

ABANDONING THE ORPHANS: AN OPEN ACCESS APPROACH TO HOSTAGE WORKS

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ABSTRACT

The lengthening of the duration of copyright protection and the elimination of copyright registration formalities have contributed to the rise of so-called orphan works: works that remain subject to copyright law but whose owners cannot be identified and located by someone who wishes to make use of the work in a manner that requires permission of the copyright owner. In this Article I examine one of the root causes of the inability to address the orphan work problem: the metaphor of the “orphan” itself. I propose that these works should not be viewed as orphans, but rather as “hostages”—constrained in their movement by the restricting combination of the set of rules established by copyright law and the absence of the owner who could release the works from what binds them in their confinement.

The hostage metaphor leads to a clearer recognition that what is needed is not a stand in for the “parent” of these orphans, rather what is called for is an incentive for responsible parties to operate as “special forces” to free the hostages. I propose a limited immunity for entities that act as “special forces” in freeing the hostages. The immunity should be available when an entity non-negligently identifies a work as a hostage work and provides an open access copy of that work with the hostage-freeing information attached in human and machine readable form. I also suggest that courts should employ equitable doctrines to limit the infringement remedies available against derivative work creators that would discourage copyright owners from delaying in making their presence and availability known. Adopting this approach would provide an appropriate level of protection for copyright owners and significantly reduce a form of waste created by the hostage work problem.

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I. INTRODUCTION

Many aspects of the copyright protection systems in the United States and other countries have contributed to the troubling situation now known as the “orphan work problem.” The lengthening duration of copyright protection—along with the elimination of the requirements for copyright registration, copyright notices on published copies, and renewal registrations—has contributed to the rise of so-called “orphan works”:¹ works that remain subject to copyright law but whose owners “cannot be identified and located by someone who wishes to make use of the work in a manner that requires permission of the copyright owner.”²

1. David R. Hansen, *Orphan Works: Causes of the Problem* (Berkeley Digital Library Copyright Project, White Paper No. 3, 2012), available at <http://ssrn.com/abstract=2038068>.

2. REGISTER OF COPYRIGHTS, U.S. COPYRIGHT OFFICE, REPORT ON ORPHAN WORKS 1 (2006), available at <http://www.copyright.gov/orphan/orphan-report.pdf> [hereinafter REPORT ON ORPHAN WORKS]; see also Orphan Works Notice of Inquiry, 70 Fed. Reg. 3,739, 3,739 (Jan. 26, 2005) (describing orphan works as those “whose owners are difficult or even impossible to locate”).

Orphan works result from market failure in which a potential user of a copyrighted work faces insurmountable transaction costs to obtain authorization from the rights holder. Facing the risk of infringement liability, the user foregoes the use, even though the parties would have struck a deal for that use had the user been able to locate the copyright owner.

Proposals abound for dealing with the orphan work problem.³ In 2006, the U.S. Copyright Office issued a massive report.⁴ In 2008, proposed legislation passed the U.S. Senate,⁵ but failed to win passage in the House of Representatives.⁶ In 2011, the European Commission proposed a directive addressing the orphan work problem.⁷ Today the class-action styled litigation over the Google Book Search project, the proposed settlement of which would have addressed aspects of the orphan work problem, remains in limbo.⁸ A recent lawsuit filed against the HathiTrust, a consortium of some of the country's leading research institutions and libraries, which sought to provide access to works it identified as "orphans," is in the earliest phases of litigation.⁹ And scholars continue to propose reforms to eliminate or at least ameliorate the problem.¹⁰

A variety of competing dynamics contribute to the inability to address the orphan work problem. The stakeholders in a solution include the wide array of potential "users"¹¹ of copyrighted works: libraries, museums,

3. For an overview of the variety of proposed solutions, see David R. Hansen, *Orphan Works: Mapping the Possible Solution Spaces* (Berkeley Digital Library Copyright Project, White Paper No. 2, 2012), available at <http://ssrn.com/abstract=2019121>.

4. See REPORT ON ORPHAN WORKS, *supra* note 2.

5. S. 2913, 110th Cong. (2008).

6. Orphan Works Act of 2008, H.R. 5889, 110th Cong. (2008).

7. *Proposal for a Directive of the European Parliament and of the Council on Certain Permitted Uses of Orphan Works*, at 10, COM (2011) 289 final (May 24, 2011), available at http://ec.europa.eu/internal_market/copyright/orphan_works_en.htm [hereinafter *Proposal for a Directive*]. In October 2012, as this Article was preparing to go to press, the European Union approved a final directive. Directive 2012/28, of the European Parliament and of the Council on Certain Permitted Uses of Orphan Works, 2012 O.J. (L 299) [hereinafter *Final Directive*].

8. See *Authors Guild v. Google Inc.*, 770 F. Supp. 2d 666, 669 (S.D.N.Y. 2011) (rejecting the Amended Settlement Agreement).

9. The lawsuit, *Authors Guild, Inc. v. HathiTrust*, No. 11-CIV-6351 (S.D.N.Y. filed Sep. 12, 2011), was filed in 2011. In October, the district court granted the HathiTrust's motion for judgment on the pleadings concerning its Orphan Works Project because of concerns over the claims' ripeness for adjudication. See *Authors Guild, Inc. v. HathiTrust*, 11 CV 6351 HB, 2012 WL 4808939, at *8 (S.D.N.Y. Oct. 10, 2012).

10. Indeed, in this Article I provide my own suggestions for reforms.

11. The terminology of "users" in the copyright context has its own metaphor power. The other instance in which the term "users" is used routinely is to describe those who are addicted to illegal drugs.

archives, educational institutions, movie producers, educators, and anyone else who would like to build on the expressive works of the past, as well as owners of copyrights in works that might erroneously be labeled as orphans. As James Grimmelmann noted, in the ongoing orphan work debate, “hope, fear, and anger will tug at stakeholders in subtle and complicated ways.”¹²

In this Article I examine one obstacle to addressing the orphan work problem: the metaphor of the “orphan” itself.¹³ I begin in Part II with an exploration of the orphan metaphor and potential alternative metaphors that could be used to identify these works. A variety of doctrines in real and chattel property provide interesting insights that help inform the approach proposed later in the Article. I conclude that these works should not be viewed as “orphans,” but rather as “hostages”—constrained in their movement by the restricting combination of copyright law and the absence of copyright owners who could release works from their confinement.

The hostage metaphor leads to a clearer recognition that stand-ins for the “parents” of these “orphans” are not the solution. Rather this problem calls for an incentive to encourage responsible parties to operate as “special forces” to free the “hostages.” Part III proposes limited immunity for entities that act as “special forces” in freeing the hostages by, first, responsibly generating and disseminating reliable information concerning the copyright status of a work, and second, by providing access to a digital copy of the work that adheres to basic open access principles. Part III also urges courts to employ equitable doctrines to limit the remedies available against derivative work creators so as to discourage copyright owners from delaying in making their presence and availability known.

As further developed in Part III, I offer this open access model in a way that could be implemented either legislatively or judicially, through a combination of the ever-malleable fair use balancing test and a variety of equitable doctrines. This model would affect the remedies that courts grant in lawsuits brought by resurfacing copyright owners. The system has the potential to facilitate the development and dissemination of reliable information, increase the public benefit through greater access to hostage works, and encourage calculated risk-taking by derivative work makers. Such a system would provide appropriate protection for copyright owners and at the same time significantly reduce a form of waste created by the hostage work problem.

12. James Grimmelmann, *The Orphan Wars*, *EDUCAUSE REV.*, Jan. 23, 2012, <http://www.educause.edu/ero/article/orphan-wars>.

13. See WILLIAM PATRY, *MORAL PANICS AND THE COPYRIGHT WARS* 76–78 (2009).

II. EXAMINING THE ORPHAN METAPHOR AND ALTERNATIVES

Metaphors can have powerful effects in both identifying problems and in shaping approaches to address them. Indeed, as others have observed, “metaphors are not merely literary, but cognitive. Language maps deep cognitive structures and thus mirrors cultural patterns and social structures.”¹⁴ The best persuaders, including lawyers and lobbyists, have long exploited the strategic use of metaphors. Examining the orphan metaphor exposes the important ways in which it has swayed our opinions both of what the problems are and what the solutions might be. Exploring alternative metaphors can productively expand thinking on this critical problem in copyright law.

A. ORPHANS

The choice to call certain works “orphan” works fits comfortably within another significant and longstanding image in copyright: the romantic author. “The romantic author is the individuated figure for whose benefit, reward, and encouragement the conferral and expansion of IP rights has been justified.”¹⁵ The vision of the romantic author creating works of genius that deserve protection has been a common story used to support the notion of granting copyright in the first place.¹⁶

In the metaphor of the romantic author, the works he creates are his children, born of his labor and genius.¹⁷ He receives the right to control, and thus protect, his children. Using the word “orphans” to describe works whose copyright owners cannot be located pulls on that metaphor and triggers the concerns any humane person would have toward abandoned children. These orphans have suffered the tragic loss of their parents. These are works whose parents have been lost or killed, or whose parents have long

14. George H. Taylor & Michael J. Madison, *Metaphor, Objects, and Commodities*, 54 CLEV. ST. L. REV. 141, 159 (2006).

15. Keith Aoki, *Distributive and Syncretic Motives in Intellectual Property Law (with Special Reference to Coercion, Agency, and Development)*, 40 U.C. DAVIS L. REV. 717, 732 (2007).

16. See Anupam Chander & Madhavi Sunder, *The Romance of the Public Domain*, 92 CALIF. L. REV. 1331, 1339 (2004); Mark A. Lemley, *Romantic Authorship and the Rhetoric of Property*, 75 TEX. L. REV. 873, 886 (1997) (reviewing JAMES BOYLE, SHAMANS, SOFTWARE, AND SPLEENS: LAW AND CONSTRUCTION OF THE INFORMATION SOCIETY (1997)).

17. In the romantic visions, the author is always male. See, e.g., Rosemary J. Coombe, *The Properties of Culture and the Politics of Possessing Identity: Native Claims in the Cultural Appropriation Controversy*, 6 CAN. J.L. & JURIS. 249, 250 n.7 (1993); Carys J. Craig, *Reconstructing the Author-Self: Some Feminist Lessons For Copyright Law*, 15 AM. U. J. GENDER SOC. POL'Y & L. 207, 242 (2007).

ago abandoned them.¹⁸ We reflexively begin to believe that orphan works need the kind of protection that society provides to abandoned children.¹⁹

The state protects orphaned children for a certain amount of time, until they reach the age of maturity or are able to care for themselves.²⁰ The state stands *in loco parentis*, tasked with protecting the orphans from the evils of the world. The perceived evils of the world are multifold and include Dickensian images: bleak orphanages, barren workhouses, and street gangs assembled by Artful Dodger of *Oliver Twist*, where the unfortunate children are put to work for commercial entities exploiting whatever commercial value can be obtained from the children's labor.²¹ These orphan exploiters fail to invest in or care for the children properly, and yet usurp the work-value of the orphan child. This implied narrative of the potential abuse has impeded the passage of orphan works legislation.

Orphan works, however, are quite different from abandoned children.²² First, the "parent" of the orphan work may not, in fact, be a single romantic author. Copyrighted works often are created through collaboration and often are prepared in an employment context.²³ In many instances the "parent," or author, is not an individual at all, but rather a corporation or other non-

18. PATRY, *supra* note 13, at 77.

19. *Id.*; see Taylor & Madison, *supra* note 14, at 162 (noting: "[i]f copyrighted works implicitly have 'parents,' rather than authors and publishers, the 'orphan' label is consistent with viewing the orphan works problem much as child welfare advocates view the problem of abandoned and abused children"). That desire to "protect" the "orphans" may be part of what has led to proposals for regimes that require licensing fees for the use of orphan works be placed into a kind of escrow, see Hansen *supra* note 3, at 16–18, and to calls for the court to appoint representatives to advocate on behalf of the absentee "parents," see, e.g., Amended Settlement Agreement at 82, Authors Guild, Inc. v. Google Inc., No. 05 CV 8136 (S.D.N.Y. Nov. 13, 2009), available at <http://www.googlebooksettlement.com/intl/en/AmendedSettlement-Agreement.zip> (defining "Unclaimed Works Fiduciary").

20. See, e.g., Or. Rev. Stat. §§ 418.005, 418.015, 418.027 (2012). All fifty U.S. states have systems in place to protect orphaned children. See CHILD WELFARE INFORMATION GATEWAY, U.S. DEPARTMENT OF HEALTH AND HUMAN SERVICES, ONLINE RESOURCES FOR STATE CHILD WELFARE LAW AND POLICY (2011), available at http://www.childwelfare.gov/systemwide/laws_policies/statutes/resources.pdf.

21. CHARLES DICKENS, THE ADVENTURES OF OLIVER TWIST 5, 11–12, 57–60, 413 (Boston: Ticknor and Fields 1866) (1838), available at <http://books.google.com/books?id=1bMXAAAAAYAAJ>.

22. Lior Jacob Strahilevitz, *The Right to Abandon*, 158 U. PA. L. REV. 355, 380–84 (2010) (discussing the intentional abandonment of children).

23. Catherine Fisk, *Authors at Work: The Origins of the Work-for-Hire Doctrine*, 15 YALE J.L. & HUMAN. 1 (2003).

human entity.²⁴ If works are not created by romantic solo authors, their creations are not “children” that may be orphaned upon the author’s demise.

Further, what matters in the context of obtaining permission for a particular use is not authorization from the author or “parent” of a work. Rather, when someone seeks to use a work in a manner that would constitute infringement, authorization of the copyright *owner* is required; authorization from the “parent” author is irrelevant unless the author has retained ownership of the copyright.²⁵ While in the United States copyright ownership vests initially in the author,²⁶ the Copyright Act expressly provides for the ability to transfer the copyright rights in whole or in part.²⁷ Some works become “orphans” through the death of the individual author who created the work and retained ownership of the copyright. Other works, however, are “orphaned” because the copyright had long ago been sold and either the assignee entity no longer exists or the chain of title can no longer be traced.²⁸ The important legal distinctions between the individuals who create a work, the legal author of a work, and the copyright owner of a work, are lost when the orphan metaphor is employed.²⁹

Orphan works are also quite different from abandoned or orphaned children with respect to what occurs upon maturation. When an orphaned child reaches the age of maturity, he or she assumes control of, and becomes responsible for, his or her own caretaking and destiny. The maturation of a copyrighted work, on the other hand, results in the work entering the public domain and its entire expressive content becoming part of the storehouse of knowledge.³⁰ A “matured” orphan work is thus freely available for others to

24. In the United States, the authors of works prepared by employees in the scope of their employment are not the employees but rather the employers—whether they are corporations, partnerships, or other entities. *See* 17 U.S.C. § 201(b) (2010) (specifying that in the case of “works made for hire,” the “author” is the hiring party); *see also id.* § 101 (defining a “work made for hire” to include works made by an employee within the scope of employment).

25. *See, e.g., American Geophysical Union v. Texaco*, 802 F. Supp. 1, 27 (S.D.N.Y. 1992) (stating that “[o]nce an author has assigned her copyright, her approval or disapproval of [defendant’s use] is of no further relevance”).

26. 17 U.S.C. § 201(a).

27. *Id.* § 201(d).

28. REPORT ON ORPHAN WORKS, *supra* note 2, at 26–29. The divisibility of the rights granted to a copyright owner further exacerbates the orphan work problem.

29. Even the Copyright Office itself uses the paired parent/orphan metaphor without careful attention to this distinction. *See, e.g., id.* at 34 (stating that the term orphan “certainly must mean what it implies: that the ‘parent’ of the work is unknown or unavailable”).

30. Even prior to the expiration of copyright protection, the ideas and other unprotected elements of the copyrighted work are already part of copyright’s public domain. 17 U.S.C. § 102(b). “[E]very idea, theory, and fact in a copyrighted work becomes instantly

copy and build upon. An orphan work's passage into the public domain permits users to incorporate expression from the older work into new expressive works of authorship. In this way, a matured copyrighted work is "owned" by the public and its use cannot be constrained.³¹

While the orphan metaphor may be misleading, the metaphor does not appear to have been in use for all that long.³² The term first gained traction in the mid-1990s to describe neglected film footage that was at serious risk of loss due to degradation in the physical medium over time.³³ In the film preservation context, the term "orphan" applied to films whose copyright owners could not be located, but it also encompassed films with other characteristics.³⁴ The first official use of the phrase to identify copyrighted

available for public exploitation at the moment of publication." *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003). See also Edward Samuels, *The Public Domain in Copyright Law*, 41 J. COPYRIGHT SOC'Y 137, 137 (1993) (suggesting that public domain is what remains when all forms of protected information are taken into account); Pamela Samuelson, *Mapping the Digital Public Domain: Threats and Opportunities*, 66 LAW & CONTEMP. PROBS. 147, 148–51 (2003).

31. The Supreme Court recently recognized the constitutionality of Congress' ability to provide exclusive rights to works that previously had entered the public domain. *Golan v. Holder*, 132 S. Ct. 873, 894 (2012). An act of Congress is, however, required, and circumstances under which this maneuver is constitutional appear at least somewhat constrained. *Id.* at 887 (discussing the limited reasons for congressional action of this type).

32. In the Westlaw Journals and Law Reviews database, the first published appearance of the phrase "orphan work" is in 2000—in two places. First, in Jane C. Ginsburg et al., *The Constitutionality Of Copyright Term Extension: How Long Is Too Long?*, 18 CARDOZO ARTS & ENT. L.J. 651, 666 (2000), the phrase appears in the context of the full reproduction of the appellant's reply brief in *Eldred v. Reno*, 74 F. Supp. 2d 1 (D.D.C. 1999). Also published in 2000 was Marybeth Peters, *Copyright Office Update*, 599 PLI/PAT 185, 242 (2000), in which Ms. Peters, then the Register of Copyrights for the United States, indicates a problem identified by educators who are unable to locate copyright owners to negotiate with, and stating that the problem of "orphan works" may become acute due to the longer term of copyright. This is in the "Licensing Issues" section of her *Update*. *Id.* at 241. While Ms. Peters provides no citation for the reference to "orphan works," the phrase appears in a report issued by the Copyright Office the previous year. See U.S. COPYRIGHT OFFICE, REPORT ON COPYRIGHT AND DIGITAL DISTANCE EDUCATION, xxiv (1999), available at http://www.copyright.gov/reports/de_rprt.pdf.

33. LIBRARIAN OF CONGRESS, FILM PRESERVATION 1993: A STUDY OF THE CURRENT STATE OF AMERICAN FILM PRESERVATION, available at <http://www.loc.gov/film/study.html>.

34. The 1993 report on film preservation issued by the Librarian of Congress used the term "orphan" in describing the category of films that were in need of preservation:

If there is a single division that separates most of the preservation issues discussed in this report, it is between two categories of films: those that have evident market value and owners able to exploit that value; and the other films, often labeled "orphans," that lack either clear copyright holders or commercial potential to pay for their continued preservation. In practice, the former are primarily features from major Hollywood studios; the latter—numerically the majority—include newsreels and

works whose copyright owners were missing did not appear until 1999.³⁵ Thus, while the metaphor enjoys widespread use today, the short duration of its use may permit a shift in terminology if a better metaphor were available. The next Sections explore candidates for alternative metaphors that could be employed to better understand the “orphan works” problem.

B. ABANDONED AND NEGLECTED PROPERTY

Without the “orphan” metaphor, what are these works whose owners cannot be located? One possible alternative metaphor is that these works are abandoned, neglected, or derelict property.³⁶ As abandoned or neglected property, these works have value that is being wasted by the absentee owner. The value is apparent because, by definition of the problem, there is a user desiring to engage in a use of the work but the user cannot locate the owner to obtain authorization. In the area of tangible property, the common law developed a variety of doctrines designed to minimize the waste that results from abandoned or neglected property. Specifically, a variety of legal rules established through common law and legislation seek to transition ownership in situations where property is not being cared for.³⁷ The new owners facilitate market transactions concerning the property. Examining these doctrines and statutory enactments provides insight into how an alternative

documentaries, avant-garde and independent productions, silent films where copyright has expired, even certain Hollywood sound films from now defunct studios.

Id. In a 1999 symposium hosted by the University of South Carolina, titled: “Orphans of the Storm: Saving ‘Orphan Films’ in the Digital Age,” <http://www.sc.edu/filmsymposium/archive/orphans1999/details.html> (last visited June 30, 2012), Paolo Cherchi-Usai asserted that the first use of the term was in 1993 by David Francis, then Chief of the Motion Picture, Broadcasting, and Recorded Sound Division at the Library of Congress, at the Los Angeles hearing for the National Film Preservation Plan. *See* Paolo Cherchi-Usai, What is an Orphan Film? Definition, Rationale and Controversy (Sept. 23, 1999) (transcript available at <http://www.sc.edu/filmsymposium/archive/orphans1999/2.1%20Paolo%20Cherchi-Usai.htm>); *see also* Press Release, San Francisco Film Society, David Francis to Receive Mel Novikoff Award at the 45th San Francisco International [sic] Film Festival (2002), *available at* http://www.sfiff.org/press/novikoff_02.html. While the term “orphans” had been used in the context of copyright law previously, it was to discuss works that were not eligible for copyright protection. *See, e.g.*, Leslie J. Hagin, *A Comparative Analysis of Copyright Laws Applied to Fashion Works: Renewing the Proposal for Folding Fashion Works into the United States Copyright Regime*, 26 TEX. INT’L L.J. 341 (1991); Natalie Wargo, *Copyright Protection for Architecture and the Berne Convention*, 65 N.Y.U. L. REV. 403, 452 (1990).

35. *See supra* note 33.

36. PATRY, *supra* note 13, at 76–77.

37. The taxation of real property can be understood in this light. When an owner of property fails to pay property taxes, the government has the ability to seize the property and sell it to an owner that will pay those taxes. Strahilevitz, *supra* note 22, at 394–98.

metaphor might assist us in thinking differently about the problem of copyrighted works whose owners cannot be located, and about the appropriate solutions.

In examining doctrines related to tangible property rights to illuminate thinking about designing doctrines for intangible rights, the fundamental differences between these two types of rights must be kept in mind. Among other ends, legal recognition of tangible property rights seeks to avoid over-consumption of, and under-investment in, property (a.k.a. the tragedy of the commons).³⁸ The intangible copyrighted work, on the other hand, does not face the same problems of potential over-consumption. Copyrights and other intellectual property assets lack inherent characteristics of excludability and rivalrous consumption. In fact, these assets are characterized by non-rivalrous consumption.³⁹ For these types of “property” rights, the risk of over-consumption does not animate the creation of property rights in the first place.⁴⁰ Rather, the utilitarian justification for copyright protection is one based on a fear of under-investment in the creation and dissemination of the expression.⁴¹ Copyrights are granted in an effort to ensure the incentive to invest in the creation and dissemination of expressive works.⁴² Mindful of these important differences in the fundamental characteristics of intangible and tangible property, we can better evaluate whether it would be more appropriate to call this problem the “abandoned works problem.”

Abandoned chattel property can present problems for society. Abandoned chattel property with little or negative value, a.k.a. garbage, will unlikely be claimed by a new owner. The cost of abandoned garbage includes the health consequences if not removed promptly and properly, along with hauling and disposal costs. To minimize these problems, governments adopt laws that prohibit abandonment of negative value property, such as anti-littering laws. Abandoned chattel property with positive value can result in what one scholar has termed “lawless-race” costs, as would-be claimants (a.k.a. “finders”) seek to gain possession, and ownership, of the abandoned

38. Garrett Hardin, *The Tragedy of the Commons*, 162 *SCIENCE* 1243 (Dec. 13, 1968) (introducing the term).

39. Julie Cohen, et al., *COPYRIGHT IN A GLOBAL INFORMATION ECONOMY* 6–7 (3d Ed. 2010).

40. Lydia Pallas Loren & Joseph Scott Miller, *INTELLECTUAL PROPERTY LAW: CASES AND MATERIALS* 2–3 (Ver. 2.2 2011).

41. *Id.*; see also WILLIAM M. LANDES & RICHARD A. POSNER, *THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW* 11, 13–14 (2003).

42. *Id.* at 56–57.

property.⁴³ To reduce the possibility of suffering the cost of the “lawless race,” laws establish rules governing title to the property.

One way to handle the potential negative effects of abandoned positive-value chattel is for title to escheat to the state, permitting the state to control the transfer of title to a new owner. Both the Uniform Unclaimed Property Act of 1995⁴⁴ and the Federal Abandoned Shipwreck Act of 1987⁴⁵ employ this approach. Interestingly one justification for the escheat rule in the case of abandoned shipwrecks is the belief that the state, rather than the first finder, will have a stronger incentive to preserve the shipwreck for research and historic purposes, as opposed to plundering the shipwreck’s assets and selling them on the open market.⁴⁶

What would happen if we referred to copyrighted works whose owners cannot be located as “abandoned works”? Calling such works “abandoned works” might lead us to desire solutions designed to identify a new owner—either we would entrust the work to the state to protect its cultural or historic value,⁴⁷ or give a new private entity the opportunity to put the work to good use. A likely candidate for the new owner of an “abandoned work” would be the party who seeks to use the copyrighted work but who cannot locate the owner. Concerned with lawless-race costs, this solution might make some sense. However, with “abandoned” copyrighted works of positive value, we do not face the costs of potential lawless races because of the non-rivalrous consumption characteristic. More than one person or entity can make use of a copyrighted work without interfering with another’s use.⁴⁸

In the context of chattel property, the distinction between negative value goods, *i.e.* trash, versus positive value goods, *i.e.* treasure, helps identify the costs of abandoned property: the health and disposal costs in the context of

43. Strahilevitz, *supra* note 22, at 409–11.

44. As of June 30, 2012, fifteen states and the U.S. Virgin Islands have adopted the Uniform Unclaimed Property Act of 1995. See Uniform Law Commission, *Legislative Fact Sheet—Unclaimed Property Act*, <http://uniformlaws.org/LegislativeFactSheet.aspx?title=Unclaimed%20Property%20Act> (last visited June 30, 2012).

45. 43 U.S.C. §§ 2101–2106 (2010).

46. See Shelly R. McGill, *Are Criticisms of the Abandoned Shipwreck Act Anchored in Reality?*, 29 ENVIRONS ENVTL. L. & POL’Y J. 105, 117 (2006).

47. Interestingly, this is consistent with the context in which the metaphor of “orphan works” was first employed—to support the creation of the National Film Preservation Board whose “primary mission is to save orphan films . . . the living record of the twentieth century.” See National Film Preservation Board, *About the Board*, <http://www.loc.gov/film/filmabou.html> (last updated Aug. 31, 2011).

48. In this context it is important to not confuse tangible *copies* of a copyrighted work with the intangible work. The copies have rivalrous consumption characteristics common to all tangible property.

negative value goods and the costs of lawless races and waste in the context of positive value goods. Should we characterize copyrighted works for which the copyright owners cannot be located as negative value or positive value abandoned works? Interestingly, part of the problem with calling these works “orphans” is that the metaphor obscures whether each individual orphan work is trash or treasure.⁴⁹ Consequently, we have difficulty recognizing and evaluating the costs that society suffers. However, the “problem” of “orphan works” arises when there exists a user who desires to make a use of a copyrighted work. The fact that there is a new user desirous of making a use indicates that the work retains at least some positive value.

With regard to “abandoned” copyrighted works, while we do not face the costs associated with lawless races, we do face a problem of waste—these works are not being disseminated but they should be. Society endures the costs associated with waste without any offsetting benefit gained by continuing to respect the copyright rights of the absent owner. If someone could grant permission for the use, then the waste could be avoided or at least ameliorated. Rules that establish a new owner facilitate market-based transactions. An individual desiring to engage in a use that requires permission would be able to determine who could grant that permission. Identifying a new owner does not further copyright’s incentive for creation, although it might facilitate an incentive for subsequent dissemination.⁵⁰ Adverse possession of real property, discussed below, has a similar dynamic.

The fact that copyright law already has an abandonment doctrine presents a major hurdle to calling works whose copyright owner cannot be located “abandoned works.” Abandonment extinguishes the copyright interest.⁵¹ To abandon a copyright in a work the owner must intend to surrender the rights and must commit some overt act showing this intent.⁵² Courts have been quite stringent in applying these requirements: a mere loss of interest in exploiting the exclusive rights is not sufficient to give rise to

49. “The Congressional Research Service has estimated that just two percent of copyrighted works that are 55 to 75 years old retain any commercial value.” Lawrence Lessig, *Little Orphan Artworks*, N.Y. TIMES, May 20, 2008, at A23.

50. Golan v. Holder, 132 S. Ct. 873, 888 (2012) (discussing the importance of an incentive for dissemination in addition to an incentive for creation).

51. See 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, 319–22 (2007).

52. Nat’l Comics Publ’ns, Inc. v. Fawcett, Inc., 191 F.2d 594, 598 (2d Cir. 1951); Hadady Corp. v. Dean Witter Reynolds, Inc., 739 F. Supp. 1392, 1395–96, 1398–99 (C.D. Cal. 1990).

abandonment.⁵³ Given the strict requirements of the abandonment doctrine in copyright law and the consequences of a determination of abandonment, courts have deemed very few works to have been abandoned.⁵⁴

When an owner abandons the copyright in a work, that work enters the public domain. This result comes from the notion that the intangible rights protected by copyright, while referred to as intellectual *property* rights, are merely exclusive rights Congress grants for limited times. If an owner no longer is interested in those exclusive rights, it does not follow that another should be granted rights. Instead, the work should enter the public domain faster than it would in due course.⁵⁵ If works whose copyright owners cannot be found were referred to as “abandoned works,” the solution to the “problem” would seem clear: courts should deem these works to be in the public domain.⁵⁶

C. ADVERSE POSSESSION

The doctrine of adverse possession merits exploration as a doctrine relevant when an owner of real property⁵⁷ is neglectful, absent, or difficult to locate. Adverse possession provides a possessor of property with a mechanism to obtain legal title to the property if the possessor can demonstrate the required elements: possession must be (1) actual, (2) open

53. See generally Matthew W. Turetzky, *Applying Copyright Abandonment in the Digital Age*, 19 DUKE L. & TECH. REV. ¶¶ 21–24 (2010) (exploring the doctrine of copyright abandonment and reviewing cases).

54. *Id.* ¶¶ 22–23.

55. Trademark law is similar: “When a trademark falls into disuse, there is no longer any justification for impoverishing the public domain . . . so the mark is returned to the commons where it can be appropriated by any other firm that wishes to use it in commerce.” Strahilevitz, *supra* note 22, at 391.

56. Courts’ resistance to declaring works to be in the public domain results in part from the nature of litigation: the copyright owner is asserting her rights by litigating an infringement action, yet in that action the defendant is seeking a declaration that the copyright owner has abandoned her rights. It is difficult to rule a copyright owner has abandoned her copyright when she is litigating a case of alleged infringement.

57. Adversely possessing chattel property generally follows the same requirements of adverse possession of real property. However, a fundamental difference is that an adverse possessor’s use of personal property can be open and notorious and yet even a diligent owner may not be able to obtain notice of the adverse claim. Patty Gerstenblith, *The Adverse Possession of Personal Property*, 37 BUFF. L. REV. 119, 124 (1989). This difficulty arises from the fact that the statute of limitations for asserting one’s claim begins to run only once the owner knows or should know the location and possessor of the property. See *O’Keeffe v. Snyder*, 416 A.2d 862 (N.J. 1980); *Solomon R. Guggenheim Found. v. Lubell*, 569 N.E.2d 426 (N.Y. 1991) (holding that a statute of limitations does not begin to run until a demand for return of the property is made to a good faith purchaser). Therefore, adverse possession of chattel property is difficult to accomplish.

and notorious, (3) exclusive, (4) continuous, (5) hostile under a claim of right, and such possession must have occurred for a time that exceeds the statute of limitations for an ejection action.⁵⁸

One way to understand the doctrine of adverse possession is that it seeks to penalize the neglectful owner. Sometimes referred to as the “demerit” theory of adverse possession,⁵⁹ this view of the doctrine penalizes the negligent or dormant owner for “sleeping upon his rights.”⁶⁰ By creating a risk of loss of title, the doctrine establishes an incentive for owners of real property to remain at least minimally attentive to their assets.

Another way to understand the doctrine is that it seeks to reward the industrious possessor. Sometimes referred to as the “merit” theory of adverse possession, this view of the doctrine creates an incentive for possessors to productively use the property.⁶¹ Because the use must be open, notorious, and continuous for the relevant time period, only one who is using the property will be able to obtain legal title. In an important study of judicial application of the doctrine, it appears courts may also require, implicitly if not explicitly, the subjective good faith of the adverse possessor.⁶² Requiring good faith, or at least the absence of bad faith, is in keeping with a “merit” theory of adverse possession.

A more prevalent and accepted view of the doctrine, offered by Professor Ballantine almost a century ago, is that adverse possession “has not for its object to reward the diligent trespasser for his wrong nor yet to penalize the negligent and dormant owner for sleeping upon his rights; the great purpose is automatically to quiet all titles which are openly and consistently asserted, to provide proof of meritorious titles, and correct errors in conveyancing.”⁶³ In other words, adverse possession helps to identify with whom someone can deal if they desire to make use of property.⁶⁴ If an adverse possessor’s use is open for all to see and the prior

58. See Thomas W. Merrill, *Property Rules, Liability Rules, and Adverse Possession*, 79 NW. U. L. REV. 1122, 1123 (1985).

59. See Henry W. Ballantine, *Title by Adverse Possession*, 32 HARV. L. REV. 135, 135 (1918) (quoting JAMES BARR AMES, LECTURES ON LEGAL HISTORY: AND MISCELLANEOUS LEGAL ESSAYS 197 (1913)) (internal quotation marks omitted) (“English lawyers regard not the merit of the possessor, but the demerit of the one out of possession.”); see also Matthew W. Daus, *The Adverse Possession of Copyright*, 13 LOY. L.A. ENT. L. J. 45, 86 (1992).

60. Ballantine, *supra* note 59, at 135 (quoting AMES, *supra* note 59, at 197).

61. John G. Sprankling, *An Environmental Critique of Adverse Possession*, 79 CORNELL L. REV. 816 (1994).

62. R.H. Helmholz, *Adverse Possession and Subjective Intent*, 61 WASH. U.L.Q. 331, 347 (1983).

63. Ballantine, *supra* note 59, at 135.

64. Carol M. Rose, *Possession as the Origin of Property*, 52 U. CHI. L. REV. 73, 78 (1985).

owner fails to act to evict the possessor, the community may come to rely on the possessor as the person with whom to deal concerning the property.⁶⁵

Professor Carol Rose articulated a related view of the doctrine:

No matter how much the doctrine of adverse possession seems to reward the one who performs useful labor on land at the expense of the lazy owner who does nothing, the crucial element in all these situations is, once again, communication. “Possession” means acts that “apprise the community[,] . . . arrest attention, and put others claiming title upon inquiry.”⁶⁶

Clear title reduces resource-wasting conflict and increases beneficial transactions.⁶⁷

A potential adverse possessor faces risks and rewards. The potential reward for the possessor is not only legal title to the property, but the benefits that come with the use during the time of the adverse possession. The risks involve investment in the property that ultimately may not inure to the benefit of the possessor.⁶⁸ This risk becomes a reality when the owner of the property successfully seeks ejection prior to the expiration of the statute of limitations.

What if we called the users of copyrighted works whose owners cannot be located “adverse possessors”?⁶⁹ Translating the concepts pertinent to adverse possession into the realm of intangible property faces immediate problems. What constitutes actual possession of an intangible asset? One can certainly “use” intangible property, for example by reproducing it or publicly performing it, but “possession” per se is fundamentally difficult. Further, how would an adverse possessor of intangible property demonstrate that their possession was exclusive? By excluding others from real property an adverse possessor appears to the community to be the owner.⁷⁰ The ways to exclude others from using a copyright include threatening litigation, offering licenses, and, ultimately, suing for infringement. Non-owners face serious

65. *Id.* at 79.

66. *Id.* at 80 (citation omitted).

67. *Id.* at 81.

68. It is an open question, based on the particular facts of a specific case, whether a quantum meruit claim would be successful.

69. There have been some copyright cases that have employed the doctrine of adverse possession. *See, e.g.,* *Gee v. CBS, Inc.*, 471 F. Supp. 600, 642–45 (E.D. Pa. 1979). However, recent cases have resoundingly rejected application of the doctrine as state law that is preempted by federal copyright. *Advance Magazine Publishers, Inc. v. Leach*, 466 F. Supp. 2d 628, 634–35 (D. Md. 2006); *see also* *Daus*, *supra* note 59, at 55–56 (1992).

70. *Rose*, *supra* note 64, at 81.

consequences if they engage in any of these activities.⁷¹ Finally, the requirement that the use be “open and notorious” provides the owner of real property with clear notice of the adverse possessor’s action. Yet, open use of a copyrighted work may not be sufficient to provide the copyright owner with notice of the use.⁷²

Setting aside the problematic doctrinal application issues, it is worth considering the application of the underlying policy justifications for adverse possession to the situation facing potential users of a copyrighted work whose owner cannot be located. If adverse possession applied, the neglectful or absentee copyright owner would face a risk of loss of title to the copyright by failing to maintain contact information in accessible directories, such as the Copyright Office.⁷³ Would it be appropriate to reward the user of the copyrighted work with title to the copyrighted work, presumably for the remaining duration of the copyright term?⁷⁴ The productive user of the work would have the potential of benefiting not only from the uses he makes but also from the potential ownership of the copyright after the possessory period expired. Finally, and perhaps most importantly, if such a new owner were identified the world would now have an owner with whom they could transact concerning the copyrighted work. Because so much of the so-called “orphan work problem” stems from a lack of an entity from whom to obtain permission, identifying a new owner solves this roadblock.⁷⁵

The idea of granting rights in a work to someone other than the author may seem antithetical to fundamental aspects of copyright law. While the copyright granted by statute to the author is assignable, it is a very different proposition to grant rights to someone outside of that chain of title. However, as the Supreme Court has recently emphasized, inducing dissemination is part of what Congress can consider when fashioning the

71. Consequences could include liability for fraud and Rule 11 sanctions if an infringement lawsuit is filed. FED. R. CIV. P. 11.

72. Daus, *supra* note 59, at 73–74.

73. I envision that a doctrine of adverse possession would only be applied when a user cannot locate the copyright owner. Certainly checking the records of the Copyright Office would be a logical requirement to impose. This would be similar to the modern statutes that require the adverse possessor to be acting in good faith. *See supra* note 62 and accompanying text.

74. Other durations would be a possibility. For example, a user of a copyrighted work whose owner cannot be located could be rewarded through a statutory grant of exclusive use for a set period of years.

75. France has adopted a model that provides a collective society with the ability to grant licenses for the use of works whose copyright owners cannot be found. *See* Lucie Guibault, *France Solves Its XXe Century Book Problem!*, KLUWER COPYRIGHT BLOG (Apr. 13, 2012), <http://kluwercopyrightblog.com/2012/04/13/france-solves-its-xxe-century-bookproblem/>.

copyright law.⁷⁶ The Constitution requires that exclusive rights be granted to “authors.”⁷⁷ Granting exclusive rights to non-authors, therefore, may be constitutionally impermissible, although Congress could attempt to rest its authority on other Constitutional provisions, such as the Commerce Clause.⁷⁸

More fundamentally, the need to designate someone as the owner in the context of real property has roots in the rivalrous nature of tangible property and a desire to avoid the tragedy of the commons. For copyrights, intangibles that are inherently non-rivalrous, the need to designate an owner stems solely from legal liability rules established by Congress.

The lack of a potential reward of title to the work does not appear to be what is holding back users of copyrighted works whose owners cannot be located. Rather the stumbling block is the potential penalty the user may encounter if the copyright owner surfaces and sues for infringement. Unlike possession of real property, which may result in an eviction action, copyright infringement may result not only in lawsuit seeking an injunction, the arguable equivalent to an eviction, but also a hefty damages award. While an adverse possessor may have to compensate the owner for any proven actual damages to the property, and may even have to disgorge ill-gotten gains from his trespass under a quantum meruit claim, an infringement defendant faces the possibility of an award of statutory damages even if no harm can be shown and no profits were gained through the use.⁷⁹

A final problem in translating the doctrine of adverse possession to copyright is interpreting the Copyright Act’s statute of limitations.⁸⁰ While copyright has a three-year statute of limitation,⁸¹ courts have employed a concept of a “rolling” statute of limitations: each new reproduction, each

76. *Golan v. Holder*, 132 S. Ct. 873, 888 (2012) (citing Thomas B. Nachbar, *Constructing Copyright’s Mythology*, 6 *Green Bag 2d* 37, 44 (2002)); *see also* *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 555–58 (1985); *Eldred v. Ashcroft*, 537 U.S. 186, 206 (2003); *see generally* Brett M. Frischmann & Mark A. Lemley, *Spillovers*, 107 *COLUM. L. REV.* 257, 284 (2007) (discussing the incentive for distribution, as well as for creation, of new works).

77. U.S. CONST. art. I, § 8, cl. 8.

78. *See generally* Mark Tushnet, *Constitutional Workarounds*, 87 *TEX. L. REV.* 1499 (2009) (arguing that some courts have left open the possibility of relying on alternative provisions in the Constitution depending on the nature of the protection afforded); *see, e.g.*, *United States v. Martignon*, 492 F.3d 140, 151 (2d Cir. 2007) (finding criminal anti-bootlegging legislation was not an exercise of the intellectual property power and thus the limitations on that power did not apply).

79. Pamela Samuelson & Tara Wheatland, *Statutory Damages in Copyright Law: A Remedy in Need of Reform*, 51 *WM. & MARY L. REV.* 439, 480–81 (2009).

80. *Roley v. New World Pictures, Ltd.*, 19 F.3d 479, 481 (9th Cir. 1994).

81. 17 U.S.C. § 507(b) (2010) (requiring a claim be brought within three years from the time that the “claim accrued”).

new distribution of a copy, each new public performance, or each new public display constitutes a new act of infringement for which the copyright owner may pursue an infringement claim.⁸² This view of the statute of limitations doctrine differs from adverse possession, in which initial occupancy or use of land triggers the statute of limitations clock.⁸³ So long as that occupancy or use is open and continuous, the traditional requirements for adverse possession may be met. Unlike with copyright where each new copy distributed starts a new limitations period, each new day of trespassing use does not start a new limitations period running. Rejecting the rolling statute of limitations doctrine in copyright law would be a small but helpful step.⁸⁴

D. PRESCRIPTIVE EASEMENTS

While adverse possession that meets the necessary requirements results in the transfer of ownership of real property in fee simple, prescriptive easements involve non-possessory use of property that results in the creation of an easement, not full title to the property. Called the “first cousin” of adverse possession,⁸⁵ prescriptive easements can arise when an owner of the land fails to make effective objection to another’s use of that land. The elements necessary to establish a prescriptive easement parallel those elements required for adverse possession, and the theoretical justifications are similar. The extent of the use defines the easement that arises.⁸⁶

Similar to easements granted by an owner of land, a prescriptive easement can be either appurtenant or in gross. An easement that is appurtenant has “a dominant estate to which the easement is attached,”⁸⁷ and can be transferred only in connection with the transfer of that dominant

82. “In a case of continuing copyright infringements, an action may be brought for all acts that accrued within the three years preceding the filing of the suit.” *Roley*, 19 F.3d at 481. Section 507(b) “does not provide for a waiver of infringing acts within the limitation period if earlier infringements were discovered and not sued upon.” *Hoey v. Dixel Sys. Corp.*, 716 F. Supp. 222, 223 (E.D. Va. 1989).

83. See H. Tomás Gómez-Arostegui, *Prospective Compensation in Lieu of Final Injunction in Patent and Copyright Cases*, 78 FORDHAM L. REV. 1661, 1712 (2010) (discussing the consequences of labeling a trespass “permanent”).

84. But see Aryeh L. Pomerantz, *Obtaining Copyright Licenses by Prescriptive Easement: A Solution to the Orphan Works Problem*, 50 JURIMETRICS J. 195, 223–27 (2010) (arguing that because the result of adverse possession is the transfer of title, a much longer statute of limitations than the three-year limitations period is necessary).

85. Thomas W. Merrill, *Property Rules, Liability Rules, and Adverse Possession*, 79 NW. U. L. REV. 1122, 1124 (1985).

86. JON W. BRUCE & JAMES W. ELY, JR., *LAW OF EASEMENTS AND LICENSES IN LAND* § 5.4 (2012).

87. 25 Am. Jur. 2d *Easements and Licenses in Real Property* § 10 (2002).

estate. An easement in gross, by contrast, is personal and traditionally cannot be transferred.⁸⁸

If users of copyrighted works whose owners cannot be located were deemed to have obtained a prescriptive easement, their use could continue after the limitations period without fear of infringement liability.⁸⁹ Some of the problems associated with the application of adverse possession elements, as well as its justifications, are similar in the context of prescriptive easements. Although the “use” of the rights of a copyright owner more closely parallels the concepts of use of real property that can lead to a prescriptive easement, the problem of an open use not necessarily informing the owner of the copyright is similar to the problem in the context of adverse possession. The “property” asset of the copyright is not located in one place that the owner can easily monitor.

Additionally prescriptive easements, unlike adverse possession, do not result in a transfer of title to the property being used. Rather, only a license to continue the use is recognized and that license, at least one that is “in gross,” is not transferrable. Thus, the application of the prescriptive easement doctrine does not have the advantage of identifying a “new owner” from whom others interested in making use of the work may seek authorization. Although, as explored above, in the context of intangible property, a new owner is not needed. One interesting aspect of the prescriptive easement may be particularly helpful when considering a user who makes a derivative work incorporating the copyrighted work: perhaps under the right circumstances we should consider the derivative work as the dominant estate to which a prescriptive easement to use the work should attach. In this way a derivative work could continue to be exploited even after the copyright owner resurfaces, so long as the requisite limitations period has passed.

E. DOCTRINE OF WASTE

The doctrine of waste dates back for centuries as one of the ancient writs of the common law. The doctrine of waste “applies when two or more persons have interests in property, but at least one of them is not in possession.”⁹⁰ The doctrine is designed to prevent the person in possession of the property from injuring the non-possessor’s interest in the property. Waste comes in a variety of forms.⁹¹ Permissive waste involves a form of

88. *Id.* § 90.

89. *See* Pomerantz *supra* note 84, at 223.

90. Thomas W. Merrill, *Melms v. Pabst Brewing Co. and the Doctrine of Waste in American Property Law*, 94 MARQ. L. REV. 1055, 1056 (2011).

91. *Id.* at 1057.

nonfeasance, for example a life-tenant who fails to fix a leaking roof that results in damage to the house.⁹² Voluntary waste is a form of misfeasance, for example a life-tenant of an orchard that cuts down the trees.⁹³ Ameliorative waste involves changes to the property that alter the fundamental character of the property but results in a higher value for the property, for example a life-tenant that demolishes a home on the property in order to build a more valuable industrial building.⁹⁴

What if we called the problems associated with copyrighted works whose owners cannot be located a problem of “copyright waste”? One can view the rights of copyright as at least two parties having an interest in the subject property: the copyright owner who has exclusive rights for a period of time and the public who obtains full use of the work upon expiration of the copyright. The copyright owner is the “life tenant,” the one currently “in possession” of the property. The public, as the remainderman, also has an interest in the property. Viewed in this light, a copyright owner who is not available to consider authorization for various exploitation possibilities, possibilities that would result in further dissemination of the work, is engaging in a type of waste. In this context the “waste” produced by the absentee copyright owner is similar to the permissive waste situation exemplified by the life-estate tenant failing to repair the leaky roof. Failing to be available to consider dissemination possibilities results in less distribution and use of the work. Such increased obscurity may ultimately degrade the value of the asset that is the copyrighted work.⁹⁵ Under the doctrine of waste, the public, as the remainderman, has an interest in preventing that waste and in compensation when it has occurred.

If we characterize the situation faced by users of copyrighted works whose owners cannot be located as a “copyright waste problem,” that metaphor might lead us to conclude that different solutions are appropriate. For example, a desire to reduce the waste engaged in by the absentee copyright owners, rather than to protect orphan works or to identify new owners of abandoned works, argues in favor of a solution that lets the public’s interest in greater access prevail.⁹⁶

92. *Id.*

93. *Id.*

94. *Id.*

95. Bernard Lang, *Orphan Works and the Google Book Search Settlement: An International Perspective*, 55 N.Y.L. SCH. L. REV. 111, 116 (2010) (arguing that a “major reason for changing the rules regarding orphan and unregistered works is to revive them as part of our active cultural heritage”).

96. See Herkko Hietanen, *Honey, I Took Out the Trash: Curbside Recycling Motivations and Free Culture Movement*, ISUMMIT08, at 6 (2008), available at <http://commonsresearch.org>.

As Professor John Lovett has highlighted, the doctrine of waste matters most “in settings in which some kind of dramatic, and relatively sudden physical, environmental or economic transformation has taken place.”⁹⁷ That observation rings especially true in copyright today. In two short decades the world experienced the digital revolution. The birth and dramatic expansion of the world wide web itself⁹⁸ created both significant challenges and opportunities for copyright owners and those who are interested in using copyrighted works. During those same two decades, copyright law in the United States has seen the abandonment of formalities⁹⁹ and lengthening of the duration of protection,¹⁰⁰ changes that increased the quantity of copyrighted works whose owners would be difficult, if not impossible, to locate. As Professor Lovett observed, during periods of “radical change,” the “social and economic circumstances affecting the underlying property relationship are changing dramatically.”¹⁰¹ This description fits copyright well. It is during these times of change that courts “confront difficult questions about waste.”¹⁰²

F. HOSTAGE WORKS

The exploration of the different tangible property doctrines demonstrates that alternative metaphors to “orphans” can assist in expanding how we think about the real problems and the possible solutions. All of those tangible property doctrines, however, face challenges translating their policy justifications and their doctrinal elements to the realm of the intangible rights

wdfiles.com/local--files/fc2008-paper3/Honey%20I%20took%20out%20the%20trash.pdf (“Our copyright system, where the majority of works have a low value and transaction costs are high, creates massive amounts of copyright waste”) (citing Edgar J. McCaffery, *Must We Have a Right to Waste*, in *NEW ESSAYS IN THE LEGAL AND POLITICAL THEORY OF PROPERTY* 76 (Stephen R. Munzer ed., 2001)).

97. John A. Lovett, *Doctrines of Waste in a Landscape of Waste*, 72 *MO. L. REV.* 1209, 1212 (2007).

98. Tim Berners-Lee first proposed the hypertext mark-up language that would become the World Wide Web in March 1989. TIM BERNERS-LEE, *WEAVING THE WEB* 21 (2000).

99. In 1989 Congress eliminated the requirement of copyright notice on published copies of a work to maintain federal copyright protection. Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853 (1988) (codified as amended in scattered sections of 17 U.S.C.). In 1992 Congress eliminated the need to file a renewal registration in order to maintain copyright protection beyond the initial twenty-eight year term for works published prior to January 1, 1978. Copyright Amendments Act of 1992, Pub. L. No. 102-307, 106 Stat. 264 (codified as amended in scattered sections of 17 U.S.C.).

100. 1998 Sonny Bono Copyright Term Extension Act, Tit. I, Pub. L. No. 105-298, 112 Stat. 2827 (1998) (codified as amended in scattered sections of 17 U.S.C.).

101. Lovett, *supra* note 97, at 1012.

102. *Id.*

granted by copyright law. In this Section I provide the alternative metaphor of “hostage works” that I believe better reflects the source of the problem and ultimately facilitates solutions that incorporate lessons learned from the tangible property doctrines.

Copyright law has created a system of automatic rights that lock up the use of expression. The system grants those exclusive rights to authors and subsequent copyright owners with no obligation to identify themselves, or to remain available (let alone an obligation to remain in existence) to consider requests for use of those rights. These works are held hostage by a set of rules that result in an inadvertent lock-up of the expression these works contain.¹⁰³ Whether caused by the lengthy duration of copyright protection, the lack of a registration requirement, the lack of a required maintenance fee to maintain copyright protection, the lack of a notice requirement, the infinite divisibility of copyright ownership, the lack of a requirement for recording transfers of copyright interests, or the exceedingly low threshold for what types of works might be subject to copyright protection, the end result is the same: the copyright owner is difficult or impossible to identify and/or locate. Thus, a market failure results, hindering the public’s access to the expression. Whether caused by the uncertainty of the fair use defense,¹⁰⁴ the hefty statutory damages possible under copyright,¹⁰⁵ or the potential for injunctive relief, the end result is the same: a risk of a magnitude or type of liability that is too great to undertake for many would-be users of hostage works—a market failure results and the public’s access to the expression is hindered. Identifying the problem as a “hostage work problem” therefore seems appropriate.

When viewed as a “hostage work problem” it becomes clear that these works do not need foster parents or protection against inappropriate exploitation—the end result of an orphan metaphor. Nor do these works need new owners—the end result of a metaphor of abandoned or neglected property. What these works need are “special forces” that can free them

103. It is the expression that is locked up because, even during the term of copyright, others are free to use the ideas and concepts embodied in those works. See 17 U.S.C. § 102(b) (2010); see also *supra* note 30.

104. But see Pamela Samuelson, *Unbundling Fair Uses*, 77 *FORDHAM L. REV.* 2537, 2537 (2009) (arguing that the fair use cases are “more coherent and more predictable than many commentators seem to believe”).

105. 17 U.S.C. § 504 (2010) (providing for an award of up to \$30,000 per work infringed, or even higher to \$150,000 per work if the infringement is willful). See also *Rob Reid: The \$8 Billion iPod*, TED (Mar. 2012), http://www.ted.com/talks/lang/en/rob_reid_the_8_billion_ipod.html (video presentation of “Copyright Math (TM),” which vividly demonstrates how quickly statutory damages can add up).

from the constraints placed on them by the combination of the regulatory effects of copyright and the lack of a locatable owner who can grant permission to avoid the consequences of the regulation.

In the previous Section I noted several places where the theoretical underpinnings of property law doctrines do not fit well with copyrights given the inherent characteristics of the rights of copyrights, mainly non-rivalry and non-excludability. The utilitarian justification for copyright protection is premised on a perceived need that to promote progress in knowledge and learning we must guard against not the risk of overuse, but rather the risk of underproduction. However, to achieve the desired progress, the copyright law is designed not only to create an incentive for creation but also an incentive for distribution.¹⁰⁶

In the context of hostage works, the incentive for creation functioned as intended: the work was created. But the incentive for distribution has actually backfired. Instead of a *risk* of underinvestment in distribution, we have a *manifestation* of such underinvestment. Copyright protection is obstructing distribution, not enabling or facilitating it.¹⁰⁷ This is a type of waste: copyright law is “inhibiting access . . . without any countervailing benefit.”¹⁰⁸ In addressing the hostage work problem, we should focus on a solution that reduces the waste by removing the barriers to non-owner distribution.

When one considers the potential users of orphan works, they broadly fall into two categories: access facilitators and derivative work creators.¹⁰⁹

106. See *supra* note 76 and accompanying text. In the sense that the protection afforded by copyright law helps overcome the Arrow’s disclosure paradox, copyright *enables* disclosure and distribution. Arrow’s disclosure paradox describes the problem encountered when one person has developed valuable information but, to commercialize that information, it must be disclosed to others. Once disclosed, there is no reason for the recipient of the information to pay for the information. See Kenneth Arrow, *Economic Welfare and the Allocation of Resources for Invention*, in NATIONAL BUREAU OF ECONOMIC RESEARCH, *THE RATE AND DIRECTION OF INVENTIVE ACTIVITY: ECONOMIC AND SOCIAL FACTORS* 609, 614–16 (1962).

107. Importantly in the context of hostage works, it is not the copyright owner electing to withdraw the work from public circulation or other exploitation that is interfering with the distribution of the work. See REPORT ON ORPHAN WORKS, *supra* note 2, at 34. Instead it is the inability to locate the owner to seek, and hopefully obtain, the authorization for a desired distribution that creates a hostage work problem.

108. *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 450–51 (1984). The Court specified that this concern was particularly salient in a fair use analysis when there was “no demonstrable effect upon the potential market for, or the value of, the copyrighted work.” *Id.*

109. The Copyright Office Report identified four categories of uses: (1) uses by subsequent creators, (2) large-scale access uses, (3) enthusiast uses, and (4) private uses. REPORT ON ORPHAN WORKS, *supra* note 2, at 36–40. Uses in categories 3 and 4 often can be

Each role has risks and considerations that need to be thought through carefully. The harm that results from the existence of millions of hostage works stems from an inability of the public to have access to those works both in their original form and as incorporated into new derivative works that employ those works.¹¹⁰

The access facilitators are those entities that are interested in distributing copies of the orphan works themselves but fear the infringement liability for doing so. Libraries, archives, museums and other similarly focused entities see providing access to these works as helping advance their core mission of spreading knowledge in their fields. The inability to obtain authorized copies, particularly in desired formats, leads these entities to want to make their own copies. But, without an ability to obtain authorization from the missing copyright owner, engaging in such copying entails a certain amount of risk.¹¹¹ Access facilitators may also include for-profit organizations that would like to harness the commercial value of a storehouse of material and provide additional services that the public may be willing to pay for, such as search engine services or printed copies of works. These types of access facilitators also desire authorization for their copying activity, but again face a risk of infringement liability¹¹² due to an inability to locate the rightful copyright owner. To the extent that the liability risk faced by these actors causes them to forgo providing access to these works, the public loses a benefit it otherwise would have gained had the copyright owner and the access facilitator been able to work out an arrangement.

Derivative work creators include movie producers, educators, authors, musicians, and really anyone who would like to create their own original work of authorship that incorporates the previous work in a way that would

fit into categories 1 or 2 depending on the nature of the use by the private user or enthusiast, e.g., a use that creates a derivative work.

110. Hansen, *supra* note 1, at 8–13.

111. The level of risk is influenced by the problems of narrowly crafted library exemptions, 17 U.S.C. § 108 (2010), the vagaries of the fair use doctrine, 17 U.S.C. § 107 (2010), and the costs of litigating even a strong fair use defense. PRUDENCE ADLER, BRANDON BUTLER, PATRICIA AUFDERHEIDE & PETER JASZI, FAIR USE CHALLENGES IN ACADEMIC AND RESEARCH LIBRARIES 6–7, 13–15 (2010), available at http://www.arl.org/bm~doc/arl_csm_fairusereport.pdf (describing concern among library employees, and discussing practices for minimizing risk of copyright infringement amidst efforts to digitize and preserve collections in non-obsolete formats). The recent willingness of courts to grant attorney's fees to prevailing fair use defendants may begin to have some effect on settlement negotiations. *See, e.g.*, *Brownmark Films LLC v. Comedy Partners*, 101 U.S.P.Q. 2d 1241, 1246–47 (E.D. Wis. 2011).

112. Commercial users face additional risk because their commercial nature may weigh against a claim of fair use. *Sony*, 464 U.S. at 449.

require the copyright owner's authorization.¹¹³ These potential users of orphan works also face a risk of infringement liability if the copyright owner surfaces. Derivative work creators are scared off by the risk of lawsuits from heirs and other claimants coming out of the woodwork if the new use proves economically successful.¹¹⁴ To the extent that the liability risk faced by these actors causes them to forgo the creation and dissemination of the derivative work, the public suffers. The harm here is magnified because not only did the public lose the benefit of access to the hostage work but it also lost out on the benefit of the new work the derivative work creator was going to create but did not.

A solution to the hostage work problem should address both types of users. As I describe below, the access facilitators really are the "special forces" that are freeing the hostages. This role will typically be played by libraries, museums, nonprofit educational institutions, archives, and public broadcasting entities,¹¹⁵ although my proposal is in no way limited to these entities. In addition to the public that will be obtaining access to a work previously held hostage by the rules of copyright, an important beneficiary of the actions of these special forces will be the derivative work creators who should be able to rely on the identification of works as hostage works and, particularly as time passes without a copyright owner surfacing, be willing to use such works.

III. FREEING HOSTAGE WORKS

Freedom for hostage works could come from a reform of the underlying regulations that have led to the hostage crisis in the first place. For example, a return to the duration of copyright protection at the time of the framing of the U.S. Constitution (fourteen years with a possible fourteen-year renewal

113. REPORT ON ORPHAN WORKS, *supra* note 2, at 36 ("The typical scenario might involve an author or publisher that wishes to include a photograph in a new book, or a movie studio that wishes to create a film version of an obscure novel.").

114. The fear is not only of monetary liability but of the injunctive relief that could halt a project in which millions have been invested. *See, e.g.,* Whitmill v. Warner Bros. Entm't, Inc., No. 4:11CV00752 (E.D. Mo. May 24, 2011) (denying requested preliminary injunction by tattoo artist who designed Mike Tyson tattoo that appeared in the movie *Hangover II*), available at <http://docs.justia.com/cases/federal/district-courts/missouri/moedce/4:2011cv00752/113287/41/>.

115. *See, e.g., Final Directive, supra* note 7, at 8 (specifying entities eligible to make certain uses of orphan works are limited to "publicly accessible libraries, educational establishments or museums, as well as by archives, film or audio heritage institutions and public-service broadcasting organisations").

term),¹¹⁶ implementation of a maintenance fee for continued protection,¹¹⁷ or requiring an affirmative act on the part of an author to obtain copyright protection,¹¹⁸ would significantly reduce the quantity of works that become hostages in the first place. Despite the persuasiveness with which reform proposals have been presented,¹¹⁹ I assume that such significant changes will not be forthcoming.¹²⁰ Instead, solving the hostage work problem can come through legislatively or judicially implemented rules that provide protection for responsible “special forces” who act to free hostage works. Also desirable is a robust application of equitable principles for those who use freed works in newly created derivative works.

A. PROTECTING RESPONSIBLE “SPECIAL FORCES”

Freedom for hostage works comes in the form of reliable information concerning the copyright status and the copyright owner of the work. Through the sharing of reliable information,¹²¹ the hostage works will be freed for exposure to interested audiences and potential users of such works. Existing databases can assist with the search for such information,¹²² but someone must invest resources in researching those databases, connecting the discovered information to a particular work, and disseminating the information discovered. Thus, creating incentives to produce and publicize this type of high quality information should be a prime focus of any approach to solving the “hostage work” problem.

In copyright law, as well as in patent law, we are accustomed to granting exclusive rights as an incentive for the creation and distribution of intangible

116. Act of May 31, 1790 § 1, 1 Stat. 124, 124 (repealed 1831). For a thorough discussion of copyright renewal, duration, and term extension, see Tyler T. Ochoa, *Patent and Copyright Term Extension and the Constitution: A Historical Perspective*, 49 J. COPYRIGHT SOC'Y U.S.A. 19, 26–51 (2002).

117. See Lawrence Lessig, *Protecting Mickey Mouse at Art's Expense*, N.Y. TIMES (Jan. 18, 2003), available at <http://www.nytimes.com/2003/01/18/opinion/protecting-mickey-mouse-at-art-s-expense.html> (proposing reintegration of formalities into the Copyright Act).

118. See generally Christopher Sprigman, *Reform(aliz)ing Copyright*, 57 STAN. L. REV. 485 (2004).

119. See, e.g., *id.*; Pamela Samuelson and Members of The CPP, *The Copyright Principles Project: Directions For Reform*, 25 BERKELEY TECH. L.J. 1175, 1222–29 (2010).

120. A variety of obstacles stand in the way of reform, including international treaty obligations. See Sprigman, *supra* note 118, at 545–55.

121. Hansen, *supra* note 3, at 8 (citing *Commission Proposal for a Directive*, *supra* note 7, at 3) (indicating that the proposed EU directive “contemplates that the results of searches would be posted in publicly accessible databases”).

122. See, e.g., *W.A.T.C.H.: Writers Artists & their Copyright Holders*, HARRY RANSOM CENTER, <http://tyler.hrc.utexas.edu/> (last visited June 20, 2012) (providing assistance in determining the status of a particular copyright owner); F.O.B: Firms out of Business, HARRY RANSOM CENTER, <http://tyler.hrc.utexas.edu/fob.cfm> (last visited June 20, 2012).

assets—like information—that we, as a society, believe has value.¹²³ In the context of hostage works, granting an exclusive right to an entity that researches, develops, and publishes information concerning a work could provide an incentive to engage in that activity. The nature of the exclusive right might, for example, permit that entity to control subsequent reproduction of the work. In some ways, this would be similar to the doctrine of adverse possession in which a new owner for the property is designated.¹²⁴ Using a period of exclusivity as a type of “bounty” that would provide an incentive to collect and distribute hostage-work freeing information, however, has the potential to create a second layer of ownership with its own hostage-taking effects. Additionally, granting a new exclusive right for an entity that researches and disseminates this information raises constitutional problems.¹²⁵

More importantly, evidence indicates that there is not a risk of underproduction of this type of information. Recent activities demonstrate that not-for-profit entities are willing to engage in the required information gathering and publishing to free the hostage works so long as they are permitted to distribute copies of the work itself.¹²⁶ For-profit entities, such as Google, likely would engage in this activity as well, so long as there were permissible ways to obtain remuneration.¹²⁷ These not-for-profit and for-

123. For example, in patent law prior to 2003 we encouraged the marshaling of information to challenge questionable pharmaceutical patents by generic manufacturers through the Abbreviated New Drug Application, part of the Hatch-Waxman Amendments. This mechanism granted a 180-day period of semi-exclusivity to “the first generic drug maker who establishes the salability of a product that the name-brand firm’s patent does not control (because the patent is either void or too narrow).” Joseph Scott Miller, *Building a Better Bounty: Litigation-Stage Rewards for Defeating Patents*, 19 BERKELEY TECH. L.J. 667, 723–24 (2004).

124. See discussion *supra* Section II.C.

125. See *supra* note 78 and accompanying text.

126. Many libraries and non-profit entities have demonstrated a desire to be involved in facilitating this access. The libraries that formed the consortium known as the Hathitrust sought to provide access to specifically identified works whose copyright owners the employees of the Hathitrust had researched and could not locate. See *HathiTrust Statement on Authors Guild, Inc. et al. v. HathiTrust et al.*, HATHITRUST DIGITAL LIBRARY (Sept. 15, 2011), http://www.hathitrust.org/authors_guild_lawsuit_statement.

127. While the Google Books project sought to digitize works, Google’s desire to harness the value of the information contained in those works for a variety of purposes could easily translate into a willingness to research the information required to identify hostage works. For example, Google described its efforts in connection with the Google Book Search project and subsequent litigation:

In order to facilitate Rightsholders’ investigations of the copyright status of their books, however, Google put its technical resources to work on the problem. After discussions with Rightsholders and Class Counsel,

profit entities do not appear to need an incentive in the form of an exclusive right. Rather, what these entities need is a reduction in the risk of liability for their actions.¹²⁸

I propose granting immunity from monetary liability for entities that act as responsible “special forces” and free hostage works so long as the entity satisfies two criteria. First, the entity must not be negligent in designating a work as a hostage work or in its approach to correcting status information and removing digital access to a work inaccurately (albeit non-negligently) identified as a hostage. Why negligence is the right standard and what might constitute negligence is explored more fully below. Second, to gain “special forces” immunity from monetary liability, the entity should be required to provide an open access copy of the work with embedded hostage freeing information related to that work.

The requirement of providing open access to the work is a way to ensure the public benefit in return for granting a reduction in liability. In a quid pro quo arrangement that is a familiar way to think about the exclusive rights granted by intellectual property protections,¹²⁹ I suggest that the public benefit is best accomplished by a requirement to provide an open access copy of the work with attached information concerning the copyright and copyright owner status. The details of the open access criteria are explored below.¹³⁰

This proposal for “special forces” immunity could be implemented by judges applying the fair use doctrine: courts should conclude that it is fair use if an entity non-negligently identifies works as hostage works, shares a digital

Google scanned the entirety of the *Catalog of Copyright Entries* from 1923 (before which any books listed in the registry records are in the public domain) to 1978 (after which registrations are listed on the Copyright Office website) and made it freely available for searching through Google Book Search. See *Searching Google's Scans of the Catalog of Copyright Entries*, at <http://books.google.com/googlebooks/copyrightsearch.html>. Thus anyone—both Rightsholders and members of the public—can research the registration status of a pre-1978 book electronically.

Google's Brief in Support of Motion for Final Approval of Amended Settlement Agreement at 60, *Authors Guild v. Google, Inc.*, 770 F. Supp. 2d 666 (S.D.N.Y. 2011).

128. Libraries fear statutory damages, despite statutory provisions that make the imposition of statutory damages against libraries more difficult. See 17 U.S.C. § 504(c)(2) (2010). See also ADLER, ET AL., *supra* note 111, at 3.

129. *Eldred v. Ashcroft*, 537 U.S. 186, 214 (2003) (reviewing what the “bargain” in copyright law entails). See also Shubah Ghosh, *Patents and the Regulatory State: Rethinking the Patent Bargain Metaphor*, 19 BERKELEY TECH. L.J. 1315, 1316–21 (2004) (“Patents are commonly understood as a hypothetical contract between the inventor and the government resulting in a quid pro quo of innovation for exclusivity.”).

130. See *infra* Section III.A.2.

copy of that work under an open access model, and that digital copy contains the hostage freeing information.¹³¹ Similar to the rulings which hold that under certain circumstances reverse engineering of computer software is fair use,¹³² a “special forces” immunity fair use rule, once established, could significantly reduce the perception of risk faced by libraries and other non-profits. One downside of implementing this proposal through the fair use doctrine is that, as an affirmative defense, fair use places the burden on the defendant to prove certain elements in support of the defense.¹³³ In the context of a re-surfacing copyright owner who sues a defendant for use of a work identified as a hostage work, it would seem more appropriate for the plaintiff copyright owner to have to prove the negligence of the defendant, as any claim that relies on negligence as a basis for liability would require.¹³⁴ Under current fair use law, judges could impose this burden on a plaintiff.¹³⁵ Of course, legislative enactment of a type of safe harbor immunity for “special forces” that free hostage works could make clear that the plaintiff would need to prove the defendant’s negligence in order to remove the protection of the safe harbor immunity from monetary liability.¹³⁶

1. *Responsible Identification of Hostage Freeing Information*

To qualify for immunity from monetary liability, an entity that seeks to free hostage works must not be negligent in its identification of a work as a

131. See Jennifer Urban, *Fair Use As a Partial Solution to the Orphan Works Problem*, 27 BERKELEY TECH. L.J. 1379, 1392–1404 (2012).

132. See, e.g., *Sega v. Accoclade*, 977 F.2d 1510, 1527–28 (9th Cir. 1992) (holding that “where disassembly is the only way to gain access to the ideas and functional elements embodied in a copyrighted computer program and where there is a legitimate reason for seeking such access, disassembly is a fair use of the copyrighted work, as a matter of law.”).

133. See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 590 (1994) (identifying fair use as “an affirmative defense” and noting that defendant would have difficulty prevailing without “favorable evidence about relevant markets”).

134. DAN B. DOBBS, *THE LAW OF TORTS* 269 (2000) (identifying the elements for which the plaintiff bears the burden of proof when demonstrating a prima facie case of negligence).

135. In the *Sony* case the Supreme Court appeared to place a burden on the plaintiff of demonstrating that a particular use was not fair. *Sony Corp. of Am. v. Universal City Studios*, 464 U.S. 417, 451 (1984). Subsequently the Court stated that fair use is “an affirmative defense,” although it did not discuss whether merely the burden of production or the burden of persuasion shifts to the defendant. Therefore it would be entirely appropriate for a court to require a resurfacing copyright owner to carry the burden of persuasion and demonstrate what actions a library, for example, should have taken, under the circumstances, that would have resulted in accurately identifying information that would have led to viable contact with the copyright owner.

136. Congress knows how to create different types of safe-harbors. See, e.g., 17 U.S.C. § 512 (2010) (codifying a set of safe harbor defenses for on-line service providers); 17 U.S.C. § 104A (creating a type of safe harbor for certain actions of “reliance parties” who were using works in the public domain when those copyrights were restored).

hostage work. The entity's negligence would be evaluated when the copyright owner of a work identified as a hostage work sues for copyright infringement.¹³⁷ The doctrine of negligence rests on a duty to exercise due care in one's conduct toward others from which injury may result.¹³⁸ While copyright infringement is often identified as a strict liability offense,¹³⁹ an evaluation of negligence would be entirely appropriate within the fair use defense.¹⁴⁰

Identifying a work as a hostage work has a risk that injury to the copyright owner may result. The injury could result from actions that infringe on the exclusive rights granted to the copyright owner.¹⁴¹ Such infringing conduct would include providing an open access digital copy of the work, a requirement of my proposal discussed in more detail below.¹⁴² The identification of a work as a hostage work should lead to greater freedom for follow-on uses that third parties might engage in after relying on that

137. For any of these issues to be litigated, a copyright owner of an identified hostage work would need to surface and sue. Recently, authors groups asserted claims for infringement against the HathiTrust for its "orphan works project." See discussion of HathiTrust litigation *supra* note 9 and accompanying text. To the extent the claims in the HathiTrust litigation were being asserted by author organizations, rather than specific copyright owners, the court concluded that the domestic author organizations lacked standing under the Copyright Act and thus could not seek to assert the rights of the associations' members. *Authors Guild, Inc. v. HathiTrust*, 11 CV 6351 HB, 2012 WL 4808939, at *3 (S.D.N.Y. Oct. 10, 2012). The Copyright Act is clear that only those having a legal or beneficial ownership interest in the allegedly infringed copyright may institute an action for infringement. 17 U.S.C. § 501(b). See also *Warren v. Fox Family Worldwide, Inc.*, 328 F.3d 1136, 1145 (9th Cir. 2003) (holding that a composer of a work-for-hire television series soundtrack could not claim beneficial ownership of copyright based on his entitlement to ongoing royalties); *Silvers v. Sony Pictures Entm't, Inc.*, 402 F.3d 881, 890 (9th Cir.) (en banc) (rejecting assertion of beneficial ownership based on assignment of accrued infringement claim without assignment of underlying rights in the copyrighted work), *cert. denied*, 546 U.S. 827 (2005); *Righthaven, LLC v. Hoehn*, 792 F. Supp. 2d 1138 (D. Nev. 2011). The probability of a lawsuit against a user of a hostage work would increase significantly if author trade organizations could instigate litigation.

138. See 57A Am. Jur. 2d *Negligence* § 5 (2012); see also BLACK'S LAW DICTIONARY 712 (9th ed. 2009).

139. *Religious Tech. Ctr. v. Netcom On-Line Comm'n Servs.*, 907 F. Supp. 1361, 1370 (N.D. Cal. 1995).

140. Steven Hetcher, *The Kids Are Alright: Applying A Fault Liability Standard To Amateur Digital Remix*, 62 Fla. L. Rev. 1275, 1279 (2010); Steven Hetcher, *Copytort's Fault Liability Standard*, in COMMON LAW & INTELLECTUAL PROPERTY (Shyamkrishna Balganeshe ed., forthcoming 2012). See also Wendy J. Gordon, *Harmless Use: Gleaning from Fields of Copyrighted Works*, 77 FORDHAM L. REV. 2411 (2009).

141. Note, however, that the "injury" to that intangible right may not, in fact, result in any actual damages that could be proven by the copyright owner.

142. See *infra* Section III.A.2.

identification.¹⁴³ Because those follow-on uses could be infringing, inaccurate identification of a work as a hostage work creates a potential for further injury to the copyright owner by others.¹⁴⁴ Importantly, these injuries only occur if, in fact, there is an existing copyright owner that is interested in continuing to exercise control over the exclusive rights granted by the Copyright Act. However, because there is a risk of injury that can result if a work is inaccurately identified as a hostage work, imposing a duty of care on entities that engage in the identification process would minimize the potential that harm will result.

The Copyright Office's proposal focused on reducing that risk by restricting the remedies available to that later-surfacing copyright owner, so long as the user engaged in a "reasonably diligent search" for the rightsholder.¹⁴⁵ What constitutes a "reasonably diligent search" created anxiety among libraries and archives.¹⁴⁶ A professional negligence standard, in contrast, has a lengthy development in the common law.¹⁴⁷

Professional standards relate to the standard of care typically undertaken by qualified practitioners in the same profession in a given context¹⁴⁸ and will, helpfully, evolve over time as practices evolve.¹⁴⁹ Through the use of a "best practices" model, libraries and archives could establish a standard of care that should be taken in researching the copyright status and copyright owner information for a particular work.¹⁵⁰ In the hostage-freeing context, using a

143. See *infra* Section III.B.

144. Fear of this type of harm appeared to be at the heart of visual artists' objections to U.S. legislation. See *The "Orphan Works" Problem and Proposed Legislation: Hearing Before the H. Subcomm. on Courts, the Internet, and Intellectual Prop., Comm. on the Judiciary*, 110th Cong. (2008) (statement of Marybeth Peters, Register of Copyrights), available at <http://www.copyright.gov/docs/regstat031308.html>.

145. REPORT ON ORPHAN WORKS, *supra* note 2, at 96.

146. *Id.* at 108–09 (discussing the resistance of stakeholders to a formal rulemaking to define the actions that would constitute a diligent search).

147. See Cornelius J. Peck, *Negligence and Liability without Fault in Tort Law*, 46 WASH. L. REV. 225, 226–27 (1971).

148. Dobbs, *supra* note 134, at 633.

149. The ability of the common law to evolve is considered one of its hallmarks. Karl Llewellyn, *THE COMMON LAW TRADITION* 4–7 (1960).

150. The best practices model has worked well in certain fair use areas. See, e.g., CENTER FOR SOCIAL MEDIA, AMERICAN UNIVERSITY, DOCUMENTARY FILMMAKERS' STATEMENT OF BEST PRACTICES IN FAIR USE (2005), available at http://www.centerforsocialmedia.org/sites/default/files/fair_use_final.pdf; ASSOCIATION OF RESEARCH LIBRARIES ET AL., CODE OF BEST PRACTICES IN FAIR USE FOR ACADEMIC AND RESEARCH LIBRARIES (Jan. 2012), available at <http://www.arl.org/bm~doc/code-of-best-practices-fair-use.pdf>. Importantly, the *Best Practices for Documentary Filmmakers* has had an effect on the practices of insurance companies that operate in that market. PATRICIA AUFDERHEIDE & PETER JASZI, *RECLAIMING FAIR USE: HOW TO PUT BALANCE BACK IN COPYRIGHT* 102–05 (2011).

professional negligence framework could address issues such as which databases concerning ownership or entity information should be consulted. Such a framework could also establish whether hostage freeing entities should first provide information concerning works they have identified¹⁵¹ and then wait a specified amount of time until actually making a digital version available.¹⁵²

The duty of care framework could also include standards for sharing particular information that led to a determination that the work is a hostage work, and a standardized format for that information. Importantly, I propose that the information must include the name of the entity making the identification and the date on which that identification is being made public. Finally, the access provider should be required to provide that attached information in both human readable and machine readable language.¹⁵³

2. *Requiring Open-Access to Works with Accompanying Freeing Information*

Establishing a “special forces” immunity must provide a public benefit. Whether that benefit is conceived of as a quid pro quo for the offered immunity from monetary liability, or as a type of compensation for waste caused by the absentee copyright owner,¹⁵⁴ benefitting the public should be primary in the design of a solution to the hostage work problem. Copyright’s

151. Whether the duty of care would impose a requirement to disclose identified hostage works on a centralized database is also something that could evolve as hostage freeing practices matured. The possibility of reliable databases of orphan works was a component of the Orphan Works Act of 2008, which would have tasked the Copyright Office with certifying reliable databases. *See* The Orphan Works Act of 2008, H.R. 5889, 110th Cong. (2008); Shawn-Bentley Orphan Works Act of 2008, S. 2913, 110th Cong. (2008). If such databases evolved, the provenance information attached to the open access copy of the hostage work could indicate in which database the authoritative provenance information is kept. This would facilitate the correction of erroneous designations.

152. For example, the HathiTrust proposed a project for identifying works whose copyright owners could not be located that involved a ninety-day notice period during which time copyright owners could come forward to correct the identification of the work as not having a locatable copyright owner. While no copyright owner came forward, several authors were identified, and HathiTrust nonetheless found itself embroiled in litigation. *See Authors Guild, supra* note 9 and accompanying text. The difference between copyright owners and authors is critical in the context of who can provide authorization for otherwise infringing activity. *See supra* note 25 and accompanying text.

153. The requirement to include this information in both human readable and machine readable is familiar to those using Creative Commons licensing tools. *See RDFa*, CREATIVE COMMONS (Mar. 9, 2012), <http://wiki.creativecommons.org/RDFa> (explaining that by using machine readable information concerning a work, “CC licensed objects can be discovered by search engines and auto-discovery mechanisms without the need for a human to hand-curate content directories or lists”).

154. *See supra* Section II.E.

primary purpose is to benefit the public, specifically to promote the progress of knowledge and learning.¹⁵⁵ Copyright seeks to promote that progress by granting exclusive rights that will provide an incentive for creation and dissemination of new works of authorship.¹⁵⁶ When copyright is hindering dissemination with no beneficial effect on the creation incentive it provides,¹⁵⁷ the public interest in access to extant works is paramount.¹⁵⁸ Additionally, because the increase of hostage works is a direct consequence of the reduction in works that are in the public domain due to longer terms of copyrights and an elimination of formalities to obtain and maintain copyright protection, the public should be compensated through the solution to the hostage work problem.¹⁵⁹

In the context of hostage works, the public benefit would be best served by requiring entities seeking “special forces” immunity to provide an open access copy of the work itself together with attached hostage freeing information for that work. The requirement that an entity must provide an open access copy of the work in order to obtain immunity prevents users of hostage works from exploiting the work for commercial gain with no guarantee of public benefit.¹⁶⁰

For a work to be an “open access” work, a copy of it must be in digital form and accessible through the Internet.¹⁶¹ Additionally, for a work to be an “open access” work it must be free of legal restrictions that would bar the access of the work over the Internet.¹⁶² Open access works must also be free

155. *Golan v. Holder*, 132 S. Ct. 873, 888 (2012).

156. See Landes & Posner, *supra* note 41.

157. Randal C. Picker, *Private Digital Libraries and Orphan Works*, 27 BERKELEY TECH. L.J. 1259, 1280–82 (2012) (explaining how an orphan works licensing regime is likely to have minimal effect on most authors at the time that they are deciding to create a work).

158. When a work’s copyright owner cannot be located, it is safe to assume that author of that work is not receiving any compensation for the exploitation of the work. In that context, it is likely that most author’s preference would be to have the work publicly accessible and their name to live on in connection with that work. Lang, *supra* note 95, at 124, 133.

159. *Id.* at 124, 145. See also Pamela Samueslon, *Legislative Alternatives to the Google Book Settlement*, 34 COLUM. J.L. & ARTS 697, 720 (2011) (arguing in favor of open access for orphan works as “more consistent with the utilitarian tradition of American copyright law”).

160. In this way, the proposal seeks to avoid one of the fears that the orphan metaphor implies: exploitation of the orphan for purely personal gain. See *supra* Section II.A (discussing the orphan metaphor).

161. Peter Suber, *Creating an Intellectual Commons through Open Access*, in UNDERSTANDING KNOWLEDGE AS A COMMONS: FROM THEORY TO PRACTICE 171 (Charlotte Hess & Elinor Ostrom eds., 2007) (“Open access (OA) is free online access. . . . The physical prerequisites for OA are that a work be digital and reside on an Internet server.”).

162. *Id.*

of technological protection measures and should not require the user to disclose personal information to obtain access to the work.¹⁶³

Open access facilitates authors' and copyright owners' adoption of less restrictive rights that currently attach automatically under the laws of the United States and other maximalist oriented copyright regimes, including those found in the major multilateral treaties of the Berne Convention¹⁶⁴ and the TRIPS Agreement.¹⁶⁵ Open access licenses such as those facilitated by Creative Commons have been described as attempts to minimize waste utilizing optimal licensing regimes.¹⁶⁶

To date, open access has been based on either author consent or public domain status.¹⁶⁷ My proposal would add a third category: hostage work status. To obtain immunity an entity must embed the information that led it to conclude the work is a hostage work. In open access protocols, information concerning the public domain status, referred to as its provenance, includes who declared the work to be public domain.¹⁶⁸ Similarly, the hostage status information must indicate who is making that declaration and the date of the declaration. This type of hostage provenance information will serve important purposes, especially for follow-on creators.¹⁶⁹

The information that is gathered and disclosed by the special forces in connection with the open access copy must not be subject to claims of exclusivity. For example, that data should be released under express

163. Free access means that the "price" of disclosing personal information should also not be permitted.

164. Berne Convention for the Protection of Literary and Artistic Works, Paris Act, July 24, 1971, 25 U.S.T. 1341, 828 U.N.T.S. 221.

165. Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, *available at* http://www.wto.org/english/docs_e/legal_e/27-trips.pdf.

166. *See* Hietanen, *supra* note 96, at 3 (citing Lawrence Lessig, *Re-Crafting a Public Domain*, 18 YALE J.L. & HUMAN. 56 (2006); Lawrence Lessig, *The Creative Commons*, 65 MONT. L. REV. 1 (2004)).

167. *See* Suber, *supra* note 161.

168. The standards for the communication protocols could be established through the W3C Provenance Working Group. *See, e.g., Connection Task Force Informal Report*, W3C (Sept. 29, 2011), http://www.w3.org/2011/prov/wiki/Connection_Task_Force_Informal_Report#Creative_Commons:_Using_Provenance_in_the_Context_of_Sharing_Creative_Works_.28.2A.2A.2A.2A.29 (noting that when it comes to provenance information, "[t]he core statements needed are who licensed, dedicated to the public domain, or marked as being in the public domain, which work, and when").

169. *See infra* Section III.B.

conditions of no assertion of ownership in that information.¹⁷⁰ This type of metadata must be freely and widely available for re-use.¹⁷¹ One way to satisfy this important responsibility would be to employ the Creative Commons Zero Universal Public Domain Dedication, a legal tool developed to make data available without restrictions on reuse.¹⁷²

Requiring public disclosure of the hostage freeing information permits inspection by others, and may lead to the identification of the copyright owner. If that occurs, that copyright owner should then be able to have the provenance information corrected and, if the owner desires, have that work removed from the open access repository. The ability to correct such information along with an obligation of a designating party or an open access database provider to update records could lead to beneficial effects. First, the longer a work is listed without correction, the more likely the hostage designation is an accurate one. Second, different designating entities are likely to develop differing reliability reputations for accuracy. Third, to the extent a follow-on creator desires to invest in the creation of a new work incorporating a designated hostage work, the length of time that has elapsed from designation and the reputation of the designating entity could help facilitate more calculated risk taking and potentially an insurance market to encourage follow-on creation. The risk for follow-on creators could be decreased even further through robust application of a variety of equitable doctrines discussed below.¹⁷³

While the open access copies of an identified hostage work may proliferate, any subsequent commercial user of that work would be wise to check the records of the entity that identified the work as a hostage work in the first place. As proposed, the identity of that entity is a required element

170. The importance of this information being in the public domain parallels the recent move by the Harvard Library to make twelve million catalog records from Harvard's seventy-three libraries available in accordance with its Open Metadata Policy and under a Creative Commons Zero (CC0) public domain license. See Quentin Hardy, *Harvard Releases Big Data for Books*, NEW YORK TIMES: BITS BLOG (Apr. 24, 2012, 9:00 AM), <http://bits.blogs.nytimes.com/2012/04/24/harvard-releases-big-data-for-books/>; *Millions of Harvard Library Catalog Records Publicly Available: Harvard Library Releases Nearly 100% of Its Records*, THE HARVARD LIBRARY TRANSITION NEWS ARCHIVE (Apr. 24, 2012), <http://isites.harvard.edu/icb/icb.do?keyword=k77982&pageid=icb.page498373>.

171. Europeana has also moved to require that the metadata for digitized objects be public domain. See EUROPEANA, THE EUROPEANA LICENSING FRAMEWORK (2012), available at <http://pro.europeana.eu/documents/858566/7f14c82a-f76c-4f4f-b8a7-600d2168a73d>.

172. Creative Commons Legal Code: CC0 1.0 Universal, CREATIVE COMMONS, <http://creativecommons.org/publicdomain/zero/1.0/legalcode> (last visited June 18, 2012); Diane Peters, *Expanding the Public Domain: Part Zero*, CREATIVE COMMONS (Mar. 11, 2009), <http://creativecommons.org/weblog/entry/13304>.

173. See *infra* Section III.B.

of the information that should be attached to the open access copy of the work. Open access uses could be halted following either a notification from the now-contactable copyright owner, or a discovery of relevant contact information as a result of a requirement in the evolving negligence standards for open access providers that would necessitate periodic checks with the designating entity as part of the “duty of care.”¹⁷⁴

B. HOSTAGE WORKS AND DERIVATIVE WORK CREATORS

The second important type of users of hostage works are those that create derivative works. The risk for derivative work creators is that the copyright owner of a hostage work may resurface and seek to enforce its rights against the derivative work creator. Copyright owners have the right to control the preparation of derivative works¹⁷⁵ and can seek both damages and injunctive relief against those who infringe that right.¹⁷⁶ Derivative work creators often have stronger claims to fair use because they are creating a new work that is transformative.¹⁷⁷ If the use at issue is a fair use, the use is not infringing, and there is no hostage work problem—the owner does not need to be contacted because no authorization is needed. The hostage work problem only arises when the use in the derivative work exceeds the bounds permissible under fair use but the copyright owner cannot be located to obtain the desired authorization.

Initially, the difficulty in finding the copyright owner in the first place should weigh heavily in favor of these types of derivative work uses being ruled fair uses, thus expanding the permissible zone of fair use activities.¹⁷⁸ But beyond the fair use inquiry, the hostage work problem for derivative work makers should also trigger a robust application of equitable doctrines. First, courts should be extremely hesitant in granting injunctive relief against

174. The machine readable nature of these records is a critical component that will permit such record updating and periodic checks to occur efficiently. *See supra* note 153.

175. 17 U.S.C. § 106(2) (2010).

176. *Id.* §§ 502, 504.

177. *See* *Campbell v. Acuff-Rose*, 510 U.S. 569, 579 (1994) (“[T]he more transformative the new [derivative] work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use.”). The importance of transformative uses to prevailing on a fair use defense can be seen in many recent fair use cases; *see, e.g.*, *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605 (2d Cir. 2006) (affirming summary judgment in favor of publishers who reproduced images of concert posters throughout a biographical book because presenting them in a new context was sufficiently transformative); *Perfect 10, Inc. v. Amazon, Inc.*, 508 F.3d 1146 (9th Cir. 2007) (vacating a preliminary injunction because a search engine’s display of thumbnail images of copyrighted photographs was a “significant transformative use,” making a fair use defense likely to succeed).

178. Urban, *supra* note 131, at 1394–1401.

derivative work creators who use a work believing in good faith that the work is a hostage work. Second, courts should reject the rolling statute of limitations doctrine, at least in the context of hostage works. Third, courts should engage in a robust application of the doctrine of laches to provide assurances to derivative work makers that viable claims against them will be limited.

1. *Injunctive Relief*

For derivative work makers, the threat of injunctive relief creates serious impediments to using any copyrighted elements for which clearance cannot be obtained. For example, a movie studio may invest tens of millions of dollars creating a movie. If that movie contains an element that might lead to a strategically-timed injunction by a copyright owner, the movie studio will forgo inclusion of that element rather than risk injunctive relief.¹⁷⁹ Of course the threat of injunctive relief can also lead to acquiescence to disproportionate licensing demands by later-surfacing copyright owners.¹⁸⁰

The Supreme Court has been quite adamant in recent years that injunctions in intellectual property cases must be evaluated under traditional principles of equity.¹⁸¹ Specifically, a plaintiff seeking a permanent injunction must demonstrate:

(1) that it has suffered an irreparable injury; (2) that remedies available at law, such as monetary damages, are inadequate to compensate for that injury; (3) that, considering the balance of hardships between the plaintiff and defendant, a remedy in equity is warranted; and (4) that the public interest would not be disserved by a permanent injunction.¹⁸²

While there is some evidence that the Supreme Court's admonitions have fallen on deaf ears in the lower courts,¹⁸³ there is ample room within these equitable considerations for courts to weigh the good faith belief in the

179. REPORT ON ORPHAN WORKS, *supra* note 2, at 37 (noting that “commercial users tend to be highly sensitive to any injunctive relief available to the surfacing copyright owner, especially in situations where an injunction comes at a critical point in the marketing and distribution of the work”).

180. This problem of “holdouts” is a familiar one and not unique to copyright law. See Guido Calabresi & A. Douglas Melamed, *Property Rules, Liability Rules, and Inalienability: One View of the Cathedral*, 85 HARV. L. REV. 1089, 1106–07 (1972).

181. *eBay Inc. v. MercExchange, LLC*, 547 U.S. 388 (2006).

182. *Id.* at 391.

183. Jiarui Liu, *Copyright Injunctions After eBay: An Empirical Study*, 16 LEWIS & CLARK L. REV. 215, 228 (2012) (asserting that in the 506 lower court decisions that substantively weighed in on the availability of injunctive relief post *eBay* from May 15, 2006 through June 1, 2010, only 11.3% of the cases even cited the *eBay* decision).

hostage status of the copyrighted work in determining whether to grant injunctive relief.¹⁸⁴ Instead, courts should only be willing to provide a reasonable license fee award to the plaintiff.¹⁸⁵ If courts routinely deny injunctive relief in the context of hostage works, this would likely lead to more reasonable compensation arrangements if copyright owners do surface.

2. *Statute of Limitations*

Courts should also reconsider the application of the statute of limitations in the context of both open access providers and derivative work creators. The Copyright Act provides that “[n]o civil action shall be maintained under the provisions of this title unless it is commenced within three years after the claim accrued.”¹⁸⁶ As described above, the “rolling” statute of limitations doctrine makes it almost impossible to cut off a copyright owner’s ability to sue for ongoing activities that reproduce, distribute, or display the copyrighted work.¹⁸⁷ Eliminating the application of that doctrine in the context of hostage works would be appropriate. If courts determined the limitations period begins when a work is identified as a hostage work and made available in a publicly accessible and searchable repository, the fact that it remains in that repository should not begin a new limitations period each day. The creation of a derivative work should rightly be classified as a “new” act of infringement that would begin a new three-year limitations period, but each new distribution or public performance of that derivative work should not begin a new three-year limitations period.¹⁸⁸

184. The Supreme Court has noted the disservice that injunctive relief might cause in copyright cases. *See, e.g.,* *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578 n.10 (1994) (citing *Abend v. MCA, Inc.*, 863 F. 2d 1465, 1479 (9th Cir 1988), *aff’d sub nom. Stewart v. Abend*, 495 U.S. 207 (1990) (noting the “special circumstances” that would cause “public injury” if the court issued an injunction)).

185. *See* *New York Times v. Tasini*, 533 U.S. 483, 505 (2001) (noting that even once infringement is found, “it hardly follows . . . that an injunction . . . must issue”); *see also* *Davis v. The Gap, Inc.*, 246 F.3d 152 (2nd Cir. 2001) (rejecting claim for \$4 million and holding instead that a reasonable license fee of \$400 to a sunglass designer whose sunglasses were worn by models in a print advertisement was an appropriate remedy).

186. 17 U.S.C. § 507 (2010).

187. *See supra* note 82 and accompanying text.

188. Additionally, the fact that a work was publicly identified as a hostage/orphan by a reliable access provider more than three years prior to the creation of the derivative work could be used in the construction of a laches defense to infringement. It is even possible that derivative work creators would devote resources to assisting access providers in their work or in even becoming access providers themselves. *See infra* Section III.B.3.

Changing the application of the limitations period would encourage prompt publication of hostage freeing information¹⁸⁹ and create an incentive for copyright owners to remain aware of such repositories. The requirement of machine readable metadata would help facilitate automated searching of those repositories.¹⁹⁰ Such open designations with access to digital versions of the work would enrich the public exchange of expressive content.

3. *Laches*

Finally, the application of a robust laches doctrine would create incentives for identifying hostage works early and often. Generally, a “party asserting laches must show: (1) lack of diligence by the party against whom the defense is asserted, and (2) prejudice to the party asserting it.”¹⁹¹ Laches is an equitable doctrine that requires an examination of the facts. As the leading treatise on federal practice provides:

[L]aches does not result from a mere lapse of time but from the fact that, during the lapse of time, changed circumstances inequitably work to the disadvantage or prejudice of another if the claim is now to be enforced. By his negligent delay, the plaintiff may have misled the defendant or others into acting on the assumption that the plaintiff has abandoned his claim, or that he acquiesces in the situation, or changed circumstances may make it more difficult to defend against the claim.¹⁹²

Laches doctrines could come into play when a work is identified as a hostage work and made available in a publicly accessible and searchable repository and no copyright owner has surfaced. A copyright owner who waits to surface until someone else makes a new derivative work should trigger a strong laches defense. As the Ninth Circuit has recognized:

189. The best practices developed could help mediate the tension between desire to publish early and ensuring that best practices are followed in researching the status of the work.

190. The ARROW (Accessible Registries of Rights Information and Orphan Works towards Europeana) project is a good example of various groups working to automate machine readable data to facilitate identifying rightsholders of orphan works in Europe. *About Arrow*, ARROW, <http://www.arrow-net.eu> (last visited June 18, 2012). *See, e.g., Google Alerts*, GOOGLE.COM, <http://www.google.com/alerts> (last visited June 18, 2012) (exemplifying how metadata alerts could be created to allow passive monitoring of newly published orphan works).

191. *Herman Miller, Inc. v. Palazzetti Imps. & Exps., Inc.*, 270 F.3d 298, 320 (6th Cir. 2001).

192. 11A Charles Alan Wright, Arthur R. Miller & Mary Kay Kane, *FEDERAL PRACTICE AND PROCEDURE* 117 (2d ed. 1995) (quoting William Quimby de Funiak, *HANDBOOK OF MODERN EQUITY* 41 (2d ed. 1956)).

It must be obvious to every one familiar with equitable principles that it is inequitable for the owner of a copyright, with full notice of an intended infringement, to stand inactive while the proposed infringer spends large sums of money in its exploitation, and to intervene only when his speculation has proved a success. Delay under such circumstances allows the owner to speculate without risk with the other's money; he cannot possibly lose, and he may win.¹⁹³

Application of the laches doctrine to bar claims against derivative work creators would, over time, reduce the magnitude of the risk faced by these types of hostage work users.

IV. CONCLUSION

Metaphors shape how we approach challenging legal issues. Reorienting the metaphor from “orphans” to “hostages” illuminates the real problem with copyright owners that cannot be located: lock-up of expressive works. Solving the hostage work problem requires creating protections for those who act as “special forces” and free the hostages. If an entity is not negligent in gathering and disclosing information that identifies a work as a “hostage work” and that entity provides an open access copy of the work together with the hostage freeing information, then that entity should be immune from monetary liability for infringement. Copyright owners should retain the ability to obtain injunctive relief to either correct inaccurate status or owner information, or obtain removal of the digital copy of the work from an open access database. This injunctive power would translate into an enforceable obligation of open access providers to update inaccurate information and remove works inappropriately designated as hostage works. For derivative work creators, courts should freely apply equitable doctrines to prevent inappropriate injunctive relief and limit the ability of later re-surfacing copyright owners to sue derivative work creators.

This combination of changes would appropriately reduce the risk that both types of users face when considering utilizing “hostage works” and engaging in activities that would otherwise constitute infringement. At the same time it would provide an appropriate level of protection for copyright owners whose works may be inaccurately identified. In the end, true hostage works would be freed and the public would benefit.

193. *Danjaq LLC v. Sony Corp.*, 263 F.3d 942, 951 (9th Cir. 2001) (quoting *Haas v. Leo Feist, Inc.*, 234 F. 105, 108 (S.D.N.Y. 1916)); *see also* *Chirco v. Crosswinds Cmtys., Inc.*, 474 F.3d 227 (6th Cir. 2007) (holding that laches was properly interposed).