



---

# United States Copyright Office Inquiry concerning Orphan Works and Mass Digitization

Docket 2012-12

---

## Written comments of the Association of Learned and Professional Society Publishers (ALPSP)

21 May 2014

### Introduction

The Association of Learned and Professional Society Publishers (ALPSP) is the international membership trade body which works to support and represent not-for-profit organizations and institutions that publish scholarly and professional content around the world. Its membership also encompasses those that partner with and provide services to not-for-profit publishers. ALPSP has over 320 institutional members in 39 countries, who collectively publish over half the world's total active journals as well books, databases and other products.

### Summary

Scholarly publishing has long recognized the issue of orphan works and, in 2007, three Trade Bodies (ALPSP, STM and AAP) came together to publish a set of Safe Harbor Provisions for the Use of Orphan Works<sup>1</sup>. These provisions provide agreement from signatory copyright owners that, subject to payment of a reasonable royalty for the use, the owners will waive rights to any statutory, punitive, exemplary or other special damages. The provisions also provided guidance on what may be considered to be a diligent good faith search for copyright owners of scholarly material, plus the types of resources that might be used as part of that search.

### Specific questions

#### The need for legislation in light of recent legal and technological developments

*Can the orphan works problem be resolved under existing exceptions and limitations contained in the current copyright act, such as fair use?*

*Should this determination hinge on the type of use or user making use of the work?*

---

<sup>1</sup> [http://www.stm-assoc.org/2014\\_03\\_04\\_Safe\\_Harbor\\_Provisions\\_for\\_the\\_Use\\_of\\_Out\\_of\\_Commerce\\_Works.pdf](http://www.stm-assoc.org/2014_03_04_Safe_Harbor_Provisions_for_the_Use_of_Out_of_Commerce_Works.pdf)

*If legislation is deemed necessary, should it reflect or acknowledge recent developments in fair use law, if at all?*

*Have technological advancements mitigated the orphan works problem, or are the technologies not being effectively utilized in the context of orphan works?*

1. It is unlikely that an orphan works solution could be found under fair use, particularly given that the use of the works will not change, merely their format. This could hardly be thought of as transformative.
2. Technologies have not yet developed enough to fully mitigate the orphan works problem and indeed, given the proliferation of various versions of copyright works online, technology may even enhance the orphan works problem.

### **Defining the good faith ‘reasonably diligent search’**

*What are the relative advantages or risks of flexible versus rigidly-defined search standards?*

*Should the Copyright Office be involved in developing search criteria or evaluating searches and should these be in the regulations?*

*What should be the role of community-developed best practice documents and who should develop them?*

*What role should the Copyright Office play in developing, monitoring or certifying search criteria?*

3. It would be helpful for the minimum scope of a diligent search to be defined, as a guideline for those undertaking it. For example, the UK legislation provides a list of sources that should be consulted during a diligent search, depending on the category of work in question, in order to establish whether a work is orphan or not.
4. This type of approach would be advantageous for both the prospective user of orphan works and the licensor, as well as the copyright owner, who could be tracked down by such a search.
5. As noted above, it would be helpful to provide a list of sources that would be useful in establishing whether a work was truly an orphan. Such sources may not be immediately apparent to prospective users.
6. The respective communities will already be very aware of the existence of orphan works and many may already have best practice, safe harbor agreements or Memorandum of Understanding documents. Indeed a series of such documents and agreements<sup>2</sup>, produced by the International STM Association, provided guidance in the development of the European Orphan Works Directive.
7. Trade bodies or collective management agencies, or other agencies representing specific rights holder communities, may develop such documents.
8. It would be helpful if the Copyright Office were to include a list of sources that should be utilized as part of a diligent search in any regulations or guidance produced.

---

<sup>2</sup> [http://www.stm-assoc.org/2006\\_06\\_04\\_EU\\_Orphan\\_Works\\_Memorandum.pdf](http://www.stm-assoc.org/2006_06_04_EU_Orphan_Works_Memorandum.pdf)



### The role of private and public registries

*How could the Copyright Office facilitate and incentivize owners to register their works and keep their ownership and contact information current?*

*How could any such incentives be reconciled with the United States' obligations under the Berne Convention and other international instruments?*

*What could be the Copyright Office's role in overseeing or certifying third party registries? Is there a need for the Office to establish a register for users to register their use or, or intent to use, orphan works, similar to that envisioned in the Orphan Works Act 2008?*

*Does the recently-passed UK orphan works legislation, which envisions a key role for a web portal connecting multiple private and public Web sites and databases, present an attractive model for utilizing and organizing these registries in the United States?*

9. It would be necessary to provide notification that a license to use orphan works had been issued, else missing copyright owners would never be able to re-establish ownership of their works.

### Types of works subject to orphan works legislation, including issues related specifically to photographs

*Should an orphan works solution exclude any particular type of work or should it include all copyrighted works?*

*Would the exclusion of certain types of works substantially undermine the effectiveness of any orphan works solution?*

*If all types of works are included, what (if any) special provisions are required to ensure that all copyright owners, such as photographers, are treated equitably within the legislative framework?*

*Do recent developments such as the creation of voluntary registries, like the PLUS Registry, mitigate any of the earlier concerns regarding the treatment of photographs?*

10. ALPSP can only comment on the scholarly literature, but it would obviously be helpful to have a solution that included as many works as possible. One problem that will need to be overcome will be the stripping of metadata from files, including photographs, and technology to prevent the removal of information relating to the original of a work should be encouraged.
11. Ensuring copyright owners can be identified from their work will likely require technology (possibly legislation) around the prevention of the removal of such information.
12. Registries can be extremely useful, but depend on the copyright owner registering the work. By definition, works which may be considered orphan would not be included in such registries.

### Types of users and uses subject to orphan works

*Should orphan works legislation apply equally to commercial and noncommercial uses and users? If not, how should specific types of uses and users be treated within the legislative framework?*

*Should orphan works legislation be limited only to uses by non-commercial entities with a public service mission?*

*Should these entities be permitted to use orphan works only for limited purposes such as preservation, or should they be able to broadly use orphan works to provide access to the public?*

*Should commercial entities be able to make commercial use of orphan works? What are the relative advantages or disadvantages of allowing such use?*

13. The reuse of orphan works should be treated in the same way as non-orphan works. Failure to do so risks a negative impact on the non-orphan work market.
14. There is no reason to limit the reuse of orphan works only to non-commercial entities. Orphan works, following an appropriate diligent search and good faith attempts to identify, locate and contact the copyright owner, could be licensed in the same way as non-orphan works are.

### Remedies and procedures regarding orphan works

*What remedies should be available where orphan works rights holders emerge after a third party has already begun to use an orphaned work?*

*What rights should be available for creators of derivative works based on orphan works?*

*What procedures should be put in place where these situations arise?*

*Does the limitation on liability model still make sense in the current legal environment?*

*Should orphan works legislation instead be re-framed as an exception to copyright as it is in an increasing number of foreign jurisdictions?*

15. If a user carries out a diligent and good faith search for the copyright owner, and subsequently makes use of a work considered to be orphan, then any returning rights owner should be entitled to a reasonable remuneration for the use of that work, but the user should not be subject to statutory, punitive, exemplary or other special damages.
16. Reasonable remuneration should be agreed between the returning copyright owner and the user, based on any fee that would have been agreed should the work have been licensed under normal circumstances. Only in the event of a failure to agree should there be recourse to the courts. This does not affect the right of the returning copyright owner to refuse requests for further licences as it wishes.
17. It is the view of ALPSP that there is no justification for an exception as each situation needs to be determined on its individual facts. Procedures for searching, as outlined in this response, are more appropriate for this situation.

### Mass digitization – general

*What types of digitization projects should be covered by any legislative proposal, including the scope of activities that can be accurately described as “mass digitization.”*

*What are the risks and benefits of mass digitization projects?*

*What types of entities might be able to engage in such activities under any legislative proposal, and what types or categories of works should be covered?*

*Under what circumstances should mass digitization projects proceed and how may digitized materials be used?*

*How might any mass digitization solution differ from that of a general orphan works solution?*

*Would potential solutions developed in the context of mass digitization ameliorate the issue of orphan works?*

*How might these potential solutions interact?*

18. Generally, mass digitization projects are desired by those with large historical collections of works. Primarily these are likely to be institutions such as museums, galleries and national libraries. Digitization includes not just the transfer of literary works from print to digital media, but also scanning of artworks and photographs as independent works as well as those embedded in literary works. Such institutions are likely to outsource such activities, and engage commercial organizations to assist them in such projects.



19. The benefits are primarily around the preservation of works, but also the desire to make material available to an audience wider than those able to travel to specific locations to view them, i.e. making them available online. One of the risks of making such content available online is the potential to interfere with the primary market for commercially available works.
20. The purpose of any mass digitization legislation would be to avoid having to contact each copyright owner individually, but rather to work through a trusted coordinating body, to provide licenses for the uses required, in return for a fee. This could be handled under Extended Collective Licensing, as in the following section.
21. It is very important that the two solutions not be confused. Orphan works have been established as such following a diligent and good faith search for the copyright owner. Mass digitization projects should proceed as if all the content was covered by a license for the use required. A body needs to be responsible for providing the license for the use required, to ensure that the content digitized in no way impedes the natural primary market for copyright works. Works that are to be digitized cannot be confused as being orphan works; there are likely to be some in-copyright, in-commerce works involved.

#### Extended collective licensing and mass digitization

*Should the United States look abroad to foreign extended collective licensing approaches for ideas on domestic action on the issue of mass digitization. If so, which approach or components of any particular approach present attractive options for a potential U.S. course of action?*

*Should such a system include both commercial and noncommercial uses, or be limited to noncommercial entities?*

*How do extended collective licensing systems work in practice in the countries where they have been adopted?*

*Are there statistics or any longitudinal data regarding the success of extended collective licensing regimes, particularly vis-a-vis orphan works and mass digitization, around the world?*

*Would the U.S. political, legal, and market structures, which can be quite different from foreign counterparts, support an extended collective licensing-type solution?*

22. Extended Collective Licensing (ECL) has been established in other countries for some time, as indicated in the Copyright Office's Notice of Inquiry and the 2011 paper *Legal Issues in Mass Digitization: A Preliminary Analysis and Discussion Document*.
23. Such a scheme can include both commercial and noncommercial uses, assuming that the end use will be licensed appropriately, to ensure adequate remuneration to copyright owners.

Dr Audrey I McCulloch  
Chief Executive  
On behalf of ALPSP Members