

Copyright and the Digital Economy, 2012

Submission to the ALRC regarding questions 1(b), 1(d), 21 & 54

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Sydney, 16 November 2012

Dear Sir/Madam,

Confirming the copyright status of individual works in Australia's cultural institutions, be they photographs, paintings, books or sculptures, is a never-ending task - especially when so many have unknown authorship, missing provenance or moral rights considerations. Fortunately for those works that have confirmed authorship, the statutory limitation of the copyright term is a bright line, clarifying when a work is definitively in the Public Domain (PD). However, what is not at all clear is the copyright status of the digital reproductions of artworks, that are produced by the museums themselves or by other professionals. That is, what is the copyright status of the images created by, and displayed on art gallery websites - are they also PD like the physical works they represent, or does it have a separate copyright status as a new work? This submission examines the moral and financial arguments about the copyright status of digitised works of PD art - firstly the justifications that they are copyrightable, and then the counter-arguments. It will then look at the legal precedents used to back up these claims in the United States, the United Kingdom and Australia with specific focus on competing levels of "originality" as they pertain to the digitisation of PD artworks. Finally it makes specific recommendations to the Australian Law Reform Commission. As this submission will demonstrate, this is not merely a theoretical problem but one of the most divisive legal issues in the contemporary cultural sector worldwide.

The specific questions asked in the ALRC "Issues Paper" that this submission responds to are:¹

Question 1(b). Is there evidence about how copyright law... affects the introduction of new or innovative business models?

Question 1(d). Is there evidence about how copyright law... places Australian at a competitive disadvantage internationally.

Question 21. Should the *Copyright Act* 1968 (Cth) be amended to allow greater digitisation and communication of works by public and cultural institutions? If so, what amendments are needed?

Question 54. Should agreements which purport to exclude or limit existing or any proposed new copyright exceptions be enforceable?

Despite its inherent importance to a balanced Copyright system, the ALRC does not specifically mention the Public Domain in the Issues Paper and only uses the phrase "out of copyright" in §137 with regards to the National Library of Australia's Newspaper scanning project. While it is important to emphasise that PD is the statutory *limitation* of

¹ <http://www.alrc.gov.au/publications/copyright-ip42>

copyright and therefore cannot be framed within a statutory *exception*, it is an applicable comparison for the purposes of this submission and therefore these are the pertinent sections of the ALRC Issues Paper. Despite its non-appearance in the Issues Paper, the matter of access to and usage of the Public Domain is keenly relevant all the four key points of the ALRC Terms of Reference. Specifically, with regards to the: "...dissemination of copyright materials" (point 1), "...general interest of Australians to access, use and interact with content" (point 2), "...cultural development created by the emergence of new digital technologies" (point 3), and "...international developments." (point 4).²

It is acknowledged that the primary purpose of the Copyright Review is to create a framework for any new copyright exceptions but in doing so it must also retain a robust Public Domain that is not encroached upon either by overreaching copyright claims (sometimes called "copyfraud") or by restricting its status to that of a bounded exception to copyright.

With regards to the scope of this submission, it is also important to distinguish between professionally produced "faithful" or "slavish" reproductions and photographs that merely include the original artwork - such as those taken by passing tourists, at an oblique angle, or those which also include the (three dimensional) frame in the composition. The distinction is important because the former is considered a true "digitisation" whereas the latter are "merely" original photographs (not necessarily very good ones). Furthermore we must distinguish between professional digitisations of three dimensional artworks into a two dimensional medium (such as a photograph of a sculpture) and digitisation that starts and finishes in two dimensions (such as converting a glass plate negative, an engraving, or painting into a contemporary digital image file).³ Inherent to photographing a 3D object is the conscious decision about what to show and consequently what not to show in the picture. Such choices must be made even for "flat" 3D objects such as coins. Hence, digitisation of 3D works falls definitively outside of the scope of faithful reproduction, at least as far as current technology is concerned.⁴

Therefore, as per the title, this submission is focused on situations that meet the three criteria of *faithful* digitisation of *two dimensional* works of art that are in the *Public Domain*.

Status Quo

Both within Australia and internationally, there is zero definitive legal precedent on whether the digitising of a non-digital artwork is itself copyrightable. When done properly, the process requires not inconsiderable time, cost, skill and equipment - and the digital image often requires post-processing beyond the initial image-capture to match colours more closely the original or to crop away an unintentionally included background. This digitising is undertaken for a range of reasons, including: to share the work with a wider audience online (both on the institution's own website and new fora such as the "Google Art Project"); to keep as a reference for insurance and conservation purposes; to provide to

² <http://www.alrc.gov.au/inquiries/copyright/terms-reference>

³ While there is some art-theory debate about whether painting is a two or three dimensional artform, this is independent to the legal and practical realities of how paintings are treated.

⁴ See also 3D printing (discussed below).

third-party individuals or organisations for use in publications or research; and to sell as images on posters, postcards or other forms of merchandise.

Internationally, the overwhelming majority of art museums assert copyright in reproduction images of PD works in their collection.⁵ For example, the UK National Gallery in London states:

“Where any of the items on this site are being republished or copied to others, the source of the material must be identified and the copyright status acknowledged, eg: “Leonardo, The Virgin of the Rocks, 1491-1508 Photo © The National Gallery, London”.⁶

On the other hand, when an original work remains *within* copyright, the copyright status of the *digitisations* is left unstated with mention of copyright only as it pertains to the physical work. Commonly, in these situations institutions neither claim nor deny copyright in the digitisation. When physical works are within copyright, the cultural institutions are unwilling to assert a layer of copyright on top of that, out of deference to the artist (or their estate). The difference in practice is worth noting.⁷

It is also not uncommon for the institution to remain silent on the specific matter of copyright and instead to “contract-out” with restrictions equivalent to copyright in the form of website terms and conditions and multimedia licensing contracts. These terms are often a standard or “boilerplate” text that contain a mixture of copyright-like claims as well as elements that attempt to cover moral rights, indigenous rights and any potential donor restrictions. For example, the terms and conditions of the National Gallery of Victoria’s website state:

“No image or documentation displayed on this site may be reproduced, communicated or copied (other than for the purposes listed above; criticism or review, or reporting the news) without the Gallery’s permission. Use and referral is allowed for the purposes of research or study so long as full and proper attribution is given.”⁸

Technical Protection Measures (TPMs) are often used to enforce or enhance such claims.⁹ However it is relatively rare that the system used is purpose-built for security. Rather, it is often the case that institutions will use “zooming” software as a stand-in solution. These display only a small section of the artwork on screen at any given time, similar to the interface of online map applications. Beyond allowing high-resolution images to be easily displayed on a screen, this has the significant side-benefit of removing the

⁵ Hama, Kenneth (2005), “Public Domain Art in an Age of Easier Mechanical Reproducibility” *D-Lib Magazine* Vol.11 no.11 <http://www.dlib.org/dlib/november05/hamma/11hamma.html>

⁶ <http://www.nationalgallery.org.uk/terms-of-use/>

⁷ Crews (2011) “Control of Museum Art Images: The Reach and Limits of Copyright and Licensing”, *Columbia Law and Economics Working Paper*. <http://ssrn.com/abstract=2026476>

⁸ <http://www.ngv.vic.gov.au/about-us/reports-plans-key-documents/policies/copyright-and-reproductions>

⁹ Crews (2012) “Museum Policies and Art Images: Conflicting Objectives and Copyright Overreaching” in *Fordham Intellectual Property, Media & Entertainment Law Journal*. July, Vol 22. http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2120210

“right click and save” option from end-users. Nevertheless, even the most popular software package is quick to emphasise that it is not intended as a genuine TMP:¹⁰

“[The] zoom-and-pan viewing solution makes copying images much more difficult than other viewing alternatives....no image presented on the web can be completely protected - if you can see an image, the data is on your computer and it can be retrieved by someone sufficiently determined. For this reason, we provide Zoomify as a viewing solution and not an image security system.”

In some rare cases the institution makes a conscious effort to deny any restriction - either by copyright or by contract - in the digitisation and instead informs potential users of their access and re-use rights. For example the National Gallery of Art, Washington DC, in direct contradistinction to the National Gallery of the UK considered above, has a detailed “Open Access” policy for works they believe are in the Public Domain. It states that “No copyright or other proprietary right in the image itself or in the underlying work of art is conveyed by making the image accessible”.¹¹

The gallery also enumerates what this means in practice, including that the images may be used for commercial purposes, without seeking explicit permission and that there is only a recommendation, not an obligation, to attribute the gallery as the source.

Justifications

There are two broad categories of justification for claiming copyright (or copyright-like contracts), the first being based on the mission of the institution itself. The purpose of the art museum, particularly when it is publicly funded, is to acquire, conserve and display art for the advancement of general and academic understanding in the particular culture relevant to the institution. To fulfill this mission the institution must endeavour to ensure that accurate information about its collection is published and made available to the public and also it must cultivate good relationships with the artists (or their estates) in order to acquire or be loaned new works in the future. This objective is sometimes summarised as the need to “preserve the integrity of the work” and the collection as a whole.¹² Or, to put it more directly, “We control how our collection is used not through enforcement of copyright but by limiting access to reproducible images of it. We can deny use to a publication that we think will not use the image appropriately.”¹³

A second but no less significant argument used in claiming copyright in PD art is financial. That is, creating a restricted access to content by commercially licensing it allows the institution to raise revenue from direct sales and through the gift shops. Sometimes these will be flatrate charges as an “access fee” (purportedly to pay for the staff time and any or all of: processing the request; copyright checking; undertaking the digitisation itself; moving the request to the front of the digitisation queue; and/or postage costs). Often, the

¹⁰ http://www.zoomify.com/support.htm#a20081222_2247

¹¹ <https://images.nga.gov/en/page/openaccess.html> The policy also notes that in some cases Public Domain works are not available online due to extenuating circumstances such as donor restrictions, the work has not been digitised to appropriate standards, or because the work is on loan.

¹² <http://museumscopyright.org.uk/resources/articles/bridgeman/>

¹³ King, L. (1997) "The Fair Use Dilemma" *Museum News*, July /August, page 36.

cost will also include a “usage fee” depending on whether the use is for personal or academic research or for publication online (variable according to publication time period) or in print (variable according to print run). Other factors often affecting the fees are the size, file-format and quality of the digital file required and how prominently the digital work will be used. For example, proposing to use an image as a front cover is likely to incur a higher charge. The fee schedule for the National Gallery of Australia, Canberra, for instance, states that the high resolution “image fee” is \$120, plus a “usage fee” of \$200 if it is used in a book with a print run over 50,000, plus \$10 postage.¹⁴

Such fees are accompanied with extensive license agreements to ensure the image is not altered or cropped. Clauses can also include the demand of the institution to approve the final usage before publication to check the context of the use and to ensure that the attribution is the approved version.

There are three broad explanations given to justify these fees. They are summarised as “cost recovery”, “subsidising the physical experience” and “commercial advantage but academic support”. In truth, the costs of professional digitisation are not inconsiderable - both in staff time as well as for hardware and software. One full digitisation could take several working days because a typical procedure would include: taking the work off display; preparing it for digitisation; the photography session; returning it to display; retouching the digital image; and recording the new file in the relevant database(s). In large institutions, each activity would need to be undertaken by different members of staff and the queue for new digitisation work is, in effect, never ending. When an access request is made this also incurs new staffing requirements for copyright and/or moral rights clearance, financial processing and customer interaction. The costs charged are often differentiated (as discussed above) based on the degree of intended commercialisation by the applicant. Frequently, discounts or waivers on the standard rates are given for academic requests. It is also noted that on-site access to works, either through an associated research library or simply by public visitation is generally free. Taken together, the financial justifications for claiming copyright (or enforcing copyright-like contracts) are a genuine attempt to balance the public interest with financial realities. Nevertheless, a far more pervasive and fundamental financial justification for such restrictions is, “We don't see any reason why we should allow others to make profit from our collection”.¹⁵

Counter-arguments

Increasingly, there is opposition to the practice of claiming rights in digitisations of PD art on both legal and moral grounds, parallel to the global movements towards Open Access publishing (OA) and Open Educational Resources (OER).¹⁶ Within the cultural sector this movement is best summarised by the “Public Domain Charter” of *Europeana* (the digital culture portal of the European Commission) which states:¹⁷

¹⁴ <http://nga.gov.au/Collection/repro.cfm>

¹⁵ Private interview with the director of a major Australian library.

¹⁶ For example, the influential *Berlin Declaration on Open Access to Knowledge in the Sciences and Humanities* (2003) <http://oa.mpg.de/lang/en-uk/berlin-prozess/berliner-erklarung/>

¹⁷ <http://pro.europeana.eu/web/guest/publications>

“Digitisation of Public Domain content does not create new rights over it: works that are in the Public Domain in analogue form continue to be in the Public Domain once they have been digitised.”

The Charter provides three principles of a healthy public domain: that “Copyright protection is temporary”; that “What is in the Public Domain needs to remain in the Public Domain”; and that “The lawful user of a digital copy of a Public Domain work should be free to (re-) use, copy and modify the work.” Broadly speaking, there is an increasing global awareness of the principle of the Public Domain and increasing activism in its defence.¹⁸

It is indisputable that cultural institutions have a duty of care for their collections - they do. However, it is not the curators or conservators - those who are charged with that duty - who express the desire to "preserve the integrity of the collection" through restrictive digital access. Rather, it is the sales and marketing managers who make this argument, using the curators as a shield, so as to preserve privileged access over the collection in order to execute a business model based on enforced scarcity.

This justification is often mocked as “the tea towel problem” or “Keeping the World Safe from Naked-Chicks-in-Art Refrigerator Magnets” whereby “integrity” considerations are conveniently ignored when it comes to the ways the art is adapted for merchandise in the museum’s own shop.¹⁹

Curators understand that restricting access (and thereby stopping people “misusing” the collection) does not preserve “integrity” because people who wish to misuse information will do so anyway. By analogy, the science behind climate-change needs to be made readily available in order to foster intelligent community debate. Restricting access to the scientific information would not stop climate-change deniers, but it would increase the power of the skeptic’s misuse of the data through the absence of an authoritative voice. Curators understand that if their knowledge is made difficult to access then people will obtain less accurate information elsewhere - bypassing the museum in the process. This was exemplified in 2011 by the National Gallery of the Netherlands, the Rijksmuseum:²⁰

“‘The Milkmaid’ [1660], one of Johannes Vermeer’s most famous pieces, depicts a scene of a woman quietly pouring milk into a bowl. During a survey the Rijksmuseum discovered that there were over 10,000 copies of the image on the internet—mostly poor, yellowish reproductions. As a result of all of these low-quality copies on the web, according to the Rijksmuseum, “people simply didn’t believe the postcards in our museum shop were showing the original painting. This was the trigger for us to put high-resolution images of the original work with open metadata on the web ourselves. Opening up our data is our best defence against the ‘yellow Milkmaid’.” ”

¹⁸ Boyle, James (2008) *The Public Domain: Enclosing the Commons of the Mind*, Yale University Press, and Lessig, Lawrence (2001) *The Future of Ideas: The Fate of the Commons in a Connected World*

¹⁸Random House, New York <http://www.the-future-of-ideas.com/download/>. passim.

¹⁹ Butler, K.C. (1998) “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”, *Hastings Communication & Entertainment Law Journal*. Vol 21, Issue 55, Pages 57-58.

²⁰ Verwayen et al., (2011) “The Problem of the Yellow Milkmaid: A Business Model Perspective on Open Metadata” <http://pro.europeana.eu/web/guest/publications>

With regards to the financial arguments, it is highly contested whether image licensing is actually a profit-making activity. Indeed, the vast majority of institutions that publish their sales figures indicate that the cost of administering the licensing system is as high or higher than the revenue recouped by it.

"Everyone interviewed wants to recoup costs but almost none claimed to actually achieve or expected to achieve this...Even those services that claimed to recoup full costs generally did not account fully for salary costs or overhead expenses...Many had gained their equipment through special funding and thus equipment was again not a direct cost item in relation to the price tag offered."²¹

Moreover, the assumption that only the institution that owns the physical work should be entitled to a share of any profits made with it is often expressed irrespective of whether that institution actually attempts or succeeds to commercialise the work. As a result there is a small but increasing number of art institutions that are abandoning a business model based on "enforced scarcity", instead allowing anyone to access high quality content and charging for services such as art-quality printing. An Australian example of this is Sydney's Powerhouse Museum, which has seen no decrease in sales since making high resolution PD images freely available online.²²

This approach has potentially lower per-unit sale price but at a significantly lower overhead cost and greater turnover due to increased public awareness of the works themselves, thereby increasing profit margins. It should be noted that the right to charge a fee to cover staff-costs of commissioned digitisation work is uncontested, it is the charging of fees to "access" works that are already digitised and online which require no staff intervention that is controversial. As the director of digital policy for the world's wealthiest art foundation, J.P. Getty Trust, stated in 2005:²³

"placing these visual reproductions in the public domain and clearly removing all questions about their availability for use and reuse would likely cause no harm to the finances or reputation of any collecting institution, and would demonstrably contribute to the public good."

The business model aspect of this issue is important because it speaks to the fundamental purpose of copyright - a limited-term monopoly to provide incentive for the creation of further artistic works. While it is argued that the use of copyright to control PD art is invalid, the perceived need is not - especially in an era when public cultural institutions are increasingly asked to fund their core activities through cross-subsidisation from increased commercial activities. Therefore it is important to demonstrate that financial viability is not made impossible when copyright controls are removed.

²¹ Tanner, Simon (2004) *Reproduction charging models and rights policy for digital images in American art museums*, King's College London. King's Digital Consultancy Services, page 35. <http://msc.mellon.org/research-reports/Reproduction%20charging%20models%20and%20rights%20policy.pdf/view> Or, as world the peak body for libraries OCLC stated in the introduction to their 2008 *Seeking Sustainability* report, "We tried subscription, licensing, advertising, and many other ways to try to establish them as self-supporting services. While it would be more gratifying to report on successes, it is in fact the disappointments that are more illuminating and instructive as we navigate the way forward." <http://hangingtogether.org/?p=434>

²² Bray, P. Open Licensing and the Future for Collections (2009) <http://www.museumsandtheweb.com/mw2009/papers/bray/bray.html>

²³ Hamma, *ibid.*

Finally, the standard practice of superimposing contractual obligations over the top of copyright is a form of gatekeeping where the power to undertake the action derives from the possession of the art as a physical object. The museum is the sole determiner of the terms of the deal - ostensibly non-negotiable - and proposes those terms in a manner that appears to be binding but which in reality has dubious legal standing. The claims that are made are grounded in intellectual property law, but they are borne of an attempt to replicate the restrictions possible within the physical environment of the institution.²⁴

In making these requirements, the museum claims rights that sometimes far exceed the purview of intellectual property law. Specific restrictions can include, among other things prohibitions on: cropping; bleeding images off a pages; superimposing anything on the image; printing on coloured paper; printing black-and-white photographs with colored ink, or making alterations even if they are to digitally restore a damaged original.²⁵

Even if the institution were to acknowledge that the digitised image is in the Public Domain, forcing the end-user to “contract-out” of the Public Domain not only overreaches the original limits of copyright law but does so in perpetuity. This move towards indefinite control was criticised by the president of the Society of American Archivists, “Museums (and archives) that seek perpetual control over the use of a work are in effect saying that act of stewardship of a work is more important than the act of creation.”²⁶

This situation is consistent with the findings of the Australian Copyright Law Reform Commission’s findings in 2002 that contracts are being used in a way that “...undermines the copyright balance established by the *Copyright Act*”.²⁷

To further quote the Public Domain Charter:

“No other intellectual property right must be used to reconstitute exclusivity over Public Domain material. The Public Domain is an integral element of the internal balance of the copyright system. This internal balance must not be manipulated by attempts to reconstitute or obtain exclusive control via regulations that are external to copyright. No technological protection measures backed-up by statute should limit the practical value of works in the Public Domain.”²⁸

Legal situation

There are three fundamental facts about copyright and images that are universal and uncontested. They are: that any image, whether a traditional photograph or digital image, is a “photograph”, within the meaning of copyright; all photographs are “artistic works”

²⁴ Crews (2011), page 3.

²⁵ Crews (2012), page 827.

²⁶ Hirtle, P. “Archives or Assets”, plenary presentation given to the annual conference, 2003. <http://ecommons.library.cornell.edu/bitstream/1813/52/3/Archives%20or%20assets.html>

²⁷ Copyright Law Review Committee, *Copyright and Contract* (2002), Ch 5 page 142. <http://www.ag.gov.au/Copyright/CopyrightLawReviewCommittee/Reports/Copyrightandcontract/Pages/default.aspx>

²⁸ *Europeana*, Public Domain Charter <http://pro.europeana.eu/web/guest/publications>

irrespective of artistic quality; and that the three criteria for subsistence of copyright in an artistic work is that it have an author, be set down in a material form and, most importantly for the purposes of this submission, that it be “original”. The major point of legal difference and contention is what precisely constitutes “original” as it is not made clear in any nation’s statutes. Traditionally at least, the UK has held a low bar for this test focusing on “skill and labour”, while the USA has held a relatively high one focusing on “evident creative spark”, and in Australia recent cases (relating specifically to data compilations) might indicate a movement from a standard equivalent to the former to the latter, higher standard.

Given that the Australian-USA Free Trade Agreement (FTA) (2005) required the harmonisation of much of Australia’s copyright law to USA standards it is perhaps not surprising that the courts have been passing judgements that would seem to be more in line with US principles. However it was noted how IP harmonisation in the FTA was quite selective to “..only when it broadens rather than narrows the scope of IP protection”, focusing on raising the bar for aspects that protect copyright owners but not requiring changes in areas which focus on users-rights (such as Fair Use and the Originality threshold). This asymmetry places Australia at a competitive disadvantage.²⁹

Therefore, the principle that come into play are competing tests of the levels of "originality" required - the lower bar being commonly referred to as "sweat of the brow". That is, whether copyright vests in an artwork because of the effort required to create it, or merely because it is new. The absence of specific statutory law on this issue means there is only quasi-related judicial precedent and standard industry practice - and that practice, as argued above, is highly contested.

United Kingdom

In the UK there is no specificity in statutes but the courts have generally held a very low threshold of originality - thereby implying, although not conclusively, that digitised artworks are probably independently copyrightable. There are four commonly cited historical cases in UK that deal with the threshold of originality and are seen to underpin of the “sweat of the brow” doctrine. In an early case, *Walter v. Lane* (1900) the court held that a newspaper’s journalists owned copyright in published speeches due to the effort expended in manually transcribing them. In *University of London Press v University Tutorial Press* (1916) the court held that “...the Act does not require that the expression must be in an original or novel form, but that the work must not be copied from another work — that it should originate from the author”. *Cummins v Bond* (1924) held that a psychic owned copyright in the writings she produced while in a trance, even though she claimed no creative control but insisted the ghost instructed her, because it was her penmanship that formed the words. However, the earliest case, known as “*Graves’ Case*” (1869), is the only precedent to support “sweat of the brow” that specifically deals with visual arts. It declared that copyright did indeed exist in copies of engravings in photography. However, given the age of the case, its specific facts including the degree of likeness, are sparse.

²⁹ Dee, Philippa (2004) The Australian-US Free Trade Agreement An Assessment: Paper prepared for the Senate Select Committee on the Free Trade Agreement between Australia and the United States of America. Page 15. http://www.apf.gov.au/Parliamentary_Business/Committees/Senate_Committees?url=freetrade_ctte/rel_links/index.htm

Sometimes cited in the UK is *Antiquesportfolio.com v. Rodney Fitch* (2001). While significantly more recent, this case deals only with the copyrightability of photographs of *three-dimensional* artworks such as sculptures and as such does not shed light on the matter of faithful digitisation. Although ostensibly a case about registered design rights, the case of *Interlego AG v Tyco Industries Inc* (1989), held before the Privy Council, is the most applicable (and comparatively recent) precedent that is seen to lean strongly away from the “sweat of the brow” perspective.³⁰ In determining that the design of Lego bricks did not reach the threshold of copyrightability, Lord Oliver stated:

“Take the simplest case of artistic copyright, a painting or a photograph. It takes great skill, judgment and labour to produce a good copy by painting or to produce an enlarged photograph from a positive print, but no one would reasonably contend that the copy painting or enlargement was an “original” artistic work in which the copier is entitled to claim copyright. Skill, labour or judgment merely in the process of copying cannot confer originality.”

United States

The leading case in the USA about determining the threshold of originality is *Feist Publications, Inc., v. Rural Telephone Service Co.* (1991)³¹ which focused on the copyrightability of the telephone directory. It found that information alone, without creative input, cannot be deemed to have met the threshold and in effect, *Feist* declared “sweat of the brow” invalid in America. Until this time the UK precedent of *Walter v Lane* was considered to be the leading opinion. Though influential as a Supreme Court decision, the applicability to artworks is limited by the fact that this case found the underlying work was uncopyrightable in the first place. No one suggests this is the case for art.

However, in the USA there is one specific precedent - considered to be the only specifically relevant judgement anywhere in the world on this topic - the New York district court case *Bridgeman Art Library v. Corel Corporation* (1999).³² Bridgman, arguably the world’s largest commercial provider of reproduction art images, sued Corel, a software company best known for creating the “WordPerfect” and “CorelDraw” application, for unauthorised use of images in a CD-ROM called “Professional Photos”. Bridgeman alleged that it owned copyright in many of the images and that Corel must have illegally obtained them from a Bridgeman licensee as it owned exclusive rights to distribution of the reproductions - licensed to them by the various galleries that owned the physical works. Both parties moved for a summary judgement.³³

The court decided in both its first and second judgements that exact photographic copies of Public Domain images could not be protected as they were merely “slavishly copied”. Even if the creation of accurate reproductions required skill, experience and effort, the key

³⁰ <http://www.bailii.org/uk/cases/UKPC/1988/3.html>

³¹ <http://caselaw.lp.findlaw.com/scripts/getcase.pl?court=US&vol=499&invol=340> It is a case similar in facts to *Desktop Marketing Systems v. Telstra* (2002) in Australia (below).

³² http://www.law.cornell.edu/copyright/cases/36_FSupp2d_191.htm

³³ Stokes, S., (2001) *Art and Copyright*, Hart Publishing, Oxford, Page 103

element for copyrightability under US law is that copyrighted material must show sufficient originality.

Despite the seeming conclusiveness of the decision, “By and large, museums have been holding their noses and hoping this ruling will neither be broadly noticed nor challenged”.³⁴ It is untrue that cultural institutions do not care about following the law, in fact they are nearly always overly cautious, but the lack of deference to the *Bridgeman* decision’s implications shows that either they believe it does not represent good law and would be overturned if challenged, or that it is not binding. In a surprisingly frank speech, Barry Szczesny, Government Affairs Counsel for the American Association of Museums thought that the art reproduction industry should remain quiet on the *Bridgeman v Corel* decision, arguing against asking for an appeal:³⁵

“Just about every museum attorney looking at the case objectively thinks it came out the correct way according to US copyright law - that's why no museum had ever brought such a suit. The US Copyright Office informally agrees. Thus, no one saw any real chance for reversal on appeal. In addition, an affirmation by the Second Circuit, arguably the most influential court on copyright issues, would be even more damaging.”

Therefore, it is clear that the only reason the cultural sector does not comply with the *Bridgeman* decision and continues to claim copyright in their reproductions is that they believe the case to have been fought in too low a court to be binding - even given that all the institutions were based in the same district: New York. This is dispute the fact that knowingly making a false copyright claim is a criminal offense in the US punishable by a \$2,500 fine. To-date no cultural institution has been charged with this offense.³⁶

The relevant peak body in the UK, the Museums Copyright Group (MCG) undertook their own research and declared that *Bridgeman v. Corel* was neither binding nor relevant in the UK. In a follow up opinion by Jonathan Rayner James QC, stated that:

“... as a matter of principle, a photograph of an artistic work can qualify for copyright protection in English law, and that is so irrespective of whether ... the subject of the photographs is more obviously a three dimensional work, such as a sculpture, or is perceived as a two dimensional artistic work, such as a drawing or a painting ...”³⁷

In an extremely public dispute in 2009, the UK National Portrait Gallery (NPG) threatened legal action against a Wikipedia administrator in the US for downloading digitisations of PD works from the NPG website without permission, and uploading them to servers in the USA for the purposes of illustrating Wikipedia articles. Several legal claims were made by the NPG, including that their their TPM was circumvented; that their database right and

³⁴ Hamma, Ibid.

³⁵ *Excerpts from April 1999 American Association of Museums Annual Meeting Presentation, "What's Happening in Washington"*

³⁵<http://www.panix.com/~squigle/rarin/corel2.html>

³⁶ Hirtle, *ibid.*

³⁷ <http://museumscopyright.org.uk/resources/articles/bridgeman/>

copyright in their digitisations were breached; and that their website conditions were ignored.³⁸

While the matter was never tested in court, due in no small part to the inherent complexity of a cross-jurisdictional case, the fundamental issue was whether the principles espoused in the *Bridgeman* decision were applicable in the UK. A particular feature of the *Bridgeman* case was that Judge Kaplan went to great lengths to assert that his decision was valid according to UK law (though the court noted that it would have been the same result under US law).³⁹ Kaplan cited Laddie's *Modern Law of Copyright*, considered the seminal work on UK copyright law, in determining the British threshold of photographic copyright. He drew particular attention to the passage:

“Originality presupposes the exercise of substantial independent skill, labour, judgment and so forth. *For this reason it is submitted that a person who makes a photograph merely by placing a drawing or painting on the glass of a photocopying machine and pressing the button gets no copyright at all*”⁴⁰

Kaplan also noted that both in the US and Britain the greater skill required in making a photograph (as opposed to a photocopy) was immaterial to their copyrightability in that “skill, labor or judgment merely in the process of copying cannot confer originality”⁴¹ Finally, Kaplan also dismisses the argument that the change in medium (now in the digital era often called “format shifting”) did not automatically confer copyrightability either. Rather, “there must . . . be some element of material alteration or embellishment which suffices to make the totality of the work an original work.”⁴²

For example, the underlying photograph in Andy Warhol's influential *Marilyn Diptych* (1962) was a publicity photograph by another artist. However, no one would claim that Warhol did not gain copyright in the new work due to the significant changes made both by the vivid colourisation and the repetition of the image to make an artistic point.⁴³

While this submission only discusses Common Law countries, it is important to refer also to a recent European Court of Justice ruling *Football Dataco v. Yahoo!* (2012), in which a UK company sought to claim database rights over the schedule of football match fixtures.⁴⁴ In theory at least, UK copyright law is bound to follow European-wide directives. This case dealt extensively with the threshold of originality in copyright.⁴⁵ In §38 of the judgement the court held that the criterion of originality was only met when the arrangement of data was expressed by “free and creative choices” and showed signs of

³⁸ Copy of the original letter sent to Derrick Coetzee by Farrer & Co LLP https://commons.wikimedia.org/wiki/User:Dcoetzee/NPG_legal_threat

³⁹ Stokes, *ibid.* 104.

⁴⁰ Laddie, Hugh et al., (1995) *The Modern Law of Copyright and Design*, LexisNexis Butterworth, page 238.

⁴¹ *id.* at 971-72

⁴² *ibid.*

⁴³ <http://www.tate.org.uk/art/artworks/warhol-marilyn-diptych-t03093>

⁴⁴ <http://curia.europa.eu/juris/liste.jsf?language=en&num=C-604/10>

⁴⁵ It is a situation similar to *IceTV v Nine Network* case (below)

the author's "personal touch". Furthermore, in §42 the court held that "significant labour and skill of its author...cannot as such justify the protection of it by copyright."

Australia

The closest the *Australian Copyright Act* comes to addressing this issue is in section 10(1) two parts of section 21. With reference to the unauthorised digitising of in-copyright works (as opposed to PD works), the ALRC Issues Paper notes that a "digitisation of an analogue work in a digital format is a reproduction and may constitute copyright infringement...Similarly, the communication of a substantial part of a copyrighted work, for example, by showing it on a website, may also constitute copyright infringement.⁴⁶ This is explained on the basis that §10(1) of The Act defines "communicate" to mean "make available online or electronically transmit".

*The relevant parts of section 21 state:*⁴⁷

§21(1A) For the purposes of this Act, a work is taken to have been reproduced if it is converted into or from a digital or other electronic machine-readable form, and any article embodying the work in such a form is taken to be a reproduction of the work. Note: The reference to the conversion of a work into a digital or other electronic machine-readable form includes the first digitisation of the work.

§21(3) For the purposes of this Act, an artistic work shall be deemed to have been reproduced:

(a) in the case of a work in a two-dimensional form--if a version of the work is produced in a three-dimensional form; or

(b) in the case of a work in a three-dimensional form--if a version of the work is produced in a two-dimensional form.

It is clear from §21(1A) that digital images are copyrightable works, that the digitisation of a copyrightable work is considered a reproduction, and also that purely mechanical copies (such as this image of the painting embedded above) are not "new" works but simply further reproductions. §21(3) also notes that the creation of a 2D work in a 3D format (or vice versa) is also a reproduction. However, neither of these nor §10(1) above addresses our central question of whether the independent copyrightability of the digitised work itself - i.e. whether the copyright vests in the originality of the new work or in the difficulty [sweat of the brow] of the process.

With regard to judicial opinion, the Australian courts have traditionally been understood to be more favourable to a "sweat of the brow" principle to copyright. More recently, judgments relating to data compilations seem to have been determined with a higher bar that rejects that principle. This is most clearly exemplified in *Desktop Marketing Systems v. Telstra (2002)* as opposed to the more recent *IceTV v. Nine Network (2009)* and *Telstra v. Phone Directories (2010)*.⁴⁸

⁴⁶ ALRC *ibid.* page 41.

⁴⁷ http://www.austlii.edu.au/au/legis/cth/consol_act/ca1968133/s21.html

⁴⁸ Respectively, <http://www.austlii.edu.au/au/cases/cth/FCAFC/2002/112.html>, <http://www.austlii.edu.au/au/cases/cth/FCA/2010/44.html> and <http://www.austlii.edu.au/au/cases/cth/HCA/2009/14.html>

In the former the Federal Court held that copyright subsisted in the telephone directory on the basis of the labour required to compile and maintain it. However, less than a decade later, the Federal and then the High Court determined that neither the television schedule nor the telephone guide were copyrightable. This determination was made on the basis that their contents were mere facts arranged in an unoriginal manner (respectively, chronological and alphabetical). While none of these is specific to the field of visual art (the works to which they refer are, at best, literary works) the principle that effort, time and expense are irrelevant to the threshold of copyright is still applicable. However, the crucial difference from museum digitisation is that the copyrightability of the *underlying* work - the physical painting or photograph - is uncontested.

In summary, at this point it should be clear that while legal uncertainty remains. the tide of legal opinion in Australia, the UK and the USA has shifted from “sweat of the brow” to a “creative spark” approach in gauging the threshold of copyrightability - with the US leading the charge and the UK following slowly, but nevertheless still following. Furthermore, it should be clear that any remaining argument stems from a lack of binding precedent rather than contradicting judgements. Therefore, it is argued, the status quo of claiming copyright in mechanically produced scans of PD artwork remain remains such due primarily to inertia and the strong financial incentive for the cultural sector to selectively ignore this reality.

Post-Production

All of the aforementioned precedents deal entirely or almost entirely in purely mechanical reproduction - scanning, photocopying or photographing. However, contemporary best-practice for digitisation includes manual post-production using image manipulation software that does not fall neatly under the category of mechanical reproduction. It is clearly a skilled activity that requires that artistic choices be made and as such it is not at all clear that the precedents, including *Bridgeman*, are applicable to this activity.

The argument in favour of copyright on this basis was made in the aforementioned *The Modern Law of Copyright* and used as part of the UK Court of Appeal’s decision in *Sawkins v Hyperion Records* (2005):⁴⁹

“... assume a number of persons do set out to copy ... a painting, each according to his own personal skill. Most will only succeed in making something which all too obviously differs from the original – some of them embarrassingly so. They will get a copyright seeing that in each instance the end result does not differ from the original yet it took a measure of skill and labour to produce. If, however, one of these renders the original with all the skill and precision of a Salvador Dali, is he to be denied a copyright where a mere dauber is not?”

In short, yes. What this argument fails to address is in *why* the skilful copyist should be awarded copyright. Not all skilled activities are copyrightable (plumbing, for example, is not, in spite of the skill and training required to do it) and many unskilled activities can potentially, achieve copyright (for example finger-painting). It is therefore entirely plausible that someone exercising skill might fail to obtain copyright by achieving a perfect copy,

⁴⁹ <http://www.bailii.org/ew/cases/EWCA/Civ/2005/565.html>

while an unskilled person obtains copyright protection “by accident”, however unfair or perverse it might appear. This is the same distinction made earlier between the professional digitisation and the “mere” photographer.

The equivalent discussion in art theory is the perennial “...but is it art?” debate. The argument that since “I could do that, it can’t be real art”, is one that many casual observers of non-representational or non-objective art in particular have advanced. This is not only a misunderstanding of the actual skill required but also ignores the artistic vision required to come up with an *original* artistic idea. For example Jackson Pollock’s style of abstract “drip painting” was initially derided by the public as unskilled and “un-artistic”, but eventually his level of control and effectiveness at communicating his artistic intent, came to be generally acknowledged.⁵⁰

The intentionality argument is significant to art critics for assessing the artistry of a work, but as discussed, it is irrelevant for the purposes of copyright law when creating a *new* work. Here it is argued that the role of artistic intent should operate quite differently when dealing with digitised *copies* of artworks. The express intention of professional post-production of a digitisation, is to *recreate* the original as closely as possible in the new format and great care is therefore made to avoid making a new work or a new artistic interpretation.

Therefore, it is argued that the pertinent test for originality in the post-production phase of digitisation is the *intention* in making the digital work. Through the use of all available skills and technology, the sole aim of the digitisation process is to reproduce the original artwork as closely as possible in a new medium. This is evidenced by the fact that the resulting digital images are never captioned with an explanation of any treatments made to them, but rather they are published *as is*, without qualification, captioned under the title, author, and medium of the original. The digitisation staff try their best to remove any evidence of their work. Therefore, though it may seem perverse, because the *intention* is to make a slavish reproduction, the greater the effort, expense and skill that is used to make that reproduction, the less *originality* it can have. This moral principle is already well accepted in conceptual art. An artist can leave specific directions for how their artwork should be recreated (even after the artist’s death or on multiple independent occasions) without the people physically undertaking the recreation being considered to be copyright-holders in the work. Indeed, the conceiving artist and therefore the copyright holder, need not ever be directly involved in the actual making of the work - even in its original production. Sol LeWitt, considered a founder of conceptual art, in defining the discipline effectively stated his preference for the originality principle:

*In conceptual art the idea or concept is the most important aspect of the work. When an artist uses a conceptual form of art, it means that all of the planning and decisions are made beforehand and the execution is a perfunctory affair. The idea becomes a machine that makes the art.*⁵¹

⁵⁰ The purchase of Pollock’s “Blue Poles” (1952) for \$1.3m in 1973 for the National Gallery of Australia caused unprecedented public debate in Australia about the role of skill and originality in art. <http://nga.gov.au/international/catalogue/Detail.cfm?IRN=36334>

⁵¹ “Paragraphs on Conceptual Art”, Sol Lewitt, First published in *Art Forum*, June 1967 http://www.tufts.edu/programs/mma/fah188/sol_lewitt/paragraphs%20on%20conceptual%20art.htm

If we were to agree that the retouching of a work during the digitisation is sufficient to produce a new layer of copyright, and therefore a new life+70 copyright term, then it stands to reason that each time a work is digitised then the copyright period of that work is effectively “reset”. Lord Oliver left a pertinent warning to this effect in the *Interlego* judgement:

“Moreover, it must be borne in mind that the [UK] *Copyright Act 1956*; confers protection on an original work for a generous period. The prolongation of the period of statutory protection by periodic reproduction of the original work with minor alterations is an operation which requires to be scrutinized with some caution to ensure that that for which protection is claimed really is an original artistic work.”

This is a clear warning against the creation of a system of perpetual copyright, simply by re-copying a work with minor changes as time comes for the current version to fall into the Public Domain. In the digital era this would be simply a matter of re-digitising in each new and improved format that is invented. It is without question that technological advances will continue to invent new digital formats and skilled techniques for reproduction. The advent of “gigapixel” images that can be zoomed in to show a higher detail than the naked eye could detect even if standing in front of the physical painting is an example of this.

In arguing for the creation of an “intentionality test”, it is important clarify limits, for intent has never been a necessary criteria for copyrightability. Indeed, many people uploading their own images to photo sharing websites are unaware that they even own copyright in the first place.⁵²

Therefore, intent should only be a test for copyrightability when it concerns intentional reproductions, not wholly new works. This intentionality distinction is also significant in the field of art restoration as there is a parallel debate as to the copyrightability of major restorations of artworks - whether a conservator, in the use of their skills, quite literally created a new “layer” of copyright over the original artwork. In such cases there is no copying in the normal sense that the word. Restorers (in contrast to conservators) do not have available to them an existing work from which to copy and must instead make educated guesses as to the original content. The resulting form of an expression can be fairly said to originate from them and as a result of their independent efforts and therefore, it is quite possible that they might claim joint-copyright in the restored work.

Conclusion

Due to the lack of legal certainty, in either direction and in the three jurisdictions discussed, all protagonists lay claim to different moral high grounds and selectively interpret the law to suit their interests. While it would seem that the academic trend is towards wider application of Public Domain principles, this is countered in practice by the financial interests of both under-funded public institutions and corporations invested in the culture sector. Copyright law is a convenient weapon to wield by both sides of this debate and the principles argued are valid, but mutually exclusive. In the absence of legal certainty or enforcement both groups undertake activities to bolster their position. Proponents of the “Sweat of the Brow” doctrine use contract law (including licenses and “clickthrough”

⁵² Creative Commons Corporation (2009), *Defining “Noncommercial: A Study of How the Online Population*
⁵²*Understands “Noncommercial Use”* Page 45. http://wiki.creativecommons.org/Defining_Noncommercial

conditions) to “contract out” of the Public Domain as well as both simple and advanced TPMs (backed up by anti-circumvention laws) to reinforce their claim. Proponents of the “creative spark” principle on the other hand, use “jurisdiction shopping” and reverse engineering to access and publish digitisations of PD artworks often against the express wishes of the museum.

Szczesny (ibid.) arguing against the American Association of Museum’s being publicly seen to support Bridgeman Art Library’s court case,

“To have museums who argue vigorously (and rightly) on the one hand for “fair use” and on the other to assert perpetual copyright (by taking photos over and over again) over works which have fallen into the public domain would be seen by some as a bit of a double standard and would be all the more troubling coming from institutions with educational missions who hold their collections in the public trust.”

It is the author’s opinion that claiming rights in faithful reproductions of Public Domain two dimensional works of art, or imposing contractual or technical restrictions upon the use of that work, is to commit *de-accessioning by copyright*. In museums to de-accession means to remove the object from the collection - usually by selling it to raise money for other acquisitions. It is a controversial activity as it means reneging on the original commitment made when accessioning the object in the first place - to place it in public trust to preserve and make it available in perpetuity. By analogy, to de-accession by copyright is to take something that had been held in public trust and then deny it from that selfsame public in order to gain a corporate advantage. In short, it amounts to a breach of the original promise regarding the mission of a publicly funded cultural institution - that it will acquire, preserve *and make available* its collection.

While it has been shown that the *Bridgeman v Corel* decision is the only case directly applicable to this issue, and although it is a New York District case with no mandatory-precedent set over Australia, even in New York the principles it stipulated go unheeded. To this day most, if not all, art museums in New York blatantly claim copyright in the images on their websites. Furthermore, even if the judgment were binding, several “workarounds” have been devised and are often used. In the immediate wake of the *Bridgeman* decision, Szczesny (ibid) put forward four options for institutions that digitise PD art to regain control over their images. He suggested that institutions could:

- a) Introduce “creative variations” to digitised images so that they might claim to be new works and therefore qualify for copyright; (he notes however that this would undermine the purpose of the digitisation itself to “provide a true reproduction”)
- b) assemble the digitised images into a collection so that the combined work might gain copyright as a database (while this right exists in European law, this is not the case in the USA nor, since the *IceTV* case, in Australia);
- c) “impose contractual restrictions upon subsequent use of the digital copies through licensing” (though he notes that third parties cannot be bound by contracts if they somehow obtain the files); and finally
- d) “explore the possibility of placing technological restrictions on copying” (we would now recognise these as technical protection measures (TPMs).

It would be difficult to write a clearer summary of the methods that are currently being used by art digitising institutions to circumvent the principles of the statutory limitation of copyright.

3D printing

It should also be briefly noted here that all of the substantive legal points of the issues raised here will also come into stark relief as 3D printing becomes increasingly mainstream. Not merely an art form, the increasing prevalence of cheap, accurate and fast 3D printing (and a variety of digital models to print) will dramatically change the manufacturing industry, the supply-chain business model, and ideas of copyright worldwide. At present, it is possible to print a full-scale, highly accurate copy of the *Mona Lisa* at home. The copyright status of that work is currently completely undetermined. However, in the very near future not only will it be possible to print a full-scale, highly accurate 3D copy of the *Venus de Milo*, it will also be feasible to make a similar reproduction for replacement parts for a car. Already some museums are beginning to digitise 3D objects and use them as teaching tools and (touchable) alternatives to fragile objects for display.⁵³

If the status quo of claiming copyright in faithful digitisations of 2D works was carried over to the 3D world, then it would become standard practice for institutions to claim copyright in any objects that they had scanned using great skill, expense and effort. It is probable that the only reason the issue of copyrightability of *faithful* reproductions of 3D works has never been addressed by the courts is because this has never before been technically feasible. Now that it is undeniably a sooner-rather-than-later reality it is arguable that, unless clarified in the Act, all the arguments raised in the “far too complex” 1980 amendments focusing on photocopying will re-hashed.⁵⁴

Recommendation for ALRC

The copyrightability of digitisations of PD art is demonstrably a subject of some consequence to cultural institutions and the public. The legal uncertainty both in Australia and internationally causes confusion and unnecessary conflict. Therefore, the Australian *Copyright Act* needs amendment to clarify the situation. It is recommended that four distinct elements are necessary inclusions in response to Questions 1b, 1d, 21 and 54 of the ALRC Issues Paper, quoted above, any changes to the Act need to:

1. Declare a *high threshold of originality* of copyright in works and specifically exclude effort, skill or expense as relevant factors. This should be done under the guiding principle that any wording be technology-neutral so that as time progresses the specific nature of the original work and the specific nature of the copy (and the manner of its digitisation) need not be addressed anew by the courts for each new format. This is particularly necessary in order for the law to be prepared for the social and economic changes that will arise from 3D printing.

2. Stipulate that a recreator’s *intent* should be a key test in determining the threshold of originality for digitised works. This is in order to counteract claims that changes in post-production are inherently worthy of new copyright. If the digitised work is sufficiently changed through such “creative variations” that it is visibly different and therefore a new

⁵³ CollectionsLink (2012) “Are we ready for 3D printing?” in *Sustaining Digital*, May. <http://www.collectionslink.org.uk/discover/sustaining-digital/1328-3dprinting>

⁵⁴ Lahore, J. (1980) *Photocopying: A Guide to the 1980 Amendments to the Copyright Act*. Butterworths, Melbourne. Preface.

work, it should by all means be considered to have a new copyright term. However, in such a case it should not be possible to simultaneously publish the work with the title and artist of the original work while claiming a new copyright term as well. If the *intent* in post production is to conscientiously remove any changes that crept in during the image-capture stage, then that intent should be honoured by the digitisation's retaining the original artist's (expired) copyright.

3. Declare that the Public Domain cannot be "contracted out". That is, agreements which purport to exclude or limit the rights associated with the statutory limitation of Copyright should not be enforceable. Currently, in most cases, before a person can access a PD image on an art museum's website, he or she will have consented to several overlapping copyright-like contracts. Some are implied by the terms of the website which claims all rights in all content displayed and others are made explicit by requiring signing the request form which includes similar terms. Moreover, these demands are made irrespective of the copyright status of the works being accessed. Even on the rare occasions that end-users understand copyright to the point that they know the copyright status of the original work, these contracts are used to "trump" or supersede copyright. It would be an unreasonable burden to expect all websites and all access forms to be duplicated so that they only show information that is applicable to the copyright status of specific item being viewed. However, it would not be difficult to require that end-users be made aware through a standard wording that the copyright status of the original work "trumps" any contracts placed upon it. It should also be made clear that simply declaring a PD work to be "free for educational use" (or "non commercial use" or similar phrasing) is not an acceptable alternative given that this implies a right to enforce an existing restriction. This kinds of false-restrictions not to be confused with the valid restrictions or special conditions sometimes placed on works by donors or through moral rights or indigenous cultural rights.

4. Finally, that it should not be considered an infringement to circumvent a TPM if the purpose of doing so is solely to access Public Domain works.

Sincerely,
Liam Wyatt

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