

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.

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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.