



An Interview with Attorney David Koehser: How Long to Retain Copyright Documents?

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Introduction

I am frequently asked by clients: “How long do I have to keep copyright transfers and other copyright documents?” “Is there a statute of limitations when it comes to copyright?” “How about retaining digital copies of copyright documents?” These questions apply to books and magazine articles. You never know when a copyright dispute will arise and you will need to quickly access relevant copyright documents. For those reasons, I interviewed Attorney Dave Koehser, my legal advisor, to get answers.

Q- How long should copyright documents be retained? How does the statute of limitations figure into copyright?

A- The transfer documents are the same as real estate transfer documents, and they should generally be kept indefinitely (or at least until the end of the term of copyright), as they will show the chain of title and would be needed if anyone ever disputed the client's right to use the material in question. Having said that, you may be able to draw a line between magazine articles or contributions to other collective works (such as a journal or an anthology) which were done as work for hire or for which there is an assignment of copyright to the client and articles which were only licensed for limited use. As to the former, the client would be the owner of the copyright, so the transfer document (either a work made for hire agreement, signed by the author, or an assignment of copyright signed by the author) should be retained to show the clear chain of title, with title vesting in the client (see the above real estate analogy). As to the latter, there is a three-year statute of limitations in the Copyright Act (a copyright owner has to bring suit within three years after an alleged infringement has occurred), so if you are no longer using the article and do not plan to re-use it, it may be safe to destroy the license agreement, but:

(a) If the article in question is available in archived editions online, the author may argue that the alleged infringement is ongoing. This may alter the time for the expiration of the statute of limitations, and thus you would want to have the license agreement available to evidence your right to continue to publish the article.

(b) Applying the statute of limitations can be tricky, as there are court decisions stating that the three-year period does not begin to run until such time as the owner could reasonably have been expected to discover the infringement, and/or some other possible exceptions that end up extending the three-year period far beyond what you might expect. Thus, even if you stopped using the article several years ago, the copyright owner could claim that he or she could not reasonably have been expected to discover that past use until today, and thus the statute of

limitations would not start to run until the point of discovery. In that situation, you would want the agreement to show that you had the right to use the article.

Bottom line: it's better to have the documentation to establish that you were granted the rights being exercised and are not infringing rather than getting into an extended argument over whether you were actually granted rights to the article and/or whether the statute of limitations has or has not run.

Q- How about retaining copyright documents in digital format? Is that permissible?

A-The good news: you can scan the documents and save digital copies only, and those digital copies will be valid as far as evidencing the rights granted. Also, if you have stopped using an article in any form and have no intent of re-issuing that article, you could destroy the paperwork, as long as it has been at least three years since you last published the article. (Although see above regarding the possible exception where a copyright owner could claim that he or she could not have reasonably been expected to discover your last use until recently, in which case the starting and ending points for the three-year statute of limitations may be moved out.)

In summary, if you are claiming ownership of the copyright in an article, you should keep digital copies of all transfer documents (either a work for hire agreement or an assignment of copyright, as the case may be) to show the chain of title. If you only have a license/permission to use an article, it's a judgment call on your part as to when you last used the article and whether you plan to re-use it at any point in the future, and thus what the risk of an infringement claim might be. In either case, digital scans will be sufficient and you can scan the documents you want to retain and then dispose of the paper files. (Again, as with the real estate analogy, while property owners often retain actual paper deeds, county recorders in most counties have shifted to electronic records, and the recorder scans all documents and records them electronically. The days of going to the courthouse to dig through rusty file cabinets with flaking paper copies are mercifully behind us.)

Q-Do you have other comments on this subject?

A-One other thought on this: if there are any articles that are covered by an agreement for a term, there is probably no need to retain the agreement after the expiration of the term, although here again there could be a statute of limitations issue from a copyright claim by the author or a third party claim for which the author's indemnification would come into play. The statutes of limitations are different for each type of claim. For example:

Assume the agreement grants the publisher the right to publish the article for five years. After that, all rights revert to the author. The publisher ceases publication in 2015, and the five-year contract term ends in 2018. Any copyright claim by the author ("you did not have the right to publish") would have to be made by the expiration of the three-year statute of limitations, in 2018 (subject to the author invoking the reasonable discovery doctrine and pushing the date for the statute of limitations out, by claiming that the unauthorized publication could not have reasonably been discovered until some date after 2015, thus delaying the starting point for the three-year statute of limitations). However, if a third party claims that the article included defamatory material, the statute of limitations for that claim is six years, so that claim could be brought at any time up to 2021. If the third party files a claim against the publisher, the publisher will want to seek indemnification from the author (assuming that the contract with the author contains an indemnification clause) and thus the publisher will need a copy of the

agreement with the author. As explained above, a digital copy will suffice, but this example illustrates the importance of having a copy, even if the publisher's publication of the article ended some time ago.

David Koehser, Attorney-at-Law

David Koehser is a Minneapolis-based lawyer who practices in the areas of publishing, copyright and trademark law. Dave's website contains articles on the topics of: Publishing Law, Merchandise Licensing, Copyrights and Trademarks, and Theater and Performing Arts. Request a copy of Dave's informative quarterly enewsletter, *Publishing and Merchandise Licensing Law Update*. Dave has a B.A. from the University of Iowa and a J.D. *cum laude* from the University of Minnesota Law School. You can find his website at www.dklex.com.

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John B. McHugh

John B. "Jack" McHugh is a 40-year veteran of the publishing business. Jack has worked as an executive for Houghton Mifflin, Wadsworth, and Saint Mary's Press. Jack is also an experienced association publishing executive. He is a member of the ASAE Advisory Board for Publishing, Communications, and Media Issues and Practices.

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- I-14, *Copyright Aspects of Social Media: An Interview with Attorney David Koehser*, 2010, 4 pages
- I-15, *Ebooks and Copyright: an Interview with Attorney David Koehser*, 2010, 5 pages