



March 25, 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: Response by the **Society of American Archivists** to the Notice of 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) in response to 70 FR 3739 January 26, 2005, seeking information on whether and how difficulties in locating copyright owners hamper new creative work. SAA serves the educational and professional needs of its members, including 4,000 individual archivists and institutions, and provides leadership to help ensure the identification, preservation, and use of the nation's historical record. To fulfill this mission the SAA exerts active leadership on significant archival issues by shaping policies and standards, and serves as an advocate on behalf of both professionals who manage archival records and the citizens who use those records.

As professionals directly and indirectly involved in the creation of new works that incorporate information, text, and ideas from existing works, we applaud the Copyright Office's decision to investigate the extent to which recent extensions to the term of copyright, as well as the abolition of required registration, have negatively affected scholarship. We note that this has long been of concern to the Copyright Office. In both her testimony before Congress on the Copyright Term Extension Act and in the Office's *Report on Copyright and Digital Distance Education*, the Registrar has highlighted the danger that the inability to locate copyright owners might hamper the effective exploitation of older works. The background information in the Federal Register notice itself is one of the best statements we have seen of the potential problems with orphan works, and we are delighted that the Copyright Office is considering the possibility of legislative action.

Although much printed material is found in archives, SAA's primary concern is with unpublished materials. Our attached response on the scope of the orphan works problem therefore is focused on the issue of unpublished material.

Sincerely,

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

Response by the **Society of American Archivists** To the Questions Raised in the Notice of Inquiry Concerning Orphan Works, 70 FR 3739 January 26, 2005

1. Nature of the Problems Faced by Subsequent Creators and Users

Letters, diaries, reports, memoranda, drafts of published materials – these are the raw materials of historical and literary scholarship. Scholarship in these fields advances as experts revisit, reinterpret, and reuse the documentary heritage left to us by our predecessors. In some cases, extensive quotation in a new work may be necessary. In other cases, scholarship advances by publishing a scholarly edition of primary source materials that can then be used by students and other scholars in their endeavors. The importance of primary documents as a source for subsequent scholarship has been recognized and supported by the Federal government through program such as the documentary editing grants of the National Endowment for the Humanities and the National Historical Publications and Records Commission.

The raw materials for scholarship are preserved in archives. In broad terms, an archives is any cultural repository of documentary material regardless of physical format, including manuscripts, typescripts, printed and published works, photographs (whether negative, print, JPEGs, or TIFFs), sound recordings (on disks, wire, acetate, polyester tapes, cassettes, CDs, etc.), motion pictures (on silent and sound film, videotapes and DVDs), and electronic records in any computer-readable format. As one would imagine, the sheer number and divergence of physical formats presents serious challenges for anyone wanting to acquire, arrange, describe, and make accessible such material over time. Nevertheless, nothing should be selected or cared for in an archives unless it is intended to be *used*.

The core archival mission is to ensure that the knowledge created and accumulated by past generations is joined with that of the present to form a body of knowledge available for all of society. Fulfilling this archival purpose helps to build a better future for the world at large. Because we understand that knowledge is cumulative, and because we believe that our work must result in an ultimate utility, we know that the content of our archives and manuscript repositories must be copied, quoted, published, performed, broadcast, and otherwise disseminated, such as via the Internet. We need to be able to support research work that disseminates historical information using the latest information technology.

In addressing this mission, we inevitably encounter copyright issues, including, increasingly, those related to orphan works. While there is a tradition of simply ignoring the copyright issues, this approach has become untenable. For example, Julian Boyd, the editor of the Thomas Jefferson papers, addressed this issue when he testified before Congress on behalf of SAA in 1965. Boyd recounted:

...when the gathering and editing of 'The Papers of Thomas Jefferson' was begun in 1943, through the initiative of the Congress, and many thousands of documents were copied in over 600 repositories stretching from Australia to Moscow, I was given a formal opinion by the Register of Copyrights that, under common law, the technical legal right to publish the papers of our chief spokesman for liberty was vested in the hundreds of descendants of Thomas Jefferson and in the multitude of descendants of the thousands of people who wrote letters to him. In the face of such a legal obstacle, it seemed the part of wisdom to assume that the courts would sanction such a technical invasion of literary property right under the doctrine of fair use. The alternative in the face of the impossible burden that this imposed would have been to abandon the undertaking.¹

Similarly, in order to publish in digital form the collection entitled *Prosperity and Thrift: The Coolidge Era and the Consumer Economy 1922 - 1929*, the Library of Congress (in its own words) “exhaustively researched the contents of this collection to ascertain any possible legal rights embodied in the materials.” Lawyers from the National Digital Library Program within the Library worked with other library staff, including the staff of the Manuscript Division where the original items are held, in order to establish the copyright status of the items included on the web site. Yet in spite of this effort, the Library was unable to identify all of the possible rights holders in the materials in the collection and therefore makes some of the material available under an assertion of fair use.

But whereas Boyd was willing to run the risk of potential copyright infringement with the Jefferson papers, the editors of the published Eisenhower papers were not so risk-adverse. Unlike the Jefferson papers, the Eisenhower papers project decided not to print any letters Eisenhower had received. It was not because these letters were not of value in understanding the conduct of World War II, but because “the publishing of documents written by persons still or recently alive presents almost insurmountable legal problems.”²

The existing exemptions in the copyright law are inadequate for the needs of scholarship and cultural preservation. Significantly, *the fair use exemption represents a weak, inadequate, confusing, and costly device for the support of scholarship, learning, and public education*. First, fair use is a judicial finding made on a case-by-case basis only after the case has gone to trial, and perhaps appeal. Fair use rules are not clear, but overlapping and highly circumstantial. Certain kinds of transformative uses have received little support in fair use decisions, and there have also been some judicial distortions of the factors often at odds with the fundamental purposes of copyright. For example, in

¹ Copyright Law Revision, Hearings Before Subcommittee no. 3 of the Committee on the Judiciary, House of Representatives, 89th Congress, part 2, p. 1139.

² Eisenhower, Dwight D. *THE PAPERS OF DWIGHT DAVID EISENHOWER*. Baltimore: Johns Hopkins Press, 1970. Vol. 1, p. xv. Note the assumption that there should be fewer legal problems associated with publishing the papers of someone who was not “recently alive.”

1989 the Second Court of Appeals, in *New Era Publications v. Henry Holt* prevented a biographer from making fair use quotations of unpublished writings of his subject—quotations necessary to establish basic characterizations of the subject. In sum, as far as unpublished materials are concerned, fair use is little more than what Lawrence Lessig has characterized as “a license to hire a lawyer.”

The possibility of litigation and the unavoidable uncertainty about which particular uses a court will determine are “fair” has led many publishers to set aside the doctrine entirely. That is, as risk-averse agents of their corporations or institutions, they back away from utilization of “fair use” when reviewing manuscripts prior to publication and instead require that the author bear the responsibility for obtaining formal written permission from all persons quoted in the course of their work. Publishers will not permit researchers to use material from unknown and unknowable copyright holders unless the researcher can somehow get written permission.³ For example, in the late 1990s a scholar researching the different perceptions and sentiments of western Civil War soldiers with their eastern counterparts was told by the historical magazine of a Midwestern state that he had to get signed copyright permissions from the families of every one of the soldiers whose letters and diaries he quoted in the course of the article. (Because the last Civil War soldier only died in 1959, it is conceivable that some of the letters could still be copyrighted.) The article has yet to appear as a result.

On a regular basis (for some archives this may mean weekly, for others monthly or quarterly), archivists and manuscript curators receive requests from authors to satisfy their publisher’s clearance department’s interest in a written sign-off for use of a quote or photograph. Sometime it is for permission to use an entire work, such as a photograph or a single letter. Other times, it is for clearance on a quotation of as little as five words.⁴ If the ultimate use is clearly commercial and non-transformative, this request process may be justified, but in the vast majority of instances, the effort spent on seeking permission will be non-productive.

The frustration of the process is even greater when archivists’ typical response must be that our repositories do not own the copyright. Until the 1980s, it was unusual for repositories to even request legal transfer of copyright from donors of collections, and

³ One example is MIT’s journal *Leonardo*. According to its guidelines, found at <<http://mitpress2.mit.edu/e-journals/Leonardo/isast/journal/editorial/imagepolicy.html>>, ...clearing permissions for electronic use will now be mandatory. While fair use cases could be argued under our old "Guidelines for Use of Visual Materials," the new "New Electronic Theft Act" (recently signed into law) makes electronic distribution of copyrighted material, even on a non-profit basis, illegal. We therefore need to document all permission for the use of material not copyrighted by you.

⁴ The words were “Thou shalt not contemplate paradox.” from the Heinz von Foerster Papers at the University of Illinois at Urbana-Champaign.

even then of course that transfer could not include copyright in materials sent to rather than created by the donor. In addition, every archives is filled with items of mixed parentage and provenance. In some cases, a family may have donated letters and diaries to the repository, but all trace of that family has been lost. In other cases, people donate items that they discover in old houses, furniture, or suitcases, but the donor himself or herself has no direct connection to the creator. Especially problematic are photographs and other documents that may have been taken by an unknown photographer or for a business that is no longer in existence. It is impossible to tell whether the work was a work for hire, nor what the contractual conditions of employment may have been. Still other items may have been purchased, with no direct means of tracing the family that owned them.

In a majority of cases, therefore, the author is unknown or unknowable, having entered the black hole of anonymity because of the lack of a current address or even an indication that they are still alive. How for example, could one find the rightful *per stirpes* descendant copyright holders for Dr. M. W. Brubaker who wrote in 1884 on behalf of the defunct-for-a-century Charleston Institute of Medical Electricity or, worse yet, the 1877 photographer of J. Edwards Smith of Ashtabula, Ohio?

Because of institutional concern with possible risk, archivists, when publishing material on the web, omit historical photographs, films, and other documents of great interest and research value. Alternatively, archivists expend a large amount of time, money, and effort in an often-fruitless search for owners. For example, the Digital Scriptorium project at Duke University has sought to put online copies of more than 7,000 advertisements printed primarily in U.S. newspapers and magazines between 1911 and 1955. Archivists at Duke University sought to secure permission from the firms represented in the ads, in the hope that they owned the copyright in the advertisements. Duke estimates that their costs for copyright investigation at \$1.43 per ad for the 7,307 ads, or a substantial portion of the entire project. Only a handful of companies declined to participate. At the same time, the project could identify and contact fewer than half of the firms represented in the ads; the other half remains “orphan works.”⁵

In short, with items that were published when copyright registration was still a requirement, it is possible to know at least initially who claimed copyright in a work. It is often much harder, however, to identify the initial copyright owner of unpublished material. Tracking down the copyright owner can be even more challenging than with published works because there are seldom the economic interests at stake that encourage copyright owners of published works to remain identifiable. The amount of research needed to clear all copyrights can easily dwarf the amount of effort put into researching a historical piece in the first place. And even with the best possible effort, it is likely that

⁵ Lynn Pritcher, *Ad*Access: Seeking Copyright Permissions for a Digital Age*, D-LIB MAGAZINE (Feb. 2000), <http://www.dlib.org/dlib/february00/pritcher/02pritcher.html>.

the current copyright owners of some items will never be identified, and hence the copyright on these items could never be cleared.

Because of publisher demands for signed permissions instead of reasonable fair use, archivists regularly see researchers skip over better quality material and instead focus on those for which rights clearance will be easier, resulting in a sanitized historical record. The consequence is the corrosion of the infrastructure of a learned, educated, and culturally rich public.

2. *Nature of “Orphan Works”: Identification and Designation and*

3. *Nature of “Orphan Works”: Age*

The need to establish a system that will reduce the risk for users who wish to draw on unpublished orphan works is clear. It is important that an orphan works system should balance the copyright owner’s interest in exploiting a work with the public’s interest in having access to the raw material of history.

SAA therefore proposes that a blended orphan works identification and designation system be implemented. The system we propose would combine aspects of both the “case by case” approach discussed in the Federal Register Notice as well as the “formal approach.” Two actions on the part of users should be required in order to disseminate without fear of prosecution an orphan work. In addition, copyright owners should have access to a system where they can voluntarily identify their ownership interests.

First, before an archives or an archives user can publish an unpublished copyrighted work, they should be required to make a “reasonable effort” to locate the copyright owner. This requirement would be in place during the first twenty-five years after the author’s death or, in cases where the death date of the author is unknown, during the fifty years after the date of origin of the work. Such an investigation would include researching in the online files of the Copyright Office. It may also include searching as well genre-specific rights resources such as:

- For literary and artistic figures: *WATCH: Writers, Artists, and Their Copyright Holders*, an online file created by the Harry Ransom Humanities Research Center at The University of Texas at Austin and the University of Reading Library, Reading, England.
- For composers and musicians, the various publishing and performance rights societies.
- For artists, artist rights societies such as the Visual Artists and Galleries Association and the Artists Rights Society.
- When readily available, online biographical and obituary indices should also be searched.

Secondly, regardless of the age of the copyrighted work, the user should be required to publish his or her intent to exploit an orphan work. Normally, if one wants to declare a

physical property to be abandoned, publication of a notice in a local newspaper is required.⁶ While we are not proposing that copyright be abandoned by this mechanism, we think the analogy of publishing one’s intent to use an orphan work – namely, by publishing a “Notice of Intent to use an Orphan Work” via a searchable database at the Copyright Office – would be appropriate. It would be a way of announcing to the world that you consider this work to be “orphan,” and it would provide an opportunity for the copyright owner to step forward and challenge this assertion. Ninety days after submission of the notice, someone who wanted to use or disseminate an orphan work would be free to do so without fear.

Lastly, in order to protect the interests of individuals and organizations that may wish to control their copyright in seemingly orphaned unpublished works, a notification system should be established at the Library of Congress. Similar in intent and purpose to the “Notices of Intent to Enforce a Restored Copyright” and the “Notice to Libraries and Archives of Normal Commercial Exploitation or Availability at Reasonable Price,” the proposed “Notice of Intent to Enforce a Non-Registered Copyright” would be a place where copyright owners could announce to the world that their works were not “orphans.” So long as the information about the copyright owner in the registration system is kept current, no work could be published under the orphan works provisions during its term of copyright without the permission of the copyright owner.

The mechanics for defining an unpublished orphan work, therefore, would depend in part on its age. During the period up to twenty-five years after the death of the author or during the first fifty years since creation of the work (if the author is not known), an orphan work would be any work for which:

- The copyright owner cannot be found after a reasonable investigation in standard sources;
- No “Notice of Intent to Enforce a Non-Registered Copyright” has been filed with the Copyright Office;
- A notice of declaration of the work as an orphan work has been filed on the Copyright Office’s web site.

After that initial time period, an orphan work would be any work for which no “Notice of Intent” has been filed, and for which a notice of declaration of orphan work status has been filed.

4. Nature of “Orphan Works”: Publication Status

⁶ At least nineteen states have adopted statutes to permit museums and archives to establish irrevocable ownership of physical property “abandoned” by the owners. Abandonment in these statutes is similar to orphaning in the context of copyright—it has become impossible to identify the owner, and the owner’s intention as to the property (whether a loan or donation to the repository) is undocumented.

Any solution to the “orphan works” problem must address unpublished as well as published material. There are at least two reasons for this, one practical and the other based on policy.

a. The difficulty of determining what is “published”

First, on a very practical level, it is often difficult to tell if a work is published or unpublished. Current copyright law defines publication as “the distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending.” It is often difficult, however, to know whether a specific item meets this standard.

For example, newsletters of unions, church groups, and professional associations are often printed for distribution to members. Yet it is usually unclear whether these items were also made available to the general public in the past. If distribution was limited, the printed newsletters could, for copyright purposes, still be considered to be unpublished, and any effort by a library or archives to republish the collection as a contribution to historical scholarship might be thwarted.

The definition of publication excludes performance as a form of publication: “a public performance or display of a work does not of itself constitute publication.” Often movies were only leased, not sold, to theaters for performances. These movies may not technically have been published. Even something as well known as Martin Luther King’s “I have a dream” speech has been subject to lawsuits over its publication status.

One of the potentially most useful resources in America’s libraries and archives are the millions of photographs taken by local amateur, news, and commercial photographers. Such photographs provide an invaluable visual window to the past. Most often they are true orphan works, with no certainty as to whether the images were “work for hire” or the property of the photographer, and with no evidence as to who is the current copyright owner. While often intended for publication, there is often no evidence whether any individual photograph actually was published.

Limiting any new rules governing the use of orphan works to published works is likely to just replace uncertainty as to the identity of copyright owners with uncertainty over the publication status of the work. The end result will be the same, however: users are unlikely to exploit the hundred of thousands of works of minor commercial value yet great historical value found in the nation’s archives and libraries.

b. The public policy case for making unpublished orphan works available

Unpublished materials constitute an important component of those “orphan works” that subsequent creators and users might wish to incorporate in new creative efforts or make available to the public. Unpublished papers form the core of historical research and the

basis for historical understanding. Their importance to future scholarship and understanding has been recognized in the historical editing and publication projects sponsored by the National Endowment for the Humanities and the National Historical Publications and Records Commission. These Federal agencies have supported the publication of the papers of the Presidents and other prominent figures, even though in most cases the identity of the current copyright owners of the individual documents was not known. The benefit to scholarship of making these “orphan works” widely available outweighed the risk.

Andrew Carroll’s *War Letters: Extraordinary Correspondence from American Wars*, a compilation of letters home from soldiers in many of America’s wars, in both its published form and as a PBS special, has reminded us of the power of the writings of ordinary Americans to convey the sense of the past. As the Legacy Project, the organization that collected the letters, notes:

The Legacy Project focuses on letters because we believe they offer unique insight into warfare and its effect on those who experience it firsthand. Letters also serve as powerful reminders of the human cost of war, and they record the thoughts and observations of common servicemen and women, whose individual voices are so often unheard.

War letters from average Americans are perhaps the quintessential “orphan work.” They were written with no expectation of commercial gain, in most cases it would cost a fortune to discover who was the current copyright owner (especially if the soldier died in combat), and yet their value in future creative works is tremendous. But war letters are not the only unpublished orphan works with these qualities. So too are letters to Presidents, letters to local governments, diaries whose authors’ whereabouts are uncertain, local photographs, oral history recordings, and organizational newsletters, to name a few. To exclude them from “orphan work” legislation merely because they are unpublished would be unconscionable.

c. Right of “First Publication”

In the Federal Register notice, the Copyright Office asked specifically:

If “orphan work” status would apply to unpublished works, how would such a system preserve the important right of first publication recognized by the Supreme Court in *Harper & Row*?

While the Court identified a right of first publication in the decision, the right focused on its commercial aspects. The Supreme Court correctly noted that the copyright owner’s commercial interests would be harmed if the right to first publication were not exclusive. As the Court noted,

The author's control of first public distribution implicates not only his personal interest in creative control, but his property interest in exploitation of prepublication rights, which are valuable in themselves and serve as a valuable adjunct to publicity and marketing.⁷

In the Harper & Row case, the commercial right of first publication was important: by violating Harper & Row's right to first publication, *The Nation* magazine usurped Harper & Row's own intent to publish (and profit) from the work. It is the commercial harm to the copyright owner, therefore, that is the focus of the Court's concern. The decision is by and large silent on the implications for works that were not intended for commercial release. It is difficult to imagine that the Court would have argued after Harper & Row that initiative to publish the papers of Thomas Jefferson and Calvin Coolidge would have to shut down because they might negatively impact the prepublication rights of heirs who are unlikely to know that they even own rights in the papers.

The Court concluded that "Under ordinary circumstances, the author's right to control the first public appearance of his undissemated expression will outweigh a claim of fair use." It is not hard to conclude, however, that the publication of "orphan works" where the copyright owner is not known (and may not even know that he or she owns the rights) and which are of limited commercial value does not constitute the "ordinary circumstances" of commercial publication considered in the decision.

Justice Story, in *Folsom v. March*, noted that there are times when the government has the right if not the duty to publish unpublished items containing "historical, military, or diplomatic information," even against the will of the writers.⁸ Private individuals as well, he believed, had the right to publish private letters "upon fit and justifiable occasions." The right of first publication, therefore, is far from an absolute right, and it seems clear that it is not a right that can be managed effectively under Federal copyright.

d. Adverse Consequences

Lastly, the Copyright Office asked specifically what would be "the negative consequences of applying such a system to unpublished works?" There are none. As has been noted above, there is a long tradition already of publishing, often with Federal support, unpublished "orphan works." Any recommendations that the Copyright Office develops to ensure that there are not negative consequences to the use of published "orphan works" (such as the simple system of notices we outline here) will also protect unpublished "orphan works."

5. Effect of a Work Being Designated an "Orphan Work"

⁷ Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 550-555 (1985).

⁸ *Folsom v. Marsh*, 9 F. Cas. 342 (1841).

To solve the problem that “orphan works” constitute for users, a series of provisions are needed that on the one hand makes it easy for owners to make clear their interest in enforcing their copyrights and on the other hand frees users who have made good faith efforts from the liabilities which currently have a chilling effect on creative works.

The designation of a work as “orphan” is less the result of a conscious decision on the part of the copyright owner than the result of a reasonable investigation with in the competence of capable researchers. It must be easily reversible if a rightful owner comes forward to request removal of a work from “orphan” status but without penalizing the user who used the work after a good faith effort to find the owner.

To establish this safe harbor for the creative use of “orphan works,” the following elements are needed:

1. An on-line database for users to post a “Notice of Intent to use an Orphan Work” whenever a user determines he/she does not wish to employ one of the other exemptions (e.g., § 107, 108, 109, 110, etc.). If, after a reasonable interval of ninety days, no one comes forward to assert a documentable copyright ownership claim, the user may proceed and shall be eligible for an “orphan works” defense.
2. In no case does use of an orphan work remove ownership from the original copyright owner. Furthermore, the user’s copyright in a derivative work created from an “orphan work” extends only to that new expression which the user has added.
3. If an “orphan work” has been used after proper completion of “Notice of Intent to Use an Orphan Work”, and if the original copyright owner then comes forward and can sustain a claim of ownership, the following shall apply:
 - A) The orphan works database shall be amended to reflect that an owner has been identified so that the work can no longer be deemed to be an orphan.
 - B) The user may continue to use the orphan work after payment of a reasonable license fee.
 - C) The user of the work previously considered to have been an orphan shall not be liable for statutory damages, attorney’s fees, criminal damages, or any of the other remedies available in the Copyright Act and in other laws (such as the No Electronic Theft Act) for any use commenced prior to the time that the validity of the ownership claim has been clearly established by a court. The copyright owner would be entitled to an appropriate portion of any profits that may have accrued through the use of the previously orphan work.

4. At any time, a copyright owner may file a “Notice of Intent to Enforce a Non-Registered Copyright” with the “orphan works” database system.

5. Individuals who file a spurious “Notice of Intent to Enforce a Non-Registered Copyright” and organizations that license rights for copyright owners must meet the highest standards for accuracy. Failure to report accurately the copyright status of a work would subject them to the same penalties as are faced by a copyright infringer.