Golan Restoration: Small Burden, Big Gains

Dale Nelson[*]

I. INTRODUCTION

In *Golan v. Holder*, the Supreme Court will have an opportunity to decide whether Congress violated either the Progress Clause or the First Amendment when it enacted section 514 of the Uruguay Round Agreements Act ("URAA"), which contains the restoration provisions codified in § 104A of the United States Copyright Act. The URAA, through § 104A, restores copyright protection for a small class of foreign works that fell into the public domain in the United States for reasons other than expiry of the copyright term. This Essay supports the view that § 104A is not unconstitutional and that Congress was well within its authority in restoring copyright protection for these works. This Essay will not

* Vice President, Senior Intellectual Property Counsel, Warner Bros. The views expressed herein are my own and should not be attributed to Warner Bros. Many thanks to Jeremy N. Williams, Eric J. Schwartz, and Wendoline C. Infante for their generous assistance and comments.

address the legal arguments in the case, which have been fully briefed by the parties and their amici. Rather, it presents a focused factual look at exactly which works are restored by the URAA and an overview of the myriad of interests served by the URAA. This examination will illustrate that the class of works affected is small relative to the public domain in general and relative to the significantly greater gains achieved by the URAA. These gains are multifaceted and include (1) improved international trade relations between the United States and its trading partners; (2) improved copyright protection for the works of all U.S. authors; (3) furtherance of the goals of the Progress Clause; (4) greater uniformity between U.S. and foreign copyright law; and (5) fair, equitable, corrective, and just results for deserving authors of foreign countries.

II. SMALL BURDEN

The *Golan* Petitioners express concern that the URAA depletes the rich supply of public domain works and restores copyright protection for "millions" of works, to the detriment of reliance parties such as Lawrence Golan and the late Richard Kapp.[1] Petitioners cite the musical compositions of Russian composer Dmitri Shostakovich as examples of restored works that should never enjoy any U.S. copyright protection. Rather, Petitioners argue, such musical masterpieces should stay in the U.S. public domain, where they have been since their creation, so that others may copy, adapt, and otherwise use them freely. Putting aside for a moment the injustice of this position to Shostakovich—a point to which I will return—let us explore Petitioners' assertion that "millions" of works are affected by the URAA. Although it is impossible to know the actual number of restored works, can we estimate the size of the pool? And if we can estimate, then how significant is the effect of their restoration on the public domain and users?

A. Statutory Limitations on Restoration

Application of the statute reveals a number of temporal parameters that help define the class of works eligible for restoration. To begin, restoration applies only to works published after 1923, because the U.S. copyright terms for works published earlier have already expired. By its terms, § 104A provides that any restored work is entitled to only "the remainder of the term of copyright that the

1. Brief for the Petitioners at 10, 25, Golan v. Holder, No. 10-545 (U.S. June 14, 2011).

work would have otherwise been granted in the United States if the work never entered the public domain in the United States."[2] The copyright term that any work published prior to 1923 "would have . . . been granted" expired under either the applicable Copyright Act of 1909 ("1909 Act"), which provided fifty-six years of protection;[3] the Copyright Act of 1976 ("1976 Act"), which extended protection to seventy-five years;[4] or earlier copyright acts than these.[5] Such a work fell into the public domain *due to expiry of the term* and therefore has no remainder of the term left under § 104A(h)(6)(C). The work will stay in the public domain and will not be restored. Thus, anything published before 1923—such as the works of Charles Dickens, Jane Austen, Confucius, Shakespeare, Mozart, Titian, Michelangelo, and millions and millions of other great works created over the past thousand years and beyond—is untouched by the restoration provision of the URAA and remains in our rich public domain. Copyrights in works published during 1923 will expire in 2018, only six years away, joining the others in the public domain. As each year passes thereafter, works from 1924, 1925, and so on will likewise pass into the public domain. For these works, there will be no copyright term barrier to Petitioners' exploitation of them in the United States. After 2018, therefore, Petitioners can look forward to an increasingly diminished class of restored works than that which currently exists.

As shown above, a publication date prior to 1923 comprises one temporal parameter limiting the set of works eligible for restoration under § 104A. A further examination of the statute suggests several additional temporal limitations. To qualify for restoration, a work must have fallen into the public domain through one of three potential

---

2. 17 U.S.C. § 104A(a)(1)(B) (2006). Read with the definition of "restored work" in § 104A(h)(6)(C)—namely, that "[t]he term 'restored work' means an original work of authorship that . . . is in the public domain in the United States due to–(i) noncompliance with formalities imposed at any time by United States copyright law, including failure of renewal, lack of proper notice, or failure to comply with any manufacturing requirements; (ii) lack of subject matter protection in the case of sound recordings fixed before February 15, 1972; or (iii) lack of national eligibility"—§ 104A(a)(1)(B) means the restored work will receive copyright protection for the remainder of the term it would have received if it had not fallen into the public domain for the reasons enumerated in § 104A(h)(6)(C).

3. Copyright Act of 1909, ch. 320, § 23, 36 Stat. 1075, 1080 (codified at 17 U.S.C. § 24 in 1947, repealed 1978).

4. Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (codified as amended at 17 U.S.C. §§ 101-805 (2006)). The 1976 Act used the system in the Copyright Act of 1909 to compute copyright duration for works protected by federal copyright before January 1, 1978, with one major change: the length of the renewal term was increased to forty-seven years, to equal a total of seventy-five years of protection. *Id.* § 304(a)–(b) (codified as amended at 17 U.S.C. § 304(a)–(b)).

5. For a general explanation of applicable terms of protection and their timing, see 3 NIMMER ON COPYRIGHT §§ 9.08, 9.11 (2011).

avenues: (i) noncompliance with formalities imposed at any time by U.S. copyright law, including failure of renewal, lack of proper notice, or failure to comply with any manufacturing requirements; (ii) lack of subject matter protection in the case of sound recordings fixed before February 15, 1972; or (iii) lack of national eligibility.[6] Let us take each category in turn.

Noncompliance with renewal requirements applies only to works published prior to 1964. For works governed by the 1909 Act—namely, works created or published before January 1, 1978—a copyright owner was required to file a timely renewal registration in order to prevent her work from entering the public domain.[7] Congress subsequently enacted the Copyright Renewal Act of 1992 ("1992 Act"), which made renewal terms automatic for any works copyrighted between January 1, 1964, and December 31, 1977 (that is, works that were still in their first term when the 1992 Act went into effect).[8] Where renewal was automatic, a work could not fall into the public domain for failure to renew. Thus, at least for works that fell into the public domain for failure to renew, the class of restorable works is limited to those published prior to 1964. Given the above analysis, the set of works restorable under the URAA in this category is limited to those published between 1923 and 1964, a span of only forty-one years. When compared to the *centuries* of works published prior to 1923, which are already committed to the public domain, and the nearly fifty years (and growing) worth of works created since, which were not subject to renewal, this subset of forty-one years worth of works is temporally narrow in scope (and further limited in size by factors set forth below).

Similarly, the formality of copyright notice, which was mandatory under both the 1909 and the 1976 Acts,[9] was eliminated by the Berne Convention Implementation Act of 1988 ("BCIA").[10] Thus, after the Berne Convention became effective in the United States in 1989, a work could no longer fall into the public domain for failure to

---

6. 17 U.S.C. § 104A(h)(6)(C) (2006).

7. Any work created or published after January 1, 1978 does not require renewal. *Id.* §§ 302–03 (2006).

8. Copyright Renewal Act of 1992, Pub. L. No. 102-307, 106 Stat. 264 (codified as amended at 17 U.S.C. § 304(a) (2006)).

9. Copyright Act of 1909, ch. 320, § 9, 36 Stat. 1075, 1077 (codified at 17 U.S.C. § 10 in 1947, repealed 1978); Copyright Act of 1976, Pub. L. No. 94-553, §§ 401–06, 90 Stat. 2541, 2576–79 (amended 1988).

10. Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, § 7, 102 Stat. 2853, 2857–59 (codified at 17 U.S.C. §§ 401–06 (2006)). The United States eliminated the notice requirement in order to comply with its Berne Convention obligations to protect works without condition of formalities.

use a notice. Even as to copies distributed prior to the United States' accession to Berne, an omission of notice would not invalidate the work's copyright under the "savings" exemptions of the 1976 Act. Under those exemptions, the work would not fall into the public domain if the notice was omitted from a relatively small number of copies; if registration of the work was made within five years after the publication without notice and a reasonable effort was made to add notice after the omission was discovered; or if the notice was omitted in violation of the copyright owner's express written requirement.[11] Accordingly, the set of works that was restored for lack of notice is limited to those of which copies were distributed prior to 1989 and that were not "saved."

The manufacturing clause requirements of the 1909 Act originally required that all mechanical printing and binding of English-language literary printed works sold in the United States had to be performed in the United States.[12] These requirements were significantly reduced under the 1976 Act[13] and ultimately removed in 1986.[14] However, prior to that time, foreign nationals of a country that was a party to the Universal Copyright Convention ("UCC")[15] were exempt from the requirements starting in 1955.[16] Aside from the United States, there were numerous signatories to the UCC in 1955,[17] including many countries that are important creators of literary works. As a practical matter, then, works that fell into the public domain for failure to observe the manufacturing clause (which by definition are limited to English-language literary printed works) are limited largely to those published prior to 1955.

Another subset of restorable works consists of pre-1972 sound recordings. Sound recordings were granted federal protection if fixed after February 15, 1972; consequently, only pre-1972 sounds recordings can be subject to restoration. Assuming, from a technological standpoint, that there were not many sound recordings

---

11. 17 U.S.C. § 405(a) (2006).

12. Copyright Act of 1909, ch. 320, § 15, 36 Stat. 1075, 1078–79 (codified at 17 U.S.C. § 16 in 1947, repealed 1978).

13. Copyright Act of 1976, Pub. L. No. 94-553, § 601(b), 90 Stat. 2541, 2588–89 (amended 1982).

14. 17 U.S.C. § 601(a) (2006).

15. Universal Copyright Convention, Sept. 6, 1952, 6 U.S.T. 2731, 216 U.N.T.S. 132, revised July 24, 1971, 25 U.S.T. 1341, 943 U.N.T.S. 194.

16. Act of Aug. 31, 1954, Pub. L. 83-743, 68 Stat. 1030 (codified at 17 U.S.C. § 9(c), repealed 1978).

17. *See Treaties Database*, WORLD INTELLECTUAL PROP. ORG., http://www.wipo.int/wipolex/en/other_treaties/parties.jsp?treaty_id=208&group_id=22 (last visited Sept. 26, 2011) (listing parties to the UCC and effective dates).

on the market until the late 1940s,[18] the set of restored sound recordings is limited to a mere two decades between 1950 and 1972. Sound recordings fixed after that date are given a full term of protection and thus need not be restored.

Works that "lack national eligibility" are subject to restoration under § 104A(h)(6)(C)(iii). This subset consists of works that were not protected under any copyright treaty with the United States at the time of their creation, but that are protected by such a treaty as of the date of the enactment of the URAA or later.[19] Since most creative-market countries entered into copyright relations with the United States through either bilateral copyright treaties (which were common in the 1890s, e.g., Germany, Italy, and the Netherlands), the UCC beginning in 1955, or the Berne Convention beginning in 1989,[20] this subset would tend to include, for the most part, internationally unknown or lesser-known works from other countries. A notable exception is an author such as Shostakovich (having created Russian works prior to 1973), but similar examples of large bodies of works (other than sound recordings mentioned above) are difficult to identify.

Thus far in the analysis we have identified the estimated set of restorable works as those published between 1923 and 1964, or in the case of English-language literary printed works, 1955, and in the case of sound recordings, 1972. This set of four or five decades worth of restored works looks small when compared to all the works created during the preceding centuries already in the public domain and to the later published works that U.S. law never made eligible for restoration in the first place.

The set of restored works is even further limited when one considers that all U.S. works are excluded from the set. U.S. works are not eligible for restoration;[21] thus, all U.S. works that fell into the public domain for any reason remain there. This reduces the restored set by a significant amount given that the United States is a leading creator and exporter of copyrighted works, especially those consumed in the United States.

---

18. Columbia Records introduced the 33 1/3 RPM record in 1948 and RCA introduced the 45 RPM record in 1949. *See* MARK COLEMAN, PLAYBACK: FROM THE VICTROLA TO MP3, 100 YEARS OF MUSIC, MACHINES, AND MONEY 58, 68 (2004).

19. *See* 17 U.S.C. § 104A(h)(3) (2006) (listing treaties to which countries must be party in order to be eligible for restoration).

20. *See* U.S. COPYRIGHT OFFICE, CIRCULAR NO. 38A: INTERNATIONAL COPYRIGHT RELATIONS OF THE UNITED STATES 2–10 (2010), *available at* http://www.copyright.gov/circs/circ38a.pdf (listing countries having copyright relations with the United States).

21. 17 U.S.C. § 104A(h)(3), (h)(8)(A) (2006).

A final statutory limitation is that the work must not be in the public domain in the "source country"—defined differently than "eligible country"—due to expiration of the term of protection on the date of restoration (January 1, 1996).[22] A significant number of foreign works fell into the public domain in their source countries prior to 1996. In 1995, the European Union ("EU") harmonized its copyright terms to be seventy pma,[23] which is the current term for works of EU authors today.[24] Thus, any works of EU authors who died prior to 1926 would not qualify for restoration because their source-country terms would have expired by 1996. Many WTO and Berne Convention countries, moreover, had shorter terms in 1996, commonly fifty pma or fifty years from publication,[25] depending on the type of work. Works of authors from those countries, therefore, would not qualify for restoration if their authors died prior to 1946 or if the works were published prior to 1946. In such a situation, the 1923 temporal parameter moves inwards a full twenty-three years, further reducing the set of restored works from a source country having a copyright term of fifty years pma or from publication.[26]

---

22. *Id.* § 104A(h)(6)(B). Section 104A(a)(1)(A) provides that restoration is automatic for "restored works" as of the date of restoration. A "restored work" is defined in part in § 104A(h)(6)(B) as a work that is not in the public domain due to expiry of the term in its source country. The "date of restoration" is defined in § 104A(h)(2)(A) as January 1, 1996. Thus, a restored work is one which (among other things) had not fallen into the public domain due to expiry of the term in it source country as of January 1, 1996. This concept should not be confused with the Rule of the Shorter Term, which the United States does not employ. The § 104A(h)(6)(B) requirement—based on Berne Convention Article 18(1)—is only to determine whether a work was entitled to the automatic restoration effective January 1, 1996; once it was, then the work's restored U.S. term is not limited by the term the work enjoys or may have enjoyed in its source country.

23. "Pma" is a shortened form for *post mortem auctoris*, a Latin term meaning "after the author's death." Seventy pma would thus be life of the author plus seventy years of protection after his or her death.

24. *See* Estelle Derclaye, *The European Union and Copyright*, *in* INTERNATIONAL COPYRIGHT LAW AND PRACTICE § 4[2][e] (Melville B. Nimmer & Paul Edward Geller eds., 2010) (describing the EU Directive harmonizing the term of protection of copyright). There are some exceptions, such as Spain, which has a term of eighty pma for works whose authors died prior to December 7, 1987. *See* Royal Legislative Decree No. 1/1996, Fourth Transitional Provision (Spain), *available at* http://www.wipo.int/wipolex/en/text.jsp?file_id=126674. Some countries provide wartime or other extensions in certain cases, such as in France, which provides an extension to authors who "died for France." *See* French Intellectual Property Code, Art. L 123-10, *available at* http://www.legifrance.gouv.fr/html/codes_traduits/cpialtext.htm.

25. *See* Teruo Doi, *Japan*, *in* INTERNATIONAL COPYRIGHT LAW AND PRACTICE, *supra* note 24, § 3 (describing the Japanese term of protection); Ysolde Gendreau & David Vaver, *Canada*, *in* INTERNATIONAL COPYRIGHT LAW AND PRACTICE, *supra* note 24, § 3 (describing the Canadian term of protection).

26. An additional consideration is where the copyright in the work was at one point owned by the Alien Property Custodian and where the restored copyright would be owned by a government or instrumentality thereof. 17 U.S.C. § 104A(a)(2) (2006). Although probably a rare

After applying these statutory filters, a relatively small set of works remains eligible for restoration. Furthermore, restoration is temporary, lasting only until the remainder of the U.S. term has expired. Take as an example a French book published in 1925. Restored U.S. protection lasts only until 2020, nine years from now. An unusually prolific and brilliant composer such as Shostakovich, who composed from about 1920 to his death in 1975, has had many valuable works restored by the URAA. But, even among his works, the earliest ones would not be restored and the majority will expire in the United States within the next thirty years. As discussed below, it is prolific and creative authors, such as Shostakovich, who are the very authors that deserve to be rewarded for their genius.

B. Protections for Reliance Parties

Even with respect to the small set of works eligible for restoration, any detrimental effect on users is limited because of the URAA's reliance-party protections.[27] As a practical matter, restoration affects primarily people known as "reliance parties," who used the restored works while they were in the public domain.[28] But unless a Notice of Intent to Enforce a Restored Copyright ("NIE") is filed in the Copyright Office or served on the reliance party, the reliance party is completely protected and can continue to use the work as if it had never been restored.[29] Potential users who are not reliance parties are not protected, but they are no worse off than had the work never entered the public domain in the first place. Such users need only

---

exception, such a work would be disqualified from restoration. The identity of the Alien Property Custodian is unclear. *See* 3 NIMMER ON COPYRIGHT, *supra* note 5, § 9A.04[A][1][d] (hypothesizing that the Alien Property Custodian is a reference to an American official of World War I or World War II vintage charged with receiving money and property from enemies of the United States).

27. 17 U.S.C. § 104A(d)(2)–(3) (2006).

28. A literal reading of the definition of "reliance party" in § 104A(h)(4)—a party that exploited a work before the source country became an eligible country—is confusing and arguably was not what was intended by the drafters. Nimmer agrees. *See* 3 NIMMER ON COPYRIGHT, *supra* note 5, § 9A.04[C][1][b][i] (suggesting that the statute be rewritten to read, "A reliance party is one who has exploited a given work before the date of restoration of the restored copyright in the work."). Nimmer's suggested rewrite is what must have been intended, and at least one court has applied the same interpretation. *See generally* Troll Co. v. Uneeda Doll Co., 483 F.3d 150, 156–57 (2d Cir. 2007) (interpreting § 104A(h)(4) as tying reliance-party status to the source country's status as an eligible country as of the date of enactment of the URAA (December 8, 1994) rather than as of the date of restoration (January 1, 1996), but recognizing that other courts have applied the latter (Nimmer's) interpretation).

29. *See* 17 U.S.C. § 104A(d)(2)(A)–(B) (2006) (outlining NIE requirements); Hoepker v. Kruger, 200 F. Supp. 2d 340, 347 (S.D.N.Y. 2002) (refusing a party redress because he failed to file notice).

wait—often a very short time—until the copyright term has expired, just as they must do with protected works.

In addition to the general reliance-party protection, the URAA provides special protection for derivative works based on restored works, even if an NIE is filed. This protection applies regardless of whether the derivative work was created when the underlying work was in the public domain or was created under an original license before it entered the public domain. A reliance party may continue to exploit the derivative work for the duration of the restored copyright if the reliance party pays reasonable compensation to the owner of the restored copyright.[30] This protection, in effect, is a compulsory license to continue to exploit the derivative of the restored work. Significantly, no injunctive relief is available against the party using the derivative work. As to the amount of compensation, if the parties cannot agree, then a federal court must decide the issue.[31] By this scheme, not only is the reliance party no worse off than she would be had the work never entered the public domain in the first place, but she is better off, given that she need not fear an injunction and has enjoyed the benefit of using the work for the time she did.[32]

As a practical matter, NIEs will only be filed for works that have an enduring commercial value, thus narrowing the effect of the restoration scheme on users even further. Section 104A limits the time available for filing an NIE as a means of constructive notice in the Copyright Office to two years from restoration. Because most works were restored on January 1, 1996, this statute set an effective deadline for filing of January 1, 1998.[33] According to the Government's estimate, fewer than fifty thousand notices were received before that date.[34] Regardless of Petitioners' claim that there are millions of restored works, it appears that only a relatively small number of owners have demonstrated any intention to enforce their restored copyrights. Alternatively, perhaps this low turnout is merely a reflection of the analysis set forth above—in other words, there are not really that many restored works after all.

---

30. 17 U.S.C. § 104A(d)(3)(A) (2006).

31. *Id.* § 104A(d)(3)(B). I was unable to find any reported court decisions making a determination of reasonable compensation under this section, but there is no reason to believe that a court would not be guided by evidence of comparable licensing fees for any given work.

32. *Id.* § 104A(d)(3). In determining an amount, a court is to consider what would "reflect any harm to the actual or potential market for or value of the restored work from the reliance party's continued exploitation of the work, as well as compensation for the relative contributions of expression of the author of the restored work and the reliance party to the derivative work." *Id.*

33. *Id.* § 104A(d)(2)(A).

34. Brief for the Respondents at 41, Golan v. Holder, No. 10-545 (U.S. Aug. 2011).

The practical effect of U.S. restoration on any given user is further limited by the fact that restored works are most likely still protected outside the United States.[35] Thus, any benefit that a user may have enjoyed from these works while they were in the public domain in the United States would have been limited, or even nullified, by the fact that the user would have still needed a license to distribute the work (or any derivatives thereof) outside of the country. Given today's international marketplace, and in particular the surge in online commerce, users typically wish to exploit a work, if at all, in markets beyond the United States. The fact that a work is in the public domain in the United States may be useful in negotiating a price, but the user must have the leverage to limit exploitation to the U.S. market if a bargain cannot be struck. Users such as Lawrence Golan and the late Richard Kapp may have had such leverage if they only wanted to perform works in the United States, but such restriction to the U.S. market is not the typical commercial user's model.

In many instances, even if a user were interested in exploiting a work only in the U.S. market, there may be other rights, such as trademark or subsisting underlying copyrights, which would prevent the user from fully enjoying a pure public domain status of any given work. For an example of the latter, consider a foreign film that was not renewed in the United States and therefore fell into the public domain. This film may have been based on a book that had not fallen into the public domain. A user wanting to exploit the film could not do so without permission from the copyright owner of the underlying book, despite the public domain status of the film.[36] Even non-intellectual property rights may limit a user, such as in the case of a copyright owner of a public domain sound recording who is in possession of the singular master recording and will not allow a user to copy it without contractual restrictions and a fee.

Finally, restored works are still subject to fair use, the protections of the idea/expression dichotomy, and all of the exceptions and limitations provided for in the Copyright Act.[37] Thus, if Lawrence Golan wishes to perform Shostakovich's music to his students at the University of Denver and his use satisfies the provisions of § 110(a),

---

35. Indeed, a work that has expired in its source country is not eligible for restoration. *See supra* notes 22–26 and accompanying text.

36. Russell v. Price, 612 F.2d 1123, 1124 (9th Cir. 1979) (upholding damages awarded to copyright owner of the play *Pygmalion* against defendant who distributed public domain film *Pygmalion*).

37. *See* 17 U.S.C. §§ 102(b), 107–12 (2006) (enumerating subject matter that cannot be copyrighted and limitations on a copyright holder's exclusive rights).

he is free to do so even after restoration.[38] By the same token, if Petitioners wish to make a fair use of one of these works, they are not prevented from doing so by the restored status of the work.[39]

III. BIG GAINS

In contrast to the small, temporary burden to the public domain created by restoration, the political, economic, and equitable benefits that the URAA provides to the United States and to U.S. and foreign authors are comparatively large and significant. When the Tenth Circuit considered *Golan v. Holder*, it identified three interests advanced by the Government: (1) attaining indisputable compliance with international treaties and multilateral agreements; (2) obtaining legal protections for American copyright holders' interests abroad; and (3) remedying past inequities to foreign authors who lost or never obtained copyrights in the United States.[40] The court held that the Government had demonstrated both the importance of the second interest and that the URAA is narrowly tailored to advance that interest.[41] Because the court upheld the URAA on the basis of the second interest, the court expressly declined to consider the first and third interests,[42] although the Supreme Court may examine them. This Part looks at each of the interests that the Government has advanced, as well as other interests that the URAA protects.

A. The URAA Improved Relations with Our Trading Partners and Improved Copyright Protection for Works of All Authors

The URAA put the United States into unquestionable compliance with the Berne Convention and the TRIPS Agreement, which require, among other things, (a) no formalities as condition to protection;[43] (b) reciprocal protection;[44] and (c) minimum terms of

38. *But see* Brief for the Petitioners, *supra* note 1, at 11 (asserting that restoration of works of Shostakovich and others makes it "infeasible" for Professor Golan to teach the standard repertoire of classical music to his students).

39. 17 U.S.C. § 107 (2006).

40. Golan v. Holder, 609 F.3d 1076, 1083 (10th Cir. 2010).

41. *Id.* at 1094.

42. *Id.* at 1083 n.6.

43. Berne Convention for the Protection of Artistic and Literary Works art. 5(2), Sept. 9, 1886, as revised at Paris on July 24, 1971, and amended in 1979, S. Treaty Doc. No. 99-27 (1986), *available at* www.wipo.int/treaties/en/ip/berne/pdf/trtdocs_wo001.pdf [hereinafter Berne Convention].

44. Agreement on Trade-Related Aspects of Intellectual Property Rights art. 3.1, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869

protection.[45] Compliance with the treaties ensures their benefits. The benefits of reciprocity are clear and simple: if we protect the works of other nations, then they will protect our works. Thus, to the extent that other countries perceived that the United States had not been in compliance, the United States felt it necessary to take steps to dispel that perception. Phrased another way, if the United States takes the small step of protecting the small set of unprotected foreign works defined in Part II, then protection for *all* U.S. works will be secured in *all* other Berne Convention countries.[46] To give an example, if Shostakovich's previously unprotected but qualifying symphonies are restored in the United States, then all of Professor Kapp's arrangements of them will be protected in Russia and all other treaty countries. Full reciprocity operates not only to safeguard the protections already afforded to U.S. works in other countries, but also to ensure that the scope of protection is expanded.[47] Because the United States is the largest exporter of copyrighted works in the world, it presumably gets the bigger benefit of the bargain.[48]

In addition, without the URAA, anti-piracy protection for U.S. works abroad could be put in jeopardy. Based on a myriad of testimony from trade representatives and content owners, Congress properly concluded that to decline to take restoration steps would have weakened the United States' pursuit of its foreign policy objectives—for example, "[p]utting 'pirates' out of business in

---

U.N.T.S. 299, 33 I.L.M. 1197 [hereinafter TRIPS Agreement], *available at* http://www.wto.org/english/docs_e/legal_e/27-trips.pdf; Berne Convention, *supra* note 43, art. 5.

45. TRIPS Agreement, *supra* note 44, art. 12; Berne Convention, *supra* note 43, art. 7.

46. Berne Convention, *supra* note 43, art. 5(1)–(3). Most, if not all, commercially significant countries are Berne and TRIPS members. *See* U.S. COPYRIGHT OFFICE, *supra* note 20, at 2–10 (listing countries and the international agreements to which they are a party).

47. Congress heard testimony that, for example, as of 1994, U.S. sound recordings were unprotected in as many as seventy countries. *General Agreement on Tariffs and Trade (GATT): Intellectual Property Provisions: Joint Hearing before the Subcomm. on Intellectual Prop. and Judicial Admin. of the H. Comm. on the Judiciary and the Subcomm. on Patents, Copyrights and Trademarks of the Subcomm. on the Judiciary*, 103d Cong. 265 (1994) (statement of Jason S. Berman, Chairman and Chief Executive Officer, Recording Industry Association of America) [hereinafter *Joint Hearing*]. Eric Smith of the IIPA testified that Latvia and Lithuania did not protect U.S. films; Russia and the eleven other members of the Commonwealth of Independent States provided no protection for pre-1973 U.S. works including films, music, and books; and South Korea provided no protection for pre-1987 U.S. works including films, music, and books. *Id*. at 250–51 (statement of Eric Smith, Executive Director and General Counsel, International Intellectual Property Alliance).

48. *See id.* at 262 (statement of Jason S. Berman, Chairman and Chief Executive Officer, Recording Industry Association of America) ("[T]here are vastly more US works currently unprotected in foreign markets than foreign ones here, and the economic consequences [of restoring copyright protection] are dramatically in favor of US industries.").

Thailand, China or Mexico"[49]—by encouraging other countries to read their own obligations under the TRIPS Agreement, the Berne Convention, and other international agreements narrowly. The United States' leverage in negotiating such agreements comes from adhering to international norms for protection.[50] The General Counsel of the Office of the U.S. Trade Representative testified that "if the largest exporter of copyright material in the world takes the position that we have no or limited obligations" under the Berne Convention, then the United States would "have little credibility in convincing our trading partners that they should be protecting" U.S. works.[51]

From a historical perspective, adopting Petitioners' position would move the United States back to the international position it was in before 1891, when it begrudgingly granted copyright protection to foreign authors for the first time.[52] Although it is beyond the scope of this Essay to explain in detail,[53] the American attitude toward copyright relations with foreign authors at the time of the first Copyright Act of 1790 is commonly characterized as "embarrassing"[54] and even shameful.[55] Exemplary of a pirating nation, with far fewer works to export than to import, the Copyright Act of 1790 unabashedly protected only American authors[56] and expressly condoned the filching of foreign authors.[57]

This approach benefited American publishers who widely copied and distributed the works of British authors such as Charles Dickens and Gilbert and Sullivan without penalty.[58] This practice infuriated British and other foreign authors whose nations, in

---

49. *Id.* at 268.

50. *See The Berne Convention: Hearings Before the Subcomm. on Patents, Copyrights and Trademarks of the S. Comm. on the Judiciary*, 100th Cong. 101 (1988) (statement of Clayton Yeutter, United States Trade Rep.) (stating that the United States' adherence to the Berne convention is important to other international intellectual property negotiations).

51. *Joint Hearing*, *supra* note 47, at 131 (statement of Ira S. Shapiro, General Counsel, Office of the United States Trade Rep.).

52. Act of Mar. 3, 1891, ch. 565, § 13, 26 Stat. 1106, 1110.

53. For an entertaining and informative history of U.S. copyright law, see EDWARD SAMUELS, THE ILLUSTRATED STORY OF COPYRIGHT (2000).

54. *Id.* at 230.

55. Barbara A. Ringer, *The Role of the United States in International Copyright—Past, Present, and Future*, 56 GEO. L.J. 1050, 1051 (1968).

56. The 1790 Copyright Act provided protection to "the author and authors . . . being a citizen or citizens of these United States, or resident therein." Act of May 31, 1790, ch. 15, § 1, 1 Stat. 124, 124.

57. *Id.* § 5 ("[N]othing in this act shall be construed to extend to prohibit the importation or vending, reprinting or publishing within the United States, of any map, chart, book or books, written, printed, or published by any person not a citizen of the United States, in foreign parts or places without the jurisdiction of the United States.").

58. SAMUELS, *supra* note 53, at 230–34.

retaliation, refused to extend protection to American authors. As American creativity began to blossom in the nineteenth century—producing prominent authors such as Ralph Waldo Emerson, Henry Wadsworth Longfellow, Edgar Allen Poe, Harriet Beecher Stowe, Mark Twain, and others—tensions increased over the reciprocal piracy. British authors petitioned the U.S. government to extend protection to their works, arguing that the sale of cheap versions of their works in the United States caused injury to their reputations and property. American authors filed their own petition urging the same, complaining not only that their works were unprotected in foreign markets, but also that competition from cheap editions of English works made it difficult to sell their works at home. *A Memorial of American Authors*, submitted to the U.S. government in 1886, urged the passage of an international copyright law.[59] It was signed by 145 American authors, including Louisa May Alcott, Mark Twain, and Oliver Wendell Holmes. It stated as follows:

> The undersigned American citizens who earn their living in whole or in part by their pen, and who are put at disadvantage in their own country by the publication of foreign books without payment to the author, so that American books are undersold in the American market, to the detriment of American literature, urge the passage by Congress of an International Copyright Law, which will protect the rights of authors, and will enable American writers to ask from foreign nations the justice we shall then no longer deny on our own part.[60]

Sound familiar?[61] At that time, the petition fell on deaf ears.

Eventually copyright relations began to change. The Europeans were the first to see the light. Recognizing that reciprocal copyright protection would lead to greater benefits for domestic and foreign authors alike, they began to extend protection to foreign authors, conditional upon reciprocity. This led to the British International Copyright Acts of 1838, and eventually to the first Berne Union for the Protection of Literary and Artistic Works in 1886. The United States, still resisting protection for foreign works, declined to join at that time.[62]

The United States eventually moved forward in improving and harmonizing copyright relations with its international trading partners, but it was slow progress. Barbara Ringer, then Assistant

---

59. *See* R. R. BOWKER & THORVALD SOLBERG, COPYRIGHT: ITS LAW AND ITS LITERATURE (Fred B. Rothman & Co. 1986) (1886), *reprinted in* SAMUELS, *supra note* 53, at 239 (reproducing a facsimile of the original petition).

60. *Id.*

61. These sentiments are remarkably similar to those made by trade officials and authors in the URAA hearings themselves, leading one to conclude that the concerns raised in the URAA context are identical to those raised and debated for well over a century.

62. SAMUELS, *supra* note 53, at 231–34.

Register of Copyrights, later Register of Copyrights, described the American role in international copyright in 1968 as follows:

> Until the Second World War the United States had little reason to take pride in its international copyright relations; in fact, it had a great deal to be ashamed of. With few exceptions its role in international copyright was marked by intellectual shortsightedness, political isolationism, and narrow economic self-interest. . . . After a century as a virtual outlaw, a half century as an outsider, and 15 years as a stranger at the feast, the United States suddenly finds itself cast as a leading champion of literary property. . . . In view of our dubious past performance we are hardly in a position to adopt a tone of moral indignation.[63]

Since 1968, the United States has made great strides in improving the situation by removing domestic barriers to U.S. protection, such as formalities, and by steadily granting greater protection to foreign authors through bilateral treaties, the UCC, the Berne Convention, the TRIPS Agreement, and finally the URAA. Presently, there is nearly full reciprocal protection within the Berne Convention and TRIPS Agreement requirements among most, if not all, major trading partners of the world. Denying copyright protection to the small set of foreign works restored by the URAA would, in this historical context, be a step backward. It would unravel significant advancements made by the United States in copyright relations over the past century.

B. Rewarding Foreign Authors with Restoration Is in Furtherance of the Progress Clause

The Progress Clause of the U.S. Constitution gives Congress the power "to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."[64] Petitioners focus on the "limited Times" language and argue that the Progress Clause is all about getting works into the public domain. But placing works in the public domain is not an end in itself—otherwise there would be no need for copyright at all. It is well established that the purpose of the copyright scheme in this country is not simply to reward authors for their creation, nor simply to deposit works in the public domain, but rather to further the public interest by promoting the progress of knowledge and culture through a system of rewards.[65]

---

63. Ringer, *supra* note 55, at 1051, 1078.

64. U.S. CONST. art. I, § 8, cl. 8.

65. *See* Eldred v. Ashcroft, 537 U.S. 186, 212 & n.18 (2003) ("The constitutional command [of the Copyright Clause], we have recognized, is that Congress, to the extent it enacts copyright laws at all, create a system that promotes the Progress of Science. . . . JUSTICE STEVENS' characterization of reward to the author as a secondary consideration of copyright law

What's good for authors is, over time, good for the public domain. Stating the obvious, the reward of exclusive rights produces income for the author, which he or she can then invest to create more works and to disseminate copies of existing works more broadly and in higher-quality form. This is particularly important for works requiring a great deal of investment for creation and distribution, such as motion pictures, or works that are disseminated through new technologies. By this system, more works of high quality ultimately find their way—after the term has expired—into the public domain. Whereas the incentive theory may prove truer with some works or authors than with others,[66] Congress should not be inhibited from enacting a single rule applicable to all works and authors where the rule as a whole results in a greater body of creation.

Petitioners desire to shortcut the constitutional scheme and deny the authors of restored works their due reward of exclusive rights. They do not want to wait until "limited Times" expire, as the Constitution directs. Instead, they want those authors to have either no exclusive rights or only a period of exclusive rights cut short by formalities or other barriers unrelated to creative incentives. Given the goals of the copyright system—to promote progress and enrich the public domain through a system of rewards—the position that these works and authors should be exempted from those rewards, exempted from the general constitutional scheme, and denied the same rights as other authors is not supportable.[67]

---

understates the relationship between such rewards and the 'Progress of Science.' As we have explained, the economic philosophy behind the Copyright Clause is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors. Accordingly, copyright law *celebrates* the profit motive, recognizing that the incentive to profit from the exploitation of copyrights will redound to the public benefit by resulting in the proliferation of knowledge. The profit motive is the engine that ensures the progress of science. Rewarding authors for their creative labor and promoting Progress are thus complementary; as James Madison observed, in copyright 'the public good fully coincides . . . with the claims of individuals.' JUSTICE BREYER's assertion that copyright statutes must serve public, not private, ends similarly misses the mark. The two ends are not mutually exclusive; copyright law serves public ends by providing individuals with an incentive to pursue private ones." (citations omitted) (quoting THE FEDERALIST NO. 43) (internal quotation marks and alterations omitted)).

66. For every author who lives by Samuel Johnson's maxim, "No man but a blockhead ever wrote except for money," there are others who do not hesitate to dedicate their works to the public domain upon creation or who wish to accept less than their full copyright by means of Creative Commons license or otherwise.

67. Petitioners disparagingly call the restored copyright a "private economic benefit" and a "windfall." Brief for the Petitioners, *supra* note 1, at 49. But this is what a copyright is. As the *Eldred* Court explained, " '[C]opyright law *celebrates* the profit motive . . . . The profit motive is the engine that ensures the progress of science.' " *Eldred*, 537 U.S. at 212 n.18 (quoting Am. Geophysical Union v. Texaco Inc., 802 F. Supp. 1, 27 (S.D.N.Y. 1992)).

In *Eldred v. Ashcroft*, the Supreme Court recognized that extending the copyright term by an extra twenty years of protection would in the long run lead to a richer public domain, even though it would temporarily deprive the public domain of existing works.[68] As such, term extension was held to advance the important government interest of furthering the Progress Clause. The same logic applies with respect to restoration—namely, that the temporary deprivation from the public domain of the small set of works defined in Part II will lead to a richer public domain after the terms of protection have expired. This promotes the goals of the Progress Clause.

C. Rewarding Foreign Authors with Restoration Is Fair, Equitable, Corrective, and Just

Petitioners argue in their brief that the works at issue cannot be pulled out of the public domain because their copyrights expired.[69] In doing so, Petitioners fail to appreciate the reasons why the restored works fell into the public domain in the first place. There is a crucial distinction between falling into the public domain through expiration of the term—which is what is meant by "limited Times"—and falling into the public domain for failure to follow formalities or the other reasons excused by § 104A. By definition, URAA-restored works did not fall into the public domain by reason of expiry of the term. Had they done so, they would still be in the public domain. Nor did they fall into the public domain because they are facts or ideas, because they are functional or otherwise uncopyrightable, or because of any other legal principle that would dictate they should not be protected by copyright. As explained above, the restored works fell into the public domain merely because of formalities long disfavored and abandoned or because of reluctance on the part of the United States to extend full reciprocal protection to foreign authors. These are not justifiable reasons to prevent otherwise deserving works from enjoying the copyright protection to which they were entitled in the first place.

Prior U.S. formalities, such as registration, renewal, copyright notice, and the manufacturing clause, are prohibited by the Berne Convention[70] and have been eliminated as conditions to U.S.

---

68. *Eldred*, 537 U.S. at 212 n.18.

69. *See* Brief for the Petitioners, *supra* note 1, at 22 ("Removing works from the public domain violates the 'limited [t]imes' clause by turning a fixed and predictable period into one that can be reset or resurrected at anytime, even after it expires." (alteration in original)).

70. Berne Convention, *supra* note 43, art. 5(2) ("The enjoyment and the exercise of these rights shall not be subject to any formality.").

protection over time.[71] In the international context, formalities have been disfavored because they penalize authors for reasons unrelated to creativity or rewards and are viewed as interfering with the goal of having a uniform and harmonized international copyright system.[72] Even scholars who advocate "re-formalities" do not support the complete loss of protection for failure to observe them.[73]

As recently as 2009, one district court criticized the use of formalities as a barrier to protection. In *Moberg v. 33T LLC,* the defendants in an infringement action tried to characterize an unregistered German work as a U.S. work so that it would be subject to formalities. The court rejected that attempt:

> To hold otherwise would require an artist to survey all the copyright laws throughout the world, determine what requirements exist as preconditions to suits in those countries should one of its citizens infringe on the artist's rights, and comply with those formalities, all prior to posting any copyrighted image on the Internet. The Berne Convention was formed, in part, to prevent exactly this result.[74]

Formalities have nothing to do with rewards, creativity, or progress. As noted above, they are remnants of a time when the United States tried to unfairly benefit from copying the works of foreign authors. As applied in this country, prior formalities were strict and unforgiving. They took exclusive rights away from authors without warning or an opportunity to defend.[75] Should Shostakovich—a brilliant composer, among the most deserving of authors—lose his copyrights (and his family's livelihood) simply because he happened to live in the Soviet Union before détente?[76] To correct this situation through restoration is a just and equitable measure.

---

71. Some formalities, such as registration, are encouraged for evidentiary reasons or for good order and public notice. But it is now generally accepted that to condition protection on formalities is too punitive.

72. *See* 1 SAM RICKETSON & JANE C. GINSBURG, INTERNATIONAL COPYRIGHT AND NEIGHBOURING RIGHTS: THE BERNE CONVENTION AND BEYOND §§ 6.87–6.92 (2d ed. 2006) (discussing treatment of formalities under the Berne Convention).

73. *See* Pamela Samuelson et al., *The Copyright Principles Project: Directions for Reform*, 25 BERKELEY TECH. L.J. 1175, 1185–86 (2010) ("[R]ights [should not] be entirely forfeited, as in the past, if a work's authors or other rights holders or licensees failed to comply with some fine detail of notice or registration requirements."); Christopher Sprigman, *Reform(aliz)ing Copyright*, 57 STAN. L. REV. 485, 490 (2004) (arguing that reformalizing copyright would restore balance between rights holders and users, but that there should not be "unilateral readoption of old-style formalities").

74. Moberg v. 33T LLC, 666 F. Supp. 2d 415, 422–23 (D. Del. 2009).

75. Unlike the reliance party provisions in question here, there were no reliance procedures for foreign authors who, often unwittingly, lost their copyrights for failing to follow the rules.

76. A search of the Library of Congress shows records indicating that the late Professor Kapp's publishing companies and employers-for-hire registered many of his works. They, as well as the works of countless other U.S. authors, will enjoy a full copyright term in the United

At the same time, the international norm does recognize that expiry of the term is a valid reason for works to enter the public domain. Berne Convention Articles 18(1) and (2) provide that no Berne Convention country is obligated to protect a work that fell into the public domain for this reason.[77] Restoration has no effect on expiry of the term, which is the proper endpoint of "limited Times." The public domain will include these works when that time comes. But there is no justification, legally or equitably, that these works should enter the public domain any earlier. All that is required is patience, not a constitutional challenge.

IV. CONCLUSION

The passage of the URAA was a necessary step in securing important governmental interests pertaining to international trade and copyright protection. Congress enacted it in a measured way that places a very limited burden on the public domain. The burden is small: The URAA does not affect any U.S. works or pre-1923 works. It affects only those created during a few decades, with a few exceptions for works from countries such as Russia. Even for restored works, the effect is temporary and protections are provided for the users most significantly affected. The gains are big: treaty protections are secured, the goals of the Progress Clause are served, and deserving authors are provided their just rewards.

States, in Russia, and in other treaty countries. By contrast, without restoration Shostakovich would be completely denied any U.S. term of protection (which would otherwise last until 2045) for many of his works. The unfairness of this situation is obvious.

77. Berne Convention, *supra* note 43, arts. 18(1)–(2).