and make the digital works available for selection and retention by the Library of Congress for its digital collections.

The Copyright Office and the Library of Congress will also cooperatively establish the policies and operating procedures necessary for both the Office and the Library to maintain the electronic works in digital repositories and to store, retrieve, and use digitized copyrighted materials in accordance with the law and the terms and conditions of access and use established by copyright creators and owners.

CORDS OBJECTIVES

The Copyright Office has four major objectives in implementing CORDS: (1) to make it much easier and faster for copyright applicants to submit their claims and deposits of their works for registration; (2) to control costs and operate more efficiently on behalf of Copyright Office and copyright claimants through the effective use of technology; (3) to enhance the Office's relationship with its customers and to enable creators and owners of online works to submit these works electronically, without the cumbersome limitations of the paper-based registration and deposit procedures, and (4) to facilitate streamlined back-end processing of electronic claims by enabling staff to examine claims and works, issue registration certificates, and prepare copyright records faster and more efficiently by fully automated means. The Internet is helping the Copyright Office accomplish all four goals.

TECHNICAL REQUIREMENTS FOR CORDS PARTNERS

CORDS partners need Netscape 3.0 or higher or MS Internet Explorer 4.0 to access the CORDS applications forms on the CORDS website. The CORDS software and Helper Application are freely available from the CORDS website to CORDS test partners. This allows claimants to prepare and sign copyright applications digitally, using public key/private key encryption technology embedded in the CORDS software (for the Copyright Office to verify the authenticity and integrity of submissions), and to send claims and accompanying deposits securely to the Copyright Office using the latest version of privacy-enhanced mail. Basic instructions are incorporated in the CORDS software, describing deposit requirements for electronic works. The CORDS system sends electronic acknowledgments to claimants and has email correspondence capabilities as well. The CORDS system also provides a batch processing capability for more efficient system-to-system submission of claims and deposits. All CORDS electronic claims and deposits are stored securely behind the Copyright Office firewall and are accessible only to authorized Copyright Office staff or on-site in accordance with the Copyright Law.

CORDS TEST PARTNERS

Since the 1996-97 successful proof of concept of the CORDS testbed with the first CORDS test partners, Carnegie Mellon University and Stanford University (for electronic technical reports) and MIT Press/Journals Division (for eJournals), the Copyright Office has continued to make systematic progress in CORDS testing and development with a growing number of external CORDS test partners. Almost 15,000 claims (14,993) were received and processed electronically through CORDS during 1999.

CORDS utilizes many new technologies involving emerging uses of the Internet, including applying digital signature technology that authenticates the source and ensures the integrity of communications with far more depth of reliability and security built into it than basic FTP or email communications-based systems. CORDS participants represent users with all

different types of platforms, each with a different technology infrastructure supporting its own individual organization. This affects how each one submits copyright claims, deposits and email correspondence securely through CORDS. Because of these factors, as well as the new technologies involved in CORDS, the CORDS development team is addressing as many of the endless technical variables as possible, while testing web-based transmissions of CORDS applications, deposits and secure email with a wide variety of test partners. In bringing on additional test partners, the major goal has not been to achieve a high volume of receipts initially, but rather to work with a gradually increasing variety of different partners in order to learn, adapt and enhance the system by working closely with each new partner on a one-to-one basis while strengthening and scaling the system for later high-volume wide-scale usage.

CORDS also successfully implemented system-to-system submissions during 1999, with high-volume processing of thousands of claims in doctoral dissertations and masters theses in partnership with Bell & Howell Information and Learning (formally UMI Company). In 2000, the Copyright Office is initiating another major CORDS partnership with the Harry Fox Agency, a subsidiary of the National Music Publishers Association, for electronic submissions of claims and deposits of musical works on behalf of music publishers. Other CORDS partnerships are being planned and developed as well.

MIXED CORDS

The Copyright Office recognizes that many publishers and producers are not ready to deposit their works online and the Library of Congress is also not ready yet to accept digital versions as archival copies for many types of works. Therefore, the Office is developing ***Mixed CORDS*** *(electronic applications with hard-copy deposits)*, including various print formats, CDs, CD-ROMs, motion pictures and so on. Mixed CORDS offers the benefits of CORDS electronic filing, with savings in time and effort in preparing copyright applications. Mixed CORDS also enables faster processing by the Copyright Office, helps the Office expand the CORDS system gradually, proves its viability, and ultimately benefits all copyright industries as well as the Copyright Office.

CORDS IMPLEMENTATION

The Office is trying to make the CORDS website both functional and attractive. The CORDS Helper software, including electronic forms, is freely available from the CORDS website for CORDS test partners and will be freely available later for all CORDS users. Claimants are asked to identify the nature of the work they want to submit — text, images, computer programs, serials — and then they are taken directly to instructions and application forms aimed specifically for their needs.

Claimants can make changes to their online applications before claims are finalized with a digital signature more easily than they can in preparing copyright claim forms on paper. On the CORDS website, they can use hypertext links to access appropriate background information in Copyright Office circulars or instructions and to answer copyright-related questions raised as they proceed, such as the meaning of the terms "work-made-for-hire" or "publication." CORDS' sophisticated online site includes many pages of detailed copyright information, easily accessible through dozens of hypertext links.

The CORDS electronic claim process has been specially adapted for large customers who file hundreds or more claims a year. It also supports claimants who file less frequently and may need more explanation and assistance as they proceed to complete CORDS claims online. In the future, CORDS will permit claimants to check on the status of their claims while in process, as well as to use other payment mechanisms such as credit cards.

The Copyright Office is making the CORDS online registration and deposit system an integral part of its overall operation and its services for the future. High quality customer service is an important goal of the Copyright Office. CORDS helps the Office provide better and faster service to its customers. The Office has created a focused team to build the web-based CORDS operation, people who are dedicated to the goals of the copyright system, the Office, and its mission of providing effective support for copyright creators and publishers, as well as the public that relies on its copyright records. While only a handful of the Office's 500-plus employees are dedicated full-time to CORDS web-based operations at this time, many people throughout the Copyright Office contribute information and expertise to CORDS system development and operation. The Copyright Office is embracing CORDS as a fundamental part of its copyright registration and deposit operations in order to enjoy and share the full range of benefits that result.

BENEFITS OF CORDS

When fully implemented, CORDS will offer publishers and other copyright claimants more efficiency through electronic filings, saving time and effort in preparing and transmitting copyright claims and deposits. CORDS processing helps the Copyright Office save time, speed processing, better assist copyright claimants, communicate by email to resolve examiners' questions regarding claims, and avoid

future costs. The CORDS system also enables faster processing by the Copyright Office and more secure handling of deposits. CORDS automatically charges claimants' Deposit Accounts for claims, creates in-process tracking records, and prepares preliminary catalog records. CORDS permits streamlined processing by Copyright Office staff in examining new works, issuing registration certificates, completing copyright catalog records, and publicizing cataloging records in the Office's online databases.

Workload and time spent opening, bundling and moving claims for manual processing are greatly reduced, with increased security and efficiency in operations. Time and effort spent by data entry personnel to create tracking records for claims received and to prepare preliminary copyright catalog records are eliminated by the automatic population of data by the CORDS system into the Copyright Office's other major systems. Both copyright claimants and the Copyright Office realize significant benefits when claimants use CORDS to file copyright claims and deposits.

FOR FURTHER INFORMATION

For additional information about copyright registration and CORDS, visit the Copyright Office homepage at <www.loc.gov/copyright>. Frequently requested Copyright Office circulars, announcements, regulations, other related materials, and all copyright application forms are available via the Internet. Copyright Office circulars and other information (but not application forms) are also available by using a touchtone phone to access *Fax-on-Demand* at (202) 707-2600.

For general information about copyright, call the Copyright Public Information Office at (202)707-3000. The TTY number is (202) 707-6737. Information specialists are on duty from 8:30 a.m. to 5:00 p.m., eastern time, Monday through Friday, except federal holidays. Recorded information is available 24 hours a day. Specific application forms and circulars may be requested from the *Forms and Publications Hotline* at (202)707-9100 24 hours a day; leave a recorded message.

For more information about CORDS, see the Copyright Office website or visit the CORDS website at <www.CORDS.loc.gov>. To inquire about collaboration with the U.S. Copyright Office in a CORDS test partnership, contact the Associate Register for National Copyright Programs at (202) 707-8350.

SUMMARY

CORDS enables creators to register their copyrighted works more efficiently by allowing them to prepare and transmit both the application and the accompanying works in digital form, with resulting registration information incorporated into the Copyright Office's national online database of copyright registration records.

CORDS helps the Copyright Office achieve greater productivity, process an increasing number of copyright claims on a timely basis, and provide faster and better service to copyright claimants and the public.

CORDS enables the Library of Congress to acquire new copyrighted works in electronic form for its digital collections for use by the Congress and Library of Congress patrons, with access to the works available only in accordance with the law and authors' or copyright owners' terms and conditions.

CORDS will allow copyright owners and agents to record electronically documents pertaining to transfers of copyright ownership (such as assignments, licenses, and security interests), which are also accessible in the Copyright Office's national online databases.

REFERENCES

U.S. Copyright Office. *Copyright Act of 1976*, as amended.

<www.loc.gov/copyright/title17/>

[U.S. Copyright law. 17 U.S.C. §§ 101, et seq.]

U.S. Copyright Office. *Copyright Basics.* Circular 1,1996. 12 pp.

<www.loc.gov/copyright/circs/>

[Circular 1 provides general information and answers basic questions that are frequently asked about copyright.]

U.S. Copyright Office. *Copyright Registration for Online Works.* Circular 66,1998. 4 pp.

<www.loc.gov/copyright/circs/>

[Circular 66 provides instructions for copyright registration of online works, using the traditional process of submitting paper claims and using identifying material as the deposit.]

U.S. Copyright Office. *Copyright Office Website.*

<www.loc.gov/copyright/>

[Most of the information published by the U.S. Copyright Office on paper is also available for viewing and downloading from the Office's website and gopher site, including information circulars, federal copyright

regulations, the Register's testimony, the Office's recent major reports, copyright application forms, and access to Copyright Office records from 1978. To access Copyright Office online databases of copyright records, use <telnet: locis.loc.gov>.]

U.S. Copyright Office. *CORDS Brochure & Description Flowchart.* 2 pp.

<www.loc.gov/copyright/CORDS/>

[Some CORDS background information is available on the Copyright Office website, including the CORDS brochure and a graphic depicting the CORDS system.]

U.S. Copyright Office. *CORDS Website.*

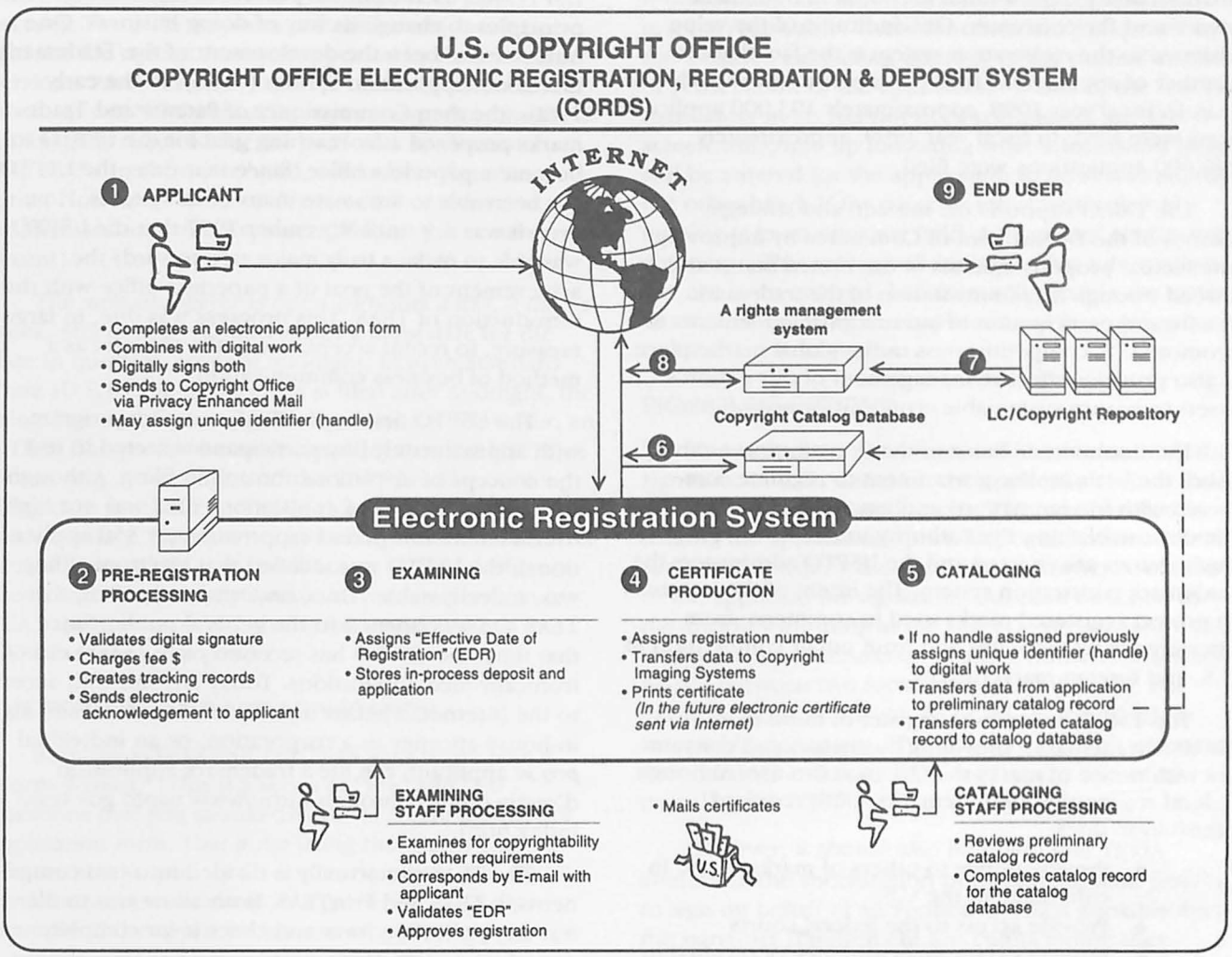
<www.CORDS.loc.gov>

[The CORDS website provides detailed instructions to CORDS test partners on how to submit copyright claims and deposits electronically using the CORDS system.]

U.S. Copyright Office. *NEWSNET Listserv.*

<www.loc.gov/copyright/newsnet>

[Newsnet is an electronic mailing list from the U.S. Copyright Office that sends periodic email messages, which alert subscribers to congressional and other hearings, new regulations, publications and other copyright-related subjects.]



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OVERVIEW OF THE TRADEMARK EXAMINING OPERATION

by Craig Morris, Manager
Trademark Business Process Reengineering
U.S. Patent and Trademark Office
2900 Crystal Drive
Arlington, VA 22202

The Trademark Examining Operation (TMEO) is crucial to accomplishing the mission of the United States Patent and Trademark Office (USPTO), administering trademark laws that assist businesses in protecting their investments, promoting goods and services, and safeguarding consumers against deception in the marketplace. Trademarks, as intellectual property, have financial and practical value for both the trademark owner and the consumer. One indicator of the value assigned to the registration system is the fact that the number of applications filed continues to grow each year. In fiscal year 1998, approximately 193,000 applications were filed. In fiscal year 1999, approximately 240,000 applications were filed.

The TMEO supports the mission and strategic themes of the Department of Commerce by improving intellectual property systems in the United States and abroad through its administration of the trademark statute and participation in international agreements to promote U.S. competitiveness in the global marketplace. It also provides effective management of our nation's assets to ensure sustainable economic opportunities.

The Commerce Clause of the Constitution establishes the basis for the government to regulate commerce with foreign nations and among the states, thereby establishing the authority under which trademark statues are enacted and the USPTO administers the trademark registration system. The intent of the statute is to protect registered marks used in commerce from interference by the states and from unfair competition in U.S. and foreign marketplaces.

The TMEO maintains a register of more than 900,000 trademarks, providing businesses and consumers with notice of marks that are in active use. Although federal registration of trademarks is not required, registration does:

- Provide notice to others of marks in use in commerce in the U.S.
- Provide access to the federal courts
- Provide *prima facie* evidence of ownership
- Provide access to anti-counterfeiting statutes
- Permit enforcement of rights
- Provide a basis for foreign filing

THE TRADEMARK ELECTRONIC APPLICATION SYSTEM (TEAS)

BACKGROUND

In order to meet the growing demands placed on the TMEO by dramatic increases in filing levels, the USPTO has used business process reengineering principles to change its way of doing business. One outcome has been the development of the Trademark Electronic Application System (TEAS). In the early 1980s, the then Commissioner of Patents and Trademarks proposed a far-reaching goal for the USPTO to become a paperless office. Since that time, the USPTO has been able to automate many of its systems. However, it was not until November 1997 that the USPTO was able to make a truly major step towards the achievement of the goal of a paperless office with the introduction of TEAS. This progress was due, in large measure, to recent acceptance of the Internet as a method of business communication.

The USPTO first began TEAS as a pilot program, with approximately fifty participants selected to test the concept of operations for online filing. Although the overall number of applications filed was not high over a ten-month period (approximately 350 applications), the USPTO was satisfied that electronic filing was, indeed, viable. Thus, on October 1, 1998, the TEAS site was opened to the general public. Since that time, the USPTO has received over 23,000 electronically-filed applications. Today anyone with access to the Internet, whether an attorney in a law firm, an in-house attorney in a corporation, or an individual *pro se* applicant, can file a trademark application directly online, through http://www.uspto.gov/teas/index.html.

The TEAS site actually is divided into two components, e-TEAS and PrinTEAS. Both allow you to fill out an application form and check it for completeness over the Internet. Using e-TEAS you can then submit the application directly to the USPTO over the Internet, paying by credit card or through an existing USPTO deposit account. On the other hand, through

PrinTEAS you can print out the completed application for mailing to the USPTO, paying by check, money order or through an existing USPTO deposit account.

TEAS gives step-by-step instructions for completing a trademark or service mark application form properly—the site features "links" to help information at the bottom of the form, which can be accessed for any particular section. It also provides access to a wide variety of information about USPTO procedures and practices. Although the different sections of the forms may appear straightforward and easy to fill out, the USPTO strongly encourages applicants to read the HELP instructions very carefully for EACH section PRIOR to actually completing it. Failure to follow this advice may cause sections of the form to be completed incorrectly, jeopardizing legal rights.

There are some basic technical requirements for using the system: TEAS works only if you use either Netscape Navigator (Version 3.0 or most recent) or Microsoft Internet Explorer (Version 4.0 or most recent). The e-TEAS system utilizes frames, JavaScript, and the file upload feature supported by these browser versions. Also, Internet Explorer on the Macintosh platform will NOT permit a proper image attachment, if an image is required for the particular application. PrinTEAS, on the other hand, works best if you use either Netscape Navigator (Version 3.0 or most recent) or Microsoft Internet Explorer (Version 4.0 or most recent).

The web site server is open 24 hours a day, 7 days a week, 365 days a year and issues a filing date for the date in question up until midnight, Eastern Standard Time (U.S.). If an application is filed after midnight, the filing date is the next regular business day. However, an e-TEAS filing *could* be made on a day that the USPTO is closed (e.g., Saturday), and the USPTO will accord a filing date for that day (rather than the next regular business day). Please note, however, that there is a brief period, from 12:01 a.m. until 6 a.m. Monday, when credit card transactions cannot be processed, so an e-TEAS application could not be fully submitted to the USPTO during that period.

THE FORM WIZARD AND APPLICATION

Both the e-TEAS and PrinTEAS sites begin with a "Form Wizard." This is a series of "Yes" and "No" questions that you should answer to create the proper application form. That is, by using the "Form Wizard," you are able to pull up an application form that ONLY contains sections relevant to a particular filing. For example, if the applicant is a *pro se* applicant, by answering "No" to the question asking "Is an attorney filing this application," the form that will be pulled up after answering all questions on the "Form Wizard" and clicking the NEXT button will NOT include an Attorney Information section. However, if a "complete" form is needed, there is an option to select "Standard Form," which includes ALL possible sections.

Once the form comes up, entries are simply made in the appropriate boxes. There are five (5) fields that are delineated with a red asterisk. These are the "mandatory" fields that must be completed, under the terms of the Trademark Law Treaty Implementation Act of 1998 (TLTIA), to receive a filing date. Although the other fields are optional, in terms of receiving a filing date, the USPTO encourages you to complete ALL fields for which you have the necessary information, to avoid later delays in the prosecution of the application.

When the form is completed, there is a Validate Form button. This validation function will permit the USPTO to check whether information has been entered in particular fields. It is not, however, in any way checking the validity of the information entered, nor is it performing any sort of search to see whether the mark is registrable. These functions are performed by the assigned examining attorney in the normal course of prosecution of the application. If one of the five (5) mandatory fields has not been completed, an "error" screen will come up indicating what information must still be entered for the application to be submitted. On the other hand, if the piece of information that is missing is in an optional field, a "warning" screen will come up. This screen will indicate what information has not been entered, but then will provide the option of either submitting the application as is or going back to enter any missing data.

SIGNATURE OPTIONS

Many attorneys are concerned about obtaining the signature of their client on the application when the client is located in another city. This was handled by making the application "portable," which means that it can be filled out by the applicant's attorney, e-mailed to the applicant for signature, and then returned to the attorney for filing at the USPTO. The signature that is used is any combination of alpha-numeric characters placed between two forward slash symbols (/). For example, /john smith/ or /js/ or /s123/ would all be acceptable signatures. This is totally at the discretion of the signatory and does NOT require any sort of approval by the USPTO.

However, it should also be noted that TLTIA eliminates the specification of the appropriate person to sign on behalf of an applicant, which arguably made the signature requirement less cumbersome after October 30, 1999. Under TLTIA, the appropriate person to sign the form is:

1. a person with legal authority to bind the applicant; or
2. a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the applicant; or
3. an attorney who has an actual or implied written or verbal power of attorney from the applicant.

If there are joint or multiple applicants, or if it is corporate policy to have two or more officers sign the application for one applicant, each must sign and provide the relevant information.

IMAGE ATTACHMENT

Another major concern is how to apply electronically for a mark that is in a stylized format and/or an application that is filed based on Section 1(a), actual use in commerce, for which you want to submit the specimen (sample) of how the mark is being used, e.g., a tag or label for goods or an advertisement for services. For either of these, you must attach an image file in the GIF or JPG file format. These are the only two formats that the USPTO currently will accept. This requires that you "scan" or take a digital photograph of the specimen. If you cannot do so, then you could use the PrinTEAS option and mail the printed application to the USPTO.

Please note that due to technical limitations within the browsers now available, and to simplify the process and prevent possible errors, where you are filing an application with 1) a mark image file (in JPG or GIF format, to show the mark in a stylized manner or a design); and/or 2) a specimen image file (in JPG or GIF format, to show the mark as actually used in commerce), neither of these image files will be available for viewing or printing an application that was previously downloaded and saved. Either or both of these image files will need to be re-attached to the application before final submission to the USPTO.

VALIDATION

Once the application is properly validated, you may check the information entered on the form, in one of two formats. You can either use the icon for the "scannable format," which would show all of the information entered converted into a data tag format (e.g., <NAME> John Jones). You could also use the "Input" format, which presents the data in a table or chart format, which some users find easier to read. You can also check the drawing page, which will show the mark for which registration is being sought (either words alone or a stylized presentation and/or design element, based on the attached GIF or JPG that was attached). The specimen image file can also be viewed to ensure that it has "loaded" properly. You should print out each of these pages for your records by using the print function within your browser.

If you discover any errors, you would use the Go Back to Modify button to re-enter the proper information. Upon re-entry, the application must be re-validated. It is critical that the information be checked completely before submission, because once you submit an application, either electronically or through the mail, the USPTO will not cancel the filing or refund your fee, unless the application fails to satisfy minimum filing requirements. The fee is a processing fee, which is not refunded even if the USPTO cannot issue a registration after a substantive review.

After a successful validation, you may save the file to your choice of drive and directory, using the Download Portable Form button at the bottom of the Validation Screen and the SAVE function within your browser. Once you have saved an application in this manner, you can then use it as you would any other file, i.e., opening it again for additional review and/or attaching it to an e-mail message to transfer it to another person and/or location. The portable form could also be used to save out a template if you plan on doing multiple filings.

If you transfer the file to another person via an e-mail message, the recipient of the message can (as long as the recipient has a compatible web browser) simply save the attachment to a local drive and directory and then open it from within his or her web browser for review (and "signature" if that person is the appropriate person to sign on behalf of the applicant).

The recipient can then make changes to the application and/or sign it (if that person is the appropriate person to sign on behalf of the applicant) and save the changes and/or signature using the same "Download Portable Form" button and SAVE functions used originally to save the application. Once an application has been signed and saved in this manner, it can then be returned to the applicant's attorney via e-mail for actual filing with the USPTO. Each time a new party accesses the form, it must be re-validated in order to reach the page that will allow either the save function or the Pay/Submit function.

PAYMENT

If you are ready to submit the application, you would click on the Pay/Submit button. If you are paying by credit card, this will bring up a screen asking standard questions regarding the credit card payment (card number, expiration date). The USPTO accepts MasterCard, Visa, American Express, and Discover. Once all of the required information is entered, the application is submitted to the USPTO. If paying

through an existing UPSTO deposit account, hitting the Pay/Submit button will immediately submit the application to the USPTO.

Upon successful receipt of an electronically-filed application by the USPTO, within the same session you will see a screen that says "SUCCESS! We have received your application and assigned serial number _____." If you do not see this screen, the USPTO did NOT receive the application. You will also receive a separate e-mail confirmation within 24 hours that will include the same serial number, as well as a summary of the information entered in the application (although if the mark consists of stylized wording and/or a design, this will not be bounced back, nor would any specimen image—this is why you should print out a hard copy of these pages, as accessed through the icons on the validation page, before actual submission).

CORRECTING ERRORS

If you determine after submitting your application that you made an error in the information you entered, DO NOT request via e-mail that we correct your filing. The application is considered officially filed as submitted and the TEAS staff cannot make any changes. This is why you must carefully review the information before hitting the Pay/Submit button. To attempt to correct an error discovered after submission, you must send a hard copy (not electronic) preliminary amendment to the following address:

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202

There is no set "form." On a piece of paper, you would use the heading of the MARK and the SERIAL NUMBER, followed by the caption PRELIMINARY AMENDMENT, and then the request (i.e., please change X to Y). Please note that the examining attorney will determine whether the requested changes are acceptable (for example, if you made a major error in your mark, and want the mark changed to something else, this most likely would NOT be acceptable). Also, you should wait one month before submitting the request, in order to allow the case file to get to the proper office (so that your paper could be properly matched with the file).

Once received by the USPTO, a paper copy of the electronic filing is generated (since, at this time, the bulk of work in the USPTO is still done in a paper format). Assuming that, upon review of the filing by the Pre-Examination section, all minimum filing requirements have been satisfied, the user will receive an official paper filing receipt via regular U.S. mail approximately 40-50 days after submission of the application. If, on the other hand, the minimum filing requirements have not been satisfied, the USPTO will return all papers to the applicant and refund the filing fee. This is not the scenario when minimum filing requirements have been satisfied; once examined by the examining attorney, papers are not returned and fees are not refunded, even if the examining attorney determines that the mark cannot be registered.

For general trademark information, please telephone the Trademark Assistance Center at 703-308-9000. For automated status information on an application that has an assigned serial number, please telephone 703-305-8747, or check the USPTO status server at http://tarr.uspto.gov/. Please note that the Trademark Application and Registration Retrieval System (TARR) site will, in addition to providing current status information, list the current owner of the mark, the goods and/or services, and the full prosecution history of the application or registration. You may wish to perform a search to see if there is a federal registration or pending application for a similar mark used on related goods and/or services. Please see http://www.uspto.gov/tmdb/index.html.

If you need help in resolving glitches or need answers to technical questions, you can send an e-mail to PrinTEAS@uspto.gov. Please include your telephone number, so someone can contact you directly, if necessary. However, please do NOT use this e-mail for general questions (again, please call the Trademark Assistance Center at 703-308-9000). The front page of the TEAS site also includes links to Frequently Asked Questions about Trademarks and a "Bug Report" to alert the USPTO of any technical problems.

ADVANTAGES OF ELECTRONIC FILING

Electronic filing has many advantages over filing on paper via mail or express delivery services, including:

- a dramatic increase in the speed with which applications can be filed;
- the ability to receive a filing date up until midnight Eastern Standard Time, rather than an earlier time (often 5 p.m.) — which is the case using the U.S. Postal Service Express Mail certificate procedure;
- substantial savings on Express Mail postage, fax charges or courier delivery costs, because electronic applications are created, reviewed, and filed electronically using the Internet; and
- more efficient review of the applications because they are in a standard format recommended by the USPTO.

Because electronic applications can be prepared and passed around via e-mail almost instantaneously, the speed for filing can increase dramatically. For

example, a large multinational corporation based in Europe that has used the system extensively has cut the average time to file an application from five to seven working days to less than two. In the past, they drafted applications on a word processor in the United States, e-mailed them to Europe to be printed out, signed, and faxed or mailed them back to their U.S. office to be filed at the USPTO. Their e-TEAS applications are filled out by counsel in the U.S., sent via Internet e-mail to Europe, signed electronically, and returned to counsel in the U.S. for immediate filing. In one urgent situation, an application was drafted in the U.S., sent via e-mail to Europe, signed, returned, and filed at the Trademark Office, all in just 32 minutes.

The extended operating hours of the e-TEAS system also offer substantial benefits. Because six-month Paris Convention priority deadlines are statutory, being able to file so quickly and getting the benefit of up to seven extra hours before a filing date passes may be crucial. Using the paper system, a filing date may be lost if the application is not filed at the USPTO by 5 p.m. Eastern Standard Time, or at least mailed via Express Mail by the time the post office closes. Using e-TEAS enables you to file until midnight, providing applicants on the East Coast an extra seven hours and those on the West Coast an extra four hours for filing.

Finally, cost savings may be substantial. A company or law firm that files a large number of applications each year can essentially cut the out-of-pocket postage and/or fax expenses for filing an application from $15-20 down to nothing, simply by using e-TEAS and the Internet. For example, it may cost $3-4 in long distance charges to fax an application to a client for review and signature and have it faxed back. It then costs $10.95 to use Express Mail to forward the application to the USPTO. Filing via e-TEAS costs nothing. The application is created electronically, sent via e-mail to the client for review and signature, returned via e-mail and filed electronically. Savings could be substantial over the course of filing hundreds of applications.

THE FUTURE

While the TMEO probably will always have to be prepared to accept paper documents, the TMEO believes it is well on the way to at least having the capabilities of becoming a "paperless" office. The introduction of the TEAS filing site for basic applications has clearly established the viability of electronic filing. Expectations are that, within a year, electronic filing could amount to at least 25% of all applications filed. Moreover, by April 2000, the USPTO plans to expand the TEAS site to include ALL forms (e.g., Section 8 and Section 9 filings, extension requests, and Allegations of Use). Also, future plans include the ability to prosecute fully all filings electronically, not only to submit the original filing, but also to respond electronically to any actions from the attorney or paralegal. The TMEO will continue to "push the envelope" - but it won't be a paper one!

THE COPYRIGHT MANAGEMENT CENTER AT IUPUI: BRIEF HISTORY, DYNAMIC CHANGES, AND FUTURE DEMANDS

by Kenneth D. Crews
Associate Professor of Law and of Library and Information Science
Associate Dean of the Faculties for Copyright Management
Indiana University Purdue University Indianapolis
755 West Michigan Street
Indianapolis, IN 46202-5195
e-mail: kcrews@iupui.edu

From its base at Indiana University Purdue University Indianapolis (IUPUI), the Copyright Management Center has completed five years of innovative and diverse service for the campus, for Indiana University and for a larger academic community that finds itself increasingly caught in a tangled web of copyright concerns. Since its establishment in August 1994, the Copyright Management Center has had a central objective of helping the university community pursue innovations in teaching, research, and service by addressing the complex issues of copyright and the law's relationship to the needs of higher education. These issues sweep a broad spectrum, from the legal ownership of new works to the lawful uses of protected works under "fair use" and other opportunities.

The Copyright Management Center grew out of recognition that the relationship between university activities and copyright law was becoming more convoluted and in need of creative solutions. First, copyright law itself has been changing in ways that have direct consequences for higher education and library services. Second, new technologies at the university have given rise to new methods for creating and using copyrighted works. Third, innovations in teaching and research, such as the rapid expansion of distance learning, have generated a vast array of formidable copyright questions.

On this foundation, plans to establish the Copyright Management Center took shape in mid-1993. While many colleges, universities and libraries around the country were beginning to recognize that copyright posed concerns, key leaders at IUPUI took the initiative to establish an office that would guide the academy to a more constructive understanding of the issues and their possible solutions. Individuals such as Chancellor Gerald Bepko, Executive Vice Chancellor William Plater, and Barbara Fischler, former Director of IUPUI University Libraries, brought the idea to reality with their combined vision, support, and the all-important funding that made the new office possible. They also made the strategic decision that the Copyright Management Center should be closely aligned with the faculty. The office might have been formulated as an administrative unit, perhaps as part of the Office of University Counsel, or it could have been established within the University Library so that it could focus specifically on library concerns. However, aligning the office most closely with the faculty served multiple purposes. This positioning helped to allay some concerns that the Copyright Management Center would hinder faculty objectives and not respond to the needs of teaching and research. Appointing a faculty member to direct the office would also allow it to be a service unit, as well as a research center for copyright issues.

At this point, the story becomes more personal. The recruitment and hiring process from my perspective began with a telephone call in November 1993 from Tom Allington, the Associate Dean of the IU School of Law - Indianapolis. The School of Law and the IU School of Library and Information Science (SLIS) expressed early interest in having the director of the Copyright Management Center join their faculties, depending upon background and qualifications. In 1993, I was an Associate Professor of Business Law at San Jose State University and interested in the exact issues of central importance to the Copyright Management Center. I had practiced law in Los Angeles from 1980 to 1990, and in 1990, I earned a Ph.D. from the UCLA School of Library and Information Science. My dissertation analyzed copyright policies at research universities around the United States. That dissertation later became the foundation of my book, *Copyright, Fair Use, and the Challenge for Universities* (The University of Chicago Press, 1993).

After a few conversations, I was persuaded to apply for the position, and in March 1994, I visited Indianapolis and Bloomington for interviews. In August of that year, I arrived in Indianapolis with my family to assume a complex roster of duties. Not only was I

appointed as Director of the Copyright Management Center, but I was also named Associate Professor in both the School of Law and SLIS. Any one of these appointments alone could be a full-time job.

Throughout the past five years, I have attended to a host of responsibilities, including teaching courses in two programs and participating in faculty meetings and committee duties. But the activities of the Copyright Management Center have expanded enormously in a relentless chase to understand the relationship between copyright law and higher education. Here is a brief summary of some of the Copyright Management Center's major activities:

- Participation in the Conference on Fair Use. CONFU was an effort lasting from 1994 to 1998 to convene participants with diverse perspectives on the interpretation of fair use by educators and librarians. I attended to articulate the views of higher education and to advance a balanced understanding of fair use.

- Development of new policy for Indiana University. In particular, the Copyright Management Center led the task of developing the new policy for IU. This office also has developed policies and procedures related to reserve systems in the library, ownership of distance education courses, and many other critical subjects.

- Hosted guest speakers on campus. Our visitors have included David Post from Temple University, Raymond Nimmer from the University of Houston, and Peter Jaszi of American University.

- Organized and hosted a "Town Meeting on Fair Use, Education, and Libraries". We held this national conference in April 1997, with nearly 100 attendees and several speakers from throughout the country.

- Ongoing workshops and discussion sessions. We have conducted open sessions on issues ranging from ownership of websites to the specialized use of visual images by artists and art historians.

- Online Copyright Tutorial. During two recent semesters, Spring and Fall 1998, the Copyright Management Center offered an Online Copyright Tutorial. This tutorial provided an overview of copyright law, particularly as it applies to higher education and libraries, by means of a series of brief and readable email messages distributed on a listserv by subscription. We were able to provide this service at no charge to subscribers. Each semester brought approximately 2,500 subscribers from around Indiana University, the state and the world.

- Copyright Management Center Website. Our website at http://www.iupui.edu/~copyinfo provides access to a wealth of materials organized according to the subtopics in copyright law of greatest interest to our constituents. The original site was largely the work of Judy Homer of the Copyright Management Center and Cindy Hollingsworth of IUPUI's Center for Teaching and Learning. Major developments in the law and in the scope of the Copyright Management Center's activities led to a need for to overhaul the website. A new version, prepared with the talents of Allison Kopczynski of the IUPUI University Library, was launched in March 1999. Since that time, the new site often has received 100 visits per day.

- Copyright publications. The Copyright Management Center and its staff members have prepared numerous brief publications and announcements about recent developments and commonly occurring problems related to copyright and education. Most of those publications are available on the Copyright Management Center website. Original publications range from summaries of the newly enacted Digital Millennium Copyright Act to the meaning of fair use when mounting readings on a website for classroom instruction.

- Federal Government Relations. The Copyright Management Center works closely the IU Office of Public Affairs and Government Relations to help communicate the concerns of Indiana University with respect to pending legislation in Congress and other federal-policy developments. We have met with members of Congress to communicate our views and concerns, and we have worked with the President of Indiana University and others to advance those concerns.

- Coordination with state and national organizations. The creation of the Copyright Management Center in 1994 was instrumental in the formation of a Copyright Committee of the Indiana Partnership for Statewide Education. With members from several colleges and universities around Indiana, this committee is examining and advancing the understanding of copyright issues, especially as applied to distance learning. I also serve on the Task Force on Copyright and Intellectual Property for the Association of American Universities, the National Association of State Universities and Land-Grant Colleges, and the American Council on Education.

- Organization of a statewide meeting on distance learning and copyright. In January 1999, the Copyright Management Center organized a meeting, in association with the Indiana Commission on Higher Education. The purpose of the meeting was to discuss the pending effort by the U.S. Copyright Office to recommend changes in the copyright statute addressing the use of works in distance learning. Attending the meeting were participants from all colleges and universities within Indiana. An outcome of the meeting was a report encompassing the views and perspectives of Indiana educators. That report was delivered to the U.S. Copyright Office and made a part of the official study.

- Participation in public hearings on distance learning legislative proposals. In February 1999, I testified in

public hearings before the U.S. Copyright Office to discuss experiences addressing copyright issues and to present a proposal developed by the AAU, NASULGC, and ACE. Dwayne K. Buttler of this office also testified that day on behalf of the Indiana statewide effort and the report that resulted from the January conference.

- Numerous individual inquiries. The Copyright Management Center has fielded hundreds of individual inquiries from faculty, librarians, and many other members of the university community, as well as from interested and concerned individuals around the country. Handling these inquiries can be enormously rewarding and at the same time challenging and perplexing. They can also be a severe test of the limits of our service. An inquiry may be of tremendous importance to the particular person who brings it forward, but responding to it may not be the most efficient use of our scarce staff time and resources. Moreover, the Copyright Management Center is not a law office, and thus we cannot give legal advice. Consequently, the practical realities are that we sometimes need to decline politely many individual requests for support and assistance.

In 1996 the Copyright Management Center was fortunate to receive a three-year grant from the Indiana University Strategic Directions Charter, under the direction of President Myles Brand. That grant enabled the Copyright Management Center to expand its staff and services. Current members of the Copyright Management Center staff accompanying me on this copyright journey include Dwayne K. Buttler, Senior Copyright Analyst, and Becky Parman, Administrative Secretary. Mr. Buttler is a graduate of IUPUI and the IU School of Law-Indianapolis. Ms.Parman is a graduate of the University of Evansville. Part-time staff members assisting with special projects include Barbara Gushrowski and Noemí Rivera-Morales. Both are graduates of SLIS.

The Copyright Management Center continues its work with committed support from IUPUI and operates from offices in the IUPUI University Library. With variable university funding and swift changes in the complexity and magnitude of copyright issues, we unfortunately cannot address all issues and serve all needs. Therefore, we have identified these priorities for the current year:

- The copyright complexities of distance education. Distance education raises formidable concerns related to the fair use of existing works, along with identifying and establishing rights of ownership associated with websites, videotapes, and other instructional materials created at the university.

- Electronic reserves and "Oncourse." Electronic reserves in the library and the university's web-based instructional delivery system, known as "Oncourse," allow instructors to make the full text of selected works available to students enrolled in particular classes. These systems raise thorny issues of fair use and of the need to secure permissions from copyright owners under certain circumstances.

- Community education. The Copyright Management Center continues to offer information resources on its website and in public instructional programs. This year we have offered a series of programs open to the public and geared specifically for the university community on a range of major issues, such as fair use in the web environment, ownership of faculty scholarly works, and copyright issues for distance education.

- Online Copyright Tutorial. During 1998, the Copyright Management Center twice offered the Online Copyright Tutorial. We hope to offer some variation of the tutorial in the near future.

- Licensing of library resources. The University Library is increasingly acquiring journals and other resources in electronic form under the terms of detailed license agreements that govern the permissible uses of the materials. The Copyright Management Center is addressing alternatives for license agreements and identifying issues of major interest or concern.

Through all of its services and activities, the Copyright Management Center continues to keep its focus on the needs of higher education and librarianship. While the Copyright Management Center may well address the law and be immersed in questions of statutory interpretation and liability risks, we address these issues with an eye toward understanding and applying the principles of copyright law for the benefit of higher education and research. For example, copyright law may fundamentally establish an ownership right in new works, but the creative and insightful management of that ownership can further the educational goal of making new works widely available to advance learning. Moreover, the ownership rights that are granted by copyright law may often prevent or limit some constructive uses of protected works, but fair use and other exceptions allow the university community to build on existing materials, within limits, for the advancement of teaching, scholarship, and research.

The central mission of the Copyright Management Center in all of its activities is to promote new understanding of copyright law and its relationship to the university. Senior officials at IUPUI and IU deserve enormous credit for their early recognition of these important issues and for establishing the Copyright Management Center to address the complexities of copyright law for the benefit of the broader academic community.

THE DIGITAL MILLENNIUM COPYRIGHT ACT AND LIBRARY LIABILITY

by Fred H. Cate, Professor of Law, Harry T. Ice Faculty Fellow, and Director, Information Law and Commerce Institute Indiana University School of Law-Bloomington; Senior Counsel for Information Law Ice Miller Donadio & Ryan

I. INTRODUCTION

Copyright law affects libraries in many ways. It protects the core activities of most libraries - collecting information resources and making them available to the public. This is no small accomplishment. Other countries (for example, Great Britain) charge a royalty every time a library loans a book.[1] Copyright law protects the original expression of librarians and library staff, and helps clarify which rights belong to the library and which to the individual creators. Although copyright law is generally highly protective of the interests of libraries, it also provides for liability when libraries, or in some cases their employees or even their patrons, infringe the copyrights of others.

The proliferation of the Internet and other digital technologies has expanded the importance of copyright law not only to libraries, but to virtually every segment of U.S. society. As statutes, judicial opinions, and legal scholarship race to adapt to this technological change, the application of copyright law has become both more complex and more uncertain. Again, libraries may be especially vulnerable to this complexity and uncertainty because many libraries both use and make available to the public technologies - photocopiers, videotape and disc players and recorders, networked computers, tape recorders, online databases, CD-ROMs, facsimile machines - each one of which has among its primary uses the infringement of copyrighted works.

Congress took its first step towards addressing this situation in October 1998 when it passed the Digital Millennium Copyright Act (DMCA).[2] The Act creates significant new rights for copyright holders and new defenses for copyright users, both of which are potentially critical to the activities of most libraries. This article provides a brief overview of the current state of U.S. copyright law and a summary of the DMCA's recent changes to that law that are likely to affect libraries.

II. OVERVIEW OF COPYRIGHT LAW

Copyright law in the United States is based on the Copyright Clause in the U.S. Constitution, which empowers Congress to "secur[e] for limited Times to Authors . . . the exclusive Right to their respective Writings" to "promote the Progress of Science and useful Arts."[3] In 1976, Congress concluded more than a decade of hearings and debate by passing a new Copyright Act that substantially rewrote U.S. copyright law.[4] Under the prior law, which had been enacted in 1909,[5] federal copyright protection applied only to limited categories of works and then only if the work was published;[6] required strict compliance with a variety of formalities, including registration with the Copyright Office and publication with appropriate copyright notice;[7] and lasted for only 28 years (56 years, if the copyright was renewed).[8]

The 1976 Act substantially broadened and extended federal copyright protection. Rather than protecting only specified categories of works, Congress applied copyright law to all works of authorship,[9] provided that they were "fixed" and "original," regardless of whether they were published. A work is "fixed" when it is embodied, by or with the permission of its creator, in "any tangible medium of expression" from which the work can be "perceived, reproduced or otherwise communicated, either directly or with the aid of a machine or device . . . for a period of more than transitory duration."[10] A work may be fixed on paper, videotape, disk, or on many other forms of media, but not on a television or computer screen because these images are of only "transitory duration." A work is "original" if it is "independently created by the author (as opposed to copied from other works), and . . . possesses at least some minimal degree of creativity."[11] These requirements are deliberately broad and easy to satisfy. As a result, copyright law now protects every letter, memo, note, home video, answering machine message, e-mail, and doodle.

Moreover, unlike other areas of intellectual property, the 1976 Act, as amended in 1988[12] and again in 1998,[13] does not require compliance with statutory formalities or application to the government as a condition for protection.[14] Protection begins as soon as the work is "fixed" - whether or not the author wishes the work to be protected - and lasts for 70 years past the life of the author.[15] If the author is an organization, protection lasts for 120 years after creation or 95 years

after publication, whichever expires first.[16] Under current copyright law, protection is easy to come by, long-lasting, and difficult to lose.

The rights protected under current law are equally expansive. Copyright law gives a creator, or, in some circumstances, a creator's employer,[17] five exclusive rights: the right to reproduce, adapt, distribute, publicly perform, and publicly display a copyrighted work.[18] For the period covered by the copyright, the law permits only the copyright holder to engage in, or authorize someone else to engage in, any activity covered by the five exclusive rights. In addition, the 1976 Act grants to the copyright owner the right to control importation of copyrighted works into the United States.[19]

The exclusive rights may be transferred or licensed, individually or collectively, for use by others.[20] Transfers and exclusive licenses must be in writing; nonexclusive licenses may be granted orally or even implied.[21] The transferee or exclusive licensee is entitled "to the extent of that right, to all of the protection and remedies accorded to the copyright owner by this title."[22] The new copyright holder or exclusive licensee can enforce his or her rights against even the original creator or copyright holder.[23]

Courts have interpreted copyright law's infringement provisions very broadly. Individuals and institutions are liable not only for their own conduct, but also for the conduct of employees (under the doctrine of *respondeat superior*[24]); the conduct of anyone whom they supervise and in whose work they have a financial interest (vicarious infringement);[25] and the conduct of anybody whose infringing activity they knowingly induce, cause, or to which they materially contribute (contributory infringement).[26] Libraries run the risk of liability - if their conduct is not protected by a statutory defense, discussed below - under contributory infringement when they provide patrons with *both* copyrighted material (e.g., books) *and* access to the means for copying that material (e.g., a photocopier), with knowledge that patrons will likely use the latter to infringe the copyright in the former. The law does not require that the defendant intend to infringe, or, except in the case of contributory infringement, even have knowledge of the infringing conduct. Innocent intent or lack of knowledge may affect damages, but they do not affect liability.[27]

The 1976 Act provides significant penalties for violating the exclusive rights, including injunctions,[28] impoundment and destruction of infringing copies,[29] actual damages and lost profits,[30] statutory damages,[31] court costs,[32] and attorneys' fees.[33] The Act also provides criminal penalties for "[a]ny person who infringes a copyright willfully and for purposes of commercial advantage or private financial gain."[34]

Although broad, copyright protection in the United States is not limitless. The most significant limit in copyright today is that the law protects expression only. No matter how original or creative, "[i]n no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work."[35] In Feist Publications, Inc. v. Rural Telephone Service Company, a unanimous Supreme Court stressed: "The most fundamental axiom of copyright law is that '[n]o author may copyright his ideas or the facts he narrates. . . .' [C]opyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work."[36]

As a result, courts will not protect expression if it includes one of a limited number of ways of conveying an idea, concept, or fact, or if it is necessary to implementing an idea or concept. Under the doctrine of "merger," courts withhold copyright protection from original, fixed expression if that expression "must necessarily be used as incident to" the work's underlying ideas or data.[37] In that situation, courts find that the expression and the underlying idea or fact have "merged."[38] The doctrine of merger highlights the importance of preventing copyright law from ever protecting a fact or idea: it is preferable to exclude otherwise protectable expression from copyright law's monopoly rather than to allow that monopoly to extend to any fact or idea.

Copyright protection is also subject to four other significant limitations relevant to libraries. The "first sale" doctrine, codified in Section 109,[39] limits copyright owners' rights by subjecting only the initial distribution of a particular copy of a copyrighted work to their control. The first sale doctrine provides that once the copyright holder has distributed or authorized the distribution of copies of her copyrighted work, subsequent possessors of those copies may redistribute them without the copyright holder's permission.[40] Without the first sale doctrine, reselling, lending, or giving away a copy of a copyrighted work would violate the copyright holder's exclusive distribution right.[41] The first sale doctrine is therefore particularly important to libraries.

Copyright law also includes specific exemptions from the exclusive rights to publicly display and perform copyrighted works. Section 109 exempts the public display of a lawful copy of a copyrighted work by its rightful owner.[42] Without this exemption, it would be a violation of the copyright law to publicly display a photograph, painting, or other copyrighted work without the permission of the copyright owner.

This exemption applies whether the display is direct (e.g., hanging the painting) or by projection of no more than one image at a time (e.g., showing slides of one or more paintings in series). However, the viewers must be "present at the place where the copy is located."[43] Again, because this provision permits the public display of book jackets and other copyrighted material, it is important to libraries.

"Fair use" constitutes a statutory defense to copyright infringement. According to the 1976 Act, certain uses of copyrighted works may be fair "for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research."[44] Fair use expressly permits certain uses of copyrighted works that serve important public purposes and that do not harm the market for the original work. The Act sets out four factors for courts to consider when determining whether an otherwise infringing use is fair.[45] Courts often focus on the fourth factor: "the effect of the use upon the potential for or value of the copyrighted work."[46] According to the Supreme Court, unauthorized uses of copyrighted works are unfair (1) if it is proved that the particular use is harmful to the market for the original work, or (2) if it is shown by a preponderance of the evidence that "should [the use] become widespread, it would adversely affect the potential market for the copyrighted work."[47] Fair use immunizes activities such as quoting portions of a book or song in a review; its value to libraries is clear.

Finally, Section 108 provides for defenses specifically applicable to libraries. Section 108 establishes certain "safe harbors" - situations in which libraries and archives and their patrons may reproduce and distribute copies of copyrighted works without infringing. This provision permits limited photocopying of books and periodicals for scholarly or archival purposes as long as the copying is neither systematic nor a substitute for purchase or subscription.[48] To qualify, a library or archives must make its collections available to the public or to unaffiliated persons doing research in appropriate fields.[49] Moreover, the reproduction or distribution must be made without direct or indirect commercial advantage.[50] Section 108 also permits interlibrary loan photocopying "of no more than one article or other contribution to a copyrighted collection or periodical issues" or "a small part of any other copyrighted work," subject to important limitations.[51] Finally, Section 108 appears to absolve libraries and library employees for infringement resulting from "the unsupervised use of reproducing equipment located on its premises," provided that "such equipment displays a notice that the making of a copy may be subject to the copyright law."[52]

III. DIGITAL MILLENNIUM COPYRIGHT ACT

The DMCA creates important new rights for both copyright holders and users. Although intended to resolve issues presented by digital technologies, the DMCA has considerably broader impact. It is a complex piece of legislation consisting of five titles, only three of which are relevant to the activities of libraries.

A. Title I - WIPO Treaties Implementation

Title I of the DMCA implements two World Intellectual Property Organization (WIPO) treaties: The WIPO Copyright Treaty and The WIPO Performances and Phonograms Treaty, adopted at the WIPO Diplomatic Conference in December 1996. Those treaties require member nations to protect digitally transmitted works in two ways:

(1) to provide legal remedies against the circumvention of technological measures designed to block access to copyrighted works, and

(2) to prohibit the interference with copyright management information digitally encoded in copyrighted works, including information about copyright ownership and licensing terms.

1. Anti-Circumvention

The Act achieves the first purpose by adding Section 1201 to the copyright law. The new section prohibits the circumvention of technological measures taken by copyright owners to control access to their works or to prevent the unauthorized exercise of the copyright owner's exclusive rights. Section 1201(a) applies to circumvention for the purpose of obtaining access to a work, and prohibits both circumventing technological measures that impede access and "manufactur[ing], import[ing], offer[ing] to the public, provid[ing], or otherwise traffic[ing] in any technology, product, service, device, component, or part thereof" that is primarily designed to circumvent technological measures designed to control access to a work.[53]

This provision takes effect two years after enactment of the DMCA, on October 28, 2000. During this two-year period, the Librarian of Congress is to conduct a rulemaking proceeding to evaluate the impact of the prohibition against the act of circumventing the access control measures set forth in the Act.[54]

Congress recognized legitimate reasons for engaging in circumvention. Accordingly, Title I specifically provides for one broad and six specific exceptions to the prohibition on circumvention and circumvention devices.[55] One is specifically applicable to nonprofit libraries. Section 1201(d) provides an exemption for nonprofit libraries, archives, and educational institutions to gain access to commercially exploited copy-

righted works solely to make a good faith determination of whether to acquire the work. The exemption applies only if a qualifying institution cannot obtain a copy of the work by other means.[56]

2. Copyright Management Information

Section 1202 of the DMCA prohibits altering "copyright management information" (CMI) and creates liability for any person who provides or distributes false CMI.[57] In addition, the Act prohibits the intentional removal or alteration of CMI, and its knowing distribution in altered form.[58] "CMI" includes all identifying information involving the author or performer, the terms and conditions for the use of the work, and other information such as embedded pointers and hypertext links.[59] These provisions respond to the use of digital technologies' ability to encode significant amounts of data, which can be used to identity the copyright owner and to facilitate the licensing of copyrighted works. Pertinent information, such as name and address, telephone number, fax number, e-mail address, and licensing rates, can be encoded into the work and displayed to a potential customer. For works available over digital networks, embedded links to the copyright owner can make electronic licensing even more convenient. As more and more works become available in electronic form, this information could significantly reduce the transaction costs associated with copyright licensing and greatly enhance enforcement of copyright laws.

The DMCA creates civil remedies and criminal penalties for violations of Sections 1201 and 1202.[60] The Act provides for statutory damages of as great as $2,500 per act of circumvention, and up to $25,000 for each violation of the CMI provisions.[61] The Act gives courts wide discretion to grant injunctions and award damages, costs, and attorney's fees, and also to reduce damage awards against innocent violators.[62] For nonprofit libraries, archives, or educational institutions, however, courts *must* remit damages if they find that the violator had no reason to know of the violation.[63] In addition, criminal penalties do not apply to nonprofit libraries, archives, and educational institutions.[64]

The new CMI provisions raise many concerns that have yet to be resolved by courts. Although targeted at copyright-related information imbedded in digital files, the provisions are not limited to electronic works. To be covered by the Act, the CMI must be conveyed with a copyrighted work.[65] As a result, these new provisions would prohibit removing or altering information about the creator, copyright, license terms, and the like concerning *any* copyrighted work. Arguably, this extends not only to reproducing a copyrighted work, but to any use made of such a work, for example, a quote in a review. Including all of the original work's CMI in such a situation will likely prove cumbersome or even impossible. Moreover, there is no indication in the DMCA that the CMI provisions are subject to fair use or other defenses. Finally, the damages for violating CMI provisions - $25,000 for each violation - are considerable. Taken together, these factors lead to the fear that copyright holders will sue possible infringers in the future not for their alleged infringement (which is often difficult and time-consuming to prove), but rather for violating the CMI provisions. Although libraries are exempt from criminal penalties and face reduced civil damages if they had no reason to know that they were removing CMI, the potential threat of significant and easy-to-obtain damages under the CMI provisions is nevertheless significant.

B. Title II - Online Copyright Infringement Liability Limitation

The DMCA includes important new provisions applicable to "online service providers" (OSPs). Although few libraries might think of themselves as OSPs, the law defines the term very broadly as "a provider of online services or network access, or the operator of facilities therefor."[66] Because some libraries do provide Internet access, e-mail, chat room, web page hosting, and other transmission, routing, and connection services, and more are likely to do so in the future, a brief summary of the OSP provisions is warranted. However, the OSP provisions are detailed and technical, so it is only possible to provide a broad overview below.

Prior to enactment of the DMCA, some courts had found that OSPs were liable - both directly and contributorily - for the infringing conduct of the users of their services.[67] Title II of the DMCA limits OSP liability in three important situations, discussed below. Beginning on October 28, 1998, these exemptions from liability add to any defense that an OSP might have under copyright law. These exemptions do not constitute complete defenses to copyright infringement suits. Rather, they eliminate the availability of monetary damages, and reduce the situations in which injunctions may be granted.

1. Transmission and Routing - Section 512(a)

Title II of the DMCA insulates an OSP from liability when it is merely acting as a passive conduit for materials passing between other parties.[68] This provision applies only if the following conditions are met:

(1) the transmission of the material was initiated by or at the direction of a person other than the service provider;

(2) the transmission, routing, provision of connections, or storage is carried out through an automatic technical process without selection of the material by the service provider;

(3) the service provider does not select the recipients of the material except as an automatic response to the request of another person;

(4) no copy of the material made by the service provider in the course of such intermediate or transient storage is maintained on the system or network in a manner ordinarily accessible to anyone other than anticipated recipients, and no such copy is maintained on the system or network in a manner ordinarily accessible to such anticipated recipients for a longer period than is reasonably necessary for the transmission, routing, or provision of connections; and

(5) the material is transmitted through the system or network without modification of its content.[69]

Collectively, these conditions require that the role of the OSP is entirely passive towards the allegedly infringed material.

2. System Caching - Section 512(b)

Virtually all networked computers "cache" documents - that is, they store a copy of the document on the hard drive for faster reference in the future. This allows computers to manage large files and also to provide for speedier access to commonly used or recently used documents. Since caching necessarily involves making a copy of a file, it would likely constitute copyright infringement. The DMCA provides that caching is not copyright infringement, provided that the OSP is not itself downloading material for storage or altering the content of cached material, and that the OSP complies with industry standards related to caching.[70]

3. Storing and Linking - Section 512(c)-(d)

Finally, Title II of the DMCA limits OSP liability under the copyright law for two common OSP activities: (1) storing material, such as a web page, on a server;[71] and (2) referring users to material at other online sites through hypertext links.[72] The former would clearly constitute copyright infringement, absent the defense provided by the DMCA, because it involves reproducing (as well as, perhaps, publicly displaying) copyrighted material. It is unsettled whether merely linking to a site could constitute copyright infringement, or whether the operator of a web page could be contributorily liable for linking to another page that contained infringing material. Fortunately, this provision of the DMCA makes the resolution of those issues unnecessary. The Act limits liability based on the material being stored or referred to if the OSP meets the following conditions:

(1) does not have actual knowledge that the material or an activity using the material on the system or network is infringing;

(2) in the absence of such actual knowledge, is not aware of facts or circumstances from which infringing activity is apparent;

(3) upon obtaining such knowledge or awareness, acts expeditiously to remove, or disable access to, the material;

(4) does not receive a financial benefit directly attributable to the infringing activity, in a case in which the service provider has the right and ability to control such activity; and

(5) upon notification of claimed infringement . . . responds expeditiously to remove, or disable access to, the material that is claimed to be infringing or to be the subject of infringing activity.[73]

4. Threshold Conditions

To qualify for any of the exemptions in Title II, an OSP must meet three general conditions. First, it must adopt, implement, and inform its subscribers and account holders of its policy providing for termination of users who are repeat infringers.[74] Second, the OSP must accommodate and not interfere with "standard technical measures" used by copyright owners to identify and protect copyrighted works.[75] Third, an OSP must comply with the DMCA's "notice and takedown provisions." These provisions are covered in minute detail in the DMCA, but they basically require that the OSP (1) designate an agent to receive notifications of claimed copyright infringement, and (2) provide publicly (including on the OSP's web site) the name, address, phone number, and electronic mail address of the agent.[76] Significantly, as Professor Marshall Leaffer has written, "an OSP does not need to monitor its service or affirmatively seek out information about copyright infringement on its service, except to accommodate technical measures described above."[77]

The importance of these provisions can hardly be overstated. They effectively codified the result of Religious Technology Center v. Netcom On-Line Communications Services,[78] which held that Netcom, operator of a Usenet bulletin board, should not be held strictly liable for user infringement of which it had no knowledge. Moreover, under these provisions, compliance with fairly straightforward requirements can eliminate much of the uncertainty surrounding Internet-related copyright complaints; libraries no longer need to guess what the law has to say about how they handle such complaints. On the other hand, should a library fail to take the simple step of designating and registering an agent with the Library of Congress, it loses all of the protection provided by Title II of the DMCA.

5. Additional Provisions

Finally, Title II provides for liability for knowingly, falsely claiming that material or activity is infringing,[79] and protects OSPs from liability for "good faith disabling of access to, or removal of, material or activity claimed to be infringing or based on facts or circumstances from which infringing activity is apparent, regardless of whether the material or activity is ultimately determined to be infringing."[80]

C. Title IV - Sec. 404 - Exemption for libraries and archives

With only one exception, the balance of the DMCA contains no provisions relevant to libraries. That exception is a small but important amendment to Section 108 of the copyright law, which, as noted above, provides special protections for libraries. As amended by the DMCA, qualifying libraries may now make three copies - instead of only one - of an unpublished work for preservation or for deposit for research use by another library or archives.[81] Libraries may make three copies of a published work that is "damaged, deteriorating, lost, or stolen, or if the existing format in which the work is stored has become obsolete," provided that the library has not been able to locate an unused replacement at "a fair price," and that if the new copies are in digital format, that they are not made available to the public in that format outside of the library.[82] In this case, the DMCA not only increased the number of copies, but also added the language about obsolete formats, which the Act defines as being the case if "the machine or device necessary to render perceptible a work stored in that format is no longer manufactured or is no longer reasonably available in the commercial marketplace."[83] Finally, prior to passage of the DMCA, Section 108 provided that libraries could reproduce and distribute a single copy of a copyrighted work, provided that they met certain conditions, including placing appropriate copyright notice on the copy. This had led to the question of what libraries should do when the original work being copied had no copyright notice. The DMCA resolved that question by providing that in such a situation libraries should simply affix a statement that the work may be protected by copyright.[84]

IV. CONCLUSION

U.S. copyright law has traditionally been very protective of the activities of libraries and librarians. The DMCA is no exception to this laudable trend. The Act expands the protections afforded libraries in Section 108, provides significant new protections for online activities, and offers important clarification for how complaints of online infringement are to be handled. Many of the protections of the DMCA, however, turn on compliance with quite technical (although seldom burdensome) requirements, such as the designation and registration of an agent to receive notices of alleged online infringement. In addition, the Act does create the potential of new liability for libraries, especially for removing or altering CMI. Even in the face of new liability, however, the Act reflects the law's longstanding solicitude for libraries by providing for reduced damages.

At present, a number of the DMCA's provisions are not applicable to many libraries, because few libraries today act as OSPs. But this is certain to change as more and more libraries expand their Internet services. As that happens, attention to the details of the DMCA will become increasingly important, if libraries are to realize the full protection of the law.

NOTES

1. *See* generally Paul Goldstein, *Copyright's Highway* 163-64 (1994); John Cole, Public Lending Right, 42 *Library of Congress Info. Bull.* 427 (Dec. 12, 1983).

2. Pub. L. No. 105-304, 112 Stat. 2860 (1998) (codified as amended at 17 U.S.C. at 101 et seq).

3. U.S. Const. art. I, art. 8, cl. 8.

4. Pub. L. No. 94-553, 90 Stat. 2541 (1976) (codified as amended at 17 U.S.C. at 101 et seq).

5. Act of March 4, 1909, ch. 320, 35 Stat. 1075 (superseded by Pub. L. No. 94-553, 90 Stat. 2541 (1976)).

6. Id. at 2. The 1909 Act provided exceptions from the publication requirement for certain works "not reproduced for sale" and common law provided copyright-like protection for many unpublished works. Id. at 12.

7. Id. at 10.

8. Id. at 24.

9. 17 U.S.C. at 102(a). Works subject to copyright include, but are not limited to, literature, music, drama, pantomime, choreography, photography, graphic art, sculpture, film, computer software, sound recordings, or architecture. Id.

10. Id. at 102(a), 101.

11. Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 345 (1991).

12. Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853 (1988) (codified at 17 U.S.C. at 101 et seq).

13. Digital Millennium Copyright Act, Pub. L. No. 105-304, 112 Stat. 2860 (1998) (codified at 17 U.S.C. at 101 et seq); Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298 (1998) (codified at 17 U.S.C. at 301 et seq).

14. The 1976 Copyright Act offers several incentives to prompt registration, including making registration a prerequisite for filing a copyright infringement action or for obtaining statutory damages. 17 U.S.C. at 411(a), 412. Similarly, despite elimination of the notice requirement, affixing notice may affect the copyright owner's monetary recovery for infringement. As a general rule if notice appears on the published copy to which the infringer had access, a court will give no weight to a defense that innocent infringement mitigates actual or statutory damages. Id. at 401(d), 402(d).

15. Id. at 302(a).

16. Id. at 302(c).

17. The right belonged initially to the creator unless the work was "made for hire." The statute defines a "work made for hire" as

> (1) a work prepared by an employee within the scope of his or her employment; or
>
> (2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.

Id. at 101.

18. Id. at 106.

19. Id. at 602(a).

20. Id. at 201(d), 101.

21. Id. at 204(a), 101; *see* Effects Associates, Inc. v. Cohen, 908 F.2d 555 (9th Cir. 1990).

22. 17 U.S.C. at 201(d)(2).

23. *See*, e.g., Gross v. Seligman, 212 F. 930 (2d Cir. 1914).

24. Whitol v. Crow, 309 F.2d 777, 782-83 (8th Cir. 1962); M. Whitmark & Sons v. Calloway, 22 F.2d 412 (E.D. Tenn. 1927).

25. Shapiro, Bernstein & Co. v. H.L. Green Co., 316 F.2d 304 (2d Cir. 1963).

26. Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 451 (1984); Gershwin Publishing Corp. v. Columbia Artists Management, 443 F.2d 1159 (2d Cir. 1971).

27. *See* Buck v. Jewell-LaSalle Realty Co., 283 U.S. 191, 198 (1931) (stating "Intention to infringe is not essential under the act."); Playboy Enter. v. Frena, 839 F. Supp. 1552, 1556 (M.D. Fla. 1993) (stating "Intent or knowledge is not an element of infringement, and thus even an innocent infringer is liable for infringement."). *See* generally Paul Goldstein, *Copyright* at 9.4 (1989).

28. 17 U.S.C. at 502.

29. Id. at 503.

30. Id. at 504(b).

31. Id. at 504(c). Statutory damages range from $200 for innocent infringement to $100,000 for willful infringement.

32. Id. at 505.

33. Id.

34. Id. at 506(a).

35. 17 U.S.C. $102(b).

36. 499 U.S. at 344-45, 349 (quoting Harper & Row Publishers, Inc. v. Nation Enter., 471 U.S. 539, 556 (1985)).

37. Baker v. Selden, 101 U.S. 99, 104 (1879).

38. *See* Herbert Rosenthal Jewelry Corp. v. Kalpakian, 446 F.2d 738, 742 (9th Cir. 1971) (explaining that when an "'idea' and its 'expression' are thus inseparable, copying the 'expression' will not be barred, since protecting the 'expression' in such circumstances would confer a monopoly of the 'idea'"); Merrit Forbes & Co. v. Newman Invest. Serv., 604 F.2 Supp. 943, 951 (S.D.N.Y. 1985) (stating that "where an underlying idea may only be conveyed in a more or less stereotyped manner, duplication of that form of expression does not constitute infringement, even if there is word for word copying"). *See* generally Goldstein, *supra* note 27, at ' 2.3.2 .

39. 17 U.S.C. $ 109(a).

40. Id. Columbia Pictures Indus. v. Aveco, 800 F.2d 59, 64 (1986) (stating "When a copyright owner parts with title to a particular copy of his copyrighted work, he thereby divests himself of his exclusive right to vend that particular copy.").

41. The first sale doctrine does not apply with equal force to all types of copyrighted works. Under current law, the owner of a lawfully made copy of a computer program or a phonorecord of a sound recording may not rent, lease, or lend that copy or phonorecord for direct or indirect commercial advantage. 17 U.S.C. ' 109(b).

42. Id. ' 109(c).

43. Id.

44. Id. ' 107.

45. In determining whether the specific use made of a work in any particular case is fair, the factors to be considered shall 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." Id.

46. Id.

47. Sony, 464 U.S. at 451; Harper & Row, 471 U.S. at 566 (stating "This last factor is undoubtedly the single most important element of fair use."); *see also* Campbell v. Acuff-Rose Music, 510 U.S. 569 (1994).

48. 17 U.S.C. ' 108(g).

49. Id. ' 108(a)(2).

50. Id. ' 108(a)(1).

5. Id. ' 108(d).

52. Id. ' 108(f)(1).

53. Id. ' 1201(a).

54. Id. '' 1201(a)(1)(B)-(E).

55. Id. '' 1201(a)(b)-(E), (d)-(j).

56. Id. ' 1201(d).

57. Id. ' 1202(a).

58. Id. ' 1202(b).

59. Id. ' 1202(c).

60. Id. '' 1203-1204.

61. Id. ' 1203(c)(3)(B).

62. Id. ' 1203(b).

63. Id. ' 1203(c)(5).

64. Id. ' 1204(b).

65. Id. ' 1202(c).

66. Id. ' 512(k)(1)(B).

67. *See*, e.g., Sega Enters. Ltd. v. MAPHIA, 948 F. Supp. 923 (N.D. Cal. 1996); Playboy Enters., Inc. v. Frena, 839 F. Supp. 1552 (M.D. Fla. 1993).

68. 17 U.S.C. ' 512(a).

69. Id. ' 512(a).

70. Id. ' 512(b).

71. Id. ' 512(c)

72. Id. ' 512(d)

73. Id. ' 512(c)(1).

74. Id. ' 512(i)(1)(A).

75. Id. ' 512(i)(1)(B).

76. Id. ' 512(c)(2).

77. Marshall Leaffer, *Understanding Copyright Law* 423 (3d ed 1999).

78. 907 F. Supp. 1361 (N.D. Cal. 1995).

79. 17 U.S.C. ' 512(f).

80. Id. ' 512(g).

81. Id. ' 108(b).

82. Id. ' 108(c).

83. Id.

84. Id. ' 108(a)(3).

COURSE RESERVES, E-RESERVES AND SERVING THE REMOTE USER

by Steven J. Schmidt,
Access Services Team Leader
IUPUI University Library

At the end of the last century, American academic libraries developed the concept of a special collection that could help to ensure the availability of high demand items. These collections were known as academic reserves, or more typically, just reserves. Reserve collections circulated these special "reserved" materials for a very short period, typically 2-4 hours for in-building use. Although this increased the availability of these items, it also created several other problems for both the library and for students.

The high turnover of these reserve materials made this a very labor-intensive process for libraries. The constant cycle of checking materials out, checking them back in and re-filing was time-consuming and actually led to a loss of control, since a particular item could be in any of a half dozen steps at any one time. The concentrated demand for these materials also created long lines, as hordes of students competed for the limited resources. This queuing negated the ready access that the system was intended to provide. The solution was to add extra copies to the reserve collec-

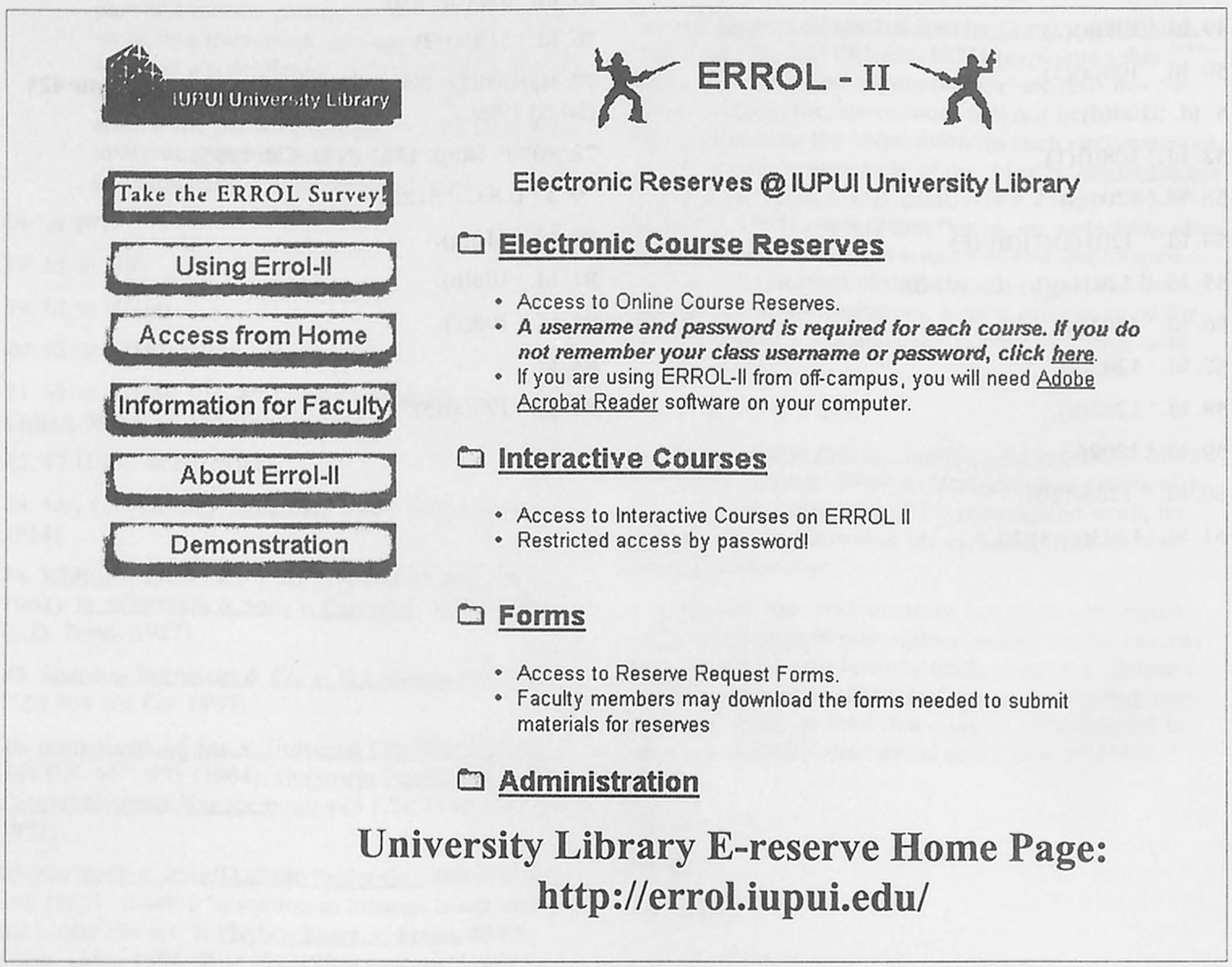


Figure #1: University Library E-reserve home page: http://errol.iupui.edu/

tion, which added to the staff's burden.

A full century later, many of these reserve processes have been automated, but the fundamental administration of most of these operations has barely changed. This is in spite of the fact that the volume of materials involved and the complexity of maintaining this type of system have increased exponentially.

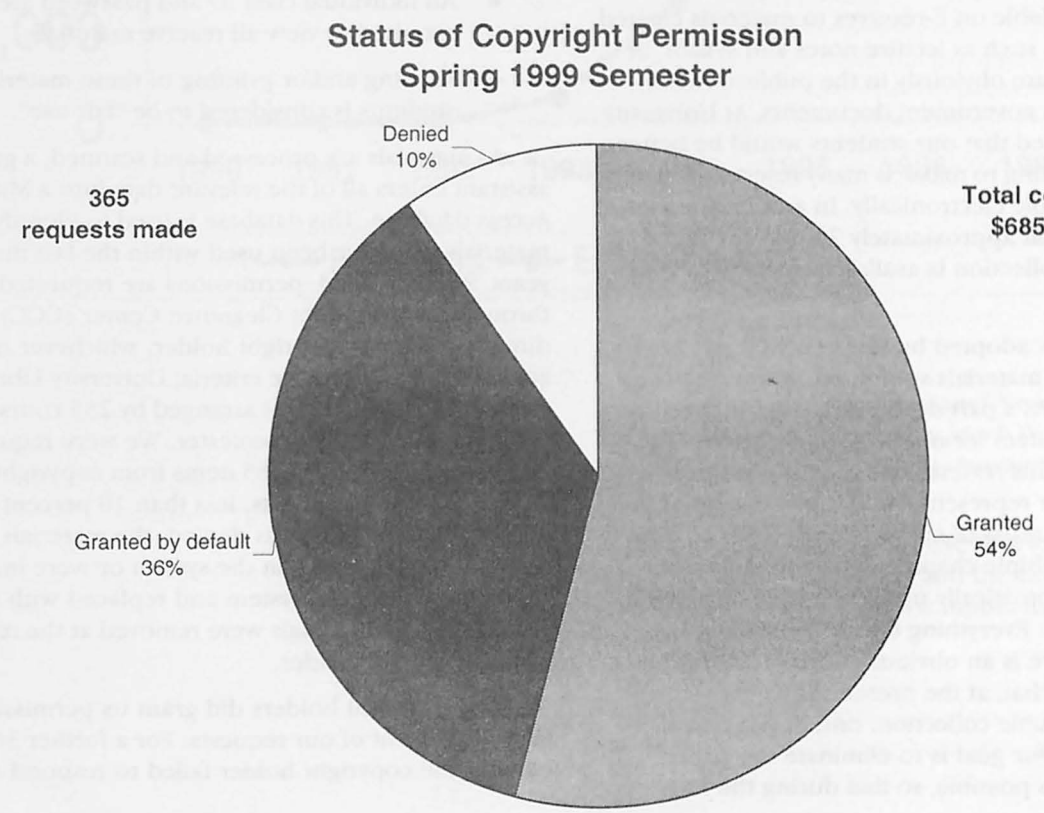
During the last decade, many libraries discovered that the solution might found through electronic access. Electronic reserves, commonly referred to as E-reserves, are the process where the course readings are converted into an electronic file format. These files are then made available over the Internet or campus network. Electronic access to high-demand materials has several benefits for both the library and its users.

The benefits for the users are most evident. First of all, both the library's hours and its location become irrelevant, since users can now access reserve materials at any time of the day or night. Multiple users can also access the same materials at the same time, doing away with the long lines of people at the circulation desk waiting for the material to become available.

University Library at IUPUI (Indiana University Purdue University Indianapolis) is a classic example of a case where an E-reserve system makes sense. IUPUI is an urban commuter school which serves over 27,000 students in central Indiana. The vast majority of the students do not fit the traditional 18-year-old college freshman profile. On average, students at IUPUI are five to seven years older and are working at least part-time. Many are trying to juggle the responsibilities of work, school and family, and a large number commute an hour or more one-way to attend classes. In this type of environment, students do not have time to stand in line at the reserve desk, hoping that the one copy of the one item they must read before their next class session is available. With E-reserves, this is no longer an issue. After class is over, these students can go home, put their kids to bed or just spend some quality time with their families. Then, when their schedules permit, they can log on to the E-reserve system and review or print the relevant class readings.

The popularity of such a system is very easy to measure. Traditionally, paper-based reserves amounted to approximately one-third of University Library's total circulation, averaging between 40,000 and 50,000 reserve transactions each year. In the six years since University Library began offering E-reserves, use of the paper-based reserve materials has declined at a steady rate, to a figure less than half than was common at the start of the decade. Meanwhile, use of E-reserves has skyrocketed.

Figure #2: Comparison of Traditional & E-reserves Use at University Library



Despite the obvious success and popularity of this system, the transition from paper has not always been an easy one. In any E-reserve system, there are three major components which must be balanced: usability, labor, and copyright.

In order for an E-reserve system to work, the system must be easy for both users and library staff. In a commuter environment like IUPUI, it is imperative for the system to be intuitive for users, because it is not possible to provide hands-on training for over 27,000 remote students. The question of usability also arises when you consider the technology that is available to your users, both on campus and at home.

In 1993, University Library partnered with Xerox Corporation on the development of a web-based interface known as ***DocuWeb***, which was based on their established ***DocuTech*** Image Management System. ***DocuWeb*** uses standard Internet browsers and the Adobe Acrobat reader to locate, view, and print files in .pdf format. Five years later, after outgrowing the capabilities of that particular system, University Library chose ***Digital Curriculum***, another Xerox service, to upgrade its E-reserve system. On the surface ***Digital Curriculum*** looks very similar to ***DocuWeb***, but behind the scenes, it greatly enhanced the capabilities on the library staff side while simplifying the overall workflow.

Many libraries with extensive E-reserve operations limit materials on their system to items that do not present copyright complications. Typically this restricts the readings available on E-reserves to materials created by the instructor, such as lecture notes and syllabi, or to materials that are obviously in the public domain, such as most U.S. government documents. At University Library, we decided that our students would be better served by attempting to make as many reserve materials as possible available electronically. In a normal semester, this means that approximately 70 percent of our entire reserves collection is available electronically at any one time.

The workflow adopted by University Library is to process all of the materials submitted by the faculty for paper reserves. As a part of this process, a staff member reviews each item for our E-reserves system. The criteria used for this review are straightforward. Reserve item requests that represent a major percentage of the entire work, or consist of multiple parts from a larger work, such as multiple chapters from the same book, are excluded automatically until the copyright issues can be addressed. Everything else is considered fair game, unless there is an obvious copyright issue. This workflow means that, at the present time, we are still maintaining a double collection, one in paper and another online. Our goal is to eliminate the paper system as much as possible, so that during the 1999/2000 academic year, University Library will begin to drop the paper copies of as many of these reserve items as possible and move toward a totally paperless system.

Over a century ago, long before the advent of photocopiers and E-reserves, Mark Twain wrote, "there is one thing [that is] impossible for God, and that is to make sense out of any copyright law in existence."[1] To a great degree, he was right. The interpretation of copyright law can be very complicated and is best left to lawyers. For this reason, University Library chose to work closely with Dr. Kenneth D. Crews, J.D., Indiana University Copyright Management Center, to distill a small set of guidelines to help library staff deal with the copyright issues in a timely fashion.

Some critical aspects of our copyright policies are as follows:[2]

- The first time that a particular instructor uses a particular item for a particular class is considered "fair use" and the item can be mounted on an E-reserve system.
- The next time that same instructor uses that same item for that same class, the library is responsible for requesting permission from the copyright holder before that item can be mounted on an E-reserve system.
- All reserve materials are searchable by department, course number, and instructor only.
- An individual class ID and password are required to view all reserve materials.
- Viewing and/or printing of these materials by students is considered to be "fair use".

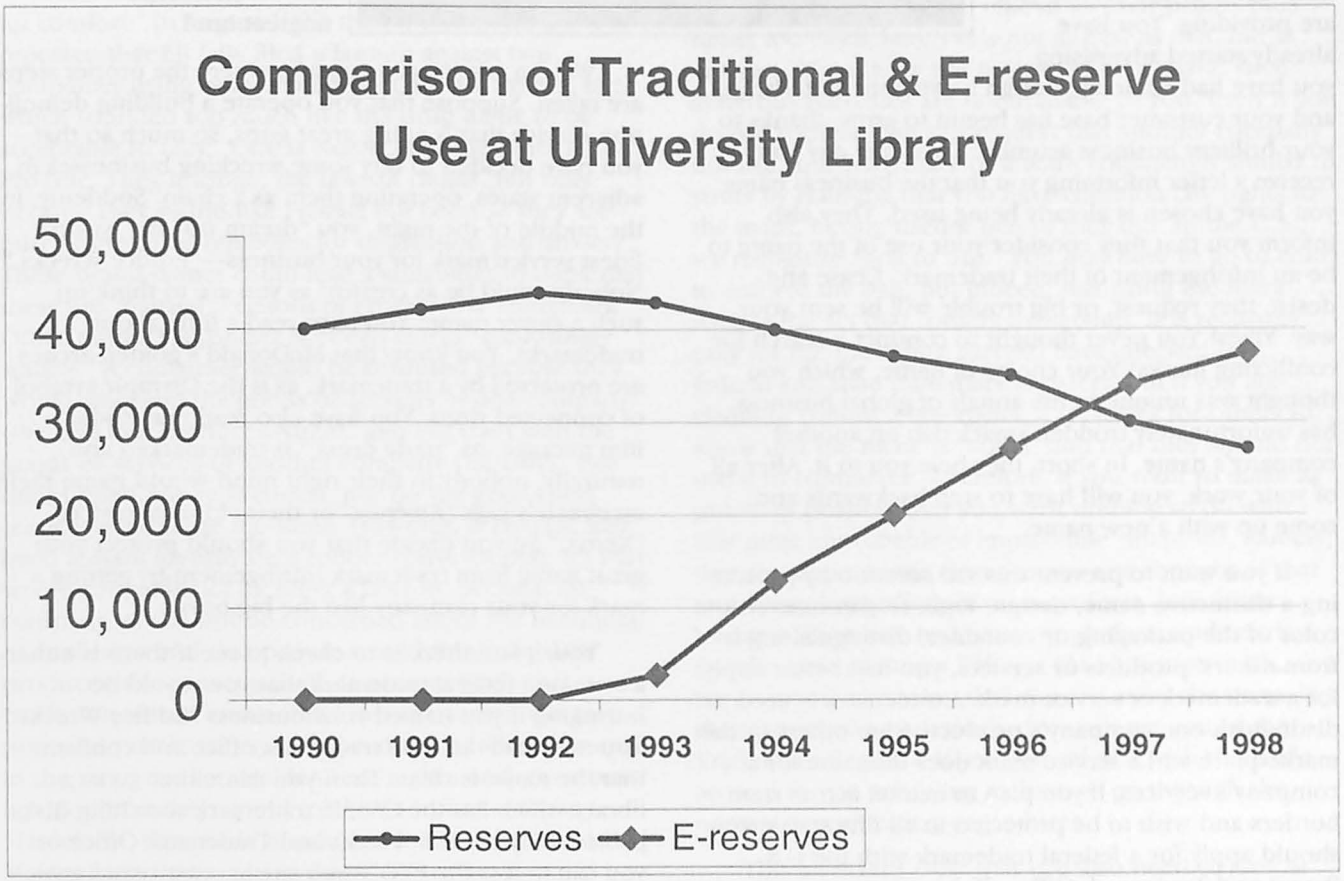
As materials are processed and scanned, a graduate assistant enters all of the relevant data into a Microsoft Access database. This database is used to identify materials that have been used within the last three years. When needed, permissions are requested through the Copyright Clearance Center (CCC) or directly from the copyright holder, whichever is appropriate. Using these criteria, University Library mounted 920 documents arranged by 255 courses during the spring 1999 semester. We were required to request permission for 365 items from copyright holders. Of these requests, less than 10 percent were denied. If permission was denied, the materials were either never mounted on the system or were immediately pulled from the system and replaced with a flag stating that the materials were removed at the request of the copyright holder.

The copyright holders did grant us permission for over 54 percent of our requests. For a further 36 percent the copyright holder failed to respond to our

requests at all. In most cases, these articles were accepted as permission granted by default. For the spring 1999 semester, University Library paid $6,850 in royalties to the CCC and other copyright holders for these permission.

As these figures all too clearly show, there are some real costs associated with E-reserves that go far beyond the price of the equipment. However, these costs must be weighed against the convenience and service we are providing to our students. In the 1890s, our predecessors had to decide whether the programs they put in place were the right solutions for the times. Today, as we look past the end of a century and into the dawn of a new millennium, we have to make the same decision. Does the provision of E-reserves fit the needs of our students in today's society? At IUPUI, this answer is an overwhelming "Yes".

Figure #3: Status of Copyright Permission, Spring 1999 Semester.



NOTES:

1. "Mark Twain in Copyright Law," New York Times, December 25, 1881, quoted in *Mark Twain Speaks for Himself*, edited by Paul Fatout, Purdue University Press, 1978. pp. 132.

2. For the document on fair use developed jointly by the IUPUI University Library and the Copyright Management Center, see http://www.iupui.edu/~copyinfo/ereserves.html

TRADEMARKS: MORE THAN MEETS THE EYE

by Phyllis Karrh, Reference Librarian
Robin Kelley, Reference Librarian
Business, Science and Technology Service Section
Indianapolis-Marion County Public Library
40 East St. Clair Street
Indianapolis, Indiana 46204

You have thought long and hard about what you want to name the product you have developed or the service you are providing. You have already started advertising, you have had someone design a dynamite letterhead, and your customer base has begun to grow, thanks to your brilliant business acumen. Then one day you receive a letter informing you that the business name you have chosen is already being used. They also inform you that they consider your use of the name to be an infringement of their trademark. Cease and desist, they request, or big trouble will be sent your way. Yikes! You never thought to conduct a search for conflicting marks! Your choice of name, which you thought was unique in the annals of global business, has unfortunately trodden smack dab on another company's name. In short, they beat you to it. After all of your work, you will have to step backwards and come up with a new name.

If you want to prevent this sad scenario by protecting a distinctive name, design, logo, slogan or even the color of the packaging or container, distinguishing it from others' products or services, you had better apply for a trademark or service mark. A trademark is used to distinguish one company's products from others in the marketplace and a service mark does the same for a company's services. If you plan to market across state borders and wish to be protected in all fifty states, you should apply for a federal trademark with the U.S. Patent and Trademark Office. If, however, you are only interested in doing business in Indiana, you may apply for a state trademark. To apply for the federal mark, you are permitted to be intending but not yet using the mark in commerce. However, for the state trademark, you must already be using the mark and provide proof that you are. The federal marks cost $245 to register in one class of goods or services, while the state marks cost $10. Both have terms of 10 years, renewable indefinitely. During the sixth year of a federal trademark, the registrant must file a statement of use in order that the mark does not lapse. For the state, you would call the Secretary of State's Office, Trademark Division, where they will do a preliminary search for you. There are plans to allow individuals to do their own searching in the future. Contact them for more information at (317) 232-6540 or visit them on the web at www.state.in.us/sos/bus_service/corps/tmgreet.html.

We can construct a scenario where the proper steps are taken. Suppose that you operate a building demolition service that is going great guns, so much so that you have decided to buy some wrecking businesses in adjacent states, operating them as a chain. Suddenly, in the middle of the night, you "dream up" the world's finest service mark for your business—"Edifice Wrecks." Nobody could be as creative as you are to think up such a clever name! You have read a little about trademarks. You know that McDonald's golden arches are protected by a trademark, as is the Olympic symbol of connected rings. You have also read that Kodak's film package, its "trade dress," is trademarked and, naturally, nobody in their right mind would name their mechanic's rags "Kleenex" or their cloning services "Xerox." So you decide that you should protect your great name from trademark infringement by getting a mark for your company like the big boys.

Your plan, then, is to check to see if there is either a state or a federal trademark that you would be infringing if you named your business "Edifice Wrecks." You must call the state trademark office and confirm that the name is clear. Then you can either go to a library which has the CASSIS trademark searching disks provided by the U.S. Patent and Trademark Office or you can access the PTO's web site at www.uspto.gov and do what is called a "Combined Marks Search." The safest way to search is to do some serious playing around with the keywords of the aspiring mark. First, put in the mark as you want it to be. If that comes up with no hits and if your proposed name has more than one keyword, then type in one word at a time. Look at any marks which use the individual words, truncating with the asterisk if it makes sense to do so. Check both registered and pending marks with the "Combined Marks Search", which will pick up translations of foreign marks and "pseudo-marks," which are those cute, alternate spellings for the same sound, such as Easy, EZ, Eze, EeeZee, and Easi. The problem is that the search will not necessarily pick up *all* of the variations, so the searcher needs to enter any alternate

spellings he or she can think of. Our mark, for instance, could be Wrex rather than Wrecks. Maybe a "Combined Mark Search" would pick up Wrex and "normalize" it to Wrecks, maybe not. Perhaps we decide Wrecktec is another possible choice. We need to try it as both one word and as two. Also, we would need to spell –tec as –tek, as -tech, and maybe even as -tex, since the Trademark Office considers that a mark that sounds similar to an existing mark is not necessarily registrable. Just misspelling a word does not cut the mustard with the Trademark Office, so beware of sound-alikes.

Here is an example of a sound-alike, a "too close for comfort." In August 1999, the *Indianapolis Star* reported that Eli Lilly filed a lawsuit against two companies using brand names that are not Prozac, but which sounded too much like the drug name to be acceptable to Lilly. One is NuZAC and the other is ProTrac. They infringe, the lawsuit claims, not only because they sound like Prozac, but because they are purporting to be remedies for depression and anxiety. These brand names could lead a consumer to think that these are "natural" versions of Prozac. The Trademark Office terms this conflict between marks "confusingly similar." A consumer would be confused because they would associate the goods or services of one company (the one that produces NuZAC and ProTrac) with the goods or services of another company (Eli Lilly). The marks need not be identical, nor do the goods and services need to be the same. However, if ProTrac had been a mark identifying a rubber conveyor belt, Eli Lilly would probably not be filing a lawsuit, because the company would not be concerned about the likelihood of confusion and that people would think that Lilly produced the conveyor belt. It is more likely that confusion would ensue if the two marks had the same potential purchaser or if the products or services were in the same market. Maidenform makes underwear, and it is doubtful they would tolerate another company, Manlyform, that made men's shorts or a company called Maidenform that made sweaters. However, if a company called Maidenform made store mannequins, they might ignore it, but maybe not. It depends how touchy a company is about the strength of its mark. In fact, there are statutes in the majority of states applying only to well-known marks that prohibit little guys from using marks that would make it more difficult for the consumer to distinguish the famous companies' marks from our more recent innovations. Nor may we undermine or tarnish the big companies' images by naming our new condom, for example, "Microsoft."

Before you commit yourself to spending money for a federal trademark, perhaps you should consider what benefits you gain for your money. Eli Lilly's lawsuit is demanding that the infringing company not only stop using the two product names, but also that the company turn over to Lilly any profits that they have made on their products. On the other hand, when the company Streamline, which produces the hair restorative, Rogaine, sued a company for calling their product "Regaine", the infringing company simply entered into an agreement to stop using their product name commercially. What these two companies are doing are examples of the 1946 Lanham Act in action. The statute provides the opportunity to register a trademark and also provides court remedies for infringement of distinctive marks. One can ask for treble damages or be awarded the defendant's profits plus attorney fees. Wow, you say, I hope someone infringes my trademark, and I will rake in all their profits plus mine, too! Well, surely it is not as easy as that, but at any rate, if you have not registered your mark, such generous remedies are not available to you. Even if you do not register, you can request that another company not use your trademark or a mark confusingly similar to yours by claiming that you have common law rights to the mark, having used it before they did. In the U.S., we recognize "first to use." You may have to go to court to enforce the ban, but indeed, just using the mark itself is the act that confers ownership. It is relatively easy for the infringing party to have checked the federal and state trademark registers, but if you are claiming common law rights, it is harder for others to know that the name is "taken" and that they should not use it in commerce. Therefore, if you want to make as public as possible that you want nothing to do with that most improbable of improbable situations, namely, that someone was as clever as you and thought of that mind-bogglingly distinctive name for a demolition business, then you had better apply for a trademark. Besides, just putting a TM or a SM after your mark, because you are saying that you are using the name in the context of a trademark, does not get you in the Trademark Register. If you want that R with the circle around it, you are going to have to go through the necessary registration procedures.

This all makes clear that you also need to look at sources other than the trademark databases when you name your service or product. Look on the web for your mark, and also go to the library to look in company databases such as *American Business Disc* or *D&B Business Locator* to see if your company name is listed. If it is not, then you have a pretty good chance that the service mark is clear for use. If it is not clear, you must decide whether a similar mark owner in California, for example, would pursue litigation against you or not and whether you want to take a chance. If there is no geographical conflict, your activities using the name might be ignored. For product names, besides the web, check your library for lists of brand names, which may or may not be registered, in Gale's *Brands and Their Companies* or in the *Thomas Register of American Manufacturers* or *MacRae's Blue Book.*

The Trademark Office does not look upon all marks as equal. They emphasize that a strong trademark that can be defended is one that is distinctive. We do not have much trouble in the line of distinctiveness for our mark, "Edifice Wrecks." A product or service name should be unusual or sort of strange for the context, coined or fanciful. Such distinct marks are legally more secure and easier to defend, so that coined words like Kodak or Prozac or fanciful names, such as Hard Rock Café, are considered strong marks. Weak marks would include surnames, geographical names or marks simply describing the product or service, such as Smith's Auto Body, Indiana Finance or Cellular Phone Sales. Of course, once one of these "weak" marks becomes well known over time, even surnames, such as McDonald's, Campbell's or Disney, or geographical names, such as American Airlines, are recognized as very strong marks. The Trademark Office prohibits marks that disparage people, living or dead, which we are not guilty of with the mark that we have chosen. Nor are we using a famous person's name without his or her permission. You must have the consent of a living person to use his or her name, so we would not name our printer cover "The Bill Gates Cover-up." We are not allowed to be immoral, deceptive or scandalous, nor may we use national symbols or insignias. Good, honest folks that we are, we simply want to name our services cleverly, not maliciously.

When you get ready to file for the federal trademark, you can get the relevant form from the PTO web site and fill it out or you may fill the form out online and submit it electronically to their site. You can get a hard copy of the form and the *Basic Facts about Trademarks* brochure by calling the Patent and Trademark Office at (800) 786-9199. The mark will be published for opposition in the *Official Gazette* where anybody, even if their mark is not federally registered, may oppose the mark being placed on the register on the grounds that it would be confusingly similar to their own. If approved for registration, the mark is eligible for becoming incontestable after being continually used for five years after registration. It becomes "abandoned" if not in use for three or more years. However, the owner could bring it to life again and begin using it as before.

You now know how you are supposed to do a search for a conflicting mark and that time is of the essence. You use the company databases already mentioned that list millions of businesses and unfortunately there is already a company out there using your name! Reeling from the shock, you manage to note that the company is in Massachusetts. Since that state is far from Indiana and may have a much different business clientele, you decide to assume that the company will not notice. However, since you know that a registered trademark gives this business the right to use the name nationwide, you brace yourself and check the federal trademarks. Yes, indeed, the business registered in 1998 and has been using the mark in commerce since the end of 1991. Crestfallen, but informed, you begin searching your next best choice, "Tyrannosaurus Wrecks."

PATENTS FOR THE SPORADIC SEARCHER

by Adele Hoskin, Adjunct Lecturer, Indiana University School of Library and Information Science

INTRODUCTION

Patents are an important component of intellectual property law. In the past, patents were of interest to the research and development areas of a corporation, because patents were the source of new inventions and technology. Today, patents are managed as assets to the entire organization because the patent portfolio is an indicator of future strength. Together, corporate management and R&D plan strategies for the patenting of an invention. Such strategies include the timing of the filing of the patent and the countries where the filing will occur. Global business requires global patent management. The role of the information professional is to understand the patents and the patenting process so that he or she can provide support for patent management.

What are patents? Why are they important? How is information about patents obtained? This paper will provide a beginning to the patent journey, that is, an overview of the filing (prosecution) process, the information contained in the patent, and suggestions for searching. Finally, this paper will provide sources and exercises to further the reader's knowledge of patents and patent searching.

WHAT IS A PATENT?

A patent is a legal document granting a limited monopoly for a period of time to the holder of the patent in exchange for the disclosure of information about the invention. The authority for United States patents is from the U.S. Const. Art. 2, sec. 8, clause 8. That clause is

"The congress shall have the power to promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries".

A patent granted in the U.S. after June 8, 1995, provides the owner the right to ***exclude others from practicing, making, using, or selling the invention*** for 20 years from the date of the application for the patent. The June 8 date resulted in trade agreements with the World Trade Organization (WTO) affecting intellectual property.

The patent statute is 35 US Code. The Rules of Practice is 37 Code of Federal Regulations. For an invention to be patented, the invention must be useful, novel (35 US Code. Sec. 102), and non-obvious (35 US Code. Sec.103). The standard for novelty is "not known in US or other country or in use prior to 1 year before filing." The standard for unobviousness is the invention is not obvious "to person having ordinary skill in the art."

Simply put, the process of patent prosecution is to reduce the idea to practice and submit an application to the U.S. Patent and Trademark Office (USPTO). The application, detailed in 35 US Code. Sec. 112, must include the identification of the inventor(s), the enablement/best mode, a drawing, and a claim. The specification, which is detailed in 35 US Code. Sec.112, shall describe the invention "in exact terms as to enable any person skilled in the art to which it pertains...and set forth the best mode contemplated by the inventor." The claim must contain language that will be "particularly pointing out and distinctly claiming the subject matter." (35 US Code. Sec 112). If these elements are present, a serial number and application date are issued. The application date may or may not be the priority date. The priority date is an initial filing date of a patent application. The priority date may be received from a filing in another country. The priority date allows the inventor to establish the novelty of the invention. The application is then assigned to a patent examiner, who reviews the application for usefulness, novelty, and nonobviousness. The inventor and the examiner have correspondence and discussions about the invention until a decision is made either grant or abandon the patent. Any information concerning the application, including the application itself, any amendments, and all correspondence between the inventor and the examiner, is not public until the granting of the patent. The file, which contains this information, is called the patent wrapper. In the U.S., the granting of the patent is the first publication of the patent. Actually, the inventor has already received a notice of allowance. The actual issue date is determined after the fees are paid.

The U.S. patenting process differs from the patenting processes in other countries in that the U.S. does not publish the patent application, only the granted patent. Also, the U.S. is a "first to invent" rather than a

"first to file" country. If there is interference (two patents with competing inventions), the first to invent will prevail.

The inventor may file the patent application or the inventor may use a Patent Agent or a Patent Attorney. The Patent Agent is a person with a technical background who has passed the Examination For Registration To Practice Before The U.S. Patent and Trademark Office. A Patent Attorney is a person who is an attorney with a technical background who has also passed the Examination For Registration To Practice Before The U.S. Patent and Trademark Office. The Patent Agent may practice only before the USPTO, that is, the agent may work with the inventor and the patent examiner until the patent is granted or abandoned. The Patent Attorney may perform these same tasks, as well as participate in any litigation after the granting of the patent.

In a granted patent, the inventor has the ***right to exclude others from making, using, or selling the patented invention throughout the U.S.*** The claims in the patent define the metes and bounds of the patent. The interpretation of claims lies solely within the power of the court. To maintain enforceability, the owner of the patent must pay appropriate fees to the USPTO. If the fees are not paid, the patent is no longer in force.

Once a patent is granted and the appropriate fees are paid, any enforcement is decided by the courts. The party that initiates the suit alleges infringement, that the defendant is practicing the invention without permission, while the defendant alleges that the patent is invalid. The case is heard in the District Court; on the appeal, the case will go to CAFCA and then to the Supreme Court.

New U.S. patents are announced Tuesday at noon and are available on many of the databases by Thursday of that week. The announcement is in the U.S. Patent and Trademark Gazette published weekly by the USPTO.

WHAT CAN BE PATENTED?

There are three kinds of patents: Design, Plant, and Utility. Design patents are "any new, original, and ornamental design for an article of manufacture."(35 US Code. Sec. 171) The patent has a claim, and a drawing and the term is 14 years. Plant patents are awarded to whomever "invents or discovers and asexually reproduces any distinct and new variety of plant, including cultivated sports, mutants, hybrids, and newly found seedlings, other than a tuber propagated plant or a plant found in an uncultivated state."(35 US Code. Sec. 161) Utility patents are "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof." (35 US Code. Sec. 101) This paper will concentrate on searching and locating utility patents.

Utility patents are mechanical, electrical or chemical. The kinds of things that cannot be patented are laws of nature, mathematical algorithms, and things that occur in nature. Biotechnology patents occur here, not in plant patents, because they are a new composition of matter.

INTERNATIONAL PATENTS

Since each sovereign nation retains the right to grant patents, there are no international patents. This means that no patent granted by one sovereign nation is enforceable in another sovereign state. For example, a valid U.S. patent is not enforceable in Japan or any other country. However, since the Paris Convention for the Protection of Industrial Property in 1883, harmonization efforts have progressed. Harmonization is an attempt to bring patent laws into some kind of unity. From the Paris Convention, eleven countries agreed that an inventor who files a patent application in any of the participating countries may use that date to establish priority for other filings within those countries and foreigners have the same rights as nationals to establish priority.

More of the harmonization continues to be standardizing the beginning of the process. The same requirements for an application allow for one application to be used in several countries. The Patent Cooperation Treaty (PCT) in 1979 provided for the application to require similar elements – identification of the inventor(s), a specification, a drawing, and a claim. Although the official office of the PCT is in Switzerland, filings may be made in the U.S. at the USPTO and in Tokyo at the Japanese Patent Office to obtain filing and priority dates. PCT is an application process only. Patents are never granted by PCT. Patents are actually granted by participating countries. An inventor may file a PCT application, designating several countries, and then each country must examine the patent application. The PCT application is published 18 to 24 months after filing. These applications are made public on Thursday. More information about PCT is available on the website, http://www.pct.org.

One entity that transcends political boundaries is the European Patent Office (EP). This office accepts applications and will grant patents that are enforceable in several countries. The EP applications will be published 18 to 24 months after filing and are made public on Wednesday. Nineteen countries participate in this process and the list is available at http://www.epo.org/. Each application must be examined and will be granted or abandoned.

With the globalization of commerce, several of the treaties negotiated contain regulations for intellectual property. With NAFTA and the new WTO agreements, the US patent laws had to be changed to accommodate the treaties. The most significant change involved the alteration of the patent term from 17 years from date of grant to 20 years from date of application.

This has been a cursory overview of the major patenting offices. Other patent conventions are developing, such as the African Intellectual Property Organization (OAPI) and the African Regional Industrial Property Organization (ARIPO).

BASIC PARTS OF THE PATENT OR PATENT APPLICATION

The basic parts of the patent or patent application include the identification of the inventors, the filing date, the title, an abstract, background, a summary, a brief description of the drawing, detailed description, and the claim or claims. The title on a patent is often too short or too general to yield much information. The abstract enables the reader to ascertain the purpose of the patent. The background section provides specific details of the prior art and will often include references to prior journal articles and patents, along with analysis of the problems encountered in the prior art that are alleviated by the present application. The summary of the invention succinctly states the nature and purpose of the invention. The drawing accompanying the application is described. A detailed description explains how to make and use the invention. The claim or claims must precisely define the patent.

The front page of the patent document contains the title, the name of the patent owner (at the time of granting), inventors complete name, serial numbers, and dates (application, priority, and issue), the abstract, patent classification numbers (International and National), patent examination information (field of search, cited patents). On the front page of the patent, each of the parts has a number in a bracket called an INID (Internationally agreed Numbers for Identification of Data) codes. These codes were established by WIPO and the World Intellectual Property Organization and are consistent across patent publications. For instance, [54] is the title, [11] is the patent number, and [45] is the date of the patent. This standardization is useful for finding numbers or other information on patents without knowledge of the language of the patent.

WHY SEARCH PATENTS?

Patents contain a wealth of information that never appears in other sources of technical information. The USPTO estimates the amount to be as high as 70 percent. Searching the content of the patent provides the searcher with a variety of information. The information may be the directions for making a product or a state-of-the-art analysis in a subject area. Also, since patent protection provides a competitive advantage to an organization, the enforcement of that patent is important, and conversely, if the patent has expired, the invention may become a business opportunity. Therefore, searching for patent information is approached differently with different purposes.

To discover the legal status of the patent, that is, is the patent in still in force, have the fees been paid, or has the court declared it invalid? The answers to these questions are of interest to organizations, which want to make or use the invention. In addition to contacting the specific patent office, several databases provide this information.

Another approach is to search the content. The inventions themselves are of interest because of new technology. A search of the content provides a snapshot of the state of the art in that technology. Also, searching the content for specific areas provides information about who is working in this area and is the basis for competitive intelligence.

SEARCHING THE PATENT LITERATURE

Journal literature is theoretical, is subject to peer review, has systematic nomenclature, indexes entire documents, and uses systematic indexing. Those who have searched MEDLINE and used MeSH (Medical Subject Headings) know how comforting it is to search knowing that the terms are consistently applied throughout the database. Chemical Abstracts, with its chemical structure searching and registry number system, also promises reliable indexing across the database.

Patent literature, on the other hand, is practical and generic in scope, has highly stylized language, has creative nomenclature (the inventor is his own lexicographer), and indexes only what is in the claims. Patent offices devised classification schemes for their own internal use. Fortunately, an International Patent Classification scheme has been introduced and is widely used. This classification scheme is revised every five years by WIPO. The U.S. continues to use its own classification scheme and U.S. patents will have two classification numbers on the front page. Both of these schemes are hierarchical. These classification schemes are available in print or CD-ROM versions. While the classification schemes are updated and revised, the patent retains its original classification once it is published. Classification schemes work with the mechanical and electrical patents quite well. For chemistry, the chemical substructure programs developed by Chemical Abstracts, DerWent Publications, and Questel/Orbit provide powerful searching tools for new chemical entities.

In searching the patent literature and looking at the technical content, the searcher may be doing a state of the art analysis by seeing what has been patented recently. The search may also be trying to discern whether this invention is patentable. In this case, the searcher is hoping to find nothing, but must be exhaustive in the searching process. The searcher might be looking for information on how to make something – the technical information. The classification schemes available are too general and too inconsistent.

SEARCHING FOR US PATENTS

A searcher could go to the USPTO and conduct a search. The information is organized by the U.S. classification scheme. A searcher goes to that area or "shoe" and literally looks through the printed patents. For librarians, two problems are readily apparent - misfiled patents and missing patents. The USPTO has an electronic system specifically for in-house use and a full text search system on the USPTO website (http://www.uspto.gov/patft/index.html).

Patent and Trademark Depository Libraries also have all of the U.S. patents on CD-ROM or microfilm. The Indianapolis-Marion County Public Library (IMCPL) Central Branch is such a library and has personnel trained to aid in patent searching.

SEARCHING THE PATENT DATABASES

The databases that have patent information will contain legal status information, bibliographic information, subject information, full-text, and full-text with images. Obtaining information from the patent databases provided by the commercial vendors – DIALOG, STN, QUESTEL-ORBIT – utilizes field-directed searching, set building and manipulation, multi-file searching, and cross-file searching. The content providers – Chemical Abstracts, DerWent Information, IFI, INPI, and INPADOC provide extensive indexing of the patent unit record. The fields in most patent records are application information (country, date, inventor, assignee); dates (priority, application, granted,) for all countries; published information (granted, status, patent number, assignee, claims, reexamination information); and content (subject keywords, chemical substructure, and classification codes). The description for these major databases can be found in the database summary sheets for DIALOG, Questel/Orbit, and STN.

DerWent Information, Ltd., produces World Patents Index (DIALOG, Questel/Orbit, STN), U.S. Patents (Questel/Orbit), Patent Citation Index (DIALOG, Questel/Orbit, STN), Biotechnology Abstracts (DIALOG, Questel/Orbit, STN), and GENESEQ (STN). Chemical Abstracts produces USPATFULL (STN), CA File, CA Plus (STN), MARPAT (STN), and CA SEARCH (DIALOG). Other patent databases are IFI/Plenum's PATFULL (DIALOG) and CLAIMS (DIALOG, Questel/Orbit, STN) and International Patent Documentation's INPADOC (DIALOG, Questel/Orbit, STN). These are the large general databases. Several specialty files are also available and information about these can be obtained from DIALOG, Questel/Orbit, and STN.

Successful searching for chemical entities must include using one of the chemical structure coding products. Chemical Abstracts (via STN) has two such routines: structure and MARPAT. DerWent Information has the fragment code and a MARKUSH product. DerWent coding is available via STN, DIALOG, and Questel/Orbit. MARKUSH is available via Questel/Orbit. In chemical structure searching, a MARKUSH structure is a general structure for a chemical entity, with descriptions of the variations of bonds, atoms, and functional groups. The chemical program to search general structures is called MARKUSH for the DerWent version and MARPAT for the Chemical Abstracts version. Both vendors provide extensive training for information professionals.

Another type of information that can be obtained from these databases is patent family or equivalent applications. Patent family information, as described below, is that information that shows the countries where the application was filed and when and if a patent has been granted.

The Internet patent sites have arrived on the scene within the last two years and provide more ease in finding patent information. These sites are great because the actual patent can be seen and copied. However, the search engines for these sites are not as sophisticated as for the commercial sites. Also, each site has to be searched individually. The information from one site cannot be searched in the other.

SEARCH EXAMPLES

Novelty searches: As previously mentioned, patent searches can be grouped into several groups. The first is the novelty or patentablility search. This search answers the question – Is this invention known? The information searched is not only for that idea but also any similar ideas or inventions. The search is not limited to only the recent patent literature; the search must encompass the journal literature and other sources of information. The search is not limited to years, so information that is not in machine-readable form must be searched. A comprehensive search is conducted by the person/company pursuing the possibility of applying for a patent. After a patent application is filed, the examiner also conducts an exhaustive search of the prior art.

Infringement Searching: Infringement searches are intended to look for new products or repackaged

products that might infringe on the patent. Searching needs to be done only for patents in force in the areas where the new product is active.

Validity/Opposition: Here the searcher, who is probably not acting for the owner of the patent but for another party who is interested in the technology, is searching all of the literature at the time of the patent for novelty or nonobviousness.

State-of-the-art: The searching is done for a background to see what the business environment looks like for new and forthcoming products.

Alerting: This type of search looks at new patent publications (both granted and applications) for new entities altogether or for new publications of competitors.

Family and equivalent searching: The example below is from DIALOG®File 351:DERWENT WPI bluesheet unit record to show the patent family. In the DerWent system, the first patent application that is published becomes the basic patent from which the bibliographic and content indexing information is obtained. As other patents or patent applications from the same invention appear, a family develops. The commonality is based on the priority filing. Each family member cites the same priority information. In this case, it is a US priority of 19900222. DerWent accumulates this information into the patent record. In the example below, a patent number WO9112850 is the basic number. Although there are no world patents, the two-letter designation "WO" is from the PCT filing at WIPO. The two letters at the beginning of the patent number indicate the country of the application. In this example, WO is the PCT application, AU is Australia, US is the United States, EP is the European Patent office, JP is Japan, and DE is Germany. The EP also shows the designated nations where the filer wants protection. The letter following the number is the kind code, which can be decoded on the databases. Kind code "A" usually means an application, except for the US, where that is a granted patent. The kind code "B" indicates a granted patent and the date of the grant. The other columns provide the application number, the date filed, and the main International Patent Classification code. In later records, the language of the application or patent is given. From the example, it is apparent that the EP patent has been granted. For content, either the application or the patent will provide the necessary information. For information about what is enforceable, the claims of the granted patent must be examined. The patent family information can provide a language equivalent to examine, rather than requiring that a potential inventor or company pay for a translation in the preliminary stages.

```
  NP=   Number of Countries: 017  Number of Patents: 008
      Patent Family:

     Patent No  Kind  Date   Applicat No Kind  Date   Main IPC  Week

    WO 9112850  A  19910905                                    19913B
Designated States (Regional): AT BE CH DE DK ES FR GB GR IT LU NL SE
    AU 9173372  A  19910918                                    199150
    US 5092332  A  19920303 US 90483455  A  19900222          199212
    EP 516699   A1 19921209 EP 91904930  A  19910206 A61N-001/05
199250
   Designated States (Regional): DE FR GB IT NL SE
    JP 5504495  W  19930715 JP 91504692  A  19910206 A61N-001/30
   199333
   AU 648782    B  19940505 AU 9173372   A  19910206 A61N-001/05
   199423
    EP 516699   B1 19940824 EP 91904930  A  19910206 A61N-001/05
199433
Designated States (Regional): DE FR GB IT NL SE
    DE 69103623 E  19940929 DE 603623    A  19910206 A61N-001/05
199438


Priority Applications (No Kind Date): US 90483455 A 19900222 ; WO
91US810   A  19910206
```

Classification Scheme searching: Although the individual patent authorities assign a classification code that is published with the patent or patent application, the schemes are constantly revised as technology changes. To do a search using the codes, the searcher must have the latest edition of the code and its changes close at hand. The USPTO web site has an overview of the classification system for retrieval.

SEARCHING PATENTS ON THE INTERNET

Searching patent information on the Internet has become more sophisticated within the last two years. The Internet sites described below provide full-text searching, front page searching for free, and document delivery; the searcher can either order from the supplier or print using the browser. These sites provide content, bibliographic searching, and document delivery. Comprehensive chemical searching still needs to be performed on Chemical Abstracts and DerWent World Patent Index.

USPTO - Welcome to the USPTO Web Patent Database
http://www.uspto.gov/patft/index.html

This database can be searched two ways: Full-text or Bibliographic (front page only). Both databases support boolean, manual or advanced, and patent number. The database includes utility patents back to 1976, design patents back to 1976, and plant patents back to 1976, as well as reissues, defensive publications, and SIR (statutory invention registrations). U.S. Patent Classification data in the full-text database (Issued U.S. Classification) correspond to classification data that appear on the printed patent and may not match current classification data. U.S. Patent Classification data in the bibliographic database (Current U.S. Classification) has been updated to reflect the most current Master Classification File (1 July 1999) and may not match the classification data that appears on the printed patent. The fact that an invention cannot be found by searching in the PTO's patent databases does not mean that the invention is patentable. A complete patentability search must consider all prior art, including earlier patents, foreign patents, and non-patent literature.

IBM Intellectual Property Network - http://
www.patents.ibm.com/

This site contains several databases. The patent collections available for searching are U.S. Front Pages, U.S. Front Pages & Claims, U.S. Titles & Abstracts, U.S. Inventors & Companies, Espace-A (Applications)(1979-), Espace-B (Issued)(1980-), Patent Abstracts of Japan, and WIPO PCT Publications (1997-). All U.S. databases are from 1971 to the present. In addition to searching patents, this site also has documents that can be viewed using a standard web browser. They are US 1974-, ESPACE – EP-A (1979-), Ep-B (1980-), and PCT (1998-). The fields that are searchable are title, inventor, assignee, abstract, claims, agent, and combinations of these fields. This site has bi-directional hyperlinks on all patents to provide easy access to a referenced patent or to all other patents that reference the original.

The following sites provide full text searching and document delivery for a fee.

QPAT (http://www.qpat.com/) has full-text of U.S. patents from 1974.

Chemical Patents Plus (http://casweb.cas.org/chempatplus/) offers full-text for all classes of patents issued by the U.S. Patent and Trademark Office from 1975 to the present, including partial coverage from 1971-1974. Complete patent page images are available for patents issued from 1 January 1995.

Micropatent (http://www.micropat.com) provides access to U.S. Patents, European Patents (applications and granted) and PCT applications.

Patent Explorer (DerWent) (http://
www.patentexplorer.com/) provides access to U.S. Patents, European Patents, and PCT applications.

SUMMARY

This paper has been a quick overview into the world of patents and patent searching. The information is fascinating and searching is challenging. Exercises, tutorials, websites, and a bibliography have been included for further information.

TO GET STARTED:

Patent Searching Tutorial (http://
www.lib.utexas.edu/Libs/ENG/PTUT/ptut.html) presents the basics of patent searching. The specifics were written for patrons of the Patent and Trademark Depository at the Richard W. McKinney Engineering Library, the University of Texas at Austin.

PIUG Patent Information User's Group (http://
www.piug.org). PIUG is an organization of individuals having a professional, scientific or technical interest in patents. Through this forum and discussion, PIUG tries to promote and improve retrieval and dissemination of patent information.

EXERCISES

1. What is the design patent for the Steinway piano, the Rhapsody? Ans. Design patent 414797

2. I noticed that on the Furby box, it said patent pending. Is it possible to find the patent? Look for assignee Tiger Electronics.

3. Is there a patent for a rose named Lady Diana? Ans.USPP005360 issued to Lowell L Hoy, Jr. of Richmond IN.

4. What did Lanny Potts invent? Ans. Exercise equipment assigned to Stairmaster Sports Medical Products, Inc.

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U.S. Constitution, Article 8

US Code – Title 35 – Patents

USPTO Patent Class Definitions: http://www.uspto.gov/web/offices/pac/clasdefs/index.html

VENDORS

STN (http://www.cas.org) - provides online access to scientific and technical information

Dialog (http://www.dialog.com)

Questel-Orbit (http://www.questel.orbit.com/)

CONTENT PROVIDERS/DATABASES

Chemical Abstracts (http://www.cas.org), supplier for chemical and related information.

DerWent (http://www.derwent.com) Derwent World Patents Index (DWPI), produced by Derwent Information, provides access to information from more than 18 million patent documents, giving details of over 9 million inventions. Each week, approximately 20,000 documents from 40 patent-issuing authorities are added to DWPI.

CLAIMS from IFI is a database of US chemical patents from 1950. Mechanical and electrical patents were added in 1963 and design and plant patents from 1976.

INPADOC is a family and legal status database produced by the European Patent Office. The database consists of patent family information from 66 countries and organizations and legal status information for 22 countries.

PATENT OFFICE WEB SITES

European Patent Office (http://www.european-patent-office.org/index.htm)

Japanese Patent Office (in English) (http://www.jpo-miti.go.jp/)

United States Patent and Trademark Office (http://www.uspto.gov)

World Intellectual Property Organization (http://www.jpo-miti.go.jp/)

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by Carole Gall, Director of Collection Management
Ruth Lilly Medical Library
975 W. Walnut St. IB310
Indianapolis, IN 46202-5121
cfgall@iupui.edu

As libraries borrow materials, they are required by the U. S. Copyright Act of 1976 to record data in order to pay copyright fees. The data that forms a copyright report has the dual purpose of assisting the librarians responsible for managing journal subscriptions and preparing collection development budgets. An outcome of journal subscription selection can be the decision not subscribe to a journal and instead to rely on just-in-time article delivery and/or table-of-contents alert services. Thereafter, the copyright report can be used to monitor the balance between journal subscriptions and article delivery services.

BACKGROUND

The number of interlibrary borrowing transactions skyrocketed from 1986 to1996, showing a 116% increase for borrowing by Association of Research Libraries. In the past decade, interlibrary borrowing has remained constant at one-half photocopies of journal articles and one-half books. (1) The dramatic increase in interlibrary borrowing is partially the result of libraries shifting from buying print and electronic materials for their collections in favor of just-in-time delivery. "As local libraries cut back their scientific subscriptions, the collections grow more homogenous," according to Duane Webster, Executive Director, Association of Research Libraries. (2) Consequently, more borrowing occurs for the unique items that library customers request.

The cost of borrowing a journal article varies. In 1998, Mary E. Jackson studied high-performing interlibrary loan-document delivery operations in research libraries. She concluded that "[t]he average borrowing unit cost for the 25 high-performing research libraries is $11.94, 35 percent less than the $18.35 average borrowing unit cost for all 97 research libraries." (3) She shares her expertise on contemporary interlibrary services in workshops throughout the U.S., including one sponsored by the Indiana Cooperative Library Services Authority (INCOLSA) on April 28, 1999.

As libraries borrow materials, they are required by the U. S. Copyright Act of 1976 to record data in order to pay copyright fees.(4) These fees may be paid through the Copyright Clearance Center (CCC), a not-for-profit clearinghouse for photocopy authorizations for over 1.7 million titles. (5) The CCC Titles and Fees lists the charges due and explains how to pay the fees. Also, the Commission on New Technological Uses of Copyrighted Works (CONTU) Guidelines were developed to assist librarians. CONTU guidelines stipulate that the borrowing library must retain records of all the journal requests for three complete calendar years. The Rule of Five from the CONTU guidelines is that libraries should pay a fee to the CCC once a library's borrowing has reached five articles from the last five years of a given title in a given calendar year. (6) For more information, see http://www.iupui.edu/~copyinfo/uscopy.html.

DATA GATHERING ON JOURNAL BORROWING

As interlibrary borrowing is recorded for the purpose of paying the copyright fees, this same data identifies the journal titles that library customers find relevant, but not available, in the library's print or electronic journal collections. Borrowing reports are useful for a library of any size. Borrowing data in electronic format is available from the web for libraries that use OCLC, a major vendor of interlibrary services. Several companies have developed interlibrary service management software, such as Clio from Perkins & Associates, and most are compatible with Microsoft Access database management software.

Expertise in database management is becoming essential to develop and manage raw borrowing data to form useful, customized reports. Typical raw borrowing data which can be downloaded electronically includes the basic data elements of International Standard Serial Number (ISSN), journal title, number of interlibrary borrowing requests for a year, the date of publication of the journal article, and whether or not the journal title must be reported to the CCC. The usefulness of the reports depends on the sophistication of the software and the skill of the operator who is designing and implementing the software search queries. Soft-

ware such as Microsoft Access has the capability to combine multiple data elements into a formula and respond to search queries with instantaneous results.

DUAL PURPOSE OF DATA

The copyright report data has the dual purpose of assisting the librarians who are responsible for selecting journal subscriptions by identifying journals to consider for purchase. To improve the analysis process for determining new subscriptions, the file of copyright data can be enhanced by adding two data elements, the annual subscription cost of the journal and the copyright fee to be paid to the CCC.

There is extra effort needed to add these data elements to the existing copyright data file. Once the fee is determined for copyright reporting purposes, it requires minimal effort to input the fee into an additional column of the copyright data file for use in journal selection. The second additional column of data, annual journal subscription cost, usually can be downloaded from the library's subscription vendor(s). With these data elements, experienced searchers of database management software can perform the calculations needed in journal selection decisions. A small amount of data can be analyzed without the aid of a computer.

There is an assumption that underlies these reports. One assumption is that all the citings of a journal title were identified. Preferably, compilation and matching are done by ISSN numbers, rather than strictly by using the words in the journal title. The words in titles in the database may be abbreviated or not, be abbreviated differently, differ in the inclusion of articles and minor words (a, an, the, of, for), or be spelled or coded differently, all of which may jeopardize a thorough compiling of activity per journal title. The software sort capability may be sensitive to upper- and lower-case, numerals, symbols, hyphens, and spacing. Publishers change the titles of journals with some regularity. The safest way to find all the variations of a journal title is to match by ISSN.

COPYRIGHT DATA FOR JOURNAL SUBSCRIPTION SELECTION

A basic report from the enhanced copyright file shows the collection development librarian the journal title name, the number of articles borrowed, the copyright fee, and the annual subscription cost for the journal. In this report, there is one additional column of information that is generated by the result of the search query. The search query equation is composed of the number of articles borrowed times the copyright fee. This figure is then divided into the subscription cost. The resulting quotients are meaningless numbers until the numbers in the new column are sorted from smallest to greatest. The sort transforms the new data into a list of journal titles of high borrowing costs in relation to their subscription costs.

The results of the sort of this new column is a powerful identification tool for finding journal titles to be considered for purchase by the library. For several examples, see the first three entries in Table 1. Results from the enhanced copyright data file can be effective in persuading administrators, advisory boards, and library staff of the need to subscribe to a journal and to explain to library patrons why some journal titles are added to the collection while others are not.

A point worth emphasizing is the simplicity of data needed to create a cost relativity between borrowing and subscribing. Examples of the sorted data are presented in Table 1.

LOW BORROWING COST IN RELATION TO SUBSCRIPTION COST

Also of immense value is the opposite end of the sort that points to journal titles with low borrowing costs in relation to their subscription costs. For an example, see the bottom entry for *Journal of Pharmaceutical and Biomedical Analysis* in Table 1. Based on cost only, the report points to journal titles for which it is best to rely on just-in-time article delivery.

For those journals identified as having a low borrowing costs in relation to their subscription cost, the librarian may want to make library patrons aware of table of contents (TOC) electronic mail alert services. TOC services can usually be purchased from publishers or professional organizations. TOCs can be sent by email to those who sign up to receive a journal's table of contents. Many free TOC alert services are available. For a list and discussion of table-of-contents services, see the Ruth Lilly Medical Library web page developed by Colleen Method and the author at URL: http://www.medlib.iupui.edu/ref/toc.html .

SELECTION PROCESS FOR NEW SUBSCRIPTION:

The journal titles tagged for possible subscription should undergo the normal decision-making process for new subscriptions to the library. Criteria for selecting journals include curriculum support, indexing, whether similar information is already available, local availability of the journal title, and cost. (7) For selection criteria on electronic resources, see Polin Lei's web page on "University of Arizona Library Policy for Selecting and Acquiring Electronic Products - June 30, 1996." http://dizzy.library.arizona.edu/library/teams/iat/elecpub.htm .

CONCLUSIONS

Copyright data from interlibrary borrowing has a second purpose, which is to identify journals for the library to consider for subscription in print and/or electronic formats. When the copyright borrowing data file is augmented with copyright fee and subscription

cost information, the query results show borrowing costs in relation to subscription costs. Results can be effective in informing administrators, advisory boards, library staff, and library patrons concerning the decision to subscribe to a journal or to offer article delivery and/or table-of-content services. A point worth emphasizing is the simplicity of data needed to create a cost relativity between borrowing journal articles and subscribing to journals.

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3. Mary E Jackson, *Measuring the performance of Interlibrary Loan Operations in North American Research & College Libraries.* (Washington, DC: Association of Research Libraries, 1998): 55

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Table I: Cost Relativity Between Borrowing and Subscription Purchase

Journal Title	# of Articles Borrowed	Copyright Fee	# of Articles Borrowed Times Copyright Fee	Subscription Annual Cost	Relation of Borrowing Cost to Subscribing
Seminars in Urologic Oncology	9	$5	45	$142	3.1
International Journal of Gynaecology and Obstetrics	23	$15	345	$1,161	3.4
International Journal of Eating Disorders	19	$14	266	$940	3.5
Neuropsychologia	26	$15	390	$1,919	4.9
Journal of Molecular Evolution	16	$8	128	$1,125	8.8
Journal of Pharmaceutical and Biomedical Analysis	11	$15	165	$1,805	10.9

Manuscript Submission Guidelines

1. Manuscripts should be double spaced and submitted in one of two ways:
   a. Microsoft Word (preferred), Wordperfect, or plain ASCII text file on an IBM-compatible disk, accompanied by two paper copies.
   b. Microsoft Word (preferred), Wordperfect, or plain ASCII text file (IBM-compatible) attached to an E-mail message addressed to both sschlag@iupui.edu and twhitehd@doe.state.in.us.
2. References or endnotes should appear at the end of the manuscript; footnotes should not be used. Manuscript should conform to MLA style (Gibaldi, Joseph. MLA Handbook for Writers of Research Papers. 4th ed. New York: Modern Language Association, 1995.) Pages should be unnumbered.
3. Authors should be identified by a cover sheet with the author's name, position, and address. MLA style exception: Identifying information should not appear on the manuscript.
4. Photographs and illustrative material should be in black and white, and graphics should be of good technical quality. Visuals cannot be returned.
5. Authors are responsible for the accuracy of all materials including quotations, references, etc.
6. Upon publication, each author will receive two complimentary copies of the journal. No payment will be made for articles published.
7. The editors retain the right to edit manuscripts for clarity and style.
8. If you would like to discuss a possible paper or topic, contact the editor, listed on page 42.

Indiana Libraries

Indiana Libraries is a professional journal for librarians and media specialists. Published twice a year, it is a joint publication of the Indiana Library Federation and the Indiana State Library. Practitioners, educators, and researchers are invited to submit manuscripts for publication. Manuscripts may concern a current practice, policy, or general aspect of the operation of a library system in Indiana. The ILF Publications Committee is currently taking suggestions for subsequent themes for the publication. If you would like to discuss possible themes for the publication or have ideas for a paper, contact *Indiana Libraries* editor:

Emily Okada
Indiana University
UGLS Main Library W121
Indiana University
Bloomington, IN 47405
Phone: (812)855-9857
Fax: (812)855-1649
E-mail: okada@indiana.edu

All manuscripts should be submitted on a computer disk, if possible. The article should be double-spaced throughout with good margins. Writers should be identified by a cover sheet with the author's name, position, and address. Identifying information should not appear on the manuscript.

Photographs or graphics are welcome and should accompany the manuscript. Contributions of major importance should be 10-15 pages, double spaced. Rebuttals, whimsical pieces, and short essays should be 2-7 pages, double spaced.

Manuscripts will be acknowledged upon receipt, and a decision concerning use will be made 20 days after the date the manuscript is issued. The editor reserves the right to revise all accepted manuscripts for clarity and style. Upon publication, the author will receive two complimentary copies.

Indiana Libraries
Guest Editor Guidelines

1. It is important that each issue of *Indiana Libraries*, when not constrained by subject focus, represent all types of libraries. It is also important that each issue of *Indiana Libraries* be geographically representational. In other words, each issue of *Indiana Libraries* must be composed of articles about different types of libraries which have been written by members of the library community who are from geographically diverse areas of the state, in order to provide a diverse, statewide sampling of current research, articles, etc.

2. The guest editor of an issue of *Indiana Libraries* will work with the appropriate ILF unit(s) to produce a cooperative publication.

3. The guest editor of an issue of *Indiana Libraries* should have a professional background related to the scope of the issue, especially when dealing with technical or profession-specific topics.

4. The guest editor of an issue of *Indiana Libraries* must be prepared to review and edit articles for content, clarity, and style.

5. The specific terms and conditions of a guest editorship will be detailed in a professional services contract for that issue. The guest editor of an issue of *Indiana Libraries* will be required to sign the professional services contract with the Indiana Library Federation upon being selected.

6. All applicants must submit a letter of application and writing samples. The guest editor of an issue of *Indiana Libraries* must be an ILF member. ILF staff and/or the current volunteer editor of *Indiana Libraries* are eligible to apply for the position of guest editor of an issue of *Indiana Libraries.*

7. The ILF Publications Committee and executive office will interview each applicant for the position of guest editor and make a hiring recommendation to the ILF executive office and Board. The final and official decision will be made by the ILF Executive Board.

Adopted by Committee: 8/5/98
Approved by COES: 7/28/98
Ratified by ILF Executive Board: 9/9/98

Indiana Library Federation
Publication Subscription Information

Focus on Indiana Libraries

Focus is the Federation's newspaper. Published 11 times a year in cooperation with the Indiana State Library, it keeps members up to date on news and information of interest to the Indiana library community. Included are articles about innovative programs, upcoming conferences, continuing education opportunities, and legislative issues. A current listing of job opportunities in Indiana libraries is also included.

Publication Schedule: Monthly (April/May issues combined) **Subscription:** $15.00/year

Indiana Libraries

Indiana Libraries is a professional journal for librarians and media specialists. It is also published jointly by the Federation and the Indiana State Library.

Publication Schedule: Two issues per year **Subscription:** $10.00/year

To subscribe to either publication, fill out the information requested below and return with a check or money order to: Indiana Library Federation, 6408 Carrollton Avenue, Indianapolis, Indiana 46220. Questions should be directed to the Federation executive office at (317)257-2040.

Please make checks payable to the Indiana Library Federation.

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Business: _____

Department: _____

Address: _____

City, State, Zip Code: _____

I would like to subscribe to:

❑ *Focus on Indiana Libraries* $15.00/year

❑ *Indiana Libraries* $10.00/year

Total: _____

Return to: Indiana Library Federation ■ 6408 Carrollton Avenue ■ Indianapolis, IN 46220
Phone: (317) 257-2040 ■ **Fax:** (317) 257-1389 ■ **E-mail:** ilf@indy.net

About the Indiana Library Federation

The Indiana Library Federation is a statewide organization for library and media center professionals and supporters. It is the largest organization of its kind in Indiana, boasting more than 3,000 personal, institutional, and library trustee members. The Federation is also fortunate to have individual and corporate contributing members who support the organization's work.

The Federation is devoted to fostering the professional growth of its members and the promotion of all libraries in Indiana. It accomplishes its goals through statewide continuing education, public awareness, and library advocacy. The organization works to create a strong sense of unity within the library community. Members have the opportunity to become organized advocates for Indiana libraries. The Federation also offers members a number of opportunities for library leadership, professional growth, networking, and community service.

The Federation is governed by an executive board which is elected by the membership. The board is responsible for establishing direction, goals, and policies for the organization.

To achieve its stated purpose, the Federation participates in partnerships with other organizations. A long standing partnership with the Indiana State Library has resulted in joint publication of *Focus on Indiana Libraries*, the newspaper of the Indiana library community, as well as trustee education and training. The Federation has also worked with the Indiana Literacy Foundation, Indiana Health Science Library Association, Friends of Indiana Libraries, and The Children's Museum.

Committees

Various committees -- supported by a small professional staff -- do the administrative work of the Federation. These committees include: Archives; Awards & Honors; Budget and Finance; Annual Conference Planning; Constitution & Bylaws; Continuing Education; Financial Development; Insurance & Benefits; Intellectual Freedom; Legislative; Long-Range Planning; Membership; Nominating; Organization, Evaluation & Structure; Personnel; Public Awareness; Publications; and Scholarship.

Associations

The Federation is made up of five library associations. Members of the Federation may choose one or more associations with which to affiliate. The five associations are the Association for Indiana Media Educators, Indiana Academic Library Association, Indiana Corporate & Network Library Association, Indiana Library Trustee Association, and Indiana Public Library Association.

Special Interest Divisions and Sections

Federation members may also join special interest groups, called divisions and sections. Each group is centered around a particular topic of interest to its members. Some of these groups plan workshops, meetings, and conferences that address their particular interests.

Districts

The Federation separates statewide membership into eight geographic districts. Each district elects officers and has their own organizational structure and schedule of events. Annual district conferences are held to provide an opportunity for local library staff to exchange ideas.

Legislative Program

The Federation has a legislative advocate on staff and a legislative network that keeps state and federal lawmakers informed of the concerns of Indiana's library community. Past legislative efforts have been instrumental in securing funding for Indiana libraries and protecting intellectual freedom. The Federation organizes opportunities for members to get to know their elected officials.

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Publications

Federation members receive two major publications: *Focus on Indiana Libraries* and *Indiana Libraries.*

Focus on Indiana Libraries is ILF's newspaper. Published eleven times a year in cooperation with the Indiana State Library, it keeps members up to date on news and information of interest to the library community.

Indiana Libraries is a professional journal, which is also published jointly by the Federation and the Indiana State Library.

Conferences

The Indiana Library Federation's conferences provide an excellent opportunity for professional networking and serve as a forum for the exchange of ideas. Conference workshops and programs offer up-to-date information on a variety of library-related topics.

Federation members receive reduced registration rates for the annual conference as well as many other continuing education conferences and workshops throughout the year.

Endowment Fund

The Federation has established a general endowment fund to provide money for programs, services, and public awareness efforts that cannot be supported by the Federation budget. These programs and services include special events, lectures, seminars, providing funds to promote library services, and granting scholarships and awards for achievement in the library field.

The ILF Endowment also maintains two memorial funds. The Esther Schlundt Fund was donated in the memory of a Lafayette woman and is to be used for general scholarships or programs. The Sue Marsh Weller Fund is dedicated to the memory of Sue Weller, who was a children's librarian at Morrisson-Reeves Public Library in Richmond. Money from this fund provides scholarships for future children's librarians.

The Endowment Board works in conjunction with the ILF Scholarship Committee to see that funds from the endowment go to worthy recipients.

Insurance Program

The Federation has a wide range of insurance and other financial benefits that can be offered to its members. Currently, institutional members can participate in a comprehensive Indiana Library Federation Group Health and Life Insurance program. In 1997, ILF hired Richard Sutton, D.B. Englehart & Associates, as the organization's insurance agent of record. The ILF Group Health Insurance program began coverage on January 1, 1998 with coverage offered through Anthem Blue Cross & Blue Shield. More than 50 libraries currently participate in this program.

In 1999, the Federation began offering:

-- A directors' and officers' insurance program to trustee members

-- A long- and short-term disability insurance program to institutional members

-- A long-term care insurance program to personal members

In 2000, the Federation began offering:

-- Homeowner and auto insurance to personal members

INDIANA LIBRARY FEDERATION
6408 Carrollton Avenue
Indianapolis, Indiana 46220
Phone: (317)257-2040
Fax;: (317)257-1389
E-Mail: ilf@indy.net
Web Page Address: www.ilfonline.org