

**Green Light for Grey Literature?  
Orphan Works, Web-Archiving  
and other Digitization Initiatives—  
Recent Developments in U.S.  
Copyright Law and Policy**

*Prepared for*

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# Use Problems: Options

- ***What Users Receive: Exemption*** (Sections 107 and 108) vs. **Limitation** on Liability (\$\$\$) (Section 504 and Orphan Works proposals).
- **Exemption: THE SECTION 108 STUDY GROUP REPORT** (March, 2007).
- **Limitation** on Liability: Solving the Problem of Orphan Works.
- DRM (***TPM*** and CMI), section 1201 regulatory **exemption** process.
- **Exemption: Fair Use** and recent litigation.
- Copyright law particulars and Risk Management: a hidden advantage for grey literature initiatives.

# Reform of 17 U.S.C. §108

- SECTION 108 STUDY GROUP REPORT (March, 2007), recommendations related to archiving and digitization:
  - Allow outsourcing if no other commercial benefit.
  - Increased access: off-site lending of physical-digital if that was the original format of the item (for preservation/security copying and replacement copying under subsection (b) and (c).
  - Preservation copying should apply to published works: as many copies as is reasonably necessary, best practices, restrict access, labeled, additional technical and administrative requirements.
  - Internet archiving allowed: “publicly available online content” not protected by password or “requiring an affirmative act by the user to access” but would likely exclude content subject to EULAs, initial on-premise access only, remote after passage of time, opt-out for owners, no harm to website, label, limited to private study, scholarship and research.

# The Problem of Orphan Works

- “[A] term used to describe the situation where the owner of a copyrighted work cannot be identified and located by someone who wishes to make use of the work in a manner that requires permission of the copyright owner.” U.S. COPYRIGHT OFFICE, REPORT ON ORPHAN WORKS 15 (2006).
  - “Many users of copyrighted works who have limited resources or are particularly risk-averse have indicated that the risk of liability for copyright infringement, however remote, is enough to prompt them simply to not make use the work. *Such an outcome is not in the public interest*, particularly where the copyright owner is not locatable because he no longer exists or otherwise does not care to restrain the use of his work.” *Id.*

# Solving the Problem of Orphan Works

- **Limitation on Liability:** S. 2913, 110th Congress, 2d Session (April 24, 2008) (Shawn Bentley Orphan Works Act of 2008); engrossed in the House September 27.
- ***What Users Receive:*** Remedy of the owner limited to...
  - Reasonable Compensation (no actual damages, statutory damages, costs, or and attorney’s fees).
  - No compensation if: “no purpose of direct or indirect commercial advantage; primarily educational, religious, or charitable in nature; and after notice and opportunity to conduct an expeditious good faith investigation of a notice of a claim of infringement, use promptly ceases.
  - Derivative (“significant amount of original expression”) Use: court can not enjoin continued use but can order reasonable compensation and attribution (“statutory license”).

# Solving the Problem of Orphan Works

- ***What Users Must do in Return: Attribution and Search.***
  - **Attribution:** “provided attribution, in a manner that is reasonable under the circumstances, to the legal owner of the infringed copyright, if such legal owner was known with a reasonable degree of certainty, based on information obtained in performing the qualifying search. ”
  - **Search:** “performed and documented a qualifying search, in good faith, to locate and identify the owner of the infringed copyright; and was unable to locate and identify an owner of the infringed copyright” and “diligent effort ... reasonable under the circumstances to locate the owner ... prior to, and at a time reasonably proximate to, the infringement.”
    - a search of the records of the Copyright Office or other reasonably available sources of copyright authorship and ownership, use of appropriate technology tools including appropriate databases, printed publications, and where reasonable, internal or external expert assistance; Copyright Office “Recommended Practices” and additional appropriate best practices, “may require use of resources for which a charge or subscription is imposed to the extent reasonable under the circumstances.”

# Technical Protection Measures

- Primary liability separate from copyright:
  - Prohibits circumvention of technological measures that control access, 17 U.S.C. § 1201(a)(1),
  - Prohibits distribution (trafficking) of technologies that control access, 17 U.S.C. § 1201(a)(2),
  - Prohibits distribution (trafficking) of protection technologies that control specific uses of a work, so called “black-box” devices, 17 U.S.C. § 1201(b).
    - “Trafficking” defined: primarily designed to circumvent, or limited commercially significant purpose, or marketed as an anti-circumvention device.
    - “Control” defined: In-place by owner, no corruption and no distortion of work.
- 17 U.S.C. § 1201(a)(1)(D): 3 year cycle of rule-making, de novo review. Statutory Standard: “noninfringing uses by persons who are users of a copyrighted work are, or are likely to be, adversely affected”

# Regulatory/Statutory Adjustment

- The classes of works under current exemption: 37 C.F.R. §201.40 (2006).
  - “Computer programs protected by dongles that prevent access due to malfunction or damage and which are obsolete.”
  - Library preservation of “computer programs and video games distributed in formats that have become obsolete.”
- H.R. 1201, the Freedom and Innovation Revitalizing U.S. Entrepreneurship Act of 2007 (FAIR USE Act of 2007), 110th CONGRESS, 1st Session (February 27, 2007).
  - Compilations consisting primarily of public domain works.
  - Work of “substantial public interest” for purposes of “criticism, comment, news reporting, scholarship, or research.”
  - Harmonization of section 108(c) privileges, but excludes works in “obsolete” formats.



# Web Archiving and Fair Use

- *A.V. v. iParadigms, Ltd.*, 2008 WL 728389 (E.D. Va. 2008) (archiving of student papers in the TurnItIn database is a fair use).
- *Perfect 10 v. Amazon.com, Inc.*, 487 F.3d 701 (9th Cir. 2007) (vacating injunction regarding Google's use of thumbnail images) (Thumbnail reproductions a fair use: “[w]e must weigh Google's superseding and commercial uses of thumbnail images against Google's significant transformative use, as well as the extent to which Google's search engine promotes the purposes of copyright and serves the interests of the public.” *Id.* at 722.)
- *Field v. Google, Inc.*, 412 F.Supp.2d 1106 (D. Nev. 2006) (Google caching is a fair use, bad faith as Field “deliberately ignored the protocols,” implied license defense available).

# Web Archiving and Fair Use

- *The McGraw-Hill Cos. Inc. v. Google Inc.*, No. 05 CV 8881 (S.D.N.Y. filed Oct. 19, 2005); and *Authors Guild v. Google Inc.*, No. 05 CV 8136 (S.D.N.Y. filed Sept. 20, 2005). Consolidated under *Authors Guild v. Google Inc.*, No. 05 CV
  - Claims of willful infringement subject to quintuple statutory damages ( $\$30,000 \times 5 = \$150,000$  per work infringed).
- MOTION to Approve /Notice of Motion for Preliminary Settlement Approval (October 28, 2008); and STIPULATION AND ORDER FOR AMENDMENT OF PLEADINGS (October 30, 2008) available at <http://news.justia.com/cases/featured/new-york/nysdce/1:2005cv08136/273913/>

# Copyright Law Particulars: Protection?

- Non-Copyrightable works: facts, names and titles, scenes a faire, basic forms, etc.
  - Impact: some grey literature may not be subject to copyright or DRM rules protection. See, *Online Policy Group v. Deibold, Inc.*, 337 F. Supp. 2d 1195 (N.D. Calif. 2004); and *Lexmark International, Inc. v. Static ControlComponents, Inc.*, 387 F. 3d 522 (6th Cir. 2004).
- Fair use: works of factual nature represent “thin” copyright (second prong: nature of the work).
- Works designated in the public domain: 17 U.S.C. § 105 (“Copyright protection under this title is not available for any work of the United States Government.”).
- Works that have fallen into the public domain:
  - Failed to comply with technical requirements of registration or renewal, when those requirements mattered.
  - Works for which the copyright has expired.
  - But see, 17 U.S.C. § 104A, restoration of copyright for selected foreign works: published works.

# Copyright Law Particulars: Publication

- Publication is defined in Section 101 as the “distribution of copies or phonorecords of a work to the public by sale other transfer of ownership, or by rental, lease, or lending”: Examples: 1. The distribution of copies on a busy street is publication. 2. The unrestricted gift of copies constitutes publication. 3. Leaving copies in a public place for anyone to take is publication. 4. Distributing text at a seminar for use only by the recipients is ordinarily not publication. Compendium II, Copyright Office Practices § 905.02 (1984).
  - *Estate of Martin Luther King, Jr. v. CBS, Inc.*, 194 F.3d 1121 (11th 1999) (“I Have a Dream” speech heard by thousands and broadcast to thousands more was not a publication.)
  - *Getaped.com v. Cangemi*, 188 F.Supp.2d 398 (S.D.N.Y. 2002) (website revised in June, infringement in July, registration in August, litigation follows): “Thus, when a webpage goes live on the Internet, it is distributed and ‘published’ in the same way the music files in *Napster* or the photographs in the various *Playboy* decisions were distributed and ‘published.’” *Id.* at 402.
- **Impact:** Internet post can be a publication but must be by the owner, conference proceedings may be a publication.

# Other Factors in Risk Assessment

- The statute of limitations: three years for civil actions and five years for criminal actions. 17 U.S.C. § 507.
- Registration and litigation over infringing use of orphan works:
  - Permissive. 17 U.S.C. § 408: “[T]he owner of copyright or of any exclusive right in the work may obtain registration ...”
  - Prerequisite to litigation. 17 U.S.C. § 411: “[N]o action for infringement ... shall be instituted until registration of the copyright claim has been made...”
- Damages and publication status: statutory damages and attorney’s fees available if registration before infringement of an unpublished work and within three months of publication for published works. 17 U.S.C. § 412.
- Legal Risk: the potential for liability (“can I be sued”), the likelihood of litigation (“will I be sued”) as well as settlement and the impact of that litigation or settlement (“how much will I owe”).
- **Impact:** Fair use of archive/digitization initiatives and new exemptions/limitations. Reduced legal risk for use of unpublished grey literature

**THANK YOU!**  
Questions and Comments  
... now or later ...

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