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September 29, 2015

Maria Pallante
Register of Copyrights
U.S. Copyright Office
101 Independence Ave., S.E.
Washington, DC 20559-6000

RE: Reply Comment, Notice of Inquiry, U.S. Copyright Office, Library of Congress
Copyright Protection for Certain Visual Works (Docket No. 2015-01)

Dear Ms. Pallante and the Copyright Office Staff:

The Copyright Office's 2015 Report on *Orphan Works and Mass Digitization*, submitted to Congress in June contains a misleading comment about previous legislation and a misstatement of fact about visual arts registries that we believe should be clarified to lawmakers; both could have a direct bearing on any potential copyright legislation Congress may draft. We also wish to comment on a judgment made by the Copyright Office that demonstrates the kind of unintended consequence that can arise when outside interests try to make large decisions better left to the marketplace. And finally we intend to expand on our initial comments regarding the relevance of the Constitution's Ex Post Facto Clause to the proposed orphan works legislation.

The Shawn Bentley Act: Unanimous Consent in Name Only

The Copyright Office states (page 12) that the Senate passed the Shawn Bentley Act by unanimous consent. In fact, it was passed by a legislative maneuver called hotlining that effectively bypassed Senate consideration. According to *Roll Call*, Sept 17, 2007:

> "The practice [of hotlining] has led to complaints from Members and watchdog groups alike that lawmakers are essentially signing off on legislation neither they nor their staff have ever read…In order for a bill to be hotlined, the Senate Majority Leader and Minority Leader must agree to pass it by unanimous consent, without a roll-call vote. The two leaders then inform Members of this agreement using special hotlines installed in each office and give Members a specified amount of time to object – in some cases as little as 15 minutes. If no objection is registered, the bill is passed." [1]

The Shawn Bentley Act was hotlined twice during the summer of 2008, but both times artists contacted Senators and holds were put on the legislation. On September 26, 2008, the bill was hotlined again, this time during early evening hours the night of the first Obama/McCain Presidential debate. With most Senate offices closed, even the legislative aides we were able to reach by blackberry said they lacked the time to read the hotlined bill, and so it was passed by what Senate protocols are allowed to call "unanimous consent." [2]

Unanimous consent, however, in name only.

On December 5, 2008, we received an email from Senator Charles Schumer, whose empty office we had phoned the night of the hotlining. In the letter, the Senator assured us of his conviction "that protecting intellectual property is one of the best ways to promote innovation," and that "it is vital that we continue to protect both incentives for innovation and the means of livelihood of millions of New York artists." Then he concluded:

> "The Orphan Works Act is *currently* being carefully considered by the Senate. Members of my staff have met with representatives of artists and small business owners who have expressed many of the same concerns you

[1] http://www.rollcall.com/issues/53_27/-20011-1.html

[2] http://ipaorphanworks.blogspot.com/2008/09/orphan-works-devils-own-day.html

> mentioned. I will *continue* to closely study *developments* on this bill and I will work with both my Senate colleagues and the New York artist community to ensure that any bill that is *ultimately* passed appropriately balances these competing concerns." (Emphasis added.) [3]

Apparently the Senator was unaware that the Shawn Bentley Act had passed the Senate more than two months earlier, by "unanimous consent" including – allegedly – his. We doubt that he was the only lawmaker left in the dark by this controversial procedure.

The Senate's success in passing the bill in this fashion apparently inspired advocates of the House bill to lobby for similar tactics to be used there. On October 6, 2008, Gigi Sohn, President of Public Knowledge, wrote this on her blog:

> "The best option [for passing the House bill] was to put it on the 'suspension calendar,' which is the place largely non-controversial legislation gets put so that it will get passed quickly. There can be no amendments to bills placed on the suspension calendar." [4]

Until the very last minute, Sohn acknowledged, she and other lobbyists "were on the phone imploring the [House leadership] to move the bill" in this surreptitious fashion. Yet in the end, "it was to no avail." On October 3, 2008, with lawmakers struggling to package the 700 billion dollar TARP bailout, Congress adjourned without passing the Orphan Works Act.

Elsewhere, we have argued that an author's exclusive right of copyright is a Constitutional provision, and as such, cannot be abridged without a Constitutional amendment. Congress, of course, cannot abridge a Constitutional right by means of statute law. But to try to do it by legislative maneuver should be unthinkable.

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[3] Email from Senator Charles Schumer to Brad Holland, December 5, 2008. See Appendix.

[4] https://www.publicknowledge.org/news-blog/blogs/orphan-works-bill-wait-til-next-year

May we ask, respectfully, that the Copyright Office issue an official clarification to all members of Congress involved with drafting new copyright legislation, noting the unique circumstances of the Shawn Bentley Act's passage. Otherwise lawmakers might be misled into believing that it was a non-controversial bit of legislation, duly considered by the Senate, voted on by all members with unanimous approval, and therefore pre-approved for inclusion in whatever copyright legislation they may be drafting.

Credible Visual Arts Registries: Still Years Off

There is another comment in the 2015 Report that we believe requires clarification. According to the Copyright Office, "developments since 2008 have helped to reduce the obstacles facing visual artists in an orphan works context – most notably the development of credible visual art registries…Currently, several visual arts organizations support the non-profit PLUS Registry as an important way to enable diligent searches for owners of orphan works. PLUS functions as a 'hub' connecting registries in eighty-eight countries, and provides both literal and image-based searches." [5] Working artists, however, know that there is no such registry. Here are just some of the many comments submitted to the Notice of Inquiry:

> Brad Holland: "Stated this way, it might suggest to Congress that such a registry actually exists, that it is stocked with artists' images, and is ready and able to start licensing those images to the world. If this is what you've been told, I'm afraid you have been misinformed. There is no such thing.
>
> "I am one of the most prolific published artists of the last 50 years, with multiple awards, a client list that includes nearly every major publication in the country and a place in the Illustrators Hall of Fame. If there were such a registry I would know about it, and if I thought it would be beneficial to my

[5] 2015 Report on Orphan Works and Mass Digitization, p. 52. http://copyright.gov/orphan/reports/orphan-works2015.pdf

interests, my work would be in it. But I know of no such registry and neither do any of my colleagues."

Katherine Guevara-Birmelin: "According to the Copyright Office's report in 2015, there already exists a credible visual arts registry which functions as a hub, connecting registries in 88 countries, providing both literal and image based-searches. My understanding of this phrasing is that such a registry actually exists, and therefore if I am reading it in this manner, so is everyone else, including those holding power in Congress. It would be my experience in networking with other artists in my field, that the above is false. No such registry exists."

Scott Stanton: "The claim that there is already a viable visual arts registry that would benefit artists and the reprographic and secondary rights licensing agency that pays artists royalties are both incorrect. Currently this is NO viable visual arts registry, only stock houses which in my opinion do NOT best represent artists' interests."

Cynthia Yolland: "There is no national registry to date. The 'registries' that currently exist are pseudo-registries and not economically viable to artist[s], in fact in many instances they give no remuneration to the artists involved and use images without credit or value."

Taina Litwak: "There are no registries in any overseas markets that behave in the proposed fashion as would be required to make a viable market for artist[s] to thrive."

Angela Treat Lyon: "Even the PLUS registry under development appears to be utilizing metadata and watermarks - both identifiers that are useless currently to protect ownership information."

> Dena Matthews: "I am also troubled that the Copyright Office makes claims in it's report that a viable search for a suspected orphan work of visual art could be conducted on the Copyright Office's website or on the PLUS registry, when in fact, that is impossible. As you know, The Copyright Office's registry is not searchable by image; one must have the Title, Name, Keyword, Registration Number, Document Number or Command Keyword of a registered work to find it there and the search results do not display an image, only text based-information. The PLUS Registry is in Beta Phase 1 and one can only search[ed] by PLUS ID or Name. We are suspicious of the PLUS Registry because, while not even a litigant in the case, they have received from Google a confidential amount of settlement money that should have gone to infringed artists and rights holders."

We are, of course, well aware that there are many "wannabe registries, beta sites, etc." such as PLUS. In fact the Illustrators Partnership was one of the first visual arts groups to support PLUS. We did so, however, on the assurance that it would be a *voluntary* registry only and would not, under any circumstances, be used to justify passage of orphan works legislation.

PLUS has never been open to visual artists to register their works. PLUS is still not open for registration as of this writing. And even if it were, it would take at least a decade or longer for artists to load up their works – *if they could afford to*. Artists know all this, as the comments we've quoted above – and many more – demonstrate.

As a result, we again respectfully request that the Copyright Office officially inform members of Congress that contrary to misinformation given to the Copyright Office, no credible visual arts registry currently exists that is even remotely populated with enough images to make a search of that registry a viable search. Furthermore, lawmakers should be told that in the opinion of those best qualified to know – working artists – no such registry can possibly be viable for the foreseeable future. Or, it may never be viable at all.

Useful Articles and Unintended Consequences

On page 54 of its 2015 Report, the Copyright Office recommends that art on useful articles be exempted from orphan works legislation, but that all other forms of art should be subjected to it.

> "The Copyright Office recommends that future orphan works legislation apply to all types of uses and all types of users, noncommercial and commercial, *with the single exception of fixations of works of visual art in or on commercially available useful articles."* (Italics added.)

The Office goes on to defend this "single exception." But with all due respect, how can it be defended? By what possible standard is a drawing on a mug or a t-shirt more valuable, to either the creator, his clients or to the public, than a book or magazine illustration, a political cartoon, a medical or scientific illustration, a mural in the Smithsonian Air and Space Museum? Who in government believes themselves qualified to make such a sweeping judgment on the relative value of such works? And on what possible grounds can such a judgment be made?

Let's take an example of what could happen if art on useful articles were to continue to receive the full protection of copyright law, while all other art becomes subject to orphan works infringement:

A clothing manufacturer infringes an unregistered magazine illustration orphaned by the law and places the art on a cheap line of t-shirts. Now, thanks to orphan works legislation, the creator of the original drawing will have lost the exclusive right to his own creation while the infringer will have acquired it. This would be not only an unjust reversal of the principle of copyright, it would defy any rational definition of private property rights.

We assume that such a situation would be the unintended consequence of a governmental decision. Yet it highlights the problem of trying to socially engineer details of a multi-billion dollar cottage industry.

At the 2014 Roundtable we tried to make the point that no person or group of persons can ever know enough about other people's business affairs to make decisions better left to those whose interests are at stake:

> "Because there are so many lawyers involved in this, we're talking about [copyright law] as if it's some arcane branch of law. It's not. What you're talking about is prescribing business models for people in businesses in which frankly, most of you don't know enough [about our businesses] to be creating business models…The marketplace will create business models. It can move faster than Congress. It can move faster then the Copyright Office, faster than the lobbyists and legal scholars. If an artist comes up with a better means of being discovered, other artists will find out about it and will copy the same technique. Leave this to the marketplace. That's the best laboratory for creating business models." [6]

In the famous economic fable "I, Pencil," Leonard Reed showed that no individual or special group possesses sufficient "know-how" to "master-mind" the "complex combination" of creative and economic decisions that go into making something even as simple as a common lead pencil, let alone more complicated enterprises.

> "The lesson I have to teach is this [he concluded]: Leave all creative energies uninhibited. Merely organize society to act in harmony with this lesson. Let

[6] Brad Holland Roundtable Transcripts March 10, 2014, Session 1, pp. 80-82. http://copyright.gov/orphan/transcript/0310LOC.pdf

> society's legal apparatus remove all obstacles the best it can. Permit these creative know-hows freely to flow. Have faith that free men and women will respond to the Invisible Hand. This faith will be confirmed. I, Pencil, seemingly simple though I am, offer the miracle of my creation as testimony that this is a practical faith, as practical as the sun, the rain, a cedar tree, the good earth." [7]

Artists, for whom common lead pencils are still a principle means of expression, would ask for nothing more or less than this from our government.

The Ex Post Facto Factor

The Copyright Office says that for purposes of orphan works infringement, "there should be no distinction as to whether a work is currently being exploited [by the author], or whether it was created decades ago." [8] However, we've already noted in our initial comments that the distinction *does* matter, and matters greatly to artists who depend on licensing their work – past *and* present – to make a living. Moreover, we noted that "**Article 1, Section 9** of the Constitution states that no 'ex post facto Law shall be passed' by Congress. Therefore any orphan works legislation that permits the infringement of work created since 1978 would seem to be abridging yet another Constitutional right." [9]

We're well aware that since the drafting of the Constitution, courts have generally held the Ex Post Facto Clause to apply only to criminal cases. But according to The Heritage Guide to

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[7] "I, Pencil" by Leonard E. Reed, From *Essays on Liberty*, Volume VI, originally published in the December 1958 issue of *The Freeman*.
http://www.econlib.org/library/Essays/rdPncl1.html

[8] 2015 Report on Orphan Works and Mass Digitization, p.51.
http://copyright.gov/orphan/reports/orphan-works2015.pdf

[9] Comments of the Illustrators Partnership to Notice of Inquiry, Copyright Protection for Certain Visual Works (Docket No. 2015-01), July 17, 2015.

the Constitution, "opposition to ex post facto laws was a bedrock principle among the Framers. In The Federalist No. 78, Alexander Hamilton noted that 'the subjecting of men to punishment for things which, when they were done, were breaches of no law' is among 'the favorite and most formidable instruments of tyranny.'" And in an 1813 letter to Isaac McPherson, Thomas Jefferson noted "that ex post facto laws are against natural right." [10]

"In Philadelphia, the Framers debated the issue vigorously. Some thought an explicit ban on ex post facto laws an absolute necessity," while others had differing opinions about the effectiveness of a ban. The current holding regarding the scope of the Ex Post Facto Clause derives from "one of [the Supreme Court's] earliest constitutional decisions, *Calder v. Bull*, decided in 1798." In it, Judge Samuel Chase defined ex post facto laws as pertaining to criminal judgments and according to The Heritage Guide, based his decision on the fact that, "had the ex post facto law clauses barred all retroactive civil laws, the prohibition on the impairment of contracts by states (Article I, Section 10, Clause 1) and on uncompensated takings by the federal government (the Fifth Amendment's Takings Clause) would have been unnecessary."[11]

Ever since, however, some have argued that Judge Chase's reasoning meant that the true scope of the Ex Post Facto Clause had never been "squarely presented."

"[A] few commentators and two Justices, William Johnson in *Satterlee v. Matthewson* (1829) and Clarence Thomas in *Eastern Enterprises v. Apfel* (1998), have voiced doubt over the accepted rule that the Ex Post Facto Clause applies only to criminal legislation. In *Apfel*, citing Justice Joseph Story, Thomas contended that the Ex Post Facto Clause, even more

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[10] The Heritage Guide to the Constitution, "Ex Post Facto, Article 1, Section 9, Clause 3." http://www.heritage.org/constitution/#!/articles/1/essays/63/ex-post-facto

[11] *Ibid*.

clearly than the Takings Clause, reflects the principle that retrospective laws are 'generally unjust.' He [Judge Thomas] continued:

> "'Since *Calder v. Bull*,...this Court has considered the Ex Post Facto Clause to apply only in the criminal context. I have never been convinced of the soundness of this limitation, which in *Calder* was principally justified because a contrary interpretation would render the Takings Clause unnecessary....In an appropriate case, therefore, I would be willing to reconsider *Calder* and its progeny to determine whether a retroactive civil law that passes muster under our current Takings Clause jurisprudence is nonetheless unconstitutional under the Ex Post Facto Clause. They do so effectively where personal liberty is at issue. But the clause is of little use to those who are aggrieved by most forms of retroactive civil legislation, which frequently affect property rights of one form or another.'" (Emphasis added.)[12]

Orphan Works legislation, as we have repeatedly pointed out, *would* affect property rights. It would affect the most personal form of private property that exists: the work that citizens create themselves, the work we use to make a living, the art we create to express our short time on Earth. Orphan Works legislation would affect any form of creative expression – from professional artwork to family photos, home videos, songs and lyrics – and anything that anyone ever places on the Internet.

Artists by the thousands have already commented on the damage this legislation would do to their lives and careers. But to orphan copyrighted work retroactively would open new doors for financial and personal abuse. We have already noted that disgruntled clients could easily use the law as an excuse to sue artists for failing to register work during the four decades that registration was not required. And respondents to the Notice of Inquiry have cited other concerns: "Does the US Copyright Office plan to pay back all the registration fees (plus

[12] *Ibid*.

interest) to those who, like me, registered diligently over decades?" "It would be impossible for me to furnish deposit data and register all of my work created since 1975." "I am nonplussed that the US Copyright Office would wish to invalidate copyright registration certificates I have filed for over 30 years by its own Orphan Works policy."[13]

Would this not be an "appropriate case" then to reconsider the wisdom, not to mention the fairness, of passing legislation that would reach back to 1978 and effectively penalize artists and citizens alike for failing to register work that existing law did not then require them to register?

In Federalist Number 44,[14] James Madison expressed concerns many of us would still agree with:

> "Bills of attainder, ex post facto laws, and laws impairing the obligations of contracts, are contrary to the first principles of the social compact, and to every principle of sound legislation. ... The sober people of America are weary of the fluctuating policy which has directed the public councils. They have seen with regret and indignation that sudden changes and legislative interferences, in cases affecting personal rights, become jobs in the hands of enterprising and influential speculators, and snares to the more-industrious and less-informed part of the community."

We thank the Copyright Office for the opportunity to offer these comments.

Respectfully submitted on behalf of my colleagues,

Brad Holland

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[13] Comments of Teri McDermott, McDermott Medical Illustration to Notice of Inquiry, Copyright Protection for Certain Visual Works (Docket No. 2015-01), July 14, 2015.

[14] The Federalist Papers No. 44. http://usgovinfo.about.com/library/fed/blfed44.htm

Appendix

Email from Senator Charles Schumer to Brad Holland, December 5, 2008

From: <senator@schumer.senate.gov>
Date: Friday, December 5, 2008 4:35 PM
To: Brad Holland
Subject: A message from Senator Charles E. Schumer

Dear Mr. Holland:

Thank you for contacting me to express your views regarding the Shawn Bentley Orphan Works Act of 2008, S.2913. I share your support for strong intellectual property rights protections that reward creativity and entrepreneurship.

Like you, I believe that protecting intellectual property is one of the best ways to promote innovation. Indeed, intellectual property laws are what allow artists to earn a living while contributing to America's vibrant culture. The Shawn Bentley Orphan Works Act was introduced to address concerns expressed by the U.S. Copyright Office that it is sometimes extremely difficult to track down the original copyright holder of a work of art. This is a particularly important problem for museums or other non-profit educational institutions, who want the ability to share such "orphan" works of art. At the same time, in addressing this problem it is vital that we continue to protect both incentives for innovation and the means of livelihood of millions of New York artists.

The Orphan Works Act is currently being carefully considered by the Senate. Members of my staff have met with representatives of artists and small business owners who have expressed many of the same concerns you mentioned. I will continue to closely study developments on this bill and I will work with both my Senate colleagues and the New York artist community to ensure that any bill that is ultimately passed appropriately balances these competing concerns.

Thank you for contacting me about this important issue. Please do not hesitate to contact me in the future if I can ever be of assistance to you on this, or any other matter.

Sincerely,

Charles E. Schumer
United States Senator

Please do not respond to this email. To send another message please visit my website at http://schumer.senate.gov/SchumerWebsite/contact/webform.cfm . Thank you.