A copyright holder whose content has been infringed on the Internet may have a cause of action against the alleged infringer and possibly against the Internet service provider under the Digital Millennium Copyright Act (“DMCA”). The following provides a brief overview of what a service provider is, the notice requirements a copyright holder must comply with when sending a takedown request under DMCA and what you can expect from the service provider once it receives the notification. The article will also provide a brief overview of recent case law and industry developments, which will impact future DMCA disputes.

**DMCA Takedown Process: A Procedural Overview**

17 U.S.C. § 512, Title II, the Online Copyright Infringement Liability Limitation Act, exempts Internet service providers from direct and indirect liability for infringement, provided the service provider complies with the requirements set forth in the statute.

*What is a Service Provider?* Service Provider is defined under § 512(k)(1)(A) as “an entity offering the transmission, routing, or providing of connections for digital online communications, between or among points specified by a user, of material of the user’s choosing, without modification to the content of the material as sent or received.” Social media platforms, such as YouTube, and search engines like Google, have been treated as service providers for purposes of the DMCA.

*(Continued on page 4)*

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**Inside This Issue**

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What career path led you to your current position (and are you a lawyer)?

During my senior year in college, I interned with the Smithsonian’s National Museum of American History. As a Philosophy and English major, law school was already on my radar at the time and the internship experience with the Smithsonian inspired me to apply for the Museum Studies program at my university while in law school to pursue a joint degree. After graduation, I was fortunate to be offered a judicial clerkship in Hawaii’s First Circuit Court. During my clerkship, I began volunteering with the Bishop Museum. As my clerkship came to an end, I accepted an offer from the Bishop Museum to come on board as an Associate General Counsel.

What is the name of your department, and where it is positioned within the organization (do you report to the GC, CEO, CIO, etc.)?

I work in the Bishop Museum’s Legal Department as part of a small team of three attorneys and two staff members. The Bishop Museum has a President and three Vice Presidents: the Vice President and General Counsel, the Vice President and CFO, and the Vice President of Institutional Advancement. I report to the Vice President and the General Counsel.

How does your legal training and experience add to the effectiveness of your current role?

With a background in both law and museums, you could say I am “bilingual.” I am able to traverse both professions seamlessly and fluently. I understand the unique needs of museums and am able to anticipate and address them. For example, when drafting an exhibition agreement, I understand that the terms governing the details of installation and de-installation are especially important not only for the safety and security of the objects, but also because any logistical obstacles encountered during installation or de-installation (such as a variation of venue floorplan or mis-specification of equipment needed) could delay the opening date or shipping schedule, both of which are material terms of such an agreement. There have been many other occasions where I provided effective counsel precisely because of my museological background. Being “bilingual” ultimately enables me to help make my museum a better place.

Who is your biggest ally in your organization and why?

Without a doubt, the visitors! Although they are not “in” my organization, they are the Museum’s lifeblood, and visitors really are the reason for all that we as museum professionals do. To me, there is no better sight at the museum than galleries full of visitors enjoying themselves, curious and engaged. Every time I see that, I’m reminded of that joyous feeling of discovery, and it inspires me to continue to do the best job I can.

What is the most interesting project you’ve worked on this year?

There have been two very interesting projects I worked on this year and both of them involved orphan works, a copyright issue that disproportionately affects museums, archives, and those in the arts. Earlier this year, I presented a 90-minute webinar on orphan works with the AAM and MALC – it was such an extraordinary experience! The second project was a pro bono matter involving a very interesting publishing project described further below.

(Continued on page 3)
Do you provide pro-bono legal services or volunteer with other legal or professional organizations? If yes, can you briefly describe some key projects and the value you derive from participating in these activities?

Absolutely! Most museums are small nonprofit organizations, and the creation of art is usually a labor of love. Generally, neither museums nor artists have the resources to procure vital legal services and many end up having to do without it. In this field, pro bono legal services really make a difference. Personally, it brings me great fulfillment to be able to contribute. Earlier I said my second interesting project this year was a pro bono matter. A few months ago, an author sought my help regarding a book project he was doing as a labor of love. The book was about a late architect, who was a close personal friend of the Author, and he wanted to include several beautiful historic black and white photos of the architect’s work but due to the passage time and other circumstances, the photos were "orphaned.” I applied my knowledge and experience in orphan works to research the provenance of the photos, and we ultimately found the rights holder and I negotiated a license for the author to use the images. My client was so thrilled to be able to complete his book with those photos and I was glad to have been part of the process.

What do you see as the next big issue/trend?

There are three big issues I see on the horizon. First, I expect society’s increasing reliance on digital experiences and communication will present some unique challenges to museums in the years to come. As media degrades, obsolete hardware fails, and file formats evolve, how will museums cope with the eventual necessity and logistical hurdles of migrating data from already obsolete platforms to platforms not even invented yet? And what will be said of authenticity when today’s “born digital” works – digital works created to be displayed on today's hardware – eventually need to be emulated on future hardware to be viewed? A glimpse of that future discussion can be found today in the gaming world, where discussion of [born digital] ‘70s and ‘80s video games revolves around whether the integrity of gameplay and artistic vision of developers is altered when those games are emulated on 21st century hardware. Second, I see the fate of archives in arena where new material is dwindling and even the archives themselves are going digital will present challenges to archivists and donors alike. Third, there is the emerging challenge of bequeathing “digital assets,” which is a new frontier in probate law that museums and archives will certainly want to keep up with.

What keeps you up at night? And why?

The ongoing loss of life and destruction of historic and culturally significant sites and objects in the Middle East keeps me up at night. A somber topic, I know. It’s a tragic loss of life, history and culture. Articles have been written about it, including in Provenance, and the U.N. recently passed a resolution condemning the continued destruction of cultural property, but I feel more needs to be done. I am heartened that the public does seem to understand the loss of life and cultural heritage that has occurred thus far is a loss to humanity, and thus a loss to every single one of us, and the sentiment that it needs to stop is almost universally shared.

What advice would you offer law students and recent law graduates interested in pursuing a career in law and the arts?

This is a very good question, because it speaks to the importance of personal fulfillment. Art law is a challenging field to gain practical experience in initially. Additionally, gaining experience as museum in-house counsel is complicated by the fact that so few museums have the budget to support in-house counsel and instead rely on pro-bono services or pay outside counsel as needed to represent their legal interests. Therefore, as with many public service law careers, you must have passion for this area of law and think creatively about how best to gain practical experience to demonstrate your interest in museums and simultaneously hone your legal skills to best service your potential clients. Read all you can about it. I invite law students and recent graduates to contact me for suggested reading. If you live in a state that has a “Lawyers for the Arts” organization, consider joining. If you are a student, intern with a museum to get exposure to the day-to-day environment and to get an idea of the legal issues they face. If you can't find a museum to intern with, intern with a nonprofit organization because you will gain exposure to similar legal issues. If you are a recent graduate and if your schedule allows, consider doing pro bono work for a museum or artists’ organization to gain valuable legal experience.
What information must be included in my takedown notice to the service provider?

§ 512(c)(3)(A) sets forth the notification elements you are required to include if you have a good faith belief your copyright protected material has been infringed. The notification must be in writing, signed, contain enough information about you or your organization to permit the service provider to contact you (i.e. telephone number, address, email, etc.) and must identify the copyrighted work as well as the infringing work in sufficient detail to allow the service provider to locate the material. The notice must also contain a statement that you or your institution have a good faith belief that the use of the material in the manner complained about is not authorized by the copyright owner, its agent or the law; that the information in the notice is accurate; and the party issuing the notice is authorized to act on behalf of the copyright owner of the exclusive right that has allegedly been infringed. No specific format required.

What are the service provider obligations once it receives my takedown notice? Once the service provider receives your properly submitted takedown notice, in order to shield itself from monetary and equitable liability for infringement, the service provider must comply with the conditions set forth in Section 512(b)(2)(e), which require it respond expeditiously to remove, or disable access to, the material that is claimed to be infringing. The service provider has a corresponding obligation under Section 512(g)(2)(A) to the subscriber accused of infringement to provide prompt notification that it has removed or disabled access to the material. This notification becomes part of the procedural process you can expect under DMCA. Policies governing the administration of this procedure may vary by service provider (for example, YouTube may have different administrative procedures than Facebook) but much of the process is typically automated and so practical variations are minimal.

Success! The infringing content was removed!...but is subsequently re-posted. What now? The takedown process does not end with your notice and the subsequent removal of the offending material by the service provider. Section 512(g) provides the accused subscriber an opportunity to counter the complaint. If a subscriber properly submits a counter notification objecting to the takedown, the service provider must provide you with a copy of the counter notification and will inform you that the material will be replaced or access restored in 10 business days. At this point, if you still feel strongly that an infringement has occurred, you may file a claim in a court of law and provide notice to the service provider.

Are there special rules for non-profit educational institutions? Yes, but only with respect to infringing activity (17 U.S.C. § 512(e)); i.e. where a non-profit educational institution is in receipt of a DMCA takedown notice. As a copyright holder or a service provider, there are no special provisions for non-profit organizations.

Recent Case Law Development: 9th Circuit Dancing Baby

In September 2015, the Court of Appeals for the Ninth Circuit rendered a decision in the ongoing Lenz v. Universal Music Corp. case involving a home video posted by the Plaintiff on YouTube featuring her two children dancing to the song, Let’s Go Crazy by Prince. The Court of Appeals determined § 512(c)(3)(A)(v), which requires inclusion of “a statement that the complaining party has a good faith believe that use of the
material in the manner complained of is not authorized by the copyright owner, its agent, or the law” (emphasis added), requires a copyright holder consider fair use before issuing a takedown notice to the service provider. The Court found that failure to do so raises a triable issue as to whether the copyright holder formed a subjective good faith belief that the complained of use was not authorized by law; thus potentially making the aforementioned statement in the takedown notice a misrepresentation under § 512(f), which could expose the copyright holder to nominal damages.

As a copyright holder, this means that prior to issuing a takedown notice to a service provider, you must consider whether the use complained of might be authorized by law, i.e. fair use. The Court did not articulate specific procedures or steps that must be taken to satisfy this requirement, but it did attempt to strike a reasonable balance, acknowledging the onslaught of infringement copyright holders face in the digital age and stating if “a copyright holder forms a subjective good faith belief the allegedly infringing material does not constitute fair use, we are in no position to dispute the copyright holder’s belief even if we would have reached the opposite conclusion...in order to comply with § 512(c)(3)(A)(v), a copyright holder’s consideration of fair use need not be searching or intensive...[and] does not required investigation of the allegedly infringing content.” However, the court warned a copyright holder would face liability if it knowingly misrepresents in the takedown notice that it had formed a good faith believe the use was not authorized by the law.

Recent Industry Development: YouTube Finding its Voice
In the wake of DMCA, service providers, such as YouTube, developed policies for the treatment of repeat offenders as well as semi-automated processes for administering DMCA takedown notifications and counter notification in order to comply with § 512 and preserve their exemption from direct and contributory liability in infringement claims. The Ninth Circuit Court of Appeals in Lenz went to some length to describe these processes. Up until recently, service providers have been performing this rote function and not much more.

Recognizing that “creators can be intimidated by the DMCA’s counter notification process and the potential for litigation that comes with it” YouTube recently announced it would step up and foot the legal bills of certain users hit with frivolous DMCA takedown notices on the popular video sharing social media platform. YouTube Will Defend Users Against Unfair DMCA Takedowns, B. Donahue, Law 360, http://www.law360.com/articles/729422, accessed 11/20/2015. The extent to which the Google-owned company will step forward is yet to be seen. YouTube noted it would only defend a few select and strategic cases that “represent clear fair uses” in the hopes that such a move will help reduce “legally unsupported DMCA takedowns” and “make a positive impact on the entire YouTube ecosystem, ensuring YouTube remains a place where creativity and expression can be rewarded.” Id.

Conclusion:
The above article is a limited overview of the DMCA takedown procedures and recent developments; it is not an in-depth discussion of DMCA or its many nuances. For further information and to consider the facts of your specific situation, please refer to the statute and consult with an attorney.
Events Recap:

**Stump the Lawyers: Legal Issues for Museums,**
Wednesday November 4, 2015, 2:15-3:15p.m.
**Moderator:** Nina Zannieri, Executive Director, Paul Revere Memorial Association

**Speakers:**
- Mark Gold, Partner, Parese Sabin Smith & Gold, LLP, Williamstown, Massachusetts
- Kevin J. Haskins, Associate, Preti Flaherty, Portland, Maine
- Katherine E. Lewis, Associate, Meister Seelig & Fein LLP, New York, New York

This year continued the popular Stump the Lawyer’s session at the annual NEMA conference and was quite well attended with approximately 56 professionals from museum executives, board members, curators, registrars, collections management and educators. The goal of the panel is to allow audience members to set the agenda and ask questions of general interest on any legal topic. The panelist response to the questions, doing their best to offer practical advice and recommend next steps. Employment law was by far the most popular topic of the session this year, with particular emphasis on American’s with Disabilities compliance. Other topics of interest included Native American Graves Protection and Repatriation Act and the myriad of intellectual property issues surrounding digitization of museum collections.

**Hey, Can I Use This Image? Navigating the World of Copyright,**
Thursday, November 5, 2015, 3:15-4:45p.m.
**Facilitator:** James Sousa, Registrar, Addison Gallery of American Art, Phillips Academy, Andover, Massachusetts

**Speakers:**
- Erin Damon, Assistant Registrar, Portland Museum of Art, Portland, Maine
- Katherine E. Lewis, Associate, Meister Seelig & Fein, LLP, New York, New York
- Anne M. Young, Manager of Rights and Reproductions, Indianapolis Museum of Art, Indianapolis, IN
- Meredith Vasta, Collections Steward, Peabody Museum of Archeology & Ethnology, Harvard University, Boston, MA

This session was also well attended with approximately 65 professionals in the audience of varying backgrounds, including registrars, exhibitions, collections, educators, development, membership and risk managers. Anne Young attended virtually by Skype, which worked out very well. The goal of the session was to use several role playing exercises to demonstrate different scenarios in the museum where the question of whether an image can be used for a particular purpose, and whether and how to go about getting the necessary permissions. Scenarios included various types of media and explored how museums have tackled some of the challenges of obtaining permissions by building relationships with copyright holders themselves, tracking copyright with their databases, and managing risk exposure.

In The News

**Art Hospital: Breathing New Life into Damaged Works**
Decades after the great Arno River flood in Florence, Italy, the community continues to feel the effects of the fateful day. In addition to the tragic loss of life, many precious artworks were damaged or destroyed. Vasari’s Last Supper, which has become “the symbol of the flood,” remained under water for 48 hours. Now, the Last Supper and other works by masters such as Botticelli, Da Vinci, and Pollack have been sent to the Opificio delle Pietre Dure, or the OPD, which has been described as “part museum, part workshop, and part hospital for threatened treasures.” The restoration team combines new technology with more historic methods and expertise. According to the article, “multispectrum scanning techniques have been used to peer beneath layers of wood,” but wood experts are necessary to analyze the various types of wood beneath the paintings. Read more here. [http://www.pbs.org/newshour/bb/decades-florences-great-flood-art-hospital-renews-still-damaged-treasures/](http://www.pbs.org/newshour/bb/decades-florences-great-flood-art-hospital-renews-still-damaged-treasures/)
Copyright Fundamentals in the Music Industry,
February 17, 2016, 7-8:30PM
Donahue Fitzgerald, LLP
Oakland, CA 94612
Presenter: Daniel Schacht, Esq.

International IP Protection for Your Art and Technology, February 24, 2016 7-8:30PM
Wells Fargo Building, 2140 Shattuck Ave, Berkley, CA 94704
Register at CA Lawyers for the Arts
MCLE credit available
Presenter: Louis Wu, Esq.

Intersections in International Cultural Heritage Law, Tuesday, March 29, 2016
Georgetown University Law Center
600 New Jersey Ave NW
Washington, DC 20001

**GET INVOLVED!**

**NEWSLETTER:** We’re accepting submissions for the Spring 2016 Newsletter! Please email submissions, suggestions for topics you would like to see covered and/or questions to Ria De las Alas, our Newsletter Editor, at redelasalas@gmail.com.

**WEBSITE:** We are looking for volunteers to help maintain our website to keep things updated and interesting! If interested contact Barron Oda at boda@hawaii.edu for more information.

**ARTS LIAISON:** A major goal of the Committee is to act as a liaison between the museum/arts community and the legal profession. If you know of national, regional or local museum/arts groups we should be contacting, send an e-mail to boda@hawaii.edu.

**SUGGESTION BOX:** We’re currently accepting suggestions for additional legal topics that would be helpful to museum audiences. Please email suggestions to katlewis864@gmail.com.

**About Us**

The Museums & The Arts Committee is part of the American Bar Association’s Section of Science & Technology Law. *Provenance* aims to provide news and thoughtful, brief discussion on legal topics relevant to museology and the arts.

http://tinyurl.com/scitechmac010

Our committee undertakes a variety of projects related to all types of museums and all types of art that are being affected by new developments. Naturally, this requires an appreciation for how those institutions and communities function in general. The Committee thus welcomes active participation from those involved in museums or the arts. In addition to attorneys and law students, membership is also open to non-attorneys who may join as Associates at:

http://tinyurl.com/scitechmac011

Current projects the Committee is exploring include authenticating artwork, collecting digital forms of art, digitization for archival and commercial purposes, and copyright issues in ownership, derivative use, and online distribution.