Zombie Copyrights: Copyright Restoration Under the New 104A of the Copyright Act

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ZOMBIE COPYRIGHTS: COPYRIGHT RESTORATION UNDER THE NEW § 104A OF THE COPYRIGHT ACT*

Adam P. Segal†

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I. INTRODUCTION

Overprotecting intellectual property is as harmful as underpro-
tecting it. Creativity is impossible without a rich public domain.
Nothing today, likely nothing since we tamed fire, is genuinely
new: Culture, like science and technology, grows by accretion,
each new creator building on the works of those who came before.
Overprotection stifles the very creative forces it's supposed to
nurture.¹

Even those wholly without formal legal education are likely to
have a basic understanding of one important aspect of U.S. copyright
law: Copyrighted works are protected for some period of time after
which copyright expires and anyone may use the work without pay-
ning the owner of the expired copyright. Many also refer to this as falling
into the public domain; a domain of creative works from which
the public is free to draw. Widespread common knowledge of this
concept is a testament to its fundamental nature. Copyrights exist for
a time and then they expire.² The new § 104A of the U.S. Copyright
Act alters this fundamental characteristic and, in effect, provides that
certain copyrights, though lost and committed to the public domain,
have been resurrected as of January 1, 1996.³

The restoration of copyrights effects a major shift in the balance
between the monopoly that is copyright and the public's access to
creative works. Previously, once a work fell into the public domain
anyone was free to use it without concern or obligation to the copy-
right owner. In exchange for a monopoly, limited by time, the author
would commit his work to the public after that time expired. How-
ever, the duration of copyright could be cut short if an author did not
comply with various formalities of the U.S. Copyright Acts,⁴ such as
affixing copyright notice or executing a renewal application. Many of

¹ White v. Samsung Electronics Am., Inc., 989 F.2d 1512, 1513 (9th Cir. 1993)
(Kozinski, J. dissenting from the order rejecting the suggestion for rehearing en bane).

² Fred Koenigsberg, Copyrights, 7 KIRK-OTHMER ENCYCLOPEDIAS OF CHEMICAL
TECHNOLOGY (4th ed.), reprinted in PRACTISING LAW INSTITUTE, UNDERSTANDING BASIC
COPYRIGHT LAW 1995 7 (1995) ("Under United States law, a work is either protected
("copyrighted"), or unprotected and free for all to use (in the "public domain"). Once a work
enters the public domain, it cannot thereafter be recovered and protected again.") (hereinafter
Koenigsberg).

³ Although the U.S. Copyright Office has declared January 1, 1996, to be the date of
restoration (see Appendix B) at least one court has held that the date of restoration was a year

⁴ The plural refers to the major revisions that occurred in 1831, 1870, 1909, and 1976.
See Koenigsberg, supra note 2 at 6.
those copyrights that were cut short belonged to foreign authors unfamiliar with the intricacies of U.S. copyright law.\(^5\) Current political and economic considerations require the United States to recognize these foreign copyrights so that U.S. authors will be sure to receive reciprocal protection outside the United States. It is this concern for reciprocal protection that spurred the creation of § 104A.

Congress' enactment of § 104A may have been necessary to receive reciprocal protection and even commendable in light of the harsh effects of copyright formalities. However, its execution leaves much to be desired. Section 104A is complex, poorly-drafted, convoluted and in some cases contains clear mistakes.\(^6\) Nonetheless, copyright owners and legal practitioners must endeavor to understand how copyright restoration works.\(^7\) If not, many who freely use works in reliance on their public domain status will find themselves in court defending infringement suits. And those who may claim the restored copyrights, but do not understand § 104A, will not benefit from this new source of revenue.

This article will first survey, in Part II, the development of formalities in U.S. copyright law. Part III will then focus on two of the most problematic formalities for foreign authors: notice and renewal applications. Part IV will take a step-by-step walk through the new law. The purpose of this article is to give the reader an understanding of copyright formalities and the public domain, and to provide a practical guide to § 104A for claimants of restored copyrights and those using the works in reliance on their public domain status.

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5. 103 CONG. REC. 2,263 (daily ed. Oct. 8, 1994) (Rep. William J. Hughes explains: "Because of the United States unique history of depriving authors of their copyrights for failure to comply with formalities, there are works of foreign Berne origin that are in the public domain in the United States for reasons other than expiration of term."). See also Alan J. Hartnick, GATT Copyright Restoration: Loss for Public Domain for Benefit of Trade Policy, N.Y. L.J., Jan. 27, 1995, at 5.

6. Jon A. Baumgarten & Eric J. Schwartz, Summary Outline of the Copyright Restoration Provisions of the Uruguay Round Agreements Act, in UNDERSTANDING BASIC COPYRIGHT 1995, supra note 2, at 127 ("The copyright restoration provisions of the Uruguay Round Agreements Act are quite detailed, complex in relevant points, and in some cases subject to anticipated clarification or correction.").

7. See Hartnick, supra note 5: [The United States, in a trade-driven policy, adopted a full-scale copyright restoration under GATT of all works throughout the world . . . that had fallen into the public domain in the United States because of non-compliance with formalities. It will be difficult, indeed, to determine the copyright status of many foreign works except to assume copyright ownership and validity. Every entertainment and copyright lawyer must have some notion of the profound effects of this new law.]}
II. The Development of Copyright Formalities in United States Law

A. Constitutional Grant of a Limited Monopoly

United States Copyright law derives from the Constitution, which grants Congress the power "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." Copyright has not always been a limited right, however. As early copyright law developed it was initially perpetual. Protected works did not fall into the public domain after some specific period of protection. This is probably because the earliest copyrights were not statutorily created, but instead were regarded as property rights that were "peculiarly one's own."

B. The Statute of Anne and Its Progeny

Modern copyright is limited to fixed terms, which expire leaving the work in the public domain. In U.S. law, whether expiration occurs naturally (at the end of a complete term of copyright) or prematurely has depended, in the past, largely on compliance with copyright formalities. Foreign authors often lost their U.S. copyrights because many authors did not understand the complex web of formalities in U.S. law. Both the terms of copyright and the formalities in U.S. law grew out of the English Statute of Anne.

In an effort to concentrate and control the ability to publish, Queen Mary and King Philip granted a royal charter, including complete control over the printing industry, to the Worshipful Company of Stationers of England in 1557. The Stationers' complete control
was gradually diminished, and on April 10, 1710, the Statute of Anne was passed by the English Parliament. The Statute of Anne gave authors an exclusive right to publish for 14 years and a possible 14 year renewal term if the author was living. Despite this, when the first term expired the Stationers Company still asserted perpetual copyright protection and many lower courts supported this view. The Statute, they asserted, merely granted additional rights and remedies. In 1774, however, in Donaldson v. Becket, the House of Lords ruled that the term of copyright protection did in fact expire at the end of the 14 or 28-year term. The Statute also provided for registration of works and later for notice of copyright to be placed on each copy of a work.

The Statute of Anne would become the model for the first U.S. Copyright Act. On May 31, 1790, President Washington signed into law "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." The Copyright Act of 1790 granted an initial term of protection lasting 14 years, and a renewal term of 14 years, to the author or her assigns, if the author was then living. Registration was required at the initiation of each term. There was no requirement that copyright notice be affixed to each copy; publication of the registration was, however, required. Also, copies of the work had to be deposited with the Secretary of State prior to publication. The 1790 Act did not protect foreign authors or their works.

In 1802 the Act was amended to require copyright notice on all publicly distributed copies. Failure to affix such a notice would inject the work into the public domain and forfeit all federal copyright protection. The 1831 general revision of the Act extended copyright protection to musical works. Also, the initial term of copyright was extended to 28 years, though the renewal term remained 14 years. The renewal term, however, could no longer be secured by an as-
signee of the author. This right was now restricted to the author or his family. Copyright notice was simplified but still required, although publication of the registration was not.

Not until 1891 were the works of foreign authors protected under U.S. copyright law. The International Copyright Act was enacted on March 3, 1891. This Act protected foreign authors, provided that (1) their country was a signatory to an agreement that provided reciprocity of protection to U.S. authors, (or “the President . . . determined that U.S. authors were provided copyright protection in the foreign author's country on substantially the same basis as the country extended protection to the works of their own citizens),” (2) they complied with all the formalities of U.S. law, and (3) foreign authors and artists had their works printed or typeset within the United States.

The 1909 Copyright Act made several important changes. The renewal term was extended from 14 to 28 years, providing a total possible term of 56 years. The new Act also provided provisions for curing an improper copyright notice. But the 1909 Act did not do away with the formal requirements of notice, deposit, and registration, and foreign authors were still required to comply with all of these formalities. One author criticized the 1909 Act as follows: “On balance, the 1909 Act continued the lamentable American tendency of retaining the early-eighteenth-century English formalities long after the English had moved to a more continental approach. By so doing, the United States deliberately stood outside the international copyright community for almost 50 years . . . .”

Some of these formalities were eased in 1954 when the Universal Copyright Convention (UCC) was passed. Members of signatory countries no longer were required to deposit their works in the United States to receive protection here. Nor did they need to manufacture their works within the United States. However, copyright notice was still required under the UCC; specifically, proper notice required the © symbol followed by the year and the name of the claimant.

Although the Copyright Act of 1976 is the current law, the 1909

22. 1 PATRY, supra note 9, at 48-50.
23. Id. at 48.
24. Id. at 59.
25. Id.
26. Id. at 59-60.
27. Id. at 61.
28. See id. at 68-69.
29. Id. at 69.
Act still governs works published prior to January 1, 1978. Those works may be protected, in the longest case, until 2052 (1977 plus 75 years). Because of this the 1909 Act is alive and well despite the major revision of U.S. copyright law in 1976.

C. The Current State of Copyright Formalities in United States Law

The Copyright Act of 1976, the current U.S. law, became effective on January 1, 1978, and governs all works first created and fixed in a tangible medium of expression after that time. Works created but not published before January 1, 1978, are also governed by the 1976 Act. Perhaps the most important change brought about by the Copyright Act of 1976 is the adoption of a single copyright term that lasts for the life of the author plus 50 years. Because of the single term, there is no longer any renewal requirement for works governed by the 1976 Act. This eliminates any danger of falling into the public domain for failure to file a renewal application for post-1977 works. The new Act also continued the provisions for curing a publication without proper copyright notice, although copyright notice was still required.

The requirement that copyright notice “shall be placed on all publicly distributed copies” was finally amended (by the 1988 amendment, effective March 1, 1989) to make copyright notice optional and not mandatory. This was the date that the Berne Convention entered into force in the United States. The Berne Convention is an international copyright treaty that seeks to harmonize international copyright law. Article 5 section 2 of Berne provides that “The enjoyment and the exercise of these rights shall not be subject to any formality . . . .” When the United States became a Berne signatory it was necessary to eliminate the requirement of copyright notice to maintain copyright protection. However, works distributed prior to

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32. Id. § 302(a).
33. See infra Part III.B.
36. 1 PATRY, supra note 9, at 100.
37. Id.
38. See Garnier v. Andin International, 36 F.3d 1214, 1219 (1st Cir. 1994).
March 1, 1989, were still subject to the notice requirement. The 1988 amendment was a significant easing of copyright formalities in U.S. law.

The 1992 amendment also eased copyright formalities, but this time it was the renewal provisions under the 1909 Act that were relaxed. This amendment provided that for works published between January 1, 1964, and December 31, 1977, it was no longer necessary to file a renewal application in order to preserve copyright protection for the renewal term. For these works the renewal term commenced automatically.

Thus, U.S. copyright law has steadily moved away from the formal requirements borrowed from old English law: Today, copyright registration, deposit, renewal, and notice are no longer requirements for securing copyright protection. But along the way many works fell into the public domain due to failure to comply with these formalities. The next part of this article examines two of the most problematic formalities: copyright notice and renewal application.

III. TWO MAJOR FORMALITIES THAT CUT SHORT COPYRIGHT DURATION

A. Publication Without Proper Copyright Notice

Until adherence to the Berne Convention in 1989 U.S. copyright law required that each copy of a work distributed to the public be marked with a copyright notice. Failure to do so would inject the work into the public domain. This requirement in U.S. law comes from the English Statute of Anne. The idea of giving copyright notice on each copy is not exclusive to the English copyright system. As far back as 1511, the German author Dürer placed the following no-

40. See infra Part III.A.
41. 1 PATRY, supra note 9, at 108-109.
43. 17 U.S.C. § 401 (1988); Koenigsberg, supra note 2, at 21:
   In the past, the law contained an absolute requirement that each copy of a published work bear a proper copyright notice. This notice formality was a major trap for unawary copyright owners. Failure to comply with the technicalities of the law's notice provisions resulted in the unintentional loss of protection for many works.
44. Unless the inadequacy or omission of notice could be cured. 17 U.S.C. § 405 (1988).
45. See supra Part II.B.
tice on his work:

Hold! You crafty ones, strangers to work, and pilferers of other men's brains. Think not rashly to lay your thievish hands upon my works. Beware! Know you not that I have a grant from the most glorious Emperor Maximilian, that not one throughout the imperial dominion shall be allowed to print or sell fictitious imitations of these engravings? Listen! And bear in mind that if you do so, through spite or through covetousness, not only will your goods be confiscated, but your bodies also placed in mortal danger. 46

By comparison, the © symbol appears quite benign. However, the required compliance with the notice provision in U.S. law (and under the Universal Copyright Convention) was strict. Attempts to cure defective notices were not always successful, as the following cases illustrate.

In Ross v. New York Merchandise, 47 a U.S. company (plaintiff) released its inflatable figure of a baseball catcher in Japan. Japan and the United States are, and were at the time this case arose, signatories to the Universal Copyright Convention. 48 Both U.S. law in 1964 and the UCC required copyright notice in the form of a © symbol, the date, and name of the claimant. 49 The plaintiff's toy had a tag attached to it that was written in Japanese and when translated did contain the word "copyright" followed by a number. 50 The number was not the date but instead a patent number for the toy's material. 51 Further, the tag did not contain the claimant's name. 52 The defendant saw the toy at a toy fair and then produced identical toys. 53 The court held that the plaintiff's toy was in the public domain because, as a U.S. proprietor, he was governed by U.S. law, which required proper copyright notice. 54 Also, even if plaintiff had been Japanese, the tag did not comply with the UCC's notice provisions either. 55 Neither the fact that the tag contained the word "copyright" nor that the toy was not released in the U.S. could save plaintiff's toy from the public domain.

46. Reprinted in 1 PATRY, supra note 9, at 5.
48. Id.
49. Id. at 262.
50. Id.
51. Id.
52. Id.
53. Id. at 261.
54. Id. at 263.
55. Id. at 262.
domain.

One who publishes his work without proper copyright notice may be able to cure the defective notice. Cure provisions were included in the 1909 Act and may be found in the 1976 Act in § 405(a). The 1988 amendment to the 1976 Act removed the mandatory requirement of copyright notice. The case of Garnier v. Andin examines a situation where a copyrightable work was first distributed before March 1, 1989, (the effective date of the 1988 amendment) and continued to be distributed after that time without copyright notice. The plaintiff, in Garnier, manufactured a swirled hoop earring from 1988 through 1992. Not until 1992 did the plaintiff register the earring and begin affixing copyright notice. Section 405(a)(2) provides that inadequate copyright notice may be cured if: "[R]egistration for the work has been made before or is made within five years after the publication without notice, and a reasonable effort is made to add notice to all copies or phonorecords that are distributed to the public in the United States after the omission has been discovered . . . ."

Plaintiff attempted to cure the defective notice on those copies distributed prior to the amendment by (1) sending a letter to its 50 largest retailers which informed them of the earrings' copyright status and (2) providing all its retailers with a card, which contained notice and was meant to accompany the earrings when they were sold. The court found that the letter did not instruct the retailers to attach any copyright notice to the earrings and the cards themselves were not meant to attach to the earrings. The result was that despite registering the earrings within 5 years of publication and the 1988

56. Nanette Petruzzelli, Copyright Registration Issues, reprinted in UNDERSTANDING BASIC COPYRIGHT LAW, supra note 2, at 43:

   For works published between January 1, 1978 and March 1, 1989, the omission of the required copyright notice from copies publicly distributed will not invalidate the copyright if registration has been made before or is made within 5 years of the date of publication without notice and reasonable effort is made to add the notice after the omission has been discovered.

(emphasis in original)

58. Id.
59. Garnier v. Andin Int'l, 36 F.3d 1214 (1st Cir. 1994).
60. Id.
61. Id. at 1216-17.
63. Garnier, 36 F.3d at 1227.
64. Id.
amendment to the Copyright Act ending mandatory notice, plaintiff’s earrings were in the public domain.\textsuperscript{65}

The preceding two cases illustrate the draconian results of the strict notice requirements previously contained in U.S. copyright law. Despite the attempts of the American plaintiff in \textit{Ross} to comply with the requirements, it lost its copyrights to the public domain. Certainly, foreign proprietors like the plaintiff in \textit{Garnier}, who are less familiar with U.S. law were more likely to lose their copyrights for failure to comply with the notice provisions. Now such works may be restored under \S\ 104A.

\textbf{B. Failure to File a Renewal Registration}

Under the 1909 Act, which governs works published prior to January 1, 1978, U.S. copyright protection consisted of an initial term of twenty-eight years followed by a renewal term of twenty-eight years.\textsuperscript{66} The renewal term was extended to forty-seven years for works that were still protected in 1962.\textsuperscript{67} For those works that were first published before 1964 renewal was not automatic and copyright claimants were required to file a renewal application with the copyright office.\textsuperscript{68} Failure to do so would cause the work to fall into the public domain after only twenty-eight years of protection.\textsuperscript{69}

This requirement proved to be the downfall of many foreign works. The Italian film \textit{Ladri Di Biciclette (The Bicycle Thief)} provides one example. \textit{The Bicycle Thief} was first published in Italy on December 6, 1948.\textsuperscript{70} At that time, the film was published with a proper U.S. copyright notice, thereby triggering the initial twenty-eight year term.\textsuperscript{71} It was not necessary that \textit{The Bicycle Thief} be published in the United States to establish U.S. copyright protection.\textsuperscript{72} On December 6, 1976, the initial twenty-eight year term expired.\textsuperscript{73} In order to secure the renewal term, a valid renewal application had to

\begin{itemize}
\item[\textsuperscript{65}] Id. at 1228.
\item[\textsuperscript{66}] ROBERT A. GORMAN & JANE C. GINSBURG, COPYRIGHT FOR THE NINETIES 330-331 (4th ed. 1993).
\item[\textsuperscript{67}] Id.
\item[\textsuperscript{68}] Id.
\item[\textsuperscript{69}] Id.
\item[\textsuperscript{71}] Id. at 634 and n.7.
\item[\textsuperscript{72}] Id.
\item[\textsuperscript{73}] Id. at 635.
be filed during the year prior to expiration of the initial term.\textsuperscript{74} However, no valid renewal application was filed for \textit{The Bicycle Thief}, and it fell \textquote{irrevocably [into] the public domain upon the expiration of the initial term of copyright.}\textsuperscript{75} Under § 104A, copyright in \textit{The Bicycle Thief} has likely been resurrected.

Beginning in 1964, renewal became automatic.\textsuperscript{76} A filing is no longer necessary to continue copyright protection. Further, works created from January 1, 1978, to the present have a single term of protection, life of the author plus fifty years, or seventy-five years total in the case of works made-for-hire.\textsuperscript{77} There is no longer an initial term and a renewal term. Therefore, by 1991 (1963 plus twenty-eight years) all works for which a renewal filing was required to continue copyright had either been renewed by filing or had fallen into the public domain.\textsuperscript{78} Now, however, those works that were not renewed may be restored, if eligible, pursuant to § 104A. In fact, \textit{The Bicycle Thief} is an excellent example of a potentially restored copyright that may be claimed under the new law; if so, it will enjoy protection until 2023 (1948 plus seventy-five years).\textsuperscript{79}

\textsuperscript{74} Id.

\textsuperscript{75} Id. at 635 (emphasis added). Of course, the court's observation was based on pre-restoration law. Italy has had a formal copyright relationship with the United States since the late 1800s. See 17 U.S.C. §104 (1988) (list of treaties and conventions contained in the annotations following the section text). Therefore, \textit{The Bicycle Thief} was restored on January 1, 1996, to the remainder of its 75-year term, which expires in 2023 (1948 + 28-year initial term = 1976; 1976 + 47-year renewal term = 2023). See generally \textit{Gorman & Ginsburg, supra} note 66, at 330-31 (for a helpful copyright duration chart). Note, however, that like most restored works, \textit{The Bicycle Thief} may not have been claimed yet. Very few owners of restored copyrights have yet to take advantage of the copyright office's published notice system. Seth Goldstein, \textit{Demand for Reclaiming Foreign C'rights Less Frenzied Than Expected, BILLBOARD}, June 8, 1996. A copyright renewal application was filed for \textit{The Bicycle Thief}. However, it was filed by a licensee, who claimed the renewal in its own name. 621 F. Supp. at 635. To be valid, a renewal must be claimed in the name of the author. Id. at 636.

\textsuperscript{76} \textit{Gorman & Ginsburg, supra} note 66, at 330-31; \textit{Copyright Office Circular 15, reprinted in UNDERSTANDING BASIC COPYRIGHT 1995, supra} note 2, at 66:

\textit{Works copyrighted between January 1, 1964, and December 31, 1977, are affected by P.L. 102-307 which extends automatically the term of copyright and makes renewal registration optional. The term of copyright in works copyrighted between January 1, 1964, and December 31, 1977, is 75 years. There is no requirement to register a renewal in order to extend the original 28-year copyright term to the full term of 75 years. There are, however, benefits that derive from making a renewal registration during the 28th year of the original term.}

\textsuperscript{77} 17 U.S.C.A. § 302(c) (West 1996).

\textsuperscript{78} \textit{Gorman & Ginsburg, supra} note 66, at 330-31.

\textsuperscript{79} \textit{See infra Part IV.A; see generally Cordon Art B.V. v. Walker, 40 U.S.P.Q.2d (BNA) 1506 (S.D. Cal. 1996).}
C. Other Works Restored Under § 104A

Section 104A also restores copyright protection in sound recordings fixed prior to February 15, 1972. Before that date, U.S. copyright law did not protect sound recordings. Because the United States can never be an eligible source country, the restoration of pre-1972 sound recording copyrights does not benefit recordings made in the United States. Another large group of works that have been restored are those from countries that lacked a copyright relationship with the United States. Countries that did not recognize U.S. copyrights did not receive copyright protection in the United States. If those countries are now Berne signatories, or members of the World Trade Organization (WTO), their works were “restored” to copyright protection under § 104A.

IV. A Step-by-Step Look at the New § 104A

In an effort to comply with article eighteen of the Berne Convention and ensure that U.S. works will receive reciprocal copyright protection abroad Congress enact[ed] the new § 104A of the 1976 Copyright Act. Although the United States declared its adherence to the Berne Convention in 1988, the United States did not comply with article eighteen until after the passage of § 104A. Article

81. GORMAN & GINSBURG, supra note 66, at 457-58 (“Until 1971, recorded performances were protected by state law, if they were protected at all . . . . In 1971, Pub. L. 92-140 offered federal protection for the first time to sound recordings . . . . The 1976 statute carries forward protection of these sound recording . . . .”) (citations omitted).
82. See infra Part IV.A.
85. Because these works were never really protected in the United States, the term “restored” is not completely accurate.
87. See supra Part II.C.
88. See Hartnick, supra note 5:
While the United States declared its compliance with the Berne Convention in 1989, it never addressed or enacted legislation to implement Article 18 of the Convention. Article 18 requires that the terms of the Convention apply to all works that have fallen into the public domain by reasons other than expiration of its terms of protection.
eighteen provides that Berne signatories shall provide copyright protection "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."\textsuperscript{89} As illustrated above, formalities in U.S. copyright law have caused many works, including those of foreign origin, to prematurely fall into the public domain. Section 104A seeks to rectify this situation by restoring certain non-U.S. works to copyrighted status. Unfortunately, §104A is a complex, convoluted statute, requiring close analysis to fully understand. Further, the new law contains several errors and omissions that promise to aggravate and boggle the minds of many copyright owners, while ensuring copyright attorneys employment for decades to come.

\textit{A. Durationally and Geographically Eligible Works}

To be eligible for copyright restoration, a work must come from an eligible country. An eligible country is one that is a member of the WTO, a signatory to the Berne Convention, or has been proclaimed by the President of the United States to be eligible.\textsuperscript{90} In no case, however, is the United States ever an eligible country.\textsuperscript{91} At the time the work was created, at least one of the authors must have been a national or domiciliary of an eligible country.\textsuperscript{92} If the work has been published, the source country is the country where it was first published.\textsuperscript{93} However, if the work is also published in the United States within thirty days of the foreign publication, the work is ineligible for copyright restoration.\textsuperscript{94} For unpublished works the source country is that of the author, or majority of authors, unless a majority of the authors are from the United States. In that case the source country is

\textsuperscript{89} Berne Convention, \textit{supra} note 39, art. 18.
\textsuperscript{90} 17 U.S.C.A. §§ 104A(g), 104A(h)(3). \textit{See also} Copyright Office: Proposals for URAA Registration and Intent to Enforce Notices Are Issued, 50 Pat. Trademark & Copyright J. (BNA) 246, 247 (July 13, 1995) \textit{[hereinafter Proposals for URAA Registration]}:

An eligible country is a country other than the United States that is a member of the Berne Convention or the World Trade Organization (WTO), or that is subject to a presidential proclamation extending copyright restoration to works of that country based on reciprocal treatment to the works of U.S. nationals or domiciliaries.

\textsuperscript{91} 17 U.S.C.A. § 104A(h)(3).
\textsuperscript{92} \textit{Id.} § 104A(h)(6)(D).
\textsuperscript{93} \textit{Id.} § 104A(h)(8)(C)(i).
\textsuperscript{94} \textit{Id.} § 104A(h)(6)(D); Proposals for URAA Registration, \textit{supra} note 90, at 247 ("If the work is published, it must not have been published in the United States within 30 days of first publication in the eligible country.").
the one with the "most significant contacts with the work."95

The eligibility provisions in § 104A contain a clear favoritism for non-U.S. works.96 And it is perhaps true that foreign authors suffered more under United States copyright formalities than domestic authors. This is probably because authors in the United States were more likely to be familiar with the intricacies of the U.S. copyright law. It may be fair, therefore, to leave U.S. authors without copyright protection once they have failed to comply with the formalities. But why not restore all copyrights, whether foreign or domestic, on equal terms? Doing so would eliminate the inconsistent treatment between domestic and foreign works. Not doing so hurts U.S. authors while offering no particular advantage to foreign authors. Section 104A favors non-U.S. authors over U.S. authors, though both have had their copyrights cut short because of the draconian operation of copyright formalities.

To be durationally eligible for copyright restoration, a work must have been under copyright protection in its source country on January 1, 1996.97 It must also have been within the duration of U.S. copyright protection on that date because a restored work will only enjoy the same length of copyright protection it would have had if it had not fallen into the public domain.98 In effect, works governed by the 1909 Act are restored for only what remains of a 75-year term.99 This creates a certain complexity: If the source country offered the life-plus-fifty years term of the Berne Convention, the term of protection in the source country may differ from the restored copyright term.100 Although copyright restoration's goal is reciprocal protection, it does not necessarily result in concurrent protection.

B. Who May Claim a Restored Copyright?

It may be difficult in many cases to determine who has the right to claim a restored copyright. Section 104A(b) offers this deceptively simple sentence to determine ownership of a restored copyright: "A restored work vests initially in the author or initial rightholder of the

96. Hartnick, supra note 5 ("[C]opyright restoration . . . does not apply to U.S. works in the United States that have fallen into the public domain for failure to comply with various formalities. Unless some backdoor approach is found, I cannot believe that this discrimination in favor of foreigners will long persist.").
98. Id. § 104A(a)(1)(B).
99. Uruguayan Prism, supra note 84.
100. Berne Convention, supra note 39, art. 7(1).
work as determined by the law of the source country of the work."

This is a change in that U.S. courts normally construe U.S. copyright law according to U.S. law, including issues of ownership. The term "rightholder" has a specialized meaning and does not refer to an employer (in a work made for hire situation), or to an assignee, but instead to the copyright owner of a sound recording. This special treatment recognizes that outside the United States sound recordings are sometimes not protected by copyright law, but other statutes instead. What then is the fate of one who acquired rights from the author (of something other than a sound recording) prior to restoration? It appears that the a restored work could not initially vest in an assignee of the author. The phrase "in the author" could be modified to protect assignees: "in the author or copyright owner . . . as determined by the law of the source country . . . ." This would simplify, somewhat, the determination. If the source country's law would recognize the assignment, then the assignee will receive the restored copyright. If the assignment does not include the U.S. copyright on the work, the original author may claim the restored copyright.

Although the source country's law determines who the author of a given work is, its effect on the author's assignments is unresolved. If the author has assigned the U.S. rights, which then fell into the public domain, did the restored copyright vest momentarily in the author, only to instantly be transferred to the assignee? Or must a new assignment be made? If the latter is not the case, the word "author" should probably be "owner." That way, if the source country's law would hold the assignment valid, the restored copyright would have vested in the assignee.

Section 104A also offers no help in determining if statutory rights of reversion and termination will apply to restored works.

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102. Uruguayan Prism, supra note 84.
103. 17 U.S.C.A. § 104A(b)(7). A "work made for hire" is defined in 17 U.S.C. § 101, and 17 U.S.C.A. § 201 (1988) provides that, "In the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author . . . ." See Alan J. Hartnick, Gatt Copyright Restoration, N.Y.L.J., Feb. 3, 1995, at 5 (hereinafter Hartnick II) ("The term 'rightholder' is used because certain European countries protect the owners of sound recordings through neighboring rights rather than copyright.").
104. Proposals for URAA Registration, supra note 90, at 247 ("The [Copyright] Office does not plan to question an applicant's determination of foreign law issues.").
105. See, e.g., Baumgarten & Schwartz, supra note 6, at 131 ("It is intended, however, that this initial ownership be subject to assignments, licenses, and the like — including those made before restoration — that are applicable to the work under pertinent considerations.").
106. But see id. ("Legislative history provides that the duration provisions of the Act do
Under the 1909 Act, if an author assigned his entire copyright during the first twenty-eight-year term, but died before the renewal term commenced, his heirs could claim the renewal term. The rights to the renewal term reverted to the heirs. The right of reversion protected the author’s family in a case where the author received little for the assignment, then the work became successful years later. If the author was alive when the renewal term commenced, he had to live with his deal. If a foreign author assigned her entire copyright to Company in 1976, and then it fell into the public domain in the United States in 1977 for lack of a copyright notice, it would have been restored to Company on January 1, 1996. If she dies before 2004 (76 + 28) may her heirs recapture the restored U.S. copyright in 2004? Further, if the restored copyright initially vests in the author, would she and her heirs already own the restored copyright?

It may be extremely difficult to resolve a case where the source country’s laws uphold the assignment to Company, while a U.S. court applies the right of reversion in favor of her heirs. The chain of ownership would begin with the author until the 1976 assignment. Then, Company would own the copyright, but lose the U.S. rights in 1977 due to publication without copyright notice. Then on January 1, 1996, the U.S. copyright was restored to the author — the source country’s laws caused it to immediately jump back to Company under the original assignment — and then the author died. In 2004 the author’s heirs may assert their reversionary rights. Maybe. Section 104A is silent on the matter.

Statutory reversions were created to protect an author’s heirs in

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107. GORMAN & GINSBURG, supra note 66, at 318:

Under the 1909 Act, it was provided that the renewal term could be claimed by the author if he or she survived the initial term (or at least until the date in the twenty-eighth year when renewal was sought; the statute was altogether silent about such details). If the author had died, then the right to claim the renewal passed successively to three other statutory beneficiaries.

108. Id. at 345-46:

Under the 1909 Copyright Act . . . the principal purpose of the renewal format was to assure that the transferred copyright, when a transfer was made in the initial term, could be recaptured by the author (or his surviving family, or legatees, or next of kin) after a reasonable time. The economic rewards during the renewal term could thus be fully enjoyed by the author, unencumbered by any rights, interests, or licenses previously contracted away. The author, or her statutory successors, was to have a “new estate,” a second chance to license or assign for a new consideration.

a two-term copyright system with renewals. Because U.S. law now has a single term, and § 104A is an attempt to counteract some of the effects of the two-term system, copyright reversions should perhaps not be carried forward into the new, restored copyright terms.

Additionally, the 1976 Copyright Act provides for termination of transfers in two situations, each of which may affect restored copyrights depending on interpretation of § 104A. The same policies that drove the renewal scheme discussed above carried over into the 1976 Act in the form of § 203. That section provides that a transfer of copyright may be terminated thirty-five years after the transfer is made. Likewise, the extension of the renewal term from twenty-eight to forty-seven years (resulting in seventy-five years of total protection) created a windfall nineteen years of protection for assignee’s who, prior to the extension, bargained for a mere twenty-eight year renewal term. That nineteen-year extension may also be terminated and recaptured by the author. As with reversionary rights, § 104A is silent as to the application of these termination rights to restored works.

The ability to recapture the nineteen-year extension on the renewal term, like the reversions discussed above, is a product of the two-term system that should not be carried forward in § 104A. Any restored work governed by the 1909 Act should last the remainder of a full seventy-five year term in favor of the copyright owner as determined by the source country’s law. The thirty-five year recapture provision in the 1976 Act, however, is an important facet of current U.S. copyright law, even if its rationale — protection of an author’s heirs — continues from provisions in the older law. A restored work that is governed by the 1976 Act, and is assigned by the author, should be subject to recapture of the assignment after thirty-five years.

110. 17 U.S.C. § 203 (1988); H.R. Rep. No. 94-1476, 94th Cong. 124-28 (1976) ("The provisions of section 203 are based on the premise that the reversionary provisions of the present section on copyright renewal (17 U.S.C. sec. 24) should be eliminated, and that the proposed law should substitute for them a provision safeguarding authors against unremunerative transfers.").


112. GORMAN & GINSBURG, supra note 66, at 346:

[The life plus 50 year term of the 1976 Act] was even more of an issue for works that were already in copyright under the 1909 Act, as to which the author (or statutory successor) had conveyed the renewal term — at a time (prior to January 1, 1978) when that term was understood by the parties to last for only 28 years. In such a case, who should benefit from the 19 years that Congress added to the renewal term subsequent to the grant, the author or the assignee?

years. This will allow all U.S. copyrights protected under the 1976 Act to be treated equally.

C. Infringement of Restored Copyrights

Section 104A will impact anyone using a restored work in reliance on its public domain status. Such persons are divided into three categories: nonreliance parties, reliance parties, and derivative works reliance parties. For each type, acts that were previously lawful became copyright infringement under the new law. However, what is now prohibited differs depending on the status of the potential defendant.

Anyone who begins using a work after its restoration on January 1, 1996 is a nonreliance party. Use of a restored work by a nonreliance party is copyright infringement and § 104A offers no protection from the remedies available under the Copyright Act. The requirements of notice, and the twelve month grace period, that benefit reliance parties (discussed in the next paragraph) are not available to nonreliance parties. Therefore, anyone who intends to exploit a supposedly public domain work of foreign origin now, i.e., since January 1, 1996, must take care to determine whether the work has been restored or face the consequences of copyright infringement.

The effect of § 104A on reliance parties and derivative works reliance parties is less drastic. A reliance party is one who “engages in acts, before the [date of restoration], which would have violated” the copyright, and who, after the date of restoration, “continues to engage in such acts.” A reliance party will receive a twelve month grace period following notice from the restored copyright claimant. Therefore, one who was using a work prior to January 1, 1996, in reliance of its public domain status need not stop selling the work until twelve months after she receives notice, though no new copies or derivative works may be made. Notice may be made by the restored


As against any party who is not a reliance party, the remedies provided in chapter 5 of this title shall be available on or after the date of restoration of a restored copyright with respect to an act of infringement of the restored copyright that is commenced on or after the date of restoration.


117. Id. § 104A(d)(2)(A)(ii).

118. Proposals for URAA Registration, supra note 90, at 247 (“Those users relying on the public domain status of the works must stop reproducing or preparing derivative works based on restored works on the date the work is identified in the Copyright Office list or when they
copyright claimant directly to the reliance party and such notice will begin tolling the twelve month grace period. The reliance party will be liable for any use that occurs after the end of the twelve month period and must not make new copies or phonorecords during the twelve month grace period. From January 1, 1996, until January 1, 1998, a restored copyright claimant may give constructive notice by filing a notice of intent to enforce the restored copyright with the copyright office. The copyright office will publish a list of restored works claimed by constructive notice every four months in the Federal Register. Publication in the Federal Register will begin to toll the twelve month grace period, and if both constructive and actual notice are given, the earlier notice will prevail. It will be incumbent on potential reliance parties to check the Federal Register for the works they are using.

A special situation occurs when a reliance party has created a derivative work based on the restored work, which may be done freely with public domain works. Section 104A softens the impact of copyright restoration significantly for these derivative works reliance parties. Such a party "may continue to exploit that work for the duration of the restored copyright if the reliance party pays to the owner . . . reasonable compensation . . . . In the absence of an agreement . . . the amount . . . shall be determined by an action in U.S. district court . . . ." To be eligible for this benefit of continued exploitation, the derivative work must have been created before January 1, 1996, or, if the source country becomes eligible later than that, before that country becomes eligible.

The provisions in § 104A in favor of reliance parties are extremely important because they soften the effect of the new law on those who are exploiting these works in reliance on their public domain status. However, § 104A contains several errors that, if given receive actual notice of an intent to enforce a restored work . . . ."

120. Id. § 104A(d)(2)(B)(ii)(I) & (II).
121. Id. § 104A(d)(2)(B)(ii)(III).
122. Id. § 104A(d)(3)(A)(ii).
123. Id. § 104A(d)(3)(B).
125. Hartnick, supra note 5 ("Section 104A(d)(3) provides additional protection to a reliance party who used a restored foreign work to create a derivative work because a one year sell off period might be an inadequate period to recoup the investment.").
127. Id. § 104A(d)(3)(A). But see infra notes 128-134 and accompanying text.
128. Hartnick II, supra note 103, at 8 ("I suspect that there will be much litigation over
literal effect, severely undermine the benefits afforded reliance users.

Perhaps the most profound error, hopefully on the verge of legis-

lative correction, is in the definition of "reliance party."129 That

section provides that a reliance party is one who "engages in acts,

before the source country of that work becomes an eligible country,

which would have violated § 106 if the restored work had been sub-

ject to copyright protection, and who, after the source country be-

comes an eligible country, continues to engage in such acts . . . ."130

The definition of "eligible country" is "a nation, other than the

the identity of a reliance party because non-reliance parties have fewer rights.").

129. 17 U.S.C.A. § 104A(h)(4); Uruguayan Prism, supra note 84. As of this writing, the

Copyright Clarifications Act of 1996 appeared close to passage. H.R. 1861, 104th Cong.

(1996). The Act reads in part:

Section 104A of title 17, United States Code, is amended as follows:

(1) Subsection (d)(3)(A) is amended to read as follows:

"(3) EXISTING DERIVATIVE WORKS.—(A) IN THE CASE OF A

DERIVATIVE WORK THAT IS BASED UPON A RESTORED WORK AND

IS CREATED—(I) BEFORE THE DATE OF THE ENACTMENT OF THE

URUGUAY ROUND AGREEMENTS ACT, IF THE SOURCE COUNTRY OF

THE RESTORED WORK IS AN ELIGIBLE COUNTRY ON SUCH DATE,

OR (II) BEFORE THE DATE OF ADHERENCE OR PROCLAMATION, IF

THE SOURCE COUNTRY OF THE RESTORED WORK IS NOT AN

ELIGIBLE COUNTRY ON SUCH DATE OF ENACTMENT, A RELIANCE

PARTY MAY CONTINUE TO EXPLOIT THAT DERIVATIVE WORK FOR

THE DURATION OF THE RESTORED COPYRIGHT IF THE RELIANCE

PARTY PAYS TO THE OWNER OF THE RESTORED COPYRIGHT

REASONABLE COMPENSATION FOR CONDUCT WHICH WOULD BE

SUBJECT TO A REMEDY FOR INFRINGEMENT BUT FOR THE

PROVISIONS OF THIS PARAGRAPH."

(2) SUBSECTION (E)(1)(B)(II) IS AMENDED BY STRIKING THE LAST

SENTENCE.

(3) SUBSECTION (H)(2) IS AMENDED TO READ AS FOLLOWS:

"(2) The 'date of restoration' of a restored copyright is the later of-

(A) January 1, 1996, the date on which the Agreement on Trade-

Related Aspects of Intellectual Property referred to in section 101(d)(15)

of the Uruguay Round Agreements Act enters into force with respect to

the United States, if the source country of the restored work is a nation

adhering to the Berne Convention or a WTO member country on such

date, or

(B) the date of adherence or proclamation, in the case of any other

source country of the restored work."

(4) Subsection (h)(3) is amended to read as follows:

"(3) The term 'eligible country' means a nation, other than the United States,

that, after the date of the enactment of the Uruguay Round Agreements Act-

(A) becomes a WTO member,

(B) is or becomes a member of the Berne Convention, or

(C) becomes subject to a proclamation under subsection (g)."

United States, that . . . adheres to the Berne Convention . . . .”131
Taken together, to qualify as a reliance party one must have com-
menced use before the source country adhered to the Berne Conven-
tion or became part of the WTO.132 What if the source country is
England, which adhered to Berne in the late 1800s? To be a reliance
user of an English work that is in the U.S. public domain, one would
have had to commence use nearly 100 years ago! There are no works
created that long ago that are still protected by copyright and dura-
tionally eligible for restoration. The result is that, through poor
drafting, § 104A grants a beneficial status to reliance users, but
makes it impossible (in many cases) to qualify for that status. This
will be the case for dozens of countries that became “eligible” quite
long ago. It appears that the italicized phrases above should have
read: “before the date of restoration.”133 If so, the ridiculous result
reached by literal interpretation will be avoided.134

Another interpretation is that, for this particular provision, be-
coming an “eligible country” occurs on the date the Uruguay Round
Agreement was enacted, December 8, 1994.135 However, such an in-
terpretation results in an awkward period from December 8, 1994,
until January 1, 1996, in which initial use of works that are still in the
public domain will not create reliance party status. Also, nothing in
the definition of an “eligible country” indicates that countries become
“eligible” on any specific date.136

Two further errors affect reliance use of derivative works. Sec-
tion 104A provides that, subject to a duty to pay a fair royalty, a
“reliance party may continue to exploit [derivative] works for the du-

131. Id. § 104A(h)(3).
132. Adherence to the World Trade Organization, or presidential proclamation, will also
suffice. 17 U.S.C.A §104A(h)(1).
133. Uruguayan Prism, supra note 84.
134. See Hartnick II, supra note 103 (“Generally, a ‘reliance party’ is a person who, be-
fore the restoration of copyright, engaged in acts that would have constituted infringement if
the work had been subject to copyright and who continue to do so after the restoration date.”
(emphasis added)).
135. See Baumgarten & Schwartz, supra note 6, at 131 (“It appears intended that the
‘source country . . . becomes an eligible country’ for this purpose on December 8, 1994 — the
date of enactment of the Uruguay Round Agreements Act — or of a country’s later adherence
to Berne, membership in WTO, or special proclamation.”); see also Marybeth Peters, The
parties are those who have been using a work on or before December 8, 1994.”).
other than the United States, that is a WTO member country, adheres to the Berne Convention,
or is subject to a proclamation under section 104A(g).”)}
ration of the restored copyright.”137 The problem arises in the limitation of this clause to a:

derivative work that is based upon a restored work and is created—

(i) before the date of the enactment of the Uruguay Round Agreements Act, if the source country of the derivative work is an eligible country on such date, or

(ii) before the date of adherence or proclamation, if the source country of the derivative work is not an eligible country on such date of enactment . . . .138

The “source country of the derivative work” will likely always be the United States. It is in the United States that these works are being exploited in reliance on their public domain status, and it is the United States that is bound by the U.S. Copyright Act. However, as indicated in the definition of an “eligible country” above, the United States can never be an eligible source country. Copyright restoration does not benefit U.S. works. Therefore, if interpreted literally, there cannot possibly be a single beneficiary who qualifies as a derivative work reliance user. The entire concept has been undermined by this error. In this case, the italicized phrases above should read: “underlying work” not “derivative work.”139 Again, this simple change would give this section meaning where now there is none.

D. Nullification of Representations and Warranties

In many licenses and assignments, the assignor gives a warranty to the assignee that the subject matter does not infringe any copyrights. If the subject matter of such an agreement is a public domain work, now restored under § 104A, the assignee might have a cause of action against the assignor for violation of the warranty. However, § 104A prevents such liability from arising. It provides, “Any person who warrants, promises, or guarantees that a work does not violate an exclusive right . . . shall not be liable . . . if the warranty . . . is breached by virtue of the restoration of copyright under this section, if such warranty, promise, or guarantee is made before January 1, 1995.”140 This section raises two problems.

First, may the assignee recover the consideration he paid for the

137. Id. § 104A(d)(3)(A).
138. Id. (emphasis added).
139. Uruguayan Prism, supra note 84.
agreement containing the warranty? The assignor may have used a public domain song as the theme in a film and then assigned the film to a distributor. The assignor guarantees that the film does not infringe on any copyrights. Now, the song is restored and the foreign author has served notice on the distributor of an intent to claim the restored copyright. Presumably the assignee would seek indemnification from the assignor for any copyright infringement action brought by the copyright owner of the infringed work. But, under § 104A, the assignor will not be liable. Does this mean that the assignee is liable to the restored copyright claimant, or that the restored copyright claimant may not recover in this instance? The assignee may find himself in a position of paying the assignor for the right to use a derivative work (i.e., the film mentioned above), including royalties, then having also to pay a royalty to the claimant of the restored copyright in the underlying work. This despite the assignor’s guarantee. Perhaps § 104A should include a provision requiring assignors in this scenario to bear some part of the burden of compensating the copyright claimant. The percentages each should pay — if the parties cannot agree — could be decided upon application to a district court.

V. CONCLUSION

Copyright restoration under § 104A effects a fundamental change in U.S. copyright law. The fundamental tenet that once a work has fallen into the public domain its copyright is lost forever no longer holds true for potentially thousands of foreign works. In an effort to achieve global harmony of copyright protection, Congress has dramatically shifted the balance between the public’s free access to unprotected works and copyright protection. This may be necessary to assure that U.S. authors receive reciprocal copyright protection in other nations. However, § 104A is unnecessarily complex, and clearly faulted with several errors and omissions. It is also possible that the return of public domain works to copyright protection effects an unlawful taking under the Fifth Amendment; or that enforcing the royalty provisions on derivative works violates the First Amendment’s protection of free expression (subjects perhaps worthy of another entire article). At the very least, corrective legislation is required to clarify the most problematic drafting problems. In the meantime, however, authors and their attorneys need to scruti-

141. Uruguayan Prism, supra note 84.
nize § 104A so that they may have as clear an understanding of copyright restoration as is possible under this new law.
# APPENDIX A

Format—Notice of Intent to Enforce a Copyright Restored under the Uruguay Round Agreements Act (URAA)

1. Title: ____________________________

   If this work does not have a title, state "No title.")

   OR

   Brief description of work (for untitled works only):

2. English translation of title (if applicable):

3. Alternative title(s) (if any):

4. Type of work: ____________________________

   (e.g. painting, sculpture, music, motion picture, sound recording, book)

5. Name of author(s) : ____________________________

6. Source country:

7. Approximate year of publication:

8. Additional identifying information:

   (e.g. for movies: director, leading actors, screenwriter, animator; for photographs: subject matter; for books: editor, publisher, contributors, subject matter).

9. Name of copyright owner: ____________________________

   (Statements may be filed in the name of the owner of the restored copyright or the owner of an exclusive right therein.)

10. If you are not the owner of all rights, specify the rights you own:

    (e.g. the right to reproduce/distribute/publicly display/publicly perform the work, or to prepare a derivative work based on the work)
11. Address at which copyright owner may be contacted:

________________________________________________________________________

________________________________________________________________________

(Give the complete address, including the country and an “attention” line, or “in care of” name, if necessary.)

12. Telephone number of owner: ________________________________

13. Telefax number of owner: ________________________________

14. Certification and Signature:

   I hereby certify that, for each of the work(s) listed above, I am the copyright owner, or the owner of an exclusive right, or the owner’s authorized agent, the agency relationship having been constituted in a writing signed by the owner before the filing of this notice, and that the information given herein is true and correct to the best of my knowledge.

   Signature: ________________________________

   Name (printed or typed): ________________________________

   As agent for (if applicable): ________________________________

   Date: ________________________________

NOTE: Notices of Intent to Enforce must be in English, except for the original title, and either typed or printed by hand legibly in dark, preferably black, ink. They must be on 8 1/2 by 11 inch white paper of good quality, with at least a 1-inch (or 3 cm) margin.
APPENDIX B

Circular 38b

Highlights of Copyright Amendments Contained in the Uruguay Round Agreements Act (URAA)

.....

NOTICE OF INTENT TO ENFORCE (NIE)

.....

.....

The URAA authorizes the owner of a right in a restored work either to provide actual notice by notifying a reliance party directly, or

— to provide constructive notice through the filing of a Notice of Intent to Enforce (NIE) a Restored Copyright with the Copyright Office.

— The URAA further directs the Copyright Office to publish in the Federal Register, the U.S. government's publication for official agency notices, a list identifying restored works and their ownership where NIEs have been filed with the Office. The Copyright Office must also maintain a list containing all NIEs for inspection and copying by the public.

Date to File NIEs

Eligibility on January 1, 1996. The owner of a restored work may file an NIE directly with a reliance party at any time after the date of restoration. If the owner wishes to file an NIE with the Copyright Office, the owner of a work whose source country as of January 1, 1996, is a member of the Berne Convention or the WTO must file an NIE for that work between January 1, 1996, and December 31, 1997. The Office will publish the first listing of NIEs no later than May 1, 1996, and will publish lists at regular four-month intervals for the next two years.

.....
FILING AN NIE IN THE COPYRIGHT OFFICE

The following information describes how to file an NIE with the Copyright Office. Filing actual notice on a reliance party is described later in this circular.

Form

The Copyright Office does not provide a form for filing an NIE, however, the attachment to this circular and the regulations published in the Federal Register and the Code of Federal Regulations contain a format that may be used to file notices. This format also may be downloaded from LC MARVEL through the Internet. (World Wide Web address is: http://lcweb.loc.gov/copyright or use a Gopher client to connect to: marvel.loc.gov and select the copyright file.)

The format includes both required and optional information. The Copyright Office strongly recommends use of this format. An NIE filed with the Copyright Office should be typed or printed legibly by hand on 8 1/2 X 11-inch (or 210 x 297-mm, A4) white paper with a 1-inch (or 3-cm) margin.

Content of Notice of Intent to Enforce.

The URAA specifies the minimum content of an NIE. It requires that the notice be signed by the owner or the owner's agent. In addition to the signature, it must contain the title, or a brief description if untitled; an English-language translation of the title if the title is in a foreign language; any other alternative titles known to the owner by which the restored work may be identified; the name of the copyright owner of the restored work or owner of an exclusive right therein; and the address and telephone number at which the owner can be contacted. Although the Copyright Office can ask for additional information, failure to provide it will not invalidate the NIE.

The Copyright Office has identified certain information that is not required by the URAA but is important for proper identification of a restored work. It includes:

1. type of work (painting, sculpture, music, motion picture, sound recording, book, etc.);
2. name of author(s);
3. source country;
4. approximate year of first publication;
5. additional identifying information (e.g., for movies: director, leading actors, screenwriter, animator; for photographs: subject matter; for books: editor, publisher, contributors);
6. rights owned by the party on whose behalf the NIE is filed (e.g., the right to reproduce/distribute/publicly display/publicly perform the work, or to prepare a derivative work based on the work); and
7. telefax number at which the owner, exclusive rights holder, or agent can be reached.

Multiple Works

Multiple works may be included on a single NIE provided that:
1) each work is identified by title, or a brief description if untitled; 2) all the works have the same author; 3) all the works are owned by the same copyright owner or the owner of the exclusive rights therein; and 4) the rights owned by the party on whose behalf the notice is being filed are the same.

Signature and Certification

The NIE must be signed by the owner of the restored copyright, the owner of an exclusive right therein, or an agent of the owner. The agency relationship must be established in writing and signed by the owner before the NIE is filed.

The NIE must include a certification statement indicating that the information given is correct to the best of the filer’s knowledge. Any material false statement knowingly made with respect to any restored copyright identified in an NIE shall void all claims and assertions against reliance parties made about such restored copyright. The certification statement is found on the sample format.

Fee

The fee for filing an NIE is $30 for a notice covering one work. For a notice covering multiple works, the fee is $30, plus $1 for each additional work covered beyond the first work. (For example, the fee for an NIE covering three works would be $32.) The fee includes the cost of an acknowledgment of recordation, which will be mailed to the filer after the Copyright Office records the NIE. The fee is not re-
The fee may be paid by any of the following methods:

1. Checks, money orders, or bank drafts made payable to the Register of Copyrights. Remittances must be redeemable without service or exchange fees through a U.S. institution, must be payable in U.S. dollars, and must be imprinted with American Banking Association routing numbers. Currency, international money orders, and postal money orders that are negotiable only at a Post Office are not acceptable.

2. Copyright Office deposit account. This is an account into which an applicant makes advance payment for use later in paying copyright fees. For information on Deposit Accounts, request Circular 5, "How to Open and Maintain a Deposit Account in the Copyright Office."

3. Credit cards (for use only in filings under the URAA). The Copyright Office will accept VISA and MasterCard. Debit cards cannot be accepted for payment. To pay by credit card, the filer must provide in a separate letter the name of the credit card used, the credit card number, the expiration date of the credit card, the total amount authorized to be charged, and a signature authorizing the Copyright Office to charge the fees to that account. To protect the security of the credit card number, the credit card number must not appear on the NIE, since the notice becomes part of the public record. The filer of an NIE must insure that sufficient funds accompany the NIE or are available in a deposit account. Insufficient fees could delay the effective date of notice. Address Send NIEs to the following address:

URAA/GATT, NIEs P.O. Box 72400, Southwest Station
Washington, D.C. 20024 U.S.A.

Do not mail to the Copyright Office. Serving Notice Directly on a Reliance Party The Copyright Office does not provide a form for use in serving a NIE directly on a reliance party. Those parties choosing to serve a Notice of Intent to Enforce a Restored Copyright on the reliance party should note that the URAA requires additional information. Therefore, if they use the Copyright Office’s NIE format as a guide for the actual notice, it will be incomplete unless the additional information specified is added. The URAA specifications follow, with italic type added to show additional requirements for actual
notice: Notices of Intent to Enforce a Restored Copyright served on a reliance party shall be signed by the owner or the owner's agent, shall identify the restored work and the work in which the restored work is used, if any, in detail sufficient to identify them, and shall include an English translation of the title, any other alternative titles known to the owner by which the work may be identified, the use or uses to which the owner objects, and an address and telephone number at which the reliance party may contact the owner. If the notice is signed by an agent, the agency relationship must have been constituted in writing and signed by the owner before service of the notice. 104A(e)(2)(B) of the URAA. Actual notice may be served on a reliance party at any time after copyright in the work is restored.

REGISTRATION OF CLAIMS TO COPYRIGHT IN RESTORED WORKS

The URAA directs the Copyright Office to provide procedures for registration of claims to copyright; however, copyright owners of restored works need not register their works. Although the copyright law provides that the author or copyright owner of a work that is not considered a Berne Convention work must register the work or seek registration before he or she can bring a copyright infringement action in Federal court, the owner of rights in a Berne work does not have to register before initiating a copyright infringement suit. The question of whether a work from a country that is a member of WTO but not Berne must be registered was not specifically addressed in the legislation, but one can only assume that works that do not come under the definition of "Berne Convention work" found in 17 U.S.C. 101 would have to be registered before the owner can initiate suit.

Who May Claim Copyright

A claim in a restored work may be registered only in the name of the owner(s) of the U.S. copyright on the date that the application is submitted; that is, in the name of the owner(s) of all U.S. rights in that work. A licensee or other owner of only certain exclusive rights in a work is not permitted to register a claim in a restored work in his or her name. Forms Special GATT registration forms must be used for registration of works restored under the URAA. Form GATT is for claims to copyright in individual restored works and restored works published under a single series title. Form GATT/GRP is for
registration of groups of related restored works on a single form. Free application forms are supplied by the Copyright Office, Publications Section, LM-455, Library of Congress, Washington, D.C. 20559-6000, or they may be ordered by calling (202) 707-9100 at any time. In addition, legible photocopies of the forms are acceptable if reproduced on good quality 8 1/2 x11-inch white paper.

GATT Group Registration Requirements

A group of between 2 and 10 related works may be registered on the Form GATT/GRP, provided the following conditions are met: the author is the same for all works in the group; the owner of all U.S. rights is the same for all works in the group (however, the author and owner need not be the same party); all works have been first published in the same calendar year; and all works fit within the same subject matter category, for example, literary works, musical works, motion picture, etc. Applicants registering a group of related works must file for registration on the Form GATT/GRP. Publication When determining publication information regarding restored works for which registration is sought, the following guidelines are offered:—

For works published on or after January 1, 1978: Publication is the distribution anywhere in the world of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending. The offering to distribute copies or phonorecords to a group of persons for purposes of further distribution, public performance, or public display, constitutes publication. A public performance or display of a work does not of itself constitute publication. (17 U.S.C.101)—

For works published before January 1, 1978: Publication maybe defined as the act of making one or more copies of a work available to the general public, usually by the sale, placing on sale, or public distribution of one or more copies or sound recordings without express or implied restrictions as to future use. Recordings of musical compositions were not considered copies of the recorded music before January 1, 1978. A distribution of a recording before that date would publish the sound recording but not the music contained on the recording. Registration Instructions, Instructions for completing the application forms and deposit preferences are included on the forms supplied by the Copyright Office. Applications, deposit copies and fees should be submitted in one package. Registration Fees For an individual work, the basic registration fee is $20 per work. This $20
fee is also applicable to a series of works published during a calendar year under a single title in episodes, installments, or issues. The fee for a group registration of 2 to 10 related works is $10 per individual work. For example, four works submitted on Form GATT/GRP would cost $40. The methods of payment for registration fees are the same as those for NIEs (see page 5). Address Applications to register restored works should be sent to the following address:

URAA/GATT, NIEs
P.O. Box 72400, Southwest Station
Washington, D.C. 20024 U.S.A.

PUBLIC ACCESS TO NIE INFORMATION AND COPYRIGHT OFFICE REGISTRATIONS

Public Access The information contained in NIEs filed with the Copyright Office and in copyright registrations and related documents catalogued since January 1, 1978, to the present, is open to the public for searching. These records are available through the Library of Congress Information System (LOCIS), which may be accessed at terminals in the Library of Congress or via the Internet. In addition, upon request, the Copyright Office will search its files for a fee. LOCIS contains several different Library of Congress files. NIE information is available in the online file known as COHD (Copyright Office History Documents). Information includes: the title or brief description if untitled; an English translation of the title; the alternative titles if any; the name of the copyright owner or owner of an exclusive right; the author; the type of work (if given); the date of receipt of the NIE in the Copyright Office; the date of publication in the Federal Register; the rights covered by the notice (if given); and the address, telephone and telefax number (if given) of the copyright owner. Online records of NIEs are searchable by the title of the work the copyright owner or owner of an exclusive right, and the author. Registration information is available in the following LOCIS files: COHM, which contains all original and renewal registrations except serials; COHD, which contains documents; and COHS, which contains serials. To search the files via the Internet, use any of the following addresses: connect to the Copyright Office Home Page on the WorldWide Web at http://lcweb.loc.gov/copyright, use a Gopher Client to connect to marvel.loc.gov, port 70, or telnet tolocis.loc.gov. LOCIS is available Monday to Friday, 8:00 a.m. to 9:00 p.m., Satur-
day, 8:00 a.m. to 5:00 p.m., and Sunday, 12:00 p.m. to 5:00 p.m. It is
not available on Federal holidays. The Library of Congress and the
Copyright Office do not charge fees to connect to their Internet re-
sources. Office Searches The Copyright Office is located in the Li-
brary of Congress, James Madison Memorial Building, 101 Inde-
pendence Avenue, S.E., Washington, D.C. The public records of
Notices of Intent to Enforce may be searched by the public Monday
through Friday, 8:30 a.m. to 5:00 p.m., Eastern Time, except Federal
holidays. Public terminals are located in the Copyright Office and in
the reading rooms of the Library of Congress. Upon request, the
Copyright Office staff will search the records at the rate of $20 for
each hour or fraction thereof and furnish a written report.

For further information, request Circular 22, “How to Investigate
the Copyright Status of a Work,” or contact: Reference and Bibliog-
raphy Section, Room LM-451

Copyright Office
Library of Congress
Washington, D.C. 20559-6000 U.S.A. Tel: (202) 707-6850
Fax: (202) 707-6859

RELATIONSHIP TO NAFTA

Under the NAFTA Implementation Act, a number of Mexican
motion picture owners timely filed a Statement of Intent to Restore
with the Copyright Office. These works will continue to enjoy copy-
right protection, but such protection will be governed by the new
2057./9/ See 60 Fed. Reg. 8252 (Feb. 13, 1995) for a list of these
works. Copyright owners of these works need not file an NIE under
the URAA. However, other works from NAFTA countries that are in
the public domain in the United States, including motion pictures for
which no NAFTA restoration was sought, are subject to copyright
restoration under the new section 104A. NAFTA works that have not
been registered may be registered using the URAA registration pro-
cedures, including GATT forms and deposit preferences.

FURTHER QUESTIONS

For further information, call (202) 707-3000 (TTY: (202) 707-
6737) between 8:30 a.m. and 5:00 p.m., Eastern Time, Monday to
Friday, except Federal holidays, or write:

Publications Section, LM-455
Copyright Office
Library of Congress
Washington, D.C. 20559-6000 U.S.A.

To order a limited supply of circulars or application forms for registration, write to the above address or call the Copyright Office Hotline, anytime day or night at (202) 707-9100, TTY: (202) 707-6737, and leave a recorded request. Please allow 2 to 3 weeks for delivery of your order. Frequently requested Copyright Office circulars, announcements, regulations, and other related materials are available over the Internet at the following addresses: World Wide Web:http://lcweb.loc.gov/copyright or gopher to: marvel.loc.gov. The World Wide Web home page offers information created by the Copyright Office and links to other copyright resources created elsewhere.

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