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Springing Back to Life: The Supreme Court in *Golan v. Holder* Upholds Statute that Applies Copyright to Foreign Works Once in the Public Domain

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The U.S. Supreme Court has upheld in *Golan v. Holder* the constitutionality of a U.S. statute that "restored" U.S. copyright protection to millions of foreign-authored works that, for much of the twentieth century, had none at all. The Court found no constitutional bar to making foreign works that once were free of copyright protection now subject to the full regime of rights. The decision raises far-reaching implications for anyone who has copied, sold, or otherwise published foreign works of the 20th century that were assumed to be in the public domain, and raises anew the importance of considering the various layers of copyright protection that follow a single work.

BACKGROUND

In 1886, the Berne Convention for the Protection of Literary and Artistic Works (the "Convention") took effect. Under the Convention, member countries agreed to provide the same copyright protection for works created in other countries as they would provide for their own, unless the copyright term in either country had expired.

The United States was not a party to the Convention in 1886. For the century that followed, the only foreign works eligible for protection under the U.S. Copyright Act were those whose authors' countries granted reciprocal copyrights to American authors, and those whose works were printed in the United States. Everything else could be copied, incorporated into other works, or displayed, for example. When the United States finally did join the Convention in 1989, it did not provide foreign works the protections to which they were entitled under many of the treaty's articles, effectively maintaining the United States' self-granted exemption from international copyright cooperation.

That changed in 1994. Trade negotiations in Uruguay resulted in the creation of the World Trade Organization ("WTO") and the Agreement on Trade-Related Aspects of Intellectual Property Rights ("TRIPS"), both of which the United States joined. TRIPS required the United States to implement the Convention's first twenty-one

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articles—which the United States had to that point left unenforced—while the WTO threatened tariffs or cross-sector retaliation against any non-complying country. Congress passed the Uruguay Round Agreements Act, whose § 514 ("§ 514") is at the heart of the Supreme Court's decision in *Golan v. Holder*.

Under § 514, preexisting works from the Convention's member countries acquired copyright protection in the United States where they had lacked protection for at least one of three reasons: 1) the United States did not protect works from that country at the time of the work's first publication; 2) the United States did not protect sound recordings before 1972; or 3) the work's author had failed to comply with the United States' then-applicable statutory copyright formalities. As a result, countless works were restored from the public domain—the legal realm from which unprotected works can be taken and used for free—and given copyright protection under U.S. law.

In 2001, a group of orchestra conductors, musicians, publishers, and other users of works from the public domain sued, claiming that by plucking from the public domain countless free works, § 514 violated the Copyright and Patent Clause (the "Copyright Clause") of and the First Amendment to the United States Constitution. Removing works from the public domain, the plaintiffs insisted, violated the Copyright Clause's "limited times" restriction; essentially, they argued that § 514 impermissibly expanded the limitation on copyright terms. Section 514 also violated the First Amendment, they urged, because it deprived them of the "vested" rights they had in works that had existed in the public domain and which they had been using at little or no expense.

THE DECISION

Following a lengthy history of litigation in the lower courts, the Supreme Court upheld the constitutionality of § 514 against these challenges under both the Copyright Clause and the First Amendment. First addressing the Copyright Clause argument, the Court rejected any notion that the Copyright Clause's "limited times" language created a barrier around the public domain through which no free works could pass and become protected. The Court held that its decision in *Eldred v. Ashcroft* in 2003 upholding the Sonny Bono Copyright Term Extension Act of 1998's extension of copyright terms by twenty years settled the issue of whether the time prescription on copyright terms was somehow fixed or inalterable under the Copyright Clause. Contrasting their case to *Eldred*, the plaintiffs had argued that the "fixed" copyright term that foreign works had in the public domain before § 514 was "zero," and therefore distinct from works that had existent, running copyright terms, which the twenty-year extension prolonged. The Court's failure to recognize the distinction, the plaintiffs argued, would permit Congress to impose successive terms on copyrights, which would frustrate the limits of copyright protection contemplated in the Constitution.

Rejecting this argument, the Court invoked historical examples in which Congress had sought protection for works previously in the public domain. The Copyright Act of 1790, the Corson Act of 1849, the Helmuth Act of 1874, and the Jones Act of 1898 all restored, in one fashion or another, the copyrights of works that, before these laws' introduction, had been in the public domain. Patent statutes and related cases have provided similar restorative protections for inventions.

The Court also rejected what it called the plaintiffs' "ultimate" Copyright Clause argument. The plaintiffs contended that the Copyright Clause promotes the "Progress of Science and useful Arts" through its incentive of protections with definitive limits, and that restoring or creating copyrights on existing works inhibits that progress by discouraging future innovation and creativity. That promotion, the Court explained, need not be limited to inducing the creation of works. Rather, promoting the dissemination of works, which Congress could rationally have done through § 514, also satisfies the call of the Copyright Clause.

Turning to the First Amendment issue, the Court again invoked its decision in *Eldred v. Ashcroft*. The plaintiffs in that case argued that extending copyright terms violated the First Amendment's freedom of expression guarantee. Addressing the so-called "traditional contours" of copyright protection—the idea/expression dichotomy and the "fair use" defense—the Court in *Eldred* refused to conduct a heightened review. It did the same in *Golan*, determining that § 514 does not offend either contour of copyright law.

Further, the Court was again unpersuaded by the plaintiffs' idea that § 514 violates users' "vested rights" in works in the public domain. Notably, the Court saw no reason to sanctify the public domain itself, nor any historical legal basis for an inviolable public domain. The Court expressly rejected the notion that users of material somehow acquire or own public domain works through their use of them. It went on to highlight the key trade-off § 514 imposes: while some once-free works have suddenly become costly or otherwise difficult to use in full compliance with the law, the statute also ensures that many foreign national authors, long deprived of the Convention's egalitarian protections, obtain some measure of intellectual property rights under U.S. law.

LOOKING AHEAD

Although the implications are not new (given the age of § 514), they are, in the finality of *Golan*, far-reaching for anyone who operated—correctly, at the time—under the belief that an entire category of works could be used or copied without implicating the Copyright Act. Section 514 applies primarily to works first published abroad between 1923 and 1989, though works from periods before or, particularly, since that period may also receive its application. That large body of works may include as well foreign ones whose authors failed to meet U.S. statutory requirements in seeking copyright protection, works published in China, Russia, and other countries, and all sound recordings published after February 15, 1972. In 1996, the Register of Copyrights estimated the total number of works that § 514 affects to be in the "millions." Of particular administrative difficulty are so-called "orphaned works": lesser-known works whose age and obscurity render their authors difficult to find and engage for licensing purposes.

The confirmation of § 514 also shakes a principle on which many people rely, namely, that entrance into the public domain is forever a release from the need to navigate the protective scheme of the Copyright Act. Consider, for example, this scenario: an American sees in a European magazine or on display in the United States a painting or sculpture whose author did not observe U.S. copyright formalities. She takes her own photographs or makes her own painting incorporating the image, and sells her own (copyrighted) work or reproductions of it. Before § 514, she had not infringed. After § 514 and *Golan*, she could have—and never have realized it. Likewise, an author who draws on a text or a composer who quotes a melody could also be liable for infringement.

Short of employing a fair use defense (itself the subject of much recent attention), a wide array of creative artists and businesses may be affected by this ruling. Considering their possible exposure is an important first step.

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