



Orphan works – US developments

In spring the US Congress began considering legislation which would extend protection to users of “orphan works”. Orphan works are works for which there is no identifiable parent or, if there is one, it can’t be found. Congress cares about them because copyright

terms have, in the eyes of many, become too long. Longer copyrights bottle up the public domain so that even works of questionable value can’t be used for fear of litigation reprisals.

In 1998 Congress, to conform to European practices, extended pre-1978 copyrights to 95 years and provided for a term of life plus 70 (95 years for works-for-hire) for post-1978 works. Practically speaking, the older the work, the less likely it will have any real economic value and the more likely that the owner will be difficult, if not impossible, to locate or even identify. Given the risk involved in creating new works based on older ones, few will incorporate one of the “orphans” into a new work for fear of a ruinous award of damages or, even worse, an injunction prohibiting all use of the new work.

Orphan work legislation would restore balance to a system where longer terms mean more works are withheld from public use. It would generally limit or regulate awards of damages and even prohibit injunctions in certain cases where a user conducts a reasonable investigation but can’t identify or locate the owner. Should the owner make himself known after commencement of the use, he will generally be limited to claiming a reasonable royalty. Ultimately, disputes would still need to be resolved in the courts although the legislation, as currently drafted, clearly favours negotiated settlements for use of works which were reasonably believed to be without owners.

It is not clear whether this legislation will ultimately be passed by Congress and signed into law by the President. Copyright owners have raised legitimate concerns about how a “reasonable” search can be defined without giving prospective users a blue print or licence for circling around and avoiding legitimate right holders. Unless these concerns are met, orphan works may continue to languish somewhere between a zone of amorphous exclusivity and the public domain.

Edwin Komen, Sheppard Mullin Richter & Hampton, LLP



Martin Kretschmer is Professor of Information Jurisprudence and Joint Director of the Centre for Intellectual Property Policy & Management (www.cippm.org.uk) at Bournemouth University, UK.



Lisa Peets, Special Counsel, Covington & Burling. A former editor of the Harvard Law Review, Ms Peets practises intellectual property law with a focus on international copyright issues. She has practised law in both the United States and Europe in a range of capacities.



Elliott Simcoe is a partner in Smart & Biggar/Featherstonhaugh’s Ottawa office. Mr Simcoe has a broad range of experience in all aspects of intellectual property and computer law including litigation, licensing, prosecution and counselling, with an emphasis on patent, trade-mark and copyright litigation in the Federal Court of Canada.



Luis C Schmidt is a partner at Olivares & Cia, Mexico. With a Masters in IP Law from the Franklin Pierce Law Center in New Hampshire, USA, Mr Schmidt’s practice focuses on entertainment, copyright and cyberlaw.



Justin Watts, undertakes both contentious and non-contentious work for technology, media and communications clients. Dr Watts became a partner at Freshfields Bruckhaus Deringer in 2003 following many years at Bristows.

Editorial Board

■ UK

Alex Chapman, Briffa

Simon Clark, Berwin Leighton Paisner

Martin Kretschmer, Centre for Intellectual Property Policy & Management, Bournemouth University

Lisa Peets, Covington & Burling

Hamish Sandison, Bird & Bird

Mark Stephens, Finers Stephens Innocent

Justin Watts, Freshfields Bruckhaus Deringer

■ USA

Edwin Komen, Sheppard Mullin Richter & Hampton

Cydney A Tune, Pillsbury Winthrop Shaw Pittman

Daniel Glazer, Shearman & Sterling

■ Germany

Jan Pohle, Taylor Wessing

■ Canada

Daniel Lack, Ogilvy Renault

Elliot Simcoe, Smart & Biggar/ Featherstonhaugh

■ India

Akash Chittranshi, Akash Chittranshi & Associates

■ Poland

Janusz Fiolka, Dr Janusz Fiolka Patent and Trademark Attorney

■ Mexico

Luis Schmidt, Olivares & Cia