Sent by electronic mail to orphanworks@loc.gov

March 24, 2005

Jule L. Sigall
Associate Register for Policy & International Affairs
U.S. Copyright Office
Copyright GC/I&R
P.O. Box 70400
Southwest Station
Washington, DC 20024

Subject: Comments in Response to Orphan Works Notice of Inquiry

Dear Mr. Sigall:

By this letter, the J. Paul Getty Trust, The Metropolitan Museum of Art, and The Solomon R. Guggenheim Foundation submit comments to the Copyright Office in response to the Notice of Inquiry concerning orphan works ("NOI").[1] The Los Angeles County Museum of Art (LACMA) is filing a letter with the Copyright Office in support of these Comments. We are non-profit institutions headquartered in the United States, and we each operate one or more art museums.[2] While we submit these comments based on our experiences in art museums, we believe they have application to a wide range of museums and collecting institutions.[3] We would like to thank the Copyright Office for its leadership on this issue and for the opportunity to present our views.

The Problem

Orphan works are a frustration and a risk for our institutions. None of us can easily afford the costs of defending a copyright infringement claim, on the one hand, or the costs of handcuffing an important scholarly project, on the other hand. Art museums spend a lot of time and energy trying to locate copyright holders for rights to reproduce and distribute works in our collections and for the rights to use the important papers, photographs and letters in our archives. We are extremely cautious about using works for which we are unable to obtain rights, and while we do sometimes assume risk of a copyright infringement claim for use of an orphan work, this is done on a limited and fact-specific basis. Indeed, the number of orphan works reproduced and

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[1] See http://www.copyright.gov/fedreg/2005/70fr3739.html

[2] The J. Paul Getty Trust operates the J. Paul Getty Museum, the Getty Research Institute and Research Library, the Getty Conservation Institute, and the Getty Foundation. In addition, the Getty has a publishing division, Getty Publications, and the Getty Leadership Institute that offers programs for museum professionals. In formation since 1870, the Metropolitan Museum's collection now contains more than two million works of art from all points of the compass, ancient through modern times. The Solomon R. Guggenheim Foundation operates the Guggenheim Museum in New York City; the Peggy Guggenheim Collection in Venice, Italy; the Guggenheim Bilbao in Spain; the Deutsche Guggenheim in Berlin, Germany; and the Guggenheim Hermitage Museum in Las Vegas. The Guggenheim publishes scholarly books and catalogs on a worldwide basis under the imprint, "Guggenheim Museum."

[3] Please see the attached Appendix for background information about the purposes and mission of museums, ownership of copyrights in works in museum collections, uses of copyrighted works in museums, and copyright challenges in museums.

distributed by museums is a miniscule percentage when compared to the number of works in museum vaults and archives.

Summary of Proposal

To the extent Congress is willing to address orphan works, we believe it is best to do so not in the remedies section of the Copyright Act but in its exemptions. Exemptions give users comfort and the ability to make major, institutional decisions about projects and budgets. Museums and other non-profits, even those without counsel, are very much aware of the exemptions that apply to them and conduct business accordingly. We are aware that some others (including those of organizations whose interests are closely allied with our own) propose a solution focused on remedies, *i.e.,* reduced damages. While we appreciate the intent of these proposals, which is to provide much needed relief to users, we do not believe a damages fix provides enough relief or incentive for museums. Most museums and non-profits are fearful of any monetary risk whatsoever, regardless of the amount. If a goal is to get important cultural material out of storage and available to the public, then a reduction in damages will not be effective enough.

We note, for example, that non-profits already have some flexibility through the remedies provisions of the Copyright Act. First, actual damages are not usually a reality against museums (See 17 U.S.C. §504(b)). Second, statutory damages often are not available to the claimant (See 17 U.S.C. §412). And third, reduced awards are already possible for non-profits (See 17 U.S.C. §504(c)). These sections already function as a sort of practical safe harbor for museums. But the protection is incomplete. And while these sections are a comfort of last resort, they are used infrequently and only then for isolated works. When it comes to publishing entire archive collections of photographs, letters and related materials – projects that are of great interest to our audiences – most museums do not take significant risks. The majority of our orphan works, therefore, are not disseminated.

We believe there is room to move the law forward and we are hopeful that a solution will emerge that is fair to both copyright owners and copyright users. We note, with pride, that the United States is already accomplished in its balance of competing interests; our copyright law has managed to ensure the rights of owners even while providing user-exemptions and affirmative defenses that do not exist in the laws of other countries.

In this spirit, we submit to you a proposal that we believe is compatible with existing U.S. copyright law and international treaties. The proposal suggests:

1) A reasonable standard of due diligence for locating copyright owners;
2) A temporary safe-harbor exemption from liability and damages; and
3) A system for identifying and publicizing orphaned works once they are used.

Art Museums, Copyright and Orphan Works

As a general rule, art museums do not own the copyrights to the artworks or objects in their collections including the many drawings, renderings, notes, photographs, private letters or

other documents in their libraries and archives.[4] Yet, in the course of ordinary business, our institutions must reproduce and use copyrighted works on a daily basis in formats that span print, 3-dimensional replicas, and digital media. These copies are used in our exhibitions and other educational programming; in gallery design and on-site ephemera; in educational brochures; in marketing and press materials; in catalogs, journals and other scholarly publications; on our websites; for research and reproduction services; and in our museum stores.[5] Such uses are integral and essential to our educational missions.[6]

It is also important to note that while fair use and other exemptions are valued by art museums, they are of limited application. Historically, copying by museums was minimal and undertaken primarily within the four walls of museum buildings. Fair use provided an obvious defense and reassuring safety net. Times have changed. Many museums today are part of a global educational network. Art collections are digitized and available in large formats on websites. Exhibitions travel the globe and are reproduced in whole or in part in virtual form. Many catalogs feature large color images, are translated into multiple languages, and distributed throughout the world. Museum stores, in an effort to be relevant and to raise funds for museum operations, operate Internet shops and ship products, including reproductions of art, beyond museum premises. Photography departments provide high-resolution reproductions of artworks and objects to our educators, who have come to expect this high quality. There is pressure to make digital images of both collection works and archive and library materials available on-line. Simply put, both educators and more general audiences (who are located throughout the world) expect museums to embrace the potential of the Internet. Many museums would be glad to do so, but cannot go forward without the permission of copyright owners.

Unfortunately, where rights clearance may be necessary, it is not always possible. Many artworks have unclear facts about authorship, country of origin, date of creation, publication, and copyright duration and, therefore, copyright ownership. Many protected works have changed hands frequently and lost identifying information during wartime, particularly when located in countries under Nazi occupation. Much of our important archival materials, including photographs and letters, lack even the most basic contact information.[7] In the instances where we cannot locate an owner, we must weigh the desire to make culturally important materials available to the public (in fulfillment of our missions) against the risk and cost of copyright infringement.[8] This is particularly frustrating with respect to artworks and archival materials whose copyrights would have expired by now, or very soon, but are instead in a 20-year protection period by virtue of the 1998 Sonny Bono Copyright Term Extension Act.

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[4] See Section 2 of the attached Appendix.

[5] Sometimes the copyrighted works are in the museum's collection, in which case, the museum does not need to acquire the physical materials from which to make the copy such as a slide transparency or digital file; and sometimes the copyrighted works are owned by other institutions and individuals. In the latter situation, the museum will need to locate and purchase the physical materials from which to make the copy.

[6] See Sections 3 and 4 of the attached Appendix.

[7] The Research Library at the Getty Research Institute has a Photo Study Collection with over 2 million images, most of which have no copyright notice or other identifying information.

[8] For a detailed explanation of ownership of works in museum collections and copyright challenges in museums, see Sections 2 and 4 of the attached Appendix.

The Proposed Solution[9]

As stated above, in our view, a new exemption would allow users of orphan works a meaningful period of time in which to exercise the activities in 17 U.S.C. §106 of the Copyright Act without any attachment of liability or damages and without the formality and cost of a compulsory license.

Definition of Orphan Work: The definition of orphan work should be narrowly drafted to ensure that the legitimate copyright owner is truly not available and that users have undertaken an acceptable level of due diligence before giving up their search. To make a real impact, the definition must also cover both published and unpublished works. Museums are institutions of scholarship and work often with original, unpublished materials. These materials are potentially of great value to the public, but for the fact that they are not often copied or disseminated for fear of copyright implications. Moreover, the act of discerning whether a work has been published is often an impossibly challenging, fact-specific investigation that leads to no clear answer, particularly where publication appears to have taken place abroad. In the case of visual art, the act of publication requires something other than exhibition or public display, such as an authorized newspaper photograph or, in early days, a newspaper sketch.[10] As a practical matter, publication records do not often accompany the works that ultimately make their way into our possession.[11]

As an initial thought, it seemed reasonable to say that a work that is publicly registered with the U.S. Copyright Office cannot be orphaned, but not all Office records are searchable electronically or even easily and not all transfers of copyright are recorded. (Searching records on-site at the Copyright Office is costly and time-consuming, particularly for users who are located outside of Washington, D.C.) Moreover, the nature of archival material is such that often there is not sufficient information on which to base a search, including missing facts about authorship, dates of creation, and publication. We, therefore, conclude that registration can be one factor in assessing reasonable due diligence, but cannot alone be dispositive.

Safe-Harbor, Exemption-Based Solution: We recommend a safe-harbor period that allows only for non-exclusive use and runs in increments of five years from first publication of the user's work, with additional five-year increments available in succession if no owner appears. The safe-harbor period is long enough for a user to make valid business judgments and proceed with confidence, but short enough to give newly-arrived owners a date-certain from which to negotiate further use. If all safe-harbor uses are on a non-exclusive basis only, the owner will, of course, be able to exploit the work during the safe-harbor period or license it to others. These limitations should ensure that the rights of authors under existing law (particularly Article 13 of TRIPS and Section 9(2) of the Berne Convention) are not unduly prejudiced.

One advantage of this approach is the renewed attention orphan works will receive. A clear exemption would ignite new interest in works that are culturally important but long since

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[9] Additional information and details of this proposed solution are set forth in Section 5 of the Appendix.

[10] See 17 U.S.C. §101.

[11] For more information on this important issue, we note the submission of the College Art Association, Subsection "Nature of Orphan Works: Publication Status.")

forgotten by, or previously unknown to, the public. Moreover, while our proposal is innovative in some respects, it is not without precedent. It borrows elements from three relatively recent amendments to the Copyright Act: the concept of the good faith reliance party under 17 U.S.C. §104(A); the agent (take-down) notification process of the Digital Millennium Copyright Action ("DMCA") under 17 U.S.C. §512(c); and the limited freedom to copy certain works in the last 20 years of protection that is allowed currently under 17 U.S.C. §108(h)-(i).

We also believe that, far from harming the rights of copyright owners, our exemption-based proposal will ultimately serve to help them. It is quite likely that lost owners will connect with interested users and engage in mutually beneficial commerce – either after the initial safe-harbor period (with respect to the original user), or during the safe-harbor period (with respect to subsequent users who also have an interest in the work).

Due Diligence: It is fundamentally important to museums that statutorily prescribed due diligence not be more burdensome than the practices currently employed by conscientious users. In this regard, reasonable due diligence would differ from industry to industry, and particularly from for-profit to non-profit institutions, and there will be differences in reasonableness based on the specific facts and circumstances of the use. We believe that the legislative history and regulations relating to orphan works could state examples of reasonable due diligence based on certain hypothetical situations. In short, the level of required due diligence should be a reasonableness standard based on efforts recognized and practiced routinely by respective industries taking into account the facts and circumstances of use.[12]

Identification of Orphan Works: We suggest that users could identify the orphan work (when used) in ways that indicate no owner was found, perhaps through an "Orphaned Work" copyright notice on reproductions (*e.g.*,"(OW)"), or a narrative statement (*e.g.* "*The following are Orphan Works:…*"), and/or in a database listing maintained by a private entity or the Copyright Office (the "Copyright Orphanage"). Such notices and database listing do not need to be mandatory prerequisites for use of the orphan work, but they could be evidence of the user's good faith and they should be taken into account when evaluating the user's reasonable due diligence efforts. By contrast, a model that forced the user to put out advance notices or inquiries (prior to actual use) would make planning difficult, would create the potential for illegitimate "owners" to corrupt the system, and would give users a required step of activity that we do not now have when making a decision. A concurrent or post-use notice process for users is not unfamiliar to our system and has recent precedent in the DMCA agent notification requirement.

Issues of Dispute: Under our proposed solution, disputes about whether a work is orphaned would turn not on the question of whether a copyright holder ultimately exists, but rather on the defense of whether the user properly complied with the standards of due diligence to find him or her. If a user identifies the work as orphaned, through the notices and/or database listings described above, a rebuttable presumption could exist in the user's favor, provided,

[12] We support, for example, the general approach to due diligence that is outlined in the Copyright Clearance Initiative ("CCI") proposal submitted to the Copyright Office by the Glushko-Samuelson Intellectual Property Law Clinic.

however, that the use of these identifications is available only to those who first comply with the requisite combination of statutory and industry-specific due diligence. It should be noted that while such notices and listings are indeed legal formalities, they are formalities imposed on the user, not the owner, and do not, therefore, violate TRIPS or the Berne Convention. These acts, which would serve both the public and lost copyright owners, seem a fair exchange for the benefit of the proposed exemption.

Rights of Legitimate Copyright Owners: Should legitimate copyright owners come forward, there should be a moratorium on new use (*i.e.*, new projects) unless permission is obtained from the owner. However, there should be no immediate requirement to stop using the work in completed projects prior to expiration of the prescribed safe-harbor period, provided the user complies with due diligence standards. An owner would always have the right to bring legal action, but, again, under this proposal the action would be limited to whether the standards of due diligence were met. This would not be unlike the analysis undertaken for fair use and other exemptions. Following expiration of the safe-harbor period, the owner would be free to engage in market negotiations. Again, there is some precedent for a reliance procedure such as this, in particular the process of continued use available to some parties under copyright restoration.

No Compulsory License: Finally, a solution that forces users to apply for a compulsory license is not satisfactory. It would give museums more costs and, therefore, it would be an additional obstacle to our educational activities. In addition, a compulsory license could add more potential exposure than we face now when publishing orphaned works. This would be particularly true if users choose not to apply for the compulsory license because the use might also be a fair use or otherwise permitted under a statutory exemption, but the law establishes a rigid level of liability for the decision not to apply.

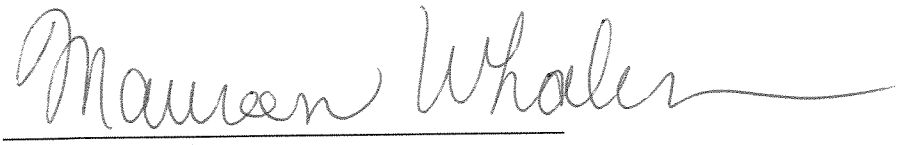
Conclusion

While the term "orphan works" is being used to describe a particular group of copyrighted works, one could say the "orphan" works in museums are not really orphans. By definition an orphan is "one deprived of some protection or advantage."[13] Art museums are guardians and stewards. We protect and preserve thousands of orphan works at our own cost, but lack the legal means to use, reproduce or distribute copies of these works, including, providing access to the works via the World Wide Web.

We have offered a solution that allows, even encourages, people and institutions to use orphan works and we believe this approach protects the rights of copyright holders. We know that allowing use of orphan works would be an important contribution to society. We hope that a solution can be realized.

[13] Merriam Webster's Collegiate® Dictionary, Tenth Edition, ©1995, Merriam-Webster, Incorporated.

Signature Page



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APPENDIX

COMMENTS IN RESPONSE TO ORPHAN WORKS NOTICE OF INQUIRY Submitted by the J. Paul Getty Trust, The Metropolitan Museum of Art, and The Solomon R. Guggenheim Foundation

Section 1. Purposes and Missions of Museums

The International Council of Museums (ICOM) defines a museum as "a non-profit making, permanent institution in the service of society and of its development, and open to the public, which acquires, conserves, researches, communicates and exhibits, for purposes of study, education and enjoyment, material evidence of people and their environment."[14] The American Association of Museums (AAM) in its Code of Ethics for Museums states that museums make a "unique contribution to the public by collecting, preserving, and interpreting the things of this world." Museums, whether they are operated and funded privately or by federal, state, or local governments, or a combination thereof, serve the public as "centers of learning, civic institutions, and protectors of our artistic, historic, scientific and cultural heritage."[15]

Some specific examples of institutional mission statements:

- The J. Paul Getty Trust is an international cultural and philanthropic organization serving both general audiences and specialized professionals. Educational in purpose and character, the Getty focuses on the visual arts in all of their dimensions and their capacity to strengthen and inspire aesthetic and humanistic values. The Getty makes a difference by weaving together the presentation, enjoyment, study, and conservation of the visual arts in order to increase the public's knowledge and sensitivity, expand its awareness and creativity, sharpen its understanding and caring – all with the conviction that cultural enlightenment and community involvement in the arts can help lead to a more civil society.[16]

- The mission of The Metropolitan Museum of Art is to collect, preserve, study, exhibit, and stimulate appreciation for and advance knowledge of works of art that collectively represent the broadest spectrum of human achievement at the highest level of quality, all in the service of the public and in accordance with the highest professional standards.

- The mission of The Solomon R. Guggenheim Foundation is to promote the understanding and appreciation of art, architecture, and other manifestations of modern and contemporary visual culture; to collect, preserve and research art

[14] The ICOM definition of museums has evolved over time. For more information on the definition and how it has changed see http://icom.museum/definition.html
[15] http://www.aam-us.org/aboutmuseums/publicinterest.cfm
[16] The J. Paul Getty Trust 2002 – 2003 Report

> objects; and to make them accessible to scholars and an increasingly diverse audience through its network of museums, programs, educational initiatives, and publications.[17]

There are approximately 15,500 to 16,000 museums in the United States.[18] In 2003, U.S. museums attracted well over 600 million visitors.[19] Whether they are interested in art, science, nature, technology, animals, plants, or history, or any facet or combination thereof, people from all walks of life, from diverse backgrounds, and from around the country and throughout the world, visit American museums.

American museums collect, preserve, and exhibit. Their collections are unique and diverse. For example, the Guggenheim's collection features artworks from the late 19th to early 21st century, including paintings, sculpture, photographs, video and other mixed media installations. The J. Paul Getty Trust operates both the J. Paul Getty Museum with its collections of antiquities, photography, European paintings and sculptures, drawings, illuminated manuscripts, and decorative arts, and the Getty Research Institute, including the Research Library, with its extensive special collections of archives relating to the visual arts.

Section 2. Ownership of Copyrights in Works in Museum Collections, Archives and Libraries[20]

As stated previously, museums along with their archive and library counterparts collect, preserve, and exhibit. Through their collecting activities, museums seek to find the best examples of people and their environments.[21] Sometimes those objects and artifacts are acquired along with their intellectual property rights. Frequently, however, only the object is offered for sale or donated to the museum's collection.[22] Someone else, who may or may not be known, owns the intellectual property rights, including the copyright, in the object. If the seller or donor of the work does NOT own the copyright, that person cannot transfer it to the museum at the time of the transfer of the object, and the museum will have to find the copyright holder and seek the rights to reproduce and distribute copies of the work.

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[17] Adopted December 2004.

[18] According to AAM, there have been two attempts in recent years to count the number of museums in the U.S. In 1998, the National Conference of State Museum Associations identified 15,848; in 2003, the Institute of Museum & Library Services (IMLS) identified 15,460 museums. See http://www.aam-us.org/aboutmuseums/abc.cfm

[19] Museum Financial Information 2003, American Association of Museums, http://www.aam-us.org/bookstore/detail.cfm?id=495

[20] Museum collections include the museum archives and library materials. For ease of reading, however, this inclusive reference is not repeated throughout these Comments.

[21] Art museum collections include the objects exhibited in the galleries and archives of photographs, letters, and artifacts as well as library materials. The latter may be exhibited less frequently, but they are used extensively by curators, art historians, scholars and educators, in addition to members of the general public.

[22] Ownership of copyright is distinct from ownership of the material object and the transfer of the material object does not transfer copyright; similarly, transfer of ownership of a copyright or of any exclusive rights under a copyright, does not transfer ownership of the material object. Section 202 of the Copyright Act.

For new acquisitions, museums seek to obtain information about copyright from sellers and donors at the time of the transaction. Many standard forms of purchase and sale agreements and deeds of gift include language whereby the seller or donor transfers to the museum whatever intellectual property rights s/he may have in the object *i.e.*, a quitclaim. A quitclaim, however, does not transfer rights the seller or donor does not have. Furthermore, collectors who built their collections over many years and from many different sources and who are now offering their collections to museums, may themselves have little or no information about the copyright.

Frequently, the collector will donate or sell his or her entire collection of materials, including, without limitation, photographs taken by others, letters written to and received from others, business documents, diaries, periodicals, brochures, posters, postcards, books, and works of art – published and unpublished materials. Making unpublished material available creates an additional layer of complexity for museums because it is rarely clear whether the author intended publication before the term of copyright expires. In order to help museums use orphan works, we feel that the solution should extend to unpublished works.

The unpublished material is where many copyright problems exist. Obviously, museums will not publish materials where the author has expressed his or her clear intent that they should not be published. Nor will museums try to "scoop" an author by publishing materials against his/her will. Rarely, however, are the directives for access and publication explicit, especially in older acquisitions. In the absence of clear guidance, museums have to make decisions about access and publication. We do not believe that there should be read into these questions a presumption that the author did NOT intend publication simply because the materials were not published. For example, consider a collection of unpublished letters or private photos donated in the first half of the 20th century by the authors/collectors who are now dead. There is no documentation about how the materials are to be used. We assume, today, that the authors wanted us to preserve the materials – which the museum has been doing at its cost for years – and to use the material according to the museum's mission, which includes publication. There could be copyright heirs out there somewhere, although the museum doesn't know who they are or where they are. In many instances, the museum may not have even the basic information from which to start a search. In the absence of an exemption in the copyright law, we are left with a defense of implied contract [for publication], which applies only in the case where the donor/seller was the copyright holder, and which even then is not usually enough to justify the expenditure of monies for publication costs. Unpublished materials need to be included in the definition of orphan works.

For objects already in museums' collections, the copyright information may not be easily obtained. While for certain types of works, such as unique and famous paintings, there may be a relatively straightforward copyright ownership history; for other works such as photographs, sound recordings, letters, audiovisual works, manuscripts, maps, prints, drawings, and out-of-print books, information about copyright ownership and/or the whereabouts of the copyright holder identified on the work, is frequently lost long before the copyright term has expired.

Further complicating the question of copyright ownership for museums is the application of the 1909 Copyright Act and common law copyrights. Legal questions arose as to whether the

copyright transferred when a work protected by common law copyright was transferred and the transfer documents were silent about copyright. Many of these common law copyrighted works were unpublished works (as defined by the copyright law). State law governs common law copyrights and, therefore, whether the common law copyright transferred along with the object or remained with the author varied state-by-state. Federal copyright law clearly requires a written document for the transfer of statutory copyrights.[23]

In 1942, the New York Supreme Court heard the leading case on the question of whether the common law copyright transferred along with the transfer of the object.[24] From the Pushman case, the rule evolved that absent a written statement in the transfer documents to the contrary, the common law copyright was also transferred along with the absolute and unconditional transfer of a material object. As a result of dissatisfaction with this ruling (it was seen as unfair to authors), in 1966, New York passed a statute overturning the Pushman decision; California passed a similar law in 1976.[25] Between the passage of the 1976 Copyright Act and the state laws overturning the Pushman decision, it became eminently clear that if copyrights were to be transferred, they needed to be transferred specifically and in writing. Most museums do not have such documents in their files.

Museums that do not acquire the copyrights for the works in their collections may seek to obtain a license from the copyright holder. The scope of the license will vary from a narrow, case-by-case use for, for example, an exhibition poster, to broad commercial and non-commercial rights for various uses, including web distribution. The licenses may also include the right to sublicense reproduction and distribution rights to others. Of course, in order to obtain such a license, the museum needs to be able to identify the correct copyright holder and find that person or entity.

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[23] Section 204 of the Copyright Act; see Section 28 of the 1909 Copyright Act

[24] Pushman v. New York Graphic Society, Inc., 287 N.Y. 302 (1942)

[25] See Nimmer on Copyright, **3**:10.09[B]. © 2004 Mathew Bender & Company, Incorporated

Section 3. Uses of Copyrighted Works in Museums

Museums exhibit their collections and no copyright permission is needed to do so.[26] But exhibiting collections is only one part of a museum's regular activities. Copyrighted works are used in exhibition brochures and catalogs, gallery design and on-site ephemera, books and journals, advertising and press materials, merchandise, other educational materials, and the museum's web site.[27] These uses are not optional; they are integral and essential to museums' missions.

In addition to educational programs for students at all levels, and conservation programs spanning all forms of preservation from paintings to historic buildings and monuments, American museums expand their physical reach to general audiences and specialized professionals through publishing activities and web sites. Book and journal publishing have long been a part of museum activities. Depending on the subject matter, the book or journal may have a small print run of 500 to 1,000 copies, or a large print run of 10,000 copies or more for an exhibition catalog. The use of materials provided online also varies widely. It is not uncommon for online visits to be an order of magnitude larger than visits to the physical museum, and in some cases, online visits can be even much greater.[28]

Museums create and sell merchandise using the works in their collections. Of course, one of the reasons for these activities is to generate income for the museum. Equally, if not more, important, reproducing images from the museum's collection gives us the opportunity to allow the visitor to take away not only the visual experience of the beauty of the object, but by printing accompanying text that describes the art and gives pertinent information about the artist, historical context, medium, and country of origin, we give visitors a valuable educational resource.

Reproduction services also are a significant activity for museums, particularly, art museums. The Mellon Foundation recently commissioned a study of rights and reproduction activities in American art museums.[29] The results indicate that art museums provide rights and reproductions services for a number of reasons; the most important is to serve the public and

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[26] Section 109(c) of the Copyright Act.

[27] Sometimes the copyrighted works are in the museum's collection, in which case, the museum does not need to acquire from an outside source the physical materials from which to make the copy – a slide transparency or digital file. The museum creates the slide or digital file from the original work at its own cost and expense and invests its time and money in creating a resource. Where others own the copyrighted works, the museum will need to obtain, and most likely purchase, the copy for use in the project. But, even that other institution may not have copyright information and will not grant reproduction rights.

[28] The J. Paul Getty Trust, the Metropolitan Museum (NY), and the Newark Museum reported high numbers of online visitors; for example, the Getty has approximately 1 million web site visitors per month compared to approximately 1.3 million visitors to the Getty Center per year. The Art Institute of Chicago and the Norman Rockwell Museum reported even greater multiples of online visitors over physical site visitors. Museum Technology Survey conducted in November 2004 by the J. Paul Getty Trust with assistance from the American Association of Museum Directors (AAMD). Unpublished survey results are available to participants.

[29] Reproduction charging models & rights policy for digital images in American art museums, A Mellon Foundation study, Simon Tanner, King's Digital Consultancy Services, August 2004. See http://www.kcl.ac.uk/kdcs/USart.htm

educational use, a key part of each museum's mission.[30] Contrary to what most people think, rights and reproduction services provided by art museums do NOT, for the vast majority of museums, generate profits; indeed, they usually result in a loss of revenue.[31] Furthermore, one of the high costs of providing these services is the constant need to maintain up-to-date copyright information and to ensure that the museums' rights and reproduction requests are consistent with its rights to make and use copies of the objects and to protect the rights others have in these objects.

Section 4. Copyright Challenges for Museums

The Search

When the museum determines that permission is needed for the use, it begins the process of trying to find the copyright owner. For example, as part of the search for the copyright holder, it is important to ask certain questions: When was the work created? Who created it? Is the work published or unpublished? Once some of the basic information about the work itself has been gathered, the search for the copyright owner can begin. Certainly, the Library of Congress copyright files should be searched to determine if the copyright was registered, if it was renewed (if required), and if there were subsequent transfers properly recorded.[32] A web search should also be conducted as well as a search of files in the museum and/or the library. A close examination of the work itself needs to take place in order to determine if there are any markings on it or a copyright notice. If the artist is known, does a licensing society represent that artist, and is the copyright for this particular work likely to have been owned by the artist or transferred to another entity? If someone claims copyright, is this a reasonable claim? What is the claimed ownership interest?

If, despite searching, the museum cannot identify or find the copyright holder, the museum has to either change its plans for using the work or accept the risks of a copyright infringement claim if it does use the work.[33] While the same situation exists for all users of copyrighted materials, the search can be especially complicated, confusing and frustrating for non-profit institutions without the resources – money and lawyers – to undertake the in-depth searching and legal analysis needed to protect the institution.

Here are some stories of our activities.

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[30] See Mellon Foundation Study, pages 16-19.

[31] See Mellon Foundation Study, pages 16-19.

[32] One of the more frustrating problems confronted in copyright searches is the situation in which the copyright notice is clearly on the work and there is a registration file, but that person or entity who is listed has long transferred the copyright, gone out of business and sold the copyright assets, perhaps more than once, or simply is not locatable. Furthermore, only post-1978 registrations are online. It is difficult and expensive to search the Copyright Office's registration files that are not online, and many museums are unable to conduct or pay for card catalog searches. Therefore, registration of the copyright and a proper copyright notice on the work should not trigger liability for use of an orphan work.

[33] Museums already use orphan works under fair use exemption in Section 107 of the Copyright Act. It is important to note that nothing contained herein should be interpreted as limiting or in any way changing fair use.

Guggenheim Museum: The Guggenheim Museum staff periodically publishes photographs of artworks, installations and individuals for whom no photographer is known. These works are viewed as essential to the scholarship of the book or other project. The Guggenheim's staff includes four in-house lawyers, several of whom are familiar with copyright law, who undertake a legal analysis in such circumstances. The analysis includes the likelihood of our exposure to monetary damages; including whether an unknown claimant would be entitled to statutory damages under 17 U.S.C. §412.

In instances where we do proceed without permission (and assuming our use is not "fair use" under 17 U.S.C. §107), we generally include a narrative credit line designed to reduce any harm to the copyright owner: "Many of the works reproduced in this book are protected by copyright law and may not be available for further use without express permission of the author or other copyright holder." We also agree in advance on an appropriate, fact-specific response in the event that an owner does appear. The response may be of a legal or political nature, and may be either conciliatory or defensive, depending on our perceived view of the legitimacy of the claim and any rights we believe we may have under the law. We note here, that in the art world, the line of ownership is sometimes unclear and impossible to resolve to a level of absolute certainty. We often interact with heirs, who may or may not be the copyright owner, and who may or may not have multiple, unknown co-owners. Thus, our response in any given situation will be dictated by the totality of the circumstances.

Still, these examples illustrate a very narrow approach that we utilize only as a last resort and only in the case of isolated orphan works – as in our use of one photograph in a catalog. The approach is in no way applicable to a full scale project that would involve large numbers of orphan works, such as digitizing and/or publishing a collection of photographs or important letters. There is funding available for these sorts of projects, but we do not undertake them; the potential copyright risk is too great.

The J. Paul Getty Trust: In the spring of 2002, the J. Paul Getty Museum mounted a photography exhibition entitled *Railroad Vision*. As part of the exhibition, Getty Publications, the publishing group of the J. Paul Getty Trust, published a book of photographs also entitled *Railroad Vision*. Despite extensive efforts to identify and/or locate all of the copyright holders of the images in the book, Getty Publications had to make some decisions about using certain photographs because of questions of copyright ownership. In the end, Getty Publications opted to include all of the images selected by the author and included the following note on the Photography Credits and Copyright page: "Every effort has been made to contact photographers whose work may still be in copyright, or their estates. Any one having further information concerning copyright holders should contact the publisher so that this information can be included in future printings." There have been no claims of copyright ownership or infringement raised with the publisher. The book is still available.

Another recent instance in which decisions about copyright had to be made involved the Getty Museum's 2004 photography exhibition entitled *Close to Home: An American Album*. As in the case of *Railroad Vision*, there was a book published as part of the exhibition. *Close to*

Home was an exhibition of snapshot photographs collected from various sources; the photographers and their subjects were almost all unknown. There was no way the Getty could have identified or located the photographers and obtained their permission. Rather than forgo the book, Getty Publications went forward with the book and has not received any claims of copyright ownership.

Both of the above book publishing activities involved orphan works. Both were well received critically by scholars, and by the public. No claims of copyright ownership were raised. The Getty has in-house counsel that handles intellectual property issues. As a result of legal analysis, the Getty was prepared to take some risks in proceeding with these exhibition-related book projects. Other museums could very well choose to abandon similar projects (or not consider them at all) due to copyright infringement concerns.

Notwithstanding the above examples of uses of orphan works that were conducted without liability and resulted in critical and popular acclaim, there are a number of situations at the Getty where uses of orphan works were not approved. As a general practice, the Getty does not include works on its website where it reasonably believes there is a copyright claimant, unless permission has been obtained or a statutory exemption such as fair use applies. The Ninth Circuit held in the Kelly v. Arriba Soft Corp. case[34] that the use of thumbnail images on a website was a fair use. Initially, this decision, while fact specific, was thought to offer more opportunities to include copyrighted works on websites. Unfortunately, the lack of a legal definition of a "thumbnail" and the fact that many times the "thumbnail" does not provide sufficient resolution and detail to make the posting productive, have raised additional questions – rather than resolving them – about making orphan works accessible via the Web.

The Research Library at the Getty Research Institute receives frequent questions about orphan works. Scholars and educators ask the Research Library for help in finding the copyright owner in order to seek permission to reproduce images and text from works in the library's vast Special Collections (includes many archives of artists, living and deceased, the Photo Study Collection with over 2 million images, as well as rare periodicals published post-1923.[35]) Patrons also ask for reproduction permission from the library. While the librarians try to help and will provide as much information as we have in the files, we do not conduct comprehensive copyright research for patrons. There are many specific situations in which the scholar or educator had to forego providing the image for an article or website because the copyright owner could not be identified or found.[36]

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[34] 336 F.3d 811 (2003)

[35] In the case of post-1923 publications, the Research Library has encountered publishers who are still in business but who have merged or have been subsumed by another publisher who claims not to hold the copyright in a particular published work. There are also many photographs in the photographic archive that are credited to commercial photographic firms that are no longer reachable.

[36] There is also the time factor. Frequently, scholars and educators are seeking an image in order to add to a journal article. Publishing deadlines generally do not provide enough time to allow for the time-consuming process of trying to identify the copyright owner and locating that individual or entity to seek permission. As a result, the image is not included in the article.

The Risk Analysis

Under current law, when copyright information is not available and permission for use cannot be secured, there is risk. The level of risk tolerance for possible copyright infringement claims varies museum-by-museum, and can even vary between and among departments or programs within the same institution. Risk assessment involves more than money damages. Frequently, statutory damages and attorneys' fees, as provided under Sections 504 and 505 of the Act, may not be available to the copyright claimant because the work was not registered with the Copyright Office before the infringing action commenced.[37] Actual damages and profits may not be available because use of the work by the museum did not cause damages or generate profits. Even if monetary damages are not likely, if a copyright holder emerges and the museum and the copyright holder cannot come to an agreement about the continued use of the work, the museum has no choice but to cease the use. Since money and resources are scarce, the possible outcome of having to stop using the work and destroying the materials are significant deterrents to keep people from using the work.[38] One could say that the risk of a cease and desist and/or money damages have a chilling effect on expressions that include orphan works. Such a result is time and money wasted – time and money that could have been spent on activities that would not end so abruptly and with so little benefit. Additionally, museums shy away from use of copyrighted works without permission because they support artists and authors, and they do not want to engage in activities that are contrary to law.

Museums try to do the right thing – comply with law and respect the rights of artists and authors. In 1999, the American Association of Museums published A Museum Guide to Copyright and Trademark.[39] This publication offers museum professionals information about intellectual property law using real life scenarios of copyright questions encountered by museums. In addition, every year for the past 30 years, the American Law Institute-American Bar Association Committee on Continuing Professional Education (ALI-ABA) cosponsors with The Smithsonian Institution and the cooperation of the American Association of Museums a course of study on the Legal Problems of Museum Administration.[40] This program is well attended by museum professionals, including board members, and there are always presentations about intellectual property law. Frequent questions in the copyright law sessions are:

- Do I need permission to use the work?[41]
- If so, how do I identify and find a copyright owner?

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[37] Sections 411 and 412 of the Copyright Act.

[38] It has often been said that it is easy to remove materials from websites and, therefore, dealing with copyright infringement matters is technically simple and expedient. While true, "take-down" is not a realistic solution for many museum projects. What is not considered in this situation are the high costs of digitization and cataloging that are pre-requisites to posting anything on a museum website. And, even if digitization costs are decreasing, cataloging is labor intensive, and thus expensive. Decisions to digitize and catalog materials involve rights and permissions. A solution about orphan works would greatly help institutions make those decisions based on the collections themselves and not on what the institution has rights for and what it doesn't.

[39] American Association of Museums, Washington, D.C., ©1999

[40] See https://www.ali-aba.org/aliaba/CK061.HTM

[41] For purposes of these comments, we have not discussed the extensive analysis required to determine if the use is a fair use. That analysis is time consuming, expensive and the results can be uncertain. A solution for use of orphan works could greatly reduce the time and expense of fair use analysis.

- I've done the research. I've checked the web. I went to the library. I've made calls. I cannot find the copyright owner. Can I use the work?

When these questions arise about copyright, decisions are made – sometimes based on the institution's precedents and sometimes on an ad hoc basis. The vast majority of American museums do not have in-house counsel dedicated to intellectual property issues, and so there is a choice to either (1) seek further counsel, which can be expensive, (2) proceed with the project and hope that nothing bad happens, (3) modify the project to reduce risk, or (4) forego the project entirely. All museums encounter real problems in the search for copyright information and museums need to use copyrighted works as part of their missions. This situation poses a conflict that could be solved by a solution to the orphan works situation.

Section 5. The Proposed Solution

In thinking about the problem of orphan works, we propose that users of orphan works receive a temporary, but realistic, exemption from liability and/or damages.[42] This exemption-based proposal contains certain features that we believe should characterize any solution. First and foremost, the solution needs to encourage uses of orphan works because this will benefit the public. The solution should be simple to understand and comply with, and, at the same time it must be fair to copyright holders and users. It seems to us that it is important to follow as much of current law as possible and to avoid extensive bureaucracy, formalities, and delays. Most important, we believe that the solution should not focus on damages or monetary compensation. Rather, the solution should acknowledge the contribution of the user in bringing an orphan work to the public's attention and, potentially, the copyright holder's attention. We have been mindful that any proposed solution must comply with TRIPS, specifically Article 13,[43] and the Berne Convention including, without limitation, Article 9(2).[44] With these goals in mind, we propose the following solution.

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[42] We understand that there are other proposals being submitted in response to this NOI that suggest a reduced damages approach. We appreciate the intent of these proposals, which seek to give users some much-needed relief, but we have concerns about their application. While the damages amounts proposed in some submissions are capped (and could presumably be reduced further in a court's discretion), we are concerned that even minimal damages are beyond the budgets of many institutions, especially with respect to the use of multiple orphan works. Reduced damages would, therefore, do little to alleviate the current reluctance by museums to use orphan works. Moreover, we are concerned that the damages amounts identified in the law will become the de facto settlement amount, regardless of the facts of the situation. Finally, we are concerned that a damages remedy, instead of an exemption-based solution, will add to conflicts between users and emerging copyright owners, rather than fostering an environment in which the user and recently identified owner try to resolve the matter including any questions the owner may have about the use of the work. U.S. copyright law contains a number of exemptions for use of copyrighted works without permission of the copyright owner. Clearly, exemption-based solutions are accepted as appropriate public benefit solutions and as legally sound both under U.S. and international laws

[43] Article 13 Limitations and Exceptions "Members shall confine limitations or exceptions to exclusive rights to certain special cases which do not conflict with the normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the right holder."

[44] "It shall be a matter for legislation in the countries of the Union to permit the reproduction of such works in certain special cases, provided that such reproduction does not conflict with a normal exploitation of the work and does not unreasonably prejudice the legitimate interests of the author."

1. Orphan works should include all works protected by copyright, including, without limitation, unpublished works; there should be no restrictions relating to the age of the work; works of foreign origin used in the United States; and, works from all media should be covered. We recognize that copyright law provides authors with the exclusive right to determine if, when, and how their works are made available to the public. The courts have protected unpublished works in the context where known authors objected to publication.[45] Museums do not usually have a record of objections to publication. Yet, unpublished works, especially, letters and photographs, include much of what is in museum archives and special collections. These kinds of orphan works are potentially of great value to our shared cultural heritage and need to be included.

2. Users and uses should not be restricted. Users should be any person or entity, commercial or non-profit. Uses should be allowed regardless of commercial or non-commercial purpose. Copyright law does not regulate the expressions it protects. Therefore, the orphan works solution should not limit the rights to use orphan works based on who is using the work or how it is being used, though the type of use and resources of the user may affect the due diligence currently practiced from industry to industry.

3. Use of the orphan work should be non-exclusive, and any other person or entity should be able to use the orphan work, provided such other user complies with the due diligence. It may be that references to prior uses of the orphan work by others could be considered reasonable due diligence, and the longer the work has been used without a claim, the more reasonable the use might be considered. Additionally, non-exclusive use during the statutory safe-harbor period (described in Point 8, below) will not unduly prejudice the exploitation of the work by the copyright owner, should one appear.

4. Users of orphan works should be required to conduct a reasonable due diligence for identifying and/or finding the copyright owner(s). Due diligence can be expensive and complicated and there are different opinions as to how much investigation and searching should be required. We believe that as a result of this NOI, there will be a number of suggestions for due diligence. We do not think it is necessary or advisable to prescribe in the law the specific steps of reasonable due diligence as these will vary based on the facts and circumstances of use as well as specific industry practices. The legislative history and regulations (when promulgated) could state examples of reasonable due diligence. This approach will provide flexibility and still give people good ideas of what could be done. Furthermore, we think that a rebuttal presumption of good faith and due diligence could include identifying orphan works through notices or database listings as described in Points 6 and 7, below. NOTE: It seems to us that by definition an orphan work could include a work for which a claim of copyright was registered with the U.S. Copyright

[45] Salinger v. Random House, Inc., 811 F.2d 90 (Second Circuit 1987). Congress voted to allow the use of unpublished materials without permission even where the author or artist was identifiable and locatable. In 1992, Section 107 of the Copyright Act was amended to clarify specifically that "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." This amendment recognizes the public purpose and public benefit of publishing previously unpublished materials.

Office, *i.e.* registration. Because "registration" as defined in Section 101 of the Copyright Act does not include the recordation of a "transfer of copyright ownership" with the Copyright Office, a work could have been properly registered, but owing to subsequent transfers of ownership or through exclusive licenses, lack a currently identifiable or locatable copyright owner. We believe that this is a matter to be determined as part of reasonable due diligence.

5. Users should be required to maintain records and documents of their searches to find and identify the copyright owner(s). While it may seem obvious, we believe that it is important to note the importance of record keeping by users. Presumably, users already do this.

6. Users could identify the orphan work(s) on the new work or reproduction of the original work by inclusion of a legal notice symbol or narrative statement developed by the Copyright Office. The placement of a legal notice symbol or narrative statement – "OW" or "The following are Orphan Works:..." – on the new or reproduced work by users, not copyright holders, would not violate the prohibitions against formalities provided for under the Berne Convention. If the new work uses many different orphan works, such as a documentary film, the user could provide one notice that orphan works were included and provide information on where to get the detailed information about them. This approach is similar to the Digital Millennium Copyright Act (DMCA) designated agent notice.[46] The notice on the new work or reproduced work would be an indication of the user's good faith and should be considered as part of the evaluation of reasonable due diligence. Failure to include the notice (usually as a result of inadvertent error) should not be negatively construed or impose liability or damages on the user.

7. Users could publicize information about the use of orphan works. The user could undertake another proactive notice. This could be accomplished by allowing users to post the information about the use of orphan works on the web, either on the user's own web site or on an aggregated web site operated by the Copyright Office or a private, but designated, third party, *e.g.* the "Copyright Orphanage." A simple required protocol for the structure and content of such web postings, such as that for meta data harvesting from the Open Archives Initiative, could be used. This should also be considered when evaluating the user's reasonable due diligence and it could provide an alternative mechanism for providing notice of use of the orphan work as well as providing lost copyright owners with a mechanism to come forward and make themselves known – a laudable public policy goal in and of itself.

8. The user should be permitted to continue to use the orphan work without liability or damages during a statutory safe-harbor period, even if a valid copyright claim is raised. This right to use the work for a minimum statutory period after a copyright owner has been found is essential to encourage the use of orphan works. Under this proposal, users will expend time and money in their use of orphan works. A benefit should attach to

[46] DMCA Agent notice, Section 512(c)(2) of the Copyright Act.

these efforts. This statutory period should be at least five (5) years long, and if no claims are raised during this time period, another five (5) year statutory period should commence (provided all other use requirements are fulfilled). Five (5) years is the minimum amount of time we believe is necessary for museums to be able to use up inventory and justify the cost of digitization and cataloging. It is important that use of orphan works during this statutory period is without liability. Otherwise, we do not believe that the intended benefits of the solution will be realized.

9. If someone raises a claim of copyright ownership, both the user and the claimant should have all of the rights they have under existing law to prove or reject the claim; users will have all of their current exemption rights, including, without limitation, fair use. Any legal determination would only impose liability for continued use after the statutory safe-harbor period described in Point 8, above. It would be relevant, however, for all other new users.

10. Money damages should be available only if it is proven that the user did not comply with the orphan works requirements for reasonable due diligence. If the user opts to include the orphan work notice on the new or reproduced work and publicizes use of the orphan work information on the web, then both actions should be considered when determining if the user conducted a reasonable due diligence. Only abusers of the right to use orphan works should be subject to money damages during the statutory safe-harbor period.

11. There is no need or rationale for a compulsory license. Under this proposal, the entire economic burden for use of the orphan work falls on the user – the need to conduct due diligence, maintain records, and, include notices and post information. There are no costs being incurred by the Copyright Office. There are no obligations imposed on the copyright holder, although there is potential for gain – economic gains from exploitation of the work through subsequent uses and/or gains through recognition of the work and the reputation of the artist. A compulsory license fee for use of the work would impose a liability on the user that is unjustified. It would result in limited use of these works, thus negating the goal of encouraging people to use orphan works.

12. If the user and the claimant cannot resolve the question of copyright ownership and/or compliance with orphan works procedures, an alternative dispute resolution (ADR) procedure could be encouraged through various incentives. We do not think an ADR procedure should be required, but we do think it could offer benefits to users and copyright holders. It may be that the Copyright Office would be an appropriate body to provide this service or existing ADR providers could be used.