

Orphan Works In The United States And Copyright Issues

Dear Karyn Temple Claggett/Catherine Rowland

This is the research work of [Perry4Law](#)¹ in which we are sharing our views about the orphan work related problems in US. The crux of our discussion is that there should be a balance between copyright protection of orphan works and their suitable publications. For any further informatin or clarification, kindly contact us at info@perry4law.com.

I. The Background-Orphan Works

Copyright protection is made available the moment a copyrightable work is brought into force. There is no statutory requirement to get a copyrighted work registered at the copyright office of the respective Nation, including United States.

This is also the main reason that copyright protection shares an invese relationship with copyright infringement. Despite much copyright awareness campaigns, many copyright infringers still believe that copyright protection is available only if the work is registerd with the copyright office. This is definitely a misconception and a sure recipe for facing a copyright infringement suit.

However, many times a copyrighted work is published and is made available to public without it being registered. In some exceptional cases the authors of such copyrighted work do not provide relevant details about themselves. In such a situation it becomes very difficult to contact such author to do commercial negotiations about such copyrighted work.

Such work becomes an orphan work in which though copyright subsists yet it becomes very difficult to contact the author to seek his/her/its permission to reproduce the work. Nevertheless, using such copyrighted work amounts to copyright violation and in many cases results in a legal suit.

Further, such orphan works also cannot be used in new works and such works are also not available for digital preservation and digitisation. Thus, any use of the orphan work beyond fair use is potentially a violation of copyright. Very few users of orphan works are willing to take the risks of copyright violation.

Active use of e-commerce and e-books has further complicated the situation. Many books/e-books writers simply pickup the contents of such orphan works and the publishers does not undertake any background check on the contents of such books/e-books. This results in unnecessary copyright violation litigations.

¹ Perry4Law is the exclusive techno legal IP and ICT law firm of India that deals in techno legal areas like copyright, trademarks, patents, cyber law, cyber forensics, cyber security, e-discovery, e-commerce, e-governance, etc. Contact Perry4Law at info@perry4law.com and visit <http://perry4law.com/> or more details. See <http://iprsi.blogspot.com/> for our Intellectual Property related discussions.

II. Regulatory Requirements

Regulatory requirements are certainly required to deal with orphan works. The following may be relevant in this regard:

(a) Definition Of Orphan Works: The first and foremost requirement is to “define” an orphan work. Presently many publishers are misusing the concept of orphan work for their own commercial benefits.

For instance, many publishers send publication requests to even well known copyright works with full and complete details as if the copyrighted work is an orphan work. They presume that by sending an e-mail and requesting the publication is enough compliance that would entitle them to publish the copyrighted work.

These publishers generally incorporate a negative covenant that stipulates that unless the copyright owner expressly denies publication of his/her/its copyrighted material, the publisher would deem the consent to be granted. This is definitely a misconception as a copyright owner is not at all required to provide personal answers to all the requests of publication of his/her/its copyrighted work.

Should we treat a copyrighted work to be an orphan work simply because the copyright owner did not respond back to the request of the publisher? The answer is definitely in negative and if any such work is published without an express written permission of the copyright owner, the publisher can be, rather should be, prosecuted for copyright violation. The proposed legislation by US in this regard must keep this aspect in mind.

(b) Definition Of Bona Fide And Due Diligence: The next step is to define the concepts of bona fide and due diligence while contacting the owner of a copyrighted work or orphan work. Merely sending a communication showing intention to publish a copyrighted work or orphan work neither proves bona fide intentions nor it can be considered exercise of due diligence.

This is more so where express copyright notice is accompanying the copyrighted work or orphan work that forbids publication of such work without prior written permission of the owner/author.

The dubious and mala fide behaviour on the part of publishers must be properly guarded against through regulations and stiff penalties must be prescribed where concepts like bona fide and due diligence are “misused” by dubious publishers.

(c) Compensation: A “pre defined” compensation package must be prescribed for copyright violations of orphan works. This can be done on the lines of [remedies for copyright small claims](#) as is under discussion in US. This would also serve as a deterrent so that unscrupulous publishers may not violate copyright of others.

(d) Publication: Copyright office of respective nation must be involved while dealing with orphan works. The copyright office must prescribe a standard procedure that must be followed by all publishers if they wish to publish an orphan work. Any deviance from the prescribed procedure must be stringently dealt with by the copyright office and suitable penalty must be imposed against the publisher. Further, reasonable compensation must also be provided to the owner of copyright/ orphan work if procedure prescribed by the copyright office is not complied with.

(e) Best Practices: At the industry level, best practices must be prescribed by industrial players with active consultation of the copyright office. These best practices must be voluntarily followed by the publishers, companies, business houses, organisations, etc so that copyright of owners must be adequately protected without agitating them at the courts level.

(f) Opt In Method: Unless the copyright owner specifically opt in for considering his/her/its work as part of open source, creative common, orphan work, copyright free work, etc, the copyrighted work must be deemed to be not available for reproduction or publication. Such work should be published or reproduced only with prior written approval of the copyright holder.

III. Online Legal Issues

Availability of orphan works on Internet has further complicated the issue. The desire to digitise everything has added contentious issues to the already complicated world of orphan works. The *American Society of Photographers, Inc. et al. v Google Inc., Case No. 10-CV-02977, Authors Guild et. al. v. Google, Inc., no. 05-8136 (S.D.N.Y. March 22, 2011)*, etc has raised crucial issues pertaining to copyright violations in the present Internet era.

There is an urgent need to prescribe stringent regulatory mechanism that can curb and penalise unauthorised, illegal and copyright violating digital publishing behaviour on the part of publishers and others.

To discourage such profit motive oriented copyright violations of orphan works and other copyrighted works labelled as orphan works, the presumption of copyright violation and presumption of absence of permission to publish copyrighted/orphan work must be prescribed through appropriate legislation.

The option of opt in and not opt out must be prescribed through the legislation for copyrighted works and orphan works. It must be specifically mentioned through legislation that unless the copyright owner expressly and in writing agrees to allow his/her/its copyrighted work to be used for any print and digital publication, all publications of such work, whether in print form or digital form, shall be deemed to be copyright violation and punishable as per the mandates of applicable law(s).

Pre defined fines, penalties and compensation must also be prescribed for violation of copyright and orphan works where litigation hassles must be reduced to minimum to facilitate claim of compensation and damages.

Remedies like class action suits and cross border IP violation dispute resolutions through alternative dispute resolution mechanisms, including online dispute resolution and [e-courts](#), shall be made available to world at large.

Perry4Law hopes that your esteemed office would find these suggestions useful and would consider the same while formulating a law in this regard.

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