BY EMAIL: orphanworks@loc.gov

Jule L. Sigall
Associate Register for Policy and International Affairs
U.S. Copyright Office
James Madison Memorial Building, Room LM-401
101 Independence Ave., S.E.
Washington, DC 20540

Dear Mr. Sigall:

On behalf of the Committee on Copyright and Literary Property ("Committee") of the Association of the Bar of the City of New York ("Association"), I write to offer reply comments in response to the 716 initial comments the Copyright Office received in connection with the January 21, 2005 Notice of Inquiry regarding the problem of orphan works. The Association, founded in 1870, is a voluntary organization of attorneys with more than 22,000 members located in nearly every state and more than forty countries. The Committee on Copyright and Literary Property is one of the Standing Committees of the Association, made up of both practitioners and scholars, and is actively engaged in monitoring, commenting on and participating in developments in copyright law.

The consensus views of the Committee are set forth in the numbered paragraphs below. Additional and dissenting views are addressed in footnotes.

OBJECTIVES OF ORPHAN WORK PROPOSAL:

1. The Committee agrees with virtually all commenters that orphan works present a genuine problem, and that society would benefit from greater access to such works. The Committee further believes that any solution should accomplish several important objectives: (a) substantially lessen the risk for those who seek to make use of orphan works, (b) impose the least possible burden on both users and copyright owners, (c) comply with the international obligations of the US to avoid imposing formalities as a precondition of copyright protection, (d) require the least possible intervention by the courts and the Copyright Office, and (e) avoid creating "traps for the unwary" which could disadvantage individual authors.

DEFINITION OF ORPHAN WORKS:

A. Functional Definition

2. The definition of orphan works should consist of a broad, functional description to be applied by the courts in the event of litigation.

3. The broad definition should be phrased in terms of the result, e.g., "the owner cannot with reasonable diligence be located," rather than specifying any particular investigation the

prospective user must undertake. Courts would be free to interpret "reasonable" in light of all the facts and circumstances of a particular use.[1]

4. Some Committee members are concerned that the mere availability of any such flexible, fact-specific defense would create a perverse incentive, and cause users to engage in less diligence than the present strict-liability system. The Committee believes, however, that a flimsy, pretextual argument of orphan work status should fail (just as weak fair use and First Amendment arguments routinely fail) and will also increase the likelihood of an attorney's fee award against a defendant who advances it. Accordingly, the Committee believes that the potential for such unintended consequences is small.

5. The definition should not be limited to older works, as there are many recent works which raise the same issues.

6. It is also important that the definition recognize the possibility of an orphan element within an otherwise non-orphan work, e.g., the set design or music incorporated into a film of a dance performance.

7. Further, the definition should apply only to published works. Many commenters have proposed that an orphan-works regime should be applicable to unpublished works as well. But the Committee agrees with Prof. Goldstein and Prof. Ginsburg (comment OWO519) and the Graphic Artists Guild (OWO547) that the inclusion of unpublished works would erode an author's non-economic right to withhold his or her works from the marketplace. This right is recognized both domestically (Harper & Row v. Nation Enters., 471 U.S. 539 (1985)) and internationally (Berne Convention, Art. 10, 10bis).[2]

B. Safe Harbor Provisions

8. In addition to the judicially-applied definition, a solution might also incorporate a series of specific statutory safe harbors which would create an unrebuttable presumption of orphan work status, similar to the DMCA safe harbors for ISP's or the section 110 exemptions for

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[1] While the Committee as a whole endorses this approach, some members expressed concern that a broad definition could conflict with U.S. obligations under the Berne Convention, if works could too easily be deemed orphaned. Similarly, members expressed concern that a work could be deemed an orphan through no fault of the copyright owner, for example, if an unauthorized copy were posted online without identifying information.

[2] One member noted that it is often very difficult to determine the publication status of a work, and that the "reasonable diligence" standard should be applied to this issue as well. Several others argued that unpublished works should not be excluded altogether from the definition of orphan works, just as they are not excluded from the scope of fair use under § 107. Instead, unpublished works could be considered orphans after some period of time, such as 28, 56 or 75 years, beyond which the first publication rights of authors have presumably diminished greatly in significance. The Committee as a whole did not adopt these views.

certain performances and displays. Adding such a presumption could increase certainty for specific users of orphan works, such as libraries and non-profit educational institutions, and could obviate the need for court intervention in many cases. The specific conditions giving rise to a safe harbor would likely include some combination of facts about the user, the nature of the use, and the type of work, as is presently the case under § 108 and § 110.[3]

9. Such safe harbors, if any can be agreed upon, should recognize the different informational resources available with respect to different classes of works. Thus, as with § 110, not all safe harbors would be available for all types of works. Owners of musical compositions, for example, are almost universally identifiable in the databases of ASCAP, BMI and SESAC, but photographs (often untitled) are frequently impossible to trace through any central source. Copyright Office records cannot be definitive in this regard, because many works are not registered, even after successful commercial publication.

10. The Committee disagrees with those who have proposed voluntary or mandatory registration of works, and believes that the operation of the safe harbors should not be contingent on the creation of any new informational resource or clearinghouse, whether private or governmental. That is, the safe harbors (if any) should be workable now, and not at some unspecified future date.[4]

OPERATION AND EFFECT:

A. Safe Harbor Uses

11. A user falling within one of the safe harbors should not be liable for past infringing acts, but a copyright owner who comes forward should not be without a remedy, even for such uses. As with reliance party works under sec. 104A, a copyright owner who can prove ownership should be entitled to an injunction against the sale of the work going forward, but not to money damages for past uses.[5]

12. If the work has been incorporated into a derivative work or compilation from which it cannot practicably be separated, there should be no injunctive relief going forward, but a court

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[3] Some members were not in favor of any attempt to define safe harbors, but felt that orphan work status should only operate as a case-by-case affirmative defense in infringement actions. The consensus of the Committee was that safe harbors should be incorporated into the legislative solution if politically feasible.

[4] In dissent, some members supported some form of voluntary registration or clearinghouse of information, and emphasized that these would be particularly important if no safe harbors could be agreed upon. The Committee as a whole did not adopt this view.

[5] One member dissented, and suggested that some form of monetary relief should always be available.

would be empowered to set a reasonable license fee for continued use, as with reliance party derivative works under § 104A. This could be implemented with a change to the remedies provisions in Chapter 5 of Title 17, without affecting the availability of copyright protection vel non.[6]

B. Other Uses

13. For works and uses not falling within the safe harbors, the orphan status of a plaintiff's work should still be available as a defense in an infringement action to preclude monetary damages for past actions.

14. The burden should fall on defendant to prove that the work's owner "could not with reasonable diligence be located," (or whatever the statutory standard might be) by coming forward with evidence of the affirmative steps defendant took to locate him or her.

15. The plaintiff would still have the burden of proving ownership, however, as in any infringement action. This might be difficult if the work was registered more than five years after publication (as will frequently be the case – a promptly registered work is not likely to be hard to identify).

INTERNATIONAL IMPLICATIONS

16. The above proposal would seem to be consistent with the international obligations of the U.S. because, like section 104A, it does not impose any formalities as a condition to copyright protection, but merely restricts the availability of remedies in certain circumstances. Under Art. 9(2) of the Berne Convention, however, any exception or compulsory license can be no broader than necessary, and only apply to "certain special cases" that "do not conflict with the normal exploitation of the work," or "unreasonably prejudice the legitimate interests of the author." Where the works really are orphans, it would be hard to argue that that the legitimate interests of

[6] One member dissented, and argued that no special treatment should be given to derivative works. Another member argued, to the contrary, that the "reasonable license fee" for continued use of a derivative work or compilation should expressly consider the economic returns from continued exploitation, which might be nominal or zero in some circumstances. If the license fee does not consider the purpose of the use and the expected return, it was argued, many of the most likely users, such as nonprofit schools and libraries, might be dissuaded from using orphan works by the threat of high compulsory license fees after the fact. The Committee as a whole did not adopt these views.

the author or the normal exploitation of the work are being harmed, but the Committee urges caution in adopting a standard that could lead too easily to a finding of orphan status.

Respectfully submitted,

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