



# ORPHANS IN TURMOIL: HOW A LEGISLATIVE SOLUTION CAN HELP PUT THE ORPHAN WORKS DILEMMA TO REST

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## I. INTRODUCTION

The orphan works issue has continued to grow in the United States despite strong efforts to find a workable solution. Stakeholders on both sides of the issue have proposed and opposed both solutions and compromises that could have alleviated the problem and are still no closer to an agreement. This paper posits that the solutions offered in the proposed legislation of 2006 and 2008<sup>1</sup> provide a strong working foundation for a legislative answer to the issue. To create a workable solution to the orphan works issue, a new legislative effort would have to take into account the questions raised by stakeholders to the previous legislative attempts of 2006 and 2008. This paper also proposes that those answers can be found in the working models used by other jurisdictions attempting to solve the orphan works dilemma.

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<sup>1</sup> Orphan Works Act of 2006, H.R. 5439, 109th Cong. (2006), *available at* <https://www.govtrack.us/congress/bills/109/hr5439>; Orphan Works Act of 2008, H.R. 5889, 110th Cong. (2008), *available at* <https://www.govtrack.us/congress/bills/110/hr5889/text>; Shawn Bentley Orphan Works Act of 2008, S. 2913, 110th Cong. (2d Sess. 2008), *available at* <https://www.govtrack.us/congress/bills/110/s2913/text>.

The first part of this paper will provide background on the issue of orphan works, including the massive size of the issue, and the parties affected by the issue. The second part will look at the legal background of the issue from both the domestic and international law perspectives. This portion of the paper will include an abbreviated review of the law, culminating with the legislative solutions proposed in the Orphan Works Act of 2008 and the Shawn Bentley Orphan Works Act of 2008. The third part will explore some of the more appropriate solutions found in international law models. The last part of the paper will examine previously proposed solutions and offer a unifying answer to the orphan works issue.

## II. THE NATURE OF ORPHAN WORKS

Orphan works are those works still under copyright protection for which would-be users or exploiters of that work are unable to locate the right holder but whose use or exploitation does not fall under a copyright exception or limitation.<sup>2</sup> A work can be considered orphaned if the right holder cannot be identified or located. The age of the work itself is irrelevant in the consideration of orphanage.<sup>3</sup> Advances in technology, particularly in the area of graphic arts and photography, have made it possible for works to become orphaned in a very short time because they can easily be

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<sup>2</sup> See Copyright Office Notice of Inquiry: Orphan Works, 70 Fed. Reg. 3739 (Jan. 26, 2005). The notice defines orphan works as “copyrighted works whose owners are difficult or even impossible to locate.” *Id.*

<sup>3</sup> See *id.* The notice describes taking into consideration what an appropriate time period would be in order for a worked to be of “orphaned status;” however, the notice recognizes that the age of works considered “orphaned” is likely unknown. See also Denise Troll Covey, *Rights, Registries, and Remedies: An Analysis of Responses to the Copyright Office Notice of Inquiry Regarding Orphan Works*, in FREE CULTURE AND THE DIGITAL LIBRARY: SYMPOSIUM PROCEEDINGS 2005 117 (2005), available at [http://repository.cmu.edu/cgi/viewcontent.cgi?article=1048&context=lib\\_science](http://repository.cmu.edu/cgi/viewcontent.cgi?article=1048&context=lib_science) (explaining how setting a minimum age to define orphan work would be arbitrary). The appropriate solution is to make age irrelevant if a “reasonable effort” or compulsory licensing is adopted to solve the orphan works problem.

digitized and disseminated without proper attribution.<sup>4</sup> The orphan works issue is not new. Even with a system of registration and renewal for copyrighted works, there is potential for the right holder's contact information to become outdated during the period of copyright protection. Because of increased longevity in copyright protection,<sup>5</sup> there would appear to be more opportunities for difficulties in locating rights holders.<sup>6</sup>

The increased duration of protection is not the only factor leading to the creation of orphan works. Lack of formalities, such as registration and renewal, the expansion of copyright protection to greater types of work, and the divisible nature of intellectual property rights have also contributed to the proliferation of orphan works. Given the divisible nature of the bundle of rights concept in copyright law, the scope of original transfer of rights can create situations where certain types of exploitations themselves, in particular those created by new technologies, might be orphaned. When an original right holder has retains the rights to exploitations based on new technologies after transferring more traditional rights to a locatable publisher, those rights to new exploitations can become orphaned.

In order to create a working solution to the orphan works issue, it is also important to acknowledge that reduction in formalities and extended protection are not the only causes creating orphan

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<sup>4</sup> See Comments on Orphan Works Study (70 FR 3739) from Brad Holland & Cynthia Turner, *Illustrator's P'ship of Am.*, to Jule L. Sigall, Assoc. Register for Policy & Int'l Affairs, U.S. Copyright Office (Mar. 24 2005), *available at* <http://www.copyright.gov/orphan/comments/OWo660-Holland-Turner.pdf>; *see also* Comments on Notice of Inquiry Regarding Orphan Works from Stephen Morris, *Prof'l Photographers of Am.*, to Jule L. Sigall, Assoc. Register for Policy & Int'l Affairs, U.S. Copyright Office (Mar. 25, 2005), *available at* <http://www.copyright.gov/orphan/comments/OWo642-PPA.pdf>.

<sup>5</sup> See 17 U.S.C. §§ 302-304 (2014). The Sonny Bono Copyright Term Extension Act of 1998 increased the terms of protection from life of the author plus fifty years to life plus seventy for works created as of 1978 and seventy-five years from publication to ninety-five years from publication for works published before 1978. *Id.* This protection was also extended to works published before 1964 whose original copyright term had been renewed. *Id.*

<sup>6</sup> Notice of Inquiry, Orphan Works and Mass Digitization, 77 Fed. Reg. 204 (Oct. 22, 2012), *available at* <http://www.copyright.gov/fedreg/2012/77fr64555.pdf>.

works. Right holders in the formality-based system found in the United States, prior to enactment of the Copyright Act of 1976, may have also proven difficult to locate because even with registration and renewal requirements, the U.S. system did not require the updating of right holder information.<sup>7</sup> The recording of right holder information beyond the original renewal application was never a requirement for retaining a copyright, so it is possible for works protected under the formalities system to become orphaned due to lack of accessibility to the right holders.

### III. WHO IS AFFECTED?

The range of potentially affected users extends from commercial entities trying to reissue out-of-print works or to create derivative works from orphans, to cultural and educational institutions like libraries, archives, and museums conducting digital preservation, to individuals who are simply attempting to use materials found on the Web.

### IV. HOW BIG IS THE ISSUE?

In 2005, the European Union launched a series of initiatives, labeled “i2010” initiatives, as a framework for addressing the main challenges and developments in the information society and media sectors through 2010.<sup>8</sup> A year later, in August 2006, the European Commission issued a recommendation to member countries to improve accessibility and preservation of works through digitization in support of the i2010 digital libraries initiative.<sup>9</sup> The degree of effort and expense required to collect materials for the digital libraries initiative that resulted from these

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<sup>7</sup> See generally Copyright Act of 1909, ch. 320, 35 Stat. 1075.

<sup>8</sup> See generally *Communication from the Commission to the Council, the European Parliament, the European Economic and Social Committee and the Committee of the Regions: “i2010—A European Information Society for Growth and Employment”*, COM (2005) 229 final (Jan. 6, 2005).

<sup>9</sup> See Commission Recommendation of 24 August 2006 on the Digitization and Online Accessibility of Cultural Material and Digital Preservation 585/EC, 2006 O.J. (L 236/8) 6.

recommendations served to highlight the level of the orphan works issue.<sup>10</sup> The European Commission's report on the assessment of orphan works in the EU concluded that there were at least 3,000,000 books and 129,000 films that could be considered orphaned.<sup>11</sup> In the United Kingdom alone, 17,000,000 photographs, that is 90% of the total collections of photographs in museums in the United Kingdom, have untraceable right holders, and "[i]n the collections of the Danish National Library there are around 160,000 works from the period 1880-1930 with uncertain copyright status."<sup>12</sup> In the United States, few studies compare to the scope of the EU report, but the U.S. Register of Copyrights has stated that the orphan works issue is "pervasive."<sup>13</sup> A study

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<sup>10</sup> ANNA VUOPALA, EUROPEAN COMM'N, ASSESSMENT OF THE ORPHAN WORKS ISSUE AND COSTS FOR RIGHTS CLEARANCE 4-6 (2010), available at [http://ec.europa.eu/information\\_society/activities/digital\\_libraries/doc/reports\\_orphan/anna\\_report.pdf](http://ec.europa.eu/information_society/activities/digital_libraries/doc/reports_orphan/anna_report.pdf).

<sup>11</sup> *Id.* at 5.

<sup>12</sup> *Id.*

<sup>13</sup> See *The "Orphan Works" Problem and Proposed Legislation Before the H. Subcomm. on Courts, the Internet, and Intellectual Prop. of the H. Comm. on the Judiciary*, 110th Cong. (2008) (statement of Marybeth Peters, the Register of Copyrights), available at <http://www.copyright.gov/docs/regstat031308.html>.

In fact, the most striking aspect of orphan works is that the frustrations are pervasive in a way that many copyright problems are not. When a copyright owner cannot be identified or is un-locatable, potential users abandon important, productive projects, many of which would be beneficial to our national heritage. Scholars cannot use the important letters, images, and manuscripts they search out in archives or private homes, other than in the limited manner permitted by fair use or the first sale doctrine. Publishers cannot recirculate works or publish obscure materials that have been all but lost to the world. Museums are stymied in their creation of exhibitions, books, websites and other educational programs, particularly when the project would include the use of multiple works. Archives cannot make rare footage available to wider audiences. Documentary filmmakers must exclude certain manuscripts, images, sound recordings and other important source material from their films.

conducted by Carnegie Mellon University libraries during the planning to digitize their collections highlighted the scope of the issues faced by this single institution. In order to determine the copyright status of its collection, Carnegie Mellon used a statistically valid, random sample of the works therein.<sup>14</sup> Publishers or right holders of almost a quarter (22%) of the books selected for the study could not be located.<sup>15</sup> Even in the cases where the publishers or right holders could be identified and located, over a third (36%) did not respond to *multiple* letters of inquiry, and “[m]ost (79%) of the books about which they did not respond were out of print.”<sup>16</sup>

Cornell University Library also completed a study of its collection, and in comments to the Copyright Office, reported that of 343 copyright-protected monographs that were out of print and were candidates for inclusion in a digitization project more than

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*Id.*; see also Marybeth Peters, *The Importance of Orphan Works Legislation*, U.S. COPYRIGHT OFF. (Sept. 25, 2008), <http://www.copyright.gov/orphan/OWLegislation/>.

The problem is pervasive. Our study recounts the challenges that publishers, filmmakers, museums, libraries, universities, and private citizens, among others, have had in managing risk and liability when a copyright owner cannot be identified or located. In testimony before the Senate, a filmmaker spoke of the historically significant images that are removed from documentaries and never reach the public because ownership cannot be determined. In testimony before the House, the U.S. Holocaust Museum spoke of the millions of pages of archival documents, photographs, oral histories, and reels of film that it and other museums cannot publish or digitize.

*Id.*

<sup>14</sup> Comments on Orphan Works Notice of Inquiry from Denise Troll Covey, Principal Librarian for Special Projects Carnegie Mellon Univ. Libraries, to Jule L. Sigall, Assoc. Register for Policy & Int’l Affairs, U.S. Copyright Office 3 (Mar. 22, 2005), *available at* <http://www.copyright.gov/orphan/comments/OW0537-CarnegieMellon.pdf>.

<sup>15</sup> *Id.*

<sup>16</sup> *Id.*

half (198) were orphan works.<sup>17</sup> Cornell also reported that in forty-seven cases permission for digitization was denied because the person contacted was unsure if they were authorized to allow use of the work.<sup>18</sup> All told, Cornell University Library generated over \$50,000 in staff remuneration for time spent trying to reconcile copyright issues, yet only ninety-eight of the 343 titles were found to be eligible for digitization.<sup>19</sup>

## V. U.S. COPYRIGHT LAW PRIOR TO BERNE

### A. COPYRIGHT ACT OF 1790

Congress first enacted a federal copyright regime under the grant of authority given by Article I, Section 8, Clause 8 of the U.S. Constitution, which states that “Congress shall have the Power... [t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”<sup>20</sup> This first constitutional enactment resulted in the creation of the Copyright Act of 1790.<sup>21</sup> The Act of 1790 granted authors a fourteen-year monopoly<sup>22</sup> over their works for the purpose of “foster[ing] the growth of learning and culture for the public welfare.”<sup>23</sup> Congress drafted the Act of 1790 with careful attention to the limitations of

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<sup>17</sup> Comments on Orphan Works Notice of Inquiry from Sarah E. Thomas, Cornell’s Carl A. Kroch Univ. Librarian to Jule L. Sigall, Assoc. Register for Policy & Int’l Affairs, U.S. Copyright Office 2 (Mar. 23, 2005), *available at* <http://www.copyright.gov/orphan/comments/OW0569-Thomas.pdf>.

<sup>18</sup> *Id.*

<sup>19</sup> *Id.*

<sup>20</sup> U.S. CONST. art. I, § 8, cl.8.

<sup>21</sup> *See generally* Copyright Act of 1790, 1 Stat. 124.

<sup>22</sup> *Id.* § 1.

<sup>23</sup> COPYRIGHT OFFICE, REGISTER’S REPORT ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 7 (1961), *available at* [http://ipmall.info/hosted\\_resources/lipa/copyrights/Register%27s%20Report%20on%20the%20General%20Revision%20of%20the%20U.S.pdf](http://ipmall.info/hosted_resources/lipa/copyrights/Register%27s%20Report%20on%20the%20General%20Revision%20of%20the%20U.S.pdf).

copyright protection.<sup>24</sup> Formalities in the way of registration, deposit, notice, and renewal clearly demarcated the boundaries of the monopoly given to the authors by creating a set of rules that must be strictly followed to prevent loss of protection.<sup>25</sup>

U.S. copyright law continued to develop with amendments to the Act of 1790 in 1831,<sup>26</sup> 1834,<sup>27</sup> and 1870,<sup>28</sup> but these developments did not change the scheme of formalities laid out by the original. The 1831 amendment, however, did extend the duration of copyright protection to twenty-eight years, but even with this longer term the public still enjoyed a fairly early release of protected materials into the public domain.<sup>29</sup>

## B. COPYRIGHT ACT OF 1909

The first major revision of copyright law in the United States resulted from the Copyright Act of 1909, which was enacted by Congress as a reaction to technological developments.<sup>30</sup> The first key change in the new Act of 1909 resulted in the linking of federal copyright protection to the moment of publication in a work.<sup>31</sup> The second key change extended the renewal term to twenty-eight years, increasing protection to a potential term of fifty-six years.<sup>32</sup> The Act of 1909 also doubled the length of copyright protection for published works, but that protection still contained the division of

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<sup>24</sup> See generally WILLIAM PATRY, PATRY ON COPYRIGHT, ch. 1, § III.A.

<sup>25</sup> See Copyright Act of 1790, ch. 15, 1 Stat. 124, 124-25.

<sup>26</sup> Copyright Act of 1831, ch. 16, 4 Stat. 436 (codified as amended at 17 U.S.C. §§ 302-304).

<sup>27</sup> Act of June 30, 1834, ch. 157, § 1 (codified as amended at 17 U.S.C. § 205).

<sup>28</sup> Act of July 8, 1870, ch. 230, § 85.

<sup>29</sup> See ch. 16, 4 Stat. at 436.

<sup>30</sup> See generally PATRY, *supra* note 24 at ch 1, § III.C.

<sup>31</sup> See Copyright Act of 1909, ch. 320, 35 Stat. 1075.

<sup>32</sup> *Id.* §§ 24-25.



and initial and renewal terms.<sup>33</sup> This division allowed for potential early release of protected works into the public domain.<sup>34</sup>

## VI. THE INTERNATIONAL SYSTEM: PARIS CONVENTION AND THE BERNE CONVENTION

The international system of intellectual property protection is based on the concept of preventing theft of intellectual property while enhancing international trade.<sup>35</sup> This general principle was introduced by the first significant international treaty on intellectual property, the Paris Convention for Protection of Industrial Property, in 1883.<sup>36</sup> The Paris Convention allows individuals in a signatory country to have protection for inventions, trademarks, and industrial designs in all other signatory countries.<sup>37</sup>

While the Paris Convention laid the foundation for intellectual property protection across international borders, it was not until 1886, with the Berne Convention for the Protection of Literary and Artistic Works<sup>38</sup> that issues of transnational copyright protections really began to be addressed. The Berne Convention's purpose was to protect author's rights in signatory countries by implementing the concept of national treatment; this guarantees authors from other member nations the same protection as national authors in their home countries.<sup>39</sup> The level of protection afforded to authors

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<sup>33</sup> *Id.* § 24.

<sup>34</sup> *Id.* §§ 24-25.

<sup>35</sup> See Coree Thompson, Note, *Orphan Work, US Copyright Law, and International Treaties: Reconciling Differences to Create a Brighter Future for Orphans Everywhere*, 23 ARIZ. J. INT'L & COMP. L. 787, 795 (2006).

<sup>36</sup> See generally Paris Convention for Protection of Industrial Property, Mar. 20, 1883, 828 U.N.T.S. 305.

<sup>37</sup> *Id.*

<sup>38</sup> See Berne Convention for the Protection of Literary and Artistic Works, Sept. 8, 1886, 828 U.N.T.S. 221.

<sup>39</sup> *Id.*

under Berne is the highest internationally recognized standard of protection given to authors.<sup>40</sup>

Berne signatories must follow three basic principles of the Convention: (1) the principle of national treatment,<sup>41</sup> (2) the principle of automatic protection,<sup>42</sup> and (3) the principle of independence of protection.<sup>43</sup> In addition, one of the most important influences the Berne standards would have on U.S. law would be the principle that the enjoyment of copyright should “not be subject to any formality.”<sup>44</sup>

## VII. BEYOND BERNE

### A. TRADE-RELATED INTELLECTUAL PROPERTY RIGHTS (TRIPS) AGREEMENT (1994)

The TRIPS Agreement is made up of seventy-three different articles covering a broad range of subjects with an objective to “contribute to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations.”<sup>45</sup> Among the seventy-three articles in TRIPS are specific provisions directly addressing copyrights and related rights.<sup>46</sup> TRIPS also incorporates the Berne rule, which forbids formalities as a precondition to the enjoyment of copyright.<sup>47</sup>

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<sup>40</sup> S. REP. NO. 100-352, at 2-3 (1988), *reprinted in* 1988 U.S.C.C.A.N. 3706, 3707-08.

<sup>41</sup> Berne Convention, *supra* note 38, art. 5(1).

<sup>42</sup> *Id.* art. 5(2).

<sup>43</sup> *Id.*

<sup>44</sup> *Id.*

<sup>45</sup> Agreement on Trade-Related Aspects of Intellectual Property Rights Part 1, art. 7, Apr. 15, 1994, 1869 U.N.T.S. 299 [hereinafter TRIPS].

<sup>46</sup> *Id.* arts. 9-14.

<sup>47</sup> *Id.* art. 9(1).

## B. WIPO COPYRIGHT TREATY (WCT)

On December 20, 1996, the World Intellectual Property Organization (WIPO) adopted two treaties, the WIPO Copyright Treaty (WCT) and the WIPO Performances and Phonograph Treaty (WPPT), for the protection of authors, performers, and phonogram producers.<sup>48</sup> The WCT is a complement to Berne, adapting it to the digital environment by covering the protection of expression in digital works.<sup>49</sup> Under the WCT, copyright owners have exclusive control and additional protections over the communication of their works by means other than the physical distribution of copies.<sup>50</sup> The WCT also raises the minimum duration of protection for photographic works from the Berne minimum of twenty-five years to the fifty year minimum of all other works covered by Berne.<sup>51</sup> The U.S. has implemented the WCT through the Digital Millennium Copyright Act (DMCA).<sup>52</sup>

## C. WIPO PERFORMANCE AND PHONOGRAMS TREATY (WPPT)

The WIPO Performance and Phonogram Treaty (WPPT), which WIPO adopted along with the WCP in 1996, is an update to the Rome Convention of 1961 covering and updating the challenges presented in the exercise of the rights given to performers and producers of phonograms by the Rome Convention.<sup>53</sup> The WPPT addresses issues of copyright protection in a number of ways. It addresses piracy issues in light of recent technological developments,<sup>54</sup> grants copyright protection to the intangible

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<sup>48</sup> See HOWARD B. ABRAMS, LAW OF COPYRIGHT § 19:8 (2012).

<sup>49</sup> *Id.*

<sup>50</sup> WIPO Copyright Treaty, arts. 1, 6-8, Dec. 20, 1996, 36 I.L.M. 65.

<sup>51</sup> See ABRAMS, *supra* note 48.

<sup>52</sup> Digital Millennium Copyright Act, Pub. L. No. 105-304, 112 Stat. 2860 (1998).

<sup>53</sup> WIPO Performances and Phonograms Treaty, arts. 18-19, Dec. 20, 1996, 2186 U.N.T.S. 231.

<sup>54</sup> *Id.*

component of performances,<sup>55</sup> and provides for remuneration rights for broadcasting and communication to the public of phonograms published for commercial purposes.<sup>56</sup> Most importantly, the WPPT requires “national treatment” of copyright holders from member States.<sup>57</sup> Contracting parties, however, may opt out of certain provisions of the WPPT, thus rendering the “national treatment” provision more like a reciprocity clause.<sup>58</sup>

## VIII. COPYRIGHT ACT OF 1976

The Copyright Act of 1976<sup>59</sup> changed the historical orientation towards formalities that characterized U.S. law until that point. Prior to 1976, right holders had to comply with requirements for registration, notice, deposit, and renewal terms in order to assert their rights as copyright holders.<sup>60</sup> Without these formalities, copyright did not attach to the work. The rationale behind formalities was to create an incentive that would serve to screen works for which there was no commercial value. Consequently, this preserves a strong public domain regime where commercially “dead” works would reside.<sup>61</sup> The Act of 1976 also marked a shift from an opt-in system to an opt-out system by aligning U.S. law with the Berne model of automatic protection without formalities and extended copyright terms.<sup>62</sup> The Berne Implementation Act of 1988 further bolstered the concept of protection without

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<sup>55</sup> *Id.* art. 6.

<sup>56</sup> *Id.* art. 15.

<sup>57</sup> *Id.* art. 4.

<sup>58</sup> See DAVID BENDER, *COMPUTER LAW: A GUIDE TO CYBERLAW AND DATA PRIVACY LAWS* § 3D.07[3][a][ii] (2014).

<sup>59</sup> See generally *General Revision of Copyright Law*, Pub. L. No. 94-553, 90 Stat. 2541 (1976).

<sup>60</sup> Copyright Act of 1909, ch. 320, §§ 6, 13, 19, 26, 35 Stat. 1075.

<sup>61</sup> Christopher Sprigman, *Reform(alizing) Copyright*, 57 STAN. L. REV. 485, 489-90 (2004).

<sup>62</sup> Copyright Act of 1976, 17 U.S.C. §§ 102(a), 302.

formalities by bringing U.S. law in line with Berne through specific amendments to the 1976 Act.<sup>63</sup> Specifically, on the issue of protection, the amendments to the Act of 1976 include automatic renewal of works published between 1964 and 1977,<sup>64</sup> and retroactive protection for foreign works falling into the public domain because of failure to comply with formalities.<sup>65</sup>

Congress continued efforts to harmonize U.S. law with the international community by passing the Sonny Bono Copyright Term Extension Act of 1998 (CTEA).<sup>66</sup> A 1993 EU directive mandated that member countries adopt a life-plus-seventy years protection term.<sup>67</sup> Complying with Article 7 of Berne, the directive stipulated that a copyright from a country with a lesser protection term would not be recognized in the EU once protection had expired in the country of origin.<sup>68</sup> If Congress had not chosen to harmonize U.S. protection terms with those of the EU, American works would have lost protection at an earlier rate than European works in the EU. The enactment of the CTEA did not go unchallenged.<sup>69</sup>

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<sup>63</sup> See generally Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 1988 U.S.C.C.A.N. (102 Stat.) 2853 (1988).

<sup>64</sup> Copyright Amendments Act of 1992, Pub. L. No. 102-307, § 2, 1992 U.S.C.C.A.N. (106 Stat.) 264 (1992).

<sup>65</sup> 17 U.S.C. § 104A (LexisNexis 2014).

<sup>66</sup> See generally Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, 1998 U.S.C.C.A.N. (112 Stat.) 2827 (1998) (codified in various sections of 17 U.S.C.).

<sup>67</sup> See Council Directive 93/98, 1993 O.J. (L 290) 9 (EC). "Whereas there are consequently differences between the national laws governing the terms of protection of copyright and related rights . . . the laws of the Member States should be harmonized so as to make terms of protection identical throughout the Community . . . ." *Id.*

<sup>68</sup> *Id.* art. 7(1).

<sup>69</sup> See *Eldred v. Ashcroft*, 537 U.S. 186 (2003) (upholding the constitutionality of the CTEA); *Golan v. Ashcroft*, 310 F. Supp. 2d 1215 (D. Colo. 2004) (upholding the CTEA based on the reasoning in *Eldred*); *Kahle v. Ashcroft*, No. C-04-1127(MMC), 2004 U.S. Dist. LEXIS 24090 (N.D. Cal. Nov. 19, 2004) (same).

## IX. PROPOSED ORPHAN WORKS ACT OF 2008

In April 2008, the House and Senate contemplated two similar, but not identical bills proposing solutions to the orphan works issue.<sup>70</sup> These bills followed a 2006 proposal the Copyright Office had endorsed and was based on the Copyright Office Report on Orphan Works, which was published January 2006.<sup>71</sup> This proposal failed. The failure resulted from opposition by users and copyright owners, principally visual artists, due to the proposal's lack of detail on what exactly constituted a "reasonably diligent" search.<sup>72</sup> The 2008 bills, like the 2006 proposal, attempted to minimize the risks of exploitation of orphaned materials. The 2008 bill would accomplish this by limiting remedies against users in the event of infringement actions that might result from surfacing right holders.<sup>73</sup> The protection given to users would apply only if the users performed a reasonably diligent search for the right holder and, where possible, attributed the work to the holder.<sup>74</sup> The Senate bill passed but the House bill did not, and orphan works legislation stalled once again.<sup>75</sup> Perceived drawbacks to the bills included issues on the meaning of "reasonable compensation" and on what constituted a "reasonably diligent" search.<sup>76</sup> Both bills left the interpretation of "reasonably

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<sup>70</sup> See Orphan Works Act of 2008, H.R. 5889, 110th Cong. (2008); see also Shawn Bentley Orphan Works Act of 2008, S. 2913, 110th Cong. (2008).

<sup>71</sup> See generally U.S. COPYRIGHT OFFICE, REPORT ON ORPHAN WORKS (2006); see also Orphan Works Act of 2006, H.R. 5439, 109th Cong. (2006).

<sup>72</sup> See Statement of Marybeth Peters, *supra* note 13 (describing response of copyright community to 2006 bill); see generally JAMES LORIN SILVERBERG, AMERICAN PHOTOGRAPHIC ARTISTS, POST-ROUNDTABLE COMMENTS OF THE AMERICAN PHOTOGRAPHIC ARTISTS INC. (2013), available at [http://copyright.gov/orphan/comments/Docket2012\\_12/American-Photographic-Artists\(APA\).pdf](http://copyright.gov/orphan/comments/Docket2012_12/American-Photographic-Artists(APA).pdf).

<sup>73</sup> Ryan Andrews, Note, *Contracting Out of the Orphan Works Problem: How the Google Book Search Settlement Serves as a Private Solution to the Orphan Works Problem and Why it Should Matter to Policy Makers*, 19 S. CAL. INTERDISC. L.J. 97, 111 (2009).

<sup>74</sup> *Id.* at 111-12.

<sup>75</sup> *Id.* at 111.

<sup>76</sup> *Id.* at 113.

diligent search” to judicial determination, which opponents believed would have created a chilling effect on potential users.<sup>77</sup>

As they did in 2006, visual artists actively opposed the 2008 legislation on grounds that visual artists would be the most adversely affected by changes to the present Copyright Act.<sup>78</sup> Visual artists did not oppose orphan works legislation *per se*, but felt its language lacked clearly defined regulations that would lead to “case-by-case” definitions.<sup>79</sup> Photographers led the charge against change in the legislation because of the nature of photography, which photographers believe becomes orphaned almost at the moment of creation. Photographers and other visual artists felt they would have been the most negatively affected had the proposed 2008 bills been enacted.

## X. INTERNATIONAL MODELS

As previously mentioned, the orphan works issue is not just a phenomenon exclusive to U.S. copyright law. In fact, a recent survey conducted for the British Film Institute revealed that, as late as 2011, a majority of European countries did not have mechanisms allowing for the use of orphan works.<sup>80</sup> However, some European countries — notably France, Denmark, Hungary, the Czech Republic, and the Netherlands — have implemented solutions to deal either entirely or partially with the issue.<sup>81</sup> The majority of these countries limit the scope of the licenses allowing for use of orphan works.<sup>82</sup> Several other European countries —

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<sup>77</sup> Laura N. Bradrick, Note, *Copyright – Don’t Forget About the Orphans: A Look at a (Better) Legislative Solution to the Orphan Works Problem*, 34 W. NEW ENG. L. REV. 537, 559 (2012).

<sup>78</sup> *Id.*

<sup>79</sup> *Id.* at 560.

<sup>80</sup> KEA EUROPEAN AFFAIRS, AUDIOVISUAL ORPHAN WORKS IN EUROPE – NATIONAL SURVEY, REPORT PREPARED FOR THE BRITISH FILM INSTITUTE 9 (2011), available at <http://www.keanet.eu/docs/ORPHAN%20WORKS%20STUDY%20KEA.pdf>.

<sup>81</sup> *Id.*

<sup>82</sup> *Id.*

Germany, Greece, Romania, Slovakia, and the United Kingdom — have introduced processes to implement changes in their laws in order to resolve the orphan works issue.<sup>83</sup> Canada, Japan, and India have also created legislation to address this issue.<sup>84</sup> This paper will continue by briefly examining the most promising solutions from these jurisdictions in order to determine if those solutions, or some adaptation of them, could apply in the context of U.S. copyright law.

## A. DENMARK

The Scandinavian countries (Denmark, Finland, Iceland, Norway, and Sweden) have created a system of collective licensing schemes that are accommodated to handle orphan works issues.<sup>85</sup> Extended Collective Licensing (ECL) systems have existed in the Scandinavian countries since the 1960s,<sup>86</sup> but are typically only applied to selective categories of users.<sup>87</sup> Denmark, unlike the other Scandinavian countries, has a system that allows ECL for any type of use.<sup>88</sup> Under the Danish model, users and Collective Management Organizations (CMO), which represent a substantial number of right holders, can agree to exploit specific categories of work for specific uses.<sup>89</sup> The Ministry of Culture reviews and these agreements and, once approved, the agreement extends to all right holders in that specific category, even when those right holders are

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<sup>83</sup> *Id.*

<sup>84</sup> See generally MARCELLA FAVALE, FABIAN HOMBERG, MARTIN KRETSCHMER, DINUSHA MENDIS & DAVIDE SECCHI, COPYRIGHT, AND THE REGULATION OF ORPHAN WORKS: A COMPARATIVE REVIEW OF SEVEN JURISDICTIONS AND A RIGHTS CLEARANCE SIMULATION (2013), available at <http://www.ipso.gov.uk/ipresearch-orphan-201307.pdf>.

<sup>85</sup> See KEA EUROPEAN AFFAIRS, *supra* note 80, at 15.

<sup>86</sup> See FAVALE ET AL., *supra* note 84, at 20 (citing DANISH COPYRIGHT ACT, No. 158 of May 31, 1961 (Den.)).

<sup>87</sup> See *id.*

<sup>88</sup> See KEA EUROPEAN AFFAIRS, *supra* note 80, at 15.

<sup>89</sup> *Id.*



not members of the CMO.<sup>90</sup> The Danish ECL system also extends to foreign right holders.<sup>91</sup> In response to the amendments of the Copyright Act of 2008, the Danish scheme has been modified to allow for extended licensing agreements for any use, and therefore covers the exploitation of orphan works despite the fact that they are not explicitly mentioned in the law.<sup>92</sup> Some specific conditions, however, must be met to allow for the exploitation of orphaned works.<sup>93</sup> Those conditions include that “mass exploitation of the defined category of the work in the use occurs, that there is no possibility in practice to conclude individual agreements, that the organization [sic] concluding the agreement is representative of rights holder(s) and that the agreement is fair.”<sup>94</sup> This is an opt-out system.<sup>95</sup> The CMOs collect the royalties for their members, and if they remain unclaimed for a specified period of time, they are donated to public welfare programs.<sup>96</sup>

## B. FRANCE

In 2012, France issued a law on digital exploitation of unavailable books of the 20th century.<sup>97</sup> This law modified the French Intellectual Property Code by introducing the creation of an orphan works database to which any user can add an

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<sup>90</sup> See *id.* (citing DANIEL GERVAIS, STUDY ON APPLICATION OF AN EXTENDED COLLECTIVE LICENSING REGIME IN CANADA: PRINCIPLES AND ISSUES RELATED TO IMPLEMENTATION 47-51 (2003)).

<sup>91</sup> See FAVALE ET AL., *supra* note 84, at 20.

<sup>92</sup> See KEA EUROPEAN AFFAIRS, *supra* note 80, at 15.

<sup>93</sup> *Id.*

<sup>94</sup> *Id.* (internal citation omitted).

<sup>95</sup> *Id.*

<sup>96</sup> *Id.*

<sup>97</sup> See FAVALE ET AL., *supra* note 84, at 29 (citing Loi n° 2012-287 du 1er mars 2012 relative à l'exploitation numérique des livres indisponibles du XXE siècle, available at <http://www.legifrance.gouv.fr/affichTexte.do?cidTexte=JORFTEXT000025422700&fastPos=3&fastReqId=809414056&categorieLien=cid&oldAction=rechTexte> (last visited Feb. 1, 2015)).

unavailable work; creating a central collecting society charged with licensing orphan works, setting licensing prices, and collecting and keeping the revenues of unknown or un-located rights holders for ten years; allowing free use of orphan works by public libraries after ten years from the first use (libraries may only allow viewing of the works by their subscribers); and creating an opt-out provision for right holders.<sup>98</sup>

The Ministry of Culture and Communication approved La Société Française des Intérêts des Auteurs de l'écrit (French Society for the Interests of Print Authors - SOFIA) as the collecting society charged with managing this system in March of 2013.<sup>99</sup> SOFIA is in charge of researching the right holders of suspected orphaned works, and while the requirements of a diligent search are not specified by law, its definition is incorporated into that of orphan works.<sup>100</sup>

In France, there is also a secondary way of licensing the use of audiovisual and musical orphan works. The Institut National de l'Audiovisuel (National Audiovisual Institute – INA) has the capacity to negotiate contracts with French authors' collecting societies, like SACEM, SACD, SCAM, and ADAGP, and the trade unions of performers and directors.<sup>101</sup> The INA negotiates agreements with the collecting societies apply to all holdings, including orphan works, of the works managed by the collecting societies.<sup>102</sup> The INA also has the power to digitize and make available orphan works either for commercial or non-commercial

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<sup>98</sup> See *id.* at 29 n.152 (providing that “[u]navailable books include Orphan Works and out of print books” (internal citations omitted)). The database of unavailable works can be found at the following address: <http://relire.bnf.fr/>. *Id.* at 29 n.154.

<sup>99</sup> See *id.* at 29 n.155. SOFIA's website can be found at <http://www.la-sofia.org/sofia/Adherents/index.jsp?lang=fr>.

<sup>100</sup> FAVALE ET AL., *supra* note 84, at 29 n.157 (quoting FRENCH INTELLECTUAL PROPERTY CODE Art. L-113-10) (“The orphan work is a work protected and divulged, of which the owner of rights cannot be identified or found, despite diligent searches, recogni[z]ed and serious searches.”).

<sup>101</sup> See KEA EUROPEAN AFFAIRS, *supra* note 80, at 16.

<sup>102</sup> *Id.*

uses.<sup>103</sup> If the right holder were to reappear, the collecting society would pay him/her the remuneration paid by the INA.<sup>104</sup> In addition, users can request a court order from the Tribunal de Grande Instance, or through the Ministry of Culture, to receive clearance to exploit an orphan work.<sup>105</sup>

### C. GERMANY

Germany is one of the EU countries currently working out a legislative solution to the orphan works issue. In Germany, the Digital Libraries Working Group of the German Literature Conference (Deutsche Literaturkonferenz) heads a project on digital use of orphan works that brings together authors' representatives, publishers, libraries and collecting societies.<sup>106</sup> This project is a print-based model that has been implemented as an interim solution, but it can be used to extend to other media as well.<sup>107</sup> Key aspects of the project include "diligent search" requirements that must be met prior to digitization of the work and payment of fees into an escrow account managed by the collecting society (VG Wort, Verwertungsgesellschaft Wort).<sup>108</sup> The escrow account is set up to indemnify the German Literature Conference in the event of the right holder surfacing because the collecting society does not have the legal right to license the work.<sup>109</sup>

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<sup>103</sup> *Id.*

<sup>104</sup> *Id.*

<sup>105</sup> *Id.* at 17.

<sup>106</sup> Elisabeth Niggemann, How to Deal with Orphan Works in the Digital World?, EUR. PARL. DOC 7 (2009), available at <http://www.europarl.europa.eu/document/activities/cont/200911/20091113ATT64507/20091113ATT64507EN.pdf>.

<sup>107</sup> *Id.*

<sup>108</sup> FAVALE ET AL., *supra* note 84, at 31.

<sup>109</sup> *Id.*

The German legislative solution is based on implementation of the EU's Directive 2012/28/EU,<sup>110</sup> which would modify the definition of orphan work under current German copyright law.<sup>111</sup> The current proposal demands a "costly and diligent" search, which would require exploiters to "search in the European Union country where the work was first published, consult information sources in other member states, and forward any document to Germany's Patent and Trademark Office."<sup>112</sup>

#### D. UNITED KINGDOM

For some time, the U.K. Parliament has been considering the adoption of a two-tier orphan works system that would allow for commercial and non-commercial use with different processes for digitization and other uses of orphan works.<sup>113</sup> In April 2013, Parliament passed such a two-tier system as part of the Enterprise and Regulatory Reform Act.<sup>114</sup> The two tiers are modeled after the regimes used in the Scandinavian countries and those in Canada, Japan, and Hungary.<sup>115</sup> The first tier is reserved for cultural institutions, like libraries and archives, which are permitted to

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<sup>110</sup> See Directive 2012/28, of the European Parliament and of the Council of 25 October 2012 on Certain Permitted Uses of Orphan Works, 2012 O.J. (L 299) 5, available at <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2012:299:0005:0012:EN:PDF>.

<sup>111</sup> Jabeen Bhatti, *German Parliament Rejects Left Party Amendments to Orphan Works Bill*, WORLD INTELL. PROP. REP., Aug. 1, 2013, at 8, available at BloombergLaw.

<sup>112</sup> *Id.*

<sup>113</sup> David R. Hansen, Gwen Hinze, & Jennifer Urban, *Orphan Works and the Search for Rightsholders: Who Participates in a "Diligent Search" Under Present and Proposed Regimes?* 19 (Berkeley Digital Library Copyright Project, White Paper No. 4, 2013), available at [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=2208163](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2208163).

<sup>114</sup> See Enterprise and Regulatory Reform Act, 2013, c. 24, § 77(3) (U.K.) (amending The Copyright, Designs and Patents Act of 1988), available at [http://www.legislation.gov.uk/ukpga/2013/24/pdfs/ukpga\\_20130024\\_en.pdf](http://www.legislation.gov.uk/ukpga/2013/24/pdfs/ukpga_20130024_en.pdf).

<sup>115</sup> See Hansen, Hinze & Urban, *supra* note 113, at 19 (internal citations omitted).

digitize orphans by means of an ECL system.<sup>116</sup> The second tier is for non-exclusive license grants to exploiters made through a central licensing agency that has not been created yet.<sup>117</sup> The whole system is based on recommendations made by Professor Ian Hargreaves in a report to the U.K. government.<sup>118</sup>

The “diligent search” requirement is present in both tiers and subject to review and regulation by a new government body created for this purpose.<sup>119</sup> Licenses for exploitation will not be issued without this “diligent search,” the definition of which will be covered in regulations and guidance published by the Intellectual Property Office.<sup>120</sup>

## E. CANADA

The Copyright Board of Canada (the Board) is the regulatory body:

empowered to establish, either mandatorily or at the request of an interested party, the royalties to be paid for the use of copyright works, when the administration of such copyright is entrusted to a copyright collective society . . . and has the power to issue licenses for the use of works when the copyright owner cannot be located.<sup>121</sup>

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<sup>116</sup> *Id.*

<sup>117</sup> *Id.*

<sup>118</sup> See generally IAN HARGREAVES, DIGITAL OPPORTUNITY: A REVIEW OF INTELLECTUAL PROPERTY AND GROWTH, AN INDEPENDENT REPORT (2011), available at <http://www.ipo.gov.uk/ipreview-finalreport.pdf>.

<sup>119</sup> Hansen, Hinze & Urban, *supra* note 113, at 19.

<sup>120</sup> See INTELLECTUAL PROP. OFFICE, FACTSHEET – ORPHAN WORKS LICENSING SCHEME AND EXTENDED COLLECTIVE LICENSING (2014), available at <http://www.ipo.gov.uk/orphanworks-licensing.pdf>.

<sup>121</sup> *Unlocatable Copyright Owners*, COPYRIGHT BOARD OF CAN. (Sept. 7, 2011), <http://www.cb-cda.gc.ca/unlocatable-introuvables/brochure2-e.html>.

Licenses to use orphan works are granted by the Board only after the exploiter has made every “reasonable effort” to find the right holder.<sup>122</sup> The “reasonable efforts” standard required by the Board originated in section 77(1) of the Copyright Act of Canada and states the Board must be satisfied that the applicant has made every effort to locate the right holder.<sup>123</sup> However, the Act does not specify what constitutes a “reasonable effort,” thereby giving the Board latitude to interpret the issue.<sup>124</sup> Consequently, the Board has created a set of informal standards to determine if applicants have met the requirement, which includes the adequacy of the search on a case-by-case basis; the nature of the applicant (i.e., is the applicant an individual, a commercial entity, or a not-for-profit organization); the proposed use of the work (is it for a commercial or non-commercial use); whether the search was reasonable in the circumstances; and the nature of the work and information about its owner (e.g., a book may have information on the initial right holder, if he was the author, while a photograph may not carry that information).<sup>125</sup> The Board’s website also states that a potential exploiter can satisfy the “reasonable search” requirement by checking with copyright collective societies; using Internet searches; contacting publishers, libraries, universities, museums, and other depositories; and extending the search beyond Canadian borders.<sup>126</sup>

If the Board feels that the potential exploiter has completed a “reasonable effort” search, it may issue a license for the use of the orphan work.<sup>127</sup> The Board is not obliged to accept and may reject

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<sup>122</sup> *Id.*

<sup>123</sup> FAVALE ET AL., *supra* note 84, at 34 (citing Copyright Act, R.S.C. 1985, c. C-42, § 77(1) (Can.), available at <http://laws-lois.justice.gc.ca/eng/acts/C-42/page-71.html#h-79>).

<sup>124</sup> *Id.*

<sup>125</sup> *Id.* (citing Jeremy De Beer & Mario Bouchard, *Canada’s “Orphan Works” Regime: Unlocatable Owners and the Copyright Board*, 10(2) OXFORD U. COMMW. L.J. 215 (2010), available at <http://www.cb-cda.gc.ca/about-apropos/2010-11-19-newstudy.pdf>).

<sup>126</sup> De Beer & Bouchard, *supra* note 125.

<sup>127</sup> FAVALE ET AL., *supra* note 84, at 35.

an application even if a reasonable effort search has been conducted.<sup>128</sup> Between 1990 and 2012, the Board issued 260 licenses while rejecting eight applicants.<sup>129</sup> The approval process takes, on average, between thirty to forty-five days.<sup>130</sup>

## F. JAPAN

Japanese law has had orphan works provisions since the enactment of Article 67 of the Copyright Act of 1970 (the “1970 Act”).<sup>131</sup> In Japan, licensing of orphan works is managed under a compulsory licensing system by the Agency for Cultural Affairs (ACA) under Article 67 of the 1970 Act.<sup>132</sup> The ACA, a special body of the Japanese Ministry of Education, has the power to grant compulsory licenses of orphan works for all Japanese works, as well as the works of foreign authors, as long as the work is to be exploited in Japan.<sup>133</sup> Exploitation of orphan works is predicated on the exploiter’s successful application to the ACA, his conducting of an unsuccessful diligent search for the right holder, and the paying of licenses for compensation to the right holders if they are located after exploitation has begun.<sup>134</sup>

Under the Japanese system, a completed diligent search must include the following steps:

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<sup>128</sup> *Id.*

<sup>129</sup> *Id.*

<sup>130</sup> *Id.*

<sup>131</sup> Chosakuken Hō [Japanese Copyright Act], Law No. 48 of 1970, art. 67 (Japan), *translated by* Chosakuken Kankei Hōrei Dēta Bēsu [Copyright-related Law Database] (Copyright Research and Information Center (CRIC)), *available at* <http://www.cric.or.jp/english/clj/cl2.html>.

<sup>132</sup> Comment on Orphan Works from Nathan Peters to U.S. Copyright Office, *available at* <http://copyright.gov/orphan/comments/OW0670-Peters.pdf>.

<sup>133</sup> FAVALE ET AL., *supra* note 84, at 42.

<sup>134</sup> *Id.*

1. Search databases which contain names and addresses of the right holder, including web searches;
2. Make inquiries through collecting societies;
3. Make inquiries by contacting those conducting businesses with similar kinds of copyrighted works which the applicant would like to use;
4. Request information from the general public for information about the right holder. This can take one of two forms: (a) newspaper advertisement or (2) advertising on the Copyright Research and Information Centre (CRIC) website.<sup>135</sup>

Once a diligent search has been completed, ACA can grant the exploiter authority to use the material.<sup>136</sup> If the application is granted, copies of the exploited work must be marked as made under a compulsory license grant and must state the date of issue of that grant.<sup>137</sup> In 2009, amendments to Japanese copyright law made possible the creation of a national electronic archive, administered by the National Diet Library, providing for digitization of “orphan works subject to the relevant laws.”<sup>138</sup> These recent amendments also provide for the ability to exploit a work while the application for a compulsory license is underway.<sup>139</sup> Under Article 67*bis*, which embodies the 2009 amendments, the applicant may pay the deposit money up front, before the result of the application is known, and begin exploitation of the work

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<sup>135</sup> *Id.*

<sup>136</sup> *Id.* at 44.

<sup>137</sup> *Id.*

<sup>138</sup> *Id.* at 44-45 (citing *Purpose of Establishment and History*, NAT'L DIET LIBR., <http://ndl.go.jp/en/aboutus/outline/purpose.html> (last visited Feb. 1, 2015)).

<sup>139</sup> *Id.* at 42.



immediately.<sup>140</sup> If the work is exploited during the application time, the ACA will retain the money deposit; however it will issue a refund if the application is ultimately denied and the work was unexploited.<sup>141</sup>

## XI. PROPOSED MODELS

Since the failure of the both proposed Orphan Works Act of 2008,<sup>142</sup> legal scholars, stakeholders, and other interested parties have continued to search for a working solution to the issue. These proposed solutions have included using models from water law,<sup>143</sup> the application of the adverse possession doctrine,<sup>144</sup> secondary liability rules,<sup>145</sup> the application of the fair use doctrine,<sup>146</sup> and the

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<sup>140</sup> *Id.* at 42-43.

<sup>141</sup> *Id.* at 43.

<sup>142</sup> Orphan Works Act of 2008, H.R. 5889, 110th Cong. (2008); Shawn Bentley Orphan Works Act of 2008, S. 2913, 110th Cong. (2d Sess. 2008), available at <https://www.govtrack.us/congress/bills/110/s2913/text>.

<sup>143</sup> See Joel Sage, *Revenue Streams and Safe Harbors: How Water Law Suggests a Solution to Copyright's Orphan Works Problem*, 16 B.U. J. SCI. & TECH. L. 294, 295 (2010).

<sup>144</sup> See Megan L. Bibb, Note, *Applying Old Theories to New Problems: How Adverse Possession Can Help Solve the Orphan Works Crisis*, 12 VAND. J. ENT. & TECH. L. 149, 168-77 (2009).

<sup>145</sup> See generally Paul J. Heald, *How Copyright Makes Books and Music Disappear (and How Secondary Liability Rules Help Resurrect Old Songs)* (Ill. Program in Law, Behavior and Soc. Sci., Paper No. LBSS14-07, July 5, 2013), available at <http://www.cardozo.yu.edu/sites/default/files/Paul%20Heald,%20HOW%20COPYRIGHT%20MAKES%20BOOKS%20AND%20MUSIC%20DISAPPEAR.pdf> (studying the availability of books and songs on Amazon.com and YouTube, respectively, and arguing that copyright law stifles distribution and market availability).

<sup>146</sup> See generally David R. Hansen et al., *Solving the Orphan Works Problem for the United States*, 37 COLUM. J.L. & ARTS 1 (2013).

use of ECLs,<sup>147</sup> among many examples. Each of these models offers solutions with their own merits.

The water law model is based on the idea of water as a form of property that, like intellectual property, does not fit easily into the normal paradigms of real property.<sup>148</sup> This analogy extends to cover the idea that present copyright law deals with the rights of the copyright holder in the same way that unlimited exploitation rights are covered under the riparian doctrine.<sup>149</sup> However, the model proposes that application of prior appropriation concepts, as used where water is a scarce resource, would better accommodate the reality of copyright.<sup>150</sup> Under this model, the right holder would maintain the monopoly so long as he was making beneficial use of the work.<sup>151</sup> Once the creator abandons the work, it becomes available for other exploiters to use.<sup>152</sup> The creator may reassert his right in the work and be compensated using a policy-based scheme to recoup some of the revenue value of the work.<sup>153</sup>

Other proposed solutions only address limited areas within the orphan works issue. Among these limited solutions is a proposal to use limited liability rules to revitalize and monetize the use of old songs.<sup>154</sup> Under this proposal, file sharing services<sup>155</sup> could inform the right holder, on notification of infringing works in the

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<sup>147</sup> See Ariel Katz, *The Orphans, the Market, and the Copyright Dogma: A Modest Solution for a Grand Problem*, 27 BERKELEY TECH. L.J. 1285, 1331-37 (2012).

<sup>148</sup> Sage, *supra* note 143, at 306.

<sup>149</sup> *Id.* at 309.

<sup>150</sup> *Id.* at 312.

<sup>151</sup> *Id.* at 313-14.

<sup>152</sup> *Id.*

<sup>153</sup> *Id.* at 314.

<sup>154</sup> See generally Heald, *supra* note 145.

<sup>155</sup> See *id.* (describing how videos shared through YouTube can be used to monetize old musical performances, and how the idea of monetizing old performances can be analogized to almost any file sharing service).

services, of potential monetization opportunities by way of advertisements, allowing the right holder to profit on subsequent views of the material.<sup>156</sup> Using this model, the sharing services become low cost intermediaries between those who own copies of the phonorecord, those who want to hear that music, and the owners of rights on that music.<sup>157</sup>

The adverse possession model is a limited model because it is based only on narrowing the uses of orphan works and limiting the pool of potential users to nonprofit libraries and archives.<sup>158</sup> This model works on a modification of the adverse possession doctrine to serve as the basis for finding a solution to the orphan work issue by implementing a requirement that is satisfied by a good faith effort to find the original right holders.<sup>159</sup> Under this system, databases already created by libraries and archives would be expanded to cover media not presently collected.<sup>160</sup>

In the author's opinion, a complete solution to the orphan work issue should not be limited in its scope. The solution should apply to all manner of potential exploiters equally or, at least, put all potential exploiters on an equal footing. To be successful, the solution should avoid the pitfalls of the 2006 and 2008 proposals by addressing the issues deemed important to all stakeholders. As stated before, principal opposition to the previous proposals came from visual artists who felt those proposals left key issues of protection for their works unanswered or undefined.<sup>161</sup> More specifically, various stakeholders, including visual artists, felt that the previously proposed legislation lacked clear definitions on two key issues, "reasonable compensation" and a "reasonably diligent" search.<sup>162</sup> It is possible that the product of the previous legislative efforts in 2006 and 2008 can be revised to clarify those

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<sup>156</sup> Heald, *supra* note 145, at 23.

<sup>157</sup> *See id.* at 24.

<sup>158</sup> Bibb, *supra* note 144, at 176.

<sup>159</sup> *Id.* at 178-79.

<sup>160</sup> *Id.* at 179.

<sup>161</sup> *See* Bradrick, *supra* note 77.

<sup>162</sup> *See* Andrews, *supra* note 73, at 113.

definitions. This, in addition to combining the previous proposals with existing foreign models that have already been implemented, could effectively address the issue of orphan works and the opposition expressed by some stakeholders.

Canada,<sup>163</sup> Germany,<sup>164</sup> and Japan<sup>165</sup> have enacted orphan works regimes that are based on the idea of grants by government-sanctioned agencies for the non-exclusive licenses for the exploitation of orphan works. While the Canadian and German models lack an explicit definition of “reasonably diligent” search, the Japanese model provides a list of steps that must be carried out to effectively complete such a search.<sup>166</sup> The steps outlined in the Japanese model can easily be adapted for inclusion in U.S. legislation, thereby avoiding the fear expressed by stakeholders that the definition of “diligent search” would be left to judicial interpretation.<sup>167</sup>

The issue of “reasonable compensation” can also be addressed by looking for options in the existing foreign models. The U.K. model presents a two-tier system of licensing into which cultural and educational institutions and commercial users are separated.<sup>168</sup> A set schedule of fees can be worked out, according to the tier of the exploiter, and those fees can be deposited in an escrow account as done in the German model and disbursed to the right holder should that individual ever surface.<sup>169</sup> Management of the fees and escrow accounts can be carried out by CMOs representing right holders, as is done in the Scandinavian model.<sup>170</sup> A two-tier system of licensing that sets up fees according

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<sup>163</sup> See generally FAVALE ET AL., *supra* note 84, at 34-35 (internal citations omitted).

<sup>164</sup> See *id.* at 31.

<sup>165</sup> See *id.* at 42-43.

<sup>166</sup> *Id.* at 44 (internal citations omitted).

<sup>167</sup> See Statement of Marybeth Peters, *supra* note 13 (describing response of copyright community to 2006 Bill).

<sup>168</sup> Hansen, Hinze & Urban, *supra* note 113, at 19.

<sup>169</sup> See FAVALE ET AL., *supra* note 84, at 31.

<sup>170</sup> KEA EUROPEAN AFFAIRS, *supra* note 80, at 15.

to type of use would alleviate the concerns that cultural institutions would be unable to participate because of the expenses involved.<sup>171</sup>

In the U.S. there is an entity that could manage an orphan works exploitation program. The Copyright Clearance Center (CCC) is a not-for-profit, global rights broker responsible for managing licensing rights to all manner of copyrighted materials.<sup>172</sup> The CCC deals with right holders, businesses, and academic institutions to facilitate licensing and permissions of copyright-protected materials.<sup>173</sup> It has a global network, enhanced by its acquisition of RightsDirect in 2010 and Pubget in 2012, which is custom designed to address orphan works issues.<sup>174</sup> RightsDirect is a Europe-based subsidiary of the CCC that focuses on providing copyright compliance solutions for publishers, collecting societies, and right holders not only in the European market, but also globally.<sup>175</sup> Pubget is a solutions provider focusing on simplifying the process of content discovery, access, and copyright management in the field of science publication.<sup>176</sup>

A two-tier system based on pre-paid fees and managed by the CCC would provide users with the certainty and predictability required to safely exploit orphan works and would also provide surfacing right holders with compensation for their work. This system would have to encompass the creation of an orphan works database that would be added to as potential exploiters request licenses to use works. Exploiters would have to meet a list of requirements, adapted from the Japanese example to complete a “diligent search”<sup>177</sup> and submit their efforts to the CCC. The CCC

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<sup>171</sup> See Hansen et al., *supra* note 146, at 44-49.

<sup>172</sup> See *About Us*, COPYRIGHT CLEARANCE CENTER, <http://www.copyright.com/content/cc3/en/toolbar/aboutUs.html> (last visited Feb. 1, 2015).

<sup>173</sup> See *id.*

<sup>174</sup> *Id.*

<sup>175</sup> See *generally* RIGHTS DIRECT, [http://www.rightsdirect.com/content/rd/en/toolbar/about\\_us.html](http://www.rightsdirect.com/content/rd/en/toolbar/about_us.html) (last visited Feb. 1, 2015).

<sup>176</sup> See *generally* PUBGET, <http://pubget.com/about> (last visited Feb. 1, 2015).

<sup>177</sup> See FAVALE ET AL., *supra* note 84, at 43-44 (internal citations omitted).

could act as the certifying agency validating the efforts of the exploiters to find the right holders and insulating the exploiters, through the CCC's certification, from potential litigation of surfacing right holders. The CCC would also manage a schedule of fees, either dictated by Congress or based on a reasonable evaluation and comparison to fees collected by the CCC for licensing non-orphan works. The collected fees would be maintained in an escrow account, as in the models that collect fees *ex ante*, and disbursed according to a pre-published schedule of payments to surfacing right owners.<sup>178</sup> Once the CCC has certified that an exploiter has completed a "reasonable search" and has paid the required "reasonable fees", the exploiter would receive a limited, non-exclusive license to use the certified orphan work. A surfacing right holder would have to prove his right to the work, *prima facie* evidence of which would be registration with the Copyright Office. In this case, registration would not be a prerequisite to the enjoyment of a copyright but simply evidence of the holding of copyright, much like the present requirement of registration to qualify for statutory damages in a successful litigation.<sup>179</sup>

The CCC would also be charged with maintaining a current database of orphan works that could be populated as requests for exploitation and certification of those requests are completed. In addition, as right holders surface to claim their formerly orphan works, the CCC can update the database removing previously identified works. Part of this database already exists as part of the digitization efforts undertaken by the European Commission and by several American university libraries.<sup>180</sup> Collating of the existing efforts would create the seed of a master database that would encompass a large portion of already identified orphan works.

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<sup>178</sup> See *supra* notes 80-140 and accompanying text, for further discussions of escrow fee collection models.

<sup>179</sup> See 17 U.S.C. § 412 (2012).

<sup>180</sup> See *supra* notes 8-19 and accompanying text, for further discussions on the effects of orphan works on digitization.

## XII. CONCLUSION

The effects of the orphan works issue will only grow as time goes on. In the U.S., there have been two unsuccessful attempts at solving the issue because of valid concerns expressed by various stakeholders. If we look to the international community, we find functioning solutions appropriate to our own statutory regime. By learning from these examples and adapting from the best, simplest, and most direct elements of those solutions we have the capacity to enact a working legislative answer to this critical issue that would answer the concerns all potential users and lay to rest one of the most vexing issues in Intellectual Property law today.