



10-1-2011

Is the Copyright Public Domain Irrevocable?: An Introduction to *Golan v. Holder*

Tyler T. Ochoa

Santa Clara University School of Law, ttochoa@scu.edu

Follow this and additional works at: <http://digitalcommons.law.scu.edu/facpubs>



Part of the [Law Commons](#)

Recommended Citation

64 *Vand. L. Rev. En Banc* 123 (2011)

This Article is brought to you for free and open access by the Faculty Scholarship at Santa Clara Law Digital Commons. It has been accepted for inclusion in Faculty Publications by an authorized administrator of Santa Clara Law Digital Commons. For more information, please contact sculawlibrarian@gmail.com.

VANDERBILT LAW REVIEW

EN BANC

VOLUME 64

OCTOBER 2011

ROUNDTABLE

Is the Copyright Public Domain Irrevocable? An Introduction to *Golan v. Holder*

*Tyler T. Ochoa**

I.	INTRODUCTION	124
II.	BACKGROUND: THE BERNE CONVENTION	125
III.	CONGRESS'S ASSAULT ON THE PUBLIC DOMAIN.....	129
IV.	CONSTITUTIONAL CHALLENGES.....	132
V.	GOLAN'S EFFECT ON AND IMPORTANCE TO THE PUBLIC DOMAIN	138
	A. <i>Copyright Restoration</i>	138
	B. <i>Future Implications</i>	144
VI.	CONCLUSION.....	146

* Professor, Santa Clara University School of Law. A.B. 1983, with distinction, J.D. 1987, with distinction, Stanford University. Copyright © 2011 Tyler T. Ochoa. The author would like to thank the editors of the VANDERBILT LAW REVIEW for the invitation to participate in this Roundtable and for their work in editing and cite-checking the manuscript.

I. INTRODUCTION

The public domain may be defined as that body of literary and artistic works (or other information) that is not subject to any copyright (or other intellectual property right), and which therefore may be freely used by any member of the general public.¹ This concept is implicit in the Patent and Copyright Clause of the Constitution, which stipulates that patents and copyrights may only be granted “to promote the Progress of Science and useful Arts,” and only “for limited Times.”² The “limited Times” restriction implies that patents and copyrights must expire at some point,³ and the “Progress” limitation implies that patents and copyright can only be granted for new works, not for pre-existing ones.⁴ Thus, once a previously granted copyright on a work has expired, the general public has a “federal right to copy and to use” the work without attribution.⁵

Traditionally, the copyright public domain has been considered irrevocable. When a work enters the public domain, even if it failed to obtain any copyright protection in the first place, it remains in the public domain.⁶ However, Congress breached this traditional limitation when it enacted section 514 of the Uruguay Round Agreements Act in 1994.⁷ (Section 514 is codified at 17 U.S.C. § 104A.) Section 514 “restored” copyright protection in the United States for all

1. BLACK'S LAW DICTIONARY 1349 (9th ed. 2009); J. THOMAS MCCARTHY, MCCARTHY'S DESK ENCYCLOPEDIA OF INTELLECTUAL PROPERTY 354 (2d ed. 1995). For attempts at a more detailed definition and description of the public domain, see Jessica Litman, *The Public Domain*, 39 EMORY L.J. 965, 975–77 (1990); Tyler T. Ochoa, *Origins and Meanings of the Public Domain*, 28 U. DAYTON L. REV. 215, 217–22 (2003); Pamela Samuelson, *Enriching Discourse on Public Domains*, 55 DUKE L.J. 783, 783–813 (2006); Pamela Samuelson, *Mapping the Digital Public Domain: Threats and Opportunities*, 66 LAW & CONTEMP. PROBS. 147, 149–52 (2003).

2. U.S. CONST. art. I, § 8, cl. 8.

3. *Cf. Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 37 (2003) (Congress may not “create[] a species of perpetual patent [or] copyright”).

4. *See Graham v. John Deere Co.*, 383 U.S. 1, 6 (1966) (“Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available. Innovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in a patent system which by constitutional command must ‘promote the Progress of . . . useful Arts.’”).

5. *Dastar*, 539 U.S. at 34.

6. Ochoa, *supra* note 1, at 234 & nn.132–33, 262–64, 320–22 (collecting cases); *see also* WILLIAM B. HALE, A TREATISE ON THE LAW OF COPYRIGHT AND LITERARY PROPERTY § 213, 13 C.J. 1075 (1917) (“The omission of the notice by or with the consent of the copyright proprietor destroys the copyright and puts the work irrevocably in the public domain.”). Trademark law represents a limited exception to this principle, allowing business owners to appropriate words and symbols for use as source identifiers for their goods and services, thereby removing certain uses of those words and symbols from the public domain. *See* Ochoa, *supra* note 1, at 264–66.

7. Pub. L. No. 103-465, § 514, 108 Stat. 4809, 4976 (1994) (codified at 17 U.S.C. § 104A (2006)).

works of foreign origin that were not yet in the public domain in their source countries, but that were in the public domain in the United States for various specified reasons.⁸ By removing an entire body of works from the public domain, Congress challenged the idea that the Patent and Copyright Clause implicitly limits Congress's power to grant patents and copyrights over material that previously was in the public domain and could be freely used by anyone.

In *Golan v. Holder*,⁹ the Supreme Court will consider whether Congress's action in removing thousands of foreign works from the public domain violates either the Patent and Copyright Clause of the Constitution or the First Amendment.¹⁰ *Golan*, however, is not an isolated case; it is one of four test cases that were initially filed by law professor Lawrence Lessig to challenge various aspects of a decade-long expansion of copyright—and corresponding diminution of the public domain—enacted by Congress in the 1990s.¹¹ Thus, in order to understand the significance of *Golan*, it is helpful to revisit the major congressional actions that led to those test cases, and to consider how the public domain has been harmed by those actions.

Part II of this Essay describes the international copyright considerations that motivated Congress to act, while Part III reviews Congress's revisions to copyright law and the effect of those revisions on the public domain. Part IV examines the court challenges brought against those revisions. Part V discusses the importance of *Golan* and the actual and potential impact it will have on the public domain. Other essays in this Roundtable will discuss the merits of the case.

II. BACKGROUND: THE BERNE CONVENTION

The Berne Convention for the Protection of Literary and Artistic Works is the major international treaty concerning copyright protection for works of foreign nationals.¹² The United States, however, did not join the Berne Convention for more than a century after it was signed in 1886,¹³ because our approach to copyright

8. For details of copyright restoration, see *infra* Part V.A.

9. 609 F.3d 1076 (10th Cir. 2010), *cert. granted*, 131 S. Ct. 1600 (2011).

10. See Petition for Writ of Certiorari at i, *Golan v. Holder*, No. 10-545 (U.S. Oct. 20, 2010).

11. See *infra* Part III (congressional expansion of copyright); *infra* notes 63–76 and accompanying text (test cases).

12. Berne Convention for the Protection of Artistic and Literary Works, 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].

13. See PAUL GOLDSTEIN & BERNT HUGENHOLTZ, INTERNATIONAL COPYRIGHT: PRINCIPLES, LAW, AND PRACTICE § 3.1.2.1, at 37–38 (2d ed. 2010) (“The United States of America was the

protection was fundamentally different from that of the rest of the world. Whereas most nations consider copyright to be a natural right of the author, which arises automatically as a result of the act of authorship,¹⁴ the United States has traditionally viewed copyright primarily as a utilitarian law, designed as an incentive for the creation and distribution of new works of authorship.¹⁵ As a result, while the Berne Convention prohibits conditioning copyright protection on any formalities,¹⁶ the United States previously required authors to comply with various formalities in order to obtain copyright protection.¹⁷ For example, under the 1909 Copyright Act, authors had to publish their works with proper copyright notice to obtain a federal statutory copyright.¹⁸ If a work was published without proper notice, the author was deemed to have dedicated the work to the public domain.¹⁹ The United States also required authors to register their works in order to enforce their copyrights by an infringement suit.²⁰ Another fundamental difference between the United States and Berne parties was the question of duration. While the Berne Convention

single, commercially most important country to remain outside the Berne Union for its entire first century. . . . The United States finally adhered to the Berne Convention on March 1, 1989.”).

14. See, e.g., Universal Declaration of Human Rights, G.A. Res. 217 (III) A, U.N. Doc. A/RES/217(III), art. 27(2) (Dec. 10, 1948) (“Everyone has the right to the protections of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author.”); GOLDSTEIN & HUGENHOLTZ, *supra* note 13, § 1.2, at 6–7.

15. See, e.g., Harper & Row Publishers, Inc. v. Nation Enters., 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.”); Sony Corp. v. Universal City Studios, Inc., 464 U.S. 417, 432 (1984) (“The immediate effect of our copyright law is to secure a fair return for an author’s creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good.” (citation and internal quotation marks omitted)).

16. See Berne Convention, *supra* note 12, art. 5(2) (“The enjoyment and the exercise of these rights shall not be subject to any formality . . .”).

17. See GOLDSTEIN & HUGENHOLTZ, *supra* note 13, § 3.1.2.1, at 38 (“Political pressure to retain formalities . . . , which were prohibited since 1908 by the Berlin Text [of the Berne Convention], was one reason the United States declined to join Berne.”). Formalities serve a number of purposes in a utilitarian-based system of copyright, including recording and preserving data concerning ownership and duration, and requiring authors and artists to distinguish those works for which copyright protection is desired from those for which it is not. See Christopher Sprigman, *Reform(aliz)ing Copyright*, 57 STAN. L. REV. 485, 500–39 (2004).

18. Copyright Act of 1909, ch. 320, § 9, 35 Stat. 1075, 1077 (codified at 17 U.S.C. § 10 in 1947, repealed 1978).

19. See, e.g., Universal Film Mfg. Co. v. Copperman, 212 F. 301, 302 (S.D.N.Y. 1914) (“[P]ublication without such notice amounts to a dedication to the public sufficient to defeat all subsequent efforts at copyright protection.”), *aff’d on other grounds*, 218 F. 577 (2d Cir. 1914); HALE, *supra* note 6, § 213, at 1075.

20. Copyright Act of 1909, ch. 320, § 12, 35 Stat. 1075, 1078 (codified at 17 U.S.C. § 13 in 1947, repealed 1978) (“No action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this Act with respect to the deposit of copies and registration of such work shall have been complied with.”).

required that member nations protect works for the life of the author and fifty years after the author's death,²¹ under the 1909 Act the United States provided only a fixed term of twenty-eight years of copyright protection, which could be renewed once for another twenty-eight years if the author complied with the formality of registering the copyright in the renewal term.²²

The Copyright Act of 1976²³ removed some of the objections to Berne membership by automatically granting protection from creation to new works of authorship for a term of life of the author plus fifty years.²⁴ However, the United States still could not join the Berne Convention because the 1976 Act continued to require the formalities of notice when a work was published and registration as a condition of judicial enforcement.²⁵ In addition, the United States retained the formality of renewal for works already published or registered under the 1909 Act.²⁶

Because the United States was (and is) the world's largest exporter of copyrighted works, it was in the national interest to encourage other nations to grant broad copyright protection to U.S. works. Such protection, however, could only effectively be accomplished by joining the Berne Convention.²⁷ Thus, in 1988 Congress enacted the Berne Convention Implementation Act ("BCIA").²⁸ The BCIA made copyright notice optional rather than

21. See Berne Convention, *supra* note 12, art. 7(1). The life-plus-fifty term was recommended in the 1908 Berlin text of the Berne Convention and became mandatory in the 1948 Brussels text. See Tyler T. Ochoa, *Copyright Protection for Works of Foreign Origin Under the 1909 Copyright Act*, 26 SANTA CLARA COMPUTER & HIGH TECH. L.J. 285, 290 & nn.26–27 (2010).

22. Copyright Act of 1909, ch. 320, § 23, 35 Stat. 1075, 1081 (codified at 17 U.S.C. § 24 in 1947, repealed 1978).

23. Pub. L. No. 94-553, 90 Stat. 2541 (1976) (current version at 17 U.S.C. §§ 101–805). The Act took effect January 1, 1978. *Id.* § 102, 90 Stat. at 2598–99.

24. *Id.* § 302(a), 90 Stat. at 2572.

25. See *id.* §§ 401–06, 90 Stat. at 2576–79 (notice); *id.* §§ 408–12, 90 Stat. at 2580–83 (registration).

26. See *id.* § 304(a), 90 Stat. at 2573–74; H.R. REP. NO. 94-1476, at 139 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5755 (“A great many of the present [renewal] expectancies in these [works] are the subject of existing contracts, and it would be unfair and immensely confusing to cut off or alter these interests. Renewal registration will be required during the 28th year of the copyright but the length of the renewal term will be increased from 28 to 47 years.”).

27. See S. REP. NO. 100-352, at 2–5 (1988), *reprinted in* 1988 U.S.C.C.A.N. 3706, 3707–10 (stating the reasons for joining the Berne Convention).

28. Pub. L. No. 100-568, 102 Stat. 2853 (1988). The BCIA took effect March 1, 1989. *Id.* § 13, 102 Stat. at 2861; World Intellectual Prop. Org., Berne Notification No. 121, Accession by the United States of America, November 17, 1988, *available at* http://www.wipo.int/treaties/en/notifications/berne/treaty_berne_121.html (listing date of entry into force of March 1, 1989).

mandatory,²⁹ and it retained the formality of registration as a condition of filing suit only for domestic works.³⁰ For foreign works, an infringement suit can now be filed without the formality of registration,³¹ although registration was (and is) still required to obtain the additional remedies of statutory damages and recovery of attorney's fees.³²

Article 18 of the Berne Convention requires that new member nations provide retroactive protection to other Berne parties' works "which, at the moment of [the Convention's] coming into force, have not yet fallen into the public domain in the country of origin through the expiry of the term of protection."³³ This provision is subject to two limitations. First, if "through the expiry of the term of protection which was previously granted, a work has fallen into the public domain of the country where protection is claimed, that work shall not be protected anew."³⁴ Second, in the absence of a special agreement on retroactive protection, each country may determine for itself "the conditions of application of this principle."³⁵

When the United States joined the Berne Convention in 1989, however, it took no action to implement Article 18. Moreover, Congress made it abundantly clear that it did not consider the Berne Convention to be self-executing, and that the Convention could be enforced only to the extent that it had been implemented in domestic law.³⁶ Thus, despite Article 18, works of foreign origin that had

29. Pub. L. No. 100-568, § 7, 102 Stat. 2853, 2857-58 (1988) (codified as amended at 17 U.S.C. §§ 401-406 (2006)).

30. The original statutory phrase was "[e]xcept for actions for infringement of copyright in Berne Convention works whose country of origin is not the United States." *Id.* § 9(b)(1)(B), 102 Stat. at 2859 (codified as amended at 17 U.S.C. § 411(a) (2006)).

31. The current statutory phrase is "no civil action for infringement of the copyright in any United States work shall be instituted until . . . registration of the copyright claim has been made in accordance with this title." 17 U.S.C. § 411(a) (2006). A "United States work" is defined as a work first published in the United States or simultaneously published in the United States and in another country, or an unpublished work whose authors are all nationals, domiciliaries, or habitual residents of the United States. *Id.* § 101.

32. *Id.* § 412.

33. Berne Convention, *supra* note 12, art. 18(1).

34. *Id.* art. 18(2).

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

36. *See, e.g.*, 17 U.S.C. § 104(c) (2006) ("No right or interest in a work eligible for protection under this title may be claimed by virtue of, or in reliance upon, the provisions of the Berne Convention, or the adherence of the United States thereto. Any rights in a work eligible for protection under this title . . . shall not be expanded or reduced by virtue of, or in reliance upon, the provisions of the Berne Convention, or the adherence of the United States thereto."); Pub. L. No. 100-568, § 2, 102 Stat. 2853, 2853 (1988) ("The obligations of the United States under the Berne Convention may be performed only pursuant to appropriate domestic law. . . . The amendments made by this Act . . . satisfy the obligations of the United States in adhering to the

previously entered the public domain in the United States remained there for the time being.³⁷

III. CONGRESS'S ASSAULT ON THE PUBLIC DOMAIN

In the 1990s, Congress enacted four major pieces of legislation that had the effect of drastically reducing the scope of the public domain.

First, in 1992, Congress enacted the Copyright Renewal Act.³⁸ This Act applied only to works that had been published or registered under the 1909 Act between January 1, 1964, and December 31, 1977.³⁹ All such works were still subject to the requirement that the copyright be renewed after the initial twenty-eight-year term in order to receive an additional term of protection.⁴⁰ Historically, only about ten to fifteen percent of all eligible works were renewed; the remaining eighty-five to ninety percent entered the public domain after the expiration of the first twenty-eight years of copyright protection.⁴¹ The Act, however, made copyright renewal automatic, so that even if no author or other copyright claimant came forward to register the work, the renewal term automatically vested anyway.⁴² By changing

Berne Convention and no further rights or interests shall be recognized or created for that purpose."); *id.* § 3(a), 102 Stat. at 2853 ("The provisions of the Berne Convention . . . shall be given effect under title 17, as amended by this Act, and . . . shall not be enforceable in any action brought pursuant to the provisions of the Berne Convention itself.").

37. Pub. L. No. 100-568, § 12, 102 Stat. 2853, 2860 (1988) ("Title 17 . . . as amended by this Act, does not provide copyright protection for any work that is in the public domain in the United States.").

38. Pub. L. No. 102-307, tit. I, 106 Stat. 264 (1992).

39. *Id.* § 102(g)(2).

40. See Copyright Act of 1976, Pub. L. No. 94-553, § 304(a), 90 Stat. 2541, 2573. The 1976 Act had extended the second term from twenty-eight years to forty-seven years, resulting in a maximum term of protection of seventy-five years from first publication or registration. *Id.*; see also Tyler T. Ochoa, *Patent and Copyright Term Extension and the Constitution: A Historical Perspective*, 49 J. COPYRIGHT SOC'Y U.S.A. 19, 42-43 (2001) (explaining the term extension in the 1976 Act).

41. See BARBARA A. RINGER, COPYRIGHT LAW REVISION STUDY NO. 31: RENEWAL OF COPYRIGHT app. C at 222 (Comm. Print 1961) (prepared for the S. Subcomm. on Patents, Trademarks, and Copyrights of the S. Comm. on the Judiciary) (finding that for works first published between 1923 and 1932, for which renewal was to be made between 1950 and 1959, the percentage of renewals varied between 9.85% (in 1953) to 14.70% (in 1959)). The data from 1959 showed that of works registered in 1931-32, thirty-five percent of musical compositions (Class E) and seventy-four percent of motion pictures (Class L) were renewed, but only seven percent of books (Class A) and only eleven percent of periodicals (Class B) were renewed. *Id.* at 220-21.

42. See Pub. L. No. 102-307, § 102(a), 106 Stat. 264, 265 (1992) (codified as amended at 17 U.S.C. § 304(a)(2)(A)-(B) (2006)) (providing for the vesting of a renewal term both when an application for extension has been made and when such application has not been made by the expiration of the initial copyright term).

copyright renewal from an “opt-in” system to an “opt-out” system, Congress effectively deprived the public domain of the eighty-five to ninety percent of works that would otherwise have entered the public domain between 1993 and 2006 under the renewal provisions of the 1976 Act.⁴³ Instead, all of those works would remain under copyright until at least between 2040 and 2053.⁴⁴

Second, in 1994, Congress enacted the Uruguay Round Agreements Act (“URAA”).⁴⁵ The purpose of the URAA was to implement the changes made by the Agreement on Trade-Related Aspects on Intellectual Property Rights (the “TRIPS Agreement”), which was one of the annexes to the Agreement Establishing the World Trade Organization (“WTO”).⁴⁶ The TRIPS Agreement made all of the substantive provisions of the Berne Convention (except for Article 6^{bis}, on moral rights) enforceable between nations under the dispute-resolution mechanism of the WTO.⁴⁷ Because Article 18 of the Berne Convention would now be enforceable against the United States, the United States had to make some effort to comply with Article 18. However, where other nations chose only minimal compliance with Article 18, by enacting permanent protection for so-called “reliance parties” (persons or entities that had relied on the public domain status of the works in some way),⁴⁸ Congress enacted

43. Because “[a]ll terms of copyright . . . run to the end of the calendar year in which they would otherwise expire,” 17 U.S.C. § 305 (2006), works published or registered in 1964 had their first twenty-eight-year term run until December 31, 1992, and would have entered the public domain on January 1, 1993, if not renewed. Works published or registered in 1977 had their first twenty-eight-year term run until December 31, 2005, and would have entered the public domain on January 1, 2006, if not renewed.

44. For works published or registered in 1964, seventy-five years of copyright protection would endure until December 31, 2039, and the work would enter the public domain on January 1, 2040. For works published or registered in 1977, seventy-five years of copyright protection would endure until December 31, 2052, and the work would enter the public domain on January 1, 2053. These periods were extended again by twenty years in 1998. *See infra* notes 55–58 and accompanying text.

45. Pub. L. No. 103-465, 108 Stat. 4809 (1994) (copyright restoration provisions codified as amended at 17 U.S.C. § 104A (2006)).

46. *See* Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 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].

47. *Id.* arts. 9(1), 64.

48. *See* Golan v. Holder, 611 F. Supp. 2d 1165, 1174 (D. Colo. 2009) (citing “temporally permanent” accommodations provided by Germany, Hungary, the United Kingdom, Australia, and New Zealand), *rev'd*, 609 F.3d 1076, 1092–93 (10th Cir. 2010) (discussing the U.K. law), *cert. granted*, 131 S. Ct. 1600 (2011).

far more sweeping protection. Effective January 1, 1996,⁴⁹ section 514 of the URAA automatically restored copyright protection to all works of foreign origin that were not yet in the public domain in their source countries, but that were in the public domain in the United States for specified reasons.⁵⁰ As for reliance parties, Congress required that they be given either actual or constructive notice of the restoration.⁵¹ Once notice was given, reliance parties had one year to sell off any existing inventory of copies of restored works, after which any further exploitation would be infringing.⁵² The result was that thousands of foreign works that had been in the public domain in the United States were placed under copyright protection for the same terms that they would have received if they had been eligible for copyright protection and had complied with all the necessary formalities required by U.S. law.⁵³

Third, in 1998 Congress enacted two major pieces of legislation: the Digital Millennium Copyright Act (“DMCA”)⁵⁴ and the Sonny Bono Copyright Term Extension Act (“CTEA”).⁵⁵ While the DMCA did not directly affect the scope of the public domain,⁵⁶ the CTEA extended the terms of all existing and future copyrights by twenty years,⁵⁷ resulting in a near-moratorium on new works entering the public domain until 2019.⁵⁸

49. See 17 U.S.C. § 104A(h)(2)(A) (2006) (defining the “date of restoration” of a restored copyright as January 1, 1996, for works with a source country that adheres to the Berne Convention or that was a WTO member country on such date).

50. *Id.* § 104A(a)(1)(A), (h)(6). For details concerning copyright restoration, including the specified reasons, see *infra* Part V.A.

51. *Id.* § 104A(c).

52. *Id.* §§ 104A(d)(2), 109(a). In order to protect the movie industry, however, Congress provided that a reliance party could continue to exploit any existing derivative works that were based on now-restored works, upon payment of “reasonable compensation.” *Id.* § 104A(d)(3).

53. See *id.* § 104A(a)(1)(B).

54. Pub. L. No. 105-304, 112 Stat. 2860 (1998) (codified as amended in scattered sections of 17 U.S.C.).

55. Pub. L. No. 105-298, tit. I, 112 Stat. 2827 (1998) (codified as amended at 17 U.S.C. §§ 101, 108, 203, 301–04 (2006)).

56. However, the DMCA made it more difficult for consumers and users to gain access to public domain works distributed only in encrypted formats by prohibiting the distribution of decryption devices and software. Pub. L. No. 105-304, § 103(a), 112 Stat. 2860, 2863 (1998) (codified as amended at 17 U.S.C. § 1201(a)(2), (b) (2006)).

57. Pub. L. No. 105-298, tit. I, § 102, 112 Stat. 2827 (1998) (codified as amended at 17 U.S.C. §§ 302–04). See Ochoa, *supra* note 40, at 44–46.

58. Ochoa, *supra* note 40, at 46. The only works that will enter the public domain before 2019 are works by authors who died more than seventy years before the current year that were unpublished and not registered on January 1, 1978, and that remained unpublished on December 31, 2002. See 17 U.S.C. § 303(a) (providing duration of copyright for works created but not published or copyrighted before January 1, 1978).

The net result of these congressional actions on the public domain was dramatic. Had the 1909 Act remained the law, all works published or registered before 1955 would now be in the public domain.⁵⁹ Even under the 1976 Act as enacted, all works published or registered before 1936 would now be in the public domain,⁶⁰ along with the vast majority of works published or registered between 1936 and 1977.⁶¹ Many works of foreign origin would be in the public domain for failure to comply with formalities, and all works of foreign origin published before the United States had copyright treaty relations with the country of origin would be in the public domain.⁶² Instead, the public domain is now limited to works published or registered before January 1, 1923, and those domestic works published or registered between 1923 and 1963 that were not renewed. All domestic works published or registered in 1923 or later and properly renewed, all domestic works published or registered in 1964 or later, and all works of foreign origin published or registered in 1923 or later are currently under copyright in the United States.

IV. CONSTITUTIONAL CHALLENGES

Lessig's first test case was *Eldred v. Reno*, which challenged the CTEA on the ground that it violated both the First Amendment and the Patent and Copyright Clause of the U.S. Constitution.⁶³ Each of the plaintiffs⁶⁴ alleged it was harmed because it had planned to

59. Under the 1909 Act, the maximum term of copyright was fifty-six years from first publication, so any works published in 1954 would have remained under copyright until 2010 and would have entered the public domain on January 1, 2011. *See supra* note 22 and accompanying text.

60. Under the 1976 Act as enacted, the maximum term of copyright for works published before 1978 was seventy-five years from first publication, so any works published in 1935 would have remained under copyright until December 31, 2010, and would have entered the public domain on January 1, 2011. *See supra* note 40.

61. Under the 1976 Act as enacted, works published before 1978 still had to be renewed. If not renewed, they entered the public domain at the end of their first twenty-eight-year term. Historically, only about ten to fifteen percent of all eligible works were renewed. *See supra* note 41.

62. *See infra* Part V.A.

63. Second Amended Complaint at ¶¶ 58–66, 76–80, *Eldred v. Reno*, 74 F. Supp. 2d 1 (D.D.C. 1999) (No. 99-CV-00065), available at http://cyber.law.harvard.edu/eldredvreno/cyber/complaint_amd2.html. Another count alleged that the CTEA violated the public trust doctrine, *id.* ¶¶ 69–73, but this theory was rejected by the district court and was not appealed. For an analysis of the public trust theory, see Ochoa, *supra* note 40, at 113–16.

64. Eric Eldred is an individual who posts public domain literary works on the Internet under the name the Eldritch Press. He was later joined by three publishers of public domain works: Dover Publications, Inc., Higginson Book Co. (genealogy & history), and Tri-Horn International (golf); three users of public domain sheet music: Jill A. Crandall (church choir director), Luck's Music Library (retailer) and Edwin F. Kalmus & Co. (publisher); two users of

reprint, restore, perform, or use works that would have entered the public domain but for the CTEA.⁶⁵ On October 28, 1999, the district court granted the Government's motion for judgment on the pleadings, and the judgment was affirmed by a divided panel of the D.C. Circuit on February 16, 2001.⁶⁶ After new Attorney General John Ashcroft succeeded Janet Reno, the plaintiffs' petition for rehearing was rejected on July 13, 2001.⁶⁷

Following the D.C. Circuit's ruling in *Eldred*, Lessig filed two more test cases, each challenging both the CTEA and section 514 of the URAA on the grounds that they violated the Patent and Copyright Clause and the First Amendment. *Golan v. Ashcroft* was filed on September 19, 2001,⁶⁸ and *Luck's Music Library v. Ashcroft* was filed on October 29, 2001.⁶⁹ The plaintiffs in each case alleged that they were affected by copyright restoration when various works of foreign origin were removed from the public domain.⁷⁰

Before the district courts could act, however, the Supreme Court granted certiorari in *Eldred v. Ashcroft*.⁷¹ As a result, both district courts stayed the actions pending the outcome of *Eldred*. On January 15, 2003, the Supreme Court held, 7–2, that the CTEA did not violate either the Patent and Copyright Clause or the First

public domain movies: American Film Heritage Association (non-profit association devoted to film preservation) and Moviecraft, Inc. (commercial film archive); and Copyright's Commons, a non-profit public domain advocacy organization founded by Lessig (later renamed Creative Commons). Second Amended Complaint, *supra* note 63, ¶¶ 1–11; CREATIVE COMMONS, <http://creativecommons.org> (last visited Sept. 20, 2011); ELDRITCH PRESS, www.eldritchpress.org (last visited Sept. 20, 2011).

65. Second Amended Complaint, *supra* note 63, ¶¶ 27–55.

66. *Eldred v. Reno*, 74 F. Supp. 2d 1, 9 (D.D.C. 1999), *aff'd*, 239 F.3d 372, 380 (D.C. Cir. 2001), *aff'd sub nom.* *Eldred v. Ashcroft*, 537 U.S. 186, 222 (2003). For an analysis of the district court's opinion, see Ochoa, *supra* note 40, at 109–16. For an analysis of the circuit court opinion, see *id.* at 116–20.

67. *Eldred v. Ashcroft*, 255 F.3d 849, 852 (D.C. Cir. 2001). For an analysis of the opinion denying rehearing, see Ochoa, *supra* note 40, at 120–24.

68. Complaint, *Golan v. Ashcroft*, 310 F. Supp. 2d 1215 (D. Colo. 2004) (No. 01-B-1854), available at <http://cyber.law.harvard.edu/openlaw/golanvashcroft/complaint.pdf>. The plaintiffs in *Golan* were Lawrence Golan, a music professor at the University of Denver and conductor of the Portland (Maine) Ballet Orchestra and the Atlantic Chamber Orchestra; Richard Kapp, conductor and founder of the Philharmonia Virtuosi, and his recording company, S.A. Publishing Co. (d/b/a ESS.A.Y Recordings); the Symphony of the Canyons, a community orchestra in Utah; Ron Hall, d/b/a Festival Films; and John McDonough, d/b/a Timeless Video Alternatives International. *Id.* ¶¶ 6–11.

69. *Luck's Music Library, Inc. v. Ashcroft*, 321 F. Supp. 2d 107, 111 (D.D.C. 2004), *aff'd sub nom.* *Luck's Music Library, Inc. v. Gonzales*, 407 F.3d 1262, 1266 (D.C. Cir. 2005). The lead plaintiff in *Luck's Music Library* was a retailer of public domain music and was joined by Moviecraft, Inc., a commercial film archive. 321 F. Supp. 2d at 110–11.

70. *Luck's*, 321 F. Supp. 2d at 110–11; Complaint, *supra* note 68, ¶¶ 78–90.

71. 534 U.S. 1126 (2002).

Amendment.⁷² In rejecting the Patent and Copyright Clause challenge, the Court noted that the plaintiffs did not challenge the absolute duration of the copyright term, but only contended that whatever period Congress selected could not be extended retroactively.⁷³ In rejecting the First Amendment challenge, the Court remarked that “when, as in this case, Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary.”⁷⁴

In the wake of *Eldred*, Lessig filed a fourth test case, *Kahle v. Ashcroft*, which attempted to capitalize on the Supreme Court’s remarks by arguing that Congress *had* changed the “traditional contours of copyright protection” when it changed copyright from an “opt-in” system requiring renewal to an “opt-out” system of automatic renewal, and that the life-plus-seventy-year term itself violated the “limited Times” provision of the Patent and Copyright Clause.⁷⁵ The district court summarily dismissed the case based on *Eldred*, and the Ninth Circuit affirmed.⁷⁶

Meanwhile, in the two pending cases concerning copyright restoration, the court in *Golan* acted first, denying the Government’s motion to dismiss on March 16, 2004.⁷⁷ Three months later, the district court in *Luck’s Music Library* granted the Government’s motion to dismiss on the grounds that Congress had on three previous occasions removed some works from the public domain,⁷⁸ and that the

72. *Eldred v. Ashcroft*, 537 U.S. 186, 222 (2003).

73. *Id.* at 193.

74. *Id.* at 221.

75. Complaint at 35–52, 92–101, *Kahle v. Ashcroft*, 2004 U.S. Dist. LEXIS 24090 (N.D. Cal. Nov. 19, 2004) (No. C-04-1127). The plaintiffs were Brewster Kahle, founder and chairman of the Internet Archive, a non-profit corporation that makes public domain works available on the Internet; and Richard Prelinger, President of Prelinger Associates, Inc., which owns and operates the Prelinger Archive, an extensive collection of advertising, educational, industrial, and amateur films. *Id.* ¶¶ 1–4. Plaintiffs alleged that they desired to make “orphan” works (works for whom no copyright owner can be located) available on the Internet, but were deterred by the threat of criminal copyright infringement. *Id.* ¶¶ 75–78.

76. *Kahle v. Ashcroft*, 72 U.S.P.Q.2d (BNA) 1888 (N.D. Cal. Nov. 19, 2004), *aff’d sub nom.* *Kahle v. Gonzales*, 487 F.3d 697, 701 (9th Cir. 2007).

77. *Golan v. Ashcroft*, 310 F. Supp. 2d 1215, 1221 (D. Colo. 2004), *motion for summary judgment granted sub nom.* *Golan v. Gonzales*, 74 U.S.P.Q.2d (BNA) 1808, 1809 (D. Colo. Apr. 20, 2005), *rev’d in part*, 501 F.3d 1179, 1196 (10th Cir. 2007), *on remand sub nom.* *Golan v. Holder*, 611 F. Supp. 2d 1165, 1177 (D. Colo. 2009), *rev’d*, 609 F.3d 1076, 1094 (10th Cir. 2010), *cert. granted*, 131 S. Ct. 1600 (2011).

78. *Luck’s Music Library, Inc. v. Ashcroft*, 321 F. Supp. 2d 107, 113–16 (D.D.C. 2004), *aff’d sub nom.* *Luck’s Music Library, Inc. v. Gonzales*, 407 F.3d 1262, 1266 (D.C. Cir. 2005). The Copyright Act of 1790 allowed previously published works to qualify for copyright upon compliance with the requisite formalities; and following World Wars I and II, Congress allowed foreign copyright owners who were unable to comply with the requisite formalities during the war a grace period to do so after the cessation of hostilities. 321 F. Supp. 2d at 113–16. Whether

“traditional contours of copyright protection” were limited to the idea-expression dichotomy and the fair use doctrine.⁷⁹ The plaintiffs appealed only the Patent and Copyright Clause portion of the ruling, and the D.C. Circuit affirmed on May 24, 2005.⁸⁰

The district court in *Golan* fell into line, granting the Government’s motion for summary judgment on April 20, 2005, on the grounds that Congress had previously restored some works from the public domain, and that the private enforcement of copyrights does not implicate the First Amendment.⁸¹ On appeal, the Tenth Circuit affirmed the ruling that the Patent and Copyright Clause does not prohibit Congress from removing copyrights from the public domain; but with regard to the First Amendment, it held that “the traditional contours of copyright protection include the principle that works in the public domain remain there”⁸² The court acknowledged that “the history of the 1790 [Copyright] Act could be highly informative of the Framers’ views,” but it concluded that “the answer to the question of whether Congress thought it was removing works from the public domain [in 1790] is probably not just unclear but also unknowable.”⁸³ It also found that two wartime acts allowing foreign copyright owners a grace period to comply with the required formalities after the cessation of hostilities “were, at most, a brief and limited departure from a practice of guarding the public domain.”⁸⁴ The court further held that the plaintiffs’ First Amendment interests were implicated by the Government’s action in restoring copyrights, and that neither the idea-expression dichotomy, the fair use doctrine, nor the URAA itself were adequate to protect the First Amendment interests at stake.⁸⁵ It therefore remanded the case with instructions to determine whether

Congress believed in 1790 that previously published works were in the public domain or not remains a hotly debated question. See Brief of H. Tomas Gomez-Arostegui and Tyler T. Ochoa as Amici Curiae in Support of Petitioners, *Golan v. Holder*, No. 10-545 (U.S. June 17, 2011), available at http://www.americanbar.org/content/dam/aba/publishing/previewbriefs/Other_Brief_Updates/10-545_petitioneramcu2scholars.authcheckdam.pdf.

79. *Luck’s v. Ashcroft*, 321 F. Supp. 2d at 118–19.

80. *Luck’s v. Gonzales*, 407 F.3d at 1265–66.

81. *Golan v. Gonzales*, 74 U.S.P.Q.2d (BNA) at 1821. The court also held that the URAA did not violate the Due Process Clause of the Fifth Amendment. *Id.* at 1821–22. The plaintiffs did not appeal this portion of the district court’s opinion.

82. *Golan v. Gonzales*, 501 F.3d 1179, 1186–89 (10th Cir. 2007), *on remand sub nom. Golan v. Holder*, 611 F. Supp. 2d 1165 (D. Colo. 2009), *rev’d*, 609 F.3d 1076 (10th Cir. 2010), *cert. granted*, 131 S. Ct. 1600 (2011).

83. *Id.* at 1191.

84. *Id.* at 1192; see also *id.* (“The fact that the legislation was passed in response to the exigencies of a world war suggests that Congress felt compelled to depart from its normal practice of preserving the public domain.”); *supra* note 78 (discussing postwar grace periods).

85. *Golan v. Gonzales*, 501 F.3d at 1192–96.

the URAA was content-based or content-neutral, and to apply the appropriate level of scrutiny to the legislation.⁸⁶

On remand, the parties agreed that the URAA was a content-neutral law, and that it should be upheld “if it advances important governmental interests unrelated to the suppression of free speech and does not burden substantially more speech than necessary to further those interests.”⁸⁷ The Government proffered three interests allegedly served by section 514. The first, compliance with Article 18 of the Berne Convention, was conceded to be an important interest,⁸⁸ but the plaintiffs claimed that they were “reliance parties”⁸⁹ and that Article 18(3) gave member nations the discretion to permanently exempt reliance parties, as several other nations had done.⁹⁰ The district court agreed, and held that section 514 was “substantially broader than necessary to achieve the government’s interest,”⁹¹ becoming the first court ever to hold that a copyright law violated the Free Speech Clause of the First Amendment.

The second governmental interest offered was the protection of American authors abroad. The Government argued that enactment of section 514 would encourage other countries to reciprocate and to provide broad protection to American authors, despite the discretion afforded those countries by Article 18(3) of the Berne Convention.⁹² The court, however, found that there was “no evidence showing how suppression of reliance parties’ First Amendment rights will lead to suppression of reliance parties’ rights in foreign nations, or how such suppression will provide a ‘direct and material’ benefit to United States authors.”⁹³ Instead, the court credited testimony made before Congress suggesting that other nations were *unlikely* to follow the United States’ lead.⁹⁴ Third, the Government argued that restoration of foreign authors’ copyrights was itself equitable and an important governmental interest. The court rejected this argument, noting that section 514 protects only foreign authors, and that the argument was

86. *Id.* at 1196–97.

87. *Golan v. Holder*, 611 F. Supp. 2d 1165, 1170 (D. Colo. 2009) (quoting *Turner Broad. Sys., Inc. v. FCC*, 520 U.S. 180, 189 (1997) (*Turner II*)), *rev’d on other grounds*, 609 F.3d 1076 (10th Cir. 2010), *cert. granted*, 131 S. Ct. 1600 (2011).

88. *Golan v. Holder*, 611 F. Supp. 2d at 1172.

89. Defined as “those persons with a vested interest in previously public-domain works.” *Id.* at 1174.

90. *Id.* (citing Germany, Hungary, the United Kingdom, Australia, and New Zealand).

91. *Id.* at 1175.

92. *Id.*

93. *Id.* at 1176.

94. *Id.*

therefore inconsistent with the argument that the statute would result in greater copyright protection for American authors.⁹⁵

On appeal, the Tenth Circuit reversed, focusing only on the second asserted interest.⁹⁶ It held that obtaining greater copyright protection for American authors in other countries was an important government interest, and that Congress was entitled to credit “testimony from a number of witnesses that the United States’ position on the scope of copyright restoration . . . was critical to the United States’ ability to obtain similar protections for American copyright holders” in future negotiations with foreign countries.⁹⁷ It also held that even if “the government could have complied with the minimal obligations of the Berne Convention and granted stronger protections for American reliance parties,”⁹⁸ that fact was immaterial for two reasons: (1) Congress legitimately could have sought greater copyright protection for American authors abroad than the Berne Convention required, which could only be achieved by granting greater copyright protection to foreign authors here;⁹⁹ and (2) intermediate scrutiny did not require that the Government adopt the least restrictive means of advancing its interest.¹⁰⁰ It also held that in any event, “[t]he United Kingdom model is not substantially less restrictive of speech than” section 514.¹⁰¹ It therefore concluded that section 514 did not violate the First Amendment.¹⁰²

Nine months later, on March 7, 2011, the Supreme Court granted certiorari to review the judgment of the Tenth Circuit, with

95. *Id.* at 1177.

96. *Golan v. Holder*, 609 F.3d 1076, 1083–84 & n.6 (10th Cir. 2010), *cert. granted*, 131 S. Ct. 1600 (2011).

97. *Id.* at 1084–86, 1088. The court noted the existence of conflicting testimony that predicted other countries would *not* follow the United States’ example, but it held that Congress was entitled to weigh the conflicting evidence, and that “in areas that involve predictions of foreign relations and diplomacy, where empirical data will rarely be available, . . . considerable deference is owed to Congress and the Executive.” *Id.* at 1089.

98. *Id.* at 1091.

99. *Id.* at 1091–92.

100. *Id.* at 1092.

101. *Id.* at 1093. Section 514 gives U.S. reliance parties one year to sell off existing inventory after being placed on actual or constructive notice of restoration, and it allows reliance parties who created derivative works to continue to exploit those works upon payment of reasonable compensation to the copyright owner. *Id.* Under the U.K. legislation, reliance parties may continue using the restored work, including any derivative works, unless the copyright owner “buys out” the reliance party by paying compensation. *Id.*

102. *Id.* at 1094. The court also rejected the Petitioner’s cross-appeal concerning the Patent and Copyright Clause, on the ground that the previous Tenth Circuit opinion in *Golan* was the law of the case. *Id.* at 1094–95.

Justice Kagan recusing herself because of her previous participation in the case.¹⁰³ The questions presented to the Supreme Court are:

(1) Does the Progress Clause [i.e., the Patent and Copyright Clause] of the United States Constitution prohibit Congress from taking works out of the public domain?

(2) Does section 514 violate the First Amendment of the Constitution?¹⁰⁴

V. *GOLAN'S* EFFECT ON AND IMPORTANCE TO THE PUBLIC DOMAIN

The immediate effect of *Golan* will be to decide whether thousands of foreign works whose copyrights were “restored” in 1996 will remain under copyright, or whether they will be returned to the public domain. Its future implications, however, will depend on the decision and reasoning of the Supreme Court.

A. *Copyright Restoration*

To understand the immediate effect of *Golan*, it is necessary to take a closer look at section 514 and how it actually operates. Section 514 of the URAA was codified at 17 U.S.C. § 104A. Effective January 1, 1996,¹⁰⁵ § 104A “restored” copyright protection to foreign works that were not in the public domain in their country of origin, but that were in the public domain in the United States for one of three specified reasons: (1) “noncompliance with formalities imposed at any time by United States copyright law, including failure of renewal, lack of proper notice, or failure to comply with any manufacturing requirements”; (2) “lack of subject matter protection in the case of sound recordings fixed before February 15, 1972”; and (3) “lack of national eligibility.”¹⁰⁶ Thus, there are three categories of foreign works that had their copyrights restored on January 1, 1996, the first category of which is further divided into three subcategories.

The first category consists of works from all eligible countries¹⁰⁷ that were in the public domain in the United States for lack of renewal, lack of proper notice, or failure to meet the requirements of the manufacturing clause, and that were still under copyright in their

103. *Golan v. Holder*, 131 S. Ct. 1600 (2011).

104. Petition for Writ of Certiorari at i, *Golan*, No. 10-545 (U.S. Oct. 20, 2010).

105. 17 U.S.C. § 104A(h)(2)(A) (2006).

106. *Id.* § 104A(a)(1), (h)(6).

107. Countries that are members of the Berne Convention, the World Trade Organization, or certain other copyright treaties. *Id.* § 104A(h)(3) (defining “eligible country”).

source countries on January 1, 1996.¹⁰⁸ Since copyright protection is automatic in Berne countries, and subsists for either the life of the author plus seventy years (in the European Union and other countries)¹⁰⁹ or the life of the author plus fifty years (in other Berne nations),¹¹⁰ the vast majority of foreign works published in 1923 or later were still under copyright in their source countries and were therefore eligible for restoration.

The first subcategory consists of works from all eligible countries that were published in the United States between January 1, 1923, and December 31, 1963, and that were not renewed. Because only about ten to fifteen percent of all works published during this period were renewed, this subcategory includes tens of thousands of works, including such famous works as Carl Dreyer's *The Passion of Joan of Arc*, Fritz Lang's *Metropolis* and *M*, Alfred Hitchcock's *Blackmail*, *The Lady Vanishes* and *The 39 Steps*, Jean Renoir's *The Grand Illusion* and *The Rules of the Game*, *The Blue Angel* (starring Marlene Dietrich), *The Private Life of Don Juan* (starring Douglas Fairbanks), *The Private Life of Henry VIII* (starring Charles Laughton), *Fire Over England* (starring Laurence Olivier and Vivien Leigh), and *The Third Man* (featuring Orson Welles).¹¹¹

The second subcategory consists of works from all eligible countries that were published in the United States without proper notice between January 1, 1923, and December 31, 1977,¹¹² or published anywhere in the world without proper notice between January 1, 1978, and February 28, 1989, the day before the United States joined the Berne Convention.¹¹³ Works in this subcategory include *The Hobbit* and *The Lord of the Rings* trilogy by J.R.R. Tolkien, writings by Joseph Conrad, George Orwell, H.G. Wells, and

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

109. See Council Directive 2006/116 of 12 December 2006 on the Term of Protection of Copyright and Certain Related Rights, art. 1(1), 2006 O.J. (L 372) 12, 13 (EC), available at <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2006:372:0012:0018:EN:PDF>.

110. Berne Convention, *supra* note 12, art. 7(1).

111. See, e.g., Complaint, *supra* note 68, ¶¶ 82–83, 88; *Copyright Restoration and Foreign Works: Be Careful*, PUBLIC DOMAIN SHERPA, <http://www.publicdomainsherpa.com/copyright-restoration.html> (last visited Sept. 20, 2011).

112. After initial publication with notice, the 1909 Act required notice on “each copy thereof published or offered for sale in the United States by authority of the copyright proprietor.” Copyright Act of 1909, ch. 320, § 9, 35 Stat. 1075, 1077 (codified at 17 U.S.C. § 10 in 1947, repealed 1978). It was unclear what the effect was of publication without notice when the initial publication occurred in a foreign country. For a discussion of this ambiguity and its effect on copyright restoration, see Ochoa, *supra* note 21, at 295–97, 303–05, 308–10.

113. Before the effective date of the Berne Convention Implementation Act, the 1976 Act required notice be placed “[w]henver a work . . . is published in the United States or elsewhere.” Pub. L. No. 94-553, § 401(a), 90 Stat. 2541, 2576.

Virginia Woolf, paintings by Pablo Picasso (including *Guernica*), drawings of M.C. Escher, and innumerable photographs.¹¹⁴

The third subcategory consists of nondramatic literary works in the English language published between January 1, 1923, and July 1, 1986, that were not manufactured in the United States.¹¹⁵ Since most major publishers complied with the manufacturing clause when it was operative, this subcategory includes far fewer works than the other two. Moreover, foreign publishers of English-language works could deposit a foreign edition for *ad interim* protection and then register the American edition when it was published.¹¹⁶ However, if the *ad interim* copyright expired before an American edition was published, the work entered the public domain and was eligible for copyright restoration.¹¹⁷

The second category consists of sound recordings from all eligible countries that were fixed before February 15, 1972 (the date sound recordings became eligible for federal copyright protection),¹¹⁸ and that were not in the public domain in their source countries on

114. See, e.g., Complaint, *supra* note 68, ¶¶ 82–83, 88; PUBLIC DOMAIN SHERPA, *supra* note 111.

115. The 1909 Act required that all English-language books and periodicals be printed and bound within the United States, from type set within the United States, or by engraving or lithography done within the United States, with certain exceptions. Copyright Act of 1909, ch. 320, § 15, 35 Stat. 1075, 1078–79 (codified as amended at 17 U.S.C. § 16 in 1947, repealed 1978). The 1976 Act required that copies of nondramatic literary works in English be manufactured in either the United States or Canada, with certain exceptions, with a sunset date of July 1, 1982. Pub. L. No. 94-553, § 601, 90 Stat. 2541, 2588. The sunset date was extended to July 1, 1986, by Pub. L. No. 97-215, 96 Stat. 178 (1982). The expired provision was finally repealed in 2010. Copyright Cleanup, Clarification, and Corrections Act of 2010, Pub. L. No. 111-295, § 4(a), 124 Stat. 3180, 3180.

116. Copyright Act of 1909, ch. 320, §§ 21–22, 35 Stat. 1075, 1080 (codified as amended at 17 U.S.C. §§ 22–23 in 1947, repealed 1978). As originally enacted, the foreign edition had to be deposited within thirty days of publication in the foreign country, and the *ad interim* copyright lasted only thirty days, which did not provide enough time to get a new edition published in the United States. *Id.* § 21. In 1919, Congress amended the statute to provide that the foreign edition could be deposited within sixty days of the foreign publication, and the *ad interim* copyright would last for four months. Pub. L. No. 66-102, 41 Stat. 368, 369. In 1949, Congress again amended the statute to provide that the foreign edition could be deposited within six months of the foreign publication, and the *ad interim* copyright would last for five years. Pub. L. No. 81-84, § 2, 63 Stat. 153, 154 (codified at former 17 U.S.C. § 22, repealed 1978). In the 1976 Act, Congress eliminated *ad interim* protection and instead gave an alleged infringer a defense if foreign-made copies were imported or distributed by the copyright owner in violation of the manufacturing clause and the infringing copies were manufactured in the United States or Canada. Pub. L. No. 94-553, § 601(d), 90 Stat. 2541, 2589 (repealed 2010).

117. According to one scholar, the combination of the *ad interim* provisions and copyright “has made it almost impossible to determine with certainty whether a book published in the United States after 1922 and before 1964 is in the public domain.” Peter B. Hirtle, *Copyright Renewal, Copyright Restoration, and the Difficulty of Determining Copyright Status*, D-LIB MAG., (July/Aug. 2008), <http://www.dlib.org/dlib/july08/hirtle/07hirtle.html>.

118. See 17 U.S.C. § 301(c) (2006).

January 1, 1996.¹¹⁹ In most countries, sound recordings are not protected by “copyright,” or author’s rights, but are instead accorded protection under so-called “neighboring rights.”¹²⁰ Indeed, sound recordings are not protected under the Berne Convention, but are instead the subject of a separate treaty, the Rome Convention, to which the United States is not a party.¹²¹ The United States, however, is a party to the Geneva Convention for the Protection of Producers of Phonograms,¹²² as well as the TRIPS Agreement and the World Intellectual Property Organization (“WIPO”) Performances and Phonograms Treaty (“WPPT”).¹²³ Under the Rome Convention and the Geneva Convention, sound recordings are protected for a minimum of only twenty years from the date of fixation (for Rome) or the date of first publication (for Geneva).¹²⁴ However, under the TRIPS Agreement, sound recordings are protected for at least fifty years from the date of fixation;¹²⁵ and under the WPPT, sound recordings are protected for at least fifty years from the date of first publication, if they are published within fifty years of fixation.¹²⁶ Thus, sound recordings from most foreign countries are eligible if they were fixed (or published) between January 1, 1946, and February 14, 1972.¹²⁷

119. *Id.* § 104A(h)(6)(B), (h)(6)(C)(ii).

120. See GOLDSTEIN & HUGENHOLTZ, *supra* note 13, § 2.2.2, at 22; 2 SAM RICKETSON & JANE C. GINSBURG, INTERNATIONAL COPYRIGHT AND NEIGHBOURING RIGHTS: THE BERNE CONVENTION AND BEYOND §§ 19.01–19.04, at 1205–10 (2d ed. 2006) (introducing the background and development of the “neighbouring right” concept).

121. See International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations, Oct. 26, 1961, 496 U.N.T.S. 43, available at http://www.wipo.int/treaties/en/ip/rome/trtdocs_wo024.html [hereinafter Rome Convention]; *Contracting Parties*, WORLD INTELLECTUAL PROP. ORG., http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=17 (last visited Sept. 20, 2011) (listing contracting parties to the Rome Convention).

122. See Convention for the Protection of Producers of Phonograms Against Unauthorized Duplication of Their Phonograms, Oct. 29, 1971, 25 U.S.T. 309, 888 U.N.T.S. 67, available at http://www.wipo.int/treaties/en/ip/phonograms/trtdocs_wo023.html [hereinafter Geneva Convention]; *Contracting Parties*, WORLD INTELLECTUAL PROP. ORG., http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=18 (last visited Sept. 20, 2011) (listing contracting parties to the Geneva Convention).

123. See WIPO Performances and Phonograms Treaty, Dec. 20, 1996, S. Treaty Doc. No. 105-17, available at http://www.wipo.int/treaties/en/ip/wppt/trtdocs_wo034.html [hereinafter WPPT]; *Contracting Parties*, WORLD INTELLECTUAL PROP. ORG., http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=20 (last visited Sept. 20, 2011) (listing contracting parties to the WPPT).

124. Rome Convention, *supra* note 121, art. 14; Geneva Convention, *supra* note 122, art. 4.

125. TRIPS Agreement, *supra* note 46, art. 14(5).

126. WPPT, *supra* note 123, art. 17(2).

127. If the source country protects sound recordings for fifty years rather than twenty years, then a sound recording fixed or published in its source country in 1946 or later would not be in the public domain in its source country on January 1, 1996, the date of restoration.

This category includes such important sound recordings as all of the recordings of the Beatles, *Tommy* by The Who, early recordings by Led Zeppelin (“Stairway to Heaven”), the Rolling Stones, and Pink Floyd, and the best-selling classical album of all time, a complete recording of Wagner’s four-opera *Ring of the Nibelungen* cycle, conducted by Georg Solti.¹²⁸ As of January 1, 1996, these foreign sound recordings received federal copyright protection in the United States for the first time.¹²⁹ However, this category of works cannot truly be said to have been “removed” from the public domain. This is because federal copyright law does not (and will not) preempt state-law protection for sound recordings until February 15, 2067,¹³⁰ and most states likely will protect foreign as well as domestic sound recordings under their common law.¹³¹ Thus, intentionally or not, section 514 arguably resulted in these foreign sound recordings having *both* state and federal protection. If the Supreme Court holds that section 514 is unconstitutional, these sound recordings will remain protected (and therefore out of the public domain) as a matter of state law. In other words, for this category, the decision in *Golan* will have no practical effect.

The third category consists of works from those eligible countries with whom the United States did not have any copyright relations until sometime after January 1, 1923, and that were not in the public domain in their source countries on January 1, 1996.¹³² While the United States has long had copyright treaty relations with its major trading partners in Western Europe and Latin America,¹³³ this category includes all works published (after 1922) in Russia and

128. See NORMAN LEBRECHT, *THE LIFE AND DEATH OF CLASSICAL MUSIC: FEATURING THE 100 BEST AND 20 WORST RECORDINGS EVER MADE* 136, 209–11 (2007) (describing Solti’s eighteen-million-selling recording).

129. 17 U.S.C. § 104A(a)(1)(A) (2006).

130. *Id.* § 301(e).

131. See, e.g., *Capitol Records, Inc. v. Naxos of Am., Inc.*, 830 N.E.2d 250, 265 (N.Y. 2005) (holding that all sound recordings are entitled to *perpetual* protection under New York common law until federal preemption occurs, even if they are in the public domain in their country of origin).

132. 17 U.S.C. § 104A(h)(6)(B), (h)(6)(C)(iii) (2006).

133. The United States established bilateral copyright relations with Belgium, France, the United Kingdom, and Switzerland on July 1, 1891, with Germany on April 15, 1892, with Italy on October 31, 1892, with Spain on July 10, 1895, with Mexico on February 27, 1896, with Chile on May 25, 1896, with Costa Rica on October 18, 1899, with Japan on May 10, 1906, with Canada on January 1, 1924, and with Argentina on August 23, 1934. The United States joined the Buenos Aires Convention effective July 13, 1914, through which copyright relations were established with Bolivia, Brazil, Costa Rica, Cuba, the Dominican Republic, Ecuador, Guatemala, Haiti, Honduras, Nicaragua, Panama, Paraguay, Peru, and Uruguay before 1923, and with Colombia on December 23, 1936. U.S. COPYRIGHT OFFICE, *CIRCULAR NO. 38A: INTERNATIONAL COPYRIGHT RELATIONS OF THE UNITED STATES* 2–10 (2010).

the countries of the former Soviet Union before May 27, 1973;¹³⁴ in the People's Republic of China before March 17, 1992;¹³⁵ in Hong Kong before August 1, 1973;¹³⁶ in Singapore before May 18, 1987;¹³⁷ in South Korea before October 1, 1987;¹³⁸ in North Korea before April 28, 2003;¹³⁹ and in Turkey and the former Yugoslavian states before March 1, 1989,¹⁴⁰ among other countries. Important works in this category include most of the works of twentieth century Russian composers Sergei Prokofiev, Dmitri Shostakovich, and Igor Stravinsky,¹⁴¹ and Russian films such as Sergei Eisenstein's *The Battleship Potemkin* and *Alexander Nevsky*.¹⁴²

The immediate effect of *Golan* will be to determine whether all of these works (and thousands of others) validly had their copyrights restored in 1996, or whether they are all (once again) in the public domain in the United States. The long-term impact of the opinion, however, may be even greater.

134. *Id.* at 9, 11 n.2.

135. *Id.* at 3, 11 nn.5–6.

136. *Id.* at 4, 11 n.13.

137. *Id.* at 9.

138. *Id.* at 5.

139. *Id.* Because North Korea joined the Berne Convention after 1996, the effective date of copyright protection for preexisting works would be the date of its accession (Apr. 28, 2003). 17 U.S.C. § 104A(h)(2)(B) (2006).

140. The former Yugoslavian states are Bosnia and Herzegovina, Croatia, Macedonia, Montenegro, Serbia, and Slovenia. U.S. COPYRIGHT OFFICE, *supra* note 133, at 3, 5, 8–9. Both Turkey and Yugoslavia were members of the Berne Convention before the United States joined. *See id.* at 9 (Turkey); World Intellectual Property Organization, Berne Notification No. 75, Ratification by the Socialist Federal Republic of Yugoslavia of the Paris Act (1971), June 2, 1975, available at http://www.wipo.int/treaties/en/notifications/berne/treaty_berne_75.html (last visited Sept. 20, 2011). Hence, works published in these countries after the United States joined the Berne Convention on March 1, 1989, are not in the public domain and did not need to be restored.

141. *See, e.g.*, Complaint, *supra* note 68, ¶¶ 56, 66, 69–71, 76.

142. These films were first published in 1925 and 1938, respectively. *See* www.imdb.com/title/tt0015648 and www.imdb.com/title/tt0029850. In 1925, the former Soviet Union had a copyright term of twenty-five years from first publication, which was increased to life of the author plus fifteen years in 1928, and to life of the author plus twenty-five years in 1973. *See* MICHIEL ELST, COPYRIGHT, FREEDOM OF SPEECH, AND CULTURAL POLICY IN THE RUSSIAN FEDERATION 74–76, 81–83 (2005). Eisenstein died in 1948, and because the 1973 law was not retroactive, *id.* at 527, these films were in the public domain in the Soviet Union from 1964 onward. After the breakup of the Soviet Union, however, the Russian Federation enacted a new copyright law in 1993 that has a duration of life of the author plus fifty years. *Id.* at 393, 436. Because the 1993 law was retroactive, *id.* at 525–35 (analyzing the problem and concluding that retroactive application was intended), the films were no longer in the public domain in Russia on January 1, 1996, the date of restoration.

B. Future Implications

Ultimately, what is at stake in *Golan* is nothing less than the entire corpus of works in the public domain, and even the entire concept of a public domain. If the Court holds that the Patent and Copyright Clause or the First Amendment prohibits removal of material from the public domain, then the public domain will indeed be irrevocable, and the public will have a bright-line constitutional safeguard against future incursions by Congress.¹⁴³ If the Court holds that material may be removed from the public domain, but only for specified reasons or only within certain limits, then any future congressional action regarding the public domain will at least be subject to constitutional challenge. But if the Court holds that Congress has the discretion to remove material from the public domain whenever it chooses, the potential future consequences will be staggering.

If Congress can validly take any work out of the public domain and put it back under copyright protection, then there is nothing to keep Congress from taking *all* works out of the public domain and putting them back under copyright protection. The works of Shakespeare, Beethoven, Jane Austen, Mark Twain, and millions of other long-deceased authors could be privatized and become the private property of a particular publisher,¹⁴⁴ just as they were before the House of Lords' landmark decision in *Donaldson v. Becket*,¹⁴⁵ which recognized the public domain for the first time in Anglo-American jurisprudence.¹⁴⁶ Moreover, the "limited Times" restriction in the Patent and Copyright Clause will be rendered a dead letter. In

143. See Transcript of Oral Argument at 43–44, *Eldred v. Ashcroft*, 537 U.S. 186 (2003) (No. 01-618), available at http://www.supremecourt.gov/oral_arguments/argument_transcripts/01-618.pdf ("Question [Justice Souter]: If the equity argument under the Necessary and Proper Clause justifies extension of the copyright for those whose copyright will expire tomorrow if it's not extended, in order to put them on parity with those getting copyrights for new works, why doesn't it apply to the copyright, the holder of the copyright that expired yesterday? General Olson [for the Government]: You could arguably—you could conceivably make that argument, Justice Souter, but there is a bright line there. Something that has already gone into the public domain, which other individuals or companies or entities may then have acquired an interest in, or rights to, or be involved in disseminating . . .").

144. See *id.* at 29–30 ("Question [Justice Breyer]: [I]f Congress tomorrow wants to give a copyright to a publisher solely for the purpose of reproducing and disseminating Ben Jonson, Shakespeare, it can do it? General Olson [for the Government]: It may . . . I don't think there is a per se rule that should apply here because this is a grant of Congress, to Congress to exercise its judgment as to what may be beneficial.").

145. [1774] 98 Eng. Rep. 257 (H.L.) (appeal taken from Eng.).

146. See Ochoa, *supra* note 1, at 223–24; Tyler T. Ochoa & Mark Rose, *The Anti-Monopoly Origins of the Patent and Copyright Clause*, 49 J. COPYRIGHT SOC'Y U.S.A. 675, 682–84 (2002).

Eldred, the majority responded to the argument that copyright term extension would effectively allow “perpetual copyright on the installment plan”¹⁴⁷ by stating that there was no evidence that Congress was attempting to protect copyrights in perpetuity.¹⁴⁸ But if Congress can restore copyrights, there is no need for copyright term extension: Congress can simply allow the “limited Times” to expire and then restore the copyrights in the works for another “limited Time” the following day.

Perhaps these scenarios seem far-fetched—although in a political system that relies on checks and balances, we should be loath to accept that nothing more than congressional forbearance and good sense will protect the public domain from significant depletion. But there is one scenario that is anything but far-fetched: if the Court upholds copyright restoration for foreign works, and the opinion in any way states or implies that failure to comply with the “formalities” formerly imposed under U.S. law does not irrevocably place works into the public domain in a way that implicates the Constitution, then Congress will come under tremendous pressure from domestic copyright owners to give them the benefit of the same bargain that was given to foreign copyright owners in 1996. Domestic copyright owners will cry that it is “unfair” to give significant benefits of copyright restoration to foreign copyright owners without affording the same benefit to U.S. copyright owners, and domestic reliance parties will be hard-pressed to explain why the line should be drawn here. The result will very likely be that the eighty-five to ninety percent of all works that were not renewed between 1923 and 1963, and the tens of thousands of works that were published without proper copyright notice, will once again be placed under copyright protection. The temptations for putative copyright owners to earn monopoly profits are simply too great. Public choice theory suggests that a small minority with a lot of money to gain will consistently be more successful in lobbying Congress than a diffuse majority that will

147. Peter Jaszi, *Caught in the Net of Copyright*, 75 OR. L. REV. 299, 303 (1996). The phrase originated in Jaszi’s testimony to Congress in 1995. *The Copyright Term Extension Act of 1995: Hearing Before the S. Comm. on the Judiciary*, 104th Cong. 73 (1995) (statement of Peter Jaszi, Professor, American University Washington College of Law).

148. *Eldred v. Ashcroft*, 537 U.S. 186, 208–10 (2003). *But see id.* at 242 (Stevens, J., dissenting) (“[A] categorical rule prohibiting retroactive extensions would effectively preclude perpetual copyrights. More importantly, . . . unless the Clause is construed to embody such a categorical rule, Congress may extend existing monopoly privileges *ad infinitum* under the majority’s analysis.”); Ochoa, *supra* note 40, at 45 & n.150 (quoting Rep. Mary Bono, who expressly sought a copyright term of “forever less one day”).

each lose only a small amount of money with each transaction,¹⁴⁹ even though the net result will be a congressional giveaway of billions of dollars of public property to private ownership.

VI. CONCLUSION

For the first two hundred years of our history, copyright was a relatively short-term proposition: some works entered the public domain immediately upon publication, if the author or publisher failed to comply with the prescribed statutory formalities; the vast majority of works entered the public domain after only fourteen or twenty-eight years; and a small percentage of financially lucrative works were renewed and received a total of twenty-eight, forty-two, or fifty-six years of copyright protection before entering the public domain.¹⁵⁰ Each year, the public received the benefit of new works entering the public domain, where they would remain irrevocably.¹⁵¹ Today, copyright lasts for the life of the author plus seventy years—likely three or four generations for most works.¹⁵² Virtually no one will live to see the favorite works of their childhood enter the public domain, and no published works will enter the public domain again until 2019.¹⁵³ Indeed, the very notion of the public domain as a repository of works existing for the benefit of the public is under attack.

In *Golan v. Holder*, the plaintiffs are challenging only one piece of Congress's assault on the public domain: the grant or restoration of copyright protection to foreign works that were previously in the public domain. The Supreme Court will decide whether the public domain will remain irrevocable and inviolate, or whether it exists only at the whim and forbearance of Congress and can be taken away from the public and privatized at any time.

149. On public choice theory as applied to copyright, see Tyler T. Ochoa, *Copyright Duration: Theories and Practice*, in 1 INTELLECTUAL PROPERTY AND INFORMATION WEALTH 133, 138 (Peter K. Yu ed., 2007).

150. The 1790 Act had a fourteen-year term, renewable once; the 1831 Act had a twenty-eight-year initial term, with a fourteen-year renewal term; and the 1909 Act had a twenty-eight-year term, renewable once. Ochoa, *supra* note 40, at 29–32, 38–39. *See also supra* notes 17–22, 40–41 and accompanying text.

151. *See supra* note 6 and accompanying text.

152. 17 U.S.C. § 302(a) (2006).

153. *See supra* note 58.