

**IN THE MATTER OF NOTICE OF INQUIRY OF THE COPYRIGHT OFFICE,
LIBRARY OF CONGRESS REGARDING ORPHAN WORKS AND MASS
DIGITIZATION**

Docket No. 2012–12

**REPLY COMMENTS OF PUBLIC KNOWLEDGE AND THE ELECTRONIC
FRONTIER FOUNDATION**

Public Knowledge (PK) and the Electronic Frontier Foundation (EFF) appreciate the opportunity to file reply comments in the above-mentioned docket. In these reply comments we contend that the orphan works inquiry does not present an appropriate framework for dealing with inequities that certain creative communities face as a result of current copyright practices. We also call for a careful analysis of the various uses of orphan works in the context of mass digitization, and recommend against attempting a “one-size-fits-all” solution. Finally, we agree that an Intent to Use database could be a useful part of an orphan works solution.

- 1. *Issues arising out of poor artist bargaining power and lack of access to justice are deep systemic problems and require solutions that are beyond the scope of the orphan works inquiry.***

Representatives of performing artists and photographers have made several proposals that seek to undo the inequities faced by artists and small copyright owners. While the issues faced by these artists are real and warrant consideration, an orphan works inquiry does not offer the appropriate framework for dealing with them. Including elements that attempt to solve these issues within an orphan works solution is likely to render orphan works solutions impracticable, while doing little to solve problems faced by artists.

- a. *Requiring search for or compensation of authors, where owners are not found, would introduce undue complexities and make orphan works solutions unusable.*

The Future of Music Coalition (FMC) and Screen Actors Guild-American Federation of Television and Radio Artists (SAG-AFTRA) posit that any orphan works solution must protect the interests of authors. To achieve this goal, they suggest various solutions that would place authors in the position of controlling uses of their work, even where they have parted with any copyright ownership in it. Thus, SAG-AFTRA suggests that when an *owner* of a work cannot be found, a prospective user be required to search for the author and compensate her in accordance with the terms of her contract with the copyright owner.¹ FMC suggests that users seek the author’s permission before commencing new uses of a work, except in situations where the user has already incorporated the orphan works

¹ Comments of Screen Actors Guild-American Federation of Television and Radio Artists, *In the Matter of Orphan Works and Mass Digitization*, 4, Docket No. 2012-12, February 4, 2013, http://www.copyright.gov/orphan/comments/noi_10222012/SAG-AFTRA.pdf (SAG-AFTRA comments)

within a larger work.² It further suggests that the author be entitled to receive compensation if the owner fails to emerge within two to three years after the use commenced and also sue the user for failure to compensate authors on the terms it outlines.³

These suggestions are no doubt animated by a desire to protect artists. However, the inequities they seek to address arise out of the functioning of the copyright system generally. The concerns that FMC and SAG-AFTRA identify arise primarily because authors and performers transfer their copyrights to record labels or movie studios. Inequality in bargaining power may drive unfair copyright transfers, but that problem lies well beyond the scope of this inquiry. The ideal solution to this problem would be to empower artists to exercise greater control over their creative works and not give up their copyrights. In addition to this long term goal, a near term solution might be presented by the right of authors to terminate the transfer of their copyright ownership, a right that will soon be newly available to many authors.⁴

Moreover, adopting the FMC/SAG-AFTRA proposals would hamper the effort to solve the orphan works problem by imposing upon the prospective user the burden of grappling with complex questions of copyright authorship and ownership. At a minimum, the FMC and SAG-AFTRA suggestions overlook the fact that the task of identifying the authors in creative works such as sound recordings and motion pictures is often far from straightforward. In the case of sound recordings, the performing artists as well as sound engineers and others contribute creatively.⁵ A clear answer as to which of these contributors are “authors” of the work may not always be available. These uncertainties are generally resolved by contracts under which any copyright ownership that may vest in performers and other authors is transferred to the record label. Orphan works users must not be called upon to make these legally complex determinations about authorship in order to compensate the “author”. Requiring them to do so would render the orphan works solution unusable in many instances.

By the same token, many works are likely to have multiple authors.⁶ If the SAG-AFTRA proposal were adopted, users would have to search for these multiple authors. If the search for one author leads nowhere, the user would have to continue her search for the other authors. Combining the obligation to search for multiple authors with the obligation to search for owners would increase search costs and uncertainties. Furthermore, a user sued post-search could also be exposed to the threat of lawsuits from multiple authors.

Finally, all of these proposals, but in particular the one that calls for compensation based on artists’ contracts, misconstrue the nature of the orphan works user and use. Most users are unlikely to exploit the orphan work in the same context as the owner. The

² Comments of Future of Music Coalition, *In the Matter of Orphan Works and Mass Digitization*, Docket No. 2012-12, February 4, 2013, http://www.copyright.gov/orphan/comments/loi_10222012/Future-Music-Coalition.pdf, (FMC comments).

³ *Id.*

⁴ See 17 U.S.C. § 203.

⁵ Mary LaFrance, *Authorship and Termination Rights in Sound Recordings*, 75 S. Cal. L. Rev. 375, 392-394 (2002)

⁶ *Id.*

Copyright Office Report on Orphan Works published in 2006 (Copyright Office Report)⁷ provides a useful framework for understanding the different orphan works use scenarios, and how they are a poor fit for the role suggested by these proposals.⁸

The Copyright Office Report noted that orphan works uses could fall into four categories:⁹ The first category of uses would be by subsequent creators who incorporate orphan works in their own creative expressions. An author incorporating an orphan photo in his book would be an example of such a user. The second category would be large-scale access uses where the user would make a large quantity of works available to the public. Many of these users would likely be academic or non-profit institutions. The third category would consist of enthusiast uses by those who are interested in particular types of works and would like to make them available to other enthusiast users. A user who wants to use “journals and magazines with information about the history of the steel industry in the US” would be one example of such a user.¹⁰ The fourth category would consist of private uses. A typical example of a private use would be a person restoring or reproducing old family photographs where the original photographer has gone out of business. The one significant addition to this category of uses could be digitization by commercial entities.

It is unlikely that any of these users, including commercial users, can properly stand in the shoes of the copyright owner. First, these users are using the work in a context that is entirely different than the use by the copyright owner. The subsequent creator is generally using only a portion of a work, in contrast to commercial exploitation of the entire work by the original copyright owner. The large-scale access user is often using the work in an entirely different context, generally for educational purposes or to enable non-consumptive uses such as indexing and searching. The enthusiast user is often using a work out of historical, social, or cultural interest in the subject matter of the work and less out of a desire to commercially exploit it. The private user, similarly, has little intention to commercially exploit a work.

Second, most subsequent users, including a large number of commercial users, are likely to have far fewer resources and abilities than the copyright owner, likely rendering them unable to pay the authors and performers on the same terms as the copyright owner. Furthermore, these users were not present and did not negotiate the terms of the license agreements, contracts, or transfers that authors and performers had with the copyright owner, leaving them at a significant disadvantage in interpreting any express or implied agreements as to authorship or ownership.

More fundamentally, an orphan work is unlikely to have the same market value as a work that is being commercially exploited. In recognition of this principle, the Copyright Office Report and recommendations contained in the Report called for compensation to be based on what a reasonable copyright user and reasonable owner would have agreed to prior

⁷ Register of Copyrights, *Report on Orphan Works*, January 2006, <http://www.copyright.gov/orphan/orphan-report.pdf>. (Copyright Office Report)

⁸ While the FMC and SAG-AFTRA proposals are made in the context of music and audiovisual works, presumably, any orphan works solution would apply to all works. Even if a solution were to apply to music and audio-visual works only, the Copyright Office Report’s framework is relevant.

⁹ Copyright Office Report, *supra* note 7, 36-39.

¹⁰ *Id.*, 38, n.82.

to the use.¹¹ The SAG-AFTRA and FMC suggestions, unfortunately, seem to presume that uses of orphan works will generate revenues sufficient to compensate all artists based on their contracts with copyright owners.

- b. *Submission to the jurisdiction of a small claims system should not be a quid pro quo for benefitting from a limitation on remedies.*

The American Society of Media Photographers (ASMP) has argued that an orphan works solution must require the user to submit to the jurisdiction of a copyright small claims system as a *quid pro quo* for benefitting from a limitation on remedies.¹² The ASMP notes that one of the impediments facing the establishment of a copyright small claims system is the constitutional difficulty of forcing defendants to submit to the jurisdiction of an alternative to the federal court system. They argue that an orphan works *quid pro quo* requirement would be one mechanism to overcome that difficulty.

Pursuing this proposal could hold up any solution to the problem of orphan works for an indefinite period of time. A small claims system has not yet been established and it is not at all clear that such a system can be established. The Copyright Office's recent notice of inquiry sets out a number of unsettled issues, including:¹³ whether the system would be mandatory or voluntary; what types of works and issues it might cover; whether injunctive relief would be available; and whether the system will address secondary liability. In view of these uncertainties, incorporating a requirement to submit to the jurisdiction of a small claims system could hold up an orphan works solution indefinitely.

2. Orphan works solutions may be necessary only for certain uses of works that are mass digitized.

Many commenters have focused on mass digitization and claimed either that it is beneficial to society and must be facilitated¹⁴ or that it is detrimental to authors and owners and must not be permitted unless done with the owner's authorization.¹⁵ What is less clear in many of these comments is whether they address mass digitization *per se* or particular later uses of works that are digitized *en masse*. Further, many comments fail to draw a distinction between various uses of works that are mass digitized.

¹¹ Copyright Office Report, *supra* note 7, 116.

¹² Comments of the American Society of Media Photographers, *In the Matter of Orphan Works and Mass Digitization*, February 4, 2013, http://www.copyright.gov/orphan/comments/noi_10222012/American-Society-Media-Photographers.pdf.

¹³ Remedies for Small Copyright Claims: Third Request for Comments, U.S. Copyright Office, Docket No., 78. Fed. Reg. 38 (February 26, 2013), <http://www.copyright.gov/fedreg/2013/78fr13094.pdf>.

¹⁴ See, e.g. David Hansen *et al.*, University of California, Berkeley, *In the Matter of Orphan Works and Mass Digitization*, 14-19, Docket No. 2012-12, February 4, 2013 http://www.copyright.gov/orphan/comments/noi_10222012/Berkeley-Digital-Library-Copyright-Project.pdf;

Comments of Carnegie Mellon University, *In the Matter of Orphan Works and Mass Digitization*, Docket No. 2012-12, January 30, 2012, *In the Matter of Orphan Works and Mass Digitization*, 14-19, Docket No. 2012-12.

¹⁵ See, e.g., Comments of American Society of Media Photographers, *supra* note 12.

PK and EFF submit that the mere act of digitization represents only one type of use of orphan works. Collections of digitized works could be used for a variety of purposes, including searching and indexing, provision of access to particular classes of users such as disabled users, and broad public access.

Many mass digitization efforts that facilitate preservation of works and non-consumptive uses such as indexing are likely to be fair uses. Comments of the Berkeley Digital Library Copyright Project¹⁶ and the Library Copyright Alliance¹⁷ provide greater analysis of how fair use is likely to apply to such uses of orphan works. They note the trend in case law development towards finding fair use in mass digitization cases. In view of these developments, we submit that any solution pertaining to mass digitization should recognize the user's right to rely on fair use.

Digitization projects whose intended uses go beyond preservation and indexing and include public access to digitized works, however, might not fall within fair use. Yet as many have noted, these projects offer many benefits to society and must be facilitated. To achieve that goal, an orphan works solution in addition to fair use is necessary.¹⁸

That solution could employ standards that are different from standards applicable to other uses of orphan works. In particular, the Office should consider recommending a lower search standard for orphan works or other unexploited works that are part of a mass digitization project. As many commenters have observed, many entities that digitize works are non-profit educational institutions that cannot afford an intensive search for the copyright owner of every individual works in a collection. Imposing a particular search requirement for each work in such collections would severely limit the ability of these institutions to rely on orphan works solutions. Instead, the Office could recommend lower search standards for mass digitization projects. In doing so it can be guided by best practice guidelines developed by various communities of practice. Furthermore, as the Berkeley Digital Library Copyright Project recommends,¹⁹ the Office must recognize ongoing efforts to create these best practices and give them time to develop.

The Library Copyright Alliance²⁰ notes that in some instances authors might surface even after a search conducted by a user. This possibility might increase if a lower search standard is in place. To protect the interests of the copyright owner, a mass digitization regime could adopt a notice and takedown scheme as proposed by Microsoft.²¹ This scheme

¹⁶ Dave Hansen *et al.*, *supra* note 14, 15-16.

¹⁷ Comments of Library Copyright Alliance, *In the Matter of Orphan Works and Mass Digitization*, 2-4, Docket No. 2012-12, January 14, 2013, http://www.copyright.gov/orphan/comments/noi_10222012/Library-Copyright-Alliance.pdf.

¹⁸ None of the following is intended to suggest that a generalized orphan works solution would be inapplicable to mass-digitized works. Users who wanted to make a further uses of a particular work that was included in a mass-digitized corpus should still be able to use the work within a diligent-search framework.

¹⁹ Dave Hansen *et al.*, *supra* note 14, 17-19.

²⁰ Comments of Library Copyright Alliance, *supra* note 17, 6-7.

²¹ Comments of Microsoft Corporation, *In the Matter of Orphan Works and Mass Digitization*, 5, Docket No. 2012-12, February 4, 2013, http://www.copyright.gov/orphan/comments/noi_10222012/Microsoft-Corporation.pdf.

would allow the owner to demand take down of copyrighted content that has been made publicly accessible through a mass digitization project.

3. An Intent to Use database could be a useful step towards matching owners and users.

A number of commenters, including the Recording Industry Association of America (RIAA)²² and SIIA,²³ have observed that an Intent to Use database or another form of public declaration of use could be part of an orphan works solution. The RIAA observes that such a database would allow the owner to exercise diligence and ensure that his work is not orphaned. The SIIA offers the Intent to Use proposal in the context of mass digitization contending that a public announcement might be necessary to offset the impact of lower search standards.

PK and EFF support the idea behind both comments. Such an approach could be useful in matching owners with users, a goal that should animate any orphan works solution.

Conclusion

We remain at your disposal to answer any questions regarding these reply comments.

Respectfully submitted,

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²² Comments of the Recording Industry Association of America, *In the Matter of Orphan Works and Mass Digitization*, 2, Docket No. 2012-12, http://www.copyright.gov/orphan/comments/noi_10222012/RIAA.pdf

²³ Comments of Software and Information Industry Alliance, *In the Matter of Orphan Works and Mass Digitization*, 8, Docket No. 2012-12, February 4, 2013, February 4, 2013.