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J.D. Salinger and Copyright's Rule of the Shorter Term

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ABSTRACT

Recently, the small publishing house Devault-Graves took on the Salinger Estate in an, almost, epic battle to determine whether the copyright term had ended on three of Salinger's early short stories in each country around the world. Devault-Graves wanted a declaratory judgment stating that if the copyright term had expired in the United States, it would have expired in all other countries with a "rule of the shorter term" (RST). But copyright is never that simple, as Devault-Graves soon found out. This short-lived case provides a useful lens through which to view the property rights as defined by the "limited" term in copyright and the pesky concept of RST embodied in the Berne Convention. RST posits that the copyright term for a work in a given country is limited to the amount of protection that its home country gives that same work; if a work is first published in Country A, and Country A provides ten years of protection, while Country B provides one hundred years, Country B need only provide ten years of protection to that work from Country A. RST becomes a key property boundary for foreign works, marking the moment between copyright and the public domain. And yet, whether RST is applied to foreign works in a given country is often unclear, or defining RST itself becomes very complicated. In the end, RST was not a friend to Devault-Graves. The Salinger short stories (in the US public domain) turned out to have copyright terms that were much more difficult to assess worldwide and, in many cases, were still protected by copyright in many countries around the world. This Article provides an in-depth discussion of RST and how it plays out on an historical as well as a practical level. This

* Associate Professor of Law and Jill H. and Avram A. Glazer Professor of Social Entrepreneurship, Tulane University. Thanks to Robert Spoo, for encouraging the topic for his "How Long?" conference at the University of Tulsa (2016), and to Peter Jaszi, Dale Nelson, David Olson, Dan Collier, Betsy Rosenblatt, Helen Buckley, and everyone who participated and helped to make the discussion of RST that much deeper. Thanks especially to Helen Buckley at TLS, and the members of the VANDERBILT JOURNAL OF ENTERTAINMENT & TECHNOLOGY LAW for all of their hard work in making this article beautiful, and to SKG and WRG, as always.

Article ends by suggesting a three-part test to determine whether RST applies in a particular country for a particular foreign work.

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I. SALINGER IN THE COURTS

J.D. Salinger and his estate are no strangers to copyright litigation. In the mid-1980s, a biographer's failed attempt to publish Salinger's letters added to the debate over the applicability and extent of fair use.[1] Two decades later, the Second Circuit ruled again in favor

1. Salinger v. Random House, Inc., 811 F.2d 90 (2d Cir. 1987). The accused biographer wrote a book about his experience. The Second Circuit found that Salinger had the right to control how even excerpts were used and therefore found no fair use. *Id.* In response, Congress

of Salinger in a case about an unauthorized derivative work—a sequel to *Catcher in the Rye* called *60 Years Later: Coming Through the Rye* by John David California.[2] Both court rulings had a long-term impact on copyright law. In the first case, after the court found that unpublished works were not covered by fair use, Congress amended the Copyright Act to include published and unpublished works under Section 107.[3] The second case confirmed standards of injunctions to copyright that had been developed in the patent arena.[4]

In 2015, the Salinger Estate again found itself in court, this time with a small publisher, Devault-Graves, who wanted the court to declare that three short stories in the public domain in the United States, were also in the public domain around the world, if a particular country applied "Rule of the Shorter Term" (RST).[5] If this case followed suit, this new litigation would have done for RST what the previous cases did for injunctions, fair use, and unpublished

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amended the 1976 Copyright Act in 1992 so that Section 107 included the following phrase: "The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors." 17 U.S.C. § 107 (2012). The biographer in the case, Ian Hamilton, wrote a book about the experience of using Salinger's letters and getting sued. IAN HAMILTON, IN SEARCH OF J.D. SALINGER (Random House 1988). Amazon describes it by stating: "This text is the story of that quest, a literary detective story which ends in court, with a bitter and protracted lawsuit in which Salinger sought to restrict the use Hamilton could make of his letters." *In Search of J.D. Salinger, A Biography*, AMAZON, https://www.amazon.com/Search-J-D-Salinger:Biography/dp/0394534689/ref=la_B000APLMJS_1_14?s=books&ie=UTF8&qid=1474044716&sr=1-14&refinements=p_82%3AB000APLMJS [https://perma.cc/NRJ5-PSY4] (last visited Apr. 4, 2017). Ian Hamilton was so affected by the suit, he went on to write *Keepers of the Flame: Literary Estates and the Rise of Biography*. When Ian Hamilton, poet and renowned biographer of several subjects, passed away, the headline was "Ian Hamilton, 63, Whose Salinger Book Caused a Stir, Dies." Douglas Martin, *Ian Hamilton, 63, Whose Salinger Book Caused a Stir, Dies*, N.Y. TIMES (Jan. 7, 2002), http://www.nytimes.com/2002/01/07/arts/ian-hamilton-63-whose-salinger-book-caused-a-stir-dies.html?_r=0 [perma.cc/6DME-Y6WH] (last visited Sept. 9, 2016).

2. Salinger v. Colting, 607 F.3d 68 (2d Cir. 2010). The Second Circuit held that *eBay*'s ruling applied not only to patents but to copyright as well, requiring a four-part analysis to obtain a preliminary injunction. *Id.* (referencing eBay, Inc. v. MereExchange, L.L.C., 547 U.S. 388 (2006)). The sequel was first published in the United Kingdom. It was later revealed that the publisher, Colting, was also the author. Dennis Johnson, *Fraud Behind Salinger Fraud Admits He's a Fraud*, MELVILLE HOUSE (June 12, 2009), http://www.mhpbooks.com/fraud-behind-salinger-fraud-admits-hes-a-fraud/ [https://perma.cc/FY69-T6GT].

3. "The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors." 17 U.S.C. § 107 (2012). This last sentence in Section 107 was added after *Salinger v. Random House*. *See supra* note 1 and accompanying text. It is important because it signals that fair use also applies to unpublished works, which is key for many scholars and individuals working with archival materials. *See* § 107.

4. *Colting*, 607 F.3d 68.

5. Amended Declaratory Action and Complaint for Damages ¶ 3, Devault-Graves Agency, LLC v. Colleen M. Salinger and Matthew R. Salinger as Trustees of J.D. Salinger Literary Trust, No. 2:15-cv-02178-STA-tmp, 2015 WL 6143513 (W.D. Tenn. Oct. 19, 2015) [hereinafter Devault-Graves Amended Complaint].

works: provided a concrete standard by which to measure, in this case, the duration of a work's copyright term around the world. This case, however, would be dropped before that could occur.

This Article takes up the topic: the relationship between the status of a public domain work in the United States and its status around the world in countries that apply RST. That simple request by the plaintiffs turns out actually to be an extraordinarily difficult and misguided quest. This Article determines that the Salinger Estate was right: making an accurate determination requires a country-by-country analysis, and just because a work is in the public domain in the United States, does not mean that is its status in any other country. The complicated process of determining the term of a US work abroad requires an understanding of US domestic law, laws of each foreign country, treaty analysis, and even interpretation from the World Intellectual Property Organization (WIPO). This is the story of why clear and succinct RST analysis remains elusive and this Article suggests ways to tame this unruly doctrine through a three-part process. Salinger's works, as in past Salinger litigation, turn out to be the perfect platform upon which to discuss duration calculations in both international and domestic contexts.

How long a copyright lasts is key in defining the property boundaries of a work. Many think copyright terms are straightforward measurements: life plus fifty years, or publication plus ninety-five years.[6] However, a number of mechanisms exist that make determining the copyright status of a work more complicated. One of those mechanisms is the "Rule of the Shorter Term," or "Comparison of Terms." RST is a mechanism found in copyright treaties that helps to negotiate the differing lengths of term between one or more countries.[7] The Berne Convention's Section 7(8) is the most famous version of it.[8]

RST states that a country is permitted to shorten the length of protection for foreign works if the work's country of origin has a shorter term than the country in question.[9] For example, if Country A provides one hundred years of protection, but Country B provides only ten years, Country A need only provide, under the RST, ten years of protection to a Country B work in Country A, not one hundred. Many countries have adopted RST as part of their domestic law, but many more countries remain silent as to whether they observe it. These

6. *See* 17 U.S.C. §§ 302–304 (2012).

7. Berne Convention for the Protection of Literary and Artistic Works, art. 7(8), July 24, 1971, (Paris Act) [hereinafter Berne Convention Paris Version].

8. *Id.*

9. *Id.*

latter countries are members of the Berne Convention, which established RST as the default, but left unclear whether RST applies directly through the treaty to domestic law or whether it must affirmatively be adopted *because* it is often not clear if the Berne Convention (or other treaties) are directly applicable. Other elements—bilateral treaties, for example, or Free Trade Agreements—further complicate the question as to whether RST applies. So, without clear answers, we are actually left wondering if the term for the hypothetical Country B work in Country A is ten years or one hundred. We are left with nothing more than a best guess that it is likely to apply.

Some may think RST is old fashioned, that the Salinger case is an anomaly, and that RST is passé. The Salinger case, and a brief mention in the now unsettled Trans-Pacific Partnership (TPP),[10] show that RST is relevant and debate about it continues. In order to establish a concrete applicability standard for RST, we must know *when* and *under what circumstances* RST applies. In an effort to clarify those issues, this Article proposes a three-part test to determine whether RST applies and under what circumstances.

Part II of this Article tells the Salinger story as an introduction to RST. Part III briefly discusses the difference between domestic and international copyright in general. Part IV explains RST in more detail, including its history, purpose, and application. Part V investigates the copyright term—what is the term in the country of origin, and is a foreign country's term longer or shorter? Part VI discusses RST in action: how it is applied in different countries and, specifically, the example of the complexity of applying RST in Germany. Part VII then turns to the possible limitations of RST, particularly in bilateral treaties and free trade agreements like the Trans-Pacific Partnership. Part VIII suggests a RST rule of thumb, charting forty-three countries' stances on RST as compared to that of the United States. Part IX offers a solution to the RST problem: a three-part analysis, applicable to any case, to determine whether RST applies. Part X concludes with how the Salinger case turns out and a suggestion on next steps in clarifying RST for the world.

No one has written a comprehensive analysis on the history, state, and implications of RST. Most treatises and articles explain what it is and little else. This Article seeks to begin to fill that void, provide context, and begin to apply the complexities of RST. But is

10. Trans-Pacific Partnership Agreement, art. 18.63(b)(i), 18-35 n.77, Oct. 5, 2015, 129 Stat. 319, http://dfat.gov.au/trade/agreements/tpp/official-documents/Documents/18-intellectual-property.pdf [https://perma.cc/8WLY-24YE]. Included in the TPP as a small footnote in the Copyright section of Chapter 18. *Id.*

only the first step in an area that needs more research. The hope of this Article is to start a dialogue about how to make RST more transparent for everyone—the estates of the world, the publishers, and others out to capture and capitalize on public domain works.[11]

II. SALINGER AND RST

The latest Salinger case began after members of publisher Devault-Graves saw a documentary on writer J.D. Salinger (1919–2010), an American author most famously known for the iconic classic 1951 novel *Catcher in the Rye*.[12] The Devault-Graves Agency specializes in republishing public domain works: "No good book deserves to fall into obscurity. We search for titles that deserve a presence in the digital age, and we bring them back to life for the enjoyments of today's readers."[13] The owners of the publishing company, after seeing the documentary, began to wonder if they could find J.D. Salinger works that had come into the public domain. Finding such gems is the goal of re-publishers.[14] It is how copyright law is supposed to work; once a work is in the public domain, anyone else is free to republish it. The question was whether Devault-Graves could find public domain writings by Salinger—one of the most controlling writers known, who had successfully sued copyright infringers at least twice before.[15] The publishers found three short stories.[16]

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11. The Copyright Research Lab at Tulane Law School has created a software tool, the Durationator®, which actually determines not only the status of works anywhere in the world, but also includes RST analysis and information. *See* DURATIONATOR, www.durationator.com [https://perma.cc/A3X3-XS98] (last visited Mar. 25, 2017). This Article is the substance of our research that helped us create the RST portion of the tool.

12. "In 2013, after the release of Shane Salerno's documentary feature Salinger, the principals of Devault-Graves began researching whether any of J.D. Salinger's short stories had fallen into public domain." *See* Devault-Graves Amended Complaint, *supra* note note 5, ¶ 24.

13. DEVAULT-GRAVES AGENCY, http://devault-gravesagency.weebly.com/ [https://perma.cc/37W6-C9QA] (last visited Sept. 9, 2016).

14. *See, e.g.*, QUID PRO BOOKS, www.quidprobooks.com [https://perma.cc/HNU2-6ZGU] (last visited Mar. 25, 2017). This republication of public domain works by third parties is also what the *Eldred v. Ashcroft* case was about in part, as well as *Golan v. Holder*. *See* Golan v. Holder, 565 U.S. 302 (2012); Eldred v. Ashcroft, 537 U.S. 186 (2003).

15. *See* Salinger v. Colting, 607 F.3d 68 (2d Cir. 2010). This case led to Congress changing copyright law to include unpublished works under fair use. *See* 17 U.S.C. § 107 (2012); Salinger v. Random House, Inc., 811 F.2d 90 (2d Cir. 1987).

16. *Three Early Stories by J.D. Salinger*, DEVAULT-GRAVES AGENCY, http://devault-gravesagency.weebly.com/three-early-stories-by-jd-salinger.html [https://perma.cc/FZ43-5X5P] (last visited Mar. 25, 2017). Interestingly, there is a website that purports to have twenty-two public domain short stories by Salinger. Freddie Moore, *22 out-of-Print J.D. Salinger Stories You Can Still Read Online*, AIRSHIP, http://airshipdaily.com/blog/96201322-out-of-print-jd-salinger-stories-you-can-still-read-online [https://perma.cc/368H-GN88] (last visited Sept. 9, 2016).

How Devault-Graves found the stories remains unclear, but it found three Salinger works from the 1940s whose copyright terms were not renewed. For domestic works from this era to be protected, the works' copyrights needed to have been renewed at the US Copyright Office during their twenty-seventh year.[17] Since they were not renewed, Devault-Graves set about publishing the stories as a collection of works titled *Three Early Stories*.[18]

From Devault-Graves's Amended Complaint, it appears the Salinger Trust did not take kindly at first to the Devault-Graves re-publication. It eventually conceded that the three short stories were, indeed, in the public domain due to lack of proper renewal.[19] Devault-Graves, however, was looking beyond US re-publication. Since the stories were out of copyright in the United States, the publishers wanted to take advantage of the little-known component of copyright law, RST. They believed that if the work was out of copyright in the United States, that work would also be out of copyright in other countries, thanks to RST.[20]

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17. 17 U.S.C. § 304 (2012); *see also* 17 U.S.C. § 24 (repealed 1978).

> The copyright secured by this title shall endure for twenty-eight years from the date of first publication, whether the copyrighted work bears the author's true name or is published anonymously or under an assumed name: Provided, That in the case of any posthumous work or of any periodical, cyclopedic, or other composite work upon which the copyright was originally secured by the proprietor thereof, or of any work copyrighted by a corporate body (otherwise than as assignee or licensee of the individual author) or by an employer for whom such work is made for hire, the proprietor of such copyright shall be entitled to a renewal and extension of the copyright in such work for the further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright: And provided further, That in the case of any other copyrighted work, including a contribution by an individual author to a periodical or to a cyclopedic or other composite work, the author of such work, if still living, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower or children be not living, then the author's executors, or in the absence of a will, his next of kin shall be entitled to a renewal and extension of the copyright in such work for a further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright: And provided further, That in default of the registration of such application for renewal and extension, the copyright in any work shall determine at the expiration of twenty-eight years from first publication.

Id. (while repealed in 1978, it is still relevant for determining the copyright status of pre-1978 works).

18. J.D. SALINGER & MICHAEL COMPTON, THREE EARLY STORIES (Scholastic ed. 2015).

19. Devault-Graves Amended Complaint, *supra* note 5, ¶ 33.

20. Berne Convention Paris Version, *supra* note 7, art. 7(8).

Pursuing international publication, Devault-Graves contacted a German publisher, claiming the work was out of copyright due to RST—and the Salinger Estate fought back. It is not clear why Devault-Graves chose Germany to republish and sell the short stories. In fact, there could not have been a worse country to choose. A German court found that RST did not apply to these three short stories.[21] The same resulted when Devault-Graves sought to publish in Italy.[22] So far, the re-publisher's plan of globally exploiting the three stories had been foiled. Devault-Graves felt harassed and bullied by the Salinger Estate, so it filed suit in the Western District of Tennessee to obtain a declaratory judgment. In its complaint, Devault-Graves claimed that "[d]efendants [the Salinger Estate]—acting without any legal basis . . . have attempted to thwart Devault-Graves from exploiting [Devault-Graves's republication rights], including by tortiously interfering with Devault-Graves's contractual agreements with foreign publishers."[23] The publisher wanted the court to declare that, since the stories were in the public domain in the United States, the works were also in the public domain in any country where RST applied.

Why did Devault-Graves believe the stories were in the public domain outside the United States while a German court and the Salinger Estate believed otherwise? To understand the answer to that question, we must look more closely at domestic and foreign copyrights in an international context.

III. DOMESTIC VERSUS INTERNATIONAL COPYRIGHT

Copyright law protects works based on a number of factors: who created the work, where it was created, when it was created, how (and if) it was disseminated to the public, what type of work it is, and where the work is being used. Each factor may alter the term of copyright, and the factors required are sometimes different or slightly altered for each country in the world.

To illustrate the varying copyright protection terms, Margaret Mitchell's *Gone with the Wind* (1936), for instance, has a term of ninety-five years from first publication in the United States.[24] In Canada, the term for *Gone with the Wind* begins upon the death of the

21. Memorandum of Law in Support of Defendants' Motion to Dismiss, Devault-Graves Agency v. J.D. Salinger Literary Trust, No. 15 Civ. 2178 Sta-tmp at 5 (W.D. Tenn. May 22, 2015).

22. *Id.* at 12–13.

23. Devault-Graves Amended Complaint, *supra* note 5, ¶¶ 2–4.

24. 17 U.S.C. § 304 (2012). The term is ninety-five years from first publication, which is discussed in this section of the 1976 Copyright Act. *See id.*

author and extends fifty years thereafter. Since Mitchell passed away in 1949, the work came into the public domain in Canada in 1999.[25] The same work is protected in the United Kingdom for the lifespan of the author plus seventy years, or through 2019.[26] The Dominican Republic (DR) applies a term of the lifespan of the author plus fifty years, but also applies RST.[27] So in this case, if the US term of protection (its country of origin) were shorter than that of the DR, the US term would control protection in the DR. Because US protection will not expire until 2031 and the DR was set to expire in 1999, RST has no application here. *Gone with the Wind* is now in the public domain in the Dominican Republic. So, a work has many copyright terms: a term in its country of origin and a term in each country of the world in which protection is granted. This means one work could have up to 270 different copyright terms worldwide.[28]

Determining the term in a given country is sometimes straightforward, but in certain instances, calculating the term can be complicated. Factors affecting the status and term include the author's home country, bilateral treaties between country of use and country of origin, RST, and the quirkiness of the laws themselves, particularly whether a law is retroactive or has special terms for restoring works. All of these issues relate to the laws of

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25. "The term for which copyright shall subsist shall, except as otherwise expressly provided by this Act, be the life of the author, the remainder of the calendar year in which the author dies, and a period of fifty years following the end of that calendar year." Copyright Act, R.S.C. 1985, c C-42 § 6 (Can.). The term ends with the calendar year. However, "[n]ot long ago, copyright in Canada expired 50 years after the exact date of the author's death, and not at the end of the calendar year." *See* LESLEY ELLEN HARRIS, CANADIAN COPYRIGHT LAW 125 (4th ed.). The Trans-Pacific Partnership requires a minimum term of life of the author plus seventy years, Trans-Pacific Partnership Agreement, *supra* note 10, art. 18.63(a), but the United States is no longer part of the TPP as of January 23, 2017.

26. "Copyright expires at the end of the period of 70 years from the end of the calendar year in which the author dies, subject as follows." Copyright, Designs and Patents Act of 1988, c. 48, § 12(2) (Eng.), http://www.legislation.gov.uk/ukpga/1988/48/contents [https://perma.cc/2VPX-TMUT] (last amended 6 February 2017 and continuously as amended by the legislation indicated in the overleaf).

27. Copyright, art. 21, Law No. 65-00 (Dom. Rep. 2012).

> Copyright shall accrue to the author during his lifetime and to his spouse, heirs and successors in title for 50 years after his death. In the case of duly established joint authorship, the period of 50 years shall commence on the death of the last joint author. . . . In the case of non-resident foreign authors, the duration of copyright may not be greater than that recognized under the laws of the country of origin; however, where those laws afford greater protection than that granted by this Law, the provisions of this Law shall apply.

Id.

28. At Tulane Law School's Copyright Research Lab, we have been working for a decade to research and code every copyright law in the world, in order to determine the status of any given work in each country or territory. *See* DURATIONATOR, *supra* note 11.

the country, and the diplomatic relations between countries. The remaining sections of this Article attempt to understand these complications—particularly, how to determine the copyright status of a work outside of its home country. More specifically, this Article looks at how to determine the copyright status of US works abroad, in the context of the Berne Convention and RST, bilateral treaties, and free trade agreements.

IV. RST EXPLAINED: HISTORY, PURPOSE, AND APPLICATION

A. History of RST: The Berne Convention

1. RST and Treaties

RST has been part of copyright law from the beginning, or nearly so. Germany's 1870 copyright law included RST, for instance.[29] Germany had unified that year and with that came a copyright law applying to works in the North German Confederation:

> Those works by foreign authors which have been published in a place that is geographically situated within the boundaries of the former German Confederation, but not within those of the North German Confederation, shall enjoy the protection of this law, provided that the legislation of the state concerned gives works which come out in the North German Confederation the same level of protection as works by native authors; however, the term of protection *shall not exceed that which is valid in that state itself.* The same applies to unpublished works by authors who are not citizens of the North German Confederation, but who do come from the territory of the former German Confederation.[30]

It would be through treaties, though, that RST would make its mark—notably the Berne Convention, the dominant copyright treaty around the world. More research is necessary, however, to understand its early development. Like much about RST, there is not enough deep research to fully understand its origins.

RST found its beginning with the first version of the Berne Convention.[31] In fact, RST predates the requirement of minimum

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29. *Copyright Act for the German Empire (1870)*, PRIMARY SOURCES ON COPYRIGHT (1450-1900) (L. Bently & M. Kretschmer eds.), www.copyrighthistory.org [https://perma.cc/9VUL-K5EG] (last visited Apr. 17, 2017).

30. *Id.* This is not necessarily the origin point of RST. Everyone is still searching to understand its origins. *Id.* at § 8 (emphasis added).

31. This Section is based on the work by Ricketson and Ginsburg, SAM RICKETSON & JANE GINSBURG, INTERNATIONAL COPYRIGHT AND NEIGHBOURING RIGHTS: THE BERNE CONVENTION AND BEYOND (2d ed. 2006) (2 volumes), and the earlier version by Ricketson, SAM RICKETSON, THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS: 1886-1986 (1987). This Section is meant to give an overview of the Berne development of RST. They have written the definitive book on the Berne Convention, and because this is foundational, the choice was made to stick to well-known texts. This is not meant as a historical uncovering of

terms in the Berne Convention by sixty years.[32] During the first round of negotiations, and in the first version of the Berne Convention, no term of copyright was agreed upon, but RST was.[33]

Early in the debates surrounding the Berne Convention, the Germans supported the principle of *lex loci*, applying the law of the author's own country to determine the term of a work in a foreign country.[34] *Lex loci* allowed for a single term (that from the country of origin) applied throughout the Berne Member countries.[35] In contrast, national treatment, or *lex fori*, was also proposed. *Lex fori* allowed for a single term within a particular country to control both foreign and domestic works. According to Professor Sam Ricketson, the leading scholar on the Berne Convention, the delegates at the 1884 Conference preferred *lex fori*,[36] but they also wanted to make sure that only countries with comparatively long terms got the benefit. By a vote of six to three, RST was included: "[T]he advantages of national treatment were only to be reciprocally assured to authors belonging to a country of the Union 'during the existence of their rights in their country of origin.'"[37] Ricketson explains, "All it meant was that a work should not be protected for any longer than it was protected in its country of origin."[38] This limitation only applied to the duration of a copyright's term.[39]

Years later, the question of how a term should be measured was revisited at the Berlin Conference for revision of the Berne Convention. The Germans then suggested a *lex fori* approach, without regard to the term in the country of origin.[40] This was known as a principle of independence of protection.[41] But the Union countries

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RST, but a summary of the story that is told about RST. Note that some of the materials used in this section, from the earlier version of the book, were edited out of the newer version.

32. Twenty years later, with the 1908 revisions, uniformity was coming into play, with fifty *pma.* dominating nine of the fifteen countries that were part of the Union. A compromise included fifty *pma*, but included Rule of the Shorter Term. Ricketson and Ginbsurg explain, "This continuing reference to the *lex loci* origins was a significant exception to the principle of independence of protection . . . ." RICKETSON & GINSBURG, *supra* note 31, at 540.

33. *Id.* at 537.

34. RICKETSON, *supra* note 31, at 325.

35. Interestingly, we hear stories of people assuming the term of the work is whatever the term is in the country of origin. In many ways, *lex loci* would be very useful today, in our global world. But unfortunately, we are not living in a *lex loci* system. There is no, single, global copyright, and the country of origin copyright is only that: the term in the country of origin.

36. RICKETSON, *supra* note 31, at 326–27.

37. *Id.* at 326 (citing *Actes* 1884, 78).

38. *Id.*

39. *Id.*

40. *Id.* at 327.

41. *Id.*

favored a standard minimum term and did not like the idea of abandoning material reciprocity.[42] A compromise was reached, with RST once again playing a prominent role; a minimum term was encouraged as fifty years *post mortem auctoris (pma)*—after the author's death—but if countries would not adopt the minimum term, the protection "must not exceed the term fixed in the country of origin of work."[43] The 1908 Berlin version of the Berne Convention finally adopted a suggested term of protection of fifty *pma*, with RST in place to allow for maintaining shorter terms.[44]

In 1948, the Brussels version of the Berne Convention finally applied fifty *pma* as mandatory, but continued to include RST.[45] The 1967 Stockholm revision included the minimum term of fifty *pma* and RST.[46] The 1971 Paris version continued both, with no changes in the RST language from the 1971 version.[47] The 1979 version again held no changes.[48] This history of inclusion lends support to the idea of RST's continued relevance.

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42. *Id.* ("By 1908, 9 of the 15 of these [countries] had terms of 50 *pma* or more.").

43. *Id.* at 328 (citing *Actes* 1908, 243).

44. Revised Berne Convention for the Protection of Literary and Artistic Works, art. 7, Nov. 13, 1908 (Berlin Act).

> The term of protection granted by the present Convention shall include the life of the author and fifty years after his death. Nevertheless, in case such term of protection should not be uniformly adopted by all the countries of the Union, the term shall be regulated by the law of the country where protection is claimed, and must not exceed the term fixed in the country of origin of the work. Consequently, the contracting countries shall only be bound to apply the provisions of the preceding paragraph in so far as such provisions are consistent with their domestic laws. For photographic works and works produced by a process analogous to photography, for posthumous works, for anonymous or pseudonymous works, the term of protection shall be regulated by the law of the country where protection is claimed, provided that the said term shall not exceed the term fixed in the country of origin of the work.

Id.

45. "The term of protection granted by this Convention shall be life of the author and fifty years after his death." Berne Convention for the Protection of Literary and Artistic Works, art. 7(1), June 26, 1948 (Brussels Act). "However, where one or more countries of the Union grant a term of protection in excess of that provided by paragraph (1), the term shall be governed by the law of the country where protection is claimed but shall not exceed the term fixed in the country of origin of the work." *Id.*

46. RST reads: "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." Berne Convention Paris Version, *supra* note 7, art. 7(8).

47. No changes from the Stockholm Act. RST reads: "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." *Id.*

48. No changes from Stockholm or Paris Acts: "In any case, the term shall be governed by the legislation of the country where protection is claimed; however, unless the legislation of

The Berne Convention is not the only treaty to utilize RST. The Buenos Aires Copyright Convention of 1910, which required copyright protection to be obtained in the country of origin "in conformity with its laws,"[49] also applied RST.[50] The Inter-American Convention included a RST provision, as well.[51] This tells us that RST has long been believed to be a key element in regulating trade of copyrighted works.

2. RST Today

Outside of the Berne Convention, the most significant contemporary example of RST occurred in the European Union (EU). This is part of the reason, or so the story goes, that the United States had to extend the term of copyright from fifty to seventy years with the Copyright Term Extension Act.[52] In Europe, RST was included in the 1993 European Union Term Directive, as part of the attempt to harmonize terms across the EU:

> Whereas, for works whose country of origin within the meaning of the Berne Convention is a third country and whose author is not a Community national, *comparison of terms of protection should be applied*, provided that the term accorded in the Community does not exceed the term laid down in this Directive.[53]

Works from countries outside of the European Union receive a shorter term of protection within the EU.[54] However, there is a caveat: "[C]omparison of terms should not result in Member States being brought into conflict with their international obligations."[55] International obligations can include a number of elements. Given that certain treaties may override RST, bilateral treaties and free trade agreements must be reviewed to see if RST is compliant with their specific terms and that special arrangements have not been

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that country otherwise provides, the term shall not exceed the term fixed in the country of origin of the work." Berne Convention Paris Version, *supra* note 7, art. 7(8).

49. Copyright Convention Between the United States and Other American Republics, art. 6, August 11, 1910 (Buenos Aires).

50. *Id.* ("The authors or their assigns, citizens, or domiciled foreigners, shall enjoy in the signatory countries the rights that the respective laws accord, without those rights being allowed to exceed the term of protection granted in the country of origin.").

51. Inter-American Convention on the Rights of the Author in Literary, Scientific and Artistic Works, art. VIII, June 22, 1946 (Washington, D.C.).

52. This Article shows that this might not have been true because of a bilateral treaty with Germany. *See infra* Part VI.B.

53. Council Directive 93/98/EEC, art. 1(22), 1993. O.J. (L 290) (EU) (harmonizing the term of protection of copyright and certain related materials).

54. Directive 2006/16, of the European Parliament and of the Council of 12 December 2006 on the Term of Protection of Copyright and Certain Related Rights O.J. (L 372).

55. Council Directive 93/98/EEC, art. 1(22), 1993. O.J. (L 290) (EU).

made between countries. One further question is whether a bilateral treaty in place with, say, Germany, which does not follow RST, is sufficient to prohibit application of RST in all of the other countries in Europe, as well.

V. DETERMINING TERM IN THE COUNTRY OF ORIGIN FOR RST PURPOSES

Under RST, we look to the country of origin to determine the length of the original term. Devault-Graves assumed that the term for the three early Salinger works was twenty-eight years because the works were not renewed. It then likely compared the term to other current terms around the world, usually life of the author plus seventy years, and believed that the three stories were in the public domain. Simple math. But copyright is rarely that simple. Devault-Graves's mistake was believing that the actual term of the US domestic works was indeed proper means for the measuring term abroad for RST.[56]

A. The Term When the United States Is the Country of Origin

Under RST, we look to the country of origin to determine the length of the original term. Term in the country of origin is a particularly challenging determination when it comes to works from the United States and, in particular, pre-1978 works like the three Salinger short stories. Works published in or before 1978 had to satisfy a number of formalities in order to obtain an initial term of protection and more hurdles to renew protection for additional years.[57] Given the strict formality and renewal requirements applicable to pre-1978-published works, a question arises regarding how missteps in those processes affect measuring the original term for RST.

Under the 1909 Copyright Act, a work had to meet certain requirements in order to gain federal protection. First, works could have come into the public domain upon publication because they failed to meet the formality requirements under the 1909 Copyright Act.[58] Second, works that met the formality requirements under the 1909 Copyright Act and gained an initial twenty-eight years of protection but were not promptly renewed between the twenty-seventh and

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56. This is a common error. The website Public Domain Treasure Hunter has a long explanation of "RST." Unfortunately, the calculation is off because, as this Article will show, expiry, rather than actual terms, govern according to WIPO. Debra Conrad, *Republishing U.S. Public Domain Works in the U.K.*, PUB. DOMAIN TREASURE HUNTER, http://www.publicdomaintreasurehunter.com/2010/07/25/republishing-u-s-public-domain-works-in-the-u-k/ (last visited Mar. 27, 2017).

57. 17 U.S.C. § 24 (repealed 1978).

58. *See Id.* §§ 10, 22, 24 (repealed 1978).

twenty-eighth years of the initial term, or, in the case of works published between 1950 and 1964, within the twenty-eighth year of the initial term, would come into the public domain.[59] Third, works that were properly renewed, or met the formality requirements and published on or after January 1, 1964, and are therefore protected for ninety-five years from publication, receive federal protection.[60] So, any work could have had a term of zero years, twenty-eight years, or ninety-five years. This was the actual term of any one work, and it was dependent on a number of events occurring or not occurring.

All of the Salinger works were published in 1940, when renewal of the copyright term was required during the twenty-seventh year.[61] According to the complaint, no renewal record was found.[62] Therefore, the works should have come into the public domain twenty-eight years after their publication date.[63] However, if formalities were not followed, they would have entered the public domain upon publication. Whatever the circumstances were, the 1940 short stories appear to have been in the public domain as of the filing of the complaint.

B. Potential Versus Actual Term

Most would think that if a work entered the public domain, by not meeting either the formality or renewal requirements, the work's term abroad should be measured by its actual, original term in the United States. But nothing is ever easy with copyright terms. Instead, the international community developed the concept of "expiry of term" or what we will call *potential term*: the optimal term under a country of origin's laws, rather than the term the country of origin actually accorded to the work. Potential term fits with the philosophy of the Berne Convention, which does not allow formalities such as those used in the United States under the 1909 Copyright Act. It also does not require fact-based searches in formalities-based countries, making it easier to determine the term for countries other than the country of origin from that of the country of origin.

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59. *Id.* § 24 (repealed 1978); 17 U.S.C. § 304 (2012).

60. 17 U.S.C. § 304 (2012).

61. *See id.* § 24 (repealed 1978); *id.* § 304.

62. The renewal year for the 1940 short stories would have been 1967. There are no renewal records for J.D. Salinger before 1974. However, he did renew works that had appeared in the Colliers' and New Yorker. *See* David Applegate, Sixty Years Later: Holden Caulfield, Fair Use, and Prior Restraint Under the Copyright Act, INTELL. PROP. (Mar. 2010). Complaint ¶ 43, Salinger v. Doe, No. 09-cv-5095 (S.D.N.Y. June 1, 2009), http://online.wsj.com/public/resources/documents/salingersuit.pdf [https://perma.cc/WF9R-FNPE].

63. *See* 17 U.S.C. § 304.

Other treaties have addressed this question of the split term. The Inter-American Convention on the Rights of Authors in Literary, Scientific and Artistic Works evidences that the potential term, rather than the actual term, is the standard measurement.[64] Article VIII of the convention sets forth the application of RST: "The duration of the copyright protection shall be governed by the law of the Contracting State in which the protection was originally obtained, but it shall not exceed the duration fixed by the law of the Contracting State in which the protection is claimed."[65] This is another version of RST. The treaty also addresses the US split term problem: "In case the law of any Contracting State grants two successive periods of protection, the duration of the protection with respect to the State shall include, for purposes of the present Convention, the aggregate of both periods."[66] Here we have a treaty that directly addresses the US split term problem. Both periods of protection—the initial term as well as the renewal term—are to be counted for the purposes of determining the length of the term in a Member state.

The Universal Copyright Convention (UCC) also indicates a preference for the potential term over the actual term: "For the purposes of the application of the preceding provision, if the law of any Contracting State grants two or more successive terms of protection, the period of protection of that State shall be considered to be the aggregate of those terms."[67] This means that the full two terms would apply in determining RST in the United States. The following sentence reads: "However, if a specified work is not protected by such State during the second or any subsequent term for any reason, the other Contracting States shall not be obliged to protect it during the second or any subsequent term."[68] This lack of obligation suggests that a Contracting State is not required to apply a work's potential term. This is particularly interesting in light of the Berne Convention, which was to stand as distinct from the UCC.

The Berne Convention itself did not address the split term or expiry of term. But the United States, upon joining the Berne

64. *See generally* Inter-American Convention on the Rights of the Author in Literary, Scientific and Artistic Works, *supra* note 51 ("Members included Argentina, Bolivia, Brazil, Chile, Colombia, Costa Rica, Cuba, Dominican Republic, Ecuador, El Salvador, Guatemala, Haiti, Honduras, Mexico, Nicaragua, Panama, Paraguay, Peru, United States, Uruguay, and Venezuela. All were signatories, but El Salvador, Peru, the United States, Uruguay, and Venezuela did not ratify the treaty.").

65. *Id.*

66. *Id.* art. VIII.

67. Universal Copyright Convention, art. IV, Sept. 6, 1952, 25 U.S.T. 1341.

68. *Id.*

Convention, called on WIPO for clarification.[69] The letters between the United States Patent and Trademark Office (USPTO) and WIPO discussed "the correct interpretation of certain articles of the Berne Convention as they pertain to the protection of US works [that] are in the public domain in the United States because of a failure to satisfy certain formalities." [70]

The letter addressed to Dr. Kamil Idris, Director General of WIPO, was from Robert Stoll, former USPTO Commissioner for Patents,[71] who felt that the issue of expiry of term was a matter of "great importance to the United States."[72] The issue was framed in relationship to Article 18, rather than Article 7(8), of the Berne Convention. Mr. Stoll was expressing his concern that US works that have fallen into the public domain for noncompliance with formalities would be denied a full term of protection in Berne member countries.[73] He posited that such formalities as notice, original registration, and renewal should not hold a work back from foreign protection, despite lack of protection in the United States anymore.[74]

Here is the heart of the argument: the United States no longer penalizes foreign works in the United States for lack of formalities and, therefore, other Berne countries should not penalize US works for lacking formalities even if they have lost US protection. Stoll concludes, "We believe that under the cited articles, other Berne Union countries are obligated to extend a 'full term' of protection to such existing works, regardless of their public domain status in the United States."[75]

Shozo Uemura, Deputy Director General, responds: "The Convention obliges the countries party to the Convention to protect 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.'"[76]

For works that had no copyright protection because they did not meet formality requirements under the 1909 and 1976 Copyright Acts, and therefore fell into the public domain upon publication, Uemura concludes, "It is clear that they have not fallen into the public

69. *USPTO/WIPO Letters Part II*, 46 J. COPYRIGHT SOC'Y U.S.A. 87 (1998–1999).
70. *Id.* at 87.
71. *See generally id.* at 88.
72. *Id.*
73. *Id.*
74. *See id.*
75. *Id.* at 90.
76. *Id.* at 93.

domain . . . through the expiry of the term of protection."[77] Uemura believes that the potential term should apply regarding RST, given the consensus that the formalities should not have existed. He writes: "I believe that the answer to this question is obvious, namely that that term should be considered to be "the term fixed in the country of origin of the work" which would be applicable provided that the formalities would have been complied with (or put in another way, provided that the formalities would not have existed)."[78] He ends with a definitive statement: "[Where] a work has fallen into the public domain through the non-compliance with formalities, the 'term fixed in the country of origin of the work' should be considered that term which would be applicable provided that the formalities would have been fulfilled (or would not have existed) . . . ."[79] While an informal dialogue, this makes it clear that the potential term, or expiry of term, seems the norm regarding the Berne Convention, rather than the actual term.

Scholar Christine Angelopoulos confirmed the adoption of the WIPO position in France that the potential term ought to dictate RST.[80] In 2009, the French court *Cour de cassation* reviewed the copyright status of the American film *His Girl Friday*.[81] According to the case, like the Salinger short stories, the original work was published in 1940 and not renewed.[82] However, the court found that the prohibition of formalities under Article 5(2) of the Berne Convention meant that the requirements for declining protection in France did not apply.[83] Due to its rejection of formalities, this is the key case establishing the notion that a potential term, rather than an actual term, would be applied regarding RST.

One example of an exception to potential term application is Argentina, which does not require any kind of treaty relations in order to gain protection. However, Argentina requires that formalities in the country of origin be satisfied and that RST be applied.[84] One could

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77. *Id.*

78. *Id.* at 96.

79. *Id.*

80. Susanne Nikoltchev, *Forward* to Christina Angelopoulos, *The Lifespan for Copyright of Audiovisual Works*, IRIS *PLUS* 2012-2, 3 (2012), http://www.ivir.nl/publicaties/download/54 [https://perma.cc/JL58-Z2ZM].

81. Christina Angelopoulos, *The Lifespan for Copyright of Audiovisual Works*, IRIS *PLUS* 2012-2, 19 (2012), http://www.ivir.nl/publicaties/download/54 [https://perma.cc/MK5E-KFRG].

82. *Id.*

83. *Id.*

84. Law No. 11.723 of Sept. 28, 1933, on Legal Intellectual Property Regime, art. 15 (Copyright Law, as last amended by Law No. 26.570 of Nov. 25, 2009) (Arg.) ("The term of protection that Argentine law grants to foreign authors shall not exceed that granted by the laws of the country where the work was published. If such laws grant a longer term of protection, the term fixed by this Law shall apply.").

argue that renewal is a formality and, therefore, the actual term applies. But Argentina is a member of the Berne Convention, and this portion of the law—applying formalities as a condition for protection—may be seen as violating Berne. The law itself is clear, but it is unclear whether Berne overrides the law.

VI. RST IN ACTION

A. RST Applied

Some countries explicitly include RST in their copyright statutes. For example, Armenia[85] and Bosnia and Herzegovina[86] are among those with copyright provisions specifically instructing application of RST.

The United States is among those countries that does not apply RST, excluding its application in Section 104(c) of its copyright law.[87] While not explicitly addressing RST from Article 7(8), Section 104(c)

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85. Copyright Law and Related Rights, art. 72(3) (2006) (Arm.).

> The provisions of paragraph (1) and (2) of this Article shall apply to the subject matters of copyright and related rights, which have been created, prepared, made available to the public, performed, published or broadcasted outside the Republic of Armenia, provided that the *term of validity thereof has not expired according to the legislation of the country of origin,* (notwithstanding the former activities) and *that country is a party to any international treaty in the copyright and related rights field to which the Republic of Armenia is a party too, if similar protection is granted,* according to an international treaty or the legislation of that country, to the subject matters of copyright and related rights, which have been created, published, prepared, made available to the public, performed or broadcasted in the Republic of Armenia.

Id. (emphasis added).

86. Copyright Law, art. 180 (2010) (Bosn. & Herz.).

> (1) The terms of protection under this Law shall apply to foreign authors enjoying the protection under this Law, but they expire no later than the date of expiry of protection in the state whose nationals they are, and they may not be longer than the terms under this Law. (2) The terms of protection under this Law shall apply to foreign holders of related rights who enjoy protection under this Law, but *they expire no later than the date of expiry of protection in the state whose nationals they are or in which they have principal place of business, and they may not be longer than the terms under this Law.*

Id.

87. 17 U.S.C. § 104(c) (2012).

> 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.

Id.

states that no rights from the Berne Convention can be directly claimed in a US copyright suit.[88] We do see the United States use a modified version of RST in Section 104A, a restoration provision, in requiring a work still to be under copyright in its country of origin at a specified period, but then applying its own term, without regard to that of the country of origin.[89] But in a general sense, Article 7(8) of the Berne Convention has not be replicated in the 1976 Copyright Act, and Section 104(c) makes plain that Berne is not directly applied.

The above are examples of laws that clearly address the application of RST, but the laws of many other countries remain silent, creating uncertainty as to whether RST applies to their works. Consider the countries of South America. Only Argentina and Suriname include RST.[90] All of the other countries are silent as to whether RST applies: Brazil,[91] Bolivia,[92] Chile,[93] Colombia,[94] Ecuador,[95] Paraguay,[96] Peru,[97] Venezuela,[98] and Uruguay.[99] The question becomes whether RST applies even when it is not included in a statute. Does one assume RST applies? Does it matter whether it is a civil law country or a common law country? That is the common distinction of when treaties are directly applied, as discussed later. How do we interpret silence?

Article 7(8) of the Berne Convention is presumed to be the norm: "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

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88. *Id.*

89. 17 U.S.C. § 104A (2012).

90. Law on Copyright, art. 43 (1913) (Act of 22 Mar. 1913 laying down new rules of copyright (GB 1913 no. 15), as it stands after the amendments thereto at GB 1915 no. 78, GB 1946 no. 2, GB 1946 no. 77, GB 1959 no. 76, SB 1980 no. 116, SB 1981 no. 23) (Surin.). Note that Argentina has been previously mentioned.

91. Law No. 9.610, Fevereiro 19, 1998 (Law on Copyright and Neighboring Rights) (as amended through 2014) (Braz.).

92. Copyright Law No. 1322 of Apr. 13, 1992 (Bol.).

93. Law No. 17.336 on Intellectual Property, Agosto 28, 1970 (as amended up to Law No. 20. 435 of May 4, 2010) (Chile).

94. L. 23, Enero 28, 1982 on Copyright (as modified by 1403 Act of July 19, 2010) (Colom.).

95. Intellectual Property Law (Consolidation No. 2006-13) (amended 2006) (Ecuador).

96. Law No. 1328/98 on Copyright and Related Rights (Para.).

97. Copyright Law, Legislative Decree No. 822 (1996) (as amended 2002, 2003, 2005, 2008 and 2014) (Peru).

98. Law of Aug. 14, 1993 on Copyright (Venez.)

99. Law No. 9.739 of Dec. 17, 1937 on Copyright (as last amended by Law No. 18. 046 of Oct. 24, 2006) (Uru.).

fixed in the country of origin of the work."[100] Confirmed in 1967, RST applies unless a country proclaims otherwise.

The 1967 discussions in Stockholm on the revision of the Berne Convention included discussions regarding RST. Eighty years after those first discussions, Switzerland proposed a change because it believed RST "ran counter to the principle of assimilation."[101] Switzerland proposed

> transposing the order of application of the principle of "comparison of terms.' Under the Swiss proposal, the term of protection would be subjected to the general rule of Article 4(1), i.e., to the legislation of the country in which protection was claimed, but countries of the Union would be entitled to depart from the rule contained in the Convention and declare that the law of the country of origin was applicable.[102]

RST would not be presumed. Instead, it would be an option. The Delegation from Czechoslovakia argued in response, "[I]f this proposal [were] adopted, those *countries whose legislation contained no provision* concerning the term of protection granted to foreign works would be forced to change their national legislation."[103] Czechoslovakia obviously read the proposal as forcing RST onto silent countries in lieu of their enacting new legislation. Thus, silence would be interpreted as adopting RST. This is important. It is a first step in understanding silence in the laws and that indeed countries expected RST to be applied, even in absence of mention in the copyright statute itself. There was good news for Czechoslovakia, however: the Swiss proposal was rejected by twenty-one votes to eight, with six abstentions.[104] The text for RST was adopted unanimously and resides in the Berne Convention at Article 7(8).[105]

The Berne Convention is not directly applied in the United States. Countries that remain silent regarding RST are often silent on whether Berne is applied directly to their domestic laws, as well. How does one determine, in the face of silence, whether Berne is directly applicable to the domestic law of a particular country? Paul

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100. Berne Convention, art. 7(8), Sept. 9, 1886 (emphasis added).

101. WIPO, RECORDS OF THE INTELLECTUAL PROPERTY CONFERENCE OF STOCKHOLM, JUNE 11 TO JULY 14, 1967, Volume II, art. 1242.2 (Geneva 1967). Switzerland proposed the following at Switzerland Berne Convention Article 10(1) S/69 (doc. S/1): "In any case, the term shall be governed by the law of the country where protection is claimed; however, the legislation of that country may provide that the term of protection shall not exceed the term fixed in the country of origin of the work." WIPO, RECORDS OF THE INTELLECTUAL PROPERTY CONFERENCE OF STOCKHOLM, JUNE 11 TO JULY 14, 1967, Volume I, art. S/69 (Geneva 1971).

102. WIPO Volume II, *supra* note 101, art. 1242.2.

103. *Id.* art. 1243.

104. *Id.* art. 1244.

105. Berne Convention for the Protection of Literary and Artistic Works, art. 7(8), July 14, 1967, 828 (Stockholm Act).

Goldstein and Bernt Hugenholtz explain how to determine whether Berne is a self-executing treaty in a particular country in *International Copyright*:

> Most countries, including many that follow civil law tradition, will view treaties as self-executing, a directly applicable source of rights to private parties, at least so long as the treaty rules are capable of having normative effect without implementing legislation. But contrast, countries following the British and Scandinavian constitutional traditions hold that treaties are never self-executing, so that private actions must be founded on domestic legislation that implements the treaty.[106]

While a helpful starting point, this assertion leaves us wanting for a comprehensive list of countries that do or do not hold treaties to be self-executing. We are left to wonder, indeed speculate, what the term is for many works whose country of origin has a shorter term.

B. Potential Term in Action: The Cases of Germany

Silence in statutes and application of the potential term are only two problems. Determining when RST applies also involves delving into bilateral treaties, multilateral treaties, and multiple domestic laws. Germany is the poster child for complexities related to RST, particularly with regard to US works. As Goldstein and Hugenholtz explain, "[t]he relationship between multilateral and bilateral treaties is chronological as well as hierarchical."[107] It also concerns domestic law and sometimes retroactivity.

Germany and the United States have a number of treaties in place: (1) the 1892 US-German Bilateral Treaty, (2) the Universal Copyright Convention (UCC), and (3) the Berne Convention. The Bilateral Treaty allowed German works to obtain protection in the United States and vice versa. It applied to literature and art, including photographs. All sources agree that the Treaty continued after World War I and World War II and is still valid today.[108] The

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106. PAUL GOLDSTEIN & P. BERNT HUGENHOLTZ, INTERNATIONAL COPYRIGHT: PRINCIPLES, LAW, AND PRACTICE 30 (3d ed. 2013).

107. *Id.* at 51.

108. "The Convention between Germany and the United States of America on the mutual protection of copyright of 15 January 1892 (RGBl S. 473), as the Court of Appeal rightly stated, remained untouched in its continued existence through the World Wars (German Law of May 18, 1922, Imperial Law Gazette II, p 129 and Proclamation by the US President on 25 May 1922 texts at Nordemann-Vinck-Hertin, International Copyright S. 466; Bappert-Wagner, International Copyright, S. 313, 314; further Exchange of notes of 6 February 1950 and 20 June 1950, both sides memoranda Text: GRUR 1950, 414)." Bundesgerichtshof [BGH] [Federal Court of Justice], Jan. 27, 1978, BUNDESGERICHTSHOF URTEIL "BUSTER-KEATON-FILME" 19, 1978 (Ger.).

bilateral language makes clear that the relationship was to be that of national treatment without restrictions, with protection granted "on the same basis on which such protection is granted to subjects of the Empire."[109] Under this treaty, US works in Germany were provided with the same term of protection as German works at the time, regardless of their terms in the United States, an obvious absence of RST.

However, Germany and the United States eventually joined the UCC, which applied RST. Then, Germany subsequently enacted a new copyright law in 1965, which partially incorporated the UCC. Later still, the United States joined Berne in 1988, further complicating matters. There is, however, German case law that helps us sort through the issues of whether RST applies and, more to the point, what the term of a US work would be in Germany.

The case *Atlas Films* concerned American films by Buster Keaton that had not been renewed in the United States and therefore came into the public domain twenty years after the dates of their first publications.[110] The plaintiff believed the films were still protected in Germany, even though their copyrights had expired in the United States. This belief was based upon reliance on the US-Germany Bilateral Treaty because the treaty did not contain any limits requiring the works still to be protected in their countries of origin; it merely provided for national treatment. Some of the films were first

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"Even though the United States, on 1 March 1989, acceded to the Berne Convention (in the Paris Act of 1972), the treaty with Germany of 1892 is still in force. Under Art. 20 of the Berne Convention, the precedence of bilateral agreements is provided 'in so far as such agreements grant to authors more extensive rights than those granted by the Convention.' Thus, in those cases the treaty of 1892 has priority over the Berne Convention and the TRIPS agreement of 1994, which refers to the respective provisions of the Berne Convention (Art. 9 to 21)." Friedemann Kawohl, *Commentary on: Bilateral Treaty Between the German Reich and the U.S.A. (1892)*, PRIMARY SOURCES ON COPYRIGHT (1450-1900) (L. Bently & M. Kretschmer eds.), www.copyrighthistory.org [https://perma.cc/9VUL-K5EG] (last visited Apr. 17, 2017).

109. Agreement Between the German Reich and the United States of America Concerning the Reciprocal Protection of Copyrights, U.S.-Ger., art. 1, Jan. 15, 1892. "Apart from the 1876 Industrial Designs Copyright Act for the German Empire (d_1876), which after multiple amendments is still in force, the Copyright Treaty of 1892 between the German Empire and the U.S.A. is the only piece of nineteenth-century legislation for the German-speaking lands that is still in force in its original form." *Id.*

110. Bundesgerichtshof [BGH] [Federal Court of Justice] Jan. 27, 1978, BUNDESGERICHTSHOF URTEIL "BUSTER-KEATON-FILME" 4–7, 1978 (Ger.). The films included *The General*, *College*, *Three Ages*, *Steamboat Bill Junior*, *One Week*, *Electric House*, *The Play House*, *The Boat*, *The Paleface*, *Cops*, *My Wife's Relations*, *The Frozen North*, *Day Dreams*, *The Blacksmith*, and *Balloonatic*. According to the decision, four of the films—*The General*, *College*, *Three Ages*, and *Steamboat Bill Junior*—were simultaneously in the United Kingdom, and *The General* was also in Japan, both Berne member states. *See id.* There were also 1950s versions edited by Buster Keaton that the applicant believed were also protected under German law.

published in the United States, but others were initially published in Great Britain or Japan.

The films were created between 1921 and 1928,[111] and the case sought to determine whether the Bilateral Treaty or the UCC governed protection. The court looked to Article XIX of the UCC: "[This] Convention shall not abrogate multilateral or bilateral conventions or arrangements between two or more Contracting States."[112] The third sentence of Article XIX states that if the copyrights were acquired before the enactment of the UCC, the older rights applied.[113] This meant that works created or published before the enactment of the UCC, September 16, 1955, would be governed by the Bilateral Treaty. Thus, US works published before this date are protected by the US-German Bilateral Treaty and treated in the same manner as a German national's publication, whereas those created or published afterward would be governed by the UCC. The court concluded that the Bilateral Treaty applied and that, therefore, RST would *not* apply in this situation because the treaty gave full national treatment to US works.[114] *Atlas Films* gives us the chronology and hierarchy of understanding the relationship between the Bilateral Treaty and the UCC.

But that was not the end of the inquiry on the Keaton films. To qualify under the 1965 Germany law, the foreign works had to have been protected in their country of origin as of January 1, 1966. These works were, in fact, protected as of January 1, 1966, both in Germany (under the concept of national treatment through the Bilateral Treaty) and in the United States using the potential term. The films, therefore, gained the additional twenty years of protection afforded by the new 1965 law. So, in addition to seeing the Bilateral Treaty trump the UCC, we see also that the 1965 law required looking to the country of origin to assess the copyright term.

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111. *Id.*

> The films have been in [their] original version in 1921 to 1928 in the United States by Buster Keaton, who had American citizenship created. They have been also published in these years there. An extension of the valid in the United States general copyright term of 28 years, beginning with the first publication of a work is not requested. Buster Keaton died on February 1, 1966.

Id. at 3; *see also* Universal Copyright Convention, as revised at Paris, July 24, 1971, art. XIX, 25 U.S.T. 1341, TIAS 7868, 943 U.N.T.S. 178.

112. Universal Copyright Convention, *supra* note 111, art. XIX.

113. GOLDSTEIN & HUGENHOLT, *supra* note 106, at 53. But, as Goldstein points out, the second sentence of Article XIX seems to indicate that if there were a difference between the UCC and an earlier treaty, the new UCC would apply, and thus RST *would* apply. *Id.*

114. Bundesgerichtshof [BGH] [Federal Court of Justice] Jan. 27, 1978, URTEIL DES BUNDESGERICHTSHOF IN ZIVILSACHEN, 1, 1978 (Ger.).

A case decided at the same time as *Atlas Films* involved Jack London's short story *White Fang*.[115] In that case, the story (and the novel version) was published in 1905, and Jack London died eleven years later. The issue was whether the work qualified for protection under the 1965 Copyright Act in Germany. The 1935 term was a bit complicated:

> Copyright protection ends fifty years after the death of the author but in any case it will not lapse until the expiration of ten years from the date of first publication of the work. If the work is not published after [fifty] years have passed since the death of the author, it is presumed that the possessor of the work is entitled to the copyright.[116]

In this case, Jack London died in 1916 and the work had been published within his lifetime. Therefore, the term under the previous law expired fifty years after his death, in 1966.

To qualify for the extension within the 1965 Copyright Act, the work had to possess two qualifications. First, it must have been under copyright as of January 1, 1966, in Germany, which *White Fang* satisfied. Second, the work had to have been protected in the country of origin as of January 1, 1966. In this case, the work had been published in 1905 and, as of 1966, the term of protection, even with renewal, had expired.[117] The term for a pre-1909 work was no longer than fifty-six years or, in this case, when the work came into the public domain on January 1, 1962. Therefore, the work did not qualify for an additional twenty years of protection when the new German law came into force in 1966.

Another German case concerned *The Big Book* from Alcoholics Anonymous.[118] *The Big Book* was registered with the US Copyright

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115. Article 29, Copyright Law for Literary and Musical Works, June 19, 1901 (as amended 1910 and 1934) (Ger.).

116. Bundesgerichtshof [BGH] [Federal Court of Justice] Jan. 27, 1978, URTEIL DES BUNDESGERICHTSHOF IN ZIVILSACHEN, 16, 1978 (Ger.).

> However, this has the result that under the applicable domestic law for granting protection to due to the Universal Copyright Convention_respectively. Due to the bilateral agreement of 1892 in conjunction with Art. XIX WUA protected works only if and to the extent the term extension will benefit in so far as these works at the entry into force of the Copyright Law moreover, the term of protection in the country of origin was were still protected by domestic law on 1 January 1966, had not yet expired. However, since according to the findings of the court in the work "White Fang" by Jack L. was no longer protected in the United States as the country of origin on 1 January 1966 the work of the term extension comes not benefit under domestic law.

Id.

117. Oberlandesgerichte Frankfurt am Main [OLGZ] [Higher Regional Court] Oct. 7, 2003, URTEIL DER OBERLANDESGERICHTE FRANKFURT AM MAIN IN ZIVILSACHEN 45, 2013 (Ger.).

118. *Terms of Use*, ALCOHOLICS ANONYMOUS, http://www.aa.org/pages/en_US/terms-of-use [https://perma.cc/NB22-2YSR] (last visited Apr. 18, 2017).

Office on April 19, 1939.[119] However, the work had no proper copyright notice and was not renewed properly. The work was in the public domain upon first publication because formalities had not been met.[120] But what about its status in Germany?

Like previous cases, the German court began with the 1892 Bilateral Treaty, which it found continued to apply.[121] The UCC had been enacted as of September 16, 1955, but the 1892 treaty was found to control in light of conflicting terms and because the work had been published under the previous German copyright act, before the enactment of the UCC.[122] The court found that the work's German term applied, even though the work was in the public domain in the United States, and chose to apply the potential term, rather than the actual term.[123] If the work were still protected by German domestic law when the Copyright Act of 1965 became active, and the period of protection had not yet expired in the country of origin, the work would benefit from the additional twenty years of protection.[124] The court made it clear that it was reviewing the potential term: "Incidentally, it does not significantly depend on whether the concrete work in the United States was still protected by copyright. What matters is only whether the term of protection had not yet expired for works of the same description as in the United States."[125] So, even though the work was in the public domain in actuality in the United States, the court was looking to the expiry, or potential term. The court then applied the current term, seventy years after the author's death, to the 1965 Copyright Law.[126]

By the time of the next major case related to US works in Germany, the *Tarzan* case, the United States had joined the Berne Convention. The novel *Tarzan of the Apes* was first published in the United States on September 10, 1912, and was registered and renewed with the US Copyright Office. The copyright expired in the United States seventy-five years after the original publication, at the

119. *Id.*

120. *Id.*

121. *Id.* at 47–48.

122. See GOLDSTEIN & HUGENHOLTZ, *supra* note 106, at 51–54.

123. Bundesgerichtshof [BGH] [Federal Court of Justice] Jan. 27, 1978, URTEIL DES BUNDESGERICHTSHOF IN ZIVILSACHEN 55, 1978 (Ger.).

124. Oberlandesgerichte Frankfurt am Main [OLGZ] [Higher Regional Court] Oct. 7, 2003, URTEIL DER OBERLANDESGERICHTE FRANKFURT AM MAIN IN ZIVILSACHEN 55, 2003 (Ger.).

125. *Id.* ("Article IV, para 4 WUA (UCC) provides the shorter term not on the term of protection for the concrete work, but to those 'for works of this kind.'").

126. This is consistent with the *Atlas Films* and *White Fang* cases. What it leaves unresolved is how works created on or after September 16, 1955, would be treated in Germany. There has not yet been a case addressing this question.

end of 1987.[127] As in the previous cases of works before September 16, 1955, the inquiry followed the same steps to determine the applicability of the 1965 Copyright Act. However, the court also looked into whether the work was protected in the country of origin as of March 1, 1989, when the United States joined Berne. If so, *Tarzan* would gain the full term of protection under Germany's copyright law because Berne applies the US-Germany Bilateral Treaty as long as the work is still protected in the country of origin. The work, however, expired in the United States in 1987. The German court thus determined the copyright protection to be subject to RST in accordance with Section 121, paragraph 4, sentence 1 of the 1965 German Copyright Act.[128]

Additionally, the court found that "[a]fter the UCC (September 16, 1955), the work accrued only the term of protection to [fifty] years."[129] The court seemed to think that the enactment of the UCC stunted or froze the copyright term for works created before the UCC's enactment to the term in place at the time:

> The term of copyright protection has indeed [been] extended by the Copyright Act of 9 September 1965, [seventy] years after the author's death. However, this extension of the right enjoys no grandfathering under Art. XIX sentence 3 WUA because they took place only after the entry into force of the Universal Copyright Convention for Germany.[130]

The work, therefore, came into the public domain in Germany as of 2001, fifty years after the death of the author.

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127. 17 U.S.C. § 304 (2012) (the work expired before the extension to ninety-five years and therefore did not receive the additional term of protection in the United States).

128. Copyright Act of 9 September 1965 (Federal Law Gazette Part I, p. 1273), art. 121(4), as last amended by Article 8 of the Act of 1 October 2013 (Federal Law Gazette Part I, p. 3714). "For the rest, foreign nationals enjoy copyright protection on the content of Treaties. In the absence of international treaties, there is for such works copyright protection, as far as in the State of which the author belongs, according to an announcement by the Federal Minister of Justice in the Federal Law Gazette German nationals enjoy equivalent protection for their works."

129. Bundesgerichtshof [BGH] [Federal Court of Justice] Feb. 26, 2014, URTEIL DES BUNDESGERICHTSHOFES IN ZIVILSACHEN [BGHZ] 36, 2014 (Ger.).

130. SUSY FRANKEL & DANIEL J. GERVAIS, ADVANCED INTRODUCTION INTERNATIONAL INTELLECTUAL PROPERTY 52 (2016) (explaining that "[n]ational treatment simply means that WTO members must treat foreign intellectual property owners at least as well as they treat domestic intellectual property owners" and that you may treat the foreigner better).

VII. EXEMPTIONS FROM RST?

A. Bilateral Treaties, Free Trade Agreements, and the TPP

1. Bilateral Treaties

Both Germany and Italy believe their bilateral treaties afford complete national treatment without RST limitations. However, not all bilateral treaties embrace complete national treatment.[131] The bilateral treaty between Italy and Spain, for example, explicitly includes RST.[132] Germany and the United States agreed to national treatment without any discussion of RST.[133] However, other German

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131. *Id.* at 53 (The opposite of national treatment is material reciprocity—that is 'you only get what you give.'"). *See generally* Berne Convention Paris Version, *supra* note 7, art. 14.

132. Treaty Between Italy and Spain Concerning Literary, Scientific and Artistic Copyright, June 28, 1880, art. 1 ("Nevertheless, these rights shall not have duration in excess of that granted to national authors, publishers, translators, or successors in title, and shall not, in any case, exceed the duration granted by the laws for the country of origin.").

133. Agreement Between the Reich and the United States Concerning Reciprocal Protection of Copyrights, Ger.-U.S., 1892, art. 1.

> Citizens of the United States of America shall enjoy, in the German Empire, the protection of copyright as regards works of literature and art, as well as photographs, against illegal reproduction on the same basis on which such protection is granted to subjects of the Empire." Article 1, Agreement between the Reich and the United States concerning Reciprocal Protection of Copyrights, 1892. German courts have continually recognized that the 1892 bilateral treaty is still in force, and that no RST applies. The 1892 bilateral treaty provided for national treatment without restrictions. In 1955, Germany and the US joined the UCC. If a work is created before the UCC's enactment, September 16, 1955, then the work gets the term provided for before the enactment of the law. If the work is still protected by the *potential* term in the US, as of March 1, 1989, when the US joined Berne, and also still protected by the term before 1955, then the work gains protection of the 1965 Copyright Act.

Id.

The 1892 bilateral treaty was reconfirmed in 1922:

> In consideration of the national treatment granted to nationals of the German Reich in the United States of America, nationals of the United States of America shall enjoy in the German Reich, for their copyrights in works of literature, art, and photography, legal protection to the extent set forth in the Agreement of January 15, 1892. This shall apply especially to works created in the period between August 1, 1914 and July 2, 1921, Provided that any rights which may have been acquired by any person through the multiplication or distribution of such work before December 18, 1919, shall remain unaffected.

Law for the Protection of Copyright of Nationals of the United States of America, art. 1 (May 18, 1922) (Ger.). Note: the 1922 document also included the following:

> If the protection of German copyrights in the United States of America undergoes a modification, the German Reich, with the consent of the Council of the Reich, shall determine to what extent the protection provided by Section 1 for nationals of the United States of America shall be modified.

Id. art. 2.

bilateral treaties have different terms and conditions. So how does one determine whether RST applies in bilateral treaties? This, unfortunately, requires a treaty-by-treaty analysis looking for mention of RST.

2. Free Trade Agreements

In the same way we must look at bilateral treaties, we must also review free trade agreements. Like many treaties, most free trade agreements (FTAs) are silent on whether RST applies. Given their name, FTAs should signal that national treatment *without* RST limitations applies. But many do not include information about RST—only that national treatment applies.

a. Canada

Canada excludes works from Mexico and the United States in its use of RST for joint authors because all three are signatories to the North American Free Trade Agreement (NAFTA), Article 1703 of which provides for national treatment without formalities or conditions for new works only.[134] Regarding copyright, NAFTA explicitly cites to Berne Article 2 for subject matter protection and also sets out minimum terms of fifty years from publication for

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134. North American Free Trade Agreement [NAFTA], U.S.-Mex.-Can., art. 1703, Dec. 17, 1992, 32 I.L.M. 289 (1993).

> 1. Each Party shall accord to nationals of another Party treatment no less favorable than that it accords to its own nationals with regard to the protection and enforcement of all intellectual property rights. In respect of sound recordings, each Party shall provide such treatment to producers and performers of another Party, except that a Party may limit rights of performers of another Party in respect of secondary uses of sound recordings to those rights its nationals are accorded in the territory of such other Party. 2. No Party may, as a condition of according national treatment under this Article, require right holders to comply with any formalities or conditions in order to acquire rights in respect of copyright and related rights. 3. A Party may derogate from paragraph 1 in relation to its judicial and administrative procedures for the protection or enforcement of intellectual property rights, including any procedure requiring a national of another Party to designate for service of process an address in the Party's territory or to appoint an agent in the Party's territory, if the derogation is consistent with the relevant Convention listed in Article 1701(2), provided that such derogation: (a) is necessary to secure compliance with measures that are not inconsistent with this Chapter; and (b) is not applied in a manner that would constitute a disguised restriction on trade. 4. No Party shall have any obligation under this Article with respect to procedures provided in multilateral agreements concluded under the auspices of the World Intellectual Property Organization relating to the acquisition or maintenance of intellectual property rights.

Id.

photographs or, failing publication, fifty years from creation.[135] Sound recordings are also required to have a minimum term of fifty years from fixation.[136] These are longer terms than Berne would provide.

Regarding protection of existing subject matter, Article 1720 of NAFTA refers back to Article 18 of the Berne Convention and reiterates that if a work is in the public domain in its country of origin, it does not gain additional protection.[137] Annex 1705.7 specifically addresses motion pictures that have fallen into the public domain in the United States.[138] But no explicit discussion of Section 7(8)—RST—of the Berne Convention is included. Because RST garners no mention, we must assume that national treatment trumps RST in importance.

b. US-Singapore Free Trade Agreement

We see more explicit mention of protection duration in the US-Singapore FTA.[139] Article 2.1 of the treaty sets out the general national treatment requirements.[140] The 2004 treaty sets out the terms upon which copyright is calculated: seventy years *pma*, and if not calculated on the natural life of a person, no shorter than seventy years from publication.[141] However, if publication does not occur within fifty years of creation, then copyright applies for seventy years from the creation of the work.[142]

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135. *Id.* art. 1706(2).

> Each Party shall provide that, where the term of protection of a work, other than a photographic work or a work of applied art, is to be calculated on a basis other than the life of a natural person, the term shall be not less than 50 years from the end of the calendar year of the first authorized publication of the work or, failing such authorized publication within 50 years from the making of the work, 50 years from the end of the calendar year of making.

Id. art. 1705(4).

136. *Id.* ("Each Party shall provide a term of protection for sound recordings of at least 50 years from the end of the calendar year in which the fixation was made.").

137. *Id.* art. 1720(2)–(3).

138. *Id.* Annex 1705.7, explaining that:

> The United States shall provide protection to motion pictures produced in another Party's territory that have been declared to be in the public domain pursuant to 17 U.S.C. Section 405. This obligation shall apply to the extent that it is consistent with the Constitution of the United States, and is subject to budgetary considerations.

Id.; *see* 17 U.S.C. § 104A (2012) (this original Section of 104A was revised with the passage of the URA).

139. US-Singapore Free Trade Agreement, art. 16.4(4), Jan. 1, 2004.

140. *Id.* art. 2.1.

141. *Id.* art. 16.4(4).

142. *Id.*

For the United States, Berne is not self-executing, so authors from member country Singapore must rely on Section 104A of the US Copyright Act and traditional means of obtaining copyright in the United States instead. On the flip side, for US works in Singapore, while the 1998 Copyright (International Protection) Regulations provide for RST in Singapore,[143] no restoration provisions are included directly in the regulations, nor are the terms of the FTA explicitly included in the current law. So does RST apply to US works? Does the FTA override RST?

c. Other FTAs

Australia's FTA with the United States, which contains the same language regarding copyright term as Singapore's mandates national treatment.[144] Peru and Panama also have the same language: minimum terms, national treatment, and Article 18.[145] In Oman, national treatment and Article 18 apply but the minimum terms are different.[146] Like the bilateral treaties, each FTA must be reviewed to see if anything related to RST and Article 18 has been included, as we saw with Germany. Why was Article 18 included, but not Article 7(8)? One might come to the conclusion that RST does not apply because one term is included and the other is not.

3. The Trans Pacific Partnership

The fate of the TPP is uncertain since the United States withdrew on January 23, 2017. The TPP originally included the United States, Canada, Australia, New Zealand, Malaysia, Singapore,

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143. Copyright (International Protection) Regulations, U.S.-Singapore, art. 4 (1998) ("Copyright subsisting in a published work, published cinematograph film or published sound recording by reason only of the operation of these Regulations ceases to subsist upon the expiration of the term of the protection in the nature of copyright that subsists in relation to such a work, film or recording under the law of the country of origin of the work, film or recording.").

144. Free Trade Agreement, U.S.-Aus., art. 17.1(6), Jan. 1, 2004.

145. Free Trade Agreement, U.S.-Peru, art. 16, Feb. 1, 2009.

146. Free Trade Agreement, U.S.-Oman, art. 15.4(4), Jan. 1, 2009.

> Each Party shall provide that, where the term of protection of a work (including a photographic work), performance, or phonogram is to be calculated: (a) on the basis of the life of a natural person, the term shall be not less than the life of the author and 70 years after the author's death; and (b) on a basis other than the life of a natural person, the term shall be (i) not less than 95 years from the end of the calendar year of the first authorized publication of the work, performance, or phonogram, or (ii) failing such authorized publication within 25 years from the creation of the work, performance, or phonogram, not less than 120 years from the end of the calendar year of the creation of the work, performance, or phonogram.

Id.

Japan, Mexico, Peru, Vietnam, Brunei, and Chile as signatories and addressed changes to copyright term among its provisions.[147] The TPP allowed for greater protection, requiring some states to increase their terms of protection (e.g., Japan and Canada) to seventy years, under the guise of harmonization for better trade relations. Key, as in the Berne Convention, is the requirement of national treatment.[148] The TPP explicitly noted that Article 18 of the Berne Convention must be applied and that works are not restored if the work is in the public domain in its country of origin.[149]

The minimum terms of protection in the TPP were set out in Article 18.63: life of the author plus seventy years and, for those whose triggering event is publication, performance, or phonogram, seventy years from that event.[150] If a work is not published within twenty-five years of creation of the work, performance, or phonogram, the term will be "not less than [seventy] years from the end of the calendar year of the creation of the work, performance, or phonogram."[151]

This has an interesting effect on the term of protection in numerous countries and the question of RST application. Canada, a TPP country, will have had to raise its term from fifty to seventy years after the author's death. Japan and New Zealand would also have had to change their laws. Footnote 75 of the TPP is particularly significant for the purposes of RST:

> The Parties understand that if a Party provides its nationals a term of copyright protection that *exceeds life of the author plus 70 years*, nothing in this Article or Article 18.8 (National Treatment) shall preclude that Party *from applying Article 7.8* of the Berne Convention with respect to the term in excess of the term provided in this subparagraph of protection for works of another Party.[152]

Article 7.8 contained RST (previously referred to here as Article 7(8)). The question becomes which country has a term longer than seventy years that may want to apply RST. The answer: only Mexico. Mexico has a term based on one hundred years, either from life or publication. Mexico's laws are silent as to whether RST applies. It is also unclear whether Berne is self-executing in Mexico. So, for

147. Trans-Pacific Partnership Agreement, *supra* note 10, art. 18.63(b)(i), 18-35 n.77.

148. *Id.* art. 18.8(1) ("In respect of all categories of intellectual property covered in this Chapter, each Party shall accord to nationals of another Party treatment no less favourable than it accords to its own nationals with regard to the protection of intellectual property rights.").

149. *Id.* art. 18.64 ("Each Party shall apply Article 18 of the Berne Convention and Article 14.6 of the TRIPS Agreement, *mutatis mutandis*, to works, performances and phonograms, and the rights in and protections afforded to that subject matter as required by this Section.").

150. *Id.* art. 18.63.

151. *Id.*

152. *Id.* at 18-34 n.75.

many years, experts believed or presumed RST *did not* apply in Mexico. However, this footnote seemed to strongly suggest that RST *does* apply in Mexico.[153] RST seems to apply only in the context of author-based works with a term greater than seventy years. What about publication-based terms or other situations? Those scenarios were not included in the TPP footnote. It stands that a more transparent way of assessing whether RST applies is needed.

VIII. RST RULE OF THUMB FOR US WORKS

If the United States has a bilateral or free trade agreement with a jurisdiction, it is prudent to review the actual agreement. It will likely be silent regarding RST, but for US works abroad, it probably means that national treatment, and not RST, applies. Other intervening issues may still arise, such as Germany's inclusion of the UCC into the law that overrides the terms of bilateral agreements for certain works, whether a work is protected by its *potential term*, whether the work was protected in the United States as of March 1, 1989, when the United States joined Berne, and any additional FTAs.

For pre-UCC works, bilateral treaties protect a work under national treatment. If the UCC is included in the national law, then the UCC applies *after* its enactment, unless the domestic law is retroactive. It is unclear whether national treatment or RST applies when the UCC is not directly included in a country's law or is included as a self-executing treaty on post-1955 works. If a work is still under copyright in the United States as of March 1, 1989, the work likely obtains national treatment again. FTAs provide for national treatment, along with implementation of Article 18. So the March 1, 1989, date is likely the key to determining how the work is treated.

The following lists the countries where RST is unlikely to apply to US works:

153. *Id.* Canada's transitional laws for unpublished works, which if not changed will have a shorter term in some cases than seventy years, may be another area applicable to RST.

FIGURE 1. COUNTRIES RST IS UNLIKELY TO APPLY TO US WORKS

Country	Likely RST?	Bilateral[154]	Berne	BAC[155]	FTA[156]	TPP
Australia	No	X (1918)	X (1928)		X	X
Canada	No	X (1924) (with UK previously 1891)	X			X
Argentina	Maybe	X (1934)	X (1967)			
Austria	No	X (1907)	X (1920)			
Bahrain	No		X		X (2006)	
Belgium	No	X (1891)	X			
Bolivia			X (1993)	X (RST?)		
Brazil			X (1922)	X (RST?)		
Brunei	No		X (2006)			X
Chile	No	X (1896)	X (1970)	X (over-ridden)	X (2004)	X
Costa Rica	No	X (1899)	X (1978)		X (2009)	
Cuba	No	X (1903)	X (1996)			
Colombia			X (1988)	X (RST?)	X (2012)	
Denmark	No	X (1893)	X (1903)			
Dominican Republic			X (1997)	X (RST?)		
Ecuador			X (1991)	X (RST?)		

154. No RST.

155. Copyright Convention Between the United States and Other American Republics, art. 6, August 11, 1910 (Buenos Aires). RST applies.

156. No RST.

El Salvador	No	X (1908)	X (1993)			
Germany	No	X (1892)	X (1987)			
Greece	No	X (1932)	X (1920)			
Guatemala	No		X (1997)	X (over-ridden)	X (2006)	
Haiti	No		X (1995)	X (over-ridden)		
Honduras	No		X (1989)	X (over-ridden)	X (2006)	
Hungary	No	X (1912)	X (1922)			
Indonesia	No	X (1989)	X (1997)			
Ireland	No	X (1929)	X (1927)			
Israel	No	X (1948) (previously UK as of 1911)	X (1949)		X (1985)	
Italy	No	X (1892) and (1915)	X (1887)			
Japan	No	X (1906)	X (1899)			X
Jordon	No		X (1999)		X (2001)	
Korea	No				X (2012)	
Malaysia	No		X (1990)			X
Mexico	No	X (1896)	X (1967)		X (1994)	X
Morocco	No		X (1917)		X (2006)	
Netherlands	No	X (1899)	X (1912)			
New Zealand	No	X (1916)	X (1928)			

Nicaragua	No		X (2000)	X (over-ridden)	X (2006)	
Norway	No	X (1905)	X (1896)			
Oman	No		X (1999)		X (2009)	
Panama	No		X (1996)	X (over-ridden)	X (2012)	
Paraguay			X (1991)	X (RST?)		
Peru	No		X (1988)	X(over-ridden)	X (2009)	X
Philippines	No	X (1948)	X (1950)			
Portugal	No	X (1893)	X (1911)			
Singapore	No	X (1987)	X (1998)		X (2004)	
South Africa	No	X (1924)	X (1928)			
Spain	No	X (1887)	X (1887)			
Sweden	No	X (1891)	X (1904)			
Thailand	No	X (1921)	X (1931)			
United Kingdom	No	X (1891)	X (1887)			
Uruguay			X (1967)	X (RST?)		
Vietnam	No	X (1998) and (2001)				X

This list is based on the US Copyright Office's Circular 38A: International Copyright Relations of the United States, along with the reading of the relevant bilateral or FTA for language related to RST. While RST may apply to non-US works, US copyright owners should not generally fear the effect of RST in forty-three countries. But this is not definitive. It is a best guess. More certain answers would require WIPO to step up and produce a list, asking each country of the world to confirm the status of RST within its laws and any limitations

or exceptions that may exist. It is time we create this list. It is becoming increasingly necessary in today's world economy. Indeed, this Article, like Devault-Graves in the Salinger case, is calling on WIPO for a reliable status check regarding the applicability of RST. But until WIPO comes through in that respect, this Article proposes a three-part analysis to apply in any case raising questions of RST applicability.

IX. RST ANALYSIS: THREE-PART TEST PROPOSAL

Rule of the Shorter Term can be complicated, but it is not impossible to discern. It would have been interesting for the Salinger court to take up the issue of RST, as the United States has specific situations that are distinct from the rest of the world. This Article suggests a three-part test for determining whether Rule of the Shorter Term applies:

A. Preliminary Questions

1. Would it make a difference if RST were applied? That is, is the country of origin's term shorter than the term of the country where protection is sought? If no, RST analysis is not necessary.
2. The Work: Identify the country of origin of the work. This is the country of first publication.

B. Does RST apply between country of origin and country where protection is being sought?

1. RST in the Copyright Statute. Does the statute of the country where protection is being sought explicitly indicate that RST applies?
    a. If yes, skip to PART C.
    b. If no, proceed.
2. Multilateral/Bilateral Treaties. Are both countries (the country of origin and the country where protection is being sought) members of a multilateral agreement that explicitly applies RST?
    a. If yes, proceed.
    b. If no, no RST.
3. Role of Treaties in Country Where Protection Is Being Sought. Is the multilateral agreement applied directly in the country; that is, is the multilateral agreement self-executing?
    a. If yes, proceed.
    b. If no, no RST.

    Note: this question of direct application is the crux of the problem: how to determine when treaties are directly applicable when the statute is silent.
4. Role of Bilateral Treaties in Country Where Protection Is Being Sought. Are there any bilateral agreements or other treaties that exempt the country of origin from RST within the country where protection is being sought?
    a. If yes, no RST.
    b. If no, proceed.

5. Relationship Between National Legislation, Treaties and Bilateral Treaties. How are we to interpret competing agreements and treaties? See if there are cases or other secondary sources. Also look to the treaties themselves. Check to see any specific national legislation that would alter the results.

C. Applying RST

1. Measure the term of the country of origin (be mindful that this could either be a potential or an actual term) and then compare it to the country where protection is being sought.
    a. If the origin term is shorter, apply RST. Note, "expiry" of term may be applied, rather than the actual term, as in the case of the United States.
    b. If the origin term is longer or the same, do not apply RST.
    c. If simultaneous publication occurred and both countries are members of Berne, the shorter term of the two countries applies. If some countries that had simultaneous publication were not members of Berne, then only the countries that are members of Berne apply for determining the shortest term.

What becomes clear is that anyone working through foreign works in a particular jurisdiction must come to grips with RST. Otherwise, one can end up with the wrong term for a given work and maybe even end up in messy litigation, as evidenced by Devault-Graves and its publication of the three early Salinger stories.

X. CONCLUSION

Devault-Graves was looking for a US court to affirm that if RST applied in a particular country, the three Salinger stories were in that country's public domain. The first judge, in Tennessee, transferred the case to New Hampshire where the Salinger Estate resides, but there was no ruling on the merits. Then, in New Hampshire, the Salinger Estate wanted the case dismissed because the kinds of questions would be too complicated, looking at each country of the world to determine whether RST applied or not. Before the New Hampshire judge could rule, Devault-Graves decided to drop the lawsuit.

An Associated Press story reported that Devault-Graves did not see this move as the end, declaring that it "is certainly no loss for us."[157] And what of the fight to publish the work around the world? The Associated Press reported representatives of Devault-Graves as

157. Kathy McCormack, *Publisher Seeks to Drop Suit Against J.D. Salinger's Family*, ASSOCIATED PRESS (Dec. 11, 2015), http://bigstory.ap.org/article/51c04c839f4946698e4279e032006e27/publisher-seeks-drop-suit-against-jd-salingers-family [https://perma.cc/MB7C-CTA9].

saying it will "defend our right to publish in every foreign market that is legitimately open to us. It is merely a new way of looking at the equation."[158] According to Publisher's Weekly, "[d]espite Salinger's opposition, Graves told *PW* that the publisher had licensed the book to [ten] foreign publishers, and that there are now six foreign editions in print."[159] Perhaps the *Devault-Graves v. Salinger Estate* litigation will continue around the world, after all.

And to the issue that Devault-Graves raised? There is a crucial question as to when RST applies in each country of the world, especially when the country's law is silent on whether it is included. Even though RST is presumed in Berne, it is less clear when Berne is directly applicable. There is need for clarification from WIPO through a study or informal letter that confirms that RST applies to all countries that do not opt out, regardless of whether the term is included in the copyright law itself, and regardless of whether treaties are directly applied or not. Otherwise, the property rights of foreign copyrighted works remain unclear in many jurisdictions around the world.

158. *Id.*

159. Andrew Albanese, *J.D. Salinger Copyright Suit Is Dropped*, PUBLISHERS WEEKLY (Dec. 11, 2015), http://www.publishersweekly.com/pw/by-topic/digital/copyright/article/68922-j-d-salinger-copyright-suit-is-dropped.html [https://perma.cc/GFY4-B7Y8].