

THE COLUMBIA JOURNAL OF
LAW & **ARTS**
the

A QUARTERLY JOURNAL OF LAW AND THE ARTS,
ENTERTAINMENT, COMMUNICATIONS AND INTELLECTUAL PROPERTY

Restoration of Copyrights: Dueling Trolls and Other Oddities
Under Section 104A of the Copyright Act
William Gable

Vol. 29, No. 2 ♦ **Winter 2005**

COLUMBIA UNIVERSITY SCHOOL OF LAW

Restoration of Copyrights: Dueling Trolls and Other Oddities Under Section 104A of the Copyright Act

William Gable*

Introduction	182
I. Background of Section 104A	184
A. Enactment of Section 104A	184
B. The Emerging Landscape Of Section 104A	187
C. The Problem Cases	188
II. Scope and Application of Section 104A	189
A. Works Eligible for Restoration.....	189
1. The first requirement: the work is original.....	191
2. The second requirement: the work is not in the public domain in the source country through expiration of copyright.....	194
3. The third requirement: the work is already in the public domain in the United States under enumerated circumstances.....	195
4. The fourth requirement: the author was a national or domiciliary of an eligible country when the work was created.....	201
5. The fifth requirement: the work was first published in an eligible country and was not published within thirty days in the United States	202
B. Persons Entitled to Enforce a Restored Copyright Against Infringers.....	204
1. Identifying the author under foreign law	205
2. Cases finding rights initially vesting in the owner rather than the author	206
3. Problems created by the inconsistent designation of “authors” under sections 104A, 203 and 304(c) of the Copyright Act	208
C. Enforcement of Restored Copyrights.....	211
1. Providing notice of restored work claims to users of restored works	211
2. Persons deemed to be “reliance parties” under section 104A.....	212
3. Reliance parties’ rights to ongoing use of restored works	218
4. The blurred line between “derivative works” and “substantially similar reproductions”	220
D. Remedies of Copyright Owners Under Section 104A	228
1. Section 104A cases discussing the availability of attorneys’ fees	229
2. Immunity from warranty and related liability.....	229
III. Conclusion	231

* William Gable practices intellectual property law, entertainment law and mediation in the Los Angeles and Century City offices of Morrison & Foerster. The author gratefully acknowledges the following persons for their comments on this article and for their esteemed friendship: Paul Goldstein, Anthony Press, Gabe Perle, Lon Sobel, Sylvia Mulholland and Rufus Pichler. Any defects or other oddities in the piece owe solely to the author. The views expressed in this article are those of the author alone and may not be attributed to Morrison & Foerster or any of its clients.

INTRODUCTION

In 1994, Congress fundamentally altered the landscape of United States copyright law by enacting Section 104A of the 1976 Copyright Act.¹ In a single stroke, this provision—aimed at bringing the United States into compliance with the Berne Convention’s “Rule of Retroactivity”²—automatically restored U.S. copyrights in a vast universe of foreign works as a matter of law on January 1, 1996.³

During the first ten years of section 104A’s existence, the handful of published decisions relating to “restored copyrights” have concerned such various works as

- flame-haired “Troll Dolls,” originally from Denmark, in vogue with children throughout the United States during the 1960s;⁴
- the sound recording of the theme song, underlying musical composition and artwork from classic Japanese *Godzilla* motion pictures;⁵
- numerous masterpieces of twentieth-century Russian composers Prokofiev, Stravinsky, Shostakovich, Khatchaturian, Glier, Kabalevsky and others;⁶
- thousands of foreign films, including the 1963 motion picture *The*

1. Section 104A is part of the legislation implementing the General Agreement on Tariffs and Trade (“GATT”). See Uruguay Round Agreements Act, Pub. L. No. 103-465, 108 Stat. 4809, 4976 (1994) (codified as amended at 17 U.S.C. § 104A (1994)); Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, as last revised at Paris, July 24, 1971 (amended 1979), 25 U.S.T. 1341, 828 U.N.T.S. 221 [hereinafter Berne Convention] (providing minimum standards for protecting copyrights internationally); Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994-Marrakesh Agreement Establishing the World Trade Organization art. 9, 33 I.L.M., 1125, 1197 [hereinafter TRIPs Agreement] (establishing minimum standards for protecting intellectual property rights internationally).

2. See 17 U.S.C. § 104A. “This protection results from the United States’ promise, in the context of the TRIPs annex to the Agreement Establishing the World Trade Organization (‘WTO’), to adhere to the Berne Convention, which the United States had entered in 1989. In order to comply with the Berne Convention’s ‘Rule of Retroactivity’ contained in [a]rticle 18, Congress enacted the Uruguay Round Agreements Act. The Act supplanted a previous version of § 104A (enacted only one year earlier in an effort to comply with the North American Free Trade Agreement (‘NAFTA’), and provided for broad restoration of foreign works.” *Dam Things From Den. v. Russ Berrie & Co. (Dam Things II)*, 290 F.3d 548, 554 (3d Cir. 2002) (citations omitted).

3. See *Dam Things II*, 290 F.3d at 552 (“Section 104A is a highly unusual provision which has restored copyright protection in a vast number of foreign works previously in the public domain.”). Section 104A operates only to restore U.S. copyrights in foreign works. See PAUL GOLDSTEIN, INTERNATIONAL COPYRIGHT: PRINCIPLES, LAW AND PRACTICE § 3, at 61 (2001) [hereinafter GOLDSTEIN, INTERNATIONAL COPYRIGHT] (“Copyright is territorial: a French or Japanese copyright does not exist outside France or Japan.”). See also *Subafilms, Ltd. v. MGM-Pathe Comm’ns Co.*, 24 F.3d 1088, 1091 n.6 (9th Cir. 1994) (“The Copyright Act does not extend to acts of infringement that take place entirely abroad . . .”).

4. See *Dam Things From Den. v. Russ Berrie & Co. (Dam Things I)*, 173 F. Supp. 2d 277, 279 (S.D.N.J. 2001); *Dam Things II*, 290 F.3d at 553.

5. See *Toho Co. v. Priority Records*, 2002 U.S. Dist. LEXIS 14093, at *2-3 (C.D. Cal. 2002); *Toho Co. v. William Morrow & Co.*, 33 F. Supp. 2d 1206, 1209 (C.D. Cal. 1998).

6. See *Luck’s Music Library, Inc. v. Ashcroft*, 321 F. Supp. 2d 107, 110 (D.D.C. 2004); *Luck’s Music Library, Inc. v. Gonzalez*, 407 F.3d 1262 (D.C. Cir. 2005).

Sicilian, and many dozens of films by the legendary Mexican actor-writer-producer Cantinflas, from that country's "Golden Age" of cinema;⁷

- elaborate woodblock prints of the German artist M.C. Escher that have long enjoyed widespread commercial success in the United States;⁸
- a photograph of Charlotte Dabney by well-known German photographer Thomas Hoepker, the image of which was published once in the German photography magazine *Foto Prisma* in 1960⁹ and
- vintage recordings of Pablo Casals, Yehudi Menuhin and Edwin Fischer from the 1930s originally recorded for The Gramophone Company Limited (now known as EMI Records).¹⁰

As artistically and commercially significant as these many works may be, they represent only the tip of the iceberg. The universe of restored works is commercially and artistically far-reaching and may prove to be of considerable financial and creative significance over time.¹¹

Given changing demographics in the U.S. and the vast number of restored copyrights that exist in classic Mexican films¹²—many of them owned by Hollywood studios—it is no surprise that these works have spawned some of the earliest section 104A lawsuits.¹³ In the future, Hollywood could find itself drawn even further into section 104A litigation, over not only foreign films but foreign

7. See *id.* See also *Alameda Films v. Authors Rights Restoration Corp., Inc.*, 331 F.3d 472, 475 (5th Cir. 2003); *Laparade v. Ivanova*, 387 F.3d 1099 (9th Cir. 2004); *Ivanova v. Columbia Pictures*, 217 F.R.D 501, 503 (C.D. Cal. 2003); *Films By Jove, Inc. v. Berov*, 154 F. Supp. 2d 432, 435 (E.D.N.Y. 2001).

8. See *Cordon Holding B.V. v. Nw. Publ'g Corp.*, 2002 U.S. Dist. LEXIS 6111, at *3-4 (S.D.N.Y. 2002); *Cordon Art B.V. v. Walker*, 1996 U.S. Dist. LEXIS 20708, at *2-3 (S.D. Cal. 1996); *Cordon Holding C.B. v. Nw. Publ'g Corp.*, 2005 U.S. Dist. LEXIS 3860, at *4 (S.D.N.Y. 2005).

9. See *Hoepker v. Kruger (Hoepker I)*, 2001 U.S. Dist. LEXIS 13043, at *1 (S.D.N.Y. 2001); *Hoepker v. Kruger (Hoepker II)*, 200 F. Supp. 2d 340, 342 (S.D.N.Y. 2002).

10. See *Capitol Records v. Naxos of Am. (Capitol Records I)*, 262 F. Supp. 2d 204 (S.D.N.Y. 2003); *Capitol Records v. Naxos of Am. (Capitol Records II)*, 372 F.3d 471, 474 (2d Cir. 2004).

11. Notices of Intent to Enforce a Restored Copyright ("NIEs") have been filed at the U.S. Copyright Office for numerous internationally prominent authors and works. (See Section II.C.1, *infra*, for a discussion of NIE filing and service procedures.) NIEs have been filed on behalf of Robert Graves, Leni Riefenstahl, C.S. Lewis and Alain Robbe-Grillet, for example. NIEs have been filed for many hundreds of European, Russian and Mexican films claimed by entities such as MGM, Inc., Merchant Ivory, UGC DA International, Soyuzmultfilm Studios, Columbia Pictures (e.g., *Los Tres Mosqueteros*), Star TV Filmed Entertainment, Ltd. (e.g., *Bruce Lee, the Legend*) and CAM, SRL (claiming Fellini films such as *8 1/2*, *La Dolca Vita*, *Casanova*, *Juliet of the Spirits*, *The Leopard* and others). NIEs for many hundreds of music compositions, some by prominent twentieth-century foreign composers, have been filed by entities such as Boosey & Hawkes, Chester Music, Ltd., G. Schirmer, Music Sales Corp. ("Alley Cat") and Larrikin Music Publishing Pty. ("Kookabura Sits in the Old Gum Tree"). Numerous literary works have been claimed by Harcourt Brace, among many others. Once public domain Beatles photographs owned by Apple Corps also have been claimed.

12. See *supra* note 11.

13. See *Alameda Films v. Authors Rights Restoration Corp., Inc.*, 331 F.3d 472 (5th Cir. 2003); *Laparade v. Ivanova*, 387 F.3d 1099 (9th Cir. 2004); *Ivanova v. Columbia Pictures*, 217 F.R.D 501, 503 (C.D. Cal. 2003).

works incorporated in Hollywood productions (e.g., novels, screenplays and soundtracks) whose U.S. copyrights may have been restored.¹⁴ Author J.R.R. Tolkien's *Lord of the Rings* trilogy, for example, is among those many works whose U.S. copyrights have been restored under section 104A.¹⁵

Use in the United States of restored foreign works assumed to be in the public domain is widespread. Scientific texts previously in the public domain, now protected under restored U.S. copyrights (often from countries with which the U.S. has never had copyright relations), are routinely published in the United States verbatim without a license. U.S. distributors and publishers of books and records regularly sell foreign works that are thought to be in the public domain but are now protected by restored copyright. Entire businesses, some built upon decades of previously legal use of foreign public domain materials, could be forced to close their doors.¹⁶

Restoration of foreign works operates automatically and, thus, is a trap for the unwary. Section 104A treats U.S. works differently from foreign works, resurrecting not a single domestic copyright from the public domain.¹⁷ The obvious question arises: what led Congress to enact such a thing?

I. BACKGROUND OF SECTION 104A

A. ENACTMENT OF SECTION 104A

After decades of reluctance, the United States finally became a member of the Berne Convention on March 1, 1989.¹⁸ Despite the fact that the first Berne Act,

14. In discussing why the U.S. should not join the Berne Convention, a Senate Foreign Relations Report from the 1950s stated, "This revival of copyright under the retroactivity doctrine would have worked considerable prejudice to American motion picture, music, and publishing houses. Thus, for example, it might have required an American movie producer to start paying royalties to a foreign author for a work which had been adapted for the cinema when it was not protected in the United States." See, e.g., S. EXEC. REP. NO. 5, 83d Cong., 2d Sess. 3 (1954).

15. See Copyright Restoration of Works in Accordance With the Uruguay Round Agreements Act, 61 Fed. Reg. 46,134, 46,158 (Aug. 30, 1996).

16. See, e.g., *Luck's Music Library, Inc. v. Ashcroft*, 321 F. Supp. 2d 107, 111 (D.D.C. 2004) (noting that "many of Moviecraft's customers refuse to purchase and use the [restored] foreign works"). See also Moviecraft Memos, <http://www.moviecraft.com> (last visited Jan. 17, 2005) (indicating that Moviecraft has been in business since 1985).

17. See, e.g., 17 U.S.C. § 104A(h)(6)(E) (restoring copyrights in foreign sound recordings, even though U.S. copyright protection remains unavailable for U.S. sound recordings fixed prior to February 15, 1972). See also *Barris v. Hamilton*, 1999 U.S. Dist. LEXIS 7225, at *16 (S.D.N.Y. 1999) (finding "[p]laintiff's work is not eligible for 'restoration' once the copyright lapsed as it was authored by an American").

18. Nevertheless, the 1976 Copyright Act included various provisions anticipating the United States' eventual ratification of Berne. See Berne Convention Implementation Act, Pub. L. No. 100-568, 102 Stat. 2853 (1988); H.R. REP. NO. 100-609, at 21, 41 (1988) ("It can safely be stated that Congress drafted and passed the 1976 Act with a 'weather eye' on Berne"); *Chere Amie, Inc. v. Windstar Apparel Corp.*, 191 F. Supp. 2d 343, 350 (S.D.N.Y. 2001) ("An innovation of the 1976 Copyright Act was to move to a system of 'automatic copyright' in which copyright vests by the mere act of creation.") (citation omitted). This change was made in contemplation of the United States' eventual joining of the

which was enacted in 1886, had long established the *de facto* standard for international copyright norms and protection, the United States had steadfastly resisted membership in the Convention because it objected to Berne's protection of moral rights,¹⁹ its prohibition on formalities²⁰ and its requirement of restoring certain expired copyrights.²¹

During the 1990s, however, the United States became increasingly concerned over piracy.²² It engaged in efforts to protect intellectual property rights

Berne Convention for the Protection of Literary and Artistic Works, article 5(2) of which prohibits the "enjoyment and exercise" of copyright being "subject to any formality." (citing 1 WILLIAM PATRY, COPYRIGHT LAW & PRACTICE 59, 428 (1994)); GOLDSTEIN, INTERNATIONAL COPYRIGHT, *supra* note 3, at § II ("[T]he prospect of Berne membership explains the decision in the 1976 Act to extend the general term of copyright to the Berne minimum term of fifty years after the author's death."). *But see* 17 U.S.C. § 104(c) ("No right or interest in a work eligible for protection under this title may be claimed by virtue of, or in reliance upon, the provisions of the Berne Convention, or the adherence of the United States thereto. Any rights in a work eligible for protection under this title 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.").

19. Although beyond the scope of this article, moral rights (for example, rights of attribution, integrity, divulgation and withdrawal) are recognized by many countries and are reinforced by international treaty. *See, e.g.*, Berne Convention, *supra* note 1, art. 6*bis*, 10, 10*bis*; WIPO, Performances and Phonograms Treaty art. 5(I), Dec. 20, 1996, 36 I.L.M. 76, 86 (1997). Except in the most limited circumstances, however, moral rights are not protected and may not be asserted under U.S. copyright law. *See, e.g.*, 17 U.S.C. § 106A (extending rights of attribution and integrity to certain "works of visual art" under highly circumscribed situations). Nevertheless, in the United States, some protection for rights amounting to attribution and integrity can be had under state and federal unfair competition, privacy, defamation and other laws.

20. *See* Berne Convention, *supra* note 1, art. 5(2). *See also infra* Section II.A.3.a. Throughout the twentieth century, the United States maintained certain copyright "formalities" that the vast majority of other nations did not impose. However, since the amendment of the 1976 Act by the Berne Convention Implementation Act (effective March 1, 1989), the formalities of copyright notice, deposit and registration are no longer conditions of copyright protection in the United States. *See* Berne Convention Implementation Act, Pub. L. No. 100-568, 102 Stat. 2853 (1988).

21. Article 18 of the Berne Convention provides that member countries shall provide copyright protection "to all works which, at the moment of its coming into force, have not yet fallen into the public domain in the country of origin through the expiry of the term of protection." *See* Berne Convention, *supra* note 1, art. 18. Although this provision does not require "restoration" per se, article 18 has been interpreted as requiring the restoration of foreign works provided for under section 104A.

22. The Motion Picture Association of America ("MPAA"), the Recording Industry Association of America ("RIAA") and the International Intellectual Property Alliance ("IIPA") all supported passage of section 104A. *See Intellectual Property Provisions: Joint Hearing on H.R. 4894 and S. 2368 Before the Subcomm. on Intellectual Property & Judicial Administration of the H. Comm. on the Judiciary and the Senate Subcomm. on Patents, Copyrights and Trademarks of the S. Comm. on the Judiciary*, 103d Cong. 133, 255 (1994) (statement of Jack Valenti, President and CEO, MPAA) (urging Congress to adopt retroactive foreign copyright restoration to benefit U.S. business abroad). *See also id.* at 250 (comments of Jason Berman, CEO, RIAA); *id.* at 244 (comments of Eric H. Smith, Executive Director, IIPA). These organizations saw section 104A as a compromise that would result in overriding benefits to U.S. copyright owners whose works were being infringed elsewhere in the world. *See Dam Things From Den. v. Russ Berrie & Co.*, 173 F. Supp. 2d 277, 281 n.3 (S.D.N.J. 2001) ("The motivation for this startling change in copyright policy is ultimately to benefit United States authors—the hope being that retroactive American protection of foreign works will induce foreign countries to afford retroactive protection to American works.") (citing 3 DAVID NIMMER, NIMMER ON COPYRIGHT, § 9A.01. (2001)); *Intellectual Property Provisions: Joint Hearing on H.R. 4894 and S. 2368 Before the Subcomm. on Intellectual Property & Judicial Administration of the H. Comm. on the Judiciary and the Senate*

worldwide, joining the World Trade Organization ("WTO") during this period.²³ In 1994, the United States spearheaded adoption of the Uruguay Round agreements, a central legal accomplishment of which was the Agreement on Trade-Related Aspects of Intellectual Property Rights ("TRIPs Agreement").²⁴ TRIPs did not recognize moral rights, but it otherwise made provisions of Berne enforceable through WTO mechanisms. In order to comply with Berne's article 18 and avoid sanctions, the United States enacted section 104A.²⁵

Section 104A was implemented on a fast-track basis.²⁶ "After [section 104A] was introduced on September 27, 1994, Congress promptly adjourned for its midterm election campaigns. When passed in December by a largely lame duck Congress, not one comma was altered."²⁷ Moreover, because TRIPs was not a "treaty," it was never presented to the U.S. Senate for advice and consent.²⁸ Consequently, the legislative history of section 104A is limited solely to several

Subcomm. on Patents, Copyrights and Trademarks of the S. Comm. on the Judiciary, 103d Cong. 133, 248 (1994) (statement of Eric H. Smith, Executive Director, IIPA) ("Obtaining protection for U.S. movies, music, sound recordings, software, books, and other copyrighted works on a 'retroactive' basis has been one of the key objectives of the last three Administrations. The reason is simple: vast libraries of valuable works remain unprotected in many countries that have been either late in passing copyright legislation or late in entering into copyright relations with the [United States]."). See also Marshall A. Leaffer, *Protecting United States Intellectual Property Abroad: Toward a New Multilateralism*, 76 IOWA L. REV. 273, 282-83 (1991) (describing a change in attitudes among developing nations that are beginning to see the benefits of strong copyright protection).

23. See *supra* note 1.

24. See David Nimmer, *The End of Copyright*, 48 VAND. L. REV. 1385, 1391 (1995) [hereinafter Nimmer, *The End of Copyright*].

25. Various commentators suggest that section 104A went well beyond the mandate of Berne Article 18 or the requirements under the Uruguay Rounds. See, e.g., Peter A. Jaszi, *Goodbye to All That—A Reluctant (and Perhaps Premature) Adieu to a Constitutionally-Grounded Discourse of Public Interest in Copyright Law*, 29 VAND. J. TRANSNAT'L L. 595, 607 (1996) [hereinafter Jaszi]; Gloria C. Phares, *Retroactive Protection of Foreign Copyrights: What Has Congress Be-GATT?*, 7 J. PROPRIETARY RTS. 2 (1995).

26. See Nimmer, *The End of Copyright*, *supra* note 24, at 1398. See also Irwin Karp, *Final Report, Berne Article 18 Study on Retroactive United States Copyright Protection for Berne and Other Works*, 20 COLUM.-VLA J.L. & ARTS 157, 173, 185-86 (1996) [hereinafter Karp Report] (attributing the lack of a legislative history to the adoption of section 104A under a "fast track" regimen and noting that "[a]s part of the overall trade bill, written primarily by the USTR the new § 104A could only be defeated if Congress rejected the entire bill"); see WILLIAM PATRY, *COPYRIGHT AND THE GATT: AN INTERPRETATIONAL LEGISLATIVE HISTORY OF THE URUGUAY ROUND AGREEMENTS ACT 1* (1995) [hereinafter PATRY, *COPYRIGHT AND THE GATT*] (noting that "[t]he Uruguay Round was signed on April 15, 1994, just before the Clinton Administration's authority to submit implementing legislation to Congress under fast-track procedures expired."). MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT § 9A.04[C][3][b]* (2003) [hereinafter NIMMER ON COPYRIGHT] (referring to "the black hole of legislative history surrounding the Uruguay Round Agreements Act").

27. Nimmer, *The End of Copyright*, *supra* note 24, at 1407-08. Section 104A "was written by the Administration . . . The copyright and other intellectual property provisions were prepared by the Office of the United States Trade Representative (USTR). Among the principal architects of § 104A were USTR's associate general counsel, Catherine Field, and two Patent and Trademark Office attorneys, Chris Meyer and Michael Keplinger (well-respected copyright experts). Counsel for the Judiciary Committee copyright subcommittees played a minor role. The Register of Copyrights and her staff were not invited to participate in the drafting process." Karp Report, *supra* note 26, at 185-86.

28. See PATRY, *COPYRIGHT AND THE GATT*, *supra* note 26, at 3.

pages in the Statement of Administrative Action (“SAA”), adopted by Congress as “quasi-legislative history,”²⁹ a scant House Report,³⁰ and an equally brief and un-instructive Senate Report.³¹ As a result, courts, commentators and litigators are largely on their own when interpreting section 104A.

B. THE EMERGING LANDSCAPE OF SECTION 104A

Section 104A creates numerous problems for copyright owners and users, litigators and courts.³² Even experienced U.S. copyright practitioners may be unaware of the legal significance of January 1, 1996, the date on which U.S. copyrights in qualifying public domain foreign works were automatically restored. Owners of restored works and their counsel may often be unaware of, or slow to assert, their rights under section 104A.

The section 104A landscape is further complicated by the statute itself, which is highly technical, convoluted, oftentimes difficult to decipher and fraught with potential unintended consequences.³³ The provision’s shaky beginnings are evidence of this; in its short existence, section 104A has already required several Congressional clarifying amendments to render it decipherable.³⁴ Certain provisions of section 104A remain highly problematic and could benefit from additional clarification.

Although there have been challenges to the constitutionality of section 104A,³⁵

29. The URAA provides that “[t]he statement of administration action . . . shall be regarded as an authoritative expression by the United States concerning the interpretation and application of the Uruguay Round Agreements and this Act in any judicial proceeding in which a question arises concerning such interpretation or application.” See Uruguay Round Agreements Act, Pub. L. No. 103-465, 108 Stat. 4809, 4819 (1994). Thus, the SAA arguably serves in the place of committee reports created under the normal legislative process.

30. H.R. REP. NO. 103-826, pt. 1, at 8 (1994), as reprinted in 1994 U.S.C.C.A.N. 3773, 3780.

31. S. REP. NO. 103-412, at 123 (1994).

32. See Nimmer, *The End of Copyright*, supra note 24, at 1404, 1420 (observing that passage of section 104A “creates myriad issues and questions, which is why the recapture provision is so lengthy” and that, as a result, “practitioners and scholars trained in the discipline formerly called ‘copyright’ will in the future be called upon to answer even more questions, which will increase geometrically in complexity.”).

33. See, e.g., NIMMER ON COPYRIGHT, supra note 26, at § 9A.04[A][4], 9A-28 (“[T]he crepuscular language in which [section 104A] resurrection is clothed gives ample opportunity for copyright plaintiffs to exercise their ingenuity.”).

34. See Copyright Clarifications Act of 1996, H.R. 554, 104th Cong. (1996) (proposal to amend section 104A(d)(3) “safe harbor” provision to correct a word change made “during technical and conforming revisions . . . [that] inadvertently altered the effect of the subsection and in large part nullified its purpose;” to amend section 104A(h)(2) to address statutory ambiguity over whether “date of restoration” was intended to be January 1, 1995 or January 1, 1996 and to amend section 104A(h)(3) definition of “eligible country” to correct provision inadvertently requiring that use of a restored work commence prior to 1886 in order to qualify the user for “reliance party” status); see also Proclamation 6780, 60 Fed. Reg. 15,845, 15,847 (March 23, 1995) (proclamation of President Clinton clarifying January 1, 1996 as the date upon which the TRIPs obligations would take effect in the United States).

35. See *Golan v. Ashcroft*, 310 F. Supp. 2d 1215 (D.C. Colo. 2004) (plaintiffs challenging the constitutionality of section 104A were found to have cognizable claims under the Intellectual Property clause and the First and Fifth Amendments and to have adequately distinguished their case from the holding of *Eldred v. Ashcroft*, 537 U.S. 186 (2003)). But see *Luck’s Music Library, Inc. v. Ashcroft*,

the Supreme Court's recent *Eldred* decision suggests the Court may not be overly-inclined to second-guess Congress's expansion of copyright protection under section 104A.³⁶ Indeed, certain commentators suggest Congress could eventually bend to pressure to expand restoration to United States works, rather than treating them disparately under the Act.³⁷ For the time being at least, it appears that copyright restoration is here to stay.

This Article highlights many areas of concern in the statute and emerging section 104A case law and aims to provide a roadmap to understanding and exploiting the provision.

C. THE PROBLEM CASES

As this Article illustrates, courts have struggled in applying section 104A due to incomplete or inaccurate applications of foreign law, inadequate factual records or findings of fact to conclusively establish or dispute required elements of the provision, or erroneous interpretations or applications of various parts of the provision.

Although this Article references every reported 104A decision to date, three restoration lawsuits figure heavily in its analysis: the *Dam Things* cases out of the Third Circuit,³⁸ the *Hoepker v. Kruger* cases decided by the Southern District of New York,³⁹ and the *Cordon Holding* and *Cordon Art* cases⁴⁰ filed in both the Southern District of California and the Southern District of New York. As these

321 F. Supp. 2d 107, 109 (D.D.C. 2004) (court not persuaded by plaintiff's post-*Eldred* constitutional challenge to section 104A under the Intellectual Property Clause and the First and Fifth Amendments).

36. See *Eldred*, 537 U.S. at 222 (upholding constitutionality of copyright duration extension); *Luck's Music Library, Inc. v. Gonzalez*, 407 F.3d 1262, 1265 (D.C. Cir. 2005) (finding U.S. Constitution does not bar section 104A); *Golan v. Gonzalez*, 2005 U.S. Dist. LEXIS 6800, *48 (D.C. Colo. 2005) (also finding U.S. Constitution is no bar to section 104A). Cf. PATRY, COPYRIGHT AND THE GATT, *supra* note 26, at 22 (pointing out that the first U.S. Copyright Act of 1790 "provided protection to maps, charts, and books that were created before the date of enactment so long as they were unpublished on that date."). But see *United Christian Scientists v. First Church of Christ*, 829 F.2d 1152, 1166 (D.C. Cir. 1987) (striking down law restoring copyrights in Mary Baker Eddy's works as violative of Establishment Clause, noting "it is not the office of Congress to grant continual, if indeed not perpetual, dominion over the text"). See also *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989) (holding, in patent case, that Congress does not have the authority to remove knowledge from the public domain because such action violates the federal policy of free competition).

37. See *Jaszi*, *supra* note 25, at 596 (arguing that, due to the disparate treatment of U.S. authors under section 104A, "[s]ooner or later, and more likely sooner than later, one will see legislation introduced in the U.S. Congress to restore protection for domestic works now in the public domain because of a pre-March 1989 failure of notice or a pre-June 1992 failure to renew"). See also Nimmer, NIMMER ON COPYRIGHT, *supra* note 26, at § 9A.01 ("In future years, the pressure towards copyright restoration may gain greater momentum. American authors, disgruntled about the favoritism displayed under U.S. law towards foreign authors, may secure new amendments, rescuing their own works as well from the public domain."); *id.* at § 9A.05[A], [B] (discussing a 1997 Congressional clarifying amendment effectively restoring U.S. copyrights in musical compositions having previously entered the public domain due to their having been included on phonorecords without notice).

38. See *supra* note 4.

39. See *supra* note 9.

40. See *supra* note 8.

cases illustrate, restoration actions involving multiple, related works can be highly problematic, both from an evidentiary and legal standpoint. The *Dam Things* cases, in particular, raise complex issues under copyright law and are given special attention.

II. SCOPE AND APPLICATION OF SECTION 104A

Section A below identifies and discusses the criteria under which works may be eligible for restoration under section 104A. Section B identifies the persons eligible to assert copyright actions for infringement of restored works. Section C discusses enforcement of copyrights in restored works and the requirements for “reliance party” status under section 104A. Section D outlines the remedies available to the owner of a restored copyright. Finally, Section E summarizes the conclusions reached and identifies those section 104A provisions most in need of further clarification by courts, Congress or the Copyright Office.

A. WORKS ELIGIBLE FOR RESTORATION

“Restored works” are defined in section 104A(h)(6). In relevant part, this section provides that

“[t]he term ‘restored work’ means an original work of authorship that:

(A) is protected under subsection (a);⁴¹

(B) is not in the public domain in its source country⁴² through expiration of term of

41. Subsection 104A(a)(1)(B) provides that copyright in a restored work “shall subsist for the remainder of the term of copyright that the work would have otherwise been granted in the United States if the work never entered the public domain in the United States.” Thus, section 104A(h)(6)(A) underscores that copyright restoration is not available for works whose copyright terms under U.S. law would otherwise already have expired.

42. Section 104A(h)(8) defines a “source country” as “a nation other than the United States” and, in the case of a published work, “the eligible country in which the work is first published.” See 17 U.S.C. §§ 104A(h)(8)(A), (C)(i) (2000). The term “eligible country” includes, among other things, any country adhering to the Berne Convention, other than the United States. See 17 U.S.C. § 104A(h)(3). See *infra* Section II.A.4.

Sub-section (h)(8)(B) defines “source country” in the case of an *unpublished* work. This sub-section is a thorough anomaly. Under U.S. law, there are no circumstances in which an unpublished work (whether U.S. or foreign) would ever have entered the public domain in the United States or be subject to section 104A. See 17 U.S.C. § 104(a) (unpublished works “are subject to protection under this title without regard to the nationality or domicile of the author.”).

One further, problematic aspect of section 104A(h)(8) is worth noting. Sub-section (h)(8)(C) provides that when a work is published on the same day in more than one eligible country, “source country” means the eligible country that has the most significant *contacts* with the work. See 17 U.S.C. § 104A(h)(8)(C)(ii) (emphasis added). Although no published section 104A opinion has yet to address the issue, disputes are bound to arise under this provision. Traditional conflicts-of-law principles would resolve the issue by applying the law of the state with the *most significant relationship* to the transaction

protection;

(C) is in the public domain in the United States due to (i) noncompliance with formalities imposed at any time by United States copyright law, including failure of renewal, lack of proper notice, or failure to comply with any manufacturing requirements; (ii) lack of subject matter protection in the case of sound recordings fixed before February 15, 1972; or (iii) lack of national eligibility;

(D) has at least one author or rightholder⁴³ who was, at the time the work was created, a national or domiciliary of an eligible country, and if published, was first published in an eligible country and not published in the United States during the 30-day period following publication in such eligible country;⁴⁴ and

(E) if the source country for the work is an eligible country solely by virtue of its adherence to the WIPO Performances and Phonograms Treaty, is a sound recording.⁴⁵

The discussion that follows addresses these requirements one by one,

and the parties after considering (1) the needs of international systems, (2) the relevant policies of the forum, (3) the relevant policies of other states and their relative interests in the issue, (4) protection of justified expectations, (5) basic policies underlying the particular field of law, (6) predictability of the result and (7) ease in determining and applying the law. See Restatement (Second) of Conflicts of Laws 2d, §§ 188(2), (6) (1971). Did Congress intend courts to apply a traditional *most significant relationship* analysis under sub-section (h)(8)(C)(ii) or did it wish to supplant those principles with a *most significant contacts* analysis (i.e., more similar to a test for personal jurisdiction)? Neither section 104A nor its legislative history sheds any light whatsoever on this question. See PATRY, COPYRIGHT AND THE GATT, *supra* note 26, at 42 (noting that the term "significant contacts" under sub-section (h)(8)(C) is undefined, but suggesting that the country where the author resides or where there has been a greater degree of exploitation of the work would be determinative).

43. "Rightholder" as used in section 104A is a term of art and refers solely to "the person (A) who, with respect to a sound recording, first fixes a sound recording with authorization, or (B) who has acquired rights from the person described in subparagraph (A) by means of any conveyance or by operation of law." See 17 U.S.C. § 104A(h)(7). This designation takes into account the fact that in many countries there is no "author" of "copyright" in a sound recording; outside the U.S., sound recordings are often protected under neighboring rights regimes rather than under copyright. See PATRY, COPYRIGHT AND THE GATT, *supra* note 26, at 37.

44. A work that is published in the United States within thirty days of first publication in a source country is considered simultaneously published in the United States and is ineligible for copyright restoration under section 104A. See 17 U.S.C. § 104A(h)(6)(D). The reasons for this are largely historical, having to do with the so-called "back door to Berne." Under the 1948 Brussels Text and 1971 Paris Text Berne Conventions, a second publication made within thirty days of the first was deemed to have occurred "simultaneously." See NIMMER ON COPYRIGHT, *supra* note 26, at § 17.04[D][2][b]. Thus, prior to the United States joining Berne, U.S. authors were able to obtain "back door" protection in all Berne member countries by "simultaneously" publishing in a Berne member country (such as the U.K. or Canada) when first publishing in the U.S. See *id.* Section 104A effectively adopts the Berne definition of "simultaneous" publication: if a work was "simultaneously" first published in the source country and the United States, it will not be deemed a "foreign work" eligible for restoration under section 104A. See *infra* note 106.

45. No discussion of section 104A(h)(6)(E) is required since it is self-explanatory. Cf. 17 U.S.C. § 104(d) ("[N]o works other than sound recordings shall be eligible for protection under this title solely by virtue of the adherence of the United States to the Geneva Phonogram Convention or the WIPO Performances and Phonograms Treaty.").

highlighting the key substantive issues raised under the statute and court decisions.

1. The first requirement: the work is original

“Originality” is a threshold requirement of a restored work.⁴⁶ This is hardly remarkable, because works lacking originality are not copyrightable under U.S. law.⁴⁷ To be “original,” a work need contain only some minimal level of expression independently contributed by the author.⁴⁸

No published section 104A decision has yet turned on whether or not a restored work possessed or lacked sufficient originality to be copyrightable.⁴⁹ Such cases are likely to arise, however. In addition, cases appear certain to arise in which it is alleged that particular works were not original to the author but were copied from pre-existing sources. Given that works potentially eligible for restoration oftentimes will have been created by foreign authors many years ago, it may be especially difficult for restored copyright owners to prove independent creation.⁵⁰

a. The role of registration in establishing originality

In the typical U.S. copyright action alleging infringements of U.S. works, the plaintiff must obtain a copyright registration as a prerequisite to conferring federal subject matter jurisdiction over the action.⁵¹ Registration within five years of first publication further entitles the registrant to a *prima facie* presumption of valid copyright and, hence, of originality.⁵²

46. See 17 U.S.C. § 104A(h)(6) (“The term ‘restored work’ means an *original work* . . .”) (emphasis added).

47. See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 351 (1991).

48. *Id.* at 345.

49. However, as discussed in Section II.A.5., *infra*, the originality requirement played a key role in the most complicated section 104A decision to-date, *Dam Things From Den. v. Russ Berrie & Co. (Dam Things II)*, 290 F.3d 548, 564 (3d Cir. 2002) (remanded for failure to determine whether works met requirements for “derivative works,” which “requires a determination as to originality”).

50. See NIMMER ON COPYRIGHT, *supra* note 26, at § 12.11 (“Given that United States copyrights subsist for nine decades or more, and given further that such questions as place of first publication or affixation of notice on early copies can affect the validity of the copyrights for all time, the burden of proof in copyright cases can, thus, often be dispositive.”).

51. 17 U.S.C. § 411(b) (“[N]o action for infringement of the copyright in any United States work shall be instituted until registration of the copyright claim has been made in accordance with this title.”).

52. 17 U.S.C. § 410(c) (“In any judicial proceedings the certificate of a registration made before or within five years after first publication of the work shall constitute *prima facie* evidence of the validity of the copyright and of the facts stated in the certificate. The evidentiary weight to be accorded the certificate of a registration made thereafter shall be within the discretion of the court.”). Courts have extended the presumption of valid copyright not only to originality but to copyrightability, chain of title and compliance with formalities of plaintiff’s registered work. See PAUL GOLDSTEIN, COPYRIGHTS § 14.3.1 (2d ed. 2000 & Supp. 2004) [hereinafter GOLDSTEIN, COPYRIGHTS]; NIMMER ON COPYRIGHT, *supra* note 26, at § 12.11[B]. The section 410(c) presumption is rebuttable, though, and merely orders the burdens of proof. See, e.g., *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 908 (2d Cir. 1980) (“[A] certificate of registration creates no irrebuttable presumption of copyright validity.”). See also H.R. Rep. No. 94-1476, at 157 (1976) (discussing 17 U.S.C. § 410) (“[A] rebuttable presumption of the validity of the copyright does not deprive the defendant in an infringement suit of any rights; it merely

Due to the Berne Convention Implementation Act (effective March 1, 1989), registration is not required to confer jurisdiction over infringement actions based upon Berne country works.⁵³ Because registration is not generally required in their source countries, owners of foreign Berne works are unlikely to have registered those works in the United States within five years of first U.S. publication. As a result, many copyright restoration plaintiffs will come to court unaided by the presumption of valid copyright normally provided by U.S. copyright registration.

In the absence of a registration certificate, should a U.S. court extend to the owner of a restored copyright a presumption of a valid copyright in that work? Unless there are particular reasons for doubting a plaintiff's claim to originality, courts should extend the presumption to foreign works without a U.S. registration. This is principally due to issues of fairness: it is generally easier for a defendant to prove a plaintiff copied from existing works than it is for a plaintiff to prove independent creation.⁵⁴

b. Further benefits of registering foreign works

Owners of foreign works should nevertheless always obtain U.S. copyright registrations and as soon as practicable.⁵⁵ This is especially true if registration may be obtained prior to a defendant's commencement of U.S. infringement, because doing so entitles a prevailing plaintiff to seek attorneys' fees and statutory

orders the burdens of proof. The plaintiff . . . [need not] prove all of the . . . facts that underlie the validity of the copyright unless the defendant, by effectively challenging them, shifts the burden of doing so to the plaintiff.”)

53. See 17 U.S.C. § 411(b) (requiring registration only for U.S. works). See also Berne Convention Implementation Act, Pub. L. No. 100-568, 102 Stat. 2853 (1988). However, one court's treatment of registration in a section 104A case has been somewhat confusing. *Dam Things From Den. v. Russ Berrie & Co.*, 173 F. Supp. 2d 277, 282 n.5 (S.D.N.J. 2001) (suggesting that registration is a prerequisite to bringing an infringement action on a restored work); *id.* at 287, n.14 (concluding summarily that plaintiff was entitled to a prima facie section 410(c) presumption, when registrations of restored works were plainly untimely, while finding defendant's certificates were entitled to same presumption of validity).

54. See GOLDSTEIN, COPYRIGHTS, *supra* note 52, at § 14.3.1 n.12 (arguing that because a defendant “is better placed to present proofs on ownership . . . in cases where the work in suit is not subject to the registration requirement because it is a Berne Convention work whose country of origin is not the United States . . . and no registration is introduced, the defendant should bear the burden of going forward, just as if the plaintiff had properly obtained a registration certificate”); see also NIMMER ON COPYRIGHT, *supra* note 26, at § 12.11[B][1] (“To require the plaintiff to prove his (or his predecessor author's) originality rather than requiring the defendant to prove lack of originality would, it is said, impose upon the plaintiff ‘an impossible burden’ in that he would be required to prove a negative (*i.e.*, that he did *not* copy from any other source).”).

55. For example, there may exist some question as to whether registration is required prior to institution of suit for foreign works from non-Berne countries. See Karp Report, *supra* note 26, at 201 (“Registration is not required as a condition for suit, by virtue of § 411(a), for a work whose source country is a member of Berne. It would be required for a restored work whose source country was not a Berne member—*i.e.*, a country eligible because of WTO membership or Presidential Proclamation.”). *But see* Bermudez and Co. v. Bermudez Int'l, 2000 U.S. Dist. LEXIS 12354, at *35 (S.D.N.Y. 2000) (“No proof of registration is required if the work for which plaintiff seeks protection has been authored in a foreign country covered by an applicable Convention,” and describing Berne as “one such convention.”).

damages.⁵⁶

U.S. registrations obtained at *any* time may provide significant benefits, however, as courts have the discretion to extend a presumption of validity even where the works were registered more than five years after first publication.⁵⁷ Only one court has thus far addressed the issue in the context of section 104A. In a case involving 1500 animated films dating back to 1936, that court concluded that it was “particularly appropriate” to presume the restored copyrights in those works valid despite untimely registration.⁵⁸

Additionally, because U.S. courts are not accustomed to plaintiffs proceeding with their lawsuits without having U.S. registrations of their works, the owner of a restored work places himself or herself on much more familiar procedural ground in a U.S. infringement action by conforming to U.S. practice and registering the allegedly-infringed works.

Finally, the legislative history surrounding Berne Convention implementation suggests, wrongly or rightly, that foreign authors must register in the United States to be entitled not only to seek attorneys’ fees and statutory damages but to obtain the presumption of valid copyright.⁵⁹ Thus, owners of restored copyrights should take advantage of U.S. registration and as early as possible.

56. 17 U.S.C. § 412. *See infra* Section II.D. (discussing reliance parties’ immunity from attorneys’ fees and statutory damages under section 104A(d)(4)). Courts are split over whether application for registration confers jurisdiction or whether only the issuance of a registration may do so. *See, e.g.,* Strategy Source, Inc. v. Lee, 233 F. Supp. 2d 1, 2-3 (D.D.C. 2002) (citing split in authority over whether registration is pre-requisite to initiating a copyright infringement action). A prudent plaintiff will apply for copyright registration in time to allow registration to issue prior to institution of suit. The U.S. Copyright Office currently advises applicants to expect a wait of four months or more.

57. *See supra* note 52. GOLDSTEIN, COPYRIGHTS, *supra* note 52, at § 14.3.1 (“[C]ourts should give less than prima facie effect only to those statements of fact in the certificate, such as statements of coauthorship, whose reliability is likely to have diminished with the passage of time.”).

58. *See* Films By Jove, Inc. v. Berov, 154 F. Supp. 2d 432, 479-80 (E.D.N.Y. 2001). The court reasoned that “the items in question are clearly copyrightable in that they are animated films” and that “defendants’ exact copies of said videos have already been submitted to the Court . . . and exhibit the originality of plaintiff’s works; and defendants . . . are not contesting the ability of someone to assert copyright ownership in said films because they are also seeking rights in the same films.” *Id.* at 479.

59. *See H. Joint Explanatory Statement on H.-S. Compromise Incorporated In S. Amendment to H.R. 4262*, 124 CONG. REC. H10097 (daily ed. Oct. 12, 1988). *See also* Parfums Givenchy, Inc. v. C&C Beauty Sales, Inc., 832 F. Supp. 1378, 1393 n.13 (C.D. Cal. 1993) (holding that section 412 is “applicable to works of foreign and domestic origin alike” (citing H.R. REP. NO. 1476, 94th Cong., 2d sess. 169 (1976), reprinted in 1976 U.S.C.C.A.N. 5669, 5774); 17 U.S.C. § 412 (attorney’s fees and statutory damages are not available unless the registration of a work occurs prior to the commencement of infringement by the defendant).

2. The second requirement: the work is not in the public domain in the source country through expiration of copyright

To be eligible for restoration under section 104A, a work must not be "in the public domain in its source country through expiration of term of protection."⁶⁰ That is, except where a work is no longer protected in its source country due to expired copyright, otherwise-qualifying foreign works are subject to automatic U.S. copyright protection on the "date of restoration" (which, for most restored copyrights, was January 1, 1996).⁶¹

Courts generally have had little difficulty applying this element of section 104A.⁶² The Fifth Circuit, however, recently misconstrued it. In *Alameda Films v. Authors Rights Restoration Corp., Inc.*,⁶³ the Fifth Circuit determined that a number of classic Mexican films had entered the public domain in Mexico for failure to register those works under the then-applicable 1928 Mexican Civil Code.⁶⁴ Misinterpreting section 104A as denying restoration to any works "in the public domain in the source country," the court (affirming the erroneous decision below) concluded that the films were ineligible for U.S. copyright restoration.⁶⁵ However, these films had not entered the public domain in Mexico due to *expiration of term of protection* but solely due to failure to comply with Mexican formalities.⁶⁶ As a result, the court denied U.S. copyright protection outright to works that might have been eligible for restoration under section 104A.

60. 17 U.S.C. § 104A(h)(6)(B). See Berne Convention, *supra* note 1, art. 18(1) (providing that the Convention "shall apply to all works which . . . have not yet fallen into the public domain in the country of origin through the expiry of the term of protection").

61. 17 U.S.C. § 104A(a); 17 U.S.C. § 104A(h)(2) ("[D]ate of restoration' of a restored copyright is (A) January 1, 1996, if the source country of the restored work is a nation adhering to the Berne Convention or a WTO member country on such date, or (B) the date of adherence or proclamation, in the case of any other source country of the restored work.").

62. See, e.g., *Capitol Records v. Naxos of Am.*, 372 F.3d 471, 479 (2d Cir. 2004) (finding that U.K. sound recordings were not entitled to restoration because their U.K. copyrights had expired, but certifying a question for New York Court of Appeals regarding whether such recordings might still be protected under New York common law).

63. 331 F.3d 473 (5th Cir. 2003).

64. *Id.* at 480-81.

65. *Id.* at 479-80.

66. Determining the duration of copyright protection in the source country can require several steps. The term of protection may depend on whether or not the work was created as a "work for hire" in a country where such a doctrine exists. For example, under Japanese law, copyright subsists for life of the author plus fifty years, but in the case of a work for hire subsists for fifty years after publication. See Japanese Copyright Act art. 53(1), in *COPYRIGHT LAW OF JAPAN 73* (Yukifusa Oyama et al. trans. 2005). Collaborative works such as motion pictures pose special considerations, especially in countries that do not subscribe to the "work for hire" doctrine. For example, under Section 65(2) of the German Copyright Act (implementing the E.C. Term Directive, effective July 1, 1995), copyright in a cinematographic work subsists for seventy years following the death of the last of the following to die: the screenwriter, the principle director, the author of the dialogue or the composer of music created specially for the work. See also *infra* note 125.

