

Rights, Wrongs and the Law: An Interview with Frank Martinez, Esq.

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If you are a design scholar or writer of books on the history of design, you are aware that reproduction rights are getting harder to obtain. Design history books are notoriously under-funded, and now much of those meager fees are locked up in rights and reproduction expenses—that is, if they are obtainable at all. How can proper histories and analyses be written when a large percentage of the artifacts and raw materials needed to create such documents are unavailable or costly? We asked Frank Martinez, a lawyer who specializes in intellectual property for designers, illustrators and typographers, and who provides counsel to AIGA, to answer some pressing questions on IP and fair use.

Heller: As a design writer on subjects of design history, I find it harder to do a proper job because obtaining rights has become a major concern of publishers. What has happened to the idea of “fair use”?

Martinez: The doctrine of fair use is alive and well. Generally speaking, a use of a copyrighted work will be deemed a fair use when the benefit to the public outweighs the private right of the author or copyright owner. However, it is important to remember that fair use is an exception or defense to the protections embodied in copyright law; fair use is not a right or an absolute shield that creates a general immunization against copyright suit upon invocation by a scholar. The fair use guidelines are arbitrary, they have gained what definition they possess by reason of litigation and they are not embodied in the copyright statute. The statute directs a court to examine any claim for a fair use in the following and quite general manner:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.

The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.

[Source: Title 17, United States Code, Section 107]

Heller: How can we determine what is and is not fair use?

Martinez: Fair use is founded on the concept that, under certain limited conditions, the use of a copyrighted work, without the permission of the author-rights owner, should not be actionable. The premise of fair use presupposes at least two fundamental conditions. First, that the unauthorized use will not harm the author, the author's rights or the market for the author's work. The second is that the public derives some benefit, a benefit that either enriches public knowledge or otherwise provides additional material that adds to the cultural resource pool available to the public.

The first condition, that the "fair use" by another must not harm the rights of the author, is probably the single largest factor in determining whether a use will be determined to be a true fair use. The only exception to this general prohibition will be a use of a copyrighted work in news reporting, but even then there are exceptions.

The second condition is much more elusive to define. Generally speaking with respect to a scholar's work, comment, criticism, teaching, news reporting, parody and critique are deemed to add to the cultural richness of society. Under these scenarios, the value created by the otherwise impermissible use of a copyrighted work is deemed to outweigh the property rights of the author-copyright owner, if the fair use does not destroy or significantly harm the author's rights.

Heller: Okay, so what about the problem that so many design scholars are now facing?

Martinez: The problem that you are discussing springs from the growing belief among authors and artists that any use of their copyrighted work should always be compensated. In other words, people believe that they should be paid for the use their work and they are less shy about seeking legal recourse. In a way it is a classic clash between the Wiki culture and the culture of commerce. Especially when commercial power over publishing and entertainment becomes concentrated as it has in the past 50 years.

Authors of fair-use type works want information to be free and the former acceptance of fair use as a "right" has misled scholars to believe that any claim of scholarship creates a right. Publishers and entertainment conglomerates wish to avoid the trouble and expense associated with having to respond to lawsuits. Even the mere allegation of an infringement causes problems for media companies.

Our culture has become obsessed with success and access, an obsession fed by the very entities wishing to avoid trouble. Entertainment and media conglomerates strive to be more profitable each quarter, and they are not shy about trumpeting their success. In such an environment, copyright owners, even when faced with an obvious Fair Use, are almost always suspicious and usually able to find a lawyer willing to seek compensation.

Heller: I agree that intellectual property should not be flagrantly used (or taken) to generate profit without fair compensation. But practically every book or article is part of a profit-making enterprise. Does this mean a scholar must have deep pockets to produce a scholarly work that will be sold in the marketplace?

Martinez: What scholars need is an understanding of the practical limits of Fair Use. Scholarship uses must be genuine. Uses that are not rigorous academic efforts or that are nothing more than thinly veiled attempts to trade upon another's works are more likely to draw unwanted attention. Guerrilla marketing tactics or calculated attempts to create "buzz" via dispute can be of limited utility. Publishing companies operate in an extremely competitive environment with slim profit margins. They are cautious and risk averse because they have a lot to lose. Since the doctrine of fair use provides exceptions for true scholarly uses, the issue isn't whether or not scholars must have deep pockets to publish, it's whether their publishers really want scholarly works enough to support and defend the rights of their scholar-writers.

Heller: Who owns what, anyway? The maze involved in tracking "reproduction" rights is often more like bottomless pit. If you pay a museum for reproductions, that does not insure that rights have been cleared for publishing. How can a scholar work in this context?

Martinez: Copyrighted works are owned by their authors or the owners of the rights to the works. There really are no such things as "orphan works." There may be works whose authors cannot be located or who are otherwise unknown, but that doesn't mean no one owns them. If an author wishes to let others freely use their works, they are permitted to dedicate them to the welfare of the public, and by publicly and overtly disclaiming any authorship rights. Freeware, shareware or Creative Commons licensing are all well known and function quite well as alternatives to the traditional copyright mechanisms.

Scholars trying to track down permissions can use the search facilities at the Copyright Office. While not the easiest-to-use search engine, the Copyright Office now has many of its records online at <http://www.copyright.gov/records/>.

Those wishing to engage in a more diligent search can go to <http://onlinebooks.library.upenn.edu/cce/> and the extensive records available as part of the ongoing Google Books efforts at <http://books.google.com/googlebooks/copyrightsearch.html>.

Stanford University also maintains a record of copyright renewals at <http://collections.stanford.edu/copyrightrenewals/bin/page?forward=home>. These databases could be very useful because a work that was not timely renewed may be in the public domain and free to use at will.

The University of Pennsylvania offers a similar list just for periodical publications at <http://onlinebooks.library.upenn.edu/cce/firstperiod.html>.

The internet now provides a plethora of resources for those undertaking true scholarly work. Scholarly work has never been easy, and despite the internet, true scholarly work is still difficult [to produce].

Heller: The copyright on work expires after 70 years—I suspect that is in deference to the historical nature of a work—but it is also a fairly long time. Is this fair to the scholar and scholarship?

Martinez: Actually, the copyright term is “the life of the Author, plus 70 years” or, if a work is created as a work for hire, copyright expires 95 years after the date of publication. Yes, it is a long time. The Sony Bono Term Extension Act pushed the boundaries of protection for a “limited time” that the founding fathers envisioned and provided for in the Constitution. The founding fathers never envisioned the internet or media conglomerates. If they had, the term of copyright might have been shorter and expressly defined. I cannot really say whether or not it is fair to scholars; it is what we have. To paraphrase Justice Scalia, “the Congress giveth and the Congress taketh away.” The media companies have worked the Congress hard to expand the term of copyright protection and to limit the perceived value of fair use works. If scholars want the law changed, they have the right to lobby and to petition their representatives for such changes. Change requires action, scholars wishing for change need to make it a part of the dialogue.

Heller: In the realm of commercial art, so much of what a designer did—certainly in the past—was “work for hire.” And yet, there are artists’ rights groups that claim to represent the licensing rights of long-forgotten designers who did those decades ago. How can this be navigated when researching a work on design history?

Martinez: Once again, research, research, research. The fair use doctrine provides for an exception to the rule of copyright, an exception so large that it has historically been viewed as an exception that “swallows the rule.” In the alternative, good research can show whether or not a copyright was renewed and if it wasn’t, it may have fallen into the public domain. Similar research may also tell you whether or not a copyright owner is still in business. If not, the likelihood of an objection being raised is nominal. Without undertaking some research, a scholar leaves themselves at the mercy of anyone claiming rights, including rights groups whose claims may be tenuous or self-asserted. Anything worth doing is worth doing right.

Heller: With such strictures placed on what constitutes fair use, do you foresee a time when history will be skewed, simply because a scholar cannot afford the fees?

Martinez: Fair use has been litigated extensively, its perceived limits can be predicted with some accuracy. The strictures shrink and grow in direct proportion to society’s tolerance for exploration, artistic exploration. We all know that history is written by the winners. Right now greed and the culture of fame are the winners. Will it skew history? In a word, probably but it will only be temporary. Right now scholars need to make sure they do their homework, believe in their work, build consensus and acceptance will follow. If you’ve done your research and the work is really scholarship and is one of the permitted uses, fair use will obviate the need to purchase, rights or resources.

Heller: Obviously, there are many wrongs in not obtaining rights. But what are the rights that will require the least costly effort?

Martinez: The first steps are to research the available databases and follow every lead you can find. For the most part, these efforts are almost entirely without cost. Common sense can also serve you well—using controversial, famous or newly copyrighted materials in ways that are not concordant with the fair use exceptions will almost always lead to trouble. Other prudent measures are efforts directed to building consensus with your publisher about your proposed work and its likely scope and nature. A dialogue often generates “ownership” and will reduce the likelihood of rejection, a refusal to publish or withdrawal in the event of allegations of copyright infringement despite obvious fair use on the part of a scholar.

Heller: How has free content on the web affected scholarly work? Will the objections of media companies affect scholarship?

Martinez: History will look back at the 20th century as the time when Hollywood ruled copyright law. They are not yet finished. The long-running dispute between the entertainment industry and the web is now heading towards the federal district courts and almost inevitably to the U.S. Supreme Court. The body-blow suffered by Viacom last year, losing to YouTube, is now headed to the 2nd Circuit Court of Appeals in New York City. Viacom is seeking to overturn a lower court’s finding that the “safe harbor” provisions of the Digital Millennium Copyright Act shielded YouTube from Viacom’s infringement claims.

The entire internet is a resource for scholars, and the loss of the treasure trove of visual materials on YouTube and similar sites would change or entirely erase copyrighted visual assets from the internet. When pared to its core, the issues could be defined as “who owns the internet and why does it exist?” Is it owned by us, the contributors and users of the internet, or is it owned by those whose copyrighted materials are used on the internet? There are reasonable arguments on both sides. For the scholar, the issue is whether severely restricted access to visual materials will become, per se, a prior restraint on and a compulsory review by copyright owners of a scholar’s work by media companies? For the web companies and the media conglomerates, the issue is defining rights to income from use of these materials. For scholars, the issues are deeper and they go straight to the issue of whom and what we are as a society and the culture of information and the discourse in the marketplace of ideas—there is so much to lose.

About the Author. Steven Heller, co-chair of the Designer as Author MFA and co-founder of the MFA in Design Criticism at School of Visual Arts, is the author of *Merz to Emigre and Beyond: Avant Garde Magazine Design of the Twentieth Century* (Phaidon Press), *Iron Fists: Branding the Totalitarian State* (Phaidon Press) and most recently *Design Disasters: Great Designers, Fabulous Failure, and Lessons Learned* (Allworth Press). He is also the co-author of *New Vintage Type* (Thames & Hudson), *Becoming a Digital Designer* (John Wiley & Co.), *Teaching Motion Design* (Allworth Press) and more. www.hellerbooks.com