

# **COPYRIGHT TOWN MEETING: Toronto, Canada, September 7, 2002**

**Creating Museum IP Policy in a Digital World  
Museum Computer Network Conference  
co-hosted by Canadian Heritage Information Network**

## **Meeting Report**

### **Presentations**

Laura Gasaway, Drafting Copyright Policies: The University Experience

Rina Pantalony, Why Museums Need an IP Policy

Christopher Hale, Institutional IP Policy from an International Perspective

Maria Pallante, From IP Audit to Valuation and Management

### **Workshop Introductions**

Brian Porter, Putting Together a Museum's IP Policy: Renaissance ROM as a Case Study

Rachelle Browne, Constructing Values: What to Put into a Policy

---

### **WELCOME AND INTRODUCTIONS**

#### **Leonard Steinbach, Welcome**

Len Steinbach, President of the Museum Computer Network (MCN), welcomed the audience and expressed his delight that MCN could host this Town Meeting. He discussed NINCH's role as an institutional membership organization that hosts, in addition to the Town Meetings, forums where leaders in the cultural heritage community can convene to discuss the future of networking cultural information, what policies are needed, how to support promising initiatives, and how to help navigate the direction of the cultural industry. He urged the audience to support NINCH and its programs by having their institutions join the organization.

#### **David Green, The Meeting in Context**

David Green, Executive Director of NINCH, thanked the President and Board of MCN for their support, and the planning committee (Amalyah Keshet, Rina Pantalony, Len Steinbach and Diane Zorich) for their assistance in developing the nineteenth NINCH Copyright Town Meeting. He introduced NINCH as an advocacy and leadership organization comprised of a diverse coalition of member institutions drawn from around the cultural community.

Green gave a brief history of the Town Meetings, noting that they were rooted in the Conference on Fair Use (CONFU). The CONFU meetings were convened by the

United States government in the 1990s, and brought together IP stakeholders to create practical guideline for the implementation of fair use. CONFU failed, but the process revealed a lack of understanding within the cultural community about the facts of copyright, fair use, and how the Internet might change their work. With the College Art Association (CAA) and the American Council of Learned Societies (ACLS), NINCH organized a series of Town Meetings around the country to help rectify this situation. When the Town Meetings began in 1997-1998, a series of events (i.e., the failure of CONFU, the passage of the Digital Millennium Copyright Act (DMCA) and the Sonny Bono Copyright Term Extension Act, and other restricting legislative efforts) left the community struggling to keep fair use and other copyright exceptions alive in the digital world.

The focus of the Town Meetings moved on from these issues to address new arenas. In the 2000 series, meetings were held on the public domain, on distance education and faculty ownership of material, and on community guidelines and resources. In 2001, the Town Meetings examined the interaction between copyright and the public domain, and copyright and new economic models. The meetings examined emerging licensing ventures such as [AMICO](#), ArtSTOR, and the [Research Libraries Group's Cultural Materials Program](#). The meetings also began to address the "how to's" of intellectual property, such as how to seek permission for materials, and how to make and change institutional IP policy in a university environment. This last subject led directly to this Town Meeting on developing IP policies in museums. Green noted that there is a great need for such policies in museums to "mesh the needs of individuals and institutions, owners and users, in a statement that articulates values, mission, and the economic reality of institutions."

---

## I. THE IMPORTANCE OF INSTITUTIONAL INTELLECTUAL PROPERTY POLICY

### **Laura Gasaway, Drafting Copyright Policies: The University Experience**

-See the *Presentation Slides* (as [Powerpoint](#) ; as [PDF](#))

Laura Gasaway spoke about her most recent experience in developing campus IP policy at the University of North Carolina (UNC), Chapel Hill, and her appointment as Co-Chair of a UNC system task force that drafted a system-wide ownership policy for over 16 campuses. She noted that there are two aspects to copyright policies on campus: the ownership and management of copyright, and the use of copyrighted works. Universities have focused on the ownership issues rather than the use issues because the latter are more complicated, especially when dealing with slides and other images.

Gasaway identified five reasons why one should have a copyright ownership policy at a university:

1. it protects the university (copyright issues can be costly for universities);
2. it protects the faculty, who create the majority of the works at a university;
3. it clarifies the rights of staff;
4. it clarifies the rights of students; and
5. it addresses issues before disputes arise.

In the university world, the ideal process for developing an ownership policy is to involve all portions of the academic community, i.e., faculty, staff, students, librarians, administrators, legal counsel, those involved in technology transfer, etc. Policy should not be drafted solely by legal counsel or administration. (Gasaway noted that faculty would be highly suspicious of a policy drafted by either of these groups.) Fortunately, many universities have law faculty who are viewed as faculty first and foremost, and thus are treated as a more trusted partner in policy development by the larger faculty community than is university counsel.

Gasaway identified some of the important issues in copyright ownership for universities. First and foremost is the issue of faculty creations. In the university environment, there is a tradition of faculty ownership of copyright in works they produce. This tradition is often referred to as the "faculty exception" in the work-for-hire doctrine. It is a judicial exception; it is not written into the copyright statute. This tradition has come under sudden challenges because of the digital environment and the fact that some of these faculty-created digital works may be highly lucrative. The definition of a work-for-hire within US law is a work prepared by an employee within the scope of employment. (It also includes work specially ordered or commissioned for use as a contribution to a collective work.) Does a faculty member's contract create an employment situation? In some senses it does - the university pays taxes and benefits for the faculty member; in other senses it does not - the employing institution seldom states what must be produced, only that one must produce. Generally, because of the assumed faculty exemption to the work-for-hire doctrine, faculty works normally are not considered work-for-hire. This is not the case for staff works, which are usually produced within the scope of their employment. Student works on the other hand, are certainly not a work-for-hire.

Gasaway noted other complicating issues of ownership in a university environment. Who owns copyright in works resulting from grant-funded research? If there are ownership terms in a grant then they will prevail, but often there are no such terms or, if the work results from a government grant, there is no copyright (i.e., the work is in the public domain.) What about faculty-student collaborations? These come in many guises. And what do you do when you have many collaborators on a project (such as a

lab manual developed within a chemistry department)? It is often hard to assign individual authorship in these cases and copyright is more likely to be owned by the university.

There are many ways to address copyright ownership issues in universities. Faculty can agree to reimburse the university for substantial investment made by the university for creation of their work. Faculty also can give the university a "shop right" (a patent right whereby an employer permits an employee to own copyright in the work although the work technically is a work-for-hire, in exchange for a grant to the employer to use the work in the "shop.") Or the university can own the work. Joint ownership is another possibility, but it is not the easiest answer. A joint copyright owner can do anything with the work -- their sole responsibility is to account to the other party. Thus if a university sells a work in which it jointly owns copyright, it can do so without the knowledge of the co-owning faculty member, as long as the university shares the proceeds with that faculty member.

Gasaway next addressed the "use side" of copyright policy. Why should an institution have a use policy as part of its copyright policy?" First, a university wants to encourage its faculty to be creative in their use of copyrighted works in their teaching and research, and wants to establish norms for faculty behavior. The university also wants to guide students, faculty and staff, and encourage full exploitation of fair use or fair dealing privileges. A use policy also helps the university protect itself and educate its community about copyright, and helps regularize the process for seeking permission.

The development of use policies has led many universities to create a position called "copyright officer" -- often an attorney or librarian -- who works with the faculty on their IP issues. It is important that this person represents the creators of copyrighted works. A university's corporate counsel represents the university, not the creators in the university.

Use policy is rife with legal issues, so legal counsel is critical when creating them. (Ownership policy issues are less about legal issues and more about policy choices - i.e., who should own.) But in working with university legal counsel, Gasaway advised discovering their position on fair use and fair dealing, and to ensure they are not so risk averse that they refuse to use these hard-fought exemptions. You also have to make certain the legal counsel working with you has copyright experience. Many attorneys in universities do not have this experience; they usually specialize in other areas of law that are needed in a university setting.

In conclusion, Gasaway noted that the overall benefit of policy drafting is that it helps crystallize thinking about various policy choices. Policy drafting also focuses

attention on the good of the institution versus individual self-interest. And finally, it is interesting group exercise. If you involve staff at all levels you will find it easier to have a policy accepted and embraced by the community.

---

## **Rina Pantalony, Why Museums Need an IP Policy**

-See *Presentation Slides* (as [Powerpoint](#) ; as [PDF](#))

Rina Pantalony's presentation compared and contrasted university and museum IP to highlight the distinctions and the unique IP policy needs in museums.

Pantalony reviewed Gasaway's discussion of the characteristics of university IP, emphasizing that the diversity and lucrative nature of university IP assets calls for policy in areas such as trade secrets and patents, areas which are not prevalent in museums. She noted that university IP holds great economic potential and has a high level of private sector investment that requires universities to manage their assets and investments prudently. A university needs to understand who owns what, how much protection it needs as an institution, and how it can clearly articulate the relationship between the institution, its faculty, and its students. Pantalony cited MIT's recent policy to aggressively develop its most financially lucrative IP assets, and let its less financially promising IP assets go into the public domain, as an interesting reflection of the importance and impact of the economic aspects for universities (See [MIT's Open Courseware Initiative](#)).

Turning her discussion to museums, Pantalony identified four broad areas where IP is found in museums:

1. in collections (e.g., objects and images);
2. in technology (e.g. collections management database systems, innovative online applications);
3. in academic activities (e.g., curatorial and scholarly research); and
4. in administration (e.g., in institutional policies, statements).

The commercial potential of these IP assets was originally driven by media interests. A few years ago the Canadian Heritage Information Network (CHIN) commissioned a commercial market study to determine where the demand for museum content might be found. The study revealed that museum assets held interest in the broadcasting, publishing, advertising and multimedia development industries. Pantalony has also noticed a growing commercial potential in product licensing for museums, as seen in retail shops or efforts by institutions such as the [Museum of Fine Arts, Boston](#), the [Victoria and Albert Museum](#), and [Colonial Williamsburg](#). Another new and interesting area of commercial potential for museum IP is in the educational community, where it could feasibly drive R&D investment in areas of content creation and technology development for distance and lifelong learning opportunities.

Pantalony concluded by offering a non-exhaustive list of reasons why museums must develop IP policies:

1. IP is an asset (like bricks and mortar) and there are legal and fiduciary obligations for Boards and managers to manage these assets prudently. A policy is a first good step towards prudent IP management.
2. IP increases our direct communication with global audiences. This communication creates a host of new issues involving jurisdiction, commerce, etc., and has taken our management requirements and burdens to a new level.
3. IP has commercial potential; this potential requires fiscal management, and policy can guide and enhance the management.
4. The education potential of IP requires a forward-thinking, balanced strategy between users, the academic side of museums (e.g., curators), and institutions. Such a strategy must also take into account educational

exceptions such as fair use and fair dealing, making sure these exceptions are not disregarded because of our current protective environment.

5. Conflicting administrative pressures dictate a need for clarity about IP and its management.
6. Policies provide an opportunity for museums to add their voice to broader IP debates.

Pantalony cited the TEACH (Technology, Education and Copyright Harmonization) Act, a new bill in the US Congress, as an example. (See ALA's April 2002 "Issue Update" on the Act.) This bill is essentially an exception to copyright for production or use of IP in distance learning environments. Museums may not be able to take advantage of its provisions because they may not be considered accredited educational institutions within the definitions of the bill. When Pantalony spoke with individuals involved in the lobbying process behind this bill, she was asked "Where were the museums? They weren't there." Pantalony felt that by placing policies on paper and sharing them, museums begin to add their voice to the broader discussions and help ensure they are heard on a larger playing field.

---

## **Discussion**

### **Policy in University Museums**

Diane Zorich asked how policy in a university museum might interact or conflict with its parent university's policy. Gasaway mentioned that in her experience in the UNC system, which includes galleries and museums, she observed that the ownership policies for the university were broad enough to encompass the museums, although they didn't really address the curatorial aspect. She suggested that each of the galleries and museums in a university need to take the overall university policy and go further with it if there were issues not covered for them. Pantalony thought that university museums may need "subpolicies," but cautioned that if you become too granular with your policies in a university setting (i.e., every school and department having its own policies) you might lose balance with the other areas of the university.

### **Museums and the Circumvention of Copyright**

Richard Rinehart described how museums own many public domain works but control them through access to the physical object. Are museums using this as a way to circumvent copyright? Gasaway said that she has come up against this frequently in her experience with museums and archival collections. She tries to shame museums and archives by essentially asking them (when it is not an issue of preservation), "why are you doing this?" How can museums expect access to other works when they aren't offering it for their own works? Pantalony noted that by controlling access, museums are a lot more like the recording industry than they care to admit. She suggested users ask museums who restrict access why they are doing it. That might further a user's understanding for the museum's perspective and also break down some barriers that the museum has put up. She summed it up by saying, "do more than just ask, ask why."

### **Museum dot.coms**

Brian Porter liked Pantalony's list of reasons for developing a museum IP policy so

much that he said he would refer to them as "Rina's Rules." He asked if Rule #3 ("commercial potential requires sound fiscal management") was at play in the dissolution of the MoMA/Tate dot.com enterprise. Pantalony replied that the MoMA experience was not unlike what many museums were experimenting with at the time, and, like the entire dot.com environment, it was being rethought and may resurface with different permutations.

### **When is IP "born"?**

Len Steinbach asked at what point museums give birth to a piece of IP? He noted this his institution, the Cleveland Museum of Art, developed a recent project that included the published work of a conservator, xray and infrared photography from the conservation department, text by the curator, education department work, images, etc. At what point in the midst of these activities did it become IP? When does the museum start considering and treating it as their IP? Gasaway noted that the example Steinbach cited was clearly a compilation under US law, and the "work" was likely created very early in the process. She said that it may be a policy issue as to when you claim rights in a work, but the copyrightable work itself was created very early on. Pantalony noted that the definition of a compilation work is different in Canada and the answer for Canadian museums might be a little different.

---

## **THE INTERNATIONAL PERSPECTIVE**

### **Christopher Hale, Institutional IP Policy from an International Perspective**

Chris Hale broadly addressed the development of museum IP policy, and highlighted areas where international issues could come into play.

He began by emphasizing the unique role museums have as both users and owners, and noted that it is important that museums be consistent with these roles. The attitudes museums take with respect to their own IP must reflect the respect the institution shows to the IP of others. He also suggested that museums start to consider themselves as "acquirers of rights" in addition to being acquirers of objects. And he suggested that in considering IP policy development, museums start from an examination of the relationships they have with their employees, staff, volunteers and all other individuals with whom they interact.

Using Canadian and US law as examples, Hale highlighted areas where differences in copyright play out. First, the bundle of rights that constitute a copyright can vary from one country to another. Rental rights, public exhibition rights, copyright term length, work-for-hire provisions, and exceptions to infringement (e.g., fair use or fair dealing)

are also important areas where law may vary by country. Hale cautioned that if you are undertaking activities in another country, it is critical to understand and abide by its rules in all these areas. Citing fair use as a defense, for example, will not get you very far in Canada.

Moral rights constitute another important area of IP law that varies by country. In Canada, moral rights are very significant; in the US, they are less so. Canadian moral rights allow creators to be identified with their work and to have integrity over their work (i.e., to resist distortions, mutilations or other modifications to the work, and to resist association with a product, cause, or institution if it may damage the reputation of the artist.) Moral rights can be waived but not transferred by contract. They always reside with the creator, and the creator is the only one who can waive these rights. In addition, the term for moral rights in Canada is the same as the term of copyright, so moral rights pass along after the death of the creator to a bequeathed or to an heir.

In the larger realm of IP policy, copyright is only one of several IP issues. Museums must also consider patent or trademark rights, as well as their institutional liability should they infringe on someone else's patent or trademark. The latter circumstance is not as unlikely as it may seem. Patents are increasingly being given for business practices which may take place in your institution as a matter of course. For example, a patented ticketing system that is used by a museum may not be collections-related, but it is still integral to a museum's operations. In summarizing, Hale noted that it is important for museum IP policy go beyond the copyright regime, and for museums to be vigilant about laws and distinctions in other countries where they conduct business.

---

## Discussion

### Resources on International Copyright Terms

An audience member asked if there was any resource that tabulated all the known copyright terms internationally. Hale and Pantalony weren't aware of any single chart, although Pantalony recommended a work entitled *Copyright in Photographs: An International Survey* (by Ysolde Gendreau, Axel Nordemann and Rainer Oesch, Kluwer Law International, The Netherlands, 1999), which looks at laws in the US, Canada, Asia, and Europe. Hale cautioned that this work is for photographs, which are often subject to much greater restrictions in copyright term than other work, and urged the audience not to extrapolate from this to other types of objects. Pallante suggested the WIPO Web site might have a term chart; the audience member replied that she had found information at the site, but it was very sophisticated and hard to interpret.

### International Copyright Laws and the Web



Diane Zorich asked how an institution can responsibly respect the laws of other nations when it places its materials on the Web, since it can't realistically investigate the laws of every single nation (which is, theoretically, the geographic range for these materials when they are placed online.) Hale noted that making information available on the Internet makes it accessible in many jurisdictions, but the mere fact of accessibility may not constitute an infringement in the laws of other jurisdictions. Museums need to rely on domestic counsel, and this counsel will need to take a wider view of things and decide if the mere fact of display on the Internet is enough to infringe in another country.

---

## THE PROCESS OF POLICYMAKING

### **Maria Pallante, From IP Audit to Valuation and Management**

-See *Presentation Slides* (as [Powerpoint](#); as [PDF](#))

-See *Handout* (as [PDF](#))

Maria Pallante's presentation took a practical approach, building on the broader concerns articulated by previous speakers, but honing in on the actual process of finding out what intellectual property a museum actually owns as an institution, how to ascribe value to it, and how to manage it.

Beginning with the first topic -- finding out what a museum owns -- the only accurate way to accomplish this is by undertaking an IP audit. Pallante identified several reasons for conducting such an audit. First, you need an audit in order to develop an accurate IP policy. It is impossible to develop sound policy without it being rooted in the IP reality of an organization. Second, the audit tells you what it is you have and where it came from. This is revealed through an inventory of IP assets. Thirdly, an IP audit will trigger and facilitate creative projects using found assets. Pallante noted that one of the "joys of inventory" is finding out that you own something you didn't realize you owned. In the Guggenheim collection for example, Pallante and her legal colleagues discovered when going through the files that the Museum owned the copyright to the artwork Grrrrrrrrrr! by Roy Lichtenstein; the artist had bequeathed the copyright to the Museum, but the staff had not been alerted. This kind of discovery starts a chain reaction of activity: the retail store realizes it doesn't need to pay royalties on posters or other products that feature the work, the publication department realizes it can put the work online, and the institution may consider licensing the work. Creative juices flow when you realize you own IP.

Another important reason for conducting an audit is to monitor compliance. Compliance is the role of the legal office and most department heads, and to some extent the IT director. If your institution has a lot of third party institutional agreements, monitoring is very important. If you don't monitor these agreements, you run into situations such as having staff in your retail shop failing to enter proper royalty rates, or staff that is unaware of your agreement with ASCAP and thus not providing compliance data, etc. Getting your staff to do the operations once you have an agreement in place is often where things fall apart and is why monitoring is critical. With licenses, compliance is largely knowing what licenses or agreements say, not making assumptions, and making sure relevant staff know of the obligations.

Staff alertness is also critical in monitoring compliance. Pallante noted that Guggenheim staff often let her know when they see the Guggenheim name, building image, or artwork in contexts that they are not sure are legitimate. Knowing who to communicate this kind of information to is sometimes the greatest gap in monitoring compliance in an institution.

Pallante next addressed the question of who should conduct the IP audit in a museum, stating that anyone with a vested interest in these issues could take the lead. Generally, the push comes from a person who wants to know, on a regular basis, the state of the collection, the state of the files, etc. Although one person needs to take the lead, conducting the audit is not a one-person job. Every person in every department in a museum will have their own IP, so it is best for people in each department to look at their particular department's assets. This is a big project for an institution, and Pallante suggests setting up institution-wide meetings where people investigate IP in their departments and then come back to the larger group to report.

When should an IP audit be conducted? Pallante defined an IP audit as a never-ending process that must be done regularly. She cautioned that if you don't do it regularly, you will have to do it before you enter into any business venture or contract where IP is an issue, and then you will find yourself scrambling. Often the impetus for an audit is the hiring of a new rights or permissions employee: their arrival spurs action. Pallante found herself in this situation when she was hired at the Guggenheim: staff came up to her with urgent inquiries about copyright status for the collections. To help with this effort, Pallante recently hired an assistant to handle the administrative side of IP management. In order to convey some sense of what the administrative aspects entail, Pallante read some of this person's job requirements: fact-finding and the administrative work necessary to obtain permissions and rights required for artwork, photographs, essays, books, etc.; researching and identifying rightsholders; facilitating communication and negotiating and documenting the parameters of a license and the fees; monitoring compliance of trademark licenses; and helping to build and maintain

a database and Intranet site for use by employees that includes information needed to adequately manage the assets. (See the job description as [PDF](#))

Pallante quickly outlined some of the places where IP is found in museums: archives, exhibition and education departments, registrar's files, curatorial files, directors, office, etc. In reality, the location of IP is somewhat unique to each institution. Registrar's files tend to have valuable documents, such as assignments signed by artists. Curatorial files tend to have evidence of intent, i.e., what was supposed to have happened but never actually did. The museum's retail store may have global distribution agreements.

Pallante explored the question of how a museum deciphers its IP assets by focusing on trademarks, noting that museum, domain, exhibition, and catalogue names can be trademarked, as can acronyms, logos, and buildings. The Guggenheim has actively developed and registered both its Frank Lloyd Wright exterior circular image of the building, and the building's interior skylight. These two building images bring in significant income, which is promptly used for the Museum's programming and mission. The Legal Department of the Museum has had to work with the Public Relations Department to determine what are legitimate publicity uses and what images require written licenses and revenue.

As an example of how a museum-developed asset can become a trademark, Pallante discussed the Guggenheim's Learning through Art program. This particular program is identified with the Guggenheim in New York City, but the name is not very unique or distinguishing, and others elsewhere in the country use the name in related, albeit independent, ways. To further develop the common law trademark (which by itself is not registerable), the Guggenheim is creating a unique logo for the program which will incorporate the name. This combination may be registered as a design mark. Using the name with the logo clearly identifies the program as the Guggenheim's; if someone illegally uses this logo/name combination, they are clearly trying to create confusion in the marketplace. Pallante's point in presenting this example is that museums may want to register even relatively generic names if they think there is some value there that should be protected.

Ending her discussion of trademark, Pallante emphasized that trademark is a process: you have to use your trademark in interstate commerce, and you have to keep using it or else you lose it. The Guggenheim has developed an interesting policy about the licensing of its trademarks that leverages the value of its marks for an even greater benefit for the museum. For high profile licenses in which a company desires major public association with the Museum's name and image, the Guggenheim often expects the company to contribute to the Museum's mission beyond the licensing fee, perhaps as an exhibition sponsor and or a corporate member.

Turning to copyrights, Pallante quickly identified the types of works in museums where copyright might reside: in the collections, images, brochures, posters, checklists, catalogues, promotional materials, exhibition design, programs, films, products, websites, compilations, etc. She discussed licenses and noted that exclusive licenses effectively cut off other revenue sources, so the terms of the license have to be very good for one to enter into these kinds of agreements.

Once the audit has identified a museum's IP assets and their location, the next step is valuation, i.e., how do you determine what they are worth? To whom are they valuable? Is the value financial, or is it a control issue? Is its value found only in a compilation or collection like a database? Pallante displayed the IRS definition of fair market value and summed it up as saying that your IP is "worth what you can get for it."

The next activity that follows an audit is management, i.e., what do you do with what you own? Noting that this area is complex enough to merit its own conference, Pallante summarized some of the critical management needs of IP as follows: analyzing the legal status of rights, registering copyrights, trademarks and domain names, tracking renewals, tracking status and ownership, tracking license restrictions, ensuring proper notice is on reproductions, developing technical requirements and investing in software for managing the assets.

Technologists are particularly important for these latter tasks involved in database development. Pallante identified the kinds of information she'd need in an automated database, including artist's name, nationality, and birth/death dates, copyright status, contact information, licenses on file, restrictions on use, policies and procedures, lists of proper credit lines, renewal dates, etc.

An important part of management is legal notice. A museum's legal notices on its IP should be specific to what is really being claimed. For example, a museum probably can't claim copyright in many of its posters unless the layouts are original. What really should be on the poster is the artist's copyright (if the poster is using an image of an artist's work.) Similarly with digital images, catalogues, photographs, etc., the notices should be specific to the work where copyright is being claimed; e.g., "Catalog © 2002 Guggenheim Museum" or "Photo © 2002 Guggenheim Museum."

Pallante ended her presentation by noting that the final part of management is enforcement. Once you have set up your management systems, you need someone to monitor and enforce your rights and make sure you are not violating the rights of others.

---

## **OPEN FORUM 1**

### **"Scooping" a Trademark**

Scott Sayre related a trademark saga that occurred when he worked for the Minneapolis Institute of Arts (MIA). The MIA's project, ArtsConnectEd, was created with the MCI Foundation as a funder. The MIA and the Foundation agreed, in writing, that the MIA would register and own the trademark to ArtsConnectEd. When the MIA went to register the trademark, they found that MCI Corporation already owned it. The MCI Corporation told the MIA that the agreement they made was with the MCI Foundation, not the Corporation. Eventually, the MIA was able to obtain the trademark back from the MCI Corporation. Scott offered this experience as a cautionary tale about entering into an agreement with someone who sees intellectual value in the name you provide.

Pallante responded that contracts only apply to the parties specifically named within them, and suggested that one way to prevent such things from happening was to include the organization and all its affiliates in a contract, to protect yourself from being undermined by an affiliate. Hale noted that in order to obtain the US trademark registration, MCI Corporation must use the mark in interstate commerce or rely upon use by a licensee. Without knowing more, it would be interesting to see if the MCI Corporation defined their use as that of the Foundation. This would imply that there was a licensing relationship between the Corporation and the Foundation.

### **Revocation of Copyright Assignments**

Lu Harper asked the panelists about revocations of artists assignments by an estate, and whether there is an obligation to inform owners of art work when such revocation has taken place. Her institution had a written artist's assignment for a work, but was told by the estate's licensing organization that this meant nothing.

Pallante said that it sounded like the estate was ignoring the assignment of copyright under US law, and they did not have the right to do this. She urged Harper and her institution to carefully review the assignment document to understand just what it states. Hale brought up the possibility that "reversionary" rights might be coming into play here. In Canada, when 25 years remain on a term of copyright, all rights revert back to the heirs. You cannot contract out of this. Reversionary rights also exist in US law, but they are complicated and not automatic, as in Canadian law. Without knowing all the details, Hale suggested that this may be what is happening in Harper's situation. Pantalony suggested that this kind of situation necessitates "another column in your IP audit sheet" that identifies works where assignments exist, so you can give yourself a warning date when something may be reverting back.

### **Domain Name Registration: How Much is Enough?**

Len Steinbach asked how a museum can reasonably determine how many domain

names it should register. His institution (the Cleveland Museum of Art) used a computer program that took words like "art," "museum," "store," "Cleveland" etc., and created every permutation that could be used as a domain name. They came up with approximately 380 possibilities for their institution. How far does a museum really have to go in licensing all these domain names?

Pallante said that defensive registrations -- registering names you never intend to use but want to prevent others from using -- is not as important as it was in the past because new law and the development of ICANN registration/arbitration procedures are of tremendous help in countering cybersquatting. Hale added that if everyone pursues a "register all possibilities" strategy, we will be back to where we were a few years ago: needing more top-level domain names. He advised museums to simply figure out the names they really want to use, noting that the goal should be to ensure that people can easily find you on the Web.

Gasaway suggested that cease-and-desist letters that mention the anti-cybersquatting statute are often enough to get someone to surrender a domain name, but both Pallante and Hale cautioned that this can backfire, with people publishing your cease-and-desist letters on the Web or circulating them online with negative commentary. By doing so, suddenly your complaint is twisted into something that becomes a public relations disaster. Hale suggested another strategy: monitoring the registration of domain names that have been registered by a cybersquatters. Sometimes cybersquatters forget to renew their registrations, and you can then register the name for your institution.

### **Rights Management Software**

A audience member asked if there was any off-the-shelf software for managing IP. Pallante suggested researching corporations and law firms to see what they are using, since they have been managing IP for a long time. Len Steinbach said that there are very expensive software packages that deal with rights management, but also noted that the collections management systems for museums are getting sophisticated in this area. Pantalony knew of software systems that can sit on top of your collections management system and assist with the IP management aspects, but emphasized that there is nothing that offers everything you want, and you still will be resorting to multiple methods for organizing and accessing IP information. David Green noted that the NSF is sponsoring an effort to create a digital rights management core in metadata, which will help further standards in the recording of rights management information.

## **Brian Porter, Putting Together a Museum's IP Policy: Renaissance ROM as a Case Study**

- See the Presentation Slides (as [Powerpoint](#) ; as [PDF](#))
- See the ROM Copyright Policy (in [PDF](#))
- See the ROM Trademark Policy (in [PDF](#))
- See the ROM Information Management Policy (in [PDF](#))

Brian Porter began his talk by making some important points about content. In the new media environment, content, not bandwidth, is in demand, and it is content that museums like ROM have and need to exploit.

Porter provided background and an overview of the Royal Ontario Museum (ROM) and the changes that are underway there. ROM is Canada's largest museum, with a dual mandate of culture and civilization, and natural science. Porter briefly discussed "Renaissance ROM," a capital campaign and renovation program designed to reinvent the museum. He also discussed "ROM Digital," another initiative piggybacking onto Renaissance ROM, which will systematically digitize the collections and leverage these new assets. ROM Digital will consist of a number of new structures and activities in the Museum, including the implementation of a new collections management system, an imaging center, a digital repository database, a digital gallery, and education and business applications.

As ROM begins these new initiatives, the Museum has had to learn a new language of business. The fiscal responsibilities and issues involved in taking digital assets and making money, or identifying ways to make money, are a huge challenge. It will require technology, policy, process, and organizational changes, but the outcome will ensure that the Museum has a disciplined capture process and secure storage of its assets. For Porter, it is all about creating and protecting assets, providing wider access to them, helping people make personal connections through them, and last but not least, improving efficiencies in internal organization.

As Renaissance ROM and ROM Digital were underway, the ROM Board adopted a new governance model that required redrafting several policies and creating new policy where none existed before. By last Spring, ROM had 20 new policies in place, including one on copyright and related policies in the areas of public access, information management, and publications.

Porter emphasized that having a copyright policy is one way of recognizing that your IP is an asset and a commodity. The policy also addresses the demand for self-sufficiency and revenue growth and, at ROM, was critical in addressing the inconsistent practices that existed within the Museum. The process of how the policy

was put together was complex, but a group of staff members worked on its development and hired a writer, in conjunction with ROM's Chief Operating Office, to craft the document.

Porter reviewed some items outlined in ROM's IP policy. The policy notes for example, that ROM owns the economic rights in works produced by employees and has interests to economic rights created in conjunction with ROM-funded activity or research. The policy also details the steps for employees entering into projects that are not directly related to their employment at the Museum and outlines use of ROM resources for external projects. It allows employees to waive moral rights where ROM owns economic rights to the content, addresses the right of integrity for accessioned objects, and requires that senior executives have all information necessary to ensure that ROM staff and the institution is adhering to the policy.

In a model that is driving the business side of ROM's digital initiatives, the Museum is expecting immense growth in three key areas: the museum attraction, asset exploitation, and education programs. Copyright policy is key to success in these areas. As projects and programs develop, ROM will be considering its initiatives along a four-part matrix that includes process, policy, technology and organization issues. Porter concluded by suggesting that the audience members who participate in the workshop portion of the program consider this four-part matrix when they address the workshop scenarios and draft some policy statements.

---

### **Rachelle Browne, Constructing Values: What to Put Into a Policy**

Rachelle Browne examined the importance of understanding an institution's larger values in constructing policy. When asked to speak on this topic, Browne initially was overwhelmed by its complexity. Among the first questions that she asked herself was how does one identify the sources for an institution's larger values? Do you look at an institution's governing documents? Enabling charters? Any applicable codes of museum ethics? Or the general expectations of the communities that are served by the museum? Even if you assume that you can identify the sources for those values, how should those values be applied in a museum setting that may be beset with a host of financial, legal, technical, time or other practical constraints?

In constructing a policy, is there any "value" in doing so if the policy only responds to or addresses current problems or challenges? In other words, should that policy anticipate, and be drafted with an eye to being useful in addressing, future concerns and museum needs as both technologies and the "community's established practices



and understandings” evolve? And, just what policy are we constructing? Is it solely a policy on a museum’s own uses of copyrighted materials or on its handling of requests from third parties for the use of materials from the museum’s collections? Or, should the policy also address the disposition of rights between the museum and its employees, freelancers, volunteers or interns?

To get started, Browne drew upon three well -taught, but simple lessons from her grandmother (Browne reminded participants that neither her grandmother nor she made any claims of original authorship to these lessons): 1) thou shall not steal; 2) do unto others as you would have them do unto you, and 3) make new friends but keep the old. She considered these lessons in two contexts: when museums want access to others’ materials, and when other parties want access to museum materials. In both contexts, a museum may have a legal basis to do what they want to do, but that legal position is not always the most sound one for a museum. Browne noted that a prudent museum should examine the consequences of any particular policy in the context of the following:

- How does the policy fit in with the museum’s mission?
- How does the policy enhance museum delivery of education, cultural or other public good?
- Does the policy respect and support innovation and creation, as evidence in the level of fairness with which it treats artists, donors, sources communities, users and visitors?
- Is the policy consistent with stewardship responsibilities?

She asked the audience to consider two different scenarios:

Scenario 1:

A wife of an aging, visual artist asks a museum about a reproduction of his original painting in a popular trade book. The museum purchased the painting in 1977 for \$1000, and the work was reproduced in that same year in a calendar published by the museum. The museum has no record that the museum authorized the reproduction of the painting for this particular book. The Museum informs the artist of this fact, and also informs the artist that it believes that the work fell into the public domain in 1977 upon its sale to the museum (when it was also first published, without copyright notice.) The response does not mention that since 1977, the museum has collected usage fees of over \$3,000 for reproductions of the work in other contexts, nor does the response mention that the museum has included this image in a digital database created for university use in closed networks.

Is the museum’s legal position defensible (i.e., that the artist’s work is in the public domain)? Maybe. Assuming that the museum’s position is correct, is the museum now

free to usurp control of any residual economic value in the image because it controls physical access to the object? Can the museum now authorize and license reproduction of the work for a fee? Should the museum, as an ethical matter, account for and share the proceeds with the artist? If it did so, does this mean the museum also must treat all public domain works of living artists in this same manner?

Contrast the museum's response in this scenario with the response in the following one.

### Scenario 2

In the early 1970s, an artist allowed the museum to include his painting in an exhibit. The artist never retrieved the work from the museum. Twenty years later, museum staff find the painting and recommend it for reproduction as one of several images in a children's educational gameboard. The game sold for \$15.00 and never made any money for the museum. A new registrar discovers that the painting was never accessioned into the collection. The museum director, on his own initiative and without legal counsel, contacts the artist and invites the artist to the museum at the museum's expense. At the meeting, the artist is provided with a copy of the gameboard and the financial report of all sales and expenses associated with the game.

Assuming that the painting was published, without notice, upon being lent to the museum, and consequently fell into the public domain, what obligation, if any, did the museum have to the artist? Possibly none. What did the museum gain? In this instance, it got a written deed of gift from the artist for the work, an oral interview from the artist for the archives, and it removed any risk that the artist might have found out about the infringement on his own. It was a win-win situation. In the case of intangible communal property - folklore or sacred songs - in the public domain, a museum, a matter of policy and not law, may exercise a form of self-censorship, limiting access to, or dissemination and exploitation of, such materials unless adequate and respectful safeguards are followed. Browne discussed a set of guidelines that Tony Seeger (former director of Smithsonian Folkways Recordings) has written about for collecting and recording music from developing and developed countries, which emphasize fair and ethical treatment of artists and performers, even though these practices may put added burdens on the organization. Why would a museum following the same principles assume added constraints on its operations or act in a manner contrary to its mission of "disseminating information" as freely and as broadly as possible? One reason is that a museum does not want to marginalize the communities who create the works in their collections. Another reason is that a museum could risk alienating the wider community that supports its mission.

Browne addressed the second lesson -- do unto others as you would have them do unto you -- in considering requests from others to use materials in the museum's

collections. Browne noted that museums, unlike the motion picture industry, record companies, or for-profit publishers, historically have operated in a “gift economy,” where the focus is on the educational, cultural, scientific or societal exchange. But many museum are developing policies that may impair access and exchange, especially in digital environments.

The goal of most museums’ digitization projects is generally to preserve the originals and encourage and provide wider access on a non-commercial basis. The question then must be asked, given these objectives, why would a museum have a policy of imposing barriers, such as watermarks or other protective copyright management tools, that limit a website visitor’s access to, or ability to reuse a work in digital format? Or why would a museum claim rights to still images and other works in digital format when the underlying work may enjoy no copyright protection? Museums have some legitimate reasons for doing so: for example, licensing or other contractual obligations imposed by the source of the materials; a sense that the museum has a fiduciary obligation to protect the integrity of the work from diminution by “the public’s” misuse; and an obligation to prevent the disposal or “giving away” of the museum’s assets with little or no consideration for the inurement of private, commercial interests as distinguished from the general public. But increasingly some of the reasons are not really tenable (such as claiming rights in a digital copy of a public domain image) and risk incurring the ire of larger communities as well as calling into question a museum’s core values.

Browne quickly summarized the third lesson (“make new friends and keep the old”) as it applies to museums by encouraging museums to devise IP policies rooted in their core values but which also embraced the role and place of new technologies. She concluded her presentation by stating that legal issues should not be the sole lens through which a museum focuses its IP policy. Values and ethics play an equally important role.

---

## WORKSHOP ACTIVITY

See the Scenarios (in [PDF](#))

After giving their individual presentations, Porter and Browne led the group in the second part of the workshop: an exercise in drafting policy in response to three particular scenarios that they created. The audience was split into groups of six to eight people and given thirty minutes to read through, discuss, and draft a policy that addressed one of the three scenarios. Each group selected a discussion leader, a timekeeper, and a “scribe” to record the discussion and draft the sample policy

statements. At the end of this time, each group reported on what it had discussed and the statements it had crafted.

### **Exercise 1:**

The group who worked on this exercise - developing an IP policy that addressed handling requests from outside parties for copyrighted works in the museum's collection -- felt that the series of questions in the scenario, and the questions in Exercise 1, required first and foremost a broad "mission-like" statement in the policy that identified the purpose and core values of such a policy. To that end, they proposed the following:

"The purpose of the Museum's IP policy is to :

1. Respect the IP rights of all stakeholders involved
2. Protect and promote the museum's intellectual assets
3. Provide defined authorities and guidelines for managing these assets
4. Educate staff and users about the policy and monitor its compliance

Once the group agreed on this broad, philosophical position statement, they felt the museum staff could develop specific statements on handling museum assets, whether the underlying IP of these assets was owned by the museum or not. Time constraints prevented the group from crafting language that addressed these specifics.

### **Exercise 2:**

The group working on this exercise addressed the issues of fees associated with using museum IP assets. The scenario asked the group to develop a policy that addressed the issue of fees when the museum owned the IP rights, and when it did not. Participants in this group drafted the following position statements:

- The museum has the right to derive, at a minimum, cost-recovery from any request, or fees through a standard pricing schedule
- Requests to use materials must contain restrictions. All requests should follow the same process.
- Copyrighted works should not be used before the copyright holders have been contacted. Proof of copyright clearance must exist before releasing the item.

After reporting on their position statements, a short discussion ensued on practices in this area in other museums. Amalyah Keshet spoke about the distinction between a copyright and a use fee, the latter being a fee for use of the museum's product (not the underlying work). This use fee helps recoup the museum's considerable costs in creating the product. Richard Rinehart noted that most users would understand a fee for recouping a museum's time and expense in providing them with a photograph of a work or access to a work. What they object to is when they pay a use or access fee for

a photograph of a public domain work, but then cannot use the photograph (even if the user himself took it) except in very restricted circumstances.

Maria Pallante noted that museums cannot necessarily exploit their copyright in a photograph without the permission of the artist who owns the underlying work, because the photograph is technically a derivative work that requires approval of the original copyright owner. For this reason, museums need to tell artists when they acquire their work that the museum needs to photograph the work for documentation, conservation, etc., but that it will not photograph their work for commercial purposes without their permission.

### **Exercise 3:**

The third group addressed the policy issues involved in a museum's recording and use of a videotape depicting an indigenous tribe performing a traditional spiritual dance and song. The museum was using this video as a supplement to an exhibition on objects from the region. Portions of the video include chanting that is considered sacred to the indigenous community.

Two groups addressed the issues in Exercise 3. The first group agreed that any policy must:

- Respect the moral rights of authors and performers.
- When possible, create meaningful contracts with authors and performers; always negotiate directly with the creators and performers, as well as any legal entity that has the right to bargain on their behalf.
- Make certain that copyright of individual components of the performance resides with creators, but the copyright in the aggregate work should be jointly shared between the museum and the indigenous group.
- Clearly post copyright statements and/or credits whenever the work is presented; the copyright statement would be specific to the work (not a generic statement).
- If a work is used for commercial purposes, a profit-sharing agreement will be used if the commodified work makes a profit. The second group drafted the following position statements.
- The new policy will dictate that permissions will be secured, in advance of any image/sound capture, including for performance of any underlying copyrighted work. For aboriginal/traditional cultures, permission will be sought from elders/authorities of that culture. The museum will ensure ownership of copyright in the recording by the use of good, clear employment contracts.
- The permissions will be broad enough to address various uses the museum may wish to make, taking into account future (albeit unknown) technologies.

- The museum's IP policy will be guided by ethical issues, apart from strictly legal considerations.
  - The museum will make clear, allowable uses to visitors to encompass fair dealing/use, and banning commercial use.
  - The museum will ensure good copyright protection for its own content, and an efficient licensing operation.
- 

## **OPEN FORUM 2**

At the end of the workshop, David Green invited all the panelists to answer any final questions from the audience. The following issues were discussed.

### **Copyright in Web Sites**

An audience member asked if his museum could claim copyright in his Web site as a compilation. Pallante responded in the affirmative, saying that a Web site is a definitely a compilation copyright. Although licenses may be needed for use of information/images at sections of the site, the entire site is copyrightable as your compilation.

The audience member followed up with a question about copyrighting dynamic resources like a database or Web site. Gasaway noted that the US Copyright Office has been accepting Web site registrations for a couple of years now, and encouraged people to register their Web sites. Pallante suggested updating the copyright registration on these works at frequent intervals. If you do not choose to register them with the Copyright Office, you should at least keep files of these resources as "snapshots" of what they are like at certain points in time. The reason for this is that often you don't discover infringements until later, so you will want to have a sense of what your database was like at the point at which the infringement occurred. Pantalony noted that CHIN places a date range in their copyright notice (i.e., Copyright 2000-2002 Canadian Heritage Information Network) to indicate to users that there have been a series of changes to the Web site or database during this period and CHIN holds copyright to all versions of the site that existed during this period.

### **Museum Use of Copyrighted Works for Promotional Activities**

Hsiu-Ling Huang asked a question about use of images from the collection to promote certain museum programs (e.g., the education department's use of images on a teachers' calendar, the membership department's use of images on brochures to recruit new members, etc.) when the rights to the underlying work belongs to others. Is this type of use "fair use"? Amalyah Keshet amended this question to include use of such images for museum fundraising efforts.

Gasaway responded that this is possibly fair use, but not likely. Pallante noted that fair use is very fact-intensive. You cannot extract from one instance of fair use to another. A catalogue use may be judged fair in one instance, and not in another. All the examples Huang cited in posing her question are really very different from one another when considering fair use.

Huang noted that the museum was not making a profit from these uses. Gasaway responded that it was a fallacy to think that whether you make a profit or not determines fair use. Profit-making is really not the point. It is a tiny piece of one of the four factors that define the fair use doctrine. The real issue is the effect on the market for a value of the work to an artist or a photographer. Gasaway didn't think anything Huang described qualified as fair use. Browne noted that the uses Huang mentioned fall in the area of marketing and promotion, and at her institution (the Smithsonian), they do not see these as fair uses.

Keshet raised the quandary that this presents for museums: if a museum can't use images of copyrighted works in its collections to convey information about itself, how can it portray and promote itself? How can it show others what it has in its collections and why people should come to visit or use its collections for research? One Israeli copyright attorney has suggested to Keshet that ideally fair use should include an exception for informational uses, i.e., just letting people know that "this is the work I am talking about." Keshet conveyed an anecdote in which her museum wanted to use reproductions on museum maps and directional stands whose purpose was solely to point visitors to the galleries where particular works are displayed. When given a choice to pay a royalty or take the signage down, they opted for the latter. Everyone loses when control is asserted at this level.

(Editors Note. In May of 2002, a Federal court case in New York suggested that informational uses such as Ms. Keshet notes above may be permissible within the context of the First Amendment and privacy laws of various states. The lawsuit was filed against the artist Barbara Kruger for her use of a photograph of a woman (without the woman's permission) in one of her works, and against the Whitney Museum of Art and the Los Angeles County Museum of Contemporary Art for reproducing the image for merchandise and advertisement (of the Kruger work). The Court stated that the artist's use of the image fell under the First Amendment as free speech, and the "Whitney's display of the work was therefore protected by the First Amendment... as was the reproduction of the image in the exhibition catalogue. Similarly, ... the leaflets, newsletters, and other exhibition advertisements, including the large vinyl "billboards," fell outside New York's privacy protection, because they merely "proved the worth and illustrated the content" of the show" (See M. Lufkin's "Art Trumps Right to Privacy," *The Art Newspaper.com*. Sept. 27, 2002)

### **Museums, Fair Use and Risk Aversion**

Richard Rinehart wondered if the museum community needs to be more proactive in claiming fair use. At his institution (Berkeley Art Museum, UC, Berkeley), when an issue is borderline, they take the position of "taking the risk." As he sees it, when cases come before judges, the judges might look at the common practice in the field as a sort of baseline for consideration in rendering a decision. If that common practice in museums is to be risk-averse, that works against museums, for that is the rubric by which museums may be judged in future court cases. Rinehart fears that museums may be closing the fence around them by adopting this stance. He sees an ethic coming out of museums that says "being a responsible museum means being risk-averse" when it should be that being a responsible museum means being on the lookout for the public good.

Pallante cautioned that US copyright law is a strict liability law. It doesn't matter if you didn't know about something. Thus an institution's position really does have to depend on how much risk it wishes to take.

### **The Place of Privacy Rights in an IP Policy**

Julia Matthews asked if protection of personal privacy was part of an IP policy. Gasaway responded that this was an important issue that definitely required a policy, but not within an IP policy. Matthews felt that privacy issues crop up so frequently in the context of IP issues that any IP policy would need to have many "see also" references to its privacy policy. Gasaway and Pallante agreed that this might often be the case, but said that privacy rights issues occur in so many contexts that it should be the subject of its own policy.

### **MEETING CONCLUSION**

David Green closed the meeting by thanking everyone who had participated, and announcing that CHIN and NINCH will be publishing a book on this subject, based upon presentations and conversation at this meeting, to be available next Spring.