

Via Electronic Submission

March 25, 2005

Mr. Jule L. Sigall
Associate Register for Policy & International Affairs
U.S. Copyright Office
Copyright GC/I7R
P.O. Box 70400
Southwest Station
Washington, DC 20024

RE: Inquiry into “Orphan Works”

Dear Mr. Sigall:

We are pleased to respond to the inquiry of the U.S. Copyright Office with respect to “orphan works.” The five of us submitting this comment share the distinction of holding positions of responsibility for copyright issues affecting the teaching, research, and service at American universities. We are attorneys, librarians, and academic administrators who manage copyright and related intellectual property issues for universities and libraries. We also teach copyright law to faculty members, librarians, students, and others within our own institutions and throughout the country. Our efforts center on understanding and articulating proper uses of copyrighted works, balanced with important rights of ownership. In these efforts, we have encountered increasing difficulty in developing reasonable and workable solutions to growing concerns surrounding “orphan works.”

The problem of orphan works has escalated with the increased duration of copyright and automatic protection for a vast range of works that are “original” and “fixed.” As the law has expanded the scope and range of copyrighted works, the law also has produced numerous and increasing examples of works with unidentifiable or unlocatable owners. U.S. copyright law now grants protection, but nothing in the law requires owners to identify themselves. Researchers, teachers, librarians, publishers, and other users of copyrighted works might never identify or locate the owners of many old and new works. Yet as we pursue our projects, owners may locate us and raise the specter of complex and costly litigation or other legal challenges. Moreover, numerous uses in the academic and library communities involving preservation, teaching, learning, and other socially crucial activities may not always fit within fair use or other copyright exemptions, inhibiting opportunities to assess alternatives in light of potential risks.

We in the academic community therefore often need permission for many uses of copyrighted works. The realistic opportunity to seek that permission evaporates if the copyright owner is unknown or unknowable, leaving the work as an “orphan work.” In a later section of this comment (see *Nature of “Orphan works”: Identification and*

Designation) we suggest definitions of “orphan works,” along with specific and common examples.

On February 28, 2005, the signatories of this comment gathered in Indianapolis, Indiana to discuss orphan works and to fashion a response to the Copyright Office. We hope that our reply will support the efforts of the library and academic communities to further the creation and preservation of learning and knowledge for the public benefit. We also seek to safeguard the important rights of copyright owners. Indeed, our universities are the creators and owners of important copyrighted works. This comment does not respond to the multiplicity of complex issues raised in the Copyright Office’s notice of inquiry. We focus on issues with which we have had significant and direct experience as we work within the academic and library communities.

Accordingly, we will emphasize points that we hope will be most helpful as the U.S. Copyright Office presents perspectives and issues for congressional consideration. We begin with a set of principles and recommendations that we believe can lead to a workable solution to the problem of “orphan works.” The remainder of this reply follows the outline of issues raised by the Copyright Office in its notice of inquiry.

Principles and Recommendations

We recommend that the Copyright Office support the creation of a new statutory exemption that would allow the public to use orphan works. We propose that the law place the responsibility on users to determine whether the work is an “orphan work” pursuant to statutory definitions. Our recommendations would offer important opportunities for users, but it would also place responsibilities and on them and protect the interests of copyright owners. We offer the following specific recommendations.

1. The new exemption (“Section 123”) might begin with the following language: “Notwithstanding the provisions of section 106, the use of an orphaned work, including such use by reproduction in copies or phonorecords or by any other means of use within the rights of the copyright owner, is not an infringement of copyright.”
2. The definition of “orphan works” should include works whose owners are unidentifiable, unlocatable, and unresponsive as discussed more fully below later in this reply (see *Nature of “Orphan works”: Identification and Designation*). The legislation should require that users of “orphan works” conduct a “reasonable investigation” to reasonably conclude that the work is indeed an “orphan work.” Adopting the standard of “reasonable investigation” is consistent with existing 17 U.S.C. §108.
3. The definition of “orphan work” should apply to both published and unpublished works.

4. The provision should pose no limitations based upon the age of the work. Most important, for reasons stated more fully below (see *Nature of "Orphan Works": Age*) the right of use should not be confined to any pre-determined "final" years of copyright duration.
5. The provision should not require any form of public admission or affirmative declaration about the use. For example, a book that reprints an "orphan work" should not have to include a printed declaration to that effect. Users should not have to record any public document or other statement of use. Any such system requiring "public declaration" would invite false claims of ownership or other unjustifiable inhibitions on the effort of users.
6. Fair use and other exemptions in existing law must remain viable and in effect and available for application apart from any new exemption for "orphan works." Indeed, to effectively resolve "orphan work" problems, any legislative solution should afford greater protections for uses of an "orphan work" than currently allowed under fair use and existing exemptions.
7. The exemption should apply to profit or non-profit uses. Indeed, fair use applies to many for-profit uses, and without the important work of commercial publishers, the public would not have access to many works of history and biography that routinely depend upon fair use. Similarly, a commercial publisher should have some rights to use "orphan works."
8. The exemption might distinguish between "changeable" and "unchangeable" uses. A changeable use could consist of a work in which the use of the "orphan work" could be altered or deleted without undue harm. For example, a work posted to a website could be quickly removed. An unchangeable use would consist of a work in which the use will continue indefinitely once it has occurred. For example, if an "orphan work" is reprinted in a book, future editions may be changed, but existing copies would continue to be available indefinitely in bookstores, libraries, and private collections.
9. The distinction between "changeable" and "unchangeable" uses might help define initial rights of use. For example, if the use is "unchangeable," the statute could refer users to an application of fair use or other rights of use, with the allowance of greater breadth or flexibility in application (notably for "preservation and security" purposes as specified in 17 U.S.C. § 108 (b)). If the use is "changeable," we would recommend a relatively sweeping provision that would allow broad and relatively unfettered use, knowing that the use could be terminated as warranted based on later developments.

10. The distinction between “changeable” and “unchangeable” uses might help determine the appropriate remedies to apply should a rightful owner become known and assert a claim. For example, if the use is “changeable,” perhaps the remedy might begin with a “notice and takedown” system comparable to the approach in 17 U.S.C. § 512. Failing that effort, only then should more significant remedies apply. If the use is “unchangeable,” remedies may be prospective, allowing an injunction against future uses and perhaps other remedies if the use does not cease. Further, for “unchangeable” uses, if monetary damages for past uses are permitted at all, they should be limited solely to reasonable royalties. The notion of “reasonable royalty” has been addressed extensively in patent law and other intellectual property litigation.
11. If the user conducts a “reasonable investigation” to identify, locate, and contact the copyright owner, such investigation may commonly include a search of the registrations of the Copyright Office. Registration may entitle the owner to statutory damages and attorney fees. However, a registered work can still be an orphan work if ownership has changed or if the owner is currently elusive. Therefore, we recommend that those additional damages not apply to uses of orphan works.

The remainder of this letter follows the outline of issues as raised by the U.S. Copyright Office in the notice of inquiry.

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

The expanding array of works eligible for copyright, combined with the automatic vesting of rights, has exacerbated the “orphan works” dilemma. As a practical outcome, U.S. copyright law has necessitated an operating assumption that nearly all works created within the last 100 years (and sometimes beyond) are protected under the law. Often, the ability to identify, much less locate, a copyright owner for an early work is impossible. That problem becomes even more acute when we recognize that the duration of copyright for older works is often difficult or impossible to determine; much of the information and documentation necessary to determine copyright duration is often lost.

The resulting problem can be summarized in one succinct statement: The potential user of the work is often forced to choose between forgoing the use altogether or accepting the risk of copyright infringement. When a user resolves that a work is likely protected by copyright—but the owner is unidentifiable, unlocatable, or unresponsive—the user must make a disturbing choice. One alternative is to abandon the project, and with it the advancement of creativity and knowledge. The other choice for the user is to proceed with the use and incur the potentially monumental consequences of a copyright claim. Either alternative may result in a loss to users, to owners of the works, to the members of the public who would otherwise benefit from access to the new work. Also at risk is the forging of a new generation of creativity built upon works of the past.

The academic community routinely faces dilemmas related to orphan works. Often the creative teaching and research projects at our colleges and universities compel us to evaluate strategies for handling orphan works, without omitting them from the project.¹ Users might consider these possibilities:

1. Reconsider fair use. When the copyright owner is not available, perhaps the owner is not asserting a market. Hence, the use may be more likely within fair use. On the other hand, some preservation and other efforts of great social consequence may still lie beyond the protections of fair use. This outcome does not lessen the importance of these efforts. It simply suggests that we must adopt new models to address these uses and their relationship to “orphan works.”
2. Replace the materials with alternative works. Alternate materials on some occasions will provide equal learning opportunities or achieve other user goals in making use of protected works. At other times, however, substitute materials will not serve the needs of the user or will unduly compromise the user’s goals. Some protected works are chosen because of their unique qualities.
3. Alter the planned use of the copyrighted work. The user might copy only clips and portions of the work in an effort to comply with fair use or another exemption, or the user might deliver the works to a more limited audience. Again, substitute plans may not meet important needs in many situations. Teaching, learning, scholarship, and preservation activities sometimes require the use of the whole works or none at all. Not all activities are scalable in that sense.
4. Conduct a risk-benefit analysis. The user will need to determine the relative risks of proceeding against the costs of doing nothing. Unfortunately, doing nothing is often the more defensible outcome in light of many ambiguities inherent in the orphan works conundrum. Moving forward with projects of even well-defined and clear social merit is difficult to justify in the face of potentially enormous liabilities. Moving forward with a major project might also require enormous investments in technology and human resources, only to have the effort scuttled by copyright dilemmas.

The fact that such strategies have needed to evolve only underscores the importance of a solution to this growing concern. These strategies also reveal the sometimes formidable efforts we have expended to work within existing law. We have made these efforts when copyright owners are not available, and consequently when the planned uses of the copyrighted works are not likely to engender any realistic concern from the owners.

¹ One member of our group has written an advisory paper on these points. Kenneth D. Crews, “When You Cannot Get Permission: Dealing with the ‘Dead End’ of a Copyright Quest” (see <http://www.copyright.iupui.edu/permdeadend.htm>).

2. Nature of “Orphan Works”: Identification and Designation

The definition of “orphan works” is crucial to solving the problems associated with their use. A narrow definition will render the solution relatively useless. If the solution does not have a practical scope of application, librarians, teachers, scholars, student, and others will turn instead to fair use and other statutory exemptions. A broad definition, by contrast, might undermine rights of ownership that are central to the policy framework of copyright law.

We accordingly suggest three categories of orphan works that could be defined by statute. While these definitions begin the process of identifying works that would be subject to a right of use under the Copyright Act, each definition also implicitly offers important protection for the copyright owner. Specifically, the copyright owner in most ordinary situations has the authority to revise a work’s status as an “orphan.” A copyright owner is able at any time to register the work with the U.S. Copyright Office or to make other public claims of ownership. A simple and current registration will in most cases be sufficient to identify the owner and facilitate communications from prospective users of the work. Our three proposed definitional categories are:

1. The copyright owner is “unidentifiable.”

This situation is astonishingly common, and the following examples illustrate the various ways that it often arises. (1) A researcher is writing history or biography, and needs to quote from manuscripts and diaries, or needs to reprint a family photograph or early street scene. Multitudes of such materials are the foundation for the advancement of knowledge, yet they often offer no clue whatsoever of their original authors or current owners. (2) The researcher knows the name and identity of the original author of such materials, but that person died long ago. Determining the identities of current copyright owners can depend on investigations of probate files and birth records. Discovering the critical facts may be possible, but far outside the reasonable abilities of most researchers. (3) The original author may, for example, have been a professional photographer. The researcher may know that name, but cannot determine decades later whether it is a personal work or a work made for hire for a photo studio. In any event, the individual is now deceased, and the company is long out of business. Again, the facts are far out of reach. More likely, the facts are lost when files and records went into the trash many, many years ago.

2. The copyright owner is “unlocatable.”

In extraordinary cases, the user of the copyrighted work may actually have the factual information to identify the copyright owner. The researcher may know the name of the original author, may know that it was not “for hire,” and may identify subsequent generations who now share ownership of the copyrights. But the heirs, issue, extended family, and other beneficiaries are scattered. Their names and addresses shift and drift in the normal course of life. As a result, the proper owner of the copyright may no longer be discernible and certainly not locatable with any assurance.

3. The copyright owner is “unresponsive.”

This situation is most frustrating to users. A teacher, librarian, researcher, publisher, or other user may have “identified and located” the actual or likely copyright owner. The user may have conducted thorough and diligent investigations and made a proper attempt to contact the owner for permission, but the owner does not respond at all. It is true that a copyright owner has no obligation to reply to all requests. In many cases, however, circumstances can suggest that the last known location of the owner is no longer valid information, or that the owner simply does not care. A request to the famous author J.D. Salinger may stir no reply, but a researcher cannot conclude that he would not care about the uses of his works. By contrast, the lack of a response from “Joe,” the distant relative of the author of a letter written in the 1920s, may suggest that we simply cannot find Joe, or that Joe does not care about asserting his copyrights. In that case, the lack of a reply should not prevent the public from learning and benefiting from the historical or teaching value of the letter.

If a work fits into any one of these categories, it will be deemed an “orphan work” and subject to the substantive rights of use allowed under this proposal. Whether a work is in a category will depend on particular facts surrounding the work and the availability of the requisite information after a “reasonable investigation.” Consequently, whether a work is or is not an “orphan” may change with changing circumstances. For example, an owner may at one time be “unlocatable” or “unresponsive,” but that owner might later learn of a use and subsequently contact the user. As a practical effect, that contact can transform the work from being an “orphan,” at least with respect to that specific user. Should the owner register the claim with the U.S. Copyright Office, the owner may have avoided the “orphan” label with respect to many or all other future users.

Existing law already calls on users to make “reasonable investigations” for some activities. For example, 17 U.S.C. § 108(e) allows a library to make copies of full works following a “reasonable investigation” of the market. We propose building upon that concept in the solution for orphan works. A “reasonable investigation” can depend on the circumstances of each situation. Sometimes a copyrighted work may contain a notice or other identifying information that could lead to a search of publicly available records and resources. In other situations, the work may have no indication whatsoever about the

author, no clues of origin, no distinctive marks, and no other facts that could even lead to publicly available records. That dilemma is common for a wide range of modern works that receive automatic protection, and it can be equally problematic for older works.

For example, many works that libraries want to digitize and preserve for future generations offer little context to even begin an investigation. Such works may be either published or unpublished. They might be slides, photos, illustrations, or numerous other types of works that simply lack any information about their provenance. Equally common are works that have some rudimentary information about the original author, publisher, or other owner. Yet the author has died. The publisher might have been sold several times over or dissolved through bankruptcy or liquidation. The company might simply have ceased to exist, leaving no trace of assets, arrangements, or artifacts. Such outcomes can haunt the progress of knowledge and become complete impediments to use. Copyright consequently becomes a burden on creativity and upsets the balance between right of owners and the public interest.

3. Nature of “Orphan Works”: Age

We appreciate that many commentators in this inquiry will urge a definition of “orphan works” based exclusively or primarily upon factors such as date of creation, age, durations, or other factor relating to time. We strongly urge the Copyright Office to resist such recommendations. They may appear sympathetic and logical, but they may become largely unworkable and undermine the effectiveness of this effort to reform the law as it affects “orphan works.”

Consider this situation: A user has in hand a work for which no copyright owner can be identified. The user will also often be unable to identify the year of the work’s creation or publication. The work may be in an old book in the library, and we might surmise approximately its age from that context. That same work might also be on a website, and its provenance—with rich clues about age—becomes lost. The work might instead be a loose document in a file, and the yellowing paper could be from a distant century or only several years old. A useful legislative solution could not expect a user to conduct the scientific analysis necessary to reach a firmer conclusion.

A commentator might draw an analogy to 17 U.S.C §108(h), which grants certain right to libraries to use works that are in the final 20 years of copyright protection. Such a proposal likely would not provide an adequate foundation for effectively addressing “orphan works.” Determining the duration of copyright protection for many early works is sometimes impossible. The rules may appear superficially to be simple arithmetic. In reality, copyright duration frequently depends upon numerous variables and extensive factual circumstances that are beyond the user’s reach.

These variables are often uncertain and can include:

- When and where was the work created?
- Who created it?
- Did the author retain ownership or “effectively” assign it?
- Was the work a work-made-for-hire?
- Where was the work published?
- Was the work “published” at all?
- Was the “publication” of a “limited or general” nature?
- Was the work subject to certain international treaties?
- Was the work published with “notice” on the original publication?
- Was the work properly renewed; and much more?

Unfortunately, reaching a reasonable conclusion about a work and its status and duration can depend upon significant legal research and can necessitate close investigation concerning facts and circumstances related to the original creation of the work. If a user cannot determine the duration of copyright, then that user cannot determine reasonably whether the work is in its final 20 years of duration.

More fundamentally, even if determining duration were realistically possible, such determinations often remain far outside the capabilities of individual teachers, librarians, researchers, or other members of the public. In fact, such determinations are often beyond the ability of copyright experts, simply because many crucial facts are lost to history.² As a result, the law effectively bars identification of the public domain, leading users to believe they need permissions. Hence, users are caught once again to struggle with identifying and locating the copyright owners.

4. Nature of “Orphan Works”: Publication Status

A workable and useful statutory solution addressing “orphan works” should not limit that definition to published works. Unpublished works are of equal, if not greater, importance in making some of the most socially valuable uses that are hindered by the “orphan” status of a work. Indeed, many of the most important examples involve the use of unpublished works: clippings, letters, journals, and other artifacts; family photographs and scrapbooks; reports and studies prepared by defunct organizations. Moreover, these examples most often involve planned uses that pose no recognizable harm to any likely copyright owner.

² One member of our group has recently published an article on exactly this point, offering considerable additional detail about the problem of determining copyright duration. Kenneth D. Crews, “Copyright Duration and the Progressive Degeneration of a Constitutional Doctrine,” *Syracuse Law Review* 55 (2005): 189-250.

5. Effect of a Work Being Designated “Orphaned”

Our recommendations for the substantive treatment of orphan works are included in the “Principles and Recommendations” detailed earlier in this comment.

6. International Implications

We do not believe that an exemption for the use of orphan works would offend the requirements of Berne or of TRIPs. We do not offer a full analysis at this point, but rather highlight the following:

1. We are not recommending the creation of any formalities as a condition to copyright ownership. In order to facilitate the identification and location of copyright owners, they may well be encouraged to register their works. We believe that encouraging registration is good policy for owners and users. Current U.S. law includes other provisions that encourage registration, and they do not appear to violate our international agreements.
2. Exemptions to the rights of copyright owners are allowed under Berne and TRIPs. Consistent with those agreements, we believe that an exemption for orphan works, specifically defined, will be applicable only “in certain special cases.” Also consistent with the agreements, an exemption for orphan works will not conflict with the “normal exploitation” of the work and will not “prejudice the legitimate interests” of owners. A reasonable search for the owner, or the quest for permission, will most certainly have disclosed whether the owner is actively exploiting the materials or has asserted an interest in the use or nonuse of the work.

In conclusion, the issue of orphan works must always be framed within the context of the constitutional purpose of copyright. Our recommendations seek to strengthen the advancement of knowledge and innovation while maintaining and preserving the rights of copyright owners.

Thank you for this opportunity to submit our recommendations and perspectives on these important issues. If we can be of further assistance in this endeavor, please do not hesitate to contact us.

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