

February 4, 2013

Ms. Maria A. Pallante
Register of Copyrights
U.S. Copyright Office
101 Independence Avenue, SE
Washington, DC 20559-6000

Re: Docket No. 2012–12
Comments Submitted Pursuant to Notice of Inquiry Regarding
“Orphan Works and Mass Digitization,”
77 Fed. Reg. 64555 (Oct. 22, 2012)

Dear Register Pallante:

The American Intellectual Property Law Association (AIPLA) is pleased to offer comments in response to the U.S. Copyright Office Notice of Inquiry entitled “Orphan Works and Mass Digitization” (the “NOI”), as published in the October 22, 2012 issue of the Federal Register. 77 Fed. Reg. 64555.

AIPLA is a national bar association whose approximately 14,000 members are primarily intellectual property lawyers in private and corporate practice, in government service, and in the academic community. AIPLA represents a wide variety of individuals, companies, and institutions involved directly or indirectly in the practice of copyright, patent, trademark, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

Based on our review of the NOI, AIPLA offers the following comments.

1. AIPLA supports additional legislative, regulatory and voluntary solutions to address the use of Orphan Works on an occasional or case-by-case basis.

As noted in the NOI, an “orphan work” is a work protected by U.S. copyright law, for which a user cannot readily identify and/or locate the copyright owner in good faith, in a situation where permission from the copyright owner is necessary as a matter of law. 77 Fed. Reg. at 64555. Under current law, anyone who uses an orphan work without permission runs the risk that the copyright owner may appear and bring an infringement lawsuit for damages, attorneys’ fees, and/or injunctive relief unless a specific exception or limitation to copyright applies.

AIPLA supports legislative amendments to the Copyright Act which limit the remedies available to the owner of the copyright in an orphan work in circumstances where the user has conducted a reasonably diligent search in good faith for the copyright owner. The legislative scheme: (1) should require any search for a copyright owner to take place *before* use of the orphan work; (2)

should provide for regulatory and voluntary development of standards for what constitutes a “reasonably diligent” and “good faith” search; and (3) should limit copyright remedies for aggrieved owners of orphan works who ultimately come forward.

The regulatory regime supported by AIPLA is a flexible approach to provide both users and copyright owners with confidence that a fair system will apply in various circumstances. For example, different constituencies of AIPLA suggest that a strict record keeping requirement for the search may not be tenable in all circumstances, such as in the case of a not-for-profit use of an orphan work by an unsophisticated user (a student, teacher or blogger). On the other hand, sophisticated or institutional users, as in the case of a for-profit production company using an orphan work in a documentary (or other publishers, archivists, and universities) are fully capable of observing a record keeping requirement. In order for them to benefit from the remedies limitations, they should be expected not only to conduct a reasonably diligent search in good faith, but also to keep evidence of the results of this search to support its claim of diligence. Thus, AIPLA is of the view that record keeping should be one factor in the determination of what constitutes a reasonably diligent and good faith search in determining whether to limit the remedies available to a copyright owner.

AIPLA suggests that interested industry groups, in combination with the Copyright Office’s rulemaking and publication process, should develop “best practices” to provide guidelines for the types of searching which would qualify as a search that is “reasonably diligent” and conducted in “good faith.” Examples of search materials and (as footnoted) the groups collecting such information include:

- a. Records of licensing organizations and other similar searchable public databases¹
- b. Trade group resources²
- c. General searches for the author in search engines, directories, etc.³
- d. Professional searches.

AIPLA agrees that attribution should be a factor in determining whether to limit the copyright owner’s remedies, and urges that any legislation or regulatory schemes incentivize users of orphan works to provide as much attribution as possible and appropriate in the given circumstance. In this respect, attribution should be taken into account when considering whether the use was in “good faith.” This was also a recommendation of the Copyright Office 2006 Report on Orphan Works.⁴

For example, the user of an orphan work that has conducted a reasonably diligent search for the copyright owner may only have a URL or other source identifier, or may have only an author’s name as opposed to the copyright owner’s identity. Under such circumstances, the user should

¹ For example, the Copyright Clearance Center, the Photographer’s Index, ASCAP, BMI, SESAC, Harry Fox Agency, Artists Rights Society, VAGA, Motion Picture Licensing Corporation, etc.

² For example, The Authors Guild, the American Society of Picture Professionals, the American Federation of Musicians, Mystery Writers of America, Society of Children’s Book Writers & Illustrators, Writers Guild of American (East and West), etc.

³ For example, a wealth of information is available on genealogy websites.

⁴ United States Copyright Office, Report on Orphan Works (2006) (“Orphan Works Report”), at 10, available at <http://www.copyright.gov/orphan/orphan-report.pdf>.

provide as much attribution as possible. On the other hand, the user may know the author and even the owner of the copyright but is unable to find them, in which case the user can and should provide full attribution to the owner. Attribution is what separates authorship from plagiarism; as such, it must be taken into account when considering whether and to what extent an owner's remedies should be truncated under the Copyright Act.

The determination of "reasonableness" and "good faith" are fact specific to any given case, and any standards for judging these factors must take into account the sophistication of the user and the expense involved, along with a myriad of other factors to inform the relevant constituencies. Other factors that should be taken into account are: (1) the type and amount of use, (2) its commercial or educational purpose, (3) its research, news, or commentary purpose. In addition, consideration should be given to the copyright owner's diligence in keeping his or her registration information up to date, which would provide the user access to information sufficient to find the owner.

The framework for these determinations can develop in much the same manner as the landscape for fair use has developed under section 107. For example, the Copyright Office has existing publications on fair use (<http://www.copyright.gov/fls/fl102.html>), and has published a circular entitled "How to Investigate the Copyright Status of a Work" (<http://www.copyright.gov/circs/circ22.pdf>). On the other hand, it has also published fact sheet SL 30a which provides specific and detailed information to copyright owners on how to maintain contact information, effect a change of address in a registration, and file supplementary registrations with the Copyright Office. See "Changing Your Address with the Copyright Office" (<http://www.copyright.gov/fls/sl30a.pdf>). The Copyright Office can publish additional titles to inform owners of their risk of losing remedies if they do not adequately maintain their registration; it can also promote various practices to breathe life into the legislation.

However, we do not support the creation of a new public database (at the Copyright Office or elsewhere) for users to post notice of their use. In our view, a copyright owner should bear the burden of ensuring its registration information is current, and the user bears the burden of conducting a reasonably diligent search in good faith for the copyright owner. On the other hand, we would support a proposal, similar to that in the 2008 legislation, to require that the Register of Copyrights develop a certification process for, and the establishment of, a new electronic database for pictorial, graphic, and sculptural works that are registered, to facilitate searching for these types of works, which appear to present the most challenging fact patterns.

AIPLA would support legislation, similar to that offered in 2008, which would: (1) limit remedies available under the Copyright Act when a user is unable to locate the copyright owner or other appropriate rights holder after conducting a good faith reasonably diligent search; (2) be applicable on a case-by-case basis, meaning that users could not assume that an orphan work would retain its orphan status indefinitely; and (3) permit the copyright owner or other rights holder later to collect reasonable compensation from the user, but not statutory damages or attorneys' fees. Significantly, the 2008 proposal did not create an exception or limitation of general applicability, but instead limited remedies that might apply in a particular circumstance for a particular user of an orphan work. It provided a special provision for noncommercial actors engaged in noncommercial activities, with some conditions.

We further agree with the recommendation of the Copyright Office to establish a “take-down” procedure for certain noncommercial users engaged in noncommercial activities.

2. AIPLA believes that the foregoing legislative, regulatory and voluntary solutions to address the use of orphan works on an occasional or case-by-case basis has equal application to cases of so-called “Mass Digitization,” and any new rules should be structured to apply to both situations.

a. Definition of Mass Digitization.

Mass digitization was not squarely addressed in the Copyright Office’s 2006 Orphan Works Report, nor did the several proposed Orphan Works bills contain a provision defining mass digitization.⁵ A definition for “mass digitization” was considered by the Copyright Office in its report on Legal Issues in Mass Digitization: A Preliminary Analysis and Discussion Document (2011) (the “Mass Digitization Report”). The Mass Digitization Report suggests, at least in the context of books, that mass digitization is synonymous with “large-scale scanning,” though it also notes as a more general matter that mass digitization “may also refer to a systematic methodology or approach.”⁶

AIPLA agrees that a definition for “mass digitization” should account for the unique policy concerns surrounding the issue which are, according to the U.S. Copyright Office’s Notice of Inquiry, that “[orphan] works may in fact have copyright owners, but it may be too labor-intensive and too expensive to search for them, or it may be factually impossible to draw definitive conclusions about who the copyright owners are or what rights they actually own.”⁷

The 2008 Orphan Works legislation did not squarely address the possibility of systematic or en masse copying, display, or distribution, and did not address the various types of uses that would comprise mass digitization, whether considered in the nature of a project’s goals, purposes, types of work used or other variables.

b. The legislative, regulatory and voluntary solutions to address the use of orphan works on an occasional or case-by-case basis has equal application to Mass Digitization, and this should not be treated differently as a general proposition.

Use of orphan works in the context of mass digitization should be considered in the same context of diligence, searching, and good faith, within the structure advocated above. Mass digitization should not be treated as a separate candidate for specific safe harbor. The goals of the project can

⁵ See Orphan Works Act of 2006, H.R. 5439, 109th Cong. (2006); Orphan Works Act of 2008, H.R. 5889, 110th Cong. (2008); and Shawn Bentley Orphan Works Act of 2008, S. 2913, 110th Cong. (2008).

⁶ Legal Issues in Mass Digitization: A Preliminary Analysis and Discussion Document (Mass Digitization Report), at 8-9, available at www.copyright.gov/docs/massdigitization/USCOMassDigitization_October2011.pdf.

⁷ Orphan Works and Mass Digitization, 77 Fed. Reg. at 64557 (October 22, 2012).

be considered, whether the project is for profit or educational purposes, whether attribution is provided, etc. The Copyright Office or various industry groups may additionally develop best practices for particular types of projects such as libraries, research or archivists. As discussed below, recent trends suggest that mass digitization for these purposes could be considered fair use in any event.

c. Fair use is a possible solution for certain mass digitization projects; compulsory licensing should not be developed at this time in favor of development of a legal landscape relative to use of orphan works in various contexts.

The recent *HathiTrust* decision,⁸ along with scholarship discussing the orphan issue,⁹ supports the conclusion that the digitization of orphan works for not-for-profit, educational purposes may be fair use. However, reliance on fair use to solve the orphan problem is necessarily imperfect given the costs associated with raising a fair use argument in federal court for potentially every orphan in a mass digitization catalogue.

While fair use is less likely to insulate profit-motivated digitization projects in the first place,¹⁰ proving fair use in court may be prohibitively expensive, or at the very least financially undesirable, for the many not-for-profits and/or educational institutions to which the fair use doctrine more readily applies. Wholesale or even partial reliance upon fair use, while advocated by some,¹¹ may be untenable if only because “the outcome of a fair use defense for any mass book digitization project is uncertain.”¹² Furthermore, global digitization initiatives may be left unsatisfied with reliance upon fair use protection given that many foreign countries “lack the long history of judge-made precedent that is so crucial to understanding and applying the provision in the United States.”¹³ For these reasons, some have suggested that a licensing apparatus may be necessary to insulate mass digitizers against the specter of mass copyright liability. However, AIPLA does not support undertaking this initiative at this point in time.

⁸ See *Authors Guild, Inc. v. HathiTrust*, 11 CV 6351 HB, 2012 WL 4808939 (S.D.N.Y. Oct. 10, 2012) (finding that fair use was available to protect not-for-profit institutions that seek to digitize orphan works).

⁹ Urban, Jennifer M., How Fair Use Can Help Solve the Orphan Works Problem (June 18, 2012). Berkeley Technology Law Journal, Vol. 27, 2012; UC Berkeley Public Law Research Paper No. 2089526, available at SSRN: <http://ssrn.com/abstract=2089526> (“Indeed, given the lack of harm to owners who are unlocatable—who, indeed, may well not exist at all—and the social benefits that would result from libraries and archives digitizing orphans and making them accessible, the conclusion that fair use covers such activities may seem obvious.”)

¹⁰ See e.g. *Authors Guild v. Google, Inc.*, 770 F. Supp. 2d 666 (S.D.N.Y. 2011) (“Google would have no colorable defense to a claim of infringement based on the unauthorized copying and selling or other exploitation of entire copyrighted books.”); see also Mass Digitization Report, *supra* note 6, at 13 (“The fact that a digitization project is intended to make money may not change the fact that it is beneficial to the public, but it may change the application of copyright law and the acceptable reach of limitations and exceptions.”)

¹¹ See *supra* note 9.

¹² Mass Digitization Report, at 25.

¹³ *Id.*

Given the vehicles outlined above, and the scholarship and case law referenced here, with the legislative, regulatory and voluntary solutions advocated here, mass digitizers would have additional mechanisms to deal with orphan works, and, considering the circumstances of each such project on a case-by-case basis is itself necessary to arrive at reasoned results in any given scenario. What in one circumstance may clearly be not-for-profit fair use, might under other circumstances require that the user have undertaken and maintained records of its reasonably diligent search in good faith to find the copyright owner in order to avail itself of a limitation on the liability it might face of the copyright owner were to assert a claim of infringement. Thus, the rules, guidelines and case-law which become the legal landscape behind the legislative solution advocated above will be applicable to cases of mass digitization just as they will for occasional use of orphan works, and considered on a case-by-case basis. Therefore, AIPLA does not believe that any effort should be undertaken at this time to establish a compulsory licensing scheme.

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AIPLA will continue to monitor developments regarding orphan works, and we welcome the opportunity to provide Congress and the Copyright Office with any assistance and comments on these issues in the future.

Sincerely,

A handwritten signature in black ink, appearing to read "Jeffrey I.D. Lewis". The signature is written in a cursive, flowing style.

Jeffery I.D. Lewis

President

American Intellectual Property Law Association