



**IN THE MATTER OF NOTICE OF INQUIRY  
OF THE COPYRIGHT OFFICE, LIBRARY OF CONGRESS  
REGARDING ORPHAN WORKS AND MASS DIGITIZATION**

**Docket No. 2012–12**

**COMMENTS OF THE ELECTRONIC FRONTIER FOUNDATION  
AND PUBLIC KNOWLEDGE**

The Electronic Frontier Foundation (“EFF”) and Public Knowledge (“PK”) welcome this opportunity to respond to the Notice of Inquiry by the Copyright Office for comments regarding orphan works, Docket No. 2012-12, published October 22, 2012 (“NOI”).

The Electronic Frontier Foundation is a non-profit civil liberties organization that has worked for more than 20 years to protect consumer interests, innovation, and free expression in the digital world. Founded in 1990, EFF represents almost 20,000 contributing members. EFF and its members have a strong interest in promoting balanced intellectual property policy that serves both public and private interests. Through litigation, the legislative process, and administrative advocacy, EFF seeks to promote a copyright system that facilitates, and does not impede, “the Progress of Science and useful Arts.”

Public Knowledge is a non-profit public interest organization devoted to protecting citizens’ rights in the emerging digital information culture and focused on the intersection of intellectual property and technology. Public Knowledge seeks to guard the rights of consumers, innovators, and creators at all layers of our culture through legislative, administrative, grassroots, and legal efforts, including regular participation in patent and other intellectual property cases that threaten consumers, trade, and innovation.

The scope of this Notice of Inquiry is fairly broad—as is the scope of orphan works generally. While the most prominent conversations about orphan works have tended to focus on one or two specific subsets of works, such as books, and/or specific activities, such as mass digitization, the fact of the matter is that any copyrightable work can be orphaned, and the potential beneficial uses of those orphaned works are as numerous as the beneficial uses of any copyrighted work.

This means that there can never be any one solution to “the orphan works problem,” any more than there is any one solution to “the crime problem” or “the disease problem.” Various fact patterns may call for different solutions, depending upon the type of work, the proposed use, and even the type of user. Therefore, a variety of solutions should be allowed to work in parallel

to address the problem. Certain proposed solutions based upon (essentially) assigning the rights of absent rightsholders to institutional parties can interfere with other solutions, like the exercise of fair use or a system of damages limitation based on diligent searches for rightsholders.

Further, any proposed solution must serve the primary goals of copyright law. The ultimate purpose of copyright law is to promote the progress of science and the useful arts; thus, any proposed orphan works solution should ultimately increase access to, and use of, already-created creative works. The designated means for promoting this progress is securing rights to the authors; thus, proposed solutions should also ensure as best as possible that the proper rightsholders are rewarded when they can be found. These two interests—increased access and proper remuneration—should, at the very least, not be prejudiced by any proposed solution.

Proposed solutions should also be evaluated in terms of their certainty and ease of use. Orphan works remain inaccessible to the public in large part because of the uncertainty that attends their use. A larger number of beneficial uses can be made as certainty increases, whether through legislation, clarifying case law, or the existence of an indemnifying private party. Solutions must also be practically usable by potential users; prohibitively high costs or complicated formalities for the use of orphan works will lead to “solutions” that lie unused, with works remaining inaccessible.

Finally, we note the obvious: the context of the orphan works issues changed dramatically with the emergence of mass digitization projects. However, while mass digitization may raise novel questions for orphan works, mass digitization in itself remains subject to the existing system of copyright laws. Many aspects of mass digitization projects will fall under the scope of fair use and other limitations and exceptions, whether or not the projects involve orphan works. Mass digitization projects also contain a great deal of promise for public access to knowledge even beyond orphan works, including access to non-orphaned works that are not commercially available and even commercial access to works. A number of the considerations attending mass digitization and orphan works also have implications for mass digitization generally, and we address some of these issues in Part II below.

With these principles in mind, we offer the following specific guideposts for developing frameworks to alleviate the orphan works problem, both for case-by-case uses and for mass digitization.

## **I. Orphan Works on an Occasional or Case-by-Case Basis**

### **A. Fair Use**

As the Library Copyright Alliance indicates,<sup>1</sup> recent jurisprudence in fair use has increased the certainty with which a number of entities may use orphan works. Fair use remains a viable means by which users of more limited numbers of orphan works may be made available

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<sup>1</sup> Comments of the Library Copyright Alliance on Orphan Works and Mass Digitization, Copyright Office Docket No. 2012-12 (Jan. 14, 2013) <http://www.librarycopyrightalliance.org/bm~doc/lca-orphanworks-comments-14jan13.pdf>.

to the public, instead of languishing in obscurity. The nature of fair use is precisely intended to further the Copyright Act's goals of promoting access to learning, as evidenced by the examples given in section 107 (“criticism, comment, news reporting, teaching... scholarship, or research). Requiring the payment of no fees and the application of no administrative process, fair use remains as accessible to any user as copyright protection does to any author. And while fair use is frequently bemoaned as an uncertain doctrine, recent case law has shown that, despite uncertainty at its edges, a wide range of uses are sufficiently clearly fair that users can rely upon the doctrine to use orphan works.

In a large number of cases where interest in the orphaned work has to do with showing its historical or cultural significance, rather than as a reiteration of the work’s original purpose, fair use provides a likely avenue for the work's legitimate use. For example, appellate courts have approved the reproduction *in toto* and exploitation of copyrighted works, even when those works had identifiable and litigious rightsholders.<sup>2</sup> In *Bill Graham Archives*, the Second Circuit found that complete reproductions of Grateful Dead posters within a commercially published book about the Grateful Dead were fair uses, since the purpose of their use was “plainly different from the original purpose for which they were created.”<sup>3</sup> The fully reproduced image, thus recontextualized, was a fair use.

Keeping in mind that this use was deemed fair in a case where the copyright holder was known and known to object to the use, it is difficult to see how a similarly situated user or an orphaned work could fare any worse. In addition to whatever historical or biographical purpose might be served by the use of the work, the user would also be making the work accessible to the public—fulfilling the primary goal of copyright law and further tipping the first fair use factor (the purpose and character of the use) in the user's favor. Should a rightsholder eventually emerge and file suit against the user, the absence of the rightsholder up to that time can be weighed against her in, *inter alia*, the first fair use factor, increasing certainty for a number of potential users.

A use of an orphan work is also far more likely to meet the fourth fair use factor, which considers the potential market for the original work. With no known rightsholder to issue a license for the work's use, no potential market for licensing the original work can exist. Again, while the existence of litigation after the use has commenced certainly reveals the presence of an entity that could issue a license, the fact-based fair use inquiry would also have to account for the presence or absence of the eventual plaintiff at the time that the user was seeking to make use of the work. These factors, which by definition are present in the case of orphan works, make even more likely that the wide variety of fair uses indicated by recent jurisprudence can be applied to orphan works.

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<sup>2</sup> *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605 (2d Cir. 2006); *see also Perfect 10 v. Amazon.com*, 508 F.3d 1146 (9th Cir. 2007); *A.V. v. iParadigm*, 562 F.3d 630 (4th Cir. 2009).

<sup>3</sup> 448 F.3d at 609.

Existing limits to statutory damages for certain non-profit entities can also add security for certain users.<sup>4</sup> For those particular users, fair use still provides some comfort and reduces the uncertainty of liability even if they do not prevail on the merits of a reasonable fair use claim. This feature of fair use and section 504 may be instructive as policymakers consider additional protections for other users.

## **B. Legislation: Limitation of Remedies**

The NOI asks for comment on the basic framework of the original Copyright Office proposal and the legislation that grew from it. At its core, the original proposal met many of the necessary criteria for a workable orphan works solution. It created incentives for users to find rightsholders and vice versa, increasing the likelihood of both access and remuneration. It also did not legislate the use of particular methods, databases, or entities in the course of a diligent search, avoiding textual complications, interpretive problems, and leaving room for flexibility among different community and industry practices, in particular as they change over time. The core proposal also increased certainty for users; while it could not serve to eliminate potential liability, it at least narrowed the range of damages that might have to be paid by a good-faith user.

Thus, we believe that a limitation on remedies conditioned on a reasonably diligent search can serve as a useful means of lowering barriers to the use of orphan works. Specifically, damages could be limited to no more than \$200 per work, plus injunctive relief in the form of disabling public access to the full work. In addition, Section 504 should be amended to specify that the court shall reduce the award of statutory damages to \$200 with respect to any infringer who believed and had reasonable grounds for believing that his or her use of the copyrighted work was a fair use under section 107. These two provisions can reduce the risk of exposure for at least two different types of orphan works users—those who are engaging in diligent searches for users that are like to be infringing, and those who are attempting to make good faith fair uses of works generally.

As noted in the Copyright Office's 2006 Report,<sup>5</sup> orphan works legislation should also strive for efficiency and simplicity, reducing burdens on all parties involved. For this reason, proposals should endeavor to steer clear of the increasing complexity and difficulty of use that grew atop the original damages reduction proposal as it made its ultimately futile way through Congress in 2008.

Therefore, we urge the Copyright Office and others to resist adding additional caveats, distinctions, and other complexities to this idea, as they are likely to make the proposal less likely to be used and useful. For instance, conditioning the finding of a diligent search upon the use (and thus assuming the existence) of particular certified databases only serves to delay the

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<sup>4</sup> 17 U.S.C. § 504(c)(2) (stating that courts shall remit statutory damages for nonprofit educational institutions, libraries, or archives that reasonably believed their uses were fair).

<sup>5</sup> United States Copyright Office, Report on Orphan Works 8 (2006), <http://www.copyright.gov/orphan/orphan-report.pdf>

implementation of the proposal, while creating potentially endless wrangling about database architecture, fees, completeness, and so on. Attempting to define a “diligent search” more precisely within legislation will lead to multidimensional debates about what constitutes reasonable diligence for differing types of works, made in differing eras by differing types of authors and made use of by a vastly differing array of potential users. Even beyond the negotiation and debates that could attend the legislative drafting of such guidelines for particular types of works or types of uses, there would be disputes as to defining the boundaries of each type of work or use. Thus, we share the Library Copyright Alliance’s concern regarding the difficulty of prescribing, *ex ante*, the parameters of a reasonably diligent search, and we agree that definition should be left to the courts to develop. To increase legal certainty, however, we urge that any legislation referring to such a search make clear that the standard should be objective, i.e., what a reasonable person would understand to be reasonably diligent under the circumstances.

None of this should discourage particular communities of creators or users from developing best practices guidelines,<sup>6</sup> which can be useful guideposts in case-by-case scenarios, but such sets of practices should not be viewed as the sole standards in determining reasonableness.

Other proposals, such as requiring escrow fees or allowing entities other than the actual rightsholders the ability to collect licensing fees, may similarly lead to additional and unnecessary levels of complexity as to the setting, administration, and collection of such fees, as well as a high likelihood of perverse incentives that may restrict access. (See Part C below).

Finally, it bears repeating that any legislative proposal absolutely must exist independently of existing limitations and exceptions, such as fair use.<sup>7</sup> The presence or absence of a diligent search should only have any bearing upon the remedies sought from an infringing user, and not prejudice an initial finding of fair use. Any implication to the contrary would weaken a larger contributor to access than any remedies-limiting orphan works proposal could make up for.

### **C. Legislation: The Licensing Option**

The NOI notes the existence of several plans in foreign countries. These include plans where collective licensing organizations are authorized to license works that do not belong to their members, or that belong to rightsholders who cannot be located. Many other countries also will grant licenses for the use of orphan works in exchange for compensation.

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<sup>6</sup> See, e.g., the Center for Social Media at American University’s various guidelines for best practices in fair use (<http://www.centerforsocialmedia.org/fair-use/best-practices>) and the Association of Research Libraries’ Code of Best Practices in Fair Use for Academic and Research Libraries (<http://www.arl.org/pp/ppcopyright/codefairuse/index.shtml>).

<sup>7</sup> See Report on Orphan Works 94.

We do not endorse a licensing system as a means of facilitating access to orphan works. While these proposals can, in certain cases, increase the certainty that users will not face litigation, they can easily stand in the way of access and proper remuneration for a majority of orphan works, either by co-opting or prejudicing the interests of the actual rightsholders or by potentially undermining fair uses.

The authors who the Copyright Act seeks to incentivize through exclusive rights have a wide variety of reasons for creating works.<sup>8</sup> Many authors are not primarily interested in financial rewards. Rather, they seek to contribute to the cultural and educational commons, or to obtain the recognition of their peers. An author, in determining license fees, may balance a multitude of factors in setting fees and conditions upon the licensing of a work, often reducing the cost of a license in exchange for wider distribution, or even conditions that ensure further distribution from recipients of the work from the original licensee.<sup>9</sup> In contrast, a beneficiary with no tie to the actual author or rightsholder would likely have only a financial interest in the exploitation of the work, and thus would seek to optimize revenues alone, often at a cost to broader access and distribution of the works.

Furthermore, the ability of any particular entity or set of entities to fill the role of absent authors creates an incentive for that entity to frustrate the actual finding of the true rightsholders. Despite the best intentions of any entity collecting on behalf of necessarily absent authors (though best intentions are not always a given<sup>10</sup>), or its employees and agents, any diversion of fees to fund its operations will reduce the incentive for the entity to perform its intended function of finding and remunerating the actual authors or rightsholders of the works.

Even more troubling, if such an entity had standing to challenge uses of orphan works in the absence of the work's author, the entire corpus of orphaned works would become immediately subject to litigation, and with a plaintiff that had very little interest or incentive to maximize anything but the size of the licensing fee. In other words, if it were possible for a collecting agency to have standing to sue over others' uses of orphan works, the current vacuum of legitimate rightsholders will be instantaneously replaced by an entity with the incentive and ability to co-opt those rights for its own financial gain.

While the knowledge that any use of orphan works absent a license (or statutory limitation or exception) would be an infringement could definitely increase certainty, it fails to

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<sup>8</sup> See, e.g., Rebecca Tushnet, *Economies of Desire: Fair Use and Marketplace Assumptions*, 51 Wm. & Mary L. Rev. 513 (2009); Tom W. Bell, *The Specter of Copyism v. Blockheaded Authors: How User-Generated Content Affects Copyright Policy*, 10 Vand. J. Ent. & Tech. L. 841, 851 (2008); Diane Leenheer Zimmerman, *Copyrights as Incentives: Did We Just Imagine That?*, 12 Theoretical Inq. L. 29 (2011).

<sup>9</sup> See, e.g., Creative Commons licenses (<http://creativecommons.org/licenses/>), the GNU General Public License (<http://www.gnu.org/licenses/gpl.html>), the Perl Foundation "Artistic License" (<http://opensource.org/licenses/Artistic-2.0>), *et al.*

<sup>10</sup> See Jonathan Band, *Cautionary Tales About Collective Rights Organizations*, [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=2149036](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2149036).

meet the primary goals of orphan works proposals and the Copyright Act in general, preventing access with no offsetting benefit to the actual rightsholders.

For these reasons, we do not believe licensing to be the right solution for the orphan works problem. However, if such a solution is seriously contemplated, any scheme that contemplates giving an entity the right to license the use of orphan works should refrain from granting that entity a cause of action against any user of orphan works. This would prevent the licensing entity from becoming an automatic gatekeeper to the use of orphan works, but also would allow users willing to acquire a license the option of doing so in order to avoid infringement. The author of an assumed orphan work who comes forward after the grant of license would thus be able to claim any damages owed from the licensing entity only. This would prevent a user from facing two potential litigants serially, and would also prevent erstwhile-orphan authors from needing to proceed against two defendants.

#### **D. How We Got Here: Addressing the Causes Rather Than the Symptoms**

While the renewed interest in orphan works is much appreciated, it also is worth noting that the persistent problem of orphan works is due mostly to three dangerous and sadly persistent aspects of U.S. copyright law: extremely long terms, high statutory damages, and a lack of formalities for copyright protection.

With copyright terms commonly lasting more than a century, the number of works that cannot be matched with their rightsholders will necessarily be high. Add to this the fact that no effort beyond the initial fixation of the work itself is required for protection, and the number of copyrighted works in existence in the world becomes astronomical, and increases by millions each day. Each of those works, without an easy means of connecting them to the author, becomes a potential orphan. The subset of these works that were timely registered also carries with them the threat of potentially crippling statutory damages. While a number of the above-mentioned doctrines and proposals can help to alleviate this situation, a more comprehensive amelioration of the problem can only come with addressing one or more of these three basic facets of copyright law.

The Copyright Office also sensibly notes that more complete, searchable, and accessible records of registration and assignment can only help reduce the number of potentially orphaned works. Given the Patent and Trademark Office's confidence that the use of copyrighted materials in the patent examination process is a non-infringing fair use,<sup>11</sup> the Copyright Office should also seriously consider all options for creating a "reverse-searchable" registry, where searchers can find authorship and rights ownership data by providing the registry with pieces of the copyrighted work in question, whether those pieces consist of text, images, or audiovisual samples. Given both the PTO's findings and recent case law finding that reproductions made for the purposes of indexing materials are fair use, there should be no legal barriers to the Copyright Office, or its private partners, from providing such a service. Moreover, we expect that there are

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<sup>11</sup> See USPTO Position on Fair Use of Copies of NPL Made in Patent Examination, [http://www.uspto.gov/about/offices/ogc/USPTOPositiononFairUse\\_of\\_CopiesofNPLMadeinPatentExamination.pdf](http://www.uspto.gov/about/offices/ogc/USPTOPositiononFairUse_of_CopiesofNPLMadeinPatentExamination.pdf).

technologists who would be pleased to assist with overcoming any technological barriers pro bono or for little cost.

## II. Mass Digitization

Regarding mass digitization, the NOI asks:

How should mass digitization be defined, what are the goals and what, therefore, is an appropriate legal framework that is fair to authors and copyright owners as well as good faith users? What other possible solutions for mass digitization projects should be considered?

These comments will focus on elements we believe should – and should not – inform possible legal frameworks for mass digitization generally, some of which are particularly salient with regard to making available digitized orphan works.

As a preliminary matter we note that a legal framework already exists for most of what mass digitization entails: the fair use doctrine.<sup>12</sup> EFF, Public Knowledge, and several library associations have filed amicus briefs in two cases involving mass digitization of books and other works: *The Authors Guild v. Google, Inc.*, S.D.N.Y. No. 1:05-cv-08136,<sup>13</sup> and *The Authors Guild v. HathiTrust*, S.D.N.Y. No. 1:11-cv-6351.<sup>14</sup> As explained in detail in those briefs, mass digitization – that is, making digital copies for purposes of preservation, indexing and providing snippets – falls easily within the confines of fair use. Section 107 explicitly recognizes that the use of copyrighted works “for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.”<sup>15</sup> The mass digitization projects of which we are aware are serving just that purpose. In *HathiTrust*, the district court agreed that fair use applies,<sup>16</sup> as did the district court in

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<sup>12</sup> See, e.g., *Legal Issues In Mass Digitization: A Preliminary Analysis and Discussion Document*, U.S. Copyright Office, October 2011, at 22-25; *Id.* at 8-9 (“In the context of books, [mass digitization] has come to mean large-scale scanning”); J. Urban, *What Can Fair Use Do? Libraries and the Mass Digitization of Orphan Works*, Presentation slides (April 12-13, 2012) (“The fair use doctrine in U.S. copyright law is a straightforward, if partial, potential solution to fears of using orphan works”) <http://www.law.berkeley.edu/files/Urban.pdf>.

<sup>13</sup> Brief *Amici Curiae* of Electronic Frontier Foundation *et al.*, <https://www.eff.org/sites/default/files/filenode/GoogleBooksEFFLibrariesAmicusBrief.pdf>; Brief *Amicus Curiae* of Public Knowledge <http://www.publicknowledge.org/pdf/pk-gbs-amicus-20090908.pdf>.

<sup>14</sup> Brief *Amici Curiae* of American Library Association, *et al.*, <https://www.eff.org/sites/default/files/filenode/HathiTrustAmicusBrief.pdf>.

<sup>15</sup> 17 U.S.C. § 107.

<sup>16</sup> See Opinion & Order, Oct. 10, 2012, <https://www.eff.org/sites/default/files/HathiTrust%20decision%20copy%202.pdf>.



*Cambridge University Press v. Becker*,<sup>17</sup> in which Georgia State University's uses of various texts in its electronic reserve system were largely ruled to be fair.

In short, we agree with the Library Copyright Alliance's conclusion that the fair use doctrine protects the mass digitization process in most cases, and particularly where the works are orphans.<sup>18</sup>

However, it is important to note that not all mass digitization efforts implicate orphan works. Therefore, mass digitization should not be viewed solely through the lens of orphan works. Recognizing that mass digitization of books, music, photographs and so on will only reach its full potential when digitized works (especially out of print works) may be accessed, in full, by the general public, for any purpose (as opposed to the nonprofit educational purposes contemplated by many libraries), we suggest the following should be included in any legal framework that might facilitate such access. We also identify several features to be avoided. A legal framework could then condition certain benefits to the entity upon its meeting certain threshold obligations.

## **A. Towards An Appropriate Legal Framework**

### **1. The Framework Should be Opt-Out, Not Opt-in**

In the course of the Google Books litigation,<sup>19</sup> it was suggested that a fair process for mass digitization should begin with offering copyright holders the choice to opt in to the program. We believe such a premise would seriously undermine the promise of mass digitization. First, many works in the corpus will be orphan works, which means there is no copyright holder capable of opting in. Second, many copyright holders will not be aware of the opt-in option. Third, many other works will be out-of-print works. For those works, there is simply no rational justification for requiring opt-in: presumably the copyright holder has already decided it lacks sufficient economic interest to make the work available.

Copyright holders should, however, be given the ability to opt out if they so choose. One approach would be to allow the copyright holder to notify the mass digitization project ("MDP"), that it does not want specified works made available. Assuming the MDP is not so notified, it may make an out-of-print work publicly available. Should a copyright owner then come forward

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<sup>17</sup> 863 F. Supp. 2d 1190 (N.D. Ga. 2012).

<sup>18</sup> Comments of the Library Copyright Alliance, *supra* n. 1, at 2-4.

<sup>19</sup> See Press Release, EFF, Google Book Search Case Threatens Librarians' Access to Information (Aug. 1, 2012) <https://www.eff.org/press/releases/google-book-search-case-threatens-librarians-access-information>; Corynne McSherry & Michael Barclay, *Digitizing Books is Fair Use: Author's Guild v. HathiTrust*, (Oct. 10, 2012) <https://www.eff.org/deeplinks/2012/10/authors-guild-vhathitrustdecision>.

to make a claim, a limit on remedies could apply to MDPs that have met certain obligations to protect the public interest.<sup>20</sup>

To be clear, this “opt-out” approach should not apply to mass digitization *per se*, nor to the provision of snippets, indexes and the like, but simply to the final step of making full works available to the public. The availability of works to be made publicly available could also be affected by the publication status of the original work.

## **2. Limitation of remedies for out of print works**

If a copyright holder does not opt out, and later seeks to hold an MDP liable for copyright infringement for providing full access to a work that is out-of-print, those damages should be limited to no more than, e.g., \$200 per work, plus injunctive relief in the form of disabling public access to the full work. In addition, Section 504 could be amended to specify that the court shall reduce the award of statutory damages to \$200 with respect to any infringer who believed and had reasonable grounds for believing that his or her use of the copyrighted work was a fair use under section 107. Restricting the damages limitation to out-of-print works and fair uses could reduce the likelihood that a mass digitization project will be incentivized to infringe in-copyright works in a way that harms the market for those works, while possibly providing a brighter line (and lower search costs) than restriction to orphan works could.

## **3. Broad public access**

One of the unfortunate characteristics of an MDP like the HathiTrust Digital Library (which is otherwise a tremendous public resource) is that it only makes its full catalog available to specific communities.<sup>21</sup> Imagine, instead, a world in which readers around the world could have access to an online library of materials, able to view long-buried historical documents, archives of photographs, out of print movies and scientific texts. Thus, MDPs taking advantage of the various benefits of this particular legal framework could be required or incentivized to provide broad access to the general public, not merely specific communities or subscribers. Different limitations on liability could apply to different types of availability, in order to balance incentives for digitizers to both increase access and prevent abuses. Ideally, there would be sufficient incentive for at least some entity to create a universally accessible library of works.

## **4. Consider whether the copyright owner has embedded adequate identifying information in the work**

In its January 2006 Report, the Copyright Office noted that one recurring problem was “numerous situations involving works that bear no information about the author or the owner of copyright in the work – no name of the author, no copyright notice, no title in short, no indicia of

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<sup>20</sup> A truly universal digital library would ideally have some means of making in-print works available as well, likely arranged and negotiated in a separate process.

<sup>21</sup> See HathiTrust Digital Library, *HTRC Access and Use*, [http://www.hathitrust.org/htrc\\_access\\_use](http://www.hathitrust.org/htrc_access_use).

ownership on a particular copy of the work *at all*.”<sup>22</sup> This is a significant obstacle from the standpoint of both the potential user of the work (who cannot locate a copyright owner to obtain permissions) and the copyright owner (who loses potential licensing income).

In the context of digital works, however, it is relatively easy to embed adequate identifying information in the digital copy. For example, the 2006 Report commented that the problem of inadequate information “is most pervasive – by far – with photographs.”<sup>23</sup> In the case of a paper photograph, it’s difficult to include identifying information. However, for digital photographs, the problem is simple: Using Adobe Photoshop or similar tools, it is easy to embed a “watermark” or other identifying material in a photograph.<sup>24</sup> Similarly, Microsoft Office documents such as Word and Excel files easily permit embedding informative “document properties” in the digital file, such as “title, author name, subject, and keywords that identify the document’s topic or contents.”<sup>25</sup> For PDF files, Adobe Acrobat allows insertion of identifying information in the PDF’s “document properties” field, including the “title, author, subject, and keywords.”<sup>26</sup>

A framework for mass digitization should consider whether the copyright owner included watermarking or other identifying material in the digital work. Should a digital work *not* contain such information, the remedies for any alleged infringement could be limited or adjusted, in order to simultaneously encourage more frequent watermarking or other identification and make harder-to-identify works more accessible.

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<sup>22</sup> Report on Orphan Works 23.

<sup>23</sup> *Id.* at 24.

<sup>24</sup> See, e.g., Steve Patterson, “Add A Copyright Watermark Pattern To A Photo With Photoshop,” <http://www.photoshopesentials.com/photo-effects/copyright/>; Adobe Photoshop Lightroom help, “Create a copyright watermark,” [http://help.adobe.com/en\\_US/lightroom/using/WS43660fa5a9ec95a81172e08124a15d684d-7fff.html#WS2bacbdf8d487e5824c61592312ca335ea18-8000](http://help.adobe.com/en_US/lightroom/using/WS43660fa5a9ec95a81172e08124a15d684d-7fff.html#WS2bacbdf8d487e5824c61592312ca335ea18-8000); Helen Bradley, Digital Copyright School, “How to Copyright Watermark Your Images in Lightroom 3,” <http://digital-photography-school.com/copyright-watermark-your-images-in-lightroom-3>.

<sup>25</sup> See Microsoft Office.com, “View or change the properties for an Office file,” <https://office.microsoft.com/en-us/word-help/view-or-change-the-properties-for-an-office-file-HA010354245.aspx?CTT=1>.

<sup>26</sup> See Adobe help, “PDF properties and metadata,” [http://help.adobe.com/en\\_US/acrobat/using/WS58a04a822e3e50102bd615109794195ff-7c67.w.html#](http://help.adobe.com/en_US/acrobat/using/WS58a04a822e3e50102bd615109794195ff-7c67.w.html#); “Adding metadata to document properties,” [http://help.adobe.com/en\\_US/acrobat/X/pro/using/WS58a04a822e3e50102bd615109794195ff-7c34.w.html](http://help.adobe.com/en_US/acrobat/X/pro/using/WS58a04a822e3e50102bd615109794195ff-7c34.w.html); Barb Binder, “Adobe Acrobat X: Adding Description Fields to Document Properties,” <http://blog.rockymountaintraining.com/?p=2413>.

## **5. User Privacy**

### **a) Protection Against Disclosure**

A reader should be able to access and purchase content on any MDP without worrying that the government or a third party may be reading over her shoulder.<sup>27</sup> To ensure that any information it stores linking users to the content they view or purchase is not freely disclosed to the government or third parties, the MDP's liability limitations should be conditioned on commitments that it (1) will not disclose information about users or their purchases to government entities or third parties in a pending civil or administrative action absent a warrant or court order (unless they are barred from doing so by law); and (2) will notify the user prior to complying with any government or third party request for her or his information, unless forbidden to do so by law or court order.

### **b) Limited Tracking**

Just as readers may anonymously browse books in a library or bookstore, readers should be able to search, browse, and preview content without being forced to identify themselves. Thus, an MDP could be required, as a condition of legal advantages, to ensure that searching and previewing content does not require user registration or the affirmative disclosure of any personal information; commit that it will not connect any information it collects from an individual with the same individual's use of other services without her or his specific, informed consent; purge all logging or other information related to individual uses of no later than 30 days after the use to ensure that this information cannot be used to connect particular books viewed to particular computers or users; and allow users of anonymity providers, such as Tor, proxy servers, and anonymous VPN providers, to access the MDP's services.

### **c) Transparency and Enforceability**

In the interest of transparency and enforceability in the protection of reader privacy, at a minimum, an MDP should provide a robust, easy-to-read, and easy-to-access notice of its privacy provisions; ensure that any commitment it makes to protecting privacy is legally enforceable and that all data it collects about its users is stored such that it is subject to U.S. legal protections; and annually publish online, in a conspicuous and easily accessible area of its website, the type and number of requests it receives for information about its users from government entities or third parties.

## **B. Dangerous Territory**

The following things should *not* be included in frameworks for mass digitization.

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<sup>27</sup> See EFF, "Authors Guild v. Google," <https://www.eff.org/cases/authors-guild-v-google>.

## **1. So-called digital rights management schemes should not be used**

Digital rights management (“DRM”) technologies frequently harm consumers, undermine competition and innovation, and unnecessarily preempt users’ fair uses of copyrighted content – all while making no appreciable dent in “digital piracy.” In 2009, EFF presented written comments to the FTC at a town hall meeting it convened to discuss DRM.<sup>28</sup> In summary, DRM imposes impermissible burdens on consumers. First, DRM helps industry leaders dominate digital media markets and impede innovation. Second, DRM endangers consumers by rendering their computers insecure and violating consumers’ reasonable expectations of privacy. Third, DRM harms consumers by degrading products and restricting consumers’ ability to make otherwise lawful uses of their personal property, upsetting the traditional balance between the interests of copyright owners and the interests of the public. What is worse, these social costs far outweigh any conceivable benefit. DRM is touted as an effective means to restrict copyright infringement, yet evidence continues to mount that DRM not only does little to inhibit unauthorized copying, it may actually encourage it.

Thus, DRM should not be a part of any legal framework for mass digitization projects.

## **2. No monopolies**

One of the concerns about the GBS settlement was that it could have created an effective monopoly for Google; only Google would have the ability to operate free from legal liability.<sup>29</sup>

If the public is truly to benefit from MDPs, no single project or type of project should be enshrined. Rather, any MDP that is able to invest sufficient resources and meet standard legal requirements should be permitted to operate.

## **3. No exclusion for editorial reasons – court order only.**

We see the legal framework for MDPs as a tradeoff: MDPs receive protection from liability in exchange for providing a significant public resource. Such protection should be conditioned on actually providing that resource. In keeping with that principle, once content is added to the database, it should be protected against editorial tampering. MDPs purporting to provide comprehensive access to sets of works must not delete works absent a court order requiring such deletion.

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<sup>28</sup> See Richard Esguerra, *Stating the Case Against DRM to the FTC*, (Mar. 24, 2009) <https://www.eff.org/deeplinks/2009/03/stating-case-against-drm-ftc>; Corynne McSherry, EFF, *Comment: Project No. P094502*, FTC Town hall: Digital Rights Management Technologies, (Feb. 9, 2009) [https://www.eff.org/files/filenode/DRM/DRMCOMMENTS\\_final.pdf](https://www.eff.org/files/filenode/DRM/DRMCOMMENTS_final.pdf).

<sup>29</sup> See *The Authors Guild v. Google Inc.*, 770 F. Supp. 2d 666, 682-83 (S.D.N.Y. 2011); Brief Amicus Curiae of Public Knowledge, <http://www.publicknowledge.org/pdf/pk-gbs-amicus-20090908.pdf>.

## Conclusion

A range of options, none of them exclusive, can alleviate the problems created by the prevalence of orphan works. Even in the absence of more systemic change that can stem the growing number of works whose copyright information disappears into obscurity, the application of fair use and legislative work on damages reduction (both for orphan works specifically and for good faith fair uses generally) can allow a variety of users to bring a variety of works to the public. Mass digitization projects promise to be a part of that process, and should be able to proceed in many cases under current law. However, more ambitious plans for broader, publicly-available MDPs could be incentivized to serve the public interest with additional damages limitations, attended by public interest conditions. We look forward to the ongoing efforts to meet this challenge and provide these works, their authors, and the public the access and recognition they all deserve.

Respectfully submitted,

/s/

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