

sheet music publishers. Congress's focus was primarily on preventing piracy, that is, unauthorized duplication and distribution, so it did not give the owners of copyrights in recordings a performance right. Anyone could perform any sound recording without permission from the owners of the recording, though they were required to pay a statutory license fee to the owners of copyright in the underlying composition. The Internet prompted a change in this limitation, however, and recordings now enjoy a limited performance right by means of digital audio transmissions. The way recording copyrights have varied over time gives their protection a sort of "patch-work" quality that makes understanding difficult, even for lawyers.

For the next 20 minutes, we'll look a little more closely at the patchwork of protection for recordings as a way to help us figure out which recordings may be in the public domain. Then we'll focus on the special exemptions that permit us to archive and make recordings available to the public even when they are still protected, and finally, we'll assess the shortcomings in all of this and review some actions we might take to maximize what we and our patrons can do with the recordings we have so carefully preserved in our collections.

THE LEGAL FRAMEWORK

U.S. Recordings Protected by Federal or State Law. Today, federal law protects U.S. sound recordings fixed on or after February 15, 1972 (hereafter, "1972"). As indicated above, these recordings enjoy only a limited set of rights. Copyright owners have the exclusive right to reproduce a recording in phonorecords, to prepare derivatives, and to publicly distribute phonorecords. Recording copyright owners do not enjoy an exclusive right to publicly perform their recordings; rather, Section 106(6) provides that the owner of rights in a sound recording has the exclusive right to perform the recording publicly by means of a digital audio transmission. Over-the-air broadcasts by terrestrial broadcasters licensed by the FCC do not violate the limited right because there is an express exception for them. Further, there is a statutory license available for transmissions that are not interactive such as typical Web casting. Congress equates interactive transmissions with sales of records and treats them differently from "streaming" and Web casting that are primarily intended for listening. Copyright owners may authorize or forbid interactive transmissions, as they see fit, just as they authorize or forbid duplication and distribution of physical recordings.

So, what about all those pre-1972 recordings? It is tempting to conclude that U.S. sound recordings fixed before 1972 must be in the public domain since they are not protected by federal law, but that's not quite true. Pre-1972 recordings are protected by state statutes and common law copyright, misappropriation, and unfair competition laws until 2067 (95 years after the date on which recordings first received federal protection in 1972). I researched Texas's common law of copyright. What little law we had addressed the right of first publication and was superceded by federal law in 1978, the year we moved from the old dual system of common law copyright for unpublished works and federal statutory copyright for published works to a unitary system where federal law protects all works from the moment of their fixation in a tangible medium. Some states have more elaborate statutory and common law. New York, home of the publishing industry, has many cases that discuss the subject. While it is beyond the scope of this short overview to delve into the laws of all 50 states, we can note that for the most part, state laws today protect the owners of properties not protected by federal law from misappropriation and unfair competition. The hallmarks of a claim under state law are bad faith, fraud, or

misappropriation coupled with copying and distributing someone else's property. Usually, a directly competitive relationship between the owner and the user is required. Mere duplication alone is not likely actionable.

Foreign Recordings Protected by Federal Law and Possibly State Law. Foreign recordings are protected in a different manner. Until 1996, pre-1972 recordings created and published in foreign countries were ineligible for protection in the U.S., just like their U.S. counterparts. Today, a foreign sound recording *not in the public domain in the country of its origin on January 1, 1996*, when the Uruguay Round Agreements Act (URAA) of the General Agreement on Tariffs and Trade (GATT) went into effect, *and*

- first published before 1972
- in an eligible foreign country (one of the signatories to the Berne Convention or WIPO Copyright Treaty, a member of the WTO, or an adherent to the WIPO Performances and Phonograms Treaty),
- with at least one author or rights holder being a national of or domiciled in an eligible country,
- and not published here within 30 days of the foreign publication,

is protected in the U.S. for the full term of protection it would have had if published here as a book or image or other work comprising protectable subject matter under federal law—95 years from the date of publication. The URAA “restored” the foreign work’s copyright in the United States.

Here are two examples that illustrate how this works: *If a composition were created in 1920 and performed and recorded in London in 1935, the recording would be protected by U.K. law (Copyright Act of 1956) for 50 years from the end of the year in which it was first published, that is, until the end of 1985. So, on January 1, 1996, when URAA went into effect in the U.S., that recording was in the public domain in the U.K. and **would not** be eligible for restoration in the U.S.*

*Another composition created in 1920 and recorded in London in 1947 **would** qualify for restoration because the recording would still have been under U.K. protection on January 1, 1996 when URAA went into effect. It would be protected for 95 years from its date of first publication, or until the end of 2042, even though in the U.K., it would have become public domain in 1997.*

A pre-1972 foreign work that does not qualify for restoration might possibly be protected by state common law in the U.S., but courts should be reluctant to use state law to protect a work whose copyright has expired. See, for example, *Capitol Records, Inc. v. Naxos of America, Inc.*, 2003 WL 21032009 (S.D.N.Y.) and a recent Supreme Court case in which the Court came down strongly against the use of trademark law to protect a copyrighted work in the public domain, *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 123 S.Ct. 2041 (June 2, 2003).

The URAA was challenged as unconstitutional in *Golan v. Ashcroft*; the case was stayed pending a decision in another case that dealt with an overlapping issue (*Eldred v. Ashcroft*, 123 S.Ct. 769 (2003)). *Eldred* was decided January 15, 2003; however, there has been no activity on

Golan since that date.

Composition Copyrights. A further complication results from the fact that the composition embodied on a recording is itself protected by copyright, so in some cases, even if a recording is in the public domain, the underlying composition may not be, and vice versa.

THE PUBLIC DOMAIN

So, what may we conclude is in the public domain? Compositions published in 1922 or earlier and performed and recorded (or, in some cases, released) in foreign countries on a date that would result in their being in the public domain on January 1, 1996, in the source country (i.e., during or earlier than 1945 for countries that protect sound recordings for 50 years) are in the public domain, and we should be able to do with them as we wish and permit our patrons to do the same. There may be some question about possible state law claims for unfair competition, but as the *Naxos* and *Dastar* cases suggest, other laws should not be stretched to make the good faith use of public domain materials actionable.

U.S. recordings of public domain compositions (i.e., those published during or before 1922) fixed in a tangible medium before 1972 are protected by state laws, but as noted, state law causes of action center on unfair competition for the most part. That is unlikely to affect archival and research activities. Patrons who would like to commercially exploit such recordings, however, would be well advised to obtain permission from the owners.

There is one other category of works that may be in the public domain: works whose copyrights have been abandoned or waived. Before 1989, when copyright notices were required to claim federal protection, failure to affix the proper notice for publication resulted in the works becoming public domain. U.S. recordings published between 1972 and 1989 may be in the public domain if they were published or otherwise widely distributed without the proper notice. Also, works published between 1923 and 1964 had to be renewed at the end of their 28-year terms. If the copyright owners failed to renew the copyrights, those works would now be in the public domain. By some estimates, as many as 95% of copyright owners did not renew their copyrights.

OUR ARCHIVAL RIGHTS UNDER THE COPYRIGHT ACT

Section 108. Libraries have rights to archive and distribute works that are protected by the law, but when we wish to make and distribute digital archival copies, the rights do not extend much beyond the walls of the physical structures that hold our collections.

Sections 108 (b) and (c) of the Copyright Act provide our basic authority to archive and distribute works. Section 108 (b) applies to unpublished works and section 108 (c) applies to published works. The main differences between the two sections relate to the purposes for which we may make copies and the circumstances that must exist to justify making them.

We may copy unpublished works for preservation and security or for deposit for research use in another public or research library if we currently possess the work in our library. We may copy published works only to replace them if they are damaged, deteriorating, lost, or stolen, or if their format has become obsolete, and only after we have determined after reasonable effort that we cannot obtain an unused replacement at a fair price. One crippling condition applies to both

types of works: digital copies cannot be made available to the public outside the premises of the library.

Section 108 (h) provides libraries and archives with special rights during the last 20 years of a work's copyright term. If a published work is not being commercially exploited, a copy cannot be obtained at a reasonable price, or the copyright owner has not notified the Copyright Office that the work is being commercially exploited or copies are available at reasonable prices, the library may make digital copies for preservation, perform them publicly, and distribute them to the public for scholarship or research.

The language of 108 (h) is very generous, giving libraries rights to copy, perform, display, and distribute publicly even digital copies of published works in their last 20 years of protection. However, section 108 (i) says that the rights of reproduction and distribution contained in 108 do not apply to musical works except for preservation. This creates a conflict: 108 (h) says we can copy, distribute, display, and perform published works publicly, and music is clearly "performed," but 108 (i) says that 108 (h) does not apply to music (by failing to include 108 (h) in its exceptions). Frankly, I think this is just sloppy drafting. Even assuming it does apply, section 108 only covers published compositions in their last 20 years of protection and U.S. recordings published before 1972 that are not protected by federal copyright law. So, libraries can (arguably) archive digitally and distribute publicly for scholarship and research pre-1972 U.S. recordings of compositions that were published between 1923 and 1927, inclusive. Next year, the eligible dates will be from 1923 through 1928, and so on, each year adding another year's worth of works to the list.

Notice how the beginning date of 1923 stays the same; this results from the addition in 1998 of an additional 20 years of protection to all works then under copyright (the Sonny Bono Copyright Term Extension Act). Works published in 1923 that would have gone into the public domain in 1998 did not lose their protection, and for the following 19 years, no works will enter the public domain in the U.S. Thus, the next time a U.S. work will enter the public domain will be at the end of the year 2018, when protection for the works published in 1923 will finally expire—unless, of course, Congress passes another extension, which the Supreme Court, in *Eldred v. Ashcroft* cited above, has indicated it is free to do.

The only foreign restored works to which this "last 20 year" provision would apply would be those from countries, if any, whose laws protected recordings for 68 years or longer in 1996. A recording that was published in 1928 in a country with a 68-year term would still have been protected in 1996 in the source country and would have then been eligible for restoration. The restored term of protection in the U.S. would end in $(28 + 95 =)$ 2023. Such a work would be in its last 20 years starting in 2003. Next year, works published in 1929 in that country would enter their last 20 years of protection.

I am not sure that there are countries that protect recordings for 68 years or longer, however, because Article 18 of the Berne Convention requires that member countries provide a 50-year term of protection to pre-existing works originating in another WTO member country if those works have not already enjoyed a full term of protection in both countries. So the norm is 50-year terms, not 68 or 70-year terms. A work from such a 50-year term country would have to have been published no earlier than 1946 to be still under protection on January 1, 1996 when

URAA went into effect. A work published in 1946 would enjoy a 95-year term (46 + 95 = 2041) in the U.S. Its last 20 years of protection will not begin until 2021.

Because recordings embody at least two copyrights, the composition copyright and the recording copyright, those protected by U.S. federal law (foreign restored works and U.S. recordings published after 1972) would arguably require that both copyrights be in their last 20 years to qualify for digital distribution pursuant to section 108 (h). This point has never been raised, to my knowledge, so there is no legal guidance.

Fair Use and Other Exemptions. In addition to libraries' rights to archive works, libraries enjoy fair use rights as well. Section 108 specifically states that nothing in that section affects the rights of fair use, so it is reasonable to assume that fair uses may be made even of digital archival materials that would otherwise be restricted to the premises. For example, digitized archival materials may be put on electronic reserves, incorporated into class projects by faculty and students, and performed in the classroom and in distance education in accordance with fair use.

PROMOTING OUR PATRONS' USES

Generally. Although the law gives us reasonable rights to create archives, what we can do with them, and more particularly, what our patrons can do with them, is tightly constrained by copyright. In particular, the restriction to building-only use for digital archival copies of analog works tremendously limits the research value of digital archives, to say nothing of their value to the public. We are fast approaching a time when for many people, what you can't find on Google does not exist.

This unhappy circumstance suggests first that we should proactively manage our collections and copyrights to facilitate patrons' uses. Even though we may not be authorized to distribute a work digitally, we can make use of public Web sites as well as the more typical proprietary indexing and finding aids to make our holdings known to the public. Without being overly aggressive, we certainly can try to negotiate the widest scope of rights in materials we acquire from a rights holder, most importantly, the right to provide digital access to researchers at a minimum, and ideally, to the public. We can update our acquisition forms to encourage broad grants of rights to access and use. We should revisit collection restrictions periodically to encourage that they be lifted. We should not only obtain, but try to maintain accurate contact information for copyright owners when we acquire materials without rights so that we can facilitate the permissions process; alternatively, we might maintain specialized resources to help patrons locate and contact copyright owners. We may even try to acquire more general rights from a rights holder in connection with a specific patron request. We might create materials that can be used to educate researchers about the issues of rights when they are involved in the creation of recordings and forms they can use to clear rights expeditiously. Anthony Seeger speaks more extensively to these issues in "Rights Management—Intellectual Property and Audiovisual Archives and Collections" at <www.clir.org/pubs/reports/pub96/rights.html>.

Lobbying for Changes in the Law to Promote Access. Ultimately, we must bring the issue of greater access to digital archives to Congress. The changes made in section 108 in 1998 were intended to address serious problems—the complete lack of a digital archival right and the effect on research and scholarship of a new 20-year extension of the copyright term—but they

addressed these problems in a way that only opened the door a crack. Copyright owners' fears that wide access to digital copies in libraries would undermine sales of the owners' works prevented adoption of any but the most restrictive provisions. But today, the National Recording Preservation Board has a mandate from Congress to study laws that must be changed to make preserved recordings available digitally, 2 USC 1724 (b)(4). Sections 108 (b) and (c) must be at the top of their list. If they are not, the board needs to hear from librarians and archivists about the need for changes in this law.

SUMMARY

In response to a request from Ann Blonston, via e-mail before the conference, I offer as a summary this checklist of procedures to assess the extent of the rights you have to digitize the audio recordings in your collections and make them available to researchers or the public:

1. Determine whether the **recording and underlying composition** are in the **public domain** or protected only by state unfair competition and similar laws.

a. Composition published before 1923; recording created and published in a foreign country on a date that would result in its being in the public domain in the foreign country in 1996. For countries with a 50-year term of protection for recordings, the date would be during or before 1945.

b. Composition published before 1923; recording created or published in the U.S. before 1972: **note:** archival uses are very unlikely to be actionable under state law; patron commercial uses probably need permission from recording copyright holder.

c. Compositions published between 1923 and 1964 in the U.S. whose copyrights were not renewed and compositions published between 1923 and 1989 whose copyrights were abandoned by failure to follow formalities; recordings created and published in the U.S. before 1972 (see note above at 1b).

2. If the composition is still protected in the U.S., **digitize and archive recordings in accordance with sections 108 (b) or (c)** depending on whether the composition at issue is unpublished or published, respectively. Digital copies of analog works cannot be made available to the public outside the premises of the library or archive.

3. If the composition is in its **last 20 years of protection** (i.e., published between 1923 and 1927 inclusive), and the recording is pre-1972, digitize and archive U.S. recordings in accordance with § 108 (h) (see note above at 1b).

a. Determine that the work is not enjoying normal commercial exploitation.

b. Distribute it for research and scholarship with no limitation to the premises.

c. For commercial uses see note above at 1b.

4. For proposed uses that exceed the limits imposed by section 108, consider whether **fair use** or another exception (TEACH Act, for example) may apply.

5. If no exception covers a proposed use of a protected work, it requires the **permission** of the owner of copyright in the recording and its underlying composition.

6. If you find that many uses you or your patrons would like to make of your collection fall outside the scope of statutory authorizations, consider more **aggressive rights management** strategies to secure broader rights for public use when possible, **and legislative initiatives** to broaden the scope of current authorizations.

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