Extensis™

DESIGN & TECHNOLOGY & FONTS & THE LAW

Frank J. Martinez, Esq., MBA

Black's Law Dictionary, the most widely used law dictionary in the United States, and the reference of choice for terms in legal briefs throughout the United States, defines a **Type Font** as a

> "set of characters comprising a given typeface of a set point size; capitals, lower case, numbers, small caps and other symbols."

Any font designer or graphic designer, even one with the least experience, quickly perceives the hollow nature of this definition. It is not so much inaccurate as it is devoid of any articulation as to the skill and art required to design a good font. The lack of rigor in definition aside, a more corrosive factor is undermining our perception of the value associated with well-designed fonts and the consequences for designers and the practice of design cannot be overstated. This factor is the Internet and it has crippled our ability to recognize good design; its cyclonic churn of images and character restricted utterances causes many to perceive these bad representations of culture for genuine creativity. It has become increasingly difficult for designers to distinguish good design and legitimate fonts from knock-offs and pirated software. Now, design culture struggles to maintain equilibrium. It has even been argued that the Internet has irrevocably eroded the distinctions between the legal and the illegal since all that now matters is fleeting success measured in "likes" and "retweets."

Fonts and design are inextricably intertwined. Like many other digital assets, the Internet has become woven into the practice of design and is now a foundational element of the business of design. The anonymous nature of the internet, and ease of sharing files online makes it easy to lose track of the proprietary nature of font software. Stated simply, someone, usually a lone designer/ artist, created the font and someone owns the rights, including the right to license the use of the software. The implications for a designer and the designer's client, when misuse occurs are monumental, the largest of which is liability. This happens when the software is not acquired and used according to the terms of the licenses that control any intended uses. How much liability? One Federal District Court in Chicago imposed a fine of $30,000, per day, for the improper use and/or distribution of font software. While most infringement judgments are not this extreme, the history of font related litigation over the past 20 years shows that nearly 50 font infringement lawsuits have been filed in the United States. In most of these cases, the settlements almost certainly required that the infringer be required to pay some form of damages or enhanced licensing fees to the owners of the copyrighted font software. Even the most casual review of what can happen, if one does not manage font software, indicates that the liability far outweighs the cost of proper licensing. In many cases, this liability is borne by the design agency's client, a circumstance that will damage almost any professional relationship. The combination of purchasing a proper license, together with, managing the use of the licensed font software is always the more economically efficient course of action.

[1] The Law Dictionary. (2017). The Law Dictionary, Featuring Black's Law Dictionary 2nd Ed. Retrieved from: http://thelawdictionary.org/type-font/.

Extensis

*The prudent designer or design manager can avoid these problems by simply
exercising several simple steps before using a font.*

» First, understand any limitations as to the number of users associated with a font license. This will vary from foundry to foundry and from license to license. Many design agencies cannot afford to purchase a license for every potential use and every potential number of users; it's simply too expensive. The prudent licensing manager will understand those limitations and plan accordingly.

» Second, it is critical to understand any restrictions to types of uses a foundry might impose. These restrictions vary from foundry to foundry and they can expand or remain limited depending upon the type and expense of the license purchased. Simply purchasing the smallest license to use the font is frequently inadequate. An inquiry should be made as to the actual or likely needs and purchase the proper license. If the license is too expensive, consider a "design analogue" (a font with a similar design and characteristics) with more hospitable license terms.

» Third, the uses a design firm might license are almost certainly different from those that a client will reasonably need, if the client, needs to use the software. The client's ability to use the font software will always be more limited unless they purchase their own license. These costs can be built into the design fee or made known to the client thereby requiring that the client purchase their own license. In almost all circumstances, any use of the font software by the client, or the subcontractors of the client, will require additional licensing. In many circumstances, the extensive use of a designer's work product that exhibits use of the font, such as typography used on goods for sale, or in movies or entertainment broadcast on cable or the Internet, will also require a special license.

» Fourth, any digital products, such as e-books or apps, containing embedded copies of the font software will always require special licensing.

» Fifth, all webfont uses of font software require special licensing either from the foundry or from third party webfont providers.

Having worked in design prior to attending law school, I have had multiple opportunities to observe how a single-minded focus on process and ideation can lead a designer astray. Stated simply, good designers are also good managers, because design is a 360-degree activity. Not only must the design resonate with the client and the client's customer, the design must fit comfortably within the constraints of the budget and the client's business needs. The sprint from design brief to conceptualization, if well formed, incorporates an understanding of the tools and assets needed to deliver great work. Failure to understand the limits of licensing distorts that equation by creating liability. If one is fortunate, it is avoided, but is just luck leading you astray. What do designers or design managers do to create such unhappiness and disruption to their own success? Stated simply, they do not review the license.

In my experience as legal counsel, I have been involved in many licensing disputes between foundries and creative groups. These examples are drawn from actual cases, with identifying material removed, in keeping with confidentiality requirements.

Fonts convey emotion, and they carry the ability to shape perception. Occasionally, a font will have images or graphics in addition to letterforms. Just because the font is licensed for normal desktop uses does not mean that the graphics can be used in an unlimited manner. Many foundries now require special licensing if fonts and/or associated graphics are used on goods for sale. This means that the unlicensed use of the graphic images in a font, when used on hundreds of thousands of soft-drink cans, becomes a problem.

In other circumstances, use of references to a creative property owned by a third party can be uncomfortable. For example, allusions to design references or use of the tradenames or trademarks of another when creating marketing for one's work is not advised. So, referring to a successful film by name in marketing materials without a license or permission is unwise.

Webfonts are easily created with free utilities. However, it is safe to say that all foundries now provide a method of securing a webfont license. Creating a webfont from a desktop font, and using the resulting webfont in an app means that anyone with a modicum of technical expertise can access and download the font, thousands of times. Damages for misuse on the web can quickly be calculated by the number of times the web page has been accessed, which adds up quickly.

Other design teams, as part of seeking customer interactions, have provided font software to anyone, inviting "real people" to participate in "experiencing the brand." Voiced another way, a font distributed to the public without any restrictions; just log on and download results in thousands of infringements. Designers for motion pictures frequently use fonts within a film; in titling, credits on props, or as an element of an animation within the film. Unlicensed fonts used for dramatic effect crawling across a 30-foot-high screen are hard to ignore. After all, they're dramatic. Most issues with improperly used fonts arise out of the failure to understand that licensing is not as simple as it once was. It is not uncommon to find a single-licensed font being used by multiple designers, sometimes even in multiple countries. One improper use then exposes all the unlicensed users and uses to liability. I have experienced results when the license infringement involves an actual product for sale, that the destruction of the goods becomes a requirement for the settlement – whether it's a t-shirt, bag, film or other hard good. This isn't a desirable result for any party.

The most brazen activities involve designers who "port" a font to another format and then rename the font and use it for client work. Since a good font requires hundreds. If not thousands of hours to develop, it is not likely that a foundry will be duped by a false name. Remember, font designers have a deep understanding of their designs and they see letterforms as unique pieces of artwork. Trying to hide copying is an exercise in self-delusion, especially when the true designer is equipped with software tools that allow them to examine the code on a line-by-line basis.

Extensis™

Understanding and managing the uses of font software for even a modesty sized design agency requires extraordinary diligence. The bother and oversight burden can be diminished and confidence that you are compliant with your license can be greatly increased by technology such as software that controls and manages the number of typographic assets a design team can use under the license. The use of a font server, such as Extensis Universal Type Server, is one such resource. Universal Type Server avoids unauthorized copying by loading all of the fonts onto a single server, and then distributing fonts automatically to authorized users. This is critical since not only must a manager monitor who is authorized to use the fonts, they must also control the authorized number of users to keep within the font license. Any effective font server will also be able to provide extensive reporting on font usage, so that administrators can purchase the proper number of licenses to ensure proper coverage of user needs.

The importance of managing and controlling font usage within a design environment is easily measured. Simply ask your designers how many of them have read a font End User License Agreement (EULA) in the past year. It is hard to blame designers for their lack of interest in reading a EULA. These documents have become dense and complex, though not for the purpose of actively misleading or confusing legitimate users. These documents have evolved in response to increasingly sophisticated infringers who seek to "dive through loopholes" to avoid paying a fair license fee. The corollary to this behavior is the design client who teases extra services from a designer with vague promises of a "big project," only to refuse to pay for the extra services because they were not requested in writing or the project went over the agreed upon budget. Unsurprisingly, the promised big project never seems to materialize. The bottom line here is that like graphic designers and font designers rely on fair and equitable dealings between themselves and their clients, and that tools that assist in the course of these dealings benefits both design agencies and font foundries.

As part of managing or supporting a creative team, the implementation of concrete font licensing, tracking and compliance procedures is critical to your team's success, and will help keep you out of any legal troubles.

To learn more about Universal Type Server, please visit
https://www.extensis.com/products/font-management/universal-type-server/

Extensis™

ABOUT THE AUTHOR: Frank Martinez has a BFA from Pratt Institute and for a decade was the co-owner of a fine art and commercial printing company. Frank has also worked as a graphic and package design professional. Frank is now a lawyer specializing in intellectual property matters and he recently earned an MBA. After law school, Frank was a Design Patent Examiner at the U.S. Patent and Trademark Office for two years. Most of Frank's law practice is now devoted to assisting design professionals and software engineers with issues at the nexus of design, technology, business and the law. This assistance includes seeking the enforcement of Font Software license agreements in the Federal District Courts. Frank also teaches IP Law for Designers at The School of Visual Arts in the MFA Designer as Entrepreneur Program with Steve Heller. Frank is also an instructor/mentor in the SVA Groundfloor Incubator project.

About Extensis

For more than 20 years, Extensis® has helped individuals and organizations of every size drive down operational costs and accelerate profitability with font and digital asset management solutions that maximize the value of digital content, streamline workflows, ensure compliance, and accelerate collaboration. Extensis' top-rated server and desktop products include: Portfolio® for digital asset management, Universal Type Server® for organizations that require font access, synchronization and compliance, Suitcase TeamSync™ for small workgroups to share fonts, and Suitcase Fusion® for individuals to manage font collections. Founded in 1993, Extensis is headquartered in Portland, Oregon, and Northampton, England. For additional information, visit www.extensis.com.