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INTELLECTUAL PROPERTY
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Copy That — Or Not

Congress can restore copyrights to public domain works

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You might think that once a copyrighted work enters the public domain, you're free to use it unconditionally from there on out. But you would be wrong. In one of the most eagerly anticipated intellectual property cases of 2012 — *Golan v. Holder* — the U.S. Supreme Court held that Congress can restore copyright protection to works that had been in the public domain.

In 1994, Congress passed the Uruguay Round Agreements Act (URAA) to bring the United States into full compliance with the Berne Convention, the principal agreement governing international copyright relations. The convention requires member countries to protect the works of other member states unless the works' copyright term has expired in either the country where the protection is claimed or in the country of origin.

When the United States entered the Berne Convention, it didn't protect any foreign works in the U.S. public domain — including many works that were never protected here in the first place. With URAA, Congress began granting

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foreign authors copyright protection to works that were protected in their country of origin but formerly lacked U.S. protection because:

- The United States didn't protect works from the country of origin at the time of publication.
- The United States didn't protect sound recordings fixed before 1972.
- The author hadn't complied with certain U.S. statutory formalities.

URAA was challenged by orchestra conductors, musicians, publishers and others who had previously enjoyed free access to works considered to be in the public domain but to which Congress had restored copyright protection. The challengers claimed that Congress' removal of works from the public domain exceeded its authority under the Copyright Clause of the Constitution.

They further argued that URAA violated the First Amendment rights of those who had used the works while they were freely available. The case eventually made its way to the Supreme Court.

Not First Time

The Supreme Court found that the Copyright Clause doesn't exclude the application of copyright protection to works in the public domain. It dismissed the plaintiffs' argument that the clause's restriction of a copyright's lifespan to a "limited time" prevents the removal of works from the public domain.

Specifically, the Court noted that the clause contains no "command that a time prescription, once set, becomes forever 'fixed' or 'inalterable.'" And the "limited time" for the works at issue hadn't already passed because a period of exclusivity must begin before it can end, and many of these works had formerly been denied U.S. copyright protection.

Further, passage of URAA wasn't the first time Congress had extended protection to previously unprotected works. Several private bills have restored the copyrights of works previously in the public domain. Congress has also passed generally applicable legislation granting copyrights to works that had lost protection. According to the Supreme Court, these actions confirm that Congress doesn't understand the Copyright Clause to preclude protection for existing works.

Progress Of Science

The plaintiffs also argued that URAA restoration failed to "promote the progress of science," as contemplated by the initial words of the Copyright Clause, because it affects only works already created.

But the Supreme Court said that the creation of new works isn't the only way Congress can promote "science," which it defined as knowledge and learning. Rather, historical evidence, congressional practice and previous Supreme Court decisions suggest that inducing dissemination of existing works is an appropriate means to promote science.

Considered against this backdrop, the court concluded that URAA fell comfortably within Congress' authority under the Copyright Clause. Congress rationally could have concluded that adherence to Berne promotes the diffusion of knowledge, and a well-functioning international copyright system would likely encourage the dissemination of existing and future works.

Full compliance with Berne, therefore, would expand the foreign markets available to U.S. authors. It would also invigorate protection against piracy of U.S. works abroad.

Speech Not Free

The Supreme Court also held that the First Amendment doesn't inhibit the restoration of copyright. It explained that the traditional contours of copyright protection (such as, "ideas aren't copyrightable, but expressions of ideas are") and the fair use defense serve as "built-in First Amendment accommodations." The Court found no reason to extend "exceptional First Amendment solicitude" to copyrighted works that once were in the public domain.

Moreover, URAA doesn't impose a blanket prohibition on public access. The plaintiffs can still use the works; they simply must limit themselves to fair use or pay for the right to use, just as they must pay to use works of foreign authors' U.S. contemporaries.

Well within the ken

For both users and protectors of copyrighted works, the Supreme Court's decision clarifies that the public domain isn't "inviolate." Legislation removing works from it is "well within the ken" of Congress.

'Orphan Works' Conundrum

Another key aspect of *Golan v. Holder* was the majority opinion's rejection of the dissent's concerns about "orphan works." These are older and more obscure works with minimal commercial value that have copyright owners who are difficult or impossible to track down.

According to the dissent, "Unusually high administrative costs threaten to limit severely the distribution and use of those works — works which, despite their characteristic lack of economic value, can prove culturally invaluable."

The majority countered that the problem isn't peculiar to works covered by the Uruguay Round Agreements Act, and that it was up to Congress to resolve. Indeed, it asserted, "unstinting adherence" to Berne might even add impetus to calls for the enactment of legislation addressing orphan works. ■