

110TH CONGRESS
2D SESSION

S. 2913

IN THE HOUSE OF REPRESENTATIVES

SEPTEMBER 27, 2008

Referred to the Committee on the Judiciary

AN ACT

To provide a limitation on judicial remedies in copyright
infringement cases involving orphan works.

1 *Be it enacted by the Senate and House of Representa-*
2 *tives of the United States of America in Congress assembled,*

1 **SECTION 1. SHORT TITLE.**

2 This Act may be cited as the “Shawn Bentley Orphan
3 Works Act of 2008”.

4 **SEC. 2. LIMITATION ON REMEDIES IN CASES INVOLVING**
5 **ORPHAN WORKS.**

6 (a) LIMITATION ON REMEDIES.—Chapter 5 of title
7 17, United States Code, is amended by adding at the end
8 the following:

9 **“§ 514. Limitation on remedies in cases involving or-**
10 **phan works**

11 “(a) DEFINITIONS.—In this section, the following
12 definitions shall apply:

13 “(1) NOTICE OF CLAIM OF INFRINGEMENT.—

14 The term ‘notice of claim of infringement’ means,
15 with respect to a claim of copyright infringement, a
16 written notice sent from the owner of the infringed
17 copyright or a person acting on the owner’s behalf
18 to the infringer or a person acting on the infringer’s
19 behalf, that includes at a minimum—

20 “(A) the name of the owner of the in-
21 fringed copyright;

22 “(B) the title of the infringed work, any
23 alternative titles of the infringed work known to
24 the owner of the infringed copyright, or if the
25 work has no title, a description in detail suffi-
26 cient to identify that work;

1 “(C) an address and telephone number at
2 which the owner of the infringed copyright or a
3 person acting on behalf of the owner may be
4 contacted; and

5 “(D) information reasonably sufficient to
6 permit the infringer to locate the infringer’s
7 material in which the infringed work resides.

8 “(2) OWNER OF THE INFRINGED COPYRIGHT.—
9 The ‘owner of the infringed copyright’ is the owner
10 of any particular exclusive right under section 106
11 that is applicable to the infringement, or any person
12 or entity with the authority to grant or license such
13 right on an exclusive or nonexclusive basis.

14 “(3) REASONABLE COMPENSATION.—The term
15 ‘reasonable compensation’ means, with respect to a
16 claim of infringement, the amount on which a willing
17 buyer and willing seller in the positions of the in-
18 fringer and the owner of the infringed copyright
19 would have agreed with respect to the infringing use
20 of the work immediately before the infringement
21 began.

22 “(b) CONDITIONS FOR ELIGIBILITY.—

23 “(1) CONDITIONS.—

24 “(A) IN GENERAL.—Notwithstanding sec-
25 tions 502 through 506, and subject to subpara-

graph (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—

“(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;

1 “(iii) included with the public dis-
2 tribution, display, or performance of the
3 infringing work a symbol or other notice of
4 the use of the infringing work, the form
5 and manner of which shall be prescribed
6 by the Register of Copyrights, which may
7 be in the footnotes, endnotes, bottom mar-
8 gin, end credits, or in any other such man-
9 ner as to give notice that the infringed
10 work has been used under this section;

11 “(iv) asserts in the initial pleading to
12 the civil action eligibility for such limita-
13 tions; and

14 “(v) at the time of making the initial
15 discovery disclosures required under rule
16 26 of the Federal Rules of Civil Procedure,
17 states with particularity the basis for eligi-
18 bility for the limitations, including a de-
19 tailed description and documentation of the
20 search undertaken in accordance with
21 paragraph (2)(A) and produces docu-
22 mentation of the search.

23 “(B) EXCEPTION.—Subparagraph (A)
24 does not apply if the infringer or a person act-
25 ing on behalf of the infringer receives a notice

1 of claim of infringement and, after receiving
2 such notice and having an opportunity to con-
3 duct an expeditious good faith investigation of
4 the claim, the infringer—

5 “(i) fails to engage in negotiation in
6 good faith regarding reasonable compensa-
7 tion with the owner of the infringed copy-
8 right; or

9 “(ii) fails to render payment of rea-
10 sonable compensation in a reasonably time-
11 ly manner after reaching an agreement
12 with the owner of the infringed copyright
13 or under an order described in subsection
14 (c)(1)(A).

15 “(2) REQUIREMENTS FOR SEARCHES.—

16 “(A) REQUIREMENTS FOR QUALIFYING
17 SEARCHES.—

18 “(i) IN GENERAL.—A search qualifies
19 under paragraph (1)(A)(i)(I) if the in-
20 fringer, a person acting on behalf of the
21 infringer, or any person jointly and sever-
22 ally liable with the infringer for the in-
23 fringement, undertakes a diligent effort
24 that is reasonable under the circumstances
25 to locate the owner of the infringed copy-

1 right prior to, and at a time reasonably
2 proximate to, the infringement.

3 “(ii) DILIGENT EFFORT.—For pur-
4 poses of clause (i), a diligent effort—

5 “(I) requires, at a minimum—

6 “(aa) a search of the records
7 of the Copyright Office that are
8 available to the public through
9 the Internet and relevant to iden-
10 tifying and locating copyright
11 owners, provided there is suffi-
12 cient identifying information on
13 which to construct a search;

14 “(bb) a search of reasonably
15 available sources of copyright au-
16 thorship and ownership informa-
17 tion and, where appropriate, li-
18 censor information;

19 “(cc) use of appropriate
20 technology tools, printed publica-
21 tions, and where reasonable, in-
22 ternal or external expert assist-
23 ance; and

24 “(dd) use of appropriate
25 databases, including databases

1 that are available to the public
2 through the Internet; and

3 “(II) shall include any actions
4 that are reasonable and appropriate
5 under the facts relevant to the search,
6 including actions based on facts
7 known at the start of the search and
8 facts uncovered during the search,
9 and including a review, as appro-
10 priate, of Copyright Office records not
11 available to the public through the
12 Internet that are reasonably likely to
13 be useful in identifying and locating
14 the copyright owner.

15 “(iii) CONSIDERATION OF REC-
16 OMMENDED PRACTICES.—A qualifying
17 search under this subsection shall ordi-
18 narily be based on the applicable statement
19 of Recommended Practices made available
20 by the Copyright Office and additional ap-
21 propriate best practices of authors, copy-
22 right owners, and users to the extent such
23 best practices incorporate the expertise of
24 persons with specialized knowledge with re-

spect to the type of work for which the search is being conducted.

“(iv) LACK OF IDENTIFYING INFORMATION.—The fact that, in any given situation,—

“(I) a particular copy or phonorecord lacks identifying information pertaining to the owner of the infringed copyright; or

“(II) an owner of the infringed copyright fails to respond to any inquiry or other communication about the work,

shall not be deemed sufficient to meet the conditions under paragraph (1)(A)(i)(I).

“(v) USE OF RESOURCES FOR CHARGE.—A qualifying search under paragraph (1)(A)(i)(I) may require use of resources for which a charge or subscription is imposed to the extent reasonable under the circumstances.

“(B) INFORMATION TO GUIDE SEARCHES; RECOMMENDED PRACTICES.—

“(i) STATEMENTS OF RECOMMENDED PRACTICES.—The Register of Copyrights

1 shall maintain and make available to the
2 public and, from time to time, update at
3 least one statement of Recommended Prac-
4 tices for each category, or, in the Reg-
5 ister’s discretion, subcategory of work
6 under section 102(a) of this title, for con-
7 ducting and documenting a search under
8 this subsection. Such statement will ordi-
9 narily include reference to materials, re-
10 sources, databases, and technology tools
11 that are relevant to a search. The Register
12 may maintain and make available more
13 than one statement of Recommended Prac-
14 tices for each category or subcategory, as
15 appropriate.

16 “(ii) CONSIDERATION OF RELEVANT
17 MATERIALS.—In maintaining and making
18 available and, from time to time, updating
19 the Recommended Practices in clause (i),
20 the Register of Copyrights shall, at the
21 Register’s discretion, consider materials,
22 resources, databases, technology tools, and
23 practices that are reasonable and relevant
24 to the qualifying search. The Register shall
25 consider any comments submitted to the

1 Copyright Office by the Small Business
2 Administration Office of Advocacy. The
3 Register shall also, to the extent prac-
4 ticable, take the impact on copyright own-
5 ers that are small businesses into consider-
6 ation when modifying and updating best
7 practices.

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

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

15 “(1) MONETARY RELIEF.—

16 “(A) GENERAL RULE.—Subject to sub-
17 paragraph (B), an award for monetary relief
18 (including actual damages, statutory damages,
19 costs, and attorney’s fees) may not be made
20 other than an order requiring the infringer to
21 pay reasonable compensation to the owner of
22 the exclusive right under the infringed copy-
23 right for the use of the infringed work.

24 “(B) FURTHER LIMITATIONS.—An order
25 requiring the infringer to pay reasonable com-

1 pensation for the use of the infringed work may
2 not be made under subparagraph (A) if the in-
3 fringer is a nonprofit educational institution,
4 museum, library, archives, or a public broad-
5 casting entity (as defined in subsection (f) of
6 section 118), or any of such entities' employees
7 acting within the scope of their employment,
8 and the infringer proves by a preponderance of
9 the evidence that—

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

13 “(ii) the infringement was primarily
14 educational, religious, or charitable in na-
15 ture; and

16 “(iii) after receiving a notice of claim
17 of infringement, and having an opportunity
18 to conduct an expeditious good faith inves-
19 tigation of the claim, the infringer prompt-
20 ly ceased the infringement.

21 “(2) INJUNCTIVE RELIEF.—

22 “(A) GENERAL RULE.—Subject to sub-
23 paragraph (B), the court may impose injunctive
24 relief to prevent or restrain any infringement
25 alleged in the civil action. If the infringer has

1 met the requirements of subsection (b), the re-
2 lief shall, to the extent practicable and subject
3 to applicable law, account for any harm that
4 the relief would cause the infringer due to its
5 reliance on subsection (b).

6 “(B) EXCEPTION.—In a case in which the
7 infringer has prepared or commenced prepara-
8 tion of a new work of authorship that recasts,
9 transforms, adapts, or integrates the infringed
10 work with a significant amount of original ex-
11 pression, any injunctive relief ordered by the
12 court may not restrain the infringer’s continued
13 preparation or use of that new work, if—

14 “(i) the infringer pays reasonable
15 compensation in a reasonably timely man-
16 ner after the amount of such compensation
17 has been agreed upon with the owner of
18 the infringed copyright or determined by
19 the court; and

20 “(ii) the court also requires that the
21 infringer provide attribution, in a manner
22 that is reasonable under the circumstances,
23 to the legal owner of the infringed copy-
24 right, if requested by such owner.

1 “(C) LIMITATIONS.—The limitations on in-
2 junctive relief under subparagraphs (A) and (B)
3 shall not be available to an infringer or a rep-
4 resentative of the infringer acting in an official
5 capacity if the infringer asserts that neither the
6 infringer nor any representative of the infringer
7 acting in an official capacity is subject to suit
8 in the courts of the United States for an award
9 of damages for the infringement, unless the
10 court finds that the infringer—

11 “(i) has complied with the require-
12 ments of subsection (b); and

13 “(ii) pays reasonable compensation to
14 the owner of the exclusive right under the
15 infringed copyright in a reasonably timely
16 manner after the amount of reasonable
17 compensation has been agreed upon with
18 the owner or determined by the court.

19 “(D) RULE OF CONSTRUCTION.—Nothing
20 in subparagraph (C) shall be construed to au-
21 thorize or require, and no action taken under
22 such subparagraph shall be deemed to con-
23 stitute, either an award of damages by the
24 court against the infringer or an authorization
25 to sue a State.

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

8 “(d) PRESERVATION OF OTHER RIGHTS, LIMITA-
9 TIONS, AND DEFENSES.—This section does not affect any
10 right, or any limitation or defense to copyright infringe-
11 ment, including fair use, under this title. If another provi-
12 sion of this title provides for a statutory license that would
13 permit the use contemplated by the infringer, that provi-
14 sion applies instead of this section.

15 “(e) COPYRIGHT FOR DERIVATIVE WORKS AND COM-
16 PILATIONS.—Notwithstanding section 103(a), an infringer
17 who qualifies for the limitation on remedies afforded by
18 this section shall not be denied copyright protection in a
19 compilation or derivative work on the basis that such com-
20 pilation or derivative work employs preexisting material
21 that has been used unlawfully under this section.

22 “(f) EXCLUSION FOR FIXATIONS IN OR ON USEFUL
23 ARTICLES.—The limitations on remedies under this sec-
24 tion shall not be available to an infringer for infringements
25 resulting from fixation of a pictorial, graphic, or sculptural

1 work in or on a useful article that is offered for sale or
 2 other commercial distribution to the public.”.

3 (b) TECHNICAL AND CONFORMING AMENDMENT.—
 4 The table of sections for chapter 5 of title 17, United
 5 States Code, is amended by adding at the end the fol-
 6 lowing:

“514. Limitation on remedies in cases involving orphan works.”.

7 (c) EFFECTIVE DATE.—

8 (1) IN GENERAL.—The amendments made by
 9 this section shall—

10 (A) take effect on the later of—

11 (i) January 1, 2009; or

12 (ii) the date which is the earlier of—

13 (I) 30 days after the date on
 14 which the Copyright Office publishes
 15 notice in the Federal Register that it
 16 has certified under section 3 that
 17 there exist and are available at least
 18 2 separate and independent search-
 19 able, electronic databases, that allow
 20 for searches of copyrighted works that
 21 are pictorial, graphic, and sculptural
 22 works, and are available to the public;
 23 or

24 (II) January 1, 2013; and

1 (B) apply to infringing uses that com-
2 mence on or after that effective date.

3 (2) DEFINITION.—In this subsection, the term
4 “pictorial, graphic, and sculptural works” has the
5 meaning given that term in section 101 of title 17,
6 United States Code.

7 **SEC. 3. DATABASES OF PICTORIAL, GRAPHIC, AND SCULP-**
8 **TURAL WORKS.**

9 The Register of Copyrights shall undertake a process
10 to certify that there exist and are available databases that
11 facilitate a user’s search for pictorial, graphic, and sculp-
12 tural works that are subject to copyright protection under
13 title 17, United States Code. The Register shall only cer-
14 tify that databases are available under this section if such
15 databases are determined to be effective and not prohibi-
16 tively expensive and include the capability to be searched
17 using 1 or more mechanisms that allow for the search and
18 identification of a work by both text and image and have
19 sufficient information regarding the works to enable a po-
20 tential user of a work to identify or locate the copyright
21 owner or authorized agent. Prior to certifying that data-
22 bases are available under this section, the Register shall
23 determine, to the extent practicable, their impact on copy-
24 right owners that are small businesses and consult with
25 the Small Business Administration Office of Advocacy re-

1 guarding those impacts. The Register shall consider the Of-
 2 fice of Advocacy's comments and respond to any concerns.

3 **SEC. 4. REPORT TO CONGRESS.**

4 Not later than December 12, 2014, the Register of
 5 Copyrights shall report to the Committee on the Judiciary
 6 of the Senate and the Committee on the Judiciary of the
 7 House of Representatives on the implementation and ef-
 8 fects of the amendments made by section 2, including any
 9 recommendations for legislative changes that the Register
 10 considers appropriate.

11 **SEC. 5. STUDY ON REMEDIES FOR SMALL COPYRIGHT**
 12 **CLAIMS.**

13 (a) IN GENERAL.—The Register of Copyrights shall
 14 conduct a study with respect to remedies for copyright in-
 15 fringement claims by an individual copyright owner or a
 16 related group of copyright owners seeking small amounts
 17 of monetary relief, including consideration of alternative
 18 means of resolving disputes currently heard in the United
 19 States district courts. The study shall cover the infringe-
 20 ment claims to which section 514 of title 17, United States
 21 Code, apply, and other infringement claims under that
 22 title.

23 (b) PROCEDURES.—The Register of Copyrights shall
 24 publish notice of the study required under subsection (a),
 25 providing a period during which interested persons may

1 submit comments on the study, and an opportunity for
2 interested persons to participate in public roundtables on
3 the study. The Register shall hold any such public
4 roundtables at such times as the Register considers appro-
5 priate.

6 (c) REPORT TO CONGRESS.—Not later than 2 years
7 after the date of the enactment of this Act, the Register
8 of Copyrights shall prepare and submit to the Committee
9 on the Judiciary of the Senate and the Committee on the
10 Judiciary of the House of Representatives a report on the
11 study conducted under this section, including such admin-
12 istrative, regulatory, or legislative recommendations that
13 the Register considers appropriate.

14 **SEC. 6. STUDY ON COPYRIGHT DEPOSITS.**

15 (a) IN GENERAL.—The Comptroller General of the
16 United States shall conduct a study examining the func-
17 tion of the deposit requirement in the copyright registra-
18 tion system under section 408 of title 17, United States
19 Code, including—

20 (1) the historical purpose of the deposit require-
21 ment;

22 (2) the degree to which deposits are made avail-
23 able to the public currently;

24 (3) the feasibility of making deposits, particu-
25 larly visual arts deposits, electronically searchable by

1 the public for the purpose of locating copyright own-
2 ers; and

3 (4) the impact any change in the deposit re-
4 quirement would have on the collection of the Li-
5 brary of Congress.

6 (b) REPORT.—Not later than 2 years after the date
7 of the enactment of this Act, the Comptroller General shall
8 submit to the Committee on the Judiciary of the Senate
9 and the Committee on the Judiciary of the House of Rep-
10 resentatives a report on the study conducted under this
11 section, including such administrative, regulatory, or legis-
12 lative recommendations that the Comptroller General con-
13 siders appropriate.

Passed the Senate September 26 (legislative day,
September 17), 2008.

Attest:

NANCY ERICKSON,
Secretary.