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To: Jule L. Sigall
Associate Register for Policy & International Affairs

Date: 03/24/2005

From: Joseph G. Walsh

Comment:
I'll try to make a more formal submission in the reply portion of this rule process, but I wanted to place at least some informal comments on the record now.

I applaud heartily the efforts of Marybeth Peters, the Copyright Office and Congress in examining the problem of orphan works. I am an attorney who has practiced copyright and trademark law for more than ten years. In particular for approximately seven years I advised clients while I was with the Law Offices of Dennis Angel (Scarsdale, NY/Washington D.C.) on the ownership and use of copyrighted works. Clients included major motion picture and television studios/networks as well as individual authors/producers. Some of my most frustrating times were when clients would seek to use an older and/or obscure work, but could not locate the owner of the work. We really could suggest no safe action (save for no action) that they could take to avoid or reduce potentially significant liability moving forward. And, of course, insurance companies for production companies and alike frown on insuring unknowable risks, thereby killing many projects in the very early stages of development. From my direct experience, I would characterize the orphan work problem as a significant one, in the number of times it occurred (it's been some time since I worked there, but I would estimate an average of over seventy five times a year in this high volume office) and in the difficult dilemma it presented to attorneys and others who wished to ascertain the rights of such works.

What was especially frustrating was that those who wished to utilize such a work(s) would usually be very willing to pay fair compensation for such uses. Obviously, rescuing works from the orphanage of neglect and oblivion is good for the original author, whose work gets to see the light of day (even if the author no longer sees said light); for the second and later users who can incorporate and expand upon creative works; and for society as a whole--which is meant to be the ultimate beneficiary of such creative endeavors.

Later I hope to write in more detail on this, but here are a few tentative comments on the kind of procedure that I would suggest. First, I would make the structure as simple as possible---for the benefit of the user---and try to limit the role of Copyright Office personnel---for their benefit (a wonderful group of people, but their resources have been and will most likely continue to be severely stunted despite the Office's importance).

Defining in the negative, I would not employ a registration regime as Judge Posner and others have discussed. I think that would run afoul of Berne, impose too great a strain on Copyright Office personnel/resources and unfairly penalize those who unknowingly forfeit rights by not registering (and maintaining) a given work---and in some instances the "owner" of the copyright may not even realize that they own the rights in such a work and/or that such a work is still protected by copyright. The most recent extension of copyright, regardless its prudence, exacerbates this scenario. I think the onus of a system dealing with orphan works should be on the user---not on the copyright owner (this may also relief the problem of no formalities on copyright conditions).

I think it would be useful to explore the Canadian licensing process further, but I balk at creating an intricate body to license such works. Also, I hesitate to have

such a body trying to determine, essentially, a kind of fair use rate, for a variety of works, involving numerous parties.

One possible approach (to be tinkered with substantially) is something like the following.

A party wishing to use a copyrighted work in a way that would otherwise violate existing copyright protections would file an Orphan Work Notice ("OWN"). This would consist of an statement by said party that they have a good faith intent to use the work and that they have taken reasonable steps to locate the copyright holder of the work and have failed. As part of the OWN, the filing party would be required to submit documentation indicating that they have completed a search of the relevant Copyright Office records, conducted by the Office or an approved outside entity. Part of this documentation would have to include some evidence of common law searching. Specific guidelines would be developed, including retention of the search records (filing statement retained by the Office; records of search maintained by the filing party).

Once the OWN was filed, the work(s) would be listed on a searchable, periodically updated, database at the Copyright Office (similar to the NIE's). This would allow significant (and other) owners of copyrighted works to monitor such a list to avoid their own works from being characterized as Orphan Works. Subsequent to this filing and notice publication, say six months, the filing party could utilize the Orphan Work, free from any copyright liability. Furthermore, should an owner assert rights after this notice publication date, but five years from the OWN publication date, the filing party would still be free from financial liability, but could be enjoined from using such a work moving forward. (It needs to be thought out whether a derivate works exception would be added allowing the filing party to create derivative works even after a copyright ownership is clarified, similar to the reaction to Stewart v. Abend, but probably not). Adjudicating those claims could follow a procedure similar to UDRP domain name proceedings. A filing party and the asserted copyright owner would present claims as to the validity of their search and ownership rights in said work(s) and a panel of up to three (possibly even just one) would rule on the validity of the claims in a streamlined process. As with domain name proceedings, the Federal District Court would serve as fallback forum, but would not be the primary adjudicator. There would be severe penalties for grossly negligent searching/fraud, but lesser penalties for simple errors. After ten years on the NOA registry, the work would be deemed to be free to use, subject to a contrary determination by a Federal Court during the pendency of the work's otherwise existing copyright term. And, a NOA filing which has successfully made it through the ten years could be used to protect the NOA filing party---and any subsequent parties--from financial liability---only injunctive relief would be available and there would be a derivative works exception for the filing party.

As orpan works are most troublesome with older works, I would limit the applicability of these OWN provisions, at least initially, to works created and/or published before 1978. This would also reduce the number of potential filings and claims relating to this class of works, while still dealing with the heart of the problem---the old, abandoned works which contemporary users are afraid to utilize given the current parameters of copyright liability. The applicability of these provisions could then be broadened and refined over time.

The above is just my experience and an initial reaction to possible ways of balancing the varied interests involved. Your call for comments raised many interesting questions beyond the scope of my commentary here, and I expect that the affected communities will present an array of interesting solutions. It's important work to be done though, and please feel encouraged in your efforts.

Thank you.

Joseph G. Walsh, Esq.