



May 6, 2005

Jule L. Sigall
Associate Register for Policy & International Affairs
U.S. Copyright Office
Copyright GC/I&R
P.O. Box 70400, Southwest Station
Washington DC 20024

Re: Reply comments by the **Society of American Archivists** to the comments on
Inquiry Concerning Orphan Works, 70 FR 3739 January 26, 2005

Dear Mr. Sigall:

I am writing on behalf of the Society of American Archivists (SAA) with a reply to the responses received by the Copyright Office to 70 FR 3739 January 26, 2005, on orphan works. The Society of American Archivists (“SAA”) serves the educational and professional needs of its members, including more than 4,100 individual archivists and institutions, and provides leadership to help ensure the identification, preservation, and use of the nation’s historical record.

Taken as a whole, the comments strongly support SAA’s contention (see OW0620) that orphan works are a significant problem for a wide range of users and across a broad variety of potential uses. They prove that both non-profit/educational and for-profit organizations have been hampered in their efforts to benefit society by the fear of the possible consequences of infringing on the copyright rights of an unknown owner of an orphan work (e.g., Jason Glazer, OW0128). As James Boyle notes in the statement from the Duke Center for the Public Domain (OW0597), the orphan works problem has emerged, in at least one significant dimension, from the removal of the old structure of publication with formalities as the necessary pre-condition for copyright. At the same time, new technology results in there now being far more works “fixed.” Thus the very nature of that fundamental change in copyright brought on by the 1976 law calls for the development of an orphan works mechanism that reaches beyond the now increasingly artificial distinction of “published” versus “unpublished.”

The very few comments suggesting that there was no problem do not withstand careful examination. Some are based on the erroneous notion that the Internet has made it possible to find accurate information and contact data for the creator of every work (e.g., “sometimes the road to finding the owner of a copyright and the status of a work can be a bit difficult but with the Internet it is not usually insurmountable,” International

Coalition for Copyright Protection, OW0693).¹ Others articulate demonstrably false assumptions (e.g., that every piece of music ever created has been registered with BMI or ASCAP—“BMI agrees that it is reasonable for the [Copyright] Office to consider the question of orphan works *if only for its impact on the licensing of non-music works*” [emphasis added]). Still others rely on challengeable assumptions (e.g., that “removal of copyright protection for orphaned work would reinforce the agenda of the ‘free culture’ movement to subvert existing copyright protection for other work,” Illustrators’ Partnership, OW0661).

We would like to focus the bulk of our reply on six issues: whether the scope of an orphan work clause should be limited to published items; how the difficulty in locating the potential owner of an orphan work should be factored into the definition of an orphan work; the specification of the nature of the “reasonable effort” needed to identify the potential copyright owner(s) of orphan works; the establishment of a registry of users and owners; what should happen when an owner of a presumed orphan work comes forward; and the penalties for those who promulgate spurious copyright claims.

1. Definition of an orphan work—published or unpublished.

Many commentators gave compelling examples of the need for orphan work legislation or rule-making to encompass unpublished as well as published works.² Few commentators challenged the need for orphan works legislation or rulemaking to encompass both unpublished and published works. Of those, fewer still gave substantial justification for the distinction. One argument for omitting unpublished works is to preserve right of first publication (e.g., Walter McDonough, OW0669; June Besek/Kernochan Center for Law, Media and the Arts, OW0666-Kernochan-Center); the other is to protect privacy rights (e.g., Paul Goldstein and Jane Ginsburg, OW0519).

As SAA suggested in our original comment, there are three strong reasons to set aside the first publication argument. First, the publication status of much material is unclear. Given the increasing difficulty of distinguishing between published and unpublished (from the age of carbon paper to the present), creating a system for orphan works that leaves out unpublished not only fails to solve a major part of the problem, but also

¹ That the Internet has created an environment in which finding the “parents” of works renders the matter of orphan works a non-problem is also disputed by James Boyle of the Center for the Public Domain, who argues convincingly that the new technology has actually made it more difficult to find the authors of a work among the seemingly endless web of works.

² Examples include a publisher who is unable to honor a former teacher by issuing recordings of his broadcasts (Karl Miller/Pierian Recording Society, OW0036-MillerKa), the Library of Congress’s efforts to make the Hannah Arendt papers available through the American Memory project (Michael Hughes/Library of Congress, OW0630-LOC), and many of the projects described in the submission from the Library Copyright Alliance (Miriam Nisbet/Library Copyright Alliance, OW0658-LCA).

introduces another layer of ambiguity—necessitating an investigation of what is and what is not “published.” Second, as many of the comments indicate, there can be a concrete public policy benefit to permitting exploitation of orphaned unpublished works. Third, the right of first publication as developed in the courts is not unadulterated, and is particularly questionable when applied to material never intended for commercial exploitation.

The privacy argument for excluding unpublished materials from orphan work status is similarly suspect. SAA represents a profession that has long been cognizant of the issues of privacy in unpublished private papers. Nevertheless we feel strongly that there are at least three reasons why copyright is not the proper mechanism for protecting privacy.

First, though admittedly less uniform and coherent than copyright law, privacy has its own distinct legal context. It runs counter to the efficacy and clarity of both copyright law and privacy law to presume that either can do the work of the other. If we want to protect privacy, we should let privacy law do so, and not call on copyright law to protect privacy. Copyright law should focus on what it does best, namely providing economic incentives for the creation of new works.

Second, among unpublished material that may be used under an orphan works provision, only a very tiny percentage will have any conceivable (not just reasonable) privacy concerns. A work may have become orphan because the author has died, in which case his or her privacy rights have also ended; using copyright to protect the presumed privacy of these authors may actually give them more privacy rights than privacy law does. By definition the authors of orphan works cannot be located. This means that the probability that anyone will be harmed by the publication of such original ideas is greatly diminished.

Lastly, in recognition that privacy may still be an issue to some, SAA proposed in our original submission that the Copyright Office establish three mechanisms to protect against abuse of any orphan works system. First, a potential user must undertake a reasonable search to locate a copyright owner. Second, the user of an orphan work would have to publish his or her intent at a Web site maintained by the Copyright Office, thus giving those who might be affected a chance to respond. Third, we proposed that the Copyright Office establish a registry in which copyright owners could identify themselves and assert control over copyrights that they own, and thus indirectly provide themselves with a mechanism that could conceivably be used to protect their privacy. When taken together, these mechanisms will establish an appropriate balance between the public benefits that can accrue from making unpublished orphan works available and the interests of the owners of the copyrights in those orphan works who might want to guard their privacy as well as their economic interests.

2. Definition of an orphan work—hard to find or effectively impossible to find.

Unfortunately, the comments of some users inadvertently supported the fears of a few respondents representing rights holders that an orphan works provision would simply be

an excuse for inexperienced, overburdened, or ill-intentioned users to ignore copyright. We wish to make clear that SAA believes that an orphan works provision should not be a free pass to use anything for which it is simply bothersome to identify and contact a copyright owner. Indeed, our position is that the definition of a “reasonable effort” to locate the copyright owner of a work should be specified in regulation so as to be as clear and specific as possible. This will give both “actionable” certainty to users who have followed the rules (see next section, below) and assurance to rights-holders that their works will not become orphaned unless true due diligence has been employed by potential users.

For this reason we do not agree, for example, with freeculture.org (OW0673) implying that students, with little “experience,” “time or resources” to track down rights-holders should have a lower threshold than other users. For the same reason we do not agree with the Glushko-Samuelson Intellectual Property Law Clinic (hereafter Glushko-Samuelson, OW0595) that the specifics of a “reasonable effort” be dependent on “the nature and resources of the user.” Similarly, we disagree with Dance Heritage Coalition (OW0649), which suggests that *having found* a rights-holder, the user should be permitted to use the work if the copyright owner simply does not respond to requests for formal assent. When there is concrete and certain evidence as to the identity of the copyright owner, then it is the copyright owner’s right to refuse permission to use a work, even in the most frustrating way possible—by not replying. As the Motion Picture Association of America notes about these cases, “Silence in response to the would-be user must not be presumed to be consent” (OW0646-MPAA).

In the case of orphan works, however, there is usually uncertainty as to the current ownership of the copyright. In these cases, failure to respond cannot be assumed to be the equivalent of a denial from a legitimate copyright owner. Thus we agree with the Duke Center for Public Domain and the North Carolina State University Library (OW0606-NCSULibraries) that after a reasonable, diligent effort to contact a presumed copyright owner of an orphan work, it would be acceptable to use the work even if the presumed copyright owner has not responded. An orphan work should be one where it is not possible, by “reasonable” means, to identify a copyright owner or to contact the owner if identified. And this is exactly what the majority of specific examples provided by respondents document. Some limitation on effort, which is what “reasonable effort” is meant to provide, is necessary to preclude infinite searches with no sane hope of success.

3. Definition of “reasonable effort” to identify copyright owner(s) of orphan work.

What should “reasonable effort” mean in practice? The Glushko-Samuelson proposal, which received support from several respondents, argues that any definition of “reasonable effort” should be general, flexible, and apply to a variety of situations. The SAA proposal requests a definition of “reasonable effort” that leans toward being more specific and less relative. Many users (or those representing users) have voiced similar concerns—e.g., “a guideline should be issued listing these steps with a great deal of specificity” (International Documentary Association, OW0686). As noted above, SAA

thinks such requests will better protect copyright owners and thus contribute to a more viable system.

But just as importantly, SAA believes that more clarity may make the difference between an approach to orphan works that succeeds and one that does not. Many non-profit and/or educational respondents clearly state that the uncertainty over what constitutes fair use—and the fact that certainty is provided only once adjudicated—makes use of that provision too risky in today’s highly litigious society. We believe, however, that simply shifting from one vague standard (“fair use”) to another (“reasonable effort”) will be insufficient to assure publishers and other “gatekeepers” that they can approve the use of orphan works while incurring only calculable and contained risks. Only a specific definition of “reasonable effort” will assure users—and particularly gatekeepers—that there will be an acceptable level of risk when making use of orphan works.

James Boyle of the Duke Center for the Public Domain provides a very useful outline of reasonableness: “...reasonableness is defined in broad, rule-like classes by the administrative body.... Reasonable efforts should involve simple, mechanistic steps involving few transaction costs.” We find a great deal of merit in Boyle’s argument for considering distinct “reasonableness” criteria based on the type of use intended to be made of the orphan work—a lower threshold for personal and non-profit educational uses, a higher threshold for commercial uses. Furthermore, the “reasonable effort” language should be part of rulemaking, as commented by several respondents, rather than legislation. It must be allowed to evolve over time in order to account properly for new sources of information or new avenues for conducting searches.

4. Users’ and owners’ lists.

Consistent with SAA’s suggestions, many respondents request that an approach to orphan works include both a provision for copyright owners to identify themselves and a parallel provision for users to declare their intended use of orphan works. Some commentators propose that users, in addition to registering their use, pay a “compulsory license fee” that would go into a pool to recompense owners of orphan works if they later appear. This fund would also cover the Copyright Office’s work maintaining both that list and a “directory of claimants” making known that their work is not orphaned (e.g., International Documentary Association; Motion Picture Association of America, OW0646; Michigan State University, OW0545). Others perceive both the user and owner lists as essentially free, administered either by the Copyright Office or by an independent non-profit (e.g., Google, OW0681; MIT, OW0515; Various Independent Film Interests, OW0663).

It seems clear to SAA that—short of a major revolution in U.S. copyright law and treaty obligations—a compulsory license fee imposed on copyright owners is not possible. Although SAA does not oppose such fees in theory, we argue that they would be difficult to determine and could, even if reasonable in each individual instance, in total represent an insurmountable burden for certain worthy uses such as documentaries or on-line archival collections. However, voluntary registries that would become one of the required search targets for any “reasonable effort” by prospective users of orphan works

have strong merit. Similarly, a register of users of orphan material, as part of an effort to assist copyright owners in determining if their material is being used under presumption of being orphaned, should be an important component of orphan works regulations.

5. What happens when an owner turns up for an orphan work.

SAA consistently maintains that the designation of an orphan work is not tantamount to placing the work into the public domain. When a copyright owner does appear to claim a work presumed to be orphaned, the owner would still rightfully hold all the rights of ownership. For this reason, we disagree with proposals that users be permitted to proceed with “ongoing uses” (including “new editions of published works, reissues of previously recorded music, updates of posted websites,” etc.) solely by being required to add a full citation identifying the copyright owner. We believe this unnecessarily diminishes the rights of the copyright holder.

That said, some provision for continued use seems reasonable when the user has invested considerable time or effort in making a derivative collection, in doing restoration or preservation, or when projects (especially digitization projects) entail a large capital outlay. SAA supports the proposal of James Boyle to allow the user of an orphan work the right to continue the use after paying a reasonable license fee to the copyright owner. Such an approach would, we feel, prevent future examples of the unfortunate fate that has befallen the documentary *Eyes on the Prize*. As several commentators noted, the post-hoc demand for (arguably) unreasonable fees by previously unknown copyright holders may result in PBS’s inability to continue to market this landmark film.

6. Damages for spurious assertions.

SAA would like to re-emphasize an important point from our original proposal: Individuals who file spurious assertions of ownership of orphan works and organizations that license rights for copyright owners must meet the highest standards for accuracy. Claiming fraudulent copyright rights in an orphan work, failing to distinguish the extent of one’s copyright in an orphan work (by failing to identify that material for which one does not hold copyright ownership), or asserting in the name of copyright rights beyond those afforded by law should subject the self-declared copyright owner to the same penalties as are faced by a copyright infringer. Copyright abuse and misuse is becoming as great a problem as copyright infringement. Orphan works legislation would be an ideal mechanism to begin to attack the problem.

Summary

SAA believes that the comments received by the Copyright Office on the matter of orphan works contain the necessary ingredients to create a system that is fair to copyright owners, clear and workable for prospective users, and of benefit to society at large. While, not surprisingly, we prefer the totality of our recommendations to other proposals, a gratifying number of respondents made thoughtful proposals consistent with major aspects of SAA’s position. These additional suggestions, partly described above, have

sufficient merit for SAA to support if they become the basis for the Copyright Office's next steps.

This is a matter of considerable importance to SAA's members and, more importantly, to the broad and varied users we serve. We look forward to doing everything we can to assist the Copyright Office in furthering its efforts to define policies for orphan works.

Sincerely,

A handwritten signature in black ink that reads "Randall Jimerson". The signature is written in a cursive style with a long, sweeping underline.

Randall C. Jimerson, Ph.D.
President, Society of American Archivists