



LEGAL ISSUES



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Legally Speaking — ResearchGate Challenges Academic Copyright

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Scholarly communication has become a significant topic in the publishing industry and the academic field recently, as organizations and universities are seeking ways to provide and obtain open access to academic publications that often infringes on copyrights that have been secured from the academic authors through contract agreements with publishers. Most notable is the recent issue with the professional network for academics and scientists called **ResearchGate** and the academic publisher **Elsevier**, as well as others interested publishing organizations, such as the **American Chemical Society**. The legal issues have gained international attention to the process and intentions of scholarly communication that has been a significant aspect in the spread of knowledge for centuries.

Scholarly communication has been a source for intellectual and scientific growth for a long time, especially during the 1960s and the 1970s as universities began to expand, however the scholarly communication remained stagnant from the 1970s to the 1990s. According to **Jack Meadows**, “Communication lies at the heart of research. It is vital for research as the actual investigation itself, for research cannot properly claim that name until it has been scrutinized and accepted by colleagues. This necessarily requires that it be communicated.” The statement is significant in understanding how information helps in the growth of science and the humanities, yet copyright laws, publishers, and technology has complicated the availability of academic information for further research. Scholarly communication is a system that utilizes research universities, libraries, and publishers.

While scholarly communication was stagnant for nearly 20 years, the technology of the 1990s provided the spark to rejuvenate the interest in scholarly communication. Of course, the technology was also the outlet for publishers to capitalize on opportunities to expand publishing for academic authors. Also, the technology allowed new academic journals to evolve and provide more opportunities for academic authors. Furthermore, the technology has created the standard of accessing information at any time from just about anywhere.

Christine Borgman noted that through this technology, researchers “can exchange data and

ideas with colleagues around the globe, and can do so quickly and conveniently... Yet essential elements such as the scholarly journal article are remarkably stable and print publication continues unabated, despite the proliferation of digital media. Thus, it is essential to consider relationships among technology, behavior, institutions, economics and policy exploring digital libraries and scholarly communication.”

Therefore, the legal issues that technology has implemented intentionally and unintentionally is the ability to easily share copyrighted information amongst academic and public persons of interest. This is evident in the recent academic professional network organizations, such as **ResearchGate** and **Academia.edu**, which “have progressively become the most popular social networking services developed specifically to support academic and research practices.”

Academic libraries and academic authors are intertwined with the publishers and the professional networking organizations by providing scholarly information within the fields of study. Typically, publishers do not pay authors for their work, nor do they provide funding into the research community. Libraries purchase the scholarly information from the publishers in order to provide that information to researchers, academic authors, and patrons. However, due to the increases in subscription prices and new academic journals entering the market, the newly found interest in scholarly communication has raised the issue of copyright ownership for academic authors.

However, the battle of ownership is between the publishers and the academic professional network organizations. In 2017, several publishers organized the **Coalition for Responsible Sharing** as they confronted the academic networking site **ResearchGate**. The coalition, which consisted of **Elsevier**, the **American Chemical Society**, **Brill**, **Wiley**, and **Wolters Kluwer** insisted that **ResearchGate** remove copyrighted material from their website. On October 5, 2017, the chairman for the coalition and senior vice president of the **American Chemical Society**, **James Milne** stated that the coalition had to take legal action

against **ResearchGate**, because of the millions of notices that would have to be sent to academic authors to remove their content from the website. A lawsuit had already been filed in a regional court in Germany against **ResearchGate**, which is the location of **ResearchGate**.

The lawsuit in Germany, according to **Dalmeet Singh Chawla**, stated that the publishers wanted “clarity and judgement” on the process of posting copyrighted materials. Similar to the coalition’s request to take down the copyrighted materials, **Elsevier** had requested **Academia.edu** to send 2,800 take down notices of copyrighted materials on their site in 2013. In this instance, **Elsevier** did not pursue any legal recourse. However, **Elsevier** and the **American Chemical Society** sued **Sci-Hub**, which **Elsevier** was awarded \$15 million; whereas the **American Chemical Society** is seeking \$4.8 million.

On October 2, 2018, **Elsevier** and the **American Chemical Society** filed a lawsuit against **ResearchGate** in the U.S. District Court, District of Maryland, which stated, “This lawsuit focuses on **ResearchGate**’s intentional misconduct vis-à-vis its online file-sharing/download service, where the dissemination of unauthorized copies of PJAs (published journal articles) constitutes an enormous infringement of the copyrights owned by **ACS (American Chemical Society)**, **Elsevier** and other journal publishers.”

ResearchGate responded to the lawsuit on February 13, 2019, which they denied the allegations of copyright infringement and for declaratory relief and damages. In the document, **ResearchGate** admitted to the following: “it accesses and makes publicly available copies of some publications where the publication is subject to a **Creative Commons** license; it stores copies of certain content obtained from publicly available websites on its servers at the direction of a user when the content’s author chooses to make the content publicly available on **ResearchGate**; and that authors who choose to make the full text of their work available can choose to share their work privately or publicly.”

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The **ResearchGate** organization does recognize that it relies on authors to increase the traffic to the website that receives revenues and investments from venture capital. The organization knows that uploading and downloading published journal articles are illegal and the organization encouraged interested persons in the academic community to upload their work and join the networking site.

The organization understands that providing a platform for academic authors to submit their works can have copyright infringement issues. Yet, authors do submit their works, despite knowing that they may have given the rights to the works to a publisher. However, this is not always the case, as co-authors may have submitted the work without the other author's knowledge. A reason authors submit their works to the networking site is to provide their works to as many people as possible. Plus, some authors may have to meet tenure requirements, which would be beneficial if the authors that could provide statistical information on the citation of the work through **ResearchGate**.

Despite being the creators of the work, authors are not included in any of the lawsuits involving copyright infringement. **David Hansen, J.D.**, an Associate Librarian for Research, Collections and Scholarly Communication at **Duke University** has discussed the lack of recognition of academic authors during the legal battles between the scholarly publishers and the professional networking organizations.

In his blog, "Giving the Authors a Voice in Litigation? An ACS v. ResearchGate Update" on February 14, 2019, **Hansen** noted that through numerous copyright lawsuits between publishers and other large organizations that the courts proceed "without much input at all from the actual authors of the works that form the basis of those lawsuits."

Interestingly, the organizations are having legal battles of copyrights that involve millions of dollars, while the authors that have created work, mostly likely for little or no income, have no say in the lawsuits nor is there any financial reward should either party of the lawsuit win a settlement. Possibly, the outcome of these lawsuits will eventually take in consideration of the author's work and their desire to provide relevant information and research to the masses, such as the concept of scholarly communication that open access to information can be vital in science, the humanities, and for society.

The lawsuits are providing awareness of the issues that have arisen in part to the new technology, the influx of new journals, and the networking sites, as well as the authors in context to copyright. Other countries, such as China, Africa, and India, are also working toward better ways of providing open access to scholarly works, which could be significant in advocating for authors and supporters of scholarly communication. In addition, the lawsuits could also be an opportunity for academic authors to negotiate and create new policies for how academic works are published and provided to the public. Libraries also have the opportunity to provide a voice in how they

can acquire academic works and provide the works for their patrons.

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Cases of Note — Disparaging Trademarks Are Free Speech

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MATAL, INTERIM DIR. U.S. PATENT AND TRADEMARK OFFICE V. TAM. 137 S.Ct. 1744 (2017).

"Chinatown Dance Rock" band "The Slants" applied for federal trademark protection for their name. All were Asian-Americans from Portland. They claimed to feel the derogatory term could be "reclaimed" and drained of its denigrating force.

And they must have gotten that language from a college professor. Or perhaps it's learned in grade school in Portlandia.

At any rate, they have a niche popularity with the subculture of Otaku, which is Japanese for "geek" or "nerd" and particularly refers to manga obsessives.

Their music is described as synth-pop similar to "Chvrches" and "1Am X." Their influences are '80s bands like "Duran Duran," "Depeche Mode," and "The Cure."

The term "slant" refers to the epicanthic fold or skin fold

of the upper eyelid, common but not universal among Asians. And was once a common slur.

And our gang of rockers has albums named "The Yellow Album" and "Slanted Eyes, Slanted Hearts."

The Patent and Trademark Office (PTO) denied the application based on 15 U.S.C. §1052(a). It prohibits trademarks that may "disparage ... or bring ... into contempt or disrepute" any "persons, living or dead."

Well, that's pretty obviously a loser if you want to stop reading right here. Can I have Little Bighorn Beer with George Custer on it stuck full of arrows?

Trademark protection is designed for distinctive marks — words, names, symbols etc. — that distinguish one artisan's goods from another's. **Wal-Mart Stores, Inc. v. Samara Brothers, Inc.**, 529 U.S. 205, 212 (2000).

This helps consumers find desired products without confusion and protects the

vendor's good will. **Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.**, 469 U.S. 189, 198 (1985).

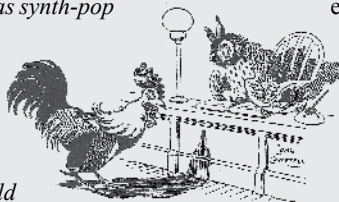
Trademark protection is ancient in origin and came here with the Common Law. For most of the 19th century, it was the province of the states. See **Two Pesos, Inc. v. Taco Cabana, Inc.**, 505 U.S. 763, 780-782 (1992).

Congress decided to wade in in 1870, and the **Lanham Act of 1946** provided for federal registration. **Lanham** bars marks that are "merely descriptive or deceptively misdescriptive" of goods. §1052(e)(1).

More to the point, it has a "disparagement clause" that bars marks "which may disparage ... persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute." §1052(a). The PTO asks whether the mark may be disparaging to a substantial composite — though not necessarily a majority — of the referenced group.

Who dreamed that up? Think 1946. The year before saw the birth of the United Nations, a dream of world government since Woodrow

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Wilson. *Franklin Roosevelt conceived of the body during WWII, began describing the Allied Powers as the “United Nations.” He was determined to join the world together in a love-fest of happy-clappy democracies. Modeled on us, of course.*

I’m totally guessing. And I sure can’t be bothered to delve into the Congressional record on the subject.

But I bet a lot of it had to do with not of-fending the symbols of foreign nations.

Strauch’s nonsense speculations aside ...

§1052(a) has been around, used inconsistently. And the PTO has made it clear it doesn’t care if the applicant is a member of the disparaged group or has good intentions.

Yet the PTO has admitted that “disparaging” is “highly subjective and, thus, general rules are difficult to postulate.” *Harjo v. Pro-Football Inc.*, 50 USPQ 2d 1705, 1737 (TTAB 1999).

And that was before the Internet outrage mobs could get in a frenzy over a “Men Working” sign.

But incredibly, the PTO didn’t survey a whole bunch of Asians to find a substantial composite. They based their ruling upon a

quote from UrbanDictionary.com and — wait for it — a picture of Miley Cyrus pulling her eyes back into a slanting shape while seated next to an Asian.

Tam was quoted in the media as saying Asians thought it all quite funny; only white people balked at it.

Well, the dogged Tam contested the denial before the examining attorney, the PTO’s Trademark Trial and Appeal Board. Then he went to federal court where they chose to sit en banc to find the disparagement clause violated the First Amendment’s Free Speech Clause and was unconstitutionally vague.

No kidding.

PTO filed a petition for cert which was granted.

Supreme Court

Before that august body, the PTO argued trademarks were government speech, not private speech. And the Free Speech Clause doesn’t regulate gov speak. *Pleasant Grove City v. Summum*, 555 U.S. 460, 467 (2009).

Government can’t regulate speech in ways that favor a viewpoint at the expense of others. But gov has its own viewpoints and couldn’t function if it self-avoided that rule.

Trademarks are created by the owner, maintained by same, and removed from the register if cancelled by the owner. It is far-fetched to call it government speech. Government would

be endorsing a vast array of commercial products and services, many of them contradictory. We have registrations for both “Abolish Abortion” and “I Stand With Planned Parenthood.”

What kind of govt. drivel would be put forward by “make.believe” (Sony), “Think different” (Apple), “Just Do It (Nike)?

Anyhow, registration does not mean approval. See *In re Old Glory Condom Corp.*, 26 USPQ 2d 1216, 1220, n.3 (TTAB 1993).

That’s kind of cute, even without reading the case.

“If there’s a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable.” *Texas v. Johnson*, 491 U.S. 397, 414 (1989); *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 55-56 (1988).

Parks and monuments convey government messages, but not trademarks. And if you pushed this idea too far, a copyright would make a book into government speech.

And doubtless you’re aware of the Washington Redskins brou-ha-ha. They had their trademark cancelled, but the Tam case obliged the appeals court to vacate the decision. So don’t imagine you can sell pirated Redskins gear. 🐼

Questions & Answers — Copyright Column

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QUESTION: *A prison librarian asks about placing sound recordings on a server so that individual inmates are able to listen to the recordings via the server.*

ANSWER: Individual listening to sound recordings is fair use. There are a couple of caveats, however. The recording should be available to one inmate at a time or played in one living area even if multiple inmates are in the room. There should also be no ability for inmates to download the sound recording or share copies electronically.

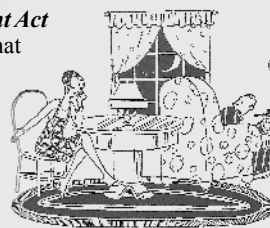
QUESTION: *An academic librarian asks why publishers object to controlled digital lending.*

ANSWER: Controlled digital lending (CDL) is based on the idea that it is fair use for libraries to digitize printed books that they have legally acquired and to lend those digital copies under restrictions similar to those physical copies of books such as lending only one copy of the book at a time for a defined loan period. The **Internet Archives** has been doing this for some time, as have some other libraries even for works that are still under copyright.

Publishers and authors certainly have noticed this movement, and they claim that CDL is systematic infringement that negatively

affects the incentives the **Copyright Act** provides them. Publishers argue that they are now making out-of-print works available digitally under license agreements and CDL interferes with exploitation of the copyright and this new source of income for them. A number of publishers’ group have joined in objecting to CDL including the **Authors Guild**, the **National Writers Union**, the **Association of American Publishers**, the **International Publishers Association** and the U.K.’s **Society of Authors**.

Publishers have repeatedly questioned the **Internet Archives**, and according to the **Association of American Publishers**, the **Internet Archives** has inconsistently responded to take down notices under the **Digital Millennium Copyright Act**. Publishers do not accept that CDL is the functional equivalent to hard copy lending. Section 109(a) of the **Copyright Act** is the first sale doctrine under which libraries lend physical books in their collections. It provides that once someone has legally acquired a copy of a physical work, he or she may dispose of that copy however he or she chooses. The doctrine does not authorize reproduction of the work, however.



Therefore, the first question is whether digitizing a work without permission of the copyright owner is fair use. Traditionally, the answer is no. The owner determines the format in which a work is made available and users are not permitted to reproduce it or to change that format. It is certainly understandable that librarians would be attracted to the idea that digital copies are no different from physical copies. This idea may not be supported by the **Act**, however, or an important recent court decision. The Register of Copyrights has repeatedly opined that there is no first sale doctrine for digital works. (See https://www.copyright.gov/reports/studies/dmca/dmca_executive.html). In addition, in a report on orphan works, the Copyright Office concluded, “there is broad agreement that no colorable fair use claim exists [for] providing digital access to copyrighted works in their entirety.”

In *Capitol Records v. ReDigi*, (910 F.3d 649 (2d Cir. 2018)), the court affirmed the district court’s decision that finding that **ReDigi** infringed copyright through its service that allowed the resale of **iTunes** files. The court

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pretty much closed the door on the concept of a digital first sale doctrine. The case raises concerns about CDL even though **ReDigi** was a commercial enterprise and the libraries involved in CDL are nonprofit. The underlying theory of CDL is now called into question. **ReDigi** has announced that it will appeal the Second Circuit ruling to the U.S. Supreme Court, but there is no indication that the Court will even agree to hear the case.

QUESTION: *A school librarian asks about the reproduction of unedited and unpublished works found on a webpage.*

ANSWER: Unedited really makes no difference regardless of whether the work is published or not. Unpublished works posted on the Internet are published by the simple act of posting. The problem is that under the *Copyright Act*, only the copyright holder has the right to publish the work or to decide that it will not be published. If the poster of the work does not have permission to post the work, he or she has infringed the copyright. If the owner posts the work on the web, then it is published and copyright attached at the time the work was created and will last for life of the author plus 70 years.

Assume that the work is unpublished. Even unpublished works are eligible for copyright

protection. Determining when the work will enter the public domain is more difficult for unpublished works, however. If the work was created before January 1, 1978, but never published, it entered the public domain on 12-31-2002, or life of the author plus 70 years, whichever is greater. For works created before 1978 but which were published between 1978 and the end of 2002, it enters the public domain 70 years after the author's death or the end of 2047, whichever is greater.

QUESTION: *A university librarian notes the recent announcement that the University of California system has canceled its multi-million dollar subscription with Elsevier. While academic libraries have long complained about high prices charged by Elsevier and the bundling of journals, this came as a surprise. What brought this about? What is the likely outcome?*

ANSWER: The University of California (UC) system accounts for about 10% of U.S. scholarly output and its annual **Elsevier** subscription cost is more than \$10 million. So, this cancellation is a big deal. Pressure on **Elsevier** has been increasing, and last year hundreds of German and Swedish institutions refused to sign a deal with **Elsevier** unless it changed fundamentally the way it charges institutions for the subscriptions to online journals. According to articles in the higher education press, UC pushed to offset the cost of open access pub-

lishing against the cost of access to subscription content. Under such a deal, all UC research published in **Elsevier** journals would be publicly available immediately, in other words, with no time embargo. **Elsevier** did offer to combine the cost of accessing pay walled content and publishing open access articles but at a high price. UC was unable or unwilling to pay that hefty amount. According to **Ivy Anderson** of UC, the UC system wanted to integrate its fees and reduce costs while **Elsevier** wanted to charge publishing fees on top of subscription fees. This made it impossible to reach an agreement and the libraries stepped away from the negotiations.

It is difficult to predict the outcome. The parties could come back to the negotiating table and reach some sort of agreement. Students and faculty in the UC system could simply adjust to using the pre-2019 journals to which UC has perpetual access and paying a per article charge for journal articles going forward. Or, students and faculty could demand reinstatement of the **Elsevier** subscriptions. Politically, this is not good for **Elsevier** but the impact on students and faculty could be negative.

Librarians do not want the big publishers to go out of business. In the era of shrinking library budgets and huge annual price increases for digital content there may now be an impasse, not only for UC but also for institutions. The open access movement is, in part, a response to these trends. 🌱