



AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION

2001 JEFFERSON DAVIS HIGHWAY ■ SUITE 203 ■ ARLINGTON, Virginia 22202

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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

Reply Comments to Comments Submitted Pursuant to Notice of Inquiry to Examine
Issues Raised by "Orphan Works" 70 Federal Register 3739 (January 26, 2005)

Dear Jule:

On behalf of the American Intellectual Property Law Association (AIPLA), I am pleased to offer reply comments to the initial comments the Copyright Office received in connection with the January 26, 2005 Notice of Inquiry regarding the issues raised by "orphan works."

AIPLA is a national bar association whose more than 16,000 members are primarily lawyers in private and corporate practice, in government service, and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

OBJECTIVES OF ORPHAN WORK PROPOSAL:

AIPLA agrees that difficulties in identifying and locating the owners of copyright in some "orphan works" present a genuine problem, and that society would benefit from greater access to such works. AIPLA 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 international obligations 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. Scope of Orphan Works

The definition of "orphan works" should consist of a broad, functional description to be applied by the courts in the event of litigation. Such a definition cannot be drafted until the Copyright Office has had an opportunity to research and identify "reasonable guidelines." These may well be different for various kinds of works or different kinds of uses. It may also be

appropriate to limit the “orphan work” regime to older works for certain categories of copyrighted works, while for others, it may be appropriate to have no age limit.

The broad definition should be phrased in terms of the result, e.g., “the owner or his/her agent cannot with reasonable diligence be located,” rather than specifying any particular investigation the prospective user must undertake. 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 or a dance performance.

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 AIPLA agrees with Professors Goldstein and 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).

Finally, we believe that the designation of “orphan work” status should not cause users to engage in less diligence than the present strict-liability system.

B. Safe Harbor Provisions

In addition, a solution might also incorporate a series of specific statutory safe harbors that would create an irrebuttable presumption of “orphan work” status, similar to the DMCA safe harbors for ISP’s or the section 110 exemptions for 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. Any statutory safe harbors, however, should be precisely spelled out and limited in scope.

Any such safe harbors 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.

AIPLA questions the proposals for voluntary or mandatory registration of works, and believes that the Copyright Office should study whether the operation of the safe harbors should be made contingent on the creation of any new informational resource or clearinghouse, whether private or governmental.

OPERATION AND EFFECT:

A. Safe Harbor Uses

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. 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.

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 reasonable license fee for continued use should be set, as with reliance party derivative works under § 104A. The Copyright Office should study the issue and determine if a change to the remedies provisions in Chapter 5 of Title 17 would be appropriate. The Office should also consider whether it would be appropriate to impose a prohibition on injunctive relief where the user, after a diligent search, had made a significant investment in creating the derivative work.

B. Other Uses

For works 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. In this case, the burden should fall on defendant to prove that the work's owner could not with reasonable diligence be located by coming forward with evidence of the steps defendant took to locate the owner. The plaintiff would still have the burden of proving ownership, however, as in any infringement action.

We believe that the above proposals would be consistent with international obligations of the United States because, like section 104A, they would not impose any formalities as a condition to copyright protection, but merely restrict the availability of remedies in certain circumstances. We are aware, however, that many questions remain. Accordingly, we urge further study and discussion before any conclusions are reached.

We appreciate the opportunity to provide these reply comments and would be pleased to assist the Copyright Office in the further examination of the issues raised by "orphan works."

Respectfully Submitted,

A handwritten signature in black ink that reads "Michael K. Kirk". The signature is written in a cursive style with a large, stylized initial "M".

Michael K. Kirk
Executive Director