

Copyright Law v. Trade Policy:

Understanding the Golan Battle Within the Tenth Circuit

Elizabeth Townsend Gard*

[I]n today's new discursive climate, those who care about the survival of the public domain must begin to find new, and newly compelling, vocabularies with which to articulate their concerns. Unless they do so, they risk the consequences of discovering that familiar constitutionally-grounded arguments for limitations on proprietary rights will become irrelevant in tomorrow's intellectual property policy debates.¹

The works that qualify for [foreign] copyright restoration probably number in the millions.²

The copyright statute does not define the phrase "public domain."³

INTRODUCTION

A. TENTH CIRCUIT'S INTERNAL SPLIT OVER THE MEANING OF COPYRIGHT: *GOLAN V. GONZALES (2008) VERSUS GOLAN V. HOLDER (2010)*

The Tenth Circuit seems to be in a battle with itself over the meaning and definition of our copyright system. In the last two years, the Tenth Circuit defined the public domain as a constitutionally protected component of the copyright system, and then reversing itself, defined copyright (ignoring the public domain) as

* Associate Professor and Co-Director, Tulane Center for Intellectual Property Law and Culture, Tulane University Law School. Ph.D. European History, UCLA; J.D./LL.M. in International Trade, University of Arizona. Thank you to Keith Werhan, Catherine Hancock, Jancy Hoeffel, Kenneth Crews, Deven Desai, Ron Gard, Graeme Dinwoodie, Graeme Austin, Roberta Kwall, Paul Heald, Dale Nelson, Robert Wohl, Peter Hirtle, John Mark Ockerbloom, Christopher Sprigman and Diane Zimmerman. This piece arose out of work done during a Leverhulme Trust Research Grant, held at the London School of Economics, 2005–06. Early versions of this paper were presented at the Queen Mary Intellectual Property Research Institute in Spring 2006, the IPSC at UC Berkeley in 2006 and the IPSC at DePaul in 2007. Thank you to archivists at the William Ready Archive at McMaster University, Hamilton, Ontario, Canada and in particular to Renu Barrett and Carl Spadoni. Thanks to the whole International Team Durationator. In particular, thanks to Evan Dicharry, Justin Levy, Jessica Edmondson and Zac Christiansen.

1. Peter Jaszi, *Goodbye to All That—A Reluctant (and Perhaps Premature) Adieu to a Constitutionally-Grounded Discourse of Public Interest in Copyright Law*, 29 VAND. J. TRANSNAT'L L. 595, 596 (1996).

2. Marybeth Peters, *The Year in Review: Accomplishments and Objectives of the U.S. Copyright Office*, 7 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 25, 31 (1996).

3. *Société Civile Succession Guino v. Renoir*, 549 F.3d 1182, 1186 (9th Cir. 2008); *see also Golan v. Gonzales*, 501 F.3d 1179, 1188–89 (10th Cir. 2007).

a tool for international trade, where treaty obligations outweigh tradition. The *Golan* case stands at the center of competing priorities and definitions. How are we to understand the “physics” of the public domain within contemporary copyright law? Does copyright have principles and an internal logic to foster creativity, or is copyright to be seen as malleable tool for trade and international relations?

Judge Henry in the 2007 Tenth Circuit *Golan v. Gonzales* stated that under the traditional contours of copyright, what comes into the public domain, stays in the public domain.⁴ With this came a First Amendment right to use public domain works, and he remanded the case back to the district court to further determine whether the statute in question required content-based or content-neutral First amendment analysis.⁵ This decision marked the first time a part of the copyright law had been found unconstitutional, and it also marked a moment where the public domain appeared to be protected by the U.S. Constitution.⁶ Upon appeal from the district court remanded decision, the Tenth Circuit appeals court—albeit with a different chief judge—found the same statute not in violation of the First Amendment, and perfectly in line with the United States’ treaty and international obligations.⁷ In this opinion, works in the public domain were fair game, particularly because their restoration would somehow help American authors indirectly.⁸ Copyright was merely a tool for trade law, and, because of this, any alteration was acceptable and necessary.

B. COPYRIGHT AS A BARGAIN OR TRADE POLICY

Copyright law has always been seen as a bargain, beginning with the language of the Constitution, which gives Congress the power to “promote the Progress of Science . . . by securing for limited Times to Authors . . . the exclusive Right to their respective Writings.”⁹ The basic utilitarian notion is that the public benefits from granting a monopoly to authors as an incentive to create new works, which the public can enjoy during the life of the copyright. Once the limited monopoly term expires, the public then benefits from the free exercise of use of the previously copyrighted work—the work comes into the public domain.¹⁰ As Justice Stevens noted in *Sony Corp. v. Universal City Studios*, each year the public domain grows, as new works complete their copyright term.¹¹ Once in the public domain,

4. *Golan v. Gonzales*, 501 F.3d at 1187–88.

5. *Id.* at 1196.

6. Anthony Falzone, *Scrutinizing the URAA*, CENTER FOR INTERNET & SOC’Y (Dec. 1, 2010, 9:38 PM), <http://cyberlaw.stanford.edu/node/6143>.

7. *Golan v. Holder*, 609 F.3d 1076 (10th Cir. 2010).

8. *Id.* at 1090.

9. U.S. Const. art. I, § 8, cl. 8.; see Diane Zimmerman, *Is There a Right to Have Something to Say? One View of the Public Domain*, 73 *FORDHAM L. REV.* 297, 304 (2004) (“This state of affairs, where speech goods once communicated were free for use except as limited by copyright law, was long accepted as both just and pragmatically desirable since it promoted individual intellectual growth and provided fodder for the development of new products of the human imagination.”).

10. U.S. Const. art. I, § 8, cl. 8.

11. *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 443 n.23 (1984) (“[S]ince copyright protection is not perpetual, the number of . . . works in the public domain necessarily increases each

individuals are free to use the work as they wish—reprint, create new versions (e.g., turning a novel into a movie), quote extensively, post on the Internet and do anything else—and all without permission of the copyright holder.¹² The work has entered its second life, free from copyright constraints. *Nanos gigantium humeris insidentes*: new works thus “stand on the shoulder of giants” as previously copyrighted works now become available for building blocks and inspiration.

Under the traditional structure of the copyright bargain, a work traveled from creation to protection under federal copyright law and ultimately to the public domain.¹³ The end of the journey was seen as permanent—once a work entered the public domain, it stayed there forever.¹⁴ But a small section of the Uruguay Round Agreements Act (URAA), congressional implementing legislation needed to join the WTO in the mid-1990s, called our basic copyright assumptions into question.¹⁵ Millions of foreign works had copyright “restored” to works that had previously been in the public domain in the United States.¹⁶ Was the journey still a one-way trip? It seemed as if copyright law had been trumped by trade policy needs.

Copyright law can also be seen, from the beginning of its history, as a tool for international trade and relationships between countries. Beginning in England, a good deal of the stress on the original copyright system came from foreign publications coming in to compete with local versions.¹⁷ By the nineteenth century, a web of bilateral treaties, and eventually the Berne Convention at the end of the nineteenth century, set out to create a system of rules based on national treatment and an even playing field.¹⁸ But the United States resisted the international system for over a hundred years. In the United States, copyright restoration is the result of joining Berne.¹⁹ Are we now paying for our sins? Or does § 104A violate our constitutionally guaranteed First Amendment rights?²⁰ The Tenth Circuit seems conflicted.

year.”).

12. This was the issue raised by *Eldred v. Ashcroft*, but with focus on the fact that the public domain for published works was suddenly delayed twenty years. *Eldred v. Ashcroft*, 537 U.S. 186 (2003). Businesses that depended on public domain works—new ones coming into the public domain each year—suddenly found themselves with a terrible wait—twenty years for any additional published works to enter the public domain.

13. *Golan v. Gonzales*, 501 F.3d at 1189.

14. *Id.* See generally Zimmerman, *supra* note 9.

15. See 17 U.S.C. §§ 104(A), 302, 303, 304, 512, 1201 (2006); see also 19 U.S.C. § 3501 (2006); Uruguay Round Agreements Act, Pub. L. No.103-465, § 514, 108 Stat. 4809, 4976 (codified as amended at 17 U.S.C. § 104A).

16. Peters, *supra* note 2, at 31.

17. See L. RAY PATTERSON, COPYRIGHT IN HISTORICAL PERSPECTIVE 155 (1968); Diane Zimmerman, *It's Original! (?)*: In Pursuit of Copyright's Elusive Essence, 28 COLUM. J.L. & ARTS 187, 191 (2005). See generally MARK ROSE, AUTHORS AND OWNERS: THE INVENTION OF COPYRIGHT (1993).

18. See generally CATHERINE SEVILLE, THE INTERNATIONALISATION OF COPYRIGHT LAW: BOOKS, BUCCANEERS AND THE BLACK FLAG IN THE NINETEENTH CENTURY (2006).

19. 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT, § 9A.02 (2010).

20. 17 U.S.C. § 104A.

C. RESOLVING THE INTERNAL CIRCUIT SPLIT

Section 104A is a complicated statute that seeks to resolve our treaty obligations under Article 18 of the Berne Convention.²¹ Enacted under the URAA as part of the requirements necessary for the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPs), § 104A (in the URAA it was Section 518) no doubt changes the “traditional contours” of the copyright law.²² But in what way? What exactly did § 104A do? Even the *Golan* court spends little time on the actual changes brought by § 104A, at least in terms of duration. This Article seeks to provide an understanding of what § 104A does—on the ground level—by looking at specific examples of works affected by the change in law. It also means to give the reader a little insight in to how these works are being used—the practical, real world affect of a change in the status of foreign works from in the public domain to under copyright. This Article also seeks to unravel the competing discourses between the two Tenth Circuit decisions by looking at foreign restoration from copyright, as well as trade policy perspectives to better understand how the Tenth Circuit should resolve its inconsistencies.²³ Just what were the treaty obligations that led to § 104A’s enactment, and was it the mandatory solution the *Golan v. Holder* court suggested? The actual evidence does not substantiate the second *Golan v. Holder* opinion—not on this point, and not on many others.

In the end, the Article hopes to produce two results: additional information on which to understand how to go forward with regard to § 104A, and also, a deeper understanding of the dangers of allowing unchecked trade policy to radically alter the traditional contours of copyright law. The danger is not merely that millions of works are now (re)copyrighted after being in the public domain. Rather, this kind of amendment to the Copyright Act brings instability and uncertainty to the whole system. If no boundaries exist, the law itself becomes meaningless.

Section 104A upset the assumptions of our contemporary understanding of what a copyright system does, but it was not the only amendment during the 1990s to challenge the boundaries and expectations of copyright law.²⁴ Anticircumvention, antibootlegging and digital rights management all introduced new elements to copyright that potentially altered the relationship of copyright and the public domain.²⁵ What if anticircumvention devices prevent access to public domain works?²⁶ What if digital watermarks trace (and report) uses long after the work is

21. *Id.*; Berne Convention for the Protection of Literary and Artistic Works art. 18, July 24, 1971, 1161 U.N.T.S. 3 [hereinafter Berne].

22. 17 U.S.C. § 104A.

23. *Golan v. Holder*, 609 F.3d 1076 (10th Cir. 2010); *Golan v. Gonzales*, 501 F.3d 1179 (10th Cir. 2007).

24. 17 U.S.C. § 104A; *see also* Eldred v. Ashcroft, 536 U.S. 186 (2003) (focusing on the fact that the public domain for published works was suddenly frozen for twenty years).

25. *See, e.g.*, Brian Danitz, Comment, *Martignon and KISS Catalog: Can Live Performances be Protected?*, 15 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1143 (2005) (analyzing two cases that found the antibootlegging statutes unconstitutional).

26. *See* Yochai Benkler, *Free as the Air to Common Use: First Amendment Constraints on Enclosure of the Public Domain*, 74 N.Y.U. L. REV. 254 (1999).

supposed to be “free as the air to common use?”²⁷ In short, are works in the public domain protectable because of their public domain status? Does the Constitution mandate a public domain?²⁸ Are works in the public domain secure from privatization and federal copyright (re)protection?

Part I provides an overview of the legal space of the public domain, both from case law as well as concrete examples of works entering their second life in the public domain. Part II explains the long history leading up to § 104A, in particular the history of the United States’ resistance to restoring foreign works.²⁹ Part III describes the copyright system before restoration and what kinds of works are subject of restoration. Part IV details the mechanics of § 104A, including the basic requirements for restoration, as well as how changes in the U.S. copyright system impact which works are the subject of restoration. Part V discusses the mechanics of reliance and reliance parties under § 104A—that is, parties who had been using the public domain before the work was restored. Part VI then turns to the *Golan* cases—the district court case, the first Tenth Circuit decision, the remanded district court decision and, upon appeal, the second Tenth Circuit decision.³⁰ Part VII concludes with a summary of the problems with § 104A, solutions and suggestions on how to solve the problems and a few concluding thoughts.

I. PROTECTING THE LEGAL SPACE OF THE PUBLIC DOMAIN

The Copyright Clause was intended “to be the engine of free expression.”³¹

Copyright provides the inducement for creation and dissemination of the works that shape our society and, in an imperfect, and almost accidental way, represents one of the foundations upon which freedom of expression rests.³²

A. THE COPYRIGHT MANDATE

In the last decade, the public domain has been the subject of great study, after

27. *Int'l News Serv. v. Associated Press*, 248 U.S. 215, 250 (1918) (Brandeis, J., dissenting). This is a famous phrase used to describe the public domain. The context of the quote:

The general rule of law is, that the noblest of human productions—knowledge, truths ascertained, conceptions, and ideas—become, after voluntary communication to others, free as the air to common use. Upon these incorporeal productions the attribute of property is continued after such communication only in certain classes of cases where public policy has seemed to demand it.

Id.; see also Julie Cohen, *A Right to Read Anonymously: A Closer Look at Copyright Management in Cyberspace*, 28 CONN. L. REV. 981 (1996).

28. Zimmerman, *supra* note 9.

29. 17 U.S.C. § 104A.

30. *Golan v. Holder*, 609 F.3d 1076 (10th Cir. 2010); *Golan v. Gonzales*, 501 F.3d 1179 (10th Cir. 2007).

31. *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1261 (11th Cir. 2001) (quoting *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 558 (1985)).

32. Barbara A. Ringer, *The Role of the United States in International Copyright—Past, Present and Future*, 56 GEO. L.J. 1050 (1968). Ringer would become the Register of Copyright, the highest post in the Copyright Office.

having been taken for granted for most of copyright history.³³ Some contemporary scholars believe the public domain exists as a constitutionally protected component of the copyright system on account of the “limited Times” aspect of the Copyright Clause in the Constitution.³⁴ Others see the public domain as encompassing not only works with expired copyright terms or subject matter that had not been protectable in the first place (i.e., facts, ideas, etc.), but including fair uses and other permissible uses of protected works.³⁵ The idea of what is included in the public domain has been conceptually expanded by scholars like Samuelson, Benkler, Zimmerman and Boyle, among others, partly in response to legislation and cases during the 1990s that significantly—sometimes temporarily but in other instances permanently—diminished the number of works included in the public domain.³⁶ Not only did the Copyright Term Extension Act (CTEA) extend the copyright term for published works for an additional twenty years, but also, four years prior, the URAA was enacted, which gave copyright to foreign works previously in the public domain in the United States.³⁷ The public domain seemed, in many ways, under attack.

In *Suntrust Bank v. Houghton Mifflin Co.*, the Eleventh Circuit succinctly summarized the idea that copyright law served three main goals: the promotion of learning, the protection of the public domain and the granting of an exclusive right to the author.³⁸ Six years after *Suntrust*, the first *Golan* appeals court seemed to affirm the second goal of the Copyright Act: the protection of the public domain, or rather “to ensure that works enter the public domain after an author’s rights, exclusive, but limited, have expired.”³⁹

The *Suntrust* court explained importance of the public domain:

Parallel to the patent regime, the limited time period of the copyright serves the dual purpose of ensuring that the work will enter the public domain and ensuring that the author has received “a fair return for [her] labors.” This limited grant “is intended to motivate the creative activity of authors . . . by the provision of a special reward, and to allow the public access to the products of their genius after the limited period of exclusive control has expired.” The public is protected in two ways: the grant of a

33. See generally JAMES BOYLE, *THE PUBLIC DOMAIN* (2008); David Lange, *Reimagining the Public Domain*, 66 *LAW & CONTEMP. PROBS.* 463 (2003); Ctr. for the Study of the Pub. Domain, *The Duke Conference on the Public Domain*, DUKE U., <http://www.law.duke.edu/pd/> (last visited Nov. 1, 2010).

34. Pamela Samuelson, *Challenges in Mapping the Public Domain*, in *THE FUTURE OF THE PUBLIC DOMAIN* (Lucie Guibault & P. Bernt Hugenholtz eds., 2006).

35. See, e.g., Benkler, *supra* note 26.

36. See, e.g., Eldred v. Ashcroft, 536 U.S. 186 (2003).

37. Copyright Term Extension Act of 1998, Pub. L. No. 105-298, 112 Stat. 2827 (codified at 17 U.S.C. §§ 302, 303, 304); Uruguay Round Agreements Act of 1994, Pub. L. No. 103-465, 108 Stat. 4809 (codified at 19 U.S.C. § 3501). Some scholars believed the extension of the copyright term in the CTEA was unconstitutional. See, e.g., Richard Epstein, *The Dubious Constitutionality of the Copyright Term Extension Act*, 36 *Loy. L.A. L. Rev.* 123 (2002); Tyler Ochoa, *Patent and Copyright Term Extension and the Constitution: A Historical Perspective*, 49 *J. COPYRIGHT & SOC'Y* 119 (2002).

38. *Suntrust Bank v. Houghton Mifflin, Co.*, 268 F.3d 1257, 1261–63 (11th Cir. 2001) (declining to issue injunction against publication of *Gone with the Wind* parody where no irreparable injury found).

39. *Id.* at 1262.

copyright encourages authors to create new works . . . and the limitation ensures that the works will eventually enter the public domain, which protects the public's right of access and use.⁴⁰

Within this paragraph, the court sets out the nature and the legal development of the public domain.⁴¹ The public and individual creators need protecting—not only by encouragement of new works, but also by the freeing of the work for use and access in any way that the public sees fit. Part of the copyright mandate, according to *Suntrust*, is protection of the public domain.⁴²

One would think that the responsibility would fall to Congress to protect the public, but there is little evidence to support that conclusion. In reviewing the legislative history behind § 104A, the concern for the public domain is only minimally addressed in the congressional testimony, at least calling into question whether Congress understood the destabilizing impact removing millions of works would have on the public's traditionally presumed right of unfettered use.

Courts have undertaken the role of protectorate. We have had cases—*Graham v. John Deere*, *Harper & Row* and *Dastar Corp. v. Twentieth Century*—that have demonstrated the U.S. Supreme Court's interest in protecting the public domain.⁴³ For example, the Supreme Court in *Dastar* explained, "Once the . . . copyright monopoly has expired, the public may use the . . . work at will and without attribution."⁴⁴ Works that have become part of the public domain no longer carry the same exclusive control provided by domestic copyright law.⁴⁵ And for the first time, it looked as if the Tenth Circuit in *Golan* was undertaking the responsibility of protecting the public's interest as a First Amendment right, creating a constitutionally protected public domain.⁴⁶ Unfortunately, the second *Golan* appellate decision has undone that work.⁴⁷

B. WHY THE PUBLIC DOMAIN

"[R]estored works" are as terrifying to many as [George] Romero's zombies ever

40. *Id.* (citations omitted).

41. The concept and importance of the public domain is not limited to U.S. soil. On January 25, 2010, COMMUNIA, the European Thematic Network on the Digital Public Domain, launched the Public Domain Manifesto. COMMUNIA, *About the Manifesto*, PUB. DOMAIN MANIFESTO, <http://www.publicdomainmanifesto.org/node/7> (last visited Nov. 16, 2010). The Third General Principle of the Public Domain Manifesto is, "What is in the Public Domain must remain in the Public Domain." COMMUNIA, *The Public Domain Manifesto: General Principles*, PUB. DOMAIN MANIFESTO, <http://www.publicdomainmanifesto.org/node/8#General> (last visited Nov. 16, 2010).

42. *Suntrust*, 268 F.3d at 1261–63.

43. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 33–34 (2003); *Harper & Row v. Nation Enters.*, 471 U.S. 539, 548 (1985); *Graham v. John Deere Co.*, 383 U.S. 1, 6 (1966).

44. *Dastar*, 539 U.S. at 33–34.

45. R. Anthony Reese, *Is the Public Domain Permanent?: Congress's Power to Grant Exclusive Rights in Unpublished Public Domain Works*, 30 COLUM. J.L. & ARTS 531, 555–56 (2007). Reese suggests that a publication right on unpublished public domain works might be different than on published works, because the materials would not have been freely accessible, and by providing a twenty-five year term, the unpublished works will be further disseminated.

46. *Golan v. Gonzales*, 501 F.3d 1179, 1196 (10th Cir. 2007).

47. *Golan v. Holder*, 609 F.3d 1076, 1095 (10th Cir. 2010).

were. The reason they are terrifying is that they do threaten the *investments* that many people and companies made because of their now-mistaken belief that works in the public domain are legally dead for all time and thus could be used without liability.⁴⁸

We have a dual relationship with public domain works: we think works should stay there, both because it would be unnatural for them to revive and also because somehow our cultural life depends on the certainty that these works remain available for common use.⁴⁹ We see examples of culture building on culture everyday. Three particular scenarios come to mind.

First, new derivative works can be built upon traditional narratives, stories and art that are in the public domain. Michael Carroll, a law professor, blogged recently about the death of a friend—a friend who had started a neighborhood theatre for children to perform new versions of Shakespeare plays.⁵⁰ That the works were in the public domain provided new opportunities to create new works without paying a fee and, more than that, enriched the lives and continuity of a community. The plays were chosen because they were in the public domain—the copyright status mattered. We all know of or have even been a part of a new version of Shakespeare. I, too, as a teenager, performed in a rewriting of Shakespeare, and I have fond, distinct memories of our Western version of *A Comedy of Errors*. We were creating something unique and interesting that no one else—we thought—had ever had done, but we were doing so with a classic that tied us to our cultural and theatrical history.⁵¹ That is what the public domain is supposed to be about—building, exploring, growing and connecting culture. It is because the work is in the public domain that it becomes valuable, and, in its public domain-ness, begins its second life.

Second, a public domain work affords the opportunity for greater freedom to write, think and comment upon a subject. Even though we have fair use and the idea/expression dichotomy, these two mechanisms are sometimes inadequate for the needs at hand. When a work comes into the public domain, users—scholars, artists, students, filmmakers or anyone else—have far greater freedom to think and express themselves about the cultural object.

Finally, once a work is in the public domain, new business opportunities present themselves, which allow both famous and forgotten works to be revitalized in new ways. Society finds value in access to works of the past—and that access comes from lack of copyright restrictions. For example, in *Eldred v. Ashcroft*, the petitioners comprised large- and small-scale publishers whose businesses republished public domain works.⁵² The idea that a work should be published

48. Lionel S. Sobel, *Back from the Public Domain: Congress Restores Copyrights to Many Foreign Works*, 17 ENT. L. REP. 3, 3 (Aug. 1995).

49. See Paul Edward Geller, *Zombie and Once-Dead Works: Copyright Retroactivity After the E.C. Term Directive*, 18 ENT. & SPORTS LAW 7 (Summer 2000).

50. Michael Carroll, *Jillian Raye and the Bard: The Vitality of the Public Domain*, CARROLLOGOS (Nov. 17, 2008, 6:51 PM), <http://carrollogos.blogspot.com/2008/11/jillian-raye-and-bard-vitality-of.html>.

51. Tom Alessandri, English teacher and theater director at Bellarmine College Prep in San Jose, Cal. rewrote *The Comedy of Errors* in 1987 (script on file with author).

52. *Eldred v. Ashcroft*, 537 U.S. 186, 193 (2003). These included Dover Publications

freely by others gets to the heart of copyright in many ways, harkening back to the Stationer's Company versus the Statute of Anne, and the cases that followed.⁵³ The concerns at the time were not idea/expression or fair use, but at what point other publishers would be freely able to republish works. The Stationer's Company had kept a stronghold on texts perpetually.⁵⁴ When the Licensing Act was not renewed to allow this procedure, the Statute of Anne was put in its place, which gave to authors (a more sympathetic group but backed by the publishers) limited time to hold a monopoly over a work; and then the work became free for all to use.⁵⁵ It was only after the *Millar* and *Donaldson* cases that the idea of statutory monopoly was fully in place—that the publishers' monopoly ended with the statutory term and did not continue as a common law right. The United States adopted the same notion of a limited statutory term, whereby, after the copyright term, the work was free to anyone to use or republish.⁵⁶ As the Petitioners in *Eldred* explained, "The whole point of the Framers' directive . . . was that copyrighted works would pass into a public domain where they would 'admit the people at large . . . to the full possession and enjoyment of all writings and inventions without restraint.'" ⁵⁷

People depend on the certainty of the public domain. Artist Barbara Kruger, for example, was the subject of a case when a work that had been in the public domain was suddenly "restored" by § 104A.⁵⁸ She had used a German photograph that had been in the public domain in the United States.⁵⁹ Upon restoration, the question of copyright infringement implicated not only the artist, but also the Whitney Museum of American Art, Museum of Contemporary Art L.A., M.I.T. Press, Boone Gallery and Educational Broadcasting Systems, all of whom had further used the Kruger work with her permission.⁶⁰ The gift shop's items, billboards, books and other

(republishing fiction and children's novels now in the public domain), Luck's Music Library (who specialized in selling and renting classical orchestral sheet music), Higgingson Book Company and Tri-Horn International (historical works now in the public domain, including maps, local histories and resources for genealogy), the American Film Heritage Association (documentary filmmakers association) and Movieraft (preservation of films in the public domain or "orphaned" works). All of these plaintiffs were taking the whole of a public domain work and republishing or reproducing the work.

53. *Millar v. Taylor*, (1769) 98 Eng. Rep. 201 (K.B.); 4 Burr. 2303. *Contra* *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834); *Donaldson v. Beckett*, (1774) 1 Eng. Rep. 1837 (H.L.); 4 Burr. 2408.

54. See generally Rose, *supra* note 17.

55. See Tyler T. Ochoa, *Origins and Meanings of the Public Domain*, 28 U. DAYTON L. REV. 215, 233 (2003).

56. *Wheaton*, 33 U.S. (8 Pet.) 591.

57. Brief for Petitioner at 36, *Eldred v. Ashcroft*, 537 U.S. 186 (2003) (No. 01-618), 2002 WL 1041928 at *36 (citation omitted).

58. 17 U.S.C. § 104A (2006); *Hoepker v. Kruger*, 200 F. Supp. 2d 340 (S.D.N.Y. 2002).

59. *Hoepker*, 200 F. Supp. 2d at 344-45.

60. *Id.* at 340. Here are just a few of the uses described in the court's opinion:

Defendant Barbara Kruger also is a well-known artist, specializing in collage works combining photographs and text. In 1990, Kruger created an untitled work incorporating Hoepker's "Charlotte As Seen By Thomas." To create her work (the "Kruger Composite"), Kruger cropped and enlarged Hoepker's photographic image, transferred it to silkscreen and, in her characteristic style, superimposed three large red blocks containing words that can be read together as, "It's a small world but not if you have to clean it." In April of 1990, Kruger sold the Kruger Composite

works now might be considered infringing goods, even though when Kruger made the artwork in question and transferred the rights to use the artwork nothing within the new composite work she created was under copyright or would have triggered copyright infringement.⁶¹ This is just one example. Think of how many other museums and art books face the same fate of copyright infringement and potential lawsuits. This is potentially the case for any work that incorporates foreign works first published between 1923 and 1989.⁶²

The *Golan* plaintiffs included examples of new derivative works from public domain works as well.⁶³ Plaintiff John Blackburn, a high school teacher, was asked to score music for a high school band competition with a “Heroes 9/11” theme.⁶⁴ The *Golan* court described Blackburn’s relationship to Shostakovich’s work:

[A]t the moment that Dmitri Shostakovich’s *Symphony No. 5* entered the public domain, Plaintiff John Blackburn had a right to create a derivative work for a high school band to perform at an event commemorating 9/11. The principle of Mr. Blackburn’s right to create the piece, and the First Amendment protected his right to copyright law that shields works in the public domain from copyright ensured perform it.⁶⁵

This was a novel argument for protecting works in the public domain—or rather

to defendant Museum of Contemporary Art L.A. (“MOCA”). MOCA thus acquired the right to display the Kruger Composite without violating Kruger’s copyright by virtue of 17 U.S.C. § 109(c) and, by separate license, acquired a non-exclusive right to reproduce the work. From October 17, 1999 to February 13, 2000, MOCA displayed the Kruger Composite as one of sixty-four works of art in an exhibit dedicated to Kruger (the “Kruger Exhibit”). In conjunction with the exhibition, MOCA sold gift items in its museum shop featuring the Kruger Composite in the form of postcards, note cubes, magnets and t-shirts. MOCA also sold a book respecting Kruger’s works and ideas entitled “Barbara Kruger” (the “Kruger Catalog”) that was published jointly with defendant M.I.T. Press. The Kruger Catalog contains three depictions of the Kruger Composite among the hundreds of pictures in the 200-plus page book. MOCA’s gross proceeds from sales of the gift items (except the t-shirts) were \$12,020, with net revenues (proceeds minus cost of goods) of \$7,485. Revenues from t-shirt sales apparently were less than \$7,300. MOCA’s gross proceeds from sales of the Kruger Catalog were approximately \$236,950, with approximately \$53,644 in net revenues (proceeds minus printing costs). M.I.T. Press claims \$134,323 in gross proceeds and \$39,084 in net revenues (proceeds minus acquisition costs and direct support costs) in connection with its own sales of the Kruger Catalog. After closing in Los Angeles, the Kruger Exhibit traveled to New York and was presented at defendant Whitney Museum of American Art (the “Whitney”) from July 13 through October 22, 2000. The Whitney advertised the Kruger Exhibit in various ways, including newsletters and brochures that incorporated the Kruger Composite. The Whitney also purchased from MOCA an inventory of the Kruger Catalog and various gift items to sell at its museum shop in conjunction with the exhibition. The Whitney’s approximate profits from sales of the Kruger Catalog were less than \$37,000, and profits from its sales of gift items were less than \$800.

Id. at 342–43.

61. *Id.* at 345.

62. *See infra* Part IV-B.

63. *Golan v. Gonzales*, 501 F.3d 1179, 1193 (10th Cir. 2007).

64. *Id.*

65. *Id.*

the public's individual rights to use works in the public domain. Judge Henry continued, "[O]nce the works at issue became free for anyone to copy, plaintiffs in this case had vested First Amendment interests in the expressions, and § 514 [§ 104A]'s interference with plaintiffs' rights is subject to First Amendment scrutiny."⁶⁶

These kinds of uses—derivative uses, republications and commentary—were exactly what should happen to works in the public domain. The incentives of copyright authors were for “limited Times.”⁶⁷ Once the work's term expired, the public was free to use the works—creating new works and opportunities. The system creates dual incentives—incentives for creators of original works and incentives to secondary creators or users of the works once they are in the public domain. Anyone can use a public domain work—whether selling the work themselves, creating new works from public domain works or using the works heavily for comment or criticism beyond fair use and the idea/expression dichotomy. That is why we see multiple copies of Jane Austen, Milton and even an expired F. Scott Fitzgerald novel.⁶⁸ Penguin, Norton and other publishers need not pay the heirs of Jane Austen to reprint her works, but they also cannot keep other publishers from republishing the same works. All of these uses—derivative versions, comment and criticism and republication of the whole work—are the focus of the subject the *Golan* court took up, and for which it found there is a First Amendment right to use works in the public domain.⁶⁹

II. THE SLOW POLICY MOVE TOWARDS RESTORATION

The United States would resist joining the Berne Convention for over a century, in great part because of the question of restoration of foreign works. Article 18(1) of the Berne Convention requires that new signatories “shall apply to all works which, at the moment of its coming into force, have not yet fallen into the public domain in the country of origin through the expiry of the term of protection.”⁷⁰ Article 18(3) provides possible flexibility for new signatories: “the respective countries shall determine, each in so far as it is concerned, the conditions of application of this principle.”⁷¹ The idea was that when a new member joined, the

66. *Id.* at 1194.

67. U.S. Const. art. I, § 8, cl. 8.

68. Fitzgerald's novel *This Side of Paradise* was published in 1920, and is therefore now in the public domain. Amazon.com lists over twenty-six different editions. AMAZON.COM, <http://amazon.com> (search “This Side of Paradise”) (last visited Dec. 3, 2010). Another example is Herman Melville's *Moby Dick*, which was originally published in 1851. Versions have been published by Oxford World's Classics (1988, 1998, 2008), Dove Giant Thrift Editions (2003), Penguin Classics Deluxe Edition (1992), A Longman Critical Edition (2007). HERMAN MELVILLE, *MOBY DICK* (Tom Tanner ed., Oxford Univ. Press 1988) (1851); (Geraldine McCaughrean ed., Oxford Univ. Press 1998); (Tom Tanner ed., Oxford Univ. Press 2008); (Paul Negri gen. ed., Thomas Crawford ed., Dover Publ'ns 2003); (Andrew Delbanco & Tom Quirk eds., Penguin Books 1992); (John Bryan & Haskell Springer eds., Longman Publ'g 2007).

69. *Golan v. Holder*, 609 F.3d 1076 (10th Cir. 2010).

70. Berne, *supra* note 21, art. 18(1).

71. *Id.* art. 18(3).

other members wanted to get the benefit of protection of not just new works, but existing works as well.

From its beginning, the United States had an antforeign element in the copyright law. The first law, in fact, only afforded protection domestically, limiting copyright to those “being a citizen or citizens thereof, or resident within the same.”⁷² For over a century, the United States was a pirate nation—all foreign works were in the public domain in the United States and cheap copies of British works were created for the new Republic.⁷³ It was only in 1891, with the implementation of the International Copyright Act, which allowed for bilateral treaties, that foreigners were allowed to obtain copyrights in the United States, although they were subject to the strict formality requirements as were required of domestic works at the time.⁷⁴ Most foreign works found themselves still in the public domain, either immediately or within twenty-eight years.⁷⁵ It is this injustice that § 104A seeks to rectify.⁷⁶

The first significant multilateral copyright treaty that the United States joined was the Universal Copyright Convention, which addressed the question of restoration directly and in the negative.⁷⁷ The UCC included a nonretroactivity clause.⁷⁸ “This Convention shall not apply to works or rights in works which, at the effective date of the Convention in a Contracting State where protection is claimed, are permanently in the public domain in the said Contracting State.”⁷⁹ Foreign works that had fallen into the public domain before the enactment of the UCC remained there.

The Berne Convention Implementation Act (BCIA) would also make explicit that works were not restored.⁸⁰ On March 1, 1989, the BCIA came into force in the United States.⁸¹ After 100 years, the United States had finally become a member of the dominant copyright multilateral treaty. The BCIA took a minimalist approach to which parts of the 1976 Copyright Act had to be altered in order to be in compliance with the Berne Convention.⁸²

72. Copyright Act of 1790, ch. 15, § 1, 1 Stat. 124, 124 (repealed 1891); *see also* 1 WILLIAM PATRY, *COPYRIGHT LAW AND PRACTICE* 33 (1994).

73. *See* Jane C. Ginsburg & John M. Kernochan, *One Hundred Two Years Later: The U.S. Joins the Berne Convention*, 13 COLUM.-VLA J.L. & ARTS 1, 1–2 (1988).

74. International Copyright (Chace) Act of 1891, ch. 565, § 13, 26 Stat. 1106, 1110.

75. *See generally* Irwin Karp, *Final Report, Berne Article 18 Study on Retroactive United States Copyright Protection for Berne and Other Works*, 20 COLUM.-VLA J.L. & ARTS 157 (1996).

76. *Id.*

77. Universal Copyright Convention art. VII, Sep. 6, 1952, 6 U.S.T. 2731, 2740 [hereinafter UCC]; *see also* Ringer, *supra* note 31, at 1060–63.

78. UCC, *supra* note 77, art. VII.

79. *Id.*

80. Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, § 12, 102 Stat. 2853, 2860 (codified as amended at 17 U.S.C. § 101).

81. William F. Patry, *Developments in International Copyright from the U.S. Perspective*, in *GLOBAL INTELLECTUAL PROPERTY SERIES: PRACTICAL STRATEGIES—TRADEMARK AND COPYRIGHT* 349, 386 (Siegrun D. Kane & Roger L. Zissu eds., 1991).

82. William Patry explained:

The consensus achieved in passing legislation that enabled the United States to adhere to the Berne Convention was made possible by an agreement on two objectives: 1) to use a minimalist

The BCIA also included a response to Article 18: “Title 17, United States Code, as amended by this Act, does not provide copyright protection for any work that is in the public domain the United States.”⁸³ Thus, the BCIA applies only to works still under copyright on or after March 1, 1989. Congress believed it had fulfilled all of its obligations under Berne, even without restoring foreign works from the public domain.⁸⁴

The first significant departure from the no-restoration policy came with the North American Free Trade Agreement (NAFTA).⁸⁵ NAFTA was the first multilateral trade agreement that the United States joined that included a retroactivity clause.⁸⁶ The first enactment of § 104A came with NAFTA, and, in contrast to the § 104A we know today, was extremely limited in scope.⁸⁷ NAFTA restored motion pictures and certain works included within motion pictures that had fallen into the public domain in the United States.⁸⁸ The restoration included songs and other components included within the movie.⁸⁹ The films eligible were not only limited to those from Mexico and Canada, but the time period of when they fell into the U.S. public domain was also limited.⁹⁰ The works must have come into the public domain due to defective copyright notice during the period between January 1, 1978, to February 28, 1989—the period of time under the 1978 Copyright Act where notice was still required, but could be fixed within the first

approach and amend the U.S. Copyright Act only where there was a clear conflict with the express provisions of the Berne Convention, and 2) to amend the law only as much as was necessary to resolve the conflict in a manner that respected the preexisting balance of rights and limitations achieved in the 1976 Copyright Act.

Id. at 387.

83. Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, § 12, 102 Stat. 2853, 2860 (codified as amended at 17 U.S.C. § 101).

84. Jaszi, *supra* note 1, at 607.

85. North American Free Trade Agreement Implementation Act of 1993, Pub. L. No. 103-182, 107 Stat. 2057 (codified as amended in scattered sections of 17 U.S.C., 18 U.S.C., 19 U.S.C., 22 U.S.C., 25 U.S.C., 26 U.S.C., 28 U.S.C., 31 U.S.C., 35 U.S.C. and 46 U.S.C.).

86. After each of the world wars, Congress allowed for the restoration of foreign works that had fallen into the public domain during the fighting. For example, in 1960, President Eisenhower restored by proclamation Austrian works to authors who had not met the requirements between March 13, 1938 and July 27, 1956, and in 1968, President Johnson restored by proclamation the works of German authors who had not met the formality requirements between September 3, 1939 and May 5, 1956. The restoration allowed Austrian authors to comply with conditions and formalities by 1961, and German authors to comply with conditions and formalities by July 11, 1968. Therefore, the restoration was not automatic, and the authors had to actively comply with U.S. laws. The number of works was more limited, and the time that reliance parties could have built derivative works is also significantly limited, compared to 17 U.S.C. § 104A (2006). 32 Fed. Reg. 10,341 (1967). The United States was not the only country to grant war extensions. Many European countries, Japan and even Russia have wartime extensions in the copyright law.

87. North American Free Trade Agreement Implementation Act § 334, 107 Stat. at 2115.

88. See 7 PATRY, *supra* note 72, § 24:56 n.4 (citation omitted).

89. See generally William Gable, *Restoration of Copyrights: Dueling Trolls and Other Oddities Under Section 104A of the Copyright Act*, 29 COLUM. J.L. & ARTS 181 (2005); Adam P. Segal, *Zombie Copyrights: Copyright Restoration Under the New § 104A of the Copyright Act*, 13 Santa Clara Computer & High Tech. L.J. 71 (1997).

90. See generally Sharan Leslie Goolsby, *Protection of Intellectual Property Rights under NAFTA*, 4 NAFTA L. & Bus. Rev. Am. 5 (Fall 1998).

five years.⁹¹ This is an incredibly limited period, and one would imagine a good deal of other Mexican and Canadian films fell into the U.S. public domain under the 1909 Act as well, but they were not eligible for restoration.⁹² David Nimmer points out, “Ironically, this resurrection is therefore inapplicable to the many Cantinflas movies from the Golden Age of Film in Mexico, inasmuch as their notice defects, if any, predated the decennial era.”⁹³

Unlike § 104A today, restoration under the first version of § 104A was not automatic.⁹⁴ Under NAFTA, copyright holders had the year of 1994 to file a notice of restoration with the Copyright Office.⁹⁵ When the list was published in February 1995, it included 345 works, nearly all Spanish-language titles.⁹⁶ This was a closed list—Nimmer referred to it as the “Lazarus List”—that is, only works on this list were restored from the public domain.⁹⁷ If the copyright holder did not file a notice of restoration with the Copyright Office during 1994, the work remained in the public domain.⁹⁸

The NAFTA version of § 104A was enacted about the same time as the European Union Term Directive.⁹⁹ The processes for harmonization, however, were very different. NAFTA took a very narrow view—probably the narrowest view one could take and still restore works. The Europeans brought in sweeping changes, including the requirement that all European countries adopt the “rule of the shorter term.”¹⁰⁰

Unlike previous acts, which applied retroactively to only a few countries and required formalities, the URAA potentially granted automatic retroactivity to all

91. 3 NIMMER & NIMMER, *supra* note 19, § 9A.0; *see also* 17 U.S.C. § 104A(a) (2006).

92. “Some examples to which this restoration provision applies are feature films, short films, silent films, documentaries, and television series, films and programs.” Fred Koenigsberg & Joan T. Pinaire, *Impact of International Copyright Developments in U.S. Practice*, in GLOBAL TRADEMARK AND COPYRIGHT 523, 548 (Practising Law Institute ed., 1994) (citing Procedures for Copyright Restoration of Certain Motion Pictures and Their Contents in Accordance with the North American Free Trade Agreement, 59 Fed. Reg. 12,162 (Mar. 16, 1994) (to be codified at 37 C.F.R. pt. 201)).

93. 3 NIMMER & NIMMER, *supra* note 19, § 9A.03 n.13 (citation omitted).

94. *Compare* 17 U.S.C. § 104A, with North American Free Trade Agreement Implementation Act of 1993, Pub. L. No. 103-182, § 334(b), 107 Stat. 2057, 2115 (codified as amended in 17 U.S.C. § 104A).

95. 8 PATRY, *supra* note 72, §25:55.

96. Copyright Restoration of Certain Motion Pictures in Accordance with the North American Free Trade Agreement; List of Titles for which Statements of Intent to Restore Copyright Were Received, 60 Fed. Reg. 8252 (Feb. 13, 1995). Nimmer got a count of 345, and like my investigation, he found that titles appeared to be from Mexico, rather than from Canada. 3 NIMMER & NIMMER, *supra* note 19, § 9A.03[B][3] n.22.

97. 3 NIMMER & NIMMER, *supra* note 19, § 9A.03[B][3] n.22.

98. 17 U.S.C. § 104A(b) (1993).

99. *See generally* Ysolde Gendreau, *Copyright Harmonization in the European Union and in North America*, 20 COLUM. J.L. & ARTS 37 (1995).

100. *See generally* Lisa M. Brownlee, *Recent Changes in the Duration of Copyright in the United States and European Union: Procedure and Policy*, 6 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 579 (1996); William Patry, *Choice of Law and International Copyright*, 48 AM. J. COMP. L. 383 (2000); J.H. Reichman, *The Duration of Copyright and the Limits of Cultural Policy*, 14 CARDOZO ARTS & ENT. L.J. 625 (1996); Kelly Slavitt, *The Copyright Term Extension Act: We May Know the Words, But Can We Find the Harmony?*, 11 MSU-DCL J. INT'L L. 457 (2002).

preexisting works of numerous eligible foreign countries.¹⁰¹ Section 104A was added to the U.S. Copyright Act, upsetting traditional expectations of how the system worked. The question is whether the new amendment is an anomaly to fix past wrongs or the beginning of trade law interpreting copyright.

III. THE CONSEQUENCES BEFORE COPYRIGHT RESTORATION

The original Golan complaint included examples of works restored by § 104A:

[S]everal hundred paintings of Picasso; the collection works by J.R.R. Tolkien . . . ; Virginia Woolf's *A Room of One's Own*, several books by H.G. Wells; . . . such favorites by the Russian composer Serge Prokofiev as *Six Pieces from Cinderella*, *Romeo and Juliet*, and *Three Children's Songs for Piano*; a collection of photographs of the Beatles; and still photographs from the Japanese film *Godzilla*.¹⁰²

Diane Zimmerman points out that the problem with copyright restoration of foreign works was not that the works were facially ineligible for protection: "The problem, for public domain purposes, arises because the attempt to give them such protection occurs after they have unambiguously lost or failed to acquire the status of intellectual property to which they were initially entitled."¹⁰³

Section 104A resurrected copyright to foreign works that had fallen into the public domain in the United States in three situations: foreign works that had not complied with U.S. formalities required for copyright protection until March 1989; works that had been published in countries without treaty relations with the United States; and foreign sound recordings published before February 1972.¹⁰⁴

A. LACK OF FORMALITIES, 1909–89

This section takes the example of lack of formalities to understand the assumptions and expectations before restoration—that is, how foreign works came to be in the public domain. The 1909 Copyright Act had strict and formal requirements for federal protection.¹⁰⁵ Formality requirements in the form of notice continued even under the 1978 Copyright Act, until March 1, 1989, when Congress finally removed the requirements.¹⁰⁶

The statue commonly referred to as the Chicago Picasso exemplifies the irrevocability of that costly error, at least perhaps until recently. The Chicago

101. 7 PATRY, *supra* note 72, § 24:23.

102. Complaint at 20–21, *Golan v. Ashcroft*, 310 F. Supp. 2d 1215 (D. Colo. 2004) (No. 01–B–1854).

103. Zimmerman, *supra* note 9, at 299.

104. 17 U.S.C. § 104A (2006).

105. For a more recent take on the problem, see generally Tyler T. Ochoa, *Protection for Works of Foreign Origin Under the 1909 Copyright Act*, 26 SANTA CLARA COMPUTER & HIGH TECH. L.J. 285 (2010).

106. Cathryn A. Heise, *Berne-ing Down the House (and Senate): The Berne Convention Implementation Act of 1988*, FLA. B.J., July–Aug. 1989, at 62, 62–63.

Picasso case study also demonstrates the assumptions under U.S. copyright law before the United States joined the Berne Convention in the late 1980s, and also what § 104A sought to rectify in the mid-1990s, albeit by disturbing the traditional expectations of the copyright bargain.

A *Chicago Tribune* writer described the scene on August 15, 1967, when the untitled Picasso statue, standing fifty feet high, was unveiled at Chicago's new Civic Center:

Just after noon, Mayor Richard J. Daley pulled a cord attached to 1,200 square feet of blue-green fabric, unwrapping a gift "to the people of Chicago" from an artist who had never visited—and had shown no previous interest in—the city. The artist was Pablo Picasso, who at age 85 had dominated Western art for more than half a century.¹⁰⁷

Three architects representing the new Civic Center had gone to visit Picasso in France, with an offering of \$100,000.¹⁰⁸ According to news stories, historians and the court records, Picasso refused payment.¹⁰⁹ Instead, Picasso—after additional work and contemplation—gave the Chicago Building Commission a modified version of a 1960s sculpture in the form of a "forty-two inch maquette, or model, for a sculpture made of Cor-Ten steel. . . ."¹¹⁰ Picasso said the sculpture was "his gift to the people of Chicago."¹¹¹ These words would later be memorialized in a legal document that included the copyright, as well as the ability to create the larger version. In fact, the Art Institute had inadvertently dedicated the sculpture not just to the people of Chicago, but also to the public domain. The smaller maquette had not been properly copyrighted.

The question of the status of the Chicago Picasso's copyright came as a result of a declaratory judgment brought by plaintiff-publisher Letter Edged in Black Press, who wanted to "market a copy of the sculpture."¹¹² The case would not only clarify the status of both the maquette and the larger statue, but would serve as key case law regarding the failure to affix proper notice to art work if the work was presented without restrictions to the general public.¹¹³ The decision articulated the mechanics as well as the essence of copyright law.

Judge Napoli in *Letter Edged in Black Press* explained the basic journey that a copyrighted work took within the copyright system at the time.¹¹⁴ Under the 1909 Act, a creative work began its life (once created) protected under state common law, which protect[ed] against "unauthorized copying, publishing, vending,

107. Alan G. Artner, *Chicago's Picasso Sculpture*, CHICAGO TRIBUNE (Dec. 19, 2007), <http://www.chicagotribune.com/news/politics/chi-chicagodays-picasso-story,0,1344585.story>.

108. See ROLAND PENROSE, *PICASSO: HIS LIFE AND WORK* 442–46 (3d ed. 1981) (providing a detailed and lovely description of the visit to Picasso).

109. *Id.*

110. Artner, *supra* note 107.

111. PENROSE, *supra* note 108, at 446.

112. *Letter Edged in Black Press, Inc. v. Pub. Bldg. Comm'n*, 320 F. Supp. 1303, 1305 (N.D. Ill. 1970).

113. *Id.* at 1303.

114. *Id.* at 1308–09.

performing and recording,” until the work had its first authorized publication.¹¹⁵ This was how the copyright system would work, until unpublished works would be brought into the federal system with the 1976 Copyright Act, at which time state common law “right of first publication” was no longer a needed mechanism.¹¹⁶ But, under the 1909 Act, unpublished works were protected by state common law. “Upon termination of the common law copyright, the work falls into the public domain if statutory protection is not obtained by the giving of the requisite notice.”¹¹⁷ The explanation for the transition from common law to federal protection can be explained, the court writes, by the Copyright Clause itself:

Protection is granted, but only “for limited times.” The inclusion of this caveat in the Constitution makes manifest the right of society to ultimately claim free access to materials, which may prove essential to the growth of the society. The copyright clause, however, does not impinge on the right of privacy of a creator. An author who refrains from publication and uses his work for his own pleasure may enjoy the common law copyright protection in perpetuity. Once a work is published, however, the Constitution dictates that the time for which the statutory copyright protection is accorded starts to run. An author is not allowed to publish a work and then after a period of time has elapsed choose to invoke statutory copyright protection. If the statutory protection is not acquired at the time of publication by appropriate notice, the work is lost to the public domain. Any other rule would permit avoidance of the “limited times” provision of the Constitution.¹¹⁸

Publication and proper copyright notice triggered federal protection. Without proper notice at the time of publication, a work under the 1909 Copyright Act came into the public domain. This was the system under which the Chicago Picasso came into existence.¹¹⁹

The court explained that at the time that “Picasso signed the deed of gift on August 21, 1966, there existed but a single copyright. Picasso had a common law copyright in the maquette” because the work remained unpublished.¹²⁰ Picasso “gave the maquette itself to the Art Institute and the right to reproduce it to the defendant [Public Building Commission of Chicago].”¹²¹ Because the monumental sculpture did not exist in 1966 when Picasso signed the deed of gift, there could be no common law or statutory copyright in the monumental sculpture.¹²² The court wrote: “It is settled that a copyright can exist only in a perceptible, tangible work. It can not exist in a vision”¹²³ The maquette, then, was the copyrightable

115. *Id.* at 1308 (citations omitted).

116. *See* 17 U.S.C. § 303(a) (2006).

117. *Letter Edged in Black*, 320 F. Supp. at 1308 (citation omitted). The court noted that this result—that the common law copyright is terminated upon first publication—has been well established as part of the U.S. copyright system. *See id.* (“It is of course true that the publication of a copyrightable ‘work’ puts that ‘work’ into the public domain except so far as it may be protected by copyright. That has been unquestioned law since 1774.” (footnotes and citations omitted)).

118. *Id.* at 1308–09.

119. The system would change dramatically under the 1976 Copyright Act.

120. *Letter Edged in Black*, 320 F. Supp. at 1309–10.

121. *Id.* at 1310.

122. *Id.* at 1309–10.

123. *Id.* at 1310.

work that Picasso deeded.

In the process of constructing the larger structure, a number of events took place related to the smaller model, including two press showings that occurred “when the maquette was placed on public exhibition at the [Chicago] Art Institute.”¹²⁴ The court had to assess whether these and other events surrounding the maquette constituted publication, and if so, whether then the maquette had proper notice, as required by the 1909 Act.

First, did the display of the maquette constitute publication? Under the 1909 Act, publication was the trigger for federal protection, which, to obtain protection, required proper notice.¹²⁵ If a work had complied with proper notice requirements for the particular category of work, the work was then protected for twenty-eight years from publication.¹²⁶ But if the proper formalities had not been followed, the work came into the public domain immediately.¹²⁷ Many works came into the public domain under this system. For example, menus, postcards, and posters often did not carry the required copyright notice but were distributed to the public. Distribution counted as publication.¹²⁸

Under the 1909 Act, one can quickly see that the penalties for improper notice were harsh: loss of the copyright in the work to the public domain.¹²⁹ The courts, even before the 1909 Act, began developing a distinction between a general publication, requiring proper notice, and limited publication, where lack of notice did not inject the work into the public domain.¹³⁰ A general publication occurred when even a single copy was offered for sale to the public.¹³¹ While not incorporated into the 1909 Act, *American Tobacco Company v. Werckmeister's* distinction between general and limited publication continued throughout the

124. *Id.* at 1306. Describing the activities surrounding the Picasso maquette, the court wrote:

Press photographers attended the showing at the invitation of the Commission and the Art Institute and later published pictures of the maquette and aluminum model in Chicago newspapers and in magazines of national and international circulation. In addition the Commission supplied photographs of the maquette and the uncopyrighted architect's aluminum model to members of the public who requested them for publication. . . . [Photographs of the maquette also] appeared in Business Week Magazine on May 6, 1967, and in Holiday Magazine in March, 1967. Fortune Magazine published three pages of color photographs about the Chicago Picasso including pictures of the U.S. Steel wooden model. The Chicago Sun Times, Midwest magazine published a cover story on the sculpture with a drawing of the maquette on the cover of the magazine. And a picture of the maquette was printed in U.S. Steel News, a house organization with a circulation of over 300,000. None of the photographs or drawings that were published in the above named publications bore any copyright notice whatever.

Id.

125. Copyright Act of 1909, ch. 320, § 9, 35 Stat. 1075 (repealed).

126. *Id.* § 23.

127. 2 NIMMER & NIMMER, *supra* note 19, § 7.14[A][1].

128. 17 U.S.C. § 101 (2006); *see also* 1 NIMMER & Nimmer, *supra* note 19, § 4.04.

129. 2 NIMMER & NIMMER, *supra* note 19, § 7.14[A][1].

130. *See generally*, Thomas F. Cotter, *Toward a Functional Definition of Publication in Copyright*, 92 MINN. L. REV. 1724 (2008); Elizabeth Townsend Gard, *Unpublished Work and the Public Domain: The Opening of a New Frontier*, 54 J. COPYRIGHT SOC'Y U.S.A. 439 (2007).

131. Melville B. Nimmer, *Implications of the Prospective Revisions of the Berne Convention and the United States Copyright Law*, 19 STAN. L. REV. 499, 516 (1967).

twentieth century.¹³² The distinctions were important. Under the 1909 Act, judges routinely had distinguished between general and limited publication to mitigate against the harsh penalties of improper notice and other formalities required to achieve federal copyright protection. Judge Napoli, using the definition from *White v. Kimmell*, explained “wherein the court found that a limited publication is a publication ‘which communicates the contents of a manuscript to a definitely selected group and for a limited purpose, without the right of diffusion, reproduction, distribution or sale.’”¹³³ The *American Tobacco Company* case was an example of limited publication, where a painting displayed in a gallery prohibited copies by posting official guards.¹³⁴ Another version of limited publication occurs when a work has been given to a select group with limited distribution and a limited purpose.¹³⁵ For example, having colleagues review a manuscript with the specific limitation of no further distribution would have constituted limited publication under the 1909 Copyright Act.

In *Letter Edged in Black*, Judge Napoli determined the display of the Chicago Picasso maquette at the Art Institute was not a “limited” publication protected under state common law, but rather a general publication, requiring proper notice to receive federal protection. Unlike *American Tobacco Company*, where no photographs or copies were permitted of a painting without copyright notice, here, the court noted, no restrictions were placed on the maquette, and in fact, “every citizen was free to copy the maquette for his own pleasure,” and the press was free to photograph and publish the maquette.¹³⁶ Officials even made uncopyrighted photographs available upon request.¹³⁷ “Were this activity classified as limited publication, there would no longer be any meaningful distinction between limited and general publication. The activity in question does not comport with any definition of limited publication. Rather, the display of the maquette constituted general publication.”¹³⁸

Because the court found a general publication, the second question the court turned to was whether the maquette had proper notice during these activities.¹³⁹ The 1909 Copyright Act had strict requirements for proper copyright notice.¹⁴⁰ If a

132. Cotter, *supra* note 130; see *Am. Tobacco Co. v. Werckmeister*, 207 U.S. 284, 300 (1907).

133. *Letter Edged in Black Press, Inc. v. Pub. Bldg. Comm'n*, 320 F. Supp. 1303, 1309 (N.D. Ill. 1970) (citing *White v. Kimmell*, 193 F.2d 744, 746–47 (9th Cir. 1952)); see also *Scherr v. Universal Match Corp.*, 297 F. Supp. 107 (S.D.N.Y. 1967). The court held that a statue displayed at a public park (at which photography and the like were common) was divested to the public even though it was adorned with a notification of copyright. *Id.* at 111–12. The plaintiff artists, having placed the copyright notice twenty-two feet off the ground, admitted that their intent was to “make the notice as inconspicuous as possible.” *Id.* In doing so, the artists had failed to adequately put the viewing public on notice and had not created any notice that the work was not to be copied or photographed. *Id.*

134. *Am. Tobacco Co.*, 207 U.S. at 300.

135. *White*, 193 F.2d at 746–47; Melville B. Nimmer, *Copyright Publication*, 56 COLUM. L. REV. 185, 200 (1956); see also *Werckmeister v. Am. Lithographic Co.*, 134 Fed. 321 (2d Cir. 1904).

136. *Letter Edged in Black*, 320 F. Supp. at 1311.

137. *Id.* at 1306.

138. *Id.* at 1311.

139. *Id.* at 1309.

140. Copyright Act of 1909, ch. 320, § 9, 18, 35 Stat. 1075, 1077, 1079 (repealed).

work did not meet the requirements—and the requirements were different for each category of work under the 1909 Act (books, art work and maps all carried different requirements, for example)—then the work came into the public domain immediately and automatically upon that first publication without notice.¹⁴¹ Only the 1976 Copyright Act gave the copyright holder an opportunity to amend and affix proper copyright notice—that is, until 1989, when the BCIA removed the notice requirement.¹⁴²

For works of art, notice was required in the form minimally of “Copyright. . .Copr. . .[or] ©” and identifying markings of the copyright proprietor (initials, name, etc.).¹⁴³ No date was required, as with other categories.¹⁴⁴ However, the placement of the notice was important: “on some accessible portion of such copies or of the margin, back, permanent base, or pedestal, or of the substance on which such copies shall be mounted, his name shall appear.”¹⁴⁵ The problem with the maquette was that the notice was not placed on the small model or near the model (on the base or pedestal), but on the wall of the museum.¹⁴⁶ The court concluded, “No copyright notice was affixed to the maquette.”¹⁴⁷ The court found that the posting did not meet the strict requirements of the 1909 Copyright Act.¹⁴⁸ The maquette, therefore, had entered the public domain upon publication.¹⁴⁹ If the maquette had entered the public domain, so too had the larger copy.¹⁵⁰

In January 1968, the Commission registered and later received a copyright certificate for the larger statue with the Copyright Office.¹⁵¹ The Commission asserted that it attached proper copyright notice to the statue on August 4, 1967—eleven days before the official dedication of the fifty-foot statue.¹⁵² But the court wrote:

This attempt to establish a statutory copyright must fail, however, if the Chicago Picasso was in the public domain prior to August 4, 1967. Such a conclusion is inescapable given the statutory admonition of 17 U.S.C. § 8 that “[no] copyright shall subsist in the original text of any work which is in the public domain.”¹⁵³

The court determined:

141. 2 NIMMER & DAVID NIMMER, *supra* note 19, § 7.14[A][1].

142. See Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853 (codified as amended in scattered sections of 17 U.S.C.). See generally Christopher Sprigman, *Reform(aliz)ing Copyright*, 57 STAN. L. REV. 485 (2004).

143. Copyright Act of 1909, ch. 320, § 18, 35 Stat. 1075, 1079 (repealed 1989).

144. *Id.*

145. *Id.*

146. *Letter Edged in Black Press, Inc. v. Pub. Bldg. Comm'n*, 320 F. Supp. 1303, 1306 (N.D. Ill. 1970).

147. *Id.*

148. *Id.* at 1309.

149. *Id.*

150. *Id.* at 1310.

151. *Id.* at 1307.

152. *Id.*

153. *Id.* at 1307–08.

[W]hen the maquette was published without statutory notice Picasso's work was forever lost to the public domain. When the monumental sculpture was finally completed it could not be copyrighted for it was a mere copy, albeit on a grand scale, of the maquette, a work already in the public domain.¹⁵⁴

Then, on January 1, 1996, those foreign works that were eligible under § 104A were automatically restored.¹⁵⁵ The question, of course, was did the Chicago Picasso qualify? This Article will further explore what qualified for restoration. But before turning to the mechanics of § 104A, many questions come to mind—if the work is restored, who now owns this newly restored copyright? The heirs of Picasso? The Art Institute? What happens to all of those works that have incorporated the Chicago Picasso because the statue was in the public domain and free for all to use for thirty years? And, what would Judge Napoli think about the fact that suddenly, “copyright *shall* subsist in the original text of any work which is in the public domain”—an idea unfathomable to him only thirty years previously.¹⁵⁶ This Article attempts to understand this monumental shift. We will return to the Chicago Picasso shortly.

B. LACK OF TREATY RELATIONS

The *Golan* case also concerned works that had not been protected because no treaties existed between the United States and the source country.¹⁵⁷ Russian paintings and classical music, for instance, had been in the public domain in the United States from their inception because the United States did not have treaty relations with Russia until May 27, 1973, when the Soviet Union joined the Universal Copyright Convention.¹⁵⁸ Russian works in the public domain in the United States included literature by Alexander Block, Sergei Yesenin, Marina Tsvetaeva, Vladmiir Mayakovsky, Maxim Gorky, Vladimir Nabokov, Mikhail Sholokhov, Mikhail Bugaboo and Alexander Solzhenitsyn; and music by Sergei Prokofiev, Dmitri Shostakovich and Isa Dunayevsky.¹⁵⁹ Section 104A automatically restored all of these works, as long as they met the other requirements.¹⁶⁰

Businesses were affected, especially those dependent on foreign composers.¹⁶¹ For example, the initial complaint in *Golan* explains that *Golan* is an orchestra

154. *Id.* at 1310.

155. 17 U.S.C. §104A (2006).

156. *Letter Edged in Black*, 320 F. Supp. at 1308 (emphasis added).

157. *See generally* 17 U.S.C. §104A(h)(6)(iii) (defining restored works as those in the public domain due to lack of national eligibility).

158. *See* U.S. COPYRIGHT OFFICE, INTERNATIONAL COPYRIGHT REGULATIONS OF THE UNITED STATES, CIRCULAR 38A, at 9 (2010), available at <http://www.copyright.gov/circs/circ38a.pdf>.

159. *See List of Russian Composers*, WIKIPEDIA, http://en.wikipedia.org/wiki/List_of_Russian_composers (last visited Dec. 1, 2010); *see also Russian Literature*, WIKIPEDIA, http://en.wikipedia.org/wiki/Russian_literature (last visited Dec. 1, 2010) (listing notable Russian authors).

160. *See* 17 U.S.C. § 104A.

161. Complaint, *supra* note 102.

conductor, who had previously used foreign composers—generally Russian composers—whose works had fallen into the public domain.¹⁶² All works by Russian composers before 1973 were in the public domain until January 1, 1996, when they were automatically restored.¹⁶³ Now, the costs to use the same works were prohibitive because of the limited budget of the orchestras he conducted. The Lamont Symphony Orchestra and the Atlantic Chamber of Commerce, for example, “have a limited annual budget of \$2000 and \$300 respectively. For the Portland Ballet Orchestra, which has no funds at all for the renting of copyrighted music, Golan had to rely exclusively on public domain works.”¹⁶⁴

C. THE STRANGE CASE OF SOUND RECORDINGS

A third category affected by restoration is sound recordings. Sound recordings were not protected under federal copyright law in the United States until 1972.¹⁶⁵ Before 1972, sound recordings were protected by state common law as unpublished works.¹⁶⁶ A short window exists where sound recordings required proper notice to be considered published, and therefore, works without proper notice between 1972 and 1989 may have fallen into the public domain.¹⁶⁷ But what is strange about § 104A is that sound recordings, even though not protected by federal protection before 1972, remain under state copyright. They would not qualify for § 104A, if one included state protection.¹⁶⁸ One must read the public domain as a federally created space. Section 104A appears to restore federal copyrights, while ignoring state common law copyrights. Only works in the public domain may be restored. Foreign works created before 1972 remain under state common law.¹⁶⁹

The addition of this category is particularly peculiar and suspicious. A good deal of the legislative hearings discussed the need to protect U.S. works abroad, particularly sound recordings. In fact, the first TRIPs case the United States would submit to the WTO for dispute resolution would be against Japan for *sound recordings*.¹⁷⁰

Foreign sound recordings had not been protected in Japan until October 14,

162. See *id.* at 24.

163. See Janice T. Pilch, *U.S. Copyright Relations with Central, East European, and Eurasian Nations in Historical Perspective*, 65 *SLAVIC REV.* 325, 339 (2006).

164. Complaint, *supra* note 102, at 22.

165. See 1 *NIMMER & NIMMER*, *supra* note 19, § 2.10.

166. *Id.*

167. See Peter Hirtle, *Copyright Term and the Public Domain in the United States*, CORNELL U. COPYRIGHT INFO. CENTER, <http://www.copyright.cornell.edu/resources/publicdomain.cfm> (last visited Nov. 10, 2010).

168. See 3 *NIMMER & NIMMER*, *supra* note 19, § 9A.04[A][1][b][iii].

169. See *Capitol Records, Inc. v. Naxos of America, Inc.*, 830 N.E.2d 250, 263 (N.Y. 2005). We have uncovered some instances where sound recordings may have come into the public domain in individual states, but as *Naxos* indicates, New York State holds pre-1972 sound recordings as protected under state copyright, regardless of their status abroad. See *id.* at 265.

170. See *Dispute Settlement: Dispute DS28*, WTO, http://www.wto.org/english/tratop_e/dispu_e/cases_e/ds28_e.htm (last visited Dec. 1, 2010) (summarizing dispute).

1978, when Japan joined the Geneva Convention for the Protection of Phonograms.¹⁷¹ In 1989, Japan also joined the 1961 Rome Convention for the protection of performers.¹⁷² In both cases, neither provided for retroactive application.¹⁷³ Domestic sound recordings had been protected by varying degrees since 1899, however.¹⁷⁴ And so, in Japan, a gap had developed, whereby cheap unauthorized versions of pre-1971 foreign sound recordings were sold.¹⁷⁵ Note, however, the underlying musical compositions might have been protected; as of 1956, Japan had joined the Universal Copyright Convention, which included musical compositions.¹⁷⁶ At about the same time that the United States was implementing the URAA, Japan was also facing the question of retroactivity and their obligations under TRIPs. Japan restored sound recordings for those first fixed after January 1, 1971.

In the U.S.-Japan dispute, the United States argued that sound recordings had to carry retroactively the minimum fifty years of protection, as required by Article 14.6 of TRIPs.¹⁷⁷ At issue were U.S. recordings created between 1946 and 1971.¹⁷⁸ The U.S. Trade Representative, Charlene Barshefsky, explained:

We launched this case on a clear principle to protect intellectual property rights. . . . We sought—and will now obtain—protection for U.S. sound recordings from one of the most vibrant and popular periods in the history of American music—from the swing music of Duke Ellington, the bebop jazz of John Coltrane, the rock and roll of Elvis Presley, Chuck Berry, Little Richard, Johnny Cash, Patsy Cline and the Sixties sounds of Bob Dylan, the Beach Boys and Otis Redding. The remarkable range and stature of the music produced in that quarter-century makes it an important part of our heritage.¹⁷⁹

Language like this may be suspicious. At least one commentator has seen the case as merely the RIAA's attempt at further power and world domination.¹⁸⁰ In 1997, the United States and Japan reached an agreement, whereby Japan agreed to amendments to the Japanese Copyright Law on December 26, 1996.¹⁸¹ "The result, however, may have been only more dissonance—now, both the U.S. and Japan provide more protection for foreign recordings than they do their own."¹⁸² So, are we to see § 104A as a moral imperative—a precursor to putting pressure on

171. *Japan Resolution of WTO Dispute on Sound Recordings*, TRADE COMPLIANCE CENTER (Jan. 24, 1997), http://tcc.export.gov/Trade_Agreements/All_Trade_Agreements/exp_005579.asp.

172. See Teruo Doi, *Japan*, in 2 INTERNATIONAL COPYRIGHT LAW AND PRACTICE, at JAP § 1[2] (Paul Edward Geller & Melville B. Nimmer eds., 2010).

173. See *id.*

174. See generally Steven Obenski, Note, *Retroactive Protection and Shame Diplomacy in the US-Japan Sound Recordings Dispute, or, How Japan Got Berne-d*, 4 MINN. INTELL. PROP. REV., 183, 188–89 (2002).

175. *Id.*

176. See Doi, *supra* note 172, at JAP §6[2].

177. See Obenski, *supra* note 174, at 184–86.

178. *Japan Resolution of WTO Dispute on Sound Recordings*, *supra* note 171.

179. *Id.*

180. See Obenski, *supra* note 174, at 186.

181. *Japan Resolution of WTO Dispute on Sound Recordings*, *supra* note 171.

182. Obenski, *supra* note 174, at 186.

others to raise the standard of foreign copyrights?

Japan is only one example.¹⁸³ Interestingly, however, Japan is the example used in the amicus brief filed by the American Society of Composers, Authors and Publishers; the American Society of Media Photographers; the Association of American Publishers; Broadcast Music, Inc.; Houghton Mifflin Harcourt Publishing Co.; the Music Publishers Association of America; the Software and Information Industry Association; the Recording Industry Association of America and Reed Elsevier in support of reversal of the remanded district court decision.¹⁸⁴ They write:

To take one example, at the time GATT enforcement mechanisms became available, sound recording of American music fixed before 1971—Elvis Presley, Bob Dylan and Duke Ellington recordings, for example—could be and were widely sold in Japan with legal impunity. Because the United States had enacted section 514 [§ 104A], it was able to threaten to seek trade sanctions against Japan.¹⁸⁵

One wonders if the sound recording battle with Japan was the main purpose for the structure of § 104A, which, if so, would be tragic, indeed. Sound recordings make up such a small percentage of restored works. It seems like a more limited solution would have been possible—one that would have sent the message that U.S. mid-century works should be granted protection in Japan without destroying the basic assumptions of our domestic copyright system.

183. Taiwan is another. In discussing the restoration of foreign copyrights in Taiwan, Andy Y. Sun writes:

One of the most controversial issues in the United States-Taiwan Intellectual Property negotiations was the restoration of copyrights. Prior to the 1992 Copyright Amendment, the term of copyright protection was thirty years from the date of registration; and, prior to the Copyright Revision of July 10, 1985, the term was only 10 years from registration. Thus, for those foreign copyrightable works that were not protected in Taiwan before April 26, 1992 for lack of registration or reciprocal arrangement, their status of protection in Taiwan became a major issue. The 1992 Copyright Amendment retroactively extended, [sic] twenty years, protection to all foreign works published on or after July 10, 1965 whose copyright would have been still valid under the old statute under Article 108. In other words, all the works completed or published whichever comes first on or after 1965 are now subject to the provisions of the 1992 Copyright Amendment.

While the term of protection is now the life of the author plus fifty years, the United States pressed Taiwan, as a precondition to the latter's accession to the WTO, to further extend its retroactive protection to foreign works dating from fifty years before Taiwan's formal accession date to the WTO. After a series of negotiations, Taiwan finally obliged. This is apparently due to Taiwan's fear of a serious disruption to its domestic copyright registry and financial loss to its indigenous industry.

Andy Y. Sun, *From Pirate King to Jungle King: Transformation of Taiwan's Intellectual Property Protection*, 9 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 67, 111–12 (1998).

184. Brief of the American Society of Composers et al. in Support of Reversal at 22, *Golan v. Ashcroft*, 609 F.3d 1076 (10th Cir. 2010) (Nos. 09–1234 & 09–1261), 2009 WL 3760477 (citations omitted).

185. *Id.*

IV. THE MECHANICS OF § 104A

A. THE BASIC ELEMENTS OF § 104A

Not all foreign works required restoration. Many had properly registered and had renewed their term through the U.S. Copyright Office in the twenty-eighth year, and so the copyright had been continuous since the year of publication. Take, for example, the British writer, Vera Brittain. Of the forty works she wrote during her lifetime, she properly registered and renewed at least nine.¹⁸⁶ These works carry a continuous term of ninety-five years from publication, and did not require a § 104A analysis. But what of her other works? These became eligible for restoration under § 104A. Using Vera Brittain's *Testament of Youth*, let's walk through the requirements necessary to be a restored work.

Testament of Youth, published in 1933, was Brittain's most famous work.¹⁸⁷ First published in London, the work was also published in the United States, where it became a smash hit.¹⁸⁸ The work was properly registered, but not renewed, which means that *Testament of Youth* came into the public domain in the United States twenty-eight years after publication, or after 1961. Did it qualify for renewal nearly thirty years later?

The first requirement, of course, was that the work was in the public domain in the United States prior to January 1, 1996 due to one of the three scenarios discussed in Part III: failure to follow formalities in the United States, lack of subject matter protection for sound recordings or lack of treaty relations.¹⁸⁹ In addition, a work and its author also had to meet the following requirements:

1. Original Work of Authorship

First, the foreign work must be an original work of authorship. This is a

186. These recordings included: *Honourable Estate* (Macmillan), first published in 1936, renewed by Vera Brittain in 1964 and will come into the public domain in the United States after 2031; *Thrice a Stranger* (Macmillan), first published in 1938, renewed by Vera Brittain in 1966 and will come into the public domain in the United States after 2033; *England's Hour* (Macmillan), first published in 1941, renewed by Vera Brittain in 1968 and will come into the public domain in the United States after 2036; *Account Rendered* (Macmillan), first published in 1944, renewed by Brittain's husband in 1972 and will come into the public domain in the United States after 2039; *On Becoming a Writer* (Hutchinson), first published in 1947, renewed by Brittain's husband and children in 1975 and will come into the public domain in the United States after 2042; *On Being an Author* (Macmillan), first published in 1948, renewed by Brittain's husband and children in 1975 and will come into the public domain in the United States after 2043; *Born 1925* (Macmillan), first published in 1949, renewed by Brittain's husband and children in 1976 and will come into the public domain in the United States after 2044; *Testament of Experience* (Seaview Books 1981), first published in 1957, renewed by Shirley Williams in 1985 and will come into the public domain in the United States after 2052. *Copyright Renewal Database*, STANFORD U., <http://collections.stanford.edu/copyrightrenewals/bin/page?forward=home> (follow "Advanced Search" hyperlink; enter "Vera Brittain" in "Author" search field) (last visited Dec. 1, 2010).

187. VERA BRITTAIN, *TESTAMENT OF YOUTH: AN AUTOBIOGRAPHICAL STUDY OF THE YEARS 1900–1925* (Penguin Books 2004) (1933).

188. See generally VERA BRITTAIN, *TESTAMENT OF EXPERIENCE* (Macmillan 1957).

189. 17 U.S.C. § 104A (2006).

constitutional requirement for protection in the United States, and requires only a modicum of creativity.¹⁹⁰ Most works would meet this requirement, but some works in foreign countries would not meet the U.S. originality requirement, as the United States also mandates fixation.¹⁹¹ But for most works, this is not a difficult hurdle, as was the case for *Testament of Youth*. Moreover, registration of the work also served to create a prima facie presumption of a valid copyright, “and hence, of originality.”¹⁹² *Testament of Youth* was registered, and so it would also be presumed to have met the originality requirement.¹⁹³

2. Copyright in the Source Country Prior to January 1, 1996

Second, the work must not be in the public domain in the source country through the “expiration of term of protection.”¹⁹⁴ *Testament of Youth* is protected in the United Kingdom for the term of life of the author plus seventy years.¹⁹⁵ Since Vera Brittain passed away in 1970, the work is protected through 2040.¹⁹⁶

One question the Fifth Circuit has taken up is whether this public domain status in the source country meant only that the work was in the public domain, in this case because the works had not met the formality requirements under the 1928 Mexican Civil Code, or rather if § 104A meant that a work must have had its term expire of potential copyright protection.¹⁹⁷ *Alameda Films v. Authors Rights Restoration Corp.* found it was the latter, but others have disagreed, instead believing that the “expiration of term of protection” means the term of copyright protection available, sans any mistakes by the copyright holder.¹⁹⁸

3. An Eligible Source Country

The source country must have joined one of the following: the WTO, Berne, WIPO Copyright Treaty, WIPO Performances and Phonogram Treaty or the

190. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).

191. 17 U.S.C. § 102. *But cf.* Code de la Propriété Intellectuelle art. L111-1-2 (Fr.) (English translation), available at http://195.83.177.9/upl/pdf/code_35.pdf (according enforceable property rights to the creator of any work of intellect upon realization of the creator's concept, regardless of any public disclosure).

192. Gable, *supra* note 89, at 191.

193. *Id.*

194. 17 U.S.C. § 104A(h)(6)(B).

195. Copyright, Designs and Patents Act, 1988, c. 48, § 12(2) (U.K.). It's actually slightly more complicated. First, one must determine if the work had been in existence prior to July 31, 1989, and if so, if it was still under copyright in the United Kingdom. In this case, it was still under its original term of life plus fifty years, as Vera Brittain died in 1970. The term was then extended to life plus seventy. See Lionel Bently & William R. Cornish, *United Kingdom*, in 2 INTERNATIONAL COPYRIGHT LAW AND PRACTICE, *supra* note 172, at UK § 1.

196. Copyright, Designs and Patents Act, 1988, c. 48, § 12(2) (U.K.). The term in the United States, however, runs from the year of first publication in the source country for ninety-five years, or until 2028 (1933 plus ninety-five years). Section 104 was not designed to create uniform terms—but again to satisfy the obligations required by Article 18 of the Berne Convention.

197. *Alameda Films v. Authors Rights Restoration Corp.*, 331 F.3d 472 (5th Cir. 2003).

198. See *id.* *But see* Gable, *supra* note 89, at 194.

Presidential proclamation.¹⁹⁹ This means that not all foreign works are eligible. Notably, countries without intellectual property treaties are not eligible for restoration, nor are countries that have only joined the Universal Copyright Convention.²⁰⁰ In the case of Brittain's *Testament of Youth*, the United Kingdom was a member of all of the treaties listed, and so her work was eligible for protection.²⁰¹

4. "Work must have gone into the public domain in the United States prior to January 1, 1996"

Section 104A requires the work to have been in the public domain, as discussed above, due to one of three scenarios: lack of formality, subject matter of sound recordings or lack of treaty relations.²⁰² The first part—that the work was in the public domain—represents an important marker. Unpublished foreign works are governed by § 303(a).²⁰³ Unpublished works from every country are protected in the United States, regardless of nationality; and sound recordings were protected as unpublished under the 1909 Copyright Act.²⁰⁴ Determining whether a work was considered published or unpublished (think the Chicago Picasso), therefore, becomes essential in determining its public domain status.

In the case of *Testament of Youth*, we know that the work was registered and not renewed, causing the work to come into the public domain after twenty-eight years of protection.²⁰⁵ This is a straightforward example, but that will not always be the case. Later in the Article, we will explore further the implications of the public

199. 17 U.S.C. § 104A(h)(1).

200. See 3 NIMMER & NIMMER, *supra* note 19, § 9A.04[A][2].

201. U.S. COPYRIGHT OFFICE, *supra* note 158.

202. 17 U.S.C. § 104A(h)(6)(C). A D.C. Circuit case, *Luck's Music Library v. Ashcroft*, reviewed the constitutionality of the statute's national eligibility category; the court upheld the statute. *Luck's Music Library v. Ashcroft*, 407 F.3d 1262 (2005).

203. 17 U.S.C. § 303(a).

204. Although unpublished, registered works would be covered under § 104A because registered, unpublished works were treated like published works. See Elizabeth Townsend Gard, *Unpublished Work and the Public Domain: The Opening of a New Frontier*, 54 J. COPYRIGHT SOC'Y U.S.A. 439 (2007).

205. In the case of Vera Brittain, we are focused on the first situation—noncompliance with formalities imposed at any time by U.S. copyright law. From the record, it looks like she was unaware that she needed to renew her work in the twenty-eighth year, as the first significant pieces—*Testament of Youth*, *Poems of the War and After* and *Testament of Friendship* were the first of her U.S. editions to need renewing, and all three were not renewed, falling into the public domain in the U.S. after their twenty-eighth year of copyright. After that, she and/or her family promptly renewed the works in the twenty-eighth year for those works that had been published in the United States. At least nine of Brittain's works had been renewed. Had Vera Brittain known about the renewal requirement, there is no doubt in my mind that she would have renewed *Testament of Youth*, as it was her seminal life's work and also brought great economic security to her and her family. The work was very popular in the United States, and again, was a source of income and fame. Section 104A was designed to restore works that suffered from just such a mistake in formalities, and to allow the author to reap the benefit of the copyright for the term as if it had not fallen into the public domain. The copyright page on the Penguin classic version of *Testament of Youth* seems to confirm this as well. See BRITAIN, *supra* note 187.

domain requirement and, in particular, case law that makes the status of foreign publication murky at best.

5. National or a Domiciliary of the Source Country

At least one of the authors of the work must be a national or a domiciliary of the source country at the time it was created or first published.²⁰⁶ Vera Brittain was a citizen of the United Kingdom and resided in London during this particular period in the 1930s (and for most of her life).²⁰⁷

6. First Published in a Source Country Other than the United States

The first publication must have taken place in a country other than the United States. *Testament of Youth* was first published in the United Kingdom in August 1933, and then later published in the United States around October 10, 1933.²⁰⁸ Therefore, *Testament of Youth* would qualify under its U.K. publication.

The question of publication, however, is not always that clear. Take for example, again, the Chicago Picasso. Did first publication take place in France or in the United States? Judge Napoli came to the conclusion that the maquette had remained unpublished when Picasso transferred the work to the Art Institute.²⁰⁹ Using this scenario, the Art Institute then created a general publication without notice.²¹⁰ If this is the case, then a U.S. organization, rather than the foreign author, was responsible for the lack of notice, and therefore, the Chicago Picasso, under § 104A, would not be restored.

But what if Judge Napoli was wrong? What if the mere gift of the maquette from Picasso to the Art Institute created a general publication of the work? Some courts have held that a mere sale of a work constituted a general publication.²¹¹ According to Nimmer, “Thus even the private sale of a work of art will be a publication if there is no prohibition on the purchaser making further copies of the work.”²¹² Under this scenario, the work would have been published in France, and therefore, would be eligible for restoration by § 104A.

206. 17 U.S.C. § 104A(h)(6)(D).

207. See generally PAUL BERRY & MARK BOSTRIDGE, *VERA BRITAIN: A LIFE* 262 (2002).

208. *Id.* (reporting U.K. publication date as Aug. 28, 1933). As for the U.S. publication date, I found in the edited collection of her diaries from the 1930s an entry on October 10, 1933: “T of Y. pub. in the U.S.A.; cable from Latham saying 11,000 already sold.” VERA BRITAIN, *CHRONICLE OF FRIENDSHIP: DIARY OF THE THIRTIES, 1932–1939*, 158 (Alan Bishop ed., 1986); see also VERA BRITAIN, *TESTAMENT OF YOUTH: AN AUTOBIOGRAPHICAL STUDY OF THE YEARS 1900–1925* (The Macmillan Co. 1934) (1933) (first U.S. publication with 1933 copyright notice).

209. *Letter Edged in Black Press, Inc., v. Pub. Bldg. Comm’n*, 320 F. Supp. 1303 (N.D. Ill. 1970).

210. *Id.* at 1311.

211. See 1 NIMMER & NIMMER, *supra* note 19, § 4.09.

212. *Id.* (citing *Peter Pan Fabrics, Inc. v. Dan River Mills, Inc.*, 295 F. Supp. 1366 (S.D.N.Y. 1969), *aff’d*, 415 F.2d 1007 (2d Cir. 1969); *Grandma Moses Props., Inc. v. This Week Magazine*, 117 F. Supp. 348 (S.D.N.Y. 1953); *Pushman v. New York Graphic Soc’y.*, 25 N.Y.S.2d 32 (Sup. Ct. 1941), *aff’d on other grounds*, 287 N.Y. 302 (1942)).

7. Limitation of Simultaneous Publication

When the work was published, it must not have been published in the United States during the thirty-day period following publication in such eligible country, what is commonly referred to as “simultaneous publication.”²¹³ “Simultaneous publication” had previously been used as a back-door method of gaining the protection of Berne in a non-Berne member country, particularly useful for Americans, as the United States did not join Berne until 1988.²¹⁴ So, if in 1980, an American author published a work simultaneously in the United States and Canada, that American author’s work obtained Berne protection, because Canada was a member of Berne, even though the United States was not a party to Berne.²¹⁵ Now, simultaneous publication under § 104A is being used as a limitation on copyright restoration. Since “back door” Berne was used mostly by U.S. authors, this limitation means that § 104A does not apply to U.S. works. But, we might see instances where the U.S. and foreign publication (for reasons other than “back door” Berne protection) may have occurred within thirty days of each other.²¹⁶ In that case, the foreign work’s copyright would not be restored.²¹⁷

The question, then, was whether the British and American versions of Vera Brittain’s *Testament of Youth* had been published within thirty days of one another. If this were the case, then the copyright for *Testament of Youth* would not be restored under § 104A.

One way to determine whether simultaneous publication had occurred was to look at the biographical record. The authorized biography of Brittain reports that the U.K. version was published on August 28, 1933.²¹⁸ So, the question was whether the U.S. version was published before September 25, 1933. Brittain’s diary recorded on October 10, 1933: “T of Y. pub. in the U.S.A.; cable from

213. See 17 U.S.C. § 104A(h)(6)(D) (2006).

214. Barbara Ringer, writing in 1968, explained:

It did not take American copyright owners long to discover an attractive loophole that has come to be known as the “backdoor to Berne.” By the simple device of simultaneous publication of an American work in the United States and in a country which was a Berne Union member, such as Canada, a work became entitled to protection throughout the Berne Union without any corresponding obligations on the United States to protect Berne works.

Ringer, *supra* note 32, at 1059.

215. 3 JAY DRATLER, JR. & STEPHEN M. MCJOHN, *INTELLECTUAL PROPERTY LAW: COMMERCIAL, CREATIVE, AND INDUSTRIAL PROPERTY*, § 6.04[3] n.137 (2010).

216. “A work shall be considered as having been published simultaneously in several countries if it has been published in two or more countries within thirty days of its first publication.” Berne, *supra* note 21, art 3(4). While there have been a number of law review articles that have focused on § 104A, strangely many have not taken up an analysis of “simultaneous” publication.” See generally Gable, *supra* note 89. *Dam Things from Denmark v. Russ Berrie & Co.* is the first case to look at the “first publication” requirement under § 104A, but it did not look at the issue of “simultaneous publication.” *Dam Things from Denmark v. Russ Berrie & Co.*, 173 F. Supp. 2d 277 (D.N.J. 2001), *vacated*, 290 F.3d 548 (3d Cir. 2002).

217. In working through Vera Brittain and *Testament of Youth*, I found that I could not actually determine the exact date of publication for the U.S. work.

218. BERRY & BOSTRIDGE, *supra* note 207, at 262.

Latham saying 11,000 already sold.”²¹⁹ Was this the actual date of publication?

Another way to look for the answer is in the copyright records themselves. The *Catalog of Copyright Entries* is the published version of the registration and renewal records.²²⁰ The first registration record (for the Gollancz edition) reads as follows: “© 1c. Sept. 13, 1933; A ad int. 18172; pubd. Aug. 28; Vera Brittain, London. (33-30135).”²²¹ The entry indicates that the work was published on August 28, and the term “ad int.” indicates that the work was published in English abroad. The work received ad interim protection of the British version as of September 13, 1933. Ad interim protection differed from simultaneous publication. Ad interim copyright was a limited exemption for English language books first published abroad from the tough manufacturing clause in the United States under the 1909 Act that required all works to be printed and bound in the United States.²²² So, according to the first entry, Vera Brittain obtained ad interim copyright protection by depositing the required copy with the Copyright Office. From the record, again we learn that the original publication date in London was August 28.

The second record for *Testament of Youth* occurs on October 10, 1933: “© Oct. 10, 1933; 2 c. Oct 11 : aff. Oct. 18 ; A 65790; V. Brittain, London. (33-30698).”²²³ The first version was published on August 28 in London, and the second (U.S.) version was published on October 10. We see from the record that the work was registered in Category A, for books, with two copies, confirming that it was a full registration, and not ad interim.²²⁴ Brittain is listed again as the copyright holder, with residence in London.²²⁵ In this case, the U.K. and the U.S. versions were published forty-two days apart, and therefore, *Testament of Youth* was not simultaneously published. Therefore, the work meets this final qualification for restoration.

Brittain had two additional works that were registered but not renewed in the United States: *Testament of Friendship* (1940) and *Poems of the War and After* (1934). *Poems of the War and After* did not qualify for simultaneous publication. The London version of *Poems of the War and After* was published in April 1934, and the New York version was published in September of the same year. And in many ways, this makes sense. Simultaneous publication benefited authors of non-Berne countries by allowing them to gain Berne protection. There would have been no incentive for Vera Brittain, a member of a Berne country, to take advantage of this law.

Testament of Friendship presented a different scenario. It appears there was only a U.S. version registered, and not an ad interim copy. The *Catalog of*

219. BRITAIN, *supra* note 208, at 158.

220. According to William Patry, these records began as an attempt to create a list for Customs to keep out infringing works. 1 Patry, *supra* note 71, § 1:38.

221. Library of Cong. Copyright Office, 30 CATALOGUE OF COPYRIGHT ENTRIES, n.s., pt. 1, Books, Group 1, no. 141, at 1450 (1933)

222. 7 PATRY, *supra* note 72, § 23:72.

223. Library of Cong. Copyright Office, *supra* note 221, at 1859.

224. *Id.*

225. *Id.*

Copyright Entries record reads: “© Jan 2, 1940 2 c. and aff. Jan 3.”²²⁶ All three Brittain examples—*Testament of Youth*, *Testament of Friendship* and *Poems of the War and After*—met all of the U.S. formalities at the time of publication and were properly registered with the U.S. Copyright Office, but none of them were properly renewed. So, each of the works fell into the public domain at the end of their twenty-eight year term. Having met the requirements, their copyrights were then restored under § 104A in 1996, and each will now be under copyright for ninety-five years from publication.

8. Term of Protection

If a work met all of the § 104A requirements, then the work was restored under U.S. law, with the term ending ninety-five years from publication.²²⁷ What is strange about the term, however, is that it violates the requirements of the Berne Convention. Berne requires that a copyright term protect works based on the life of the author and for a minimum of fifty years (except for photographs, sound recordings and a few other specific categories).²²⁸ Section 104A still bases the term of protection on the publication date of the work, rather than the author.²²⁹

So, even with the restoration of foreign works, the United States is still in violation of Article 18.²³⁰ For example, under Berne’s minimum standards, Henri Matisse’s works should be protected for at least fifty years from his death, or until 2004 (1954 plus fifty years), and with the term extension in the United States, until 2024. Instead, under § 104A, only Matisse’s works published after 1923 receive retroactive protection. For example, Matisse’s *Women Reading* (1894) and *A Glimpse of Notre-Dame in the Late Afternoon* (1902) are both in the public domain in the United States, but with proper implementation of Article 18, would have been restored and protected in the United States until 2024. None of the *Golan* decisions have addressed this issue.

B. THE FOUR PHASES OF U.S. COPYRIGHT LAW DURING THE TWENTIETH CENTURY

What works got restored? Millions of works met the requirements above and were automatically restored—Nazi propaganda posters, foreign stamps, menus and theatre programs, classic films like *Metropolis* (1927, Germany), twentieth-century Russian art and music, to name just a few examples. The years affected by foreign restoration are works published abroad between 1923 and 1989.²³¹ Within that

226. Library of Cong. Copyright Office, 37 CATALOG OF COPYRIGHT ENTRIES, n. s., pt. 1, group 1, Books, no.1, at 4 (1940).

227. 17 U.S.C. § 304 (2006).

228. Berne, *supra* note 21, art. 7.

229. 17 U.S.C. § 104A.

230. See generally Irwin Karp, *Final Report, Berne Article 18 Study on Retroactive United States Copyright Protection for Berne and Other Works*, 20 COLUM.-VLA J.L. & ARTS 157 (1996).

231. Foreign unpublished works are not eligible and are covered by 17 U.S.C. §§ 104(a), 302, 303(a) (2006).

period, U.S. copyright law was altered significantly four times with regard to foreign works. This section traces these changes, again using Brittain's work as examples.

1. Works Before 1923 and the CTEA

Vera Brittain had only one work that was published before 1923, a slim volume of poems, *Verses of a V.A.D.* (1918). The work was published only in the United Kingdom—her father supplied the paper. Under the U.S. copyright law, and under § 104A, works published before 1923 are ineligible for protection because the maximum term for works would have expired before restoration.²³² In this case, the CTEA, enacted in 1998, plays no role in works published before 1923.²³³

Before the CTEA, works would have carried a term of seventy-five years from the date of publication (as of the enactment of the 1976 Copyright Act).²³⁴ A work published in 1922 would have had a term of protection through 1997.²³⁵ In 1998, the CTEA extended the term of protection for twenty years, but only to works still under copyright.²³⁶ Any work published or registered before 1923 had come into the public domain and therefore was ineligible for protection. Thus, Vera Brittain's small book of poetry would be in the public domain in the United States, or at least that is the simple answer for now.²³⁷

2. 1923–55: The Remaining Works from the Era of Bilateral Treaties

Until March 3, 1891, foreign works received no protection under U.S. law.²³⁸ Only with the passage of the International Copyright Act (often referred to as the Chase Act) were foreign works eligible for national treatment, and only then by presidential proclamation or by a bilateral treaty.²³⁹ The United Kingdom had such a proclamation.²⁴⁰ On July 1, 1891, President Benjamin Harrison extended copyright benefits to the citizens of Belgium, France, Great Britain and Switzerland by Presidential Proclamation, since each of these countries provided national treatment to citizens of the United States.²⁴¹ To qualify for protection in the United States, foreign works had to meet three requirements: 1) the President, by proclamation, determined that U.S. authors were provided copyright protection in the foreign author's country on "substantially the same basis" as the country extended protection to the works of its own citizens, or that the foreign nation was

232. 17 U.S.C. § 104A(a)(1)(B). See also 3 PATRY, *supra* note 72, § 7:41 n.3 (explaining that works protected in the United States and published before January 1, 1923 are in the public domain).

233. Copyright Term Extension Act of 1998, Pub. L. No. 105-298, 112 Stat. 2827 (codified at 17 U.S.C. §§ 302, 303, 304).

234. 3 NIMMER & NIMMER, *supra* note 19, § 9.01.

235. *Id.*

236. 17 U.S.C. §304.

237. The Article will analyze this result further in Part D-2.

238. PAUL GOLDSTEIN, INTERNATIONAL COPYRIGHT: PRINCIPLES, LAW AND PRACTICE 18 (2001).

239. *Id.*

240. U.S. COPYRIGHT OFFICE, *supra* note 158, at 11 n.3.

241. Proclamation No. 3, 27 Stat. 981 (July 1, 1891).

a party to an international agreement that provided for reciprocity and to which the United States could adhere; 2) *the foreign author complied with all formalities applicable to works of U.S. authors* (e.g., notice and deposit); and 3) foreign authors of books (in *all* languages) and creators of photographs, chromos and lithographs had their works either *printed from type set “within the limits of the United States”* or “from plates made there from, or from negatives, or drawings on stone made within the limits of the United States, or transfers made there from.”²⁴²

Most foreign works never met the U.S. notice or deposit requirements, nor did they reprint their works “within the limits of the United States”²⁴³ Ad interim protection, discussed above, was created to allow English language foreign works a period where the foreign works could be sold before the manufacturing requirement came into effect.²⁴⁴

Vera Brittain published two novels early in her career, *The Dark Tide* (1923) and *Not Without Honour* (1924). Both works were only published in the United Kingdom, and never in the United States. The works qualify under § 104A because they were published by a foreign national and they are still under copyright in the source country.

In terms of the term of protection, in the United Kingdom, the novels are protected seventy years after the death of the author, or through 2040.²⁴⁵ The works were never under copyright in the United States, however, having failed to meet any of the formality requirements for foreign works. Both of these early novels, therefore, were in the public domain in the United States from their publications in the 1920s until the “restoration” of their copyright on January 1, 1996. For over seventy years, the two novels were in the public domain in the United States. Now they finish out a ninety-five year copyright term that begins with their original date of publication, or until 2019 and 2020, respectively.

In addition to these two novels, Vera Brittain published eleven other works in the United Kingdom (and not in the United States) during the 1923–55 period. All of these were in the public domain in the United States from their time of publication in the United Kingdom, and have now had copyright “restored” as of 1996.²⁴⁶ Regarding the restoration of these works, I wonder to what benefit? Most of the works have never been made directly available to a U.S. audience—not during the period where the works had originally been published, the decades that they were in the public domain, or when they were restored. During this new phase

242. 1 PATRY, *supra* note 72, § 1:38 (first and third emphases added).

243. See generally Gable, *supra* note 89.

244. 1 HOWARD D. ABRAMS, *THE LAW OF COPYRIGHT* § 7:12 (2010).

245. Copyright, Designs and Patents Act, 1988, c. 48, § 12 (U.K.).

246. She also wrote or contributed to a number of other works that would have suffered the same fate: *Women’s Work in Modern England* (Douglas 1928); *Halcyon, or the Future of Monogamy* (K. Paul, Trench, Trubner & Co., Ltd. 1929); *War-Time Letters to Peace Lovers* (Peace Book Co. 1940); *Humiliation with Honour* (Fellowship Publ’n 1943) (1942); *One of these Little Ones . . .* (A. Dakers Ltd. 1944); *Above all Nations* (George Catlin, Vera Brittain & Sheila Hodges eds., V. Gollancz 1945); *The Story of St. Martin’s: An Epic of London* (Rev. L.M. Charles-Edwards 1951); and *Search after Sunrise* (Macmillan 1951). All were in the public domain upon publication and received copyright protection in the United States with § 104A.

of copyright, a paperback version of *The Dark Tide* was reissued by Virago in 1999 (in the United Kingdom where the copyright had always subsisted, but the work was/is distributed in the United States with regularity), in 2002 by Brown, Little in the United States (where the work was now under copyright again) and a complete and unabridged audio cassette version was recorded, also in the United Kingdom, in 2000. Under this theory, the work fared better under copyright, at least in terms of republication.

From what I could find, except for reissued copies of *The Dark Tide*, no incentive in the United States is being taken advantage of upon restoration. But the works are now (for the last ten years) restricted within the United States. Where before scholars and others were free to use the works as they wanted, now one must ask permission for the same uses. How does this encourage “Progress”? It is one of the places where § 104A went wrong.

3. The Arrival of the Universal Copyright Convention: 1955–64

For most of its two centuries, the United States has been a copyright island, its jurisprudence having evolved in isolation from developments elsewhere. As long as it served American interests, U.S. copyright law did not concern itself with the waves that our statutes or rulings would set in motion outside our borders, and few ripples from abroad affected U.S. copyrights. In 1955, however, the international tide began to lap against U.S. copyright shores.²⁴⁷

The Universal Copyright Convention (UCC) ushered in a significant change for foreign works.²⁴⁸ As long as a foreign work bore the “UCC notice” requirements, the work was protected in the United States for the initial copyright term of twenty-eight years.²⁴⁹ The UCC was an alternative multilateral treaty to Berne, allowing the United States to continue to require formalities for renewal and for its own nationals, and also allowing the United States to remain on its publication-based system, rather than a fixation system, as was required under Berne.²⁵⁰ The multilateral treaty was negotiated in 1952, and by 1954 Congress had ratified the treaty and passed the necessary implementing legislation.²⁵¹ On September 16, 1955, the UCC came into effect in the United States.²⁵²

247. David Nimmer, *Nation, Duration, Violation, Harmonization: An International Copyright Proposal for the United States*, 55 LAW & CONTEMP. PROBS. 211, 211 (Spring 1992).

248. UCC, *supra* note 77; *see also* 7 PATRY, *supra* note 72, § 23:11; Leonard D. DuBoff, *Out of UNESCO and into Berne: Has United States Participation in the Berne Convention for International Copyright Protection Become Essential?*, 4 CARDOZO ARTS & ENT. L.J. 203 (1985); Nimmer, *supra* note 131.

249. 3 PATRY, *supra* note 72, § 6:44. The treaty required national treatment of both published and unpublished work. 7 *Id.* § 23:11.

250. 7 PATRY, *supra* note 72, § 23:11. “As of January 1, 1989, some 26 countries are members of the UCC but are not Berne adherents. These include certain developing countries in Africa and several Latin American countries.” Marshall Leaffer, *International Copyright from an American Perspective*, 43 ARK. L. REV. 373, 376 n.7 (1990).

251. Nimmer, *supra* note 247, at 214–15 (“UCC status ultimately conveyed copyright relations with eighty countries . . .”).

252. *Id.* at 214 (citing Act of August 31, 1954, Pub. L. No. 743, 68 Stat. 1030).

The UCC notice requirement was simple: a work must contain the © symbol, the name of the copyright proprietor and the year of first publication “in such manner and location as to give reasonable notice of claim of copyright.”²⁵³ To meet the requirements under the UCC, a published work had to have been “(1) protected under the Convention; (2) first published outside the country imposing the formality; or (3) by an author who is not a national of that country”²⁵⁴ The UCC only applied to foreign works.²⁵⁵ The UCC also required national treatment for both published and unpublished works.²⁵⁶ One important element, however, would differ from § 104A and Article 18 of the Berne Convention.²⁵⁷ The UCC was not retroactive.²⁵⁸ Therefore, the new “UCC notice” requirements only applied once the source country had signed the treaty.²⁵⁹

Renewal of a work, however, still required an affirmative step with the U.S. Copyright Office.²⁶⁰ In a right of privacy case, *Hoepker v. Kruger*, a U.S. district court found that the photograph “Charlotte as Seen by Thomas” was considered published in Germany in 1960.²⁶¹ Since Germany and the United States were both signatories to the UCC, the photograph in the United States had an initial term of twenty-eight years from its publication in Germany, with the option of renewal in the twenty-eighth year.²⁶² “Because Hoepker failed to renew protection as required by then-applicable United States law, his copyright terminated after this initial term.”²⁶³ Barbara Kruger, the defendant, was then free to use the photograph after 1988, as it was in the public domain in the United States. This was how the UCC worked before § 104A. An initial term was granted upon fulfilling the notice requirements at publication and renewal was required for anything beyond the first twenty-eight years. The copyright on the photograph was then restored by §

253. UCC, *supra* note 77, art. III.

254. 7 PATRY, *supra* note 72, § 23:11.

255. 4 NIMMER & NIMMER, *supra* note 19, § 17:04.

256. *Id.*

257. Berne, *supra* note 21, art. 18(1).

258. The convention does not apply “to works or rights in works which, at the effective date of the Convention in a Contracting State where protection is claimed, are permanently in the public domain in the said Contracting State.” UCC, *supra* note 77, art. VII.

259. Universal Copyright Convention as revised at Paris art. II, July 24, 1971, 25 U.S.T. 1341, 1345.

260. 2 ABRAMS, *supra* note 244, § 11:32; 3 PATRY, *supra* note 72, § 7:50; William M. Hart, *An Overview of the Copyright Renewal Amendment and its Impact on Renewal Practices Under U.S. Law*, 17 COLUM. J.L. & ARTS 311 (1993); Lionel S. Sobel, *Copyright Renewal After the 1992 Amendments: The Strategic Choices to be Made Between Automatic and Applied-for Renewals*, Ent. L. Rep., Dec. 1992, at 3.

261. *Hoepker v. Kruger*, 200 F. Supp. 2d 340 (S.D.N.Y. 2002). The court’s description of the photograph:

The image, “Charlotte As Seen By Thomas,” pictures Dabney from the waist up, holding a large magnifying glass over her right eye. Dabney’s eye fills the lens of the magnifying glass, and the lens covers a large portion of Dabney’s face. The image was published once in the German photography magazine FOTO PRISMA in 1960.

Id. at 342.

262. *Id.* at 345 (quoting the court’s August 28 Order; citing UCC, *supra* note 77, art. II(1)).

263. *Id.*

104A.²⁶⁴

In the unreported case *Barris v. Hamilton*, the court faced similar questions as well, but explained the reasoning in greater detail.²⁶⁵ Here, photographs of Marilyn Monroe were first published in a British newspaper, *The Daily Mirror*, in 1962.²⁶⁶ It would not be until 1986 that the plaintiff would register the photographs with the U.S. Copyright Office.²⁶⁷ Like the Kruger case, the photographs had been incorporated into a collage.²⁶⁸ The question was whether the photographs were in the public domain in the United States.²⁶⁹ A foreign author need not register the work to gain the initial twenty-eight year term of protection.²⁷⁰ However, renewal was not automatic:

Unlike the original copyright, the renewal is created, not by publication with a claim to the copyright, but by registration of an application for renewal in the Copyright Office. *Such an application cannot be validly made until the last year of the original term of the copyright* so that, until that time, no one can have anything more than the “right to secure” a renewal.²⁷¹

The United Kingdom would sign the UCC in 1957.²⁷² Therefore, as of 1957, Vera Brittain’s works were automatically protected in the United States for twenty-eight years, as long as the UCC notice requirement was met. Of her works, four qualified under this rubric.²⁷³ None of them were renewed in the United States,

264. See *id.* (applying a § 104A analysis, inter alia, determining that the photograph at issue was still under copyright in Germany). See also *supra* Part I-B for more on this case, regarding enforcement of the new term of copyright.

265. *Barris v. Hamilton*, No. 96 CIV. 9541(DAB), 1999 WL 311813, at *2 (S.D.N.Y. May 17, 1999).

266. *Id.* at *1.

267. *Id.*

268. *Id.*

269. *Id.* at *3.

270. *Id.* (citing 17 U.S.C. § 104(b)(2) (1996)).

271. *Id.* at *4 (quoting *Rose v. Bourne, Inc.*, 176 F. Supp. 605, 610 (S.D.N.Y. 1959), *aff’d* 279 F.2d 79 (2d Cir. 1960) (emphasis in original)). Interestingly, the court neglected to apply § 104A to the works, but given the dates of the uses, it is unlikely to have changed the outcome of the case:

Plaintiff alleges that Hamilton altered the copyrighted images and incorporated them into a collage “approximately two years later,” in 1964 or 1965. In 1992, Hamilton’s piece was then printed in a catalogue book entitled “Richard Hamilton” published by D’Offay and Tate, and in a book entitled “Art and Film Since 1945—Hall of Mirrors” published by Monacelli Press. The “Richard Hamilton” book was then sold at two New York book stores: Madison Avenue, and Hacker Art Books. The Hamilton piece was shown at an exhibition at MOCA from March 17 to July 28, 1996. Further, Plaintiff alleges that MOCA sold the Monacelli book, and published a quarterly newsletter called “The Contemporary” that featured the Hamilton piece. Plaintiff alleges that he was first made aware of the existence of these publications after the MOCA exhibition in 1996.

Id. at *1 (internal citations omitted).

272. U.S. COPYRIGHT OFFICE, *supra* note 158, at 10.

273. They included *IN THE STEPS OF JOHN BUNYAN* (Rich and Cowan 1950); *THE WOMEN AT OXFORD* (Macmillan 1960); *SELECTED LETTERS OF WINIFRED HOLTBY AND VERA BRITTAİN* (A. Brown 1960) and *PETHICK-LAWRENCE* (Allen & Unwin 1963).

and therefore, after the first term, they entered the U.S. public domain.²⁷⁴ These works were then eligible for § 104A because they were in the public domain in the United States but not their source country, and they were in the public domain because they had not been renewed.

One question arose regarding ad interim copyright and the Universal Copyright Convention with regard to J.R.R. Tolkien's trilogy.²⁷⁵ As discussed, before the UCC, English-language works were allowed to apply for ad interim copyright protection through the Copyright Office.²⁷⁶ This allowed for a period of time where a work would be granted protection under the foreign version, in order to have time to meet the manufacturing clause and publication in the United States. As we saw, Vera Brittain took advantage of ad interim protection for *Testament of Youth*.

In the case of Tolkien, the works had been published in 1952 in Great Britain, and then were licensed to Houghton Mifflin for publication in the United States in 1954.²⁷⁷ Using the ad interim mechanism under the 1909 Act, Houghton Mifflin obtained a five-year temporary copyright for the British copies.²⁷⁸ In 1949, ad interim protection was considerably lengthened from four months of protection from ad interim registration to five years of protection.²⁷⁹ The 1949 amendment also lengthened the period from sixty days from initial foreign publication to file an ad interim registration to six months from publication.²⁸⁰ Ad interim protection continued to be available only for English-language works.²⁸¹

Under ad interim, proper copyright notice was not required.²⁸² The transition to the UCC meant some works had gained protection without copyright notice, but they still eventually had to meet the formality and manufacturing requirements of the U.S. copyright law system. The transition was handled by an amendment to § 9:

Upon the coming into force of the Universal Copyright Convention into a foreign state or nation . . . every book . . . of a citizen or subject thereof in which ad interim copyright was subsisting on the effective date of said coming into force shall have copyright for twenty-eight years from the date of first publication abroad without the

274. *Copyright Renewals Database*, *supra* note 186.

275. *Eisen, Durwood & Co. v. Tolkien*, 794 F. Supp. 85 (S.D.N.Y. 1992).

276. *See supra* Part IV-A-7.

278. *Tolkien*, 794 F. Supp. at 86.

279. 8 NIMMER & NIMMER, *supra* note 19, app. 6 § 22.

280. *Id.* The 1949 amendment to 17 U.S.C. § 22 read as follows:

In the case of a book or periodical first published abroad in the English language, the deposit in the Copyright Office, not later than six months after its publication abroad, of one complete copy of the foreign edition, with a request for the reservation of the copyright and a statement of the name and nationality of the author and of the copyright proprietor and of the date of publication of the said book or periodical, shall secure to the author or proprietor an ad interim copyright therein, which shall have all the force and effect given to copyright by this title, and shall endure until the expiration of five years after the date of first publication abroad.

Act of June 3, 1949, Pub. L. No. 84, ch.171, sec. 2, § 22, 63 Stat. 153, 154 (1949).

281. 8 NIMMER & NIMMER, *supra* note 19, app. 6 § 22.

282. *Tolkien*, 794 F. Supp. at 86.

necessity of complying with the further formalities specified in section 23 of this title.²⁸³

This meant that J.R.R. Tolkien's trilogy would be protected without notice because an ad interim copyright had been filed before the UCC went into effect in the United States, and was still in its temporary term. What this means for those researching works is that one must determine if a work without proper copyright notice had filed for an ad interim copyright and whether that allowed the work to have an initial twenty-eight year term. For the Tolkien works, the court noted that a copyright was filed in 1983, thereby meeting the renewal requirement under the UCC.²⁸⁴

4. 1964–77: Automatic Renewal for All

For works published in the United States and foreign works abroad between 1964 and 1977, only notice and not renewal is required to obtain the full ninety-five-year copyright term.²⁸⁵ The United States now had a dual notice requirement system: one for U.S. works (and foreign works if they wanted), and the other for foreign works. But this means that foreign works with either U.S. notice or UCC notice remained under copyright, with no need for restoration under § 104A.

Continuing to use Vera Brittain as an example, Brittain has three works that fall under this category, each of which have always been under copyright from their publication in the United Kingdom, even though they were not registered with the U.S. Copyright Office.²⁸⁶

5. 1978–89: Formalities Still Required

The United States did not remove formality requirements until the enactment of the BCIA in 1988, with the changes applying after March 1, 1989. This means that foreign works that did not comply with the UCC or U.S. notice requirements came into the public domain in the United States. So, there are works from the post-1978 period that may be restored as well. The period is small, but there is that potential.

6. Conclusion

With § 104A, errors were fixed—Vera Brittain presumably had not wanted *Testament of Youth*, *Poems of the War and After* and *Testament of Friendship* to come into the U.S. public domain after their twenty-eighth year. She might have

283. *Id.* (citing the Copyright Act of 1909, Pub. L. No. 60-349, § 9, 35 Stat. 1077 (codified as amended at 17 U.S.C. § 10 (1947)).

284. *Id.*

285. Copyright Amendments Act of 1992, Pub. L. No. 102-307, § 102(a), 106 Stat. 264, 264–66 (codified as amended at 17 U.S.C. § 304(a) (1982)).

286. VERA BRITAIN, *THE REBEL PASSION* (George Allen & Unwin Ltd. 1964); ENVOY EXTRAORDINARY: A STUDY OF VIJAYA LAKSHMI PANDIT AND HER CONTRIBUTION TO MODERN INDIA (George Allen & Unwin Ltd. 1965); RADCLYFFE HALL—A CASE OF OBSCENITY? (Femina Books, Ltd. 1968).

liked the idea that her British works published before 1957 had copyright finally in the United States, although it appears that no one had taken advantage of the public domain status in the United States with regard to new publication. And she might have liked the copyright restored on her post-1957–64 works. One wonders, however, what kind of difference this made to the works or expectations of the copyright holders. Did the Vera Brittain estate see a measurable financial difference with this restoration? One imagines it made little difference at all. While a number of works that had substantial economic value were restored—we’ve seen this with Vera Brittain, *Testament of Youth*—many more that had little or no economic value or any interest for most people were restored as well.

C. DOMESTIC AUTHORS

There is no doubt that foreign authors struggled to understand the necessary requirements under the changing copyright system in the United States, although the system became easier with time. Similar patterns of protection and mistakes exist for domestic authors and foreign authors. Gertrude Berg (1899–1966) serves as one example.²⁸⁷ Berg was an early pioneer and very popular figure of early radio and television.²⁸⁸ Her body of works presents us with many of the problems one might encounter when trying to determine the copyright status of a pre-1978 work published in the United States by an author. Berg wrote, produced and performed in nearly every medium—radio, television, film, the stage—and even wrote a memoir and a cookbook.²⁸⁹

In the case of Berg, we have one example of a book that was registered and renewed, and two books that were not renewed. In 1931, Berg published a collection of radio scripts as a book for sale to the public, *The Rise of the Goldbergs*, which was registered at the Copyright Office and renewed in its twenty-eighth year, bringing the term of protection to ninety-five years, or through 2026.²⁹⁰ No renewal records exist for her memoir, *Molly and Me* (1961), or *The Molly Goldberg Jewish Cookbook* (1955).²⁹¹ These two works, therefore, are in the

287. *Gertrude Berg*, WIKIPEDIA, http://en.wikipedia.org/wiki/Gertrude_Berg (last modified Nov. 25, 2010).

288. *Gertude Berg*, MUSEUM BROADCAST COMM., <http://www.museum.tv/archives/etv/B/htmlB/berggertrude/berggertrud.htm> (last visited Dec. 2, 2010).

289. *Gertrude Berg Papers*, SYRACUSE U. LIBR., http://library.syr.edu/digital/guides/b/berg_g.htm (last visited Nov. 11, 2010).

290. *Copyright Renewals Database*, STANFORD U., <http://collections.stanford.edu/copyrightrenewals/bin/page?forward=home> (follow “Simple Search” hyperlink; enter “The Rise of the Goldbergs” in search field; follow “Long Record” hyperlink) (last visited Nov. 11, 2010) (providing that the original registration date was April 18, 1931, and was renewed on November 5, 1958—during the twenty-eighth year of the copyright). Under the 1909 Act, years were measured by the actual date, rather than as under the 1976 Copyright Act, where it is measured by the calendar year. Compare Copyright Act of 1909, Pub. L. No. 60-349, § 23, 35 Stat. 1077, 1080, with Copyright Act of 1976, 17 U.S.C. § 305 (2006).

291. Since both works were published before 1964, they did not qualify for automatic renewal. GERTRUDE BERG, *MOLLY AND ME* (McGraw-Hill Book Co., Inc. 1961) came into the public domain in the United States after 1989, and MOLLY GOLDBERG, *THE MOLLY GOLDBERG JEWISH COOKBOOK* (Doubleday & Company, Inc. 1955) came into the public domain in the United States after 1983.

public domain. Unlike Vera Brittain, however, Berg's works were not restored with § 104A, and remain in the public domain; Berg made the same mistake as Brittain, but with a very different result. So, with a quick search at the Stanford Renewal Records, and a little knowledge about the law, we have found out that scholars and anyone else are free to use *Molly and Me* in whatever way they want—quoting extensively, republishing, publicly performing the work, making the autobiography into a movie or a play and even posting the entire work on the Internet.²⁹² In fact, *The Molly Goldberg Jewish Cookbook* was republished by Ivyland Books in 1999, presumably because the work is in the public domain.²⁹³ This was how the system worked for all works before § 104A, and continues to operate for domestic works.

The law was unforgiving, but in its strictness, the public benefitted. The *Letter Edged in Black* court explained:

An analysis of the legal issues presented in this action compels the conclusion that the copyright to the Chicago Picasso is invalid due to the fact that the sculpture has entered the public domain. This decision comports with a strict adherence to copyright law and is also in consonance with the policy of enriching society which underlies our copyright system. The broadest and most uninhibited reproduction and copying of a provocative piece of public sculpture can only have the end result of benefiting society.²⁹⁴

D. NO MAN'S LAND: UNPUBLISHED WORKS, *TWIN BOOKS* AND § 104A

"It has never been clearly established whether a work only published abroad is to be treated as a published work for purposes of duration under U.S. law or should be treated as unpublished for these purposes."²⁹⁵

1. Foreign Unpublished Works

Section 104A focused on published works; unpublished works are governed by §§ 303(a) and 104(a).²⁹⁶ Congress dramatically altered the "traditional contours of the copyright law" with § 303(a), which brought unpublished works into federal protection for the first time.²⁹⁷ Until January 1, 1978, unpublished works were

292. For a scholar working on Gertrude Berg, the fact that her autobiography is in the public domain dramatically alters the potentials for a project. Caren Demining explains the changes in her thinking when she found out that one of the main texts she plans to use in her work is in the public domain: "Two important lessons to be learned. First, scholars and others do not tend to look at the legal status of the works they are using until after their project is well underway or complete. Second, it is often unpredictable what will be renewed and what will not." Grant Application from Caren Demining (on file with author).

293. GERTRUDE BERG & MYA WALDO, *THE MOLLY GOLDBERG JEWISH COOKBOOK* (Ivyland Books 1999) (1955).

294. *The Letter Edged in Black Press, Inc., v. Pub. Bldg. Comm'n*, 320 F. Supp. 1303, 1313 (N.D. Ill. 1970).

295. *Société Civile Succession Richard Guino v. Beseder, Inc.*, 414 F. Supp. 2d 944, 948 (D. Ariz. 2006) (quoting 2 U.S.A. INTERNATIONAL COPYRIGHT LAW AND PRACTICE § 3[2][b][3] n.46 (2005)).

296. 17 U.S.C. §§ 303(a), 104(a) (2006).

297. 17 U.S.C. § 303(a). See generally Elizabeth Townsend Gard, *January 1, 2003: The Birth of*

protected by state common law perpetually, until “first publication,” whereby the work then became part of the federal system.²⁹⁸ As already noted, a work that was considered a general publication had to follow proper formalities (notice, registration, etc.) or the work fell immediately into the public domain.²⁹⁹ Under the 1976 Act, all unpublished works no longer had the state law common law protection.³⁰⁰ Instead, federal law automatically protected works.³⁰¹

Section 303(a) served as the transition in the change of the “traditional contours” of the copyright law.³⁰² No work would come into the public domain earlier than December 31, 2002.³⁰³ Take, for example, the unpublished works of Gustav Klimt (1842–1918), an Austrian painter.³⁰⁴ His unpublished works were protected in the United States under § 303(a) until December 31, 2002.³⁰⁵ If his heirs or copyright holders published the unpublished materials (all created before 1978), the works would carry an additional term through December 31, 2047.³⁰⁶ Any materials not included in the published version (edited out content) would be in the public domain on January 1, 2003.³⁰⁷

Why did Congress get this alteration right? First, all unpublished works—regardless of nationality—were protected.³⁰⁸ Through § 104(a), § 303(a) applies the principle of national treatment, whereby domestic and foreign authors are treated the same.³⁰⁹ Second, Congress gave all unpublished works twenty-five years of protection.³¹⁰ No unpublished works fell into the public domain automatically upon the enactment of the 1976 Copyright Act. The effect of this tremendous change was gradual. It prepared copyright holders for their loss. Third, Congress gave incentive for copyright holders to publish new works by publishing unpublished works for the first time. In return for publishing a new work, the copyright holder was given an additional term of forty-five years of exclusive use.³¹¹ Those that did not publish their unpublished works within the twenty-five year period (1978–2002) did not gain the additional term, and those works came into the public domain on December 31, 2002, or life of the author plus seventy years, whichever was longer.³¹²

the Unpublished Public Domain and Its International Implications, 24 *CARDOZO ARTS & ENT. L.J.* 687 (2006); Elizabeth Townsend Gard, *Unpublished Works in the Public Domain: The Opening of a New Frontier*, 54 *J. COPYRIGHT SOC'Y U.S.A.* 439 (2007).

298. 17 U.S.C. § 303(a).

299. 2 *NIMMER & NIMMER*, *supra* note 19, § 7.14.

300. *Id.*

301. 17 U.S.C. §§ 301, 303(a).

302. Townsend Gard, *Unpublished Works in the Public Domain*, *supra* note 297.

303. 17 U.S.C. § 303(a).

304. *Gustav Klimt*, WIKIPEDIA, http://en.wikipedia.org/wiki/Gustav_Klimt (last modified Dec. 2, 2010).

305. 17 U.S.C. § 303(a).

306. *Id.*

307. *See* Townsend Gard, *January 1, 2003*, *supra* note 297.

308. 17 U.S.C. § 104(a).

309. *Id.*

310. *Id.* § 303(a).

311. *Id.*

312. *Id.*

Let's return to the example of Vera Brittain (1893–1970).³¹³ Her literary estate did just what it should have. In 1981, an edited collection of her diaries was published, followed by two more volumes in 1986 and 1989.³¹⁴ This meant that the copyright was extended from the end of 2040 to the end of 2047.

More dramatic is the case of Brittain's brother and friends killed in the Great War—all British citizens killed in France or Italy.³¹⁵ Her brother Edward Brittain, her fiancé Roland Leighton and her friends, Victor Richardson and Geoffrey Thurlow, all died between 1915 and 1918.³¹⁶ Even though this is greater than seventy years, all of their unpublished letters were protected by federal statute through December 31, 2002, regardless of whether the copyright holder(s) elected to publish the letters.³¹⁷ In this case, an edited collection of their letters was published in 1999, and therefore the published portions of the letters are now protected through December 31, 2047—around 130 years after their deaths.³¹⁸ This is how the system was supposed to work.

While the “traditional contours” of unpublished works being protected by state common law might have changed, the underlying notion of an incentive system did not. Also, there seems to be a nice balance of the public interest and the copyright holder. The public had twenty-five years to prepare for a work to be in the public domain but knew from the beginning that, at any time during that twenty-five year period, the copyright holder had one last shot at obtaining additional copyright protection. It was a transparent transition for all. Moreover, it retained the concept of balance—the essential element we are all taught when it comes to the Copyright Clause.³¹⁹

A recent case challenged the constitutionality of § 303(a). In 2008, the Ninth Circuit analyzed the copyright term of two sets of Renoir sculptures created between 1913 and 1917.³²⁰ The court took up the question of the constitutionality of § 303(a).³²¹ The defendant purported that, unlike in *Eldred*, where the term was limited and finite, the term under § 303(a) was limitless, and therefore violated the

313. Vera Brittain, WIKIPEDIA, http://en.wikipedia.org/wiki/Vera_Brittain (last modified Oct. 4, 2010).

314. VERA BRITTAİN, CHRONICLE OF YOUTH (Alan Bishop ed., Victor Gollancz, Ltd. 1981); CHRONICLE OF FRIENDSHIP: DIARY OF THE THIRTIES, 1932–1939 (Alan Bishop ed., Victor Gollancz, Ltd. 1986); WARTIME CHRONICLE (Alan Bishop ed., Victor Gollancz, Ltd. 1989).

315. VERA BRITTAİN, LETTERS FROM A LOST GENERATION: THE FIRST WORLD WAR LETTERS OF VERA BRITTAİN AND FOUR FRIENDS, ROLAND LEIGHTON, EDWARD BRITTAİN, VICTOR RICHARDSON, GEOFFREY THURLOW (Alan Bishop & Mark Bostridge eds., Northeastern Univ. Press 1999).

316. BRITTAİN, *supra* note 187.

317. 17 U.S.C. §§ 104(a), 303(a).

318. BRITTAİN, *supra* note 315.

319. U.S. Const. art. 1, § 8, cl. 8.

320. *Société Civile Succession Richard Guino v. Jean-Emmanuel Renoir*, 549 F.3d 1182 (9th Cir. 2008). Strangely, they were found not to be protected by federal copyright or in the public domain. *Id.* at 1188. This is a particularly sticky part of the case that will be discussed later in this Article. The sculptures were published in 1917 and 1974 in France, each time without copyright notice. *Id.* at 1187. The Ninth Circuit affirmed the district court's decision that the works were considered not published, and therefore not copyrighted. *Id.* at 1188. They were, therefore, protected under § 303(a), rather than § 104, which required publication and a work to have passed into the public domain in the United States.

321. *Société Civile*, 549 F.3d at 1190–91.

“limited Times” clause of the Constitution.³²² Using the example of a newly found Greek text, the Ninth Circuit rightly explained:

[T]he term is not limitless. Instead, the copyright term for a newly discovered ancient work that is not in the public domain or copyrighted would be limited to a finite term of seventy years after the death of the last author, §§ 303(a), 302(a), (b), or December 31, 2047, whichever is later. . . .³²³

This is the first case to take up the constitutionality of § 303(a), even in a limited context. It is not a sophisticated argument, but it gets the math right. Section 303(a) has a limitation on the term, whereby all unpublished works come into the public domain, whether an ancient work or a child’s painting. Some would say it completes the task set out by the Statute of Anne (1709), *Donaldson v. Beckett*, the U.S. Constitution and *Wheaton v. Peters*: all works, published and unpublished, fall under the “limited Times” of the Constitution, and come eventually into the public domain.³²⁴

2. *Twin Books* and the Question of Publication of Foreign Works

“The court will follow *Twin Books* . . . but expresses criticism of the rule announced in *Twin Books*. . . . The *Twin Books* Court’s reading of Heim is arguably incorrect, leads to an unreasonable result, and unduly restricts the copyright restoration provisions of §104A.”³²⁵

One question, then, is when is a foreign work considered published for the purposes of § 104A, or instead falls under § 303(a) as unpublished? While the case law surrounding the 1909 Act had a great deal of commentary and opinion on what constituted general and limited publication, as demonstrated by the Chicago Picasso case, a strange line of cases has arisen concurrent to § 104A case law.

We turn once again to the case of Vera Brittain to better understand the problem. Brittain’s first publication occurred in 1918, with the slim volume of poems entitled, *Verses of a V.A.D.*³²⁶ As we have seen, the work was only published in the United Kingdom. Before this Article, I would have answered quickly that the work was in the public domain, as all works published before 1923 are in the public domain in the United States, with § 104A having no bearing. But duration is never that simple, in this case because the work is of foreign origin. Moreover, and

322. U.S. Const. art. 1, § 8, cl. 8; *Société Civile*, 549 F.3d at 1190.

323. *Société Civile*, 549 F.3d at 1191.

324. U.S. Const. art. 1, § 8, cl. 8.; see also Statute of Anne, 8 Ann., c. 19 (1709); *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834); *Donaldson v. Beckett*, (1774) 1 Eng. Rep. 1837 (H.L.); 4 Burr. 2408.

325. *Société Civile Succession Richard Guino v. Beseder, Inc.*, 414 F. Supp. 2d 944, 949 (D. Ariz. 2006).

326. VERA BRITAIN, *VERSES OF A V.A.D.* (Imperial War Museum 1995) (1918). In April 2007, a first edition copy was listed for sale for over \$1000 from Summerfield Books BA in the United Kingdom through www.abebooks.com. The descriptions reads, “46pp. Printed boards, with small 'nick' in spine. The extremely scarce original issue of Vera Brittain's first published work, being poems on the theme of 1st world war loss and emotion. Bookseller Inventory # ABE-856280422.” AbeBooks.com, <http://www.abebooks.com/servlet/BookDetails?bi=856280422&AID=7169465&PID=555228> (last visited Apr. 2, 2007).

depending on if one is in the Ninth Circuit, one may have to contend with a different result, thanks to the ten-year-old *Twin Books* case, and more recent 2006 decision of *Société Civile Succession Richard Guino v. Beseder, Inc.*³²⁷ *Twin Books* calls into question the definition and dividing line of publication for foreign works, and makes the work in a post-§ 104A environment that much more uncertain.³²⁸ If § 104A applies, the work is in the public domain. If § 303(a) applies, the work could be under copyright through 2047.

Twin Books was a 1996 Ninth Circuit case that involved the children's classic, *Bambi, A Life in the Woods*, which was first published in Germany in 1923 without a copyright notice.³²⁹ As the court wrote, the work "contained no notice to the world that Mr. Salten (the author) intended to protect the young German fawn. Therefore, *Bambi* was fair game for any deer hunter in the world outside of Germany."³³⁰ The court continues, "However, in 1926, Salten must have realized this potential danger, and therefore, he republished the German language *Bambi, A Life in the Woods in Germany*, this time with a notice of United States copyright, in an attempt to afford *Bambi* some protection from the dangerous American hunters."³³¹ The 1926 version was timely registered in the United States in early 1927 and was properly renewed in 1954.³³² In 1993, Salten's heirs assigned all of the rights in *Bambi* to Twin Books.³³³

Disagreements arose relating to agreements made in 1958, and Twin Books brought suit. Disney moved for summary judgment, claiming, in part, that *Bambi* fell into the public domain in 1923 because there had not been proper copyright notice on the original German version.³³⁴ The court reviewed the strict formality requirements for foreign works under § 19 of the 1909 Copyright Act, which were in effect prior to the United States joining Berne in 1989, and the more relaxed standards under the UCC beginning in the mid-1950s.³³⁵ Without proper copyright notice, a work would fall into the public domain.³³⁶ William Patry aptly explains the problem:

Twin Books . . . held that U.S. copyright did not begin until publication with notice in the U.S., that is, in 1926. So what then of the status of the work in 1923–1925? The court held that within that period, anyone in the U.S. could have used the work without liability. But that makes no sense: if the work was not "published" within the meaning of the U.S. copyright before 1926, then it was "unpublished." There is no third category. If it was unpublished, it was protected in the U.S. and no one could use

327. *Twin Books Co. v. Walt Disney Co.*, 83 F.3d 1162 (9th Cir. 1996); *Société Civile*, 414 F. Supp. 2d 944.

328. *Twin Books*, 83 F.3d at 1162.

329. *Id.* at 1164.

330. *Id.*

331. *Id.*

332. *Id.*

333. *Id.*

334. *Id.*

335. *Id.* at 1165–66.

336. *See id.* at 1166 (citing *Ferris v. Frohman*, 223 U.S. 424 (1912) (determining under the 1909 Act "that performance of a play in England did not alter that play's subsequent United States copyright status.")).

it. The court of appeals thus created a new category of work never before seen or dreamed of, even by Walt.³³⁷

Section 104A restored foreign works that were in the public domain in the United States due to lack of formalities, including improper notice, *inter alia*.³³⁸ Did *Twin Books* create a new category of works—works without any notice published abroad? Wasn't that what § 104A was supposed to address?

Ten years later, in 2006, the U.S. District Court in Arizona applied the *Twin Books* decision in *Société Civile Succession Richard Guino v. Beseder, Inc.*³³⁹ In dispute were works of art created by Pierre-Auguste Renoir.³⁴⁰ Among the issues was the question of determining the appropriate copyright term for the works.³⁴¹ The works in question were sculptures created between 1913 and 1917 by Renoir and Richard Guino.³⁴² The sculptures were published in 1917 in France as works by Renoir, and then published as Renoir-Guino works in 1974, again in Paris.³⁴³ The plaintiff, a French trust for Guino, registered the copyright of the sculptures with the U.S. Copyright Office in 1984.³⁴⁴ Neither the 1917, nor the 1974 publication contained proper copyright notice, even though the 1974 work would have come under the UCC requirements.³⁴⁵ The question the court faced was whether the works were considered unpublished, and therefore gained protection in the United States through § 303(a), or whether § 104A applied.³⁴⁶ If the 1917 works were considered published, the sculptures were not eligible for protection; if the works were unpublished, then they would then be protected by § 303(a).

The court turned to *Twin Books*, controlling law in the Ninth Circuit: “The Ninth Circuit has held ‘that publication without a copyright notice in a foreign country [does] not put the work in the public domain in the United States.’”³⁴⁷ The court went on to follow *Twin Books*, but not before criticizing it.³⁴⁸ First, the court found that the *Twin Books* court had misread the underlying Second Circuit case, *Heim*.³⁴⁹ *Heim* really stood for the “rule that foreign publication without a

337. 3 PATRY, *supra* note 72, § 7:24.50. Patry believes:

The correct rule is that publication of a work without notice injected the work into the public domain in the United States; such works were, if from an eligible country, restored by Section 104A, and enjoy the term of protection they otherwise would have had if U.S. formalities had been complied with.

Id.

338. 17 U.S.C. § 104A (2006).

339. *Société Civile Succession Richard Guino v. Beseder, Inc.*, 414 F. Supp. 2d 944 (D. Ariz. 2006).

340. *Id.* at 945.

341. *Id.* at 947.

342. *Société Civile Succession Guino v. Renoir*, 549 F.3d 1182, 1184 (9th Cir. 2008).

343. *Id.* at 1187.

344. *Id.* at 1184.

345. *Id.* at 1187.

346. *Id.* at 1186.

347. *Société Civile Succession Richard Guino v. Beseder, Inc.*, 414 F. Supp. 2d 944, 948 (D. Ariz. 2006) (quoting *Twin Books Co. v. Walt Disney Co.*, 83 F.3d 1162, 1167 (9th Cir. 1996)).

348. *Id.* at 949.

349. *Id.*

copyright notice can commence the term of an American copyright, not the rule that foreign publication cannot place a work in the public domain in the United States, which the Ninth Circuit adopted in *Twin Books*.³⁵⁰ The court explained that the proper reading means that formalities are waived for foreign works; the *Twin Books* reading means the copyright term does not begin for a foreign work until proper copyright notice is affixed.³⁵¹

The court then followed the reasoning of *Twin Books* to its logical conclusion, namely that foreign works created before January 1, 1978 and published with improper or no copyright notice would be considered unpublished, and therefore would be protected by § 303(a).³⁵² These foreign works, because they were not considered published in the United States (and then in the public domain because of, for instance, lack of formalities), would not be eligible for § 104A protection. Thus, the court saw the *Twin Books* decision as limiting the scope of § 104A with regard to foreign works. Not all foreign works would be eligible for ninety-five years from publication, even though the statute itself explicitly includes improper notice as a reason a foreign work would have been in the public domain in the United States.³⁵³

I would argue, however, that the court overlooked an important element. *Twin Books* actually implies that what is included under copyright is far more expansive. Under § 104A, only foreign works published after 1922 are eligible.³⁵⁴ In contrast, any foreign work that was published without copyright notice or with improper copyright notice would be eligible for the additional protection of life of the author, or until December 31, 2002; and if the work was published (under the 1976 definition of “published”) for the first time between 1978 and 2002, the work would be granted protection through December 31, 2047.

It appears from the registration record that the Estate of Guino was claiming the work to be unpublished, rather than published.³⁵⁵ Therefore, the term, if the work remained unpublished through December 31, 2002, would end as of that date.

Currently, however, the *Renoir* court did not apply the terms of the UCC, which allowed for copyright protection of twenty-eight years for a foreign work with proper UCC notice. In this case, that would mean the work published in 1974 in France would have received an automatic term, and after 1964, renewal would have occurred automatically. The question was whether the work had proper UCC notice. The work would have been under copyright—and not in need of § 104A—until ninety-five years after the 1974 publication, or 2069.

In December 2008, the Ninth Circuit reviewed the *Renoir* case.³⁵⁶ The Ninth Circuit phrased the issue as follows: “Whether the sculptures are protected by §§

350. *Id.*

351. *Id.* at 949–50.

352. *Id.* at 952.

353. 17 U.S.C. § 104A (2006).

354. *Id.*

355. *Copyright Records Catalog*, U.S. COPYRIGHT OFF., <http://cocatalog.loc.gov/cgi-bin/Pwebrecon.cgi?DB=local&PAGE=First> (search for “Societe Civile Succession Richard Guino”) (last visited Dec. 5, 2010).

356. *Société Civile Succession Guino v. Renoir*, 549 F.3d 1182, 1182 (9th Cir. 2008).

303(a) or 104A turns on whether the sculptures passed into the public domain in the United States.”³⁵⁷ Applying *Twin Books*, the Ninth Circuit found that the works had not passed into the public domain, and therefore were not eligible for copyright restoration under § 104A.³⁵⁸ The Ninth Circuit continued with the strange conclusion: “For the years between 1917 and 1978, therefore, the sculptures were neither protected by copyright nor injected into the public domain.”³⁵⁹ Does this mean that they were unpublished and protected by state common law? The court then analyzes the sculptures under § 303(a). I quote in full because the Ninth Circuit gets it wrong:

Section 303(a) of the 1976 Act applies because the sculptures were “created before January 1, 1978, but not theretofore in the public domain or copyrighted.” 17 U.S.C. § 303(a). The sculptures were created between 1913 and 1917. Pursuant to *Twin Books*, the sculptures have not passed into the public domain, 83 F.3d at 1167, and were not protected by copyright after foreign publication without notice, *see id.* at 1168. The sculptures were not copyrighted until 1984. Section 303(a) provides protection for the term provided by § 302, which is a term seventy years after the death of the last surviving author. Because Guino passed away in 1973, the sculptures are entitled to protection until 2043, which the district court properly held.³⁶⁰

The sculptures were registered, not copyrighted, in 1984. The question the court needed to further investigate was whether they remained unpublished or were published in 1984. The court actually gets it even more wrong in a footnote:

Although not pressed on appeal, it is worth noting that § 303(a) also provides that “if the work is published on or before December 31, 2002, the term of copyright shall not expire before December 31, 2047.” Under the 1976 Act, the sculptures may have been published “before December 31, 2002,” because they were distributed for public sale in 1917 and 1974. *See* 17 U.S.C. § 101 (“Publication” is defined as “the distribution of copies . . . of a work to the public by sale or other transfer of ownership”). Although perhaps a minor distinction, the district court conducted no inquiry into whether the sculptures were published for purposes of the 1976 Act.³⁶¹

This information is *not* minor. First, the public sale in 1917, if constituting publication, would mean the sculptures were not eligible for § 104A or § 303(a) protection. If only the 1974 date counted, then the UCC may have applied. Moreover, the required publication under § 303(a) must have occurred between 1978 and 2002 for the additional protection. If the original publications counted, then *Twin Books* wouldn’t apply; they would be considered published and then be analyzed for restoration under § 104A. This would inject the 1917 version into the public domain and would only cover the additional alterations (if original enough to qualify as a derivative work) of any subsequent version.

357. *Id.* at 1186.

358. *Id.* at 1187 (“Because those publications were in a foreign country and without notice of United States copyright, they ‘did not put the work in the public domain in the United States.’” (citing *Twin Books v. Walt Disney Co.*, 83 F.3d 1162, 1167 (9th Cir. 1996))).

359. *Id.* (citing *Twin Books*, 83 F.3d at 1167).

360. *Id.* at 1187–88.

361. *Id.* at 1188 n.1.

To merely end the discussion with a rehashing of the case law would not further our inquiry, and Vera Brittain provides a perfect example of the *Twin Books* problem. *Twin Books* applies potentially to any work that has either improper or no notice. This means that to determine the status of a work—in the Ninth Circuit—one must not only have the bibliographic information, but an actual copy of the book. *Twin Books* has brought enormous uncertainty and great legal contradictions to play in a world that had previously been rather stable. There is no easy way to read *Twin Books* and § 104A together.

Verses of a V.A.D. would not qualify under § 104A, because the work was published before 1923. However, the work might still qualify for protection in at least three different instances: under *Twin Books*, by restoration of the 1934 poetry collection through § 104A or through § 303(a) upon republication by the Imperial War Museum.

To determine whether *Twin Books* applies, we must look at the original copyright notice on the work. The work was published by Erskine MacDonald (listed on the title page), and on the following page, we find, “All rights reserved. First published August 1918.”³⁶² In the United States, this would not have counted as proper notice.³⁶³ Moreover, the work was never registered, renewed or manufactured in the United States. From its first publication, until the 1990s, the work had been considered to be in the U.S. public domain. The question is whether *Twin Books* applied; if it did, then the work would still be under copyright through § 303(a).

To add complexity, in 1995 the Imperial War Museum reissued *Verses of a V.A.D.* with a new introduction by Mark Bostridge and Paul Berry, the authors of Brittain’s authorized biography.³⁶⁴ The new publication, therefore, extends the term of the *unpublished* original version through December 31, 2047, because the work now falls under § 303(a). However, some of the poems were published as reprints in *Poems of the War and After*, which had its own copyright history.³⁶⁵ The work had U.S. protection for twenty-eight years, and then came into the public domain in the United States for thirty years, at which point, the work was restored by § 104A.

If the 1918 *Verses of a V.A.D.* did not count as a publication, then all of the poems in *Poems of the War and After* would be eligible for copyright protection. If *Verses of a V.A.D.* did count as a publication—and was therefore in the public domain—then only the new poems and the compilation itself would be protected, and not the original poems from *Verses of a V.A.D.*

There is no way to actually know the status of *Verses of a V.A.D.* One would assume that it is in the public domain because of the 1918 publication date from the

362. VERA BRITTAIN, *VERSES OF A V.A.D.* (MacDonald 1918).

363. The formalities in the United States required under 1909 were revised to consist of the word “Copyright,” or the abbreviation “Copr.,” accompanied by the name of the copyright proprietor. 3 NIMMER & NIMMER, *supra* note 19, § 7.07.

364. VERA BRITTAIN, *VERSES OF A V.A.D.* (1918), *reprinted in* *VERSES OF A V.A.D. AND OTHER WAR POEMS* (Imperial War Museum 1995).

365. VERA BRITTAIN, *POEMS OF THE WAR AND AFTER* (The MacMillan Co. 1934).

United Kingdom. But *Twin Books* calls that into question. The restoration of *Poems of the War and After* doesn't help. Finally, if *Twin Books* applies, the copyright on *Verses of a V.A.D.* had been extended by the Imperial War Museum publication in 1995. Is the work in the public domain (due to the 1918 publication), are some poems protected through 2029 or is the entire set of poems protected through 2047?

V. RELIANCE IN § 104A

A. THE MECHANICS OF RELIANCE IN § 104A

The previous section sought to demonstrate how complicated and convoluted the status of foreign works has become under § 104A. The mechanics of what qualifies for § 104A is complicated, even though the restoration occurs automatically. But qualifying for protection is just half of the statute; there is still the question of reliance parties—those who used the works when they were considered public domain works, and now have an economic/personal interest in their continued use.³⁶⁶ It is this second part that the *Golan* courts have been focusing on.³⁶⁷ This Section will first look at the mechanics of reliance, and then turn to the *Golan* court decisions themselves and their competing views on reliance parties. What happens when a work that had previously been in the public domain suddenly now has a restored copyright? In some cases, users had been relying on the public domain work for sixty-plus years, when suddenly the work's copyright was “restored.” Section 104A set up a mechanism to govern just such situations.

1. Notice Requirement

On January 1, 1996, copyright was restored automatically to all foreign works that qualified under § 104A.³⁶⁸ Remedies for infringement, however, were neither automatic nor immediate.³⁶⁹ Two paths existed for copyright holders of restored works, and both required notice. First, under § 104A(d)(2)(A)(i), during the first two years after restoration, restored copyright holders could file a Notice of Intent (NIE), which served as *constructive notice* to enforce the restored copyright with the Copyright Office.³⁷⁰ If such a NIE was filed with the Copyright Office, those using the previously public domain works—in this Section referred to as “reliance parties”—had a twelve month window in which to continue to use the work without being found liable for infringement.³⁷¹ If no NIE was filed, a copyright holder had a second possibility: actual notice, where again a twelve month reprieve was given

366. 3 NIMMER & NIMMER, *supra* note 19, § 9A.04[C][1].

367. *Golan v. Holder*, 611 F. Supp. 2d 1165 (D. Colo. 2009), *rev'd*, 609 F.3d 1076 (10th Cir. 2010).

368. 17 U.S.C. § 104A(h)(2)(A) (2006).

369. *Id.* § 104A(d)(2).

370. *Id.* § 104A(e)(1). Upon publication of the notice in the Federal Register, the NIE served as notice to all reliance parties. *Id.* § 104A(c).

371. *Id.* § 104A(d)(2)(A).

for continued uses, after which the use would be considered infringing.³⁷² Let's take a look at a few examples.

a. Tolkien: NIEs on Public Domain and Copyrighted Works

One of the most famous NIEs was filed by the estate of author J.R.R. Tolkien. The estate filed a notice of intent to enforce restoration with *The Fellowship of the Ring*, *The Two Towers*, *The Return of the King*, *The Hobbit* and *Farmer Giles of Ham & Three Other Works*.³⁷³ Does this mean that the works had been in the public domain in the United States previously? *The Fellowship of the Ring* and *The Two Towers* were registered in 1954 and renewed in 1982.³⁷⁴ *The Return of the King* was published in 1955 (which we know from the court case), had ad interim protection, but was converted to a twenty-eight-year term by the UCC and then was renewed in 1983.³⁷⁵ An NIE was filed for this work as well. So, perhaps they were just filing NIEs as a precaution, but the trilogy was never in the public domain to my knowledge.

An NIE was also filed for *The Hobbit*, and in this case, the NIE matters. *The Hobbit* was published in the United Kingdom on September 21, 1937.³⁷⁶ No interim copyright seemed to have been sought in the United States, but a U.S. version was published March 1, 1938, and promptly registered with the Copyright Office.³⁷⁷ *The Hobbit* does not appear to have been timely renewed.³⁷⁸ From 1967

372. *Id.* § 104A(d)(2)(B).

373. U.S. COPYRIGHT OFF. PUB. CATALOG, <http://cocatalog.loc.gov> (search by keyword: V8001P933, V8001P932, V8001P931, V8001P934, V8001P929) (last visited Nov. 4, 2010).

374. Copyright Renewal Database, STANFORD U., <http://collections.stanford.edu/copyrightrenewals> (follow "Simple Search" hyperlink; then search for "Fellowship of the Ring" and "The Two Towers") (last visited Nov. 18, 2010).

375. Copyright Renewal Database, STANFORD U., *supra* note 374 (follow "Simple Search" hyperlink; then search for "The Return of the King").

376. *Publication History of The Hobbit*, TOLKIEN COLLECTING RESOURCES, <http://www.tolkiencollector.com/hobbit.htm> (last visited Nov. 4, 2010) ("The Hobbit by JRR Tolkien. The center of the binding has a design made from the runes Th, D, Th. The bottom of the spine includes the publisher's name, George Allen & Unwin, Ltd. Page 6 states, 'FIRST PUBLISHED IN 1937. . . . [']"). Of course, this brings up similar questions addressed by *Twin Books*. Does "FIRST PUBLISHED" satisfy the notice requirement, or could there be an argument made that it was "not published" in the United States until the next year with the United Kingdom version?

377. *Id.*; Library of Congress, Copyright Office, 35 CATALOG OF COPYRIGHT ENTRIES, n.s., pt. 1, Books, Group 1, no. 5770, at 246 (1938) ("Tolkien, J. R. R.,* Oxford, England. Hobbit. © Mar. 1, 1938; 2 c. Mar. 7: aff. Mar. 4; A 115280. 5770."). As explained by John Mark Ockerbloom, an expert on the CCE Records:

This record attests that an affidavit was made of American manufacture, (that's what the "aff." means in this case), and that affidavit was received on March 4, followed by 2 copies of the work on March 7. The copyright registration date is March 1, and it was given registration identifier A-115280 The asterisk after Tolkien's name indicates that he is the copyright proprietor as well as the author.

E-mail from John Mark Ockerbloom to Elizabeth Townsend Gard (June 16, 2009) (on file with author).

378. We did find a record for the alternative title, *There and Back Again*, at the Rutgers site, but it was a record for 1994—many years past the renewal period. See RUTGERS COPYRIGHT RENEWAL RECORDS, <http://comminfo.rutgers.edu/~lesk/copyrenew.html> (search for "There and Back Again") (last

until January 1, 1996 (for twenty-nine years) *The Hobbit* was in the public domain. Section 104A restored the copyright, and therefore, the NIE proved useful for this work.

b. Vera Brittain: No NIEs

In the case of Vera Brittain, no NIEs were filed during the two-year period allotted by § 104A in the Copyright Act. So, the estate did not give constructive notice to the U.S. public that they intended to enforce their restored copyrights. This is particularly strange, as many of the works of her contemporary writers did have NIEs filed, including “Robert Graves, Leni Riefenstahl, C.S. Lewis and Alain Robbe-Grillet, for example.”³⁷⁹ Does this mean that *Testament of Youth* is actually free for use in a public domain context? No. Section 104A had a second method to notify reliance parties of an intent to enforce copyright restoration, and that is actual notice to the reliance party.³⁸⁰ If the restored copyright holder directly notifies a person using the previously public domain work, the restored copyright holder has the same twelve-month waiting process before infringement has actually occurred.³⁸¹ During that time, the reliance party is free to sell off copies made before the actual notice. However, no new uses of the previously public domain work may occur during the twelve-month period.³⁸²

The impact of actual notice is bizarre. A scholar, artist or other user could continue to incorporate *Testament of Youth* or *Poems of the War and After* into his work for the last fourteen years, without having had actual notice of enforcing the copyright from the copyright holder. If, however, the copyright holder sends actual notice, those uses must cease within twelve months, unless payment is negotiated. This is *not* how the copyright system works. Users run the risk of using materials—and copyright holders potentially gain a windfall—where a work has been built up to be economically valuable; and then, with actual notice, they can demand payment.

visited Nov. 4, 2010).

379. Gable, *supra* note 89, at 183 n.11. In 1996, Marybeth Peters noted which NIEs had already come into the Copyright Office:

It is interesting to note what has come in so far. By far, the majority of Notices of Intent to Enforce have been for motion pictures. Interestingly enough, they are generally Mexican films that were published without copyright notices before 1978. Owners of these Mexican films originally were under the impression that they were already protected under NAFTA, but subsequently discovered that they were not. We have also received many notices concerning Spanish motion pictures. In effect, the subject matter of the Notices of Intent to Enforce reveal the segments of the U.S. population in which works can be exploited. We are starting to receive notices for films from the United Kingdom, France, and Russia. In fact, Russian filmmakers contacted the Office with approximately 40,000 films to register. We are also getting notices for Russian music. Owners of rights to most of the works by major Russian composers, like Shostakovich and Kachaturian, have filed Notices of Intent to Enforce their works.

Peters, *supra* note 2, at 36–37.

380. 17 U.S.C. § 104A(e)(2) (2006).

381. *Id.* § 104A(d)(2)(B).

382. *Id.*

c. Improper NIEs: The Case of Charlie Chaplin

Two NIEs were filed for Charlie Chaplin's films.³⁸³ Both films were produced within the United States, and each had a first release date in the United States.³⁸⁴ Do they qualify merely because Chaplin was a U.K. citizen? If so, the expansion of restored works could be very great. But, in all likelihood, the NIE is invalid. However, the underlying script could have been registered as a work by Charlie Chaplin, and therefore restored if the script had not been renewed in its twenty-eighth year. I found no records to indicate that it had been registered.³⁸⁵ Moreover, the films do not meet the requirements, and there is no mechanism in place for improper NIEs. How is the public to know or to investigate whether NIEs are actually constructive notice or merely bullying over works that are actually ineligible?

B. Timing Reliance: The Two Year Gap

Section 104A creates three kinds of reliance situations where the uses are not infringing: the sale of copies (§ 109), the use of a work, and the creation of derivative works.³⁸⁶ All of the activities must have begun before the date the source country becomes eligible for their works to be restored.³⁸⁷ That date for many countries is December 8, 1994, when § 104A was enacted.³⁸⁸ But the work itself is not actually restored until January 1, 1996.³⁸⁹ So, § 104A creates a strange category of reliance parties who could have lawfully used the work for two years, but who are not eligible to be reliance parties.

Take, for example, my work on Vera Brittain. By June 1994, I had written my masters thesis, using quotes from *Testament of Friendship*, a work in the public domain in the United States due to lack of formalities. That use would be covered as reliance. Let's say I drafted my doctoral work during 1994 and 1995, again using materials from *Testament of Friendship*, but also *Testament of Youth* and *Poems of the War and After*, both of which were also still in the public domain. Under the current structure of § 104A, those uses—although still works that were in the public domain—do not allow me to be defined as a reliance party. If the use began before December 8, 1994 and continued, I would be granted reliance status. But if the use began before December 8, 1994 and expanded, only the materials

383. U.S. COPYRIGHT OFF. PUB. CATALOG, *supra* note 373 (search by keyword: V8002P599, V8002P600).

384. *A Woman of Paris*, WIKIPEDIA, http://en.wikipedia.org/wiki/A_Woman_of_Paris (last modified Oct. 23, 2010); *The Gold Rush*, WIKIPEDIA, http://en.wikipedia.org/wiki/The_Gold_Rush (last modified Dec. 5, 2010).

385. A manual investigation of the CCE records for dramatic compositions did not reveal entries for either film.

386. 17 U.S.C. §§ 104A, 109.

387. 3 NIMMER & NIMMER, *supra* note 19, § 9A.04[C][1][a].

388. Uruguay Round Agreements Act, Pub. L. No. 103-465, § 514, 108 Stat. 4809, 4976 (codified as amended at 17 U.S.C. § 104A).

389. 3 NIMMER & NIMMER, *supra* note 19, § 9A.04[B][1][b]. *But see* 7 PATRY, *supra* note 72, § 24 (arguing that the date is Jan. 1, 1995).

used before December 8, 1994 would fall under reliance. So, again, using the example of my doctoral work: if I incorporated my M.A. work into my dissertation, those uses would be reliance. But the work done after December 8, 1994, incorporating new public domain material—material still in the public domain for another two years—would as of January 1, 1996 constitute infringement.

Interestingly, the *Golan* cases contain no discussion of which dates and who counts as reliance parties.³⁹⁰ We are left wondering what First Amendment protection 1994–96 public domain users have.

VI. THE *GOLAN* COURT(S): COPYRIGHT TRADITIONS VS. TRADE POLICY

The Plaintiffs in *Golan* were all groups or individuals who relied on public domain works.³⁹¹ With the enactment of § 104A (Section 514 of the URAA), the works they had previously used were now automatically under copyright, and so they either had to cease the activities with the works or obtain licenses.³⁹² In many cases, the works had been chosen explicitly because no fees or permissions were required.³⁹³ The plaintiffs argued that the act of removing works previously available in the public domain violated the traditional contours of copyright law, and therefore required First Amendment scrutiny.³⁹⁴ In April 2005, Judge Babcock ruled in a motion for summary judgment, inter alia, that Section 514 of the URAA (§ 104A of the 1976 Copyright Act) did not require First Amendment scrutiny, as copyright restoration did not alter the traditional contours of copyright law.³⁹⁵

A. TENTH CIRCUIT *GOLAN* APPEAL

The (first) Tenth Circuit decision found that § 104A violated the traditional contours of copyright law, and therefore required First Amendment scrutiny.³⁹⁶ The Tenth Circuit came to this conclusion through the “traditional contours of copyright protection” language from *Eldred*.³⁹⁷ If the traditional contours are altered, then First Amendment review is warranted.³⁹⁸ Removing works from the public domain alters the traditional process of copyright—moving from creation to copyright to public domain. With § 104A, “the copyright sequence no longer

390. *Golan v. Holder*, 609 F.3d 1076 (10th Cir. 2010); *Golan v. Gonzales*, 501 F.3d 1179 (10th Cir. 2007).

391. *Golan v. Gonzales*, 501 F.3d at 1182.

392. Uruguay Round Agreements Act, Pub. L. No. 103-465, § 514, 108 Stat. 4809, 4976 (codified as amended at 17 U.S.C. § 104A).

393. *Golan v. Gonzales*, 501 F.3d at 1182.

394. *Id.* at 1186.

395. *Golan v. Gonzales*, No. Civ. 01-B-1854(BNB), 2005 WL 914754, at *17 (D. Colo. Apr. 20, 2005).

396. *Golan v. Gonzales*, 501 F.3d at 1192.

397. *Id.* at 1187.

398. *Id.*

necessarily ends with the public domain: indeed, it may begin there.”³⁹⁹

The *Golan* court defined “traditional contours” as a three-step process consisting of a work’s creation, a period during which it enjoyed copyright protection and when it finally enters the public domain.⁴⁰⁰ The court explained, “Until [§ 104A’s restoration of copyrights in foreign-origin works], every statutory [copyright] scheme preserved the same sequence Thus, by copyrighting works in the public domain, [§ 104A] has altered the ordinary copyright sequence.”⁴⁰¹ After further review, the court concluded that “[§ 104A] deviates from the time-honored tradition of allowing works in the public domain to stay there.”⁴⁰² The *Golan* court focused on the question of how does one actually define traditional contours, finding it involved both a historical and functional definition.⁴⁰³

The Tenth Circuit then described how the removal of the works from the public domain affected the First Amendment rights of the plaintiffs.⁴⁰⁴ They were no longer able to use the same works without restriction, a right the court called a nonexclusive “right to unrestrained artistic use of these works” protected by the First Amendment.⁴⁰⁵ Once the works entered the public domain, any artist, scholar or anyone else could use the work as they wished. That right was protected by the First Amendment: “once the works at issue became free for anyone to copy, plaintiffs in this case had vested First Amendment interests in the expressions, and § 514’s interference with plaintiff’s rights is subject to First Amendment scrutiny.”⁴⁰⁶ The Tenth Circuit remanded the case back to the district court for First Amendment analysis to determine whether § 104A should be analyzed as subject to content-based or content-neutral scrutiny.⁴⁰⁷ The question was not whether the plaintiffs were worthy reliance parties, but whether the foreign works could be restored without triggering a First Amendment right.⁴⁰⁸

B. THE REMANDED DISTRICT COURT DECISION

The Tenth Circuit had defined the question around the nature of the journey of a cultural work, and that once a work was in the public domain, the public had a First Amendment right to use the work freely and without interference.⁴⁰⁹ The recopyrighting of a work, after a work had come into the public domain, subjected the work to First Amendment scrutiny.⁴¹⁰ The task of the district court was to analyze whether Section 514 (§ 104A) should be scrutinized under a content-based

399. *Id.* at 1189.

400. *Id.*

401. *Id.*

402. *Id.* at 1192.

403. *Id.* at 1189.

404. *Id.* at 1192.

405. *Id.* at 1193.

406. *Id.* at 1194.

407. *Id.* at 1196.

408. *Id.* at 1192–93.

409. *Id.* at 1194.

410. *Id.*

or content-neutral standard.⁴¹¹

Judge Babcock wrote a thoughtful and balanced opinion. He recognized the need for the United States to comply with the Berne Convention and that restoration is an important government interest.⁴¹² But he also noted, following the lead of the Tenth Circuit, that restoration must be informed by constitutional restraints.⁴¹³ He found that the plaintiffs' interests required full First Amendment protection of use, once the work entered the public domain, and § 104A did not satisfy those needs.⁴¹⁴

He then turned to the question of reliance.⁴¹⁵ He explained that Berne gives no direct reference or specific suggestion on how to address reliance parties, and that Article 18(3) grants discretion to members on how to implement restoration.⁴¹⁶ He noted, "Several member nations—including Germany, Hungary, the United Kingdom, Australia, and New Zealand—provide accommodations that are temporally permanent so long as certain conditions are met."⁴¹⁷ Moreover, Judge Babcock noted that Congress understood that it had broad latitude on how to fulfill the Article 18 obligation.⁴¹⁸ He did not find the suppression of the plaintiffs' use of the works beyond the set reliance period in § 104A sufficiently "tied to the Government's interest" in complying with the Berne Convention, and it therefore was overly broad.⁴¹⁹

The third area he addressed was the Government's argument that § 104A was enacted in order to protect U.S. authors abroad. Judge Babcock rejected this argument fairly quickly, with the Government not providing sufficient evidence: "the Government proffers no evidence showing how suppression of reliance parties' First Amendment rights will lead to suppression of reliance parties' rights in foreign nations, or how such suppression will provide a 'direct and material' benefit to United States authors."⁴²⁰ Moreover, he noted that the same protection is not extended to American authors, and he did not see how allowing restoration of foreign works, but not domestic works, constitutes an important government interest.⁴²¹

411. *Golan v. Holder*, 611 F. Supp. 2d 1165 (D. Colo. 2009), *rev'd*, 609 F.3d 1076 (10th Cir. 2010).

412. *Id.* at 1172.

413. *Id.*

414. *Id.* at 1173.

415. *Id.* at 1174.

416. *Id.*

417. *Id.*

418. *Id.*; *see also* Brief of Professor Daniel Jervais as Amicus Curiae Supporting Respondents at 10–11, *Golan v. Holder*, 609 F.3d 1080 (10th Cir. 2010) (Nos. 09-1234 & 09-1261), 2009 WL 4899116 (noting that the Government's position that Article 18(3) should be interpreted narrowly has no textual basis in Berne itself: "Indeed, the text of the Convention may be constructed to take the position that it is desirable to apply retroactive protection narrowly."); SAM RICKETSON & JANE C. GINSBURG, *INTERNATIONAL COPYRIGHT AND NEIGHBOURING RIGHTS: THE BERNE CONVENTION AND BEYOND* 342 (2d ed. 2006).

419. *Golan v. Holder*, 611 F. Supp. 2d at 1175 (internal quotation marks and citation omitted).

420. *Id.* at 1175–76 (quoting *Turner Broad. Sys., Inc. v. F.C.C.*, 512 U.S. 622, 664 (1994)).

421. *Id.* at 1177.

The opinion is stunning. (This Article was nearly complete when the district court decision was handed down, and I was quite pleased that the court made the same connections that I had found in my research.) It took the Tenth Circuit decision in a slightly different direction, however. Judge Babcock began with the concept that the plaintiffs had vested rights in public domain works, and then focused on reliance questions.⁴²² To my thinking, it seems that Judge Babcock was bringing in the distinction of *Eldred* to *Golan*—that some who have already begun using the works have an interest, while those who had not begun using the works would not.⁴²³ But I think this is a wrong reading of *Eldred*, for it means that those who used a work at one time are treated differently from those who used the same work at a different time. *Eldred* concerned works that had not yet been in the public domain, while *Golan* concerns works that were in the public domain without a doubt.⁴²⁴ The status of a copyright term has never been determined by the user of the work, but rather focused on the work itself. The court makes a reasonable distinction between the two time periods, as a compromise.⁴²⁵ But it seems flawed in the logic of copyright law.

C. THE TENTH CIRCUIT REVIEWS THE REMANDED DISTRICT COURT DECISION

What happened next could only be described as a plot-twister. The remanded district court decision was appealed to the Tenth Circuit.⁴²⁶ The story would have probably ended there. Chief Judge Henry would have denied the appeal or affirmed the decision of the district court, perhaps expanding the decision not to merely reliance parties, but also extending the scope to any work that was in the public domain. The protection of the public domain was nearly at hand. One more potential fight at the Supreme Court level. Then, there was a shift in climate. Chief Judge Henry, the champion of the public domain, stepped down—after only two years as chief judge—to take a position as President at Oklahoma City University.⁴²⁷ Replacing Chief Judge Henry was Mary Beck Briscoe.⁴²⁸ Both Henry and Briscoe were Clinton appointees, but Briscoe had come up through government as her career path.⁴²⁹ Chief Judge Briscoe would dramatically alter the course of the debate with her opinion on June 21, 2010.⁴³⁰ The Tenth Circuit, on appeal from the remanded district court, found for the Government on all of the grounds that the remanded district court had dismissed.⁴³¹ Trade needs ruled the

422. *Id.* at 1165.

423. *See Eldred v. Ashcroft*, 537 U.S. 186 (2003).

424. *Id.*; *Golan v. Holder*, 611 F. Supp. 2d at 1167.

425. *Eldred*, 537 U.S. at 195.

426. *See Golan v. Holder*, 609 F.3d 1076 (10th Cir. 2010).

427. *Chief Judge Robert Henry is Appointed as the President of Oklahoma City University*, FOUND. FOR FUTURE (Dec. 21, 2009), <http://www.foundationforfuture.org/en/node/1137>.

428. *Mary Briscoe*, JUDGEPEdia, http://judgepedia.org/index.php/Mary_Briscoe (last modified May 5, 2010).

429. *Mary Beck Briscoe*, WIKIPEDIA, http://en.wikipedia.org/wiki/Mary_Beck_Briscoe (last modified Nov. 1, 2010).

430. *Golan v. Holder*, 609 F.3d 1076.

431. *Id.*

day. Copyright and the original Tenth Circuit decision became merely a footnote.

The decision is strange—the language becomes almost angry at times, defensive.⁴³² Gone is all reference to the “traditional contours of copyright law,” and “what goes into the public domain stays in the public domain.” In the procedural history regarding the first Tenth Circuit decision, the court writes, “We recognized that ‘legislation promulgated pursuant to the Copyright Clause must still comport with other express limitations of the Constitution,’ and concluded that the plaintiffs had ‘shown sufficient free expression interests in works removed from the public domain to require *First Amendment* scrutiny of [Section] 514.’”⁴³³ That is the only reference to Judge Henry’s argument about the nature of copyright law. The latest decision buries the arguments of its predecessor, and instead embraces a trade-approach and the government-is-always-right approach to the problem. The Tenth Circuit reverses the remanded district court decision and “conclude[s] that Section 514 of the URAA is not violative of the *First Amendment*.”⁴³⁴

The new decision is all about trade, with no trace of interest or concern for copyright laws or tradition. First and foremost, the court sees itself as a protectorate for American copyright holders’ interests abroad, and whatever it takes to put pressure on trading partners to protect American goods is a legitimate government interest, even when no actual cause and effect or substantial evidence exists.

The court begins the story regarding the United States joining the Berne Convention, and the requirement of Article 18: “[W]hen a country joins the Convention, it must provide copyright protection to preexisting foreign works even when those works were previously in the public domain in that country.”⁴³⁵ The implementing legislation, however, did not include this requirement, and it was only when a dispute resolution was put in place through TRIPs that the United States took seriously the need to restore foreign works. Congress was merely complying with its treaty obligations, and reliance parties had been taken into account.

The court starts with the presumption that foreign works had to be restored due to Article 18 of the Berne Convention.⁴³⁶ The *Golan v. Holder* court not only ignores the larger context in which Article 18 needs to be enacted, but it actually writes, “The parties’ arguments about what the Berne Convention requires and permits are beside the point.”⁴³⁷

The plaintiffs had made the argument that in restoring works in compliance with Article 18, the Government need also take into consideration “First Amendment interests of reliance parties.”⁴³⁸ The court does not address this argument, but

432. *Id.*

433. *Id.* at 1082 (quoting *Golan v. Gonzales*, 501 F.3d 1179, 1182 (10th Cir. 2007)) (emphasis added).

434. *Id.* at 1080 (emphasis added).

435. *Id.*

436. *Id.*

437. *Id.* at 1091.

438. *Id.*

instead goes into almost a defensive rant: “Thus, it is immaterial whether, as plaintiffs contend, the government could have complied with minimal obligations of the Berne Convention and granted stronger protections for American reliance parties.”⁴³⁹ The real focus of the government was not on American reliance parties, but rather on trade conditions abroad.⁴⁴⁰ If the United States provided strong reliance protection at home, foreign countries might also have done that as well, and American interests would have been hurt. The court has replaced with pure realpolitik the copyright arguments that had dominated the first *Golan* circuit court decision and the remanded district court opinion.

Three justifications have been offered for § 104A as it was drafted: 1) the need to meet treaty obligations; 2) the need to obtain legal protection for American copyright holders’ interests abroad; and 3) remedying past inequities. The second is held out as the most important reason—American interests abroad—and so this Article will pay particular attention to American interests in general, as well as abroad.

1. Meeting Treaty Obligations

One of the justifications the court gave for finding § 104A constitutional was the need to meet treaty obligations.⁴⁴¹ Under this rationale, TRIPs was enacted, and therefore anything in conflict with Berne must be altered in order to comply.⁴⁴² There are two basic problems with this line of thinking. First, § 104A does *not* meet the treaty obligations, as discussed before.⁴⁴³ Second, even the court acknowledges that § 104A could have given more to reliance parties, but that the United States did not want to have to reciprocate.⁴⁴⁴

Moreover, while the legislative history is full of testimony about the great need to enact § 104A, the United States quickly demonstrated disregard for other portions of the Berne Convention. The most blatant disregard came not from the moral rights requirement, which the United States was able to avoid fulfilling, but from § 110(5), the homestyle exception for playing music in restaurants.⁴⁴⁵ The European Union would win a WTO dispute against the United States, and the United States still did not change the law.⁴⁴⁶ Fear of a WTO dispute and even financial penalties does not seem to be a legitimate justification in light of our actual history.

439. *Id.*

440. *Id.* at 1087–88.

441. *Id.* at 1083.

442. *Id.* at 1081.

443. *See supra* Part II.

444. *Golan v. Holder*, 609 F.3d at 1091.

445. 17 U.S.C. § 110(5) (2006). The U.S. negotiated to make moral rights an option rather than a requirement for Berne and TRIPs. *See* ROBERTA ROSENTHAL KWALL, *THE SOUL OF CREATIVITY: FORGING A MORAL RIGHTS LAW FOR THE UNITED STATES* 37 (2010).

446. *See Dispute Settlement: Dispute DS160*, WORLD TRADE ORG., http://www.wto.org/english/tratop_e/dispu_e/cases_e/ds160_e.htm (last visited Dec. 4 2010) (summarizing dispute with E.U. over 17 U.S.C. § 110(5)).

2. Of Benefit to Americans Abroad

The court focuses most heavily on the need to protect American interests abroad.⁴⁴⁷ When Congress held hearings regarding what would become § 104A, a number of themes stand out, but most strongly was the rhetoric that § 104A was needed to benefit American authors and American industry. A number of congressmen and witnesses espoused the point that restoration of foreign works provided the “best way to ensure that some of our older American works, anything from Motown, to ‘Star Trek’ to ‘The Hardy Boys’ get the protection in some of these emerging foreign markets.”⁴⁴⁸ Adopting § 104A had no direct effect on the restoration of American works.⁴⁴⁹ If these works had fallen into the public domain in the United States, they remained there. A good example is George Romero’s *Night of the Living Dead*, which has become an industry in itself and is in the public domain due to lack of copyright notice.⁴⁵⁰ The film was not restored by § 104A, and, in fact, as we have discussed before, American works were explicitly excluded from restoration.⁴⁵¹ Why were American works excluded when the rhetoric was all about American works?

The court and the legislation divided Americans.⁴⁵² In fact, the court refers to the plaintiffs as one case and American copyright holders as another.⁴⁵³ The problem is that the court only looked to large industry concerns about enforcement of copyrights abroad.⁴⁵⁴ Domestic American works became the enemy and irrelevant. At one point, the court even writes that the reason reliance has to be short is that we don’t want to have to give very much reliance time to foreigners abroad using American works. This attitude is pure capitalist trade. The spirit of copyright is gone. The idea that the United States would not respect reliance parties abroad, and that to do so would harm their own citizens is shocking from a copyright standpoint. Copyright law is territorial.⁴⁵⁵ We should be caring about the laws at home, rather than using the laws at home as part of a larger trade tool abroad.

In its analysis, the court begins with the question of whether § 104A was “directed at an important or substantial government interest unrelated to the

447. *Golan v. Holder*, 609 F.3d at 1083.

448. *General Agreement on Tariffs and Trade (GATT): Intellectual Property Provisions: Joint Hearing on H.R. 4894 Before the Subcomm. on Intellectual Property and Judicial Administration of the H. Comm. on the Judiciary and the Subcomm. on Patents, Copyrights and Trademarks of the S. Comm. on the Judiciary*, 103d Cong. 85 (1994) (statement of Rep. Becerra, Member, H. Comm. on the Judiciary).

449. 3 NIMMER & NIMMER, *supra* note 19, § 9A.04 n.51.

450. *Night of the Living Dead*, WIKIPEDIA, http://en.wikipedia.org/wiki/Night_of_the_Living_Dead#Copyright_status (last modified Dec. 4, 2010).

451. 3 NIMMER & NIMMER, *supra* note 19, § 9A.04 n.51.

452. *Golan v. Holder*, 609 F.3d at 1084.

453. *Id.*

454. *Id.* at 1085–86.

455. See William Patry, *Territoriality*, PATRY COPYRIGHT BLOG (Nov. 21, 2006, 9:34 AM), <http://williampatry.blogspot.com/2006/11/territoriality.html> (discussing the territorial nature of copyright law).

suppression of free expression,” the first requirement in upholding the law.⁴⁵⁶ The court defensively explains, “Although plaintiffs have First Amendment interests, so too do American authors.”⁴⁵⁷ First, the plaintiffs are American authors. Second, the First Amendment interest to which the court refers is the right to have American works covered by copyright abroad. I do not think this is actually a First Amendment interest because U.S. law does not cover it. Moreover, if the government was to make a First Amendment argument for the indirect impact of § 104A pressuring governments abroad to restore copyright in U.S. works, the argument would actually have to be *made*. Instead, the court merely writes, “Securing foreign copyrights for American works preserves the authors’ economic and expressive interests. These interests are at least as important or substantial as other interests”⁴⁵⁸ Section 104A does not secure foreign copyright for American works. Section 104A secures foreign copyrights in the United States. The court chooses an indirect American interest in which the copyright law has no territorial jurisdiction over a direct American *First Amendment* interest covered by copyright law.

The court then, feeling it has proved a substantial government interest in enacting § 104A for American interests abroad, moves to the idea that “Section 514 [§ 104A] addresses a real harm.”⁴⁵⁹ The task of the court is to find that the “statute must be directed to a real, and not merely a conjectural harm.”⁴⁶⁰ Of course, this is all conjecture—that foreign countries will restore American works because the United States has set a moral example. At the time of enactment, there was no guarantee that that would occur. The court acknowledges that there must be evidence of real harm, and then also spends a great deal of time describing the need to give substantial deference to Congress.⁴⁶¹ The court uses two pieces of testimony, one from the Recording Industry Association of America (RIAA) representative and the other from the International Intellectual Property Alliance (IIPA), both industry groups.⁴⁶² In fact, the court heavily relies for all of its evidence on Eric Smith from IIPA.⁴⁶³ From the RIAA, the court quotes, “[T]here are vastly more U.S. works currently unprotected in foreign markets than foreign ones here,” suggesting that U.S. works are unprotected throughout the world.⁴⁶⁴ In fact, the numbers of countries that were not members of Berne, or that had not implemented the required copyright protection for the United States was very small: Japan for sound recordings from the 1940s through 1970s, Russia for works before they joined the U.C.C. in 1973 and a few other countries, like China and Thailand. On the other side, the amount of works that were restored by § 104A is uncountable because it included not only musical compositions, paintings, films

456. *Golan v. Holder*, 609 F.3d at 1084.

457. *Id.* (internal citation omitted).

458. *Id.*

459. *Id.*

460. *Id.*

461. *Id.* at 1084–85.

462. *Id.* at 1086, 1088.

463. *Id.* at 1088–89.

464. *Id.* at 1086.

and literature, but also every piece of ephemera created through most of the twentieth century—menus, theatre programs, posters, stamps, sketches, labels on commercial goods—everything that could possibly have copyright.

Having relied on the RIAA and IIPA for evidence of harm, the court then turns to the question of whether § 104A would alleviate the harm.⁴⁶⁵ The harm described was billions of lost dollars from works unprotected by copyright abroad.⁴⁶⁶ Section 104A has no direct relationship in recovering those lost dollars. It is speculated that Russia and Thailand will follow the lead of the United States, at least according to the General Counsel of the IIPA. The court also acknowledges that § 104A “may induce” compliance from other countries.⁴⁶⁷ The evidence and the question of whether the harm will be alleviated are weak at best. But the court does not stop there.

The court next turns to the question of reliance, and why the period and protection for reliance parties was so short.⁴⁶⁸ The court blatantly explains that American copyright holders do not want to provide reliance periods of any length abroad. We sacrifice at home to get more abroad. Again, this means that the court chooses to prioritize some American copyright holders’ speculative interests by harming Americans abroad. It is here the court gets defensive, declaring that there is no requirement that the United States enact only the minimum requirements for Article 18.⁴⁶⁹ The court then goes into a convoluted discussion comparing the U.S. system to the British system.⁴⁷⁰ Again, striking a rather defensive tone, the court explains that the British system requires the copyright holder to buy out any reliance party if the copyright holder wants the use to cease.⁴⁷¹ The court hastily rejects this idea.⁴⁷² Then, the court suggests the American system—whereby the burden is on the user to try to work out a licensing arrangement with the copyright holder once the twelve-month period has lapsed—is just like the British system in reverse, and that it really makes no difference which system one adopts.⁴⁷³ Of course, the systems are very different. The British system gives the user an ongoing right until a copyright holder pays them to stop.⁴⁷⁴ The American system creates copyright infringers of users, unless they are able to negotiate a license (from a very weak negotiating place).⁴⁷⁵ The court even admitted, “the United Kingdom model is arguably more protective of reliance parties’ *economic* interests”⁴⁷⁶ But reliance parties are really not the concern of this court.

The court ends its discussion with reference to the first district court decision—

465. *Id.*

466. *Id.*

467. *Id.* at 1087.

468. *Id.* at 1091.

469. *Id.* at 1091–92.

470. *Id.* at 1092.

471. *Id.* at 1093.

472. *Id.*

473. *Id.*

474. *Id.*

475. *Id.*

476. *Id.*

ignoring the first appellate decision and the remanded district court decision—explicitly stating that the “plaintiffs have provided no legal support for their claim that the First Amendment—either by itself or informed by any other provision of the Constitution—draws such absolute, bright lines around the public domain, and we are aware of no such authority.”⁴⁷⁷ The court held that “Congress had the authority to extend copyright to works that were in the public domain.”⁴⁷⁸

But more than the details is the lack of awareness of copyright law at all. The fact that the court eagerly supports a system whereby copyrights are restored abroad with little legal support for reliance parties is shocking. In fact, the only place we have been able to determine that a system such as this has been put in place is in Russia.⁴⁷⁹ Foreign and domestic works were restored, and upon that restoration, any further use of the works was copyright infringement.⁴⁸⁰ I would imagine the 2010 Tenth Circuit *Golan* court would see that as great success. However, it does not conform to fairness, or to the incentive based copyright system upon which we have come to rely.

VI. CONCLUSION

The public domain is all around you: all the words in our language, all the works published by the US government, all of Shakespeare, all of Dickens, all of Wells, Verne, Austen, etc. It’s our collective inheritance, the limitlessness resource from which all may draw: Disney can use it to make *Snow White and the Seven Dwarfs*, and so can I, and so can you. Sometimes, we do good things with the public domain (being married to an Alice, I have a passion for wonderful *Alice in Wonderland* editions, and there are many of these). Sometimes, we do stupid things with it (Mr. Burton, I’m looking at your *Alice* adaption in particular). But no matter what we do with it, it endures, and all and any may use it as they wish.⁴⁸¹

A. A SUMMARY OF THE PROBLEMS

In a key hour of need, Judge Henry abandoned the public domain for a post at a university.⁴⁸² The U.S. Supreme Court could have overturned the decision, of course, but then we would not be in the situation we are now. We had been on the path of a constitutionally protected public domain. Now, trade law has blindly trumped copyright tradition. Nothing is safe or sacred in the path of trade policy. We must band together to preserve the public domain, so that it *may endure for all to use as they wish*. At the moment, it seems to be under great threat.

In *Suntrust Bank v. Houghton Mifflin Co.*, the court explained that the

477. *Id.* at 1095.

478. *Id.*

479. See generally MICHEL ELST, COPYRIGHT, FREEDOM OF SPEECH, AND CULTURAL POLICY IN THE RUSSIAN FEDERATION (William B. Simons ed., Law in Eastern Europe Ser. No. 53, 2005).

480. *Id.*

481. Cory Doctorow, *Proprietary Interest*, LOCUS (Sept. 2, 2010), <http://www.locusmag.com/Perspectives/2010/09/cory-doctorow-proprietary-interest/>.

482. *Chief Judge Robert Henry is Appointed as the President of Oklahoma City University*, *supra* note 427.

relationship between copyright law and the First Amendment was bound by the common goal of preventing censorship.⁴⁸³ “In copyright law, the balance between the First Amendment and copyright is preserved, in part, by the idea/expression dichotomy and the doctrine of fair use.”⁴⁸⁴ This has become a fairly standard argument—that First Amendment protections are satisfied by idea/expression and fair use.⁴⁸⁵ The first *Golan* appeals court saw the First Amendment as playing an additional role in what the *Eldred* court has called “the traditional contours of copyright law” and what *Suntrust* saw as integral to the copyright mandate.⁴⁸⁶ The First Amendment seemed to have been playing a new role of protecting and preserving the public domain. But the most recent *Golan v. Holder* dashes all hopes.

Article 18(1) of the Berne Convention does require new signatories to adhere Berne minimum standards “to all works which, at the moment of its coming into force, have not yet fallen into the public domain in the country of origin through the expiry of the term of protection.”⁴⁸⁷ However, Article 18(3) provides possible flexibility for new signatories.⁴⁸⁸ Moreover, the *WIPO Guide* notes recognize the concept and needs of reliance parties, that is those “who have, quite properly, taken steps to exploit these [public domain] works and who would be financially embarrassed, to say the least, if the authors suddenly acquired exclusive rights to control what [the reliance parties] had been freely doing.”⁴⁸⁹ Section 104A did not go far enough in taking into consideration the needs for protecting reliance parties in a temporally permanent context.

Earlier in this Article, I suggested that §§ 104(a) and 303(a) got it right in how the change altered the copyright status of unpublished works but upheld the traditional contours of copyright.⁴⁹⁰ It seems that § 104A, however, got it wrong. The original Tenth Circuit decision found that a key element to the public domain was that once a work came into the public domain, it should stay there, and that § 104A violated this principle.⁴⁹¹ That said, § 104A got it wrong in other ways as well. Unlike § 303(a), which allowed for monumental changes to be implemented with a twenty-five year transition period, § 104A happened rapidly. The legislation was enacted at the end of 1994, and for most works, the restoration occurred in 1996, with the reliance parties only being given one year to alter their behavior.⁴⁹² Works that had long been in the public domain were given copyright protection,

483. *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1263 (11th Cir. 2001).

484. *Id.*

485. *See, e.g., Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003); *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349–50 (1991).

486. *Eldred*, 537 U.S. at 221.

487. Berne, *supra* note 21, art. 18.

488. *Id.*

489. CLAUDE MASOUYÉ, WORLD INTELLECTUAL PROP. ORG., GUIDE TO THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS (PARIS ACT, 1971) 101 (1978).

490. *See supra* Part IV-D-1.

491. *Golan v. Gonzales*, 501 F.3d 1179, 1189 (10th Cir. 2007).

492. Uruguay Round Agreements Act, Pub. L. No. 103-465, § 514, 108 Stat. 4809, 4976 (codified as amended at 17 U.S.C. § 104A).

often for the first time, with no incentive given to the copyright holder to further enhance the public benefit. Section 104A should have had a longer transition period, especially when it came to reliance parties, and should also have had a mechanism that encouraged copyright holders to exploit their works, rather than merely giving a copyright term without any additional benefit to the public.

More important, however, was the addition of looking outside of our system to determine the copyright status of a work. Before the enactment of § 104A, the copyright system operated as a unified closed system. We did not adopt the Rule of the Shorter Term, and therefore, to determine the copyright status of a given work, we need only look to the copyright term within the United States.⁴⁹³ Now, with the enactment of § 104A, in order to determine when a foreign work expires in the United States, one must determine the copyright term in its country of origin.⁴⁹⁴ This may seem a simple task, but it means that nearly 200 country's laws are now incorporated into the U.S. copyright law.⁴⁹⁵ It has complicated the U.S. system beyond reason, without giving any benefit to U.S. citizens. Moreover, the Rule of the Shorter Term is not applied to foreign works that have been restored, and so foreign works gain greater benefit from the system.⁴⁹⁶

Was there a better way to fulfill the Article 18 requirements, and should we fulfill those requirements, ignoring the public benefit and expectations under our traditional contours? Moreover, should anyone trust that the public domain is just that—a domain of works open to the public? Could other works be restored? Could other restrictions be placed on public domain works?

Unfortunately, § 104A took its own path—neither complying with Berne, nor complying with the traditional contours of our copyright system. Our public domain has suffered greatly, both by the removal of works, and also by the added uncertainty of which works now are under copyright and which remain in the public domain. The short transition periods given under § 104A further frustrate the intentions of the Copyright Clause, and should have been more comparable to the incentive and longer transitions available for § 303(a). No incentives for copyright holders to further use or take advantage of the restored work were built in, again contravening the essence of our copyright system. Moreover, the legislation—clearly a trade tool—should be reevaluated on the grounds of the motive behind the Act. There is some indication that alternative government measures to achieve the same gains might have been possible, if not more prudent. Moreover, if sound recordings in Japan were one of the main reasons for enacting § 104A, with restoration of sound recordings in the United States comprising only a very small amount of the restored works, one wonders how the government can justify restoration of many more millions of works to achieve a specific trade goal, again when other mechanisms, such as Special 301 and bilateral trade agreements might have solved the problem without disrupting the entire ecosystem of copyright. What limits do trade representatives have on dismantling long

493. 3 NIMMER & NIMMER, *supra* note 19, § 9.12[A].

494. 17 U.S.C. §104A(h)(6)(B) (2006).

495. See U.S. COPYRIGHT OFFICE, *supra* note 158.

496. 3 NIMMER & NIMMER, *supra* note 19, § 9.12[A].

established copyright norms and systems?

Reliance parties suffer the most in this system, not to mention all of the future parties that might have used the work had they remained in the public domain. Section 104A creates a sort of strange quasi-public domain, where if a person had been using the work before 1994, they can continue until an NIE or actual notice was filed.⁴⁹⁷ This means that now, in 2010, a reliance party could have been consistently using a work—a short story in an anthology, or musical composition in a film—for over sixteen years, and a restored copyright holder can stop that use through actual notice. No incentive or limitations on the restored copyright holders' actions were taken into account, and those that were—going to court to determine reasonable payment, for example—are out of reach for most people.

B. SOLUTIONS

So, what are the alternatives now that the system has been put in place?

1. Overturn *Twin Books*

Twin Books makes restoration confusing and messy, and the opinion seems to be based on a misunderstanding of the law.⁴⁹⁸ Nevertheless, the opinion has brought uncertainty and confusion, broadening, overlapping and limiting § 104A. There is no need for *Twin Books*. *Twin Books* brings uncertainty to the copyright status of works published before 1923, which most assume is a settled category. Section 104A includes works that did not meet the formality requirements under U.S. law; so too does *Twin Books*.

2. Reform the Reliance Portion of § 104A

First, reliance should include not only users before December 1994, but also users legally using a work until restoration on January 1, 1996. Second, users should not have the burden of negotiating for continued use with the copyright holder. Third, the term of one year should have been considerably longer, giving the user enough time to recoup expectations, both financial and otherwise. Finally, there is the case of actual notice.

The period of constructive notice, for the most part, is over. We are now in a state of actual notice, where those copyright holders who did not file NIEs may put a specific user on notice of enforcing their copyright. The law should be changed to allow for the use to continue for a period greater than one year. Reliance users—those using the work before the work became restored—have now been using the work for almost fifteen years post-restoration. The idea that a copyright holder could suddenly stop that activity seems to create a disincentive for copyright. Copyright is a utilitarian system whereby creators and the public all are encouraged

497. 17 U.S.C. § 104A.

498. *Twin Books Corp. v. Walt Disney Co.*, 83 F.3d 1162 (9th Cir. 1996).

to create works.⁴⁹⁹

Users wanting to use restored works should have a mechanism by which they can provide constructive notice of interest in using the work. These are new post-1998 reliance parties. If the user gets no response to the constructive use notice, presumably filed at the U.S. Copyright Office, or even at the source country's copyright office, then the reliance party should be able to use the work without worry of statutory damages or injunctions.

If there is no evidence of productive uses on the part of the restored copyright holder after a period of years, the work should be presumed to be in a quasi-public domain, modeled after the translation rights available for developing countries under TRIPs.⁵⁰⁰ If after a period of time—even twenty years from reenactment—no economic activity has occurred within the United States, users should be allowed to use the work without fear of statutory damages or injunctions.

Noncommercial uses of restored works should be available without permission from copyright holders, regardless of when the use begins (pre-1994 reliance and post-1994 reliance parties). Statutory damages should not be available for restored works. Alternatively, the United States could adopt a system similar to the British model, where copyright holders “buy out” reliance users.⁵⁰¹ But this method would require further study, as well as looking into potential other ways that countries have successfully managed reliance interests. The *Golan* courts have spent little time comparing these systems to date.

3. Revising the Terms of § 104A

If § 104A is to stand, it should at least actually conform to the requirements of Article 18(1) of Berne.⁵⁰² This would mean that publication-based duration would be replaced with a life-plus-fifty minimum term, except in select categories, as required by the Berne Convention. Second, § 104A should include the Rule of the Shorter Term.⁵⁰³ Currently, we have to look outside to foreign law to determine the eligibility of a potentially restored work, but the work gets the benefit of the term in the United States.⁵⁰⁴ If we are going to a Berne-like system, we should adopt the Rule of the Shorter Term as well. If trade law is really the rule of the day, then the Rule of the Shorter Term makes a great deal of sense because it encourages other systems to adopt longer terms for greater protection in the United States. Right now, we look outside to foreign law, but then use our own law as the sole source of calculation.⁵⁰⁵ It makes no sense.

499. U.S. Const. art. I, § 8, cl. 8.

500. CAROLYN DEERE, *THE IMPLEMENTATION GAME: THE TRIPS AGREEMENT AND THE GLOBAL POLITICS OF INTELLECTUAL PROPERTY REFORM IN DEVELOPING COUNTRIES* 59 (2009).

501. *Golan v. Holder*, 609 F.3d 1076, 1093 (10th Cir. 2010).

502. Berne, *supra* note 21, art. 18(1).

503. See Paul Edward Geller, *International Copyright: An Introduction*, in 1 *INTERNATIONAL COPYRIGHT LAW AND PRACTICE*, *supra* note 172, at INT § 2[3][b]; see also GOLDSTEIN, *supra* note 238, at 239.

504. 3 NIMMER & NIMMER, *supra* note 19, § 9A.04[B][3].

505. *Id.*

4. Protecting the Concept of the Public Domain

Most importantly, we should balance our trade needs with our domestic copyright system. Article 18(3) provided for such a mechanism.⁵⁰⁶ Congress chose to ignore this portion of Article 18. Our system requires certainty and stability. Section 104A dramatically disrupted both. The public domain is not a free space where works can be re-propriety. The public suffers the loss, and the public deserves better. While foreign copyright holders gain additional monopolies on their work, the public has gained nothing in return. Congress too easily gave away works that were not theirs to re-copyright. Could they give back Louisiana and all of the land of the Louisiana Purchase? We must think of the greater consequences of trade policy on domestic uses of resources. The bargain does not seem worthwhile, particularly when other alternatives for conforming to Article 18 and putting outside pressure on foreign governments (i.e., Special 301s) exist.⁵⁰⁷

C. CONCLUDING THOUGHTS

In many ways, it appears as if we are at a crossroads—a *Donaldson v. Becket/Wheaton v. Peters* moment of sorts.⁵⁰⁸ The turn of the eighteenth into the nineteenth century saw English and American law deciding that once a work was published, statutory protection ended the common law “right of first publication.”⁵⁰⁹ Copyright in a cultural work was not perpetual—statutory protection expired after “limited Times.”⁵¹⁰ Judge Learned Hand wrote, “It is of course true that the publication of a copyrightable ‘work’ puts that ‘work’ into the public domain except so far as it may be protected by copyright. That has been unquestioned law since 1774.”⁵¹¹ These decisions created the public domain, which had been taken for granted ever since—until the mid-1990s, when an amendment to the 1976 Copyright Act revived/restored copyright to foreign works that had entered the public domain in the United States.⁵¹² Now, the courts have been asked to decide the stability or permanent nature of that statutory protection. Once a work has passed into the public domain, can it revive?⁵¹³ Can a work’s copyright begin and end and begin again? What exactly is the physics of copyright?

Copyright law had seen a good deal of alterations to its “traditional contours”

506. Berne, *supra* note 21, art. 18(3).

507. See generally Nicole Telecki, Note, *The Role of Special 301 in the Development of International Protection of Intellectual Property Rights After the Uruguay Round*, 14 B.U. Int’l L.J. 187 (1996).

508. See *Millar v. Taylor*, (1769) 98 Eng. Rep. 201 (K.B.); 4 Burr. 2303. *Contra* *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834); *Donaldson v. Beckett*, (1774) 1 Eng. Rep. 1837 (H.L.); 4 Burr. 2408.

509. See 1 NIMMER & NIMMER, *supra* note 19, § 4.02.

510. *Letter Edged in Black Press v. Pub. Bldg. Comm’n*, 320 F. Supp. 1303, 1308 (N.D. Ill. 1970) (“The inclusion of this caveat in the Constitution makes manifest the right of society to ultimately claim free access to materials which may prove essential to the growth of the society.”).

511. *Nat’l Comics Publ’ns, Inc. v. Fawcett Publ’ns, Inc.*, 191 F.2d 594, 598 (2d Cir. 1951).

512. See 17 U.S.C. § 104A (2006).

513. See generally Geller, *supra* note 49.

throughout the 1990s—in part as a reaction to new technologies, and as in this case, as a response to treaty obligations. Antibootlegging, digital rights management and anticircumvention of access controls are three examples, as was restoration of foreign works. The question people began to ask was how far could legislation push copyright law? Were there basic assumptions that guided copyright law, or was copyright law merely a response to contemporary needs?

Until the last *Golan* decision, the *Golan* case began to provide hope that there are limitations to the trade-madness of the 1990s. We must bring back a proper balance of copyright and trade, rather than forgetting the traditional contours of a long-established system for specific, short-term gains abroad. Perhaps we are coming closer to a constitutionally-defined public domain.

As the first Tenth Circuit decision in *Golan* described it, once a work is in the public domain, it stays there.⁵¹⁴ A constitutionally-defined public domain would protect the concept that a work is created, legally protected and then released into the public domain. A constitutionally-defined public domain would require certainty—that users are able to determine the legal status of a work, without any confusion or difficulty surrounding the legal status.⁵¹⁵ A constitutionally-defined public domain would recognize that the public domain is a great U.S. cultural resource that is to be protected, just as national parks, historical monuments or other great treasures are protected. Our policies would reflect not merely large industry's pressuring for higher standards of protection abroad, but also would reflect our own high standards, based on the constitutional clause, "to promote the Progress . . . for limited Times . . ." for the benefit of all.⁵¹⁶

Concepts like "traditional contours of copyright law" and "the copyright mandate," with the help of the First Amendment just might ensure that courts take action to preserve such spaces.⁵¹⁷ In the end, I suggest that Peter Jaszi's search for language might be found in the combination of the phrase "traditional contours of copyright law" and the First Amendment.⁵¹⁸ The removal of millions of works that the Register of Copyright, Marybeth Peters, previously acknowledged were part of the public domain might just turn out to be the event that triggers the recognition of the need to define and protect our national treasures held in common.⁵¹⁹ The internal logic or physics of copyright law must be taken into account, even as needs and technology change. Now, in the early years of the twenty-first century—three hundred years after the first copyright act—we may be on the threshold of constitutionally defining the public domain.

This Article suggests that part of the problems with § 104A stems from a focus on extraterritorial trade, rather than copyright concerns. This Article advocates for

514. *Golan v. Gonzalez*, 501 F.3d 1179, 1189 (10th Cir. 2007).

515. We have been working on this problem for a number of years at Tulane Law School, and it has taken the form of a software tool we call the Durationator™. See THE DURATIONATOR, <http://www.durationator.com> (last visited Nov. 3 2010).

516. U.S. Const. art. I, § 8, cl. 8.

517. See *Eldred v. Ashcroft*, 537 U.S. 186, 221 (2003); *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257 (11th Cir. 2001).

518. See Jaszi, *supra* note 1.

519. Peters, *supra* note 2, at 31.

2011]

COPYRIGHT LAW V. TRADE POLICY

199

the public's cultural resources. The pressures of trade law must be balanced with the copyright bargain set out in the Constitution and developed both through legislation and the courts. While sacrifices may have to be made in the name of trade, they should not be done recklessly or with disregard to established expectations and traditions. Section 104A, unfortunately, is not the only instance where Congress disregarded copyright law for trade law pressures.