

COMMENT

1. Definition of Orphan Works

The *term* “orphan works” has a specific definition in the copyright community that should be adopted by the Copyright Office with a slight modification. Although most individuals define “orphan works” as “copyrighted works where the rights holder is hard to find”¹ the definition should be “works which are under copyright *or whose copyright status is uncertain* and whose owners are difficult or (possibly) impossible to locate” so as to include within the scope of the definition situations such as the undated letters hypothetical discussed below.

2. Concerns Raised by Orphan Works

Authors who wish to incorporate an orphan work into a new work or individuals who wish to make an orphan work available to the public may be discouraged from taking action due to the possibility of infringement liability if the copyright owner of the orphan work eventually shows up. While it can be argued that the purposes of copyright² will still be furthered by discouraging use of orphan works in the cases where the owner of the work still has a desire to enforce his or her copyright rights, in the cases where orphan works are actually no longer under copyright, no longer have an owner, or have an owner who no longer wishes to enforce his or her copyright, discouraging people from using orphan works does not further the purpose of

¹ See e.g., <http://www.orphanworks.org/>, <http://www.eldred.cc/>, see also <http://www.publicknowledge.org/issues/ow>.

² U.S. Const. art. I, § 8, cl. 8.

copyright. Because (by definition) it is difficult to tell if the copyright of an orphan work is held by someone who wishes to assert their copyright rights and because (by definition) the probability of the copyright owner eventually asserting their rights is low, the existence of orphan works subverts the purposes of the copyright act.

Below are hypotheticals highlighting some of the problems involved in orphan works:

a. Work Under Copyright, but Corporate Owner No Longer in Existence:

A company (BigCo) owned the copyright in several films produced in 1930. The company filed for a renewal of its copyrights in 1958. The company subsequently went out of business. The films are under copyright until 2025. John Doe wants to make a digital copy of the films so they can be preserved. In addition Jane Smith wants to re-make one of the movies. If neither can identify and contact BigCo's successor in interest and obtain a license, both will probably be afraid to undertake their project. This outcome is undesirable if there is no company or individual that wishes to assert 17 USC § 106 rights with respect to the movies.

b. Work Under Copyright, but Cannot Find the Owner:

John Doe wants to make a new work based on a book that was published in 1965 with a copyright notice. He however cannot locate the copyright owner. He may be afraid to undertake efforts to make the new book. This is an undesirable outcome if the copyright owner would be happy to have John Doe make a derivative work of her work.

c. Copyright Status Uncertain:

Jane Smith wants to make a new work based on fan mail sent to her favorite TV star. The letters do not have a date or copyright notice. Works published without a copyright notice after March 1, 1989 can be under copyright. Works published from 1923 to 1977 without a copyright notice are in the public domain. If Jane Smith has no way of knowing which year the

letters were written or of contacting the authors of the letters to get licenses she may be afraid to publish the book. This outcome is undesirable if the letters are in the public domain.

3. Specific Questions Asked by the Copyright Office

a. Nature of “Orphan Works”: Identification and Designation

There are two main reasons the case-by-case approach to the identification/designation of orphan works is preferable to a formal approach. First, because the Berne Convention’s restriction on “formalities,” copyright holders cannot be *required* to participate in a registry system as a means of preventing their works from being deemed “orphaned.” Second, because of Canada’s experience with its orphan works registry (only 125 licenses have been issued since 1990),³ there is an indication that it might be more cost-efficient for the Copyright Office to have procedures for deeming a work an “orphan work” rather than procedures for preventing works from being deemed “orphan works.” This is because, the number of authors who wish their works not be deemed “orphaned” probably greatly outweighs the number of people who wish to use orphan works.

The Copyright Office should make determinations as to whether a work is an “orphan work.” If an individual wishes to deem a work an “orphan” he or she should submit an application for a determination of “Orphan Status” to a department within the Copyright Office dedicated solely to orphan works. Like the Patent and Trademark Office, this department’s operating budget should come from application fees. If the Copyright Office determines that the applicant has satisfied the criteria for deeming a work an “orphan” then the office will: (1) deem the work an “orphan;” (2) give the applicant a certificate indicating the Copyright Office’s determination; (3) add the work to a list of orphan works on the Copyright Office’s website; and

³ 70 Fed. Reg. 3739 (Jan. 26, 2005).

(4) add the work to a paper-copy list of orphan works located at the Library of Congress. If other individuals wish to use an orphan work they must request a “Orphan Status” certificate from the Copyright Office and pay a fee. This will enable the Copyright Office to keep track of all the individuals using a given orphan work.

In order to determine if it should deem a work an orphan work, the Copyright Office should investigate the steps an individual has took to contact the copyright holder. To make these investigations consistent from work to work, the Copyright Office should come up with a non-exclusive list of actions an individual should undertake to contact a copyright holder. Some examples of actions that could be part of the non-exclusive list include: posting notices in national newspapers, searching the death records of the author’s home town (if it is known), and contacting the publisher (if it is known).

b. Effect of a Work Being Designated “Orphaned”

i. Good Faith Reliance on Certificate as a Defense to Infringement Liability

An individual who has a certificate that a given work is an “orphan” may treat the orphan work as if it were in the public domain. If an individual relies on the certificate in good faith, that will be a complete defense to infringement liability, subject to the limitations in paragraph (ii).⁴ This provision will work to eliminate individuals fear of using orphan works.

ii. Procedure for Revoking “Orphan Work” Status

If a copyright holder learns that his or her work is listed as an “orphan work” by the Copyright Office, he or she can request to have the work delisted. The copyright holder would file a “delisting request” form with the orphan works department within the Copyright Office and

⁴ See 17 U.S.C. § 302 (e).

pay a fee.⁵ This procedure should be similar to the procedure for registering a copyright with the copyright office.⁶ The Copyright Office must then immediately order the work delisted and contact all the users of the orphan work, informing them of the delisting.

iii. One Year Mandatory License Once Copyright Owner Reappears

If an orphan work is delisted, individuals who were using the work based on a good faith reliance on the certificate are entitled to a one year license to use the work.⁷ A reasonable royalty shall be paid to the rights holder during that year. In addition, a reasonable royalty shall be paid for all the years the individuals were using the orphan work in good faith. The Copyright Office shall determine the reasonable royalties by considering factors such as: whether or not the “new” work made its authors a profit; how many copies of the “new” work were distributed, percentage of the “old” work is in the “new” work, costs expended by the individual in developing the “new” work, and reasons why the original copyright holder was difficult to locate.

After the year of the mandatory license is complete, the user of the former orphan work cannot utilize the orphan work without a license from the copyright holder of the original work.

After a rights holder has his or her orphan work delisted, the user of the orphan works may challenge the validity of the copyright of the orphan work or of the rights holder’s ownership interest in the copyright. Such challenge may be brought in any federal district court that has jurisdiction.

⁵ See 17 U.S.C. § 411(a). If § 411(a) does not violate the Berne Convention restriction against formalities, this procedure should not violate the Berne Convention either.

⁶ See 17 U.S.C. § 409.

⁷ See 17 U.S.C. § 104A(d)(2)