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Independence Day

“Tip of the Month”

Are You Secure in Your Copyrightable Works?

For all your important copyrightable works, such as your website, your ad campaign, your smartphone app, etc., do you have signed agreements from all the contributors involved in creating these works? If your answer is “No,” then you have no grounds to prevent an outsider from infringing your works.

The US Copyright Act requires that all transfers of copyright ownership be in writing. This is called an “assignment” of copyright. It’s not enough to have a contract with a web designer or software consultant containing a promise to assign the work to you. Such a promise in a contract only gives you the “equitable” right to use the work, but this promise does not give you legal title to the copyrighted work.

Having an “equitable” right to the work is not enough to proceed with a copyright lawsuit against an alleged infringer. To bring suit or to obtain a valid copyright registration, you must have the “legal” right to the work. You receive the “legal” right to the work only through actual assignments of copyrights from **all** of the parties who contributed to the contracted work. Having some of the assignments is not enough.

You may have heard the term “work-for-hire” or maybe you know a little about the “work-made-for-hire” provision of the US Copyright Act. You probably also think “Well, I can rely on that for legal ownership.” Think again! This provision is very limited. The contracted work must fit neatly into one of the limited and specific categories under the Act that qualify a work as a “work-for-hire.” Most creative works created by third-party contractors do not qualify under the “work-for-hire” provision.

Thus, you need an actual assignment in writing signed by each of the parties who contributed creatively to your work. Assignments can be provided at the time the work is delivered or after delivery. This is especially important if your contractor uses sub-contractors. Either your contractor must have an assignment transferring all of the sub-contractors’ rights in the work to the contractor, who then can transfer the ownership rights in writing to you, or you need the assignments from the sub-contractors to you.

So, what’s the big deal? The big deal is that you cannot prevent the unauthorized infringement of your copyrightable property if you only have the “equitable” right to the work. You need to prove that you have the “legal” right to the work. You also need to prove that you have a valid copyright registration, which can only be obtained if you have the “legal” right to the work.

If you need help to sort out ownership of the copyrights in your creative works that are provided to you by independent contractors, then call the attorneys at Mesmer & Deleault today at 668-1971, or contact us by email at mailbox @ biz-patlaw.com.

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