

## INTELLECTUAL PROPERTY: A KEY TOOL FOR MUSEUMS

GLOBAL DIGITAL ENCOUNTER 27,  
MAY 18TH, 2023

### PANELISTS:

- **Prof. Yolanda BERGEL SAINZ DE BARANDA**, Professor of Private Law at Universidad Carlos III de Madrid in Spain.
- **Dr. sc. Haris HASIĆ**, Associate Professor and the Vice-Dean for research and development at the University of Travnik Faculty of Law in Bosnia and Herzegovina.
- **Prof. Laurent MANDERIEUX**, Professor of Intellectual Property and Competition Law at Bocconi University in Italy. Director of TIPSA. Chair of the European IP Teachers Network. Member of Fide's Academic Council.
- **Jur. dr. Ulrika WENNERSTEN**, researcher and teacher in Intellectual Property Law and Market Law, Lund University, Sweden.

### OBJECTIVES

Intellectual property is key to Museums: from IP rights attached to artworks to digitalization of works and merchandising, museums do operate within IP limits. The fast digitalization of collections, issues connected to museum websites' development, and the entry of museums world in a closer relationship, for the good or for the bad, with business, makes the relationship between IP and Museums more complex and dynamic than ever. For this 27th Encounter, the FIDE/TIPSA Global Digital Encounters pool their forces with the European Intellectual Property Teachers' Network (EIPITN), the largest such network in Europe, and in particular with its Working Group on Teaching IP in relation to Arts, Fashion, Culture and Creative Industries: EIPITN Academics from Europe will provide a worldwide picture of recent developments on IP and Museums, and the future of Museums thanks to a dynamic and yet careful use of IP tools.

## REPORT

### INTRODUCTION

For the first time FIDE/TIPSA (Transatlantic Intellectual Property Academy) Global Digital Encounters pool their forces with the European Intellectual Property Teachers' Network (EIPITN) to propose an exceptional 27th Global Digital Encounter: "Intellectual Property: a key tool for museums". It is also the first Encounter of the Working Group on Teaching Intellectual Property in relation to Arts, Fashion, Culture, and Creative Industries. **Professor Laurent MANDERIEUX** highlighted the particular scope of the subject: from the Intellectual Property rights attached to artwork, digitization of collections and merchandising, to issues connected with museum websites' development and with the public. The museum cannot live without Intellectual Property, since Intellectual Property is at the heart of museum activity. EIPITN Academics from Europe will provide a worldwide picture of recent developments on Intellectual Property and Museums, and the future of Museums thanks to the dynamic and careful use of Intellectual Property tools.

As mentioned by **Professor Javier FERNÁNDEZ-LASQUETTY**, this topic aims at observing new points of view about museums and learning from specialists.



**Dr. Ulrika WENNERSTEN**, the moderator, laid the foundation by speaking about the opportunity that Intellectual Property represents for museums. In order to analyse better the different actors, she distinguished schematically the topics to be discussed: the museum as the user (1), the museum as creator (2), the museum and the public (3), the specific issue of users taking pictures in the museums (4-7), moving forward the use of museum Intellectual Property's leveraging negotiations (8) and finally the use and potential use of museum in Intellectual Property Law teaching (as part of the joint event with the EIPTN) (9).

**QUESTION 1: WHAT INTELLECTUAL PROPERTY ISSUES SHOULD MUSEUMS CONSIDER WHEN BUYING, LENDING OR BORROWING WORKS OF ART? (THE MUSEUM AS USER)**

**Professor Yolanda BERGEL SAINZ DE BARANDA** responded that museums are users of work protected by copyrights. One of the many aspects in which they interplay with Intellectual Property rights is the reproduction (for catalogs), distribution (for merchandising), and digitalization of their collections involving an act of communication to the public. Intellectual property diligence must be taken into account not only for works already existing in their collection but also when purchasing new works of art. The museum must obtain prior authorization before carrying out its activities since the purchaser of the work has no copyright over it unless legal or contractual provisions stipulated otherwise. For example, in countries where the "first sale rule" applies, the first acquirer obtains the right to the exhibition (generally, unless excluded in the contract), but if the buyer wants to make any other use of the work

the authorization of the rights holder is necessary.

**Prof. BERGEL** added that contracts of sale could be very brief regarding Intellectual Property issues and that can cause problems later on. Therefore, contracts should include Intellectual property provisions allocating to the museums the rights necessary for their purposes and determining the scope (mediums, exclusivity, duration, territory, etc.). This can be easier in primary sales (work acquired from the artist) than in secondary sales (work acquired from a subsequent buyer) in which case the lack of information on the seller's rights could be critical.

With regard to loan agreements, if the museum is the lender, it has to be determined whether it can authorize the use or whether the authorization has to be granted by someone else (artists, heirs, collective management entities, and so on). The same logic applies to a museum as a borrower, the right holder will have to authorize the uses foreseen. Normally, standard contracts between museums include an Intellectual Property clause stating that it is the borrower's responsibility to obtain these rights.

**Dr. WENNERSTEN** asked the topic to be further explored in terms of museums as producers of protected works.

**QUESTION 2: WHAT INTELLECTUAL PROPERTY ISSUES SHOULD MUSEUMS CONSIDER WHEN PRODUCING WORKS? (THE MUSEUM AS CREATOR)**

First of all, **Prof. BERGEL** explained that in fact, museums are not only users of protected works but that they also create works protected by copyright and that these works and products are a great source of income. In the era of digitalization, the spread and communication of the content of collections are meaningful. Some of them place importance on Instagram or videos shared on YouTube, as a way of promotion and development of its prestige and reputation.

The main example of works that may be protected by Intellectual Property rights is the photographs of the pieces of art in the collections or the catalogs that the museum publishes. To take pictures of the works the museum needs the reproduction right (unless the work has fallen into the public domain), but once obtained, the photograph itself could be protected by reproduction rights or by related rights. When it comes to determining the originality of these photographs, there are international differences between Civil Law and Common Law systems. Once taken, the photograph may be protected. If the photographer is not a member of the museum staff, consent for reproduction is therefore necessary. If Intellectual Property rights on the piece of art have expired and fall into the public domain, reproduction by third parties cannot be limited. This topic is mainly regulated in Article 14 of Directive (EU) 2019/790 on copyright and

related rights in the Digital Single Market, stating that any material resulting from an act of reproduction of works in the public domain is not subject to copyright or related rights.

Moreover, **Prof. BERGEL** took the example of a museum as a producer of multimedia products (with music, comments, videos, etc.) that shall need the assignment of rights of the different participants in the product. For this purpose, the works have to be digitalized (the act of reproduction due to change of medium). The commercialization of multimedia products might be online (by uploading the product) constituting an act of communication to the public, or offline/physical commercialization (by selling DVDs) which constitutes an act of distribution. She also raised the question of merchandising, for which museums can mandate a third party. Merchandising contracts must be well defined, specifying the use, purpose, and quality of the product.

**Prof. BERGEL** concluded with a few words on exhibitions organized by museums, considering for example the role of curators, the selection of works, and text labels. All these works combined can benefit from protection under Intellectual Property or related rights. Once again, if the curator or designer does not work for the museum, they must conclude a contract assigning the necessary rights to the exhibition.

**Moderator Dr. WENNERSTEN** found interesting the role of the curators also as creators.

**QUESTION 3: DIGGING DEEPER INTO THE QUESTIONS ABOUT THE MUSEUM SHOPS. IN THE CURRENT DIGITAL ERA, THE FIRST THING WE DO WHEN EXPLORING A MUSEUM IS CHECK GOOGLE FOR ITS COLLECTION. WHAT OTHER KINDS OF INTELLECTUAL PROPERTY RIGHTS CAN BE IMPORTANT FOR A MUSEUM BESIDES COPYRIGHT? ? (THE MUSEUM AND THE PUBLIC)**

**Prof. MANDERIEUX** identified this point as a key to our discussions. Indeed, museums need a larger public for a globalized reach and visibility, through digitalization and user creators. This means not only growing but also evolving beyond just copyright. One example is the choice of domain names to develop digital communication, as well as trademarks related to merchandising. Industrial designs likewise play an important role in the presentation of collections and in the creativity of museums, as do the creators and producers of art who are involved and are not solely bound by copyright.

**Prof. MANDERIEUX** continued by saying that copyright and digitalization permit immense possibilities, but present, at the same time, challenges. For example, watermarking works of art could be a way of ensuring the safe circulation of reproductions, but it can also limit it, in what the professor called the "double-sided" effect. In addition, because museums are curators/conservators, they are now caught up in the picture of the "digital rights management" option, a skill that is still struggling to be fully developed by their leaders. Museums need positive help to gain more resources, and commercial services are

offered in this respect, with all the drawbacks that entail. Google permits the contents of many museums to be visible and, at the same time, may offer commercial services or arrangements out of it. Opinions on this subject remain open, but one thing is certain: the demand is strong and museums have a real need for digitalization. This brings us to the question already addressed by European legislation and Intellectual Property academics, of how Intellectual Property rights are actually controlled: Are museums actors or victims in this context? This debate is fascinating and proves, once again, that the museum is part of a global, multidisciplinary initiative intended for a broad public to fulfill its historical and social function.

**Dr. WENNERSTEN** agreed and mentioned the digitalization within museums when visitors are taking their own pictures. If this work has fallen in the public domain, article 14 of Directive (EU) 2019/790 may legally authorize its reproduction when it is not original. **Prof. MANDERIEUX** identified this point as a key to our discussions. Indeed, museums need a larger public for a globalized reach and visibility, through digitalization and user creators. This means not only growing, but also evolving beyond just copyright. One example is the choice of domain names to develop digital communication, as well as trademarks related to merchandising. Industrial designs likewise play an important role in the presentation of collections and in the creativity of museums, as do the creators and producers of art who are involved and are not solely bound by copyright.



**QUESTION 4: IN THIS CONTEXT, HOW CAN MUSEUMS PREVENT VISITORS FROM TAKING A PICTURE INSIDE THEIR PREMISES?**

**Prof. BERGEL** further elaborated that speaking about the case of Museo del Prado, or any other old master museums, mostly all their collections have copyrights expired and photographs should in theory be allowed inside their premises. Works of art fallen in the public domain cannot be protected under Intellectual Property rights or any related rights and therefore reproduction cannot be limited under these grounds. It is again the topic of the aforementioned article 14 of Directive (EU) 2019/790 on copyright and related rights in the Digital Single Market which stated that once the term of protection of a work of visual art has expired, any material resulting from an act of reproduction shall not be subject to copyright or related rights unless the material resulting from the active reproduction is original (the author's own intellectual creation).

However, **Prof. BERGEL** specified that this permission does not entail a right of access to a work. Indeed, museums are not obliged to grant access to these pieces of art to third parties and may prevent it by contract, for example on the grounds of the duty of preservation of the work. For instance, it is the typical limitation used to demand pictures to be taken by visitors without a flashlight. Policies may differ. If the museum bans the possibility of taking any picture and does not otherwise grant access to

reproductions, the result is to prevent access to the art in the public domain. Generally speaking, museums upload pictures of their art collections into their websites for a free-use but quality is a different matter (it could be high or low). As such, digitalization may be an expensive procedure. On the one hand, the European Commission promotes no copyright limitations on public domain works. On the other hand, it also encourages joint cooperation between the public and private sectors for digitalization, granting individual and restricted rights for a limited period of time.

The Italian Cultural Heritage Code (CHC) states that specific cultural heritage institutions have the right to authorize the use of works from their collections in the public domain, and may charge a fee for such use, under its articles 107 and 108. She mentioned a polemic case in this respect, about the image use of the "Vitruvian Man" by Leonardo Da Vinci, which has opposed the Gallerie dell'Accademia, the Italian Ministry of Culture, and a German company, Ravensburger. The Italian plaintiffs claimed that the German defendant has never submitted an application for a reproduction license and had not paid any license fee for commercializing a puzzle with its reproduction. The verdict in favor of the plaintiffs leaves Italy in a delicate position, as it contradicts the aim of Article 14 of the Directive (EU) 2019/790.

**Prof. MANDERIEUX** pointed out that the result of the digitalization of art collections will be of lower quality for the public if it remains too limited. The necessity of building a relationship with commercial work is crucial, and at the same time tends to be antagonistic to the museum's purpose.

**QUESTION 5: WHAT IS THE CURRENT SITUATION REGARDING ARTICLE 14 OF DIRECTIVE (EU) 2019/790 IN BOSNIA AND HERZEGOVINA?**

Froms From **Professor Haris HASIĆ's** point of view, it is important to reward the efforts made by museums and art institutions to offer public access as well. He mentioned the work of Sunimal Mendis: "A Copyright Gambit: On the Need for Exclusive Rights in Digitised Versions of Public Domain Textual Materials in Europe". Indeed acquiring, publishing, conserving, and offering general access to a work in the public domain requires resources. In Bosnia and Herzegovina, under certain circumstances, the publisher of an unpublished work in the public domain may receive similar economic rights to the author for a limited period of time (shorter than copyright duration) for the act of offering access to the public through publishing. Additionally, in the case of the production of special editions, which offer added value to the work that has fallen into the public domain, special rights, equivalent to the economic rights of the author of the relevant work are also granted. This would be an incentive for museums, as creators, to invest in

creations that they could profit from through the exploitation of these rights.

**Dr. WENNERSTEN** continued the thread of questions by asking for clarification regarding the photograph taken by the public:

**QUESTION 6: COULD A SITUATION WHERE THE PUBLIC HAS PAID AN ENTRANCE FEE AND AGREED ON THE TERMS AND CONDITIONS TO ENTER THE MUSEUM BE COMPARABLE TO A CONTRACT? IF SO, COULD TAKING A PHOTO IN THE MUSEUM BE CONSIDERED A BREACH OF CONTRACT (EVEN WITHIN A STATE-FUNDED MUSEUM AND WITH THE EXPIRATION OF COPYRIGHTS)?**

**Prof. Haris HASIĆ** pointed out that this is an issue of (real) property as compared to intellectual property. He offered a concrete national example from Bosnia and Herzegovina: the case of the Sarajevo Haggadah. This is a famous Jewish text which has been in the public domain for a long time. It is conserved at the National Museum of Bosnia-Herzegovina in Sarajevo. The museum tries to preserve, among others, by restricting access, which enables it to recoup some of the costs of preservation, but also limits public access to the work.

**QUESTION 7: FOLLOWING THE PREVIOUS QUESTION, CAN A PICTURE TAKEN FOR ONLY PERSONAL USE BE AN INFRINGEMENT?**

**Prof. BERGEL** replied that generally speaking, it is possible to take pictures. However, as previously mentioned by both **Prof. HASIĆ** and **Prof. BERGEL**, because the visitor purchased a ticket, comparable to concluding a contract, he must comply with museum rules and adopt appropriate behavior regarding pictures. To overcome the ban of consumers from taking pictures, museums normally upload web page photographs of the artwork for free and with great quality, as a fair reason.

**Prof. MANDERIEUX** commented on this solution of uploading online, mentioning that unlike the solutions brought by the previous examples of digitalization, this one offers a positive problem-solving approach. Thirty years ago, cameras were prohibited and visitors were therefore forced to buy postcards at the museum shop. This solution, permitted by copyright law, shows the double face aspect of digitalization, and the complex issue of the legislation in this respect.

**QUESTION 8: CAN A MUSEUM USE THEIR IP RIGHTS AS LEVERAGE IN NEGOTIATIONS? THIS COULD BE A USEFUL INSTRUMENT IF THE MUSEUM ACTUALLY OWNS SOME OF THE INTELLECTUAL PROPERTY RIGHTS OVER THEIR COLLECTION. (IP LEVERAGE NEGOTIATIONS)**

**Prof. Haris HASIĆ** explained that Intellectual Property may be both the "carrot and the stick", following the famous metaphor. Is very much about control, allowing the right holder to control certain uses of protected works, especially as a leverage tool. The Professor mentioned the difficult situation of Bosnia-Herzegovina, especially regarding the public-funded cultural institutions on the national level, and in particular the lack of subsidies for certain national museums, due to political reasons (The National Museum was even forced to close its doors for a time for this reason).

He gave the example of the Muzej Alija Izetbegović negotiation experience (the museum named after Alija Izetbegović, the first democratically elected president of Bosnia and Herzegovina). A foundation was created after his death in 2003 to promote his legacy and to manage the museum. Part of their project was to digitise the archive of recordings of the former President's speeches and public interventions. The public broadcaster, the Bosnian-Herzegovinian Radio Television (BHRT), owned part of the materials and entered into a negotiation with the museum for its access. They attempted to impose very difficult conditions during the negotiation, discouraging the museum more than once from pursuing the project. However, the museum realised, with the appropriate guidance about Intellectual Property rights, that the president's speeches could be protected under copyright (as his own creations) and related rights of a performer. They used these rights as leverage in the negotiation.

Following the transfer of rights to the museum by the president's heirs, part of the negotiations involved considering the removal of access to BHRT and no longer allowing it to broadcast the relevant materials. The broadcaster argued that the works of the President were public news, which (under the "news exemption") cannot be protected by copyright. However, this exception only covers current events and not speeches from 20-30 years ago. The museum's knowledge of intellectual property rights enabled them to enter the negotiations from a position of strength, managing to secure a satisfactory contract.

**Moderator Dr. WENNERSTEN** steered the debate on the use of museums in teaching intellectual property law. Problem-based learning is taking place in the museum at Lund University and is used as a tool to help students better understand Intellectual Property Law. Indeed, this interdisciplinary method provides the opportunity to problematize different kinds of intellectual Property law problems. This method also stimulates students' curiosity, about the artists and art in general. The ensuing conversation attests to the effectiveness of this method when students are trained to talk about these issues to non-lawyers.

**QUESTION 9: In this regard, are you also adopting practical approaches in your Intellectual Property Law teaching? (EIPN Working Group)**

**Prof. BERGEL** talked about her personal experience, as a Professor of Art Law at Universidad Carlos III de Madrid. Museum employees are regularly invited to talk about Intellectual Property

problem-solving. In turn, students were invited, for the first time this year, to the digitalization department of a museum so that they can discover different means of reproduction (analogic, digital, electronic), communication to the public, and more.

Following the previous remarks, **Prof. MANDERIEUX** distinguished two different approaches: conservation and promotion. Based on what **Prof. HASIĆ** said, teaching Intellectual Property Law implies a part connected to conservation (for instance, limiting access like the B&H National Museum in order to protect its collections) and the same time, a part connected to promotion thanks to Intellectual Property tools linked to digitalization (so that people can see these artworks from outside). This dual function brought by Intellectual Property offers interesting perspectives. **Prof. MANDERIEUX**, who has taught some elements of Intellectual Property in museology courses at the University of Quebec in Montreal and in Ottawa, mentioned the projects of students' artwork that encouraged them to identify Intellectual Property issues connected to their own creation. This approach provides new inspirations and simultaneously new content to analyze from legal and commercial views, i.e. a compendium of Intellectual Property law useful for students' future, also destined for non-lawyers.





**Prof. HASIĆ** concluded by saying that one of the functions of Intellectual Property is to control the message, against quasi-facts. As such, the museum's goal is to essentially ensure that the message remains consistent and preserved.

**Moderator Dr. WENNERSTEN** resumed that digitalization has its share of problems and solutions. It may help preservation but may be limited when digitization supports are themselves obsolete (reading old CDs, DVDs).

### QUESTIONS FROM THE AUDIENCE

#### **QUESTION 1: PERHAPS MUSEUMS COULD ADOPT AN OPEN-SOURCE MODEL TO FACILITATE ACCESS TO CERTAIN WORKS OF ART, AS PART OF A FORM OF DIGITAL CULTURAL HERITAGE?**

**Prof. BERGEL** replied that it was mainly a question of policy, which depends on the museums. The Rijksmuseum for instance uploads all its content with all quality available. From the Professor's point of view, it is a very good idea, and it reinforces the museum's reputation for being completely open to the public, even if the financial aspect can sometimes limit it.

Furthermore, **Prof. HASIĆ** reminded us that even if museums can sometimes adopt open-source standards, their remit to do so can be limited, among others by the terms and conditions of licensing given to the museum to use the protected works. Digital Rights Management tools could therefore be required, especially with the arrival of museums in the Metaverse and with the

proliferation of NFTs as being of potential interest to museums.

**Prof. MANDERIEUX** agreed with this conclusion and mentioned that open-source development is maturing quickly. In the future, we will have a better maturity that permits commercials based on open-source models.

### CONCLUSION

**Professor Manuel DESANTES REAL** came to the conclusion that museums cannot work without Intellectual Property because it is at the center of museum activities (copyrights, trademarks, domain names to industrial designs), quoting the words of **Prof. MANDERIEUX** "Museums bring cultural knowledge to people". This topic covered a lot of questions and stakes and testifies to the day-by-day work of museums regarding Intellectual Property.

Report written by **Adèle SERIO** and **Javier LOPEZ-GUZMAN**



## GLOBAL DIGITAL ENCOUNTERS

[Fide](#) and TIPSA (Transatlantic Intellectual Property Academy) join forces to organize a series of digital encounters to try and find out if Intellectual Property is equipped to face the ongoing changes that our world is experiencing.

All online encounters are opened to any interested person and speakers have been selected among the most relevant IP scholars and professionals all over the world.

The [Global Digital Encounters](#) form integral part of the solidarity projects run by both organizations to support the international, European and national plans to overcome the sanitary and financial consequences of the COVID-19

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