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March 25, 2005

Jule L. Sigall
Associate Register for Policy & International Affairs
United States Copyright Office
Via orphanworks@loc.gov

Re: Notice of Inquiry concerning "Orphan Works"
70 Fed. Reg. 3739-43 (January 26, 2005)

Dear Mr. Sigall:

I write in response to the Copyright Office Notice of Inquiry concerning "Orphan Works," dated January 26, 2005. The Copyright Office is to be commended for undertaking this important inquiry. In private practice and, more recently, in my work at the Kernochan Center for Law, Media and the Arts at Columbia Law School, I have encountered instances in which works were not used (or projects not pursued) because of the difficulty in contacting copyright owners. Users who would be willing to pay a license or permissions fee are sometimes unwilling to proceed with a use if there is a possibility that the copyright owner will later surface and force them to pay a fee out of proportion to the use, or halt distribution altogether.

While it is worthwhile to try to find a means to encourage uses of works that are genuine "orphans," it is important to safeguard the rights of authors. Sometimes the copyright owner cannot be located because she is completely unaware of her rights in the work, or inattentive or indifferent to them. But there are many other reasons as well. The author or her heirs may be assuming other family members are handling rights issues, particularly where the author or her surviving spouse is elderly, recently deceased or the family is otherwise in transition; the user's inquiry may never reach the author because it "dead ends" with an employee of a publisher or studio who is unable or unwilling to provide information about the author; or the user may fail to uncover the name or contact information of the author due to an incomplete, albeit well-

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meaning, attempt to locate her. How do we protect authors and their heirs in such situations? The problem is most acute where the use is one that would preclude other uses the author might wish to make or authorize, or where the use (e.g., the nature or context) is not one that the author would have agreed to license.

It is essential to have more information about the scope of the problem to determine how best to address it. The Notice of Inquiry will likely yield many examples of users who have encountered difficulties in locating copyright owners. It is important to consider carefully the nature of those difficulties, and how they were ultimately resolved. Specifically: (1) When have would-be users been deterred merely by the prospect of having to undertake a search, without actually commencing it? (2) When has a fruitless search for the author deterred use of a work? (3) When has a fruitless search led to modifications in the nature of the use (e.g., a more abbreviated or modified use to allow greater reliance on fair use)? (4) When, after exhausting “due diligence” efforts, has the user nevertheless proceeded with the planned use? In such cases, what has been the user’s experience with regard to authors or artists later coming forward to object? There are organizations that deal with orphan works on a regular basis; it would be helpful to seek their input if they do not file comments

It is also essential to have more information concerning the difficulties encountered in identifying and locating authors. What due diligence efforts do users make, and where does the trail grow cold? Sometimes the problem is that ownership is ambiguous (e.g, it’s unclear whether the work was for hire, or whether the relevant rights were within the scope of a contract), as discussed further below. But it is also possible that users are unaware of potential sources of information about authors, and the Copyright Office could play a useful role in collecting information about potential ways to track authors and other copyright owners, providing suggestions or guidelines to users seeking to clear rights. It may also be possible to develop additional information sources (e.g., a registry or other database) to assist users in locating authors, although, as discussed below, registration by copyright owners should be optional.

Ironically, although the orphan works issue is attributed in part to the diminution of information available to users now that copyright registration and renewal are no longer required, the pre-1978 copyright records are apparently of limited use. I understand from attorneys who supervise rights clearance on a regular basis that they often do not require a search of the pre-78 Copyright Office records as part of “due diligence” due to the time and resources involved in such a search. Perhaps digitizing the pre-1978 records could facilitate efforts to locate copyright owners and reduce the scope of the “orphan works” problem.

1. Nature of the Problems Faced by Subsequent Creators and Users

My recent experience of “orphan works” problems has been in the context of digital libraries and preservation initiatives. For example, a few years ago the Kernochan Center was asked to assist in formulating a proposal to create a digital dance library that would serve as an

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educational and reference tool for dance teachers, students and scholars. The library, which was to include video clips of dances noteworthy for their choreography, participants, or historic significance, was to be made available online to registered users. The Center's role was to consider the rights issues and how they could be addressed. It became increasingly apparent that the project would involve complicated clearance issues. Those issues were not limited to copyright, but copyright was a central concern. In many instances, it was impossible to identify the author, much less locate her. Some of the video clips that the organizers sought to include were of unidentified origin, probably made informally by a member of a dance company or its staff; in some, neither the underlying musical composition nor the musicians could be identified; others were of foreign origin with little information as to the creator of the film, the date of creation and so on. While copyright privileges might allow some limited use of the clips, there is little doubt that the inability to identify and locate the copyright owner in such circumstances would be a significant factor in deciding which clips would be used, and the manner of use. That particular digital library project did not go forward for various reasons, but I understand another, similar project is being planned.

In private practice I was involved in an assessment of rights in short stories and articles written for a now-defunct magazine over a span of more than fifty years. Many of the pieces in the magazine had significant potential for republication or adaptation, but it quickly became clear that there were many ambiguities about the rights: Which pieces were works made for hire, and which were used pursuant to license? Even where it was established that there were licenses, those licenses could sometimes not be found, and when they could be found, the scope of permitted use was sometimes ambiguous. Issues concerning renewal rights presented another layer of complication. Even when we were able to identify the author or her heirs as the current copyright owner(s), we faced the prospect of locating them based on incomplete, aged records. At the time I was involved in the matter, the earliest issues of the publication had passed into the public domain (clarifying matters as to material published in those issues), but the CTEA loomed on the horizon, and was passed shortly thereafter.

These are but two examples, but they illustrate the layers of complexity that can be involved in clearing rights. The difficulty may lie as much (or more) in determining as a factual and legal matter who the copyright owner is, as it does in locating an identified copyright owner.

2. Nature of "Orphan Works": Identification and Designation

I offer below a few observations on the possibilities raised in the Notice of Inquiry. It would be premature for me to make specific recommendations on how to address orphan works issues without an opportunity to consider the evidence of other respondents to the Notice of Inquiry who have had more experience with orphan works.

First, any designation of a work as an "orphan work" should be made only after a bona fide effort to identify and locate the author or other copyright owner. The burden should be on the user to establish the conditions precedent to use of the work, since it is the user who is in

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effect seeking relief from the requirement to get permission to use it. I hope that one outcome of this process will be to provide guidance to users as to what constitutes a bona fide effort to locate an author (which will likely vary according to the type of work involved).

Second, I question whether the Canadian approach would be a workable solution to the orphan works problem in the United States. Formal clearance procedures of this nature would require expenditure of significant time and resources even if no copyright owner ever comes forward to object. Although it is not clear how many people would likely avail themselves of such a procedure, I suspect it would create a bottleneck. It would likely require considerable lead time, and unfortunately, many uses cannot be anticipated far in advance.

Third, one possibility raised in the Notice of Inquiry is the adoption of a system in which the would-be user files a notice of intent to use an unlocatable work. The relevant question, of course, is the effect on the rights of an author who fails to register a timely protest. A system that places the burden on an author to regularly monitor a publication and risk losing rights unless she files an objection within a narrow time window is very troubling. I have heard this proposal compared to the *Official Gazette (OG)* in which notices of proposed trademark registrations are published. However, the comparison is not apt: a mark doesn't reach the *OG* until a PTO examiner has determined that there is no likelihood of confusion or other reason why the mark should not be registered; failure to file a notice of opposition does not lead to loss of an existing trademark registration, nor does it preclude a trademark owner from later seeking cancellation of the offending mark; and trademarks are usually owned by commercial entities that employ assistance in policing their marks. Moreover, a system that penalizes copyright owners who do not ceaselessly monitor their rights might facilitate massive, systematized efforts to deprive them of those rights.

Finally, the Notice of Inquiry also raised the possibility of some form of registry. While a registry could provide a useful tool, registration should be voluntary. Authors' rights should not be contingent on periodic registration. These issues were thoroughly aired in the course of passing the Copyright Act of 1976 and the Copyright Renewal Act of 1992.

3. Nature of "Orphan Works": Age

While a work can be an orphan work regardless of age, the older it is, the less likely it is that an author or her heirs will come forward, or that a use will harm their economic interests. The age of a work and the time from publication figures into the scope of protection in certain aspects of the Copyright Act, e.g., 17 U.S.C. §108(h), §302(e), and also in the UK statute cited in the Notice. If an orphan works provision were to place some kind of obligation on authors in order to retain rights, or create a presumption in favor of use along the lines of the UK or U.S. provisions cited above, an age limitation would be appropriate.

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4. Nature of “Orphan Works”: Publication Status

It is the author’s right to determine whether and under what circumstances to publish her work. An “orphan works” designation should not deprive an author of that right.

Can a distinction between published and unpublished works be maintained in addressing the “orphan works” problem? My own experience suggests that in many cases the work at issue will have been published, for the user will encounter it through an old book, newspaper or magazine. In other cases, a reasonable inference can be made that the work was not published. Nevertheless, it is sometimes impossible to know whether a work has been published or not, and I suspect that some of the material that users find most difficult to “clear” is unpublished material. But fundamentally, the question is where the presumption should lie in the case of a work that may or may not have been published, and – subject to additional information that may be submitted in the course of this inquiry – I believe the balance should be drawn in favor of the author in such cases. Perhaps special consideration should be given to a user who can demonstrate that under the circumstances, the user reasonably believed the work had been published.

5. Effect of a Work Being Designated “Orphaned”

An “orphan works” designation should be made on a case-by-case basis. An author who later comes forward should not find herself divested of copyright or prevented from taking action against future unauthorized uses in other contexts. The troubling question is how one balances the equities as between a user who has invested time and effort in developing a derivative work, and an author whose ability to license the work is significantly impaired by that use. The lower the threshold showing necessary to have a work deemed an orphan, the greater the problem this becomes. While the “reasonable royalty” proposal is a constructive effort to address this issue, difficult questions remain where the use precludes other uses, or the author would have chosen not to license this use.

6. International Implications

Since I have not recommended a proposed solution at this time, I will not speculate as to whether the various permutations of possibilities raised in the Notice could be made consistent with the Berne Convention and other international treaties to which the U.S. is a party. We must of course be mindful of our treaty obligations in constructing any proposal that conditions rights on registration or imposes what is, in effect, a compulsory license. While Berne permits differential treatment of U.S. works, it would be unfair (and impractical) to impose a different regime on works of U.S. origin.

Finally, if any legislation is proposed to deal with “orphan works” issues, careful consideration should be given to the effect on existing clearance practices.

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Conclusion

There is no simple way to resolve the problems raised by orphan works. The greater the certainty we provide to users, the greater the likelihood that we will unjustly deprive authors of valuable rights. Consideration should be given to a multi-faceted approach to the problem, e.g., (1) improve the quality of information available to users by digitizing existing Copyright Office records, and possibly by creating new information resources to enable more efficient identification and location of authors and other copyright owners; (2) provide education and guidance for users concerning avenues available for finding copyright owners; and, assuming it is warranted by the evidence, (3) create limited legislative relief to reduce the risk for those who have made a bona fide attempt to locate the author of a copyrighted work, without success. Specific suggestions as to legislation must await further information on the scope of the problems raised.

Thank you for the opportunity to submit these comments.

Sincerely,

June M. Besek