

May 21, 2014

The Honorable Maria A. Pallante
Register of Copyrights
U.S. Copyright Office
101 Independence Avenue, SE
Washington, DC 20559-6000

Re: Docket No. 2012-12 Comments Submitted Pursuant to Notices of Inquiry Entitled “Orphan Works and Mass Digitization; Request for Additional Comments and Announcement of Public Roundtables,” 79 Fed. Reg. 7706 (February 10, 2014) and 79 Fed. Reg. 18932 (April 4, 2014)

Dear Register Pallante:

The American Intellectual Property Law Association (AIPLA) is pleased to submit these comments in response to the above-referenced Notices of Inquiry concerning the Office’s ongoing assessment of orphan works and mass digitization.

AIPLA is a national bar association with approximately 15,000 members who are primarily lawyers in private and corporate practice, government service, and the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved 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.

AIPLA addresses four issues raised in the notices.

1. The Need for Orphan Works Legislation.

In February 2013, AIPLA submitted written comments in response to another notice of inquiry, “Orphan Works and Mass Digitization,” 77 Fed. Reg. 64555 (October 22, 2012). In those comments, AIPLA gave its support for legislation to limit the remedies available to the owner of the copyright of an orphan work where the user has conducted a reasonably diligent search in good faith.

The most recent notice asks, among other things, whether recent legal and technological developments have obviated the need for legislation and whether the orphan works problem can be resolved under existing exceptions and limitations contained in the current Copyright Act, such as fair use.

AIPLA remains of the view that legislation to address the orphan works issue is appropriate. AIPLA reiterates its position that legislation should limit the remedies available to the owner of the copyright of an orphan work where the user has conducted a reasonably diligent search in

good faith. Such legislation should ensure that any determination is on a work-by-work basis, relying on stakeholder-developed best practices for assisting in the definition of what constitutes a reasonably diligent and good faith search.

2. Defining the Good Faith “Reasonably Diligent Search” Standard.

AIPLA’s February 2013 comments proposed that interested industry groups, working with the Office, develop “best practice” guidelines for what constitutes a good faith, reasonably diligent search. The most recent Notice of Inquiry asks specifically what role to give community-developed best practices documents that may guide particular groups of users making particular types of uses, who should develop these best practices, and what role the Office should play in developing, monitoring, or certifying search criteria.

AIPLA’s view is that best practices should be designed as guidelines to assist stakeholders and courts in determining whether a search was reasonably diligent and in good faith. Best practices should not be dispositive. An orphan works regime will work best when it is flexible and adjusts, as it must, to the facts of each case.

Best practices should be developed by stakeholders on all sides – rights owners and users, large and small. Standards or “best practices” developed solely by one industry trade group or by an association of users tend to be one-sided and, as a general matter, will have limited utility. Thus the Office must ensure that participation in the development of standards is robust through public roundtables and outreach.

AIPLA suggests that the Copyright Office facilitate the development of best practices by convening small working groups made up of different stakeholders. The working groups would discuss and draft best practices and illustrate examples with respect to types of copyrighted works – for example, use of photographs, and printed materials like books, and music. The Office could then compile, further elaborate upon, and publish these practices as guidelines for copyright owners and users, practitioners, and courts. The Office could provide for comments on draft practices through publication in the Federal Register. To ensure that the best practices remain relevant, the Office should conduct a review and comment period on a regular interval, perhaps every five years, to evaluate whether the standards need to be adjusted in light of technology and court decisions.

3. Treatment of Different Types of Works.

The notice asks whether an orphan works solution should exclude any particular type of work or whether it should include all copyrighted works. It also asks whether the exclusion of certain types of works would substantially undermine the effectiveness of any orphan works solution. These questions appear to be prompted by concerns previously raised with respect to photographic works.

AIPLA’s position is that the law should not discriminate against or provide special exceptions for certain types of works. Legislation, if appropriately drafted, should be flexible enough to apply to all types of copyrighted works and the various uses of such works. What constitutes a reasonably diligent search should reflect the circumstances of each individual use.

4. Mass Digitization.

The Notice of Inquiry asks how mass digitization fits into an orphan works solution, and specifically, how a mass digitization solution should differ from that of a general orphan works solution. The Office seeks comment on whether potential solutions developed in the context of mass digitization could ameliorate the issue of orphan works.

AIPLA strongly believes that the law should apply across the board, such that those who engage in mass digitization, regardless of the type of copyrighted work being digitized, would be subject to any orphan works legislation. Mass digitizers should not be given a special exemption or treated differently under the law merely because the conduct is on a massive scale rather than with regard to an individual work. This is for two reasons.

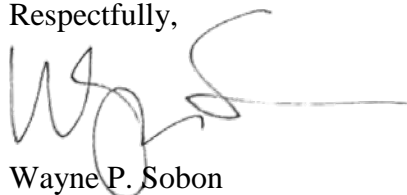
First, the recent Google Books district court decision demonstrates that, under certain circumstances, services that digitize copyrighted works on a large scale may qualify for fair use. The Copyright Office of course is familiar with the Google Books matter. No analysis of Judge Chin's evaluation of the multifactor fair use test is necessary for these comments, and AIPLA takes no position here on the merits or validity of his ruling. It is telling, however, that what appears to underpin Judge Chin's decision is his view that Google Books "advances the progress of the arts and sciences, while maintaining respectful consideration for the rights of authors and other creative individuals, and without adversely impacting the rights of copyright holders Indeed, all society benefits." *Authors Guild, Inc. v. Google Inc.*, 954 F. Supp. 2d 282, 293 (S.D.N.Y. 2013). Judge Chin's remarks are significant, and if his decision is affirmed on appeal, they potentially will lead to significant protections for mass digitization efforts. In light of the Google Books decision (and the *HathiTrust* decision), there appear to be significant legal protections for mass digitizers – obviating the need for any additional protections.

Second, orphan works legislation, if properly drafted, should be flexible enough to reasonably accommodate all types of users of copyrighted works, including small-scale users of individual works and large-scale mass digitizers. AIPLA firmly believes that when properly drafted, interpreted, and applied by the federal courts, such legislation can apply in all contexts and to all users. As such, it will support the underlying principles on which copyright protection was founded, balancing the public interest with those of creators and rights holders.

* * *

Thank you for considering AIPLA's comments in response to the Notice of Inquiry. We would be pleased to answer any questions these comments may raise and look forward to continue working with the Copyright Office on these issues.

Respectfully,



Wayne P. Sobon
President

American Intellectual Property Law Association