



Comments from the Duke University Libraries in response to the Copyright Office’s Notice of Inquiry concerning orphan works and mass digitization.

January, 2013

The Duke University Libraries have digitized a significant number of “special” collections, which are made available on the Internet for the general public, because we believe that these materials make an important contribution to teaching and learning. While our principal users are the students and faculty of the University, we believe these collections also serve a broader educational purpose, and making them available to the public serves Duke’s [signature commitment](#) to put knowledge in the service of society.

Among these online, digital collections are a number that undoubtedly contain “orphan” works – works that are still protected by copyright but the rights holder(s) for which cannot be located. Among such collections we could list [AdViews](#), which makes historic television commercial once more viewable for the public, the [“Vica” comic books](#) created as pro-Nazi propaganda at the behest of the Vichy government in France, a collection documenting the [Caribbean Sea Migration](#) of refugees from Cuba, Haiti and the Dominican Republic between 1965 and 1996, a collection of [images from articles and advertising](#) of mainline Protestant children and families, and another that documents [African- American life in the Jim Crow South](#) .

With the exception of the Vica comic books (which are entirely “orphaned”), each of these collections contains a mixture of materials, including some for which a rights holder could be found and some for which that would be impossible. This is almost certainly the case with any collection of materials from the early and middle part of the twentieth century, and it is particularly the case when a collection includes images or published works from newspapers and popular magazines. Because of Duke’s strong collection of advertising materials, which are a rich source of twentieth-century social history, we frequently encounter this situation.

Faced as we are with this uncertain situation every time we consider a digitization project that includes such popular materials from the mid-twentieth century, the Duke University Libraries have developed a four-pronged strategy to manage the risk associated with

such digitization. To arrive at that strategy we first had to recognize that all efforts to make these materials more broadly available involved some degree of risk, broadly because of the need to rely on fair use, which is always uncertain and highly contested, and more specifically because of the orphan works contained in each of these collections, as well as in others. The four prongs of our IP strategy are these:

First, recognize that some of the materials in the collection are likely to be in the public domain. Most often this will be because of publication without copyright notice or a failure to renew copyright, during the period when these two formalities were required by U.S. law.

Second, seek permission from those identifiable individuals or organizations that are likely to hold copyright in a significant portion of materials from any given collection, or where we know that a rights holder might be sensitive to online access to the works in question. Thus we will contact publishers and other companies, literary estates, and other groups that would be most likely to what to have a say in the process of creating a digital collection. Obviously, in the case of orphan works as well as many works where the process of identifying a rights holder would be prohibitively labor-intensive, such requests are impossible.

Third, recognize that the creation of these themed collections, with identifiable pedagogical and historical purposes, is a strong example of a transformative use of the constituent materials that would be highly likely to be regarded as fair use.

Fourth, provide contact information so that any putative rights holder who we have not been able to contact can get in touch with the University Libraries. Such contacts, while rare, have proved very fruitful. The librarians have learned a good deal about certain materials from those who have contacted us, and we have been able, in some cases, to explain why we believe that the specific resource in question has historical import for teachers and researchers. Although we have temporarily blocked access to materials in order to have these conversations, we have never ultimately had to remove a collection item due to rights holder complaints.

The implementation of this strategy in the actual process of digitizing collections and making them available has taught us a number of lessons that we would like to share in response to the Copyright Office's Notice of Inquiry issued on October 22, 2012.

As an initial matter, we note that the distinction between the occasional or case-by-case use of an orphan work and mass digitization is an unworkable and probably irrelevant division of the question. For one thing, it is not clear how “mass digitization” would be defined. How large must the body of material be before it qualifies as “mass”? This question is complicated by the fact that most collections that academic libraries wish to digitize are mixed, as noted above, and so even determining the quantity of “orphans” contained in a proposed digitization project would mean extensive research into every item, which is clearly impossible in most cases. Indeed, that impossibility is presumably why the question in the Notice of Inquiry is bifurcated, but the very definition of mass digitization in the context of orphan works is undermined by it.

The Vica comic books that were digitized by the Duke Libraries offer a rare exception to this problem, where we were able to do research into the author and publisher of the books, which led to the conclusion that no rights holder could, or need, be contacted. But this is truly rare; most of the time a project must proceed, if it is to proceed at all, on the knowledge that some individual works are probably orphaned, but not a specific knowledge of which works they are, or how many a specified collection contains. It is for this reason that the Duke University Libraries developed the strategy described above, and it illustrates why fair use, rather than a specific orphan works “solution” is the best alternative for these types of projects.¹

With this background as to the perspective that the Duke University Libraries bring to this inquiry, we would like to make the following points:

Regarding occasional or case-by-case uses of orphan works

- The legislative approach to Orphan works that was proposed in 2008 was unhelpful because the proposed “reasonably diligent search” required to determine if a work was an orphan or not would have been prohibitively expensive and time consuming. Only in the rarest of occasions, such as a case like the Vica comic books, would it be possible for an academic library, and it would not have addressed the problem of “mass” digitization at all, as described above. For academic institutions, the benefit that such a search would gain, a remission of damages in cases where a rights holder arose later and

¹ This point is argued persuasively in Jennifer Urban, “How Fair Use Can Help Solve the Orphan Works Problem,” 27 *Berkeley Technology Law Journal* (2012). Available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2089526.

brought suit, was not worth the cost, both because it is very unlikely and because the same benefit is available under section 504(c)(2) of Title 17 for a good faith assessment of fair use.

- A system which imposes an onerous requirement for users to search for owners, but does not require owners to take an affirmative steps to be easier to locate (i.e. participation in some form of voluntary registry), seems profoundly unfair.
- As the discussion above indicates, in most instances, fair use is an adequate provision to accommodate such “one off” digitization projects by academic libraries.
- If a remedies-based solution for the use of orphan works, separate from fair use, were enacted, it should address only those uses where fair use would clearly not apply – perhaps only uses that are obviously commercial in nature. In that case, it would make sense to impose a flexible requirement that a reasonable search for a rights holder had been conducted, but the reasonableness should be left to the trier of fact to evaluate, since that standard, like fair use, will be extremely dependent on the specific circumstances surrounding the work and its use. If a trial court determined that a reasonable search had taken place, it could be authorized to waive statutory damages. It would be logical to also allow for such a waiver if the rights holder had failed to take an affirmative steps to facilitate being located.

Re. mass digitization

In addition to what has been said above about the importance of fair use and other steps to reduce the risk of copyright infringement in the context of discussing the actual practice of digitizing collections at the Duke University Libraries, we would like to make two additional points:

- The largest problem associated with any digitization of a special library collection such as those at Duke comes from the non-textual material that is included – advertisements, illustrations and other images. Often these materials were licensed for a single publication at some point in the past and neither the creator nor the heirs of the creator would seek or expect compensation. In general, then, the fair use argument for such research collections seems very strong. Where a rights holder would expect compensation, or at least contact, it is perfectly reasonable to ask that rights holder to

take the voluntary step of registering their interest with some kind of rights registry. Without such a registry there is often no chance at all of locating a rights holder in materials like those just mentioned. Were such a registry in use, it would be very reasonable to take registration into account, on either side of the balancing test, when evaluating a claim of fair use.

- The one suggestion that certainly would not improve the current situation would be a collective licensing regime. Such schemes impose a “tax” on educational uses of orphan works without adding anything to the creative incentive that copyright is intended to foster. As had been extensively documented, these systems seldom make substantive payments to actual creators and are rife with corruption.² Collective licenses almost never actually do what they purport to do, and they discourage socially-beneficial and educational digitization projects such as those undertaken by the Duke Libraries:
 - Since it is nearly impossible to determine which works in a collection being considered for digitization are truly orphans, it would be impossible in many cases to determine if a collective license was needed and what the scope of that license would be.
 - Many of the materials in these collections were never intended for commercialization or were commercialized immediately at the time of creation (as is the case, for example, with studio portrait photography). When there was no expectation of residual revenues for the creator, paying a collective rights organization to use such works is inefficient and contrary to sound public policy.

Thank you very much for the opportunity to share these thoughts about an important aspect of the copyright law for library services.

Sincerely,

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University Librarian and Vice-Provost
for Library Affairs

Kevin L. Smith
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² See the compilation of difficulties associated with collective rights organizations in Jonathan Band, “Cautionary Tales about Collective Rights Organizations” (2012) available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2149036.