



WESTERN NEW YORK LIBRARY RESOURCES COUNCIL

Questioning existing practices.
Testing new ideas.
WNYLRC: a leader in library innovation.

Ask the Lawyer

Ask the Lawyer Request Form

Recent Questions

New for 2016/2017

WNYLRC has allocated funds to retain an attorney to offer members, free of charge, timely input on intellectual property, digital rights management, vendor contracts, first amendment, civil rights, employment law, and other legal issues that can impact library operations. In addition, a WNYLRC Legal FAQ section will be developed over time to provide information on issues pertinent to the entire membership.

To request the service, members must complete the *Ask the WNYLRC Lawyer! Request Form*. Members should provide as much information as possible on the issue to ensure the attorney has the information needed to fully answer the member library's inquiry. Member libraries also have the ability to upload documents that might be helpful in assisting the attorney who is reviewing the issue. We ask members to check the RAQ section first before completing the form. Another member may have already asked the same question!

Questions sent to WNYLRC's "Ask the Lawyer" service will be reviewed by a WNYLRC staff member who is the service liaison, and sent to our counsel for answers. Responses and answers may be provided in several formats:

- a memo shared with all members if the issue is pertinent to more than one member library,
- a training session if the issue is pertinent to a group of member libraries or type of library members,
- an addition to the "WNYLRC Legal FAQ" on the WNYLRC web site, or
- a memo shared only with the member library requesting the information and the WNYLRC service liaison who manages the service.

Please keep in mind: the "Ask the Lawyer" service is not legal advice to your organization. Always alert officers at your institution if a lawsuit is threatened, or if a matter is so specific or critical that your own institution's attorney should be involved. And yes--you can always "Ask the Lawyer," if you don't know if a particular issue hits that threshold!

RAQ: Recently Asked Questions

Topic: Photocopying Music Scores

Posted: November 8, 2016

MEMBER QUESTION

We have a request from a patron from another state for scans or photocopies of music scores that we own and that are still under copyright. They are rare and only a few libraries have them across the country. The patron does not intend to perform the music, only to study the scores. Is it fair use to copy or scan them for the patron who is writing a doctoral thesis?

WNYLRC ATTORNEY'S RESPONSE

Short answer: The proposed copying would not be a permitted, duplication or Fair Use without some additional steps consistent with the four Fair Use factors.

Long answer: This is a great question, as it marries the practical consideration of access with the scary question of a liability for infringement. To answer it, there are a few initial points of priority....

First, it is critical to note that Section 108 (a) of the Copyright Act, which would normally allow for *one* copy of a work to be provided to fulfill this request, expressly excludes musical works (see Section 108 (i)).

Second: Because of the Section 108 (a) exclusion, it is important to distinguish: while the *patron* may have a Fair Use defense if they duplicate the work for the purposes of scholarship, the library, in simply making the copy to **provide easier access** to a remote patron, might not.

Third, as plaintiffs can sue “innocent infringers,” careful steps should be taken to ensure the library could not be viewed as a part of the **chain of infringement**, if the patron ends up *not* having a valid Fair Use defense for any copy or derivative work they generate.

Fourth, while this scenario does not state the original copy requires archiving, it sounds as if you have a rare and precious copy, so we'll draw a bit from the law, case law and guidance covering the protection of deteriorating/rare documents.

And now...how do you enable the proposed access, but keep the library safe? By ensuring 108(c) and the “Fair Use” factors are on your side, whether you send them a scanned copy, or loan a physical copy.

Digital copy

Informed by the latest case law and guidance, the following steps could help claim Fair Use for providing the proposed copy digitally:

Step 1: As the *Code of Best Practices for Fair Use in Academic and Research*

Libraries (www.arl.org/focus-areas/copyright-ip/fair-use/code-of-best-practices) puts it: “Providing [digital] access to published works that are available in unused copies on the commercial market at reasonable prices should be undertaken only with careful consideration, if at all.” **It is essential to verify that the works, or a licensed copy, are not commercially available.** This is essential for 108(c), too.

Step 2: It is best if the transformation of format is not an *ad hoc* effort, but rather is part of an effort to promote a special resource of your library. Making the digital copy a part of “**special collection**”—for instance, of rare music scores—will give you a stronger Fair Use defense.

Step 3: Again from the *Code*: “The Fair Use case will be stronger when the availability of the material is appropriately publicized to scholars in the field and other persons likely to be especially interested.” In other words, once you have the collection digitized, don’t let it be just that *ad hoc* project—**promote it**.

Step 4: Use **appropriate technological controls** (digital watermarks, etc.) to restrict the access, limit duplication, and ensure proper attribution of materials in the collection. That way, any eventual copying or derivative work generated by the patron is separate and distinct from the access provided by the library.

Step 5: As with any digital collection, make sure the library has an easily found way for people to register privacy or intellectual property concerns related to digital collections.

Physical copy

What if you just want to provide them with a physical copy? Following Section 108(c)’s rules for duplicating deteriorating copies, you can generate a copy for preservation purposes, loaning it to them with the expectation that it will be returned. Just take care that the work is not commercially available, and that the original copy is not available while the preservation copy is out on loan.

[NOTE: 108(c) bars a digital copy made on this basis from leaving your institution.]

Overall

The bar on Section 108 (a) applying to musical works makes this a bit more challenging than the usual duplication request, but with some care, access can be provided.

Further, if the patron wants to make a copy of what your library loans them (either digitally, or in hard copy), if their use is as you describe, they may have their own Fair Use defense. This will mean both the library and the patron can stand on separate, but solid, copyright ground.

Topic: Showing Performance Video to a Sanctioned College Club

Posted: November 8, 2016

MEMBER QUESTION

The question relates to showing a performance video to a sanctioned college club. I understand that as long as the college's library owns the DVD or streaming rights, the movie can be shown in its entirety for educational purposes in a classroom to registered members of the institution. Does the same hold true for showing the same movie to clubs on campus as long as the event is restricted to college members?

This second question is related to the movie presentation but is concerned with publicity. Can the cover image be copied and inserted into the event posters and on the college's website? The web announcement would be removed immediately after the event.

WNYLRC ATTORNEY’S RESPONSE

First question

As you say, a college can show a movie they own, without further licensing, so long as:

- The institution is a not-for-profit

- The performance of the film is in connection with face-to-face teaching activities, in a classroom or similar place of instruction.
- The copy was legitimately acquired

This is a broad exemption, but it absolutely does **not** apply to non-instructional, non-classroom showing of movies by student clubs. Such a showing would require express permission via license.

Of course, if a student club has an academic focus (for instance, Spanish Club) and the film is to be part of an academic experience (for instance, watching the movie in Spanish, to enhance learning), in an academic setting (class room, with a qualified academic instructor) one could argue that the required elements are still met. But the educational purpose must be bona fide...no watching "Deadpool" for entertainment and then having a half-hearted, academically disconnected discussion on modern comic book tropes. And of course under no circumstances should money be charged.

Second question

The second question is very simple: the cover images of most commercial films are subject to copyright. Because of that, and because there is no exemption allowing them to be duplicated, unless permission is obtained, the college is well-advised not to allow copies to be displayed to promote the event, and especially should not allow that image to be published on the college website.

Keeping it off the website is critical. Even smaller rights holders police the internet for images they own, and insurance companies, facing mandatory statutory damages and attorneys' fees, will quickly settle claims...something that will eventually lead to higher insurance premiums for your institution.

The best way to promote the licensed showing is to either use the approved promotional material that comes with the license, or generate a version that does not infringe on the content of the original (or the film).

Topic: Digitization of Newspapers Prior to 1923

Posted: October 17, 2016

MEMBER QUESTION

We would like to digitize newspapers that were published prior to 1923. Since the paper is still in business, does public domain apply in this case? They are very difficult to deal with. We do have a contact there. However, if there is nothing stopping us from digitizing the older issues, we prefer not to deal with them.

Would this also apply to other newspapers who are still publishing today but whose content does exist prior to 1923.

WNYLRC ATTORNEY'S RESPONSE

You have confirmed that the "Buffalo Evening News" (and other iterations) content originates BEFORE the strategic "1923" date confirmed by the Copyright Office (Circular 15a) as in the public domain. This is true whether the original article or image was owned by the paper, or licensed by the paper and owned by another person or entity.

Once an item is in the public domain, there are numerous ways for either the original owner, or another, to

create a copyright in a new medium re-presenting the content (this is a motivating factor in many “special editions”), but the original is no longer protected, and may be digitized as you describe, without concern about an successful infringement claim.

One caveat on the “Buffalo News” content: there could be a concern as you *promote* the newly created resource. “The Buffalo News” is a trademark owned by (interestingly) The Columbia Insurance Co. (registration # 75834888). So while you can list the resource, I advise against using the name “The Buffalo News” in any promotion of the collection. That is for optimal safety and so you don’t get a cease-and-desist.

The good news is that the “Buffalo Evening News” trademark is officially “dead” (see attached screenshot). This may be used to promote the service, should you wish to do so.

This analysis and a similar caveat would apply to any other newspaper.

The screenshot shows the USPTO TESS search results page. At the top, it says "United States Patent and Trademark Office" and "Trademarks > Trademark Electronic Search System (TESS)". Below that, it indicates "TESS was last updated on Thu Oct 20 03:31:44 EDT 2016". The search results are displayed in a table with 6 records found. The table has columns for Serial Number, Reg. Number, Word Mark, Check Status, and Live/Dead. The 6th record, with Serial Number 71280690 and Reg. Number 0258959, is for "BUFFALO EVENING NEWS" and is marked as TSDR and DEAD.

Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead	
1	73200335	1144143	THE BUFFALO NEWS	TSDR	LIVE
2	72362144	0911098	TV TOPICS	TSDR	LIVE
3	72362145	0911099	WEEK-END PAUSE	TSDR	DEAD
4	72260524	0849192	THE YOUNG SET	TSDR	DEAD
5	71298930	0273925	KITCHEN COUNSEL	TSDR	DEAD
6	71280690	0258959	BUFFALO EVENING NEWS	TSDR	DEAD

Topic: Reformatting VHS

Posted: October 17, 2016

MEMBER QUESTION

We are shifting away from VHS here on this campus (along with everywhere else), and have a question from an instructor about transferring a VHS tape to DVD. She's not able to get the tape on DVD or streaming, but knows that it's under copyright. Are there any loopholes to allow for making a digital backup of a VHS tape because VHS is an obsolete medium? Does going through a good-faith effort to find a digital version give some protection or leniency? Should we encourage the instructor to contact PBS or the show's producers to obtain copyright clearance for making a digital copy?

WNYLRC ATTORNEY'S RESPONSE

We'll start out with the best advice: unless you stand on the legal high ground of a disability accommodation or a

crumbling single copy unavailable in the original medium, **when it comes to creating a new format of a work, written permission from the copyright owner is always best.** That is the gold standard. If you have permission, the blood, sweat, and tears (or stress, more likely) of a Fair Use analysis are not needed.

This scenario does not occupy any legal high ground. For a library in this position—dealing with the increasing rarity of VHS players—there is great guidance out there from the Association of Research Libraries’ “Code of Best Practices in Fair Use” (<http://www.arl.org/storage/documents/publications/code-of-best-practices-fair-use.pdf>): Here is what the code has to say on this issue...

Even when libraries retain the originals of preserved items, digital surrogates can spare the original items the wear and tear that access necessarily inflicts. Section 108 of the Copyright Act authorizes some preservation activities, but does not address some of today’s most pressing needs...[including] the transfer to new formats of materials whose original formats (such as VHS magnetic tape) are not yet obsolete (as the term is narrowly defined in section 108(c)) but have become increasingly difficult for contemporary users to consult.

Case law also acknowledges this VHS problem, but gives no relief: “Fair use has never been held to be a guarantee of access to copyrighted material in order to copy it by the fair user’s preferred technique or in the format of the original.” (University Studios et al v. Corley, U.S. Court of Appeal 2nd Circuit, 2001). This case is 15 years old, which means a lot has happened in the world of technology, but is still good law.

So the answer is, for now, unless you are making a disability accommodation, or faced with a crumbling copy, there is no iron-clad loophole or clear precedent to allow the proposed conversion to be a “fair use.”

That said, **if you have a deteriorating copy**, a good-faith effort to re-purchase it in the original medium will certainly contribute to a fair use defense if you duplicate it to preserve this resource.

To help both you and your institution show that you have gone through this exercise, when you address such questions, I advise that you compose short emails to yourself, documenting the question, process, and conclusion. A simple:

“Instructor stopped by today and asked if we could convert VHS in the collection to DVD for ease of access. I let her know we’ll try to purchase a copy on DVD or seek permission of the copyright holder to make a copy on DVD.”

OR

“Instructor stopped by today and asked if we could convert VHS to a format that would allow Deaf student to view closed-captioned version; we are arranging conversion solely to allow reasonable accommodation under the ADA.”

OR

“Instructor pointed out that VHS tape in collection was not working right. [Co-worker] and I verified the condition. As best practices state it is fair use to make digital copies of collection items that are likely to deteriorate, or that exist only in difficult-to-access formats, for purposes of preservation, and to make those copies available as surrogates for fragile or otherwise inaccessible materials, the library will create a back-up copy, UNLESS a fully equivalent digital copy is commercially available at a reasonable cost. We will of course not provide access to or circulate original and preservation copies simultaneously.”

This July, various news outlets reported that the world’s last manufacturer of VCR’s has cease production. Please check back on this issue; we’ll update this entry in the FAQ when we have better guidance, which should be coming soon. Congress is working on new guidelines, and was recently told by the Register of Copyrights, Susan Pallante: “In its current state, Section 108 is replete with references to analog works and fails to address the ways in which libraries really function in the digital era, including the copies they must make to properly preserve a

work and the manner in which they share or seek to share works with other libraries.”

<http://www.copyright.gov/laws/testimonies/042915-testimony-pallante.pdf>

This message is a service to the Western New York Library Resources Council. It is not legal advice to any organization other than WNYLRC, which utilizes the service to provide general guidance, updates, forms and training events in aid of its members.

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