

Reproduced with permission from BNA's Patent, Trademark & Copyright Journal, 83 PTCJ 954, 04/27/2012. Copyright © 2012 by The Bureau of National Affairs, Inc. (800-372-1033) <http://www.bna.com>

Conferences/Copyrights

Law School Symposium Seeks Path for Digitization of Orphan Works

BERKELEY, Calif.—Legal scholars, librarians, archivists, content providers, and copyright lawyers convened April 12 and 13 for a conference sponsored by the University of California at Berkeley's Center for Law and Technology and Berkeley Technology Law Journal to address an issue that has vexed copyright stakeholders for over a decade and still seems without resolution.

The symposium, titled "Orphan Works and Mass Digitization: Obstacles and Opportunities," explored private, legislative, judicial, administrative, and technological mechanisms for removing the barriers that have long inhibited the collection and use of works whose copyright owners cannot be found.

On-Going Struggle. An October 2011 Copyright Office report suggested that the time is right for policy makers to take up the questions prompted by the mass digitization of copyrighted works, including orphan works (83 PTCJ 10, 11/4/11). The report was the most recent milestone in the long effort to facilitate the digital preservation and cataloging of such works.

Orphan works legislation made some headway in Congress in the late 2000s. However, its progress was blocked in part by the 2008 proposed settlement of a 2005 class action copyright infringement lawsuit brought by the Authors Guild and five trade publishers challenging Google's scanning of books from the collections of major research libraries for purposes of indexing their contents and serving snippets in response to user search queries (76 PTCJ 920, 10/31/08). Under the settlement, Google could commercialize orphan books and out-of-print books if it provided 63 percent of the revenues to a Books Rights Registry tasked with tracking down and compensating orphan works authors for Google's use of their books.

Meanwhile, proposed orphan works directives are under consideration in the United Kingdom and the European Commission, as educational institutions, libraries, archives, museums, and others seek to ensure their rights to access, compile, and use such works (82 PTCJ 739, 9/30/11; 83 PTCJ 305, 1/6/12).

Finding and Saving Orphan Websites and Films. Brewster Kahle, founder and digital librarian of the Internet Archives, has been battling the impediments to orphan works since he launched that project 15 years ago. Thanks to the digital age, universal access to the

world's creative works "is within our grasp," Kahle noted, "and yet we are stumbling."

"We have 29 scanning centers in six countries," Kahle said, adding that the Internet Archive is best known for its website collections. "We need to be more proactive" in the preservation process because websites are constantly being taken down, he said. "There is a demand for this old stuff," Kahle said, showing slides of floppy disks, the *pets.com* website, and even ads for slide projectors, whose authorship he has been unable to trace.

Given the general recognition of the need to uncover and protect such works, "I thought that access to orphan works would be a slam dunk with the courts and Congress," but orphan works legislation has stalled, he said. However, he cautioned that lawmakers should "slow down" and let things evolve in the courts. "When Congress proactively changes copyright laws, things go wrong," Kahle said, pointing to the "collateral damage" that he said has resulted from the Digital Millennium Copyright Act.

Kenneth Crews, director of the Copyright Advisory Office at Columbia University, wondered whether a legislative solution is even possible, given the complexity of defining what qualifies as an orphan work, and the role that other legal principles play in defining rights to orphan works. He pointed to the fair use provisions at Sections 107 and 108 of the Copyright Act, and the impact of other factors such as a work falling into the public domain after expiration of the copyright term.

However, finding the authors of orphan works and clearing rights to them will remain a struggle for archivists, Crews said. A digital collection of the annual reports of corporations, for example, could be "a treasure trove for historians and economists," but whether those works are available for such use remains ambiguous.

Film preservation also faces some obstacles when orphan works are involved, according to Eric J. Schwartz of Mitchell Silberberg & Knupp, Washington, D.C. Schwartz, who is founding director and board member of the National Film Preservation Foundation, recounted how the foundation had recently uncovered, identified, and restored parts of a lost 1924 Alfred Hitchcock film, *The White Shadow*, in the collections of the New Zealand Film Archive. Digitization and reproduction of such old film classics is too costly, Schwartz said, but they should be freely accessible through libraries and archives.

Tracing and Saving History. Preserving the historical record generated by the organizations and individuals active in the 1950s and 60s civil rights movement poses recurring challenges, Bruce Hartford said. Hartford, who maintains the Civil Rights Movement Veterans

website, said that some of the material being archived is used with the authors' permission or is in the public domain, but many of the articles, photos, papers, and letters are orphan works.

He pointed to a 1964 article in *Freedom Ways* magazine by Benjamin Van Clark, noting that tracking down copyright ownership of that piece was impossible because (1) the magazine no longer exists, and (2) Van Clark, even in the unlikely possibility that he insisted on retaining a copyright, cannot be found. Another dilemma for the website was a photo of Student Nonviolent Coordinating Committee activist James Forman, that was taken by a fellow prisoner when Forman was in jail. "Some of us are a little annoyed by a stupid rule that the person who pushed the button owns the rights" in the photo, Hartford said.

The cost of clearing rights to such works is a particular burden for archives like his that have "shallow pockets," Hartford said, adding that "the corporate intellectual property vaults should not be allowed to lock up culture." The risk, he said, is "only those with money will have a voice in the marketplace of ideas."

Rick Prelinger, whose Prelinger Archives has collected "ephemeral" advertising, educational, industrial, and amateur films since 1983, said that he has never received a "legitimate copyright claim" to the over 60,000 works amassed by his archives. The archives make some of the footage—particularly home movies—available to film producers who make use of them in feature films and documentaries, Prelinger said.

Despite these challenges under the current system, Prelinger said that he worries about amending copyright law to "fix what's not broken."

Finding and Tagging Photos. Victor S. Perlman, general counsel for the American Society of Media Photographers, said that he "despises" the term orphan works because it implies the Dickensian notion of works that are abandoned and unwanted. The photos he deals with "want to be found and published," Perlman said, but their authors want to be compensated and credited for use of those images.

Perlman acknowledged that, compared with tracking down the authors of text, even a diligent search may not turn up the rights holders of old photographic works. More recent images created and stored in digital form also present a burden to those wishing to secure or clear rights, he said, because of their sheer volume and because most images are not digitally searchable.

One solution, Perlman suggested, is to embed the photo with a digital thumbprint identifying the photographer and other information, but this could present additional costs to a group of rights holders "who are self-employed and have no 401(k)s."

As for finding legal solutions to the orphan works problem, Perlman suggested that private initiatives may be a wiser path than legislative remedies. "Do we really want this controlled by the folks who gave you the internal revenue code?" he asked.

Publishers: New Laws Are Needed. For Allan Adler of the Association for American Publishers, however, orphan works legislation "is still necessary."

Noting that the AAP has long been involved, "as users and proprietors," in the quest for a legislative remedy, Adler said that legislation is even more critical in the wake of (1) the failure of the Google Books settlement, and (2) a copyright infringement law suit filed in

September by the Authors Guild against the HathiTrust, a project of several major libraries aimed at making scanned works available online (82 PTCJ 642, 9/16/11).

Defining 'Diligent Search' for Orphans. Jeremy Williams, deputy general counsel for Warner Bros. Entertainment Inc., said that his initial reaction to the orphan works legislation was that it was "a really cool thing" because it would make it easier for clearance lawyers like him to secure rights to the photos, artwork, graphics, news film, music, maps, magazines, and even tattoos that play an incidental role in movies and TV shows.

But Williams was concerned that it may be difficult for lawmakers to define what constitutes a "diligent search" for the author of an orphan works, and to define what remedies are appropriate when such a work is used without authorization.

June Besek, a law lecturer at Columbia University, said that concerns about defining a diligent search and establishing a "use it or lose it" burden on authors to publish their works and make them available "are real." She outlined various options for listing and managing orphan works, including registries, compulsory licensing, and opt-out regimes.

Possible Solutions. Other U.S. and international legal scholars weighed in on what is the best approach for addressing the orphan works problem:

- James Grimmelman, a law professor at New York Law School, said that after the failed Google Books settlement, there is "no better alternative" than legislation.

- Randall Picker, a law professor at the University of Chicago, said that whatever regime is created "should support the entire ecosystem of private and public libraries." In Picker's view, private ventures can produce "dramatic public benefits."

- Ariel Katz, a law professor at the University of Toronto, noted that the Copyright Board of Canada grants permission to use orphan works upon payment to a collective—a solution that, in her view, "merely shifts the problem from the user to the collective."

- Stef Van Gompel, a law professor at the University of Amsterdam, said that the orphan works directive under consideration by the European Commission is not the best solution, but that there is "no one-size-fits-all" way of clearing orphan works rights for mass digitization.

- Jennifer Urban, director of UC Berkeley's Samuelson Law, Technology, and Public Policy Clinic, suggested that the Copyright Act's "straightforward but flexible" fair use provisions have served well over time for librarians and mass digitization projects. Other considerations are also important, she said, such as an archive's good faith record-keeping, limiting its offerings to those works in its collections and to its patrons, and its incorporation "opt-out" and "take-down" provisions when the authors of orphan works request them.

- Lydia Loren, a law professor at Lewis & Clark University, Portland, Ore., took issue with the term orphan works, favoring instead "hostage works." Loren said that she prefers an open access approach to orphan works, eliminating monetary liability for use of such works by libraries and other not-for-profit entities.

Copyright Register: 'Committed' to Orphan Works Bill in Next Congressional Session

BERKELEY, Calif.—Register of Copyrights Maria Pallante said April 12 during a keynote luncheon address at the University of California at Berkeley Law School's "Orphan Works and Mass Digitization" conference that she is "committed to orphan works legislation in the next congressional session," beginning in 2013.

"Differences of opinion will need to be reconciled," Pallante acknowledged, "but we have remarkable agreement on key points," including the following:

- True orphan works do not further the objectives of the copyright system.

- Finding copyright owners for a particular work is not always possible.

- Neither locking up orphan works nor rip-offs of other copyrighted works are good for copyright owners and users because they do not further respect for the law.

Pallante noted that Congress was "close to a consensus on orphan works legislation for several years," but that the unresolved question was the degree to which orphan works copyright owners should have to assert their whereabouts. In Pallante's view, however, "legislation is important because Congress is responsible for updating the law." Legislation takes time, Pallante acknowledged, adding that lawmakers and stakeholders have to "calm down and get comfortable with big ideas."

Provisions for orphan works copyright holders to opt-out of mass digitization projects may be sensible in some cases, Pallante said. She noted that "global discussions" about the orphan works controversy are ongoing in Europe and even South America.

"The Copyright Office itself must be part of the solution," Pallante said, noting that the agency will have "specific recommendations" when Congress reconvenes in January. However, the key to resolving the stalemate, she warned, is an end to "rhetorical excesses."

The Role of Registries. Several panelists considered how registries of orphan works might facilitate searches for and use of those works.

- Molly Van Houweling, a law professor at Berkeley, noted that the European Union directive contemplates a "publicly available database" of such works. However, text-based registries are useless for searching photos and dynamic works such as websites, she noted. One decentralized way of tracing these works, she suggested, might be an electronic "dog tag-type" of metadata embedded in the work.

- Jule L. Sigall of Microsoft Corp., said that registries of orphan works would be "better developed by the private sector." There should be an "all are welcome" policy, Sigall said, allowing anyone—even users of orphan works—to establish such registries.

- Bruce Nash, whose Nash Information Services provides "consulting, data, and analytical services on the

movie industry to independent film producers, investment companies, technology companies, retailers, web sites and entertainment companies," described how algorithms might be used to find likely rights holders of orphan works.

- Hal Varian, chief economist for Google Inc., suggested that, rather than a simple registry, a clearing house that both registers and licenses orphan works is a better model from an economic standpoint. A registry allows the user to identify the owner but does not necessarily allow the user to license the work, he said. Requiring the user to assert bargaining rights separately after registering would be too costly and might discouraged the user from engaging in the transaction altogether, Varian said.

- Licensing is the focus of the 30-year-old Copyright Clearance Center, the not-for-profit organization's general counsel, Fredric Haber said. The CCC is a voluntary collective, however, Haber said, so it licenses works only if there are signed agreements with the author.

Mass Digitization and Data Mining. Several panelists assessed to what extent orphan works and other digitized copyrighted works should be made available for "non-consumptive" uses through data mining. Matt Sag, a law professor at Loyola University, Chicago, said that such works should be "grist for the mill" in data mining and analysis. In Sag's view, there is no copyright problem with such non-consumptive uses because they rely on metadata and are not uses of the copyrighted expression.

One miner of such digital data is Matthew Jockers, a literary historian at Stanford University, Stanford, Calif. Jockers told how he used data mining tools to analyze the frequency of words, punctuation marks, and length of sentences, to trace how literature has changed over time depending on the gender of the author and other factors. Jockers said that he tells his graduate students that there are "hundreds of dissertations and centuries of literary research" hidden in the metadata of digitized works.

Mining Scientific Journals. Jerome Reichman, a law professor at Duke University, Durham, N.C., said that scientists need unrestricted access to databases of scientific journals and that copyright laws stand as an obstacle to such research. Fair use covers some use of journals, Reichman said, but it cannot handle data mining.

The law should be clarified to stipulate that there will be no statutory damages or injunctions available to the publishers who hold the copyrights in scientific journals when scientists inadvertently use those works, in Reichman's view. Moreover, he said, private publishers no longer add enough value to scientific journals to qualify for copyright protection, especially since much of reported research is publicly funded.

As long as the subscription model is preserved for scientific journals, Reichman said, those journals should allow full and open access for research and data mining, just as law journals do. Reichman said that he questions the current "wholesale reliance on existing information brokers" in scientific publishing.

John Unsworth, vice provost for Library and Technology Services at Brandeis University, Waltham, Mass., expressed concern that—in a "copyright creep" era where rights to Disney's 1928 "Steamboat Willy" car-

toons have already been extended until 2023, limiting use of copyrighted works to data mining is like saying “you can read, but not understand” the works.

BY CAROL OBERDORFER