Before the
Library of Congress
Copyright Office
Washington, D.C. 20024

In the Matter of	)
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Orphan Works	)
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COMMENTS OF PUBLIC KNOWLEDGE

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SUMMARY

"Orphan Works," or copyrighted works for which an owner cannot reasonably be located, are hindering the ability of copyright law to promote creativity and the dissemination of works. Public Knowledge proposes that Congress should create a "reasonable effort" defense to copyright infringement and that Congress should consider the following suggestions when crafting such a defense:

- The "reasonable effort" defense should apply to all types of creative works.
- The "reasonable effort" defense should benefit all types of copyright users.
- The "reasonable effort" defense should place a reasonable and predictable limit on the remedies available to copyright owners when users make unsuccessful "reasonable effort" searches.
- A "reasonable effort" search should be outlined as an effort to identify and locate the copyright owner (1) in good faith, (2) using location tools and other appropriate resources related to the work at issue, and (3) that is reasonable under the totality of the circumstances.
- Congress should avoid defining within the statute the exact parameters of a "reasonable effort" search because what constitutes a "reasonable effort" search varies from medium to medium and from work to work.
- Congress should encourage the publication of brochures outlining the typical parameters of "reasonable effort" searches in various creative fields.
- Congress should encourage, but not require, users to submit sworn statements describing their searches to the Copyright Office. Such statements should serve the users as *prima facie* evidence should the owner resurface and file suit against the user. Congress should specify that users who choose not to file sworn statements will not have the benefit of *prima facie* evidence at trial but will still have the right to prove that they made a reasonable effort at trial. No negative inferences should arise from the fact that a user chose not to submit such a statement.
- In the interest of avoiding a requirement that users duplicate the search efforts of those who have come before them, Congress should allow users to rely on the completed search of another user.
- Congress should limit the remedies available to a copyright owner who sues a user who has made a "reasonable effort" search to $200 per use. A use is an act or series of acts through which a work or works comes to be made available to the public, regardless of how many of the exclusive rights set forth in §106 of Title 17 are implicated.
- Congress should not provide injunctive relief, statutory damages, or attorney's fees to owners of orphan works.

PUBLIC KNOWLEDGE ORPHAN WORKS COMMENTS

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By Electronic Submission & U.S. Mail

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Dear Mr. Sigall:

Public Knowledge submits this comment in response to the notice of inquiry posted in the January 26, 2005 Federal Register by the Copyright Office and the Library of Congress.[1] Public Knowledge is a nonprofit advocacy and educational organization that seeks to address the public's stake in the convergence of communications policy and intellectual property law. We thank the Copyright Office, Library of Congress, and members of Congress for seeking comments on this important issue.[2]

I. Introduction

An orphan work is a copyrighted work for which an owner cannot reasonably be located.[3] The problem of orphan works is weakening our copyright system and injuring our national welfare by discouraging creativity and the dissemination of creative works. As the plethora of comments filed in response to the Copyright Office's notice of inquiry detail, orphan works are

[1] Orphan Works, 70 Fed. Reg. 3741 (Jan. 26, 2005).

[2] Public Knowledge would also like to thank Professor Peter Jaszi, Scott Brairton, and Nayoung Kim of the Glushko-Samuelson Intellectual Property Law Clinic of the American University Washington College of Law, Deirdre Mulligan and Jack Lerner of the Samuelson Law, Technology & Public Policy Clinic at Boalt Hall School of Law, Chris Sprigman and Lauren Gelman of the Stanford Center for Internet and Society, Jennifer Urban of the Intellectual Property Clinic, University of Southern California Law School, Jeff Cunard, counsel for College Art Association, Jonathan Band, counsel for the Library Copyright Alliance, Jason Schultz of the Electronic Frontier Foundation, and Glenn Otis Brown of Creative Commons for their extraordinarily helpful comments, criticisms and advice during this process.

[3] The Glushko–Samuelson Intellectual Property Law Clinic of the American University Washington College of Law offers the same definition in its comment.

problematic for all types of creators and disseminators.[4] Copyright laws should not prevent diligent individuals and organizations that wish to enrich our culture by building upon the creative works of others or otherwise redistributing the creative works of others from doing so.

If Congress does not address the orphan works problem, many abandoned works will continue to be unavailable to the public because they will "simply fall through the cracks."[5] Copyright owners who abandon their copyrighted works chill creativity by forcing creators and disseminators who seek to make use of orphan works into a guessing game over whether or not they will find themselves in court.[6] The problem is a severe one that deserves immediate legislative attention.

As stated in the Copyright Office's notice of inquiry, the purpose of copyright laws is to "promote the dissemination of works by creating incentives for their creation and dissemination to the public."[7] It is important to approach the issues surrounding orphan works with this purpose in the forefront. Doing so clarifies the need to construct a solution to the problem of orphan works that encompasses all types of works and addresses the concerns of all types of creators while avoiding unnecessary harm to copyright owners, unnecessary conflict with international treaties, and unnecessary burdens on the Copyright Office. The comments submitted show that in order to ensure that copyright laws serve their purpose by encouraging rather than discouraging creation and dissemination, legislative action is necessary. Congress should amend Title 17 to include a "reasonable effort" defense to copyright infringement.

II. The Reasonable Effort Defense Should Apply to All Types of Works and Creators

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[4] *See e.g.* Comment of Michael Briggs (providing that he was unable to make use of photographs in his research due to unlocatable copyright owners); Comment of Ivan Rivera (explaining that unlocatable copyright owners have prevented his production company from making use of music samples in R&B and Hip Hop songs); Comment of Mike Curtis (stating that he is unable to disseminate copies of a book of which he is a co-author because the publisher is no longer in business and he is unable to locate the current owner); Comment of Bill Corry (explaining that he is unable to post copies of Desert Magazine on the Internet because he is unable to locate the rights holder); Comment of David Nelson (providing that he is unable to show his film at festivals because he is unable to locate the owner of some of the footage that he used in the film); Comment of Dave Ruske (stating that he is unable to distribute software because the companies who sold the software are out of business and he cannot locate the owner); Comment of Lester Earnest (explaining that he was unable to locate the owner of an aerial photograph of a building that has been demolished after contacting "all the known aerial photography companies in the San Francisco Bay Area to try to find who had the copyright"); Comment of Scott Schram (providing that his wife does not place older musical compositions on her website because she is unable to locate the owners).

[5] *See* Comment of Mimi Fautley (stating that she is often unable to locate the owners of musical works).

[6] *See e.g.* Comment of Bradley J. Rhodes (explaining that he has copies of old piano music that he would like to put online but he is afraid of litigation because "copyright holders are so aggressive these days that [he is] afraid even if these pieces *are* in the public domain someone might convince [his] ISP to shut down [his] account under the DMCA, and if that happened there'd be no good way for [him] to prove [he] was in the right. So instead, [he] just gave up and ha[s] kept these scans to [him]self. It's just not worth the risk to share with others."); Comment of Michael Briggs (providing that when he was unable to locate the owner of the rights to photographs that he wished to use he contacted attorneys who told him that "there was no legally-safe way to handle such questions").

[7] Orphan Works, 70 Fed. Reg. 3741 (Jan. 26, 2005).

In our view, any revision of copyright law meant to prevent the problem of unlocatable owners from discouraging the creation and dissemination of new works should encompass all types of works. Excluding specific types of works would extend the existence of the problems associated with unlocatable owners by retaining a class of works that creators cannot safely use as " basic building blocks"[8] for new forms of expression.

A. The Defense Should Apply to Published and Unpublished Works

It is important that the defense applies to both published and unpublished works. This is because the "building blocks" of works with historical and cultural focuses, as well as many other types of works, are often unpublished works.[9] Letters, diaries, and personal research notes are invaluable sources of information and expression. In addition, creators wishing to utilize unpublished works are currently faced not only with the chilling effect of potential litigation brought about by unlocatable authors, but also with the chilling effect of a particularly unpredictable fair use doctrine.[10] Despite the 1992 Amendment to §107, which clarified that creators can make fair use of unpublished works, courts and cautious publishers are still discouraging such uses.[11] When this discouragement is combined with an unlocatable author, the potential for chilling creation and dissemination is great. Congress should not allow unpublished works to remain in copyright limbo.

While unpublished works do raise issues of privacy and legality that published works may not, these issues should never prevent the users of unpublished works from relying on a "reasonable effort" defense. First, copyright's purpose is not to protect the privacy of authors who desire to prevent the public from accessing their works. Instead, copyright law should do all that it can to encourage authors to share their works with the public. While the privacy concerns surrounding unpublished works may be valid, other areas of the law developed for that explicit purpose better address them.[12]

When the Supreme Court pronounced in *Harper & Row v. Nation Enterprises* that courts should consider the unpublished nature of a work when doing fair use analyses, the Court did not establish a per-se rule against the use of unpublished materials.[13] In fact, the Court has often warned against narrow application of dicta from its decisions within the copyright realm.[14]

In addition, Congress made it clear by amending §107 in 1992 that unpublished works do not possess any kind of untouchable status. During that amendment process, Congressman

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[8] 136 CONG. REC. H805-04 (daily ed. March 14, 1990) (statement of Rep. Kastenmeier).
[9] Peter B. Hirtle, *Unpublished Materials, New Technologies, and Copyright: Facilitating Scholarly Use*, 49 J. COPYRIGHT SOC'Y U.S.A., 259 (2001).
[10] Kenneth D. Crews, *Fair Use of Unpublished Works: Burdens of Proof and the Integrity of Copyright*, 31 ARIZ. ST. L.J. 1 (1999).
[11] Timothy Hill, *Entropy and Atrophy: The Still Uncertain Status of the Fair Use of Unpublished Works and the Implications for Scholarly Criticism*, 51 J. COPYRIGHT SOC'Y U.S.A. 79 (2003).
[12] Crews, *supra* note 8 at 35-36.
[13] *See* 471 U.S. 539, 564 (1985) (discussing the right of first publication as one factor to consider within a fair use analysis); *see also* Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1118 (1990) (stating that the "second factor should not turn solely, nor even primarily, on the published/unpublished dichotomy").
[14] *See e.g.* Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 585 (1994).

Kastenmeier, the Chairman of the Courts Subcommittee, stated that the Constitution mandates Congress to create copyright laws that "encourage free and open expression, and the fullest possible public access to that expression."[15] Therefore, given the importance of unpublished materials for creators of all kinds, a "reasonable effort" defense should apply to published works and unpublished works.

B. The Defense Should Apply to Works of All Ages

We live in an increasingly high-speed world. Copyright laws should not slow the speed at which creation and dissemination can now take place. Users should be able to rely on a "reasonable effort" defense regardless of the age of the orphan work used.

There is no legal need to limit eligibility by age. Although international treaties impose minimum copyright duration requirements,[16] there is no reason why a solution to the orphan works problem must affect copyright duration whatsoever.

C. The Defense Should Apply to Foreign and National Works

Although international treaties allow United States copyright laws to apply different standards to works of American authors than works of foreign authors,[17] the "reasonable effort" defense should apply to foreign works as well as national works. There is no legal reason that the exclusive rights of foreign authors cannot be limited in the context of unlocatable authors. A system that treated the works of national authors differently from those of the foreign authors could discourage creation within the United States.

D. All Types of Copyright Users Should Benefit from the Defense

Another important aspect of any revision intended to solve the problem of orphan works is that the solution should serve all types of creators. Proposals that address the concerns of non-profit organizations but not for-profit corporations, or the authors of books but not the makers of films, or the makers of films but not librarians and archivists will only perpetuate the overall problem.

III. Congress Should Reward Diligent Creators with a "Reasonable Effort" Defense

In order to encompass all types of works and address the concerns of all types of creators while avoiding unnecessary harm to copyright owners, unnecessary conflict with international treaties, and unnecessary burdens on the Copyright Office, Congress should create a "reasonable effort" defense to copyright infringement. Creative individuals who seek to incorporate orphan works into new creative efforts or to make orphan works otherwise available to the public should not be discouraged by the threat of excessive liability. Utilizing and disseminating such works is exactly what copyright laws should be promoting. Congress should reward creative individuals

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[15] 136 CONG. REC. H805-04 (daily ed. March 14, 1990) (statement of Rep. Kastenmeier).
[16] *See e.g.* Berne Convention for the Protection of Literary and Artistic Works, Paris Act, July 24, 1971, art. 7(1), 25 U.S.T. 1341, 828 U.N.T.S. 221 [hereinafter Berne Convention] (requiring generally a duration of life of the author plus fifty years).
[17] *See e.g.* Berne Convention, art. 5(1).

who try diligently to locate the owner of a work in order to acquire a license but fail to do so. The best way to do so is to place a reasonable and predictable limitation on the remedies available to owners who resurface subsequent to a user's diligent search and use of a work.

A. What is a "Reasonable Effort" Search?

Because of the vast array of distinct types of potentially orphaned works, specifying within the law exactly what constitutes a "reasonable effort" search in any and all cases would be extremely difficult. What is perfectly reasonable in regards to a search for the owner of a published novel may be entirely pointless in regards to an unpublished letter. What constitutes a reasonable search varies from medium to medium and from work to work. As a result, Congress should avoid defining the exact parameters of a reasonable search within the law.

Therefore, a "reasonable effort" search should be outlined as an effort to identify and locate the copyright owner (1) in good faith, (2) using location tools and other appropriate resources related to the work at issue, and (3) that is reasonable under the totality of the circumstances.[18]

Perhaps Congress could go as far as to provide a short but not exhaustive list of possible but not always mandatory search options within the statute. Alternatively, Congress could encourage the Copyright Office, trade associations, or other groups to publish brochures outlining "reasonable effort" searches for various types of works.

The Canadian Copyright Board provides an example of the latter approach.[19] That Board publishes an *Unlocatable Copyright Owners Brochure*.[20] The brochure provides that, "There are many ways to locate a copyright owner." It then goes on to suggest that users, "Start by contacting the copyright collective societies that deal with the uses [the users] are interested in." In addition, the brochure explains that, "Other options includ[ing] using the Internet, contacting publishing houses, libraries, universities, [and] museums" are effective. Congress could instruct United States courts to rely on the statutory list and/or the independent publications when determining the reasonableness of a search.

Users wishing to rely on a "reasonable effort" defense should provide attribution information, when known, in a manner consistent with applicable professional standards for crediting sources.

B. How Will Users Demonstrate Reasonable Efforts?

Congress should encourage, but not require, users to submit a sworn statement describing their search along with a processing fee to the Copyright Office. The Office would certify that the user submitted the statement. The Office should not issue a "license," but submitting the

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[18] The Glushko–Samuelson Intellectual Property Law Clinic of the American University Washington College of Law proposes similar language in its comment.

[19] Public Knowledge does not support implementation of a licensing system similar to the Canadian system.

[20] Copyright Board of Canada, *Unlocatable Copyright Owners Brochure*, *available at* http://www.cb-cda.gc.ca/unlocatable/brochurecov-e.html.

statement to the Office should serve as prima facie evidence of a "reasonable effort" search if the owner files suit within the statute of limitations. If the owner files suit, the burden should be on the owner to prove that the user did not perform the search described or that the search described was not a reasonable search given the particular circumstances. Any processing fee should be low enough so as not to be a barrier for users while also adequately covering the Office's costs in maintaining the process.

The Canadian Copyright Board requires users of works with unlocatable owners to submit applications.[21] Users must describe the work, provide the name and nationality of the owner and publisher if known, provide information on the author's date of birth or death if known, describe how and for how long the user intends to use the work, and provide a description of the efforts made to locate the owner and copies of relevant paperwork documenting the search. Congress could encourage a similar set of information for users to include in their statements.

Users who choose not to submit a sworn statement would not have the benefit of *prima facie* evidence of a "reasonable effort" search. However, Congress should specify that such users still have the right to prove that they made a "reasonable effort" search should an owner file suit against them. Congress should also specify that no negative inferences should arise from the fact that a user did not submit a statement.

Congress should also encourage, but not require, users to post a notice of intent to use a work on the Copyright Office website or some other website for a specified period of time prior to making use of the work as part of a reasonable search. The benefits of such notices are that they offer users one more way to demonstrate their good faith as well as owners an opportunity to take a proactive step to protect their copyrights.

In the interest of avoiding a requirement that users duplicate the search efforts of those who have come before them, Congress should allow users to rely on the completed search of another user. In some cases, such as when a respectable corporation has already completed a reasonable search and made use of a work, users may feel comfortable relying on the efforts of the corporation should the owner resurface. However, in other cases, such as when an otherwise unknown individual has documented a "reasonable effort" search, users may not choose to trust the efforts of the individual. Congress should allow users to make such choices and provide a way for users to rely on the previous efforts of others should an owner resurface and file suit.

C. How Should the Defense Limit Remedies?

Congress should set reasonable and predictable limits on the remedies available to owners within the statute of limitations when a user makes a reasonable effort to locate the owner but fails. If Congress addresses the problem of orphan works without providing users with some level of comfort as to what their potential liability will be should an owner resurface, it will perpetuate the chilling effects facing creators today. Under no circumstances should statutory damages, attorney's fees, or injunctive relief be available against a user who made a reasonable effort to locate a copyright owner.

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[21] *Id.*

Although it is difficult to establish an appropriate standard remedy for use of an orphan work due to the diverse types of potential works and uses, establishing such a standard is necessary. Congress should place a statutory limit of $200 per use, or some other reasonable but low figure, on remedies for owners of orphan works. A use is an act or series of acts through which a work or works comes to be made available to the public, regardless of how many of the exclusive rights set forth in §106 of Title 17 are implicated.[22] Most importantly, the damages available to resurfacing owners should be low enough so as not to discourage users from creating and disseminating new works that use the orphan works.

Congress should not provide injunctive relief for resurfacing owners of orphan works. Doing so would perpetuate the problem of orphan works by discouraging publishers, movie studios, and artists from using orphan works. The harsh impact of having to pull books from shelves, software from websites, movies from circulation, or other forms of art from gallery walls and neighborhood art shops would chill a wide variety of creativity. In addition, users who rely on a "reasonable effort" defense should not be prevented from reprinting a book, making a DVD version of a movie, or otherwise continuing to disseminate the new work either in original form or in some slightly altered form subsequent to the owner's resurfacing.

However, a reasonable effort defense should in no way dissolve any owner's copyrights in her works. If an owner resurfaces after a user has completed a reasonable efforts search and made use of the owner's work, the owner should be able to assert her presence and prevent future users from piggybacking on the reasonable search of the previous user.

Finally, Congress may want to consider altering the §512(c) "takedown" provision in order to prevent users who have made reasonable efforts from being subject to takedown notices filed by owners with Internet Service Providers.[23] One way that Congress could address the issue is by specifying that Internet Service Providers do not need to takedown works posted by users who have filed sworn statements of reasonable efforts with the Copyright Office in order to avoid liability. Instead, the sworn statement could take the place of the counter notification process provided for in §512(g)(3).[24]

D. Limiting Remedies is Consistent with International Treaties

In our view, limiting the remedies available to the owners of orphan works in no way imposes a formality under Article 5(2) of the Berne Convention or limits the exclusive rights of owners contained within §106 of Title 17. Therefore, our proposal is entirely consistent with international treaties.

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[22] Public Knowledge adopted this definition from the Glushko–Samuelson Intellectual Property Law Clinic of the American University Washington College of Law proposal.

[23] *See* 17 U.S.C. § 512(c) (2000) (providing that ISPs will be exempt from liability for infringing material residing on their networks at the direction of users if they do not have actual knowledge of the material and they remove the material upon notification of claimed infringement by an owner).

[24] *See* 17 U.S.C. § 512 (g) (3) (2000) (providing that if a user files a counter notice under penalty of perjury with the ISP that the user has a good faith belief that the takedown was the result of a mistake or misidentification, the ISP should replace the material within fourteen business days of receipt of the counter notice).

However, even if the limitation of remedies contained in our proposal was a limitation of the exclusive rights of copyright owners, limiting the remedies available for owners of orphan works would fall within the description of exceptions and limitations to exclusive rights allowed under Berne Article 9(2) and TRIPS Article 13. Those treaties establish a three-part test to determine whether or not a limitation or exception is valid by asking whether it involves "special cases which do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the rights holder." The WTO provided guidelines on how to apply this test when considering whether §110(5) of the Copyright Act violated the TRIPS agreement.[25]

First, any limitations or exceptions must be limited to "certain special cases." The WTO panel found that this requirement limits exceptions to "clearly defined" cases that are "narrow in scope."[26] Our proposal is clearly defined in that it creates a system with manageable rules whereby owners and users know their roles and options. The proposal is also narrow in scope because users will only be able to make use of works whose owners are unlocatable.

Second, limitations and exceptions must not "conflict with the normal exploitation of the work." The panel stated that "normal clearly means something less than full use of an exclusive right."[27] Thus, exceptions only conflict with normal use "if uses, that in principle are covered by that right but exempted under the exception or limitation, enter into economic competition with the ways that right holders normally extract economic value from that right to the work and thereby deprive them of significant or tangible commercial gains."[28] Our proposal would not conflict within this definition because remedies would only be limited in situations where the owner was already foregoing economic gains by orphaning the work. In addition, the owner would retain access to nominal compensation.

Third, limitations and exceptions must not "unreasonably prejudice the legitimate interests of the right holder." The panel specified that the legitimate interests of the owner only include those interests that "are justifiable in the light of the objectives that underlie the protection of exclusive rights."[29] The panel also stated that a prejudice against such legitimate rights becomes unreasonable if it "causes or has the potential to cause an unreasonable loss of income to the copyright owner." [30] Our proposal does not prejudice legitimate interests of rights holders because allowing works to become orphaned and preventing their further use and dissemination are not legitimate interests "in light of the objectives that underlie the protection of exclusive rights." Orphaning a work undermines copyright's goal of encouraging the dissemination and creation of works. The remedy limitations would not cause unreasonable loss of income because the remedies would only be limited in cases where the author was neglecting the work, and would provide an author with a reasonable and predictable compensation should she surface.

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[25] WTO Secretariat, *Report of the Panel on United States – Section 110(5) of the US Copyright Act*, WT/DS160/R (June 15, 2000).
[26] Jane C. Ginsburg, *Toward Supranational Copyright Law? The WTO Panel Decision and the "Three-Step Test" for Copyright Exceptions*, REVUE INTERNATIONALE DU DROIT D'AUTEUR (Jan. 2001).
[27] WTO Secretariat, *supra* note 25, at ¶ 6.167.
[28] *Id.* at ¶6.183.
[29] *Id.* at ¶6.224
[30] *Id.* at ¶6.229

Thus, our proposal satisfies the three-part test by creating a limitation that applies to "special cases that do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the rights holder."

IV. Conclusion

Copyright law should encourage rather than discourage creativity and the distribution of works. The comments submitted show that in order to ensure that the laws do so, legislative action is necessary. Public Knowledge's proposal outlines ways in which Congress can improve the law by encompassing all types of works and addressing the concerns of all types of creators while avoiding unnecessary harm to copyright owners, unnecessary conflict with international treaties, and unnecessary burdens on the Copyright Office. Thank you for the opportunity to comment on this important issue.

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