

U.S. Copyright Office
[Docket No. 2012-12]
Orphan Works and Mass Digitization; Request for Additional Comments

May 21, 2014

Maria A. Pallante
Register of Copyrights
U.S. Copyright Office
101 Independence Avenue S.E.
Washington, DC 20559-6000

Dear Ms. Pallante:

Thank you for the opportunity to submit comments in response to the February 10, 2014, Notice of Inquiry and the March 10-11, 2014, roundtable discussions about Orphan Works and Mass Digitization. While the University of California's February 2013 comment to the Copyright Office's earlier Notice of Inquiry concerning Orphan Works and Mass Digitization remains applicable, we appreciate the additional opportunity to highlight several key points.

No Need for Legislation in Light of Recent Legal and Technological Developments

No new legislation is needed to regulate or circumscribe the digitization, distribution, or display of orphan works either on an individual basis or in the context of mass digitization. The orphan works problem can be dealt successfully without the need for new legislation as long as fair use law remains intact and courts continue to gauge the applicability of section 107 by asking if the use is transformative and community best practices are followed.

Although neither case involved orphan works, both *Cariou v. Prince*¹ and *Authors Guild v. Hathitrust*² were decided upon principles of transformative use that are fully applicable to all fair use challenges. The court in *Cariou* stated that to qualify as a fair use, a new work generally must alter the original with "new expression, meaning, or message."³ The court in the *Hathitrust* case added that "Several courts have upheld wholesale copying of works where the use and purpose for the copies was clearly distinguishable from those of the

¹ 714 F.3d 694 (2013)

² 902 F. Supp. 2d 445 (S.D.N.Y. 2012)

³ *Cariou*, supra, at 706 (citations omitted)

original.”⁴ One example of such a use is the digital collection of AIDS posters (some of which are orphans) at the UCLA Library.⁵ The various posters were collected and made available for viewing not for their original purpose of preventing or warning people about HIV/AIDS but to show the various ways that artists and agencies worldwide chose to portray the danger and devastation of the disease. This transformative use included the added value of descriptive metadata for each separate image. The UCLA Library further protects creators of orphan works by posting notices stating that the image “may be protected by the U.S. Copyright Law (Title 17, U.S.C.). Distribution or reproduction beyond that allowed by fair use requires the written permission of the copyright owners. Responsibility for obtaining permission and for any use rests exclusively with the user” and “If you are a copyright owner of or otherwise have exclusive control over materials presently available through this collection and do not wish your materials to be available through this website, please contact the [UCLA Digital Library Program](#).”⁶

Libraries of All Types Acquire Materials Where Copyright Ownership Is Not Included and Cannot Be Identified.

Academic and research libraries, and libraries in general, acquire materials such as manuscripts, photographs, and recordings but often do not receive the copyright of the item, nor is the copyright holder always ascertainable. The donor or seller may not own the copyright and often does not know who does. Historical archival and library material such as photographs, diaries, recordings, personal papers, and architectural drawings are often unsigned and unattributed, making it impossible or nearly impossible to search for and identify the copyright holder. Further, many documents found in archive and manuscript collections were created anonymously. Ephemera and materials such as notes, flyers, or pamphlets, while often of unique research and teaching value, are also typically unsigned and therefore in most cases untraceable. Even if authorship is identifiable, it may be difficult to either locate or determine when the creators or their heirs died (if, in fact, the copyright holder had heirs), information that is necessary for determining copyright ownership. Heirs or assignees who can be located may not know the copyright status, whether the work was a work for hire and therefore subject to ownership by another, or whether copyright was legally transferred. Some copyright holders were small, independent publishers that have long since gone out of business.

More difficulties arise with works not published in the United States or published and copyrighted in more than one country, since different regions have different exceptions to exclusive rights. Works that fall into the category of traditional cultural expression are still subject to debate among copyright experts and so have uncertain status.⁷

Unfortunately, there is no single registry or list of registries that can be used to easily locate owners of non-commercial works that are protected by copyright. The Copyright Office Information Circular 22 states that “searches are not always conclusive” and further notes that particular categories of work, including archival

⁴ *Hathitrust*, supra, at 46.

⁵ See <http://digital2.library.ucla.edu/viewItem.do?ark=21198/zz0002ksb2>

⁶ Copyright Notice and Take Down. UCLA Library The Strachwitz Frontera Collection of Mexican and Mexican American Recordings. <http://frontera.library.ucla.edu/takedown.html>

⁷ See WIPO’s statement on Traditional Cultural Expressions at <http://www.wipo.int/tk/en/folklore/>

materials and collections, present additional challenges of identifying ownership. Different rules apply depending on the date of publication or creation. Works may have been registered under a different title or as part of a larger work. This lack of certainty regarding the basic question of determining copyright ownership for much historical and archival material presents a significant problem for libraries that want to take advantage of new technologies for digitization and distribution but hesitate for lack of the means to obtain permission. Too often growing segments of library and archival collections are becoming “hidden knowledge,” thus denying full scholarly and research use of unique and valuable educational resources.

Reasonably Diligent Search: Reasonableness, Flexibility, and Best Practices

There has never been, nor should there be, a one-size-fits-all approach to conducting a reasonably diligent search. This common-sense matter is recognized by the legal definition of due diligence: “a measure of prudence, activity, or assiduity, as it is properly to be expected from, and ordinarily exercised by, a reasonable and prudent person under the particular circumstance; not measured by any absolute standard but depends on the relative facts of the special case.”⁸ There is a long tradition of legal jurisprudence and reliance on the reasonable person standard as a “a certain average of conduct” and “sacrifice of individual peculiarities going beyond a certain point is necessary to general welfare” which dates back to Learned Hand and Justice Holmes⁹.

In addition, the Uniform Commercial Code (UCC) provides a framework defining good faith as a relative standard and bad faith as intentionally dishonest conduct. According to the UCC, merely not making an inquiry does not constitute bad faith unless the facts and circumstances are so obvious that to remain passive would amount to a deliberate desire to evade.

While a high level of creativity and reference experience may result in a level of relative certainty about copyright status and the location of rights holders beyond that attainable by checking multiple sources such as WATCH, VIAF, Google, FOB, COPAC, NGCOBA, LoC, and Wikipedia, such a search would be so time-consuming as to be economically unfeasible for most, if not all, libraries. On the other hand, anything less than the most thorough search might result in accusations of insufficient diligence. Where is the line to be drawn? The answer is that there shouldn't be a bright line. Academic and research libraries should be able to rely on the collective experience of those active in the profession to contribute to the drafting of codes of best practices.

The *Code of Best Practices in Fair Use for Academic and Research Libraries* states in its fourth principle that “it is fair use to create digital versions of a library’s special collections and archives and to make these versions electronically accessible in appropriate contexts.”¹⁰ The case for fair use is enhanced by the presence of commentary and metadata—the very type of added value that libraries and archives specialize in providing.

⁸ See Black’s Law Dictionary 2nd Edition <http://thelawdictionary.org/due-diligence/> See also *Perry v. Cedar Falls*, 87 Iowa, 315, 54 N. W. 225; *Dillman v. Nadelhoffer*, 1G0111. 121, 43 N. E. 378; *Hendricks v. W. U. Tel. Co.*, 120 N. C. 304, 35 S. E. 543, 78Am. St. Rep. 058; *Highland Ditch Co. v. Mumford*. 5 Colo. 330.

⁹ *Vaughn v. Menlove*, 3 Bing. (N.C.) 467, 132 Eng. Rep. 490 (Court of Common Pleas 1837).

¹⁰ Association of Research Libraries, et al., *Code of Best Practices in Fair Use for Academic and Research Libraries* (2012), 20.

As recommended by the code, and following a practice routinely adhered to by the UCLA Library and archives, all digitized large collections include a clear takedown provision, statements and examples of proper attribution wherever possible, and sensitivity to privacy issues. When the copyright status is unknown or the work is an orphan, steps are taken to decrease the quality of the image and prevent downloading.

Creators and users of all types, including libraries, have in the past restricted uses of orphan works because of the fear of violating copyright law. However, as librarians and archivists become increasingly educated about and confident in relying on fair use, new and improved access to the world's cultural heritage and the progress of new knowledge are beginning to flourish.

Procedures for and Access to Digitized Content

The University of California libraries have taken a leadership role in developing technology in support of new and innovative forms of scholarly communication and inquiry, including their use in individual and collaborative mass-digitization projects. As used here, the definition of mass digitization encompasses all forms of library digitization that are undertaken systematically for reasons fundamental to the educational, research, and public service mission for which libraries have amassed and stewarded over very long timeframes the millions of items that constitute the record of human intellectual and cultural achievement—purposes that can only be fulfilled by adopting scalable procedures that operate on the basis of collection-level judgments and best practices.

Examples include digitization for purposes of preservation, access, and discoverability; scan-on-demand services provided to individual users for personal research purposes (the digital analog of library photo duplication services allowed under Section 108); provision of access to the visually impaired; and other types of digitization routinely engaged in by libraries and archives to fulfill their missions.

Collection-level Assessment as Precursor to Digitization

In the realm of library archives and special collections, the ability to digitize entire collections and keep all of the materials of a creator or collector together both preserves the original material as intended and provides the context necessary for thorough research and complete understanding of the collection's subject matter. The interrelatedness of materials within collections conveys information about the creator or collection that goes beyond that contained in each individual object alone. Thus an entire collection, when viewed as a whole, can reveal new insights that might otherwise not be discernable—a prime example of the phrase “the whole is greater than the sum of its parts.” Digitizing only selected items and omitting orphan works misrepresents the collection as a whole as well as its individual digitized items, eviscerates valuable context, and diminishes its usefulness for most research and teaching purposes. Research and teaching at all levels – undergraduate, graduate, faculty, and external users – increasingly requires access to comprehensive collections of digitized materials, making the need to develop a commonly accepted pathway to digitizing whole collections ever more pressing.

Item-by-item Searches Are Impractical and Unreasonable in the Context of Large-scale Digitization

A diligent, item-by-item search is not a practical solution for dealing with special or archival collections containing significant numbers of orphan works. To require a separate rights search for each of hundreds or thousands of unattributed flyers, pamphlets, bumper stickers, or personal photographs, for example, would be economically unfeasible—so time-consuming and in many cases fruitless as to discourage even the most dedicated librarians and archivists. Even in those instances where an author and publisher are clearly indicated, determining the copyright status and locating the current copyright holder can pose extreme difficulties. If this were not the case, there would be no orphan works problem. Imagine, therefore, how much more difficult a search is when there is no identifying information at all.

In 2009 the Society of American Archivist issued a *Code of Best Practices* for orphan works. It states that one principle that should guide individuals undertaking diligent searches to determine the identity and location of an orphan works copyright holder is common sense. “Holdings in archival collections should be used, not left unused because of obscure ownership status.”¹¹ Quoting former U.S. Register of Copyrights, Marybeth Peters, the report advises that,

A user ought not to be required to explore meaningless steps if he has good reason to believe they will be fruitless. For example, it makes no sense to require a user to check an electronic database specializing in contemporary images of American photographers if what he is looking for is the owner of a 1930’s photograph of German origin.¹²

The impracticality of undertaking an item-by-item, reasonably diligent search for an entire large archival collection was described by Maggie Dickson in an article entitled “Due Diligence, Futile Effort: Copyright and the Digitization of the Thomas E. Watson Papers.”¹³ Dickson recounted the lengthy and expensive process of trying to identify authors, accurately pin down death dates (necessary for determining copyright status), locate and contact heirs, and request permission to use materials in a collection consisting of 7.5 linear feet of a local politician’s correspondence. A project manager and a research assistant spent more than 450 hours at a cost of approximately \$8,000; in the end, they were able to discover death dates for only slightly more than half of the correspondents. Some documents were in the public domain, some were included in other manuscript collections or repositories, and a few were excluded because no determination could be made as to whether or not they were works for hire (meaning that another person or business entity might hold the copyright). Dickson stated, “Going by a strict interpretation of copyright law, these results would allow us to make accessible online 35% of the correspondence series... Looking at the cost of our efforts in terms of the materials for which we were able to obtain permissions, our return on investment was \$2000 per document.”¹⁴

¹¹ Society of American Archivists, “Orphan Works: Statement of Best Practices.” (June 2009). <http://www2.archivists.org/sites/all/files/OrphanWorks-June2009.pdf>

¹² Marybeth Peters, “Statement of Marybeth Peters The Register of Copyrights before the Subcommittee on Courts, the Internet, and Intellectual Property, Committee on the Judiciary,” U.S. House of Reps., 110th Congress, 2nd Session, March 13, 2008.

¹³ Maggie Dickson, “Due Diligence, Futile Effort: Copyright and the Digitization of the Thomas E. Watson Papers,” *The American Archivist* (Fall/Winter 2010) 73:626-636.

¹⁴ *Ibid.*, 630, 631.

“Seeking New Landscapes” by Barbara Stratton similarly concluded that the diligent search process, when applied to large collections, was highly impractical. In her study, experienced researchers looking only at published works spent an average of four hours per book to undertake a diligent search. As she notes, “At four hours per book, it would take one researcher over 1,000 years to clear the rights in just 500,000 books—a drop in the ocean when compared to the rich collections of Europe’s cultural institutions.”¹⁵

In most cases, librarians and archivists can make a general risk/benefit assessment based on the nature of the collection and the types of items it contains (including orphan works). This assessment takes into account the desire of the donors, most of whom, like libraries, want to share with the public the resources they have donated; the presence of material in which a copyright holder is likely to have an active commercial interest; potential privacy and copyright issues; and the level of financial and legal risk to which the library could be exposed.

Fair Use Approach for Providing Access to Collection-level Assessments

Almost all academic and research libraries contain thousands of items likely to be orphan works in their collections and archives. If a library is unable to determine or locate the copyright holder of a work under copyright (or whose copyright status is undetermined), the library must either restrict access to and use of the item or apply a fair use analysis. We believe that libraries should be encouraged to do the latter.

A collection-level fair use assessment enables librarians and archivists to decide in good faith whether a group of like items can be digitized and made available, either to the public or to a more limited audience. The library or archive may also require end users to do their own fair use analysis on an item-by-item basis if the user intends to publish a particular item. Thus there may be two levels of fair use analysis conducted, one at the collection level by libraries and archives and the other by the user before employing an item for purposes other than private research. Both would utilize the four-factor test.

The first factor, purpose of the use, favors a finding of fair use for both orphan works and candidates for mass digitization, since the use by libraries is for non-profit educational purposes. The use may also be deemed transformative, since in most cases the orphaned items were created for a different purpose—for example, creating a personal scrapbook, promoting a now-defunct business or cultural event, or historical documentation such as taking minutes at a meeting—than the scholarly or educational purposes served by library digitization and access services.

The second factor, concerning the nature of the work, could go either way depending on whether the item was published and whether it can be characterized as factual or creative. However, Jennifer Urban argues that a deeper inquiry, including the orphan status of the work, should be considered. Such an inquiry “can illuminate whether copyright’s creation and dissemination goals are furthered by allowing the copyright owner full

¹⁵ Barbara Stratton, “Seeking New Landscapes: A rights clearance study in the context of mass digitization of 140 books published between 1870 and 2010,” *British Library Board* (2011).

control or instead allowing fair use....”¹⁶ If the work is likely to be an orphan and a copyright holder therefore unlikely to be found, the nature of a work may “provide insight into whether traditional copyright incentives supplied an impetus to create it, and thus whether allowing fair use would damage future incentives.”¹⁷ Following this argument, the second factor may be decided in favor of fair use if no copyright holder has made a claim on the work, nor could they likely be located were a search to be carried out, making it unlikely that the copyright holder originally created the work for economic incentives or with copyright protection in mind.

For the third factor, the amount and substantiality of the portion used in relation to the copyrighted work as a whole, the U.S. Supreme Court has stated that “the extent of the permissible copying varies with the purpose and character of the use” and the amount used should be “reasonable in relation to the purpose” for which the work is used.”¹⁸ Where the purpose of the use is education and research, it is often necessary to reproduce the entirety of the work to achieve the pedagogical or scholarly objective. This factor should therefore be considered either neutral or favoring fair use.

The final factor, effect of the use upon the potential market for or value of the copyrighted work, weighs strongly in favor of fair use. The digitization and access to collections does not supplant any market that may exist for orphan works, as it is understood that if a ready market existed, the items would not be “orphaned.” Rather, the access to the collections provided by libraries’ and archives’ digitization may be a means of unearthing and revitalizing content and collections that have long been forgotten.

This kind of collection-level fair use argument is available to research libraries in the vast majority of cases where they are considering digitization of archival and historical collections.

Remedies and Procedures Regarding Orphan Works

If a copyright holder comes forward to claim ownership of a work presumed to be an orphan, remedies such as permission fees, license agreements, and take-down should be negotiated on a case-by-case basis and in keeping with Title 17 Section 504(c)(2)(i). Any fair use arguments should also be made at this time.

Looking forward, we recommend reinstating copyright formalities to reduce the number of future orphan works. If copyright holders were required to give notice and register their work with the U.S. Copyright Office, preferably at a very minimal fee that would not discourage compliance, those with an interest in commercially exploiting their work could be readily identified. Currently, there is no single registry or list of registries that can be used to easily locate owners of typically non-commercial works that are covered under copyright, a difficulty recognized by the Copyright Office in the Information Circular 22 cited previously¹⁹.

¹⁶ Jennifer M. Urban, “How Fair Use Can Help Solve the Orphan Works Problem.” *Berkeley Technology Law Journal* 27 (2012).

¹⁷ *Ibid.*

¹⁸ *Campbell v. Acuff-Rose Music, Inc.* 510 U.S. 569, 586-87 (1994).

¹⁹ Copyright Notice and Take Down UCLA Library Strachwitz Frontera Collection of Mexican and Mexican American Music <http://frontera.library.ucla.edu/takedown.html>

Although the Berne Convention and TRIPS Agreement present a barrier to a return to the requirement of formalities, Pamela Samuelson has argued that “Treaties can be amended and should be when circumstances warrant the changes.”²⁰ A suggestion has also been made that creators who choose to disregard formalities would still be protected under copyright law but that their work would be subject to a default compulsory license similar to the Creative Commons Attribution/Share Alike license.²¹ This default license would have the effect of creating an exception to exclusivity similar to that of fair use.

Extended Collective Licensing Systems Are NOT a Solution to Problem of Orphan Works

We believe that mandating collective licensing is the wrong approach for both orphan works and mass digitization. Any system of compulsory licensing would undermine libraries’ legal entitlement to fair use. If a use is fair, then no permission or compensation should be required. There is a real and substantial risk that requiring payment of a license fee will discourage libraries from taking advantage of their fair use rights. Further, since by definition copyright holders cannot be identified or located for orphan works, there is no rightful person or entity able to accept the collected fees.

As Jonathan Band and Brandon Butler noted in an article examining collective licensing organizations operating in various countries worldwide, “Although there are a wide variety of CROs [collective rights organization] operating under divergent legal frameworks, many unfortunately share the characteristic of serving their own interests at the expense of artists and the public. ... their aggressive pursuit of revenue imposes a tax on legitimate social practices, intrudes offensively into private, non-commercial activities, and penalizes small, innovative cultural practices in favor of large, corporate ones.”²² Pointing to a specific instance of a United States collective licensing organization benefiting at the expense of creators, the authors noted that

The Copyright Clearance Center, a U.S. CRO for publishers, used the copyright license fees it collected to underwrite half the expense of litigation brought by three publishers against Georgia State University (GSU) for its electronic reserves system. After several years of litigation, the publishers were able to prove only five infringements out of ninety-nine allegedly infringing works. The court subsequently found that GSU was the “prevailing party,” and ordered the plaintiffs to pay GSU’s attorneys’ fees and costs, which totaled over \$2.8 million. Funders of the lawsuit stated publicly that they had spent millions of dollars for their own legal fees; in the end the court found only \$750 in lost licensing revenue across three representative semesters. The misguided litigation was thus an enormous waste of resources, supposedly on behalf of rights holders.²³

²⁰ Pamela Samuelson, “Too Many Copyrights?” *Communications of the ACM* 54(7)::28-31 (2011).

²¹ Justin Secor, “Restoring Balance: An Argument for the Return of Copyright Formalities.” <http://justinsecor.com/wp-content/uploads/2012/01/formalities-final.pdf> (2010).

²² Jonathan Band and Brandon Butler, “Some Cautionary Tales About Collective Licensing.” *Michigan State International Law Review*, Vol. 21:3, pp. 687-728, 689, 722 (2013)

²³ *Ibid* at 696.

In short, compulsory licensing is not the solution to the problem of orphan works. Instead, a combination of community best practices and reliance on the existing legal framework best furthers the mission of higher education and the promotion of science of useful arts.

Sincerely,

Virginia Steel
UCLA University Librarian

Cc: Kim S. Kovacs, Executive Director, Federal Relations, UCLA
Amy Blum, Senior Campus Counsel, UCLA