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Recent Changes in the Duration of Copyright in the United States and European Union: Procedure and Policy

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Cover Page Footnote

The author gratefully acknowledges the comments of David Nimmer, Irell & Manella; Professor J.H. Spoor, Vrije Universiteit; and Professor H. Cohen Jehoram, University of Amsterdam.

ARTICLES

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Lisa M. Brownlee*

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* Attorney-at-law, Trenité Van Doorne, Amsterdam. The author gratefully acknowledges the comments of David Nimmer, Irell & Manella; Professor J.H. Spoor, Vrije Universiteit; and Professor H. Cohen Jehoram, University of Amsterdam.

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INTRODUCTION

International harmonization of copyright duration laws is an increasingly important issue.¹ The exploitation of works across national boundaries has increased dramatically, due, in part, to the reduction of distribution costs that has resulted from widespread use of digital means of transmission.² As a result of recent legislation in the European Union ("EU"),³ however, the international terms of copyright protection are widely varied.

The United States' term of copyright protection was not, until recently, in harmony with the term of protection required under the Berne Convention for the Protection of Literary & Artistic Works ("Berne Convention" or "Berne")⁴ despite the United States' adop-

1. "[T]he development of the global information infrastructure makes it possible to transmit copyrighted works directly to individuals throughout the world and has increased pressure for more rapid harmonization." *Copyright Term Extension: Hearings on S.483 Before the Senate Comm. on the Judiciary*, 104th Cong., 1st Sess. (Sept. 20, 1995) (statement of Marybeth Peters, Register of Copyright, U. S. Copyright Office, and Associate Librarian of Congress for Copyright Services); Paul E. Geller, *Introduction* to 1 MELVILLE B. NIMMER & PAUL E. GELLER, *INTERNATIONAL COPYRIGHT LAW AND PRACTICE* §2 INT-15 (1995) [hereinafter NIMMER & GELLER]. ("[P]rint and newer media have increasingly exercised worldwide impact, with proliferating challenges to the law. Thus, an inexorably international dynamic has shaped the growth of copyright.").

2. See 141 CONG. REC. S14550 (daily ed. Sept. 28, 1995) (statement of Sen. Hatch) (discussing how the National Information Infrastructure provides individual creators a means of distributing their works at a very low cost).

3. The European Union is comprised of Austria, Belgium, Denmark, Finland, France, Germany, Greece, Ireland, Italy, Luxembourg, the Netherlands, Portugal, Spain, Sweden, and the United Kingdom. Treaty Establishing the European Community, Feb. 7, 1992, [1992] 1 C.M.L.R. 573 [hereinafter EC Treaty], incorporating changes made by Treaty on European Union, Feb. 7 1992, O.J. C 224/1 (1992), [1992] 1 C.M.L.R. 719, 31 I.L.M. 247 [hereinafter TEU]. The TEU, *supra*, amended the Treaty Establishing the European Economic Community, Mar. 25, 1957, 298 U.N.T.S. 11, 1973 Gr. Brit. T.S. No.1 (Cmd. 5179-II) [hereinafter EEC Treaty], as amended by Single European Act, O.J. L 169/1 (1987), [1987] 2 C.M.L.R. 741 [hereinafter SEA], in TREATIES ESTABLISHING THE EUROPEAN COMMUNITIES (EC Off'l Pub. Off. 1987). By virtue of the European Economic Treaty, the provisions of the EC Term Directive must also be implemented by the European Free Trade Association ("EFTA") countries of Iceland, Liechtenstein, and Norway. Agreement on the European Economic Area with Final Act and Declaration, 7 O.J. L 1 (1992).

4. Berne Convention for the Protection of Literary and Artistic Works of September

tion of a 50 year *post mortem auctoris* (after the death of the author ("p.m.a")) term in 1976, and implementation of the Berne Convention in 1988. For newly-created works, harmony has been achieved by the United States' implementation of Berne. Discrepancies remain, however, due to the United States' failure to retroactively apply Berne's standards.

Against this backdrop of partial harmony, the General Agreement on Tariffs and Trade's ("GATT") Trade-Related Aspects of Intellectual Property Rights ("TRIPs")⁵ and its United States' implementing legislation, the Uruguay Round Agreements Act ("U.R.A.A."),⁶ was passed. TRIPs contains provisions on copyright duration different from Berne's minimum,⁷ therefore influencing the ultimate determination of the duration of protection a work should receive in a TRIPs member country.⁸ The U.R.A.A., which came into effect on January 1, 1996,⁹ brings the United States into

9, 1886, completed at Paris on May 4, 1896, revised at Berlin on November 13, 1908, completed at Berne on March 20, 1914, revised at Rome on June 2, 1928, revised at Brussels on June 26, 1948, and revised at Stockholm on July 14, 1967 (with Protocol regarding developing countries), completed at Stockholm on July 14, 1967, art. 7(1), 828 U.N.T.S. 221 [hereinafter Berne Convention]. The Berne Convention sets a 50-year *post mortem auctoris* ("p.m.a.") term of protection, subject to certain exceptions. See *infra* part I.A.2 (discussing Berne's minimum terms and exceptions thereto). The United States implemented the Berne Convention through the Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853 (1988) (amending 17 U.S.C. § 104 (1976)).

5. Agreement on Trade-Related Aspects of Intellectual Property Rights, 33 I.L.M. 1197, in General Agreement on Tariffs and Trade: Multilateral Trade Negotiations Final Act Embodying the Results of the Uruguay Round of Trade Negotiations, April 15, 1994, 33 I.L.M. 1125, Annex 1C [hereinafter TRIPs].

6. Act of Dec. 8, 1994, Pub. L. No. 103-465, 108 Stat. 4809 (1994) (amending 17 U.S.C. § 104A (1992)) (hereinafter U.R.A.A.). The original 104A, repealed by the U.R.A.A., revived motion picture works of Canadian and Mexican origin. The revised 104A "creates eligibility for copyright restoration across the board to works of foreign origin." 2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 9A.03[C], at 9A-22 (1996) [hereinafter NIMMER ON COPYRIGHT].

7. See *infra* part II.B.

8. See *infra* part II.B.

9. 60 Fed. Reg. 15,845 (1995). The effective date of January 1, 1996 was chosen by the Copyright Office and implemented by presidential proclamation. However, some commentators argued that the terms of TRIPs itself support an earlier, January 1, 1995, effective date. Copyright Office Registration Reforms and Restoration Procedures are Aired, 50 PAT., TRADEMARK & COPYRIGHT J. 34 (1995) [hereinafter Copyright Office

almost full compliance with Berne.¹⁰ Copyrights in certain public domain works are restored,¹¹ therefore bringing the United States duration laws for pre-existing works into nearly complete harmony with Berne.

However, harmony of terms between the United States and the EU was not achieved, because six months before the U.R.A.A. took effect, the Directive on Harmonizing the Term of Protection of Copyright and Certain Related Rights ("EC Term Directive")¹² took effect in the EU, extending the copyright term applicable in all EU Member States to seventy years p.m.a.¹³ The EC Term Directive

Registration Reforms are Aired]; see also NIMMER ON COPYRIGHT, *supra* note 6, § 9A.04[B][1][b], at 9A-33 to 9A-36 (indicating that although the U.S. Copyright Office's restoration date of January 1, 1996 found logic in TRIPs transitional provisions, the statutory language of Section 104A mandated restoration of copyrights as of "the date on which [TRIPs] enters into force with respect to the United States [January 1, 1995] . . .").

10. See *infra* part II.C.4.

11. See *infra* part II.C.1.

12. Council Directive No. 93/98, O.J. L 290/9 (1993). The EC Term Directive mandates that the Member States implement national laws that are consistent with the Directive by July 1, 1995. *Id.* art 13(1), O.J. L 290/9 at 13 (1993). Thus far, only Belgium has implemented this Directive in Loi du 30/06/94, Moniteur Belge du 27/07/94, at 19297. For a discussion of proposed legislation in the United Kingdom, see M. Henry, *Rental and Duration Directives: Issues Arising From Current EC Reforms*, 12 EUR. INTELL. PROP. REV. 437 (1993). For a discussion of what happens when Member States do not implement the directive by the date of its coming into force see *infra* part II.A.4.

It should be noted here that the EC has adopted several directives protecting intellectual property rights. See Council Directive No. 89/104, O.J. L 40/1 (1989) (trademarks); Council Directive No. 92/100, O.J. L 346/61 (1992) (rental, lending and related rights); Council Directive No. 91/250, O.J. L 122/42 (1992) (software); Council Directive No. 93/83, O.J. L 248/15 (1993) (satellite and cable retransmission); Council Directive No. 87/54, O.J. L 24/36 (1987) (semiconductor chips). For a summary of these Directives, see H. Cohen Jehoram & Ben Smulders, *The Law of the European Community and Copyright* § 4[2], in NIMMER & GELLER, *supra* note 1, at EC-64-5. The EC may be considering more actions to harmonize intellectual property rights, in particular copyrights and related rights. See Commission of the European Communities, *Copyright and Related Rights in the Information Society: Green Paper presented by the Commission*, COM (95) 382 Final (July 1995) [hereinafter Green Paper]. The Commission reported that: "[T]he question to be addressed now is whether the existing harmonization is enough, and in what areas, if necessary, it ought to be taken further, at least in those areas particularly affected by the information society." *Id.* at 4.

13. Council Directive No. 93/98, *supra* note 12, art 1(1), O.J. L 290/9, at 11 (1993).

also revived certain copyrights that were previously in the public domain in the EU.¹⁴ In response to the new EU term, the U.S. Congress introduced legislation that would bring the United States back into near harmony with the EU terms: the Copyright Term Extension Act ("C.T.E.A.")¹⁵ would add 20 years to the existing U.S. terms.¹⁶

The changed rules pertaining to copyright duration are of critical practical importance to the international exploitation of existing works. Certain works that were in the public domain in the EU and United States will be revived, and therefore require a license for use to avoid infringement,¹⁷ and works by EU authors in which copyright protection still subsists will now endure 20 years longer in the EU.¹⁸ Understanding the new duration rules is of critical importance to calculate whether a work is in the public domain and to properly value licenses to use any work in which copyright still subsists.

The changed rules also have policy implications. These laws operate to discriminate against U.S. authors and works first published in the United States,¹⁹ resulting in an EU-U.S. disharmony that complicates the international exploitation of works, and that could result in widespread infringement of rights in the EU. The U.S. Congress is now in a position to remedy these problems by implementing the C.T.E.A.

This Article examines the practical application and policy implications of the new and proposed laws. Part I provides back-

The term of 70 years p.m.a. does not apply to anonymous or pseudonymous works whose terms of protection are measured from the date of their being made available to the public, the terms of which are also extended 20 years. *Id.* art. 1(3), O.J. L 290/9, at 11.

14. *Id.* art. 10(2), O.J. L 290/9 at 12.

15. H.R. 989, 104th Cong., 1st Sess. (1995); S. 483, 104th Cong., 1st Sess. (1995); 141 CONG. REC. S3390-94 (daily ed. Mar. 2, 1995) (statement of Sen. Hatch).

16. *See infra* part II.D.

17. *See infra* part II.A.1 (discussing revival of EU copyrights); *see also infra* part II.C.1 (discussing revival of United States copyrights).

18. *See infra* part II.A.1 (discussing extended term of EU copyrights).

19. *See infra* part II.A.1 (discussing discriminatory effects of new laws).

ground information on the relevant provisions of the Berne Convention, and on previous EU and U.S. laws,²⁰ including how such laws compare against the standards of the Berne Convention. Part II details the new laws—the EC Term Directive, the U.R.A.A., and TRIPs—and analyzes the proposed C.T.E.A. Part III analyzes the effects of the EC Term Directive on EU-U.S. copyright term analysis, and demonstrates how the C.T.E.A. would, if adopted, bring U.S. law back into closer harmony with the EU, as well as reduce the problems that result from the discriminatory effects of the EC Term Directive against U.S. authors and works first published in the United States and ultimately benefit the public with increased certainty in rights, and increased access to works.

I. DURATION OF COPYRIGHT—BACKGROUND

Determining the duration of copyright protection for a given work in a specific country can be a complicated process involving a myriad of national laws and international conventions, treaties, directives, and court decisions. The Berne Convention provides a framework for analyzing the new copyright duration laws because it requires its signatory countries to grant certain minimum protections to the authors of other signatory countries.²¹ It also contains rules on national treatment,²² the rule of the shorter term,²³ and on the determination of a work's country of origin.²⁴ The United States became a signatory to the Berne Convention effective

20. Bilateral treaties to which the United States is a party can also affect the term of copyright protection a work of authorship will be accorded in a specific country. RICKETSON, *THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS: 1886-1986* ¶¶ 1.29-1.42 (1987). The Berne Convention explicitly permits continued enforceability of bilateral treaties to the extent such treaties grant greater protection than the Berne Convention. Berne Convention, *supra* note 4, art. 20, 828 U.N.T.S. at 251-53. However an analysis of the effects of these bilateral treaties is outside the scope of this Article.

21. Berne Convention, *supra* note 4, art. 29, 828 U.N.T.S. at 271-73.

22. *See infra* part I.A.2.

23. *See infra* part I.A.2.

24. *See infra* part I.A.3.

March 1, 1989,²⁵ and all EU Member States are signatory members.²⁶ Thus, the Berne Convention must be understood in order to interpret and apply the recently-adopted EU and U.S. laws and to assess the proposed legislation in the United States.²⁷ EU law is also reviewed in this section, including the effect of the European Court of Justice's decision in *Phil Collins v. Imtrat Handelsgesellschaft mbH*²⁸ on calculating copyright duration. Finally, previous U.S. copyright duration law is discussed, to provide the context for analyzing the effects of the EC Term Directive, the U.R.A.A., and the proposed C.T.E.A.

A. Berne Convention

Berne prescribes certain minimum standards of protection that Berne-signatory countries must accord works.²⁹ Additionally, Berne establishes a principle of national treatment for all authors of Berne signatory countries,³⁰ and provides a minimum term of copyright protection which signatory countries must accord works.³¹ However, the Berne Convention also provides an exception to the principle of national treatment and the minimum term. This exception is known as the rule of the shorter term, which allows signatory countries to provide only the same term of protection in their

25. Berne Convention Implementation Act, Pub. L. No. 100-568, 102 Stat. 2853, 2860 (1988).

26. Berne Convention, *supra* note 4, 828 U.N.T.S. at 294-300.

27. The Universal Copyright Convention (U.C.C.), to which the United States became a signatory in 1955, is an international copyright treaty that runs parallel to Berne, but that, originally, had certain signatories that were not willing to accept Berne's requirements. The U.C.C. is not discussed in this Article, as all of the countries that are discussed are members of the Berne Convention and are required to apply the terms of the Berne Convention over the U.C.C. 3 NIMMER ON COPYRIGHT, *supra* note 6, § 17.01[B], at 17-11; Ralph Oman, *The United States and the Berne Union: An Extended Courtship*, 3 J.L. & TECH. 71 (1988).

28. *Phil Collins v. Imtrat Handelsgesellschaft mbH*, Joined Cases C-92/92 and C-326/92, [1993] 3 C.M.L.R. 773, 793.

29. See *infra* part I.A.2.

30. Berne Convention, *supra* note 4, art. 3(2), 828 U.N.T.S. at 231.

31. *Id.* art. 7 (1), 828 U.N.T.S. at 235-37.

country as the work receives in its country of origin.³² To correctly apply the rule of the shorter term, one must determine the "country of origin" of a work, as well as understand Berne's prohibition on formalities and its retroactive applicability. Finally, to properly interpret Berne as it relates to the national laws of signatory countries, the enforcement provisions of Berne must be understood.

1. Principle of National Treatment

The Berne Convention does not *standardize* the copyright laws of the Berne signatory countries. Instead it sets minimum standards for protection in certain areas of copyright.³³ For example, Berne principally provides that a Berne signatory country must give the nationals of all Berne country authors the same treatment it accords works by its own nationals.³⁴ This principle of "national treatment" is one of the fundamental tenets of the Berne Convention,³⁵ but is subject to several exceptions that permit Berne-signatory countries to adopt their own laws to address certain issues—namely, design protection,³⁶ *droit de suite* (resale rights)³⁷

32. *Id.* art. 7(8), 828 U.N.T.S. at 237; *see infra* part 1.A.2.

33. *Id.* arts. 7(1), 19, 828 U.N.T.S. at 235, 251. Member countries are free to enter into treaties with provisions which grant to authors more extensive rights than those granted in the Berne Convention. *Id.* art. 20, 828 U.N.T.S. at 251-52.

34. *Id.* art. 5(2), 828 U.N.T.S. at 231-33. Under Berne, "[a]uthors who are not nationals of one of the countries of the Union but who have their habitual residence in one of them shall, for the purpose of this Convention, be assimilated to nationals of that country." *Id.* art. 3(2), 828 U.N.T.S. at 231.

35. *Id.* art. 5(1), 828 U.N.T.S. at 231-33 ("Authors shall enjoy, in respect of works for which they are protected under this Convention, in countries of the Union other than the country of origin, the rights which their respective laws do now or may hereafter grant to their nationals, as well as the rights specially granted by this Convention."); *see also* WORLD INTELLECTUAL PROPERTY ORGANIZATION, WIPO GUIDE TO THE BERNE CONVENTION 32, 35 (1988) [hereinafter WIPO GUIDE]. ("Article 5 sets out the fundamental principles on which the Convention is based."); RICKETSON, *supra* note 20, ¶ 5.66, at 205 (The principle of national treatment is one of the "twin pillars on which protection under the Convention rests."); Oman, *supra* note 27, at 71.

36. Berne Convention, *supra* note 4, art. 2(7), 828 U.N.T.S. at 229. Berne does not mandate protection for industrial designs, but rather requires protection only in so far as they are "protected as artistic works" in the country in which protection is sought. *Id.*

37. *Id.* art. 14", 828 U.N.T.S. at 245-47. A right of an author for compensation

and, notably, copyright duration.³⁸

2. Minimum Duration and the Rule of the Shorter Term

The minimum term of protection required by the Berne Convention for works created by individual authors, except anonymous works, pseudonymous works, and works made for hire, is 50 years p.m.a.³⁹ Berne allows signatory countries to exceed this minimum⁴⁰ and also allows its signatory countries to apply the rule of the shorter term.⁴¹

Under the rule of the shorter term, also known as the "comparison of terms," a Berne signatory country may cease protecting a work when the duration of copyright has expired in the work's country of origin.⁴² This rule also provides that if the country of origin has a *longer* term than the term granted by the country in which protection is sought, the latter country's shorter term is permitted to apply.⁴³ Therefore, works by authors from Berne signatory countries are required under Berne to receive a minimum term of protection of 50 years p.m.a. in other Berne countries, unless such work was first published in a shorter term country and the country in which protection is sought applies the rule of the shorter term.⁴⁴

upon resale of his work is required under Berne "only if the legislation in the country to which the author belongs" recognizes the right, and then only "to the extent permitted by the country where this protection is claimed." *Id.* art. 14^{ter}(2), 828 U.N.T.S. at 247.

38. *Id.* art. 7(8), 828 U.N.T.S. at 237; *see infra* part I.A.2.

39. *Id.* art. 7(1), 828 U.N.T.S. at 235. The term for anonymous and pseudonymous works is 50 years after publication of the work. *Id.* art. 7(3), 828 U.N.T.S. at 237. The term for works made for hire is not specified in the Berne Convention.

40. *Id.* art. 19, 828 U.N.T.S. at 251. ("The provision of this Convention shall not preclude the making of a claim to the benefit of any greater protection which may be granted by legislation in a country of the Union.").

41. *Id.* art. 7(8), 828 U.N.T.S. at 237 ("In any case, the term shall be governed by the legislation of the country where protection is claimed; however, unless the legislation of that country otherwise provides, the term shall not exceed the term fixed in the country of origin of the work.").

42. *Id.*

43. *Id.*

44. *Id.*

Nearly all EU Member States have adopted the rule of the shorter term.⁴⁵ Works created by U.S. authors therefore receive the rule of the shorter term treatment in most EU Member States, unless the work was first published in a non-U.S. Berne-signatory country. However, since the United States has not adopted the rule of the shorter term,⁴⁶ if a party seeks to enforce the copyright of a foreign work in the United States, the full term of U.S. duration will be granted to that foreign work, so long as the author of the work is a national of one of the countries that is specified in U.S. copyright law.⁴⁷

3. Determining the "Country of Origin"

Because the rule of the shorter term is applied by comparing the term of a work's "country of origin" with the applicable term in the country in which enforcement is sought, establishing a work's country of origin is a prerequisite for determining the term of protection that work will be accorded.⁴⁸ Berne defines the rules for determining a work's country of origin.⁴⁹ The variables in this rule are whether a work has been "published";⁵⁰ whether it was published in a second country within 30 days of the first publication (known as "simultaneous publication");⁵¹ and whether the

45. COM (92) 33 Final—SYN 395, C 92/6 OJ (1992) [hereinafter COM (92)]; *see infra* part I.B.1 (discussing the national rules of the EU member states).

46. 17 U.S.C. §§ 302-305 (1994).

47. 17 U.S.C. § 104 (1996); *see infra* part I.C.4 (discussing the lack of application of the rule of the shorter term in the United States).

48. Country of origin analysis is not required for determining the length of protection a given work will be accorded in the United States, because the United States does not apply the rule of the shorter term. *See infra* part I.C.5.

49. Berne Convention, *supra* note 4, art. 5(4), 828 U.N.T.S. at 233.

50. Works are "published" when they have been published "with the consent of their authors, whatever may be the means of manufacture of the copies, provided that the availability of such copies has been such as to satisfy the reasonable requirements of the public, having regard to the nature of the work." *Id.* art. 3(3), 828 U.N.T.S. at 231. The country of origin analysis is based upon traditional notions of "publication," which are being questioned in view of on-line methods of distribution that result in simultaneous "publication" of a work world-wide. *See Green Paper, supra* note 12, COM (95) 382 Final at 25.

51. Berne Convention, *supra* note 4, art. 3(4), 828 U.N.T.S. at 233.

country of first publication or one of the countries of simultaneous publication is a Berne signatory country.⁵²

Article 5(4) of the Berne Convention defines the country of origin of a work as follows:

(a) in the case of works first published in a country of the Union, that country; in the case of works published simultaneously in several countries of the Union which grant different terms of protection, the country whose legislation grants the shortest term of protection;

(b) in the case of works published simultaneously in a country outside the Union and in a country of the Union, the latter country;

(c) in the case of unpublished works or of works first published in a country outside the Union, without simultaneous publication in a country of the Union, the country of the Union of which the author is a national.⁵³

According to article 5(4), if a work is published, the country or countries of publication determine the country of origin. If a work is first published in a Berne signatory country, and not simultaneously published in another country, the country of first publication is the work's country of origin.⁵⁴ If a work is published in one Berne signatory country and then published within 30 days in another Berne signatory country, the shorter-term country is the country of origin.⁵⁵ If a work is published in a non-Berne signatory country, and published within 30 days in a Berne-signatory country, the Berne signatory country will be the work's country of origin.⁵⁶ The author's nationality determines the country of origin *only* if a work is unpublished, or if it is first published in a non-Union coun-

52. *Id.* art. 5(4)(a), 828 U.N.T.S. at 233.

53. *Id.*

54. *Id.*

55. *Id.* art. 5(4)(b), 828 U.N.T.S. at 233.

56. *Id.* art. 3(4), 828 U.N.T.S. at 231.

try without simultaneous publication in a Berne-signatory country.⁵⁷

4. Retroactive Effect of Berne

In accordance with article 18(1) of the Berne Convention, new signatories to Berne must retroactively apply the Berne Convention minimums to all works which, upon the date of that country's accession to Berne, had not yet fallen into the public domain of that country due to expiry of the term of protection.⁵⁸

Article 18(1) of the Berne Convention provides that the Berne rules "apply to all works which, when Berne comes into force in a new signatory country, have not yet fallen into the public domain in the country of origin *through the expiry of the term of protection*."⁵⁹ If, however, a work has fallen into the public domain of the country where protection is claimed *through the expiry of the term of protection*, that work shall not be protected anew.⁶⁰

The result of these provisions is that if, as of the date of a particular country's accession to Berne, a particular work has not fallen into the public domain in either the country of origin or the country in which protection is sought, the new signatory is required to apply the durational rules of Berne.⁶¹ If the work has fallen into the public domain for reasons *other than* through the expiry of the term of protection, such as failure to fulfill copyright formalities, the work must be retroactively protected by the newly-acceding

57. *Id.*

58. The extent of retroactivity, and the accommodation of rights acquired by third parties, is left for Berne signatory countries to decide. WIPO GUIDE, *supra* note 20, at 127. However, "there is no basis on which the principle of retroactivity can be completely denied" by a newly acceding country to Berne. RICKETSON, *supra* note 20, ¶ 12.11, at 675.

59. Berne Convention, *supra* note 4, art. 18(1), 828 U.N.T.S. at 251 (emphasis added). The phrase "its coming into force" originally applied to retroactivity for the original Berne signatory countries, and to new revisions to Berne, but is also read to mean when "it comes into force in newly-ratifying countries." RICKETSON, *supra* note 20, at 672.

60. *Id.* art. 18(2), 828 U.N.T.S. at 251.

61. *Id.* arts. 18(1),(2),(4), 828 U.N.T.S. at 251.

country.⁶² However, works that have fallen into the public domain upon the country's date of accession to Berne, even if they expired as a result of a shorter than 50 years p.m.a. term, are not required to be protected.⁶³

The United States' accession to the Berne Convention reveals certain problems regarding the application of Articles 5(4)(b) (country of origin) and 18(1) (retroactivity). The country of origin of works simultaneously published in a Berne country and the United States, before the United States became a signatory to Berne, was the Berne signatory country.⁶⁴ After the United States became a signatory to Berne, rather than retaining their original country of origin, these works acquire a U.S. country of origin.⁶⁵ Because Berne—including the country of origin rules—applies to works that have not expired when a country accedes to Berne, these simultaneously-published works that first had a non-U.S. country of origin under article 5(4)(b) acquire a U.S. country of origin, if the United States grants a shorter term of protection than the Berne country.⁶⁶ This result is contrary to the conclusion that could be reached upon a first reading of Berne's country of origin rules.⁶⁷

Before the United States became a signatory to Berne, authors took advantage of the longer term benefits of a Berne country when they published simultaneously in the United States and in a Berne country. After the United States' accession to Berne, such authors find their simultaneously-published works subject to the detriments of the United States' shorter terms of protection resulting from retroactive operation of article 5(4) combined with appli-

62. *Id.* art. 18(2), 828 U.N.T.S. at 251; *see also id.* art. 5(2), 828 U.N.T.S. at 233.

63. *See* Oman, *supra* note 27, at 91.

64. Berne Convention, *supra* note 4, art. 5(4)(b), 828 U.N.T.S. at 233.

65. *Id.*

66. *Id.* art. 5(4)(a), 828 U.N.T.S. at 233.

67. *See* Berne Convention, *supra* note 4, art. 5(4)(b), 828 U.N.T.S. at 233. The country of origin of a work "published simultaneously in a country outside the Union and in a country of the Union [is] the latter country." *Id.*

cation of the rule of the shorter term.⁶⁸

5. Formalities under Berne

Berne prohibits signatory countries from imposing any formality on authors as a condition to their acquiring or receiving protection for their copyrights.⁶⁹ Further, Berne mandates that an author's enjoyment and exercise of her rights "shall be independent of the existence of protection in the country of origin of the work."⁷⁰ Therefore, a Berne country in which protection exists cannot cease protecting a work because protection has lapsed in the country of origin due to failure to fulfill formalities.⁷¹ Accordingly, if a work is unprotected in its country of origin due to failure to fulfill copyright formalities, such work must nonetheless be protected in other Berne countries.⁷²

6. Treatment in the Country of Origin

If an author seeks to enforce a copyright in the country of origin of the work, such work is governed by domestic law and need not receive the minimum protections specified in Berne.⁷³ Article 5(3) of Berne states that: "[p]rotection in the country of origin is governed by domestic law."⁷⁴ Berne states further that: "[a]uthors shall enjoy . . . in countries of the Union other than the country of origin, the rights which their respective laws do now or may hereafter grant to their nationals, as well as the rights specially granted by this Convention."⁷⁵ Therefore, if an author wishes to enforce

68. RICKETSON, *supra* note 20, ¶ 5.78, at 218 ("[A] possible problem may arise where the term of protection for the new country of origin is shorter than the old country of origin: is the author of the work to be prejudiced by this change?") This is precisely the situation in which authors who simultaneously published their works in the United States and a longer term Berne country find themselves.

69. Berne Convention, *supra* note 4, art. 5(2), 828 U.N.T.S. at 233.

70. *Id.*

71. See NIMMER & GELLER, *supra* note 1, § 5(3)(1)(b), at INT-164 ("The rule of the shorter term should not be applied in derogation of the prior and more basic principle that Berne rights should [not] depend on formalities.").

72. *Id.*; RICKETSON, *supra* note 20, ¶ 12.8.

73. Berne Convention, *supra* note 4, art. 5(1), 828 U.N.T.S. at 231-33.

74. *Id.* art. 5(3), 828 U.N.T.S. at 233.

75. *Id.* art. 5(1), 828 U.N.T.S. at 231-33.

his work in the country of the work's origin, the author's entitlements are derived exclusively from domestic law, rather than from the Berne Convention.⁷⁶

7. Berne is not a Self-Executing Treaty

Article 36 of the Berne Convention requires all Berne signatory countries to adopt "measures necessary to ensure the application of this Convention."⁷⁷ Therefore, the national laws of the country in which protection is sought apply to questions arising within the boundaries of that country.⁷⁸ If a signatory country does not adopt laws consistent with Berne, and that signatory country does not have an overriding law which states that treaties are self-executing, aggrieved individuals may not directly resort to rights under Berne.⁷⁹ Rather, Berne is enforced by the operation of a complaint system in place for signatory countries.⁸⁰ Under the Berne dispute resolution regime, disputes between Berne signatory countries may be brought before the International Court of Justice.⁸¹ Berne signatory countries may opt out of this dispute mechanism procedure.⁸² Indeed, this dispute mechanism procedure has never been used.⁸³ The dispute mechanism procedure in Berne has been largely supplanted by the procedure in TRIPs, which is considered to be vastly superior.⁸⁴

76. *See id.* art. 5(1),(2), 828 U.N.T.S. at 231-33.

77. *Id.* art. 36, 828 U.N.T.S. at 277.

78. WIPO Guide, *supra* note 35, at ¶ 2.21.

79. *Id.* ¶¶ 2.21, 36.5.

80. Berne Convention, *supra* note 4, art. 33(1), 828 U.N.T.S. at 275-77. The Berne Convention provides that:

"Any dispute between two or more countries of the Union concerning the interpretation or application of this Convention, not settled by negotiation, may, by any one of the countries concerned, be brought before the International Court of Justice by application in conformity with the Statute of the Court, unless the countries concerned agree on some other method of settlement."

Id.

81. *See id.*

82. *Id.* art. 33(2), 828 U.N.T.S. at 277.

83. Emery Simon, *GATT and NAFTA Provisions on Intellectual Property*, 4 FORDHAM INTELL. PROP., MEDIA & ENT. L.J. 267, 270 (1993); *see also* NIMMER ON COPYRIGHT, *supra* note 6, § 18.05[A][2], at 18-34 to 18-35.

84. *See infra* part II.B.2.

B. *Duration of Protection under EU Law Prior to the EC Term Directive*

The national laws of individual EU Member States govern the duration of copyright protection and application of the rule of the shorter term within that country.⁸⁵ Under the EC Treaty, however, each Member State's laws may not discriminate against nationals of other Member States.⁸⁶

1. *Duration and the Rule of the Shorter Term*

Before the EC Term Directive, all EU Member States except Germany and Spain had a duration of protection of 50 years p.m.a. for works created by individual or joint authors.⁸⁷ Belgium, Denmark, Finland, France, Germany, Italy, Spain, Sweden, and the Netherlands apply the rule of the shorter term,⁸⁸ whereas the United Kingdom ("U.K.") and Austria do not apply the rule of the shorter term.⁸⁹ All EU Member States were required to have implemented the EC Term Directive and amend their national laws to provide 70 p.m.a. copyright protection on or before July 1, 1995.⁹⁰

85. *Phil Collins*, [1993] 3 C.M.L.R. 773, 796 (citation omitted); see also J. Loewenhiem, *Intellectual Property Before the European Court of Justice*, 26 INT'L REV. IND. PROP. & COPYRIGHT L. 829, 841 (1995) (discussing European Court of Justice holdings to this effect).

86. EC Treaty, *supra* note 3, art. 6. The principle of non discrimination was originally found in article 7 of the EEC Treaty, *supra* note 3, and the SEA, *supra* note 3, but was moved to article 6 in the TEU, *supra* note 3. All subsequent references to the principle of non-discrimination in this Article will refer to article 6 of the EC Treaty, *supra* note 3.

87. Germany provided 70 years p.m.a. protection and Spain provided 60 years. These terms do not include certain war-time extensions, which were implemented in France (six years), Law of 3 Feb. 1919, and (eight years), Law of 21 Sept. 1951; Italy (twelve years), Legislative Decree of 20 July 1945 and Law of 19 Dec. 1956; and Belgium (10 years), Law of 25 June 1921. COM (92), 33 Final SYN 395, C 92/6 OJ at 30 (1992).

88. *Id.*

89. It should be noted that these duration and rule of the shorter term conclusions are based upon current laws, and certain exceptions may apply as to works governed by earlier laws and/or bilateral treaties.

90. Council Directive No. 93/98, *supra* note 12, art. (3)(1), O.J. L 250/9, at 13 (1993). To date only Belgium has implemented the necessary national laws. See *supra* note 3.

2. *Phil Collins* and the Principle of Nondiscrimination

EU Member States may not adopt laws that discriminate against nationals of other Member States.⁹¹ If a national court of a Member State believes an individual's claim presents a conflict between national law and EC law, the national court may refer the question to the European Court of Justice.⁹²

In *Phil Collins v. Imtrat Handelsgesellschaft mbH*,⁹³ the European Court of Justice ("Court of Justice") was asked whether a German law pertaining to performers' rights violated the nondiscrimination principle of the EC Treaty.⁹⁴ The Court of Justice confirmed that the general right of non-discrimination applies in the area of copyright and related rights.⁹⁵

Phil Collins involved an attempt by Phil Collins, a U.K. national, to enjoin distribution in Germany of a bootlegged recording of a concert performed in the United States.⁹⁶ German law provides a cause of action for such infringements, but only for German nationals.⁹⁷ The Court of Justice held that German law was discriminatory and therefore violated Article 6 of the EC Treaty.⁹⁸ Article 6 of the EC Treaty prohibits any discrimination on grounds of nationality as between nationals of Member States.⁹⁹ The Court of Justice acknowledged that in the absence of EU harmonization, Member States may adopt national laws to determine the conditions governing the grant of intellectual property rights.¹⁰⁰ It then held that granting such rights to German nationals while denying such rights to non-German EU nationals was discriminatory and, therefore, violated the nondiscrimination principle set forth in the EC

91. EC Treaty, *supra* note 3, art. 6.

92. *Id.* art. 177.

93. *Phil Collins*, [1993] 3 C.M.L.R. at 791.

94. *Id.* [1993] 3 C.M.L.R. at 794, ¶ 5.

95. *Id.* [1993] 3 C.M.L.R. at 797, ¶ 27.

96. *Id.* [1993] 3 C.M.L.R. at 793, ¶ 3.

97. *Id.* [1993] 3 C.M.L.R. at 793-94, ¶ 4.

98. *Id.* [1993] 3 C.M.L.R. at 797-98, ¶ 28.

99. E.C. Treaty, *supra* note 3, art. 6.

100. *Phil Collins*, [1993] 3 C.M.L.R. at 796, ¶ 24.

Treaty.¹⁰¹

Even though *Phil Collins* did not concern copyright duration, the Advocate General discussed the applicability of the nondiscrimination principle to the duration of protection:

as regards the consequences of applying the principle of non-discrimination to copyright law in general and to the question of the term of protection, it may well be that [Article 6] of the Treaty requires each member-State to grant to all Community nationals the same term of protection as its own nationals, even though the latter receive a shorter term of protection in other member States.¹⁰²

It follows that if an EU Member State exempts the works of its nationals from rule of the shorter term, it must also exempt other EU-national's works.

It should be noted that *Phil Collins* does not pre-empt the application of the rule of the shorter term analysis entirely. It merely states that if a country provides preferential treatment to its nationals, it must also provide those preferences to nationals of other EU Member States.¹⁰³

3. *Phil Collins* Complies with Berne

The decision in *Phil Collins* supports the application of the principle of nondiscrimination between EU nationals in the exercise of copyrights and related rights.¹⁰⁴ Under Berne, the *Phil Collins* principle of nondiscrimination need not be extended to benefit the copyright duration of non-EU nationals unless their works have an EU country of origin.¹⁰⁵ The rule of the shorter term¹⁰⁶ permits a

101. *Id.* [1993] 3 C.M.L.R. at 797-98, ¶ 28.

102. Opinion of Advocate General Jacobs, *Phil Collins v. Imtrat Handelsgesellschaft mbH*, Joined Cases C-92/92 and C-326/92, [1993] 3 C.M.L.R. 773, 789.

103. See *Phil Collins*, [1993] 3 C.M.L.R. at 798, ¶ 32.

104. *Id.*, [1993] C.M.L.R. at 799, ¶¶ 27-28.

105. Berne Convention, *supra* note 4, art. 5(3), 828 U.N.T.S. at 233. Some commentators have stated, however, that TRIPs could obligate the EC Member States to accord full national treatment as provided in *Phil Collins* to the nationals of all other WTO members. 1 NIMMER & GELLER, *supra* note 1, § 5, at INT-154.

country to terminate protection for a work upon the date of expiration in that work's country of origin, even if such date of expiration antedates when the work would have expired if published in the country where protection is sought.¹⁰⁷

4. Enforcement of Nondiscrimination Rights under the EC Treaty

EU-national authors can rely directly on the Court of Justice's rulings on equal treatment under Article 6 of the EC Treaty, because these rulings immediately become binding law in all countries of the EU.¹⁰⁸ The Court of Justice reiterated this principle in *Phil Collins*:

As the Court has consistently held, the right to equal treatment laid down by [Article 6] is conferred directly by Community law. [Cowan, Case 186/87 [1969] E.C.R. I, [1969] C.M.L.R. 100.] The right can therefore be relied upon before the national court when asking it to set aside the discriminatory provisions of a national law which refuses nationals of other member-States the protection accorded to nationals of the State in question . . . the principle of non-discrimination which it lays down can be relied upon directly before the national court by an author or artist of a member-State or his successor in title in order to seek the protection given to national authors and artists.¹⁰⁹

Accordingly, if an EU-national copyright owner is harmed by discriminatory application of an EU Member State's copyright laws, that party can claim rights under the EC treaty directly in national courts.

106. Berne Convention, *supra* note 4, art. 7(8), 828 U.N.T.S. at 237.

107. *Id.*

108. *Phil Collins*, [1993] 3 C.M.L.R. at 798-99, ¶¶ 34-35.

109. *Id.*

*C. Duration of Protection under Pre-U.R.A.A.**U.S. Copyright Law*

The Copyright Act of 1976 ("1976 Act"),¹¹⁰ while adopting a Berne-level term protection for works created on or after its effective date,¹¹¹ created a complicated durational scheme which established duration guidelines for three categories of works: (1) works created before January 1, 1978, with subsisting copyrights;¹¹² (2) works that had been created, but not published¹¹³ or copyrighted, i.e., registered,¹¹⁴ before January 1, 1978;¹¹⁵ and (3) works created after January 1, 1978.¹¹⁶

1. Works Created before January 1, 1978, with
Subsisting Copyrights

Under the 1976 Act, the duration of protection for all works with subsisting statutory copyrights (e.g. published or registered works) created before January 1, 1978, is 75 years following the date of publication.¹¹⁷ Determining whether a work created before January 1, 1978, has a subsisting copyright requires consulting the Copyright Act of 1909 ("1909 Act")¹¹⁸ to analyze whether the work was published with proper copyright notice and whether other stat-

110. 17 U.S.C. § 101 *et seq.* (1994).

111. *Id.* at § 302(a).

112. *Id.* at § 304.

113. Publication is defined as:

the distribution 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.

Id. at §101.

114. Prior to enactment of the 1976 Act, registration was required for federal protection in the United States. Act of March 4, 1909, Ch. 320, §§ 9-12, 35 Stat. 1075, 1077-78.

115. 17 U.S.C. § 303. All terms specified endure until the end of the calendar year in which they would otherwise expire. *Id.* at § 305.

116. *Id.* at § 304.

117. *Id.*; see also 2 NIMMER ON COPYRIGHT, *supra* note 6, § 9.01[c], at 9-19 to 9-23.

118. Act of March 4, 1909, Ch. 320, 35 Stat. 1075.

utory formalities were met.¹¹⁹ Under the 1909 Act, failure to publish with proper notice automatically injected the work into the public domain, except under certain limited circumstances.¹²⁰ The 1976 Act, however, provided for certain "curative" steps that could be taken by authors who first published their work without proper notice.¹²¹ Additionally, the 1909 Act's notice requirements were

119. In very brief summary, the formalities regarding copyright notice and renewal dictated by the 1909 Act, the 1976 Act, the Berne Convention Implementation Act of 1988, and the Copyright Renewal Act of 1992 are as follows:

Notice - works published between the dates:

1909-1978: proper notice required. Act of March 4, 1909, Ch. 320, 35 Stat. 1075.

1978-3/1/89: notice or "curative notice" required. 17 U.S.C. §401-402 (1976).

3/1/89 +: no notice required. See 2 NIMMER ON COPYRIGHT, *supra* note 6, § 7.02[C][3], at 7-17.

Renewal - works created between the dates:

pre-1950: renewal required during first 28-yr. term for an additional term of 28 years. Act of March 4, 1909, Ch. 320, 35 Stat. 1075.

1950-1964: renewal required during first 28-yr. term for an additional term of 47 years. Act of Oct. 19, 1976, Pub. L. No. 94-553, 90 Stat. 2541; see also 2 NIMMER ON COPYRIGHT, *supra* note 6, § 9.05[B], at 9-68.1 to 9-71.

1964-1977: renewal required but can be filed any time during first or extension terms. Act of Oct. 19, 1976, Pub. L. No. 94-553, 90 Stat. 2541.

1978 +: renewal not required. See 2 NIMMER ON COPYRIGHT, *supra* note 6, § 9.05[B], at 9-68 to 9-70 (detailed discussion of renewal requirements).

120. Act of March 4, 1909, ch. 320, § 12, 35 Stat. 1075, 1078.

121. 17 U.S.C. § 405 (Authors could take "reasonable effort . . . to add notice to all copies or phonorecords that are distributed to the public in the United States after the omission had been discovered.").

not eliminated by the 1988 Amendments to the 1976 Act.¹²²

The 1909 Act also required compliance with certain renewal requirements to prevent a work from falling into the public domain.¹²³ Under the 1976 Act, works by foreign authors first published in the United States were not exempt from either the notice or renewal requirements.¹²⁴ Consequently, a large number of both EU and U.S. origin works fell into the public domain in the United States for failure to meet these formalities.¹²⁵

2. Works Created but not Published or Copyrighted before January 1, 1978

Prior to the 1976 Act, works that were unpublished and unregistered did not receive federal copyright protection.¹²⁶ With enactment of the 1976 Act, works created but not published or copyrighted before January 1, 1978, were granted the same duration of copyright protection as those works created after January 1, 1978.¹²⁷ Thus, these works receive a duration of 50 years p.m.a.¹²⁸ Additionally, U.S. law provides that in no case shall the term of copyright in such a work expire before December 31, 2002,¹²⁹ and if the work is published on or before December 31, 2002, the term of copyright shall not expire on or before December 31, 2027.¹³⁰

122. Pub. L. No. 94-553, tit. I, § 101, Oct. 19, 1976, 90 Stat. 2576 (codified at 17 U.S.C. § 401), amended by Pub. L. No. 100-588, § 7(a)(1)-(4), Oct. 31, 1988, 102 Stat. 2857. An additional requirement imposed by the 1909 Act and not eliminated by the 1976 Act was the need to manufacture the work in the United States to qualify for copyright protection. 17 U.S.C. § 106 (a), as amended by the Act of July 13, 1982, Pub. L. No. 97-215 (1983).

123. Act of March 4, 1909, ch. 320, § 23-24, 35 Stat. 1075 at 1080-81.

124. 17 U.S.C. § 104(b); see also 2 NIMMER ON COPYRIGHT, *supra* note 6, § 9.01[D][1], at 9-23.

125. See *infra* part I.C.5.

126. Act of March 4, 1909, ch. 320, § 1, 35 Stat. 1075

127. 17 U.S.C. § 303.

128. *Id.* at § 302(a).

129. *Id.* at § 303.

130. *Id.*

3. Works Created on or after January 1, 1978

Works created by individual authors on or after January 1, 1978, receive copyright protection for a term of 50 years p.m.a.¹³¹ Joint works¹³² which were not created for hire¹³³ currently have a term of 50 years p.m.a. of the last-surviving author.¹³⁴ Copyright in works made for hire endures for a term of 75 years from the year of first publication, or a term of 100 years from creation, whichever expires first.¹³⁵

4. Works of Foreign Origin

Under the 1976 Act, unpublished works by foreign authors receive copyright protection in the United States for the same length of time and under the same conditions as works created by U.S. authors.¹³⁶ Published works by all authors are granted protection under the 1988 amended version of the 1976 Act if:

- (1) on the date of first publication, one or more of the authors is a national or domiciliary of the United States, or is a national, domiciliary, or sovereign authority of a foreign nation that is a party to a copyright treaty to which the United States is also party, or is a stateless person, wherever that person may be domiciled; or
- (2) the work is first

131. *Id.* at § 302(a).

132. "A 'joint work' is a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole." *Id.* at § 101.

133. A "work made for hire" is—

- (1) a work prepared by an employee within the scope of his or her employment;

or

- (2) a work specially order or commissioned for use as a contribution to a collective work, as part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.

Id. at § 101.

134. *Id.* at § 302(b).

135. *Id.* at § 302(c).

136. *Id.* at § 104(a).

published in the United States or in a foreign nation that, on the date of first publication, is a party to the Universal Copyright Convention; or (3) the work is published by the United Nations or any of its specialized agencies, or by the Organization of American States; or (4) the work is a Berne Convention work; or (5) the work comes within the scope of a Presidential proclamation.¹³⁷

These provisions result in protection for all EU author works, and for works first published in the United States or other Berne countries. Because the United States does not apply the rule of the shorter term, the authors from the countries that are eligible¹³⁸ will get the full term of protection provided under U.S. law.¹³⁹

5. Prior U.S. Copyright Law did not Comply with Berne

For works published or registered after 1978, the U.S. term is the same as that mandated by Berne: 50 years p.m.a.¹⁴⁰ However, for works published or registered before that date, U.S. copyright protection fails to meet Berne obligations in two respects. First, as a result of calculating the copyright term for pre-1978 works, the duration for some works will be shorter than the 50 years p.m.a. minimum required by Berne.¹⁴¹ Second, as a result of pre-1978 copyright formalities, the copyrights lapsed in many works that would have remained protected in the absence of such formalities.¹⁴²

137. *Id.* at § 104(b).

138. *Id.*

139. *Id.* at § 104(a).

140. Berne Convention, *supra* note 4, art. 7(1), 828 U.N.T.S. at 235.

141. *Id.*; see also Restoration of Certain and WTO works, 60 Fed. Reg. 35,522 (1995) (to be codified at 37 C.F.R. 201-02) (stating that "[t]he United States arguably failed to fully conform its law to the Berne Convention in 1989 when it declined to interpret Article 18(1) on restoration [of copyright] as being mandatory") (footnote omitted).

142. The U.S. Copyright Office expects to receive thirty to fifty-thousand notices of intent to enforce annually—a good indicator of the magnitude of the number of works that fell into the U.S. public domain as a result of failure to fulfill copyright formalities. Copyright Office Hearing on Restored Copyrights, BNA-PAT., COPYRIGHT & TRADEMARK DAILY, Mar. 29, 1995 (statement of Copyright Office Acting General Counsel Marilyn

a. Copyright Term Deficiencies

Article 18 of the Berne Convention requires that Berne signatories protect works that have not, as of the date a country accedes to the Berne Union, fallen into the public domain through the expiry of the term of protection in the country under which protection is sought.¹⁴³ Therefore, all works that had subsisting copyrights in the United States on March 1, 1989, (the effective date of United States' accession to Berne), are required to be protected for a minimum of 50 years p.m.a.¹⁴⁴ Under Berne, works that expired on or before March 1, 1989, due to a shorter term of protection, are not required to be revived.¹⁴⁵

Under current U.S. law, the maximum term of protection for pre-1978 works that have subsisting copyrights is 75 years post-publication.¹⁴⁶ Therefore, any works published before 1914¹⁴⁷ and in the public domain on or before the United States' accession to Berne are not required to be protected or revived under Berne.¹⁴⁸ Works that were published between 1915 and December 31, 1977, are required, under Berne, to have a minimum 50 years p.m.a., not a 75 years post-publication, term of protection.¹⁴⁹ Accordingly, all

Kretsinger).

143. Berne Convention, *supra* note 4, art. 18(1), 828 U.N.T.S. at 251.

144. *Id.* art. 18(4), 828 U.N.T.S. 251-253. The extent of retroactivity, and the accommodation of rights acquired by third parties, is left for Berne signatory countries to decide. WIPO GUIDE, *supra* note 35, at 127. However, "[t]here is no basis on which the principle of retroactivity can be completely denied" by a newly acceding country to Berne. RICKETSON, *supra* note 20, § 12.11, at 675.

145. Berne Convention, *supra* note 4, art. 18(2), 828 U.N.T.S. at 251. *See* RICKETSON, *supra* note 20, ¶ 12.10, at 673 (Article 18(2) operates to bar any claim for renewal of protection under the Convention where the term previously granted in the country where protection is claimed has already expired).

146. 17 U.S.C. § 304.

147. 1989 minus 75 years. Works that were published longer than 75 years before the effective date of the United States implementation of Berne were, on that date, in the public domain, due to the expiration of the U.S. 75 year post-publication term of copyright, and were therefore, under Berne, not required to be protected. *See* Berne Convention, *supra* note 4, art. 18(2), 828 U.N.T.S. at 251.

148. *Id.*

149. *Id.* art. 18(1), 828 U.N.T.S. 18(1); 17 U.S.C. §304(b).

such works should, to comply with Berne, receive 50 years p.m.a. protection in the United States.¹⁵⁰ Whether or not such works actually receive the Berne-minimum term under the U.S. 75-year post-publication rule depends upon the period of time that lapsed between the work's publication date and when its author died. If an author of such work died 25 or fewer years after the date of first publication of such work, protection for that work will, under U.S. duration rules, subsist sufficiently long enough to satisfy the Berne minimum. However, if the author dies more than 25 years after first publication of the work, the U.S. term will fall short of the Berne 50 year p.m.a. minimum.

Several examples illustrate this Berne-U.S. duration discrepancy: Henri Matisse, a French painter, died in 1954.¹⁵¹ Under Berne, Matisse's works should receive protection until 2004.¹⁵² Assume his work, *The Piano Lesson*, was first published, with proper copyright notice, in the year and country in which it was created—1916 in France and was properly renewed.¹⁵³ In the United States, the term of protection for this work expired in 1991, 75 years after its first publication.¹⁵⁴ Under Berne and in most countries of the EU, however, the term of protection will endure until 2004.¹⁵⁵ This represents a 13-year deficiency in the U.S. term of protection. Had the United States retroactively applied the Berne 50 year p.m.a. in 1989 when it acceded to Berne, Matisse's work would still be in force in the United States, and would endure until 2004.

By way of another example, Pablo Picasso, a Spanish painter

150. *Id.* art. 18(2), 828 U.N.T.S. at 251.

151. H. ARNASON, *HISTORY OF MODERN ART* 99 (3d ed. 1986).

152. Berne Convention, *supra* note 4, art. 7(1), 828 U.N.T.S. at 235.

153. *Id.* A work of art is not "published" by mere exhibition. *Id.* art. 3(3), 828 U.N.T.S. at 231. Publication of a work of art takes place upon reproduction of the artwork in sufficient quantities to satisfy the reasonable demands of the public, for example, by reproduction on postcards, in catalogues raisonn  , etc. See RICKETSON, *supra* note 20, ¶ 5.45, at 490.

154. 17 U.S.C. § 304 (1994).

155. Berne Convention, *supra* note 4, art. 7(1), 828 U.N.T.S. at 235; see *supra* part I.B.1 (regarding the terms of protection in EU member states.)

who lived in France for a large part of his life, died in 1973.¹⁵⁶ His work *Girl with Mandolin* was created in 1917 in France.¹⁵⁷ Assuming it was published that year in France with proper notice, the U.S. term of protection lapsed in 1992, 75 years after publication. Under Berne and in the EU, however, his works will, pre-EC Term Directive, be protected until 2023, demonstrating a 31 year term deficiency in the United States.

b. Copyright Formality Deficiencies

The formalities imposed by pre-1978 U.S. copyright law for works published or registered on or before March 1, 1978, resulted in a lapse of U.S. copyright protection that would have survived in the absence of such formalities.¹⁵⁸ Because Berne requires revival of at least some works that lapsed due to copyright formalities,¹⁵⁹ the United States was also in violation of its Berne obligations in this respect.

EU-U.S. copyright term discrepancies can be even greater if proper formalities are not met. For example, if Picasso's *Girl with Mandolin* was published without proper copyright notice, the work would have been injected into the public domain in 1917. Under Berne and in the EU, however, the work would still be protected until 2023—106 years longer than the United States term of protection.¹⁶⁰

Even after the United States became a signatory to Berne, Congress dictated that works that had fallen into the public domain

156. ARNASON, *supra* note 151, at 142.

157. *Id.*

158. See *supra* part I.C.5.a.

159. Berne Convention, *supra* note 4, art. 18(1)-(3), 828 U.N.T.S. at 251. It should be noted here that works which expired prior to U.S. implementation of Berne, due to tolling of the initial 28 year term of protection and failure to renew are not required to be restored under Berne, since Berne does not require revival of works that are in the public domain due to expiry of the copyright term. *Id.* art. 18(2), 828 U.N.T.S. at 251.

160. Note that if an author dies 25 years or fewer after one of his works is published, the U.S. term for such work will be longer than Berne requires. For example, if Picasso had died in 1937, *Girl with Mandolin* would have expired under Berne (and in the EU) in 1987, while in the U.S. it would have expired in 1992.

would not be revived,¹⁶¹ regardless of whether such works should have received protection under Berne. When the United States joined the Berne Convention, the 1976 Act was amended to provide that:

[n]o 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 that derive from this title, other Federal or State statutes, or the common law, 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.¹⁶²

By adding this language, the U.S. Congress made it explicit that works which had fallen into the public domain in the United States, for whatever reason, would not be revived. Consequently, there was a large category of works that, under current U.S. copyright law, had fallen into the public domain and should be revived in accordance with the United States' Berne obligations: namely, those works published after 1914 whose copyright terms expired under the 75 years post-publication rule,¹⁶³ and those works that expired as a result of failure to comply with U.S. copyright formalities.¹⁶⁴ As will be later discussed,¹⁶⁵ the U.R.A.A. addresses these discrepancies regarding works that lapsed due to failure to comply with U.S. formalities, but not with respect to works whose term of pro-

161. Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, § 12, 102 Stat. 2853, 2860 (1988).

162. 17 U.S.C. § 104(c).

163. 17 U.S.C. § 304. Note that copyright in works by authors who died before 1939 would have expired by 1989 under the Berne 50 year p.m.a. term, and need not be revived. Berne Convention, *supra* note 4, art. 18(1), 828 U.N.T.S. at 251.

164. *But see infra* part II.C (discussing the Uruguay Round Agreements Act, which revives certain copyrights which have fallen into the public domain due to failure to comply with formalities, and analyzing the impact of the U.R.A.A. on the United States' Berne commitments).

165. *See infra* part II.C.4.

tection expired as of result of the United States' less than 50 years p.m.a.¹⁶⁶ This results in certain continued U.S. discrepancies from Berne.

6. Enforcement of Rights under U.S. Copyright Law

In the United States, copyrights can be enforced by any copyright claimant who satisfies the eligible country requirements of the 1976 Act.¹⁶⁷ U.S. claimants, however, must register their copyrights with the U.S. Copyright Office as a prerequisite to filing an infringement action.¹⁶⁸ Foreign claimants are exempt from this requirement, as are claimants under Section 104A of the 1976 Act.¹⁶⁹

II. NEW LAWS AND PROPOSED LEGISLATION

The previous review of the Berne Convention, pre-EC Term Directive status of EU law, and pre-U.R.A.A. U.S. law shows that there exist significant discrepancies exist between U.S. and EU copyright law. The impact of new¹⁷⁰ and proposed¹⁷¹ laws in the EU and United States on the international duration of copyright protection will show that these discrepancies remain. The EC Term Directive significantly increases the term of protection in all EU Member States,¹⁷² and introduces a large discrepancy between the EU and U.S. terms of protection. TRIPs influences copyright duration analysis in its signatory countries, which include the United States and all EU Member States.¹⁷³ The U.R.A.A. revives U.S. copyrights in eligible foreign-origin works.¹⁷⁴ Even after implementation of the U.R.A.A., however, U.S. duration still does not comply with Berne, and falls far short of the new EU term. The

166. See *infra* part II.C.4.

167. See 17 U.S.C. § 104(b).

168. 17 U.S.C. § 411.

169. *Id.*

170. Council Directive No. 93/98, *supra* note 12, O.J. L 290/9 (1993).

171. See *supra* note 15 and accompanying text.

172. H.R. 989, *supra* note 15; S. 483, *supra*, note 15

173. See *infra* part II.B.

174. See *infra* part II.C.

C.T.E.A. would, if adopted, add 20 years to the terms of copyright in the United States, and resolve some, but not all, of the U.S.-Berne and U.S.-EU discrepancies.¹⁷⁵ The C.T.E.A. would also almost completely close the term gap that results from the EC Term Directive.

A. *The EC Term Directive*

The EC Term Directive harmonizes the copyright term of protection in EU Member States to 70 years p.m.a. for works by individual or joint authors.¹⁷⁶ For works owned by legal persons the term is 70 years post-publication.¹⁷⁷ Additionally, the EC Term Directive will revive certain copyrights if they have fallen into the public domain in one Member State but are still protected by another Member State.¹⁷⁸ Application of the EC Term Directive, even though it discriminates against non-EU nationals, complies with Berne.

1. Copyright Duration under the EC Term Directive

The net result of the EC Term Directive is that in most EU Member States duration of protection will substantially increase.¹⁷⁹ The harmonized term of 70 years p.m.a. will result in an additional 20 years of copyright protection in the majority of Member States, which had a 50 years p.m.a. term of protection.¹⁸⁰ If a work is not published until after 70 years following the date of the author's death, the copyright endures for 25 years after the work is lawfully

175. See *infra* part II.D.

176. Council Directive No. 93/98, *supra* note 12, art. 1(1), (2), O.J. L 290/9, at 11 (1993).

177. See *id.* art. 1(4), O.J. L 290/9, at 11 (1993).

178. *Id.* art. 10(2), O.J. L 290/9, at 12 (1993).

179. See *supra* note 87 and accompanying text.

180. Council Directive No. 93/98, *supra* note 12, art. 1, O.J. L 290/9, at 11 (1993).

The EC Term Directive provides that:

[t]he rights of an author of a literary or artistic work within the meaning of . . . the Berne Convention shall run for the life of the author and for 70 years after his death, irrespective of the date when the work is lawfully made available to the public.

Id.

published or lawfully communicated to the public.¹⁸¹ Copyright in a joint work endures for 70 years after the death of the last-surviving author.¹⁸² Copyright in works for which a legal person is designated as the rightholder endures for 70 years after the work was lawfully made available to the public.¹⁸³

In addition to standardizing the term of copyright protection for existing and newly-created works, the EC Term Directive applies retroactively to revive expired copyrights in certain works. Copyrights in works by EU nationals that have expired in one EU country but had subsisting copyrights in another EU country on the July 1, 1995, implementation date are revived.¹⁸⁴ Because German law, even prior to the EC Term Directive, had a term of protection of 70 years, certain works that by July 1, 1995 had expired under a 50 years p.m.a. term in their member state country of origin enjoyed continued protection in Germany (that is, works created by authors who died between 1925 and 1945). Such works are revived under the EC Term Directive.¹⁸⁵

The works of James Joyce provide a good example of this revival effect. James Joyce, an Irish national, died in 1941.¹⁸⁶ His work, *Portrait of the Artist as a Young Man*, was first published in 1914 in London, England.¹⁸⁷ Copyrights in Joyce's book expired in 1991 in most EU Member States under the 50 year p.m.a. term. In Germany, however, the work is protected until 2011 (70 years p.m.a.). Accordingly, the work was protected in one Member State

181. *Id.* art. 4, O.J. L 290/9, at 11 (1993).

182. *Id.* art. 1(2), O.J. L 290/9, at 11 (1993).

183. *Id.* art. 1(4), O.J. L 290/9, at 11 (1993). All terms are to be "calculated from the first day of January of the year following the event which gives rise to them." *Id.*, art. 8, O.J. L 290/9, at 12 (1993).

184. *Id.* art. 10(2), O.J. L 290/9, at 12 (1993). The EC Term Directive provides: "[T]he terms of protection provided for in this Directive shall apply to all works and subject matter which are protected in at least one Member State, [on July 1, 1995]." *Id.*

185. *Id.*; see also Jehoram & Smulders, *supra* note 12, at 825 (discussing revival effect of E.C. Term Directive).

186. OXFORD COMPANION TO ENGLISH LITERATURE 520 (M. Drabble, ed., 1992).

187. *Id.*

on July 1, 1995, and therefore is revived and entitled to protection until 2011 in all Member States. Similarly, his work *Ulysses*, published in Paris, France in 1922,¹⁸⁸ will be revived and will endure until 2011.

The EC Term Directive does not retroactively shorten the term of protection for works whose term of protection was longer than 70 years p.m.a. in certain countries prior to the effective date of the EC Term Directive.¹⁸⁹ As to works created in those countries after July 1, 1995, however, the term of protection will be 70 years p.m.a.¹⁹⁰

The EC Term Directive mitigates the effect of retroactive revival of copyright by providing that it "shall be without prejudice to any acts of exploitation performed [prior to July 1, 1995],"¹⁹¹ and further requires Member States to adopt measures that protect third party rights which were acquired before a work's term was extended or revived.¹⁹² Because the EC Term Directive does not specify how acquired rights must be accommodated,¹⁹³ implementing legislation in the various EU Member States may result in differing protection of acquired rights of third parties.¹⁹⁴

2. Works of Foreign Origin

Under the EC Term Directive, works by EU nationals are not subject to rule of the shorter term treatment, whereas works by non-EU nationals must receive the rule of the shorter term treatment unless certain conditions specified in the EC Term Directive are fulfilled. Article 7 of the EC Term Directive states that:

[w]here the country of origin of a work, within the meaning of the Berne Convention, is a third country, and the author

188. *Id.*

189. See Council Directive No. 93/98, *supra* note 12, art. 10(1), O.J. L 290/9, at 12 (1993).

190. *Id.* art. 10(2), O.J. L 290/9, at 12-13 (1993).

191. *Id.* art. 10(3), O.J. L 290/9, at 13 (1993).

192. *Id.*

193. *Id.*

194. For a criticism of the complications arising from the ambiguity of this provision, see W.R. Cornish, *Intellectual Property*, 13 YEAR BOOK OF EUR. L. 485, 496 (1993).

of the work is not a Community national, the term of protection granted by the Member States shall expire on the date of expiry of the protection granted in the country of origin of the work, but may not exceed the term laid down in Article 1.¹⁹⁵

This provision results in differing terms of protection for works of foreign origin, depending upon whether or not the author is a national of an EU Member State.

Regarding application of the rule of the shorter term to works by EU national authors, the EC Term Directive goes further than *Phil Collins* regarding the rights it grants to such authors. Whereas *Phil Collins* dictates that an EU country cannot apply the rule of the shorter term treatment to works by nationals from other EU Member States on a discriminatory basis,¹⁹⁶ the EC Term Directive provides that works of all EU nationals are exempt from rule of the shorter term application in all EU Member States.¹⁹⁷ Such works, consistent with the EC Term Directive's goal of harmonization, will receive the 70 year term provided in the EC Term Directive, regardless of the work's country of origin.¹⁹⁸ Non-EU nationals can benefit from this term only if the country of origin of their work is an EU country.

A potential ambiguity exists because the EC Term Directive does not define the term "third country,"¹⁹⁹ nor is it defined in the

195. Council Directive No. 93/98, *supra* note 12, art. 7(1), O.J. L 290/9, at 12 (1993).

196. *Phil Collins*, [1993] 3 C.M.L.R. at 799.

197. Council Directive No. 93/98, *supra* note 12, art. 7, O.J. L 290/9, at 12 (1993).

The Commission proposal for the EC Term Directive states that:

where a work originates in a third country, it will be protected for seventy years in the Community provided it is protected for at least seventy years in the third country. But if the term of protection in the third country is shorter, protection in the Community will end at the same time as the term in the third country. This rule only applies if the author is not a Community national. If the author is a Community national, the rule of comparison of terms does not apply.

COM(92), *supra* note 45, at 38.

198. Council Directive No. 93/98, *supra* note 12, art. 2, O.J.L 290/9, at 11 (1993).

199. *Id.*

Berne Convention. The legislative history of the EC Term Directive provides some guidance as to the definition, but is not definitive.²⁰⁰ In the Proposal for the Directive, the European Commission stated:

one of the primary objective[s] [of the EC Term Directive] is to ensure that the level of protection is as high as possible in the Community and in the third countries. If third countries are to be induced to improve their protection from the point of view of its duration, one should avoid granting them the long Community term unilaterally. The introduction of a comparison system will therefore act as an incentive to third countries to prolong their term of protection.²⁰¹

This language appears to establish a dichotomy between "third countries" and "the Community," thus lending support to the argument that "third country" means "non-EU country," not "non-Berne signatory country."²⁰²

In accordance with this interpretation, if an author is not an EU national and the work is first-published outside the EU, the rule of the shorter term is mandatory.²⁰³ Therefore, works that are created

200. COM(92), *supra* note 45, at 13, ¶ 22.

201. *Id.* at 31, ¶ 60.

202. In the context of the EC Term Directive and this language, this author concludes that "third country" means "non-EU country" and not "non-Berne signatory country." Accord Jehoram & Smulders, *supra* note 12, at 835 ("Article 7(1) [of the EC Term Directive] maintains the Berne Convention rule of comparison of terms with respect to works which have a third country as their country of origin. Here one would think of the U.S. with its traditional 50 years p.m.a."). This interpretation could, however, be subject to a challenge that "third country" is intended to mean "non-Berne" country. If "third country" means "non-Berne" country, the rule of the shorter term would not be mandatory against works of U.S. origin because the U.S. is a signatory to Berne.

203. See COM(92), *supra* note 45, 33 Final, SYN 395, at 30, ¶ 60. It is clear that the EC intended this discriminatory result:

[it] is only natural that 'foreign' works and third-country nationals should not be protected for a period longer than is considered appropriate by their own country. Moreover, since Community works and nationals are not protected for as long a period in those countries as they are in the Community, comparing terms of protection is a way of ensuring reciprocity.

Id.

by U.S. nationals and that have a country of origin outside the EU (for example, by first publication in the United States) will receive mandatory rule of the shorter term treatment in the EU.²⁰⁴ On the other hand, works by U.S. nationals which are first published in an EU country would receive the 70 years p.m.a. term established in the EC Term Directive.²⁰⁵ Works by U.S. citizens who are habitually residing (or domiciled) in an EU country, regardless of where the work was first published, should also, under the rules of assimilation of Berne,²⁰⁶ receive the longer term provided in the EC Term Directive.

3. The EC Term Directive Complies with Berne

While *Phil Collins* established a principle of nondiscrimination against EU nationals in their exercise of copyright and related rights,²⁰⁷ the EC Term Directive takes this principle a step further and specifies that no EU Member State shall apply the rule of the shorter term against works by nationals of another EU Member State, regardless of the work's country of origin.²⁰⁸ As with the *Phil Collins* decision, this discrimination against non-EU nationals is permissible under Berne.²⁰⁹ Because the rule of the shorter term is a permissible exception to national treatment under Berne,²¹⁰ the EU 70 year p.m.a. treatment established in the EC Term Directive need not be extended to non-EU nationals, unless their works are first published in an EU country and, therefore, have an EU country of origin.²¹¹

204. Council Directive No. 93/98, *supra* note 12, art. 7(1), O.J. L 290/9, at 12 (1993).

205. *Id.*

206. Berne Convention, *supra* note 4, art. 3(2), 828 U.N.T.S. at 231; *see* discussion *supra* part I.A.1.

207. *See supra* part I.B.2.

208. Council Directive No. 93/98, *supra* note 12, art. 7(1), O.J. L 290/9, at 12 (1993).

209. Berne Convention, *supra* note 4, arts. 3, 7(8); *see supra* part I.B.3

210. *See supra* part I.A.2.

211. The term must also be extended for works first published in the United States after 1978 (with its 50 years p.m.a. term), therefore making the rule of the shorter term analysis moot.

4. Enforcement under the EC Term Directive

In general, EC Directives cannot be directly relied upon in disputes between individuals in national courts of EU Member States until the directive is implemented into the national law of the country in which protection is sought.²¹² Member States often fail to implement directives until long after the implementation deadline.²¹³ Failure by a Member State to timely implement a directive can, under certain circumstances, subject the defaulting Member State to damages caused to private parties by the State's failure.²¹⁴ The extent of a Member States' liability for such damages, including lost profits, expenses and exemplary damages, was recently decided by the Court of Justice.²¹⁵

B. *TRIPs and Duration*

TRIPs states that its members must "comply with articles 1 through 21 of the Berne Convention and the Appendix thereto."²¹⁶ While TRIPs provides for national treatment by signatory countries,²¹⁷ it specifically allows the exemptions to national treatment permitted under Berne to continue.²¹⁸

212. *Marshall v. Southampton and South West Hampshire Area Health Authority*, Case 152/84, [1986] E.C.R. 731-33.

213. Annual Report to the European Parliament on Commission Monitoring of the Application of Community Law (1990) (showing that, on average, EU Member States acted on at best 96.5 percent (Denmark) and at worst 81.8 percent (Italy) of the directives in effect). (1991) COM (91) 321, Annex B.

214. *Francovich and Bonifaci v. Italian Republic*, Joined Cases C-6/90, C-9/90, [1991] E.C.R. 5403, 5413-15.

215. *Brasserie du Pêcheur SA v. Federal Republic of Germany*, Joined Cases C-46/93 & C-48/93 (Eur. Ct. J. Mar. 5, 1996) (not yet reported). Regarding damages for individuals, the Court of Justice held that:

Community law confers right of reparation where three conditions are met: the rule of law infringed must be intended to confer rights on individuals; the breach must be sufficiently serious; and there must be a direct causal link between the breach of the obligation resting on the State and the damage sustained by the injured parties.

Id. at ¶ 51.

216. TRIPs, *supra* note 5, art. 9(1), 33 I.L.M. at 1201.

217. *Id.* art. 3, 33 I.L.M. at 1199.

218. *Id.* art. 4, 33 I.L.M. at 1200.

"Nationals" are defined in TRIPs as "those natural or legal persons that would meet the criteria for eligibility for protection provided for in the Paris Convention (1967), the Berne Convention (1971), the Rome Convention and the Treaty on Intellectual Property in Respect of Integrated Circuits."²¹⁹ Additionally, because Berne permits applying the rule of the shorter term, such treatment is still permissible as between TRIPs-signatory countries.

Since TRIPs mandates Berne-level protection,²²⁰ the 50 year p.m.a. Berne minimum (subject to permissible rule of the shorter term treatment) is required by TRIPs.²²¹ TRIPs, however, contains an exception not contained in Berne: despite Berne's 50 years p.m.a. minimum term of protection, and in spite of TRIPs' facially requiring Berne's minimums, TRIPs permits a minimum term of protection of 50 years post-publication, "when such term is calculated on other than the life of the author."²²² This means that for those works that should be, but are not, protected in the United States, due to the United States' 75 year post-publication term,²²³ TRIPs cannot be called upon to demand amendment of U.S. law.²²⁴

1. TRIPs Provides a Lesser Term of Protection than Berne

One of the primary purposes of TRIPs was to ensure that all signatory countries applied the minimum protections established in Berne.²²⁵ Even though TRIPs facially requires its signatory members to adhere to the Berne Convention, the 50 years p.m.a. dura-

Exempted from this obligation [of national treatment] are any advantage, favour, privilege or immunity accorded by a [TRIPs] Member: granted in accordance with the provisions of the Berne Convention (1971) or the Rome Convention authorizing that the treatment accorded be a function not of national treatment but of the treatment accorded in another country.

Id.

219. TRIPs, *supra* note 5, art 1(3), 33 I.L.M. at 1199.

220. *Id.*

221. *Id.*

222. *Id.* art. 12, 33 I.L.M. at 1202.

223. *See supra* part I.C.5.

224. *See infra* part II.B.2 (discussing enforcement under TRIPs).

225. TRIPs, *supra* note 5, art. 9(1), 33 I.L.M. at 1201.

tion of Berne is not mandatory under TRIPs, due to the shorter term of 50 years post-publication term permitted under article 12 of TRIPs.²²⁶ This provision allows a shorter term than even the United States' pre-1978 calculations of publication plus 75 years, and itself falls considerably short of Berne standards. Therefore, TRIPs does not enable non-U.S. countries to force the United States to grant the Berne minimum 50 years p.m.a. as to pre-1978 works, since TRIPs itself permits a shorter term of protection than Berne does.

2. Enforcement under TRIPs

TRIPs does not permit an individual to enforce rights granted in the Berne Convention if those rights have not been implemented into the national laws of the country in which protection is sought, either expressly or by virtue of a country's giving self-executing effect to treaties.²²⁷ The enforcement mechanisms under TRIPs provide that signatory countries require defaulting signatory countries to adhere to the Berne requirements.²²⁸ TRIPs prescribes detailed procedures in which complaints by TRIPs-signatory countries against other signatory countries may submit disputes to a newly-created General Council, pursuant to the Dispute Settlement Body.²²⁹ If the Dispute Settlement Body determines the defendant country in the dispute is indeed in violation of its TRIPs obligations, it will issue a time period in which such violating country must conform.²³⁰ TRIPs further authorizes complaining countries to suspend trade concessions to the violating country if the conformations recommended by the Dispute Settlement Body are not timely made by such country.²³¹

226. *See supra* part I.A.2.

227. TRIPs, *supra* note 5, art. 41 (1), 33 I.L.M. 1213-14.

228. *Id.* art. 64, 33 I.L.M. at 1221.

229. Understanding on the Rules and Procedures Governing the Settlement of Disputes, art. 2(1), 33 I.L.M. 112, 114 (Dec. 15, 1993).

230. *Id.* art. 21.

231. *Id.* art. 22.

C. *The Uruguay Round Agreements Act*

The United States enacted TRIPs implementing legislation under Section 514 of the U.R.A.A.²³² The U.R.A.A. retroactively revives certain copyrights that fell into the public domain as a result of the copyright owner's failure to fulfill the pre-1976 Act copyright formalities, as well as those that were in the public domain due to lack of subject matter jurisdiction.²³³ Such legislation was intended to bring U.S. law into compliance with the Berne Convention.²³⁴ The effective date of the U.R.A.A. was January 1, 1996.²³⁵ Unlike the EC Term Directive, the U.R.A.A. specifies procedures for protecting the rights of parties that were exploiting a copyright before it was revived.²³⁶ Specifically, regulations have been adopted for the filing of notices of intent to enforce copyrights in restored works,²³⁷ and for registering claims of copyright in restored works.²³⁸

1. Revival of Certain Public Domain Copyrights

The U.R.A.A. amends Section 104A of the 1976 Act to provide that U.S. copyrights may be restored in certain works of authorship.²³⁹ To qualify for revival, the work must not be in the public domain in its "source country" through expiration of the term of

232. Uruguay Round Agreements Act, Pub. L. No. 103-465, 1994 U.S.C.A.A.N. (108 Stat. 4809) 3773 (codified at 17 U.S.C. 104A (1996)).

233. 17 U.S.C. § 104A(h)(6) (1994).

234. S. REP. 103-412, 103d Cong., 2d Sess (1994).

235. See 19 U.S.C. 3511(e) (1994). President Clinton proclaimed that: it is necessary and appropriate, in order to implement the TRIPS Agreement and to ensure that section 514 of the URAA [amending sections 104A and 109 of the 1976 Act] is appropriately implemented, to proclaim that the date on which the obligations of the TRIPS Agreement will take effect for the United States is January 1, 1996.

Proclamation No. 6780 To Implement Certain Provisions of Trade Agreements Resulting from Uruguay Round of Multilateral Trade Negotiations, and for Other purposes. 60 Fed Reg. 15,845 (1995).

236. See *infra* part II.C.1.

237. See *infra* part II.C.3.

238. See *infra* part II.C.3.

239. 17 U.S.C. § 104A.

protection.²⁴⁰

A note should be made regarding works that are in the public domain in an EU Member State source country. As discussed previously,²⁴¹ the EC Term Directive revives certain public domain works in the EU—namely, most works that were created by authors who died between the years 1925 and 1945. However, on the effective date of the U.R.A.A. (January 1, 1996), many EU countries had not yet implemented the EC Term Directive. Technically speaking, works that qualified for revival under the EC Term Directive from a source country which had not yet implemented that Directive were, on the effective date of the U.R.A.A., not yet revived under the national law of such source country, and therefore in the public domain there. Query whether, when the U.S. Copyright Office (or courts) construes if a work from such non-implementing source country is in the public domain, it will apply the national law then in existence in such source country (in which case the work will be in the public domain in the source country, and therefore not qualify for restoration under the U.R.A.A.), or whether the U.S. Copyright Office will apply the supranational rights granted by the EC Term Directive and consider those works to have subsisting copyrights in their source country, thus qualifying for restoration under the U.R.A.A. This problem of non-restoration of works of EU source country would be even further exacerbated if the effective date of the U.R.A.A. was deemed to be January 1, 1995, in accordance with the opinions of some commentators,²⁴² insofar as the EC Term Directive was not in effect in any EU Member State as of that date (since it had an implementation date of July 1, 1995), and all works that would later qualify for revival under the EC Term Directive would have been, on January 1, 1995, in the public domain.

In addition to requiring that a work not be in the public domain

240. 17 U.S.C. § 104A(h). As noted by Nimmer, this introduces an element of the rule of the shorter term previously unknown to U.S. copyright law. NIMMER ON COPYRIGHT, *supra* note 6, § 9A.04[A][1], at 9A-26 & n.17.

241. See *supra* part II.A.

242. See *Copyright Office Registration Reforms are Aired*, *supra* note 9.

in its source country, to qualify for restoration in the United States such works must be in the public domain in the United States due to: (1) noncompliance with formalities imposed at any time by U.S. copyright law, including failure of renewal, lack of proper notice, or failure to comply with any manufacturing requirements;²⁴³ (2) lack of subject matter protection in the case of sound recordings fixed before February 15, 1972;²⁴⁴ or (3) lack of national eligibility.²⁴⁵

The U.R.A.A. defines "Eligible country" as "a nation, *other than the United States*, that is a World Trade Organization ("WTO") member country, adheres to the Berne Convention, or is subject to a proclamation under Section 104A(g)."²⁴⁶ Such a proclamation by the President requires that a foreign nation extends restored copyright protection reciprocally to works by authors who are nationals or domiciliaries of the United States.²⁴⁷

A restored work, whether published or unpublished, must be a work which has at least one author or rightholder who was, at the time the work was created, a national or domiciliary of an eligible (non-United States) country.²⁴⁸ If a restored work was published, it must, in addition to meeting the nationality requirements of the author, have been first published in an eligible (non-U.S.) country and not published in the United States during the 30-day period following publication in such eligible country.²⁴⁹

A work's "source country" is defined as:

(A) a nation *other than the United States*;

(B) in the case of an unpublished work—

(i) the eligible country in which the author or

243. 17 U.S.C. § 104(A)(h)(6)(c)(i-iii) (1994).

244. *Id.*

245. *Id.*

246. 17 U.S.C. § 104A(h)(3) (emphasis added).

247. 17 U.S.C. § 104A(g) (1994).

248. *Id.* at § 104A(h)(6)(D) (1994).

249. *Id.*

rightholder is a national or domiciliary, or, if a restored work has more than 1 author or rightholder, the majority of foreign authors or right holders are nationals or domiciliaries of eligible countries; or

(ii) if the majority of authors or rightholders are not foreign, the nation *other than the United States* which has the most significant contacts with the work; and

(C) in the case of a published work—

(i) the eligible country in which the work is first published, or

(ii) if the restored work is published on the same day in 2 or more eligible countries, the eligible country which has the most significant contacts with the work.²⁵⁰

The result of these definitions is that works first published in the United States and works published in the United States within 30 days of publication in an “eligible country” are excluded from the benefits of the U.R.A.A.²⁵¹ Additionally, works by U.S. nationals or domiciliaries (unless such works are jointly authored by at least one national or domiciliary of an “eligible country”) are also excluded from these benefits, regardless of the country of first publication.²⁵²

2. Protection of “Reliance Parties”

Unlike the EC Term Directive, the U.R.A.A. outlines in detail the manner in which the rights of “reliance parties”—i.e., third parties who are exploiting previously public-domain works prior to the effective date of restoration—must be protected.²⁵³

250. *Id.* at § 104A(h)(8) (emphasis added).

251. 17 U.S.C. § 104A(h)(6)(D).

252. *Id.*

253. “Reliance party” is defined in the U.R.A.A. as any person who:

(A) with respect to a particular work, engages in acts, before the source country of that work becomes an eligible country, which would have violated section

In order to enforce a restored copyright against a party who was exploiting the work while it was in the public domain, the copyright holder is required under amended Section 104A of the 1976 Act to file a claim of restoration of copyright with the U.S. Copyright Office or send actual notice to the reliance party during the 24 month period beginning on the date of restoration.²⁵⁴

Reliance parties have a 12-month grace period from receipt or publication of notice in which to continue to exploit the work.²⁵⁵ The grace period runs from the earlier of either the publication in the Federal Register or service of notice to the reliance party.²⁵⁶ The grace period excludes, however, the right to make new copies or phonorecords of the work after the rightholder publishes a Notice of Intent to Enforce a Restored Copyright ("NIE") in the Federal Register or after the reliance party receives notice of intent to restore.²⁵⁷

The U.S. Copyright Office anticipates that it will receive thirty-to fifty-thousand NIEs to restore copyrights annually.²⁵⁸ The overall impact of the U.R.A.A. will be even greater than the NIE filings will evidence, because owners of previously public-domain works

106 if the restored work had been subject to copyright protection, and who, after the source country becomes an eligible country, continues to engage in such acts;

(B) before the source country of a particular work becomes an eligible country, makes or acquires 1 or more copies or phonorecords of that work; or

(C) as a result of the sale or other disposition of a derivative work covered under subsection (d)(3), or significant assets of a person described in subparagraph (A) or (B), is a successor, assignee, or licensee of that person.

17 U.S.C. § 104A (h)(4). The Copyright Office condensed this definition in practical terms: "A reliance party is typically a business or individual who, relying on the public domain status of a work, was already using the work prior to December 8, 1994." 60 Fed. Reg. 50,414, 50,415 (Sep. 29, 1995).

254. 17 U.S.C. § 104A(d)(2).

255. *Id.* at § 104A(d)(2)(A)-(B).

256. *Id.* at § 104A(d)(2).

257. *Id.* at § 104A(d)(2)(B)(ii)(III).

258. Copyright Office Hearing on Restored Copyrights, BNA-PAT., COPYRIGHT & TRADEMARK DAILY, Mar. 29, 1995 (statement of Copyright Office Acting General Counsel Marilyn Kretsinger).

have a basis on which to commence new marketing and licensing programs to *non-reliance* third parties, without the requirement of filing an NIE. The U.S. Copyright Office must keep a list of restored copyrights and publish such list in the Federal Register every four months for two years after the effective date of the U.R.A.A.²⁵⁹

Reliance parties who have created derivative works²⁶⁰ based on previously public domain copyrights are permitted to continue exploitation of the newly-revised underlying work upon payment of a mandatory royalty to the copyright owner.²⁶¹ The U.R.A.A. provides that such a reliance party may continue to exploit a work, despite restoration of its copyrights, 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 [the U.R.A.A.]."²⁶² "Reasonable" is not defined in the U.R.A.A., but instead the U.R.A.A. specifies details for what must be considered in determining the amount of compensation: "harm to the actual or potential market for or value of the restored work from

259. 17 U.S.C. § 104A(e)(1)(B)(i) (1994).

260. A "derivative work" is defined as:

a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a "derivative work".

17 U.S.C. § 101 (1994).

261. "Existing derivative works" is defined as:

(A) In the case of a derivative work that is based upon a restored work and is created—

(i) before the date of 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 works is not an eligible country on such date of enactment.

17 U.S.C. § 104A(d)(3) (1994).

262. 17 U.S.C. § 104A(d)(3)(A).

the reliance party's continued exploitation of the work, as well as compensation for the relative contributions of expression of the author of the restored work and the reliance party to the derivative work."²⁶³ If the parties do not have an agreement regarding the compensation to be paid, either of the parties may bring an action in U.S. district court to determine the amount of compensation to be paid.²⁶⁴ The district courts have exclusive jurisdiction over such disputes.²⁶⁵ To enforce the restored copyright against parties whose exploitation began after the restoration date of the restored work, no notice filing or mailing of intent to enforce is required.²⁶⁶

3. Regulations Regarding Restored Copyrights

The U.S. Copyright Office has adopted regulations specifying the administrative procedures that must be followed to file a NIE and to register a claim of copyright in restored works.

No special form has been devised for filing an NIE.²⁶⁷ However, the U.S. Copyright Office has specified a format for filing an NIE²⁶⁸ that is available over the Internet and may be downloaded for use as a form.²⁶⁹

Any material false statement knowingly made with respect to any restored copyright identified in any NIE makes void all claims

263. *Id.* at § 104A(d)(3)(B).

264. *Id.*

265. *Id.*

266. *Id.* at § 104A(d)(1).

267. 37 C.F.R. § 201.31(c) (1995).

268. 60 Fed. Reg. 35,522, 35,527 (July 10, 1995) (to be codified at 37 C.F.R. §§ 201 & 202).

269. The form may be found on the Internet at [NPRMURAA\(A\)LOC.GOV](http://NPRMURAA(A)LOC.GOV). See 60 Fed. Reg. 35,522 (July 10, 1995). The Copyright Office will be establishing a separate address for mailing NIE forms. The address is: URAA/GATT, NIEs and Registrations, P.O. Box 72400, Southwest Station, Washington D.C. 20024 U.S.A. 37 C.F.R. § 201.33(d) (1995). The proposed filing fee is \$30 for one work, \$1 for each additional work beyond the first work. 37 C.F.R. § 201.33(e)(1) (1995). The proposed procedures also specify that the Copyright Office will accept Visa, Master Card, and American Express, as well as debits against a Copyright Office deposit account, for the payment of fees associated with the NIE filing. 37 C.F.R. § 201.33(e)(2) (1995).

and assertions made with respect to such restored copyright.²⁷⁰ Therefore, all NIE applicants are required to sign a certification statement at the end of the NIE indicating that the information given is correct to the best of the applicant's knowledge.²⁷¹

The U.S. Copyright Office procedures for the registration of copyright in restored works attempt to take into account problems arising from the fact that the registrations would be in works that were old and would be from foreign claimants.²⁷² Some of the issues considered are unfamiliarity with registration procedures of the U.S. Copyright Office,²⁷³ difficulties in communications,²⁷⁴ and problems submitting a copy or phonorecord of the work.²⁷⁵

Two new forms for registration of restored works have also been established.²⁷⁶ Form GATT is for the registration of individual restored works and works published under a single series title in multiple episodes, installations or issues during the same calendar year, provided the owner of the U.S. rights is the same for all episodes, installations or issues.²⁷⁷ Form "GATT/GRP" is for registration of groups of related restored works.²⁷⁸

The U.S. Copyright Office has stated that it does not plan to investigate whether the applicant for registration of a restored work is, under the law of the relevant jurisdiction, the proper owner of the work.²⁷⁹

270. 17 U.S.C. § 104A(e)(3) (1994).

271. 37 C.F.R. § 201.31(d)(2)(vi) (1995).

272. 60 Fed. Reg. 35,525-26 (July 10, 1995).

273. *Id.*

274. *Id.*

275. *Id.*

276. 37 C.F.R. § 202.12(c)(2) (1995).

277. *Id.*

278. *Id.* The fee for registration of a restored work will be the same as that for existing copyright registration—\$20. 37 C.F.R. § 202.12(c)(3)(i) (1995). For group works published under a single series title and published within the same calendar year, the fee would be \$20.00. *Id.* The fee for a group of up to 10 related individual works published within the same calendar year would be \$10 per individual work. *Id.*

279. 60 Fed. Reg. 35,522, 35,527 (July 10, 1995). The U.R.A.A. states that "a restored work vests initially in the author or initial rightholder (if the work is a sound

The U.S. Copyright Office has also established more lenient deposit requirements for registration of restored works. The rationale for the leniency was that the U.S. Copyright Office anticipated that problems could arise regarding access to such copies for older works.²⁸⁰ The existing copyright deposit procedures requires deposit of two complete copies of the best edition of the work.²⁸¹ The regulations permit a deposit of other than the first published edition of the work, if necessary.²⁸²

4. U.R.A.A. brings the United States into Closer, but not Full, Compliance with Berne

As discussed earlier,²⁸³ pre-U.R.A.A. U.S. copyright law violates the U.S.'s Berne obligations in two respects: First, it violates Berne's prohibition against formalities,²⁸⁴ and second, it violates Berne's 50 year p.m.a. duration requirement²⁸⁵ for certain works published between the years 1914 and 1976, whose term of duration is based on 75 years post-publication.²⁸⁶ As also discussed earlier, if the author published a work before that date and died more than 25 years after the work was published, the U.S. term will fall short of Berne.²⁸⁷ The U.R.A.A. was drafted to remedy U.S. Berne deficiencies only with respect to copyright formalities.²⁸⁸ It therefore does not address remaining duration discrepancies.²⁸⁹

Under the U.R.A.A., restoration of U.S. copyrights in eligible works by authors of eligible countries occurs immediately upon the

recording) of the work as determined by the law of the source country of the work." *Id.* at 35,525 n.7 (citing U.R.A.A., amended § 104A(b)).

280. 60 Fed. Reg. 35,522, 35,525 (July 10, 1995).

281. 17 U.S.C. § 407(a)(1).

282. 37 C.F.R. § 202.12(c)(4)(i).

283. *See supra* part I.C.5.

284. *See supra* part I.C.5.

285. *See supra* part I.C.5.

286. *See supra* part I.C.

287. *See supra* part I.C.

288. *See supra* part I.C.

289. S. REP. NO. 412, 103d Cong. 2d Sess. (Nov. 22, 1994).

effective date of the U.R.A.A.²⁹⁰ In accord with Berne, no formalities are required to restore a work. In order to enforce a restored copyright against "reliance parties,"²⁹¹ however, the owner must file an NIE with the U.S. Copyright Office or send actual notice to the reliance party.

Some commentators have argued that the NIE formalities, themselves, violate the Berne Convention.²⁹² There is irony in the fact that the United States implemented a new formality in the process of correcting Berne non-compliance resulting from earlier U.S. formalities, insofar as Berne prohibits formalities as a condition to subsistence or exercise of copyrights.²⁹³ However, the new requirements do not technically violate Berne because Berne permits newly-acceding countries to accommodate reliance parties' interests when implementing the retroactivity provisions of Berne's article 18.²⁹⁴ Also in accord with Berne,²⁹⁵ the U.R.A.A. does not revive U.S. copyrights for works which are in the public domain in their "source country."²⁹⁶

The U.R.A.A. does not, however, completely eliminate the United States' non-compliance with Berne. This is because the U.R.A.A. does not revive works that were in the public domain as a result of pre-1978 U.S. term duration calculations.²⁹⁷ Moreover, because Berne requires protection *outside the country of origin* for

290. 17 U.S.C. § 104A(a)(1)(A).

291. See *supra* part II.B.2.

292. See 60 Fed. Reg. 35,522, 35,524 (July 10, 1995) (comments of Mr. Jean-Marc Gutton for the Societe des auteurs dans les arts graphiques et plastiques ("ADAGP") and representatives of the Confederation Internationale des Societes d'Auteurs et Compositeurs ("CISAC") stating that the NIE procedures constituted "new formalities in violation of the Berne Convention").

293. Berne Convention, *supra* note 4, art. 5(2), 828 U.N.T.S. at 233; see *supra* part I.A.5.

294. "[T]he respective countries shall determine, each in so far as it is concerned, the conditions of application of this principle [of retroactivity]." Berne Convention, *supra* note 4, art. 18(3), 828 U.N.T.S. at 251.

295. See *supra* part I.A.4.

296. See *supra* part II.B.4.

297. See *supra* part I.C.5.

all works published in another Berne country, the United States should have revived works created by U.S. nationals that have a non-United States country of origin. Thus, the U.R.A.A. lessens the variance between the EU and U.S. terms of protection for works that fell into the public domain due to failure to fulfill formalities, since most such works will be revived under the U.R.A.A. However, the U.R.A.A. fails to remedy the remaining effects of the United States pre-1978 shorter than 50 year p.m.a. term, and does not revive non-U.S. Berne signatory country of origin works by U.S. authors, as required by Berne.

D. Proposed U.S. Copyright Term Extension Act of 1995

The appropriate term of U.S. copyright protection has been debated since the introduction of protection for authors in the U.S. Constitution.²⁹⁸ This debate has recently been renewed as a result of the C.T.E.A. The C.T.E.A. would add 20 years to the U.S. terms of protection currently provided in the 1976 Act and bring the U.S. term of protection to 70 years p.m.a, matching the protection provided by the EC Term Directive.²⁹⁹ As will be argued below, the C.T.E.A. should be adopted to minimize discrepancies between EU and U.S. law, and to thus facilitate and encourage international exploitation of works.

298. The debate over the duration of monopoly to be granted to authors (and inventors) in the United States pre-dates the constitutional provision granting Congress authority to award such monopolies. See, e.g., *Graham v. John Deere Co.*, 383 U.S. 1, 8, (1965). Article I of the U.S. Constitution provides that Congress has the power: "[t]o promote the Progress of Science and the useful Arts, by securing for limited Time to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8 cl. 8. (Copyright Clause). The framers of the Constitution passed the decision regarding duration of protection to Congress, resulting in great debate regarding the term of duration in the Copyright Act. See Pierre Leval & Lewis Liman, *Are Copyrights For Authors or Their Children?* 39 J. COPYRIGHT SOC'Y U.S.A. 1 (1991). What "limit" should be put on those "times" of exclusivity is at the center of a renewed debate sparked by the proposed United States Copyright Term Extension Act. See D. Karjala et. al., *Comment of US Copyright Law Professors on the Copyright Office Term of Protection Study*, reprinted in 14 EUR. INTELL. PROP. REV. 531 (1994) (arguing against adoption of the Copyright Term Extension Act).

299. See *supra* part II.A.1.

1. Duration of Protection under the C.T.E.A.

What protection a work will receive if the C.T.E.A. is adopted depends, as with the United States' accession to Berne, on the creation or publication date of the work:

1. works created before January 1, 1978 with subsisting copyrights;
2. works created but not published or copyrighted before January 1, 1978;
3. works created on or after January 1, 1978.

Under the C.T.E.A., section 304 of the 1976 Act, pertaining to works with subsisting statutory copyrights (e.g. published or registered works) created before January 1, 1978, would be amended to provide an extension of the renewal term from 47 years to 67 years, resulting in a total term of duration for such works of 95 years following the date of publication, or for unpublished works, following the date of registration.³⁰⁰ The C.T.E.A. would not revive any copyrights that have fallen into the public domain.³⁰¹

The U.S. duration of works created but not published or copyrighted before January 1, 1978, would, if the C.T.E.A. is adopted, receive a term of protection of 70 years after the death of the author.³⁰² In no event will such copyright expire before December 31, 2012, and if the work is published on or before December 31, 2012, the term of copyright will not expire before December 31, 2047.

If adopted, the C.T.E.A. would amend section 302(a) and (b) of the 1976 Act, such that works and joint works created on or after January 1, 1978 would receive a term of protection of 70 years after the death of the author.³⁰³ Terms for works made for

300. 17 U.S.C. §304(b).

301. The U.R.A.A. did, however, revive certain public domain copyrights. *See supra* part III.C.1.

302. Copyright Term Extension Act, H.R. 989, S. 483, 104th Cong., 1st Sess., § 2(c) (1995).

303. *Id.* at § 2(b)(1).

hire would also be extended 20 years, to 95 years after the work is published or 120 years from creation, whichever expires first.³⁰⁴ Proposed amendments to Section 302(e) would also extend each of the terms regarding presumptions as to author's death by 20 years.³⁰⁵

Finally, the legislation would extend the February 15, 2047 termination date of the Section 301(c) exclusion from the 1976 Act's preemption for sound recordings made before February 15, 1972, to February 15, 2067.³⁰⁶

2. The C.T.E.A. will bring the United States Closer to Berne, but not into Full Compliance

The C.T.E.A. would eliminate some of the remaining discrepancies between Berne's standards and U.S. law; however, certain disparities would remain even if the C.T.E.A. is adopted.

Because the C.T.E.A. would not revive works that are in the public domain on the effective date of the C.T.E.A.,³⁰⁷ works that fell into the public domain as a result of pre-1978 copyright duration rules will not be revived.³⁰⁸ Moreover, for the same reason, the C.T.E.A. will not resolve Berne deficiencies with respect to works by U.S. authors that have a non-U.S. Berne-signatory country of origin.³⁰⁹

For the most part, the discrepancy for term protection in works first published or registered before 1978 will be eliminated by the extension of the term from 75 years after publication to 95 years after publication.³¹⁰ In the case of most works, this extension will result in a term of protection that equals or exceeds the 50 year p.m.a. required by Berne.

304. *Id.* at § 2(b)(3).

305. *Id.* at § 2(b)(4).

306. *Id.* at § 2(a).

307. *See supra* part I.A.

308. *See supra* part II.C.4.

309. *See supra* part II.C.4.

310. That is, works published within 45 or fewer years before the author's death will have a copyright term that meets or exceeds the Berne Convention's minimums.

To illustrate, Matisse's work the *Piano Lesson*, published in 1916, receives protection under Berne until 2004—50 years after Matisse died. In the United States, the term of protection for the work would, after the C.T.E.A., receive protection until 2011—7 years longer than Berne requires. Additionally, the C.T.E.A. will result in longer terms of protection for some works that expired under Berne. For example, Joyce's *Ulysses*: the work is required, under Berne, to have received protection only until 1991, 50 years after Joyce's death in 1941. Under the C.T.E.A., the work would receive protection until 2017, 95 years after its publication in 1922. This results in a term that is, as the C.T.E.A. intends, 20 years longer than before adoption of the C.T.E.A., and is 26 years longer than Berne requires. Conversely, it is still conceivable that even with a 95 year post-publication term of protection, the U.S. duration for pre-1978 works will result in a shorter than 50 year p.m.a. term.³¹¹ For example, Picasso's work, *Girl with Mandolin* will be protected in the United States until 2012.³¹² This still represents an 11 year shortfall from the Berne-minimum protection, which requires protection until 2023.

III. COPYRIGHT HARMONIZATION WOULD ENCOURAGE THE GLOBAL EXPLOITATION OF WORKS AND REDUCE THE PREJUDICIAL EFFECTS OF CURRENT LAWS

Despite the few discrepancies between U.S. and Berne copyright duration that would remain after the adoption of the C.T.E.A., the C.T.E.A. would bring the United States into near harmony with the term of protection in the EU.

The strongest argument for the United States' adoption of the C.T.E.A. is achieving harmonization of U.S. copyright duration with that of the EU. The legal effects of *Phil Collins*, the EC Term Directive, and the U.R.A.A., in combination with the prior U.S. and EU copyright laws, and international treaties and conven-

311. Namely, those works published more than 45 years before the author's death.

312. See *supra* part I.C.5.

tions, complicate the creation and marketing of products containing pre-existing works, such as screenplays based on novels, and works containing pre-existing works, such as multimedia products. The C.T.E.A. would minimize these detriments.

Additionally, adoption of the C.T.E.A. would reduce the prejudicial effects of the current laws against U.S. authors and works first published in the United States.

A. Current EU-U.S. Term Discrepancies and the Resultant Complications

As discussed earlier,³¹³ works published or registered after 1978 receive a term of protection in the United States of 50 years p.m.a.³¹⁴ This is equivalent to the predominant EU term before the EC Term Directive.³¹⁵ After the EC Term Directive, there will be a 20 year duration discrepancy between the United States and the EU with respect to works created after that date, unless the C.T.E.A. is enacted.

For works published before 1978, the United States grants a maximum 75 year post-publication term,³¹⁶ which, as illustrated previously,³¹⁷ results in certain EU-U.S. term discrepancies. This current difference will be exacerbated by the EC Term Directive. For example, Matisse's work *The Piano Lesson*, which received a 13-year longer term of protection in the EU than in the United States will now be protected 33 years longer in the EU than the United States. Similarly, Picasso's *Girl with Mandolin* will now be protected 51, instead of 31, years longer in the EU than in the United States.³¹⁸

These effects are even more dramatic for works that were previously in the public domain but revived in the EU. As previously

313. See *supra* part I.C.3.

314. 17 U.S.C. § 302(a).

315. See *supra* part I.B.1.

316. 17 U.S.C. § 304(b).

317. See *supra* part I.C.3.

318. See *supra* part II.A.2.

discussed,³¹⁹ works that were protected on July 1, 1995, in one EU Member State are entitled to the benefits of the EC Term Directive, even if copyright in such works had expired in another EU Member State.³²⁰ For example, as discussed earlier,³²¹ James Joyce's works *Portrait of the Artist as a Young Man* and *Ulysses*, were revived in the EU and will be protected there until 2011 (70 years p.m.a.). By way of comparison, in the United States, copyright in *Portrait* expired in 1989—a 22 year shortfall from the EU term of protection,³²² and copyrights in *Ulysses* will expire in 1997—a 14 year shortfall.

Consider the effects of these protection disparities for a hypothetical CD-ROM encyclopedia containing art, music, and literature. Some works will be protected in the United States but not in the EU, and vice versa. As discussed in this article, the term of protection a work will be accorded in different countries can vary greatly, and, after full implementation of the EC Term Directive, copyright terms will, in most instances, be significantly longer in the EU than in the United States. Thus, it is a risk for current copyright holders to provide access to a developer to copy works for use in the United States, where the works could be freely copied without the copier being subject to suit for infringement.³²³

319. See *supra* part II.A.1.

320. See *supra* part II.A.1 (discussing the EC Term Directive and retroactive revival).

321. See *supra* part II.A.1.

322. See 17 U.S.C. 304.

323. Individual copies of pre-existing works are not protected as derivative works unless such copies contain "originality." 1 NIMMER, *supra* note 5, § 2.08[C]. Therefore, copying of an ordinary reproduction of a public domain work of art cannot be enjoined under copyright law. See also Jane C. Ginsburg, *Exploiting the Artist's Commercial Identity: The Merchandizing of Art Images*, 19 COLUM-VLA J.L. & ARTS 1 (1994); Gregg Oppenheimer, *Originality in Art Reproductions: 'Variations' in Search of a Theme*, 27 COPYRIGHT LAW SYMPOSIUM 207 (1982) (discussing variations from original works necessary to qualify art reproductions for separate copyright). Accordingly, if a public domain painting, for example, is reproduced in digital form on a CD-ROM, copying of such individual work may not be enjoined as a copyright infringement since the copy of the work is not a protectable work of authorship, and the original work on which the copy is based is in the public domain. Original work added to such compilations, such as

Moreover, these works can be uploaded onto the Internet in the United States and distributed to the EU, where the copyright is still protected. The result is copyright infringement in the EU by a defendant that is difficult, if not impossible, to trace.³²⁴ Even if the defendant is traceable, international jurisdiction and conflict of laws complications may result in a lack of remedy, at least in the U.S. courts, for infringement occurring abroad as a result of authorized copying that occurs in the United States.³²⁵

Further, EU rights-holders will likely suffer losses from more conventional means of importation from the United States into the EU, where royalties should be paid. The problem of unauthorized importation of products from one territory to another to circumvent a right-holder's entitlements is a notorious one for intellectual property rightsholders. The rampant digitization of works of authorship, combined with low digital transmission costs, encourages such cross-border infringement activity. If the U.S. companies employing prior works do not protect the EU rights-holders in these circumstances, rights-holders will suffer uncompensated losses. Therefore, the bifurcation of copyright duration between the EU and the United States creates problems, both for persons wishing to utilize pre-existing works in subsequent works, and for the rights-holders whose EU rights may be diminished as a result of distribution of such works in the United States. The possibility for extensive cross-border infringement of works could result in a decreased availability of such works to the public, to the extent that copyright holders of works protected in the EU but not protected

commentary, interactive search programs, etc., would likely be protectable under copyright, as may the compilation as a whole.

324. See generally Pamela Samuelson & Robert J. Glushko, *Intellectual Property Rights for Digital Library and Hypertext Publishing Systems*, 6 HARV. J.L. & TECH. 237 (1993). The EC is considering ways of addressing infringement problems resulting from the ubiquitous and sometimes anonymous on-line distribution of works of authorship. Green Paper, *supra* note 13, COM (95) 382 Final. See also Jane C. Ginsburg, *Putting Cars on the "Information Superhighway": Authors, Exploiters, and Copyrights in Cyberspace*, 95 COLUM. L. REV. 1466, 1496 (1995).

325. Ginsburg, *supra* note 324 at 1466.

in the United States may deny exploitation that would explicitly encompass U.S. distribution, or may even (due to the ease with which works now travel across borders) deny all exploitation in digital form. Should widespread infringement of EU rights occur as a result of the extant term discrepancies, copyright tensions between the United States and the EU may result.

B. The C.T.E.A. Resolves Most EU-U.S Duration Discrepancies

The U.S. Copyright Office recognized the detrimental effects of U.S. works receiving shorter protection in the EU.³²⁶ In September, 1993, the U.S. Copyright Office held hearings to consider whether the United States should, in view of the EC Term Directive, extend U.S. copyright protection by 20 years.³²⁷ Testimony contemplating the detrimental effects of the rule of the shorter term treatment on U.S. authors in the EU provided an impetus for proposal of the C.T.E.A.³²⁸ In introducing the U.S. House of Representatives' version of the C.T.E.A., Rep. Moorhead stated that "once the EU Directive is implemented, United States works will continue to be granted the shorter life plus 50 year term before falling into the public domain."³²⁹ He further stated that if the C.T.E.A. is not adopted, "American creators will have 20 years less protection than their European counterparts—20 years during which Europeans will not be paying Americans for their copyrighted works."³³⁰

The proposed C.T.E.A. would greatly increase the U.S. term of protection for both EC and U.S.-origin works, and thus eliminate or narrow many of the duration discrepancies between the United States and the EU.

The C.T.E.A. would result, for certain works, in a longer term

326. *Copyright Office: Hearing on Possible Extension of Copyright Term*, 46 PAT., TRADEMARK & COPYRIGHT J. (BNA) 466 (Sept. 30, 1993).

327. *Id.*

328. H.R. REP. NO. 989, 104th Cong., 1st Sess. at 497.

329. CONG. REC. H.R. E379 (daily ed. February 5, 1995) (statement of Rep. Moorehead).

330. *Id.*

of protection than even the new EU term of 70 years p.m.a. For example, under the C.T.E.A., Joyce's *Ulysses* will receive protection until 2017, 95 years after its publication in 1922. Under the EC Term Directive, however, it will be protected in EU member states only until 2011—6 years less than the protection in the United States under the C.T.E.A. Accordingly, the C.T.E.A. would introduce new disharmonies in certain p.m.a./publication date scenarios for pre-1978 works.

C. New Laws Create Prejudice against U.S. Authors and Works of U.S. Origin and Complicate the International Exploitation of Works

A comparison of the results of current EU and U.S. copyright duration laws shows certain significant discrepancies in terms of protection that disadvantage the rights of U.S. authors and authors who first publish their works in the United States.

The new laws, of both the EU and the United States, prejudice U.S. authors and works of U.S. origin. By definition, the advantage afforded to EU nationals by the ruling in *Phil Collins* will not benefit U.S. nationals.³³¹ As discussed earlier, the nondiscriminatory application of the rule of the shorter term mandated by *Phil Collins* benefits only authors of EU nationality.³³² The EC Term Directive exaggerates the prejudice against U.S. authors, and introduces a prejudice against works of U.S. origin. The EC Term Directive lengthens the term of protection for EU authors and works of EU country of origin, while denying such benefits to works by U.S. authors, unless such works have an EU country of origin. As a result of the United States' adherence to Berne, this prejudice also applies to works by authors that used the "back door to Berne," but whose works became U.S. origin works after the United States became a Berne signatory.³³³ This prejudice not only operates prospectively from the effective date of the EC Term Di-

331. See *supra* part I.B.2.

332. *Id.*

333. See *supra* part I.A.4.

rective, but it also operates retroactively in favor of EU authors and against U.S. and other non-EU authors, by virtue of the EC Term Directive's revival mechanisms.

The U.R.A.A. revives U.S. copyrights in works of non-United States country of origin by non-U.S. authors that have fallen into the public domain as a result of failure to fulfill copyright formalities.³³⁴ However, the U.R.A.A. specifically excludes revival of works first published in the United States, as well as works by U.S. authors, unless such works are co-authored by at least one national or domiciliary of a non-United States "eligible country." As with the EC Term Directive,³³⁵ EU authors receive a benefit under the U.R.A.A. not granted to U.S. authors, and works of U.S. origin are also prejudiced.

Authors who are damaged by such discriminatory treatment may not rely on TRIPs to remedy the prejudices resulting from the new laws. First, TRIPs permits the discriminations inherent in Berne, and thus permits the discriminations contained in the EC Term Directive, because such discriminations are permitted under Berne. Next, TRIPs sets a shorter than 50 year p.m.a. term of protection (e.g. 50 years post-publication), which thus permits the United States' 75-year post publication rule to remain intact, and does not mandate revival of those works by U.S. authors that are not revived by the U.R.A.A. Finally, even if TRIPs contained standards that would reduce the prejudice against U.S. authors, it cannot be directly relied upon in court, but must be enforced by a complaining country.

The C.T.E.A. would eliminate some of the extant prejudices against U.S. authors and works first published in the U.S. The C.T.E.A. would largely eliminate the detrimental effects of the rule of the shorter term on works by U.S. authors and works of U.S. country of origin by closing the gap between EU and U.S. terms.³³⁶

334. See *supra* part II.C.1.

335. See *supra* part II.A.2.

336. See *supra* part II.C.4.

The C.T.E.A. would also benefit U.S. authors, and the U.S. copyright industry as a whole, by extending the terms of protection in the EU for such works by 20 years.

CONCLUSION

The recent laws affecting copyright duration collectively represent a major increase in EU and U.S. copyright protection that have important practical implications when entering into licensing transactions, conducting acquisition due diligence and valuations, and preparing derivative and collective works based on pre-existing, including previously public-domain, works.

Additionally, EU and U.S. laws presently in force have both discriminatory and bifurcating effects that should be neutralized. The C.T.E.A. would reduce the current discriminations against works of U.S. authors and works of U.S. country of origin, as well as essentially eliminate the EU-U.S. term discrepancies and avoid the chilling effect such discrepancies may have on distribution of works.

