

Published in: *Entertainment and Sports Lawyer*, vol. 18 (no. 2) (2000), p. 7.
[Page breaks in the published text are shown in brackets below.
Notes, which appeared as endnotes, are set out below as footnotes.]
For updated analysis, see *International Copyright: The Introduction*,
§§ 4[3] through 5[3], at <http://www.internationalcopyrightguide.com/>.

Zombie and Once-Dead Works: Copyright Retroactivity After the E.C. Term Directive

PAUL EDWARD GELLER*

Suppose that you have a work authored by a national from one country. Will it be protected by copyright in other countries? As works get older, this question becomes more difficult to answer. A related pair of issues complicate analysis:¹ retroactivity and the rule of the shorter term.

This article will consider these issues from the point of view of the European market, where terms of rights have been made longer. Clients with interests in works or recordings with longer rights may be able to make more money in European markets. By contrast, if clients want to use an old work in these markets, for example, an old novel as the basis for a new film, they had better double-check to see that the work has not come out of public-domain graves in the European Community.²

Why the longer terms? Because of an E.C. directive. Such a directive is an order requiring E.C. countries to bring their laws into compliance with its provisions. In the fall of 1993, the E.C. adopted the Term Directive harmonizing the term of copyright and related

* Paul Geller is the General Editor of *International Copyright Law and Practice* published by Matthew Bender, teaches international intellectual property at the University of Southern California Law School, and serves as expert counsel in his field. For further information, see <http://www.pgeller.com>. © Paul Edward Geller 2000

¹ For a framework of analysis, see Paul Edward Geller, *International Copyright: An Introduction* §§ 3-5, in 1 INTERNATIONAL COPYRIGHT LAW AND PRACTICE (Paul Edward Geller & Melville B. Nimmer eds., 1999) [hereinafter INTERNAT'L COPR. LAW & PRACTICE].

² For the sake of simplicity, this article will speak of the European Community [hereinafter the E.C.], not of the European Union [E.U.]. Note, too, that many conclusions applicable throughout the E.C. might apply as well in the European Economic Area [E.E.A.], which includes all the E.C. countries plus Iceland, Liechtenstein, and Norway.

rights.³ Against the deadline of mid-1995, E.C. countries enacted legislation to implement the Term Directive. Article 1 of this Term Directive required E.C. countries to extend the normal copyright term of life plus 50 years to life plus 70 years; article 3 also required that related or neighboring rights normally last 50 years. What is the difference between copyright and neighboring rights? In the European view, copyright only protects creative works; neighboring rights protect other media productions such as performances, recordings, and broadcasts, even without creative input or an underlying protected work. For example, they protect a performance and recording of, say, a Mozart symphony or a blues tune in the public domain.

Other provisions in the Term Directive govern special terms, dates from which terms are counted, and consequences for preexisting subject matters. It is this last set of provisions, the so-called transitional provisions, that prompt the following analysis, and they have had extraordinary consequences. As of the deadline of mid-1995, article 10 of the Term Directive was retroactively to bring protection to many works and media productions that either apparently or effectively had fallen into the public domain. Why apparently or effectively? It depends on whether the works or the media productions were either zombies or truly dead in any given country. It is critical to analyze the life-or-death status of a work or other media production territory by territory. It is also useful to keep basic rules of international copyright in mind.

This article will consider three examples. First, the opera *Tosca* by the Italian composer Puccini was a zombie work in Germany in that it seemed to have fallen into the public domain in Germany. Second, *Broadway Boogie-Woogie*, painted by the Dutch artist Mondrian when he was in New York, was truly dead in Mondrian's home country, the Netherlands, where it had indeed fallen into the public domain. Third, *My Way* was a compilation of Sinatra recordings, many of which had fallen into the public domain in Germany.

A Zombie Work: *Tosca*

About half of this article will be spent on *Tosca*, the first example. It is helpful to understand zombie works before considering how the Term Directive brought truly dead works and other media productions back to life in E.C. countries. *Tosca* will illustrate two basic rules: the default rule of international copyright, namely no retroactivity at all; and the Berne rule, retroactivity subject to the rule of the shorter term. After that, it will become easier to understand how, quite exceptionally, *Tosca* became a zombie work in Germany.

³ Council Directive 93/98/EEC of 29 October 1993 harmonizing the term of copyright and certain related rights, 1993 O.J. (L 290/9) [hereinafter Term Directive]. [See also Directive 2011/77/EU of 27 September 2011 amending Directive 2006/116/EC on the term of protection of copyright and certain related rights, 2011 O.J. (L 265) (extending the term of rights in phonograms)].

Tosca had been first published in sheet music at the start of 1900. But the evidence showed that such publication took place in Italy in the middle of January 1900 and in Germany at the end of that month. The Berne minimum term of life plus 50 years became effective in most of Europe as the 20th century progressed. Puccini, the composer of *Tosca*, died in 1924, so that the Berne Convention ultimately required protection until at least the end of 1974. In some countries, this term was lengthened by wartime extensions, for example, six years in Italy.⁴ Then Germany, in its 1965 Copyright Act, extended the copyright term to life plus 70 years.⁵ This term provided the model that the E.C. Term Directive later followed for all E.C. copyright terms. [**> p. 8**]

The Italian music publisher, along with other claimants to *Tosca*, sued the Bavarian State Opera in Munich with regard to royalties for performing *Tosca* beyond 1980. They claimed to benefit from the full German term of life plus 70 years instituted on January 1, 1966. On that premise, and given Puccini's death in 1924, the claimants would benefit from copyright in Germany until the end of 1994. Note that Germany, France, and most European and other civil-law countries approach treaties differently from Scandinavian countries and British jurisdictions. In most civil-law countries, a foreign claimant may seek protection directly under a national statute or, in the alternative, directly under a treaty such as the Berne Convention. There were then two alternative grounds for this claim in *Tosca*: one lay in the 1965 German Copyright Act; the other, in the Berne Convention.

The *Tosca* claimants invoked section 121(1) in the 1965 German Copyright Act, which protects all works published within 30 days in Germany after first publication elsewhere. Rejecting this argument, the German Federal Court of Justice instead applied the default rule of international copyright: absent any provision to the contrary, copyright provisions and terms do not apply retroactively at all. As the court in the *Tosca* case stated, reliance constitutes the chief rationale for rejecting retroactivity and for applying the default rule: "Such retroactivity also raises doubts from the point of view of the interests of domestic exploiters of foreign works. They ought to be able to rely on the general principle that protection hitherto unavailable according to national law will not find grounds in a later enactment."⁶ As a result, the 30-day grace period effective at the start of 1966 was not applied to publication transactions that dated back to the very start of 1900. As already noted, the evidence displayed a gap of half a month between the first publication of *Tosca* in

⁴ See Mario Fabiani, *Italy* §§ 3[2][b], 3[3][b], in 2 INTERNAT'L COPR. LAW & PRACTICE, *supra* note 1.

⁵ See Adolf Dietz, *Germany* § 3[1], in 2 INTERNAT'L COPR. LAW & PRACTICE, *supra* note 1.

⁶ The *Puccini* decision, BGH (Federal Court of Justice), July 1, 1985, 1986 GEWERBLICHER RECHTSSCHUTZ UND URHEBERRECHT — INTERNATIONALER TEIL [GRUR INT.] 802, at 803.

Italy and its publication in Germany. Thus the 1965 German Copyright Act could not apply directly to *Tosca* by virtue of requisite "first publication" in Germany.

The alternative ground for protecting *Tosca* seemed to lie in the Berne Convention. Let us digress here on Berne retroactivity a moment. Article 18 of the Berne Convention changes the default rule on retroactivity only partially.⁷ Berne may override the loss of protection that takes place for distinct reasons, such as the failure to satisfy formalities or the lack of a prior treaty basis of protection. As an example of the first reason, we have the United States: we had to restore copyright in Berne works that had fallen into our public domain for failure to comply with our formalities of publication with notice or of renewal.⁸ As an example of the second reason, consider China, which had no copyright treaties with most countries before the People's Republic of China acceded to the Berne Convention in 1992. At that point, both China and these other Berne countries had to protect each others' works retroactively, even if they had not protected them before, albeit subject to some conditions.⁹ To describe these conditions, we might metaphorically say that a work passes through the Berne window, achieving retroactive protection, if copyright had not expired in either the country where protection is claimed or the country of origin, at the time either became a Berne member. To complete the metaphor, we should add that there is also a screen on this window: countries may qualify Berne retroactivity, for example, to accommodate pre-Berne reliance interests.¹⁰

However, under the Berne Convention, the Berne rule of the shorter term may apply to works of foreign origin. This rule allows a Berne country to cut off protection of a foreign Berne work at the end of the shorter of two so-called measuring terms: either that applicable in the country where protection is claimed, Germany in the *Tosca* case, or that applicable in the country of origin, Italy if *Tosca* was "first" published there.¹¹ Applying the same reasoning as it did to the 1965 German provision on first publication, the German Federal

⁷ Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, as last revised at Paris, July 24, 1971, art. 18, 828 U.N.T.S. 221 [hereinafter Berne Convention]. *See also* Agreement on Trade-Related Aspects of Intellectual Property Rights, including Trade in Counterfeit Goods (TRIPs), April 15, 1994, art. 14(6), *in* Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, LEGAL INSTRUMENTS — RESULTS OF THE URUGUAY ROUND vol. 31, 33 I.L.M. 81 (1994) (applying Berne retroactivity to neighboring rights).

⁸ 17 U.S.C. § 104A (2000).

⁹ *See* Guo Shoukang, *China* § 6[4][b][iii], *in* 1 INTERNAT'L COPR. LAW & PRACTICE, *supra* note 1.

¹⁰ For further analysis, see Geller, *International Copyright*, *supra* note 1, § 4[3][a].

¹¹ *See* Berne Convention, *supra* note 7, arts. 5(4)(a) and 7(8). On the applicable definitions of "first publication" and "country of origin" and the application of the rule of the shorter term, respectively, see Geller, *International Copyright*, *supra* note 1, §§ 4[2][b][ii], 4[3][b][ii], and 5[2][a].

Court of Justice concluded that the Berne 30-day grace period, established well after the initial publication of *Tosca* at the turn of the century, also did not apply retroactively to this case: on that premise, Italy was the Berne country of origin. Accordingly, the Berne rule of the shorter term would allow the German term of life plus 70 years to be cut back to the shorter copyright term applicable in Italy, namely life plus 50 years, plus a wartime extension of six years. As a result, the German Federal Court of Justice felt justified in dropping *Tosca* into the German public domain 56 years after Puccini died, that is, by the end of 1980. But the German Federal Court of Justice was wrong in even applying the Berne rule of the shorter term to *Tosca*. As we shall soon see, copyright in *Tosca* continued [**> p. 9**] in Germany pursuant to E.C. law. *Tosca* had only been buried alive in the German public domain. How then did it, zombie-like, arise out of this grave?

Here we have to refer to the *Phil Collins* case. Phil Collins had given a performance in the United States. This performance had been bootlegged, that is, recorded without consent in the United States, and marketed in an unauthorized recording in Germany. Under Germany statutory law and copyright treaties, German neighboring rights would have protected a live performance, even one taking place in the United States, if it had been given by a German national, but not one by a foreign artist performing in the United States. However, the 1958 Treaty of Rome, founding the European Community, contained a principle in article 7, now article 12, that precludes one E.C. country from discriminating against nationals of another E.C. country. The *Collins* claimants argued that this E.C. principle of nondiscrimination entitled Collins, as a British subject, to the same treatment in Germany as a German performer would receive. His performance, even though it took place in the United States, had to be protected by German neighboring rights just as a German performer's would be. The E.C. Court of Justice agreed in 1993 and held this principle to apply to copyright and all related or neighboring rights generally.¹² This principle has ostensibly bound any country from the moment it joined the E.C. *vis-à-vis* all E.C. claimants.

Because the E.C. principle of nondiscrimination requires full national treatment, it precludes applying the rule of the shorter term, which effectively discriminates on the basis of a claimant's home law. Now both Germany and Italy had entered the E.C. upon its formation in 1958. Germany then had to apply a full German term from that point forward to all works by Italian authors. Thus, with *Tosca* in German copyright indisputably in 1966, when the longer German term of life plus 70 years went into effect, Germany had to accord such copyright with this term to Puccini, as the author of *Tosca*, just as it did to German authors. The German Federal Court of Justice was then wrong in burying *Tosca* alive in the German public domain by refusing it this term. Thus, *Tosca* was a zombie work, buried but in copyright, in Germany through 1994.

¹² Joined Cases C-92/92 and C-326/92, *Phil Collins v. Imtrat Handelsgesellschaft mbH*, 1993 C.M.L.R. 773.

Indeed, since the *Phil Collins* case came down, the German Federal Court of Justice has noted that "for decades, nobody ever thought that it was possible to rely on" this principle, requiring full national treatment for E.C. authors.¹³ The same Court has now raised the question whether damages for infringing such "living-dead" copyrights might not be limited to periods after the time in 1992 when it became arguable that these rights could be "unearthed."¹⁴

A Truly Dead Work: *Broadway Boogie-Woogie*

The *Phil Collins* judgment is critical for understanding how many works and other media productions have come out of their public-domain graves throughout the E.C. Article 10(2) of the E.C. Term Directive provides for this retroactivity, as follows: "The terms of protection provided for in this Directive shall apply to all works and subject matter which are protected in at least one Member State" on July 1, 1995, "pursuant to national provisions on copyright or related rights."¹⁵

Consider, hypothetically, the painting *Broadway Boogie-Woogie*. The Dutch artist Mondrian completed it in the United States not long before he died there in 1944. Copyright expired in this painting in the Netherlands at the end of 1994 when the then-effective Dutch term of life plus 50 years lapsed. However, under the *Phil Collins* judgment, copyright in *Broadway Boogie-Woogie* was still effective in Germany on July 1, 1995, given the German term of life plus 70 years. Upon the implementation of the E.C. Term Directive in the Netherlands and indeed throughout the E.C., copyright in *Broadway Boogie-Woogie* is then revived pursuant to E.C. retroactivity.

To avoid confusion, we have to remember that a work will have its own separate public-domain grave in each country, whether truly dead or buried alive in that grave. In that perspective, reconsider our zombie and truly dead works:

1. In Italy, *Tosca* was out of copyright, truly dead, by the end of 1980, with the lapse of 56 years after Puccini's death. In Germany, it was buried alive until unearthed, so to speak, by the *Phil Collins* decision in 1993, only to fall back dead into its German grave at the end of 1994, 70 years after Puccini's death.

¹³ The *Rolling Stones* decision, BGH (Federal Court of Justice), April 21, 1994, 1995 GRUR INT. 65, *partially translated into English in* 26 INT'L REV. INDUS. PROP. & COPYRIGHT L. [I.I.C.] 730 (1995) *and, as quoted here, in* 165 REV. INT'LE DROIT D'AUTEUR 240, 280 (1995), *with a note by* A. Kéréver.

¹⁴ See the *Bruce Springsteen* decision, BGH (Federal Court of Justice), April 23, 1998, 1999 GRUR INT. 62, *partially translated into English in* 31 I.I.C. 107 (2000).

¹⁵ Term Directive, *supra* note 3, art. 10(2).

2. Shift now to *Broadway Boogie-Woogie*: In the Netherlands, it fell out of copyright, truly dead in a Dutch grave, 50 years after Mondrian's death in 1944, thus at the end of 1994. However, in Germany, it continued in copyright for 70 years after Mondrian's death, until the end of 2014, and this continuing copyright [> p. 10] was confirmed by the *Phil Collins* decision in 1993. Copyright was then revived in the work, with the term of life plus 70 years, as the Term Directive required in other E.C. countries in mid-1995.
3. To complete analysis, go back to *Tosca*: Imagine that Puccini, the author of *Tosca*, died, not in 1924, but 1934, so that the Berne term of life plus 50 years lapsed at the end of 1984 and the Italian term at the end of 1990. Assuming that hypothetical date of death, *Tosca* would fall into the German public domain at the end of 2004 by virtue of the German term of life plus 70 years. On that hypothesis, copyright would then be revived in the other E.C. countries in mid-1995.

Note that it makes no difference at all whether or not *Broadway Boogie-Woogie* was first published in the form of reproductions in the United States, where it was painted. What counts for purposes of copyright revival in this instance is the E.C. author: only such E.C. claimants may invoke the E.C. principle of nondiscrimination, as the *Phil Collins* judgment applied it. Only they may claim copyright for life plus 70 years in Germany through mid-1995 and, therefore, an equivalent term throughout the E.C. after that.

Even works originating in the United States may rise from their graves in Europe with appropriate claimants. Consider, for example, a feature film, first published in the United States, with a creative team consisting of an American screenwriter, soundtrack composer, and cinematographer, but an E.C. national as a director. That director, as one author of a cinematographic work under European law, provides a basis for a *Phil Collins* claim.

Non-E.C. Productions: *My Way*

What about non-E.C. works? To start, they are not necessarily going to benefit from the E.C. term extensions. Article 7 of the E.C. Term Directive mandates E.C. countries to apply the rule of the shorter term. However, consistent with *Phil Collins*, they may not apply the rule to works or other media productions made by E.C. nationals. Nor should they apply the rule to a work with an E.C. country as its country of origin in the Berne sense. But the rule itself is given a slightly more stringent formulation in the E.C. Term Directive than in the Berne Convention. Arguably, a foreign claimant could invoke the Berne formulation if it were more favorable.¹⁶

Furthermore, claims can be made to protect many U.S. works under bilateral treaties in some E.C. countries. In Germany, the case law has held that such a bilateral treaty may

¹⁶ See Geller, *International Copyright*, *supra* note 1, §§ 5[1][c][ii] and 5[2][b][ii].

override the rule of the shorter term.¹⁷ May a fully extended E.C. term then be claimed in countries like Germany, with which the United States has concluded bilateral treaties that included no rule of the shorter term? Article 7(3) of the Term Directive is ambiguous with regard to prior treaty obligations, but an E.C. law may not nullify treaty obligations to non-E.C. countries. Thus, for U.S. works, the argument may be made for full national treatment, that is, the present E.C. term, under an appropriate treaty. This argument, if accepted, could have a significant impact in some cases, for example, cinematographic works in Italy.¹⁸

Turn now to sound recordings that, in most E.C. countries, are protected by neighboring rights. Consider the compilation *My Way, The Best of Frank Sinatra*, consisting of recordings made and published in the United States between 1962 and 1979. These recordings had been protected by German neighboring rights pursuant to the Geneva Phonograms Convention, and one court has held that the German law that implemented the Geneva Convention in 1974¹⁹ accorded full national treatment to such U.S. recordings, even retroactively to recordings made before that date.²⁰ This holding thus precluded application of the rule of the shorter term that Germany had written into its Copyright Act for non-E.C. recordings, effective July 1, 1995, pursuant to the Term Directive.

The *Sinatra* decision goes even further. While the German term of rights in creative works was one of the longest in the E.C. before the Term Directive, generally life plus 70 years, the term of rights in sound recordings was longest in the United Kingdom, namely 50 years from the year of production or release, as compared with 25 years previously in Germany. Now, while most of the Sinatra recordings had fallen into the German public domain by mid-1995 as a result of that shorter [German] term, they were found to be protected in the United Kingdom by the longer term still running in mid-1995. Thus, as *Broadway Boogie Woogie* was resurrected, so were the Sinatra recordings in this case, on **[> p. 11]** the basis of ongoing protection in one E.C. country in mid-1995.²¹

¹⁷ The *Keaton* decision, BGH (Federal Court of Justice), Jan. 27, 1978, 1979 GRUR INT. 50, partially translated into English in 10 I.I.C. 358 (1979). See Wilhelm Nordemann, *The Term of Protection for Works of U.S.-American authors in Germany*, 44 J. COPR. SOC'Y 1 (1996).

¹⁸ See Fabiani, *Italy*, *supra* note 4, §§ 3[1][a] n.9, 3[2][b], 3[3][b].

¹⁹ Law on the Convention of October 29, 1971, for the Protection of Producers of Phonograms against Unauthorized Duplication of their Phonograms, BGBl, Part II, Dec. 10, 1973, p. 1669.

²⁰ The *Frank Sinatra* decision, OLG (Court of Appeal) Hamburg, April 29, 1999, 1999 ZEITSCHRIFT FÜR URHEBER- UND MEDIENRECHT 853, at 856-58.

²¹ See also the *Maria Callas* case (Diva S.r.l. c. Myto Records S.a.s), Tribunal Milan, April 20, 1999, 2000 DIRITTO DI AUTORE 141 (protecting, against unauthorized reproduction, selected passages of live performances by Callas from operas, including *Lucia di Lamermoor*, *Norma*, and *Traviata*, recorded from 1952 through 1956).

It remains to be seen whether, and how, the German Federal Court of Justice might review this *Sinatra* decision. However, since the decision does not regard copyright, but only one type of neighboring right, the appeal might not settle all outstanding issues regarding the interplay between treaty obligations and implementing legislation concerning terms of German rights in non-E.C. works and other media productions.²²

Caveats and Conclusion

In the case of an older work or media production in the E.C., one has to look to the longest applicable term of rights in any one E.C. country prior to the deadline of mid-1995. If that term was still running at that time, then that work or media production qualifies for any longer term of protection instituted under the Term Directive elsewhere in the E.C., assuming the requisite E.C. claimant. We have mentioned both the prior German term of copyright, namely life plus 70 years, and the prior British term of rights in sound recordings, namely 50 years from production or release. But bear in mind the following caveats, which are not exhaustive:

1. *Dates of E.C. adherence.* Consider Spain. Its old 1879 Act provided the copyright term of life plus 80 years. Spain joined the E.C. on January 1, 1986, while this long term was in effect. Then its 1987 Copyright Act superseded the older term with a shorter one, but not for all works.²³ Should the old, longer term count in a *Phil Collins* analysis? It depends on how Spain has had to apply the E.C. principle of nondiscrimination since it joined the E.C.
2. *Wartime extensions of term.* Not all implementing legislation mentions the wartime extensions of term. The Italian legislation abrogated the extension that had added six years to the term of rights in works, like *Tosca*, published before the end of World War II, but it maintained the extension accorded to foreign works under the Treaty of Peace that Italy signed in 1947.²⁴ Where, regrettably, implementing legislation makes no mention of such extensions, arguments can be made for and against the proposition that new terms supersede such extensions as have not yet fully run in some E.C. countries.
3. *Reliance interests.* Article 10(3) of the E.C. Term Directive states that the revival of rights in any work or other media production shall be "without prejudice to any acts of exploitation performed" before July 1, 1995, and leaves it up to each E.C. country to adopt provisions to protect reliance interests, "in particular acquired rights of third parties." These provisions indeed vary from country to country: different laws specify

²² See Dietz, *Germany*, *supra* note 5, § 3[3][c][ii].

²³ See Alberto Bercovitz & Germán Bercovitz, *Spain* § 3[2][b], in 2 INTERNAT'L COPR. LAW & PRACTICE, *supra* note 1.

²⁴ See Fabiani, *Italy*, *supra* note 4, § 3[3][b].

different cut-off dates for assertable reliance interests and, more rarely, concern chain of title. In the *Butterfly* case, the E.C. Court of Justice confirmed that one E.C. country properly exercised its legislative discretion in devising its scheme to account for reliance interests.²⁵

Do not assume that an older work or media production, once buried in the public domain of an E.C. country, remains dead once and for all. Keep a lookout for works with E.C. authors, bearing in mind that the national law of the protecting country may well define "author" here. Look out, as well, for performances or sound recordings or other media productions made by E.C. nationals. Otherwise, look for works or other media productions, with regard to which there are treaty or legislative grounds for claiming retroactive protection and for avoiding the application of rule of the shorter term. Ask, then, whether the work or media production was protected in any one E.C. country in mid-1995: in that event, in an appropriate case, it might have arisen from its public-domain grave at that time.

[*N.b.*: The foregoing analysis was current at the start of 2000.

For updated analysis, see *International Copyright: The Introduction*, §§ 4[3] through 5[3], at <http://www.internationalcopyrightguide.com/> .]

²⁵ Case C-60/98, *Butterfly Music SRL v. CEMED SRL*, 2000 EURO. COPR. & DESIGN REP. 1.