

110TH CONGRESS  
2D SESSION

**S.** \_\_\_\_\_

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

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IN THE SENATE OF THE UNITED STATES

Mr. LEAHY (for himself and Mr. HATCH) introduced the following bill; which was read twice and referred to the Committee on \_\_\_\_\_

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**A BILL**

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,*

3 **SECTION 1. SHORT TITLE.**

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

6 **SEC. 2. LIMITATION ON REMEDIES IN CASES INVOLVING**  
7 **ORPHAN WORKS.**

8 (a) LIMITATION ON REMEDIES.—Chapter 5 of title  
9 17, United States Code, is amended by adding at the end  
10 the following:

1 **“§ 514. Limitation on remedies in cases involving or-**  
2 **phan works**

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

5 “(1) MATERIALS AND STANDARDS.—The term  
6 ‘materials and standards’ includes—

7 “(A) the records of the Copyright Office  
8 that are relevant to identifying and locating  
9 copyright owners;

10 “(B) sources of copyright ownership infor-  
11 mation reasonably available to users, including  
12 private databases;

13 “(C) industry practices and guidelines of  
14 associations and organizations;

15 “(D) technology tools and expert assist-  
16 ance, including resources for which a charge or  
17 subscription fee is imposed, to the extent that  
18 the use of such resources is reasonable for, and  
19 relevant to, the scope of the intended use; and

20 “(E) electronic databases, including data-  
21 bases that are available to the public through  
22 the Internet, that allow for searches of copy-  
23 righted works and for the copyright owners of  
24 works, including through text, sound, and  
25 image recognition tools.

1           “(2) NOTICE OF CLAIM FOR INFRINGEMENT.—

2           The term ‘notice of the claim for infringement’  
3           means, with respect to a claim for copyright in-  
4           fringement, a written notice that includes at a min-  
5           imum the following:

6                   “(A) The name of the owner of the in-  
7                   fringed copyright.

8                   “(B) The title of the infringed work, any  
9                   alternative titles of the infringed work known to  
10                  the owner of the infringed copyright, or if the  
11                  work has no title, a description in detail suffi-  
12                  cient to identify it.

13                  “(C) An address and telephone number at  
14                  which the owner of the infringed copyright may  
15                  be contacted.

16                  “(D) Information from which a reasonable  
17                  person could conclude that the owner of the in-  
18                  fringed copyright’s claims of ownership and in-  
19                  fringement are valid.

20           “(3) OWNER OF THE INFRINGED COPYRIGHT.—

21           The ‘owner of the infringed copyright’ is the legal  
22           owner of the exclusive right under section 106, or  
23           any party with the authority to grant or license such  
24           right, that is applicable to the infringement.

1           “(4) REASONABLE COMPENSATION.—The term  
2           ‘reasonable compensation’ means, with respect to a  
3           claim for infringement, the amount on which a will-  
4           ing buyer and willing seller in the positions of the  
5           infringer and the owner of the infringed copyright  
6           would have agreed with respect to the infringing use  
7           of the work immediately before the infringement  
8           began.

9           “(b) CONDITIONS FOR ELIGIBILITY.—

10           “(1) CONDITIONS.—

11           “(A) IN GENERAL.—Notwithstanding sec-  
12           tions 502 through 505, and subject to subpara-  
13           graph (B), in a civil action brought under this  
14           title for infringement of copyright in a work,  
15           the remedies for infringement shall be limited  
16           in accordance with subsection (c) if the in-  
17           fringer—

18           “(i) proves by a preponderance of the  
19           evidence that before the infringement  
20           began, the infringer, a person acting on be-  
21           half of the infringer, or any person jointly  
22           and severally liable with the infringer for  
23           the infringement—

24           “(I) performed and documented  
25           a qualifying search, in good faith, for

1 the owner of the infringed copyright;  
2 and

3 “(II) was unable to locate the  
4 owner of the infringed copyright;

5 “(ii) provided attribution, in a manner  
6 that is reasonable under the circumstances,  
7 to the owner of the infringed copyright, if  
8 such owner was known with a reasonable  
9 degree of certainty, based on information  
10 obtained in performing the qualifying  
11 search;

12 “(iii) included with the use of the in-  
13 fringing work a symbol or other notice of  
14 the use of the infringing work, in a man-  
15 ner prescribed by the Register of Copy-  
16 rights;

17 “(iv) asserts in the initial pleading to  
18 the civil action the right to claim such limi-  
19 tations;

20 “(v) consents to the jurisdiction of  
21 United States district court, or such court  
22 holds that the infringer is within the juris-  
23 diction of the court; and

24 “(vi) at the time of making the initial  
25 discovery disclosures required under Rule

1                   26 of the Federal Rules of Civil Procedure,  
2                   states with particularity the basis for the  
3                   right to claim the limitations, including a  
4                   detailed description and documentation of  
5                   the search undertaken in accordance with  
6                   paragraph (2)(A).

7                   “(B) EXCEPTION.—Subparagraph (A)  
8                   does not apply if, after receiving notice of the  
9                   claim for infringement and having an oppor-  
10                  tunity to conduct an expeditious good faith in-  
11                  vestigation of the claim, the infringer—

12                   “(i) fails to negotiate reasonable com-  
13                   pensation in good faith with the owner of  
14                   the infringed copyright; or

15                   “(ii) fails to render payment of rea-  
16                   sonable compensation in a reasonably time-  
17                   ly manner.

18                  “(2) REQUIREMENTS FOR SEARCHES.—

19                   “(A) REQUIREMENTS FOR QUALIFYING  
20                  SEARCHES.—

21                   “(i) IN GENERAL.—For purposes of  
22                   paragraph (1)(A)(i)(I), a search is quali-  
23                   fying if the infringer undertakes a diligent  
24                   effort to locate the owner of the infringed  
25                   copyright.

1           “(ii) DETERMINATION OF DILIGENT  
2 EFFORT.—In determining whether a  
3 search is diligent under this subparagraph,  
4 a court shall consider whether—

5           “(I) the actions taken in per-  
6 forming that search are reasonable  
7 and appropriate under the facts rel-  
8 evant to that search, including wheth-  
9 er the infringer took actions based on  
10 facts uncovered by the search itself;

11           “(II) the infringer employed the  
12 applicable best practices maintained  
13 by the Register of Copyrights under  
14 subparagraph (B); and

15           “(III) the infringer performed  
16 the search before using the work and  
17 at a time that was reasonably prox-  
18 imate to the commencement of the in-  
19 fringement.

20           “(iii) LACK OF IDENTIFYING INFOR-  
21 MATION.—The fact that a particular copy  
22 or phonorecord lacks identifying informa-  
23 tion pertaining to the owner of the in-  
24 fringed copyright is not sufficient to meet

1           the       conditions       under       paragraph  
2           (1)(A)(i)(I).

3           “(B) INFORMATION TO GUIDE SEARCHES;  
4       BEST PRACTICES.—

5           “(i) STATEMENTS OF BEST PRAC-  
6       TICES.—The Register of Copyrights shall  
7       maintain and make available to the public,  
8       including through the Internet, current  
9       statements of best practices for conducting  
10      and documenting a search under this sub-  
11      section.

12          “(ii) CONSIDERATION OF RELEVANT  
13      MATERIALS AND STANDARDS.—In main-  
14      taining the statements of best practices re-  
15      quired under clause (i), the Register of  
16      Copyrights shall, from time to time, con-  
17      sider materials and standards that may be  
18      relevant to the requirements for a quali-  
19      fying search under subparagraph (A).

20          “(3) PENALTY FOR FAILURE TO COMPLY.—If  
21      an infringer fails to comply with any requirement  
22      under this subsection, the infringer is subject to all  
23      the remedies provided in section 502 through 505,  
24      subject to section 412.

1           “(c) LIMITATIONS ON REMEDIES.—The limitations  
2 on remedies in a civil action for infringement of a copy-  
3 right to which this section applies are the following:

4           “(1) MONETARY RELIEF.—

5                   “(A) GENERAL RULE.—Subject to sub-  
6 paragraph (B), an award for monetary relief  
7 (including actual damages, statutory damages,  
8 costs, and attorney’s fees) may not be made  
9 other than an order requiring the infringer to  
10 pay reasonable compensation to the legal or  
11 beneficial owner of the exclusive right under the  
12 infringed copyright for the use of the infringed  
13 work.

14                   “(B) FURTHER LIMITATIONS.—An order  
15 requiring the infringer to pay reasonable com-  
16 pensation for the use of the infringed work may  
17 not be made under subparagraph (A) if the in-  
18 fringer is a nonprofit educational institution,  
19 museum, library, or archives, or a public broad-  
20 casting entity (as defined in subsection (f) of  
21 section 118) and the infringer proves by a pre-  
22 ponderance of the evidence that—

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

1           “(ii) the infringement was primarily  
2           educational, religious, or charitable in na-  
3           ture; and

4           “(iii) after receiving notice of the  
5           claim for infringement, and after con-  
6           ducting an expeditious good faith inves-  
7           tigation of the claim, the infringer prompt-  
8           ly ceased the infringement.

9           “(C) EXCEPTION TO FURTHER LIMITA-  
10          TION.—Notwithstanding the limitation estab-  
11          lished under subparagraph (B), if the owner of  
12          an infringed copyright proves, and a court  
13          finds, that the infringer has earned proceeds di-  
14          rectly attributable to the use of the infringed  
15          work by the infringer, the portion of such pro-  
16          ceeds attributable to such infringement may be  
17          awarded to the owner.

18          “(2) INJUNCTIVE RELIEF.—

19                 “(A) GENERAL RULE.—Subject to sub-  
20          paragraph (B), the court may impose injunctive  
21          relief to prevent or restrain any infringement  
22          alleged in the civil action.

23                 “(B) EXCEPTION.—In a case in which the  
24          infringer has prepared or commenced prepara-  
25          tion of a work that recasts, transforms, adapts,

1 or integrates the infringed work with a signifi-  
2 cant amount of the infringer’s original expres-  
3 sion, any injunctive relief ordered by the  
4 court—

5 “(i) may not restrain the infringer’s  
6 continued preparation or use of that new  
7 work;

8 “(ii) shall require that the infringer  
9 pay reasonable compensation to the legal  
10 or beneficial owner of the exclusive right  
11 under the infringed copyright for the use  
12 of the infringed work; and

13 “(iii) shall require that the infringer  
14 provide attribution, in a manner that is  
15 reasonable under the circumstances, to the  
16 owner of the infringed copyright, if re-  
17 quested by such owner.

18 “(C) LIMITATIONS.—The limitations on in-  
19 junctive relief under subparagraphs (A) and (B)  
20 shall not be available to an infringer if the in-  
21 fringer asserts in the civil action that neither  
22 the infringer or any representative of the in-  
23 fringer acting in an official capacity is subject  
24 to suit in the courts of the United States for an  
25 award of damages to the legal or beneficial

1 owner of the exclusive right under the infringed  
2 copyright under section 106, unless the court  
3 finds that the infringer—

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

6 “(ii) has made an enforceable promise  
7 to pay reasonable compensation to the  
8 legal or beneficial owner of the exclusive  
9 right under the infringed copyright.

10 “(D) RULE OF CONSTRUCTION.—Nothing  
11 in subparagraph (C) shall be construed to au-  
12 thorize or require, and no action taken under  
13 such subparagraph shall be deemed to con-  
14 stitute, either an award of damages by the  
15 court against the infringer or an authorization  
16 to sue a State.

17 “(E) RIGHTS AND PRIVILEGES NOT  
18 WAIVED.—No action taken by an infringer  
19 under subparagraph (C) shall be deemed to  
20 waive any right or privilege that, as a matter of  
21 law, protects the infringer from being subject to  
22 suit in the courts of the United States for an  
23 award of damages to the legal or beneficial  
24 owner of the exclusive right under the infringed  
25 copyright under section 106.

1       “(d) PRESERVATION OF OTHER RIGHTS, LIMITA-  
2 TIONS, AND DEFENSES.—This section does not affect any  
3 right, limitation, or defense to copyright infringement, in-  
4 cluding fair use, under this title. If another provision of  
5 this title provides for a statutory license that would permit  
6 the infringement contemplated by the infringer if the  
7 owner of the infringed copyright cannot be located, that  
8 provision applies instead of this section.

9       “(e) COPYRIGHT FOR DERIVATIVE WORKS AND COM-  
10 PILATIONS.—Notwithstanding section 103(a), an infringer  
11 who qualifies for the limitation on remedies afforded by  
12 this section with respect to the use of a copyrighted work  
13 shall not be denied copyright protection in a compilation  
14 or derivative work on the basis that such compilation or  
15 derivative work employs preexisting material that has been  
16 used unlawfully under this section.”.

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

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

21 **SEC. 3. DATABASE OF PICTORIAL, GRAPHIC, AND SCULP-**  
22 **TURAL WORKS.**

23       (a) ESTABLISHMENT OF DATABASE.—

24               (1) IN GENERAL.—The Register of Copyrights  
25 shall undertake a certification process for the estab-

1        lishment of an electronic database that facilitates  
2        the search for pictorial, graphic, and sculptural  
3        works that are subject to copyright protection under  
4        title 17, United States Code.

5            (2) PROCESS AND STANDARDS FOR CERTIFI-  
6        CATION.—The process and standards for certifi-  
7        cation of the electronic database required under  
8        paragraph (1) shall be established by the Register of  
9        Copyrights, except that certification may not be  
10       granted if the electronic database does not contain—

11            (A) the name of all authors of the work, if  
12        known, and contact information for any author  
13        if the information is readily available;

14            (B) the name of the copyright owner if dif-  
15        ferent from the author, and contact information  
16        of the copyright owner;

17            (C) the title of the copyrighted work, if  
18        such work has a title;

19            (D) with respect to a copyrighted work  
20        that includes a visual image, a visual image of  
21        the work, or, if such a visual image is not avail-  
22        able, a description sufficient to identify the  
23        work;

1           (E) one or more mechanisms that allow for  
2           the search and identification of a work by both  
3           text and image; and

4           (F) security measures that reasonably pro-  
5           tect against unauthorized access to, or copying  
6           of, the information and content of the electronic  
7           database.

8           (b) PUBLIC AVAILABILITY.—The Register of Copy-  
9 rights—

10           (1) shall make available to the public through  
11           the Internet a list of all electronic databases that are  
12           certified in accordance with this section; and

13           (2) may include any database so certified in a  
14           statement of best practices established under section  
15           514(b)(5)(B) of title 17, United States Code.

16 **SEC. 4. EFFECTIVE DATE.**

17           (a) IN GENERAL.—With respect to works other than  
18           pictorial, graphic, and sculptural works, the amendments  
19           made by section 2 shall apply to infringements that com-  
20           mence on or after January 1, 2009.

21           (b) PICTORIAL, GRAPHIC, AND SCULPTURAL  
22           WORKS.—With respect to pictorial, graphic, and sculp-  
23           tural works, the amendments made by section 2 shall—

24           (1) take effect on the earlier of—

1 (A) the date on which the Copyright Office  
2 certifies under section 3 at least 2 separate and  
3 independent searchable, comprehensive, elec-  
4 tronic databases, that allow for searches of  
5 copyrighted works that are pictorial, graphic,  
6 and sculptural works, and are available to the  
7 public through the Internet; or

8 (B) January 1, 2011; and

9 (2) apply to infringing uses that commence on  
10 or after that effective date.

11 (c) PUBLICATION IN FEDERAL REGISTER.—The  
12 Register of Copyrights shall publish the effective date de-  
13 scribed in subsection (b)(1) in the Federal Register, to-  
14 gether with a notice that the amendments made by section  
15 2 take effect on that date with respect to pictorial, graph-  
16 ic, and sculptural works.

17 (d) DEFINITION.—In this section, the term “pic-  
18 torial, graphic, and sculptural works” has the meaning  
19 given that term in section 101 of title 17, United States  
20 Code.

21 **SEC. 5. REPORT TO CONGRESS.**

22 Not later than December 12, 2014, the Register of  
23 Copyrights shall report to the Committee on the Judiciary  
24 of the Senate and the Committee on the Judiciary of the  
25 House of Representatives on the implementation and ef-

1 facts of the amendments made by section 2, including any  
2 recommendations for legislative changes that the Register  
3 considers appropriate.

4 **SEC. 6. STUDY ON REMEDIES FOR SMALL COPYRIGHT**  
5 **CLAIMS.**

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

16 (b) **PROCEDURES.**—The Register of Copyrights shall  
17 publish notice of the study required under subsection (a),  
18 providing a period during which interested persons may  
19 submit comments on the study, and an opportunity for  
20 interested persons to participate in public roundtables on  
21 the study. The Register shall hold any such public  
22 roundtables at such times as the Register considers appro-  
23 priate.

24 (c) **REPORT TO CONGRESS.**—Not later than 2 years  
25 after the date of the enactment of this Act, the Register

1 of Copyrights shall prepare and submit to the Committee  
2 on the Judiciary of the Senate and the Committee on the  
3 Judiciary of the House of Representatives a report on the  
4 study conducted under this section, including such admin-  
5 istrative, regulatory, or legislative recommendations that  
6 the Register considers appropriate.

7 **SEC. 7. STUDY ON COPYRIGHT DEPOSITS.**

8 (a) IN GENERAL.—The Comptroller General of the  
9 United States shall conduct a study examining the func-  
10 tion of the deposit requirement in the copyright registra-  
11 tion system under section 408 of title 17, United States  
12 Code, including—

13 (1) the historical purpose of the deposit require-  
14 ment;

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

17 (3) the feasibility of making deposits, particu-  
18 larly visual arts deposits, electronically searchable by  
19 the public for the purpose of locating copyright own-  
20 ers; and

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

24 (b) REPORT.—Not later than 2 years after the date  
25 of the enactment of this Act, the Comptroller General shall

1 submit to the Committee on the Judiciary of the House  
2 of Representatives and the Committee on the Judiciary  
3 of the Senate a report on the study conducted under this  
4 section, including such administrative, regulatory, or legis-  
5 lative recommendations that the Comptroller General con-  
6 siders appropriate.