KERNOCHAN CENTER
FOR LAW, MEDIA AND THE ARTS

COLUMBIA UNIVERSITY SCHOOL OF LAW

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U.S. Copyright Office
101 Independence Avenue, SE
Washington, DC 20559-6000

Re: Additional Comments Submitted Pursuant to Notice of Inquiry on Orphan Works and Mass Digitization, 79 Fed. Reg. 7706 (Feb. 10, 2014)

Dear Ms. Pallante,

We submit these additional comments in connection with the Copyright Office's ongoing inquiry on orphan works and mass digitization.

Is Legislation Necessary to Address Orphan Works and/or Mass Digitization?

In our reply comments of March 6, 2013,[1] we stated that potential users would be better served by a legislative solution to address orphan works and mass digitization rather than by relying on fair use. Subsequent developments – and in particular, the decision granting summary judgment in *Authors Guild v. Google*[2] and comments made at the March 10-11 roundtable discussions – confirm that belief. Fair use opinions, necessarily framed by the specific facts of the cases before the courts, fail to provide sufficient guidance for users. Many individuals and entities are unwilling to take the risks inherent in relying on still-developing case law relating to use of orphan works or mass digitization. Even with the ascendency of transformative use as a factor in fair use, the commercial nature of a use remains part of the statutory factors, so a fair use regime provides greater certainty for not-for-profit libraries and archives than it does for commercial actors.

[1] Available at http://www.copyright.gov/orphan/comments/noi_11302012/ Comment No. 15.
[2] 954 F. Supp. 2d 282 (S.D.N.Y. 2013), appeal pending (2nd Cir.).

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One of the articulated goals of orphan works legislation is to allow users to build on earlier works that would otherwise go unused because the right holder is unaware of or indifferent to his rights in the work. Relying on fair use runs counter to this goal. It favors noncommercial use over commercial uses, and gives an advantage to more aggressive institutions, particularly if they have protection under the Eleventh Amendment from money damages for infringement or they are prepared to expend vast litigation resources in support of their fair use claims. Some for-profit institutions are understandably inclined to be more cautious than Google, since they don't have a substantial fund to subsidize litigation. So too are some not-for-profits that bear the name of the founder or founders of a profit-making entity, who are concerned they may be seen as deep pockets despite the legal separation between the two entities. In short, reliance on fair use rather than on orphan works legislation will leave many orphan works tied up in risk-averse institutions. The public interest is better served by legislation of general application rather than by piecemeal litigation.

Moreover, in relying entirely on fair use rather than on specific exceptions, we as a society miss the ability to set out more comprehensive conditions and limitations than fair use allows, appropriate to balancing the legitimate interests of both users and right holders in determining when one may use a copyrighted work without the permission of the right holder. It is often said that once something is embodied in legislation it is "carved in stone." This can also happen with fair use. Once a particular activity is deemed fair use (or not) by a court of last resort, it is rare to see it once again be brought into the scope of rights, even if developing factual circumstances would suggest a different result. [3]

We continue to believe that orphan works and mass digitization should be treated separately for purposes of legislation. In this submission, when we refer to "orphan works" we mean works that someone would like to use (e.g., to create a translation, include in a documentary film) in a manner that would not qualify as fair use (notably, because the use would entail disseminating the entire work for its original purpose) but whose right holder cannot be identified or located. Diligent searches are an essential prerequisite to orphan works' status. Mass digitization involves the wholesale digitization of all or a significant part of a particular collection, generally without any attempt to locate right holders or clear rights. Parties undertaking mass digitization argue that the enormous scope of the undertaking prohibits a work-by-work search; in *Authors Guild v. Google* and *Authors Guild v. Hathitrust*,[4] the mass digitization was permitted because the users were not supplanting the original works by making

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[3] For example, Sony Corp. of America v. Universal City Studios, Inc., 464 U.S. 417 (1984) involved time-shifting of freely available over the air television programs, and is now used to justify space-shifting, private copying, etc.

[4] 902 F.Supp.2d 445 (S.D.N.Y. 2012), appeal pending (2d Cir.). The Hathitrust court did permit the libraries to make full text available to print-disabled individuals because it deemed that use transformative, but it emphasized that the print-disabled are only a tiny minority of the market. Id. at 464.

full-text available to end users,[5] but rather were allowing use of the database for data mining, word searches that yielded only "snippets," etc.

Fair use decisions can themselves lead to a "slippery slope." Neither Google nor Hathitrust asserted in recent litigation the right to make available the full text of copyright protected books they scanned (or that were scanned on their behalf). Yet some roundtable participants pushed for full text availability, participation of online libraries, individuals, etc., all of which will likely be the subject of litigation if fair use continues to supply the operative legal standard. Lines should be drawn, and they could be drawn better and more transparently in the context of legislation. It is not "undemocratic" to allow libraries and archives to enjoy exceptions to copyright that other entities or individuals do not have: they enjoy a unique and important role in society. This point is discussed at greater length in *The Section 108 Study Group Report* (Mar. 2008) at 14-15.[6]

With regard to orphan works, we support legislation along the lines proposed in 2008, which would allow use of an orphan work, including for commercial purposes, provided one has made a reasonably diligent search and complied with certain other conditions. If a right holder subsequently comes forward, she could collect no more than reasonable compensation; in the case of a library or archive, no money damages would be recoverable if the right holder's material was removed promptly. As we suggested in our earlier comments, there should also be protection for right holders with respect to works misidentified as orphans, particularly if that occurred because the ownership information was consciously stripped from the work.

Why Not Just Rely on Guidelines?

Some of the commenters in this proceeding contend that "best practices" can elucidate fair use and provide the guidance that users require, so that no additional legislation is required. Best practices can vary in their utility and legitimacy, however, depending on how they are developed. The various best practices that have been developed for different user communities over the last few years may be sincere attempts to describe circumstances in which each community perceives a need, within the context of its mission, to make free use of a copyrighted work. But a particular community's shared perception that uncompensated copying and communication of works of authorship is necessary or desirable does not suffice to make the use "fair," particularly if the interests of the user group align almost exclusively in favor of limiting

[5] E.g., Authors Guild v. Google, 954 F. Supp. 2d at 292-93.

[6] The Section 108 Study Group Report is available at http://section108.gov. Recognizing that the terms "libraries" and "archives" are understood more broadly now than they were when section 108 was originally passed, the Study Group suggested additional requirements for eligibility for the section 108 exceptions: "possessing a public service mission, employing trained library or archives staff, providing professional services normally associated with libraries and archives, and possessing a collection comprising lawfully acquired and/or licensed materials.

the scope of copyright, or if authors and copyright owners have been excluded from the process of formulating the "best practices." Moreover, depending on how best practices are formulated, they can be misleading.[7]

The suggestion made by some commenters and roundtable participants that librarians might go beyond what is fair use is not to disparage librarians. Librarians are almost always conscientious and responsible people, but they sometimes have conflicting obligations: to use and reproduce works in accordance with the law and to serve their users by providing them with the materials they seek in the most convenient form. Moreover, many current librarians have throughout their careers measured their use against section 108. Now that section 108 largely appears to be out of the picture, their decisions may well vary from what they have done in the past. In other words, past practices are not necessarily predictive of future decisions.

Finally, the concept of a "library" or an "archives" is changing. Depending on how broadly the terms are interpreted, the decision maker in such entities could be a data manager without the education and professional standards of current librarians. Again, past practices of librarians may not be predictive.[8]

In the course of the roundtable discussions, more than once a speaker attempted to defend the legitimacy of guidelines by contending that there has been no objection raised to decisions made pursuant to best practices. However, decisions made under guidelines have been challenged in the past: for example, Georgia State University completely revised its guidelines concerning online course materials when objections were raised by right holders, and its revised guidelines are the subject of an ongoing lawsuit. And whatever guidelines Hathitrust had in place with respect to identifying orphan works were implicitly challenged when ownership information concerning several of the works it identified as orphans turned out to be readily available. With respect to the recently-developed best practices, it's difficult to know whether there have been any challenges as the system is not transparent. Those guidelines are new, and right holders may not be privy to information about what materials libraries are treating as orphans or digitizing for use within a particular user group. In short, the experience with best practices is inconclusive.

Defining Search Standards

The U.S. Copyright Office should have a role in developing or reviewing guidelines for diligent searches. The Office can have a role in evaluating guidelines for fairness. Among the complaints raised by commenters is that clearing materials is too hard, it takes too long, it costs money. But those considerations must be measured against the uses that they seek to make.

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[7] See, e.g., Mar. 11, 2014 Tr. at 144-45 (statement of Janice Pilch).
[8] See note 6, supra.

We recommend that standards of diligent search be higher with respect to more recent works readily identifiable as such.

Role of Registries

Comprehensive registries (that is, individual registries or registries linked to other trusted registries) are desirable and should be encouraged, but participation should not be mandatory.

Types of Works Subject to Orphan Works Legislation

If there is to be orphan works legislation, we suggest that all types of works be made subject to it. Representatives of some sectors (e.g., music) have argued that their sector won't have orphan works because of existing databases. Assuming that is the case, it should be rare that a user could legitimately establish that a musical work is an orphan.

Types of Users and Uses

In connection with orphan works, we should not limit the types of users eligible for the limitation. Libraries and archives occupy a special position, and the earlier proposed legislation provided that if a library performs a diligent search and a right holder later comes forward, if the library promptly removes the material, it will not be liable for damages. In general, it is more appropriate that the scope of the search vary with the nature of the work, the nature of the use and the risk to the right holder. Neither an individual nor an entity should be excused from a reasonably diligent search if the proposed use could work substantial harm to the right holder.

Mass Digitization Generally

The legal right to mass digitize should be limited to certain organizations: not-for-profit libraries, archives, museums and similar trusted institutions. They should not be permitted to use the digitized works for commercial purposes, and they should be capable of preserving digital materials, maintaining security, and so on.[9]

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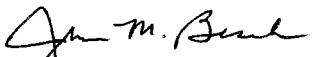
[9] See Section 108 Study Group Report, supra, at 39-42, 69-77.

We appreciate the opportunity to submit these comments, and look forward to continuing to work with the Copyright Office on issues concerning orphan works and mass digitization.

Respectfully submitted,



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