

Copyright Restoration Under the URAA

Congress passed the Uruguay Round Agreements Act (URAA) in 1994 to implement U.S. obligations under the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) of the World Trade Organization (WTO). TRIPS incorporates by reference many obligations under the Berne Convention for the Protection of Literary and Artistic Works.

The United States signed the Berne Convention in 1989, committing itself to grant the same level of copyright protection to works from other Berne countries that it provides to works of U.S. nationals.

The United States acceded to TRIPS in 1995 when it joined the WTO. TRIPS independently mandates compliance with most Berne provisions and provides additional obligations regarding enforcement that are subject to dispute resolution at the WTO.

Several provisions of the URAA amend U.S. copyright law.¹ This circular focuses on amendments to section 104A.

The URAA amended section 104A of the copyright law to restore U.S. copyright to certain foreign works that were in the public domain in the United States but protected by copyright in their countries of origin.

Restoration of Copyrights

Ownership of a restored copyright vests initially in the author or initial right-holder, as determined by the law of the restored work's source country or by the owner of an exclusive right in the United States.

Eligibility Requirements

To be eligible, a work must meet *all* of the following requirements:

- 1 At the time the work was created, at least one author (or rightholder in the case of a sound recording) must have been a national or domiciliary of an eligible source country. An eligible source country is a country, other than the United States, that is a member of the WTO, a member of the Berne Convention for the Protection of Literary and Artistic Works, or subject to a presidential proclamation restoring U.S. copyright protection to works of that country on the basis of reciprocal treatment of the works of U.S. nationals or domiciliaries.²
- 2 The work is not in the public domain in the eligible source country through expiration of the term of protection.
- 3 The work is in the public domain in the United States because it did not comply with formalities imposed at any time by U.S. law, lacked subject matter protection in the United States in the case of sound recordings fixed before February 15, 1972, or lacked national eligibility in the United States.³

- 4 If published, the work must have been first published in an eligible country and not published in the United States during the 30-day period following its first publication in the eligible country.

Effective Date of Restoration

January 1, 1996, was the effective date of restoration of copyright for works from countries that were members of the WTO or the Berne Convention on that date. Subsequently, the effective date of restoration is the date a newly eligible country accedes to the WTO or the Berne Convention or the date of a presidential proclamation restoring U.S. copyright protection to works of that country.

Term of Copyright

The copyright in any work in which copyright is restored will last for the remainder of the term of copyright that the work would have enjoyed if the work had never entered the public domain in the United States.

Generally, the U.S. copyright term for works published before January 1, 1978, lasts for 95 years from the year of first publication. Although sound recordings fixed before 1972 were not then protected by federal copyright, those sound recordings will receive the remainder of the term they would have received had they been protected by such copyright when published. For example, a sound recording published in 1925 will be protected until 2020. For works published on or after January 1, 1978, the term of copyright is the life of the author plus 70 years. For example:

- A French short story that was first published without copyright notice in 1935 will be treated as if it had both been published with a proper notice and properly renewed, meaning that its restored copyright will expire on December 31, 2030 (95 years after the U.S. copyright would have come into existence).
- A Chinese play from 1983 will be protected until December 31 of the 70th year after the year in which its author dies.
- A Mexican sound recording first published in Mexico in 1965 will be protected until December 21, 2060.

For details about the duration of copyright protection in the United States, see Circular 15A, *Duration of Copyright*.

Automatic Restoration

Eligible copyrights are restored automatically and no further steps need to be taken to make a restored copyright fully enforceable against any party other than a reliance party.

Notice of Intent to Enforce

Although copyright is restored automatically in eligible works, the URAA directs the owner of a restored work to notify reliance parties if the owner of the rights in a restored work plans to enforce those rights.

A reliance party is typically a business or individual who, relying on the public domain status of a work, was using it before the enactment of the URAA on December 8, 1994. For works from any country that was not eligible under the URAA as of December 8, 1994, reliance parties are those using the work before the date on which the country becomes eligible by joining the WTO or the Berne Convention or as a result of a presidential proclamation.

The URAA authorizes the owner of a right in a restored work to either

- provide actual Notice of Intent to Enforce (NIE) a Restored Copyright by contacting a reliance party directly,
or
- provide constructive notice by filing an NIE with the Copyright Office.

The URAA further directs the Copyright Office to publish in the *Federal Register*, the U.S. government's publication for official agency notices, a list identifying restored works and their ownership when NIEs are recorded with the Office. For inspection and copying by the public, the Office maintains a list identifying all NIEs. See "Public Record" below for details about searching NIEs.

Dates for Filing Notices

Owners of restored works can file NIEs directly with reliance parties at any time after the date of restoration. Owners of restored works from countries that become eligible source countries after January 1, 1996, and who want to file NIEs with the Copyright Office have two years from the date of eligibility to do so. Owners of works whose source countries were members of the Berne Convention or the WTO as of January 1, 1996, and who wanted to file NIEs with the Copyright Office had to do so between January 1, 1996, and December 31, 1997.⁴ The Office published the first listing of NIEs on May 1, 1996 (61 *Fed. Reg.* 19371), and published lists at four-month intervals over the following two years. All of the notices are available on the Copyright Office website at www.copyright.gov/gatt.html.

Grace Period for Use of Restored Works

A reliance party has a 12-month grace period to sell off previously manufactured stock, perform or display the relevant work publicly, or authorize others to conduct these activities. The grace period begins when the reliance party receives notice that the owner is enforcing the copyright in the restored work. The date runs from either the date of receipt of the actual notice or the date of publication of the *Federal Register* issue identifying the work. If notice is provided both by *Federal Register* publication and service on the reliance party, the period runs from whichever date is earlier. Except for certain reliance parties who created derivative works, a reliance party must cease using the restored work when the 12-month grace period expires unless the reliance party reaches a licensing agreement with the copyright owner for continued use of the restored work.

Subsection (d)(3) of the amended section 104A of the Copyright Act contains special rules for certain derivative works created before December 8, 1994, based on underlying restored works. Examples include the translation of a restored work or a motion picture based on a restored book or a play. A reliance party can continue to exploit such derivative works if the reliance party pays the owner of the restored copyright reasonable compensation.

Notices Filed in Copyright Office

The following information describes how to file an NIE with the Copyright Office. Filing actual notice on a reliance party is described later in this circular.

Format

The Copyright Office does not provide a form for filing an NIE. However, the final page of this circular and the regulations published in the *Federal Register* and the *Code of Federal Regulations* contain a sample format that can be used to file notices. This format is also available on the Copyright Office's website at www.copyright.gov/forms/formnie.txt.

The format includes both required and optional information. The Copyright Office strongly recommends use of this format. An NIE filed with the Copyright Office should be typed or printed legibly by hand on 8½" × 11" (or A4, i.e., 210 × 297 mm) white paper with a 1" (or 3 cm) margin.

Content

The URAA specifies the minimum content of an NIE. The notice must be signed by the copyright owner or the owner's agent and must contain the title of the work or a brief

description of the work if it is untitled; an English-language translation of the title if the title is in a foreign language; any other alternative titles known to the owner by which the restored work can be identified; the name of the copyright owner of the restored work or owner of an exclusive right therein; and the address and telephone number at which the owner can be contacted. Although the Copyright Office can ask for additional information, failure to provide it will not invalidate the NIE.

The Copyright Office has identified certain information that is not required by the URAA but is important for proper identification of a restored work. It includes:

- 1 type of work (for example, painting, sculpture, music, motion picture, sound recording, or book)
- 2 name of author(s)
- 3 source country
- 4 approximate year of first publication
- 5 additional identifying information (for example, for movies: director, leading actors, screenwriter, animator; for photographs: subject matter; for books: editor, publisher, contributors)
- 6 rights owned by the party on whose behalf the NIE is filed (for example, the right to reproduce, distribute, publicly display, or publicly perform the work or to prepare a derivative work based on the work)
- 7 email address and fax number at which the owner, exclusive rights holder, or agent can be reached

Multiple Works

Multiple works can be included on a single NIE provided that (a) each work is identified by title or a brief description if untitled; (b) all the works have the same author; (c) all the works are owned by the same copyright owner or the owner of the exclusive rights therein; and (d) the rights owned by the party on whose behalf the notice is being filed are the same.

Signature and Certification

The NIE must be signed by the owner of the restored copyright, the owner of an exclusive right therein, or an agent of the owner. The agency relationship must be established in writing and signed by the owner before the NIE is filed.

The NIE must include a certification statement indicating that the information given is correct to the best of the filer's knowledge. Any material false statement knowingly made with respect to any restored copyright identified in an NIE shall void all claims and assertions against reliance parties

made about such restored copyright. The sample format on the final page of this circular includes a certification statement.

Fee

The nonrefundable fee for filing an NIE covers a notice including one work. For a notice covering multiple works, there is an additional fee for each group of 10 titles. The fee includes the cost of acknowledging a recordation by mail after the Copyright Office records the NIE.

See Circular 4, *Copyright Office Fees*, for details about current fees and acceptable payment methods. The fee applicable to NIEs is listed under the subheading Recordation of Documents. Note that credit cards are accepted for filings under the URAA, even though the Copyright Office does not accept credit cards for other filings on paper forms. To pay by credit card, a filer must provide *in a separate letter* the name on the credit card being used, the credit card number, the expiration date of the credit card, the total amount authorized to be charged, and a signature authorizing the Copyright Office to charge the fees to that account. *To protect the security of the credit card number, the credit card number must not appear on the NIE, since the notice becomes part of the public record.*

Filers should ensure that sufficient fees accompany an NIE. Filing with insufficient fees can delay the effective date of notice.

NOTE: Copyright Office fees are subject to change. For current fees, please check the Copyright Office website at www.copyright.gov, write the Copyright Office, or call (202) 707-3000.

Address

Send NIEs to the following address:

GC/I&R
P.O. Box 70400, Southwest Station
Washington, DC 20024 USA

Do *not* mail them to the Copyright Office.

Notice Filed Directly on Reliance Party

The Copyright Office does not provide a form for serving an NIE directly on a reliance party. Filers who wish to do so should note that the URAA requires additional information for notices served directly on reliance parties compared with notices filed with the Copyright Office. Therefore, if a filer uses the Copyright Office's NIE format as a guide for

serving notice directly on a reliance party, the notice will be incomplete unless additional details are supplied. The URAA specifications follow, with italic type inserted to show the additional requirements for serving notice directly:

Notices of Intent to Enforce a Restored Copyright served on a reliance party shall be signed by the owner or the owner's agent, shall identify the restored work *and the work in which the restored work is used*, if any, in detail sufficient to identify them, and shall include an English translation of the title, any other alternative titles known to the owner by which the work may be identified, *the use or uses to which the owner objects*, and an address and telephone number at which the reliance party may contact the owner. If the notice is signed by an agent, the agency relationship must have been constituted in writing and signed by the owner before service of the notice. [Section 514 of the URAA as found in 17 U.S.C. section 104A(e)(2)(B) of the URAA]

Direct notice can be served on a reliance party at any time after copyright in the work is restored.

Restoration of Copyright Claims

The URAA directs the Copyright Office to provide procedures for registering copyright claims; however, copyright owners of restored works need not register their works. Copyright law provides that the author or copyright owner of a work that is not considered a Berne Convention work must register the work or seek registration before he or she can bring a copyright infringement action in federal court.⁵ The owner of rights in a Berne Convention work, however, does not have to register before initiating a copyright infringement suit.

Registration of Claim in Berne Convention Work

A claim in a restored work can be registered only in the name of the owner(s) of the U.S. copyright on the date that the application is submitted, that is, in the name of the owner(s) of all U.S. rights in that work. A licensee or party whose ownership extends only to certain exclusive rights in a work is not permitted to register a claim in a restored work in his or her name.

Registration Form

Form GATT must be used to register copyright claims in works restored under the URAA. To obtain it, go to the Copyright Office's website at www.copyright.gov/forms or call (202) 707-9100 and leave a recorded message. Alternatively, write to:

*Library of Congress
Copyright Office—COPUBS
101 Independence Avenue SE
Washington, DC 20559*

Publication

The following guidelines may help in determining required publication information for restored works for which registration is sought.

- For works published on or after January 1, 1978: Publication is the distribution anywhere in the world of copies or phonorecords of a work to the public by sale or other transfer of ownership or by rental, lease, or lending. The offering to distribute copies or phonorecords to a group of persons for purposes of further distribution, public performance, or public display constitutes publication. A public performance or display of a work does not in itself constitute publication. (17 U.S.C. 101)
- For works published before January 1, 1978: General publication may be defined as the act of making one or more copies of a work available to the general public, usually by the sale, placing on sale, or public distribution of one or more copies or sound recordings without express or implied restrictions as to future use. Limited publication may be defined as the act of making a work available to a limited audience for a limited purpose and with express or implied restrictions as to future use. Recordings of musical compositions were not considered copies of recorded music before January 1, 1978. A distribution of a recording before that date would constitute publication of the sound recording but not the music contained on the recording.

Registration Fee

The basic registration fee also applies to a series of works published during a calendar year under a single title in episodes, installments, or issues. Copyright Office fees are subject to change. For current fees, check the Copyright Office website at www.copyright.gov, write the Copyright Office, or call (202) 707-3000.

Public Record

The information contained in NIEs filed with the Copyright Office and in copyright registrations and related documents catalogued since January 1, 1978, is available on the Copyright Office website at www.copyright.gov/gatt.html and open to the public for searching.

Online Searches

Information accessible on the website includes the title of a work or a brief description of it if untitled; an English translation of the title; the alternative titles, if any; the name of the copyright owner or the owner of an exclusive right; the author; the type of work, if given; the date of receipt of the NIE in the Copyright Office; the date of publication of NIE details in the *Federal Register*; the rights covered by the notice, if given; and the address, telephone, and fax number, if given, of the copyright owner. Online records are searchable by the title of a work, the copyright owner or the owner of an exclusive right, and the author.

Office Searches

The Copyright Office's Public Records Reading Room is located in Room LM-404 of the James Madison Memorial Building of the Library of Congress. Public records of NIEs can be searched Monday through Friday, 8:30 AM to 5:00 PM, eastern time, except federal holidays. Public terminals are available.

Upon payment of a fee, the Copyright Office staff will search the records and provide a written report. For details, see Circular 22, *How to Investigate the Copyright Status of a Work*, or contact:

*Library of Congress
Copyright Office—RRC
101 Independence Avenue SE
Washington, DC 20559 USA
TEL: (202) 707-6850 or 1-877-476-0778 (toll free)
FAX: (202) 252-3485
EMAIL: copysearch@copyright.gov*

Relationship to NAFTA

Under the North American Free Trade Agreement (NAFTA) Implementation Act, some Mexican motion picture owners filed timely statements of intent to restore copyright in the United States with the Copyright Office.⁶ These works continue to enjoy copyright protection, but the protection is now governed by section 104A of the Copyright Act as

amended by the URAA. Copyright owners of these works need not file an NIE under the URAA.

However, other works from NAFTA countries that are in the public domain in the United States, including motion pictures for which no NAFTA restoration was sought, are subject to copyright restoration under the amended section 104A. NAFTA works that have not been registered can be registered using the URAA registration procedures, including GATT forms and deposit preferences.

For Further Information

By Internet

Circulars, announcements, regulations, application forms, and other related materials are available from the Copyright Office website at www.copyright.gov.

By Telephone

For general information about copyright, call the Copyright Public Information Office at (202) 707-3000 or 1-877-476-0778 (toll free). Staff members are on duty from 8:30 AM to 5:00 PM, Monday through Friday, eastern time, except federal holidays. Recorded information is available 24 hours a day. To request paper application forms or circulars, call (202) 707-9100 or 1-877-476-0778 and leave a recorded message.

By Regular Mail

Write to:

*Library of Congress
Copyright Office—COPUBS
101 Independence Avenue SE
Washington, DC 20559*

Notes

1. The URAA is contained in Pub. L. No. 103-465, 108 Stat. 4809. See also House Document 103-316, 103d Congress, 2d Session, September 27, 1994, and Statement of Administrative Action *Id.* 656, 981. The URAA amends U.S. copyright law at 17 U.S.C. section 104A, 109(b). The URAA also adds a new chapter 11 to title 17 and a new section 2319A to title 18.
2. The United States has bilateral relations with certain countries, some of which may have extended copyright protection to some of their colonies or territories. In addition, the definition of a “United States work” has been expanded since the URAA was enacted to include countries that are members of the Copyright Treaty of the World Intellectual Property Organization (WIPO) and the WIPO Performances and Phonograms Treaty.
3. Works in the public domain because of a failure to comply with one or more of the formalities required by U.S. copyright law include those for which the copyright owner may, for example, have published the work without a proper copyright notice, failed to renew the copyright, or failed to comply with the manufacturing clause or ad interim provisions of the copyright law.
4. Although a country can become a source country through a presidential proclamation, only one such proclamation has been issued to date. That proclamation has to do with Viet Nam.
5. The legislation did not specifically address the question whether a work from a country that is a member of the WTO but not Berne must be registered. But one can assume that works that do not come under the definition of “Berne Convention work” found in 17 U.S.C. 101 would have to be registered before the owner could initiate a suit.
6. The NAFTA Implementation Act is contained in Pub. L. No. 103-182, 107 Stat. 2057. See 60 *Fed. Reg.* 8252 (February 13, 1995) for a list of the works affected by the statements of intent to restore.



Notice of Intent to Enforce (NIE) a Copyright Restored Under the Uruguay Round Agreements Act (URAA)

- 1 Title: _____
OR _____
(If this work does not have a title, state "No title.")
Brief description of work: _____
(for untitled works only)
- 2 English translation of title (if any): _____
- 3 Alternative title(s) (if any): _____
- 4 Type of work: _____
(e.g., painting, sculpture, music, motion picture, sound recording, book)
- 5 Name of author(s): _____
- 6 Source country: _____
- 7 Approximate year of publication: _____
- 8 Additional identifying information: _____
(e.g., for movies: director, leading actors, screenwriter, animator; for photographs: subject matter; for books: editor, publisher, contributors, subject matter)
- 9 Name of copyright owner: _____
(Statements can be filed in the name of the owner of the restored copyright or the owner of an exclusive right therein.)
- 10 If you are not the owner of all rights, specify the rights you own: _____
(e.g., the right to reproduce/distribute/publicly display/publicly perform the work or to prepare a derivative work based on the work)
- 11 Address at which copyright owner can be contacted: _____

(Give the complete address, including the country, and an "attention" line, or "in care of" name, if necessary.)
- 12 Telephone number of owner: _____
- 13 Telefax number of owner: _____
- 14 Certification and signature:

I hereby certify that, for each of the work(s) listed above, I am the copyright owner, or the owner of an exclusive right, or the owner's authorized agent, the agency relationship having been constituted in a writing signed by the owner before the filing of this notice, and that the information given herein is true and correct to the best of my knowledge.

Signature: _____
Name (printed or typed): _____
As agent for (if applicable): _____
Date: _____

NOTE: Notices of Intent to Enforce should be in English, except for the original title, and either be typed or printed legibly by hand in dark, preferably black, ink. They should be on 8½" × 11", (or A4, 210 × 297 mm) white paper of good quality, with at least a 1" (or 3 cm) margin.