

# **COPYRIGHT LAW AND THE DIGITISATION OF CULTURAL HERITAGE**

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# COPYRIGHT LAW AND THE DIGITISATION OF CULTURAL HERITAGE

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## I INTRODUCTION

Tradition, history, and research are terms associated with a cultural heritage institution. In reality, however, these terms evoke a limited understanding of cultural heritage in the 21<sup>st</sup> century. For, today, cultural heritage institutions are going digital. Internationally, cultural heritage institutions have embraced the use of modern digital technologies with alacrity, financial constraints being the only limiting factor. Digital cameras provide the means to digitise institutional collections in the form of images that can be stored in online and offline databases. Such databases provide a digital archive of a collection that is less demanding of physical storage space than the paper-based archives of metadata and photographs that were formerly compiled by institutions to manage their collections. Digital images of collection items can also be used for interactive displays within the institution, leaving the original item protected and untouchable within its traditional glass case. In addition, digital images can be made accessible to the public on an institution's website. Online accessibility permits a geographically widespread audience to view the collection and order copies of the images, and also provides a means of 'digitally repatriating' a cultural object, albeit in the somewhat limited form of a digital reproduction, to its source community.

There is, however, much uncertainty surrounding the conceptual justifications for the activity of digitisation of institutional collections. There are three main issues. First, there is fundamental ambiguity concerning the rationale for digitisation of a cultural institution's collection. From a traditional legal perspective, for instance, the rationale for digitisation is presumed to be preservation of items in the collection. The archiving exceptions in copyright law are intended to facilitate that objective. They permit an archive or library to make one digital copy of an item in its collection for preservation purposes, without the consent of the copyright owner, if it appears likely that the original item is at risk of loss, damage or destruction.<sup>1</sup> However, preservation is not necessarily the main reason that institutions seek to digitise their collections. Interviews at selected New Zealand cultural heritage institutions

<sup>1</sup> See *Copyright Act 1994* (NZ), s 55(3). The making of a single digital copy, as permitted by this provision, is in any event impracticable and unworkable no matter what underlying purpose is identified for the digitisation.

suggest that their main objective is to provide increased accessibility to their collections.<sup>2</sup> Preservation is secondary and in any event is not limited to items in imminent danger of loss - several institutions have developed a policy under which digital copies of all new entities are made at the time of adding them to collections.

Secondly, the concept of digitally repatriating images of indigenous cultural artefacts may not meet the expectations of the indigenous community from whom artefacts were originally obtained. Digital repatriation (sometimes described as ‘virtual repatriation’) also exposes indigenous artefacts to international publicity, which may itself contravene the community laws and customs surrounding a particular entity, and may also render them vulnerable to misuse by unauthorised bodies. Furthermore, digital repatriation of an image is unlikely to be compatible with the Mataatua Declaration of Indigenous Rights, a provision of which specifically requires cultural institutions to ‘offer back’ indigenous cultural objects to their traditional owners.<sup>3</sup> The possibility of digital repatriation of Māori cultural heritage items held by New Zealand cultural heritage institutions does not provide a rationale for their digitisation activities, although digital repatriation may nevertheless be one of the outcomes. However, it is a strict policy of New Zealand institutions that they must consult widely with the Māori owners of cultural items in their collections before digitising any such item. The practices regarding digitisation of indigenous works from other countries by New Zealand institutions may, nevertheless, be less robust.

Thirdly, cultural institutional claims to ownership of copyright in both the digital images of the individual items from their collections (whether or not the original items are themselves protected by copyright or are in the public domain) and in the databases of those images, are controversial and criticised by those who argue against the erosion of the public domain.<sup>4</sup> Copyright ownership of the digital images is used as a means of controlling third party uses of the images and frequently, also, as the basis of a financial enterprise for the institution.<sup>5</sup>

<sup>2</sup> Susan Corbett, Interviews with employees of seven New Zealand cultural institutions, (unpublished New Zealand Law Foundation Research project, 2010).

<sup>3</sup> *Mataatua Declaration of Indigenous Rights*, June 1993 cl 2.14.

<sup>4</sup> K C Butler, ‘Keeping the World Safe from Naked-Chicks-in-Art Refrigerator Magnets: the Plot to Control Art Images in the Public Domain through Copyrights in Photographic and Digital Reproductions’ (1998) 21 *Hastings Communication & Entertainment Law Journal* 55; R Deazley, ‘Photography, Copyright, and the South Kensington Experiment’ (2010) 3 *Intellectual Property Quarterly* 293.

<sup>5</sup> In New Zealand cultural heritage institutions, the financial possibilities in the sense of profits do not appear to be the major driver for digitisation, although recouping the costs of digitisation is seen as important: Corbett, above n 2.

This paper discusses each of these issues in turn and explains why there is ongoing ambivalence surrounding digitisation for cultural heritage. The following part examines the concept of public domain works in the context of indigenous cultural heritage collections and their digitisation and use for digital repatriation. This is followed by analysis of the efficacy of the archiving exceptions in copyright law for the digitisation of orphan works, while in the penultimate part of the paper the assertion of copyright ownership in digital images of cultural items is considered. The conclusion proposes a tentative way forward that is founded on cultural heritage institutions' informal practices and procedures.

## II PUBLIC DOMAIN WORKS

### A *Traditional Cultural Heritage – is it in the Public Domain?*

A typical collection held by a cultural heritage institution includes items that are considered to be in the public domain, in the sense that they are not considered to be protected by copyright.<sup>6</sup> Many of these 'public domain' items will be classified as traditional cultural heritage and will include items from communities indigenous to the country where the institution itself is located and items from overseas indigenous communities. The question of whether or not the term 'public domain', a western copyright concept, is appropriate for traditional cultural heritage entities is contentious.

Formerly the standard response to the question of copyright protection for traditional cultural entities was that they are not protected by copyright (due to their age), that it is likely they were never protected by copyright (due to the inability to identify the author or authors) and hence they are in the public domain in copyright terms. More recent scholarly literature argues that this position is unsatisfactory. Commentators tend to focus on features of copyright law that do not accommodate traditional cultural heritage and argue that copyright law should be changed. For example, they suggest, copyright protection should be available for collectively produced creative works, the originality threshold should be reconsidered, and a different term of protection should be applicable to traditional cultural works.<sup>7</sup>

Although each of these arguments has merit, we suggest that a more extreme, but nevertheless logically sound position should be adopted with regard to the specific question

<sup>6</sup> It will be assumed that no other intellectual property law applies to items in the public domain (although it is possible that such an item might still have a valid trade mark, for example.)

<sup>7</sup> See for example Christine Haight Farley, 'Protecting Folklore of Indigenous Peoples: Is Intellectual Property the Answer?' (1997) 30 Connecticut Law Review 1; Michael F Brown, *Who Owns Native Culture?* (2003) 237.

of whether or not a traditional cultural entity that has never been protected by copyright can now be categorised as ‘in the public domain.’ We argue that for a creative work that has never been regulated within a western system of law (in particular copyright law) and has never been offered the protections provided by that system (copyright protection), a claim that the entity now constitutes one of a group within the system (by now falling into the public domain) is unsupportable. At the heart of this argument lies acceptance of the theoretical justification for the copyright regime. In essence a rigorous application of theory leads inevitably to the proposition that copyright concepts should be imposed on a creative work only where the traditional balance of public and private rights applies; not where the private right has never been realised.<sup>8</sup>

In addition there are uncertainties surrounding the presentation of digital images of cultural heritage items in online databases. The architecture of a database may not be reconcilable with the traditional governance models of indigenous communities which is and was of a more communal and cooperative nature. Peter Radoll warns of the cultural issues with databases:

databases display a western European governance hierarchy - one individual responsible for administration and access who holds the systems administrator password. I call this the “god” password.<sup>9</sup>

Power relationships also come into question in relation to databases. In many instances the database continues to be administered by the cultural institution that holds the original items. This leads the question as to what, if anything, has really been repatriated? Digital repatriation may in reality represent the prioritisation of a cultural institution’s digitisation policy disguised as a thinly masked paternalistic gesture. A related issue is the growing practice of cultural institutions digitising and repatriating the traditional cultural entities held in their collections.

## B *Digital Repatriation*

Paradoxically, at the same time the Dane-zaa people (a Canadian First Nations community in British Columbia) are asserting their right to control how their cultural heritage is circulated

<sup>8</sup> The need for balance applies whether the theoretical justification for copyright is viewed through the economic utilitarian lens or a natural rights lens: on this point see further Susan Corbett, ‘Creative Commons Licences, the Copyright Regime and the Online Community: is there a fatal disconnect?’ (2011) *Modern Law Review* (forthcoming).

<sup>9</sup> Peter Radoll, ‘Reconstructing Australian Aboriginal Governance by Systems Design’ (1999) 16, 3 *Interactions* 46, 48.

on-line, representations of their culture and language are more prevalent on the Internet than ever before.<sup>10</sup>

Digital, or virtual, repatriation describes the process of a cultural heritage institution taking digital photographs of cultural items held in its collection but originating from a particular indigenous community and making the digital images accessible to the specific indigenous community from whence the items were obtained. Kate Hennessey warns that such projects ‘.. can generate articulations of rights (for the indigenous peoples) but at the same time they amplify the difficulty of enforcing those rights.’<sup>11</sup> Once uploaded to a website, an image, video or sound recording can be downloaded, appropriated and remixed by any user with sufficient technical knowledge, making otherwise privately managed tangible and intangible culture public. Although most institutions confirm that they have a policy of immediately taking down an image of a ‘secret’ or ‘sacred’ entity upon request, there is anecdotal evidence that this is **not** sufficient- - once it has appeared online, no matter how briefly, it is almost certain that unauthorised copies and adaptations will appear on other websites and these of course will remain available.<sup>12</sup>

In addition there is uncertainty about the reactions of indigenous communities to the sight of a digital image of their cultural heritage.<sup>13</sup> It is likely many in the community would have been unaware that ‘their’ cultural item was held in an institution- perhaps overseas- and the somewhat patronising solution of permitting them to see a digital image of the item may not necessarily meet their expectations. Susan Scafidi notes ‘Greece would not be satisfied if its demand for return of the [Parthenon] marbles from Britain were answered with an artist’s copy, nor is the British Museum willing to accept a substitute’.<sup>14</sup> This is particularly so within the New Zealand context. Tikanga Maori views taonga (Maori treasures) as incorporating a spiritual dimension. It is difficult to view the digital repatriation of an item as being perceived as analogous to its physical repatriation and thus evoking the same response from the Maori community from whence the item originated as would its physical

<sup>10</sup> Kate Hennessey, ‘Repatriation, Digital Cultural Heritage, and the (Re)Production of Meaning in a Canadian Aboriginal Community’ (Working Paper presented at MIT 6: Media in Transition Conference- Stone and Papyrus, Storage and Transmission Panel: Race, Nationality, and Digital Technologies, April 25 2009) 1 <<http://mit.edu/comm-forum/mit6/papers/Hennessey.pdf>> at 18 March 2011.

<sup>11</sup> Ibid 12.

<sup>12</sup> Ibid.

<sup>13</sup> See discussion in Peter K. Yu ‘Cultural Relics, Intellectual Property, and Intangible Heritage’ (2008) 81, 2 *Temple Law Review* 433, 446-447.

<sup>14</sup> Susan Scafidi, *Who Owns Culture? Appropriation and Authenticity in American Law* (2005) 51, cited in Yu, above n 13.

repatriation. As Kate Hennessey reminds us, 'Institutional control of cultural heritage images sometimes conflicts with cultural protocols- it is paternalistic and mirrors "colonial controls" of former times.'<sup>15</sup> In essence these digital practices also parallel histories of research, archiving, and information dissemination that have not considered local protocols for the circulation of cultural knowledge.<sup>16</sup>

In earlier times there was little if any adherence to culturally sensitive procedures by collectors and researchers when acquiring traditional cultural heritage items. For example, many indigenous cultural items were taken without consent during colonisation, or traded for prized trinkets or weapons without any real understanding by the indigenous community of the intention of the collectors or the potential value of their items. There are instances where indigenous communities have permitted western researchers to film or record their ceremonies, dances and other performances - again, for minimal compensation and also without any real understanding of either the objectives of the researchers or of the relevant intellectual property laws.<sup>17</sup> Hence, while there may be copyright protection subsisting in derivative materials such as films, sound recordings, photographs, and manuscripts of indigenous cultural items and expressions, under copyright law the copyright is not owned by the indigenous community but by the creator of the derivative materials or the institution which employed or commissioned the creator. Although Torsen and Anderson rightly suggest that the introduction of an artist's resale right would allow indigenous artists to benefit from the resale of works based upon traditional artworks,<sup>18</sup> the ownership of copyright in derivative works does not necessarily lie with the creator of the original indigenous work.

### C *Derivative Works from Traditional Cultural Heritage*

Aside from copyright considerations there is a growing awareness of ethical and cultural concerns around reproducing so-called public domain indigenous culture and using it to convey a political message. For example the 2010 winter Olympics in Vancouver were informally referred to as the 'indigenous Olympics' and identified by a logo which incorporated a version of traditional Arctic Inuit sculptures. The logo was printed on Olympic paraphernalia and trivia, including paper cups. Chief Stewart Phillip, the president of Union of B.C. Indian Chiefs said

<sup>15</sup> Kate Hennessey 'Virtual Repatriation and Digital Cultural Heritage' (2009) 50, 4 *Anthropology News* 5,7.

<sup>16</sup> *Ibid.*

<sup>17</sup> Molly Torsen, Jane Anderson, 'Intellectual Property and the Safeguarding of Traditional Cultures' (Report, World Intellectual Property Organisation December 2010) 12.

<sup>18</sup> *Ibid* 15.

some viewers will view this marketing as a sign of harmonious bonds between natives and mainstream Canadian society.

We're deeply concerned about the concerted and aggressive marketing campaign advanced by Vanoc [the 2010 Olympics organization committee] which suggests the indigenous people of [British Columbia] and Canada enjoy a very comfortable and high standard of living. The Disney-esque promotional materials suggest a cosy relationship between aboriginal people of the province with all levels of government and it completely ignores the horrific levels of poverty our people endure on a daily basis.<sup>19</sup>

While some nations would hesitate to employ traditional cultural entities within a political context without first obtaining the approval of their indigenous peoples, this is a policy matter rather than a legal requirement. This kind of activity cannot be legally prevented without first addressing the issue of whether or not such entities are legally 'in the public domain', because if they are considered to be in the public domain then they are, by definition, freely available for any use by others. Furthermore combining a public domain work with a new design, such as occurred during the 'indigenous Olympics', may bring the entity itself into the copyright system as an inseparable part of a new copyright work, which will eventually fall into the public domain.

Copyright will exist in a derivative work, such as a film, sound recording, or photographic image of a traditional cultural entity, whether or not that entity itself is technically considered to be in the public domain in copyright terms. Ownership will rest with the institution that commissioned the work. Similarly, a separate copyright will exist in an institutional database of digital images. Databases created in Europe may have additional sui generis protection under the European Union Database Directive.

In order to protect the rights of indigenous peoples in their culture certain amendments to the law are required. The issue of whether the original cultural entity should itself be returned to the indigenous community from whom it was obtained is of course another matter. Leaving that particular issue to one side, the reality is that a cultural institution has ownership of the copyright in reproductions of its collections. But copyright ownership is a state supported legal right or bargain which is inseparably linked to the other terms of the bargain. These are the permitted exceptions to copyright infringement, which are similarly supported by the state in the interests of the public good. The most well-known example is the fair dealing exception.

<sup>19</sup> Toban Black, 'An Indigenous Olympics?' (2010) < <http://www.racialicious.com/2010/02/24/an-indigenous-olympics/>> at 15 March 2011.



However the fair dealing exception may be of limited use due to two factors. First, analysis of the relative strengths and enforceability of contract law versus copyright law in New Zealand indicates that at present contract is likely to trump copyright.<sup>20</sup> In other words where cultural institutions impose contractual terms and conditions of use on their copyright entities, it appears to be becoming a norm (certainly in the perceptions and activities of cultural institutions) that such terms and conditions can oust the public good uses that are permitted by copyright law. The second flaw is linked to the specific limitations on fair dealing in New Zealand copyright law.<sup>21</sup> Unlike the much broader fair use provisions in United States copyright law the fair dealing provision is unlikely to be of much practical use to indigenous communities.

We suggest therefore that the way forward for the law is to clarify that contractual provisions may not oust public good exceptions provided in copyright law. Secondly, fair dealing provisions should be expanded into a more generous fair use regime. Pending specific changes to the legal regime, cultural institutions should adjust their policies in regard to, particularly, their terms and conditions of entry and use of their websites. Currently many such terms and conditions provide institutions with monopoly control over their copyright images of their collection, often to the detriment of scholarship and research, education and criticism. The issue of adequate funding for the institution should not be linked to copyright as currently occurs in instances where cultural institutions charge a sum above the cost recovery amount for supplying a digital image.

### III THE ARCHIVING EXCEPTIONS IN COPYRIGHT LAW

The collections of most cultural heritage institutions include a number of items that are protected by copyright. There are potentially three sub-categories of copyright items: items whose copyright has been assigned to the institution, items whose copyright owner is known and traceable, and items which are orphan works, that is, their copyright owner is either not known or is untraceable.

The increasing awareness of the significance of copyright law to their activities has led some institutions to require, as a matter of good practice, that any new acquisition for the collection must include an assignment of its copyright to the institution. Such a requirement is generally not strictly imposed, mainly because many donors do not know whether or not

<sup>20</sup> See discussion in Part IV below.

<sup>21</sup> *Copyright Act 1994* (NZ) ss 42 and 43.

they are the copyright owners. Other items may have been donated to the institution without an assignment of copyright, but with full and accurate details of the copyright owner. Hence the institution can contact the copyright owner for permission to carry out activities, such as digitisation, which would otherwise be an infringement of copyright.

However there are also moral rights to consider. Moral rights may not be assigned (but may be waived in New Zealand law).<sup>22</sup> The practice of digitisation of a work of art and displaying it as a thumbnail image, for example, might be found to infringe an artist's moral right not to have their work subjected to derogatory treatment.<sup>23</sup> It is essential therefore that institutions obtain not only an assignment of copyright, but also a waiver of the moral rights of the author. This may be difficult, if not impossible, since the owner of copyright is not necessarily the author or artist. In addition authors and artists may be reluctant to waive their moral rights. This is particularly true of the creators of digital media works, in relation to which the integrity of the 'audience experience' is seen as a crucial element of the work itself. An alteration to the digital platform on which the work is displayed may be considered by the artist to have an adverse effect upon audience experience.<sup>24</sup>

The vast majority of copyright items in the collections of cultural heritage institutions are orphan works, that is their copyright owner is either not known or is untraceable. Hence for the digitisation of these works an institution is wholly reliant on permitted exceptions in copyright law. For orphan works, or works whose copyright owner refuses to give consent for any use that would infringe copyright, a cultural heritage institution is legally constrained in its potential digitisation practices by the scope of the permitted exceptions. The archiving or preservation exceptions in copyright law of both New Zealand and Australia apply to 'archives', make limited provision for other 'not for profit' institutions, and do not specifically mention other cultural heritage institutions such as museums.<sup>25</sup> Although admittedly some museums may also fall within the definition of an archive at least in regard to a selected part of their collections, this is not necessarily true of all museums. In addition,

<sup>22</sup> *Copyright Act 1994* (NZ) s 107.

<sup>23</sup> *Copyright Act 1994* (NZ) s 98.

<sup>24</sup> On the difficulty of protecting moral rights in their current form in a digital environment see Mira Sundara Rajan, 'Moral Rights in the Digital Age: New Possibilities for the Democratisation of Culture' (April 9-10, 2001) Paper presented at the 16<sup>th</sup> Bileta Annual Conference, University of Edinburgh, Scotland, at pg 3, available at

<http://www.bileta.ac.uk/Document%20Library/1/Moral%20Rights%20in%20the%20Digital%20Age%20-%20New%20Possibilities%20for%20the%20Democratisation%20of%20Culture.pdf>

<sup>25</sup> *Copyright Act 1994* (NZ) s 55; *Copyright Act 1968* (Cth) s 51A.

both the New Zealand and the Australian copyright exceptions are limited to permit the making of a single digital copy of an original item in a collection, for preservation purposes.<sup>26</sup>

So far as access to the digital copy thus created is concerned (recalling that this is the main reason museum staff gave for their digitisation activities) New Zealand copyright law provides that an archive may communicate one lawfully obtained digital copy in protected format to an authenticated user.<sup>27</sup> However the number of users must be no more than the aggregate number of the archive's lawfully obtained digital copies, and the user must be warned about copyright misuse.<sup>28</sup> Under Australian copyright law users can access a digital copy (in protected format) only within the premises of the institution and must be warned about copyright misuse.<sup>29</sup>

There are three main problems with the archiving exceptions in both New Zealand and Australian copyright law. First the technical reality of digitisation is that it is synonymous with multiple copying and it is nonsensical to permit the making of a single copy of the original item. The digitisation process includes an ongoing requirement to make backups of digital copies and to migrate them to new platforms.<sup>30</sup>

Secondly, the restriction of the archiving exceptions to archives and other 'not for profit' institutions adds more uncertainty. Digitisation of collections is (frequently) at least partly for fund-raising, hence this requirement may preclude institutions other than archives from making use of any the limited assistance of the archiving exceptions. In their 2005 guidelines for Australian cultural institutions seeking to digitise, Emily Hudson and Andrew Kenyon assert that 'there is a strong argument that the mere existence of commercial activities within an institution (such as a gift shop or research service) would not, of itself, mean the collection is maintained for the purpose of deriving a profit.'<sup>31</sup> However, it has become clear that the more recent practice of many institutions in New Zealand is to digitise

<sup>26</sup> *Copyright Act 1994* (NZ) s 55(3); *Copyright Act 1968* (Cth) s 51A(1) - (3).

<sup>27</sup> An 'authenticated user' is defined to be someone who has a legitimate right to use the services of the library or archive; and can access the digital copy only through a verification process that verifies that the person is entitled to access the digital copy: *Copyright Act 1994* (NZ) s 56A.

<sup>28</sup> *Ibid* s 56B.

<sup>29</sup> *Copyright Act 1968* (Cth) ss 49(5A), 51A(3A)

<sup>30</sup> See Susan Corbett, 'Digital Heritage: Legal Barriers to Conserving New Zealand's Early Video Games' (2007) 13 *New Zealand Business Law Quarterly* 48, 56.

<sup>31</sup> Emily Hudson and Andrew T. Kenyon, 'Copyright and Cultural Institutions: Guidelines for Digitisation' (Legal Studies Research Paper No. 140, Centre for Media and Communications Law, University of Melbourne, August 2005) 70. <<http://ssrn.com/abstract=881699>> at 18 March 2011.

all incoming items and place the images online for public access and purchase. Such extensive commercial, or quasi-commercial, activity might be found to override the 'not for profit' status of the institution. Furthermore 'not for profit' usually means 'State controlled'. It is questionable whether the State should control culture in an online age when much scholarly writing is directed towards envisaging a means for realising the potential for 'democratisation of culture'.<sup>32</sup>

Presently, many cultural institutions do not have access to legal expertise within their staff or sufficient funding to obtain outside legal advice regarding the scope of copyright law and the relevant exceptions that are intended to facilitate digitisation of items in institutional collections. Nevertheless it is likely to be apparent to many institutions that their digitisation operations currently operate in a grey area of the law and indeed that they may be breaking the law by digitising certain items of their collections. However the approach of many cultural institutions is to adopt a risk management strategy. Under a risk management strategy the potential ramifications of unauthorised digitisation activities for the institution are assessed, usually by considering the likelihood of an aggrieved copyright owner pursuing a legal action, rather than any consideration of actual liability. Such an approach is particularly prevalent when digitisation is undertaken for collection management purposes, such as in-house cataloguing. In these instances access to the digital copies is limited to staff of the institution and it is presumed, probably rightly, that copyright owners are likely to remain unaware that their rights have been breached.

More problematic for cultural institutions is the practice of making the cultural institution's digitised collection available online for the purpose of enhancing public access. There are two alternative approaches currently employed by New Zealand cultural heritage institutions: the first is a risk management strategy, the second is risk averse. Under the risk management strategy a cultural institution publishes images of copyright items on its website as a means to enhance public access to the collection and also to expand the institution's own knowledge of its collections. The online display of images is justified as being the only way forward, particularly for orphan copyright works. It is presumed that at least some of the unknown copyright owners will make themselves known, thus creating the potential for a relationship that is mutually beneficial to both individual and institution alike. If a copyright owner objects to the display of an image of her original work the institution is prepared to

<sup>32</sup> Jack M. Balkin, 'Digital Speech and Democratic Culture: A Theory of Freedom of Expression for the Information Society' (2004) 79 *New York University Law Review* 1.

remove that work from the website. Such an approach is legally precarious; cultural institutions are technically infringing copyright law but are relying only on their 'not for profit' public good status and the institution's 'takedown' policy as protection from any potential legal action against them.

Alternatively, some cultural institutions adopt a more cautious, risk-averse approach, choosing to not digitise and publish any copyright item without the consent of the copyright owner. Whilst remaining within the letter of the law, such an approach leads to a selective representation of items online that frequently defies any rational policy. The overarching objectives of an institution (and the prioritisations demanded by these objectives) are set aside in following an alternative framework dictated by copyright considerations. Hence, decisions are made on the basis of what may not be legally digitised, rather than what would be 'of value' in the eyes of the institution and the public interest in research, education, and culture.

#### IV CONTRACT AND COPYRIGHT

Whilst cultural institutions remain divided in their approaches to digitisation and online publication of their collections, there are other areas where their application of copyright law is similarly imprecise but a more uniform approach is taken. It seems to be common practice that a cultural institution's contractual terms and conditions in relation to its collection are imposed on the presumption that they are legally capable of overriding the provisions of copyright law.

Most cultural institutions seek to impose contractual conditions on visitors to their institution and users of their collections. Revenue from reproduction fees and licensing allows museums to support their primary educational curatorial objectives and protect their collections from inaccurate reproduction and captioning.<sup>33</sup> Additionally, a cultural institution may seek to ensure its curatorial connection with the work is made known.<sup>34</sup> Many cultural heritage institutions appear to assume that their contractual relationships with visitors to the institution and the institutional website permit them to override the exceptions that exist in copyright law that prevent copyright protection being a monopoly, including the public domain.

<sup>33</sup> Keith Wotherspoon 'Copyright Issues Facing Galleries and Museums' (2003) 25 *European Intellectual Property Review* 34, 50.

<sup>34</sup> Anthony R. Reese 'Photographs of Public Domain Paintings: How if at All, Should We Protect Them?' (2009) 34 *Journal of Corporation. Law* 1033, 1045.

Nevertheless, whilst the law provides specific protections for copyright works, explicit protections for the public domain do not exist.<sup>35</sup> Hence, it is common practice by cultural institutions internationally to employ contracts to limit reproduction of both copyright and public domain works.<sup>36</sup> For example, the Museum of New Zealand, Te Papa Tongarewa's guide for museums advises:

Various copyright issues are raised if the public is permitted to make copies of works on display by photograph, film or video. Placing a blanket ban on such copying overcomes the legal and commercial risks involved. If you prominently display the ban as a condition of entry to the museum, the public will be contractually bound to observe it.<sup>37</sup>

Cultural institutions generally employ contracts of adhesion: spelling out terms and conditions of access and use, such as prohibiting photography of exhibits; and licence agreements governing the interactions between the public and the art via the museum's website. Whilst this is common practice, to date there appears to be only one reported case on this topic: *Schwartz v. Berkeley Historical Society*.<sup>38</sup> In *Schwartz*, the issue was the reproduction by Schwartz of photographs, held to be in the public domain, but provided to him by the Berkeley Historical Society, conditional on the terms of the Society's licence agreement. A term of use was that the photographs were not to be reproduced. However Schwartz claimed that the licence agreement was unenforceable, citing s 301 of the *Copyright Act 1962* (US) which provides that any contract that prohibits an individual from copying works that are in the public domain is unenforceable:

§ 301. Preemption with respect to other laws

On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.

<sup>35</sup> Jason Mazzone 'Copyfraud' (2006) 81 *New York University Law Review* 1026, 1029, 1037.

<sup>36</sup> Mazzone, above n 31, 1029; Robin J Allan 'After Bridgeman: Copyright, Museums, and Public Domain Works of Art' (2007) 155 *University of Pennsylvania Law Review* 961, 984.

<sup>37</sup> Te Papa National Services, 'Copyright and Museums' (Resource Guide, Te Papa National Services, June 2001) 5. <<http://www.tepapa.govt.nz/nationalservices/resources/resourceguides/Pages/overview.aspx>>

<sup>38</sup> *Schwartz v. Berkeley Historical Society*, No. C05-01551 JCS (N.D. Cal. Apr. 15, 2005).

This case was settled out of court by the parties, unfortunately removing the opportunity for rigorous legal analysis of the fundamental principles at stake.<sup>39</sup>

Apart from terms or conditions that are unconscionable, oppressive or unfair to a weaker party, there are few exceptions to what can be imposed by a contract, whether or not it is a contract of adhesion.<sup>40</sup> Contract law lacks copyright's statutory exceptions: no statutory fair use or fair dealing doctrine, nor are allowances made for uses such as education, research, libraries or museums and archives.<sup>41</sup> However there is the possibility that a court will find a contractual term unconscionable and therefore unenforceable. Whether a court would enforce a contract which overrides the statutory exceptions in copyright law or conversely find it to be unenforceable as being an unconscionable contract of adhesion has been the subject of some scholarly debate in the United States.<sup>42</sup>

Practical arguments tend to support upholding some contractual terms relating to public domain items. For example one argument in favour of the enforceability of licence (contractual) restrictions applying to archived public domain material is the institution's role in storing the material and making it available for various purposes. Without the physical housing provided by a cultural heritage institution it is likely much public domain cultural heritage material would be destroyed, be inaccessible due to remaining in private ownership, or permanently lost:

The licensee is presumably (because he or she would otherwise obtain the work for free) receiving something of value: for example, the convenience of having the public domain material readily available or the desirability of having it in a certain form.<sup>43</sup>

<sup>39</sup>Informal blog discussion highlights the arguments regarding the public policy aspects of the public domain versus freedom of contract: see *Dispute over Berkeley public domain photos* (2005), SV Media Law Blog <<http://www.svmedialaw.com/articles/content/dispute-over-berkeley-public-domain-photos/>> at 18 March 2011; See also *Berkeley Historical Society lawsuit - Can a library, museum or archive charge money for photos that are in the public domain?* (2005) Law Library Blog <[http://blog.librarylaw.com/librarylaw/2005/08/can\\_a\\_library\\_m.html](http://blog.librarylaw.com/librarylaw/2005/08/can_a_library_m.html)> at 18 March 2011; *Control Of Public Domain Images And Other Intersections of Copyright And Contract* (2005) Los Angeles Copyright Society <<http://www.copr.org/Archived%20Files/LA%20CR%20Soc%27y%20re%20Copyright%20and%20Contract%20May%202008.ppt>. <http://lawvibe.com/how-libraries-and-museums-get-sued-for-public-domain-scans/>> at 18 March 2011; *Berkeley Historical Society lawsuit- Interview with Tom Edwards, former president of the Berkeley Historical Society* (2007) Law Library Blog <[http://blog.librarylaw.com/librarylaw/2007/04/minow\\_the\\_cent\\_1.html](http://blog.librarylaw.com/librarylaw/2007/04/minow_the_cent_1.html)> at 18 March 2011.

<sup>40</sup> Allan, above n 36, 987.

<sup>41</sup> Brown, Melissa A. and Crews, Kenneth D. 'Control of Museum Art Images: The Reach and Limits of Copyright and Licensing' (Working Paper, Columbia University, 2010) 11. <http://ssrn.com/abstract=1542070> at 18 March 2011.

<sup>42</sup> See, eg, Allan, above n 36, 980; Mary Campbell Wojcik 'The Antithesis of Originality: Bridgeman, Image Licensors, and the Public Domain' (2008) 30 *Hastings Communication & Entertainment Law Journal* 257, 280.

<sup>43</sup> Mazzone, above n 35, 1057.

Refusing to enforce licences of this nature would deter the making available of public domain works, and so possibly impede the availability and circulation of such works.<sup>44</sup> Conversely, however, such licence restrictions by cultural institutions could be criticised as contrary to a cultural institution's mandate to enhance access.<sup>45</sup>

Furthermore, contract law has limitations. In particular, the doctrine of privity of contract ensures that a contract binds only those parties who entered into the original contract. Public access to a cultural institution or its website is often subject to contractual conditions, such as 'Photography, filming, and videoing may be prohibited in some exhibitions',<sup>46</sup> or 'Tripods may only be used with prior approval from the Communications Department'<sup>47</sup>. However, the contract binds only those parties who visit the institution or enter its website. In such instances the underlying intention of the cultural institution may not necessarily be to impose a blanket ban on photography but rather a proscription against photographs taken for commercial use.<sup>48</sup> In any event, such contractual terms may not apply to those who profit from misusing images or reproducing works without permission if they have been obtained indirectly and not by the expected method of entering the institution itself or using its website.<sup>49</sup> Any claim against an alleged infringer who is not a party to a contractual agreement must therefore be made under copyright law rather than under the law of contract.<sup>50</sup> With this limitation to protection in mind, the next part of the paper examines the practices adopted by cultural institutions to protect their works by claiming institutional ownership of copyright.

## V MUSEUMS' CLAIM TO COPYRIGHT IN PUBLIC DOMAIN ENTITIES- COPY FRAUD?

In the United States the standard of originality for a work to be protected by copyright is somewhat higher than that in New Zealand copyright law. In United States copyright law originality, and hence copyright protection, demands at least 'a modicum of creativity'.<sup>51</sup>

<sup>44</sup> Allan, above n 36, 964; Mazzone, above n 35, 1057.

<sup>45</sup> Brown, Melissa A. and Crews, Kenneth D. 'Control of Museum Art Images: The Reach and Limits of Copyright and Licensing' Columbia University (2010) 4. <http://ssrn.com/abstract=1542070> at 18 March 2011.

<sup>46</sup> Museum of New Zealand Te Papa Tongarewa, *Terms and Conditions* (2011) Museum of New Zealand Te Papa Tongarewa, Wellington, New Zealand <http://www.tepapa.govt.nz/Pages/Termsandconditions.aspx> at 18 March 2011.

<sup>47</sup> Auckland Museum, *Photography and Filming* Auckland Museum New Zealand (2011) <http://www.aucklandmuseum.com/141/photography-&-filming> at 18 March 2011.

<sup>48</sup> Wojcik, above n 42, 278.

<sup>49</sup> Allan, above n 36, 985.

<sup>50</sup> Marilyn Phelan 'Digital dissemination of Cultural Information: Copyright, Publicity, and Licensing Issues in Cyberspace' (2001) 8 *Southwestern Journal of Law and Trade in the Americas* 177, 226.

<sup>51</sup> *Feist Publications, Incorporated v. Rural Telephone Service Company, Incorporated* (1991) 499 US 340.



Hence, the court in *Bridgeman Art Library, Ltd v Corel Corp*,<sup>52</sup> strongly rejected a claim of copyright in exact photographic reproductions of public domain paintings. The Bridgeman decision highlights the potentially illegitimate actions many United States cultural institutions undertake when they impose claims to copyright upon derivative copies of works within their collections.<sup>53</sup> For the meantime, however, many institutions simply choose to ignore the Bridgeman doctrine.<sup>54</sup> However, as Jason Mazzone asserts, whether or not a cultural institution has a legitimate claim to copyright in derivative works, there are no legal implications for making false assertions of copyright in public domain works.<sup>55</sup> In Jason Mazzone's words a cultural institution would therefore be 'crazy not to try to sell off pieces of the public domain',<sup>56</sup> or threaten an uninformed public with their assumed rights associated with copyright.

In New Zealand copyright law originality is achieved by evidence that skill and effort were employed in making the work. Interviews carried out at New Zealand cultural institutions reveal that extensive time, effort and skill are required to be expended by a photographer in order to make a suitable digital image of an item in the collection. Thus it is clear that such images will be protected by copyright whether or not the original item itself is in the public domain or is protected by copyright. Assuming the photographic image was commissioned by the cultural institution or was made by an employee of the institution, the copyright will be owned by the institution.<sup>57</sup>

Alexandra Sims argues persuasively that New Zealand should impose firm legislative limits on any ability for contract to pre-empt copyright law since such pre-emption potentially dilutes the legislator's intent behind the Copyright Act 1994 (the Act).<sup>58</sup> Whilst presently the Act contains no provisions preventing the contracting out of, or supplementing of copyrights, Sims argues such a provision is necessary and highlights the potential for abuse that such an absence could create. Her focus is on the potential for a copyright imbalance, where rights holders by virtue of the dominant bargaining position they hold may extend the benefits of copyright via contractual arrangements at the expense of the public.

<sup>52</sup> 36 F. Supp. 2d 191 (S DNY 1999).

<sup>53</sup> Colin T. Cameron 'In Defiance of Bridgeman: Claiming Copyright in Photographic reproductions of Public domain Works' (2006) *15 Texas Intellectual Property Law Journal* 31, 32.

<sup>54</sup> Wojcik, above n 42, 271; Cameron, above n 53.

<sup>55</sup> Mazzone, above n 35, 1029, 1037.

<sup>56</sup> Mazzone, above n 35, 1038.

<sup>57</sup> *Copyright Act 1994*, s 21.

<sup>58</sup> Alexandra Sims, 'Copyright and Contract' (2007) *22 New Zealand University Law Review* 469, 490.

Such scenarios include perpetual copyright licences, maintaining quasi copyrights even after the copyright term has expired, or contracting out of exceptions, such as fair dealing.<sup>59</sup> Sims' suggestion that a new provision should be inserted into the Copyright Act 1994 in order to ensure that the legal enforceability of a licence would depend on the terms and conditions being reasonable has some merit.<sup>60</sup> She proposes the following:

A term or condition in an agreement has no effect in so far as it prohibits or restricts the acts that are permitted in relation to copyright works, or has the effect of extending the acts, or the scope of the acts, that the owner of the copyright in a work has the exclusive right to do, unless the term or condition is reasonable and the section to which the act relates does not prohibit contracting out.<sup>61</sup>

Such an approach would enable Parliament to entrench some users' rights and ensure the traditional copyright balance between creator/owner and user remains firmly in place.<sup>62</sup>

## VII CONCLUSION

Today many cultural heritage institutions are sensitive to the cultures of indigenous communities and follow carefully drawn-up frameworks and codes of practice when seeking to acquire items from these communities for their collections. Although this has been described as 'soft law' with 'no real enforcement mechanisms'<sup>63</sup>, we believe this is not necessarily fatal. It is undeniable that the public image of a modern cultural institution would be severely harmed were it not to follow culturally sensitive and ethical practices. Hence this likelihood acts as a strong societal deterrent which, although it is not part of a legal enforcement mechanism, nevertheless bears with it the element of public shame and indeed also likely monetary penalty imposed on the institution since the numbers of visitors are likely to be reduced following such behavioural practices.<sup>64</sup>

<sup>59</sup> Ibid, 486, 495.

<sup>60</sup> It is of course a fundamental principle of contract law that terms which are unconscionable, oppressive or unfair to a weaker party will not be enforced by the courts. This is particularly true where the contract in question is a contract of adhesion.

<sup>61</sup> Sims, above n 58, 494.

<sup>62</sup> Ibid.

<sup>63</sup> Torsen and Anderson, above n 17, 14.

<sup>64</sup> This is dependent on understanding of and empathy with the indigenous culture by the public in general. In instances where conflicting world views exist museums may find the inverse is true, and themselves in a 'damned if they do, damned if they don't' situation. This was the case for Museum of New Zealand Te Papa Tongarewa in October 2010. See, eg Kirsty Johnston, *Pregnant Women Warned of Te Papa Tour* (12 October 2010) Stuff News. < <http://www.stuff.co.nz/national/4221890/Pregnant-women-warned-off-Te-Papa-tour> > at 18

Conversely however, many cultural heritage institutions appear to assume that their contractual relationships with visitors to the institution and the institutional website permit them to override the public good exceptions that exist in copyright law. If this practice is permitted to become a norm, without passing through the usual democratic procedures required for the law making process, we suggest there will be serious implications for both copyright law and cultural heritage policies. Legislative amendment is required to provide that contractual provisions may not oust the public good exceptions provided in copyright law. In the meantime, as a matter of good practice, a cultural heritage institution should ensure that its terms and conditions of entry to the physical institution, and also those terms and conditions which regulate visitors to their website, do not override the traditional copyright balance between users of copyright works and copyright owners.