



## EX ANTE



Referring to the headline above, loyal reader Peter Hutt of Akin Gump Strauss Hauer & Feld asked us, “If the WSJ can ask, mustn't you?” And so we do: How green are we?

### MISSING BOBBLE, ORPHAN PICTURES

The notes Michael Kwun, Jack Metzler, and Adam Sachs sent to the *Bag* (see pages 15-16 below) are just a few of the dozens of inquiries we received regarding the “Bobblenapping” article by the BLA listed on the cover of the Summer 2008 issue. Here is the story. The BLA – the Bobblehead Liberation Army – stole a law professor’s William Rehnquist bobblehead, leaving behind a ransom note. The note was in the traditional style: each letter of each word in the note was clipped from a different source, making a clunky but readable collage of threats and demands. We sought permission from the leader of the BLA to publish the note in the *Green Bag*. The following exchange ensued:

*Green Bag*: [W]e need to go with a very short *Ex Post* this time (page counts and keeping issues from inflating, you know),

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and Bobblenapping is far and away the best candidate. So, here are the proofs and the paperwork. Please get 'em back to me when you can.

BLA: I found it amusing just to get page proofs, reprint order form, etc., for this! As far as the page proofs, ... I have a slight concern about the use of the images. I wrote the content of the text (and am happy to assign the *Green Bag* my copyright in that content, such as it is) but my former secretary found a program online to create the lettering. She says it was this site, <http://metaatem.net/words/>, which pulls images from Flickr. I'm not sure what copyright protection the program or images may have. I wanted to give you a heads-up about that, so you can investigate.

*Green Bag*: Thanks for letting me know about the IP issue with the images. I think that's going to kill this one. Too bad. Still, it was fun while it lasted!

BLA: Bummer! Sorry I didn't think about the IP issue sooner.

We left the listing of the BLA on the cover of our summer issue as a monument to the orphan pictures that lost their chance at immortality in the *Green Bag*'s pages merely because it was impossible (or at least too difficult) to connect the pictures with their owners. This tragedy need not have happened. Senators Patrick Leahy (D-VT) and Orrin Hatch (R-UT) have been championing the cause of orphan pictures (and orphan works more generally) for a long time. Here is their latest effort – a bill that might become the “Shawn Bentley Orphan Works Act of 2008,” and which would amend Chapter 5 of title 17 of the United States Code by adding (along with some other terms not so relevant here) the following:

### § 514.

#### Limitation on remedies in cases involving orphan works

(a) DEFINITIONS. – In this section, the following definitions shall apply:

(1) MATERIALS. – The term “materials” includes – (A) the records of the Copyright Office that are relevant to identifying and locating copyright owners; (B) sources of copyright ownership information and,

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where appropriate, licensor information, reasonably available to users, including private databases; (C) technology tools and expert assistance; and (D) electronic databases, including databases that are available to the public through the Internet, that allow for searches of copyrighted works and for the copyright owners of works, including through text, sound, and image recognition tools.

(2) NOTICE OF CLAIM OF INFRINGEMENT. – The term “notice of claim of infringement” means, with respect to a claim of copyright infringement, a written notice sent from the owner of the infringed copyright or a person acting on the owner’s behalf to the infringer or a person acting on the infringer’s behalf, that includes at a minimum – (A) the name of the owner of the infringed copyright; (B) the title of the infringed work, any alternative titles of the infringed work known to the owner of the infringed copyright, or if the work has no title, a description in detail sufficient to identify that work; (C) an address and telephone number at which the owner of the infringed copyright or a person acting on behalf of the owner may be contacted; and (D) information reasonably sufficient to permit the infringer to locate the infringer’s material in which the infringed work resides.

(3) OWNER OF THE INFRINGED COPYRIGHT. – The “owner of the infringed copyright” is the owner of any particular exclusive right under section 106 that is applicable to the infringement, or any person or entity with the authority to grant or license such right on an exclusive or nonexclusive basis.

(4) REASONABLE COMPENSATION. – The term “reasonable compensation” means, with respect to a claim of infringement, the amount on which a willing buyer and willing seller in the positions of the infringer and the owner of the infringed copyright would have agreed with respect to the infringing use of the work immediately before the infringement began.

(b) CONDITIONS FOR ELIGIBILITY. –

(1) CONDITIONS. –

(A) IN GENERAL. – Notwithstanding sections 502 through 506, and subject to subparagraph (B), in an action brought under this title for infringement of copyright in a work, the remedies for infringement shall be limited in accordance with subsection (c) if the infringer –

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(i) proves by a preponderance of the evidence that before the infringement began, the infringer, a person acting on behalf of the infringer, or any person jointly and severally liable with the infringer for the infringement – (I) performed and documented a qualifying search, in good faith, to locate and identify the owner of the infringed copyright; and (II) was unable to locate and identify an owner of the infringed copyright;

(ii) provided attribution, in a manner that is reasonable under the circumstances, to the legal owner of the infringed copyright, if such legal owner was known with a reasonable degree of certainty, based on information obtained in performing the qualifying search;

(iii) included with the public distribution, display, or performance of the infringing work a symbol or other notice of the use of the infringing work, the form and manner of which shall be prescribed by the Register of Copyrights, which may be in the footnotes, endnotes, bottom margin, end credits, or in any other such manner as to give notice that the infringed work has been used under this section;

(iv) asserts in the initial pleading to the civil action eligibility for such limitations;

(v) consents to the jurisdiction of United States district court, or, in the absence of such consent, if such court holds that the infringer is within the jurisdiction of the court; and

(vi) at the time of making the initial discovery disclosures required under rule 26 of the Federal Rules of Civil Procedure, states with particularity the basis for eligibility for the limitations, including a detailed description and documentation of the search undertaken in accordance with paragraph (2)(A) and produces documentation of the search.

(B) EXCEPTION. – Subparagraph (A) does not apply if the infringer or a person acting on behalf of the infringer receives a notice of claim of infringement and, after receiving such notice and having an opportunity to conduct an expeditious good faith investigation of the claim, the infringer –

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(i) fails to engage in negotiation in good faith regarding reasonable compensation with the owner of the infringed copyright; or

(ii) fails to render payment of reasonable compensation in a reasonably timely manner after reaching an agreement with the owner of the infringed copyright or under an order described in subsection (c)(1)(A).

### (2) REQUIREMENTS FOR SEARCHES. —

#### (A) REQUIREMENTS FOR QUALIFYING SEARCHES. —

(i) IN GENERAL. — A search ordinarily qualifies under paragraph (1)(A)(i)(I) if the infringer, a person acting on behalf of the infringer, or any person jointly and severally liable with the infringer for the infringement, makes use of the materials and otherwise undertakes a diligent effort to locate the owner of the infringed work. A diligent effort will ordinarily be based on best practices, as applicable, and any other actions reasonable and appropriate under the facts relevant to that search, including further actions based on facts uncovered during the initial search, and be performed before, and at a time reasonably proximate to, the infringement.

(ii) LACK OF IDENTIFYING INFORMATION. — The fact that a particular copy or phonorecord lacks identifying information pertaining to the owner of the infringed copyright is not sufficient to meet the conditions under paragraph (1)(A)(i)(I).

(iii) USE OF RESOURCES FOR CHARGE. — A qualifying search under paragraph (1)(A)(i)(I) may include use of resources for which a charge or subscription fee is imposed, to the extent that the use of such resources is reasonable for, and relevant to, the scope of the intended use.

#### (B) INFORMATION TO GUIDE SEARCHES; BEST PRACTICES. —

(i) STATEMENTS OF BEST PRACTICES. — The Register of Copyrights shall maintain and make available to the public, including through the Internet, at least 1 statement of best practices for each category, or, in the Register's discretion, subcategory of work under section 102(a) of this title, for conducting and documenting a search under this subsection, which will ordinarily include reference to materials relevant to a search. The

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Register may maintain more than 1 statement for each category or subcategory, as appropriate.

(ii) CONSIDERATION OF RELEVANT MATERIALS. — The Register of Copyrights shall, from time to time, update or modify each statement of best practices at the Register’s discretion and should, in maintaining and updating such statements, consider materials and any relevant guidelines submitted to the Register that, in the Register’s discretion, are reasonable and relevant to the requirements of a qualifying search, and databases for pictorial, graphical, and sculptural works, where appropriate and reasonably available for a given use.

(3) PENALTY FOR FAILURE TO COMPLY. — If an infringer fails to comply with any requirement under this subsection, the infringer is not eligible for a limitation on remedies under this section.

(c) LIMITATIONS ON REMEDIES. — The limitations on remedies in an action for infringement of a copyright to which this section applies are the following:

(1) MONETARY RELIEF. —

(A) GENERAL RULE. — Subject to subparagraph (B), an award for monetary relief (including actual damages, statutory damages, costs, and attorneys’ fees) may not be made other than an order requiring the infringer to pay reasonable compensation to the owner of the exclusive right under the infringed copyright for the use of the infringed work.

(B) FURTHER LIMITATIONS. — An order requiring the infringer to pay reasonable compensation for the use of the infringed work may not be made under subparagraph (A) if the infringer is a nonprofit educational institution, museum, library, archive, or a public broadcasting entity (as defined in subsection (f) of section 118), or any of such entities’ employees acting within the scope of their employment, and the infringer proves by a preponderance of the evidence that —

(i) the infringement was performed without any purpose of direct or indirect commercial advantage;

(ii) the infringement was primarily educational, religious, or charitable in nature; and

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(iii) after receiving a notice of claim of infringement, and having an opportunity to conduct an expeditious good faith investigation of the claim, the infringer promptly ceased the infringement.

### (2) INJUNCTIVE RELIEF. —

(A) GENERAL RULE. — Subject to subparagraph (B), the court may impose injunctive relief to prevent or restrain any infringement alleged in the civil action. If the infringer has met the requirements of subsection (b), the relief shall, to the extent practicable and subject to applicable law, account for any harm that the relief would cause the infringer due to its reliance on subsection (b).

(B) EXCEPTION. — In a case in which the infringer has prepared or commenced preparation of a new work of authorship that recasts, transforms, adapts, or integrates the infringed work with a significant amount of original expression, any injunctive relief ordered by the court may not restrain the infringer's continued preparation or use of that new work, if —

(i) the infringer pays reasonable compensation in a reasonably timely manner after the amount of such compensation has been agreed upon with the owner of the infringed copyright or determined by the court; and

(ii) the court also requires that the infringer provide attribution, in a manner that is reasonable under the circumstances, to the legal owner of the infringed copyright, if requested by such owner.

(C) LIMITATIONS. — The limitations on injunctive relief under subparagraphs (A) and (B) shall not be available to an infringer if the infringer asserts in the action that neither the infringer nor any representative of the infringer acting in an official capacity is subject to suit in the courts of the United States for an award of damages for the infringement, unless the court finds that the infringer —

(i) has complied with the requirements of subsection (b); and

(ii) has made an enforceable promise to pay reasonable compensation to the owner of the exclusive right under the infringed copyright.

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(D) RULE OF CONSTRUCTION. — Nothing in subparagraph (C) shall be construed to authorize or require, and no action taken under such subparagraph shall be deemed to constitute, either an award of damages by the court against the infringer or an authorization to sue a State.

(E) RIGHTS AND PRIVILEGES NOT WAIVED. — No action taken by an infringer under subparagraph (C) shall be deemed to waive any right or privilege that, as a matter of law, protects the infringer from being subject to suit in the courts of the United States for an award of damages.

(d) PRESERVATION OF OTHER RIGHTS, LIMITATIONS, AND DEFENSES. — This section does not affect any right, or any limitation or defense to copyright infringement, including fair use, under this title. If another provision of this title provides for a statutory license that would permit the use contemplated by the infringer, that provision applies instead of this section.

(e) COPYRIGHT FOR DERIVATIVE WORKS AND COMPILATIONS. — Notwithstanding section 103(a), an infringer who qualifies for the limitation on remedies afforded by this section shall not be denied copyright protection in a compilation or derivative work on the basis that such compilation or derivative work employs preexisting material that has been used unlawfully under this section.

(f) EXCLUSION FOR FIXATIONS IN OR ON USEFUL ARTICLES. — The limitations on remedies under this section shall not be available to an infringer for infringements resulting from fixation of a pictorial, graphic, or sculptural work in or on a useful article that is offered for sale or other distribution to the public.



Being a 501(c)(3) nonprofit, the *Green Bag* takes no position on whether the “Shawn Bentley Orphan Works Act of 2008” should become law, nor do we urge you to contact members or employees of Congress for the purpose of proposing, supporting, or opposing the bill. But we do suggest that it is a thought-provoking proposal, and being in the business of provoking thoughts, we were provoked by our experience with the BLA’s entertaining ransom note to bring this matter to your attention.