# PROTECTION OF ORPHAN WORKS IN THE CYBERSPACE – UNITED STATES AND INDIAN LEGAL PERSPECTIVE

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## I. Introduction

Orphan Works, in terms of intellectual property, are copyright materials with no owner that can be identified or located by potential user of the work who wish to obtain rights to use the work. For example, the creator of the work may have been deceased or the publisher of the work may now be defunct, or there might be no data available to identify the author of the work. When such orphan work needs protection under the Copyright regime, confusion arises as to the category of work, scope of protection and kind of orphan work to be covered under the copyright laws. These challenges have to be tackled with due care and diligence, taking into account the situation prevailing in the era of Google digitisation cases and beyond. This paper is divided into two parts dealing with the United States and Indian legal perspective, and discusses the (i) meaning of orphan works and the legal position in the cyberspace and related issues, (ii) basic challenges with respect to orphan works, (iii) position as to why an orphan work is ill-equipped to deal with cyberspace, along with the basic problems including determination of public and private use and the enforcement of liability, (iv) the Indian scenario with respect to jurisdiction in cyberspace and finally, (v) the future of orphan works.

## II. Orphan Works Protection in Cyberspace Under the United States Legal Perspective

### *A. General Introductory Comments*

Digital technologies[1] breathe new value into old "works"[2] and at the same time "affects the operation and effectiveness of copyright law". The flip side of digital technology as an enabler is the threat of frauds leveraging on

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1 The almighty combination of digital signal processing, personal computers, and digital networks, usually called digital technologies affects how we entertain ourselves, how we communicate, how we transact, and how we create. So, one comprehensive set of rules would be insufficient to regulate all these aspects.

2 This article used the word 'work' as defined under Section 2 (y) of the Indian Copyright Act 1957, (hereinafter ICA) and the UK CDPA, 1956, Part I and Part II Sections 1 to 16. ICA does not consider broadcasting as a work. But UK CDPA, 1988, Section 1 says that, broadcasting is also a work just like literary, dramatic and musical works. Even UK copyright Act 1956 had recognized broadcasting as a work. Therefore the word "work" should be read as in the same context further.



technology that are ever increasing in intensity and sophistication,[3] because of the numerous intermediaries[4] work having involved in World Wide Web (WWW). Many scholars like Jeremy Orlebar[5], Shih Ray Ku, Raymond[6], Lesley Ellen Harris[7]and papers[8] have observed that, from Gutenberg's moveable type printing press to digital technologies brings never-ending challenges for copyright law to respond to.

In cyberspace,[9] author of a work has, reproduction right, modification rights, distribution rights, public performance rights, and public display rights.The copyright law provides a benefit to authors by ensuring that copiers will not free-ride on their investments in creativity and also provides exceptions in the form of "fair use."[10] One of the major objective of copyright laws is to ensure that authors will not have to share their profits with free-riders. It was rightly observed by the New South Wales court that 'One man may not reap where another has sown, nor gather where another has strewn'.[11] The unidentifiable nature of orphan works itself enables production of more free-riders down the line. These free-riders makes commercial gain out of the orphan works through advertisements but at the same time are claiming the defence under "fair use" provisions. The perfect example of the issue as mentioned above is the Google digitisation case in the United States.[12]

3 Federation of Indian Chambers of Commerce and Industry (FICCI), The India Risk Survey Report (2014), *available at* http://www.ficci.com/Sedocument/20276/report-India-Risk-Survey-2014.pdf (last visited on March 24, 2017).

4 Intermediaries means, between the user/authors who initiates the electronic communication or publishing of an electronic record (text, data, sound/voice, pictures, films, electronic deliverable, electronically touchable objects and other electronic creation that can be perceived by the senses) and the recipient, viewer, listener, audience, and consumer; there are numerous service providers called intermediaries. See, Section 2(w) of the Indian Information Technology Amendment Act, 2009.

5 Jeremy Orlebar, The Practical Media Dictionary (Oxford University Press, 2003).

6 Shih Ray Ku, Raymond, *The Creative Destruction of Copyright: Napster and the Economics of Digital Technology*, 69 U. Chi. L. Rev. 263, 270 (2002).

7 Lesley Ellen Harris, Licensing Digital Content: A Practical Guide for Librarians (Amer Library Assn Editions, 2009).

8 W. Ku and C.H. Chi, Survey on the Technological Aspects of Digital Rights Management (Proc. of the 7th Information Security Conference, Vol. 3225, pp. 391-403, 2004).

9 The word "Cyberspace" is not defined under any law. The internet, the only bais of cyberspace, is global in character and is a network of interconnected computers.

10 *Apple Computer, Inc.* v. *Microsoft Corp.*, 799 F. Supp. 1006, 1021 (N.D. Cal. 1992).

11 *J. I. Case Plow Works* v. *J. I. Case Threshing Mach. Co.*, 155 N.W. 128, 134 (Wis. 1915). Also *see*, *SmithKline Beecham Consumer Healthcare, L.P.* v. *Watson Pharm., Inc.*, 211 F.3d 21, 29 (2d Cir. 2000).

12 *See*, *Authors Guild, Inc.* v. *Google Inc.,* No. 05 Civ. 8136 (S.D.N.Y. Nov.13, 2009); *Authors Guild* v. *Google, Inc. (Google I)* 770 F.Supp. 2d 666, 677 (S.D.N.Y. 2011); *Authors Guild, Inc.* v. *HathiTrust*, 902 F. Supp. 2d 445 (S.D.N.Y. 2012); *Authors Guild, Inc.* v. *Google, Inc. (Google II),* 954 F. Supp. 2d 282, 286-87 (S.D.N.Y. 2013); *Authors Guild, Inc.* v. *HathiTrust*, 755 F.3d 87 (2d Cir. 2014).

### *(i) The Common and Critical Issues in Orphan works*

The problem related to orphan works affects a broad cross-section of stakeholders, including members of the general public, archives, publishers, and filmmakers. Orphan works raises practical questions about how copyright owners should be compensated for the use of their works in commercial nature (the examples of Google books and HathiTrust mass digitization projects are of great importance here), and also raises legal questions about the applicability of exclusive rights,[13] limitations and exceptions under copyright law. Is the existing copyright framework sufficiently responsive to these concerns? If not, are there important public or private goals that might warrant legislative action in this area?

The United States copyright office determined in 2006 that, "the risk of liability for copyright infringement, however remote, is enough to prompt them not to make use of [an orphan] work" – and came up with the outcome that "it is not in the public interest, particularly where the copyright owner is not locatable because he no longer exists or otherwise does not care to restrain the use of his work."[14] The Report noted that the orphan works problem was exacerbated by a series of changes in the United States copyright law over the past thirty-plus years.[15]

In particular, as per the law, literary works, pictures, sound recordings and other creative works are protected from being copied without the permission of the copyright holder. Any work, which is communicated in cyberspace, is also entitled to protection by law. However, it is still unclear how the copyright law governs or will govern these materials as they appear on the Internet. The cyberspace poses two basic challenges for the Intellectual Property Right (hereinafter referred as IPR) administrator because, cyberspace does not have any particular territory or border and no one has the absolute power to control and regulate it. That is why, it is important to address the question as to how to control it and find a way to define its extent. The IPR administrator's special challenge lies in how to balance the rights of different players on the Internet like content providers, service providers, access providers and so on. Thus, finding, tracking, and controlling wrongdoers in cyberspace has been a major threat, especially, to orphan works. Therefore, issues relating to full-text searches,

[13] Copyright protection gives the author of work a certain "bundle of rights"to exclude other from reproducing the work in copies, to prepare derivative works based on the copyright work and to perform or display the work publicly. There are numerous other rights, which are specific to dramatic, literary works etc.

[14] U.S. copyright office, Report on Orphan Works (2006), *available at* http://copyright.gov/orphan/orphan-report-full.pdf(last visited on March 24, 2017).

[15] *Id*. at 41-44.



print-disabled access, and preservation too come under this ambit. As the problem related to orphan works becomes more acute, it threatens to undermine the increasing number of digitization projects.[16]

### *(ii) Need for Protection: Innovation, Information and Ideas*

Creation, protection and utilisation are the three cardinal limbs of the IPR system. It was rightly observed by the learned Justice H. Laddie that "The whole of human development is derivative. We stand on the shoulders of the scientists, artists and craftsmen who precede us. We borrow and develop what they have done: not necessarily as parasites, but simply as the next generation. It is at the heart of what we know as progress. Borrowing and developing have always been acceptable."[17] Innovation is a central driver of economic growth, development and better jobs. It is the key that enables firms to compete in the global marketplace, and the process by which solutions are found to social and economic challenges.[18] Information became the primary *commodity* for any R&D activity. Intellectual property is all about human creativity. The impact of intellectual property rights has spread over every aspect of human life. It has got something in store for everyone ranging from philosophers, ethicist, scientist, politicians, artists, lawmakers, entertainers, business entrepreneurs, economists, professionals, labor, industrialists, students and common man.[19] Intellectual property rights are considered as reward for creative and skillfull work in execution of ideas. In fact it is more than a reward for conceiving and executing ideas[20].

As a result of the growth of digital technologies, creation of "works" has increased more than ever before in different forms including film, music, games, software producing agencies, e-publishing agencies and digital libraries. Because of its easy digitised storage, retrieval and dissemination for reading, seeing, watching and playing of works becomes much easier than in the past. At the same time, wrongdoers, in turn have started putting such digital

[16] Stef Van Gompel & P. Bernt Hugenholtz, *The Orphan Works Problem: The Copyright Conundrum of Digitizing Large-Scale Audiovisual Archives, and How to Solve It*, *available at* http://www.ivir.nl/publicaties/download/501 (last visited on March 24, 2017).

[17] Louise Longdin, *Copyright and fair use in the digital age,* University of Auckland Vol.6 (1) Business Review (2004).

[18] *See*, World Intellectual Property Report: The Changing Face of Innovation (2011), *available at* http://www.wipo.int/export/sites/www/freepublications/en/intproperty/944/wipo_pub_944_2011.pdf(last visited on March 24, 2017).

[19] Catherine Colstan, Principles of Intellectual Property (Cavendish Publishing Limited, London, 1999).

[20] Meir Perez Pugatch, The International Political Economy of Intellectual Property Rights (Edward Elgar Publicattion, 2004).

technologies to wrong use and for wrong purposes.[21]

Promoting the progress of science and technology is very important for each and every nation. The United States constitutional mandate seeks to *promote the progress of science* through the copyright system. Copyright refers to the author's (creators of all sorts such as writers, photographers, artists, film producers, composers, and programmers) exclusive right to reproduce, prepare derivative works, distribute copies, and publicly perform and display their works. The United States judiciary from time to time, keeps and updates guidelines for the users and creators, as well as the government. The Supreme Court of the United States of America reaffirmed in 2012 that, facilitating the dissemination of creative expression is an important means of fulfilling the constitutional mandate to "promote the progress of science" through the copyright system.[22] But the Orphan works'story is very different one from the incentive model to promote and protect innovations. Before further discussion, it is very important to lay emphasis on what exactly does one mean by an orphan work?

### *B. Orphan Works - Defined*

The US Copyright Office published its first Report on Orphan Works in January 2006. The Office has defined an "Orphan Work" as: any original work of authorship for which a good faith prospective user cannot readily identify and/or locate the copyright owner(s) in a situation where permission from the copyright owner(s) is necessary as a matter of law.[23] Thus, put in simpler terms, "Orphan works are copyright material with no owner that can be identified or located by someone wishing to obtain rights to use the work. For example, the copyright owner may be deceased, the publisher who owns the copyright may now be defunct, or there is no data that identifies the author of the work."[24] Orphan works are now seen as a significant problem around the world as it becomes difficult for the interested user to obtain required rights to use the work.[25] Khong D.W.K. states that, Orphan works means "copyrighted works

[21] Solange Ghernaouti, Cyber Power: Crime, Conflict and Security in Cyberspace (EPFL Press, Switzerland, 2013), has pointed out that "internet technologies are facilitators for many kinds of infringements: theft; sabotage of information; copyright infringements; breach of professional secrecy, digital privacy, or intellectual property; dissemination of illegal contents; competing attacks; industrial espionage; breach of trademark laws; dissemination of false information; denial of service; various frauds; money laundering – the list of possible offences goes on".

[22] *Golan* v. *Holder*, 132 S. Ct. 873, 887-88 (2012) (quoting U.S. CONST. art. I, § 8, cl. 8).

[23] U.S. copyright office, Report on Orphan Works (2006), *available at* http://copyright.gov/orphan/orphan-report-full.pdf(last visited on March 24, 2017).

[24] Giancarlo F. Frosio, *Google Books Rejected: Taking the Orphans to the Digital Public Library of Alexandria*, 28 Santaclaracomputer & High Tech. L.J. 81 (2011), *available at* http://digitalcommons.law.scu.edu/chtlj/vol28/iss1/3(last visited on March 24, 2017).

[25] Ian Hargreaves, *Digital Opportunity: A Review of Intellectual Property and Growth* (2011), *available at*http://dera.ioe.ac.uk/16295/7/ipreview-finalreport_Redacted.pdf (last visited on March 24, 2017).



whose owners are difficult or even impossible to locate."[26] The inability to use orphan works means that their productive and beneficial uses are lost to both users and copyright holders. Thus, questions of who should be entrusted with guardianship over orphan books, under what terms, and with what safeguards are matters more appropriately decided by the legislature than through an agreement among private, self-interested parties.[27] As per Ian Hargreaves orphan works are "the starkest failure of the copyright framework to adapt."[28]

### *C. The United States Copyright Act and its Effects*

There is no specific exception in the US Copyright Act for the use of orphan works. Unless covered by an exception or licence, use of an orphan work may constitute copyright infringement. However, orphan works may be used when covered by existing fair dealing exceptions or a statutory licence. The Copyright Act has changed gradually but has also steadily relaxed the obligations of copyright owners to assert and manage their rights and has thereby removed formalities in the law that had provided users with readily accessible copyright information. Significant among those changes were the elimination of the registration and notice requirements, which resulted in less accurate and incomplete identifying information on works, and the automatic renewal of copyrighted works that were registered before the effective date of the 1976 Copyright Act. In 1992, automatic renewal term for works was added in the first term from 1 January 1978, making it no specific requirement for the owners to renew their rights.[29] Following the introduction of automatic renewal provisions, the Sonny Bono Copyright Term Extension Act of 1998 extended the duration of copyright and thus, the major changes made to the Copyright Act, increased the likelihood that some copyright owners would become un-locatable.

The US Copyright Office has long asserted that Congress amended the law for sound reasons, primarily to protect authors from technical traps in the law and to ensure the United States' compliance with international conventions. With the 1976 Act, the United States took several important steps towards assuming a more prominent role in the international copyright community. These changes harmonized the United States copyright law with the prevailing international copyright norms and moved the United States closer to compliance

[26] D.W.K. Khong, *The (Abandoned) Orphan-Works Provision of the Digital Economy Bill*, E.I.P.R. 560 (2010), quoted in, T. G. Agitha, *International Norms for Compulsory Licensing and the Indian Copyright Law*, 15(1) The Journal of World Intellectual Property 26-50 (2012).

[27] *See*, *Google I*, *supra* n. 12.

[28] *Supra* n. *25.*

[29] Copyright Amendments Act of 1992, § 102(a), 106 Stat. 264, 264 (codified as amended at 17 U.S.C. § 304(a)).

with the Berne Convention.[30] However, "the net result of these amendments has been that more and more copyright owners may go missing".[31]

### *(i) Orphan Works: the Role of the United States' Copyright Office*

The US Copyright Office examined the topic of orphan works and mass digitization in separate publications issued in 2006 and 2011 respectively.[32] Thus, the US Copyright Office began an in-depth study of this issue and the related issue of orphan works on the 15th of June 2015.[33] As part of its subsequent "Orphan Works and Mass Digitization Report" the Office proposed the creation of a limited "pilot program" that would establish a legal framework known as extended collective licensing (ECL) for certain mass digitization activities. The Office noted the broad impact of both issues on the copyright system, discussed various potential responses, and, with respect to orphan works, proposed a legislative solution.

This Report addresses two circumstances in which the accomplishment of that goal may be hindered under the current law due to practical obstacles preventing good faith actors from securing permission to make productive uses of copyrighted works. Firstly, with respect to orphan works, referred to as "perhaps the single greatest impediment to creating new works" a user's ability to seek permission or to negotiate licensing terms is compromised by the fact that, despite his or her diligent efforts, the user cannot identify or locate the copyright owner. Secondly, in the case of mass digitization – which involves making reproductions of many works, as well as possible efforts to make the works publicly accessible – obtaining permission is essentially impossible, not necessarily because of lack of availability of identifying information or the inability to contact the copyright owner, but because of the sheer number of individual permissions required.[34]

## III. The US Initiatives to Strengthen IPR Protection and Enforcement Internationally

The United States has worked to promote adequate and effective protection and enforcement of IPR through a variety of mechanisms.

[30] *Available at* http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/berne.pdf(last visited on March 24, 2017).

[31] U.S. Copyright Office on Legal Issues in Mass Digitization: A Preliminary Analysis and Discussion Document (2011), *available at* http://copyright.gov/docs/massdigitization/USCOMass Digitization_October2011.pdf(last visited on March 24, 2017).

[32] U.S. Copyright Office, Report on Orphan Works (2006), *available at* http://copyright.gov/orphan/orphan-report-full.pdf(last visited on March 24, 2017).

[33] U.S. Copyright Office, Orphan Works and Mass Digitization, *available at* http://copyright.gov/orphan/reports/orphan-works2015.pdf (Last visited on March20, 2017).

[34] *Ibid*.



In the United States, it is difficult to separate the issue of mass digitization from two lawsuits arising out of the Google Books project, in which authors and book publishers have asserted violations of their exclusive rights and Google and libraries have asserted fair use.[35] Recent decisions in these cases have magnified the public debate surrounding the costs and benefits arising from digitization projects more generally and how best to license, except/or otherwise regulate them under the law. Meanwhile, a growing number of countries have adopted legislative responses to both orphan works and mass digitization, ranging from calibrated exceptions to government licenses to extended collective licensing. And, private entities have developed innovative new copyright information registries and other resources to more efficiently bring rights holders together with those seeking to use their works.

In 2004, Google began an ambitious project to digitize millions of books held by several major libraries, including many books still protected by copyright.[36] Google scanned and digitized more than 15 million books published both in the United States and universally and continues to scan books today. Before scanning and publishing, Google did not obtain prior permission from the authors or publishers of the books. Millions of these books were protected by copyright law at the time they were scanned, but neither Google nor the participating libraries obtained permission from the relevant copyright owners. Google provided its library partners with digital copies of these works and made them available to users for full-text searching.

The important issue here is that, the books were digitalised without the prior permission of the authors but Google took a different stand, urging that they were simply advertising and that they were simply collecting revenue from the advertising of those works. Google's search service allows end-users to view "snippets" from books that are subject to copyright protection and it allows end-users to view and download public domain books in their entirety. Google's search engine freely used, other's work without prior permission but the company collects revenue from advertising and they cleverly says that users can use the services freely. The Google search engine presented with the search results, including pages that reproduce and display images from copyrighted books. Users were permitted to view "snippets" of scanned books that were still protected by copyright and to download full copies of books that were in the public domain. A "snippets" was an excerpt consisting of one-eighth of a page.

[35] See, *Google I & Hathi Trust* (2012), *supra* n. 12.

[36] About Google Books, GOOGLE, *available at* http://books.google.com/intl/en/googlebooks/about/. (last visited on March 24, 2017).

Google implemented security measures to limit the portion of any book accessible through snippet views, including generating only three snippets in response to any given search and "blacklisting"( i.e., making unavailable) certain snippets and entire pages.[37]

Some authors and publishers objected to Google's actions. In 2005, the authors brought a class action lawsuit asserting that Google had committed wilful infringement, and publishers raised similar claims. In response, Google asserted a fair use defence. The parties entered into a proposed settlement on October 28th, 2008, and after Department of Justice (DOJ) and many others objected to the proposal, the parties filed a revised settlement proposal on November 13th, 2009. DOJ urged the court to reject this settlement, citing concerns about copyright law as well as antitrust and class action related issues. In addition, hundreds of private actors and the governments of France and Germany filed formal objections. A fairness hearing was held on February 18th, 2010.[38]

### *(i) Authors Guild* v. *Google, Inc. (Google I)*

In 2011, the United States District Court for the Southern District of New York rejected a proposed settlement in *Authors Guild* v. *Google Inc.*[39] the copyright infringement litigation in which authors and publishers challenged the highly publicized "Google Books" project.[40] It is called "Google Books" case. In the Authors Guild case it was held that, "Google would provide payments to the registry on behalf of rights holders and, in turn, the registry would distribute the funds to registered rights holders. If no rights holder came forward to claim the funds after a certain amount of time, the funds could be used to cover the expense of searching for copyright owners or be donated to literacy-based charities".[41]

In March 2011, Judge Denny Chin rejected the amended settlement agreement. The court recognized that "the benefits of Google's book project are many," including making books more accessible to "libraries, schools, researchers, and disadvantaged populations," facilitating access for persons with disabilities, generating new audiences and sources of income for authors and publishers, and preserving older books currently "falling apart buried in library stacks."[42] In this case, the question of how mass book digitization fits

[37] *See*, *Google II*, supra n. 12.
[38] *Google I*, *supra* n. 12 at 671.
[39] *Ibid*.
[40] *Supra* n.36.
[41] *Authors Guild*, *supra* n. 12 at 671-72.
[42] *Id*. at 670.



within the existing copyright framework is a timely one. In a much-anticipated opinion, the federal court found that "the settlement would inappropriately implement a forward-looking business arrangement granting Google significant rights to exploit entire books without permission from copyright owners, while at the same time releasing claims well beyond those presented in the dispute."[43] As the court explained:

> The question of who should be entrusted with guardianship over orphan books, under what terms, and with what safeguards are matters more appropriately decided by Congress than through an agreement among private, self-interested parties. Indeed, the Supreme Court has held that "it is generally for Congress, not the courts, to decide how best to pursue the Copyright Clause's objectives." [And the Supreme Court has] noted that it was Congress' responsibility to adapt the copyright laws in response to changes in technology.[44]

In October 2012, the five major publisher plaintiffs settled with Google. According to public statements about the settlement, the publisher plaintiffs will be permitted to choose whether or not to include digitized books in the Google Books project.[45] Further details of the settlement have not been made public. Notably, the settlement does not require formal court approval because it only resolves the claims of the specific publisher plaintiffs. The settlement does not affect claims made by the Authors Guild or non-parties to the lawsuit.[46] Therefore, the settlement would not address orphan works in which copyrights are owned by anyone other than the publisher plaintiffs.

### *(ii) Authors Guild, Inc.* v. *Hathi Trust (hereinafter Hathi Trust case)*

The Hathi Trust case is slightly different from the aforementioned "Google Books" case. In September 2011, the Authors Guild, along with two foreign authors' groups and a number of individual authors, sued a consortium of colleges, universities, and other nonprofit institutions known as Hathi Trust.[47]

[43] The amended settlement agreement covered photographs and other pictorial works contained in books only where a party holding a copyright interest in the image also held a copyright interest in the book. See Settlement Agreement §§ 1.13, 1.75.
[44] *Google I*, *supra* n. 12 at 677.
[45] *Publishers and Google Reach Settlement* (4th October 2012), *available at* http://www.publishers.org/press/85/(last visited on March 20, 2017).
[46] Several associations of photographers and other visual artists filed a separate action challenging the Google Books program in April 2010. That case was settled in September 2014. See Press Release, *National Press Photographers Ass'n Google, Photographers Settle Litigation Over Books* (Sep.5 2014), *available at* https://nppa.org/news/google-photographers-settle-litigation-over-books (last visited on March 20, 2017).
[47] *Authors Guild* (2012), *supra* n. 12.

Hathi Trust members had agreed to allow Google to scan the books in their collections for inclusion in the Hathi Trust Digital Library (HDL). For copyrighted works in the HDL, HathiTrust permitted three uses: (1) full-text searches by the general public, (2) full access for library patrons with certified print disabilities, and (3) creation of preservation copies under specified circumstances. In addition to those uses, the plaintiffs also challenged the University of Michigan's separate Orphan Works Project, under which out-of-print works whose copyright owners could not be located would be made accessible in digital format to library patrons. The complaint alleged, inter alia, that the plaintiffs were easily able to locate several of the authors whose works were deemed orphaned by Hathi Trust, and thus the project was not actually limited to orphan works. Shortly after the complaint was filed, the University suspended the Orphan Works Project indefinitely.[48]

In October 2012, the district court ruled in favour of Hathi Trust on issues relating to full-text searches, print-disabled access, and preservation.[49] The court found these activities to be largely transformative and ultimately protected by fair use, further opining that "the underlying rational of copyright law is enhanced" by the HDL.[50] The court did not reach the merits of the claims regarding the Orphan Works Project, however, finding instead that the issue was not ripe for adjudication in the light of the project's suspension.[51]

### *(iii) Authors Guild, Inc.* v. *Google, Inc. (Google II)*

In November 2013, Judge Chin granted Google's motion for summary judgment on its fair use defence against the remaining claims by the Authors Guild.[52] After considering the four fair use factors enumerated in 17 U.S.C. $107, the court concluded that "Google Books provides significant public benefits", and that its book scanning project constitutes fair use.[53] The court found that Google's "use of book text to facilitate search through the display of snippets" was transformative in nature because it "transforms expressive text into a comprehensive word index that helps readers, scholars, researchers and others find books.[54] Such use, the court held, "does not supersede or supplant books because it is not a tool to be used to read books."[55] The court further held that, although Google copied books in their entirety, that fact did not weigh

[48] *Id*. at 449.
[49] *Id*. at 464.
[50] *Ibid.*
[51] *Id*. at 455-56.
[52] *Google II*,*supra* n. 12.
[53] *Id*. at 293-94.
[54] *Id*. at 291.
[55] *Ibid*.



strongly against a finding of fair use because "Google limits the amount of text it displays in response to a search."[56] For similar reasons, the court found that Google Books did not negatively impact the market for books, nothing that Google's policy of "blacklisting" certain pages and snippets would prevent any user from accessing an entire book through multiple searches.[57]

Users were permitted to view "snippets" of scanned books that were still protected by copyright and to download full copies of books that were in the public domain. A "snippet" was an excerpt of the book consisting one-eighth of a page. Google implemented security measures to limit the portion of any book accessible through snippet views, including generating only three snippets in response to any given search and "blacklisting" ( i.e., making unavailable) certain snippets and entire pages.[58] Thus, while the court found the Google Books project to be fair use, it did not address whether a mass digitization project involving uses beyond the display of snippets would qualify for such protection. Nor did it separately address treatment of orphan works outside of the mass digitization context.

### *(iv) Authors Guild, Inc.* v. *Hathi Trust II*

On appeal against the decision of district court in favour of Hathi Trust, the Second Circuit upheld the district court's finding that the creation of a full-text searchable database and the provision of access for the print-disabled were fair uses.[59] The court vacated the finding that Hathi Trust's preservation function was fair use and remanded for consideration of whether the plaintiffs had standing to challenge that aspect of HathiTrust activities.[60] In addition, the court affirmed the district court's ruling that the plaintiffs' challenge to the Orphan Works Project was not ripe for adjudication.[61]

All of the United States copyright stakeholders strongly suggest that it is time to revisit potential solutions in the United States. The goal in doing so is not to interfere with jurisprudence, but rather to ensure that the rules are clear and that all parties are on an equal footing. Indeed, with so many equities at stake, the complexity and breadth of the issues make them well suited for legislative action.[62] Indeed, the Google Books settlement demonstrated that "rights holders and rights users are capable of coming to the table and arriving

[56] *Id*. at 292.
[57] *Id*. at 292-93.
[58] *Google II*, *supra* n.12.
[59] *Authors Guild* (2014), *supra* n. 12..
[60] *Id*. at 104.
[61] *Id*. at 105.
[62] U.S. Copyright Office's, Orphan Works and Mass Digitization, *available at* http://copyright.gov/orphan/reports/orphan-works2015.pdf(last visited on March 20, 2017).

at a solution which serves the interests of all stakeholders and also promotes the goals of copyright law."[63] In the Statement of Interest it filed in the case, the United States raised concerns about the settlement primarily because it would have bestowed the benefits of mass digitization on only one party, not because of any fundamental concern about the functioning or legitimacy of an appropriately structured ECL program more generally.[64]

Simplifying the process of obtaining prior permission from authors and other rights holders would be immensely beneficial. Others may suggest that with guidance and encouragement from Congress, stakeholders could and should be encouraged to explore solutions within the marketplace, including private agreements or memoranda of understanding. The questions raised in this analysis are complex and will require additional review and deliberation.

## IV. Orphan Works Protection in Cyberspace Under Indian Legal Perspective

Legal Frame work for IPR's in India and the concerned Administrative Ministries was earlier specified under The Government of India (Allocation of Business) Rules, 1962, which governed distribution of work amongst different Ministries/Departments of the Government of India. However, with the recent developments and government's commitment towards establishing a strong IPR regime in the country, now all the IPR related Laws are administered by the Ministry of Commerce and Industry through its agency, Department of Industrial Policy and Promotion. With this the functions of copyright office and its related subordinates were shifted from the Ministry of Human Resources to the Ministry of Commerce and Industries and positively the functioning of the office under its new administrative head has shown great improvement in terms of timeliness and digitalisation.

### *(i) Orphan Works in India*

Indian Copyright Act (hereinafter referred to as ICA), at no place, has expressly defined or used the term "Orphan Work"[65], but the ICA has also

[63] The book publishers settled their claims against Google in 2012. The terms are confidential. *Authors Guild, Inc.*, Comments Submitted in Response to U.S. Copyright Office's Feb.10, 2014 notice of Inquiry at 9 (Authors Guild additional Comments).

[64] *See*, Statement of Interest of United States of America Regarding Proposed Amended Settlement Agreement at 2, *Authors Guild, Inc*. v. *Google Inc.*, No. 05 Civ. 8136 (S.D.N.Y. Feb. 4, 2010), ECF No.922 (U.S Statement of Interest).

[65] T. G. Agitha, *International Norms for Compulsory Licensing and the Indian Copyright Law*, 15(1) Journal of World Intellectual Property 26-50 (2012).



covered the protection in respect of such works.[66] India's legal protection in respect of orphan works was first established in 1957 and was recently amended in 2012.[67] According to the ICA, a compulsory license[68] can be granted to an applicant who wishes to exploit an orphan work where the author is dead, unknown, cannot be traced or cannot be found.[69] It extends the scope to any work and not necessarily limited to those of Indian origin. Thus, compared to the definition of Orphan Works as given under the United States and the UK, the meaning is more relevant and extended in the Indian legal perspective.[70] ICA has also covered the published works as well as the unpublished works which originated in India. The amendment provision covered foreign works capable of being licensed compulsorily in case it is published elsewhere but withheld in India.[71]

Analysis of the relevant provision of the Act indicates that the following goals are meant to be achieved by issuance of compulsory licenses in respect of orphan works:

i. To make available Indian works which are unreasonably with held from public.
ii. To publish and bring to public those unpublished works whose authors are unknown or untraceable.
iii. To make available Indian or foreign works which are not available in India at all or at a reasonable price.
iv. To allow production and publication of translation of Indian and foreign works into Indian languages.

[66] But it does not mean to cover abandoned works. See more about abandoned work on D.W.K. Khong, *Orphan Works, Abandonware and the Missing Market for Copyrighted Goods*, 15 International Journal of Law and Information Technology, 54–89 (2007), *available at* http://ijlit.oxfordjournals.org/content/15/1/54.full.pdf+html (last visited on March 20, 2017).

[67] Received the assent of the President on the 7th June, 2012, *available at* http://copyright.gov.in/ (last visited on March 20, 2017).

[68] Compulsory/non-voluntary licensing is one method of assuring dissemination of information while giving due respect to the author's/owner's rights by compensating him. It balances the interests of owners and users by compelling the owner of copyright to grant licences on request, against the payment of equitable remuneration. *See*, L. M. C. R. Guibault, Copyright Limitations and Contracts - An Analysis of the Contractual Overridability of Limitations on Copyright (Kluwer Law International, London, 2002).

[69] *Ibid*.

[70] See the above definition of "Orphan Works" – Chapter II (B), ICA.

[71] Given how onerous our compulsory licensing sections are, especially sections 32 and 32A (which deal with translations, and with literary, scientific or artistic works), it is not a surprise that they have not been used even once. However, given the modifications to s.31 and s.31A, we might just see those starting to be used by publishers, and not just radio broadcasters. Analysis of the Copyright (Amendment) Bill 2012, *available at*http://cis-india.org/a2k/blogs/analysis-copyright-amendment-bill-2012(last visited on March 20, 2017).

v. To permit broadcasting of translations for teaching and dissemination of research results.

vi. To make available works to disabled persons.

vii. To provide for statutory licenses for cover versions.

viii. To provide for statutory licenses for radio broadcasts.

***(ii) Compulsory Licence in Unpublished Indian Works under Indian law***

As per Section 31A of the ICA,[72] where the author of any unpublished work is dead or unknown or cannot be traced or any work published or communicated to the public and the same is withheld from the public in India, or the owner of the copyright in such work cannot be found, then any person may apply to the Copyright Board for licence to publish or communicate to the public such work or a translation thereof.[73] Here, it is very important to note that the word "unpublished work" has been referred at seven different provisions under the ICA.[74] The Copyright (Amendment) Act, 2012 enhanced the scope of Section 31A (1) by extending it to cover all works and not just Indian works.

***(iii) Conditions for obtaining Compulsory Licenses for Unpublished Indian Works***

Before making such an application, the applicant shall publish his proposal in one issue of a daily newspaper in the English language having circulation in the major part of the country and where the application is for the publication of a translation in any language, such proposal must also be published in one issue of any daily newspaper in that language.[75] Every such application shall be made in such form as may be prescribed and shall be accompanied with a copy of the advertisement issued under Section 31A (2) and with such fee as may be prescribed.[76] The requirement of advertisement serves two purposes – first, the untraceable author owner may read it and come forward to discuss the potential use by the applicant and second, to invite any objections or reservations that any other person may have against such publication.[77]

[72] Section 31A, introduced on the basis of Berne Appendix, provides for issuing compulsory licences for unpublished Indian works in the case of which the author is dead or unknown or cannot be traced, or the owner of copyright cannot be found, to publish such work or translation thereof in any language.

[73] See, Sec. 31 A (1) of ICA

[74] See, ICA, Sec.2 (i) Indian work; Sec. 7, Nationality of author where the making of unpublished work is extended over considerable period; Sec13, (2) (ii) Works in which copyright subsists; Sec.16 No copyright except as provided in this Act; Sec.31A (Compulsory licence in unpublished Indian works; Sec. 40 (Power to extend copyright to foreign works) (b); Sec. 52 (p) Certain acts not to be infringement of copyright.

[75] ICA, Sec. 31A (2).

[76] ICA, Sec. 31A (3).



***(iv) Compilations of Inquiry***

Where an application is made to the Copyright Board under Section 31A, it may, after holding such inquiry as may be prescribed, direct the Registrar of Copyrights to grant to the applicant a licence to publish the work or a translation thereof in the language mentioned in the application subject to the payment of such royalty and subject to such other terms and conditions as the Copyright Board may determine, and thereupon the Registrar of Copyrights shall grant the licence to the applicant in accordance with the direction of the Copyright Board.[78]

***(v) Limitation, Fees and Benefit of the Compulsory Licenses***

Where a licence is granted under this provision, the Registrar of Copyrights may, by order, direct the applicant to deposit the amount of the royalty determined by the Copyright Board in the public account of India or in any other account specified by the Copyright Board so as to enable the owner of the copyright or, as the case may be, his heirs, executors or the legal representatives to claim such royalty at any time.[79]

Without prejudice to the foregoing provisions [Sec. 31A (6)], in case of an unpublished Indian work whose author is dead, the Central Government may, if it considers that the publication of the work is desirable in the national interest, require the heirs, executors or legal representatives of the author to publish such work within such period as may be specified by it. Where any work is not published within the period specified by the Central Government, the Copyright board may, on an application made by any person for permission to publish the work and after hearing the parties concerned, permit such publication on payment of such royalty as the Copyright Board may, in the circumstances of such case, determine in the prescribed manner.[80]

If the Board is satisfied that the licence for publication or communication to the public or translation in any language of the work, applied for may be granted to the applicant, or if there are more applicants than one, to such applicants, as, in the opinion of the Board, would best serve the interest of the general public, it shall direct the Register of Copyright to grant the licence

[77] The differences between assignment and licensing are, however, important for different reasons. For example, a failure to pay royalties due under the original agreement may, in the case of licence, enable a licence to be revoked but in the case of an assignment, cannot lead to recovery of the copyright which has been assigned. *See*,N.S. Gopalakrishnan & T.G. Agitha, Principle of Intellectual Property (Eastern Book Company, Lucknow, 2009), p. 345.

[78] ICA, Sec. 31A (4).

[79] ICA, Sec. 31A (5).

[80] ICA, Sec. 31A (7).

accordingly. Every such licence shall specify:

i. the period within which such work shall be published, translated or communicated to the public;

ii. the price at which the copies of such work are to be sold or charges to be collected for communicating the work to the public;

iii. the amount of royalty to be deposited and the account in which it has to be deposited;

iv. in case of translation of the work, the language in which the translation shall be produced and published; and

v. in case of communication to the public of the work the medium in which it is to be communicated to the public.[81]

### *(vi) The Copyright Board and its Role in Orphan Works*

Copyright Board is the statutory body responsible for recognising and issuing of compulsory license in respect of an orphan work.[82] Before making an application, an applicant must publish their proposal. All categories of works including literary, dramatic, musical, artistic works, and sound recordings etc. are covered. Where due diligence is appropriately carried out, an applicant will then make an application to the Copyright Board. The application should also be accompanied by the relevant fee. The Copyright Board takes into consideration a number of factors in determining the manner of royalties/tariffs to be paid, e.g. the retail price and prevailing standards. The licence will be subject to the payment of a royalty and to terms and conditions as the Copyright Board may determine, e.g., the duration, royalty rate (having considered a retail price) and prevailing royalty standards, and recipient with the language for translation standards. The amount of royalty deposited by an applicant will be available for a copyright owner or their heirs, executors or the legal representatives.

A licence can be cancelled if the licensee has failed to produce and publish the work, has used fraud or misrepresentation, or has contravened any of the terms and conditions. The copyright collecting societies do not play a role in orphan works in India and there does not appear to be a register or database

[81] Rule 11(5) of Copyright Rules, 2013, *available at* http://copyright.gov.in/Documents/CopyrightRules1957.pdf(Last visited onMarch20, 2017).

[82] Administration of Copyright Societies: Sections 33, 34 and 35 relate to the registration and functioning of a copyright society. These have been amended to streamline the functioning of the copyright societies. All copyright societies will have to register afresh with the registration granted for a period of five years. Renewal is subject to the continued collective control of the copyright society being shared with the authors of works in their capacity as owners of copyright or of the right to receive royalty.



detailing suspected orphan works. Furthermore, there is no case law involving an infringement of use of orphan works or a reappearing author.

### *(vii) Special Provision for Access to the Disabled*

Section 31B of the ICA provides for issuance of compulsory license in works for the benefit of the disabled in an expedited manner. The Copyright Board, on an application for a Compulsory License by any person working for the benefit of persons with disability on a profit basis or for business shall dispose such application within a period of two months from the date of receipt of application. The Compulsory License issued must specify the means and format of publication, the period during which the compulsory license may be exercised and the number of copies that may be issued including the rate or royalty.

## V. Conclusion

Indian copyright law is one of the finest and effective laws in the world dealing with every corner of protection concerned.[83] The Indian Copyright Act as amended in 2012 is in full conformity with the international treaties including those of WIPO internet treaties, to which India is not a party.[84] The legislative and statutory measures are supplemented by appropriate administrative measures by the Governments both at the Central and State levels for enforcement of IPRs; this includes Inter-Ministerial Committee on Enforcement of IPR laws, Copyright Enforcement Advisory Council (CEAC), Enforcement Cells, Intellectual Property Appellate Board (IPAB), Automated Recording and Targeting System (ARTS) portal of Central Board of Excise and Customs (CBEC) and the recently introduced Cell for IPR Promotion and Management (CIPAM).

The IP protection is not an easy task especially when it comes to digital world where no author can be hundred percent guaranteed with protection for their work. There is a need for broad public-private partnerships and more cooperation and collaboration among brand owners and their intermediaries to stop criminals from introducing their harmful, dangerous and illegal goods into the supply chain. It's easy to stay on the straight and narrow.[85] Anyone who uses an orphan work must be conscious of how much hard work the author

[83] Indian copyright law shall mean any Act, Ordinance, Regulation, rule, order, bye-law or other instrument in force in India related to copyrights.

[84] Response to Hearing Testimony on India IPR, *available at* http://www.ficci.com/sector/24/add_Docs/Response-to-Hearing-Testimony-on-India-ipr.pd (last visited on March20, 2017).

[85] *See*, *Pirated Products Like Other Crimes, Piracy Doesn't Pay, available at* http://www.ncpc.org/topics/intellectual-property-theft/pirated-products (last visited on March20, 2017).

must have put into it. It is his moral duty to not steal away someone else's credit and in case he is unable to locate the original author, he must take the proper steps as accorded by law before using any of suchorphan work(s). One must be aware of their rights and liabilities with respect to such orphan works and special attention should be paid to the points given below:

i. When one thinks of using any work which does not belongs to them, it is significant to identify the respective owner to obtain rights to use the same.

ii. When such work appears to be coming under the category of orphan works, it is important for the user to adopt measures to obtain necessary rights/ licences as per the laws in force.

iii. One must not simply proceed to make copies of orphan works'in digital medium and distribute the same them out to anyone including his friends and relatives - even as gifts. This may clearly deprive the creator of the talent he possesses and those who depend on the creator to earn their income.

iv. Irrespective the owner of copyrighted work enforcing their rights, the users must feel obligated to protect the creator's interest, even if no one readily available to claiming rights in such works.

A sleeping man can be awoken, but not a man who pretends to sleep. Most of the users in the digital world belong to the latter category and they can never be woken up unless they were educated enough why and where to wake up. The foregoing sentence is suitable *in toto* in respect of protection required for orphan works. It is not alone the law or the judiciary that can help safeguarding the interest of the unidentified with respect to their skills and investments in their work.