

Orphan Works Comment

Nature of “Orphan works”: Identification and Designation

At first glance, it would seem like the definition of an orphan work would be dependent on economic value. However, this is not really the case. The nature of an orphan work should be about the owner of the copyright. It is true that when something loses economic value, it becomes harder to locate the copyright owner. For example, this could occur when a company goes out of business. Economic value could also be relevant to measuring damages.

The burden of demonstrating that something is an orphan work should rest on the prospective user. Since an orphaned work has no “parent,” it is realistically not practical to put any burdens on the parent during the time the work is orphaned. Perhaps the burden placed on the user could be different if the work has a registration and notice. For instance, where a work has a registration and notice the copyright owner has obviously put forth more effort, so perhaps the user should carry a higher burden to locate the owner of the copyright.

It is not possible to say that any work that does not have a registration is an orphan work. However, if the work is not registered, it could be considered an orphan work unless a reasonable investigation could have been used to find the owner. Additionally, works that are registered can be orphaned if a reasonable search cannot locate the owner.

A person who wishes to use an orphan work should first have to conduct a reasonable search to locate the copyright owner of the work. Then the user should have to submit an “intent to use” with the copyright office. If the Copyright Office determines

that the effort in the search was reasonable, then the Office will set a reasonable compulsory licensing fee tailored to each individual case. Obviously there would be added costs to the Copyright Office to have to evaluate searches and determine licensing fees. But this system could differ from the Canadian system. The money from the compulsory licensing fee could go to fund the additional administrative costs for the Copyright Office. If the owner of the orphan work ever appears, she could receive the money from the compulsory licensing fee from the time of her appearance. She would not be able to receive the money from the licensing fee prior to her appearance. Although this may seem harsh, if the owner has not taken enough of an interest in her work to register it, monitor it, and “parent” it, then it could be said she hasn’t shown enough interest in her work until her appearance and thus, doesn’t deserve the past fees. It is as if the parent has abandoned her child and cannot make up for the memories she missed out on. Of course, once the copyright owner appears, she could still register her work. Her appearance removes the work from the category of orphaned work. This prevents everyone else besides the original user(s) from using it without violating the copyright.

Besides filing an “intent to use” with the Copyright Office, a user should have to put a notice in the work that it is an orphan work. If the work is to be published, this type of notice will prevent others from assuming the work is in the public domain.

Additionally, after receiving an “intent to use” from a user, that particular orphan work should be added to a database. The Copyright Office should maintain a database of all submitted orphan works in use. This database would become part of what is involved in a reasonable search. A user would have a duty, as part of his investigation, to search

the orphan works database to determine if the work is a true orphan work or if it is in the public domain. Users who come after the original user would have to perform their own searches. In that way, the original user would not carry the burden for the rest of the users that follow. Later users could see the notice in the orphan work and look it up in the database to find out when the work will enter the public domain. This database would add to the administrative burdens of the Copyright Office, but this can be offset by the compulsory licensing fees. Also, later users could be allowed to use the orphan work but they should also be required to pay compulsory licensing fees. The original user would not necessarily receive exclusive rights to the orphaned work.

It is anticipated that the database would not need categories. In this day and age of search engines like Google, most people know how to conduct effective electronic searches. If a prospective user does not, then it is that user's responsibility to learn - it becomes part of their burden of a reasonable search.

How would a copyright owner determine if someone thinks his work is an orphan work and wants to use it? When filing an "intent to use", a prospective user would have to reference the copyright registration if there is one, which would then go into the database. The prospective user would also have to send a representative sample of what he intends to use. For example, this could be a photograph or a copy of the work. Not only will this information appear in the database, but it will add to the collection of the Library of Congress. This would all be a part of the "intent to use," so the acts of filing and submitting representative samples would have to be considered not violations of the copyright. Obviously, if the owner of the orphan work is found or appears, the orphan

work is no longer orphan and would be removed from the database and the compulsory licensing fees would go to the owner.

Another way to improve the situation would be to make available to copyright owners the ability to file with the Copyright Office an intent to enforce the copyright. This would be completely optional and have no impact on an owner's ability to enforce her copyright. This would merely be something like an update – a notice of who the current owner is and where they are located. Owners who are especially serious about their works might take advantage of this opportunity. For example, this could be a way to get presumptive protection. It is true that a lot of companies, for example, do not care as much about their smaller assets. However, this filing would not be conclusive about ownership of copyright. It would merely be prima facie evidence that the work is not an orphan work. It would be purely minimal – a database. It would be an extra way to protect a work and a way to update an owner's contact information or indicate assignments and transfers. It could be compared to a "forwarding address" situation. It would have to be made clear that an owner does not have to participate. In addition, owners who have clear ownership probably would not want to worry about this at all. Of course, this could be considered not any different than re-registering. By filing with this supply-side database, an owner could also rebut the presumption that a user has performed a reasonable search.

A penalty would have to be implemented to prevent abuses of these databases. Statutory damages could be enforced for abusing the supply-side registry. This will help prevent fraud. If a person files with this database, doesn't own the work, and this false claim is detected, the offender would be subject to fierce statutory damages.

With regard to the demand side (the user database), there would be less incentive to lie because then the user could lose his right to use the orphan work. However, there would be incentive to lie about whether or not he has performed a reasonable investigation. If it was determined that a user did not perform a good faith reasonable search, lied to the copyright office, and thus defrauded the owner, the copyright owner should be able to sue the user for everything he would normally be able to get, plus extra punitive damages. In other words, the offending user is not protected and is more liable than a normal infringer. Also, if the copyright owner does not sue the offending user in a reasonable time, the copyright office can sue in place of the copyright owner. Additionally, in both circumstances, the offending user would not be permitted to use the orphan work.

It is likely that potential commercial users will want some sort of declaratory judgment on their ability to use an orphan work. Usually, it would be presumed that the use of an orphan work is fair use, so liability would only come along when a user wants to use it for commercial use. If it is fair use, a declaratory judgment is not needed. However, if it is for commercial use, the user can go to the courts for a declaratory judgment.

For non-commercial and non-profit users, it might be desirable to set a cap on damages if an owner comes along later. This cap on damages would be for cases where it is found that the search the user conducted was not reasonable, but in good faith. Of course, in a non-commercial case it would be hard to find any damages at all. There would be no statutory damages and actual damages would likely be low anyway. The normal remedies would be in place because if the owner appears, the work is no longer

orphaned. In other words, the reasonable search standards are the same for commercial and non-commercial users, but a non-commercial user will not have to worry about getting a declaratory judgment because the damages would be much lower.

Furthermore, people who reasonably rely on a statement that something is an orphaned work (for example, a user tells Kinko's that something is an orphan work and gets a copy made) should be protected from damages.

Nature of "Orphan Works": Publication Status

It should not matter whether a work is published or not to receive orphan work status. People have copyrights on unpublished works. Many of the problems with orphan works are with the unpublished ones.

International Implications

Finally, with regard to any international considerations, the most drastic thing could be to argue that the Constitution trumps treaties. It could be argued that complying with the Berne Convention contradicts the Constitution in making it more difficult to promote the progress of science and the useful arts. This would solve problems in respect to the ability to have a registration system and other formal requirements that might alleviate the problem of orphan works. However, this is an extremely far-fetched argument.