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Finding a Home for Orphan Works: Will a Human Rights Perspective Help?

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Summary

Copyright has traditionally been considered as a right that has a social function. Thus, among the various justifications for its existence, it is the utilitarian or instrumentalist justification that has often been hoisted in order to assess how well it serves the needs of society. From its inception as a concept, copyright has been justified as a necessary evil that, to quote Macaulay, “ought not to last a day longer than is necessary for the purpose of securing the good”. Accordingly, works temporarily protected by copyright should revert to the public domain immediately upon the expiration of the limited grant.

But despite the benefit of historical record from whence to look back to understand the true nature of copyright, modern society appears to continue to grapple with the idea of copyright.

Part of the reason why the development of copyright seemed to have lost its instrumentalist nature is the fact that while copyright interest is organized, the interests at the opposite end of the spectrum (i.e., the users) suffer from a collective action problem. Nevertheless, there is an increasing awareness that the continuous expansion of copyright is indeed detrimental to the public domain.

This awareness has led some copyright scholars to write in support of a more robust public domain and to organize movements in retaliation for the continuing advance of the so-called copyright expansionists in what has been depicted as a “copyright war”.

One flashpoint that has impelled public domain activists to action is the seemingly innocuous problem of orphan works. Its existence has been blamed on a copyright term that has been described as being obscenely long. The problem impacts on productivity inasmuch as new works are prevented from being created due to permission issues. Governments and the business sector are themselves constrained in their search for workable solutions by international and national legal frameworks that make it impossible to restore the system to what previously worked.

Google, a company whose name is considered by many as being synonymous to creativity and innovation, has serendipitously stumbled upon a private-ordered solution to the orphan works problem through its Book Search Project. As a profit-driven entity, however, concerns have been raised on the propriety of allowing it to usurp what otherwise would have been the role of the legislature. Still, a judicially decreed Settlement Agreement that will allow it to exploit vast amounts of orphan works is better than not being able to deal with the said orphans at all.

A discussion of these issues – be it on the general issue of copyright balance or on the more specific issue of Google’s treatment of orphan works – would be further enlightened by a human rights perspective. Human rights provide a new paradigm that could bring the conflicting interests to agree on a unified and reconciled understanding of a balanced copyright-public domain relationship

Preface

This thesis builds upon a paper that I wrote in the spring of 2009. I might as well explain how I got interested in this odd-sounding topic (for a mini-thesis) in my *European Intellectual Property Rights* course and now as the focal point of my degree thesis.

While skimming the pages of Sherman and Bently's *Intellectual Property Law*, I chanced upon a section that briefly discussed a phenomenon called "orphan works". It was the first time I read or heard about it. (I have been practicing law in the Philippines but IP was not my area of specialization.) I found the moniker quite intriguing and soon found myself trying to understand what it meant. A few minutes into my reading, I acquired a general idea of the problem it presented, and I decided to propose it as the topic of my final paper for the course. That of course required that I read further into the topic. Thus, by the end of the term I had decided to specialize further into copyright law opting for the course *HR Perspectives on Intellectual Property Law*. By the end of my studies, I was looking at copyright law (and IP in general) with a balanced perspective. This enlightenment of sorts had been inspired by Anna Nawrot and Ulf Maunsbach who handled both courses, and who guided me towards the completion of this thesis.

It is therefore only apt that I dedicate a few lines of this thesis to thank Anna and Ulf for their valuable help. I am likewise grateful to all my mentors in the Masters programme for their dedication and selfless resolve to share their knowledge.

I thank my family, especially my wife Miramar, whose unfailing love and support inspires me no end. *At sa Dakilang Panginoon, salamat po!*

Danilo Penetrante Ventajar
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Abbreviations

CDPA	Copyright, Designs and Patents Act of 1988 (UK)
DMCA	Digital Millenium Copyright Act (US)
ECHR	European Convention on Human Rights of 1950
ECtHR	European Court of Human Rights
ECJ	European Court of Justice
EU	European Union
ICCPR	International Covenant on Civil and Political Rights
ICESCR	International Covenant on Economic, Social and Cultural Rights
InfoSoc	Information Society
TRIPS	Trade-Related Aspects of Intellectual Property Rights
UDHR	Universal Declaration of Human Rights
UK	United Kingdom
UN	United Nations
US	United States
USC	United States Code
WIPO	World Intellectual Property Organization
WTO	World Trade Organization

1 Introduction

1.1 Purpose

The purpose of this thesis is to describe the orphan works problem and analyze the responses and solutions thereto with emphasis on the private-ordered solution incorporated in the Google Book Search Settlement Agreement now pending approval before the US District Court. The analysis will highlight the need to incorporate the interest of the public domain in the discourse, and to use human rights as a possible counterweight to copyright expansionism of which the orphan works problem is one symptom among many.

Finding a home for these orphans, so to speak, is no simple task. In the United States, the legislative initiative to solve the problem had hit snag and there is no indication that a new law will be promulgated sooner since conflicting interests that are difficult to reconcile are involved. However, Google had taken the cudgels to force a solution by deliberately dealing with orphan works in their Google Book Search project relying on the US doctrine of fair use that consequently gave rise to a class suit filed by the Authors Guild and the Association of American Publishers. In Europe, the Commission has laid down a road map towards making sure that users, especially the so-called digital natives will be able to exploit these orphan works. Europe is however inclined at taking another route. It finds the orphan works problem as a licensing issue that is better addressed by an extended collective license scheme.

Finding a solution to the orphan works that is mutually acceptable to conflicting interest groups requires an understanding of the role of the public domain in the copyright discourse. If public domain is the default regime for all creative works then any treatment of orphan works must be towards its subsequent fall or return to the public domain without any further delay. This understanding is further enlightened by incorporating a human rights perspective into the discourse.

1.2 Delimitation and Methodology

As indicated above, the basic objective of this paper is to be able to present a general picture of the orphan works problem in relation to the current awareness over public domain issues using human rights as a lens. It will not attempt to disentangle an array of possible conflict of laws issues that will surely arise from an absence of a harmonized or uniform solution to the problem. This legal disquisition will thus rely on books, scholarly articles and news stories about orphan works around the world to be able to have a good grasp of the concepts involved and to fuel a coherent analysis of the issues.

1.3 Structure

The disquisition is divided into four sections.

The first section will present copyright law's contemporary history in parallel with the development of the concept of the public domain. Having categorically recognized public domain as a concept that exists side by side with copyright, I will briefly discuss how this balanced view of copyright law could be attained¹.

The second section will discuss the human rights based-approach² to copyright law. The human right character of copyright law and its interaction with the other human rights will be assessed.

The third section will analyze the orphan works problem whose cause is blamed on an overly³ extended copyright term. Remedial and preventive measures will be identified on the basis of the existing normative framework.

The final section will be dedicated to a discussion of the Google Book Search project being the first real attempt to solve the orphan works problem (albeit private-ordered). It will be analyzed using the human rights lens.

¹ I therefore assume at the very outset that copyright law is in a state of imbalance.

² A Human Rights-based perspective is said to have been ignored in the copyright discourse (See Orit Fischman Afori., "Human Rights and Copyright: The Introduction of Natural Law Considerations Into American Copyright Law", Fordham Intellectual Property, Media & Entertainment Law Journal, Vol. 14, No. 2, 2004, available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1089376## accessed on March 9, 2010

³ Patry describes the current terms as being as being at "obscene levels." See, William Patry, *Moral Panics and the Copyright Wars*, Oxford University Press (2009) at p. 77

2 Copyright and the Public Domain

2.1 Background

Copyright and the public domain are related and mutually-reinforcing concepts. One cannot thrive without the other. A copyright regime that draws its inspiration from a shallow and denuded public domain will not thrive. On the other hand, no public domain can be built upon a system that does not allow copyright to grow.

Briefly defined, copyright is “a legal term describing rights given to creators for their literary and artistic works.”⁴ The public domain however is a relatively unknown concept when juxtaposed with copyright. The accepted definition of the public domain is that it is the embodiment of the entire culture freely available to society and not subject to the bundle of exclusive rights created by copyright. The wider definition of the public domain will encompass not only what is depicted as the domain outside of copyright, that is, all cultural goods that are not or no longer protected by copyright but would include “all freely available resources for intellectual production, such as fair use or other copyright limitation and exceptions.”⁵ The public domain is the basis for our art, our science, and our self-understanding. It is the raw material from which we make new inventions and create new cultural works⁶.

A brief look at the highlight of contemporary copyright history as it bears on the concomitant concept of the public domain could put the arguments in this thesis in perspective.

2.2 The Past

The origin of copyright in so far as it recognized the public domain as a counterweight is generally attributed to the Statute of Anne of 1710. The words describing the statute implicitly indicate this -- An Act for the *Encouragement of Learning*, by *Vesting the Copies of Printed Books in the Authors or Purchasers of such Copies, during the Times therein mentioned.*⁷

⁴ WIPO, General Information on Copyright, What is Copyright? available at http://www.wipo.int/copyright/en/general/about_copyright.html accessed on March 10, 2010

⁵ Valerie-Laure Benabou and Severine Dusollier, “Draw Me a Public Domain” in Paul Torremans (ed.), *Copyright Law, A Handbook of Contemporary Research*, Edward Elgar Publishing (2007), at p. 172

⁶ James Boyle, *The Public Domain: Enclosing the Commons of the Mind*, Yale University Press (2008), at p. 39

⁷ Available at <http://www.copyrighthistory.com/anne.html> accessed on March 10, 2010

With its enactment, England was hailed as the first nation to substitute a statutory rule of copyright law for a regime of royal favor.⁸ More importantly, it laid down the utilitarian justification for the existence of copyright that the government grants the authors a monopoly to exploit his or her work to encourage him or her to enrich knowledge and culture. The statute hopes to spur creativity by conferring a reproduction right on authors for fourteen years, renewable for another fourteen, if the author was still living yet imposing the formalities of registration and deposit of copies as prerequisites to protection.⁹ The Statute of Anne's two important principles are: (1) that copyright is a conditional right requiring the creation of a new work, as distinguished from an unconditional right facilitating the continued exploitation of old works; and (2) that the public domain is more important to learning than copyright, under which even new writings henceforth would be subject to the copyright holders marketing control only for short periods of time, not in perpetuity.¹⁰

The United States followed and in 1787 incorporated a Copyright Clause in its Constitution which empowers Congress (t)o *promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.*¹¹

The clause fundamentally reflected the incentive and access policy of the Statute of Anne.¹² An early construction of the constitutional intent is that the clause is

Not primarily for the benefit of the author, but primarily for the benefit of the public, such rights are given. Not that any particular class of citizens, however worthy, may benefit, but because the policy is believed to be for the benefit of the great body of people, in that it will stimulate writing and invention to give some bonus to authors and inventors.¹³

Without delving into the long history of the Anglo-American copyright law¹⁴, one can see the utilitarian justification for imposing a limited copyright monopoly to English and American authors.

⁸ Jane C. Ginsburg, "A Tale of Two Copyrights: Literary Property in Revolutionary France and America" (1990) 64 Tul. L. Rev. 99

⁹ Id.

¹⁰ L. Ray Patterson and Stanley F. Birch, Jr., *Unified Copyright Theory* (edited by Craig Joyce) available at http://www.houstonlawreview.org/archive/downloads/46-2_pdf/01_Patterson.pdf accessed on March 6, 2010, at p. 252

¹¹ Article I, Section 8, Clause 8 of the United States Constitution,

¹² See L. Ray Patterson and Stanley F. Birch, Jr., *Unified Copyright Theory* at p. 243 ("The Copyright Clause may be the only provision of the Constitution for which we can identify a specific origin. There is strong textual evidence that the source of the Clause is the title of the Statute of Anne of 1710 ...)

¹³ Ginsburg, *supra* note 8, citing H.R. Rep. No. 60-2222

¹⁴ For a detailed historical account see Lyman Ray Patterson, *Copyright in Historical Perspective* (Nashville: Vanderbilt University Press, 1968)

How about the French copyright enactments? Ginsburg's research on the history of French copyright law reveals that while authors' rights had been at the core of the grant, the public interest and the public domain were prominent in the debate. She also explains that even Le Chapelier who was often quoted for being a great exponent of authors' right rationales for copyright appears to have been quoted out of context¹⁵. Ginsburg thus presented Le Chapelier's full statement in its real context:

The most sacred, the most legitimate, the most unassailable, and . . . the most personal of all properties, is the work which is the fruit of a writer's thoughts.

But it is a property of a different kind from all the other properties. [Once the author has disclosed the work to the public] the writer has affiliated the public with his property, or rather has fully transmitted his property to the public. However, because it is extremely just that men who cultivate the domain of ideas be able to draw some fruits of their labors, it is necessary that, during their whole lives and some years after their deaths, no one may, without their consent, dispose of the product of their genius. But also, after the appointed period, the public's property begins, and everyone should be able to print and publish the works that have contributed to enlighten the human spirit. (Archives parlementaires, Assemblée nationale, January 13, 1791, pp. 212-213).¹⁶

Ginsburg provides additional historical notes showing that over and above the French authors' rights justification lies a commonality with the Anglo-American utilitarian justification in so far as the public domain is concerned. Ginsburg's study showed that

*(m)ixed motives underlay the French revolutionary copyright laws (as well as their US counterparts) and that the parliamentary speeches and the texts of the laws themselves attest to a certain tension between authors' personal claims of right and the public interest in access to works of authorship. Thus, without denying the presence of a strong authors' rights current in the revolutionary laws, I would suggest that the revolutionary legislators generally resolved that public-versus-private tension by casting copyright primarily as an aid to the advancement of public instruction.*¹⁷

The copyright or author's domain and public domain dichotomy was not an easy marriage because the booksellers' interest directly conflict with the idea of a copyright that is limited in time. History is thus replete with record of debates as to whether or not copyright is a right in common law that

¹⁵ Ginsburg, *supra* note 8

¹⁶ Jane Ginsburg, "'Une Chose Publique'? The Author's Domain and The Public Domain in Early British, French and US Copyright Law, in Paul Torremans (ed.), *Copyright Law, A Handbook of Contemporary Research*, Edward Elgar Publishing (2007), at p. 145

¹⁷ Ginsburg, *supra* note 8

would avoid statutory limited periods. In the end, that dangerous notion of a perpetual copyright has been put to rest in the oft-cited English case of *Donaldson v. Beckett*¹⁸ and the US case of *Wheaton v. Peters*¹⁹. The French on the other hand did not need a judicial ruling to define the boundaries of copyright and the public domain. They adopted a law that featured a limited period of authorial economic rights albeit depicted as “one of the longest copyright terms in the world”²⁰.

On the whole, the rationale for a utilitarian approach to copyright is best captured in Macaulay’s speech on 29 January 1841 to object to a bill seeking to amend the law of copyright in England by extending the term of copyright in a book to sixty years, reckoned from the death of the writer. Copyright historians and scholars have always come back to this speech for it eloquently expressed the required balance that even present day copyright lacks. He said:

The advantages arising from a system of copyright are obvious. It is desirable that we should have a supply of good books; we cannot have such a supply unless men of letters are liberally remunerated; and *the least objectionable way of remunerating them is by means of copyright*. You cannot depend for literary instruction and amusement on the leisure of men occupied in the pursuits of active life. Such men may occasionally produce compositions of great merit. But you must not look to such men for works which require deep meditation and long research. *Works of that kind you can expect only from persons who make literature the business of their lives*. Of these persons *few will be found among the rich and the noble*. The rich and the noble are not impelled to intellectual exertion by necessity. They may be impelled to intellectual exertion by the desire of distinguishing themselves, or by the desire of benefiting the community. But it is generally within these walls that they seek to signalise themselves and to serve their fellow-creatures. Both their ambition and their public spirit, in a country like this, naturally take a political turn. It is then on men whose profession is literature, and whose private means are not ample, that you must rely for a supply of valuable books. *Such men must be remunerated for their literary labour. And there are only two ways in which they can be remunerated. One of those ways is patronage; the other is copyright*.

[...] *and the least exceptionable way of remunerating them is by a monopoly*. Yet monopoly is an evil. For the sake of the good we must submit to the evil; but the evil ought not to last a day longer than is necessary for the purpose of securing the good.

¹⁸ *Donaldson v. Beckett*, (1774) 1 Eng. Rep. 837, 843 (H.L.)

¹⁹ *Wheaton v. Peters* (1834), 33 U.S. 591, 592

²⁰ Ginsburg, *supra* note 16
at p. 148

The principle of copyright is this. *It is a tax on readers for the purpose of giving a bounty to writers.* [...] ²¹

2.3 The Present

The debate about the author's domain and the public domain that preoccupied the minds of lawmakers and scholars continues to rage today. The terminologies may have changed but the foundational issues remain the same. The debate is now even characterized as a copyright war²². Copyright Maximalists versus Copyright Minimalists. Optimists versus Pessimists²³. High Protectionists versus Low Protectionist²⁴, Pro-commodificationists versus Anti-commodificationists²⁵. One side may also identify themselves as supporters of copyright "rights" while the other as supporters of copyright "liberties"²⁶

The stakes are higher and the arena has changed. While the protagonists in the battle of the booksellers were quarreling about rights over the distribution of tangible books, today's wars are being fought over rights in intangibles where the marginal cost of production and its distribution across the Internet and the World Wide Web is zero²⁷. Indeed, as Boyle observes, the conflict between the two opposing camps are now easily triggered even as the concept of balance between copyright and the public domain has become fuzzier. He thus laments that:

²¹ Thomas Babington Macaulay, A Speech Delivered In The House Of Commons On The 5th Of February 1841 available at <http://yarchive.net/macaulay/copyright.html> accessed on March 3, 2010

²² See William Patry, *supra* note 3; Jessica Litman, War and Peace: the 34th Annual Donald C. Brace Lecture, 53 J. Copyright Soc'y U.S.A. 1, 1, 3 (2005-06); Peter K. Yu, The Escalating Copyright Wars", 32 Hofstra L. Rev. 907, 937 (2004); Jessica Litman, Digital Copyright 151-65 (2001) ("Chapter Ten: The Copyright Wars"); Jessica Litman, War Stories, 20 Cardozo Arts & Ent. L.J. 337 (2002).

²³ See Boyle, *supra* note 6 at p. 270 (referring to Goldstein's work)

²⁴ See Paul Goldstein, "Copyright", Law and Contemporary Problems, Vol. 55. No. 2 (1992) at p. 79

²⁵ Julie E. Cohen, "Copyright, Commodification, and Culture: Locating the Public Domain" in L. Guibault and P.B. Hugenholtz (eds), *The Future of the Public Domain*, Kluwer (2006), pp. 121-166

²⁶ See Jessica Litman, "Lawful Personal Use", Symposium: Frontiers of Intellectual Property (III. Copyright), 85 Tex. L. Rev. 1871

²⁷ Yochai Benkler, *The Wealth of Networks: How Social Production Transforms Markets and Freedom* (2006) at pp. 36 and 52 (stating that there is zero marginal cost to reproduce information) See also Eben Moglen, "Freeing the Mind: Free Software and the Death of Proprietary Culture" available at <http://moglen.law.columbia.edu/publications/main-speech.html> accessed on March 10, 2010 (He writes: "For the first time in human history, we face an economy in which the most important goods have zero marginal cost. And the transformation to digital methods of production and distribution therefore poses to the twenty-first century a fundamental moral problem. If I can provide to everyone all goods of intellectual value or beauty, for the same price that I can provide the first copy of those works to anyone, why is it ever moral to exclude anyone from anything? If you could feed everyone on earth at the cost of baking one loaf and pressing a button, what would be the moral case for charging more for bread than some people could afford to pay?")

[...] Suddenly, the triggers of copyright—reproduction, distribution—can be activated by individual footsteps.

Of course, we would hope that in your daily actions you scrupulously observed the rights—all the rights—of the companies that have interests in the texts, tunes, images of celebrities, trademarks, business method patents, and fragments of computer code you dealt with. Did you? Can you be sure? I teach intellectual property, but I admit to some uncertainty.

I would not have imagined that a temporary image of a Web page captured in the cache of my browser counted as a “copy” for the purposes of copyright law. I would have thought that it was fair use for a company to photocopy articles in journals it subscribed to, and paid for, in order to circulate them to its researchers. If a conservative Web site reposted news articles from liberal newspapers with critical commentary, that, too, would have seemed like fair use. I would have thought that it was beneficial competition, and not a trespass, for an electronic “aggregator” to gather together auction prices or airline fares, so as to give consumers more choice. *I would not have thought that a search engine that catalogued and displayed in framed format the digital graphics found on the Internet would be sued for infringing the copyrights of the owners of those images.* I would not have thought that I might be sued for violating intellectual property law if I tried to compete with a printer company by making toner cartridges that were compatible with its printers.²⁸

While the utilitarian justification to copyright law continues to form part of the present normative copyright framework, the balancing imperative has been lost inasmuch as today’s copyright has been increasingly expanding under the auspices of the governments of developed economies while the public domain has been rapidly shrinking and virtually neglected²⁹. Even the Papacy has taken notice of the fact that “[o]n the part of rich countries there is excessive zeal for protecting knowledge through an unduly rigid assertion of the right to intellectual property....³⁰” This imbalance did not develop overnight. It has been the product of deliberate efforts to influence policy.

The inherent power of copyright holders and the seeming complacency of copyright users, or the public in general, are historical. As may be gleaned

²⁸ Boyle, *supra* note 6, at p. 52

²⁹ Laura N. Gasaway, “A Defense of the Public Domain: A Scholarly Essay” 101 *Law Libr. J.* 451 (2009)

³⁰ *Caritas In Veritate*, Encyclical Letter of the Supreme Pontiff Benedict XVI to the Bishops, Priests and Deacons, Men and Women Religious, the Lay Faithful and all People of Good Will On Integral Human Development In Charity And Truth, penultimate sentence, at par. 22, available at http://www.vatican.va/holy_father/benedict_xvi/encyclicals/documents/hf_ben-xvi_enc_20090629_caritas-in-veritate_en.html accessed on May 3, 2010

from the beginnings of copyright, copyright is a story “not about authors and their creative works, but about interest groups and their struggle for control of new technological innovations.”³¹ Paul Goldstein has boldly described the vested economic interests behind the invention of the concept of copyright:

Copyright was technology's child from the start. There was no need for copyright before the printing press. But as movable type brought literature within the reach of everyone, as the preference of a few royal, aristocratic or simply wealthy patrons were supplanted by the accumulated demands of mass consumers, a legal mechanism was needed to connect consumers to authors and publishers commercially. Copyright was the answer. Centuries later, photographs, sound recordings, motion pictures, videocassette recorders, compact discs, and digital computers have dramatically expanded the markets for mechanically reproduced entertainment and information and *increased copyright's function in ordering these markets.*³²

There is thus nothing to be surprised about how copyright owners (generally referring to the big media companies to whom authors' assign the economic rights to their works, and who are the equivalents of the booksellers of old) react to every technological development that comes along and threatens their existing business models. How the legal system adapts to technological advances is itself a topic that has been analyzed. For example, it has been observed that there are three typical stages that describe how the legal system accommodates new technologies. The first stage points to the presence of a disequilibrium, the second stage describes the process of adaptation and adjustment and finally a stage that involves legislative consolidation.³³ In the early stages, the copyright holders may lose some ground in the emergence of “disruptive and radical technologies”³⁴ but with their organization and financial strength eventually regain the lost ground through legislative consolidation. One can however say that the copyright holders are capable of preempting or fast-tracking the cycle through lobbying. For example, it was observed that the Digital Millennium Copyright Act which among others things criminalized circumvention of

³¹ Brian D. Johnston, “Rethinking Copyright's Treatment of New Technology: Strategic Obsolescence as A Catalyst for Interest Group Compromise” 64 N.Y.U. Ann. Surv. Am. L. 165 2008-2009

³² Paul Goldstein, *Copyright's Highway: From Gutenberg To The Celestial Jukebox* (First edition, 1994) Hill and Wang, pp 27-28

³³ Robert P. Merges, “One Hundred Years Of Solicitude: Intellectual Property Law (Symposium of the Law in the Twentieth Century) 1900-2000, 88 Cal. L. Rev. 2187

³⁴ Michael A. Carrier, *Innovation for the 21st Century: Harnessing the Power of Intellectual Property and Antitrust Law*, OUP (2009), at pp 26-27 (“Disruptive innovations displace existing business models by creating simpler, more convenient, and cheaper products that appear to new or less demanding customers. Radical innovations represent technological breakthroughs that are completely different from existing products and often render them obsolete. The concept of radical innovation is often linked to disruptive innovation. While the two often overlap they differ in their focus. Radical refers to the size of the innovation while disruptive refers to the size of the impact.”)

technological protection measures fell outside of this adaptation model because the law has been hurriedly legislated in less than ten years from the invention of the Internet.³⁵ Supporters of copyright liberties and public domain activists have mourned the death of fair use as a result of this law – a law that shrunk the public domain further.

Notwithstanding the fact that portions of the public domain have been lost in contemporary copyright battles, it appears that the warriors for the public domain are reconsolidating to reclaim what has been lost in the battles and eventually win the copyright wars. The explosion of the Internet has awakened the erstwhile scattered interests that suffered from a collective action problem. They will not surrender the Internet, the ultimate battle ground. They claim a birth right or even a human right to the use of the Internet³⁶, a technology that was designed to be open and free for everyone to use, cannot be expropriated by a few individuals who could lock others from using cultural content that belongs to the public domain.

So, at a time when everyone thought the public domain has been forgotten, came several visionaries who continued the fight for user rights. Scholars who are credited for catapulting the public domain into recent discourse through their works include David Lange in 1981 and Jessica Litman in 1990³⁷. A movement³⁸ similar to the environmental movement of the seventies has also been mobilized to stop the advance and expansion of copyright and restore the balance between copyright and the public domain. This movement, James Boyle asserts, does not introduce any radical idea but merely requires a return to the rational roots of intellectual property. He

³⁵ Merges, *supra* note 32

³⁶ This could probably be hoisted more convincingly by digital natives who have been born to a wired and interconnected world.

³⁷ David Lange, “Recognizing the Public Domain”, 44 *Law & Contemp. Probs.* 147 (1981); Jessica Litman, “The Public Domain”, 39 *Emory L.J.* 965 (1990)

³⁸ The cultural environmental movement is attributed to Boyle, an idea he broached in his book *Shamans, Software, and Spleens: Law and the Construction of the Information Society* (Cambridge, Mass.: Harvard University Press, 1996). (See also Boyle’s *The Public Domain* at p. 241-242: “To end this process we need a cultural environmentalism, an environmentalism of the mind, and over the last ten years we have actually begun to build one. Cultural environmentalism is an idea, an intellectual and practical movement, that is intended to be a solution to a set of political and theoretical problems—an imbalance in the way we make intellectual property policy, a legal regime that has adapted poorly to the transformation that technology has produced in the scope of law, and, perhaps most importantly, a set of mental models, economic nostrums, and property theories that each have a public domain-shaped hole at their center. The comparison I drew between the history of environmentalism and the state of intellectual property policy had a number of facets. The environmental movement had “invented” the concept of the environment and used it to tie together a set of phenomena that would otherwise seem very separate. In doing so, it changed perceptions of self-interest and helped to form coalitions where none had existed before—just as earth science built upon research into the fragile interconnections of ecology and on the Pigouvian analysis of economic externalities. I argue that we need to make visible the invisible contributions of the public domain, the “ecosystem services” performed by the underappreciated but nevertheless vital reservoir of freedom in culture and science. And, just as with environmentalism, we need not only a semantic reorganization, or a set of conceptual and analytic tools, but a movement of people devoted to bringing a goal to the attention of their fellow citizens.”)

reiterates the fact that “even the *droits d’auteur* tradition was built around the assumption that there were social and temporal limitations on the author’s claims; natural right did not mean absolute right” and ends with a witty observation that “neither Macaulay and Jefferson, nor Le Chapelier and Rousseau” would recognize their ideas in the copyright policy that exists today.³⁹

It is thus apt to state that the hyperbole of a raging war does not actually capture the essence of the movement. Winning a war conjures images of enemies captured in submission. The movement towards reclaiming or even simply “recognizing” (to use David Lange’s concept) the public domain actually offers a truce that could eventually lead to a balanced copyright regime where optimal levels of incentives are given to copyright owners while protecting the cultural ecosystem from further degradation, erosion and denudation (again, using a powerful hyperbole to emphasize the gravity of the situation).

2.4 The Future

The future of a peaceful co-existence between interest groups in copyright law and interests in the public domain depends on solving or remedying today’s most pressing copyright issues.

The first issue is how to properly build fences (i.e. fences that cannot be moved by the copyright industry every now and then to suit their interests) particularly in the digital environment. In the US, the DMCA’s anti-circumvention measures is singled out as impacting on users’ ability to control digital products practically denying them certain legal and productive uses -- a situation earlier described as the “death of fair use’ in the digital environment. In the EU⁴⁰, similar provisions have been embedded in the Infosoc Directive⁴¹ plus a more restrictive and exhaustive copyright limitations and exceptions clause that practically locks out the flexibility of Member States to tailor specific exceptions to support knowledge creation and culture.⁴² The EU regime of high protection for copyright is clearly expressed in its preamble:

³⁹ James Boyle, “A Manifesto on WIPO and the Future of Intellectual Property”, 2004 Duke L. & Tech. Rev. 0009, available at <http://www.law.duke.edu/journals/dltr/articles/2004dltr0009.html> accessed on March 10, 2010

⁴⁰ Apart from EU, the following countries have also enacted DMCA-type provisions: Canada, India, Japan and Taiwan (See, Ross Dannenberg and David Gerk, “DMCA Copyright Protection: Uniquely American or Common and Uniform Abroad?,” *Intellectual Property and Technology Law Journal*, Vol. 21., No. 5, May 2009

⁴¹ Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society, *Official Journal L 167*, 22/06/2001 P. 0010 - 0019

⁴² Guiseppe Mazziotti, *EU Digital Copyright Law and the End-User*, Springer (2008) at p. 119

(9) Any harmonisation of copyright and related rights must *take as a basis a high level of protection*, since such rights are crucial to intellectual creation. Their protection helps to ensure the maintenance and development of creativity in the interests of authors, performers, producers, consumers, culture, industry and the public at large. Intellectual property has therefore been recognised as an integral part of property.⁴³

No one could doubt that using the words “high level of protection” as the *raison d’être* of copyright legislation even if the interest of the “public at large” is factored into the equation obviously does not add up to a sum we could call a “balanced copyright law”. Effectively, no one would disagree that we truly live in a permission culture where one pays for every use of cultural goods in the face of the inutility or sterility of fair use, fair dealing or other similar exceptions to copyright in the digital environment.

The second issue is how to resolve the appropriate and optimal copyright term so that it does not suffer from pejoratives like “perpetual copyright on an installment plan”⁴⁴ and so that it rationalizes the term issue by cutting the periods at reasonable levels or at least prevents the further extension of existing copyright terms to more “unobscene” levels. *Eldred v Ashcroft*⁴⁵ may signal that the public domain activists have lost this particular battle inasmuch as the *Eldred* ruling was sustained in an attempt to attack it collaterally via *Kahle v Gonzales*⁴⁶. If it is any consolation, Justice Breyer’s dissent in the case at least reechoes the thoughts of Macaulay and Le Chapelier that extending copyrights relegates a vast body of knowledge to “a kind of intellectual purgatory from which it will not easily emerge.”⁴⁷ Breyer was referring to the orphans works.

In the US where most of the public domain protection movement is concentrated, convincing Congress to revive a Public Domain Enhancement Act would certainly lead to a more balanced copyright regime. Even developing countries have joined the movement with the Chilean Proposal Supporting the Public Domain⁴⁸.

⁴³ Directive 2001/29/EC, *supra* note 41

⁴⁴ Peter Jaszi, “Caught in the Net of Copyright”, 75 Or. L. Rev. 299, 303 (1996); also see Eva Hemmungs Wirtén, *Terms of Use: Negotiating the Jungle of the Intellectual Commons*, University of Toronto Press (2008), p.129; Professor Jaszi is said to have stated: “Under the authority of this case, Congress can now continue the practice of extending the term of subsisting copyrights without limit. It can thus achieve a perpetual copyright term on the installment plan.” (Statement of Professor Peter Jaszi, *The Copyright Term Extension Act of 1995, Hearings on S.483 Before the Senate Judiciary Comm.*, 104th Cong. (1995), available at 1995 WL 10524355, at *6)

⁴⁵ *Eldred v. Ashcroft*, 537 U.S. 186 (2003)

⁴⁶ *Kahle v. Gonzales*, 487 F.3d 697, 700 (9th Cir. 2007)

⁴⁷ Wirtén, *supra* note 43, at p. 133; Professor Lawrence Lessig, for his part, describes it as the “copyright black hole”. (See Lawrence Lessig, *The future of ideas : the fate of the commons in a connected world* , Random House (2001) at p. 251

⁴⁸ Gasaway, *supra* note 29

The challenge has also been put against the WIPO to take an active role in the resolution of these issues. The future thus also depends on how WIPO rises up to this challenge, for example, on how WIPO acts on particular recommendations of Union Members like the following⁴⁹:

16. Consider the *preservation of the public domain* within WIPO's normative processes and deepen the analysis of the implications and benefits of a *rich and accessible public domain*.

20. To promote norm-setting activities related to IP that support a *robust public domain* in WIPO's Member States, including the possibility of preparing guidelines which could assist interested Member States in identifying subject matters that have fallen into the public domain within their respective jurisdictions.

21. WIPO shall conduct *informal, open and balanced consultations*, as appropriate, prior to any new norm-setting activities, through a member-driven process, promoting the participation of experts from Member States, particularly developing countries and LDCs.

35. To request WIPO to undertake, upon request of Member States, *new studies to assess the economic, social and cultural impact of the use of intellectual property systems* in these States.

2.5 Balancing of Two Public Interests

It has been explained above that the future of copyright, a future of peaceful co-existence with the public domain, depends on a balancing of the interests of the copyright owner and the public, as the user of the copyright. In this respect, it would be erroneous to state that the copyright owner's interest is a private interest while the users' interest is a public interest. In principle, both interests are clothed with public interest. The proper view then is that the ultimate copyright objective is to balance the *public interest to encourage innovation* and creativity by providing exclusive rights to the copyright owner that ensures just rewards for his or her efforts vis-à-vis the *public interest for access to knowledge*, information and cultural products.⁵⁰ How such balance will be achieved is complex and may require the invocation of historical, philosophical, legal arguments, or even involve political compromises. Of late, however, a number of scholars have started looking at the human rights perspective to inform the debate.

Arguments for a balancing of competing public interests (or even rights) turns out to be a gentler way of "reclaiming" the public domain from the

⁴⁹ The 45 Adopted Recommendations under the WIPO Development Agenda
<http://www.wipo.int/ip-development/en/agenda/recommendations.html#b> March 10, 2010

⁵⁰ Robin Wright, "The Three-Step Test and the Wider Public Interest: Towards a More Inclusive Interpretation", *The Journal of World Intellectual Property*, Volume 12, Number 6, November 2009 at p. 600

unfettered expansion of copyright law. A movement for public domain could be construed as zero-sum game that further polarizes the debate. On the other hand, defining one's movement as one geared towards a balanced copyright regime pushes copyright reform without threatening the existence of copyright itself.

A workable balance will automatically grow the public domain and enhance creative culture in a world inhabited by digital natives. The public domain will grow from a proper implementation of the following fundamentals:

1. The idea-expression dichotomy⁵¹
2. A holistic interpretation of the 3-step test⁵² in relation to a paradigm shift in user rights
3. An optimally determined copyright term⁵³
4. A prohibition against term extensions, or if such extension is unavoidable on grounds of competitiveness, a prohibition against retroactive effect of such extension⁵⁴
5. A clearly defined right to abandon copyright or dedicate a work to the public domain at anytime; as well as recognition of alternative copyright regimes.

Irrespective of the nomenclature, one overriding principle should be recognized – that copyright is merely a statutory right⁵⁵ and is therefore subject to the *wider* public interest on access to knowledge and culture, and human rights in so far as the invoked rights fall into the umbrella of rights protected under the human rights conventions.

We thus turn to an examination of the role of human rights in this debate.

⁵¹ See Boyle, *supra* note 6, at p. 49 (“Both overtly and covertly, the commons of facts and ideas is being enclosed. Patents are increasingly stretched to cover “ideas” that twenty years ago all scholars would have agreed were unpatentable. Most troubling of all are the attempts to introduce intellectual property rights over mere compilations of facts.”)

⁵² Arguments in favor of reforming or refocusing the interpretation of the 3-step test has been written about lately. See for example, Christophe Geiger, “The Role of the Three Step Test in the Adaptation of Copyright Law to the Information Society”, e-Copyright Bulletin, January-March 2007, UNESCO available at http://portal.unesco.org/culture/en/files/34481/11883823381test_trois_etapes_en.pdf/test_trois_etapes_en.pdf accessed on March 10, 2010; Edward L. Carter, “Harmonization of Copyright Law in Response to Technological Change: Lessons from Europe about Fair Use and Free Expression, 30 U. La Verne L. Rev. 312 (2009), Jonathan Griffiths, “The Three-Step Test in European Copyright Law – Problems and Solutions, I.P.Q. 2009 4, 428-457

⁵³ See Boyle, *supra* note 6, at p 217 (He submits that calculations on what is optimal in copyright cannot be based on faith alone. He calls it a faith-based policy in an evidence-free zone.)

⁵⁴ Arguments against term extensions are discussed in Justice Steven Breyer’s dissent in the *Eldred v. Ashcroft* available at <http://www.law.cornell.edu/supct/html/01-618.ZD1.html> accessed on March 11, 2010; See also the Transcript of Oral Argument in *Eldred v. Ashcroft* at http://www.supremecourtus.gov/oral_arguments/argument_transcripts/01-618.pdf and at http://www.oyez.org/cases/2000-2009/2002/2002_01_618/argument/ accessed on March 11, 2010

⁵⁵ Except copyright that qualifies as human rights pursuant to General Comment No. 17 (as discussed in the next section)

3 The Role of Human Rights in Protecting the Public Domain

3.1 Human Rights as Fundamental Rights

Numerous scholarly articles have been written prescribing or at the very least suggesting ways by which the public domain could regain its rightful place in the delicate balance with copyright and thereupon formulate a theory that unifies or reconciles the conflict. Solutions vary from a rethink of the copyright-public domain balance from a legal-historical and legal-philosophical perspective to a law and economics perspective, or even probably from a Rawlsian perspective. Of late however there have been some scholars who have looked at a possible role for human rights law in this respect⁵⁶.

The basic argument of those that rely on human rights as a unifying framework lies in the fact that human rights represent fundamental rights, rights that belong to every human being⁵⁷, which every civilized nation ought to recognize. These rights provide the fundamentals of social relations that encompass even the property rights used to justify the protection of copyright. Importantly, the normative content of these human rights have been laid down in several international treaties.

3.1.1 The Universal Declaration of Human Rights

The UDHR was the first major international instrument that highlighted the importance of human rights. It continues to serve as the guide for all other international and regional instruments in human rights and as a model for national constitutions and laws.⁵⁸ Since the essence of the declaration have been incorporated and codified in many national and international instruments, there is reason to hope that the present woes that have visited copyright law may find a framework upon which a solution may be based or formulated. The primary article of relevance in relation to copyright and the public domain is Art. 27 which states:

⁵⁶ For example, Lawrence Helfer, Peter Yu and Christophe Geiger whose works are cited in this paper.

⁵⁷ A M Bolin Pennegard, "Overview Over Human Rights – the Regime of the UN, in Gudmundur Alfredsson, et al., eds, *International Human Rights Monitoring Mechanisms, Essays in Honor of Jakob Th. Moller*, Kluwer (2001), p. 32

⁵⁸ *Ibid.*, at pp. 32-33

Article 27

1. Everyone has the right freely to participate in the cultural life of the community, to enjoy the arts and to share in scientific advancement and its benefits.
2. Everyone has the right to the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author.

Leaving semantics aside, the above quoted provision virtually reproduces the two-sides of the current copyright wars. Those who root for the protection of the public domain are fundamentally aligned with those who want to exercise their *right freely to participate in the cultural life of the community, to enjoy the arts and to share in scientific advancement and its benefits* while those who argue for maintaining a high level protection for copyright take solace from the express recognition of the authors' *right to the protection of the moral and material interests resulting from any scientific, literary or artistic production*.

But do these provisions provide a way out to the current problem on copyright balance when Article 27 itself plainly presents a problem of balancing between its two paragraphs? It does not seem to be a source of clarity in itself without carefully defining the normative content of those rights as set out in the subsequent treaties – the International Covenant on Economic, Social and Cultural Rights (ICESCR) and the International Covenant on Civil and Political Rights (ICCPR).

3.1.2 The Covenants

That human rights (which are supposed to be fundamental, inalienable and universal) found its way in two separate international treaties instead of one ideal and holistic treaty that could have merely expounded on the UDHR may have affected the normative force of the individual rights. What matters though is that notwithstanding the apparent distinction between civil and political rights on the one hand and economic, social and cultural rights on the other, emphasis has been placed on the mutually reinforcing nature of these interrelated rights⁵⁹.

Under this dichotomous regime, the human right declared under Art. 27 of the UDHR became Art. 15 (1) (a) to (c) of the ICESCR, and now reads:

1. The States Parties to the present Covenant recognize the right of everyone: (a) To take part in cultural life; (b) To enjoy the benefits of scientific progress and its applications; (c) To benefit from the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author.

⁵⁹ Ibid., at p. 35

It should also be emphasized that, as noted above, the human rights defined under this article do not stand alone but reinforce the other human rights. Some of the rights that are interrelated to the above rights include the following:

Right to education

Article 13 (ICESCR)

1. The States Parties to the present Covenant recognize the right of everyone to education. They agree that education shall be directed to the full development of the human personality and the sense of its dignity, and shall strengthen the respect for human rights and fundamental freedoms. They further agree that education shall enable all persons to participate effectively in a free society, promote understanding, tolerance and friendship among all nations and all racial, ethnic or religious groups, and further the activities of the United Nations for the maintenance of peace.

Right to privacy

Article 17 (ICCPR)

1. No one shall be subjected to arbitrary or unlawful interference with his privacy, family, home or correspondence, nor to unlawful attacks on his honour and reputation.
2. Everyone has the right to the protection of the law against such interference or attacks.

Right to freedom of thought.

Article 18 (ICCPR)

1. Everyone shall have the right to freedom of thought, conscience and religion. This right shall include freedom to have or to adopt a religion or belief of his choice, and freedom, either individually or in community with others and in public or private, to manifest his religion or belief in worship, observance, practice and teaching.
2. No one shall be subject to coercion which would impair his freedom to have or to adopt a religion or belief of his choice.
3. Freedom to manifest one's religion or beliefs may be subject only to such limitations as are prescribed by law and are necessary to protect public safety, order, health, or morals or the fundamental rights and freedoms of others.
4. The States Parties to the present Covenant undertake to have respect for the liberty of parents and, when applicable, legal guardians to ensure the religious and moral education of their children in conformity with their own convictions.

Right to freedom of expression

Article 19 (ICCPR)

1. Everyone shall have the right to hold opinions without interference.
2. Everyone shall have the right to freedom of expression; this right shall include freedom to seek, receive and impart information and ideas of all kinds, regardless of frontiers, either orally, in writing or in print, in the form of art, or through any other media of his choice.

Right to practice own culture and language

Article 27 (ICCPR)

In those States in which ethnic, religious or linguistic minorities exist, persons belonging to such minorities shall not be denied the right, in community with the other members of their group, to enjoy their own culture, to profess and practise their own religion, or to use their own language.

The interrelationship and interdependence of these rights thus assume the need for a balanced interpretation of the application of the said rights relative to the others.

3.1.3 Human Rights in Europe

3.1.3.1 The European Convention for the Protection of Human Rights

In addition to the Covenants, there are also regional human rights documents. In Europe, human rights are institutionalized in the European Convention on Human Rights of 1950. The Convention created the European Court of Human Rights (ECtHR) – a working example of a regional human rights mechanism. The rights guaranteed in the ECHR however include only the classic civil and political rights such as the right to life, freedom from torture, liberty, fair trial, right to private and family life, property and possessions, freedom of thought and religion expression and association which were drawn from the UDHR.⁶⁰

There is thus no provision equivalent to Article 15 of the ICESCR that would cover copyright. Instead, copyright-related issues are governed by the right to property defined under Art. 1, Protocol 1 of the Convention which states:

Article 1, Protocol 1

Every natural or legal person is entitled to the peaceful enjoyment of his possessions. No one shall be deprived of his possessions except in the public interest and subject to the conditions provided for by law and by the general principles of international law.

⁶⁰ Kevin Boyle, “The European Experience: The European Convention on Human Rights”, 40 Victoria U. Wellington L. Rev. 168 (2009), p. 170

The preceding provisions shall not, however, in any way impair the right of a State to enforce such laws as it deems necessary to control the use of property in accordance with the general interest or to secure the payment of taxes or other contributions or penalties.

3.1.3.2 EU Charter of Fundamental Rights

With the coming into effect of the Lisbon Treaty in December 1, 2009, another human rights instrument that will gain importance in Europe (although it had been long part of ECJ's *jurisprudence constante* as part of its general principles of law) is the EU Charter of Fundamental Rights. The Charter is all-encompassing as it defines the political, social, and economic and cultural rights of the peoples of the European Union -- citizens and residents alike⁶¹ but it "is not a mine of new human rights."⁶²

In this regime, intellectual property (e.g. copyright) are expressly recognized as falling within the catalog of property rights as defined by Article 17 of the Charter:

Right to property

1. Everyone has the right to own, use, dispose of and bequeath his or her lawfully acquired possessions. No one may be deprived of his or her possessions, except in the public interest and in the cases and under the conditions provided for by law, subject to fair compensation being paid in good time for their loss. The use of property may be regulated by law in so far as is necessary for the general interest.
2. ***Intellectual property shall be protected.***

Relying on the mutual reinforcement principle of human rights, the above provision, (particularly sub-article 2, although, from a textual reading thereof, appearing to be not subject to the limitations stated in sub-article 1), needs to be balanced⁶³ with the other provisions of the Charter such as the following.

Article 11 (Freedom of expression and information)

⁶¹ "The peoples of Europe, in creating an ever closer union among them, are resolved to share a peaceful future based on common values." 1st recital of the Preamble, Charter of Fundamental Rights

⁶² Eve Chava Landau, "A New Regime of Human Rights in the EU", 10 Eur. J.L. Reform 557 (2008) at p. 562 citing Lord Goldsmith, "The Charter of Human Rights - A Brake Not an Accelerator" 5 European Human Rights Law Review 473 (2004).

⁶³ See on this point Christophe Geiger, "Intellectual Property Shall Be Protected!? Article 17(2) Of The Charter Of Fundamental Rights Of The European Union: A Mysterious Provision With An Unclear Scope", *E.I.P.R.* 2009, 31(3), pp. 113-117

1. Everyone has the right to freedom of expression. This right shall include freedom to hold opinions and to receive and impart information and ideas without interference by public authority and regardless of frontiers.
2. The freedom and pluralism of the media shall be respected.

Article 14 (Right to education)

1. Everyone has the right to education and to have access to vocational and continuing training.

Article 22 (Cultural, religious and linguistic diversity)

The Union shall respect cultural, religious and linguistic diversity.

Article 25 (The rights of the elderly)

The Union recognises and respects the rights of the elderly to lead a life of dignity and independence and to participate in social and cultural life.

Article 26 (Integration of persons with disabilities)

The Union recognises and respects the right of persons with disabilities to benefit from measures designed to ensure their independence, social and occupational integration and participation in the life of the community.

3.2 Human Rights Perspectives in Copyright

As mentioned at the beginning of this section, a human rights perspective in copyright law (and in intellectual property law, in general) is a viable option that policy makers may rely upon in order to reconstruct the unease and turbulence in copyright policy making. That perspective is guided by two important UN instruments that define the normative principles for exercising the aforesaid human rights. These instruments are:

1. General Comment No. 17, “The right of everyone to benefit from the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he or she is the author (article 15, paragraph 1 (c), of the Covenant)”⁶⁴, and

⁶⁴ General Comment No. 17 was issued by the Committee on Economic, Social and Cultural Rights during the Thirty-fifth session, Geneva, 7-25 November 2005, 12 January 2006 available at <http://www2.ohchr.org/english/bodies/cescr/comments.htm>

2. General comment No. 21 – “Right of everyone to take part in cultural life” (art. 15, par. 1 (a), of the International Covenant on Economic, Social and Cultural Rights)⁶⁵.

General Comment 17’s basic premise is that copyright, as well as other forms of intellectual property, that fall within the Comment’s normative definition is a human right. On the other hand, General Comment 21’s plain message is that right to take part in cultural life, an activity that takes on more meaning through a robust public domain, is a human right.

3.2.1 Copyright as a Human Right: The Normative Content of General Comment 17

At the very outset of General Comment 17, the Committee makes clear the message that it is “important not to equate intellectual property rights with the human right recognized in article 15, paragraph 1 (c)⁶⁶.” Before coming to that very important conclusion, it clearly makes a distinction between intellectual property as it currently exists in international treaties and individual legislation of states:

In contrast to human rights, intellectual property rights are generally of a *temporary nature*, and can be revoked, licensed or assigned to someone else. While under most intellectual property systems, intellectual property rights, often with the exception of moral rights, may be allocated, *limited in time and scope*, traded, amended and even forfeited, human rights are timeless expressions of fundamental entitlements of the human person. Whereas the human right to benefit from the protection of the moral and material interests resulting from one’s scientific, literary and artistic productions safeguards the personal link between authors and their creations and between peoples, communities, or other groups and their collective cultural heritage, as well as their basic material interests which are necessary to enable authors to enjoy an adequate standard of living, intellectual property regimes primarily protect business and corporate interests and investments. Moreover, the scope of protection of the *moral and material interests of the author provided for by article 15, paragraph 1 (c)*, does not necessarily coincide with what is referred to as *intellectual property rights under national legislation or international agreements*.⁶⁷

⁶⁵ General Comment No. 21 was issued by the Committee on Economic, Social and Cultural Rights during its Forty-third session, 2–20 November 2009, 21 December 2009 available at <http://www2.ohchr.org/english/bodies/cescr/comments.htm>

⁶⁶ General Comment 17, *supra* note 63, at par. 3

⁶⁷ *Ibid.*, par. 2

The Committee likewise asserts that “[u]nder the existing international treaty protection regimes, legal entities are included among the holders of intellectual property rights” but that “their entitlements, because of their different nature, are not protected at the level of human rights”⁶⁸. This plain statement should assuage the fear that human rights could be used by multinational media companies to ratchet up intellectual property through human rights rhetoric⁶⁹. Additionally, it explains that “the protection under article 15, paragraph 1 (c), need not necessarily reflect the level and means of protection found in present copyright, patent and other intellectual property regimes, as long as the protection available is suited to secure for authors the moral and material interests resulting from their productions...”⁷⁰ and that such material interests “need not extend over the entire lifespan of an author” because “the purpose of enabling authors to enjoy an adequate standard of living can also be achieved through one-time payments or by vesting an author, *for a limited period of time*, with the exclusive right to exploit his scientific, literary or artistic production⁷¹” practically expressing the precise limitation for the exercise of this human right even if it exhibits close linkage to the right to property as recognized in Article 17 of the UDHR⁷².

Perhaps equally important as the normative content of the Comment is its guidance on how to treat this right in relation to the other human rights. The Committee stressed that the right is linked to the other rights and that they are mutually reinforcing and reciprocally limited. It is this caveat that should be taken to heart by policy-makers in trying to balance the different rights as they tend to conflict with one another in the face of scarcity of resources. The Committee then goes to the extent of even spelling out for the State Parties specific instances (see underscored text) on how the balance should be managed:

35. The right of authors to benefit from the protection of the moral and material interests resulting from their scientific, literary and artistic productions cannot be isolated from the other rights

⁶⁸ Ibid., par 7; At the European courts, however, Article 1 of Protocol No. 1 appears to clothe corporations with “human” rights pursuant to the ECtHR holding that Article 1 protects both registered marks and trademark applications of a multinational corporation. (See *Anheuser-Busch, Inc. v. Portugal*, No. 73049/01 (Eur. Ct. H.R. Jan. 11, 2007) (Grand Chamber))

⁶⁹ Professor Peter Yu raises this as a real concern and poses the question “Will the Human Rights Ratchet up Existing Intellectual Property Protection?” (See Peter Yu, “Ten Common Questions About Intellectual Property and Human Rights”, 23 *Georgia State University Law Review* 709-753 (2007) at p. 738 citing Kal Raustiala’s statement that “the embrace of [intellectual property] by human rights advocates and entities . . . is likely to further entrench some dangerous ideas about property: in particular, that property rights as human rights ought to be inviolable and ought to receive extremely solicitous attention from the international community.”); See also Peter K. Yu, “Reconceptualizing Intellectual Property Interests in a Human Rights Framework”, 40 *U.C. Davis L. Rev.* 1039, at pp. 1124-1125

⁷⁰ General Comment 17, *supra* note 63, at par. 10

⁷¹ Ibid., at par. 16

⁷² Ibid., at par. 15

recognized in the Covenant. States parties are therefore obliged to *strike an adequate balance between their obligations under article 15, paragraph 1 (c), on one hand, and under the other provisions of the Covenant, on the other hand*, with a view to promoting and protecting the full range of rights guaranteed in the Covenant. In striking this balance, *the private interests of authors should not be unduly favoured and the public interest in enjoying broad access to their productions should be given due consideration*. States parties should therefore ensure that their legal or other regimes for the protection of the moral and material interests resulting from one's scientific, literary or artistic productions constitute no impediment to their ability to comply with their core obligations in relation to the rights to food, health and education, as well as to take part in cultural life and to enjoy the benefits of scientific progress and its applications, or any other right enshrined in the Covenant. *Ultimately, intellectual property is a social product and has a social function*. States parties thus have a duty to prevent unreasonably high costs for access to essential medicines, plant seeds or other means of food production, or for schoolbooks and learning materials, from undermining the rights of large segments of the population to health, food and education. Moreover, States parties should prevent the use of scientific and technical progress for purposes contrary to human rights and dignity, including the rights to life, health and privacy, e.g. by excluding inventions from patentability whenever their commercialization would jeopardize the full realization of these rights. States parties should, in particular, consider to what extent the patenting of the human body and its parts would affect their obligations under the Covenant or under other relevant international human rights instruments. States parties should also consider *undertaking human rights impact assessments prior to the adoption and after a period of implementation of legislation for the protection of the moral and material interests resulting from one's scientific, literary or artistic productions*.⁷³

3.2.2 The Public Domain⁷⁴ as a Human Right: The Normative Content of General Comment 21

With the issuance of General Comment 21, a more holistic view of the three-pronged Article 15 of ICESCR finds fruition. The document carries with it the usual format for stating the normative content of the right and the State's obligation to respect, protect and fulfill the right of everyone to take part in cultural life. But General Comment 21 takes a step further by a

⁷³ Ibid., at par. 35

⁷⁴ The right to participate in cultural activities is being characterized here as equivalent to a right to the public domain inasmuch as the effective exercise of such right depends on a recognition of such public domain.

powerful rewording of the section about the obligations of actors other than States from one that merely urges the State parties “to consider regulating the responsibility resting on the private business sector, private research institutions and other non-State actors to respect the rights recognized in article 15, paragraph 1 (c), of the Covenant”⁷⁵ to one that directly places upon civil society the obligation to respect, protect and fulfill the rights defined therein as well as a virtual admonition to be pro-active in its implementation, *viz.*:

Obligations of actors other than States

73. While compliance with the Covenant is mainly the responsibility of States parties, all members of civil society — individuals, groups, communities, minorities, indigenous peoples, religious bodies, private organizations, business and civil society in general — also have responsibilities in relation to the effective implementation of the right of everyone to take part in cultural life. *States parties should regulate the responsibility incumbent upon the corporate sector and other non-State actors with regard to the respect for this right.*

74. Communities and cultural associations play a fundamental role in the promotion of the right of everyone to take part in cultural life at the local and national levels, and in cooperating with States parties in the implementation of their obligations under article 15, paragraph 1 (a).

Notably, the Comment commands in paragraph 73 that “States parties should regulate the responsibility incumbent upon the corporate sector and other non-State actors with regard to the respect for this right” as though the core obligations were still not enough.

There is therefore no doubt that the normative content of this Comment bodes well for the rebirth of the public domain as it appears to lay down the people’s right to culture thought to be inhibited or locked up by the culture of permission that is being sowed by, and institutionalized through the practices of, the powerful copyright industry. Interestingly, the Comment frames the right to take part in cultural right not only as a social and cultural right but as a freedom. Without doing away with the formulaic respect-protect-fulfill obligation of the State Parties, the Comment appears to simplify those obligations stating that:

6. The right to take part in cultural life can be characterised as a freedom. In order for this right to be ensured, it requires from the State party both abstention (i.e., non-interference with the exercise of cultural practices and with access to cultural goods and services) and positive action (ensuring preconditions for participation, facilitation

⁷⁵ See General Comment 17, *supra* note 63, at par. 55

and promotion of cultural life, and access to and preservation of cultural goods).

Again, the interdependence of all human rights and freedoms and the consequent need to balance them have been impressed in the Comment⁷⁶. This notwithstanding, the Comment shows to have been clearly cognizant of the fact that the said right and freedom is prone to or presently suffer from issues of inequality and discrimination. There is thus no better way to truly give meaning to this right and freedom than to spell out how the said right and freedom could be enjoyed by specific persons and communities⁷⁷ as they had been so protected under existing international instruments, such as:

- the right to equal participation in cultural activities;⁷⁸
- the right to participate in all aspects of social and cultural life;⁷⁹
- the right to participate fully in cultural and artistic life;⁸⁰
- the right of access to and participation in cultural life;⁸¹ and
- the right to take part on an equal basis with others in cultural life.⁸²
- the rights of persons belonging to minorities to enjoy their own culture, to profess and practise their own religion, and to use their own language, in private and in public,⁸³ and to participate effectively in cultural life,⁸⁴ on
- the rights of indigenous peoples to their cultural institutions, ancestral lands, natural resources and traditional knowledge,⁸⁵ and

⁷⁶ Paragraph 2 of the Comment states: “2. The right of everyone to take part in cultural life is closely related to the other cultural rights contained in article 15: the right to enjoy the benefits of scientific progress and its applications (art. 15, par. 1 (b)); the right of everyone to benefit from the protection of moral and material interests resulting from any scientific, literary or artistic production of which they are the author (art. 15, para. 1 (c)); and the right to freedom indispensable for scientific research and creative activity (art. 15, para. 3). The right of everyone to take part in cultural life is also intrinsically linked to the right to education (arts. 13 and 14), through which individuals and communities pass on their values, religion, customs, language and other cultural references, and which helps to foster an atmosphere of mutual understanding and respect for cultural values. The right to take part in cultural life is also interdependent on other rights enshrined in the Covenant, including the right of all peoples to self-determination (art. 1) and the right to an adequate standard of living (art. 11). “

⁷⁷ These include women, children, the elderly, persons with disabilities, minorities, migrants, indigenous peoples and persons living in poverty

⁷⁸ International Convention on the Elimination of All Forms of Racial Discrimination, art. 5 (e) (vi).

⁷⁹ Convention on the Elimination of All Forms of Discrimination against Women, art. 13 (c).

⁸⁰ Convention on the Rights of the Child, art. 31, para. 2.

⁸¹ International Convention on the Protection of the Rights of All Migrant Workers and Members of Their Families, art. 43, para. 1 (g).

⁸² Convention on the Rights of Persons with Disabilities, art. 30, para. 1.

⁸³ International Covenant on Civil and Political Rights, art. 27.

⁸⁴ Declaration on the Rights of Persons Belonging to National or Ethnic, Religious and Linguistic Minorities, art. 2, paras. 1 and 2. See also Framework Convention for the Protection of National Minorities (Council of Europe, ETS No. 157), art. 15.

⁸⁵ United Nations Declaration on the Rights of Indigenous Peoples, in particular arts. 5, 8, and 10–13 ff. See also ILO Convention No. 169 concerning Indigenous and Tribal Peoples in Independent Countries, in particular arts. 2, 5, 7, 8, and 13–15 ff.

- the right to development⁸⁶

3.2.3 Towards A Human Rights Framework in Copyright

Now that the normative content of two of the three rights defined under Article 15 of the ICECSR has been laid down, the movement towards giving human rights a role in copyright policy making and legislation should make more headway and gain new ground. They can be fed into what Professor Lawrence Helfer⁸⁷ has coined as a human rights framework for intellectual property. The framework predicts three hypothetical futures for intellectual property –

- that human rights could be used to further expand intellectual property;
- that it could be used as a counter-balance by imposing external limits on intellectual property, and
- that human rights are to be achieved as ends through intellectual property means.

As to the first outcome, Helfer predicts its plausibility only if courts adjudicate human rights protection in favor of corporations which are for all intents and purposes representative of the intellectual property right-holders (the media companies in the case of copyright) also citing Raustiala's apprehensions. Courts will however think twice before furthering the cause of corporations to be awarded a human right to its intellectual property now that the Article 15 has been interpreted in the General Comments with sufficient clarity.

The second outcome is more depictive of the current turmoil and suggests the way to resolving the tension between the contenting interests by upholding the primacy of human rights over the non-human rights character of intellectual property⁸⁸. As earlier adverted to, General Comment 17

⁸⁶ Declaration on the Right to Development (General Assembly resolution 41/128), art. 1. In its general comment No. 4, paragraph 9, the Committee considers that rights cannot be viewed in isolation from other human rights contained in the two international Covenants and other applicable international instruments.

⁸⁷ Laurence R. Helfer, *Towards a Human Rights Framework for Intellectual Property*, 40 U.C. Davis L. Rev. 971-1020 (2007) at 1014-1020

⁸⁸ The principle of human rights primacy is articulated in *Intellectual Property Rights and Human Rights*, Sub-Comm'n on Human Rights Res. 2000/7, par.3, U.N. Doc. E/CN.4/Sub.2/RES/2000/7 (Aug. 17, 2000), available at <http://www.unhchr.ch/Huridocda/Huridoca.nsf/0/c462b62cf8a07b13c12569700046704e?Opendocument> accessed on April 24, 2010; See also Peter K. Yu, *Ten Common Questions about Intellectual Property and Human Rights*, 23 Ga. St. U. L. Rev. 709, 728-30 (2007) at p. 711-712, 739 (Professor Yu explains "As the CESCR reminded governments in its Statement on Intellectual Property Rights and Human Rights, states have duties to take into consideration their human rights obligations in the implementation of intellectual property

recognizes this tension and enshrines human rights as being at the apex of conflicting values. That primacy is however replaced by a balancing of rights only in cases where the conflicts arise between or among human rights. Helfer cites examples:

National courts in Europe are using the right to freedom of expression protected by the European Convention for precisely this purpose. 'In particular, there have been a number of decisions in the field of copyright in which the freedom of expression has been invoked to justify a use that is not covered by an exception provided for in the law.' [Christophe Geiger, *Fundamental Rights, a Safeguard for the Coherence of Intellectual Property Law?*, 35 *Int'l Rev. Intell. Prop. & Competition L.* 268, 277 (2004)]. These decisions rely on human rights law to overcome the "malfunctions" of the intellectual property system, using them as a "corrective when [intellectual property] rights are used excessively and contrary to their functions." [Geiger. at 278.] In effect, these cases reach beyond intellectual property's own safety valves--such as fair use, fair dealing, and other exceptions and limitations--to impose external limits, or maximum standards of protection, upon rights holders.⁸⁹

The third outcome is inductive in approach and may be characterized as being idealistic as it assumes a discursive understanding of the basic necessities dictated by human rights law using intellectual property rights (in this case, copyright) itself as a policy instrument. This outcome may not be at all realistic considering the completely opposing motivations of the two sides. Copyright owners, most of them big multinational companies, are driven by profit motives while those who demand the right to have access to cultural and knowledge goods rely upon certain inherent human rights that are being diluted by the said profit motive. The positions have been entrenched for centuries such that strategic action will always be expected from the copyright holders who historically have always sought to control this particular right.

That the contending rights are irreconcilable in a discursive sense should be recognized. Only by such admission may a framework that reins in the expansionist tendencies of current intellectual property rights through human rights law could truly make sense. In this regard, the second outcome discussed above appears better suited to create the desired balance and with legal certainty through the instrumentality of positive law that owes its validity and legitimacy through its consistency with human rights law.

policies and agreements and to subordinate those policies and agreements to human rights protection in the event of a conflict between the two.").

⁸⁹ Helfer, *supra* note 87

Christophe Geiger⁹⁰ puts on a note similar to that of Helfer. Theorizing that current copyright conflict stems from a crisis of the classical foundation of intellectual property law⁹¹, he believes in rebuilding a new foundation that is built around fundamental rights and human rights and strengthened by a synthesized view of the natural law and utilitarian justifications of copyright. In the case of copyright law, article 27 of the UDHR beacons the natural synthesis of the supposed conflicting rights and as discussed above presupposes the need to balance the mutually related and reinforcing rights of the creator of knowledge and cultural goods and the user of such goods. Geiger echoes Helfer's prognosis that human rights can act as external limit to the intellectual property. The need for external limits currently underlies some of the pro-user decisions⁹² in the context of competition cases at the ECJ that openly rebuffed the abusive practices of dominant firms in using copyright.

The perceived human rights' potential of putting a brake on a "runaway" intellectual property also builds on the consensus about the role of human rights in enriching the public domain through a recalibration of the 3-step test in assessing copyright limitations and exceptions. This is an important area in copyright policy that also impacts on the viability of any solution to the orphan works problem as the American orphan works legislation has shown. The legislation however has stopped cold in its tracks and official initiatives in other parts of the globe continue to be discussed.

It is thus not surprising that the private sector has taken on the issue and the affected parties are trying to go around the problem through contract. This is what Google did in its effort to launch a plainly commercial yet culture-enhancing undertaking in the Google Library, later Google Book Search Project. Google seemed to have forced a private-ordered solution to the orphan works problem.

The penultimate and final parts of the essay will analyze the orphan works problem and solutions, and then take the Google Book Search Settlement Agreement (in so far as it offers a solution to the orphans works problem) as a case example in an attempt to test the validity of the said agreement using the normative frame of article 15 1 (a) and (c) of the ICESCR.

⁹⁰ Christophe Geiger, "The Constitutional Dimension of Intellectual Property" in Paul C. Torremans, ed., *Intellectual Property and Human Rights (Enhanced Edition of Copyright and Human Rights)*, Kluwer (2008), pp. 101-131

⁹¹ The classical foundations being referred to are the natural law theory and utilitarian theory to intellectual property.

⁹² The Magill tv-listings case [Commission Decision 89/205, Magill TV Guide/ITP, BBC and RTE, 1989 O.J. (L 78) 43 (EC)] and the Microsoft interoperability case [Case T-201/04, Microsoft Corp. v. Comm'n, 2004 E.C.R. II-4463] are the examples in point.

4 The Public Domain and the Orphan Works Problem

4.1 Background

The orphan works problem is today one of the most discussed topic in the copyright field and impacts directly on the contours of copyright and the public domain. The importance of handling it properly is thus widely recognized⁹³. It is described as a serious problem that significantly affects the public interest.⁹⁴ Solving the problem is a global challenge as may be gleaned from the studies currently being undertaken in the EU as well as other major jurisdictions including the United States, United Kingdom and Australia.

The problem brought about by orphan works necessitates a balancing of interests between the holder of the copyright to the orphan work and the person who intends to use the said work. In today's culture of permission that requires a person who intends to use a copyrighted work to ask for a license, an orphan work suddenly becomes a rare phenomenon – an aberration in a copyright system that many would like to think to be functioning as it should. In this mysterious zone, one finds that there is no one to negotiate with or even if there are indications on who that person might be, the transactions might just be too much to justify pursuing it. In the present state of the law, the balance of the rights is tilted heavily in favor of the copyright owner whose work remains protected by copyright and incapable of further exploitation and utility even in his absence or nonchalance.

The search for a fair solution to the problem has been an arduous task in view of the fear that any solution would be unfair to unknown or absent copyright holders. For example, professional visual artists in the US are very vocal about their opposition to the proposed legislative solution to the problem fearing that “any image published without a credit is a potential orphan” and a law that allows exploitation of such orphaned works “could destroy their livelihood.” Ironically even among visual artists, no one seem to be sure about the way best way to address the problem with some of them believing that the passage of any proposed legislation unavoidable and that the industry's best response should be to participate in the legislative

⁹³ Lionel Bentley and Brad Sherman, *Intellectual Property Law*, Third ed. OUP, (2009), p.296

⁹⁴ Glushko Samuelson Intellectual Property Law Clinic Response to Notice Of Inquiry on the Issue of “Orphan Works”, <http://www.wcl.american.edu/ipclinic/documents/Glushko-SamuelsonResponsetoNOI.pdf?rd=1>

exercise and try to gain as much concessions as possible.⁹⁵ In the EU, the problem has not been as much publicized as that in the US and initiatives in this area have been in relation to the i2010 Digital Library Initiative. The Commission has issued a Green Paper on Copyright in the Knowledge Economy⁹⁶ in July 2008 to seek the people's reactions on emerging issues in copyright law including the issue of orphan works⁹⁷ and elicit debate thereon. The outcome of the consultation was published in a Communication from the Commission in October 2009.⁹⁸ There are also sentiments for European harmonization in this area.⁹⁹

4.2 Nature of the Problem

This problem has been considered in the law and economics literature as a market failure¹⁰⁰ because the orphan works gives rise to a situation where economic activity is stifled due to the fear of would-be users of orphan works of being sued for infringement in the event the lost or unknown author of the orphan works pops up. Most people are risk averse¹⁰¹ and without legal certainty on the regime governing orphan works these works will not put to use for the creation of new works. On-going activities that depend on the utilization of such type of works would most likely be abandoned if they find that the cost of possible infringement liability is higher than the benefits to be brought about by the planned new creation. The result is thus inimical to the public interest and, in the case of US orphan works, not in conformity with the mandate of Copyright Clause of

⁹⁵ Daryl Lang, "Photo Advocates Divided Over Orphan Works", http://www.pdnonline.com/pdn/eseach/article_display.jsp?vnu_content_id=1003801084 accessed on March 9, 2010

⁹⁶ Available at http://ec.europa.eu/internal_market/copyright/docs/copyright-info/greenpaper_en.pdf accessed on March 9, 2010

⁹⁷ One question raised is whether EC needs a new statutory instrument to deal with the problem (Green Paper, p.12)

⁹⁸ COMMUNICATION FROM THE COMMISSION, Copyright in the Knowledge Economy, COM(2009) 532 final, Brussels, 19.10.2009 available at

<http://eurlex.europa.eu/LexUriServ/LexUriServ.do?uri=COM:2009:0532:FIN:EN:PDF> accessed on March 11, 2010

⁹⁹ Elisabeth Niggemann, "How to Deal with Orphan Works in the Digital World", available at

<http://www.europarl.europa.eu/document/activities/cont/200911/20091113ATT64507/20091113ATT64507EN.pdf> accessed on March 11, 2010

¹⁰⁰ Lindsay Warren Bowen, Jr., "Givings and the Next Copyright Deferment" (2008) 77 Fordham L. Rev. 809;

¹⁰¹ See Ian McDonald, "Some thoughts on Orphan Works", October 2006, 24 Copyright Reporter 3, p. 155.). He writes: *Whether or not to use an orphan work is a question of risk management: a user who is risk-averse (and is not able to justify the use of the material under one of the exceptions, such as fair dealing for criticism or review) will not use the material at all, and may use substitute material for which a clearance can be obtained or which is in the public domain; a user who is less risk-averse will use the material, but will generally take steps to minimise the risk of a substantial damages claim from a copyright owner who discovers the unauthorised use.*

the US constitution that mandates copyright law “to promote the progress of science and useful arts”¹⁰²

The extent of the market failure is best captured when viewed from an understanding of the actual figure of orphan works in the market. According to Jason Schultz¹⁰³, of the 187,280 books published in the U.S. from 1927-1946, only 4,267 or 2.3%, were available in 2002 from publishers at any price and that only 9.2% of films were available. The British Library on the other hand puts the figure *at over 40% of all in-copyright works*¹⁰⁴. The *Association de Cinematheques Europennes* (ACE), on the other hand, reported that in the audio-visual sector approximately 50,000 of the surveyed works are orphans and are mostly non-fiction and created between the years 1945 to 1950. ACE stated that every year they receive around 2,500 requests to use orphan works for broadcasting, cultural as well as commercial purposes.¹⁰⁵

4.3 Definition

Orphan works are works that are in copyright whose right holders remain unidentified or untraceable making it impossible to get their consent¹⁰⁶. It thus centers on the relationship between the copyrighted work and its author who is either unknown or, if known, cannot be located, after diligent search. One may classify the former as works with an “unknown owner” while the latter as lost works or works with an “unlocatable owner” but both are characterized by the fact that they have been separated from or orphaned by their parents (i.e. the authors).

4.3.1 The Unknown Owner

This type of orphan works includes those that arise when the original owner dies intestate and his or her copyright is not transmitted to the rightful inheritor. This also occurs when a corporate copyright holder is dissolved without its copyright being properly assigned to another entity. A person who does not understand the value of a copyright that was transferred to him or her may take it for granted and exert no effort in claiming ownership thereon.¹⁰⁷

¹⁰² Frank Muller, “Owners And Users Unite!: Orphan Works In The Copyright Modernization Act Of 2006” (2006) 17 DePaul-LCA J. Art & Ent. L. 79

¹⁰³ Jason Schultz, “The Myth of the 1976 Copyright ‘Chaos’ Theory available at <http://www.lessig.org/blog/archives/jasonfinal.pdf> accessed on March 9, 2010

¹⁰⁴ Agnieszka Vetulani, “The Problem of Orphan Works in the EU: An Overview of Legislative Solutions and Main Actions in the Field”, (2008) EC, DG Information Society and Media, at p. 8, citations omitted

¹⁰⁵ *Ibid.*, at p 8

¹⁰⁶ *Ibid.*, at p. 7

¹⁰⁷ Dennis W. K. Khong “Orphan Works, Abandonware and the Missing Market for Copyrighted Goods” (2007) 15 Int'l J.L. & Info. Tech. 54

4.3.2 The Unlocatable Owner

While the rightful owner of the copyright may be known, his or her domicile could be undisclosed. The problem is also exacerbated by the fact that owners of a copyrighted work may be a foreigner whose whereabouts may be particularly difficult to locate. This type of orphan works is less serious in scope with the advent of computer searchable telephone directories and public records that makes tracing the missing parents of the orphan works easier.¹⁰⁸

4.4 Uses of Orphan Works

As stated earlier, orphan works is problematic because there are users who are interested in utilizing them but are constrained by the absence of a clear legal rule on how to deal with them. Muller¹⁰⁹ offers a handy categorization of orphan works into the following classes:

4.4.1 Use by subsequent creators

The uses falling under this type are those uses that require the incorporation of the orphan works to come up with a new work. Examples abound. An orphaned photograph may be indispensable to the publication of a new book. An orphaned novel may be adapted into a film.¹¹⁰

4.4.2 Large-scale access uses

This refers to uses typically made by academic and non-profit institutions (e.g. libraries, museums or archives) with the end in mind of making available to the public large quantity of works in their possession. Most of this works have been donated with incomplete copyright information. Apart from the purpose of making them available to the public, the digitization of the said works are also done to preserve the data contained in the said works for the future generations. Project Gutenberg is considered to be the first digital library initiative. It began in the seventies and presently houses 17,000 books in electronic format (e-books) in 45 languages. There are countless others who are engage in digitization projects but none is more controversial than Google Book Search Library Project which commenced in 2004. Google's aim is to build a database of every work in the collections of major libraries throughout the world of which more than eighty percent is copyrighted. Among these copyrighted materials are millions of orphan works that makes it virtually impracticable or even impossible to seek licenses for every title in the catalogue without incurring gargantuan costs. The functional part of this thesis will treat this topic in detail.

¹⁰⁸ Ibid.

¹⁰⁹ Muller, *supra* note 102

¹¹⁰ Ibid.

4.4.3 Enthusiast uses

Enthusiasts include hobbyists or experts in a particular field. The activities of enthusiast users normally involve works that are no longer commercially available. As such, the works of these enthusiasts are seldom of interest to the general public. An example of an enthusiast is one who is interested in republishing a specialized magazine that had since gone out of business.

4.4.4 Private uses

Private uses means uses for personal purposes. The often used examples is that of a Wal-Mart customer who wanted to have an old photograph copied but is denied such service on the pretext that copying it would violate the copyright of the author of the photograph. The customer's disappointment was understandable because she never thought that the copyright of "an unknown and likely deceased photographer"¹¹¹ could deprive her enjoyment of a memorable family photograph.

4.5 The Origin of the Problem

4.5.1 Legal Causes

The problem of orphan works is partly traced to the absence of a registration system similar to that adopted for patents and trademarks. In the case of copyright, however, such a system is cumbersome considering the sheer number of works that are created every day¹¹². The formality of registration and a renewal system for the registration to be updated are also seen as unduly penalizing the holders of copyright by causing the unintentional loss of such copyright.¹¹³ The Berne Convention¹¹⁴ thus prohibited any formality in copyright¹¹⁵.

Among the Berne Union members, it is the US that had all the reasons to put the blame to this cause. US had a regime of formalities until it joined the Berne Union that forced it to make the following changes:

1. The elimination of required registration. Under the 1976 Copyright Act, copyright protection arises in a work the instant that it is "fixed in any tangible medium of expression." There

¹¹¹ Ruthann Gray's Comment dated 2/27/05, http://www.copyright.gov/orphan/comments/orphan_work0122-Gray.pdf accessed on March 9, 2010

¹¹² Considering the level of technology today, it is posited that the harm sought to be avoided by not requiring formalities in copyright is no longer entirely true as compared to the situation at the time the Berne Convention was framed.

¹¹³ Muller, *supra* note 102

¹¹⁴ Berne Convention for the Protection of Literary and Artistic Works of September 9, 1886 (revised)

¹¹⁵ Article 5 of the Conventions states: Rights Guaranteed xxx (2) The enjoyment and the exercise of *these rights shall not be subject to any formality*; ...

was no longer any need to register a work created after January 1, 1978.

2. The elimination of copyright renewal. The Copyright Renewal Act of 1992 eliminated the requirement that a renewal registration be filed to gain the full-term of protection available under existing copyright law. Another provision of this act reached back and automatically renewed copyright in any works created between January 1, 1964 and December 31, 1977. This act thus protected an immense amount of material from falling into the public domain.
3. The elimination of the requirement of affixing notice of copyright protection. The Berne Convention Implementation Act of 1988 amended U.S. copyright law so as to bring the U.S. into compliance with the Berne Convention. An important requirement of the Berne Treaty is its prohibition in article 5(2) against any formalities that act as a prerequisite to copyright protection. By passing this implementation act, U.S. Congress eliminated the last significant formality, the need for a published work to be marked with copyright notice.¹¹⁶

4.5.2 Non-Legal Cause

The second reason that is blamed for the proliferation of orphan works is the advancement in digital technology that empowered artists to be able to easily create artistic, musical, and visual works and make them available on the Internet. Having been digitalized, these works or parts of thereof are easily separated from indications of ownership or permission such as through sound “sampling” or reposting of photographs that belong to another author¹¹⁷.

4.6 Possible Solutions

4.6.1 Granting a statutory license

One proposed solution is to appoint a competent body that would grant a statutory license for the use of orphan works. There are two existing models in this area: the British model and the Canadian Model.

4.6.1.1 The British Model

UK’s Copyright Tribunal was established pursuant to Chapter VIII of the UK Copyright, Designs and Patents Act of 1988 (CDPA) to, among other functions, give consent *‘to a person wishing to make a copy of a recording of a performance ... where the identity or whereabouts of the person entitled to the reproduction right cannot be ascertained by reasonable inquiry,’*

¹¹⁶ Tobe Leibert, “Features - The Problem of Orphan Works”, <http://www.llrx.com/features/orphanworks.htm> accessed on March 9, 2010

¹¹⁷ Elizabeth Herbert Schierman, “Orphan Works: Congress Considers Lessening Penalties to Copyright Infringers” (2009) 52-APR Advocate (Idaho) 16

subject to other evidentiary requirements.¹¹⁸ Its jurisdiction is thus very limited.

4.6.1.2 The Canadian Model

Canada, on the other hand, has an operative system that addresses the orphan works problem under Section 77¹¹⁹ of the Canadian Copyright Act. That provision allows a person to apply to its Copyright Board '*to obtain a licence to use a published work, a fixation of a performer's performance, a published sound recording, or a fixation of a communication signal ... [if] the applicant has made reasonable efforts to locate the owner of the copyright and that the owner cannot be located.*'¹²⁰ The difficult part of this licensing scheme however is the determination of the reasonableness of the efforts exerted by the user in locating the copyright owner. The Copyright Board helps in establishing the best practice in this regard and performs the following tasks in addition to its licensing function: advise the user where to check relevant information, verify the good faith of the applicant, work together with other entities in order to examine the application, advice on fees, terms of conditions. The salient features of the Canadian license are the following:

1. it is non-exclusive, is issued on a case-by-case examination
2. it applies to works of both domestic and foreign origin and is limited to the territory of Canada.
3. it *only applies to published works* and sound recordings, fixed communication signals and performances which respects the moral right of the author to decide whether or not to make his work available to the public.¹²¹

If the Copyright Board is satisfied that there is merit in the application, it then issues a licence under such terms and conditions that are warranted (e.g. type of use, restrictions, date of expiry, etc.) The royalty fees due to the work is either collected by a collective society¹²² or deposited for

¹¹⁸ Khong, *supra* note 107

¹¹⁹ Section 77 of the Canadian Copyright Act provides: (1) *Where, on application to the Board by a person who wishes to obtain a licence to use (a) a published work, (b) a fixation of a performer's performance, (c) a published sound recording, or (d) a fixation of a communication signal in which copyright subsists, the Board is satisfied that the applicant has made reasonable efforts to locate the owner of the copyright and that the owner cannot be located, the Board may issue to the applicant a licence...* (2) *A licence issued under subsection (1) is non-exclusive and is subject to such terms and conditions as the Board may establish.* (3) *The owner of a copyright may, not later than five years after the expiration of a licence issued pursuant to subsection (1) in respect of the copyright, collect the royalties fixed in the licence or, in default of their payment, commence an action to recover them in a court of competent jurisdiction.* Copyright Act, R.S.C., ch. C-42, § 77 (1985) (Can.), available at <http://www.cb-cda.gc.ca/unlocatable-introuvables/brochure2-e.html> accessed on March 9, 2010

¹²⁰ Khong, *supra* note 107

¹²¹ Vetulani, *supra* note 104, pp. 9-10

¹²² "A collective society is an organization that administers the rights of several copyright owners. It can grant permission to use their works and set the conditions for that use. Collective administration is widespread in Canada, particularly for music performance rights, reprography rights and mechanical reproduction rights. Some collective societies

subsequent payment to the copyright holder once he or she reappears within 5 years after expiration of the license, otherwise the money is then utilized for other legal purposes. However, the following drawbacks have been identified:

1. the pre-clearance of rights is a rather expensive and long process
2. the system appears to be unpopular since it only accounts for roughly 300 applications which resulted in 216 licences covering the period from its inception in 1989 until 2007 (and of which total only 25 was granted in 2007)
3. the licence is limited as it is not applicable to unpublished works and applies only to the Canadian territory.¹²³

The Canadian system is however seen as defective inasmuch as the fees act as a tax on the creative users of orphan works, benefiting collective society members who have nothing to do with the orphan work to benefit the fees.¹²⁴ Finally, it also fails to provide a solution to orphan works that are unpublished.

4.6.2 Create a New Exception

In the UK, one solution that has been proffered by the Gowers Review on Intellectual Property¹²⁵ of December 2006 is to create a new legal exception to copyright infringement when an orphan work is involved. Copyright exceptions act as defences against claims of copyright infringements and are commonly found in all mature copyright law systems. An example of an existing exception under the CDPA which affects orphan works is the following:

57. (1) Copyright in a literary, dramatic, musical or artistic work is not infringed by an act done at a time when, or in pursuance of arrangements made at a time when— (a) it is *not possible by reasonable inquiry to ascertain the identity of the author*, and (b) it is reasonable to assume— (i) that *copyright has expired*, or (ii) that the author *died 70 years* more before the beginning of the calendar year in which the act is done or the arrangements are made

Section 57 provides a partial solution to orphan works assumed to be in the public domain anyway so it does not offer any help in the case of new works that are orphaned.¹²⁶

are affiliated with foreign societies; this allows them to represent foreign copyright owners as well" (Copyright Bd. of Can., Copyright Collective Societies at <http://www.cb-cda.gc.ca/societies-societes/index-e.html> March 9, 2010; a detailed list of collective societies are also found in the page)

¹²³ Vetulani, *supra* note 104

¹²⁴ Muller, *supra* note 102

¹²⁵ Gowers Review of Intellectual Property, November 2006, Crown Copyright, available at http://webarchive.nationalarchives.gov.uk/+http://www.hm-treasury.gov.uk/d/pbr06_gowers_report_755.pdf accessed on March 9, 2010

¹²⁶ Khong, *supra* note 107

4.6.3 Extended Collective Licensing Schemes

In a collective licensing scheme, a collecting society represents a large number of copyright owners and publishers encompassing those who are not even members of the organization¹²⁷. As such, a prospective user of a work does not have to search for the copyright owner. The user goes directly to the society to negotiate the licence fee. In this scheme, lump sum payment is made. The lump sum takes into account several factors including the nature and function of the organisation, the size of the organisation, the type of material reproduced, and the frequency reproduction is made. The advantage of this scheme is that the cost for searching and other transaction costs are greatly reduced.¹²⁸

The Nordic countries (*i.e.* Denmark, Finland, Sweden, Norway and Iceland) and Hungary are acknowledged as having a functioning *extended* collective licensing system. This regime is sanctioned by the InfoSoc Directive¹²⁹ albeit via its preamble only¹³⁰.

4.6.4 Limitation on Remedy

This approach is under consideration in the US congress. The congressional initiative can be traced back from the study conducted by the US Copyright Office in January 2006. In its “Report on Orphan Works”¹³¹ the said office proposed to introduce a limitation-on-remedy rule which would limit the liability of users of orphan works (including unpublished ones) so long as they reasonably search the whereabouts of the copyright owners and that their search proved unsuccessful.¹³²

The main approach of the Act is to make orphan works accessible to users without the attendant legal risks by revising the provision of the US copyright law on infringement and remedies.¹³³ As the law stands now, an infringer may suffer from the harsh penalties or sanctions imposed by the law (that includes statutory damage at \$150,000 for each infringed material¹³⁴). The Act proposes to make the described legal risk manageable provide that the infringer:

1. has conducted a documented diligent search in good faith to locate and identify the owner of the infringed copyright

¹²⁷ See Jan Rosen, “Administrative Institutions in Copyright: Notes on the Nordic Countries”, 42 *Scandinavian Stud. L.* 165 (2002), at p.166

¹²⁸ *Ibid.*

¹²⁹ Directive 2001/29/EC, *supra* note 41

¹³⁰ The particular recital states: “(18) This Directive is without prejudice to the arrangements in the Member States concerning the management of rights such as *extended collective licences*.”

¹³¹ Available at <http://www.copyright.gov/orphan/orphan-report.pdf> accessed on March 11, 2010

¹³² Vetulani, *supra* note 104

¹³³ 17 U.S.C. § 501(a)

¹³⁴ Jennifer Davis, *Intellectual Property Law*, (OUP, 2008) p. 81.

2. was unable to locate and identify the copyright owner.
3. have 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;"
4. included with the use of the work made by the infringer a symbol or notice that the work is being used as an orphan work,
5. have asserted an orphan-works-use defence in his/her first pleading,
6. have stated, with particularity, the basis for the orphan-works-use defence at the time of making the initial disclosures under rules of court.

When these conditions are present, the infringer will only be required to pay "reasonable" compensation to the copyright owner. The recovery is limited further if the infringer is a non-profit educational institute, museum, library, archives, or public broadcasting entity, and if the infringement was not for any purpose of direct or indirect commercial advantage, was primarily educational, religious, or charitable, and the infringer ceased the infringement after receiving a notice of the infringement claim, with time to conduct a good faith investigation of the claim.

Injunctive relief is limited if a new work of authorship is created using the orphan work (a use that recasts, transforms, adapts, or integrates orphan work) so long as the "infringer" pays reasonable compensation in a reasonably timely manner upon an agreed price or determined by the court, and he or she provides appropriate attribution to the copyright owner if requested.¹³⁵

In this scheme, the user would become liable to pay only for commercial uses and payments are made *ex post*. It also does not distinguish between published and unpublished works.

4.6.5 Copyright Levy

A well-known scheme implementing a copyright levy¹³⁶ involved the charging of a fee for the purchase of blank recording material or recording equipment in order to compensate copyright owners for the loss of sale resulting from the private copying of their works. The collection is normally undertaken by collective societies that collect a levy from manufacturers and importers of blank audio recording media, including recordable CD's and DVD's. In exchange for the payment of the levy, the copying of the copyrighted material for the private use of the person who makes the copy does not constitute an infringement of the thereof. In Germany, such a system has been at work since 1950s. A levy of 12 euros is now also imposed upon every personal computer system sold.

¹³⁵ Schierman, *supra* note 117, at p. 19

¹³⁶ Khong, *supra* note 107

Copyright levy is seen as partly solving the orphan works problem because it is able to forego with the usual individual licensing of copyrighted works. It is however frowned upon as being akin to taxes.

4.6.6 Voluntary Mechanisms

Absent a clear legal rule to cover dealings with orphan works, institutions and stakeholders may themselves lay down certain voluntary mechanisms¹³⁷ or rules on the matter. One functioning example is the agreement signed up by publishers for use of orphan works in the field of scientific, technical and medical literature. The agreement between the International Association of Scientific, Technical & Medical Publishers (STM), the Association of Learned and Professional Society Publishers (ALPSP) and the Professional Scholarly Publishing (PSP), the division of Association of American Publishers (AAP) acknowledges a safe-harbour for users of orphan works and promises to waive an infringement claim and their entitlement to all fees or damages including statutory, punitive, exemplary or other special or general damages, other than a reasonable royalty so long as the said users comply with their guidelines that include the following:

1. the user has to be able to prove that he/she made a reasonably diligent and good faith search for the right holder; although it is not possible to provide an exhaustive list of resources, the search should be conducted in general in:
 - a. published indexes or published material relevant for the publication type and subject matter
 - b. indexes and catalogues from library holdings and collections
 - c. sources that identify changes in ownership of publishing houses and publications including from local reprographic rights organizations
 - d. biographical resources for authors
 - e. searches of recent relevant literature to determine if the citation to the underlying work has been updated by other users or authors
 - f. relevant business or personal directories or search engines searching for businesses or persons
 - g. sources on the history of relevant publishing houses or scientific, technical or medical disciplines
2. the user has to make an attribution to the original work, author, publisher, copyright owner, etc if the right holder identifies the work, the user has to pay a reasonable royalty (the royalty rate or fee will be identical to the publisher's normal permissions request rate);
3. if the use goes beyond the normal use then the publisher makes a good faith effort to determine the reasonable royalty rate

¹³⁷ Vetulani, *supra* note 104, at pp. 21-22

4. after the right holder has been identified, further use must be agreed by the copyright owner (beyond derivative use and further distribution).

This solution however is extremely informal and lacks the necessary norm-setting character that only a statutorily imposed solution can give.

4.6.7 Reformalizing Copyright Law

This is a preventive solution. It is however the most controversial of all solutions because it directly contravenes Berne Convention's proscription against formalities. The change is advocated by Creative Commons, a group whose leading voice Lawrence Lessig, who proposes a regime of mandatory registration of copyrighted works after an initial twenty-five years of protection followed by another renewal requirement after the first fifty years of protection except for computer software, which must be registered within five years because such works have a shorter economic life. As a necessary consequence of this system, unregistered and unrenewed works are deemed orphan works and may then be used without seeking prior permission provided that a default license fee is paid into an "orphan fund." This fund will be used to pay owners who subsequently discover that their works have been exploited.¹³⁸

The arguments in favour of returning to the "formalities" of copyright law is encapsulated in the brief filed in opposition to the government's motion to dismiss in *Kahle v. Ashcroft*¹³⁹, a case challenging the constitutionality of Congress's removal from the copyright laws of the traditional system of formalities under US laws (i.e., registration, notice, renewal)¹⁴⁰:

. . . For the first 186 years of our Republic, copyright laws established an "opt-in" system, one in which copyrights were secured only to those who took steps to claim them. In 1976 and 1989, Congress inverted this regime, transforming copyright law into an "opt-out" system, one in which rights are granted automatically and indiscriminately unless disclaimed. xxx

In a series of statutes over a relatively short period of time, Congress shifted copyright from an opt-in to an opt-out regime, by removing from our law a core set of copyright formalities. These formalities, including (1) registration, (2) notice, and (3) renewal (hereafter, "opt-in formalities"), were required of copyright owners for them to secure initial, and continued, copyright protection.

¹³⁸ Muller, *supra* note 102

¹³⁹ The case title was later changed to *Kahle v. Gonzales* 487 F.3d 697 (9th Cir. 2007).

¹⁴⁰ Christopher Sprigman, "Plaintiffs file brief in opposition to government's motion to dismiss", <http://cyberlaw.stanford.edu/about/cases/002479.shtml> accessed on March 9, 2010

The removal of formalities utterly changed the nature and reach of American copyright law. For 186 years of the American Republic, the purpose and effect of these opt-in formalities was to narrow the reach of copyright law to those works that had a continuing copyright-related interest. Given the limits that these opt-in formalities placed on the reach of the law, copyright burdened relatively few creative works, and hence burdened very few beyond commercial creators. The law thus left essentially unburdened archivists, preservationists, libraries, and non-commercial creators.

But by stripping out copyright's opt-in formalities, Congress has reversed this traditional pattern. Whereas copyright regulation before was the exception, now it is the rule. Whereas the burden of copyright before was effectively limited to works that had some continuing commercial viability, the burden of copyright now is spread broadly and indiscriminately to all creative works regardless of any continued commercial interest in the copyright. Whereas traditionally, the contours of American copyright law guaranteed that this regulation of speech was reasonably and effectively tailored to a viable commercial interest, today this regulation of speech burdens effectively all creative work, regardless of any continuing commercial interest in "Authors" to control its dissemination or use. *Works today that have no continuing commercial use, but continue under the regulations of copyright, are effectively orphaned by the current regime.*

These changes would have been significant at any time in our history. But they are especially *burdensome now*. Just at the time that digital technologies could enable an explosion in creative reuse of our culture, the burdens of an opt-out system of copyright make most reuse of orphaned work essentially impossible. Libraries and archives could use these digital technologies to make available an extraordinary range of our creative past. Yet the law now imposes burdens that make this reuse essentially impossible.¹⁴¹

As stated at the outset, no Union member can validly adopt this approach because it will contravene the Berne Convention. The only way that breach may be avoided is to make registration optional which however entirely misses the point because then it would not completely prevent the emergence of works from becoming orphaned.

4.7 Assessment

A good starting point on the inquiry on which of the identified solutions is the most sound from a perspective that takes into consideration the interests of both copyright and the public domain is to find out the stance of WIPO the issue. Because the issue is however of fairly recent vintage, WIPO

¹⁴¹ Ibid.

appears to be in a similar stage as the governments of the Berne Union members -- it is currently studying the problem¹⁴². In a document¹⁴³, WIPO declared:

The issue of orphan works is mainly a *rights clearance issue* – how to ensure that users can use orphan works in a legitimate way, e.g. to allow the digitalization of orphan works in a way as secure and fair as possible, respecting the rights of the right holders. Apart from liability concerns also the interests of the consumers and the immense cost and time needed to locate or identify the right holders (especially in case of works of multiple authorship) must be taken into account.

What is at stake is to assure *legal certainty* for the exploitation of orphan works, without dissolving Copyright Law. The problems involved may vary *according to the categories of protected matter* and so may their solutions.

Why should the issue of Orphan works be discussed in WIPO?

The orphan works issue is currently being considered both at the national and at the EU level, as well as in other WIPO member states. The European Community and its Member States believe that an exchange of information on this important topic at the international level would be a very useful exercise, and especially meaningful in the *cross-border effects of digitisation activities*.

The absence of a common approach to the problem therefore makes the search for solutions a purely national matter. Any solution that is adopted should more or less provide a predictable regime so as to encourage the use of orphan works as well as discourage possible abuses thereof that would upset the protection granted to authors.

It is submitted that the system that presently exists in Canada is the best format for a legislated solution to the problem that recognizes the interest of the copyright owner. The institution or designation of a government agency to handle and determine, *ex ante*, matters relating to the exploitation of orphan works provides a certain degree of certainty than any other system such as a system that would settle, *ex post*, the status of an orphan work and the effects of its use by an infringer.

¹⁴² “Member States Consider Future Work of Copyright Committee” dated March 13, 2008 http://www.wipo.int/pressroom/en/articles/2008/article_0013.html accessed March 9, 2010

¹⁴³ Justifications for Topics Proposed as Future Work by the European Community and its Member States at the SCCR of March 10 - 12, 2008, Standing Committee On Copyright and Related Rights, Seventeenth Session, Geneva, November 3 To 7, 2008, http://www.wipo.int/edocs/mdocs/copyright/en/sccr_17/sccr_17_4.doc accessed on March 9, 2010

The limitation on remedy system, on the other hand, can be classified as an *ex post* system and as such lacks a certain characteristic of certainty because the infringer remains contingently liable to the copyright owner. The infringer is only afforded a defence which during trial may or may not be sustained by the court. There is the possibility of a diligent search not meeting the required evidentiary threshold such that in the event the resurfacing copyright holder is able to overcome the infringer's evidence of a valid "qualifying search", the infringer reverts back to an ordinary infringer. In the end, the infringer finds himself facing the full extent of damages under the law.

The Canadian system also properly distinguishes published from unpublished works while its American counterpart does not. It is posited that only published works should be included in any scheme that authorizes the use of orphan works. Unpublished¹⁴⁴ works should be taken out of its coverage because even if the user establishes the work to be orphaned, no mechanism can verify the true intent of the author as to how he or she intends to exercise his or her right to control the work and to publish it. If a copyright holder is missing and cannot be located, no one will ever know what his or her real intentions are. If a user will be allowed to exploit a work of an author who turns out never to have wanted to publish and disclose the same, privacy rights issues could be raised in addition to the fact that it also disregards his or her right of first publication¹⁴⁵.

For purposes of the public domain, however, the proposal of the UK to create a new exception to the rights of reproduction and communication to the public is the most appropriate. However for works with European Union interests, adopting the UK solution would be problematic because it would require an amendment of the InfoSoc Directive. An additional exception in favour of orphan works cannot simply be accommodated since the Directive list of exceptions is exhaustive¹⁴⁶. It is also believed that a new exception will not pass the 3-step test¹⁴⁷ under both the Berne Convention and TRIPS¹⁴⁸ because while orphan works is clearly a special case and thus

¹⁴⁴ "Unpublished" in this context includes both undisclosed and unpublished.

¹⁴⁵ Vigdis Bronder, "Saving the Right Orphans: The Special Case of Unpublished Orphan Works" 31 Colum. J.L. & Arts (2008)

¹⁴⁶ Commission welcomes adoption of the Directive on copyright in the information society by the Council, April 9, 2001, <http://europa.eu/rapid/pressReleasesAction.do?reference=IP/01/528&format=HTML&aged=1&lan>

¹⁴⁷ The test comprises the following three steps: 1) *exceptions shall be applied 'in certain, special cases'*; 2) *which 'do not conflict with the normal exploitation of the work or the subject matter'*; and 3) *'do not unreasonably prejudice the legitimate interests of the right holder'*. ... The report on the implementation of the Copyright Directive commissioned by the EC Commission recognises that the third step allows a balancing between the interests of rights holders and the needs of society and suggests that it is the focal point of the three step test. ("Taking Forward The Gowers Review Of Intellectual Property Proposed Changes To Copyright Exceptions" <http://www.ipso.gov.uk/consult-copyrightexceptions.pdf> accessed on March 11, 2010)

¹⁴⁸ Agreement of Trade-Related Aspects of Intellectual Property Rights available at http://www.wto.org/english/docs_e/legal_e/27-trips.pdf, March 9, 2010

hurdles the first step, it would not pass the other two steps. This is especially true for unpublished and undisclosed works because tinkering with the copyright owner's legitimate interest to control the publication and dissemination of his or her work would necessarily unreasonably prejudice him¹⁴⁹. To make the exception responsive to the need for a balanced copyright law, policy-makers and legislators, or even judges should heed the *Declaration on a Balanced Interpretation of the Three-Step Test in Copyright Law*¹⁵⁰, a manifesto issued by a group of experts whose declarations are supportive of the public domain and the public interest:

1. The Three-Step Test constitutes an indivisible entirety. The three steps are to be considered together and as a whole in a comprehensive overall assessment.

2. The Three-Step Test does not require limitations and exceptions to be interpreted narrowly. They are to be interpreted according to their objectives and purposes.

3. The Three-Step Test's restriction of limitations and exceptions to exclusive rights to certain special cases does not prevent:

(a) legislatures from introducing open ended limitations and exceptions, so long as the scope of such limitations and exceptions is reasonably foreseeable; or

(b) *courts from:*

-- applying existing statutory limitations and exceptions to similar factual circumstances *mutatis mutandis*; or

-- *creating further limitations or exceptions;*

-- *where possible within the legal systems of which they form a part.*

4. Limitations and exceptions do not conflict with a normal exploitation of protected subject matter, if they:

-- are based *on important competing considerations*; or

-- have the effect of countering unreasonable restraints on competition, notably on secondary markets, particularly where adequate compensation is ensured, whether or not by contractual means.

5. In applying the Three-Step Test, account should be taken of the interests of original right-holders, as well as of those of subsequent right-holders.

6. The Three-Step Test should be *interpreted in a manner that respects the legitimate interests of third parties*, including:

-- *interests deriving from human rights and fundamental freedoms;*

-- *interests in competition, notably on secondary markets; and*

¹⁴⁹ Bronder, *supra* note 145

¹⁵⁰ "Declaration on a Balanced Interpretation of the Three-Step Test in Copyright Law", at http://www.ip.mpg.de/shared/data/pdf/declaration_three_step_test_final_english.pdf (accessed 4 November 2009); The Declaration was launched at the annual conference of the International Association for the Advancement of Teaching and Research in Intellectual Property (ATRIP) in Munich in July 2008.

- other public interests, notably in scientific progress and cultural, social, or economic development.

The Declaration deplors the fact that copyright law has responded to the threat of technological change by, primarily, seeking harmonization toward "securing right-holders' ability to benefit from new modes of exploitation and business models", and this had the effect of moving away from the equally important role of copyright to promote public interest, particularly society's right to education and research, access to information and other human rights¹⁵¹ that augur well to the creation of robust public domain. A similar tone can be read from the Response from the British Library to the Green Paper on Copyright in the Knowledge Economy¹⁵² which recommends the maintenance of the *integral link between intellectual property rights and fundamental human rights* such as education, freedom of expression, and access to culture and the *mandatory application of exceptions linked to human rights*. Another group of copyright experts had come up with so-called Adelphi charter¹⁵³ whose first two principles also emphasize the above pleas – that laws regulating intellectual property must serve as means of achieving creative, social and economic ends and must not be seen as ends in themselves, and that such *laws and regulations must serve, and never overturn, the basic human rights* to health, education, employment and cultural life. These declarations or manifestos only indicate that the incorporation of human rights perspectives into a new intellectual property culture is gaining foothold.

With regard to a system of extended collective copyright license, its adoption is also a limited solution because there are different types of authorship that they cannot be completely representative of all types of creators. They also suffer from competition law compliance concerns in so far as the EU is concerned¹⁵⁴. Copyright levies on the other hand are also medium-specific so it cannot possibly compensate all types of authors. It will also be difficult to determine which media will be levied and who will be the beneficiaries thereof. In the case of the music and film industry, the levy is imposed on all blank CD, DVD and other media that could be used to copy a copyrighted material. For photographers, what should it cover? The same media plus the personal computer itself should probably levied be to build up the fund that will compensate photographers whose work are also copied indiscriminately by the single click of the mouse.

In so far as the reintroduction of formalities is concerned, it was earlier stated that it is not legally feasible under the present international copyright regime. It is however the best preventive solution to the problem as it

¹⁵¹ Carter, *supra* note 51

¹⁵² Available at <http://www.bl.uk/ip/pdf/greenpaper.pdf> accessed on March 11, 2010

¹⁵³ Available at http://sitoc.biz/adelphicharter/pdfs/adelphi_charter2.pdf accessed on 6 November 2009

¹⁵⁴ See Rita Matulionyte, "Cross-Border Collective Management and Principles of Territoriality: Problems and Possible Solutions in the EU", *The Journal of World Intellectual Property Law* (2009), Vol. 11, nos. 5/6, pp. 467-497

would not only simplify rights management but would also prevent the occurrence of orphans in the future. Policy makers should indeed seriously consider changing to a formal system of international copyright. Such a system could possibly usher in a better balance between the right of the copyright owners and the users that would eventually result in a more robust public domain. It is also observed that given the present state of technological development and the level of computer literacy such a process of registration would neither be a cumbersome requirement nor be deemed as unduly penalizing the author.

The discussion above has established that the problem of orphan works is not an obscure and isolated problem and that it requires immediate solution. Irrespective of which solution is adopted, a common denominator of all these efforts is that they are all geared ultimately towards the creation of knowledge and wealth by making these orphan works available for re-use. The upshot of any solution that takes orphan works back into the creative and cultural life of the people is that it undoubtedly helps rebuild the public domain¹⁵⁵.

As will be shown in the subsequent discussion and comments on the solution to the orphan works proposed under the Google Book Search Settlement Agreement, the problem mainly boils down to a balancing of two human rights -- the right of the people to participate in cultural life and the right of authors to benefit from the protection of the moral and material interests to their creations.

The orphan works dilemma require policy-makers to be well-versed not only on the historical and philosophical roots of copyright but more so on the more fundamental issues presented by human rights law -- issues that traverse not only the balancing of the right to culture and the right of authors to their moral and material interests but also includes a whole gamut of human rights like the right to freedom of expression and the right to education that ensure the enjoyment by the people of said human rights in an effective and holistic manner.

The dilemma to society is clearly present in the case of orphan works because there is a clash between the interest of the authors and the users of the authors' creations but a middle ground or compromise seem to be elusive. A human rights framework however provides a common platform from where all discussions may be grounded upon in view of the universal acceptance of human rights as normative principles of law.

Under a human rights framework, all interests are drawn to certain normative concepts that would be difficult to repudiate. It thus avoids opposing interests to entrench in their original positions as they rely upon a

¹⁵⁵ Based on the more extensive definition of the public domain -- one that includes in its conceptual framework the fair and exceptional uses of copyrighted works (like in-copyright orphan works)

framework that is mutually acceptable to them being embodied in certain international treaties or instruments to which most states are signatories¹⁵⁶. Thus, one interest may be motivated by a different philosophical motivation than the other and yet still agree on certain fundamental rights that should guide their search for a solution to the dilemma.

It is submitted that in this framework, authors would recognize the right of the people to cultural participation that require them (the authors) to provide access to their works. The components to an effective taking part or participation in cultural life which authors are bound to respect are enumerated in General Comment No. 21, as follows:

15. There are, among others, three interrelated main components of the right to participate or take part in cultural life: (a) participation in, (b) access to, and (c) contribution to cultural life.

(a) *Participation* covers in particular the *right of everyone* — alone, or in association with others or as a community — to act freely, *to choose his or her own identity, to identify or not with one or several communities or to change that choice, to take part in the political life of society, to engage in one's own cultural practices and to express oneself in the language of one's choice*. Everyone also has the right to seek and develop cultural knowledge and expressions and to *share them with others*, as well as to act creatively and take part in creative activity;

(b) *Access* covers in particular the *right of everyone* — alone, in association with others or as a community — *to know and understand his or her own culture and that of others through education and information, and to receive quality education and training with due regard for cultural identity*. Everyone has also the right to learn about forms of expression and dissemination through any technical medium of information or communication, *to follow a way of life associated with the use of cultural goods* and resources such as land, water, biodiversity, language or specific institutions, and to benefit from the cultural heritage and the creation of other individuals and communities;

(c) *Contribution to cultural life* refers to the right of everyone to be involved in creating the spiritual, material, intellectual and emotional expressions of the community. This is supported by the right to take part in the development of the community to which a person belongs, and in the definition, elaboration and

¹⁵⁶ “(P)eople can agree on human rights without agreeing on the grounds of human rights. . . . For most people, agreement on human rights is not an agreement on a philosophy of human rights or a liberal political ideology.” See James W. Nickel, *Making Sense of Human Rights*, Blackwell Publishing, (2d ed. 2007) at p. 177

implementation of policies and decisions that have an impact on the exercise of a person's cultural rights."¹⁵⁷

On the other hand, the users of authors' works (i.e. the people) are equally expected to respect the right of the authors to their moral and material interests. This recognition of protection at the level of human rights of the right to the material interest of authors to their work however ends as soon as authors' material interest are assigned or transferred to corporations. In the hands of corporations, the material interests in copyright are but property rights that are subject to state control in the public interest. Stripped of its human right character, the material interest of the corporation in the copyright defers to the primacy of human rights in determining policy decisions subject only to applicable constitutional limitations on eminent domain such that no private property shall be taken without just compensation in the guise of upholding the primacy of the human right to culture or even education.

In the case of most orphan works of authors who assigned their material interest to their corporate publishers, it is assumed that most of these interests will revert or have reverted to these authors based on the traditional arrangement between authors and publishers where the latter undertakes to revert to the author whatever rights have been transferred to the publisher once the work is determined to be out-of-print. This means that upon such reversion to the individual authors, the material interest should once again be protected at the level of human rights and then balanced with the other human rights that bear upon the exercise of that right.

The balancing between the human right to culture and the human right to the material and moral interests of authors will be further explored in the next part of this thesis.

¹⁵⁷ General Comment No. 21, *supra* note 64, at par. 15 (footnotes omitted)

5 The Google Book Search Project as a Private Solution to the Orphan Works Problem

5.1 Background

Google's forward looking statement in its website¹⁵⁸ is probably the best way to capture what the Google Book Search Project is all about in its present state. Quoting its co-founder & president of technology Sergey Brin, the statement reads:

"Google's mission is to organize the world's information and make it universally accessible and useful. Today, together with the authors, publishers, and libraries, we have been able to make a great leap in this endeavor. While this agreement is a real win-win for all of us, the real victors are all the readers. The tremendous wealth of knowledge that lies within the books of the world will now be at their fingertips."

The most important claim in this statement is that the Project primarily benefits the readers than it does Google and those organizations that represent the copyright holders. In placing the reader at the core of the project, it attempts to relegate into an inconspicuous corner Google's profit motive that undergirds the project. More importantly, Google aligns itself with the mission of libraries "to preserve materials for generations to come and to provide increased access and functionality for the generations at hand."¹⁵⁹ Google in a manner of speaking has taken the cudgels for the public domain by siding with libraries whose interest is towards the dissemination of culture and knowledge, as well as its preservation.

As discussed elsewhere in this essay, Google's digitization of books into fully searchable files was not the first initiative at such digitization. Concerned about the need to preserve the vast amounts of culture and to make them available in the internet, Project Gutenberg, Internet Archive, the Million Book Project and the Library of Congress's American Memory began the first digitization activities albeit in a modest scale.¹⁶⁰

¹⁵⁸ "Google Book Settlement Agreement" available at <http://books.google.com/googlebooks/agreement/#1> accessed on May 3, 2010

¹⁵⁹ Jill E. Grogg and Beth Ashmore, "Google Book Search Libraries and their Digital Copies" in William Miller and Rita M. Pellen (eds.), *"Googilization of Libraries"* (Routledge, 2009) p. 123

¹⁶⁰ Gloriana St. Clair, "The Million Book Project in Relation to Google" in William Miller and Rita M. Pellen (eds.), *"Googilization of Libraries"* (Routledge, 2009) p. 147

What takes Google a breed apart from its predecessors is that it scanned not only public domain books but virtually all the books in some of the most important libraries of the world. As of this writing, these libraries include¹⁶¹:

1. Bavarian State Library
2. Columbia University
3. Committee on Institutional Cooperation (CIC)
4. Cornell University Library
5. Harvard University
6. Ghent University Library
7. Keio University Library
8. Lyon Municipal Library
9. The National Library of Catalonia
10. The New York Public Library
11. Oxford University
12. Princeton University
13. Stanford University
14. University of California
15. University Complutense of Madrid
16. University Library of Lausanne
17. University of Michigan
18. University of Texas at Austin
19. University of Virginia
20. University of Wisconsin – Madison.

Google's project is thus unprecedented in terms of scale and of coverage as it took en masse all the books in the libraries without distinction as to whether it is in the public domain or not. An official of one of the partner libraries has described the project as follows:

This is a very ambitious project that will provide scholars and the general public with an unprecedented ability to search for and locate books from the university's vast collection. This initiative has the potential to revolutionize the way the world's knowledge is transmitted and to democratize access to information...¹⁶²

Understandably, some libraries were cautious, as they are wont to do to avoid infringement suits, but all that changed when Google came along and showed courage to take the risk of being made to pay trillion of dollars in damages¹⁶³ and the altruism to spend billion of dollars in investment. This newfound risk taking even on the part of the libraries may have been encouraged in part by Google's indemnification clause in its contract with the libraries. University of Michigan's Karle-Zenith discloses: "The library is assuming little to no risk because, per our contract, Google indemnifies us

¹⁶¹ "Library Partners" at <http://books.google.com/googlebooks/partners.html> accessed on April 21, 2010

¹⁶² Grogg, *supra* note 159, at p. 127

¹⁶³ See Jonathan Band, "The Long and Winding Road To The Google Books Settlement", 9 J. Marshall Rev. Intell. Prop. L. 227 (2010)

against any third party claim that the project violates third party's copyrights or other legal rights.¹⁶⁴,

With Google's statement that its "ultimate goal is to work with publishers and libraries to create a comprehensive, searchable, virtual card catalog of all books in all languages that helps users discover new books and publishers discover new readers."¹⁶⁵, Google may indeed be building the second Library of Alexandria¹⁶⁶ prompting a Washington Post Editorial to observe:

"Some call it Alexandria 2.0, and the comparison with the great library of antiquity is apt. Google has digitized millions of books, and if its proposed class-action settlement with their authors and publishers passes muster, these books -- formerly the province of college libraries and research institutions -- will be available to everyone." (*Washington Post*, 8/8/09)¹⁶⁷.

5.2 The Google Book Search Project and Orphan Works

5.2.1 From an Indexing Project to a Project Granting Full Access to Books

The original project that was launched in 2004 was intended only to index the books and provide snippets of parts of the book in the possession of participating libraries in order to help the reader decide for himself or

¹⁶⁴ Grogg, *supra* note 159, at p. 129

¹⁶⁵ <http://books.google.com/googlebooks/library.html>

¹⁶⁶ A brief account of the Library of Alexandria is presented in Peter S. Menell, "Knowledge Accessibility And Preservation Policy For The Digital Age Knowledge Accessibility And Preservation Policy For The Digital Age", 44 Hous. L. Rev. 1013 (Houston Law Review, Copyright in Context: Institute for Intellectual Property & Information Law Symposium, 2007). He writes: "Dating back to the third century before the Common Era, King Ptolemy I established the Royal Library of Alexandria. The library's collection was initially organized by Demetrius of Phaleron, a student of Aristotle, as part of a research center and repository of literature and knowledge of the Hellenic culture. To hasten assembling of the collection, King Ptolemy III decreed that all visitors to Alexandria surrender books in their possession so that they could be copied for the library's archives. More than a century later, Mark Antony donated 200,000 scrolls to the library as a gift marking his wedding to Cleopatra. At its peak, the library is thought to have amassed half a million scrolls, estimated to have been between thirty and seventy percent of all books then in existence. Archaeological discoveries indicate that the library housed vast lecture halls capable of accommodating thousands of students. Scholars from throughout the Mediterranean region were attracted to the library. Although ultimately destroyed by fire, the library reflects early societal interest in collecting and preserving knowledge (footnotes omitted)."

¹⁶⁷ Benefits for libraries and library users", available at <https://sites.google.com/a/pressatgoogle.com/googlebookssettlement/what-people-are-saying-2/settlement-benefits-libraries-and-library-users> accessed on April 21, 2010

herself whether he/she is looking at the right book and thereupon find the book in the library or buy it from bookstores or the publishers directly or through their websites. Google's scanning of the books was thus an indispensable element in the effort to create a fully functional product. Google however exercised sufficient diligence to ensure that the showing of relevant search results does not harm the commercial interests of the authors and publishers. Thus, only public domain works are available for full view while copyrighted works (both in-print and out-of-print) may only be viewed through "snippets" in order to serve the purpose of pointing the researcher to the relevant parts without giving too much away of the book as to virtually serve as a substitute product.¹⁶⁸

The authors and publishers were not moved by the altruistic mission of Google and the participating libraries as they saw the wholesale scanning of books as a threat to their business (even though the avowed purpose was only for indexing purposes)¹⁶⁹. The only logical step was then to sue Google for infringement at least for those books that are in-copyright and in-print inasmuch as most of those books that are out-of-print have been deemed to be orphan works with no clear record on who the present copyright owners or where they may be found.

A suit for injunction and damages was commenced by the Authors Guild before the United States District Court for the Southern District of New York in September 2005¹⁷⁰. A case was likewise subsequently filed by McGraw-Hill, Pearson, Penguin, Simon & Schuster, and John Wiley & Sons in behalf of the Association of American Publishers for injunction alone¹⁷¹. The cases were consolidated.

On October 28, 2008, the parties agreed to settle. The salient features¹⁷² of the settlement include the payment by Google of \$125 million part of which amount (about \$34.5 million) will be used to establish a Book Rights Registry which will function as a collective rights organization representing the interests of rights holders. Notably, the Registry's representation covers even orphan works. As a copyright collective, it will be tasked to collect licensing revenues from Google for subsequent distribution to the authors and publishers it represents. There are three revenue centers created under the arrangement. The first is taken from institutional subscriptions. The

¹⁶⁸ Simon Stokes, *Digital Copyright, Law and Practice*, Third ed., Hart Publishing, 2009 at p. 177

¹⁶⁹ Google usually concocts disruptive and radical innovations that gave it the reputation of being able to "destroy entire industries without even noticing." (See David Gelles and Andrew Edgecliffe-Johnson, "Electronic commerce: A page is turned", *Financial Times*, February 9, 2010, at p. 13; also available at http://www.ft.com/cms/s/0/1aca5734-14fe-11df-ad58-00144feab49a.html?ncllick_check=1 accessed on April 26, 2010

¹⁷⁰ *Authors Guild v Google*, 05 Civ. 8136

¹⁷¹ *The McGraw-Hill Companies, Inc. v. Google Inc.*, 05 Civ. 8881

¹⁷² The summary presented is adapted from the article by Ryan Andrews, "Contracting Out Of The Orphan Works Problem: How The Google Book Search Settlement Serves As A Private Solution To The Orphan Works Problem And Why It Should Matter To Policy Makers" 19 S. Cal. Interdisc. L.J. 97, with the footnotes omitted.

second is from individual sales via full access to digital books online. The third revenue source is from advertisers to Google's Book Search site who pay to be seen on the site. Sixty three percent of the revenues will be remitted to the Registry primarily for distribution to the right holders. The revenue potential of the products envisaged in the agreement is greatly enhanced by Google's ability to exploit the orphan works through a rule that operates on an implied consent of authors of out-of-print works mostly orphan authors or right holders subject only to the right to opt-out of the arrangement. To minimize the aberration caused by orphan works, the Registry is thus tasked maintain a rights management database as well the additional burden of searching for the owners of the orphan works.

5.2.2 Google's Fair Use Defense

While the parties in the case have already settled the case, the sheer volume of objections being raised before the court would not count out the possibility that the court may ultimately throw the settlement out of the window for having gone beyond the issues raised in the case. In such an event, the parties would go back to square one and argue on the merits of the case particularly on the issue of whether or not Google's activities were consistent with section 107 of the Copyright Act (15 U.S.C. §107 2000), the fair use exception in American law. Of late, some noted scholars have complained about the assault on this very important provision of US copyright law that rendered almost nugatory its exercise and reduces it into a right to hire a lawyer.¹⁷³ Many had therefore hoped for the court to rule on the matter in the Google case to enrich US fair use jurisprudence. This, they hope, might just come about if the settlement is disapproved and the case is tried on its merits.

A lot of experts are convinced that taken to its logical conclusion the Google Book Search litigation will be decided in favor of Google, at least based on the original plan of scanning entire libraries only for the limited purpose of coming up with fully searchable databases. These experts rely on the case of *Perfect 10 v. Google*¹⁷⁴ for support which while is not a precedent that is on all fours with the facts of the present controversy is persuasive.

¹⁷³ The thought is ascribed to Professor Lessig: "But fair use in America simply means the right to hire a lawyer to defend your right to create. And as lawyers love to forget, our system for defending rights such as fair use is astonishingly bad—in practically every context, but especially here. It costs too much, it delivers too slowly, and what it delivers often has little connection to the justice underlying the claim. The legal system may be tolerable for the very rich. For everyone else, it is an embarrassment to a tradition that prides itself on the rule of law." (Lawrence Lessig, *Free culture : how big media uses technology and the law to lock down culture and control creativity* (Penguin, 2004) at p. 187)

¹⁷⁴ *Perfect 10, Inc. v. Amazon.com, Inc.*, 487 F.3d 701, 733 (9th Cir. 2007); The case title is *Perfect 10, Inc. v. Amazon.com, Inc.* after Google's case was consolidated with that of Amazon that had a similar cause of action.

In that case, Google was sued for having creating thumbnail images (not the full image) that belonged to Perfect 10. Because Google has indexed the images, said images were displayed by Google when a search term that is entered by a user of Google's search engine matches the indexed image.

The circuit court ruled in favor of Google having found Google's use of the thumbnails as transformative use following a similar holding in the case of *Kelly v. Arriba Soft Corporation*¹⁷⁵. What the court meant was that Google did not intend to compete with Perfect 10 by indexing the thumbnails for purposes organizing them to aid their easy retrieval. Google did not intend to create its own market for the thumbnails and even the claim that such thumbnail images would also affect Perfect 10's plan to market thumbnail images for cell phones was not found as sufficient to affect the holding in favor of Google. The court ruled that "the significantly transformative nature of Google's search engine, particularly in light of its public benefit, outweighs Google's superseding and commercial uses of the thumbnails in this case," cognizant of "the importance of analyzing fair use flexibly in light of new circumstances [,] ... 'especially during a period of rapid technological change.'"¹⁷⁶

5.2.3 From Fair Use to Pay for Every Use: Some Misgivings

Given the stakes in the Settlement Agreement, it is expected that the court will take some time digesting the positions of the parties and the interest groups before deciding on the fate of the agreement. Even the US Department of Justice has joined the fray to ensure that competition is not distorted by the introduction of the services contemplated by the Settlement Agreement.

What happens if the parties have their way and the Settlement is approved? Will such Settlement benefit the consumers (i.e. readers and the public general) and increase public welfare? Some experts believe that the settlement at its present state will not ultimately lead to an optimal outcome unless certain provisions of the agreement are improved. The foremost of these concerns include the possibility of Google eventually manipulating the price upwards as a natural consequence of its dominance in the market for the service. Thus, there is a proposal to allow Google and the Registry to operate the services via a consent decree in order for a government oversight to be able to continually review the services particularly the setting of prices.¹⁷⁷ Another concern is the danger of entrusting the management of

¹⁷⁵ *Kelly v. Arriba Soft Corporation*, 336 F.3d 811 (2003). This is the case James Boyle was referring to in the quote incorporate in this thesis at footnote 28, *supra*. "I would not have thought that a search engine that catalogued and displayed in framed format the digital graphics found on the Internet would be sued for infringing the copyrights of the owners of those images."

¹⁷⁶ *Perfect 10, Inc. v. Amazon.com, Inc.*, at 723

¹⁷⁷ Andrews, *supra* note 172

virtually all of the world's culture captured in books in the hands of a private entity who may opt for a windfall – profits being its ultimate reason for existence -- than hold onto the corpus of knowledge as a fiduciary of society in general. The settlement will have to be amended to at least modify the marketable nature of the corpus and impose limitations to such transfer to avoid the unthinkable scenario of one company having control over all digital information in books with the concomitant power to deny access to such information under the pretext that the information contained in the corpus is private property whose full control and disposal depend on the owner's wish if not whim. This general apprehension is also echoed in Europe, particularly by Prof. Annette Kur in her statement before the Council of Europe Committee on Culture, Science and Education:

[I]f certain search engines become sole source-databases for library stocks and/or other sources of information and knowledge, this may lead to serious distortions on the market for informational products and services, potentially resulting in misuse of dominant positions, most notably in excess pricing. For this reason, the developments in this field must be subject to adequate control, in particular by the competition authorities.¹⁷⁸

It is thus not surprising that the Open Book Alliance has proposed a change in the settlement agreement to charge a “neutral civic not-for-profit organization” with the management of the services envisioned in the agreement¹⁷⁹ This comment takes special significance in view of the fact that the settlement has also been objected to because it is claimed to have gone beyond the actual controversy of the fair use status of book digitization and indexing inasmuch as the settlement now contemplates authorizing the parties to engage in a full commercial exploitation of the scanned books, a move that some doubt the court is without jurisdiction to approve¹⁸⁰.

¹⁷⁸ Christophe Geiger, “The Future Of Copyright In Europe: Striking A Fair Balance Between Protection and Access To Information”, I.P.Q. 2010, 1, 1-14 citing the presentation by A. Kur, former president of ATRIP (International Association for the Advancement of Teaching and Research in Intellectual Property), Hearing on Copyright in Europe, Parliamentary Assembly of the Council of Europe, Committee on Culture, Science and Education, Paris, December 9, 2009 (AS/Cult (2009) 05, 15, January 15, 2009, also available at <http://www.atrip.org>

¹⁷⁹ See Open Book Alliance Calls for Scrapping Google Settlement, with Public Guardian available at <http://www.libraryjournal.com/article/CA6715477.html?nid=2673&source=link&rid=1105906703> accessed on April 19, 2010

¹⁸⁰ The case in point is *Local Number 93, Int'l Assoc. of Firefighters v. City of Cleveland* 478 U.S. 501 (1986) where the court is supposed to have ruled that it may “provide broader relief [in a class action that is resolved before trial] than the court could have awarded after a trial.” See “Google Settlement Fairness Hearing, Part Two: DOJ Expresses Opposition; Parties Mount Vigorous Defense” available at <http://www.libraryjournal.com/article/CA6719808.html> accessed on April 21, 2010 ; Google Brief states: [“*Firefighters*”] established that district courts have the authority to approve forward-looking settlements within very broad limits designed to ensure that there is jurisdiction over the dispute and that the settlement is appropriate to the controversy before the court. The Supreme Court in *Firefighters*, like many other courts, approved forward-looking relief, and the settlement proposed here is well within the capacious

The more relevant objection that go in the heart of this thesis is the treatment of the orphan works in that the parties cannot delegate unto themselves the authority to solve the orphan works problem as the problem necessitates a modicum of democratic discourse among all affected sectors of society. That discourse is best done in the halls of congress to open a more extensive consideration of the issues involved and not reduce the issue into a mere contractual issue for the authors/copyright holders of orphan authors. For one, an issue of vital importance is whether it is possible for orphan works to be returned to the public domain after a number of years of reasonably diligent search and public notice of such search for owners, a case of true orphan works, a determination of rights that only congress can validly make effective.

Whether the orphan works problem is partially resolved contractually through the Google Book Search Settlement Agreement or legislatively through the US Congress or the EU institutions, in case of European works (or even through a far reaching copyright treaty), a holistic solution is more likely to be found, one that all parties would be bound to respect, if human rights is incorporated in the discourse.

5.2.4 Google Book Search from a Human Rights Perspective

On its whole, the Google Book Search Project as defined in the Settlement Agreement is without a doubt a laudable effort considering its impact on society. The sheer volume of knowledge that will be made available to the world will surely lead to the enrichment of existing human intelligence and understanding and eventually lead to the creation of new knowledge in unprecedented scales. In its very essence, it directly provides users with the tool they are supposed to have at their disposal to understand the world.

While the original Project was intended to provide its users access only to public domain works, the Project as now contemplated grants such access not only to public domain works but also to copyrighted works that include the problematic orphan works. The user is thus offered a fully functional product. For copyrighted works, the product does not only point you to the book you want to read but offers you the possibility of just clicking¹⁸¹ into the title to view the digital copy of the book subject of course to the

standards of that case. Indeed, *Firefighters* expressly permits a federal court to approve a settlement that “provides broader relief than the court could have awarded after a trial.” 478 U.S. at 525. “Brief Of Google Inc. In Support Of Motion For Final Approval Of Amended Settlement Agreement” at p. 9 accessed from http://www.scribd.com/doc/26791328/Google-Brief-Feb-112010?secret_password=&autodown=pdf on April 21, 2010

¹⁸¹ Today’s digital natives demand that the information they seek be accessible through the internet, aptly also called the information superhighway. Boyle’s Public Domain (*supra*, note 6 at p. 10) mentions the author’s son himself who seem to develop an expectation that everything one seeks should appear in one’s screen at the click of the mouse.

payment of a fee. This latter condition, the payment of a fee, by itself is of no moment and does not in any way weakens the utility of the product. It however becomes part of the problem if access to the product is deprived as a result of pricing that are unreasonably set. Any unfair pricing on the part of Google or the Registry directly contravenes the mandate clearly laid down in General Comment No. 21 which provides:

39. Culture as a social product must be brought within the reach of all, on the basis of equality, non-discrimination and participation. Therefore, in implementing the legal obligations enshrined in article 15, paragraph 1 (a), of the Covenant, States parties must adopt, without delay, concrete measures to ensure adequate protection and the full exercise of the right of persons living in poverty and their communities to enjoy and take part in cultural life. In this respect, the Committee refers States parties to its statement on poverty and the International Covenant on Economic, Social and Cultural Rights.¹⁸²

The Comment explicitly suggests the implementation of policies for the provision of affordable access to cultural goods in this wise:

68. The Committee encourages States parties to make the greatest possible use of the valuable cultural resources that every society possesses and to bring them within the reach of everyone, paying particular attention to the most disadvantaged and marginalized individuals and groups, in order to ensure that everyone has effective access to cultural life.¹⁸³

It is also worth re-emphasizing at this point paragraph 73 of General Comment No. 21 which expressly points to the members of civil society including private organizations and businesses as having specific responsibilities in relation to the effective implementation of the right of everyone to take part in cultural life, and that states parties should regulate the responsibility incumbent upon the corporate sector and other non-State actors with regard to the respect for this right.

Simply put, Google and the Registry have a responsibility as corporate actors or as members of civil society in general to price their service fairly failing in which the US through the appropriate agency may then regulate the affairs of such private actors to ensure their compliance with human rights.

The pioneering or initial attempts at digitization of the books in the public domain particularly by non-profit institutions only prove that the general public interest is towards granting access to knowledge. The right to access is not only a right in the general interest but a human right because the body of knowledge stored in books is embraced by the term culture as it is

¹⁸² General Comment No. 21, *supra* note 64 at par. 39

¹⁸³ *Ibid.*, at par. 68

defined under existing human rights instruments and interpreted in General Comment No. 21¹⁸⁴. It then follows that the right to access to knowledge in books is embraced by the right to culture. That right to culture as has been explained earlier is a freedom that, on one part, inhibits States from interfering with its exercise and, on the other, requires States to ensure its enjoyment by facilitating and promoting such right to culture and access to cultural goods.

In the context of the Google Book Search Project, the only major setback in using the human rights language in argumentation is that the forum where the case is pending has itself not ratified the ICESCR. Still the United States may be held liable to comply with its obligations to respect, protect and fulfill the rights adverted to here considering that it is bound by its assent to the Universal Declaration of Human Rights, a document that has now achieved the status of customary international law¹⁸⁵ and a document from which the similar set of rights being adverted to here have been derived.

Accordingly, it may be argued that the US and its instrumentalities are obligated to facilitate access to cultural goods because American society has a human right to enjoy the benefits of the Google Book Search Project. That right is unfettered in so far as the access to books in the public domain is concerned. The state cannot justify any interference of the right to culture. Such interference may however be justified in the case of books that are in-copyright including orphan works which under existing copyright law are afforded protection from unpermitted uses. To the extent that such copyright falls within the narrow definition under General Comment No. 17 on the right of the author to benefit from the material and moral interests resulting

¹⁸⁴ “[C]ulture, for the purpose of implementing article 15 (1) (a), encompasses, inter alia, ways of life, *language, oral and written literature*, music and song, non-verbal communication, religion or belief systems, rites and ceremonies, sport and games, methods of production or technology, natural and man-made environments, food, clothing and shelter and the arts, customs and traditions through which individuals, groups of individuals and communities express their humanity and the meaning they give to their existence, and build their world view representing their encounter with the external forces affecting their lives. Culture shapes and mirrors the values of well-being and the economic, social and political life of individuals, groups of individuals and communities.” (Ibid., at par. 13)

¹⁸⁵ See Peter K. Yu, Ten Common Questions about Intellectual Property and Human Rights, 23 Ga. St. U. L. Rev. 709, 728-30 (2007) at p. 717; and Peter K. Yu, Reconceptualizing Intellectual Property Interests in a Human Rights Framework, 40 U.C. Davis L. Rev. 1039 (2007) at p. 1046, *supra* note 6: See John P. Humphrey, *Human Rights and the United Nations: A Great Adventure* 75-76 (1983) (providing evidence that UDHR “is now part of the customary law of nations”); Richard Pierre Claude, *Scientists’ Rights and the Human Right to the Benefits of Science*, in *Core Obligations: Building a Framework for Economic, Social and Cultural Rights* 247, 252 (Audrey Chapman & Sage Russell eds., 2002) [hereinafter *Core Obligations*] (“[A]fter fifty years, the Universal Declaration ... has begun to take on the qualities of ‘customary international law.’”); Paul Torremans, *Copyright as a Human Right*, in *Copyright and Human Rights*, *supra* note 12, at 1, 6-7 (“[W]here initially Member States were not obliged to implement it on th[e] basis [that the Declaration is merely aspirational or advisory in nature], it has now gradually acquired the status of customary international law and of the single most authoritative source of human rights norms.”). See generally Theodor Meron, *Human Rights and Humanitarian Norms as Customary Law* (1991).

from his or her creation, the right to access such orphan works will have to be balanced or reconciled with the former.

In the end, however regard had to be had on the fact that copyright “*are first and foremost means by which States seek to provide incentives for inventiveness and creativity, encourage the dissemination of creative and innovative productions, as well as the development of cultural identities, and preserve the integrity of scientific, literary and artistic productions for the benefit of society as a whole.*”¹⁸⁶. What this basically means is that even if the copyright held by authors of orphan works are characterized as a human right, the balance will have to consider the fact that copyright is but an instrument to facilitate the enjoyment of the right to culture. Thus while the human right to the material and moral interests of authors of orphan works have to be respected, there has to be a resolution to the highly aberrant and unusual situation where the authors of the orphan works themselves appear to be waiving, or not to be interested, to exercise this human right having virtually abandoned such right by failing to take diligent steps to protect such right, while those who expect to exercise their right to culture from the availability of the author’s “orphaned” creation are themselves denied the right to use the said works as a consequence.

Reason then dictates that where, despite a system of registration, public notification and diligent search covering orphan works, the authors remain untraced, a rule of dispossession of such right should come as a result. The dispossession may be in the form of a declaration that orphan works are deemed abandoned¹⁸⁷ and effectively ownerless that empowers the State as the grantor of the right to plow back the creative work into the public domain. This would be analogous to *escheat*¹⁸⁸ in common law. The staleness of a copyright holder’s claim, on the other hand, could be argued using the equitable doctrine of *laches*¹⁸⁹

It is only in this manner that the two conflicting human rights are truly reconciled. In fact, it would be highly anomalous for a collective rights organization to continue “representing” authors of orphan works after a determination that they would no longer be turning up after having taken all diligent steps to locate them. On the other hand, it is only by releasing those orphan works with untraceable authors or assignees to the public domain

¹⁸⁶ General Comment 17, *supra* note 63, at par. 1

¹⁸⁷ See for example Lydia Pallas Loren, Building a Reliable Semicommons of Creative Works: Enforcement of Creative Commons Licenses and Limited Abandonment of Copyright, 14 Geo. Mason L. Rev. 271, 319-20 (2007) explaining the judicial doctrine of copyright abandonment in US law.

¹⁸⁸ Escheat is the “reversion of property (esp. real property) to the state upon the death of an owner who has neither a will nor any legal heirs.” [Black’s Law Dictionary (8th ed. 2004) accessed via Westlaw International]

¹⁸⁹ Laches (Law French “remissness; slackness”) is the “unreasonable delay in pursuing a right or claim — almost always an equitable one — in a way that prejudices the party against whom relief is sought. — Also termed *sleeping on rights*.” [Black’s Law Dictionary (8th ed. 2004) accessed via Westlaw International]

that solves the issue of uncertainty once and for all and frees up society from the orphan works dilemma and thereupon to enjoy the right to participate in cultural life through their ability to utilize these works whether for creative purposes or otherwise, without the anxiety of being sued for infringement.

This is a response that addresses the problem at its root cause. A solution that depend on the limitation and exceptions rule suffer from a practical difficulty in view of the 3-step test that itself requires a conceptual overhaul.

Considering however that it turns the Berne Convention on its head (it disengages the automatic 50-year minimum protection for copyrighted works even of authors of orphan works in Union members-states) any move that adopts the above suggestion should be coursed through WIPO. But then again, it could be argued that no such treaty amendment is necessary because the guaranteed minimum 50-year term-protection is a right to be protected in national law only if there is reason to assume that the owner of the said right still intends to hold the right against the whole world. The assumption that the copyright owner of an orphan work still wish to hold such right adversely against the world disappears in a system that provides for an acceptable public notification of orphan works and authors and such additional methods that would ascertain that the authors are no longer expected to claim the orphans. There is no point for any State to continue protecting orphan works to its full term (lifetime of author plus 70 years, in most cases) without making the very long period of time required to lapse conspicuously absurd to reasonable thinking persons. Finally, it is axiomatic in law that one who sleeps on his or her rights, loses it. If the right holder does not show any interest in his or her work even during his or her lifetime, why should the state continue protecting it for another 70 years after his or her death?

6 Conclusion

The existence of orphan works is a symptom of a systemic malady in modern copyright law – a disease characterized by excessive use of copyright and disregard of the virtues of sharing and the public domain. In particular, orphan works is the direct result of insanely or obscenely long copyright terms that go beyond the reasonable periods for exploitation. But while the root cause of the problem is easy to identify, policy makers and the affected sectors grapple as they try to debate on the sanity of the copyright term. This is one area of the so-called copyright wars where the copyright industry continues to have an upper hand. The best evidence for this is the current legal regime in the US where the entrenched interest of the copyright industry has prevailed over the interest of the public domain in a landmark ruling that upheld the right of Congress to extend copyright terms and to extend them retroactively, if necessary. That case was *Eldred*. And there the fate of the orphan works was sealed because in a regime where Congress has a right to postpone the end of the copyright term, orphan works will continue to pile up and fall into the copyright black hole.

It is easy to see that the purpose of copyright is not served by a regime that allows for the creation of orphan works – works that have been estranged from their authors either by abandonment or lack of interest to claim copyright over such works or by sheer lack of knowledge of such automatic right to one's creations. This thesis had shown that the orphan works phenomenon forces the creative process to grind to a halt and upsets the supposed balance between copyright and the public domain. But where the balance lies is the crux of the matter. Arguments that rely on the historical and philosophical roots of copyright and the public domain have certainly helped in understanding the problem but they do not enlighten the path that leads to a solution. New paradigms need to be considered. A human rights approach towards reconciling the conflicting positions of the stakeholders in the copyright-public domain debate is one such new paradigm. Human rights have the potential of refocusing the discourse on the shared role of copyright and the public domain because of its universality. As a framework that all stakeholders recognize in common, solutions that come out of such framework could be freed from strategic arguments that have characterized the current debate.

The incorporation of a human rights perspective in copyright policy is not only helpful in ensuring the validity and legitimacy of legislative acts of states¹⁹⁰. It is even helpful in guiding private-ordered solutions to conflicts in commercial dealings that is clothed or embedded with public or societal interest. We have seen this in the case of Google and its mass digitization project (pioneering in terms of the scale) that forced the copyright industry

¹⁹⁰ States are likely to pass laws that do not conflict with fundamental and human rights since these rights are enshrined in international instruments that they ratified and more often than not incorporated in their respective basic charters.

to react with a suit. The Google project (whether in its original form or as now contemplated pursuant to the terms of the amended Settlement Agreement with the authors and publishers) has vast human rights implications. It puts into fruition what otherwise had only been an ideal human right. Google has turned into reality what most States could only aspire for – the people’s right to culture in practice, that is – the right of everyone to experience one’s own culture and those of others by just clicking on a link. If the Internet were a human right¹⁹¹, that human right becomes even more relevant with the kind of innovative content and services that Google has created and will continue to create for humanity and progress. It would also mean that the global community has a right to access Google Book Search from anywhere¹⁹² in the world as an important step towards the co-existence of different cultures.

Equally notable is that Google has also forced a solution to the market-failure problem that the orphan works¹⁹³ presented. Even as a palliative measure that alleviates the orphan works dilemma, the Google Book Search project can argue its reason for existence on the basis of human rights. Under a human rights perspective, the Project interprets the balance of the rights of the authors of orphan works and the right of the people to access to knowledge and culture (realized through Google making those works available in the Internet) in favor of the latter. Under that same human rights lens, the interrelationship between the rights of the authors of the orphan works and the rights of the people to culture is such that the former is the means in order to attain the latter. That end has to be fulfilled by interpreting the functional character of such author’s human right to benefit from the material and moral interests of his or her creations. It is worth repeating in this respect that this particular human right of authors does not necessarily coincide with the rights of authors as defined in present copyright law. Absent such coincidence, policy makers need not even bother striking a reasoned balance because the human right to culture should as a matter of principle have primacy over a copyright “right” that lacks a human right character.

Google has only blazed the trail for the others for certainly there will be more innovative products and services that will come (some of which will be radical and disruptive) that exploit the vast potential of the internet. If

¹⁹¹ Some states have declared access to the internet as a human right. In France, for example, the French Constitutional Council recognized in its Decision 2009-580 DC of June 10, 2009, Official Gazette of June 13, 2009, 9675 (par.12) a "right to access the internet" in this wise: " ... in the current state of on-line public media and in view of the importance of these services for participation in democratic life and the expression of ideas and opinions, this right presupposes the freedom to accede to these services". (Christophe Geiger, “The Future Of Copyright In Europe: Striking A Fair Balance Between Protection and Access To Information” , *supra* note 178)

¹⁹² Par. 22 of General Comment No. 21 states that “no one shall be excluded from access to cultural practices, goods and services.”

¹⁹³ Google solves the problem with existing orphan works by assigning the task of finding orphan authors to the Registry. It does not however solve the problem of new orphan works which could only be eradicated by a registration system and a shorter copyright term, as will be further explained in this concluding part.

Google is offering today's society with the possibility of accessing virtually all the books in the world, it is only a matter of time before others think of ways for people to access just about any cultural goods and services via the internet. It would be unthinkable for States to begrudge Google, as an innovator, for having found a temporary yet workable solution to the orphan works problem and try to weaken its efficacy through hostile policy or judicial interpretation of their respective national copyright laws that frowns upon more access and the sharing of content. If General Comment No. 21 is of any relevance, States should recognize that the world has shrunk and national policies have to be kept attuned to global interdependence in cultural, political and commercial relationship.

Finding a legislative solution to the orphan works problem that take into consideration the accessibility of such works across cultures must now be in each State's agenda. It must be in the agenda of international organizations tasked to formulate harmonized copyright policy, like the WIPO and the WTO. It is submitted that an approach that take into account human rights into the search for solution has a fair chance of striking a balance that satisfies the public interest in copyright and the public interest in the public domain.

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