

Circular 38b

Highlights of Copyright Amendments Contained in the Uruguay Round Agreements Act (URAA)

WHAT IS THE URAA?

On December 8, 1994, President Clinton signed the “Uruguay Round Agreements Act” (URAA). The URAA implements the Uruguay Round General Agreement on Tariffs and Trade (GATT), which includes an agreement on the Trade-Related Aspects of Intellectual Property (TRIPS). Several provisions of the URAA amend the U.S. copyright law at 17 U.S.C. 104A, 109 (b). The URAA also adds a new Chapter 11 to title 17 and a new section 2319A to title 18.¹

U.S. LAW AMENDED

The URAA amends U.S. law in several ways.

- 1 It amends the computer program rental provision found in section 109(b) of the Copyright Act by eliminating the expiration or “sunset date,” so that copyright owners of computer programs will continue to enjoy an exclusive rental right.
- 1 It amends both the Copyright Act and title 18 of the U.S. Code to create civil and criminal remedies for “bootlegging” sound recordings of live musical performance and music videos. These new remedies are in addition to any remedies that exist under the laws of the various states.
- 1 Finally, it amends section 104A of the Copyright Act to provide for the automatic restoration of copyright in certain foreign works that are in the public domain² in the United States but are protected by copyright or neighboring rights in the source country. The effective date for restoration of copyright for works from countries that are currently eligible is January 1, 1996. This circular explains this amendment to the law in considerable detail.

The URAA also gives the Copyright Office several responsibilities related to restoration and registration of those works.³

¹ Pub. L. No. 103-465, 108 Stat. 4809; House Document 103-316, 103d Congress, 2d Session, September 27, 1994. See also the Statement of Administrative Action *id.* 656, 981.

² Sound recordings fixed before February 15, 1972, would not be in the public domain; they were protected by state, not federal, copyright law.

RESTORATION OF COPYRIGHTS OF ELIGIBLE WORKS

Ownership of Restored Copyright

A restored copyright vests initially in the author or initial rightholder, 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 for Restoration

Copyright in eligible works was restored January 1, 1996. To be eligible, the work must meet all 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 country. An eligible country is a country, other than the United States, that is a member of the Berne Convention for the Protection of Literary and Artistic Works (Berne Convention), is a member of the World Trade Organization (WTO), or is subject to a presidential proclamation that extends restored copyright protection to that country on the basis of reciprocal treatment to the works of U.S. nationals or domiciliaries;
2. The work is not in the public domain in its source country through expiration of the term of protection;
3. The work is in the public domain in the United States because the work did not comply with formalities imposed at any time by the U.S. law,⁴ the work lacked subject matter protection in the United States in the case of sound recordings fixed before February 15, 1972, or the work lacked national eligibility in the United States; and
4. If published, the work must have first been published in an eligible country and must not have been published in the United States during the 30-day period following its first publication in that eligible country.

³ The Copyright Office has issued final regulations governing its administration of restoration of copyrights under the URAA, including the filing of NIEs and registration of copyright claims in restored works by amending section 201.31 of 37 CFR and by adding new sections 201.33 and 202.12 to implement the URAA (60 FR 50414).

⁴ The work could be in the public domain because the copyright owner failed to comply with one or more of the formalities required by U.S. copyright law, for instance by publishing the work without a proper copyright notice, failing to renew the copyright, or by failing to comply with the manufacturing clause or *ad interim* provisions of the copyright law.

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:

- 1 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).
- 1 A Chinese play from 1983 will be protected until December 31 of the seventieth year after the year in which its author dies.
- 1 A Mexican sound recording first published in Mexico in 1965 will be protected until December 21, 2060.

For further information concerning the length of copyright protection in the United States, request Circular 15a, "Duration of Copyright."

RESTORATION IS AUTOMATIC

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 (NIE)

Notification of Reliance Parties

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 already using the work prior to the date of enactment of the URAA on December 8, 1994.⁵

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

- 1 to provide actual notice by notifying a reliance party directly, or
- 1 to provide constructive notice through the filing of a

Notice of Intent to Enforce (NIE) a Restored Copyright 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 where NIEs have been filed with the Office. For inspection and copying by the public, the Copyright Office maintains a list identifying all NIEs.

Date to File NIEs

Eligibility on January 1, 1996. The owner of a restored work may file an NIE directly with a reliance party at any time after the date of restoration. If the owner wished to file an NIE with the Copyright Office, the owner of a work whose source country as of January 1, 1996, was a member of the Berne Convention or the WTO must have filed an NIE for that work between January 1, 1996, and December 31, 1997.⁶ The Office published the first listing of NIEs on May 1, 1996 (61 FR 19371), and published lists at regular 4-month intervals for the next 2 years. All are available on the Copyright Office Website at www.loc.gov/copyright.

Eligibility after January 1, 1996. When a country becomes eligible as a source country after January 1, 1996, owners of restored works from such a country will have a 2-year period from the date of eligibility for filing NIEs with the Copyright Office.

Grace Period for Use of Restored Work After Notification

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

⁵ This is true for the great majority of works. However, for works from any country which was not eligible under the URAA as of December 8, 1994, reliance parties would be those using the work before the date on which that country becomes an eligible country by joining Berne or the WTO or as a result of a Presidential proclamation.

⁶ Although a country may become a source country through a presidential proclamation, only one such proclamation has been issued as of June 2000. That proclamation had to do with Vietnam.

Copyright Act contains special rules with respect to certain derivative works created before December 8, 1994, based on underlying restored works, such as the translation of a restored work or a motion picture based on a restored book or a play. Such derivative works may continue to be exploited by a reliance party, if the reliance party pays the owner of the restored copyright reasonable compensation.

FILING AN NIE IN THE 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 for Filing an NIE

The Copyright Office does not provide a form for filing an NIE, however, the attachment to this circular and the regulations published in the *Federal Register* and the *Code of Federal Regulations* contain a format that may be used to file notices. This format also may be downloaded from the Internet at www.loc.gov/copyright.

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 8 1/2 X 11-inch (or 210 x 297-mm, A4) white paper with a 1-inch (or 3-cm) margin.

Content of Notice of Intent to Enforce.

The URAA specifies the minimum content of an NIE. It requires that the notice be signed by the owner or the owner's agent. In addition to the signature, it must contain the title, or a brief description if 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 may 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 (painting, sculpture, music, motion picture, sound recording, book, etc.)
2. name of author(s)
3. source country
4. approximate year of first publication
5. additional identifying information (e.g., 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 (e.g., the right to reproduce/distribute/publicly display/publicly perform the work, or to prepare a derivative work based on the work)
7. telefax number at which the owner, exclusive rights holder, or agent can be reached

Multiple Works

Multiple works may be included on a single NIE provided that: 1) each work is identified by title, or a brief description if untitled; 2) all the works have the same author; 3) all the works are owned by the same copyright owner or the owner of the exclusive rights therein; and 4) 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 certification statement is found on the sample format.

Fee

The fee for filing an NIE is \$30 for a notice covering one work. For a notice covering multiple works, the fee is \$30, plus \$1 for each additional work covered beyond the first work. (For example, the fee for an NIE covering three works would be \$32.) The fee includes the cost of an acknowledgement of recordation, which will be mailed to the filer after the Copyright Office records the NIE. The fee is not refundable.

The fee may be paid by any of the following methods:

1. **Checks, money orders, or bank drafts made payable to the Register of Copyrights.** Remittances must be redeemable without service or exchange fees through a U.S. institution, must be payable in U.S. dollars, and must be imprinted with American Banking Association routing numbers. Currency, international money orders, and postal money orders that are negotiable only at a Post Office are not acceptable.
2. **Copyright Office Deposit Account.** This is an account into which an applicant makes advance payment for use later in paying copyright fees. For information on Deposit Accounts, request Circular 5, "How to Open and Maintain a Deposit Account in the Copyright Office."

3. **Credit cards** (for use only in filings under the URAA). The Copyright Office will accept VISA, MasterCard, and American Express. Debit cards cannot be accepted for payment. To pay by credit card, the filer must provide *in a separate letter* the name of the credit card 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.**

The filer of an NIE must ensure that sufficient funds accompany the NIE or are available in a deposit account. Insufficient fees could delay the effective date of notice.

Address

Send NIEs to the following address:

GC/I&R
P.O. Box 70400, Southwest Station
Washington, D.C. 20024
U.S.A.

Do **not** mail to the Copyright Office.

Serving Notice Directly on a Reliance Party

The Copyright Office does not provide a form for use in serving an NIE directly on a reliance party. Those parties choosing to serve a Notice of Intent to Enforce a Restored Copyright on the reliance party should note that the URAA requires additional information. Therefore, if they use the Copyright Office's NIE format as a guide for the actual notice, it will be incomplete unless the additional information specified is added. The URAA specifications follow, with italic type added to show additional requirements for actual notice:

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.

104A(e)(2)(B) of the URAA. Actual notice may be served on a reliance party at any time after copyright in the work is restored.

REGISTRATION OF CLAIMS TO COPYRIGHT IN RESTORED WORKS

The URAA directs the Copyright Office to provide procedures for registration of claims to copyright; however, copyright owners of restored works need not register their works. Although the 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,⁷ the owner of rights in a Berne work does not have to register before initiating a copyright infringement suit.

Who May Claim Copyright

A claim in a restored work may 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 other owner of only certain exclusive rights in a work is not permitted to register a claim in a restored work in his or her name.

How to Obtain GATT Registration Forms

Special GATT registration forms must be used for registration of works restored under the URAA. Use Form GATT for claims to copyright in individual restored works and restored works published under a single series title. Use Form GATT/GRP for registration on a single form of groups of related restored works.

There are several ways to obtain forms.

- 1 Request a limited number of free application forms by writing to:
Library of Congress
Copyright Office
Publications Section, LM-455
101 Independence Avenue, S.E.
Washington, D.C. 20559-6000
- 1 Call the Forms and Publications Hotline at (202) 707-9100 at any time and leave a recorded message.
- 1 Download forms from the Copyright Office Website at www.loc.gov/copyright/forms. Forms should be printed head-to-head on a single piece of 8 1/2-inch by 11-inch white paper so that when you turn the paper over, the top of page 2 is directly behind the top of page 1. The Copyright Office requires downloaded applications on a single sheet of paper. Therefore, you should consider reinserting the first page back into the printer so that the back page will be printed onto it.

⁷The question of whether a work from a country that is a member of WTO but not Berne must be registered was not specifically addressed in the legislation, but one can only 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 can initiate a suit.

- 1 Fill in the forms on the Copyright Office Website. Go to www.loc.gov/copyright/forms/ and follow the instructions. The fill-in forms allow you to enter information while the form is displayed on the screen by an Adobe Acrobat Reader product. You may then print the completed form and mail it to the Copyright Office. Fill-in forms provide a clean, sharp printout for your records and for filing with the Copyright Office.
- 1 Photocopy forms legibly on a single sheet of good quality 8 1/2-inch by 11-inch white paper following the instructions for downloaded forms.

GATT Group Registration Requirements

A group of between 2 and 10 related works may be registered on the Form GATT/GRP, provided the following conditions are met: the author is the same for all works in the group; the owner of all U.S. rights is the same for all works in the group (however, the author and owner need not be the same party); all works have been first published in the same calendar year; and all works fit within the same subject matter category, for example, literary works, musical works, motion pictures, etc. Applicants registering a group of related works must file for registration on Form GATT/GRP.

Publication

When determining publication information regarding restored works for which registration is sought, the following guidelines are offered:

- **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 of itself constitute publication. (17 U.S.C. 101)
- **For works published before January 1, 1978:** 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 the public distribution of one or more copies or sound recordings without express or implied restrictions as to future use. Recordings of musical compositions were not considered copies of the recorded music before January 1, 1978. A distribution of a recording before that date would publish the sound recording but not the music contained on the recording.

Registration Instructions

Instructions for completing the application forms and information on deposit preferences are included on the forms

supplied by the Copyright Office. Applications, deposit copies, and fees should be submitted in **one** package.

Registration Fees

For an individual work, the basic registration fee is \$30* per work. This \$30* fee is also applicable to a series of works published during a calendar year under a single title in episodes, installments, or issues.

The fee for a group registration of 2 to 10 related works is \$10* per individual work, with a minimum fee of \$30*. For example, four works submitted on Form GATT/GRP would cost \$40*. The methods of payment for registration fees are the same as those for NIEs (see page 4).

*** 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

Applications to register restored works should be sent to the following address:

Library of Congress
 Copyright Office
 101 Independence Avenue, S.E.
 Washington, D.C. 20559-6000
 U.S.A.

PUBLIC ACCESS TO NIE INFORMATION AND COPYRIGHT OFFICE REGISTRATIONS

Public Access

The information contained in NIEs filed with the Copyright Office and in copyright registrations and related documents catalogued since January 1, 1978, to the present is open to the public for searching. These records are available through the Library of Congress Information System (LOCIS), which may be accessed at terminals in the Library of Congress or via the Internet. In addition, upon request, the Copyright Office will search its files for a fee.

LOCIS contains several different Library of Congress files. NIE information is available in the online file known as COHD (Copyright Office History Documents). Information includes: the title or brief description if untitled; an English translation of the title; the alternative titles if any; the name of the copyright owner or 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 in the *Federal Register*; the rights covered by the notice (if given); and the address, telephone, and telefax number (if given) of the copyright owner.

Online records of NIEs are searchable by the title of the work, the copyright owner or owner of an exclusive right, and the author.

Registration information is available in the following LOCIS files: COHM, which contains all original and renewal registrations except serials; COHD, which contains documents; and COHS, which contains serials.

To search the files via the Internet, connect to the Copyright Office homepage on the World Wide Web at www.loc.gov/copyright. LOCIS is available 24 hours a day except from 5:00 p.m. Saturday to noon Sunday, eastern time except federal holidays. The Library of Congress and the Copyright Office do not charge fees to connect to their Internet resources.

Office Searches

The Copyright Office is located in the Library of Congress, James Madison Memorial Building, 101 Independence Avenue, S.E., Washington, D.C. The public records of Notices of Intent to Enforce may be searched by the public Monday through Friday, 8:30 a.m. to 5:00 p.m., eastern time, except federal holidays. Public terminals are located in the Copyright Office and in the reading rooms of the Library of Congress.

Upon request, the Copyright Office staff will search the records at the rate of \$75 for each hour or fraction thereof and furnish a written report. For further information, request Circular 22, "How to Investigate the Copyright Status of a Work," or contact:

Library of Congress
Copyright Office
Reference and Bibliography Section, Room LM-451
101 Independence Avenue, S.E.
Washington, D.C. 20559-6000
U.S.A.

Tel: (202) 707-6850

Fax: (202) 707-6859

RELATIONSHIP TO NAFTA

Under the NAFTA Implementation Act,⁸ a number of Mexican motion picture owners timely filed a Statement of Intent to Restore with the Copyright Office.⁹ These works will continue to enjoy copyright protection, but such protection will be governed by the new section 104A substituted by the URAA.

⁸P.L. 103-182, 107 Stat. 2057.

⁹ See 60 Fed. Reg. 8252 (Feb. 13, 1995) for a list of these works.

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 new section 104A. NAFTA works that have not been registered may be registered using the URAA registration procedures, including GATT forms and deposit preferences.

FOR FURTHER INFORMATION

Information via the Internet: Circulars, announcements, regulations, other related materials, and all copyright application forms are available on the Copyright Office homepage at www.loc.gov/copyright

Information by fax: Circulars and other information (but not application forms) are available by using a touchtone phone to access Fax-on-Demand at **(202) 707-2600**.

Information by telephone: For general information about copyright, call the Copyright Public Information Office at **(202) 707-3000**. The TTY number is **(202) 707-6737**. Information specialists are on duty from 8:30 a.m. to 5:00 p.m., eastern time, Monday through Friday, except federal holidays. Recorded information is available 24 hours a day. Or, if you know which application forms and circulars you want, request them from the Forms and Publications Hotline at **(202) 707-9100** 24 hours a day. Leave a recorded message.

Information by regular mail: Write to:
Library of Congress
Copyright Office
Publications Section, LM-455
101 Independence Avenue, S.E.
Washington, D.C. 20559-6000

- ATTACHMENT -

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

1. Title: _____
(If this work does not have a title, state "No title.")

OR

Brief description of work (for untitled works only): _____

2. English translation of title (if applicable): _____

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 may 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 may 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 8 1/2 x 11-inch, (or 210 x 297-mm, A4) white paper of good quality, with at least a 1-inch (or 3-cm) margin.