



Stephen M. Doniger, Esq. +
Scott A. Burroughs, Esq.
Annie Aboulian, Esq.
Anthony M. Patchett, Esq. *
David R. Shein, Esq. *
Matthew DiNicola, Esq.*
+ Eligible to Practice in England
* Of Counsel

February 7, 2013

SUBMITTED VIA ELECTRONIC UPLOAD

**Re.:Orphan Works and Mass Digitization Notice of Inquiry: 77 Fed. Reg. 64555
(Oct. 22, 2012)**

To whom it may concern:

I am pleased to submit this comment on behalf of Doniger/Burroughs APC in response to the Notice of Inquiry referenced above. Doniger/Burroughs has represented numerous copyright holders in various media, from two-dimensional graphic designs to motion pictures to photographs, and has argued copyright law issues to both the District Courts and the 9th Circuit Court of Appeals. We feel strongly about protecting the rights of authors and artists. We submit the below in response to the orphan works issue.

A. Changes in the legal landscape over the last four years

There have been significant changes in the field of copyright law over the last four years. Technological advances have made commercial infringement easier and more discreet than ever before, and the Internet has increased the speed and amount of dissemination of copyrighted

works. Unfortunately, as Internet publishers upload or adapt previously printed material, attribution to the artists is lost along the way.

Copyright holders should not be punished because the Internet has given easier access to exploit copyrighted material and remove the author's name and contact information. Regardless of whether one can locate the original owner, the work still deserves the proper safeguards from others illegally profiting from the protected material. Strictly because an artists' work *can* be disseminated across the world almost instantaneously, it does not mean that commercial copyright protection standards should be reduced. Rather, to combat the ease and increase in the amount of infringing occurring on the Internet, stricter protections should be afforded to the copyright holders.

Moreover, in September 2012, European Parliament passed the European Union's Orphan Works Directive. The directive is similar to the United States' 2008 framework, however the EU directive only allows the orphan works to be used for **non-commercial** uses. It recognizes the importance of not permitting others from profiting from others hard-work and creativity, and provides a disincentive to companies that might otherwise attempt to exploit the work and if caught claim not to have known the origin or protected nature of the work.

B. Continued viability of 2008 framework:

The proposed 2008 legislation still faces many of its initial problems. In fact, in light of the recent court proceedings regarding orphan works, the 2008 framework may face more complexities and problems. With the continually evolving technologies, copyright infringers are using new and improved methods to infringe on authors' works. Copyright law protects

authors and copyright holders from commercial infringement, and it should cover such conduct whether or not the author can be found. The current legislation and copyright law should remain as is until a solution for the orphan works problem is developed that can be implemented easily and objectively. The language as currently formulated is impermissibly vague and provides incentives that may cause commercial entities to avoid identifying the authors of certain works in order to exploit the works without cost.

i. “Good faith, reasonably diligent search for the copyright owner”

Requiring a good faith and reasonably diligent search for the copyright owner poses several complex issues that will cause confusion and uncertainty amongst jurisprudence, copyright owners, and those trying to use the at-issue works. Conversely, imposing a case-by-case basis will create judicial inefficiency. Courts will have a difficult time in determining what constitutes a good faith and reasonably diligent search because of the various mediums of works (e.g., motion pictures, photographs, graphic works), the difference in *who* does the search and the resources that person has (e.g., university or corporation or individual), and verifying that a reasonable search was actually completed. Also, this will create large cost and time burdens on people trying to use the orphan works because they will have to document each of their searches, step by step. This subjective approach will be difficult, burdensome, expensive, and waste judicial resources. It should not be made law.

ii. “Attribution to the author and copyright owner, if possible and appropriate under the circumstances”

The criteria of providing attribution “if possible and appropriate under the circumstances” is far too subjective and lenient. Attribution should be a requirement, rather than an option because it is one of the most important elements to the artist. With the technology now available, and the rampant and swift infringement made possible by the Internet, ensuring attribution to artists is becoming increasingly important because it is so easily lost. While recognizing the difficulty sometimes presented in attributing the authors for their work, it does not change the importance of giving credit where credit is due.

iii. “Limitation on remedies that are available if users proves he or she conducted a reasonably diligent search”

Copyright holders should not be limited on the amount they can recover merely because commercial infringers could not locate them after a “reasonable” search. Damages awarded in copyright infringement are designed to compensate the author for his lost profits and to deter future commercial infringement. Copyright law permits the author to recover for statutory and attorneys’ fees. The recoverable amount should not diminish strictly because the commercial infringer could not locate the author, which occurs most often through no fault of the author. Authors may incur expensive legal fees in protecting their works, and making sure that they can be found after a “reasonable” search. This could entail constant monitoring of every art marketplace and the millions of internet site that may host the artist’ material to make sure that attribution is attached to the artist’s material. This is an undue burden. A party that realizes profits by selling an infringing work should be put back in the position they were before they

sold the infringing work, and artists should not have to bear the burden of constantly monitoring places where their art could appear via the conduct of a third party.

C. Other possible approaches:

The law cannot punish copyright holders for third-party conduct that renders the work an “orphan” work. This would create negative incentives and punish artists while placing upon them an undue burden relating to the investigation of any and all authorized and unauthorized uses of their art.

There also needs to be an explicit difference in whether the infringer is using it for commercial or non-commercial use. The proposed legislation (Section 514) allows commercial and non-commercial infringers to benefit under this Act. At the very least, the Act should not allow commercial use of the artists’ work.

This approach will conform with international legislation, as it is similar to the European Union's Orphan Works Directive. Recognizing the difference between non-commercial and commercial users is vital to properly protecting and compensating copyright owners.

Respectfully submitted

DONIGER / BURROUGHS apc

By: /s/
Stephen M. Doniger
Scott A. Burroughs
For the Firm