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U.S. Copyright Office
Copyright GC/I &R
P.O. Box 70400
Southwest Station
Washington, D. C. 20024

Submitted by Email to orphanworks@loc.gov

Re: Comments on the Orphan Works

Dear Mr. Sigall:

These comments are being submitted in response to the Notice appearing in the Federal Register Dated January 26, 2005, regarding the issues raised by “orphan works,” which are defined in the notice as “copyrighted works whose owners are difficult or even impossible to locate.”

I am a Professor of Law at The John Marshall Law School in Chicago, Illinois, where I teach, among other topics, international and domestic intellectual property law, intellectual property in a global, digital environment and unfair competition law. I have written numerous articles and books in the area, including text books and have co-authored several anthologies on international intellectual property law. Prior to entering academia, I was a practicing attorney for over 14 years, representing numerous client sin domestic and international intellectual property protection matters. The views submitted in these comments are my own and do not represent the views of The John Marshall Law School or any private or public organization,

business, agency or other entity.

I strongly favor crafting a solution to the problem of true orphan works that makes it easier for authors and other creators to use such works, without violating international norms or creating a discriminatory system that imposes undue difficulties upon individual authors to maintain their rights to control the exploitation of their works during the pendency of their period of copyright protection.

There is no question that the existence of orphan works may create problems for authors who seek to use the works for purposes for which no fair use defense available. As a co-author of several texts and anthologies in the field of international intellectual property law, I have occasionally been faced with the problem of being unable to secure permission for inclusion of a work because the author/copyright owner was either unidentifiable or non-existent (either through death for natural persons or dissolution in the case of corporately owned works). Realistically, for me, the problem posed by such orphan works is the same posed when I want to include a work for which an identifiable (and locatable) author/copyright owner has denied permission or offered to grant permission on terms that are unacceptable to me. In those instances, I must determine whether any use fits within the applicable fair use exception¹ so that permission is unnecessary or I must select another work to use. In either case, my ability to create a new work as I have originally envisioned it, is compromised. Such a compromise is unfortunate, but it is the price we pay for having a legal system that grants authors and copyright owners *the right to control the use of copyrighted works during their term of copyright protection*. Just as I do not have an absolute right to do whatever I please without legal consequences, I do not have the right to say whatever I want,² or create whatever I want³ without legal consequences. Any attempt to deal with the problem of orphan works should, therefore, be narrowly crafted to avoid either creating new categories of orphan works, or, even less desirable, effectively eliminating authors' copyrights in their works.

A Compulsory License System Is Not An Acceptable Solution Unless It Is Narrowly Crafted

In establishing the Constitutional foundation for copyright, the Founders did not grant to

¹ 17 USC § 107. Making such a determination carries certain risks since the determination of fair use in the United States is not based on categorical exceptions. The statute does not guarantee that certain types of uses are automatically fair if they fit within particular activities (such as news reporting or education). To the contrary, the determination of fairness is based on a case by case analysis. While such flexibility reduces predictability in certain cases, I do not advocate the reduction or removal of this flexibility since it allows courts to recognize “new” uses as permissible within the boundaries of the doctrine. See, e.g., *Kelly v. Arriba Soft Corp.*, 336 F.3rd 811 (9th Cir 2003) (search engine qualifies as permissible, transformative use under fair use doctrine).

² While the First Amendment guarantee of the right to free speech is a powerful civil liberty, even the doctrine of “free speech” permits regulation of speech, including its prohibition in cases such as false advertising and obscenity.

³ The copyright laws are an obvious limitation on my ability to create new works, since even the creation of derivative works is within the control of the original copyright owner. 17 USC § 106.

authors an unlimited right to *compensation* for the use of their works. It granted the right to *control* their works. Article I, section 8, Clause 8 (the so-called Copyrights and Patents Clause of the Constitution) granted Congress the power to enact laws “[t]o promote the Progress of Science and the Useful Arts, by securing for limited Times to Authors ... the exclusive *right* to their respective Writings ...”⁴ The Founders did not restrict this right to a right of compensation. Nor did they seek to establish a system of protection under which authorial interests are automatically subordinated to any potential public interest which might run afoul of authorial control. To the contrary, pre-Constitutional sources represent a strong trend toward authorial rights.⁵

Copyright owners, unique among current intellectual property owners,⁶ already face a wide ranging compulsory license system in the guise of the fair use doctrine, which allows others to use copyrighted works without permission *and without compensation*. No such equivalent fair use exists in the other arenas of intellectual property. In fact, in the area of patent law, which has often served as an analogy for copyright laws, since both arise from the same Constitutional grant clause⁷ the closest right to a compulsory use for a societal purpose – the right of experimentation – has, to date, been so narrowly crafted as to be virtually non-existent.⁸ This does not mean that fair use should be eliminated or reduced. To the contrary, it serves a valuable purpose in assuring the proper balance between author control of expression and free speech.⁹ It does suggest, however, that in the face of so wide-spread an existing compulsory licensing system, any additional compulsory licenses should be narrowly crafted.

Any registration or other system established to deal with the problem of orphan works based on the assumption that so long as the author receives some compensation his/her “rights” are satisfied poses serious Constitutional issues, and could threaten the foundations of copyright law by removing any right to authorial control. It would also result in the uniform undervaluing of copyrighted works since compulsory license fees are notoriously lower than market valued fees. Ultimately, constant devaluation of copyrighted works could adversely impact the creation of new works. Particularly for those works which require costly investments in equipment, personnel or time to create or distribute (such as motion pictures, video games and software), the economic incentives may ultimately be removed. This would leave the well-funded volunteer or the wealthy dilettante who does not have to worry about supporting a

⁴ US Const., Art. I, §8, cl. 8.

⁵ See, e.g., Marybeth Peters, Copyright Enters the Public Domain, 51 J. Copyr. Soc’y 710, 753 (2004); Jane Ginsburg, A Tale of Two Copyrights: Literary Property in Revolutionary France and America in *Of Authors and Origins: Essays in Copyright Law* (1994).

⁶ I include within this category the current traditional forms of intellectual property recognized under US law – patents, trademarks, copyrights and trade secrets.

⁷ Article I, Section 8, Clause 8 includes inventors within the scope of its grant, granting Congress the power to enact laws “[t]o promote the Progress of Science and the Useful Arts, by securing for limited Times to Authors *and Inventors* the exclusive right to their respective Writings and Discoveries...”

⁸ See, e.g., *Madey v. Duke University*, 307 F.3d 1351 (Fed. Cir. 2002)

⁹ See, e.g., *Eldred v. Ashcroft*, 537 US 186 (2003); *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 US 539 (1985)..

family or otherwise earning a living as the sole source of such works. While such individuals, through-out history have been the source of outstanding creative works, the ultimate harmful impact to the public domain if *only* such individuals were encouraged to create new works would be incalculable.

Viewing copyright protection as nothing more than a right to some form of compensation further violates international norms which recognize that authors of copyrighted works have both economic *and* non-economic interests in their works. The internationally accepted doctrine of *droit moral* (moral rights) recognizes that authors' rights include such important non-economic rights of the rights of patrimony¹⁰ and integrity.¹¹ Such rights necessarily recognize that an author's relationship with the created work goes beyond mere economic compensation. Both Article 6bis of the Berne Convention on the Protection of Literary and Artistic Works, and Article 5 of the WIPO Performances and Phonograms Treaty require the protection of these moral rights. As a signatory of both treaties, the United States is bound to grant such rights to domestic and foreign authors. A compulsory licensing system for orphan works which fails to maintain these control rights would violate both international norms and US treaty obligations.

If a compulsory licensing system for orphan works is established, the Copyright Office should have responsibility for establishing the parameters of such a system and for overseeing its operation. Any such compulsory system should be carefully crafted so that a compulsory license is rarely granted and then only in limited circumstances where reasonable efforts to locate authors/copyright owners have been unsuccessful.¹² To qualify for any such compulsory license, the user of the putative orphan work should be required to file an affidavit of reasonable location efforts, and to deposit a required compulsory fee with the Copyright Office for at least three years. Failure to make such a filing should preclude application of any orphan work exceptions to authorial control. The Copyright Office should maintain a public registry of works for which compulsory use is being sought. If after three years, no claimant appears, the monies deposited with the Copyright Office could be returned to the user. However, such return would not adversely affect the copyright owner's future right to compensation for any such use or to challenge the orphan status of the work.

Any compulsory licensing system should not give users of orphan works unlimited rights of use since by their very nature orphan works are still subject to copyright protection. Instead, the terms of use under a compulsory license should be strictly limited. Users of orphan works should have no right to authorize derivative uses. Instead, those who want to create derivatives

¹⁰ The right of paternity is generally recognized as the right to claim authorship of one's own work. *See, e.g.,* Berne Convention on the Protection of Literary and Artistic Works, Article 6 *bis*.

¹¹ The right of integrity is generally defined as the right to prevent the unauthorized distortion, modification or mutilation of a work which would be prejudicial to the author's honor or reputation. *See, e.g.,* Berne Convention, Article 6bis. *See also* 17 USC 106(A) (Visual Artist Rights Act, granting to the artists of certain visual works of art the rights of patrimony and integrity under US law.)

¹² *See* discussion *infra* regarding the determination of reasonableness and the role of compliance with registration requirements.

of the works should still be required to seek the permission of the author/copyright owner of the original work. Unlike real life, orphans in the copyright arena do not necessarily remain orphans. To remedy orphan status, all the author/copyright owner has to do is make his/her/its location readily available. Consequently, those works which contain orphan works under a compulsory license should also be obligated to contain the appropriate notice of such orphan status to qualify for any such compulsory license.

A Mandatory Registration System to Maintain Protection Would Discriminate Against Individual and Foreign Authors and Violate International Norms

Several jurists and scholars have suggested that the present optional registration system be replaced with a mandatory registration system, or a maintenance registration system, similar to the one currently used for patents where new filings are required, along with the payment of maintenance fees, to maintain patent protection. Creating such a registration system would not only violate international norms for copyright protection, it would return the present copyright system to the unfortunate days of the 1909 Act when numerous works were placed into the public domain for failure to comply with technical registration requirements. Any such mandatory licensing system would necessarily fall heaviest on non-US authors/copyright owners, who would either be unaware of the requirement or unable to secure registration without great difficulty and expense,¹³ or on non-corporate US authors/copyright owners.¹⁴ A copyright system that effectively excludes foreign and individual authors from protection cannot seriously be considered one that furthers the Constitutional goal of encouraging creativity of “authors,” regardless of origin *or economic status*.

The use of a maintenance system for patents does *not* support its adoption in connection with copyrighted works. There are critical distinctions which are often ignored by those who support a maintenance system for copyrighted works. Most significantly, patents are solely creatures of domestic government grant. No one has created a patented invention *unless and until* the US Patent and Trademark Office recognizes such invention by issuing a US patent.¹⁵ By contrast, authors create copyrighted works without the need for any such grant or recognition. As of the date of creation and fixation, without more, an author has a copyrighted work.¹⁶ Moreover, the copyrightable nature of that work extends beyond the borders of the United States.¹⁷ (Patents, by contrast, are strictly territorial in nature and have no extraterritorial effect, unless and until the appropriate foreign patent office recognizes the patentable nature of the invention in question.)

¹³ Expansion of electronic filing does not alleviate this problem since many foreign authors do not have access to the internet, particularly authors from developing countries.

¹⁴ Empirical information gleaned from the days of mandatory registration and renewal indicate that corporations generally made most of the filings under the Act and at least maintained those registrations for as long as they perceived an economic benefit in protection.

¹⁵ 35 USC § 100 et seq. .

¹⁶ 17 USC § 101.

¹⁷ Berne Convention, Article 2.

Even if such a registration system did not have the effect of creating a discriminatory registration system, (which I believe it would invariably have), any such registration system would violate international norms. Article 5 of the Berne Convention expressly provides that “[t]he enjoyment and the exercise of these rights shall not be subject to any formality...”¹⁸ A mandatory registration system which would impact the scope or term of protection of a copyrighted work, including an orphan work, would violate these provisions. It does not matter if this system is deemed a maintenance system, whereby works are protected for a limited term unless subsequent registrations to maintain protection are made, or if it is deemed an orphan works system where failure to register would lead to the presumption of a work’s being orphaned (and available for a level of unauthorized use not granted other works). Any such *mandatory* registration system effectively subjects the enjoyment of the exercise of the right to copyright (including authorial control)¹⁹ to a formality in violation of Article 5. This article has been expressly incorporated by reference into the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS).²⁰ The United States is a signatory to both treaties. Hence, any imposition of a universal registration system would clearly violate these obligations and could potentially expose the United States to potential trade sanctions under the Dispute Settlement Procedures of the World Trade Organization.²¹ Such a result would place the United States in the unfortunate role of violating the very international obligations it has consistently urged other countries to abide by.

Any registration system that would limit copyright protection to a particular term absent some “maintenance” filings would also violate international norms. Under Article 7 of the Berne Convention the term of protection for a copyrighted work (which as noted above, must be provided without formalities) is “the life of author and fifty years after his death.”²² Any loss of rights before the expiry of this term for a failure to file some type of maintenance fees or registration would violate these provisions as well. Since these term requirements have also been incorporated into TRIPS,²³ the same potential for trade sanctions based on this separate violation exists.

¹⁸ Berne Convention, Article 5(2).

¹⁹ See discussion *supra* regarding the right to exercise more than the right of compensation as a right under copyright law.

²⁰ Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS), Article 9.

²¹ See, e.g., UNITED STATES – SECTION 110(5) OF THE US COPYRIGHT ACT, Decision of the Dispute Resolution Body, World Trade Organization, WT/DS160/R (2000)(Section 110(5) found in violation of TRIPS obligations).

²² Berne Convention, Article 7(1). There are certain lesser periods of time for protection which may be imposed for certain works such as photographs and works of applied art. Even for these limited categories of works, protection must last for at least 25 years from the making of such a work. See Berne Convention, Article 7(4). These periods are substantially longer than any that have been proposed based on some theory of the “commercial shelf life” of a work.

²³ See TRIPS, Article 9.

A Mandatory Registration System For US Authors Would Undeservedly Punish Authors Based on their Citizenship

While a mandatory system of registration would violate international norms and US treaty obligations, an optional system would not (depending upon its elements). Neither would a system which only required registration for US authors. Such a mandatory system, however, would not only impose an additional burden on US authors, it could harm the economic value of works simply because they had the misfortune of being created by a US author. First, failure to file under a mandatory registration system would presumably result in a loss of at least authorial control, at a minimum, or a complete loss of rights (such as under the 1909 Act). This loss of rights would *not* be limited to the United States. Under Article 7 of the Berne Convention, countries need only grant a term of protection to works of foreign authors for a term which “shall not exceed the term fixed in the country of origin of the work.”²⁴ Thus, any system which denies US authors copyright protection for any period less than at least life plus 50 years would effectively remove the economic value of such works *through-out the world*.

Failure to Register Should Not Be the Sole Basis for Determining Orphan Status

Even if some kind of optional registration system were created, failure to register a work should *not* give rise to a presumption of a work’s being an orphan. At most, failure to register should be considered in establishing the acts which qualify as a reasonable attempt to locate a copyright owner. Regardless of the nature of the work at issue, consultation of Copyright Office records (even without any particular new registration or notice system designed to reduce the problems posed by orphan works), is a necessary first step in making reasonable efforts to locate an author/copyright owner. Other necessary steps should also include, at a minimum, attempts to locate any individual/entity listed as the copyright owner or licensee in any notices or digital rights management information contained on a legitimate copy of the work, as well as searches of appropriate electronic databases for location information.

The determination of the reasonableness of efforts taken by an individual to locate an author/copyright owner under an orphan works system should also be based on the use to be made of the work, and the age of the work. Thus, for example, commercial uses of works should require greater location efforts than non-commercial uses since such uses directly impact the economic rights of authors in their works. Similarly, uses of complete works should require greater efforts than uses of portions of work. This is particularly true since the use of a part of work may be more likely to qualify as a fair use.²⁵

Similarly, the age of the work should impact the level of effort required to locate the author/copyright owner. The older the work, the less effort should be required since, if the owner of such works is interested in controlling exploitation of the work, such owner would have

²⁴ Berne Convention, Article 7(8).

²⁵ See, e.g., *Sony Corporation of America v. Universal City Studios, Inc.*, 464 US 417 (1984)(reproduction of entire work is generally not considered a fair use).

presumably maintained some viable contact information, through copyright registration, up-to-date notices and digital rights management information, or current incorporation documentation.

Any Rights To Use Orphan Works Beyond Those Available Under Fair Use Should Be Limited To Published Works.

Orphan works status should never be applied to unpublished works. Absent fair use, authors should have the absolute right to control the use of their unpublished works. There is no question that the published nature of a work is no measure of its artistic merit or its scholarly value. Nevertheless, if authorial control is to mean anything beyond the right to compensation,²⁶ it must include the determination of when a work is to be published.

As noted above, copyrights are *not* the equivalents of patents. Patents are only granted upon disclosure, and then only upon government grant.²⁷ By contrast, copyright protection is extended to unpublished works. In fact, it attaches without any requirement of publication.²⁸ To remove the personal decision to publish a work, without the presence of the significant limitation that any such unauthorized use be a fair one, is to make the purported right of authorial control non-existent.

The Copyright Office Should Maintain a Notice Board for those Seeking to Use Orphan Works.

Regardless of what additional steps are taken in connection with orphan works, to assist creators in their efforts to locate authors/copyright owners, the Copyright Office should maintain on its website a notice board where authors seeking the right to use a work which appears to be orphaned could post notices seeking the identity of such individuals/entities. Failure to respond to such a notice should not result in a complete loss of rights over the work in question. Authors should not be burdened by the need to check for licensing opportunities when *they have no legal obligation to authorize any particular use of their works*. Nor should any such burden be imposed, absent anti-trust violations or fair use.

Closing Considerations

Many scholars have suggested that copyright protection should be limited to the commercial shelf life of a particular work and have urged compulsory rights be based on such commercial requirements. There is no question that commerce plays an important role in the economic exploitation of copyrighted works, but commerce is not the only value of copyright. Does the fact that poems of Emily Dickenson were unpublished or the artwork of many of the

²⁶ See discussion *supra*.

²⁷ See discussion *supra*.

²⁸ See discussion *supra*.

Impressionist painters were commercial failures make such works any less worthy of copyright protection? Commercial shelf life is a misnomer to say the least. What is the commercial self life of a work that is unpublished and yet discovered by later generations as a seminal work? What about the revival potential of plays and movies? Are covers of older songs less worthy of copyright protection than a newly crafted song? Any attempt to base any period of protection or any rights to compulsory uses based on the “commercial shelf life” of a work not only substitutes readily calculable periods of protection for impermissibly vague ones, it alters the public importance of copyright from one which encourages creativity to one which encourages only commercially viable works. Ultimately, the diversity of the public domain will suffer from such short-sightedness.

Thank you for the opportunity to address these critical issues. Please do not hesitate to contact me if I can be of any further assistance in this matter.

Sincerely,

Doris Estelle Long
Professor and Chair, Intellectual Property,
Information Technology and Privacy Group
The John Marshall Law School