In the Trenches with § 104A: An Evaluation of the Parties' Arguments in *Golan v. Holder* as It Heads to the Supreme Court

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I. INTRODUCTION

At Tulane University Law School, I have been directing the Durationator® Experiment, an online tool used to determine the copyright status of a work—any kind of work, including poetry, music, photographs, magazine articles, books, films, and folklore.[1] I want to

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1. Elizabeth Townsend Gard, *The Making of the Durationator®: An Unexpected Journey into Entrepreneurship*, *in* ENTREPRENEURSHIP AND INNOVATION IN EVOLVING ECONOMIES: THE ROLE OF LAW (Megan Carpenter ed., forthcoming 2012).

create a system that will be trusted, accurate, and unbiased. Because copyright is territorial, we have set out to code every copyright law in the world. In doing so, we have become quite familiar with copyright restoration, harmonization (or lack thereof), treaty enforcement, and other elements related to determining the copyright status of a work in a global context.[2]

Section 104A[3] has been particularly challenging for us, both in parsing through the statute and in implementing its provisions into our code. Having worked very carefully with § 104A, both in my research as well as in directing students' global research projects over the last four years,[4] I can honestly say that it is a nearly unworkable amendment to the copyright law. On a mechanical level, it violates the traditional contours of copyright law in a number of major ways. Moreover, enactment of § 104A did *not* satisfy the United States' treaty obligation under the Berne Convention or the TRIPS Agreement. The United States is still in violation of Berne Article 18, and foreign authors have still not been made whole. Additionally, § 104A violates the spirit of international law and does not help American authors abroad in the best, most traditional, or most logical fashion. Having spent a significant amount of time immersed in the copyright laws of every country in the world, I can safely say that § 104A is an anomaly that does not conform to international norms. It does not properly assist with copyright harmonization, and it leaves the United States vulnerable to being found in violation of the TRIPS Agreement.

The Supreme Court will consider these problems when it decides *Golan v. Holder*. The Petitioners' brief argues that restoring copyrighted works from the public domain violates the "traditional contours of copyright law" and therefore requires First Amendment intermediate scrutiny.[5] The crux of the Government's argument is

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2. As of summer 2011, we have researched every country in the world and have coded about one hundred countries. We expect to have the remaining one hundred countries completed by summer 2012. For more information, see www.durationator.com.

3. For background on § 104A and the *Golan* case in general, see Tyler T. Ochoa's introduction to this Roundtable. Tyler T. Ochoa, *Is the Copyright Public Domain Irrevocable? An Introduction to* Golan v. Holder, 64 VAND. L. REV. EN BANC 123 (2011).

4. *See, e.g.*, Elizabeth Townsend Gard, *Copyright Law v. Trade Policy: Understanding the* Golan *Battle Within the Tenth Circuit*, 34 COLUM. J.L. & ARTS 131, 155–61 (2011) (dissecting the elements of § 104A and discussing the impact of each on copyright law).

5. Brief for the Petitioners at 43–47, Golan v. Holder, No. 10-545 (U.S. June 14, 2011). The Yale Information Project has actually argued that strict scrutiny should apply, even though the parties agreed that intermediate scrutiny was the proper test. Brief for Information Society Project at Yale Law School Professors and Fellows as Amici Curiae in Support of Petitioners at 22, *Golan*, No. 10-545 (U.S. June 21, 2011).

that § 104A was necessary in order to fulfill three important objectives: (1) to live up to the United States' treaty obligations under the Berne Convention; (2) to help American authors abroad; and (3) to right the wrongs of the past done to foreign authors.[6] Outside of these specific arguments, the story of § 104A has become complex, with many issues and interests involved. How far can Congress's treaty power extend into settled domestic law?[7] Can works be taken out of the public domain and recopyrighted?[8] Were the First Amendment rights of those relying on public domain works violated by a one-year-only transition term?[9] Does history show other examples of

6. Brief for the Respondents at 11–12, *Golan*, No. 10-545 (U.S. Aug. 2011).

7. *See* Brief for the Cato Institute as Amicus Curiae in Support of Petitioners at 5, *Golan*, No. 10-545 (U.S. June 21, 2011) ("This Court should hold that treaties cannot vest Congress with new legislative power."); Brief for Public Knowledge as Amicus Curiae in Support of Petitioners at 2–3, *Golan*, No. 10-545 (U.S.) ("If the Court upholds the reasoning and opinion of the Tenth Circuit, it risks drawing a roadmap by which speech-restrictive laws may evade the proper level of scrutiny, either by wrapping the law's effects in an international agreement advancing a real government interest, or by allowing a vaguely-defined government interest to escape a proper level of scrutiny.").

8. *See* Brief for American Library Association et al. as Amici Curiae in Support of Petitioners at 5, *Golan*, No. 10-545 (U.S. June 21, 2011) ("[T]his case raises an issue of extraordinary importance: whether the Constitution permits Congress to shrink the public domain and thereby refigure the copyright balance."); Brief for the Eagle Forum Education & Legal Defense Fund as Amicus Curiae in Support of Petitioners at 7, *Golan*, No. 10-545 (U.S. June 17, 2011) (fearing that other American works will eventually be removed from the public domain); Brief for Google, Inc. as Amicus Curiae in Support of Petitioners at 11–17, *Golan*, No. 10-545 (U.S. June 2011) (arguing that the public domain is vital, and that without a clear boundary of what is included in the public domain, investment will be deterred); Brief for Heartland Angels, Inc. as Amicus Curiae in Support of Petitioners at 11, *Golan*, No. 10-545 (U.S.) (arguing that, for business purposes, we need a stable public domain, where works cannot be recopyrighted: "When investors cannot predict with any degree of certainty where the limits of copyright begin and end, logic often counsels investors to avoid the copyright market altogether."); Brief for Peter Decherney as Amicus Curiae in Support of Petitioners at 2, *Golan*, No. 10-545 (U.S. June 20, 2011) ("The history of the motion picture and television industries' longstanding reliance on public domain source materials demonstrates that these intended beneficiaries of copyright law structured their businesses on the understanding that the Constitution withholds from Congress the power to strip the public of its vested right to use source materials and other expressive resources in the public domain."); Brief for Public Domain Interests as Amicus Curiae in Support of Petitioners at 6, *Golan*, No. 10-545 (U.S.) (arguing that the public domain is essential to American creativity and democratic participation and noting that if Congress is allowed to remove foreign works from the public domain, there is fear that Congress could remove U.S. works one day as well).

9. For more on the impact of the removal of public domain materials, see Brief for the Conductors Guild and the Music Library Association as Amici Curiae Supporting Petitioners at 7–13, *Golan*, No. 10-545 (U.S. June 20, 2011), which includes a survey on the impact of § 104A on conductors, orchestras, and teaching, as well as Brief for Project Petrucci, LLC as Amicus Curiae in Support of Petitioners at 10–11, *Golan*, No. 10-545 (U.S. June 20, 2011), describing the immense difficulty of determining the new status of works under § 104A.

restoration, or is § 104A an anomaly?[10] These are only a few of the major questions surrounding the *Golan* case.

What is missing from the debate, however, is an actual analysis of § 104A itself. How do the mechanics of § 104A fulfill or fail to fulfill U.S. treaty obligations? Do the mechanics of § 104A violate or uphold the traditional contours of copyright law? Part II of this Essay assesses the Government's position and argues that § 104A accomplished neither our treaty obligations nor the objective of righting past wrongs done to foreign authors. It also argues that the actual goals of protecting American works abroad could have been addressed more efficiently by other means.[11] Part III assesses the Petitioners' position. It argues that § 104A violates the traditional contours of copyright in a mechanical (rather than an historical or functional) way and makes determining the copyright status of foreign works a near-impossible task.[12] The statutory machinery of Congress has been enlisted for seemingly very little gain.[13] Part IV concludes by suggesting how Congress might amend the copyright law.

II. BASIC FLAWS IN THE GOVERNMENT'S ARGUMENT: § 104A ANALYZED

Of all of the obligations that came with joining the Berne Convention, Article 18's retroactivity requirement posed some of the greatest challenges for the United States. Section 104A was an amendment added under the Uruguay Round Agreements Act ("URAA") implementing legislation. It restored foreign works that had been in the public domain in the United States because of failure to follow formality obligations under the 1909 Copyright Act, the 1976

10. *See* Brief for the Respondents, *supra* note 6, at 11 (arguing that historical precedent exists for Congress to restore copyright protection to works that have entered the public domain). *But see* Brief for Creative Commons Corp. as Amicus Curiae in Support of Petitioners at 10, 16–17, *Golan*, No. 10-545 (U.S.) (finding that history does not support a tradition of removal of works from the public domain, because works brought under federal copyright in 1790 and 1976 (unpublished works) were still under copyright somewhere in the territory of the United States and therefore were not in the public domain in the United States); Brief for H. Tomas Gomez-Arostegui and Tyler T. Ochoa as Amici Curiae in Support of Petitioners at 2, *Golan*, No. 10-545 (U.S. June 17, 2011) (finding that the evidence does not support such an argument based on a careful and thorough historical analysis).

11. For instance, the U.S. Trade Representative's Special 301 Report would have been the perfect mechanism to make sure American copyrights were being enforced. U.S. TRADE REPRESENTATIVE, 2011 SPECIAL 301 REPORT 19–41, *available at* http://www.ustr.gov/webfm_send/2841.

12. This Essay is not actually taking a position on the *Golan* case, but rather analyzing the parties' arguments in light of what § 104A actually does.

13. The Respondents have not provided a single example of restoration of American authors' works abroad, even though § 104A has now been in place for over fifteen years.

Copyright Act, or the Universal Copyright Convention; because the country of origin did not have treaty relations with the United States; or because the work was a foreign sound recording.[14] Millions of works previously in the public domain in the United States were given new copyrights as of January 1, 1996.[15] The Government argues that restoration was necessary to meet the country's treaty obligations under Berne Article 18, to protect American copyright holders' interests abroad, and to correct wrongs done to foreign authors.[16] This Part analyzes Article 18 and § 104A together and argues that, unfortunately, § 104A meets none of these goals. It also discusses the Rule of the Shorter Term, implementation of which would go a long way toward solving the problems § 104A has created.

A. The Government's International-Obligations Arguments

The Government begins its brief by defining the stakes: unless there is a treaty in place, foreign works do not naturally have copyright in the United States; whereas, Berne secured protection for U.S. works abroad in twenty-four new countries.[17] The implication of this statement is that Berne was a critical step in securing additional protection for U.S. works. This story is misleading. By the time the United States joined Berne in 1989, it already had treaty relations with most countries of the world, either through bilateral agreements, the Universal Copyright Convention, or other treaties. The only major additions to our copyright relations from Berne were Egypt and

14. *See* Uruguay Round Agreements Act, Pub. L. No. 103-465, § 514, 108 Stat. 4809, 4976–81 (1994) (definition of "restored work" codified as amended at 17 U.S.C. § 104A(h)(6) (2006)).

15. 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). Note that restoration also occurred for countries that joined the required treaties later.

16. The Tenth Circuit held that the statute was narrowly tailored to achieve the Government's interest in protecting Americans abroad without considering the Government's two other stated goals. Golan v. Holder, 609 F.3d 1076, 1083 (10th Cir. 2010).

17. Brief for the Respondents, *supra* note 6, at 2–3. The Government did not provide a list of these countries. A more accurate statement would be that the United States has not granted national treatment to foreign published works unless a multilateral or bilateral treaty was in place. The Government skips the history of the 1891 enactment of the Chace Act, which authorized bilateral treaties to provide national treatment for foreign authors. *See* Act of Mar. 3, 1891, ch. 565, § 13, 26 Stat. 1106, 1110. It also skips the history of the Universal Copyright Convention ("UCC"), to which the United States became a party in 1955, allowing for national treatment for foreign works. *See* 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. It also ignores the fact that, under our current system, unpublished works are protected regardless of whether treaty relations exist. 17 U.S.C. §§ 104(a), 303 (2006). This means that Congress has the power to enact laws that would not require treaty relations to gain protection.

Turkey.[18] So, while Berne made new treaty obligations, joining did not significantly alter with *whom* the United States had copyright relations.[19] Therefore, the argument that we *owed* retroactivity to our new relations does not quite hold.

A second problem with the Government's argument is quickly apparent. When the United States signed onto Berne, the ratifying legislation—the Berne Convention Implementation Act ("BCIA")—did not include a restoration provision.[20] The Government now has to explain why Congress did not find it necessary upon the enactment of Berne to restore foreign works but did just six years later. The explanation is that the BCIA took a "minimalist" approach and that discussion of restoration and Article 18 was put off until a more "thorough examination" could be obtained. But one key element to the enactment of § 104A was that there *was no thorough examination*. The amendment was passed as part of the fast-track process of the larger trade implementation package that became the URAA.[21] How did the Government manage to solve the restoration problem under the fast-track provisions but not under the full discussion of the BCIA? It is a puzzler.

The Government's response is TRIPS. Whereas Berne had no dispute mechanism, the TRIPS Agreement put consequences in place because it incorporated Berne into the World Trade Organization Dispute Settlement Understanding ("DSU").[22] The Government's story

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18. In 1986, Sam Ricketson noted that, one hundred years after the enactment of Berne, the makeup of its members remained largely Eurocentric:

> Indeed, the area to which the Convention now applies in 1986 is not much larger than was the case in 1886, when it was extended to the vast colonial empires of several of its original [nine] members. . . . Moreover, it no longer remains the only major world copyright convention: since 1952, the Universal Copyright Convention (the UCC) has come to embrace a wider membership than the Berne Convention, and includes both the USA and the USSR.

1 SAM RICKETSON & JANE C. GINSBURG, INTERNATIONAL COPYRIGHT AND NEIGHBOURING RIGHTS: THE BERNE CONVENTION AND BEYOND, at lix (2d ed. 2006).

19. In reviewing Circular 38A at the U.S. Copyright Office, which lists U.S. treaty relations with each country, including the dates, we only found fifteen countries whose relationship with the United States was altered by joining Berne. *See* U.S. COPYRIGHT OFFICE, CIRCULAR NO. 38A: INTERNATIONAL COPYRIGHT RELATIONS OF THE UNITED STATES 2–10 (2010). All but two of the countries—Egypt and Turkey—were merely former colonies. *See id.* In many ways, joining Berne was a political move, in that it eclipsed the influence of the UCC. But it did not establish very many new relationships for the United States.

20. Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853.

21. *See* Cindy Galway Buys & William Isasi, *An "Authoritative" Statement of Administration Action: A Useful Political Invention or a Violation of the Separation of Powers Doctrine?*, 7 N.Y.U. J. LEGIS. & PUB. POL'Y 73, 76–83 (2003) (describing the fast-track procedure).

22. Agreement on Trade-Related Aspects of Intellectual Property Rights art. 64, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869

is that the United States could no longer be in violation of its treaty obligations.[23] This argument would be more convincing had the country actually fulfilled its treaty obligations. In 2001, the United States was brought to the DSU for violating the TRIPS Agreement by not amending section 110(5) of the 1976 Copyright Act. Section 110(5) is a strange part of the 1976 Copyright Act. It allows for "business" and "homestyle" exemptions, both of which permit restaurants and bars to play music and television under certain circumstances without paying royalty fees.[24] The European Union believed this violated Article 9(1) of the TRIPS Agreement. Europeans did not like the fact that licenses were not paid under these "homestyle" exceptions, but the United States refused to change its tune, so to speak. The DSU has indeed found the United States in violation of the TRIPS Agreement, but the country has still not changed its copyright laws—it merely pays a fine every year for the violation.[25] So, the United

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

23. The amicus briefs in support of the Respondents repeated this sentiment (without any support).

24. *See* Sarah E. Henry, *The First International Challenge to U.S. Copyright Law: What Does the WTO Analysis of 17 U.S.C. § 110(5) Mean to the Future of International Harmonization of Copyright Laws Under the TRIPS Agreement?*, 20 PENN ST. INT'L L. REV. 301, 310–14 (2001) (describing the panel report).

25. Panel Report, *United States — Section 110(5) of the U.S. Copyright Act*, ¶ 7.1(b), WT/DS160/R (June 15, 2000), *available at* http://www.wto.org/english/tratop_e/dispu_e/1234da.pdf. *See also* Alain J. Lapter, *The WTO's Dispute Resolution Mechanism: Does the United States Take It Seriously? A TRIPs Analysis*, 4 CHI.-KENT J. INTELL. PROP. 217, 251 (2005); Notification of a Mutually Satisfactory Temporary Arrangement, *United States — Section 110(5) of the U.S. Copyright Act*, WT/DS160/23 (June 26, 2003), *available at* http://trade.ec.europa.eu/doclib/docs/2003/november/tradoc_114303.pdf. ("On November 9, 2001, the arbitration panel awarded the European Community $1,219,900 per year in royalties. . . . Later that month, the parties issued a statement that they had reached a temporary arrangement whereby the 'U.S. shall make a lump-sum payment in the amount of $3.3 million (the "Payment") to a fund to be set up by performing rights societies in the European Communities for the provision of general assistance to their members and the promotion of authors' rights (the "Fund"). The Payment served as a mutually satisfactory temporary arrangement regarding the dispute, for the three-year period commencing 21 December 2001.' "). On the WTO's website, the last paragraph related to the 110(5) dispute reads:

> On 23 June 2003, the United States and the European Communities informed the DSB of a mutually satisfactory temporary arrangement. Such temporary arrangement covered the period through to 20 December 2004. The United States has thereafter presented status reports to the DSB informing that the US Administration will work closely with the US Congress and will continue to confer with the European Union in order to reach a mutually satisfactory resolution of this matter.

United States — Section 110(5) of the U.S. Copyright Act, WORLD TRADE ORG., http://www.wto.org/english/tratop_e/dispu_e/cases_e/ds160_e.htm (last visited Sept. 28, 2011). Nothing further was reported.

States could have refused to comply with the reciprocity provisions of Berne Article 18, even if there were financial consequences.

A second alterative would have been to negotiate around Article 18. If the United States had wished, it could have negotiated for an exception to Article 18, as it had done with moral rights under the Berne Convention.[26] The United States cannot be brought to the DSU for not implementing moral rights.[27] Because retroactivity had been such an incredibly strong sticking point when the United States joined Berne—as had moral rights—the Government conceivably could have made a similar negotiation around Article 18.

But the real irony of the Government's argument about needing to fulfill its Article 18 treaty obligations is that, even with the enactment of § 104A, the United States is *still in violation* of Article 18. The Government's strongest argument is actually built on a house of cards. The danger of being brought to the DSU body remains.

Article 18 is a mechanism of harmonization. As countries join Berne, they are supposed to give foreign works the full benefit of the Berne Convention as long as the term has not expired in the works' home countries.[28] The minimum standards outlined throughout Berne are applied retroactively to works that are still protected in their home countries but that have not been protected in the new Berne member's country. This had been a particular problem with the United States, which did not want to give retroactive protection to foreign works. Thus, when the Universal Copyright Convention was created, it explicitly stated there would be no retroactivity.[29]

In joining Berne, the United States had to significantly alter its copyright system from a publication-based system to a life-plus system. Article 7 plainly states that the general term of works is based

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26. Berne Convention for the Protection of Artistic and Literary Works art. 6*bis*, 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]. For more on moral rights, see generally PAUL GOLDSTEIN & BERNT HUGENHOLTZ, INTERNATIONAL COPYRIGHT: PRINCIPLES, LAW, AND PRACTICE ch. 10 (2d. ed. 2010) and 1 RICKETSON & GINSBURG, *supra* note 18, ch. 10.

27. *See Overview: The TRIPS Agreement*, WORLD TRADE ORGANIZATION, http://www.wto.org/english/tratop_e/trips_e/intel2_e.htm (last visited Sept. 19, 2011) ("With the exception of the provisions of the Berne Convention on moral rights, all the main substantive provisions of these conventions are incorporated by reference and thus become obligations under the TRIPS Agreement between TRIPS Member countries.").

28. *See* 1 RICKETSON & GINSBURG, *supra* note 18, at 334–37 (2d ed. 2006) (discussing the development of Berne Convention retroactivity rules).

29. *See* ARPAD BOGSCH, THE LAW OF COPYRIGHT UNDER THE UNIVERSAL CONVENTION 82–85 (3d ed. 1968) (discussing works in the public domain under the UCC). Article VII of the Universal Copyright Convention is titled "Works Permanently in the Public Domain." *Id.* at 82.

on a minimum of the author's life plus fifty.[30] In order to restore works, the United States *should* have restored foreign works still under copyright to at least these minimum standards. But instead of restoring works using a life-plus system, the United States applied § 304 to restored works published before January 1, 1978, which gave restored works a term of ninety-five years from publication.[31] By applying a publication-based analysis, the United States is still in violation of Article 18 and has not fulfilled its Berne obligations. This means that some works are not given the minimum term, while others well exceed Berne's minimums.

Take as an example Edvard Munch's *The Scream*, an iconic painting in Western culture. In the United States, the painting is considered to be in the public domain, even under § 104A, as the original was available to the public starting in 1910. If § 104A had been implemented properly, all of Munch's works, including *The Scream*, would have carried a term of the life of the author plus seventy years, or until 2014 (1944 plus seventy years). Instead, *The Scream* did not qualify for restoration. Section 104A denied eighteen years of copyright to the Munch estate on its most famous painting (and on other paintings as well).

By applying the wrong term under U.S. copyright law, § 104A also created overprotection for foreign works. Take, for instance, the works of French artist Henri Matisse, who lived from 1869 to 1954. Under Berne standards, all of Matisse's works should be protected for a minimum of fifty years after 1954, or through 2004. The United States has adopted a life-plus-seventy-year term for works not falling under the 1909 Act—that is, works created after January 1, 1978, and works created but not published before January 1, 1978.[32] I contend that this life-plus-seventy term, rather than the ninety-five-year term for published pre-1978 works, should have applied here in order to meet the United States' Article 18 treaty obligations. If the term had been enacted properly, Matisse's works would have been protected through 2024 in the United States. Though many of his works are

30. Berne Convention *supra* note 26, art. 7(1) ("The term of protection granted by this Convention shall be the life of the author and fifty years after his death.").

31. 17 U.S.C. § 104A(a)(1)(B) (2006) ("Any work in which copyright is restored under this section shall subsist for the remainder of the term of copyright that the work would have otherwise been granted in the United States if the work never entered the public domain in the United States."); 17 U.S.C. § 304.

32. 17 U.S.C. §§ 302–03.

currently deemed to be in the public domain under § 104A,[33] there are also many that will be protected long after the term has expired around the rest of the world. Instead of expiring at the end of 2024, some of Matisse's paintings will be under copyright in the United States through 2049! The extra twenty-five years of protection is longer than any term the works would receive in their home country. This is because the United States is granting ninety-five years of post-publication treatment under § 304. If the proper term had been implemented under a life-plus system, this problem would not have occurred.[34]

It appears that the drafters of § 104A believed that they would fulfill the United States' Article 18 obligations by applying the term of *what the work should have received* had there been proper formalities or treaty relations.[35] But Article 18 does not require a country to apply local law to works previously unprotected. It requires the minimum Berne term be restored if the work is still under copyright in the country of origin, as a first step.[36] If Country X had a term of only ten years for domestic works and then joined Berne, Country X would be required to give foreign works a minimum term of life of the author plus fifty years, not merely the ten years given to domestic works.

Finally, the United States failed to meet its treaty obligations under Article 18 by explicitly *excluding* architectural works from retroactive protection. The Berne Convention requires the protection of architectural works as a subject-matter category.[37] On December 1,

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33. *Woman Reading* (1894), *Le Mur Rose* (1898), *Notre-Dame, une fin d'après-midi* (1902), *Green Stripe* (1905), *The Open Window* (1905), *Woman with a Hat* (1905), *Les toits de Collioure* (1905*), Landscape at Collioure* (1905*), Le bonheur de vivre* (1906), *The Young Sailor II* (1906), *Self-Portrait in a Striped T-shirt* (1906), *Madras Rouge* (1907), *Blue Nude* (*Souvenir de Biskra*) (1907), *The Dessert: Harmony in Red* (1908), *Bathers with a Turtle* (1908), *La Danse* (1909), *Still Life with Geraniums* (1910), *L'Atelier Rouge* (1911), *The Conversation* (1908–1912), *Zorah on the Terrace* (1912), *Le Rifain assis* (1912), *Window at Tangier* (1912), *Le rideau jaune* (1915), *The Window* (1916), *La leçon de musique* (1917), *The Painter and His Model* (1917), and *Interior A Nice* (1920). *Henri Mattisse*, WIKIPEDIA, http://en.wikipedia.org/wiki/Henri_Matisse (last visited Sept. 28, 2011).

34. Note that Matisse's unpublished works are measured by the proper term, because those works unpublished as of 1978 were measured under a life-plus system under § 303(a). 17 U.S.C. § 303(a) (2006).

35. This is, in fact, how the statute reads: "Any work in which copyright is restored under this section shall subsist for the remainder of the term of copyright that the work would have otherwise been granted in the United States if the work never entered the public domain in the United States." *Id.* § 104(a)(1)(B).

36. Berne Convention, *supra* note 26, art. 18(1).

37. *Id.* art. 2(1).

1990, the Architectural Works Copyright Protection Act ("AWCPA")[38] was enacted "in order to bring 'the United States in full compliance with . . . the Berne Convention.' "[39] However, architecture as subject matter was only protected on or after the passage of the Act and was *not* retroactive.[40] Article 18 requires restoration of *all* works still subject to copyright in their source country. Since the AWCPA includes plans,[41] many works that should have been given restoration were not. This is yet another example where the United States enacted legislation yet failed to become compliant with Article 18.

Two of the Government's three stated goals are therefore *not* met by § 104A: "attaining indisputable compliance with international agreements" and "remedying past inequitable treatment of foreign authors"—authors like Munch and Matisse—"who lost or never obtained copyrights in the United States."[42] Contrary to the widely held belief that § 104A set a good example for the rest of the world, the amendment instead shows once again that the United States is not willing to comply with international norms. And even when "complying," the United States makes up its own rules contrary to the treaties it has signed.

B. The Importance of the Rule of the Shorter Term and International Norms

> In any case, the term shall be governed by the legislation of the country where protection is claimed; however, unless the legislation of that country otherwise provides, the *term shall not exceed the term fixed in the country of origin of the work.*
>
> —Berne Convention, Article 7(8)[43]

The Rule of the Shorter Term, as described in Article 7(8) of the Berne Convention, is adopted around the world, including in Europe, as a way to force countries to lengthen their terms of protection. If

38. Pub. L. No. 101-650, §§ 701–06, 104 Stat. 5089, 5133–34 (codified as amended in scattered sections of 17 U.S.C.).

39. 1 NIMMER ON COPYRIGHT § 2.20[A] (2011) (quoting H.R. Rep. No. 101-735, at 4 (1990)).

40. Architectural Works Copyright Protection Act, Pub. L. No. 101-650, § 706, 104 Stat. 5089, 5134 (stating that the Act applies only to: (1) works created after enactment and (2) works that are unconstructed after enactment but embodied in unpublished plans, so long as the work is constructed by Dec. 31, 2002).

41. *See* 17 U.S.C. § 101 (2006) (defining "architectural work").

42. Brief for the Respondents in Opposition to Petition for Writ of Certiorari at 19, Golan v. Holder, No. 10-545 (U.S. Jan. 18, 2011).

43. Berne Convention, *supra* note 26, art. 7(8) (emphasis added). The Rule of the Shorter Term is also known as "comparison of terms."

Country X has a term of ten years, Country X's works will only be given a term of ten years in Country Y, even if Country Y's term is longer. The idea is that Country X will then match the longer term of Country Y to gain the additional protection. The Rule of the Shorter Term is a key component to the Berne Convention and a basic mechanism for encouraging other countries to have longer terms than merely the minimum. The European Union has readily adopted it. In the 1990s, Congress extended American copyright terms from fifty to seventy years in order to gain the additional twenty years of protection for U.S. works abroad that the Rule of the Shorter Term affords.[44]

Berne is not a self-executing treaty, and the United States elected not to include the Rule of the Shorter Term as part of the 1976 Copyright Act.[45] Foreign works thus gain the benefit of U.S. protection even if the term in the source country expires. By explicitly opting out of the Rule of the Shorter Term, the United States has not fully embraced the entire system. This puts U.S. authors abroad at a great disadvantage relative to foreign authors in the United States. Their works fall under the Rule of the Shorter Term, but foreign works at home do not. No term abroad will be ninety-five years from publication. The United States gives some foreign works a far greater term for no actual direct or even indirect benefit. While the latest of Matisse's paintings will be protected in the United States until 2049, Reginald Marsh, an American artist who also died in 1954, will fall out of copyright abroad in 2024.

Had the United States adopted the Rule of the Shorter Term, the misconfiguration under § 304 of the 1976 Copyright Act would not have been as dramatically disharmonized with the rest of the world. For the majority of works under consideration, the term would have been limited by the life-plus system of the home country, even with a term of life plus seventy. The Matisse overprotection problems under the current system would have been taken care of. All Matisse's works would have come into the public domain at the end of 2024.[46] The Rule

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44. Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, § 102(b), 112 Stat. 2827, 2827 (1998). For more on the Rule of the Shorter Term and the E.C. Term Directive, see GOLDSTEIN & HUGENHOLTZ, *supra* note 26, at 292–94.

45. 17 U.S.C. § 104(c) (2006).

46. There is a similar problem with foreign sound recordings. In *Capitol Records, Inc. v. Naxos of Am., Inc.*, 830 N.E.2d 250, 253 (N.Y. 2005), British recordings of classical works had fallen into the public domain in their home country. The New York Court of Appeals found that the Rule of the Shorter Term did not apply, and that the recordings remained under common law copyright in New York through February 15, 2067. *Id.* at 265. If the Rule of the Shorter Term had been included in federal copyright law, all foreign sound recordings in the public domain in

of the Shorter Term is a mechanism to bring harmonization to the world's copyright system. By opting out, the United States continues to be an outlier in the system.

C. Americans Abroad and at Home

The Government argues that § 104A was necessary in order to better protect American authors' interests abroad. Very little evidence is given for this assertion; what is usually cited, with no supporting evidence, are the examples of Thailand[47] and Russia. This Section discusses the research my students and I have conducted on Russian copyright at Tulane University Law School.[48] This research suggests that the Government overstates the impact of § 104 for protection of American works in Russia.[49]

Russia did restore foreign works—but not completely. The USSR only began protecting foreign works on May 27, 1973, when it joined the Universal Copyright Convention. Works published before that date remained in the public domain.[50] In 1995, Russia joined the

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their country of origin would now be in the public domain in the United States, which would conform to international expectations.

47. The United States has had a bilateral trade agreement regarding copyrights with Thailand since September 1, 1921. *See* U.S. COPYRIGHT OFFICE, *supra* note 19, at 9. This means that U.S. works should have been protected by national treatment in Thailand for ninety years. It is curious why restoration would be needed; it seems like the problem would be enforcement rather than protection.

48. Zachary Christiansen did the bulk of the research, but other students included Evan Dicharry and Tatiana Okisheva.

49. The only actual "evidence" regarding Russia and Thailand comes from testimony by Ira Shapiro, General Counsel, Office of U.S. Trade Representative, where he said, "Some other countries, such as Thailand and Russia, have refused to protect U.S. works in the public domain in their territory citing the U.S. interpretation of Berne Article 18 as justification." *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. 137, 246 (1994) (statement of Ira S. Shapiro, General Counsel, Office of the United States Trade Rep.). This same evidence is used in multiple amicus briefs. *See, e.g.*, Brief for the American Society of Composers, Authors and Publishers et. al. as Amici Curiae in Support of Respondent at 27, Golan v. Holder, No. 10-545 (U.S. June 14, 2011) (offering Shapiro's testimony as one example of the ways in which the enactment of § 104 has helped advance international protection of U.S. copyrighted works).

50. MICHIEL ELST, COPYRIGHT, FREEDOM OF SPEECH, AND CULTURAL POLICY IN THE RUSSIAN FEDERATION 81–83 & nn.150, 153 (2005); Memorandum of Law from Zachary Christiansen, J.D. Candidate, Tulane Univ. Law Sch., to Anthony Falzone, Exec. Dir., Fair Use Project (Sept. 18, 2011) (on file with author).

Berne Convention, and so Article 18 applied for the first time.[51] But regarding retroactivity, Russia made a reservation under Article 18(3): Russia would not restore works that were previously in the public domain.[52] It appears, therefore, that Russia deliberately chose not to restore works in accordance with Berne after the enactment of § 104A in the United States. Russia did alter its law in 2004—ten years after § 104A was passed—but in practice, many believe it still has not implemented retroactivity.[53] A brief in support of the Respondents admits to the same timeline but tries to spin it as proof that somehow Russia enacted retroactivity in response to the URAA.[54] Plainly, that was not the case.

There is one more interesting piece to the story. According to the Motion Picture Association of America ("MPAA"), Russia and the United States entered into a bilateral trade agreement where retroactivity upon joining Berne was part of the equation.[55] I decided to look into this statement. In 1991—before the URAA had gone to

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51. World Intellectual Prop. Org., Berne Notification No. 162, Accession by the Russian Federation, Dec. 13, 1994, *available at* http://www.wipo.int/treaties/en/notifications/berne/treaty_berne_162.html.

52. *Id.* ("It is understood that the effects of the above mentioned Convention shall not extend to the works which, at the date of entry into force of the said Convention in respect of the Russian Federation, are already in the public domain in its territory.").

53. *See* Sergey Budylin & Yulia Osipova, *Is AllOfMp3 Legal? Non-Contractual Licensing Under Russian Copyright Law*, 7 J. HIGH TECH. L. 1, 3–4 (2007) (discussing the 2004 amendments to Russian copyright law and their subsequent implementation); Brief for the International Publishers Ass'n et al. as Amici Curiae in Support of Respondents at 23 n.45 *Golan*, No. 10-545 (U.S. Aug. 4, 2011) ("The Russian Federation . . . explicitly declined to adopt any restoration when it joined Berne in 1995. In 2004, however, as Russia prepared to accede to the WTO, it amended its copyright law to provide for restoration."(citations omitted)).

54. One of the amicus briefs in support of the Respondents framed the facts as follows: "Similarly, during the 1994 joint hearing, members were told that the Russian government had made clear that it would provide retroactive protection only if the United States reciprocated with retroactive protection for Russian works. Russia subsequently amended its law, but only after section 514 was enacted." Brief for the American Society of Composers, Authors and Publishers as Amici Curiae in Support of Respondent, *supra* note 49, at 30. This seems, inaccurately, to make it appear as if retroactivity occurred immediately. The Motion Picture Association of America presented the same scenario in this manner: "Russia resisted providing protection for U.S. works created before the United States and the Soviet Union established copyright relations in 1973. But after the United States adopted Section 514, Russia restored the copyrights on U.S. works." Brief for the Motion Picture Ass'n of Am. as Amicus Curiae Supporting Respondents at 6, *Golan*, No. 10-545 (U.S. Aug. 2011).

55. *See* Brief for the Motion Picture Ass'n of Am. as Amicus Curiae Supporting Respondents, *supra* note 54, at 25 ("This commitment to follow the United States' lead on copyright restoration was memorialized in a bilateral trade agreement in which Russia pledged to join the Berne Convention and to comply with Article 18's requirement to protect preexisting works. Congress's adoption of Section 514 thus set the stage for Russia to reciprocate, which it did by granting full protection to existing U.S. works." (citations omitted)).

Congress for approval—the United States and Russia entered into the "Russian Federation–United States: Exchange of Notes."[56] The agreement memorializes an exchange of letters in 1990 and 1991. The document acknowledges that the new Russian Federation is a party to the Universal Copyright Convention "with an effective date of May 27, 1973," and to the Paris Convention as of "July 14, 1967."[57] However, there is *no* mention of the Berne Convention or retroactivity in this document. The MPAA presented no actual support for the proposition that the United States had already agreed to retroactivity with Russia in 1991. It is misleading the court to cite to the Exchange of Notes.

Aside from these specific factual discrepancies, there is something more deeply wrong with the Government's American-interests argument: it supposes that the only American interests at issue are those of copyright holders with interests abroad. It doesn't seem to recognize the impact of § 104A on copyright holders at home—reliance parties are often copyright holders who legally incorporated public domain materials into their new works.[58] The rhetoric of the Government's brief and the second Tenth Circuit decision seems to imply that the Petitioners are out to hurt American interests.[59] But the *Golan* case is about what works can be used within the United States—a deeply American question. The Government's division between Petitioners and Americans hides the reality that the Petitioners are actually Americans seeking to use works in America.

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56. Exchange of Notes Concerning the Entry into Force of the Agreement on Trade Relations, U.S.-Russ., June 17, 1991, 31 I.L.M. 790 (1992).

57. *Id.* at 791 ("It is understood that in the letters on intellectual property which the sides exchanged on June 1, 1990, references to bills introduced prior to signature of this note are not relevant for purposes of this Agreement, without prejudice to any obligations to review, introduce, support, enact or implement specified provisions of law, and that the Government of the Russian Federation will introduce in 1992 the drafts of laws required for fulfillment of the obligations contained in Article VIII of the Agreement and will take all measures necessary for enactment of these laws during 1992.").

58. *See* 1 RICKETSON & GINSBURG, *supra* note 18, at 332–33 ("[D]ifficulties may occur with respect to the position of persons in that country who have been exploiting the works in the absence of any legal protection. These users acted in good faith in reliance of a given state of affairs, namely that these works were in the public domain and could be used freely. In pursuance of this reliance, they may also have invested capital and labour in the furtherance of these activities. . . . Are these people suddenly to find themselves in the position of infringers . . . ? [I]t would be unfair for the fruits of these undertakings to be forfeited to the foreign copyright owner.").

59. *See* Golan v. Holder, 609 F.3d 1076, 1084 (10th Cir. 2010) ("Although plaintiffs have First Amendment interests, so too do American authors."); Brief for the Respondents, *supra* note 6, at 49–53 (arguing for the interests of American authors abroad).

III. SUPPORT FOR THE PETITIONERS' TRADITIONAL-CONTOURS ARGUMENT: § 104A ANALYZED

In determining that First Amendment scrutiny was appropriate, the Tenth Circuit held that § 104A violated the "traditional contours of copyright."[60] Its analysis of the issue focused on two components: the functional effect of the law on copyright and the law's consistency with Congress's historical copyright practice.[61] Before the Supreme Court, the parties' briefs and some of the amici briefs engage in a lengthy discussion of historical practice;[62] they also discuss the functional implications of the law.[63] This Part looks at the traditional contours in a third way: On a mechanical level, what does § 104A actually do? Section 104A turns out to be like nothing we've seen before in the U.S. copyright system, signaling a seismic shift in the expectations and clarity of the law.

Section 104A automatically restored copyright to three types of foreign works: (1) foreign works that came into the public domain due to lack of treaty relations (think USSR pre-1973);[64] (2) foreign works whose authors had not fulfilled the complex formality obligations under U.S. law;[65] and (3) foreign sound recordings.[66] The restoration

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60. Golan v. Gonzales, 501 F.3d 1179, 1187–88 (10th Cir. 2007).

61. *Id.* at 1189.

62. *See* Brief for the Petitioners, *supra* note 5, at 3 ("For two hundred years, copyright legislation was consistent with a simple command: what enters the public domain remains in the public domain."); Brief for the Respondents, *supra* note 6, at 2–7 (discussing historical evolution of pertinent constitutional, international, and statutory provisions); Brief for Creative Commons Corp. as Amicus Curiae in Support of Petitioners, *supra* note 10, at 10–11 ("In 1790, there was no 'public domain of the United States' because at least one state granted perpetual common law copyright protection even after publication."); Brief for H. Tomas Gomez-Arostegui and Tyler T. Ochoa as Amici Curiae in Support of Petitioners, *supra* note 10, at 2 ("This brief discusses the historical record and concludes that the record does *not* support the view that the First Congress believed it was removing works from the public domain.").

63. *See* Brief for the Respondents, *supra* note 6, at 32 ("In enforcing that 'federal policy,' this Court has held to be preempted state laws that conferred patent-like protection on inventions that were not patentable under federal law."); Brief for Information Society Project at Yale Law School Professors and Fellows as Amici Curiae in Support of Petitioners, *supra* note 5, at 12 ("Allowing Congress to disrupt [the] life cycle [of creative work] by removing works from the public domain would seriously undermine the free-speech-protecting functions of copyright.").

64. 17 U.S.C. § 104A(h)(6)(c)(iii) (2006).

65. *Id.* § 104A(h)(6)(c)(i).

66. *Id.* § 104A(h)(6)(c)(ii). Though they are included in the statute, foreign sound recordings are a complete anomaly. They were protected by state law and thus not in the public domain in the United States. Federal law will not preempt state protection of sound recordings until February 15, 2067. *Id.* § 301(c). At least one state has held that common law protection extends

was automatic, but qualifying for restoration required many elements.[67] I have written in detail on this process, so I will not repeat the analysis here.[68] Instead, this Part will point out two particularly troubling aspects of § 104A that violate traditional expectations of how copyright law works. First, for the first time, § 104A requires one to look to foreign law to determine the copyright status of works in the United States. Second, much of the data necessary to determine whether a work qualifies for restoration is unknowable or highly inaccessible. This situation leaves a good many works in limbo between the public domain and restoration—something never before seen with U.S. copyright law.[69]

One of the most dramatic shifts away from tradition is § 104A's incorporation of foreign copyright law into U.S. copyright law. The United States has never before looked to the copyright law of other countries to determine its terms of protection. Before the enactment of § 104A, as long as the source country had treaty relations with the United States, national treatment was applied to all works, regardless of the term in the source country.[70] This meant that many foreign works came into the U.S. public domain for failure to meet formalities imposed, even though the copyright continued in their source countries.[71] Now, Article 18 did require the restoration of some works that had come into the public domain in the United States. But § 104A got it wrong in its interpretation of the United States' obligation as a new member of Berne.

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to pre-1972 sound recordings until that date. Capitol Records, Inc. v. Naxos of Am., Inc., 830 N.E.2d 250, 265 (N.Y. 2005).

67. *See generally* Townsend Gard, *supra* note 4 (providing an extensive discussion of restoration of foreign works).

68. *Id.*

69. *See id.* at 179–83 (discussing § 104A's reliance mechanisms and the complications arising from the statute's creation of reliance parties, notice requirements, and situations where uses are not infringing).

70. *See* 17 U.S.C. § 104(b) (2006) (extending copyright protection to published works of foreign origin provided that the foreign nation is a treaty party with the United States). National treatment is a basic concept in international law that requires a country to apply the same copyright rules to foreign authors that it applies to its own authors. National treatment, along with minimum terms, is the bedrock principle of the Berne Convention. *See* GOLDSTEIN & HUGENHOLTZ, *supra* note 26, at 104–05 (discussing the national-treatment provision of the Berne Convention).

71. Section 104A restored copyright to these works, as well as to two other categories: (1) works that had not enjoyed protection due to lack of treaty obligations, and (2) sound recordings, which did not enjoy federal protection under U.S. copyright law until 1972. *See* 17 U.S.C. § 104A(h)(6) (2006) (defining "restored work").

Section 104A requires one to determine the copyright status of a work *before restoration occurred*.[72] For many foreign countries, this is the law just before restoration was granted in the United States, not the current law of the source country. Often, this means looking to *old* laws, not available online, as many countries around the world made significant revisions around the turn of the twenty-first century. Israel, for instance, passed a new copyright law in 2007. The previous law had been amended in 1999, and so to determine the copyright status of a foreign work from Israel, one must look to the British law of 1911 as applied by the British Mandate of 1924, the law as it was before the 1999 revisions.[73]

The burden on the copyright system to return to outdated laws radically departs from the traditional contours of copyright law. Moreover, it makes determining the copyright status of foreign works very, very difficult. At Tulane, it has taken my group and me over two years to compile the information necessary to implement § 104A into code for the Durationator® software, and we still have not completed the task. Moreover, we have never found this information collected in any form anywhere. Given this challenge, we are quite confident that at least this one element of § 104A—determining status in the source country before restoration occurred—has not been fully implemented. While the U.S. copyright laws are available for the public to view,[74] there is no similar resource for accessing the foreign laws necessary to determine the U.S. term for foreign works that are now part of the U.S. copyright system.

Had the Rule of the Shorter Term been enacted, one could argue that it would be unnecessary to look to old laws. Rather, one would only need to determine the copyright status of the work *today* and apply the Rule of the Shorter Term. This would actually fulfill the spirit of Article 18, which had as its goal harmonization of minimum

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72. As written, § 104A(h)(6)(B) requires one to determine whether the work "is not in the public domain in its source country through expiration of term of protection." Read with the other elements of the definition for "restored works" in § 104A(h)(6)(C)—including the requirement that the work be "in the public domain in the United States"—this provision establishes that one must determine the copyright status of the work in the source country at the time before restoration, when the work was still in the public domain in the United States.

73. *See* Debbie L. Rabina, *Copyright Protection in Israel: A Reality of Being 'Pushed into the Corner,'* INFO. RES. (July 2001), http://informationr.net/ir/6-4/paper110.html (analyzing intellectual property ownership rights in Israel under the British law of 1911 and describing Israeli intellectual property laws in effect in 2001).

74. *E.g.*, U.S. COPYRIGHT OFFICE, CIRCULAR 92: COPYRIGHT LAW OF THE UNITED STATES AND RELATED LAWS CONTAINED IN TITLE 17 OF THE UNITED STATES CODE (2009), *available at* http://www.copyright.gov/title17/circ92.pdf (relating the text of Title 17 of the United States Code, including all amendments enacted through June 30, 2009).

terms for all members. Moreover, if the term had been measured on the life-plus system, as required by Article 18, less configuring on a work-by-work basis would be required. But the system as it is enacted now is confused, complex, and impossible.

While gathering and researching old laws is time consuming, other data required to determine copyright status under § 104A is actually unknowable, or creates such an undue search burden as to be practically unattainable. There are many examples: a restored work must have "at least one author or rightholder who was, *at the time the work was created*, a national or domiciliary of an eligible country."[75] Hence, in order to figure out whether a work is eligible for restoration, one must determine when a work was created *and* whether a rightholder was a domiciliary or a national of an eligible country. Researching "creation jurisdiction" in this way requires biographical knowledge of the author. What about people who were stripped of their citizenship, as in Nazi Germany or Stalinist Russia? What if those authors fled to a foreign land or were imprisoned in a concentration camp on nonnative soil? These may seem like extreme situations, but § 104A concentrates on a period of time—1923 to 1989—when the world was in great upheaval.

Take, for instance, Stefan Zweig, an Austrian-born writer, who fled Austria in 1934, lived in London until 1940, moved briefly to the United States, and then moved to Brazil in 1941. Over the course of 1939 to 1941, he worked on a novella titled *The Royal Game*, which was posthumously published in 1942 in Buenos Aires, Argentina.[76] Is this work eligible for restoration if part of the work was created in the United States? What if Zweig had created all of the work in the United States? If he had never moved to Brazil, became a U.S. citizen, but published the work in Brazil? Section 104A makes us contemplate and sort through these kinds of scenarios.

But creation jurisdiction is not as problematic as "simultaneous publication"—the statutory requirement that a published foreign work "was first published in an eligible country and not published in the United States during the 30-day period following publication in such

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75. 17 U.S.C. § 104A(h)(6)(D) (2006) (emphasis added).

76. *See generally* STEFAN AND LOTTE ZWEIG'S SOUTH AMERICAN LETTERS: NEW YORK, ARGENTINA AND BRAZIL, 1940–42 (Darien J. Davis & Oliver Marshall eds., 2010) (chronicling the lives of Stefan and Charlotte Zweig and reproducing personal letters written by the couple); STEFAN ZWEIG, THE WORLD OF YESTERDAY: AN AUTOBIOGRAPHY (Anthea Bell trans., 2009) (narrating the life of Stefan Zweig); Peter Gay, *Introduction* to STEFAN ZWEIG, CHESS STORY, at v–xiv (Joel Rotenberg trans., 2006) (relating the life of Stefan Zweig and introducing the novella).

eligible country."[77] Simultaneous publication seems to come up as an impediment very frequently. Whether a work was "not published in the United States during the 30-day period" is often an impossible element to determine. It requires tremendously specific knowledge about publication history and each individual author. While working on problems for various groups and individuals seeking to determine copyright statuses of foreign works, we found that we often could not discern from records available whether a work had been published in the United States within thirty days of its first publication in an eligible country. We could arrive at a year, but arriving at a month and day was nearly impossible.[78] John Mark Ockerbloom, a copyright expert, has had similar experiences. In an email correspondence, he explained, "I've had a lot of experience (and frustration) trying to clear post-1922 works by foreign authors because of the 30-day simultaneous publication window and the lack of good, comprehensive resources on when exactly works were first published where."[79] University of Michigan librarian Anne Karle-Zenith, who clears works for the HathiTrust Project, found similar difficulties.[80] William Patry

77. 17 U.S.C. § 104A(h)(6)(D) (2006). The thirty-day provision will now have the effect of denying restoration to foreign works. However, this thirty-day window used to be referred to as "backdoor Berne," because a work was protected by Berne if it was published in a Berne country and in the United States within thirty days. *See* Barbara A. Ringer, *The Role of the United States in International Copyright—Past, Present and Future*, 56 GEO. L.J. 1050 (1968) (analyzing the United States' inadequate involvement in the development of international copyright law and suggesting the need for a new international law). As 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.

Id. at 1059.

78. Evan Dicharry, a Team Durationator student and IP Fellow, particularly felt this frustration in working with examples from the University of Michigan. He came to believe simultaneous publication was an unwelcome and unworkable exception to restoration, given the age and inaccessibility of the records. Theoretically the restriction made sense, but on a practical level, simultaneous publication was impossible.

79. E-mail from John Mark Ockerbloom, IT Senior Project Leader, Univ. of Pa. Library, to Elizabeth Townsend Gard, Assoc. Professor, Tulane Univ. Law Sch. (June 1, 2011) (on file with author).

80. E-mail from Anne Karle-Zenith, Librarian, Univ. of Mich., to Elizabeth Townsend Gard, Assoc. Professor, Tulane Univ. Law Sch. (June, 1, 2011) (on file with author) ("So right now we have 1516 volumes reviewed in CRMS but marked as undetermined because they might be foreign or first published abroad. We have over 9300 filtered out of the queue as likely to be non-US/first published outside the US, with the idea that maybe someday if we can train people to make these difficult determinations we can easily identify them if we want to have a go at

states his point nicely: "This simultaneous publication bar will, no doubt, cause many Canadian and British publications to be deemed ineligible for restoration, since U.S. publishers frequently published simultaneously in both the United States and Canada or Great Britain."[81]

Another example of the confusion created by § 104A concerns the Notice of Intent to Enforce Restored Copyrights ("NIE"), a mechanism that allowed foreign authors a two-year period to file constructive notice with the U.S. Copyright Office.[82] In our research at Tulane, we found many instances where NIEs either were not necessary because the works were still under copyright (as in the case of J.R.R. Tolkien) or were false (as in the case of two NIEs filed for Charlie Chaplin films produced in the United States).[83] An NIE is the only way to give the public constructive notice, and yet no evaluation by the Copyright Office is required to determine its accuracy. With a statute as complicated as § 104A, determining accuracy seems fairly important, as average Americans wanting to determine whether constructive notice had been served—assuming they were able to understand what that meant in a reliance context—would find the whole process nearly impossible. At a recent Copyright Office Roundtable, even a representative of the Recording Industry Association of America ("RIAA") admitted to the system's poor orchestration. When asked whether NIEs should apply to potentially federalized sound recordings, Eric Schwartz, representing the RIAA answered:

> It just doesn't make sense—to require rights-holders only in the sound recordings era to have to use it or lose it . . . . [I]n the proposals and the GATT restoration provisions with the notions of the notices of intent to enforce, which was something that Barbara Ringer of the Copyright Office was involved in the drafting, they were just full of fraudulent filings. Look at all of the Leni Riefenstahl filings. . . . [T]hese are public domain materials for which, you know, these companies filed filings and they are in the Copyright Office's database because the Copyright Office decided that it wasn't going to review the materials. So whatever got posted was posted, and people made claims on materials and there it was. That's not really an effective or efficient way to do anything.[84]

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them (or have someone else have a go—maybe once the Determinator [Durationator] is up and running!).").

81. 7 PATRY ON COPYRIGHT § 24:34 (2011).

82. 17 U.S.C. § 104A(d)(2)(A)–(B) (2006).

83. Townsend Gard, *supra* note 4, at 149–53.

84. Pre-1972 Sound Recordings Public Meeting at 00369–70 (June 3, 2011) (transcript available at http://www.copyright.gov/docs/sound/meeting/transcript-06-03-2011.pdf). It should be noted that it was I that asked him about NIEs, and whether he thought they were a good idea. I was very surprised by his answer.

Finally, it appears that NIEs were never listed at the U.S. Copyright Office for countries that became parties to the restoration provisions after January 1, 1996.[85] The constructive notice system—so critical for reliance parties—is completely unreliable, incomplete, and full of inaccuracies. The U.S. public deserves better. Registration has always been prima facie evidence of ownership, rebuttable in court.[86] The public relies on the copyright records. To have a system with such uncertainty now as part of the record violates the traditional contours of copyright law.

These are only a few examples of the problems with § 104A. Many more exist, including significant technical problems with both reliance parties (the subject of *Golan v. Holder*) and the *Twin Books* line of cases, something the Google amicus brief finds very frustrating.[87] But what these examples make clear is that the drafting of § 104A opened the door to many new, difficult elements that had not previously been part of the copyright system. In this way, § 104A deeply altered the traditional contours of copyright law on a mechanical level.

IV. CONCLUSION

The American public should be concerned about Congress's ability to dramatically change the rules of the copyright game through treaty-implementing legislation. As the Yale Law School amicus brief explains, "If public domain status . . . could be revoked at the pleasure of Congress, then authors who use public domain works to build new creations could be stripped at any time of the right to perform and distribute those new works. Such instability would discourage people from using the public domain to speak and create new works."[88] The public domain should be a constitutionally protected space, a one-way trip. Otherwise, the physics of the system becomes highly unreliable for businesses, copyright holders, and users of copyrighted works.

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85. *See Notices of Restored Copyrights*, U.S. COPYRIGHT OFFICE, http://www.copyright.gov/gatt.html (last visited Sept. 19, 2011) (providing database of NIEs).

86. *See, e.g.*, Registration of Claims to Copyright—Renewals, 72 Fed. Reg. 61,801, 61,801–02 (Nov. 1, 2007) (citing 17 U.S.C. §304(a)(4)(B) (2006)) ("A certificate of registration constitutes prima facie evidence as to the validity of the copyright during its renewal term and of the facts stated in the certificate.").

87. Brief for Google, Inc. as Amicus Curiae in Support of Petitioners, *supra* note 8, at 29–35. For more on reliance problems and *Twin Books*, see Townsend Gard, *supra* note 4, at 170–79.

88. Brief for Information Society Project at Yale Law School Professors and Fellows as Amici Curiae in Support of Petitioners, *supra* note 5, at 16–17.

Section 104A needs a careful analysis. If the Supreme Court were to find § 104A unconstitutional, Congress would be forced to revisit the policy and mechanics of restoration independent of the pressure of enacting larger treaty-implementing legislation. Once the judiciary provides clearer legal boundaries for restoration, Congress would then be given the opportunity to draft a law that fits within better-defined traditional contours of copyright.

To that end, if Congress were given an opportunity to correct the mistakes of § 104A, the following steps are suggested:

- For foreign works that were in the public domain in the United States before January 1, 1996, (or later, for works from countries whose works became eligible for restoration after January 1, 1996), the term of protection would be at least the Berne minimum of the life of the author plus fifty years. More likely, it would be the current term in the United States, life of the author plus seventy years. The United States would then be in compliance with Article 18 of the Berne Convention.

- The Rule of the Shorter Term should be applied to all foreign works, including sound recordings. The United States would be following international norms in adopting Article 7(8) of the Berne Convention.

- For works that were in the public domain in the United States before January 1, 1996, no statutory damages or attorney's fees would apply unless the copyright holder registered the work in a timely manner, with a time period designated in a revised § 104A. This registration would serve as constructive notice of intent to enforce a restored copyright, replacing the NIEs that have proved unreliable.

- The U.S. Copyright Office should adopt the use of the Durationator® software tool to aid in determining the copyright status of works in the country of origin and eligibility for restoration under § 104A.[89]

89. The Durationator® Experiment, as created by Tulane University Law School, attempts to understand all of the details needed to determine the copyright status of works, including the complexities of § 104A and the foreign laws involved. *See supra* note 1 and accompanying text. Unless there is such a tool available for the public, I am afraid that § 104A remains a barrier, both for copyright holders and users. The law has simply become too complicated.

Section 104A, as written now, contravenes the traditional contours of copyright law in its mere mechanics. Those of us at Tulane who have worked tirelessly on copyright terms from around the world hope the U.S. Supreme Court upholds the Tenth Circuit's decision in this regard. We also believe the Court should find the statute unconstitutional for want of a substantial government interest. Section 104A does not achieve the interests the Government claims it does: it does not fulfill U.S. treaty obligations under Berne Article 18, it does not make foreign authors whole, and there is no direct or even indirect evidence that it helps protect American works abroad. Therefore, the Supreme Court should uphold the Petitioners' First Amendment rights to use the public domain works and should find § 104A unconstitutional. And even if the Court decides differently, Congress should revisit the statute to give us a more manageable copyright regime.