

## Understanding the Notice of Use Provision in Orphan Works Legislation December 2008

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**What Is a Notice of Use?** Under orphan works legislation, a user has to search for the copyright owner, and if he can't be found, then the user gets to use the work. A Notice of Use provision adds another condition – prior to using the work, a user also has to file a simple form with a third party (for example, the Copyright Office). Exactly what is in the Notice of Use is still up for debate, but various formulations have the Notice of Use including one or more of the following: the name and address of the infringer, a description of the alleged orphan work, a certification that the infringer conducted the requisite search for the copyright owner, a summary of what search was conducted, documentation of the search, the location of the use, a copy of the visual art that is the alleged orphan, and/or (if known with reasonable certainty) the title and name of the author/publisher/owner. While all of these components have been discussed as possible elements of a Notice of Use, it is unlikely that all of them will be required.

**Why Is the Notice of Use Important?** As it stands, there are only two key hurdles before a user can get orphan work protection: a search for the owner and the Notice of Use. The first hurdle is often pointless as a practical matter for visual art, so it is critical to include the second hurdle.

All the emphasis on what constitutes a sufficiently diligent search for the copyright owner is irrelevant when it comes to visual art. A user has no effective way to search for the rights holder of a visual work. The Copyright Office's registration records are not image-searchable, and the Copyright Office does not permit online or physical searches or examinations of its deposits. Beyond the Copyright Office, current online search technology is primarily text-based and therefore ineffective, given that no two people describe the content of an image the same way, and thus there are untold numbers of images that could fall within the same text description. While image-based online searching is on the horizon, most art still under copyright protection was created prior to the digital revolution and is not included in those searches. And, technical experts have still not found a way to effectively conduct digital searches for some kinds of art, like 3-dimensional abstract sculpture.

A Notice of Use filing will act as a gatekeeper, which helps to ensure that only good-faith users of orphan works are given the enormous advantages provided by the statute. All too often, copyright owners encounter bad actors who infringe their works and deliberately lie about all aspects of the infringements. An Orphan Works statute, stripped of a Notice of Use provision, will exponentially increase this phenomenon. An infringer who learns that he can infringe at minimal cost, so long as he claims that he tried and failed to find the copyright owner (an easy enough claim when it comes to visual art), certainly has every incentive in the world to make that claim. And, documentation of such a search can be readily manufactured, especially when even a good-faith search for the owner of a visual artwork may not result in much paperwork.

Liars are nothing new to the judicial system. But, in a fact pattern like this, they are incredibly expensive to defeat. In a case where a defendant falsely claims to have searched for a copyright owner, the dispute has to go all the way to trial — this is an evidentiary “fact” issue that has to be determined by a jury and cannot be resolved early in the case. But the failure to file the Notice of Use stops the bad actor in his tracks, barring him entirely from claiming orphan work protection.

**Why Should the Visual Art Be Attached to the Notice of Use?** It is vitally important to also include a copy of visual work itself with the Notice, because there is simply no uniform way to describe a piece of visual art. Indeed, “geometric figures” could apply to a million different works. Thus, if the visual art is not attached to the Notice, a manufacturer of infringing abstract art posters, knowing that he is not likely to be caught anyway, might file a single Notice of Use (listing a variety of graphic art sources) but be able to use it as a shield against any number of infringement claims. There must be a way to concretely tie a Notice to a specific piece of visual art and the only way to do that is to attach the visual art itself to the Notice. Moreover, one hopes that — one day — there could be value to a catalog of genuinely orphaned works, but that value will require that the artwork itself be cataloged. Further, requiring digital copies of the work to be attached to the Notice will, at some point, permit searches based on image-recognition technology.

**Who Won't Have to File a Notice of Use?** It is possible that a Notice of Use would only be required for visual art orphans, but not other mediums. Regardless, it is currently envisioned that non-profit users (including educational institutions, libraries, and museums) would be excluded



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from the Notice of Use requirement, because they are the “core” groups that orphan works legislation was designed to help, they largely exist to serve the public good and because they are less likely to falsely claim to have searched for a copyright owner.

**Is It Burdensome to File a Notice of Use?** Many groups adamantly objected to the original proposal for the Notice of Use, saying it was too burdensome. Now it is envisioned that the filing will be pared down and will exclude non-commercial uses. Good-faith actors who want to use an orphan work should find it easy enough to file a Notice of Use.

**Will the Notices of Use Be Public?** That has not yet been decided. There are advantages and disadvantages to either scenario, but on the whole, allowing copyright owners to review the Notices of Use would be the best way for users to identify owners and allow owners to manage rights to their work — and that is the whole point of the legislation, after all. If the Notices of Use (with the visual art attached) could be reviewed online, then the archive of Notices would function like a virtual “lost and found” department, where copyright owners could self-identify directly to the user. To allay concerns by some commercial users that they would not want their competitors to see what works they are planning on using, it would be possible to redact the filer’s information, to be released only to the copyright owner, such that only the copyrighted work itself would be publicly accessible.

If the Notices are public, that doesn’t necessarily mean it will be open season on those works. A user still has to conduct his own search for the copyright owner, and one starting point will be contacting the original filer. More to the point, visual artists are faced with a choice of their work being deemed an orphan without the owner being able to do anything about it until the infringement is widely disseminated and the copyright owner happens, by chance, to learn about it (a “dark” archive of Notices of Use) or, alternatively, having the opportunity to be proactive and to claim ownership of works before the infringement begins (a “light” or public archive of Notices of Use).

A cautionary note — the use of “light” (public) and “dark” (non-public) terminology to describe the Notices of Use can be misleading. For example, if the Notice of Use only contains the user’s contact information, without a copy of the work attached, it makes no difference if that Notice is public because the Notice is completely devoid of any information about the alleged orphan, and no copyright owner would find any benefit to reviewing the Notice.

Some concerns have been raised about whether the entity publishing the Notices of Use on its website (i.e., the Copyright Office) would be liable for copyright infringement if the work is not actually orphaned. This should be a red herring, because such a publication would clearly be protected by the “fair use” doctrine. Moreover, if the Notices are online, the immunity provisions of the Digital Millennium Copyright Act would apply. If deemed necessary, the legislation could specify that the publication of the Notices would not constitute infringement.

Given the divergence of opinions on whether the Notices of Use should be publicly accessible, it may be that any legislation will defer this decision to the Copyright Office, which will solicit comments from any interested party before implementing a decision. It is possible that the Copyright Office will have the official Notice of Use be non-public but then direct the user to submit the Notice to a public repository as part of the “recommended” or “best” practices promulgated by the Copyright Office under another section of the legislation. Another possibility is that the Notice would be public but would not include a copy of the work, and concurrently, the legislation would require the user to permanently retain the work as part of the mandatory documentation of the search. There is any number of iterations possible and in discussion.

**How Can a Person Search the Notice of Use Archive?** Searching capability is pertinent only if the Notices of Use are publicly accessible. If they are public, any search function would be likely limited to text searches, because image-search capability is still under development. At some later point, the archive could become image-searchable. In the meantime however, the Notices of Use could be organized chronologically — copyright owners could regularly search the filings (by day, week, month, or year), just as trademark owners do with the weekly publication of the Official Gazette, which lists the trademarks that have been approved for registration so that anyone who thinks one of the listed trademarks is too similar to his trademark can object.

**What Is the Point of a Notice of Use If It Is Not Public?** The Notice of Use is still vitally important even if it is not (currently) accessible by the public. Some infringers, once caught, will immediately claim, “I tried to find you and couldn’t, so all you get is \$\_\_” — but if that infringer hasn’t filed the Notice of Use, then the infringer never gets into “orphan work land,” and can never claim protection under the statute.

**Where Will the Notice of Use Be Filed?** Most likely, the Copyright Office will be the repository. However, in order to satisfy the purposes of a gatekeeper and possible lost-and-found department, any reputable, neutral third party (not the user himself) could serve this role, like the Copyright Clearance Center.

**What Will the Notice of Use Cost and Who Will Pay?** It is anticipated that the filer of the Notice will pay a small fee. Given that the Copyright Office will not be substantively reviewing the filings or doing anything with them other than acting as a filing cabinet, the expense for the Copyright Office should be relatively minimal. After the legislation

is passed, the Copyright Office will determine the filing procedures and fees. It might be appropriate for the Copyright Office to permit bulk filings for a single fee, like a filing including all alleged orphan works in a to-be-published book.

The question of a search fee (as opposed to a filing fee) arises only if the Notices of Use are public. There has been, to date, no suggestion that any searcher would be charged a fee. Just as the copyright registration records currently online at the Copyright Office website are searchable without charge, one would expect the Notices of Use to be searchable without charge (again, if the archive is public).

It should be noted that the Copyright Office asserts that it will cost the Copyright Office a great deal of money to accept Notice of Use filings, even though the Copyright Office will be functioning as a drop-box. There is reason to doubt this claim, particularly because the Copyright Office already has similar intake procedures in place. The Copyright Office receives and posts ISP Designations under the DMCA (Digital Millennium Copyright Act) and does the same for illustrations and photographs pursuant to the Vessel Hull Design Protection Act.

In all probability, there won't be many Notices of Use that are filed and, therefore, the expense for the Copyright Office will not be significant. Because of the exclusion of "useful articles" from Orphan Works legislation, and given the likely exclusion of non-profits from a Notice of Use requirement, and the possibility that Notices of Use will only be required for visual art, the only groups that would file Notices of Use would be book/magazine/website publishers, fine art purveyors, art poster producers, mural designers, advertising agencies, decorative and ornamental manufacturers, and similar ventures.

**What If I Don't Want My Work included in the Notice of Use Archive?** This objection will only be raised by some artists if the Notices of Use are public. If they are not public, it is a moot point. If the Notices of Use are publicly accessible online, and a copyright owner sees one of his works in the archive, he can most likely get it removed by sending a "Notice and takedown" letter under the DMCA framework.

**Couldn't a Bad Actor File a False Notice of Use?** In other words, could a person plan to infringe a copyrighted work, intentionally choose not to search for the owner, but file a Notice of Use so he could lie and claim that he did do the search if he was ever caught? Sure, that is possible, but it is unlikely. The reality is that most thieves either do not think they will get caught, or don't realize that using someone else's visual art is prohibited. These folks aren't going to take steps to create alibis in advance of getting caught. Usually, the infringement is a shortcut, and in his rush to get an item to market, the bad actor does not stop to file paperwork like a Notice of Use or to consult a knowledgeable attorney. That said, if an infringer can file a single Notice of Use, untethered to a specific piece of visual art, and thereby protect himself from any claim of infringement for any of the works he is caught infringing, then that is more likely to happen.

**Will Copyright Owners Be Required to Review the Notice of Use Archive?** That is assuming the Notices of Use are publicly accessible. If they are public, there is no obligation for a copyright owner to review them. The downside to not reviewing publicly available Notices of Use is that a copyright owner might lose the chance to stop in advance one of his works from being used. If a copyright owner does want to review the Notices, it probably will not take him very long to do so, especially if he only looks at the Notices that were filed since the last time he checked. Because "useful articles" are excluded entirely from the legislation and non-profits will be likely excluded from the Notice of Use requirement, there will not be very many commercial entities that will file the Notice of Use. Copyright owners that register their work with the Copyright Office (and therefore are at risk of losing the most under the legislation, i.e., statutory damages and attorney's fees) will likely find that a periodic review of the Notices is a minor administrative chore, especially compared to the time and money spent with the registration process.

**How Would a Notice of Use Apply with Non-Visual Art, Like Music?** Visual art is the only medium where it is practically impossible to search for the owner and where that owner could be earning a living from that work. It would be reasonable to make the Notice of Use applicable to only visual art. But if a Notice of Use is required for all mediums, it would work the same way, with some tangible representation (like sheet music or a CD) attached to the Notice, assuming the Notice requires the work to be attached.

**Is a Notice of Use Provision in the Orphan Works Legislation?** The Senate bill (S. 2913) received unanimous consent of the entire Senate without any kind of Notice of Use provision whatsoever. The House bill (H.R. 5889) is still under consideration and the current version does contain a Notice of Use, but there are some groups that are trying to strip it out. Assuming it remains in the House bill, there is a great deal of discussion about how the Notice of Use should be changed.

**When Would a Notice of Use Be Filed?** The House bill (H.R. 5889) currently requires that the Notice would be filed prior to the commencement of use of the orphaned work. However, there is an effort to change this timeframe such that the user would have up to a month after first public distribution of the work before the user had to file the Notice. This change is problematic, given that much of the damage to the copyright owner will occur in that first push into the marketplace.