I. **OVERVIEW**

The United States Congress enacted a statute on December 8, 1994, that restored copyright protection in the United States to various foreign works, removing those works from the public domain.\(^1\) Congress restored protection to those works in section 514 of the Uruguay Round Agreements Act (URAA), granting copyright protection to foreign works protected in their home countries but not in the United States.\(^2\) To ensure that enacting section 514 would not violate the Takings Clause in the Fifth Amendment to the United States Constitution, Congress added protection for “reliance parties”: a user of a foreign work in the public domain in the United States before the enactment of the URAA may continue to use that work until the copyright holder files a notice with the United States Copyright Office within two years of restoration under the

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2. Id.
URAA or a notice of his or her intent to enforce the copyright directly to the user. After this initial step, the reliance party may continue his or her previous uses of the restored work for one year, and if the reliance party has created a derivative work from the restored work, then the reliance party may use the derivative work perpetually after paying “reasonable compensation” to the copyright holder. After Congress enacted section 514 of the URAA, some of the users of the restored works filed suit, claiming that it was unconstitutional.

In Golan v. Holder, the petitioners included musicians, publishers, and orchestra conductors who had previously used some of the works to which copyright protection was restored. The United States District Court for the District of Colorado ruled that the actions of Congress in removing works from the public domain were valid. The United States Court of Appeals for the Tenth Circuit agreed that Congress had the power to remove works from the public domain. On March 7, 2011, the Supreme Court granted the petitioner’s writ of certiorari. The Supreme Court held that removing works from the public domain does not violate the Copyright Clause of the United States Constitution. Golan v. Holder, 132 S. Ct. 873, 878 (2012).

II. BACKGROUND

Prior to the Court’s decision in Holder, the prevailing sentiment was that works in the public domain could be used without fear of liability. This notion included the belief that once in the public domain, the works could not be removed. This idea is implicit in the Copyright Clause of the Constitution: “To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” Most recently, however, the extent of Congress’s power relating to the

4. Id.
8. Gonzales, 501 F.3d at 1197.
11. U.S. Const. art. I, § 8, cl. 8 (emphasis added). The word “limited” suggests that works cannot be under copyright protection indefinitely.
Copyright Clause was tested in Eldred v. Ashcroft. Although Eldred did not pertain to works taken from the public domain, the Court’s decision may lead people to question whether Congress’s power to extend copyright protection is limited at all.

In Eldred, the Supreme Court held that it is constitutional for Congress to extend the term of copyright protection. In the 1998 Copyright Term Extension Act, Congress extended the term of protection by twenty years. This extension was applied to both existing and future copyrights and was challenged on the basis that it was at odds with the “limited Times” prescription in the Copyright Clause of the Constitution. The Court ruled that the petitioners misconstrued the term “limited” to mean “forever ‘fixed’ or ‘inalterable.’” The Court instead found that the term “limited” meant “‘confine[d] within certain bounds,’ ‘restrain[ed],’ or ‘circumscribe[d].’” The Court also discussed the history of copyright term extension starting with Congress’s first extension of the term in the 1790 Copyright Act from fourteen years to forty-two years in 1831. After Eldred, the Court considered Congress’s power to extend the term of copyright again in Holder with respect to public domain works.

The discussion of foreign works in the public domain begins with the Berne Convention for the Protection of Literary and Artistic Works (Berne Convention), which was originally signed in 1886 as an international agreement setting forth minimum standards for national copyright laws. The United States was a latecomer to the Berne Convention, initially refusing to sign the international agreement because it required, inter alia, recognition of moral rights. Unlike most countries, which “consider copyright to be a natural right of the author,” the United States

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13. See id. at 192-93.
14. Id. at 194.
17. Eldred, 537 U.S. at 199.
19. Eldred, 537 U.S. at 194-95.
considers copyright to be “an incentive for the creation and distribution of new works of authorship.” 22 However, the United States decided to join the Berne Convention in 1989 in order to inspire other countries to give copyright protection to U.S. works. 23

Article 18 of the Berne Convention requires all new member countries to protect the works of other member countries retroactively. 24 However, by December 8, 1994, the United States had not yet complied with article 18. 25 In order to bring the United States into compliance, Congress enacted section 514 of the URAA, which restored copyright protection to foreign works that were already in the public domain in the United States but were protected under copyright in their home countries. 26 The decision by Congress to remove works from the public domain disturbed the long-held belief that once a work entered the public domain, it could never leave. 27

III. THE COURT’S DECISION

In the instant case, the Supreme Court relied heavily on its decision in Eldred in holding that Congress could take works out of the public domain in compliance with article 18 of the Berne Convention. 28 Under the Eldred definition of “limited”—“restrain[ed]” rather than “fixed” or “inalterable” 29—Congress’s restoration of public domain works amounted to a limited extension of the copyright term. The Court also rejected the petitioners’ argument that allowing Congress to extend the copyright term could result in perpetual copyrights, stating that Congress intended to comply with the Berne Convention and had not abused its constitutional power. 30

22. Id. at 126.
24. Berne Convention, supra note 20, art. 18.
25. Ochoa, supra note 10, at 128.
29. Id. (quoting Eldred, 537 U.S. at 199).
30. Id. at 885.
Citing several prior Acts, the Court explained that this was not the first time that Congress had taken works out of the public domain.\textsuperscript{31} These Acts show that Congress considers the Copyright Clause not to preclude protection of existing works whose term of copyright protection has lapsed.\textsuperscript{32} Without second-guessing Congress in its political decision-making authority, the Court decided to give deference to Congress’s explicit and reasonably implied interpretations of its authority under the Copyright Clause.\textsuperscript{33}

The Court explained that Congress’s decision to comply fully with the Berne Convention should not be questioned.\textsuperscript{34} Congress could likely have had good reason for deciding to comply with the Berne Convention in lieu of keeping works in the public domain.\textsuperscript{35} For instance, Congress could have found that complying with the Berne Convention would allow more access to the foreign market and prevent piracy of U.S. works in other countries.\textsuperscript{36}

Alternatively, Congress could have reasoned that compliance with the Berne Convention is just as legitimate a means of promoting “the Progress of Science” as providing incentives under the Copyright Act to create new works.\textsuperscript{37} An analysis of the Copyright Clause itself reveals that “[i]t does not demand that each copyright provision, examined discretely, operate to induce new works,” and “[n]othing in [it] confines the ‘Progress of Science’ exclusively to ‘incentives for creation.’”\textsuperscript{38}

IV. ANALYSIS

The Supreme Court’s decision in the noted case has inspired fear that Congress could transgress a long-held boundary and remove all works from the public domain.\textsuperscript{39} If Congress were allowed to remove any and all works from the public domain, this would discourage the

\begin{itemize}
\item \textsuperscript{32} Id. at 886.
\item \textsuperscript{33} Id. at 887.
\item \textsuperscript{34} Id.
\item \textsuperscript{35} Id. at 889.
\item \textsuperscript{36} Id.
\item \textsuperscript{37} Id.
\item \textsuperscript{38} Id. (quoting Shira Perlmutter, Participation in the International Copyright System as a Means To Promote the Progress of Science and Useful Arts, 36 L.O.Y. L.A. L. REV. 323, 324 n.5 (2002)).
\item \textsuperscript{39} See Ochoa, supra note 10, at 144-45; see also Elizabeth Townsend Gard, In the Trenches with §104A: An Evaluation of the Parties’ Arguments in Golan v. Holder as It Heads to the Supreme Court, 64 VAND. L. REV. EN BANC 199, 220 (2011).
\end{itemize}
Although the Court demands we trust the political decisions of Congress,41 these concerns have merit. The public domain was once a safe haven from which creators and inventors could draw inspiration for new works and build upon old works in their pursuit of cultural progress. As the Court noted in Eldred, “‘[L]imited Times’ serves the ultimate purpose of promoting the ‘Progress of Science and useful Arts’ by guaranteeing that those innovations will enter the public domain as soon as the period of exclusivity expires.”42 In light of its decision in Holder, the Supreme Court appears to have changed its tune, ultimately rejecting the Tenth Circuit’s previous contention that “the ‘bedrock principle’ of copyright protection ‘[is] that once works enter the public domain, they do not leave.’”43

Although the fears expressed are well-grounded, perhaps it is unlikely that Congress will elect to remove all works from the public domain; the Supreme Court made it clear that Congress removed foreign works from the public domain only to comply with the Berne Convention. Still, the Court did not expressly declare that Congress is not allowed to remove all works from the public domain. In fact, the Court seemed to leave that very possibility open: Congress has the authority to remove works from the public domain in the interest of promoting cultural progress even if it would not provide incentives for new works.44

This decision will give people pause when deciding whether to use works in the public domain, and despite the Court’s somewhat weak assurances that Congress’s enactment of the URAA was meant only to satisfy its international obligations under the Berne Convention, the Court failed to set a limit on Congress’s ability to remove works from the public domain. Had the Court clearly stated that Congress’s only permissible justification for removing works from the public domain under § 104A was to comply with the Berne Convention, then its decision in Holder would be less concerning, but the Court set no such limit. This uncertainty will discourage people from using public domain

41. Holder, 132 S. Ct. at 887 (“Given the authority we hold Congress has, we will not second-guess the political choice Congress made between leaving the public domain untouched and embracing Berne unstintingly.”).
43. Holder, 132 S. Ct. at 883.
44. Id. at 888-89.
works for fear that the copyright protection of such works could be restored at any time. Thus, fewer works from the public domain will be used and fewer new derivative works will be created from them.

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