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PROTECTION FOR WORKS OF FOREIGN ORIGIN UNDER THE 1909 COPYRIGHT ACT

Tyler T. Ochoa†

Abstract

One of the principal goals of the 1909 Copyright Act was to simplify and streamline the formalities required to obtain copyright protection. Before the 1909 Copyright Act, authors had to register their works before publication in order to be eligible for copyright protection; and notice of the registration had to be included on all copies published in the United States. If a work was published anywhere in the world before registration, or if the notice was omitted when the work was published domestically, the work went into the public domain. Under the 1909 Act, however, authors only had to publish their works with proper copyright notice in order to be eligible for copyright protection.

This change introduced an ambiguity with regard to works first published outside the Untied States. If a work had to be published with proper notice to receive copyright protection, but notice was required only on copies published in the United States, what was the effect if a work was first published outside the United States without proper notice? Some courts held that mere publication in a country with whom the U.S. had copyright relations was sufficient to invest a work with a federal statutory copyright; while others held that such a work neither received a federal statutory copyright nor was it placed in the public domain by foreign publication without notice. This uncertainty can result in copyright terms that differ by as much as one hundred years, depending on how the ambiguity is resolved.

In this article, the author concludes that Congress most likely intended that works first published outside the United States without

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proper notice were not eligible for copyright protection and became part of the public domain. This result means that such works were eligible for the copyright restoration for works of foreign origin that became effective in 1996, and that parties utilizing such works should be treated as reliance parties under the restoration statute, rather than as ordinary infringers.

I. INTRODUCTION

One of the principal goals of the 1909 Copyright Act ("1909 Act") was to simplify and streamline the formalities required to obtain copyright protection. In general, the 1909 Act achieved this goal. Before the 1909 Act, authors had to register their works *before* publication in order to be eligible for copyright protection;[1] but under the 1909 Act, authors only had to publish their works with proper copyright notice in order to be eligible for copyright protection.[2] While registration was still required in order to file an infringement suit, or to obtain a renewal of the copyright term,[3] it cannot be doubted that the simplified publication-with-notice procedure made it much easier for most authors to obtain copyright protection.

To this happy generalization, however, there is one notable exception: for works of foreign origin, the 1909 Act introduced an ambiguity regarding the steps needed to obtain copyright protection. Thanks to conflicting case law, the ambiguity persists to this day for works first published in a foreign country before 1978,[4] making it extremely difficult to tell whether such a work is or is not in the public domain. As illustrated by a recent case, this uncertainty can result in copyright terms that differ by as much as one hundred years, depending on how the ambiguity is resolved.[5]

This article will describe the protection available to works of foreign origin in the United States, both before and after the 1909 Copyright Act, and will explain how the ambiguity was introduced by

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1. *See infra* notes 36-41 and accompanying text.

2. *See* Copyright Act of 1909, ch. 320, § 9, 35 Stat. 1077 (codified at 17 U.S.C. § 10 in 1947, repealed 1978).

3. *See id.* at § 12 ("No action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this title with respect to the deposit of copies and registration of such work shall have been complied with."); *id.* at § 23 (renewal available "when application for such renewal and extension shall have been made to the Copyright Office and duly registered therein within one year prior to the expiration of the original term of copyright.").

4. *See infra* notes 53-105 and accompanying text.

5. *See infra* notes 106-129 and accompanying text.

the language of the 1909 Act. It will then explore the diverging case law that has arisen under the terms of the 1909 Act. Finally, it will suggest a resolution of the problem that should be adopted in future cases.

II. 1790 TO 1908

When the U.S. enacted its first Copyright Act in 1790 ("1790 Act"), it specifically provided that copyrights would only be granted to "citizens or residents" of the United States:

> [T]he author or authors of any map, chart, book or books . . . , being a citizen or citizens of these United States, or resident therein, . . . shall have the sole right and liberty of printing, reprinting, publishing and vending such map, chart, book or books.[6]

At the time, of course, every nation that had a copyright statute offered protection only to its own citizens or residents.[7] There was no point in granting an exclusive right to citizens or residents of other nations; doing so would harm the balance of trade by increasing the royalty payments that would flow to foreign authors and publishers.[8] It was therefore very much in the national interest to restrict copyright to a nation's own citizens and residents. But just to make sure that the effect of that restriction was absolutely clear, the Copyright Act of 1790 added the following proviso:

> [N]othing in this act shall be construed . . . 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.[9]

As the U.S. was primarily an English-speaking country, the principal effect of this restriction was that books by British authors could be freely copied and disseminated in the U.S., which provided U.S.

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6. Copyright Act of 1790, ch. 15, § 1, 1 Stat. 124 (repealed 1831).

7. *See* 1 SAM RICKETSON & JANE C. GINSBURG, INTERNATIONAL COPYRIGHT AND NEIGHBORING RIGHTS: THE BERNE CONVENTION AND BEYOND §1.20 at 19 (2d ed. 2005) ("unauthorized reproduction and use of foreign works . . . [continued] for a considerable period after the adoption of national copyright laws by most countries. . . . [W]hile protecting the works of their national authors, [most countries] did not regard the unauthorized exploitation of foreign works as either unfair or immoral.").

8. *Id.* at § 1.22 at 21.

9. Copyright Act of 1790, ch. 15, §5.

citizens and residents with a large quantity of reading material at cheap prices.[10] The restriction of copyright protection to U.S. citizens and residents was carried forward in the Copyright Act of 1831.[11]

Beginning in the 1820s, however, European nations began to enter into bilateral treaties on the basis of mutual reciprocity.[12] This arrangement would benefit both nations if the balance of trade in copyrighted works between them was relatively equal. Later, in 1852, France decided to unilaterally offer copyright protection in France to all authors, regardless of nationality or domicile, in the hope that it would encourage other countries to grant similar protection to French authors.[13] This move eventually led to the adoption in 1886 of the Berne Convention for the Protection of Literary and Artistic Works,[14] under which member nations agreed to provide copyright protection to the citizens and residents of other member nations on the basis of "national treatment," meaning that each nation would provide copyright protection to the citizens of other Berne nations on terms that were no less favorable than those it provided to its own citizens.[15]

The United States sent an observer to the diplomatic conference that adopted the Berne Convention,[16] but it chose not to become a member of the Berne Union for more than a hundred years.[17] There

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10. *See* WILLIAM BRIGGS, THE LAW OF INTERNATIONAL COPYRIGHT 46-47 (1906).

11. Copyright Act of 1831, ch. 16, § 1, 4 Stat. 436 (repealed 1870) ("[A]ny person or persons, being a citizen or citizens of these United States, or resident therein, who shall be the author or authors of any book, books, map, chart, or musical composition, . . . or who shall invent, design, etch, engrave, [or] work . . . any print or engraving, shall have the sole right and liberty of printing, reprinting, publishing, and vending such book or books, map, chart, musical composition, print, cut, or engraving."); *Id.* § 8 ("[N]othing in this act shall be construed . . . to prohibit the importation or vending, printing, or publishing, of any map, chart, book, musical composition, print or engraving, written, composed, or made, by any person not being a citizen of the United States, nor resident within the jurisdiction thereof.").

12. *See* 1 RICKETSON & GINSBURG, *supra* note 7, §§ 1.29-1.31, at 27-32, 40.

13. *See* Decree of Mar. 28, 1852; 1 RICKETSON & GINSBURG, *supra* note 7, § 1.24, at 22; PAUL GOLDSTEIN, INTERNATIONAL COPYRIGHT LAW § 2.1.1, at 17 (Oxford University Press 2001).

14. *See* 1 RICKETSON & GINSBURG, *supra* note 7, §§ 2.05-2.52, at 44-83.

15. *See* Berne Convention for the Protection of Literary and Artistic Works, art. 2, Sept. 9, 1886 ("Authors who are subjects or citizens of any of the countries of the Union . . . shall enjoy in the other countries for their works . . . the rights which the respective laws do now or may hereafter grant to natives."). The most recent revision of the Berne Convention provides for national treatment in art. 5. *See* Berne Convention for the Protection of Literary and Artistic Works, art. 5, September 9, 1886, as last revised at Paris on July 24, 1971, 1161 U.N.T.S. 30 ("Authors shall enjoy, in respect of works for which they are protected under this Convention, in countries of the Union other than the country of origin, the rights which their respective laws do now or may hereafter grant to their nationals.").

16. *See* 1 RICKETSON & GINSBURG, *supra* note 7, § 2.39, at 74-75, § 2.51, at 82.

17. *See* GOLDSTEIN, *supra* note 13, § 2.1.2.1, at 23 ("The United States was the single,

were a number of reasons for this extraordinary delay. First, in the beginning it was simply not in the national interest to offer copyright protection to foreign citizens. At the time, the U.S. produced very few copyrighted works that would be of interest to readers in other nations, so the economic benefit it would have received from a reciprocal arrangement was very small.[18] Conversely, the cost to the balance of payments, in terms of the royalties that would have flowed overseas, would have been very high.[19] It therefore very much remained in the national interest that U.S. citizens would continue to have a supply of reading material at cheap prices, regardless of the diplomatic cost of foreign authors complaining about U.S. "piracy".[20] Thus, for most of the 19th Century, the U.S. chose to remain what China is today: the biggest "pirate" nation of copyrighted works in the world.

Second, even when trade in copyrighted works began to even out, U.S. law had a number of features which were incompatible with membership in the Berne Convention. For example, because U.S. law was based primarily on a utilitarian theory of copyright, under which copyright is offered as a financial incentive to encourage authors and publishers to create and disseminate new works of authorship,[21] it made little sense to offer copyright protection to an author (or publisher) unless that author affirmatively claimed that he or she wanted the benefit of copyright protection; otherwise, the government

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commercially most important country to remain outside the Berne Union for its entire first century."). The United States eventually adhered to the Berne Convention effective Mar. 1, 1989. World Intellectual Property Organization, Berne Convention: Contracting Parties, http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=15 (last visited Apr. 20, 2010).

18. *See* United Dictionary Co. v. G. & C. Merriam Co., 208 U.S. 260, 264 (1908) ("in 1802, there was little ground to anticipate the publication of American works abroad. As late as 1820 Sydney Smith, in the Edinburgh Review, made his famous exclamation, 'In the four quarters of the globe, who reads an American book?'").

19. *See, e.g.*, GOLDSTEIN, *supra* note 13, § 2.3, at 47 ("International copyright and international trade are inherently linked. Any time one country undertakes . . . to protect works originating in another country, it makes at least implicitly a calculation of the decision's implications for the balance of trade.").

20. *Cf.* BRIGGS, *supra* note 10, at 47 (with regard to the United States, "little can be expected from the pressure of external interest, for America's capacity for self-support, due mainly to its geographic position, gives it the power in many matters to dictate its own terms.").

21. Thus, the 1790 Copyright Act was titled, "An Act for the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such copies, during the times therein mentioned." Copyright Act of 1790, 1 Stat. 124. *See also* Harper & Row Publishers, Inc. v. Nation Enter., 471 U.S. 539, 558 (1985) ("By establishing a marketable right to the use of one's expression, copyright supplies the economic incentive to create and disseminate ideas.").

was simply giving away a right to royalties without receiving anything in return. Thus, U.S. law had always required formalities, such as registration and notice, as a condition of copyright protection.[22] But because European countries were influenced more by author's rights theories of copyright, under which an author had a natural right to the economic fruits of his or her creative labor, the 1908 revision of the Berne Convention prohibited the imposition of any formalities as a condition of copyright protection.[23] For similar reasons, the delegates that adopted the Berne Convention recommended the adoption of a minimum duration of 30 years after the death of the author,[24] which usually was much longer than the then-maximum U.S. duration of 42 years after first publication.[25] In the 1908 revision of the Berne Convention, a minimum duration of 50 years after the death of the author was recommended,[26] and that minimum duration was made mandatory in 1948.[27] As a result, the U.S. could not join the Berne Convention until it was willing to make major changes in its fundamental approach to copyright protection.

Throughout the 19th Century, foreign authors (British authors in particular) regularly petitioned Congress to extend copyright protection to foreigners, but those pleas fell on deaf ears.[28] Thus, the Copyright Act of 1870 carried forward the limitation that only U.S. citizens or residents were eligible for copyright protection.[29] It was

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22. *Cf.* Wheaton v. Peters, 33 U.S. 591, 663-64 (1834) ("when the legislature are about to vest an exclusive right in an author or inventor, they have the power to prescribe the conditions on which such right shall be enjoyed; and . . . no one can avail himself of such right who does not substantially comply with the requisitions of the law.").

23. *See* Berne Convention for the Protection of Literary and Artistic Works, art. 54, Berlin Text, Nov. 13, 1908 ("The enjoyment and the exercise of these rights shall not be subject to any formality."); GOLDSTEIN, *supra* note 13, § 2.1.2.1, at 23 ("Political pressure to retain formalities . . . , which were prohibited since 1908 by the Berlin Text, was one reason the United States declined to join Berne.").

24. *See* 1 RICKETSON & GINSBURG, *supra* note 7, §§ 9.14-9.15, at 536-38.

25. 1870 Copyright Act (Act of July 8, 1870), ch. 230, §§ 87-88, 16 Stat. 212 (repealed 1909) (consisting of an initial term of twenty-eight years, plus a renewal term of fourteen years).

26. *See* Berne Convention for the Protection of Literary and Artistic Works, art. 7, Berlin Text, Nov. 15, 1908.

27. *See* Berne Convention for the Protection of Literary and Artistic Works, art. 7(1), Brussels Text, June 26, 1948.

28. *See generally* JAMES J. BARNES, AUTHORS, PUBLISHERS AND POLITICIANS: THE QUEST FOR AN ANGLO-AMERICAN COPYRIGHT AGREEMENT, 1815-54 (1974); RICHARD RODGERS BOWKER, COPYRIGHT: ITS HISTORY AND ITS LAW 341-64 (The Houghton Mifflin Company 1912); George Haven Putnam, *The Contest for Int'l Copyright*, in THE QUESTION OF COPYRIGHT 376-98 (compiled by George Haven Putnam, The Knickerbocker Press 1891).

29. 1870 Copyright Act (Act of July 8, 1870), ch. 230, § 86, 16 Stat. 212 (repealed 1909) ("any citizen of the United States, or resident therein"); *Id.* at ch. 230, § 103 ("nothing herein

not until the United States could boast of some authors of international prominence that it finally became in the national interest to extend copyright protection to citizens of other nations on a reciprocal basis. Those U.S. authors who could reasonably expect to earn royalties from publication of their works overseas added their voices to the chorus of foreign authors clamoring for some kind of international copyright protection in the United States.[30] In addition, even U.S. authors whose works were only popular domestically were tired of competing for business with cheap imports from Great Britain.[31] Finally, in 1891, the U.S. adopted the Chace Act, which extended copyright protection to citizens and residents of foreign nations when those nations agreed to provide copyright protection to U.S. citizens and residents:

> Provided further, that this act shall only apply to a citizen or subject of a foreign state or nation when such foreign state or nation permits to [U.S.] citizens . . . the benefit of copyright [by national treatment], or when such foreign state or nation is a party to an international agreement which provides for reciprocity in the granting of copyright [to which the U.S. is also a party].[32]

As a direct result of the Chace Act, the U.S. quickly entered into reciprocal copyright agreements with its major European trading partners, including the United Kingdom, France, and Germany.[33]

But even though a major barrier had been breached, the U.S. still made it difficult for foreign authors to obtain copyright protection in the United States. First, in a blatant protectionist measure, the U.S. simultaneously adopted the so-called "manufacturing clause," which provided that in order to obtain copyright protection in the U.S., foreign works had to be printed from plates manufactured or type set

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contained shall be construed to prohibit the printing, publishing, importation, or sale of any [work] . . . written, composed, or made by any person not a citizen of the United States nor resident therein.").

30. Among the prominent U.S. authors who lobbied Congress for an international copyright bill were James Fenimore Cooper, Ralph Waldo Emerson, Washington Irving, Henry Wadsworth Longfellow, Walt Whitman, John Greenleaf Whittier, and Mark Twain. *See* BOWKER, *supra* note 28, at 347, 355, 359; INTERNATIONAL COPYRIGHT: REPORT OF THE HONORABLE W.E. SIMONDS, OF CONNECTICUT, FROM THE HOUSE COMMITTEE ON PATENTS ACCOMPANYING H.R. 10881 (1890) in THE QUESTION OF COPYRIGHT, *supra* note 28, at 145-47.

31. *See* BRIGGS, *supra* note 10, at 98-99.

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

33. *See* GOLDSTEIN, *supra* note 13, § 2.1.1, at 18; Presidential Proclamation No. 3, 27 Stat. 981-82 (July 1, 1891) (establishing copyright relations between the United States and Belgium, France, Great Britain, and Switzerland); Presidential Proclamation No. 24, 27 Stat. 1021-22 (establishing copyright relations between the United States and Germany).

in the United States.[34] This requirement was gradually relaxed over the years, but in some form it was retained as a part of U.S. copyright law until 1986.[35]

Second, the U.S. still required foreign authors to comply with the formalities imposed by U.S. law. One of these formalities was the condition that the work be registered in the United States before it was published anywhere in the world.[36] Thus, a foreign author who published a work in his or her domestic market before thinking about doing so in the United States irrevocably lost the opportunity to obtain copyright protection here.[37] Another one of these formalities, dating back to 1802, was the requirement that copyright notice be inserted in all published copies of the work.[38] Thus, the 1870 Copyright Act required that:

> No person shall maintain an action for infringement of his copyright unless he shall give notice thereof by inserting in the several copies of every edition published . . . the following words, viz.: "Entered according to act of Congress, in the year _____, by A.B., in the office of the librarian of Congress, at Washington." [39]

In 1874, an amendment allowed the simplified short form of the notice that is familiar to us today: the word "Copyright," the date of

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34. *See* 1870 Copyright Act (Act of July 8, 1870), ch. 230, § 86, 16 Stat. 212 (repealed 1909) ("Provided, That in the case of a book, photograph, chromo, or lithograph, the two [deposit] copies . . . shall be printed from type set within the limits of the United States, or from plates made therefrom, or from negatives, or drawings on stone made within the limits of the United States, or from transfers made therefrom. During the existence of such copyright the importation into the United States of any book, chromo, lithograph or photograph, so copyrighted, or any edition or editions thereof, or any plates of the same not made within the limits of the United States, shall be, and is hereby prohibited [with certain exceptions].").

35. *See* Copyright Act of 1909, ch. 320, §§ 15-16, 35 Stat. 1078-79 (codified at 17 U.S.C. §§ 16-17 in 1947, repealed 1978); 17 U.S.C. § 601 (effective Jan. 1, 1978; setting a sunset date of July 1, 1986).

36. Act of Mar. 3, 1891, ch. 565, § 3, 26 Stat. 1107 (codified at Rev. Stat. § 4956) ("No person shall be entitled to a copyright unless he shall, on or before the day of publication in this or any foreign country, deliver at the office of the Librarian of Congress . . . a printed copy of the title of the [work] . . . for which he desires a copyright, no unless he shall also, not later than the day of publication thereof in this or any foreign country, deliver at the office of the Librarian of Congress . . . two copies of such [work].").

37. WILLIAM B. HALE, A TREATISE ON THE LAW OF COPYRIGHT AND LITERARY PROPERTY § 211, 13 C.J. 1074 (1917) (under the former law, "first or contemporaneous publication within the United States was essential to the existence of a copyright within the United States. Works first published abroad could not thereafter secure copyright protection in this country.").

38. *See* Act of Apr. 29, 1802, ch. 36, § 1, 2 Stat. 171.

39. Act of July 8, 1870, ch. 230, § 97, 16 Stat. 214.

first publication, and the name of the author or copyright claimant.[40] Failure to include the copyright notice on published copies meant that the author or copyright owner forfeited U.S. copyright protection for his or her work.[41]

The notice requirement was retained without discussion when copyright was extended to foreign authors in 1891.[42] This immediately led to a question of interpretation: was copyright notice required only when the work was published in the United States? Or did an author also have to include a copyright notice when the work was published outside the United States, at the risk of losing his or her copyright protection?

When the question finally reached the U.S. Supreme Court in 1908, the Court, in *United Dictionary Co. v. G. & C. Merriam Co.*,[43] held that notice was only required on copies published in the United States: "We are satisfied that the statute does not require notice of the American copyright on books published abroad and sold only for use there."[44] Writing for the Court, Justice Holmes reasoned that "it is unlikely that [Congress] would make requirements of personal action beyond the sphere of its control . . . [or] that it would require a warning to the public against the infraction of a law beyond the jurisdiction where that law was in force."[45] The court also noted when the notice requirement was added in 1802, international copyright relations did not exist. "If a publication without notice of an American copyright did not affect the copyright before the days when it was possible to get an English copyright also, it is not to be supposed that Congress, by arranging with England for that possibility, gave a new meaning to the old [statute], increasing the burden of American

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40. Act of June 18, 1874, ch. 301, § 1, 18 Stat. 78-79. The use of the familiar © symbol in lieu of the word "Copyright" was first allowed for certain categories of works in the 1909 Act. *See* Copyright Act of 1909, ch. 320, § 18, 35 Stat. 1079 (codified at 17 U.S.C. § 19 in 1947). This was extended to all works in an amendment that became effective in 1955. Pub. L. No. 83-743, ch. 1161, § 1, 68 Stat. 1031 (codified at former 17 U.S.C. § 9(c), and repealed 1978); *id.* § 3, 68 Stat. 1032.

41. HALE, *supra* note 37, § 213, 13 C.J. at 1075 ("The omission of the notice by or with the consent of the copyright proprietor destroys the copyright and puts the work irrevocably into the public domain.").

42. 1 WILLIAM F. PATRY, PATRY ON COPYRIGHT, § 1:38, at 1-275 (2007) ("Under the 1891 Act, protection was available to foreign authors, but only on compliance with three conditions: . . . (2) the foreign author complied with all formalities applicable to works of U.S. authors (e.g., notice and deposit)").

43. United Dictionary Co. v. G. & C. Merriam Co., 208 U.S. 260 (1908).

44. *Id.* at 266.

45. *Id.* at 264.

authors, and attempted to intrude its requirements into any notice that might be [required] by the English law."[46]

Although the *United Dictionary* decision resolved an important question under U.S. law, it bears emphasizing that the scope of that opinion was limited. Before 1978, a work was protected by a state common-law copyright before it was published.[47] Once it was published, the state common-law copyright expired, and unless a federal statutory copyright was obtained, the work entered the public domain.[48] In *United Dictionary*, the work in question was first published in the United States with a proper copyright notice, and the plaintiff took all the necessary steps to obtain a federal statutory copyright, before a revised version of the work was subsequently published in England without notice.[49] The question, therefore, was whether the lack of notice in the English edition divested the plaintiff of a federal statutory copyright which it had obtained in the United States.[50] In the more usual case, however, a work is first published abroad without notice, and only later is it published in the United States. In such a situation, the relevant authorities were clear: if the

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46. *Id.* at 265.

47. *See, e.g.*, Wheaton v. Peters, 33 U.S. 591, 657 (1834) ("That an author, at common law, has a property in his manuscript, and may obtain redress against anyone who deprives him of it, or by improperly obtaining a copy endeavours to realise a profit by its publication, cannot be doubted; but this is a very different right from that which asserts a perpetual and exclusive property in the future publication of the work, after the author shall have published it to the world."); Caliga v. Inter Ocean Newspaper Co., 215 U.S. 182, 188 (1909) ("At common law an author had a property in his manuscript, and might have an action against anyone who undertook to publish it without authority.").

48. *See, e.g., Caliga*, 215 U.S. at 188 ("At common-law, the exclusive right to copy existed in the author until he permitted a general publication. Thus, when a book was published in print, the owner's common-law right was lost."); Tribune Co. of Chi. v. Assoc'd. Press, 116 F. 126, 127 (C.C.N.D. Ill. 1900) ("Literary property is protected at common law to the extent only of possession and use of the manuscript and its first publication by the owner. . . . With voluntary publication the exclusive right is determined at common law, and the statutory copyright is the sole dependence of the author or owner for a monopoly in the future publication.").

49. *United Dictionary*, 208 U.S. at 263. The facts are more clearly stated in the Court of Appeals opinion, which states that the work was first published simultaneously in the United States and England on Aug. 9, 1892; the work "was subsequently published commercially in England under an agreement . . . entered into on July 18, 1894." G. & C. Merriam Co. v. United Dictionary Co., 146 F. 354, 355 (7th Cir. 1906), *aff'd*, 208 U.S. 260 (1908). The court noted that there was "an exact and literal compliance with the United States statute in regard to all books published or circulated by or with the consent of [the plaintiff] in the United States," *id.*, and that the two editions were identical except for the first 3 and last 34 pages. *Id.* at 356, 359.

50. *United Dictionary,* 208 U.S. at 263 ("The question is whether omission of notice of the American copyright from the English publication, with the assent of the appellee, destroyed its rights.").

work was published anywhere in the world (with or without notice) *before* being registered in the United States, the work lost its common-law copyright, thereby placing it in the public domain and rendering it permanently ineligible for a federal statutory copyright.[51] Because British law required first publication in Great Britain, the result was that publishers had to publish works simultaneously in Great Britain and the United States in order to obtain copyright in both countries.[52]

III. 1909-1978

To complicate the matter further for foreign authors, one year after *United Dictionary* Congress adopted the 1909 Copyright Act, which contained language that reintroduced an ambiguity in the question of whether some foreign copies had to bear copyright notice. Prior to the 1909 Act, copyright protection was secured initially by registering the work (before publication) with the Copyright Office;[53] only after obtaining copyright protection by registration did the requirement of placing notice on published copies begin.[54] But under the 1909 Act, it was the act of publication with proper copyright notice that invested copyright protection in the first place. Section 9 of the 1909 Act provided:

> Any person entitled thereto by this title may secure copyright for his work by publication thereof with the notice of copyright required by this title; and such notice shall be affixed to each copy thereof published or offered for sale in the United States by authority of the copyright proprietor.[55]

The second clause of section 9 was consistent with the U.S. Supreme Court's holding in the *United Dictionary* case: after copyright

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51. *See* EATON S. DRONE, A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS IN GREAT BRITAIN AND THE UNITED STATES 295-96 (1879) ("there can be no doubt that . . . an author forfeits his claim to copyright in this country by a first, but not by a contemporaneous, publication of his work abroad."); *Tribune*, 116 F. at 128 ("As the exclusive right of publication at common law terminates with the publication in London, no protection then exists beyond that expressly given by the statute.").

52. *See* BRIGGS, *supra* note 10, at 93-94; *Tribune*, 116 F. at 128 ("Before the amendment authorizing copyright in America on foreign publications, under prescribed conditions *where the publication is simultaneous*, such foreign property was left unprotected.") (emphasis added); *see also* George Haven Putnam, *Analysis of the Provisions of the Copyright Law of 1891*, in THE QUESTION OF COPYRIGHT, *supra* note 28, at 127.

53. *See supra* note 36.

54. *See supra* note 39-39.

55. Copyright Act of 1909, ch. 320, § 9, 35 Stat. 1077 (codified at 17 U.S.C. § 10 in 1947, repealed 1978).

protection was secured, only copies of the work published in the U.S. had to bear copyright notice; and if copies of the work without notice were published in a foreign country after U.S. copyright protection was secured, it would not divest the copyright owner of his or her U.S. copyright.

But if that proposition was clear, it was now unclear what steps needed to be taken in order to secure U.S. copyright protection initially. If a work was published initially in a foreign country with whom the United States had treaty relations, did the work have to bear a U.S. copyright notice in order to secure federal copyright protection? If so, did the initial publication in that foreign country without proper notice place the work in the public domain, thereby forfeiting the right to subsequently obtain a federal statutory copyright?[56] Or was the foreign publication without notice simply to be ignored, as if it had never occurred?[57] Alternatively, was mere publication of the work in that foreign country, without any notice at all, sufficient to secure U.S. copyright protection for the foreign work?[58] Or did the work have to be republished in the United States with proper copyright notice (as the manufacturing clause seemingly required) in order to obtain U.S. copyright protection?[59]

The proper interpretation of section 9 was made even cloudier by the legislative history of the 1909 Act. An earlier draft of section 9

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56. This view was taken in Basevi v. Edward O'Toole Co. Inc., 26 F. Supp. 41, 46 (S.D.N.Y. 1939) ("publication of a book . . . in a foreign country without notice of United States copyright thereon, will prevent the owner of the book from subsequently securing a valid copyright thereof in the United States."). *See also* Universal Film Mfg. Co. v. Copperman, 212 F. 301, 304 (S.D.N.Y. 1914) ("Because, therefore, there was a publication in Europe before registration [or publication] in the United States, the bill [alleging infringement] must be dismissed."), *aff'd on other grounds*, 218 F. 511 (2d Cir. 1914), *cert. denied*, 235 U.S. 704 (1914); Am. Code Co. v. Bensinger, 282 F. 829, 833 (2d Cir. 1922) ("Publication of an intellectual production without copyrighting it causes the work to fall into the public domain. It becomes by such publication dedicated to the public, and any person is thereafter entitled to publish it for his own benefit.").

57. This view was taken in Italian Book Co. v. Cardilli, 273 F. 619, 620 (S.D.N.Y. 1918) ("publication in Italy [with reservation of rights in Italian but without U.S. copyright notice] . . . did not prevent the subsequent American copyright, if (as is the case here) there had been no publication in the United States prior to that of the copyright owner.").

58. *See* Heim v. Universal Pictures Co., 154 F.2d 480 (2d Cir. 1946); *Heim* is discussed *infra* at notes 64-69 and accompanying text.

59. *See* Twin Books v. Walt Disney Co., 83 F.3d 1162 (9th Cir. 1996); *Twin Books* is discussed *infra* at notes 83-105 and accompanying text. *See* ARTHUR W. WEIL, AMERICAN COPYRIGHT LAW 273-76 (1917) (taking the position that the initial publication of the work had to occur in the United States); *but see* RICHARD C. DEWOLF, AN OUTLINE OF COPYRIGHT LAW 38 (1925) (disagreeing with Weil that the initial publication of the work had to occur in the United States).

read as follows:

> Any person entitled thereto by this title may secure copyright for his work by publication thereof *in the United States* with the notice of copyright required by this title; and such notice shall be affixed to each copy thereof published or offered for sale by authority of the copyright proprietor.[60]

As initially drafted, the statute was relatively clear: a work had to be published in the United States with proper copyright notice in order to obtain a federal statutory copyright, and notice had to be inserted in each published copy. There was nothing to suggest that the notice requirement did not apply to copies published outside the United States. In the final version, however, the phrase "in the United States" was moved from the first clause to the second. "This change made it clear that a work duly copyrighted in the United States did not lose protection merely because there might be an edition subsequently published abroad without notice,"[61] as the *United Dictionary* case had held; but it also suggested that a work did not have to be published in the United States in order to obtain U.S. copyright protection. Thus, publication *with* notice outside the United States, in a country with whom the United States had treaty relations, was therefore now deemed sufficient to obtain a U.S. copyright.[62] But ambiguity remained with respect to the effect of an initial publication outside the United States *without* a proper copyright notice.[63]

When the issue reached the Second Circuit in 1954, the court split on the proper interpretation of section 9. In *Heim v. Universal*

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60. The earlier draft is quoted in HERBERT G. HOWELL, THE COPYRIGHT LAW 23 (2d ed. 1948), and in 2 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 6:44, at 6-56 (2007).

61. PATRY, *supra* note 60, § 6:44, at 6-56.

62. *See* DEWOLF, *supra* note 59, at 38 ("it seems probable, at least, that publication in a foreign country with the statutory notice is sufficient to initiate copyright protection, even if it takes place in advance of publication in the United States."); HALE, *supra* note 37, § 173, 13 C.J. at 1063 ("investitive publication may be made not only in the United States and its possessions, but it may be made even in a foreign country, provided it is one whose citizens or subjects are entitled to the benefit of the statute.").

63. A leading treatise published in 1938 took the view that "no person is entitled to claim statutory copyright under the Act, unless, when first publishing the work abroad or in the United States, he has affixed the statutory notice." 2 STEPHEN P. LADAS, THE INTERNATIONAL PROTECTION OF LITERARY AND ARTISTIC PROPERTY § 324, at 698 (1938); *see also* HALE, *supra* note 37, § 194, 13 C.J. at 1068 ("Foreign editions prior to registration must carry the statutory notice, except in the case of books in the English language seeking ad interim protection; after registration notice is necessary only in copies published or offered for sale in the United States. . . . First publication without notice dedicates the work and invalidates a subsequent attempted copyright.").

Pictures Co.,[64] the work at issue, a popular song, was first published in Hungary in 1935, but the copyright notice stated that the date of first publication was 1936 (the date that the work was registered and first published in the United States as part of a Hungarian motion picture).[65] Under U.S. law, notice with an incorrect date was tantamount to publication without any notice at all.[66] Nonetheless, the majority held that the error was immaterial:

> We construe the statute, as to publication in a foreign country by a foreign author . . . , not to require, as a condition of obtaining or maintaining a valid American copyright, that any notice be affixed to any copies whatever published in such foreign country, regardless of whether publication first occurred in that country or here, or whether it occurred before or after registration here.
>
> It seems to be suggested by some text-writers that . . . where publication abroad precedes publication here, the first copy published abroad must have affixed to it the notice describedFalse Such a requirement would achieve no practical purpose, for a notice given by a single copy would obviously give notice to virtually no one. . . . [T]he most practicable and, as we think, the correct interpretation, is that publication abroad will in all cases be enough, provided that, under the laws of the country where it takes place, it does not result in putting the work in the public domain.[67]

The majority nonetheless affirmed the trial court's conclusion that no copying had occurred.[68] Concurring in the result, Judge Clark criticized the majority for upholding the validity of the copyright: "The opinion holds that American copyright is secured by publication abroad without the notice of copyright admittedly required for publication here. This novel conclusion, suggested here for the first time, seems to me impossible in the face of the statutory language."[69]

Neither opinion focused on the specific language of the relevant treaty between the United States and Hungary, which stated: "The

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64. Heim v. Universal Pictures Co., 154 F.2d 480 (2d Cir. 1946).

65. *Id.* at 481.

66. More precisely, if the date in the notice was *later* than the actual date of first publication or registration, then the notice and the copyright were invalid, because the error would have had the effect of lengthening the term of the copyright; but if the date in the notice was *earlier* than the actual date of first publication or registration, then the error did not affect the validity of the copyright, but only shortened its duration. *See* Callahan v. Myers, 128 U.S. 617, 657-58 (1888); Am. Code Co. v. Bensinger, 282 F. 829, 836 (2d Cir. 1922); Baker v. Taylor, 2 Fed. Cas. 478, 478-49 (S.D.N.Y. 1848) (No. 782).

67. *Heim*, 154 F.2d at 486-87.

68. *Id.* at 488.

69. *Id.* at 488 (Clark, J., concurring).

enjoyment and exercise of the rights secured by the present Convention are *subject to the performance of the conditions and formalities* prescribed by the laws and regulations of the country where protection is claimed under the present Convention."[70]Although this language could be considered a mere tautology, it is more likely that it was intended to require that Hungarian citizens comply with the same formalities with which U.S. authors were required to comply.[71]

After the *Heim* decision, the U.S. Copyright Office began to accept copyright registrations for works that had first been published outside the United States without notice under its "rule of doubt,"[72] although it continued to instruct foreign authors to include notice when publishing their works abroad.[73] However, after the United States adhered to the Universal Copyright Convention in 1955, the Copyright Office reversed course and adopted a regulation providing that published copies had to bear copyright notice even if the work was first published outside the United States.[74] The Office reasoned that otherwise, the notice requirement of the U.C.C. (which provided that all formalities were deemed to be satisfied if the work was published with proper copyright notice[75]) would be rendered a

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70. Copyright Convention between the United States and Hungary, U.S.-Hung., art. 2, Jan. 30, 1912, 37 Stat. 1632 (emphasis added).

71. After a comprehensive review of the statute and other relevant authorities (not including the Copyright convention between the United States and Hungary), a prominent copyright practitioner reluctantly reached the conclusion that "the copyright law, as currently drafted, require[s] notice of copyright in works [first] published abroad." *See* Arthur S. Katz, *Is Notice of Copyright Necessary in Works Published Abroad? A Query and a Quandary*, 1953 WASH. U. L.Q. 55, 87 (1953).

72. *See* Abraham L. Kaminstein, *©: Key to Universal Copyright Protection*, in UNIVERSAL COPYRIGHT CONVENTION ANALYZED 23, 32 (Theodore R. Kupferman & Mathew Foner eds., Federal Legal Publications 1955). Under the "rule of doubt," "no claim should be disapproved if an Examiner has a reasonable doubt about the ultimate action which might be taken under the same circumstances by an appropriate court." *Id.* at 32 n.18.

73. *See* U.S. Copyright Office, Form A-B (Foreign), *quoted in* Katz, *supra* note 71, at 87 n.98 ("Publish the work with the statutory notice of copyright . . . After publication with the notice of copyright . . . send all the required items to the Register of Copyrights."). In addition, it should be noted that many of the then-existing bilateral treaties specifically required compliance with U.S. formalities as a condition of bilateral protection. *See* Katz, *supra* note 71, at 80; George D. Cary, *The United States and Universal Copyright: An Analysis of Public Law 743*, in UNIVERSAL COPYRIGHT CONVENTION ANALYZED, *supra* note 72, at 83, 93 & n.21.

74. *See* 24 Fed. Reg. 4956 (1959) (to be codified at 37 C.F.R. § 202.2(a)(3) (1959)) ("Works first published abroad, other than works eligible for ad interim registration, must bear an adequate copyright notice at the time of their first publication in order to secure copyright under the law of the United States.").

75. *See* Universal Copyright Convention, art. 3, para. 1, Sept. 6, 1952, , 6 U.S.T. 2732, 216 U.N.T.S. 133 ("Any Contracting State which, under its domestic law, requires as a

nullity.[76] This requirement is carried forward for pre-1978 works in the current Copyright Office Regulations.[77]

IV. 1978 TO THE PRESENT

In the 1976 Copyright Act, Congress dramatically changed the requirements for obtaining federal copyright protection. Instead of requiring publication with notice, the 1976 Act provided that a federal statutory copyright would arise as soon as a work was "fixed in any tangible medium of expression." [78] At the same time, however, Congress not only retained the notice requirement for published copies, but it also unambiguously extended the notice requirement to all copies of the work, published anywhere in the world. As enacted, section 401 of the 1976 Act stated:

> Whenever a work protected under this title is published in the United States *or elsewhere* by authority of the copyright owner, a notice of copyright as provided by this section shall be placed on publicly distributed copies from which the work can be visually perceived, either directly or with the aid of a machine or device.[79]

It was not until March 1, 1989, the effective date of U.S. adherence to the Berne Convention, that the notice requirement was finally made

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condition of copyright, compliance with formalities . . . shall regard these requirements as satisfied with respect to all works protected in accordance with this Convention, and first published outside its territory and the author of which is not one of its nationals, if from the time of first publication all the copies of the work published with the authority of the author or other copyright proprietor bear the symbol © accompanied by the name of the copyright proprietor and the year of first publication placed in such a manner and location as to give reasonable notice of claim of copyright.").

76. *See* George D. Cary, *Proposed New Copyright Office Regulations*, 5 BULL. COPYRIGHT SOC'Y 213, 213 (1959) (regulation "is intended to make clear that the Office no longer considers the dictum in the [*Heim*] case . . . as controlling its action . . . [because] the subsequent enactment of the so-called 'U.C.C. amendments' to the copyright law in effect amounted to a Congressional expression, contrary to the dictum, that foreign works, in order to obtain the benefit of U.S. copyright law, must, at the time of first publication, contain the form of notice provided for in the U.C.C."). *See also* Kaminstein, *supra* note 72, at 33; *See* Cary, *The United States and Universal Copyright*, *supra* note 73, at 91-94. The author agrees with this analysis, but it should be noted that two respected commentators have concluded otherwise. *See* 2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 7.12[D][2][a] at 7-105 to 7-106 (2007); 1 PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT § 3.7.2, at 3:114 (3d ed. 2005).

77. *See* 37 C.F.R. § 202.2(a)(3) (2007) ("Works first published abroad before January 1, 1978, other than works for which an interim copyright has been obtained, must have borne an adequate copyright notice. The adequacy of the copyright notice for such works is determined by the copyright statute as it existed on the date of first publication abroad.").

78. 17 U.S.C. § 102(a) (2006).

79. *See* former 17 U.S.C. § 401(a) (emphasis added), *as enacted in* Pub. L. No. 94-553, Title I, §101, 90 Stat. 2576-77 (1976).

optional rather than mandatory, by changing the word "shall" to the word "may."[80]

Thus, for works published on or after January 1, 1978 (the effective date of the 1976 Act),[81] it has been clear what the effect of publication without notice in a foreign country is on the federal statutory copyright in the United States. Ambiguity remains, however, regarding works first published abroad before January 1, 1978; and since some copyrights obtained under the 1909 Act will remain in effect until at least December 31, 2072,[82] we have another six decades to go before we can declare the ambiguity to be no longer material. It is important, therefore, to consider the subsequent history of the 1909 Act in the courts.

In *Twin Books Corp. v. Walt Disney Co.*,[83] the work at issue was the children's book *Bambi, A Life in the Woods*, written by an Austrian citizen, Felix Salten.[84] *Bambi* was written in German and was first published in Germany in 1923 without any copyright notice.[85] In 1926, *Bambi* was republished in Germany with U.S. copyright notice, and the work was registered in the U.S. in 1927.[86] In 1954, the copyright was renewed by Salten's heir.[87] The question presented was straightforward: when did U.S. copyright protection for *Bambi* commence? If U.S. copyright protection commenced in 1923, when the work was first published in Germany, then the 1954 renewal came too late, because the work had entered the public domain in 1951 when its first 28-year term expired.[88] But if U.S. copyright

80. *See* 17 U.S.C. § 401(a), *as amended by* Berne Convention Implementation Act, Pub. L. No. 100-568, § 7(a), 102 Stat. 2857 (1988)).

81. *See* Act of Oct. 19, 1976, Pub. L. No. 94-553, Title I, § 102, 90 Stat. 2598-99.

82. *See* 17 U.S.C. § 304(a) (2006) (providing for an initial term of twenty-eight years and a renewal term of sixty-seven years, for a maximum duration of ninety-five years from the date of first publication).

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

84. *Id.* at 1164.

85. *Id.*

86. *Id.*

87. *Id.*

88. Under the 1909 Act, a copyright had an initial duration of twenty-eight years, and it could obtain a renewal term of an additional twenty-eight years only if a renewal registration was made during the final year of the initial term. Copyright Act of 1909, ch. 320, § 23, 35 Stat. 1080 (1909) (codified at 17 U.S.C. § 24 in 1947; repealed 1978). The renewal term for pre-1978 works was extended to forty-seven years in 1976, for a maximum duration of seventy-five years from first publication. *See* 17 U.S.C. § 304(a)-(b) (as enacted in Pub. L. No. 94-553, tit. I, § 101, 90 Stat. 2573-74 (1976)). The renewal term for such works was further extended to sixty-seven years in 1998, for a maximum duration of ninety-five years from first publication. *See* 17 U.S.C. §304(a)-(b) (2006).

protection did not commence until 1926, when the work was republished in Germany with notice, then the renewal in 1954 was valid.

The Ninth Circuit held that, under the doctrine of territoriality, notice was not required when a work was first published abroad, and therefore "the 1923 publication of *Bambi* in Germany did not put *Bambi* in the public domain in the United States . . . [and] did not preclude the author from subsequently obtaining copyright protection in the United States by complying with the 1909 Copyright Act."[89] The court relied heavily on *Heim* in support of its holding.[90] However, the court ignored *Heim* in holding that the U.S. copyright did not commence until 1926, when the book was republished with U.S. copyright notice.[91] What was the status of the book during the intervening three years? According to the Ninth Circuit, the book was in some sort of copyright limbo:

> During 1923, 1924, and 1925, anyone could have sold the *Bambi* book in the United States or made some derivative movie of the *Bambi* book, and the author Salten would have had no recourse under the United States copyright law.[92]

The Ninth Circuit's holding in *Twin Books* is internally inconsistent. If during 1923-1926, "anyone could have sold the Bambi book in the United States," then the book had lost its common-law copyright when it was first published in Germany, and if it did not simultaneously obtain a federal statutory copyright, it was therefore in the public domain in the United States.[93] But earlier in its opinion, the Ninth Circuit expressly held that the book was *not* in the public domain,[94] probably because the public domain traditionally had been considered to be irrevocable.[95] Instead, the court held that a U.S. copyright arose upon publication with notice in 1926, even though the common-law copyright in the work had expired three years earlier.

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89. *Twin Books*, 83 F.3d at 1167.

90. *Id.* at 1166-67.

91. *Id.* at 1167.

92. *Id.*

93. *See supra* notes 48 & 51 and accompanying text.

94. *Id.* at 1167.

95. *See* Tyler T. Ochoa, *Origins and Meanings of the Public Domain*, 28 U. DAYTON L. REV. 215, 262-66 (2003); *but see* Tyler T. Ochoa, *Patent and Copyright Term Extension and the Constitution: A Historical Perspective*, 49 J. OF THE COPYRIGHT SOC'Y OF THE USA 19, 48-49 (2001) (noting individual instances of Congress restoring copyright in works in the public domain); *see also id.* at 61-72 (describing Congressional restoration of patent protection to inventions in the public domain).

The Ninth Circuit also mischaracterized *Heim* when it paraphrased that case as holding that "publication abroad with no notice or with an erroneous notice would not preclude *subsequently* obtaining a valid United States copyright."[96] That is not what *Heim* held; instead, *Heim* held that a valid United States copyright arose upon publication abroad with no notice or with an erroneous notice.[97] Yet two pages later, the *Twin Books* court states: "Disney cites no authority, nor could it, for the proposition that publication abroad without notice of copyright secures protection under the 1909 Act."[98] The authority that so holds is *Heim*, which *Twin Books* purported to rely on.[99]

The result reached in *Twin Books* would have made more sense if the court had held instead that publication in a foreign country simply didn't count at all for purposes of common-law copyright (even though that conclusion would have contradicted a century of precedent).[100] If the court had so ruled, then during 1923-1926, the work would still have been protected in the United States under common-law copyright as an unpublished work (that is, as a work unpublished in the United States), and then the work would have validly obtained a federal statutory copyright when it was published with notice in a country with whom the U.S. had treaty relations.[101]

Alternatively, the *Twin Books* court could have relied on copyright restoration. Effective January 1, 1996,[102] in accordance with Art. 18 of the Berne Convention,[103] Congress restored the copyrights in works of foreign origin that had entered the public domain in the United States for failure to comply with formalities, such as notice and renewal, but had not yet entered the public domain

96. *Twin Books*, 83 F.3d at 1166 (emphasis added).

97. Heim v. Universal Pictures Co., 154 F.2d 480, 486-87 (2d Cir. 1946); *id.* at 488 (Clark, J. concurring).

98. *Twin Books*, 83 F.3d at 1168.

99. *See also* NIMMER ON COPYRIGHT, *supra* note 76, § 4.01[C][1], at 4-8 n.35.11.

100. *See supra* note 51; *see also* Carte v. Duff (The Mikado Case), 25 F. 183, 184 (C.C.S.D.N.Y. 1885) ("Common law rights of authors run only to the time of the publication of their manuscripts without their consent. . . . *It is immaterial whether the publication be made in one country or another.*") (emphasis added).

101. *See Twin Books*, 83 F.3d at 1168 ("Disney is correct publication in a foreign country with notice of United States copyright secures United States copyright protection.").

102. *See* 17 U.S.C. § 104A(h)(2)(A) (2008).

103. *See* Berne Convention for the Protection of Literary and Artistic Works art. 18, para. 1, revised at Paris, July 24, 1971 ("This Convention shall apply to all works which, at the moment of its coming into force, have not yet fallen into the public domain in the country of origin through the expiry of the term of protection.").

in their source countries.[104] Had the court taken this copyright restoration statute into account, it could have found that the copyright in *Bambi* commenced in 1923, under *Heim*; that *Bambi* had lost its U.S. copyright in 1951 when Salten's heir failed to file a renewal; but that *Bambi* had its U.S. copyright restored in 1996. Alternatively, it could have held that *Bambi* had been placed in the public domain in 1923 when it was published without notice, but that it had its U.S. copyright restored in 1996. In either case, however, Disney would have been treated as a "reliance party" and would have been entitled to continue exploiting its movie version during the remainder of the copyright term on payment of a reasonable royalty.[105]

V. AN ILLUSTRATIVE CASE

The incoherence of *Twin Books* becomes all the more apparent when it is applied in a more typical factual setting, one in which publication of the work with notice does not occur until many years later, if at all. That is the situation that arose in *Société Civile Succession Richard Guino v. Renoir*,[106] a case which involved eleven sculptures created in France between 1913 and 1917 by Pierre-Auguste Renoir and Richard Guino.[107] The sculptures were first published in 1917 in France as works of Renoir,[108] and they were republished in France in 1974 as works of Renoir and Guino.[109] The works were registered in the United States in 1984[110] but there was no evidence that the works had ever been published with authorization in the United States. When the defendants advertised and sold reproductions of the sculptures at their art gallery in Arizona, the plaintiffs sued for copyright infringement.[111]

This case starkly demonstrates the differences between the *Heim* and *Twin Books* approaches to the formality of notice under the 1909

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104. *See* § 104A(h)(6)(B), (h)(6)(C)(i).

105. *See* § 104A(h)(4) (defining "reliance party"); § 104A(d)(3)(A) (defining rights of reliance parties in derivative works created before enactment of the Uruguay Round Agreements Act).

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

107. *Id.* The eleven sculptures are listed in a footnote in the district court opinion. *See* Société Civile Succession Richard Guino v. Beseder, Inc., 414 F. Supp. 2d 944, 946 n.3 (D. Ariz. 2006), *aff'd sub nom.* Société Civile Succession Richard Guino v. Renoir, 549 F.3d 1182 (9th Cir. 2008).

108. *Société Civile*, 549 F.3d at 1187.

109. *Id.*

110. *Id.* at 1184.

111. *Id.*

Act. If *Heim* is correct, then the sculptures obtained a U.S. statutory copyright no later than 1917, when the sculptures were first published in France, a country with whom the U.S. had reciprocal copyright relations.[112] Those copyrights would have expired 28 years later, in 1945, when no renewals were filed for in the United States.[113] When the 1976 Act came into effect, the works would have been in the public domain, and they would have been ineligible for further copyright protection.[114] Even assuming hypothetically that renewals had been made, the copyrights would have remained valid for another 28 years until 1973. All such subsisting copyrights were extended temporarily pending the enactment of the 1976 Act,[115] when 19 years were added to the renewal term.[116] The copyrights would therefore have expired at the end of 1992,[117] placing the works in the public domain, and rendering them ineligible for either the 1996 restoration of copyright for works of foreign origin[118] or the 1998 term extension.[119]

Under *Twin Books*, however, the 1917 publication of the

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112. *See* Pres. Proc. No. 3, 27 Stat. 981, 981-82 (1891).

113. *See* Copyright Act of 1909, ch. 320, § 23, 35 Stat. 1080 (codified at 17 U.S.C. § 24 in 1947; repealed 1978) (author or his heirs are entitled to renewal only "when application for such renewal and extension shall have made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright.").

114. *See* Pub. L. No. 94-553, tit. I, § 103, 90 Stat. 2599 (1976) ("This Act does not provide copyright protection for any work that goes into the public domain before January 1, 1978.").

115. *See* Pub. L. No. 92-566, 86 Stat. 1181 (1972) (extending all subsisting copyrights to Dec. 31, 1974); Pub. L. No. 93-573, § 104, 88 Stat. 1873 (1974) (extending all subsisting copyrights to Dec. 31, 1976).

116. *See* former § 304(b), as enacted by Pub. L. No. 94-553, tit. I, § 101, 90 Stat. 2574 (1976) ("The duration of any copyright, the renewal term of which is subsisting at any time between December 31, 1976, and December 31, 1977, inclusive, . . . is extended to endure for a term of seventy-five years from the date copyright was originally secured."); *see also* § 102 (providing that § 304(b) "take[s] effect upon enactment of this Act.").

117. *See* 17 U.S.C. § 305 (2006) ("All terms of copyright provided by sections 302 through 304 run to the end of the calendar year in which they would otherwise expire.").

118. *See* 17 U.S.C. § 104A(h)(6)(C) (2006) (restoration applies only if the work is in the public domain for one of the specified reasons, not including expiration of maximum period of duration); *see also* § 104A(a)(1)(B) ("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 had never entered the public domain in the United States.").

119. *See* 17 U.S.C. § 304(b) (2006) (as amended in 1998) ("Any copyright in its renewal term *at the time that the Sonny Bono Copyright Term Extension Act become effective* shall have a copyright term of 95 years from the date copyright was originally secured.") (emphasis added). The CTEA became effective on Oct. 27, 1998, *see* Pub. L. No. 105-298, § 106, 112 Stat. 2829, so any works already in the public domain at that time did not have their copyrights extended.

sculptures in France did *not* place the works in the public domain, nor did it secure a federal statutory copyright. Thus, when the 1976 Act came into effect, the sculptures would have been eligible for protection under section 303, as works "created before January 1, 1978, but not theretofore in the public domain or copyrighted."[120] Under this section the works are entitled to the copyright term given to new works, life of the longest-surviving author plus 70 years, subject to a statutory minimum.[121] Since Guino died in 1973, the Ninth Circuit held that the copyrights would endure until the end of 2043.[122] Moreover, since the works were "published on or before December 31, 2002" (having been published in France in 1917 and 1974), the statutory minimum term provides that "the term of copyright shall not expire before December 31, 2047."[123] The statutory minimum was apparently overlooked by the district court, but the Ninth Circuit suggested that the statutory minimum would apply under its literal language,[124] even though the purpose of the statutory minimum was "to encourage publication" of previously unpublished works.[125]

Thus, application of *Heim* would result in the copyright having expired in 1945 (or 1992, if hypothetically renewed), and being ineligible for copyright restoration; whereas application of *Twin Books* would result in the copyright enduring to the end of 2047, a difference of over 100 years! Not surprisingly, even though the district court that decided the *Société Civile Succession Richard Guino* case was located in the Ninth Circuit and was bound to follow *Twin Books*, it criticized *Twin Books* in its opinion, expressing the view that it had been decided incorrectly.[126]

But it is not as simple a matter as choosing between these two alternatives, because there are two additional possibilities that must be

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120. 17 U.S.C. § 303(a) (2006). As an aside, it is clear that Congress intended for section 303 to apply only to unpublished works. *See infra* notes 131-135. It is only the Ninth Circuit's erroneous holding that publication without notice abroad *neither* placed the work in the public domain *nor* invested it with statutory copyright that allows such works to fall within the literal language of section 303.

121. *See* 17 U.S.C. § 303(a).

122. *See* Société Civile Succession Richard Guino v. Renoir, 549 F.3d 1182, 1188 (9th Cir. 2008).

123. 17 U.S.C. § 303(a).

124. 549 F.3d at 1188 & n.1.

125. H.R. REP. NO. 94-1476, at 139 (1976), *reprinted in* 1976 U.S.C.C.A.N. at 5755.

126. *See* Société Civile Succession Richard Guino v. Beseder, Inc., 414 F. Supp. 2d 944, 949-51 (D. Ariz. 2006), *aff'd sub nom.* Société Civile Succession Richard Guino v. Renoir, 549 F.3d 1182 (9th Cir. 2008).

considered (although in this case, they lead to the same two results). First, under the Copyright Office's interpretation of the 1909 Act,[127] publication without notice in France in 1917 placed the works in the public domain, instead of investing them with a federal statutory copyright. Again, however, the works would have been ineligible for copyright restoration in 1996, because the term they otherwise would have enjoyed but for the notice and renewal requirements would have expired in 1992.[128] Alternatively, one could take the (historically incorrect) view that foreign publication simply did not count as a "publication" at all for purposes of divesting a work of its common-law copyright. If that was the case, then the work was neither "in the public domain [n]or copyrighted" on January 1, 1978, and section 303 would again be applicable, resulting in a valid copyright (under the statutory minimum) through the end of 2047.[129]

So which of these four interpretations of the 1909 Act is correct? The statute is ambiguous, and the legislative history is unclear, leaving us to rely primarily on policy arguments for making our decision.

The least likely interpretation is the one expressed in *Twin Books*, for three reasons. First, no court before or since has suggested that a work could be freely copied in the United States (having lost its common-law copyright by virtue of publication without notice abroad), but somehow not be in the public domain in the United States, and instead be in some sort of copyright limbo from which it could obtain a federal statutory copyright by subsequent publication with notice.[130] Second, it is clear from the legislative history of the 1976 Act that section 303 was intended to apply only to works which were unpublished on January 1, 1978.[131] The phrase "not in the public domain or copyrighted" was intended to exclude all published works,

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127. *See supra* notes 72-77 and accompanying text.

128. *See* 17 U.S.C. § 104A(a)(1)(B) (2006).

129. *See* 17 U.S.C. § 303(a).

130. The one case that reached a similar result, Italian Book Co. v. Cardillli, 273 F. 619 (S.D.N.Y. 1918), was apparently predicated on the view that under the 1909 Act (unlike under previous Acts), a work's common-law copyright was not lost by foreign publication without notice. *Id.* at 620. Under that view, however, the work could not have been freely copied in the United States prior to its re-publication in the United States, since it still would have been subject to a common-law copyright.

131. The House Report stated that the purpose of section 303 was "to substitute statutory for common law copyright for everything now protected at common law." H.R. REP. NO. 94-1476, at 139 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5755. But as indicated above, common-law copyright only applied to unpublished works, and publication anywhere in the world divested a work of its common-law copyright. *See supra* notes 47-52 and accompanying text.

because such works either had been published with notice (and were therefore "copyrighted")[132] or had been published without notice (and were therefore in the public domain).[133] It was also intended to exclude those few unpublished works which had nonetheless been registered under the 1909 Act (and were therefore "copyrighted").[134] The notion that there were works that had been published, but were neither in the public domain nor copyrighted, simply did not exist in the minds of the legislature.[135] Third, as the district court noted in the *Société Civile Succession Richard Guino* case, Congress intended the 1996 copyright restoration to apply to works of foreign origin that were in the public domain in the United States for failure to comply with formalities (such as copyright notice).[136] If *Twin Books* is correct, however, many fewer works would have needed copyright restoration because works of foreign origin never published in the United States would not have entered the public domain in the United States in the first place.[137]

It is also unlikely that Congress intended that publication without notice abroad simply would not count for purposes of common-law

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132. *See* Copyright Act of 1909, ch. 320, § 9, 35 Stat. 1077 (codified at 17 U.S.C. § 10 in 1947, repealed 1978) ("any person entitled thereto by this Act may secure copyright for his work by publication of notice thereof with the notice of copyright required by this Act.").

133. *See supra* notes 41, 48, 51 and accompanying text.

134. *See* Copyright Act of 1909, ch. 320, § 11, 35 Stat. 1078 (codified at 17 U.S.C. §12 in 1947, repealed 1978) ("copyright may also be had of the works of an author, of which copies are not reproduced for sale, by the deposit, with claim of copyright, of one complete copy of such work.").

135. *Cf.* H.R. REP. NO. 94-1476, at 129 (1976), *reprinted in* 1976 U.S.C.C.A.N. at 5745 ("Instead of a dual system of 'common-law copyright' for unpublished works and statutory copyright for published works, which has been the system in effect in the United States since the first copyright statute in 1790, the bill adopts a single system of Federal statutory copyright from creation. . . . Common law copyright protection for works coming within the scope of the statute would be abrogated, and the concept of publication would lose its all-embracing importance as the dividing line between common law and statutory protection *and between both of these forms of legal protection and the public domain.*") (emphasis added).

136. *See* 17 U.S.C. § 104A(h)(6)(C)(i) (2008); Société Civile Succession Richard Guino v. Beseder, Inc., 414 F. Supp. 2d 944, 950-51 (D. Ariz. 2006) ("The *Twin Books* rule would prevent a foreign work published without notice from being eligible for copyright restoration under § 104A, which expressly provides copyright restoration for foreign works published without notice of copyright."), *aff'd sub nom.* Société Civile Succession Richard Guino v. Renoir, 549 F.3d 1182 (9th Cir. 2008).

137. *See Société Civile Succession Richard Guino*, 414 F. Supp. 2d at 951 ("A prerequisite to restoration under § 104A is that a work is in the public domain, for enumerated reasons, in the United States. . . . The *Twin Books* rule provides that a work published in a foreign country without copyright notice is not in the public domain in the United States, unduly preventing copyright restoration of such work"); 1 NIMMER ON COPYRIGHT, *supra* note 73, § 4.01[C][1] at 4-9 to 4-10.1.

copyright. Although this alternative avoids the first two of the problems identified for *Twin Books*, it does not avoid the third; many fewer works would have needed copyright restoration if this rule had been in effect. In addition, as noted above, this alternative contradicts some 100 years of precedent that held that common-law copyright was divested by *any* publication, either here or abroad;[138] it also requires that a court treat publication abroad in two different ways, depending on whether notice was used. Publication with notice would count as a "publication," but publication without notice would not.

The *Heim* rule has some merit, in that it is at least arguably consistent with the ambiguous language of the statute. The 1909 Act stated that copyright protection is secured "by publication thereof with the notice required by this [title]",[139] but since "this title" only required notice on copies of the work published in the United States, arguably works first published abroad without any notice were published "with the notice required by this title."[140] Again, however, if one could secure a U.S. copyright by publishing abroad without notice, fewer works would have needed to have their copyrights restored in 1996, because they already would have had a copyright[141] (if properly renewed).[142] In addition, any third parties that began exploiting such works without permission before 1996 would not be treated as reliance parties, because the works technically would have been "subject to copyright protection" and would not have been in the public domain.[143] Instead, they would simply be longstanding (but

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138. *See supra* notes 41, 48, 51.

139. Copyright Act of 1909, ch. 320, § 9, 35 Stat. 1077 (codified at 17 U.S.C. § 10 in 1947, repealed 1978). As enacted, this section used the word "Act" instead of the word "title"; the word "title" was substituted when the statute was codified and renumbered in 1947.

140. This is the interpretation advocated by Nimmer. *See* 2 NIMMER ON COPYRIGHT, *supra* note 73, § 7.12[D][2][a] at 7-103 to 7-104.

141. *See* VINCENT A. DOYLE, GEORGE D. CARY, MARJORIE MCCANNON & BARBARA RINGER, COPYRIGHT LAW REVISION STUDY NO. 7, NOTICE OF COPYRIGHT 14 (1957) ("the doctrine of the *Heim* case would mean that the bulk of works by foreign authors first published abroad are effectively protected under U.S. copyright law without the observance of any formalities.").

142. Admittedly, the formality of renewal would have caused most of these works to enter the public domain at the end of their initial twenty-eight-year term, since only those copyright owners who were aware of the *Heim* decision would have bothered to apply for renewal of copyright in their works. These works would therefore benefit from copyright restoration. This fact makes the *Heim* approach clearly the second-best alternative in terms of making copyright restoration meaningful.

143. *See* 17 U.S.C. § 104A(h)(4)(A) (2008) (defining "reliance party" as "any person who . . . with respect to a particular work, engages in acts, before the source country of that work becomes an eligible country, which would have violated section 106 if the restored work had been subject to copyright protection, and who, after the source country becomes an eligible

newly discovered) infringers. Finally, one must admit that it is a strange reading of the statute to say that publication without any notice at all is the equivalent of publication "with the notice required by this title."[144]

That leaves us with the fourth alternative: initial publication without notice in a foreign country placed the work in the public domain in the United States, even though it would not have done so if the work had previously been published with notice. This solution is consistent with the language of the statute, and unlike *Heim*, it is also consistent with the regulation adopted by the U.S. Copyright Office in 1959 and still in effect today.[145] It is subject to the criticism that it would be pointless to require only that the initial copy sold abroad bear notice.[146] However, as a practical matter, that would be unlikely to happen. If the foreign author or publisher wanted to secure a U.S. copyright without publishing the work in the United States, it is more likely that the entire first edition sold abroad would have a copyright notice, even if subsequent editions did not.[147] And since the 1909 Act had a manufacturing clause, requiring that deposit copies be printed from type set in the United States,[148] it is likely that Congress envisioned (or desired) that most works would be published domestically first, or else that they would simultaneously be published in the United States and abroad, in order to secure United States copyright protection.[149] Finally, those works that *were* first

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country, continues to engage in such acts.").

144. *See* Heim v. Universal Pictures Co., 154 F.2d 480, 488 (2d Cir. 1946) (Clark, J., concurring) ("This novel conclusion . . . seems to me impossible in the face of the statutory language."); Twin Books Corp. v. Walt Disney Co., 83 F.3d 1162, 1168 (9th Cir. 1996). ("There is absolutely no way to interpret that language to mean that an author may secure copyright protection for his work by publishing it without any notice of copyright.").

145. *See supra* notes 74-77 and accompanying text.

146. *See Heim*, 154 F.2d at 487 ("Such a requirement would serve no practical purpose, for a notice given by a single copy would obviously give notice to virtually no one."). Note, however, that a sale of only a single copy would not likely be deemed to constitute a "publication." *See* 17 U.S.C. § 101 (2006) (defining "publication" as "the distribution of copies . . . of the work to the public").

147. That was the case in *Heim* itself, where the entire first edition published in Hungary bore a U.S. copyright notice. 154 F.2d at 481. It was only the error in the date in the notice that made it necessary for the court to determine whether publication without notice was sufficient to obtain copyright protection. *Id.* at 486. *See also* Katz, *supra* note 71, at 68 ("In practice, English language works and periodicals published abroad tend to carry the notice of copyright in the initial printing. Astute foreign publishers of foreign language works have long made the initial publication bear the appropriate United States copyright notice.").

148. *See supra* note 35 and accompanying text.

149. This is particularly true when one considers the sole express exception to the notice requirement. Works first published abroad in English could secure an *ad interim* copyright by

published abroad without notice would still be eligible for the copyright restoration enacted by Congress in 1994 (effective January 1, 1996).[150] This solution would also allow parties who began exploiting such works before 1996 to be treated as reliance parties under the copyright restoration statute.[151]

Today, because of copyright restoration, the last two alternatives will always reach the same results in terms of validity and expiration of the copyright. The only meaningful difference between them is that the Copyright Office's interpretation would allow third parties who began exploiting such works before 1996, and who continue to do so, to be treated as reliance parties under the statute. Under the *Heim* approach, there can be no reliance parties for those few works which were registered under the "rule of doubt" and were subsequently renewed.

VI. CONCLUSION

Copyright practitioners should be dismayed that an important question of interpretation of the 1909 Act is still unresolved nearly 100 years after its enactment, and that choosing the proper interpretation will still be a material issue for another 65 years. Indeed, anyone who believes that laws should be clear, consistent and easily applied should be appalled by this state of affairs. Copyright scholars have already noted the difficulty of determining whether a given work is in the public domain;[152] when the work was first published abroad without notice, the difficulties are insurmountable.[153]

While I believe that the solution outlined above is the correct

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depositing one complete copy of the foreign edition, giving the copyright owner a short time to comply with the manufacturing clause and to deposit and register the complying copies. *See* Copyright Act of 1909, ch. 320, §§ 21-22, 35 Stat. 1080 (codified at 17 U.S.C. §§ 22-23 in 1947, repealed 1978); Katz, *supra* note 71, at 60 (making this argument).

150. *See* 17 U.S.C. § 104A(h)(6)(C) (2008).

151. *See* § 104A(h)(4)(A).

152. *See, e.g.*, Kenneth D. Crews, *Copyright Duration and the Progressive Degeneration of a Constitutional Doctrine*, 55 SYRACUSE L. REV. 189 (2005); Elizabeth Townsend Gard, *January 1, 2003: The Birth of the Unpublished Public Domain and Its International Implications*, 24 CARDOZO ARTS & ENT. L.J. 687 (2006); *see generally* Tyler T. Ochoa, *Copyright Duration: Theories and Practice*, in 1 INTELLECTUAL PROPERTY AND INFORMATION WEALTH 133, 148-53 (PETER K. YU. ED., 2007).

153. For another example demonstrating these difficulties, *see* Elizabeth Townsend Gard, *Vera Brittain, Section 104(a) and Section 104A: A Case Study in Sorting Out Duration of Foreign Works Under the 1976 Copyright Act*, (Tulane Public Law Research Paper No. 07-09, 2007) (draft), *available at* http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1015575.

one, it is perhaps even more important that a single solution be agreed upon, so that copyright owners and users in different parts of the country are not tempted to shop for a favorable forum to obtain the result they desire. Thus, it can reasonably be argued that the Ninth Circuit should have adopted the reasoning in *Heim*, harmonizing its law with the plausible but second-best interpretation of the Second Circuit. Although the Ninth Circuit panel noted that "the reasoning of *Twin Books* can be, and has been, criticized,"[154] the full court declined the opportunity to take the case *en banc* and to overturn its nonsensical decision in *Twin Books*.[155] This decision leaves the circuit split intact. Practitioners seeking certainty in the application of the 1909 Copyright Act to works of foreign origin are left with the slim hope that the U.S. Supreme Court will grant a petition for *certiorari* in some future case to resolve the circuit split and decide the question once and for all.

154. Société Civile Succession Richard Guino v. Renoir, 549 F.3d 1182, 1190 (9th Cir. 2008).

155. *See* Société Civile Succession Richard Guino v. Renoir, 561 F.3d 969 (9th Cir. 2009) (denying petition for rehearing *en banc*).