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THE NEW PUBLIC DOMAIN

By Joseph P. Liu[*]

Abstract

In 1998, Congress extended the term of copyright protection, giving existing copyrighted works an additional 20 years of protection. The practical result was to freeze copyright's public domain for a period of 20 years. Unless Congress extends the copyright term again, copyrighted works will start passing into the public domain in 2019, after a 20 year hiatus. This Article takes a look at some of the issues that will arise when this happens. It argues that the works passing into the public domain post 2018 differ dramatically, and in ways not yet fully appreciated, from the works that comprised the public domain prior to 1998. In addition, dramatic economic, technological, and cultural changes in the past 10 years mean that these new works will enter a vastly changed environment, one poised to make even greater and more immediate use of these works. Together, these developments hold out the possibility that this "new public domain" will in the future play a more vital and important role in our cultural landscape than ever before. At the same time, this Article highlights a number of legal issues that may keep the new public domain from fulfilling this promise. Owners of expiring copyrights will attempt to use a number of doctrines in trademark and copyright law to limit the free use of these works even after they have passed into the public domain. This Article concludes by proposing a number of concrete steps that can be taken to ensure that the public domain lives up to its promise.

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INTRODUCTION

In 1998, Congress extended the length of the copyright term by an additional 20 years, applying this extension to both existing and future works. The practical effect of this term extension was to freeze copyright's published public domain[1] for a period of 20 years.[2] Prior to 1998, copyrighted works from the late 1910s and early 1920s had been passing into the public domain at a steady rate every year. After the term extension, however, the public domain for published works in the U.S. was effectively frozen. Thus, since 1998, no published copyrighted works have passed into the public domain.

This freeze is about to come to an end. On January 1, 2019, copyrighted works first published in the U.S. in 1923 will pass into the public domain. For each year after 2019, another year's worth of works published after 1923 will enter the public domain. Thus, unless Congress extends copyright once again, we can soon expect a number of important creative works to be available for others to freely copy, distribute, sell, and incorporate into new creative works. These include important musical works (such as songs by George Gershwin and Irving Berlin), literary works (such as novels by William Faulkner, Ernest Hemingway, Virginia Woolf), iconic visual works (such as visual depictions of Mickey Mouse, Donald Duck, Winnie the Pooh, and Superman), and classic movies (such as *Gone With the Wind* and *The Wizard of Oz*).

It is possible that the passing of these works into the public domain will raise few legal issues. After all, copyright's public domain existed for more than 200 years in the U.S. prior to 1998.[3] Ever since the very first copyright act in 1790, works had been passing into the public domain with regularity. And indeed, this is not the first time that the public domain has been temporarily frozen. Similar freezes occurred in the past when Congress passed prior retroactive copyright term extensions. Thus, we might expect the public domain in 2019 to easily and comfortably resume its place within the broad framework of copyright law and the industries that rely upon it.

This Article argues that this is too facile a view and that the "new public domain" will in fact differ in important ways from the public domain that existed before the term extension. One reason has to do with the nature of the works that will pass into the public domain post 2018. Although many important works passed into the public domain prior to 1998, the works that we can expect to pass into the public domain post 2018 are some of the most iconic and important American cultural works, encompassing the artistically rich decades of the 1920s, 1930s, and 1940s. These decades coincide with dramatic changes in technology, which led to the rise of the recorded music, radio, and motion picture industries. The new public domain will, for the first time, contain works that were distributed to the public in mass recorded form. Thus, the scale and nature of the new public domain will differ significantly from the old public domain, in ways that have yet to be fully appreciated.

In addition, dramatic technological, economic, and cultural changes since 1998 mean that these new public domain works will enter a vastly changed environment, one poised to make even greater use of these works than ever before. New digital technologies have revolutionized the distribution and consumption of copyrighted works. The old economic models supporting the

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[1] This Article uses the term "public domain" in a limited fashion to refer to creative works that are not subject to copyright protection, whether because they were never eligible for protection or because their copyright terms have expired. For alternative definitions of the term, see *infra* text accompanying note __.

[2] This freeze applies only to the expiration of copyrights in *published* works. In 2003, a large number of *unpublished* works passed into the public domain. *See* R. Anthony Reese, *Public But Private: Copyright's New Unpublished Public Domain*, 85 TEX. L. REV. 585 (2007); Elizabeth Townsend Gard, *January 1, 2003: The Birth Of The Unpublished Public Domain And Its International Implications*, 24 CARDOZO ARTS & ENT. L.J. 687 (2006).

[3] Although it may not have been expressly called the "public domain." *See* Tyler T. Ochoa, *Origins and Meanings of the Public Domain*, 28 U. DAYTON L. REV. 215 (2002) (term "public domain" imported from French law at the end of the 19th century).

copyright industries have come under enormous pressure. Consumers are more able than ever to manipulate and work with copyrighted works to make their own creative works. Thus, the environment that these new and important public domain works will enter bears little resemblance to the environment that existed prior to the freeze.

This new public domain faces new perils and opportunities. The battle over the term extension focused much scholarly attention on the importance of the public domain. As a result of the term extension debate, we now have a more complete and richer account of the role that the public domain has played, and can potentially play, in copyright law. This, coupled with the richness of the works that are about to enter the public domain, presents the potential for the public domain to play an even more vital role in the copyright balance and in our cultural landscape more generally. More specifically, as I will argue in this Article, the new public domain holds out the possibility that we will soon have a tremendously rich repository of important and iconic cultural works, which an unprecedentedly wide range of individuals, empowered by new technologies, will be able to freely access, share, re-cast, and transform, thereby creating a richer and more complex culture.

Yet this new public domain faces challenges that may limit its potential. As an initial matter, there is the danger of an additional retroactive extension of the copyright term. But even if the copyright term is not extended, copyright owners will seek alternative legal mechanisms to protect their works and limit free use, even after the works have passed into the public domain. Specifically, copyright owners will look to trademark law and to other copyright law doctrines in an attempt to limit the ability of others to use their works. Although some of these issues have been addressed in existing case law, the scale and significance of the new public domain will put increasing pressure on uncertainties in current doctrine and raise novel legal issues. Careful attention will therefore need to be paid in order to ensure that the new public domain fulfills its promise.

This Article is an effort to comprehensively anticipate and analyze the implications of the new public domain. Part I begins with a description of the current state of affairs and how we got here. It recounts the initial battle over the copyright term extension in 1998 and the consequences of the extension. Part II addresses what will happen if the term is not extended and works begin passing into the public domain again in 2019. It argues that this new public domain differs from the old public domain in important ways. It describes, in detail, the nature of the works that will soon be passing into the public domain and how they differ qualitatively from the works that passed into the public domain before 1998. It also describes the dramatically new technological, economic, and cultural environment that awaits these works.

Part III begins exploring the role that the new public domain can potentially play in the future, as an important part of the copyright law balance. It describes the burgeoning scholarship about the public domain that flourished in the wake of the term extension. It also discusses how the works that will soon pass into the public domain can play a critical role in setting the future copyright balance. Part IV then comprehensively addresses a number of important legal issues that will need to be clarified in order for the new public domain to play this role. In particular, this Part addresses various problems resulting from overlapping copyright and trademark rights. In each of these areas, this Part offers concrete proposals for addressing these problems.

When the copyright term was extended in 1998, the extension was viewed as a major setback by those who believed in the cultural benefits of a vibrant public domain. Yet this Article argues that, once works begin passing into the public domain again in 2019, the public domain has the potential to play an even more significant role than it ever did before the term extension. This Article thus ultimately holds out the hope that, with some careful attention, a new and even more robust public domain can potentially emerge from what was initially viewed as a bitter defeat.

I. THE FREEZING OF THE PUBLIC DOMAIN

A. The Copyright Term Extension

The U.S. Constitution gives Congress the power to grant copyrights for "limited Times,"[4] and every copyright act enacted under this provision has included a limited copyright term. The initial copyright term under the very first copyright act in 1790 granted authors an initial 14-year term of protection, which could be renewed for an additional 14 years.[5] Thus, after a maximum of 28 years, the copyright would expire and the work would pass into the public domain. This meant that others could then freely make and sell copies of that work without permission from the copyright owner.

The limited term of copyright reflects a balance of competing interests. On the one hand, copyright grants exclusive rights to authors to give them an incentive to create the work and as a reward for their creative labor. On the other hand, once a work is created, we want that work to be broadly disseminated, since this is, after all, the broader purpose of copyright. In addition, we want others to be able to build upon these works to create new works.

The limited copyright term is one way to balance these competing interests. The copyright term gives authors a certain amount of protection, sufficient to induce them to create the work and reward them for it. After the term has run out, the work passes into the public domain, where it can be freely disseminated and built upon by others. It becomes part of our common cultural heritage.

Precisely where the balance should be struck is a matter that the Constitution leaves largely to Congress, and Congress has, over the last several centuries, steadily increased the term of copyright protection. As mentioned earlier, the initial copyright term in 1790 was 14 years from publication, with an additional 14 year renewal term, for a total maximum term of 28 years. In 1831, Congress increased the maximum term to 42 years,[6] and then to 56 years in 1909.[7] In the major 1976 revision of the Act, the maximum term for existing works was extended to 75 years from publication.[8] For works created after the effective date of the 1976 Act, the term was the life of the author plus an additional 50 years.

Most recently in 1998, Congress once again extended the copyright term, this time by an additional 20 years.[9] Thus, for copyrighted works created prior to the effective date of the 1976 Act, copyright would now last for a maximum of 95 years from the date of publication. For works created after the 1976 Act, copyright would now last for the life of the author plus an additional 70 years.

The passage of the most recent copyright term extension in 1998 touched off a fierce debate. When the term extension was first proposed, many commentators argued that there was no proper justification for the extension. For newly-created works, any additional incentive effect was likely to be minimal, given how far out into the future the additional years would be (i.e. more than 50 years after the death of the author).[10] Even worse, there was no incentive-based justification for

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[4] U.S. CONST. Art. I, § 8, cl. 8.
[5] Copyright Act of 1790, § 1, 1 Stat. 124 (1790).
[6] Act of Feb. 3, 1831, §§ 1-2, 4 Stat. 436, 436-37 (1831).
[7] Copyright Act of 1909, 17 U.S.C. § 23 (1909) (repealed 1978).
[8] Pub. L. No. 94-553 (1976) (*codified* at 17 U.S.C. § 304 (1994)).
[9] Pub. L. no. 105-298, 112 Stat. 2827 (1998), *amending* 17 U.S.C. §§ 302-304.
[10] *See, e.g.*, *Statement of Copyright and Intellectual Property Law Professors in Opposition to H.R. 604, H.R. 2589, and S. 505 Submitted to the Committees on the Judiciary, U.S. Senate and U.S. House of Representatives*, 105th Cong. (1998) (written testimony of Dennis Karjala) [hereinafter Karjala, *Statement*]. *See generally* Joseph P. Liu, *Copyright and Time*, 101 MICH. L. REV. 409, 417-18 (2002) (summarizing debate).

applying the extension to already-existing works, since they had already been created.[11] Thus, the term extension for existing copyrighted works amounted to nothing more than a raw transfer from the general public to private copyright owners.

Supporters of the term extension argued that the term extension was necessary to make the U.S. term consistent with the term in the European Community (EC), which had recently extended the term to life plus 70 years.[12] They argued that U.S. authors would be disadvantaged in European markets, since the EC had adopted a rule that provided a term of protection for foreign works consisting of the shorter of the EC term or the term that existed in under the foreign work's domestic law.[13] Some supporters also argued that extending the term would create additional incentives for publishers to distribute existing works.[14]

Ultimately, Congress sided with supporters of the bill, which included many companies, such as Disney, that owned copyrights that would have expired absent term extension. Thus, in 1998, Congress enacted the Sonny Bono Copyright Term Extension Act,[15] extending the copyright term by an additional 20 years. The copyright term extension was subject to a constitutional challenge, brought by a number of individuals who argued that the extension violated both the "limited Times" provision of Article I as well as the First Amendment of the U.S. Constitution. In *Eldred v. Ashcroft*,[16] the U.S. Supreme Court ultimately upheld the term extension against these challenges.

B. The Old Public Domain

The practical effect of the copyright term extension was to freeze the public domain for published works for a period of 20 years. Prior to 1998, copyrighted works had been passing into the public domain at a steady rate. Thus, for example, works published in the U.S. in 1922 all passed into the public domain on January 1, 1998.[17] These works included *The Waste Land*, by T. S. Eliot,[18] and *Ulysses*, by James Joyce.[19] Works published in 1921 passed into the public domain on January 1, 1997. These included F. Scott Fitzgerald's *This Side of Paradise*,[20] Edith Wharton's *Age of Innocence*,[21] and the song "Over There" by George M. Cohan.[22]

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[11] *See, e.g.*, James Boyle, *Cruel, Mean , or Lavish? Economic Analysis, Price Discrimination and Digital Intellectual Property*, 53 VAND. L. REV. 2007, 2036 (2000); Liu, *supra* note __, at 418 n. 53.

[12] *See, e.g.*, *The Copyright Term Extension Act of 1995: Hearing on S. 483 Before the Senate Comm. On the Judiciary*, 104th Cong. 20, 23 (1995) (statement of Marybeth Peters, Register of Copyright); *Symposium, The Constitutionality of Copyright Term Extension: How Long is Too Long?*, 18 CARDOZO ARTS & ENT. L.J. 651, 690, 700 (2000) (statements by Arthur R. Miller and Jane C. Ginsburg); Liu, supra note __, at 419 (summarizing arguments).

[13] Council Directive 93/98, 1993 O.J. (L290) 9.

[14] *See* Hon. Howard Coble, *Recent Developments in Intellectual Property*, 22 COLUM.-VLA J.L. & ARTS 269, 296 (1998); Sen. Orrin G. Hatch, *Toward a Principled Approach to Copyright Legislation at the Turn of the Millennium*, 59 U. PITT. L. REV. 719, 736 (1998); Arthur R. Miller, *Copyright Term Extension: Boon for the American Creators and the American Economy*, 45 J. COPYRIGHT SOC'Y U.S.A. 319, 325 (1997).

[15] Pub. L. no. 105-298, 112 Stat. 2827 (1998), *amending* 17 U.S.C. §§ 302-304.

[16] 537 U.S. 186 (2003).

[17] The term of protection for a given work lasts to the end of the calendar year in which the term would otherwise expire. 17 U.S.C. § 305.

[18] T.S. ELIOT, THE WASTE LAND (1922).

[19] JAMES JOYCE, ULYSSES (1922). *But see* Robert Spoo, Note, *Copyright Protectionism and Its Discontents: The Case of James Joyce's Ulysses in America*, 108 YALE L.J. 633 (1998).

[20] F. SCOTT FITZGERALD, THIS SIDE OF PARADISE (1920).

[21] EDITH WHARTON, THE AGE OF INNOCENCE (1920).

[22] George M. Cohan, *Over There* (1920).

Thus, as of 1998, the public domain contained every work published in the U.S. before 1923.[23] The public domain accordingly included a vast and rich range of materials. All literature published in the U.S. prior to 1923 was in the public domain. Thus, novels and poems by famous authors from the 19th and early 20th century were in the public domain. These included many works by Charles Dickens, Jane Austen, Emily Bronte, Leo Tolstoy, John Keats, Mark Twain, Jules Verne, Victor Hugo, Henrik Ibsen, and others. Pre-1923 literary works containing famous characters such as Sherlock Holmes were also in the public domain.[24]

All music published prior to 1923 was in the public domain as well. Thus, the works of many of the great classical and romantic composers of the 19th century – Ludwig van Beethoven, Franz Liszt, Frédéric Chopin, Piotr Ilyich Tchaikovsky, Richard Wagner, Franz Schubert, Gustav Mahler, etc. – were in the public domain, free for others to copy and perform. In addition to classical music, some early popular music (e.g. Tin Pan Alley, ragtime) and early works of the jazz age published before 1923 would have been in the public domain as well.

In the visual arts, all paintings and sculptures published prior to 1923 were in the public domain. Thus, the public domain contained published[25] works by the great impressionist and post-impressionist painters of the 19th century - Claude Monet, Édouard Manet, Paul Cézanne, Georges Seurat, Pierre-Auguste Renoir, etc., - as well as sculptures by Edgar Degas, Pierre-Auguste Renoir, and others. By 1923, photography had already been invented, and thus early published photographs would have been included in the public domain as well.[26]

The public domain as of 1998 would also have included some works that were distributed using technologies that were relatively new as of 1923. Player piano rolls were, by that date, a relatively well-established means of distributing musical works. In addition, by 1923, a market for phonograph recordings had just started to develop. Thus, some of the musical works noted above would have been distributed using these new means.[27] Finally, by 1923, motion pictures had been invented, and some of the earliest silent motion pictures (e.g. featuring Buster Keaton, Charlie Chaplin, etc.) would have been part of the public domain as well.[28]

Thus, as of 1998, copyright law's public domain contained a rich array of creative works published in the U.S. prior to 1923 – literature, music, visual arts, early silent motion pictures. And indeed, the public domain had been growing steadily each year prior to 1998, as the copyright terms of creative works steadily expired.

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[23] The public domain also contained many works published after 1923, which passed into the public domain due to failure to renew the copyright or to failure to comply with formalities.

[24] *See, e.g.,* ARTHUR CONAN DOYLE, A STUDY IN SCARLET (J.B. Lippincott & Co. 1890).

[25] As we will later see, whether a given work of visual art was "published" is not always easy to determine with certainty. *See* R. Anthony Reese, *Photographs Of Public Domain Paintings: How, If At All, Should We Protect Them?*, 34 J. CORP. L. 1033 (2009) (noting some of the complications).

[26] *See, e.g., Burrow Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884) (photograph of Oscar Wilde entitled to copyright protection).

[27] Note that even if the musical work has passed into the public domain, the phonograph recording of the musical work may not be in the public domain. Prior to 1972, phonographs were not protected by federal copyright law, but instead by state law, which generally provided perpetual protection. In 1972, the federal Copyright Act was amended to bring post-1972 phonograph recordings within federal copyright. In that same statute, Congress indicated that pre-1972 phonograph recordings would all pass into the public domain no later than 2067. Thus, for most purposes, many if not most pre-1972 phonograph recordings are still protected under a patchwork of state laws.

[28] Motion pictures were expressly added as a separate category under the 1909 Act in 1912. Act of Aug. 24, 1912, ch. 356, 37 Stat. 488 (1912) (amending Copyright Act of 1909, ch. 320, §11, 35 Stat. 1075, 1078 (1909) (repealed 1976)).

C. The Effect of the Freeze

Once Congress extended the copyright term in 1998, however, this steady passage of works into the public domain was halted for a period of 20 years. Thus, works published in 1923 (and thereafter), instead of entering the public domain as planned in 1999 (and thereafter), would remain under copyright until at least 2018. Works published in 1924, instead of entering the public domain in 2000, would remain under copyright until at least 2019. And so on.[29]

These works included Disney's original Mickey Mouse,[30] Pluto, and Goofy, A. A. Milne's Winnie the Pooh,[31] George Gershwin's *Rhapsody in Blue*,[32] as well as numerous works by Cole Porter, Irving Berlin, Ernest Hemmingway, William Faulkner, and many others. These are all works that would have passed into the public domain, but for the term extension.[33]

This state of affairs is about to come to an end. Unless Congress extends the term of copyright protection again, copyrights will once again begin to expire in 2019. Thus, on January 1, 2019, all of the works published in 1923 will finally pass into the public domain, as 95 years will have passed since their publication. On January 1, 2020, all of the works published in 1924 will pass into the public domain. And so on. Thus, every year after 2018 will see an increase in the size and scope of the public domain.

II. WHAT IS NEW ABOUT THE NEW PUBLIC DOMAIN?

What will happen once works begin to pass into the public domain again in 2019? One possibility: nothing much different than what happened before. After all, the public domain existed for more than 200 years in the U.S. prior to the most recent term extension. For centuries, works had been passing steadily into the public domain. And as recently as 1998, the public domain had been steadily expanding. Both copyright owners and potential users of copyrighted works were accustomed to this state of affairs. Thus, one might expect works to resume passing into the public domain without much adjustment or fanfare.

In this Part of the Article I argue that, in fact, there are good reasons to believe that the public domain after 2018 may not perfectly resemble the public domain that existed before 1998. This is in part because the works passing into the public domain post 2018 differ both quantitatively and qualitatively from the works that passed before. In part this is also because of dramatic technological, economic, and cultural changes that have occurred in the intervening years. Thus, for many reasons, the new public domain will differ in important ways from what has come before.

A. The Works Expected to Pass

The copyrighted works that will begin passing into the public domain after 2018 consist of works first published in the U.S. in 1923 and thereafter. The new public domain will thus consist, at least initially, of works from the artistically creative and productive decades of the 1920s, 30s, and 40s. Although the works prior to 1923 encompassed many important and vital cultural works,

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[29] *See generally* Dennis Karjala, Opposing Copyright Extension, *at* http://homepages.law.asu.edu/~dkarjala/OpposingCopyrightExtension/ (listing works that would have passed into public domain but for the term extension).

[30] *See* STEAMBOAT WILLIE (Walt Disney 1928).

[31] *See* Jon M. Garon, *Media & Monopoly In The Information Age: Slowing The Convergence At The Marketplace Of Ideas*, 17 CARDOZO ARTS & ENT. L.J. 491 (1999).

[32] *See* John Solomon, *Rhapsody in Green*, BOSTON GLOBE, Jan. 3, 1999, at E2.

[33] *See* William F. Patry, *Fair Use And Statutory Reform In The Wake Of Eldred*, 92 CAL. L. REV. 1639 (2004) (describing in detail many of the foregone uses of works that would have passed into the public domain absent term extension); Marvin Ammori, *The Uneasy Case For Copyright Extension*, 16 HARV. J.L. & TECH. 287 (2002).

it is important to note some of the ways in which works after 1923 differ, both qualitatively and quantitatively, from works produced before.

Perhaps the area where there will be least difference is literature. Many important works of literature will pass into the public domain after 2018. For example, F. Scott Fitzgerald's *The Great Gatsby* will pass into the public domain in 2021.[34] Virginia Woolf's *Mrs. Dalloway* will pass into the public domain that year as well.[35] Many works by Ernest Hemingway, Joseph Conrad, Franz Kafka, W. Somerset Maugham, and others will all pass into the public domain. Yet in many ways, this is not all that different from the state of affairs that existed prior to 1998, when important literary works were passing into the public domain at a steady pace.[36]

A greater difference may be found in the realm of music. The dividing line between the new and old public domain (i.e. the year 1923) coincides with the birth of the jazz age in the U.S. Thus, after 2018, many musical works from this artistically productive era will begin passing into the public domain. Many compositions by George and Ira Gershwin ("Rhapsody in Blue,"[37] "Fascinating Rhythm"[38]), Irving Berlin ("All Alone,"[39]), and Gus Kahn ("It Had to be You,"[40] "I'll See You in My Dreams"[41]) will enter the public domain. Many songs from popular musicals, such as "Showboat,"[42] including "Ol' Man River"[43] (by Oscar Hammerstein II, Jerome Kern), will also pass into the public domain. The late 1920s and early 1930s also saw the first blues recordings of performers such as Tommy Johnson, Robert Wilkins, Son House, and Robert Johnson. The 1930s witnessed the birth of the swing era and big band music.[44] Thus, the new public domain will, for the first time, contain, not just classical music, but some of the great works of the blues, jazz, and swing ages.[45]

In addition, the decades after 1923 witnessed important changes in the way music was distributed and thus important differences in the cultural significance and salience of musical works. Prior to 1923, musical works were distributed largely through live public performances, sales of sheet music (which was a dominant industry in the 1800s and early 1900s), [46] or through the then-new technologies of the player piano roll[47] and very early gramophone recordings.[48] After 1923,

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[34] F. SCOTT FITZGERALD, THE GREAT GATSBY (1925).

[35] VIRGINIA WOOLF, MRS. DALLOWAY (1925).

[36] A similar situation exists with respect to the fine arts. *See, e.g.*, works such as the painting "American Gothic" by Grant Wood (1930).

[37] George Gershwin, *Rhapsody in Blue* (1924); *see* John Solomon, Rhapsody in Green, BOSTON GLOBE, Jan. 3, 1999, at E2.

[38] George Gershwin & Ira Gershwin, *Fascinating Rhythm* (1924).

[39] Irving Berlin, *All Alone* (1924).

[40] Gus Kahn, *It Had to Be You* (1924).

[41] Gus Kahn, *I'll See You In My Dreams* (1924).

[42] Jerome Kern & Oscar Hammerstein II, *Showboat* (1927) (musical); SHOWBOAT (1929) (film).

[43] Jerome Kern & Oscar Hammerstein II, *Ol' Man River* (1927).

[44] *See, e.g.*, Jennifer L. Hall, *Blues And The Public Domain--No More Dues To Pay?*, 42 J. COPYRIGHT SOC'Y U.S.A. 215 (1995) (highlighting some of the complications in determining whether blues recordings are in the public domain).

[45] *See generally* Paul J. Heald, *Does The Song Remain The Same? An Empirical Study Of Bestselling Musical Compositions (1913-1932) And Their Use In Cinema (1968-2007)*, 60 CASE W. RES. L. REV. 1, 11 (2009) (listing many prominent songs from this period).

[46] *See* Richard French, "The Dilemma of the Music Publishing Industry," *in* Paul Henry Lang, ed., ONE HUNDRED YEARS OF MUSIC IN AMERICA 173 (1961) ("[I]n order to have any music at all a century ago, either of two conditions had to be met: either people had to make it themselves, or they had to come within earshot of others making it. In this respect, the people of the 19th century differed in no way from their ancestors of the 18th, 16th, or 14th centuries …. They differ only from us.").

[47] *See, e.g.*, *White-Smith Pub'g Co. v. Apollo Co.*, 209 U.S. 1 (1908) (holding piano rolls did not infringe upon musical works), *legislatively overruled by* Copyright Act of 1909, Pub. L. 60-349, 35 Stat. 1075

distribution of musical works began increasingly to occur in recorded form, on phonorecords.[49] In addition, the first commercial radio stations began broadcasting in the U.S. in the early 1920s. By 1931, two out of every five homes in the U.S. had a radio. By 1938, four out of every five homes in the U.S. had a radio.[50] As a result of these dramatic technological changes, popular music became far more widespread and accessible to a greater number of individuals. This is perhaps one reason why many musical works from this era have continuing cultural significance today.

The differences are perhaps even more significant with respect to the movie industry.[51] The date 1923 also closely marks the transition from the silent film era to the talking film era. Motion pictures had, of course, already been invented prior to 1923, and a market existed for silent films, such as *Birth of a Nation*[52], and the early films of Charlie Chaplin[53] and Buster Keaton.[54] The first successful talking movie, *The Jazz Singer*, however, was not distributed until 1927.[55] Thereafter, the industry witnessed explosive growth, with the birth of the studio system in the 1920s. Thus, the new public domain after 2018 will, for the very first time, contain works from the golden age of film, such as *The Wizard of Oz*[56] and *Gone With the Wind*,[57] which is still considered the highest-grossing film of all time.[58]

The rise of both the recorded music and movie industries post-1920 highlights the way in which the new public domain will differ dramatically in terms, not only of the content of these works, but the type of works. For the first time, the public domain post 2019 will contain significant works that were distributed to the public through fixed recordings (of musical works) or public performance of fixed recordings (via radio broadcasts or in movie theaters). Prior to that time, the technology simply did not exist for this kind of mass consumption of works fixed in mechanical form.

Perhaps most significantly, a number of iconic characters and images from the 1920s and 1930s will pass into the public domain after 2018. The most iconic of these is probably Mickey Mouse, which first publicly appeared in the form of the character Steamboat Willie in 1928, in a short animated film of that same name.[59] Without the term extension, the character would have passed into the public domain in 2004. Now, however, the character will be expected to pass into the public domain on January 1, 2024. Other iconic characters include Minnie Mouse,[60] Donald Duck,[61] Pluto,[62] Winnie the Pooh,[63] and Superman.[64]

(bringing piano rolls and other recordings within copyright law, but subjecting them to a compulsory license).

[48] *See* Edward Samuels, AN ILLUSTRATED STORY OF COPYRIGHT 31-36 (2000) (describing the dramatic changes in the music industry during this period).

[49] *See id. See also* Charles Cronin, *Virtual Music Scores, Copyright And The Promotion Of A Marginalized Technology*, 28 COLUM. J.L. & ARTS 1 (2004).

[50] *See id.* at 40. *See also* B. Eric Rhoads, BLAST FROM THE PAST: A PICTORIAL HISTORY OF RADIO'S FIRST 75 YEARS (1996).

[51] *See generally* Richard Griffith & Arthur Mayer, THE MOVIES (2d ed. 1970); Joel W. Finler, THE HOLLYWOOD STORY (1988).

[52] D.W. Griffith, THE BIRTH OF A NATION (1915).

[53] *See, e.g.,* KID AUTO RACES IN VENICE (1914) (first appearance of the "Little Tramp" character); THE IMMIGRANT (1917).

[54] *See, e.g.,* THE SAPHEAD (1920); ONE WEEK (1920).

[55] THE JAZZ SINGER (1927).

[56] THE WIZARD OF OZ (1939).

[57] GONE WITH THE WIND (1939).

[58] William Patry, *The Failure Of The American Copyright System: Protecting The Idle Rich*, 72 NOTRE DAME L. REV. 907 (1997) (discussing movies that may yet pass into the public domain).

[59] Walt Disney, STEAMBOAT WILLIE (1928).

[60] First appearance in STEAMBOAT WILLIE (1928).

[61] First appearance in THE LITTLE WISE HEN (1934).

[62] First appearance in THE CHAIN GANG (1930).

These iconic visual characters represent a significant departure from the public domain pre-1998. Although the old public domain certainly included famous literary and visual characters (such as Sherlock Holmes, Santa Claus, etc.), the increase in mass and visual media post 1920 led to the creation and broad dissemination of visual characters such as Mickey Mouse, who have been the subject of aggressive marketing techniques and who have since achieved iconic status. It is difficult to find as many visual characters with the same significance in the public domain that existed prior to 1998.

Moreover, such characters have been the subject of constant continuing creative exploitation, such that they retain significance many years later. Thus, the demand for many of these new public domain works is likely to be quite strong today. For example, demand for Mickey Mouse-related works is extremely robust even today, as the sales figures at Disney stores can attest. Estimates place the annual revenue resulting from licensing of Mickey Mouse and friends at more than $5 billion.[65] Thus, when Mickey Mouse passes into the public domain, there will likely be a good deal of demand.

Again, it is certainly true the public domain prior to 1998 was quite rich and contained many important works. In making the point that the post 2018 public domain is different, it is important not to overstate the case. And there is certainly the risk that, in viewing the 1920s and 1930s from our vantage point today, we may exaggerate the differences from decade to decade.

However, it is also important to note that there are some very real and significant differences in the shape and form of the public domain to come. The new public domain will contain, for the very first time, significant numbers of important works that were performed or distributed in fixed recorded form (as opposed to live performances)—the result of the rise of mass media. It will also contain a significant number of iconic works that have enduring appeal today. These differences suggest that the new public domain will play a more prominent role in our cultural landscape.

B. Changes Since 1998

Not only are the works passing into the public domain after 2018 different from the works that passed into the public domain before 1998, but the environment they are entering also differs in dramatic ways. On the one hand, only 20 years will have passed since the public domain was frozen, and it is hard to imagine too much changing in that time period. Yet anyone who has paid attention to the copyright industries over the past 10 years knows that we are going through a dramatic period of change and disruption. The copyright industries have been subject to dramatic technological, economic, and cultural changes, which we can expect to continue for the next several years. These changes will make it possible for these new public domain works to have a greater immediate impact on our cultural and creative landscape than ever before.

1. Technological Changes

First and foremost, the technological changes that have occurred since 1998 have been breathtaking. In 1998, the first Internet boom was underway. Internet access was somewhat widespread, as approximately 40% of adults in the U.S. used the internet either at home or at work

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[63] A. A. Milne, WINNIE THE POOH (1926).

[64] Jerry Siegel & Joseph Schuster, ACTION COMICS NO. 1 (April 18, 1938).

[65] *See* Vanessa Gisquet & Lacey Rose, *Top Characters Gross $25B*, FORBES.COM (Oct. 19, 2004), available at: http://www.forbes.com/lists/2004/10/20/cz_vq_lr_1020fictionalintro.html (estimating gross worldwide merchandising and licensing revenues for the following characters: Mickey Mouse and friends ($5.8 billion), Winnie the Pooh and friends ($5.6 billion)).

(although many accessed the internet via slow dial-up connections).[66] New companies were beginning to take advantage of opportunities presented by the new technology. At the same time, significant uncertainty existed as to what business models would ultimately be successful.

This was particularly true of the copyright industries. As of 1998, authorized digital distribution of many copyrighted works through the internet was extremely limited. Although websites contained short articles and pictures, more sustained works of authorship (such as novels, music, movies) were not generally available in legal form over the internet. Many copyright owners were hesitant to begin digital distribution of their works, out of uncertainty and concerns about unauthorized copying.

Take, for example, the music industry. In 1998, consumers still purchased music CDs through local record stores or online. Indeed, per capita sales of CDs in the U.S. peaked around 1999.[67] There existed, as of 1998, no effective legal way to purchase recorded music in purely digital form. And indeed, unauthorized music file-sharing over the internet had not yet become widespread, as the peer-to-peer file sharing program Napster was not introduced until 1999.[68] The recorded music industry was thus, as of 1998, still very much based on the sale of physical CDs. Legal delivery of music online did not effectively exist.

Today, the market looks very different. After 1999, the explosive growth of unauthorized file-sharing through Napster and other peer-to-peer services led to widespread demand for purely digital distribution of music. After Napster was effectively shut down in 2001, the music industry responded to this demand by offering authorized digital downloads of music. Ever since the introduction of iTunes in 2003, legal digital distribution of recorded music has become well-established. Consumers can purchase individual songs in digital form through many on-line retailers, to play on a wide range of personal devices. Internet radio and other streaming services make music readily available to consumers. Although there is still much uncertainty about precisely what models will be successful in the long run, music is, today, widely accessible in digital form.

The differences are even greater in other copyright industries. In 1998, legal copies of motion pictures in pure digital form (as opposed to DVDs) were not generally available to consumers. Moreover, unauthorized file sharing was far more limited than for music, given limitations on Internet bandwidth. Today, authorized digital copies of motion pictures are available for download over the internet and over cable networks. Unauthorized digital downloads are available through peer-to-peer filesharing services such as BitTorrent. Consumers own many devices that are designed to play these works. Thus, ready distribution channels exist for movies in digital form.

Similarly, the market for digital copies of works of literature has changed significantly. In 1998, the market for digital copies of books was quite limited. Consumers did not enjoy reading extended literary works on their computer screens, and there were doubts about whether they would ever make this adjustment. Even though many works of great literature were in the public domain, few imagined that they would read these works on computer devices. Today, many handheld platforms exist designed specifically for digital textual works, and these platforms have wit-

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[66] *See* Pew Research Center, "Internet Adoption, 1995-2010," *available at*: http://www.pewinternet.org/Trend-Data/Internet-Adoption.aspx; Susannah Fox, "The Internet Circa 1998," (June 21, 2007), *available at:* http://www.pewinternet.org/Commentary/2007/June/The-Internet-Circa-1998.aspx.

[67] *See* Bain & Co., PUBLISHING IN THE DIGITAL ERA (2011), *available at*: http://www.bain.com/bainweb/PDFs/cms/Public/BB_Publishing_in_the_digital_era.pdf; *see also* Michael DeGusta, "The REAL Death of the Music Industry," (Feb. 18, 2011), *available at* http://www.businessinsider.com/these-charts-explain-the-real-death-of-the-music-industry-2011-2.

[68] *See A&M Records, Inc. v. Napster,* 239 F.3d 1004 (2001).

nessed widespread adoption. Moreover, this market is projected to expand rapidly.[69] Indeed, in 2011, eBook sales for the first time exceeded sales of physical books at Amazon.com.[70]

Many companies have taken advantage of these technological changes to offer access to works that are already in the public domain. So, for example, many organizations such as Eldritch Press, Project Gutenberg, Amazon.com, etc. make available, for free, works of literature that have already passed into the public domain. Many websites contain pictures of works of visual art that have passed into the public domain, thus greatly increasing the number of individuals who can view them. Organizations have yet to do this in any sustained way for recorded music or motion pictures, but this is due, as described above, to the fact that most of these works are still under copyright.

The works that will soon be passing into the public domain thus face a well-developed and established market for digital distribution, one that simply did not exist in 1998. [71] Thus, when works such as George Gershwin's *Rhapsody in Blue* or the movie *Gone With the Wind* pass into the public domain, they will be readily accessible to consumers via iTunes, Amazon.com, Netflix, or any number of other companies. Similarly, as works of literature such as F. Scott Fitzgerald's *The Great Gatsby* or A. A. Milne's *Winnie the Pooh* pass into the public domain, consumers will be able to readily download them onto their Kindles, Nooks, iPads, or other devices.

2. Economic Changes

The technological changes mentioned in the previous section have been accompanied, as one would expect, by dramatic changes in the economic structure of the copyright markets. Perhaps the most significant impact of these changes has been to dramatically reduce the marginal cost of distributing copyrighted works. In 1998, physical channels still dominated the distribution of copyrighted materials, whether in the form of CDs, DVDs, or books. Today, electronic dissemination of copyrighted materials is well-established and fast overtaking physical distribution. By 2018, we can expect even greater changes.

This reduction in the cost of distribution means that new public domain works will be trivially easy to distribute. As a result, we can expect these works to have a greater immediate impact than ever before. Prior to 1998, when a work of literature passed into the public domain, the widespread dissemination of that work took some time, as publishers printed copies of the book for sale in physical book stores. Moreover, such works, while often priced at a discount to similar books still subject to copyright,[72] still cost a non-trivial amount, due to the costs of printing, distribution, retailing, etc.

In 2019, however, once a novel passes into the public domain, copies of that novel can be distributed the next day around the world at near- zero cost. Consumers will be able to immediately download the novel for free, just as they currently do for novels already in the public domain.[73]

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[69] Mark Walsh, "E-Book Sales to Hit $9 Billion in 2013," ONLINE MEDIA DAILY (June 1, 2009), *available at*: http://www.mediapost.com/publications/?fa=Articles.showArticle&art_aid=107040; Paul Biba, "Goldman Sachs Says Ebook Sales To Rise And Pbook Sales To Drop," TELEREAD (Apr. 14, 2010), *available at*: http://www.teleread.com/paul-biba/goldman-sachs-says-ebook-sales-to-rise-and-pbook-sales-to-drop/.

[70] Chris Davies, "Kindle eBook Sales Exceed Print Sales in US," SLASHGEAR (May 19, 2011), *available at*: http://www.slashgear.com/kindle-ebook-sales-exceed-print-sales-in-us-19153084/.

[71] *See* Pamela Samuelson, *Mapping the Digital Public Domain: Threats and Opportunities*, 66 LAW & CONTEMP. PROBS. 147 (Winter/Spring 2003) (noting the ways in which digital technologies may enhance the public domain).

[72] *See* Paul J. Heald, *Property Rights and the Efficient Exploitation of Copyrighted Works: An Empirical Analysis of Public Domain and Copyrighted Fiction Bestsellers*, 92 MINN. L. REV. 1031, 1046-50 (2008).

[73] *See* K. Shampanier, N. Mazar & D. Ariely, *Zero as a Special Price: The True Value of Free Products*, 26 MARKETING SCIENCE 742 (2007) .

The same would apply for any piece of music or movie. Thus, such works will have dramatically greater immediate distribution, and impact, than works entering the public domain prior to 1998. The very technology that has posed such a significant threat to copyrighted works presents an unprecedented opportunity for widespread dissemination of works in the public domain.

The dramatic lowering of the distribution costs has also had an impact, not only on the speed and extent of distribution of public domain works, but on the range of works that can now be cost-effectively distributed. Prior to 1998, obscure works of literature passing into the public domain were often unable to find the small number of individuals who might have been interested in the work. The costs of physical printing and distribution were too high to make it worth it to serve these very small markets. Today, the low digital distribution costs make it economically feasible to distribute works with even minimal demand, satisfying the so-called "long tail" of the demand distribution. Thus, even the more obscure post-1923 public domain works will be able to find an audience.[74]

3. Cultural Changes

Finally, the new public domain works face a different cultural landscape. Digital technology has not only lowered the cost of distributing copyrighted works, it has also made it far easier for third parties to creatively work with and adapt existing works. Prior to 1998, it took a good amount of technology and skill to take existing copyrighted works and adapt them to new purposes. Today, computer technology and software make this far easier. Third parties can take digital files and clip, reuse, and remix these works into new works.

The drastic reduction in the costs of adapting copyrighted works has expanded the universe of individuals who can engage in this kind of use. Prior to 1998, these kinds of uses were more limited to established players in the industry. After all, it required special equipment and knowledge to manipulate existing works. Moreover, disseminating the results of this kind of work required resources, since they still had to be distributed in physical form. Today, no special equipment, beyond a computer and some software, is required to either engage in this kind of reuse or to distribute the results to the world. Thus, individuals are far more engaged now in this kind of use.

This change in technology has led to an increased cultural interest in these remixes and mashups.[75] Demand for such remixes can be found everywhere from popular music to YouTube to television to motion pictures. Creators of popular music and television increasingly incorporate and reference existing works. Individuals and consumers increasingly incorporate creative works into their own works, posting the results on YouTube or in other venues. Moreover, as the technologies become easier to use and more accessible, the results are becoming increasingly sophisticated. As Larry Lessig and others have documented, we are increasingly living in a remix culture.[76]

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[74] *See* Chris Anderson, "The Long Tail," WIRED (October 2004), *available at* http://www.wired.com/wired/archive/12.10/tail.html; Deirdre K. Mulligan, *Neglecting The National Memory: How Copyright Term Extensions Compromise The Development Of Digital Archives*, 4 J. APP. PRAC. & PROCESS 451 (2002).

[75] *See* Negativland, *Two Relationships To A Cultural Public Domain*, 66-SPG LAW & CONTEMP. PROBS. 239 (2003).

[76] *See, e.g.*, Lawrence Lessig, REMIX: MAKING ART AND COMMERCE THRIVE IN A HYBRID ECONOMY (2008); Dan Hunter & Gregory Lastowka, *Amateur-To-Amateur*, 46 WM. & MARY L. REV. 951 (2004); Rebecca Tushnet, *Legal Fictions: Copyright, Fan Fiction, and a New Common Law*, 17 LOY. L.A. ENT. L.J. 651 (1997); Rosemary Coombe, *Objects of Property and Subjects of Politics: Intellectual Property Laws and Democratic Dialogue*, 69 TEX. L. REV. 1853 (1991); David Lange, *At Play in the Fields of the Word: Copyright and the Construction of Authorship in the PostLiterate Millennium*, 55SPG LAW & CONTEMP. PROBS. 139 (1992).

Many of these remixes to date have been made of existing copyrighted works. These uses raise some tricky questions regarding the scope of fair use. Thus, the scope of reuse has been limited both by law and by uncertainty. Once works pass into the public domain, however, the uncertainty is practically eliminated.[77] Public domain works can be freely appropriated by third parties for reuse in all manner of ways. For example, soon it will be open season on Mickey Mouse. Once Mickey Mouse passes into the public domain, third parties can incorporate Mickey Mouse freely into their own works. They can make works of art, comic books, movies, etc. incorporating Mickey Mouse, Minnie Mouse, Donald Duck, Winnie the Pooh, Superman, and other characters. Thus, as these new works pass into the public domain, we can expect an increased ability by third parties to adapt them to create new works and to distribute the results to a wide audience.

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So for all of the reasons articulated above, not only will the works passing into the new public domain be materially different in both their distribution technologies and cultural significance, they will enter a technological, economic, and cultural environment that is poised to make immediate and effective use of these works in ways that did not exist in 1998.[78]

III. THE PROMISE OF THE NEW PUBLIC DOMAIN

In this Part, I explore some of the implications of the new public domain for copyright policy more generally. I begin by describing some of the more recent literature on the public domain that arose in the wake of the copyright term extension. As a result of this rich literature, we have a better understanding and appreciation of the role that the public domain can play in the copyright balance. I then discuss how the important differences in the new public domain, when understood in light of this new literature, help support the argument that the public domain will potentially play a far more significant role in the copyright balance. More specifically, the potential exists for the creation of a rich repository of important and iconic cultural works, which a wide range of individuals, empowered by new technology, can freely access, share, re-cast, and transform.

A. Public Domain Theory and Literature

The copyright term extension in 1998 was opposed by a wide range of economists, copyright scholars, businesses, and public interest groups.[79] Indeed, it is difficult to find any issue in copyright law for which there was greater agreement within the academic copyright community. Thus, in many ways, the successful extension of the copyright term was a bitter defeat and a frustrating reminder of the powerlessness of copyright academics, particularly in the face of determined and focused economic interests.

One positive side effect of the defeat, however, was a resurgence in academic interest regarding the public domain. Well before the debate over term extension, a number of noted scholars had written eloquently about the importance of the public domain. Both Ralph Brown and Benjamin Kaplan wrote about the importance of the public domain as a wellspring of creativity.[80] L.

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[77] *See* David Fagundes, *Crystals in the Public Domain*, 50 B.C. L. REV. 139 (2009).

[78] This reflects the fact that we are talking about two parallel time periods, the 1920s and the 2000s, which experienced dramatic technological and economic changes in the copyright markets.

[79] *See* Liu, *supra* note __, at 417 n. 51.

[80] Ralph S. Brown, Jr., *Unification: A Cheerful Requiem for Common Law Copyright*, 24 UCLA L. REV. 1070, 1093 (1977); Benjamin Kaplan, AN UNHURRIED VIEW OF COPYRIGHT 112 (1967); *see also* Zechariah Chafee, Jr., *Reflections on the Law of Copyright*, 45 COLUM. L. REV. 719, 721 (1945)

Ray Patterson's work also highlighted the role played by a vibrant public domain.[81] Thus, early commentators recognized the role that the public domain played in setting the overall copyright balance.[82]

The striking thing about some of the earliest accounts of the public domain was the way in which they characterized copyright protection as the exception rather than the rule. These early scholars saw the public domain as the general background, the default rule, against which the limited copyright rights operated. This made sense, given the structure of copyright law at the time. Prior to the 1976 Act, the public domain played a more prominent role in the copyright balance, as there were many more ways in which works could pass into the public domain, e.g. through failure to renew the copyright or failure to comply with formalities such as notice.

The 1976 Act, however, effected significant changes in the nature and scope of the public domain. Beyond extending the term of copyright protection, the Act also significantly restricted the ways in which works could pass into the public domain. First, the 1976 Act did away with the renewal term, replacing it with a single, unified term. Thus, works no longer passed into the public domain due to failure to renew. Second, and perhaps more significantly, the 1976 Act and the later 1988 amendments weakened the effect of formalities. After the 1976 and 1988 Acts, failure to comply with formalities such as notice no longer cast works into the public domain. This had the practical effect of bringing within copyright a vast number of works that formerly would have been in the public domain. It had the effect of changing the default rule, from a presumption that an un-marked work was in the public domain, to a presumption that such works were protected by copyright.[83]

In the wake of some of these changes, a number of scholars began expressing concern about the reduced scope of the public domain. Both David Lange and Jessica Litman wrote early, prescient articles about the important role of the public domain in promoting creative expression, and the ways in which that role was being undermined by more expansive visions of copyright.[84] These early articles began sounding the alarm.[85]

It was not until the recent term extension debate, however, that the public domain became a subject of sustained interest to a broad range of copyright scholars.[86] In building the case against term extension, many commentators were forced to come up with a clearer account of what, precisely, was being lost through term extension. This, in turn, led to focused attention on the con-

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[81] L. Ray Patterson & Stanley W. Lindberg, THE NATURE OF COPYRIGHT: A LAW OF USERS' RIGHTS (1991).

[82] *See* James Boyle, *The Second Enclosure Movement And The Construction Of The Public Domain*, 66-SPG LAW & CONTEMP. PROBS. 33 (2003) (tracing the early history of the development of the idea of public domain); *see also* Mark Rose, *Nine-Tenths Of The Law: The English Copyright Debates And The Rhetoric Of The Public Domain*, 66-SPG LAW & CONTEMP. PROBS. 75 (2003); Tyler T. Ochoa, *Origins and Meanings of the Public Domain*, 28 U. DAYTON L. REV. 215 (2002) (tracing history of the concept).

[83] *See* Lawrence Lessig, *Re-crafting a Public Domain*, 18 YALE J.L. & HUMAN. 56, 57 (2006); Diane Leenheer Zimmerman, *Is There A Right To Have Something To Say? One View Of The Public Domain*, 73 FORDHAM L. REV. 297 (2004); Jessica Litman, *Lawful Personal Use*, 85 TEX. L. REV. 1871 (2007).

[84] Jessica Litman, *The Public Domain*, 39 EMORY L.J. 965, 976 (1990); David Lange, *Recognizing the Public Domain*, 44 LAW & CONTEMP. PROBS. 147 (Autumn 1981).

[85] *See also* Yochai Benkler, *Free as the Air to Common Use: First Amendment Constraints on Enclosure of the Public Domain*, 74 N.Y.U. L. REV. 354 (1999); Keith Aoki, *Authors, Inventors And Trademark Owners: Private Intellectual Property And The Public Domain*, 18 COLUM.-VLA J.L. & ARTS 191 (1994); James Boyle, SHAMANS, SOFTWARE & SPLEENS: LAW AND THE CONSTRUCTION OF THE INFORMATION SOCIETY (1996).

[86] *See, e.g.*, James Boyle, THE PUBLIC DOMAIN: ENCLOSING THE COMMONS OF THE MIND (2008).

crete benefits of the public domain. These efforts were pushed along by a landmark conference at Duke, focusing expressly on the public domain and its role in the copyright balance.[87]

A good deal of this literature was definitional, analogic, or cartographic in nature, addressing the question: what, precisely, do we mean when we speak of copyright's public domain?[88] Was the public domain merely the set of works for which the term of copyright protection had expired? Or did it more broadly encompass things – such as facts, ideas, concepts – that could never be the subject of copyright protection?[89] Or perhaps even more broadly, did it include the set of all permissible uses, such as fair use? Much of the literature was aimed at coming to a clearer and more precise understanding of the term public domain.

Though in many ways descriptive, this literature also clearly had a normative impulse. It addressed, both implicitly and explicitly, the question: why do we care about these definitions? What is to be gained by, as Edward Samuels put it, "reifying the negative?"[90] Why not, for example, simply think of the public domain as what is left over, the negative space? Many scholars argued that focusing on a concrete and precise definition of the public domain not only helped foster clearer thinking about the public domain, but also served to give the concept rhetorical force, as a counterweight to unthinking copyright expansion. In more practical terms, as James Boyle argued, an affirmative account of the public domain would enable the building of coalitions to protect it, much as the concept of "the environment" facilitated the rise of the environmental protection movement.[91]

In addition to considering the definitional issue, much of the literature focused sustained attention on the concrete normative benefits of the public domain. To some extent, this was a response to arguments that the public domain in fact had few such benefits. During the extension debate, many proponents of term extension had argued that the public domain was a repository of low-value works, and therefore was not terribly important.[92] Others argued that, although the public domain might contain some valuable works, they were underutilized because no one had any incentive to commercialize them, or conversely (and somewhat contradictorily) because their value had been dissipated through overuse.[93]

In responding to these arguments, commentators detailed a number of concrete benefits derived from the public domain. First, many persuasively argued that public domain status would lead to increased, not decreased, dissemination of copies of public domain works. From a theoretical perspective, this was due to the elimination of not only royalties, but potential licensing costs, which in some cases could be quite high (for example, finding the copyright owner, negotiating a license, dealing with legal uncertainty, etc.). Empirical work by Paul Heald has supported this

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[87] Symposium, *The Public Domain*, 66 LAW & CONTEMP. PROBS. 1 (Winter/Spring 2003); James Boyle, *Foreword: The Opposite of Property?*, 66 LAW & CONTEMP. PROBS. 1, 29-30 (Winter/Spring 2003).

[88] *See* Pamela Samuelson, *Enriching Discourse on Public Domains*, 55 DUKE L.J. 783 (2006); Pamela Samuelson, *Mapping the Digital Public Domain: Threats and Opportunities*, 66 LAW & CONTEMP. PROBS. 147 (Winter/Spring 2003); James Boyle, *The Second Enclosure Movement And The Construction Of The Public Domain*, 66-SPG LAW & CONTEMP. PROBS. 33 (2003); David Lange, *Reimagining the Public Domain*, 66 LAW & CONTEMP. PROBS. 463 (2003).

[89] *See, e.g.*, Lawrence Lessig, *Re-crafting a Public Domain*, 18 YALE J.L. & HUMAN. 56, 57 (2006).

[90] Edward Samuels, *The Public Domain in Copyright Law*, 41 J. COPYRIGHT SOC'Y U.S.A. 137, 150 (1993); Edward Samuels, *The Public Domain Revisited*, 36 LOY. L.A. L. REV. 389 (2002).

[91] James Boyle, *The Second Enclosure Movement And The Construction Of The Public Domain*, 66-SPG LAW & CONTEMP. PROBS. 33 (2003); *see also* James Boyle, *Cultural Environmentalism And Beyond*, 70-SPG LAW & CONTEMP. PROBS. 5 (2007).

[92] *See, e.g.*, Scott M. Martin, *The Mythology Of The Public Domain: Exploring The Myths Behind Attacks On The Duration Of Copyright Protection*, 36 LOY. L.A. L. REV. 253 (2002).

[93] *See id.*

view.[94] Thus, one concrete benefit can be seen in the wider dissemination and availability, at lower cost, of public domain works. This furthers the broad copyright interest in expanding access to creative works.

Second, a rich and vibrant public domain can encourage greater creativity. As many commentators have long noted, authors and creators often draw on prior works for inspiration. No work is completely and utterly original. To the extent more works are in the public domain, authors and creators have more material to draw upon in creating their own works. Moreover, they can build upon these works without incurring the not-insignificant costs of royalties or licensing. Thus, from an economic perspective, a robust public domain reduces the cost of creating additional works by reducing the cost of one of the critical inputs.

More interesting, however, has been recent attention on the role the public domain can play, not in the economics of creativity, but in the psychology of creativity. David Lange, Julie Cohen, and others have focused attention on the creative process and on the intrinsic rather than extrinsic motivations for creativity.[95] Much recent research on the psychology of creativity has revealed the importance of freedom and play in the creative process. Scholars such as Lange and Cohen have noted how copyright law can inhibit the creative impulse by limiting the freedom of authors to engage with existing works. Even the need to consider asking for permission can have an impact on the creative impulse. Conversely, a robust public domain, as a permission-free zone, can play an important role in supporting and encouraging these intrinsic motivations, in freeing up the artistic imagination.[96]

Relatedly, a robust public domain encourages, not only more creativity, but a broader range of perspectives. In many cases, copyright owners can not only extract payment for use of their works, but also control what kinds of uses are made of their works. And indeed, there is an extensive history of copyright owners using copyright to prevent uses with which they disagree. For example, the estate of James Joyce has used copyright to restrict particular kinds of critical commentary. The owners of the copyright in Martha Graham's dances have prevented certain interpretations with which they disagree. The owners of the copyright in Samuel Beckett's "Waiting for Godot" refused to give permission for a version of the play in which the tramp characters were played by women. Once these works are in the public domain, however, this kind of control vanishes, and we can expect a far wider range of perspectives on existing works.

Third, a robust public domain plays an important role in facilitating, not only an increase in the absolute amount of creative effort, but an expansion in the range of individuals who engage in creative endeavors. Once the economic barriers to building on existing works are eliminated, productive activity is no longer limited to those who have the resources and sophistication to trace copyright ownership, negotiate licenses, and pay royalties. Instead, anyone who has access to the original work can build upon it. Thus, a robust public domain can play an important role in in-

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[94] Paul J. Heald, *Property Rights and the Efficient Exploitation of Copyrighted Works: An Empirical Analysis of Public Domain and Copyrighted Fiction Bestsellers*, 92 MINN. L. REV. 1031, 1046-50 (2008).

[95] *See* David Lange, *Reimagining the Public Domain*, 66 LAW & CONTEMP. PROBS. 463(2003); Julie E. Cohen, *Creativity And Culture In Copyright Theory*, 40 U.C. DAVIS L. REV. 1151 (2007); Julie E. Cohen, "Copyright, Commodification, and Culture: Locating the Public Domain," *in* THE FUTURE OF THE PUBLIC DOMAIN 121 (L. Guibault & P.B. Hugenholtz, eds. 2006); Roberta Rosenthal Kwall, *Inspiration And Innovation: The Intrinsic Dimension Of The Artistic Soul*, 81 NOTRE DAME L. REV. 1945 (2006); Lydia Pallas Loren, *The Pope's Copyright? Aligning Incentives With Reality By Using Creative Motivation To Shape Copyright Protection*, 69 LA. L. REV. 1 (2008); Note, *Designing The Public Domain*, 122 HARV. L. REV. 1489 (2009).

[96] *See* David Fagundes, *Crystals In The Public Domain*, 50 B.C. L. REV. 139 (2009); Lawrence Lessig, *Recrafting a Public Domain*, 18 YALE J.L. & HUMAN. 56, 57 (2006) (public domain as permission-free and lawyer-free zone).

creasing participation in the creation of culture.[97] This is a view grounded, less in the ideal of romantic authorship, and more in the notion of participation and civic republicanism.[98]

Fourth and finally, some commentators have focused, not on the actions of creators, but on the end-results of their creation, arguing that a robust public domain supports the creation of a rich and satisfying culture. This view departs somewhat from the general ostensible position of aesthetic neutrality in copyright.[99] It asks whether our copyright laws are successful in creating a rich and robust culture.[100] On this account, rather than limiting the development of subsequent works to those who own the original copyright (or can negotiate a license), a robust public domain enables a greater diversity of expression by a greater number of individuals, and this is, on balance, a good thing.

At the same time, there have been voices counseling some caution about the unalloyed benefits of the public domain. Unlike some earlier critiques of the public domain, these accounts acknowledge the general benefits of a robust public domain. However, they note some of the ways in which the public domain may have distributional consequences, favoring some while harming others. For example, Anupam Chander and Madhavi Sunder have noted how an overly idealized notion of the public domain may fail to recognize the harms suffered by those who do not have the means to commercially exploit valuable resources of which they are stewards.[101]

Thus, in the years immediately before the term extension and during the subsequent freeze in the public domain, there has been a flourishing of academic literature on the importance and value of the public domain. The result is a far richer and more nuanced understanding of what we mean when we speak of the public domain and the role that the public domain can potentially play in setting the copyright balance. It is somewhat poignant, and perhaps not at all unexpected, that this understanding came soon after these benefits of the public domain were temporarily frozen due to the term extension.

B. The Public Domain's New Potential Role

The new literature on the public domain provides a valuable framework for understanding how the new public domain, as described in the preceding sections, is poised to play an even more important role in setting the overall copyright balance. To some extent, the extensive definitional literature on the public domain is less directly relevant to the new public domain as defined in this Article. This Article has adopted a narrow definition of the public domain, limiting it to just the set of works for which copyright protection has expired. Thus, although much careful and important work has been done to better define the public domain, this better understanding will have less of an impact on this particular issue.

Yet the new public domain can have a definitional impact in other ways, not discussed in this literature. To an extent, some of this literature is motivated by a desire to expand the legal definition of the public domain, as a way of providing a counterweight to copyright expansionism. However, another way of expanding our understanding of the public domain is to expand, not its definition, but its content. Even if we keep a particular definition of the public domain constant,

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[97] *See* Negativland, *Two Relationships To A Cultural Public Domain*, 66-SPG LAW & CONTEMP. PROBS. 239 (2003).

[98] *See* David Lange, *Reimagining the Public Domain*, 66 LAW & CONTEMP. PROBS. 463 (2003); Note, *Designing The Public Domain*, 122 HARV. L. REV. 1489 (2009).

[99] *See* Alfred Yen, *Copyright Opinions and Aesthetic Theory*, 71 S. CAL. L. REV. 247 (1998).

[100] *See* John Fiske, TELEVISION CULTURE (1987) (coining term "semiotic democracy"); William Fisher III, PROMISES TO KEEP (2004).

[101] Anupam Chander & Madhavi Sunder, *The Romance of the Public Domain*, 92 CAL. L. REV. 1331 (2004).

we can still increase its practical significance by ensuring that the definition or category is populated by a rich and ever-increasing set of important works.

Once the important and iconic works of the 1920s and 1930s begin entering the public domain, the practical definition of the public domain (or at least one part of the public domain) will have been expanded. Once Mickey Mouse enters the public domain, the content of the public domain will have changed, along with our understanding of what it means. Once the public domain contains, for the first time, major motion pictures and other new types of works, we will think of the public domain in different terms. In this way, the relevance and importance of the public domain can be increased without changing its definition.

Moreover, as more important works enter the public domain, the popular appreciation for and understanding of the public domain will change as well. To some extent, the potential benefits of a robust public domain have not yet been fully realized, given the nature of the works pre-1923 and the limited means of distribution of these works pre-1998. The iconic works about to enter the public domain, along with the new environment that these works will soon enter, hold the potential that the public domain will have a greater practical and more immediate relevance to the general public.

For example, owners of eBook readers like the Kindle will see a direct, concrete benefit when a host of literary works pass into the public domain on January 1, 2019, as they will immediately have free access to a list of new works. Similarly, once other companies begin making and selling their own Mickey Mouse or Winnie the Pooh movies, books, comics, etc., the consuming public will begin to see the practical benefits of the new public domain in a way that is far more concrete than general appeals to the abstract idea of a public domain.

This, in turn, holds out the potential for the building of coalitions around protecting the public domain. Coalitions are more likely to form when the members have a direct and concrete interest in the subject matter. Until recently, the popular interest in the public domain has been relatively limited, as its benefits have been diffuse. Once those interests become more concrete, future attempts to limit the public domain will run into more resistance.[102] This is likely one reason many copyright owners have fought so fiercely to extend the copyright term, to prevent these interests from forming.

Our better understanding of the normative function of the public domain can also shed light on the role of the new public domain. Certainly, the benefits from dissemination of public domain works will be greater and more immediate. As already mentioned above, the important literary, musical, and audio-visual works of the 1920s and 1930s will have an already existing and well-developed infrastructure for immediate and low-cost dissemination. Rather than waiting for the physical production and distribution of public domain works, consumers will have immediate free access to these works. Indeed, one could imagine detailed lists of soon-to-be-public-domain works that are "coming soon," just as new movies or DVDs are announced prior to distribution.

In addition, the creative benefits of the new public domain will potentially be greater. New artists will be able to build upon a rich new set of important works. Moreover, they will have the technological ability to transform these works and distribute them around the world at nearly zero cost. Thus, for example, once Mickey Mouse passes into the public domain, other companies will be able to create their own Mickey Mouse cartoons and movies. Moreover, changes in technology mean that an even wider range of individuals can participate in the production of culture. Not only companies, but creative individuals will be able to make their own Mickey Mouse cartoons and distribute them to a world-wide audience.

These abilities will be enhanced by the nature of some of these new public domain works, as they will, for the first time, encompass significant numbers of creative works in fixed, recorded form, namely major motion pictures. Although pre-1998 public domain works included fixed vis-

[102] Along these lines, the political economy may grow to resemble that of patent law, where there are significant interests who rely upon the expiration of patents.

ual works (such as paintings, images, and photographs), they largely omitted fixed works in recorded form. Post 2018, individuals will be able to, for the first time, manipulate public domain talking movies. Thus, the types of expression based on public domain works will have expanded.[103]

The public domain status of these new works will be particularly important, given the insights from the psychological literature on creativity. By expanding the scope of the public domain and populating it with important works that have continuing relevance today, the new public domain holds the potential for a wider and richer realm of creative play. This realm will be free from the uncertainty of fair use or concerns about royalties and licensing.[104] Thus, if this literature is accurate, we can expect not only differences in the amount of creative activity, but the nature of that activity. The end result, will be a more robust and diverse cultural landscape.

Of course, there may be costs incurred by a new and more robust public domain. One potential risk is that critics of the public domain may be right, and that there will be little incentive to commercialize public domain works, since those who commercialize these works (e.g. by putting them in digital form, promoting them to a wide audience) will not be able to keep others from free-riding on their efforts. However, the dramatic reduction in the costs of distribution suggest that there is little public goods concern here. Moreover, empirical studies suggest that existing incentives are more than adequate to ensure commercialization of these works.[105]

Certainly, former copyright owners will experience a real loss. For example, Disney Corp. stands to lose hundreds of millions, if not billions, in revenue from the expiration of its copyrights. Yet this revenue is a direct transfer to Disney from consumers. Disney was able to obtain this revenue by using copyright law to restrict free dissemination and prevent competition. This was justified, at least originally, by the need to provide incentives to create works in the first place. But having created them based on the existing copyright term, there is no justification for future such restrictions. Thus, while this is a private loss to Disney and other copyright holders, it is not a net social loss, as the public will reap substantial benefits from the public domain status of these works and their subsequent wide dissemination.

Perhaps more serious is a potential concern about the loss of coherence of formerly copyrighted works. This is not a concern about the economic benefit to the copyright owner, but rather a concern about losses experienced by consumers as a result of the dissipation of the meaning of a work. For example, once others are free to make their own Mickey Mouse cartoons, or tell their own Winnie the Pooh stories, the possibility exists that we will have many variations of Mickey Mouse (a Chinese Mickey Mouse, a drug-dealing Mickey Mouse, an alien Mickey Mouse), such that the value that consumers place on a coherent vision of Mickey Mouse will be reduced. This is a serious concern, and one that has been thoughtfully developed by Justin Hughes, in particular.[106]

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[103] Unfortunately, the public domain status of sound recordings is more complicated. Pre-1972 sound recordings are protected, not by federal copyright, but by a patchwork of state laws. Most of these laws protect sound recordings indefinitely. In 1972, Congress placed an outer time limit on protection, set at 2067. Thus, even these early sound recordings, unlike fixed motion pictures, will likely be protected until 2067. However, the underlying musical works may have passed into the public domain if sheet music for those works was published during this time.

[104] *See* David Fagundes, *Crystals in the Public Domain*, 50 B.C. L. REV. 139 (2009).

[105] *See* Paul J. Heald, *Property Rights and the Efficient Exploitation of Copyrighted Works: An Empirical Analysis of Public Domain and Copyrighted Fiction Bestsellers*, 92 MINN. L. REV. 1031, 1046-50 (2008). *See generally* the widespread current availability of public domain literature in digital form.

[106] *See* Justin Hughes, *"Recoding" Intellectual Property and Overlooked Audience Interests*, 77 TEX. L. REV. 923 (1999); *see also* Leslie A. Kurtz, *The Methuselah Factor: When Characters Outlive Their Copyrights*, 11 U. MIAMI ENT. & SPORTS L. REV. 437, 451 (1994) ("These characters may cease to exist as we know them, if they are given to the public for unrestricted use."); Alex Kozinski, *Mickey & Me*, 11 U. MIAMI ENT. & SPORTS L. REV. 465 (1994) (calling this an "anti-utilitarian" argument); Michael

Note that this is a concern that is somewhat unique to expressive and communicative products such as copyrighted works. When it comes to other consumer products, we do not ordinarily object to variety or a wide range of different products or features. Indeed, we ordinarily believe that this is a benefit to consumers. We do not believe that consumers would be better off with a single shared understanding of the specific features of a toaster oven or car radio. Similarly, a good argument can be made that diversity and a wide range of options serves consumers of copyrighted works. By giving Disney exclusive control over Mickey Mouse, we fail to serve the market for alternative visions of Mickey.

At the same time, communicative works are not entirely like other consumer products in that the experience of some copyrighted works depends on a shared vision of that work, and consumers do seem to derive some value from this.[107] For example, imagine that J.K. Rowling had not had the right to control sequels of her first Harry Potter book.[108] Others would have written their own sequels, based on the popular characters. Although Rowling herself could have proceeded to write her own sequels, the singular vision and coherent plot would have been diluted by these other versions. Thus, in this instance, some consumers might well prefer to have less choice, less variety.

Although a sustained analysis of this phenomenon is beyond the scope of this Article, there are some initial responses. One answer is that the expiration of the copyright provides one way of satisfying both of these interests. It gives copyright owners a period of exclusive control, during which they can articulate a coherent and singular vision of that work. Consumers who value this can thus satisfy this interest, even though it comes at the expense of consumers who would value different visions of that work. Once the copyright term expires, however, the balance shifts, and the interests of those with more diverse preferences can be satisfied, at the expense of those who prefer a more limited view.[109]

Another answer is that this may be addressed, even after the expiration of the copyright term, through doctrines outside copyright law, such as trademark law. Disney will be able to make its own Mickey Mouse movies after the expiration of the copyright, and Disney's strong trademark rights will ensure that consumers can easily choose the version of Mickey authorized by Disney. In this way, those who prefer the vision set forth by Disney can still get access to that version, even if they will need to screen out the influence of other versions.[110]

Thus, in the end, the new public domain holds out the potential for a richer and more vital realm of free creative play accessible to an unprecedentedly broad range of cultural participants. It will be populated by some of the most important and iconic cultural works of the 1920s, 30s, and 40s. Access to these works will be free and robust. Moreover, technology will enable a far wider range of individuals to access, share, re-cast, and transform these works in new, interesting, and unexpected ways. The result is, potentially, an unprecedented level of robust and uninhibited creativity.

Abramowicz, *A Theory Of Copyright's Derivative Right And Related Doctrines*, 90 MINN. L. REV. 317 (2005) ("Should Mickey Mouse enter the public domain, there might be reduced monopoly pricing of Steamboat Willie, but that benefit seems trivial and is not the focus of the statute's critics. The more significant effect would be to allow, subject to trademark limitations, anyone to insert Mickey Mouse into their own films and comic books. Do we really need even more Mickey Mouse movies and comic books than we already have?"); *but see* Paul J. Heald, *Does The Song Remain The Same? An Empirical Study Of Bestselling Musical Compositions (1913-1932) And Their Use In Cinema (1968-2007)*, 60 CASE W. RES. L. REV. 1 (2009) (providing some empirical evidence countering the "overgrazing" thesis).

[107] Is this a network externality?

[108] J. K. Rowling, HARRY POTTER AND THE SORCEROR'S STONE (1998).

[109] *See* Joseph P. Liu, *Copyright and Time: A Proposal*, 101 MICH. L. REV. 409 (2002).

[110] *See also* Alex Kozinski, *Mickey & Me*, 11 U. MIAMI ENT. & SPORTS L. REV. 465 (1994) (noting the potential First Amendment issues raised by a contrary view).

IV. THE PERILS OF THE NEW PUBLIC DOMAIN

Although the end of the term extension freeze holds out the potential of a vital and re-invigorated public domain in copyright, there is no guarantee that this will come to pass. Indeed, there are many legal obstacles that potentially stand in the way. Specifically, the owners of expiring copyrights will look for many ways to limit free use of their works. And existing law is not as clear as it could be about precisely what happens to works that pass into the public domain.

This Part addresses a number of these concerns and attempts to anticipate and resolve some of these issues. In particular, this Part takes a look at three main issues: (1) the potential for another term extension; (2) the use of trademark law as a way of limiting free use of public domain works; (3) various doctrines in copyright law that may be invoked to limit free use. [111] Although some of these issues have been addressed in existing case law involving public domain works, the scale and significance of the new public domain will put increasing pressure on existing areas of doctrinal uncertainty, as well as raise novel legal issues. In each of these areas, this Part offers a number of concrete responses to these problems, in order to ensure that the new public domain fulfills its promise.

A. Another Term Extension? – Sonny Bono Redux

The first and most immediate threat to the new public domain is, of course, that it may not come to pass. This would be so if Congress extends the term of copyright once again, just as it did in 1998 and on many previous occasions. If Congress does in fact extend the copyright term again, we would face another extended period during which no published works would enter the public domain.

This is not an insignificant risk. On the one hand, the interests opposed to term extension have grown stronger in the years since the 1998 term extension. Prior to that debate, these interests were not very organized, and the general public interest in term extension was limited or nonexistent. The term extension debate galvanized many of the interests opposed to extension. Moreover, the constitutional challenge to the term extension, and the subsequent U.S. Supreme Court decision, led to increased visibility for this issue. Finally, as discussed in the preceding sections, there are more private interests that now have a concrete stake in a robust public domain.[112]

At the same time, the fundamental public choice issue remains. Companies like Disney derive concrete and substantial financial benefits from term extension. As already noted above, Disney receives more than $10 billion per year from its rights in Mickey Mouse, Minnie Mouse, Donald Duck, Winnie the Pooh, and the rest.[113] Disney thus stands to lose a tremendous amount if these works pass into the public domain. Add that amount to all of the other potential future licensing revenues for all other works subject to term extension, and you arrive at a staggering figure.

Owners of expiring copyrighted works thus have huge incentives to spend tremendous amounts of money lobbying for yet another term extension. And while the harm of extension to

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[111] *See* Jon M. Garon, *Media & Monopoly In The Information Age: Slowing The Convergence At The Marketplace Of Ideas*, 17 CARDOZO ARTS & ENT. L.J. 491 (1999) ("a combination of trademark law and subsequent design changes will keep Mickey Mouse safe in perpetuity"); Jessica Litman, *Mickey Mouse Emeritus: Character Protection And The Public Domain*, 11 U. MIAMI ENT. & SPORTS L. REV. 429 (1994) (highlighting the potential threat).

[112] *See* Marshall Leaffer, *Life After Eldred: The Supreme Court And The Future Of Copyright*, 30 WM. MITCHELL L. REV. 1597 (2004) (expressing view that future term extensions will be difficult to pass).

[113] *See* Vanessa Gisquet & Lacey Rose, *Top Characters Gross $25B*, FORBES.COM (Oct. 19, 2004), available at: http://www.forbes.com/lists/2004/10/20/cz_vq_lr_1020fictionalintro.html (estimating gross worldwide merchandising and licensing revenues for the following characters: Mickey Mouse and friends ($5.8 billion), Winnie the Pooh and friends ($5.6 billion)); Marvin Ammori, *The Uneasy Case For Copyright Extension*, 16 HARV. J.L. & TECH. 287 (2002).

the public (through raised prices and foregone uses) is significant in the aggregate, it is distributed diffusely across many parties and individuals in the public at large, each of whom bears only a small fraction of the cost. Thus, public choice theory predicts that it will be more difficult and more costly for these interests to organize and oppose the more focused industry interests.[114]

The discussion in the preceding sections indicates that the potential harm from another term extension would be particularly significant. Because of the iconic nature of the works subject to the freeze, the foregone value of the public domain during the additional 20 year period may well be greater than the foregone value of the public domain from the preceding 20 year period. Thus, we cannot measure the value of the foregone public domain from 1923-43 with the value of the public domain from 1902-1922.

Moreover, a real risk exists that, the longer these important works are kept from the public domain, the more consumers will view the existing state of affairs as inevitable. Already, the extremely long term of copyright protection means that the concrete benefits of the public domain are relatively diffuse. Most consumers are vaguely aware of a public domain, but think of these works in relatively remote terms (e.g. Shakespeare, classical music, etc.). The longer they continue to think about the public domain in these terms, the less they will be concerned about future term extensions, since the benefits of the new potential domain have not yet been realized. The public will become accustomed, if it has not already done so, to a world in which Mickey Mouse is owned exclusively by Disney, and may soon view this as natural and inevitable.[115]

Thus, in order for the public domain to play a new and more robust role in the future, any future attempt to extend the copyright term retroactively must be defeated. An important part of resisting term extension will be to concretely document the harm from another extension. This will involve listing the precise works that will be kept from the public domain. This will also involve identifying specific parties that will be harmed by a future extension and obtaining their testimony. It will be important to document, in as concrete fashion as possible, the actual losses resulting from another term extension. Part of this will also involve summarizing and clearly articulating the policy arguments against such an extension.

An equally important task will be to develop the political support for resisting term extension. This will involve identifying public interest groups, libraries, academics, internet companies, and many other groups in order to build a robust coalition against term extension. Public attention will, of course, be very important, as will communication of these interests to the relevant lawmakers, particularly in districts that have companies that rely upon public domain works.[116]

B. The Trademark Problem – Mickey© vs. Mickey®

Assuming that the copyright term is not extended, the next greatest threat likely comes from trademark law. Unlike copyright law, trademark law places no temporal limit on the length of protection. Trademark protection lasts as long as the trademark is being used and as long as it serves the function of identifying the source of the particular good or service to which it is at-

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[114] *See* Liu, *supra note* ___ (describing the public choice pressures pushing toward term extension); *see also* Yochai Benkler, THE WEALTH OF NETWORKS: HOW SOCIAL PRODUCTION TRANSFORMS MARKETS AND FREEDOM (2006) (expressing belief that future extensions will meet more resistance); *but see* Lior Jacob Strahilevitz, Book Review, *Wealth Without Markets?*, 116 YALE L.J. 1472 (2007) (reviewing Benkler and expressing more pessimism).

[115] *See, e.g.*, Alex Kozinski, *Mickey & Me*, 11 U. MIAMI ENT. & SPORTS L. REV. 465 (1994).

[116] *See* Arlen W. Langvardt, *The Beat Should Not Go On: Resisting Early Calls For Further Extensions Of Copyright Duration*, 112 PENN ST. L. REV. 783 (2008); Arlen W. Langvardt, *Unwise Or Unconstitutional?: The Copyright Term Extension Act, The Eldred Decision, And The Freezing Of The Public Domain For Private Benefit*, 5 MINN. INTELL. PROP. REV. 193 (2004).

tached. Thus, trademark protection can potentially last forever. It is accordingly quite likely that owners of soon-expiring copyrights will try to protect their works through trademark law.[117]

Not all copyrighted works will be entitled to trademark protection.[118] Indeed, many if not most works will have no trademark significance at all, as they will not have been used to identify the source of a good or service. Thus, for example, third-party uses of the movie *Gone With the Wind* or the book *The Great Gatsby* will probably not raise any trademark concerns.[119] Other works, however, may have trademark significance. For example, United Airlines has prominently used George Gershwin's "Rhapsody in Blue," in its commercials, and therefore may have trademark rights in the song, as used in connection with airline services. Similarly, certain works of visual art may have been used as trademarks, to identify the source of a good or service.

Take, for example, the case of Mickey Mouse. The pictorial character Mickey Mouse is subject to copyright protection, which will eventually expire. After that point, Mickey Mouse will pass into copyright law's public domain and be available for others to copy, transform, and make derivative works of. At the same time, Disney undoubtedly has trademark rights in the Mickey Mouse symbol. Disney uses that symbol to identify its goods, and consumers undoubtedly associate pictures of Mickey Mouse with the Disney Corporation. Thus, Disney's trademark rights in Mickey Mouse will continue to exist after expiration of the copyright.[120]

In theory, this overlap of trademark and copyright need not be problematic, since copyright and trademark serve different goals.[121] Trademark law does not provide absolute rights over a particular word, logo, or symbol. It does not prevent others from engaging in any and all uses of a trademarked symbol. Instead, it only protects against uses that are likely to cause consumer confusion as to the source of a good or service, or to dilute the distinctive character of the particular symbol. So even if United Airlines has trademark rights in "Rhapsody in Blue," it cannot prevent a symphony orchestra from performing the song in a concert hall or recording and selling CDs of a particular performance. Thus, in theory, trademark does not necessarily stand in the way of free use of works that have passed into the public domain.

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[117] A number of scholars have written thoughtfully about the nexus between copyright and trademark in the specific context of fictional characters passing into the public domain. *See, e.g.,* Leslie A. Kurtz, *The Methuselah Factor: When Characters Outlive Their Copyrights*, 11 U. MIAMI ENT. & SPORTS L. REV. 437 (1994) (thoughtful analysis of the trademark implications of expiring copyrights in fictional characters) [hereinafter Kurtz, *Methuselah*]. *See also* Christine Nickles, *The Conflicts Between Intellectual Property Protections When A Character Enters The Public Domain*, 7 UCLA ENT. L. REV. 133, 168 (1999) [hereinafter Nickles, *Conflicts*]; Kathryn M. Foley, *Protecting Fictional Characters: Defining The Elusive Trademark-Copyright Divide*, 41 CONN. L. REV. 921, 932 (2009); Michael Todd Helfand, Note, *When Mickey Mouse is as Strong as Superman: The Convergence of Intellectual Property Laws to Protect Fictional Literary and Pictorial Characters*, 44 STAN. L. REV. 623 (1992). The discussion in this Part takes a broader approach and extends the analysis beyond fictional characters to apply to copyrighted works more broadly. *See generally* Tyler T. Ochoa, *Introduction: Rights Of Attribution, Section 43(A) Of The Lanham Act, And The Copyright Public Domain*, 24 WHITTIER L. REV. 911 (2003); Laura A. Heymann, *The Trademark/Copyright Divide*, 60 SMU L. REV. 55 (2007) (noting increasing overlap of trademark and copyright claims).

[118] *See, e.g.,* Nickles, *Conflicts supra note __* ,at 168 (1999) (noting the many ways that characters might fail to garner trademark protection); *Universal City Studios, Inc. v. Nintendo Co.*, 746 F.2d 112 (2d Cir. 1984) (no trademark rights in King Kong).

[119] *See Comedy III Prods., Inc. v. New Line Cinema*, 200 F.3d 593 (9th Cir. 2000) (finding to trademark rights in 30 second clip from a public domain Three Stooges film).

[120] *See, e.g., Warner Bros., Inc. v. Am. Broadcasting Co*., 720 F.2d 231, 246 (2d Cir. 1983) ("We do not doubt that the image of a cartoon character and some indicia of that character can function as a trademark to identify the source of a work of entertainment"); *DC Comics Inc. v. Unlimited Monkey Business, Inc.*, 598 F.Supp. 110 (D.C.Ga. 1984) (finding trademark rights in Superman and Wonder Woman characters).

[121] *See, e.g., Frederick Warne & Co. v. Book Sales*, 481 F. Supp. 1191 (S.D.N.Y. 1979); cf. *Boston Prof'l Hockey Ass'n. v. Dallas Cap & Emblem*, 510 F.2d 1004 (5th Cir. 1975).

In practice, however, the lines between copyright and trademark are not so clear. This is largely due to the systematic expansion of trademark liability over the past several decades. Although trademark law was historically a form of consumer protection law, it has evolved in recent years to become a broader entitlement. This has been in part a response to the licensing practices of trademark owners, who have increasingly placed their trademarks on a wide range of unrelated goods. Congress and the courts have, moreover, provided support for this view by expanding the substantive scope of trademark law. Thus, a very real possibility exists that owners of expired copyrights could use trademark law to restrict free use of these works.

1. Expansive Likelihood of Confusion Claims

Owners of expired copyrights may seek to limit free use of their works through expansive applications of the basic trademark liability standard: likelihood of consumer confusion. Originally, courts interpreted this standard rather narrowly, to apply to confusion by actual purchasers of goods with misleading trademarks on them. Over time, however, courts have expanded the nature and types of confusion that are potentially subject to trademark liability. Thus, for example, confusion as to endorsement or sponsorship can be a basis for liability. Secondary confusion by third parties (i.e. not the purchaser) can be a source of liability.[122] Even the use of a similar trademark to capture the initial interest of a consumer can be the source of liability, even if any such confusion is later dispelled before purchase.[123]

These expansive understandings of likelihood of confusion pose a risk to the free use of public domain works. Imagine, for example, the case of a Mickey Mouse film made, not by Disney, but by a third party after the copyright has expried. Disney could claim that the very use of Mickey Mouse in a new movie would likely cause consumer confusion. Disney could argue, quite persuasively, that most consumers viewing the Mickey Mouse film would mistakenly believe that Disney either created the film or endorsed the film.[124] Disney might even conduct surveys, which could establish actual confusion by consumers. At the very least, Disney could argue that consumers could be initially confused, even if that confusion is later dispelled through a disclaimer. If accepted, such a broad understanding of trademark law could effectively gut the ability of third parties to make use of certain public domain works, by making it impossible to create and market their own works based on the original.

This concern is not theoretical. Indeed, courts have found potential trademark liability under circumstances similar to those described above. In *Frederick Warne & Co. v. Book Sales*,[125] for example, the plaintiff was the publisher of a number of Peter Rabbit books written and illustrated by Beatrix Potter. The books and the illustrations had passed into the public domain, and defendants had published their own version of these books, using the same cover illustrations. The plaintiff brought a trademark suit, claiming that the defendant's use of the illustrations infringed on the plaintiff's trademark rights, since consumers could mistakenly believe that defendant's books were published by the plaintiff.

The court in *Warne* held that, even though the illustrations and books were in the public domain, it was possible that the illustrations had acquired secondary meaning and that defendant's

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[122] *See, e.g., Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-Le Coultre Watches*, 221 F.2d 464 (2d Cir.), *cert. denied*, 350 U.S. 832 (1955).

[123] *See, e.g., Mobile Oil v. Pegasus Petroleum*, 818 F.2d 254 (2d Cir. 1987); *Blockbuster Entertainment Group v. Laylco*, 869 F. Supp. 505 (E.D. Mich. 1994). *See* Litman, *Mickey Mouse Emeritus*, *supra note* __, at __.

[124] *See* Kurtz, *Methuselah*, *supra note* __, at 444 ("When a well-known character is used in a new story, such as a book, movie, or cartoon, the public may well be deceived into believing that they are getting the "real," or at least the "authorized," version of the character.").

[125] 481 F. Supp. 1191 (S.D.N.Y. 1979).

use of the illustrations could confuse consumers as to the source of the books. In particular, the court noted that the public domain status of the illustrations did not prevent them from serving a trademark function, and that consumers might well associate the cover illustrations with a particular publisher of the books. The court thus left open the possibility that defendant's use of the public domain illustrations could lead to a trademark infringement claim. Thus, it is possible that expansive understandings of trademark law might operate to practically restrict the ability of third parties to make use of public domain works.

This is particularly true of famous and iconic works, such as those that are about to enter the public domain. Visual characters such as Mickey Mouse, Minnie Mouse, Donald Duck, Winnie the Pooh, Superman, and others are famous and easily recognized around the world. They have also been used aggressively by the copyright owners as symbols for identifying products and services – i.e. as trademarks. As a result, the public has come to strongly identify these visual characters with a single producer, and that identification has up until now been backed by the force of copyright law. Thus, expansive applications of the likelihood of confusion standard are likely to find a form of confusion that may be used to justify limitations on third-party use.

Fortunately, trademark law contains doctrines that, properly understood, stand in the way of such a result. Courts have, for many years, been aware of the possibility that an overly expansive trademark law would conflict with other areas of intellectual property law. This has been most apparent in the area of patent law, where the public domain plays a more immediate role due to the far shorter patent term. For example, in *National Biscuit v. Kellogg*,[126] the U.S. Supreme Court addressed a potential conflict between trademark law and patent. In that case, the National Biscuit Company had, for many years, exclusively produced its shredded wheat cereal under a patent. When the patent expired, a competitor, Kellogg, began making the cereal and selling it under the term "shredded wheat." National Biscuit under unfair competition, arguing that consumers associated the term "shredded wheat" and the particular pillow-shape of the cereal with a single producer, namely National Biscuit.

The Supreme Court rejected National Biscuit's argument. Interestingly, the Court appeared to recognize that consumers might in fact associate the term "shredded wheat" and the pillow shape of the cereal with National Biscuit, given National Biscuit's long period of exclusive use. Nevertheless, the Court found no liability.[127] The Court pointed to the fact that, the patent having expired, competitors had the right to make and sell shredded wheat. Along with this right came the right to accurately label their product "shredded wheat."[128] Any other holding would result in trademark law undercutting the purpose of patent law. Thus, courts have recognized that, even in cases where some consumer confusion might be possible, trademark law should not be so broadly interpreted so as to limit the use of items that other areas of federal law have expressly placed into the public domain.

There is no reason in principle why the same understanding should not be applied to copyright law, and indeed, there are recent signs that the Supreme Court takes this point very seriously. In its recent decision in *Dastar v. Twentieth Century Fox*,[129] the U.S. Supreme Court used copyright principles to limit the potential scope of trademark law. In *Dastar*, the plaintiff Twentieth Century Fox originally owned the copyright to a television series about World War II. The work passed into the public domain when Fox failed to timely renew the copyright, and the defendant Dastar incorporated much of the Fox footage into its own television series, without crediting Fox. Fox sued under the Lanham Act, alleging that the failure to give Fox credit amounted

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[126] 305 U.S. 111 (1938).

[127] *See* Graeme Dinwoodie, "The Story of *Kellogg Co. v. National Biscuit Co.*: Breakfast with Brandeis," *in* Jane Ginsburg & Rochelle Cooper Dreyfuss, eds., INTELLECTUAL PROPERTY STORIES 220, 236-39 (2006) (noting ambiguities in the Court's discussion of secondary meaning).

[128] Addresses question re: whether could limit public domain use to visual depiction, but not the name.

[129] 539 U.S. 23 (2003).

to a "false designation of origin." The Supreme Court in *Dastar* rejected Fox's argument and held that Dastar was not liable.

The Court's opinion is interesting and somewhat odd in a number of ways. In particular, the Court drew a distinction between the origin of the physical product (i.e. the video tapes) and the copyrighted content (i.e. the footage), and held that the Lanham Act's protection of consumer interests extends only to the physical product. Therefore, according to the Court, there could be no false designation of origin in this case, since there was no false labeling of the physical video tapes. Some commentators have called into question the factual and doctrinal basis for this distinction, at least with respect to communicative works such as novels, movies, and the like.[130]

Nevertheless, the Court also based its opinion on the implications for copyright policy more generally. The Court held that such an expansive interpretation of trademark law would have the effect of practically hindering the ability of third parties to make use of works that had passed into the public domain. The Court noted that a contrary result in *Dastar* would give rise to a highly uncertain obligation about when individuals had to give credit for public domain materials that they incorporated into their own works. This would, in effect, create a "mutant species" of copyright law, akin to a moral right of attribution.[131] Thus, in *Dastar*, the Court limited the potential reach of trademark law through a direct appeal to copyright law policy and the importance of free use of public domain materials.

The reasoning in *Dastar* would appear to be applicable to other kinds of trademark claims based on the use of public domain works. [132] An overly expansive interpretation of likelihood of confusion would have the effect of limiting the ability of others to make free use of public domain works. Thus, courts should be quite hesitant to accept claims that the mere use of a formerly copyrighted work would inevitably lead to confusion. In the Mickey Mouse example above, third parties should be able to make and sell copies of public domain Mickey Mouse films, as well as create their own Mickey Mouse movies, without fear of trademark liability.[133]

This should be the case even if some consumers mistakenly believe that such movies originated with, or were endorsed by, Disney. Just as in the *National Biscuit* case, this mistaken belief is based on the fact that the law, for a very long time, gave Disney the exclusive right to make and authorize works incorporating Mickey Mouse.[134] Once Mickey Mouse passes into the public domain, this is no longer the case, and competitors are free to make their own Mickey Mouse movies without Disney's permission. Such a right would be greatly hindered if Disney could restrict such uses through trademark law. Thus, copyright policy and the importance of free competition should operate to trump whatever initial confusion might exist among consumers as a result of these uses.

Even if a court believed this kind of confusion was problematic, at most, the appropriate remedy would be a disclaimer, which would address the confusion without limiting the ability of a third-party to use the underlying work. Arguments based on disclaimers are not always well-

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[130] Cite.

[131] *Dastar*, 123 S. Ct. at 2050 (2003) ("To hold otherwise would be akin to finding that § 43(a) created a species of perpetual patent and copyright, which Congress may not do.").

[132] *See also Comedy III Productions v. New Line Cinema*, 200 F.3d 593 (9th Cir. 2000) (rejecting trademark claim based on 30-second clip from public domain Three Stooges film, because "If material covered by copyright law has passed into the public domain, it cannot then be protected by the Lanham Act without rendering the Copyright Act a nullity.").

[133] *See* Richard Ronald, Note, *Dastar Corp. v. Twentieth Century Fox Film Corp*., 19 BERKELEY TECH. L.J. 243, 256 (2004) ("The Dastar ruling will prove significant as more works of authorship fall into the public domain after their copyrights expire."); Lynn McLain, *Thoughts On Dastar From A Copyright Perspective: A Welcome Step Toward Respite For The Public Domain*, 11 U. BALT. INTELL. PROP. L.J. 71 (2003).

[134] *See* Helfand, *Mickey Mouse, supra note __*, at 663 ("When a character passes into the public domain, the reality of the marketplace and psychological associations between a character and its source remain intact. Even if the law will not protect the mark from infringers, the result is a mark in fact if not in law.").

received in trademark infringement cases, particularly ones adopting more expansive notions of trademark liability such as initial interest confusion. However, where there is a strong independent interest in promoting free use of a public domain work, a disclaimer should be more than enough to address any lingering concerns about confusion. And indeed, *Dastar* suggests that such a disclaimer may not even be necessary.

To be clear, Disney would still retain rights against uses that are classic trademark uses. So, for example, if a third party began selling products using a small picture of Mickey Mouse as a logo, Disney would still have the standard trademark claims against that party. If such a use caused consumers to mistakenly believe that the product was being sold by Disney, there should be a claim for trademark liability. However, Disney would not be able to use an expansive understanding of trademark law to prevent what are effectively non-trademark uses of the work, e.g. the creation and sale of a new Mickey Mouse movie, the packaging and reselling of an existing Mickey Mouse movie, etc.[135]

The above analysis raises an interesting question about the precise relevance of a work's public domain status in determining questions of likelihood of confusion. In particular, does the trademark analysis differ depending on whether the underlying work is in the public domain or still protected under copyright? Consider, for example, *Warner Bros. v. American Broadcasting Co.*[136] In that case, the owners of copyright and trademark rights in the characters Superman and Wonder Woman brought a lawsuit against proprietors of a singing-telegram company whose employees dressed up in costumes similar to those of Superman and Wonder Woman.

The court in that case found the defendants liable for both copyright and trademark infringement. The depictions of both Superman and Wonder Woman were still under copyright, and therefore these uses of those characters infringed upon the copyright owners exclusive rights. Moreover, the court held that these uses infringed upon the plaintiff's trademark rights, since consumers might mistakenly believe that they were authorized by the plaintiff copyright owner. To a large extent, this case seems to track instincts about the purpose of trademark law. After all, this kind of use does seem quite likely to cause confusion as to the source of the good or service.

But what would the trademark analysis look like, on the same facts, if Superman and Wonder Woman were in the public domain? Does this now change the trademark analysis? One possible response would be to treat the case exactly the same, on the grounds that copyright and trademark protect independent interests. Thus, the singing telegram company would still be liable. Yet this view would seem to be in some tension with a strong understanding of copyright law's public domain, since it would have the effect of limiting free uses of creative works that are no longer protected. Once these characters are in the public domain, presumably other people should be able to make, sell, and perform in their own Superman and Wonder Woman costumes.

The above scenario indicates that the public domain status of the underlying copyright is doing real work in affecting how we see the trademark analysis. It is not true that copyright and trademark are conceptually entirely distinct, and that we can therefore feel comfortable analyzing the trademark claims independently, without looking to copyright policy. Rather, just as the U.S. Supreme Court did in both *Dastar* and *National Biscuit*, courts interpreting trademark claims based on formerly-copyrighted works or formerly-patented products must take into account copyright and patent policies in an express fashion.

This, in turn, suggests that prior case law that finds trademark infringement based on the use of copyrighted characters or materials should be treated carefully when applied to copyrighted

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[135] *See* Foley, *Protecting*, *supra note* __, at 932 (arguing that, post *Dastar*, public domain fictional characters can serve as trademarks, but only for tangible goods, not for communicative works).

[136] 720 F.2d 231, 246 (2d Cir. 1983).

material that has passed into the public domain.[137] It is possible that these cases are wrongly decided, insofar as there should only be copyright liability and not trademark liability, even in cases where the underlying work is still under copyright. To some extent, the ready availability of copyright liability in these cases lessens the pressure on the trademark issue, since the scope of copyright protection is often (though not always) greater. Thus, we might view these cases as wrongly decided based on an insufficiently careful and attentive parsing of the proper scope of copyright and trademark. [138]

Alternatively, these cases can be distinguished based on the fact that, for the copyrighted works, copyright law in fact gives the copyright owner the exclusive right to use the work, and therefore consumer expectations are backed by the force of law. Conversely, when a work has passed into the public domain, there is no longer any legal basis for these expectations. Furthermore, the strong copyright interest in free use precludes the application of trademark liability. Unlike the cases where the work is still under copyright, once the work is in the public domain, there is a strong copyright interest in free use. Accordingly, there are good reasons for treating the public domain examples differently.[139]

In the end, there are doctrines in trademark law that, properly understood, prevent former copyright owners from using expansive understandings of likelihood of confusion to bar third parties completely from engaging in these uses of their works. In order for the public domain to fulfill its purpose, courts must be conscious of the potential conflict between trademark and copyright and be careful to police this boundary, as they have in the past. Thus, third parties should, consistent with a sound understanding of the limits of trademark law, be able to exercise their right to use public domain works freely.

2. Merchandising Claims

Even if courts recognize (as they should) that important copyright interests should operate to limit expansive likelihood of confusion claims, there may still be some uncertainty about precisely what kinds of uses invoke copyright interests, as opposed to trademark interests. For example, in the case of the new Mickey Mouse film, the divide between copyright and trademark is relatively clear, as the example involved a use that clearly fell within the core of copyright. Similarly, the use of a small Mickey Mouse symbol as a trademark falls comfortably within the scope of trademark, and raises few copyright concerns.

But what about uses that fall in between? For example, imagine that a third party produces, not a Mickey Mouse movie, but a Mickey Mouse suitcase? The visual depiction of the Mickey Mouse character on the suitcase would give rise to no copyright liability once the work is in the public domain. But would Disney have a trademark claim? What about a t-shirt with a large picture of Mickey Mouse? Or other Mickey Mouse merchandise, like a stuffed animal?

Here, copyright runs into another area of expanding trademark liability, namely merchandising. Over the past several decades, trademark owners have increasingly used their marks, not only

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[137] *See Lone Ranger, Inc. v. Cox*, 124 F.2d 650, 651-52, 654 (4th Cir. 1942) (enjoining third party use of Lone Ranger character); *Lone Ranger, Inc. v. Currey*, 79 F. Supp. 190, 191-95 (M.D. Pa. 1948) (same); *Brown v. It's Entm't, Inc.*, 34 F. Supp. 2d 854, 860 (E.D.N.Y. 1999) (same issue in the dilution context).

[138] *See* Helfand, *Mickey Mouse, supra note* __ (critiquing such cases for improperly merging copyright and trademark claims).

[139] *Cf. In re DC Comics, Inc.*, 689 F.2d 1042, 1052 (C.C.P.A. 1982) (Nies, J., concurring) ("Obviously, the subject designs are not necessary for competition if their use by others can be entirely barred under the copyright statute. If others become entitled to use the designs upon the expiration of copyright protection, the continued registration of the designs as trademarks may be addressed in the context of a conflicting claim of a right to use, but the question of possible loss of rights is not before us").

to identify the source of their goods, but as marketable goods in and of themselves.[140] They do so by attaching their marks to unrelated goods and merchandise, such as t-shirts, clothing, fashion items, etc. Moreover, consumers have evinced an increasing interest in purchasing such goods, based on the existence of the trademark itself and the communicative impact of the trademark. Thus, for example, a consumer might purchase a t-shirt or cap with the Red Sox logo, not because she believes the major league baseball team makes particularly good t-shirts or caps, but because of the presence of the symbol itself and the significant informational investments in that symbol that the Red Sox have made over the years. Again, this is a particular concern for some of the iconic works about to pass into the public domain, as the copyright owners have aggressively marketed merchandise based on these works.

This kind of use does not fit easily within the traditional framework of trademark law, as it is a fundamentally different kind of use, and the precise doctrinal basis for this kind of claim is not entirely clear. In these cases, the mark may be serving some source-identifying function, but that function seems secondary to its communicative function. Nevertheless, trademark owners have increasingly engaged in these kinds of uses, and some courts have been willing to recognize exclusive rights over these uses, under expansive notions of likelihood of confusion or dilution.[141]

Although the use of public domain works in this fashion – i.e. on t-shirts, posters, and other merchandise – sits uneasily between copyright and trademark, courts should err on the side of finding these uses by third parties privileged in cases involving public domain works. They should do so for two reasons: (1) the weak nature of the trademark interest; and (2) the importance of preserving a robust public domain.

Taking the second of these reasons first, the public domain interest in free use of images of Mickey Mouse and other similar creative works is extremely strong. Once Mickey Mouse passes into the public domain, copyright law principles clearly require that others be free to make and sell works based upon the character. These uses will quite logically include representations beyond simply making new Mickey Mouse films or stories. These uses will include other derivative works, such as posters, figurines, stuffed animals, and the like. If these uses were automatically deemed to be trademark violations, this would greatly undercut the ability of third parties to make use of these public domain works.[142]

Moreover, the countervailing trademark interest in these cases is more attenuated. It is important to note at the outset that these uses are not traditional trademark uses. We are not talking about the use of a small Mickey Mouse logo on the label of a shirt, to identify the source as Disney. Instead, Mickey Mouse itself is the product. Consumers are purchasing the stuffed animal or t-shirt, not because the image denotes the source as Disney, but because of its communicative function, its content. This interest is at the core of copyright law, not trademark law. The widespread and lower-cost dissemination of such public domain works is precisely one of the benefits of a work's passage into the public domain. Thus, to the extent that consumers purchase a good because of the public domain content, these uses should fall outside the scope of trademark law.[143]

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[140] *See* Stacey L. Dogan & Mark Lemley, *The Merchandising Right: Fragile Theory Or Fait Accompli?*, 54 Emory L.J. 461 (2005) [hereinafter Dogan & Lemley].

[141] *Id.*

[142] *See In re DC Comics, Inc.*, 689 F.2d 1042, 1052 n. 6 (C.C.P.A. 1982) (Nies, J., concurring) ("if a copyrighted doll design is also a trademark for itself, there is a question whether the quid pro quo for the protection granted under the copyright statute has been given, if, upon expiration of the copyright, the design cannot be used at all by others. Whether there should be a temporary, permanent, or no loss of trademark protection at that time must await resolution in an appropriate case and I merely note the problem. At least during the term of copyright here, if any, I find no reason to deny trademark rights.").

[143] *See* Helfand, *Mickey Mouse, supra note* __, at 668 ("courts should presume that the use is adornment when the character appears on the actual product itself rather than the label, tag, or packaging. Character merchandising is the prime example. Consumers buy the product because of the character rather than the

What about the argument that consumers will, as a factual matter, associate this kind of merchandise specifically with Disney? Even though a broad merchandising right rests on somewhat uncertain legal ground,[144] it is probably true that many consumers in fact believe that such uses are exclusive.[145] Thus, if a third party, after the expiration of the copyright term, made Mickey Mouse t-shirts, it is quite possible that a consumer survey would indicate that most consumers believed that the t-shirt was made by Disney. Is this not a classic trademark harm?

Once again, courts should recognize that some initial amount of confusion may need to be suffered in order to ensure that works in the public domain can be freely used. In *National Biscuit*, the U.S. Supreme Court acknowledged that some consumers might indeed associate the term "shredded wheat" with the National Biscuit, due to the long period of exclusive use, but ultimately found this trumped by the need for free competition. Similarly, any initial association with Disney, due to its lengthy period of exclusive use, should be trumped by the need for free use of public domain works.[146]

In addition, the strength of this association will diminish over time, as consumers become accustomed to the wide availability of Mickey Mouse merchandise from third parties.[147] One reason consumers have such an association is because Disney and other companies have enjoyed such a lengthy period of exclusive use, protected by copyright law. Thus, consumers have assumed a single source because copyright law ensured that this was the case (just as patent law did in the *National Biscuit* case). Once third-parties begin exercising their public domain rights, consumers will adjust their expectations.[148] Moreover, any initial confusion could be dispelled by the judicious use of disclaimers.[149]

A good example of an appropriately limited understanding of trademark law in this context can be found in the Ninth Circuit panel's initial decision in the recent case, *Fleischer Studios v. A.V.E.L.A.*[150] In *Fleischer Studios*, a panel of the Ninth Circuit rejected a trademark claim brought by the alleged owners of the trademark rights in the cartoon character Betty Boop, against defendants who had sold t-shirts, posters, and other paraphernalia with the cartoon image. The court noted that consumers purchasing merchandise with the Betty Boop image were purchasing it, not

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manufacturer. Once copyright no longer protects such use, the burden is on the plaintiff to overcome the presumption of adornment and prove that a significant number of consumers utilize the character as a true trademark"). Note that Helfand would make an exception for marks that are so famous and iconic that inevitably associated with source, e.g. Mickey Mouse. This would appear to be a major restriction in the public domain status. *See* Kurtz, *Methuselah, supra note* __ , at __ (rejecting this view).

[144] *See* Dogan & Lemley, *supra note* __.

[145] *See* Kurtz, *Methuselah, supra note* __, at 444 ("Several courts have noted that the public has come to expect the exploitation and licensing of well-known characters."); Litman, *Mickey Mouse Emeritus, supra note* __ (citing study); Kozinski, *Mickey & Me, supra note* __.

[146] *Warner Bros., Inc. v. Am. Broadcasting Co.*, 720 F.2d 231, 246 (2d Cir. 1983) (acknowledging the possibility that some consumers may be confused, but nevertheless refusing to find trademark liability because "[o]therwise the scope of protection a competitor is entitled to enjoy would be expanded far beyond what Congress prescribed in the Lanham Act").

[147] *See* Kurtz, *Methuselah, supra note* __, at 446 ("If others were permitted to offer unauthorized merchandise, so that a variety of versions competed for public acceptance, the perception that all such products are sponsored would be undercut.").

[148] A good analogy to this phenomenon can be found in the case of private label goods. Retail stores often sell their own private label goods in competition with branded goods, and in so doing, often adopted a very similar trade dress to the private label goods. Courts have generally been quite accepting of these similarities, despite the potential for some amount of confusion. Over time, consumers have been accustomed to similarities in trade dress, and have therefore adjusted their expectations. Note also: private labeling cases and the focus on free competition. Note also circularity of consumer expectations and the importance of establishing entitlement right away.

[149] *See* Kurtz, *Methuselah, supra note* __, at 451 (suggesting disclaimers as the proper potential remedy).

[150] 636 F.3d 1115 (9th Cir. 2011).

because of the source-denoting function of Betty Boop, but rather because of the image itself. The court expressly held that this kind of "functional" use of an alleged trademark fell outside of the scope of trademark law.[151] In addition, the court, citing the Supreme Court's *Dastar* opinion, noted that a contrary result would effectively limit the ability of third parties to make use of works that had passed into copyright's public domain.[152]

Unfortunately, the Ninth Circuit panel's initial decision in *Fleischer* was later vacated and superseded by the same panel.[153] In the superseding opinion, the panel no longer advanced its previous argument based on functionality (which the panel had apparently raised *sua sponte*), but instead focused on whether the plaintiff in *Fleischer* had established secondary meaning with respect to the Betty Boop character. On this score, the panel remanded for additional development of the record. Thus, the relevant portion of the initial opinion has unfortunately been vacated.

Nevertheless, that initial panel decision in *Fleischer* provides a model for future cases limiting the potential reach of overly-expansive merchandising claims. The panel's initial decision was correct in noting that such uses of public domain works sit properly within the scope of copyright law, not trademark law, because they are ultimately communicative uses.[154] Consumers purchase this merchandise primarily based on the content of the work, not based on its source-identifying function. The opinion suggests that courts can police this line by invoking trademark law's functionality doctrine, which bars trademark law from protecting aspects of a trademark (typically trade dress or product design) that are functional or utilitarian. A number of courts have extended this doctrine to apply to aesthetically functional aspects of a trademark, i.e. cases where the appeal of the trademark goes beyond its source identifying function.[155] The initial *Fleischer* opinion indicates that this doctrine can play a more important role in the future, as more such copyrighted works pass into the public domain.

3. Dilution Claims

Finally, courts will need to resolve potential conflicts between copyright policy and trademark dilution. In addition to the traditional cause of action for likelihood of confusion, federal law recognizes a cause of action for dilution for famous marks, either through blurring or tarnishment.[156] A use of a famous mark blurs that mark when it lessens the distinctive character of the mark. So, for example, if I sell Nike ball bearings, even though consumers are unlikely to be confused as to the source of those ball bearings, this use may weaken the uniqueness of the Nike mark. A use of a famous mark tarnishes that mark when it harms the reputation of the mark, typically through use on an unseemly or inferior product. So, for example, if I open a Nike strip club, again there will be little confusion, but there may be harm to the reputation of the mark.

Owners of expiring copyrights may attempt to use these doctrines to further limit use of their works. So, for example, if a third party made a pornographic Mickey Mouse film, Disney could bring a lawsuit for dilution, either through blurring (i.e. arguing that this use dilutes the distinctive

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[151] *See also International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912 (9th Cir.1980). *But see Boston Prof'l Hockey Ass'n. v. Dallas Cap & Emblem*, 510 F.2d 1004 (5th Cir. 1975).

[152] "If we ruled that A.V.E.L.A.'s depictions of Betty Boop infringed Fleischer's trademarks, the Betty Boop character would essentially never enter the public domain." *See also* Foley, *Fictional Characters, supra note* __, at 932 (suggesting a division based on *Dastar's* distinction between source of physical product and communicative content).

[153] *Fleischer Studios, Inc. v. A.V.E.L.A.* ___ F.3d ___, 2011 WL 3633512 (9th Cir. 2011).

[154] *See* Kurtz, *Methuselah, supra note* __, at 444 ("It must be recognized, however, that the law of trademarks and unfair competition is being used to protect the expressive elements of a character as well as its ability to denote its source."); Helfand, *Mickey Mouse, supra note* __, at 667 (arguing in favor of a clearer distinction between copyright and trademark uses, in the context of fictional characters).

[155] *See, e.g., International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912 (9th Cir.1980).

[156] 15 U.S.C. § 1125(c).

character of the mark) or through tarnishment (i.e. by harming the reputation of the mark). And such a claim would not be without basis, as it is not hard to believe that, even if there were no confusion as to source, such a use would, in fact, make the trademark Mickey Mouse both less distinct and less reputable.[157]

Once again, however, such a result would impose a significant limitation on the public domain. These kinds of uses would clearly be privileged under copyright law once the work passes into the public domain. Moreover, from a policy standpoint, the recasting and re-use of formerly copyrighted works in new and different ways, even and perhaps especially ways that the former owners object to, is precisely one of the key and important benefits of the public domain. This is particularly the case, given the iconic status of the new public domain works, along with the increased potential, afforded by technology, for many individuals to participate creatively in such re-casting and re-use. Thus, if trademark dilution were interpreted in such a broad fashion, it would have the potential to hinder these benefits.

Fortunately, trademark law once again contains doctrines that could (and should) be interpreted to prevent such a result. In particular, dilution law contains exceptions for non-commercial and fair uses.[158] The uses noted above are quite likely non-commercial uses. Even though they might well be commercial in a literal sense (in that the creators of the movie intend to make money), courts have interpreted the term "non-commercial" to apply to uses that are communicative, rather than purely trademark-related.[159] Thus, it is quite likely that these uses would fall outside the scope of a dilution claim, at least properly understood. Moreover, to the extent that there is any ambiguity about this, the policies underlying the public domain should prompt courts to err on the side of no liability.[160]

Companies would still be able to maintain dilution claims, but only in a limited fashion that does not implicate these broader concerns. So, for example, if a company used a small picture of Mickey Mouse as a logo for selling ball bearings, or as a logo for a strip club, these would be classic trademark uses. Preventing these uses would raise little concern about interference with the public domain. Disney would not, however, be able to deploy dilution claims to restrict uses that fall within the scope of copyright law, i.e. that are communicative in nature.

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Thus, in the end, the potential exists for trademark law to limit the benefits of a robust public domain. At the same time, courts have the tools and doctrines to interpret trademark law in a way that limits these encroachments. Some of these doctrines are internal to trademark law itself. However, the consistent pattern of relatively unthinking expansion of trademark law by the courts in the past suggests it would be unwise to rely solely on these internal doctrines. Instead, courts should supplement these doctrines with a strong understanding of the preemptive scope of copyright law's public domain. The importance of the public domain in copyright law is relatively easy to grasp and can serve (as it has already done so in past cases) as a concrete counterweight to expansive notions of trademark liability.

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[157] *See, e.g., Danjaq LLC v. Sony Corp.*, 49 U.S.P.Q.2d 1341, 1343-44 (C.D. Cal. 1998) (enjoining third party from making unauthorized James Bond film because such a film would lead to dilution of trademark rights); *Brown v. It's Entm't, Inc.*, 34 F. Supp. 2d 854, 860 (E.D.N.Y. 1999) (enjoining unlicensed uses of costumed Arthur Aardvark character, on the grounds that such uses would lead to dilution).

[158] 15 U.S.C. § 1125(c)(3).

[159] *See, e.g., Mattel v. MCA Records*, 296 F.3d 894 (9th Cir. 2002); *see also Louis Vuitton Malletier v. Haute Diggity Dog*, 507 F. 3d 252 (4th Cir. 2007).

[160] *See generally*, Graeme B. Dinwoodie, *Developing Defenses In Trademark Law*, 13 LEWIS & CLARK L. REV. 99 (2009); *but see* Kristen Knudsen, Note, *Tomorrow Never Dies: The Protection of James Bond and Other Fictional Characters Under the Federal Trademark Dilution Act*, 2 Vand. J. Ent. L. & Prac. 13, 23 (2000) (arguing broadly in favor of dilution protection for fictional characters).

Courts can use these understandings to develop clearer lines between the source-identifying uses of trademarks and more communicative uses that properly belong in the realm of copyright.[161] In the past, courts have not had to draw such fine distinctions, as many of the works subject to potential expansive trademark protection were already protected by copyright law. In the future, however, as more iconic works enter the public domain, courts will be asked to draw clearer lines between the realms of trademark and copyright. In so doing, they can rely on both internal trademark doctrines (such as functionality and trademark use) and better understandings of copyright law's public domain.[162]

C. The Copyright Problem – Mickey vs. Steamboat Willie

Another set of challenges to the new public domain comes from within copyright law itself. Copyright law is quite clear about the immediate consequences of a work passing into the public domain: third parties are completely free to make copies of that work, sell it, perform it in public, make derivative works based upon it, etc. Thus, once *The Great Gatsby* goes into the public domain, I can sell copies of it, write a sequel to it, make a movie based upon it, all without fear of copyright liability. Still, a number of wrinkles in copyright doctrine raise issues about the precise scope of these rights at the margin, and we can expect former owners of expired copyrights to attempt to assert these claims. Courts will thus need to keep clearly in mind, when deciding these cases, the importance of making sure that third parties can freely access and use works that have passed into the public domain.

1. Tracing Multiple Versions of Works

One complication arises from the fact that copyright owners may, in some cases, have created multiple versions of a creative work at different time periods. Thus, there may be questions about what, precisely, passes into the public domain and at what time. In the discussion above, we have largely assumed that there is a single version of Mickey Mouse that will pass into the public domain on January 1, 2024. In fact, however, the visual depiction of Mickey Mouse has changed significantly over time. The first widespread public appearance of Mickey Mouse occurred in 1928, in the black and white cartoon *Steamboat Willie*. The character Steamboat Willie, though similar to the modern depiction of Mickey Mouse, differs in important ways. In addition to being black and white (as opposed to in color), Steamboat Willie is more mouse-like and less cartoon-like, with smaller ears, hands, feet and eyes.[163] Moreover, his actions in the film *Steamboat Willie* indicate that he is a mischievous character, unlike the friendly, unthreatening Mickey Mouse of today.[164]

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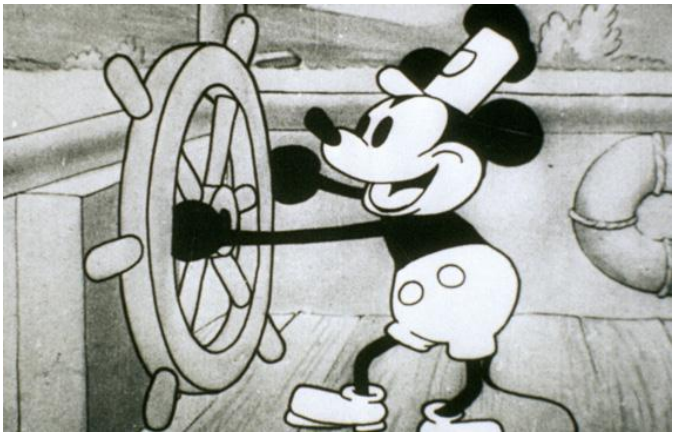
[161] *See* Laura A. Heymann, *The Trademark/Copyright Divide*, 60 SMU L. Rev. 55 (2007) (arguing for clearer dividing line). Because of the long period of copyright protection, courts have not had as much of an opportunity to develop this line.

[162] Note that there may also be an impact in limiting overly-expansive trademark claims for works still subject to copyright.

[163] *See* Claire Suddath, "A Brief History of Mickey Mouse," TIME (Nov. 18, 2008) (describing changes to Mickey Mouse over time) *available at* http://www.time.com/time/arts/article/0,8599,1859935,00.html.

[164] *See* Kurtz, *Methuselah*, *supra note* __, at 447-48 ("When Mickey Mouse made his debut in Steamboat Willie in 1928, he was a "rambunctious, even a slightly sadistic fellow."); "The Evolution of Mickey Mouse," at http://www.youtube.com/watch?v=-JIMBG_7S3A; Stephen Jay Gould, "A Biological Homage to Mickey Mouse," *in* THE PANDA'S THUMB: MORE REFLECTIONS IN NATURAL HISTORY 89 (1980) ("Mickey, however, has traveled this ontogenetic pathway in reverse during fifty years among us. He has assumed an ever more childlike appearance as the ratty character of Steamboat Willie became the cute and inoffensive host to a magic kingdom"). *See also* Douglas A. Hedenkamp, *Free Mickey Mouse: Copyright Notice,*



In light of this fact, what aspects of Mickey Mouse will pass into the public domain in 2024? The short and easy answer is the version that was created in 1928, namely Steamboat Willie. Because the copyright term for works created prior to the 1976 Act was measured from the date of publication, only the work that was published in 1928 will expire in 2024. Thus, as of that later date, third-parties will be able to distribute copies of the film *Steamboat Willie*, sell posters featuring pictures of Steamboat Willie, and make their own movies using the visual depiction of Steamboat Willie.

What about later, more modern depictions of Mickey Mouse? Will third parties be able to make copies of the later versions of Mickey Mouse in 2024? Probably not. A later, changed version of the Mickey Mouse character would probably be a derivative work, and under general copyright law principles, the derivative work would be entitled to a separate copyright covering any additional original content. Thus, while Disney would not be able to prevent use of elements of the character that had passed into the public domain with Steamboat Willie, Disney would be able to protect the additional original expression in the new version, at least until that new version itself passes into the public domain.[165]

A nice example of this basic result can be found in *Silverman v. CBS*,[166] which involved the popular *Amos n Andy* radio show. The show was first created in 1928 and broadcast on radio through the early 1950s. A television show based on the characters was broadcast from 1951-53. In 1981, Silverman, a playwright, planned to create a musical based on the *Amos n Andy* characters, and sought a declaratory judgment establishing his right to do so. Silverman based his claim on the fact that the copyrights in the pre-1948 radio scripts had expired due to failure to renew. However, CBS still owned valid copyrights in the post-1948 radio scripts as well as the television shows.

The court ultimately held that Silverman could use all of the elements of the pre-1948 radio scripts. These included the characters Amos and Andy, as delineated in those radio scripts, since the court found that these earlier scripts in fact provided sufficient details about the two characters so as to put them broadly in the public domain. However, the court also held that Silverman could not make use of any further delineation of those characters that appeared in any of the post-1948 works still under copyright, to the extent such additional delineations were sufficiently orig-

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Derivative Works, And The Copyright Act Of 1909, 2 VA. SPORTS & ENT. L.J. 254 (2003) (arguing that Steamboat Willie may already be in public domain due to failure to comply with formalities).

[165] *See* Scott M. Martin, *The Mythology Of The Public Domain: Exploring The Myths Behind Attacks On The Duration Of Copyright Protection*, 36 LOY. L.A. L. REV. 253 (2002) (using this distinction to argue that Disney will not be appreciably harmed upon the passing of Steamboat Willie into the public domain).

[166] 870 F.2d 40 (2d Cir. 1989).

inal. In particular, to the extent that the television shows provided any additional visual depictions of the characters, beyond those already described in the public domain scripts, these depictions could not be used.[167]

Thus, the *Silverman* case provides a nice illustration of the kind of careful parsing that courts will need to engage in, in order to separate out the unprotected elements of earlier public domain works from the additional originality found in later, still-protected works. The *Silverman* court itself expressly noted that such an inquiry, though easy in principle, may at times be difficult in practice, as it involves careful tracing of the source of particular original contributions. However, the basic idea is relatively straightforward.

Although the basic understanding is relatively clear-cut, one interesting question has to do with whether the new versions are sufficiently original to warrant protection as a derivative work. In other words, are the differences between the original visual depiction of Steamboat Willie and the more modern Mickey Mouse enough to give rise to a separate copyright? In general, the threshold for originality in copyright is quite low. Accordingly, it is quite possible that a court would find enough additional originality in the new version of Mickey Mouse so as to lead to a separate copyright. Under this view, only the earlier Steamboat Willie would pass into the public domain in 2024.

At the same time, there is some copyright case law that lends support to a heightened originality requirement for derivative works. For example, in *Gracen v. Bradford Exchange*,[168] the plaintiff Gracen entered a contest by submitting a drawing of a scene from the movie *The Wizard of Oz*. The copyright owner of the movie, MGM, authorized the contest and therefore gave Gracen permission to create this work. The contest specifically asked contestants to provide their own interpretation of the movie, and Gracen produced a drawing of Dorothy, based on a scene from the movie. Later, a dinnerware company copied Gracen's drawing and placed it on dinner plates without her permission. Gracen sued, alleging copyright infringement.

In an opinion by Judge Posner, the Seventh Circuit Court of Appeals rejected Gracen's claim, finding that she had no copyright in her drawing. The court held that Gracen's drawing was not sufficiently original to qualify for protection, despite the fact that Gracen had clearly added her own artistic interpretation in creating her picture. Judge Posner wrote that a somewhat higher standard of originality applied to derivative works because of potential difficulties in establishing proof of copying. If a derivative work resembles the original too closely, then it may be difficult for a particular copyright owner to establish that an alleged infringer copied from one work as opposed to the other. In order to avoid this result, Posner suggested that a higher degree of originality applied to derivative works.

Gracen holds out the possibility that small modifications of earlier copyrighted works may not be sufficiently original to warrant separate copyright protection. Thus, in the Mickey Mouse example, there is a possible argument that later visual depictions of Mickey Mouse do not contain sufficient additional originality to warrant separate protection. This result would be justified by the same policy rationale stated in *Gracen*, namely that it would otherwise be difficult to establish whether the defendant copied from the public domain version or the later derivative version. Under this view, once Steamboat Willie passes into the public domain, many (and perhaps all) later visual depictions of Mickey Mouse would also pass into the public domain, since there would not be enough additional originality to sustain a new copyright. Thus, third parties would be free to make and sell copies of all versions of Mickey Mouse.

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[167] *Compare Warner Bros. v. X One X Productions*, No. 10-1743 (8th Cir. July 5, 2011) ("a book's description of a character generally anticipates very little of the expression of the character in film").

[168] 698 F.2d 300 (7th Cir. 1983).

Posner's opinion in *Gracen* is controversial and has not been accepted by all courts.[169] Indeed, a number of other courts reject the higher standard for derivative works, and would thus apply largely the same standard of originality that applies to new works. Thus, it is quite possible that many courts would find sufficient originality in the later versions of Mickey Mouse. Moreover, even under the heightened standard in *Gracen*, the newer version of Mickey Mouse may be sufficiently original. In any event, this at least highlights one of the complications that may arise when there are different versions of copyrighted works published at different times. Courts will have to sort through the different versions and establish if and when a new version of a work adds enough originality to warrant separate copyright protection.

Moreover, even if later versions are separately copyrighted, there may arise the tricky questions of proof identified by Judge Posner in *Gracen*. It may, in some cases, be difficult to establish whether an alleged infringer copied from the public domain version or a later version still subject to copyright.[170] To some extent, these are simply issues of fact that will need to be established at trial. At the same time, the difficulties of establishing provenance may have a practical impact on the ability to use works that are ostensibly in the public domain.[171] Thus, there may well be complications associated with tracing specific versions of works.

Although the above example uses a work of visual art, the problem with multiple versions applies to other works as well. For example, imagine that a novel was published in 1923 and passes into the public domain in 2019. Imagine that a sequel to the novel was published in 1925. When the first novel passes into the public domain in 2019, does anything from the 1925 sequel also pass into the public domain? Upon initial inspection, the answer seems clear – only the 1923 novel passes into the public domain. Thus, while third parties could distribute copies of the 1923 novel or write their own sequels to that novel, the 1925 novel will remain protected for an additional two years.

But what about fictional events from the 1925 novel? For example, say I write my own novel using characters, events, and the world from the 1923 novel. But I also assume, in my new novel, events from the 1925 novel. I do not reproduce any of the text from the later novel. Nor do I expressly incorporate any significant portions of the plot of that novel. But I assume that the events in my novel occur after the events of the 1925 novel, so reference those facts in my novel. I also assume that the characters have changed (whether physically or emotionally) due to these events. Have I infringed upon the later novel?

To make this more concrete, consider the case of Sherlock Holmes, the famous detective created by Arthur Conan Doyle in a series of stories published from 1887 to 1930. Most of these stories were published before 1923 and are therefore in the public domain.[172] However, several stories were published after 1923, and therefore remain under copyright.[173] Since the basic charac-

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[169] *Compare Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99 (2d Cir. 1951); *Montgomery v. Noga*, 168 F.3d 1282 (11th Cir. 1999).

[170] *See, e.g.*, *Ty v. GMA Accessories*, 132 F.3d 1167 (7th Cir. 1997) (Posner, C.J.). *See also* Douglas Lichtman, *Copyright as a Rule of Evidence*, 52 DUKE L.J. 683 (2003). This is made even more complicated by the fact that unconscious copying may lead to liability. *See Bright Tunes v. Harrisongs*, 420 F. Supp. 177 (S.D. N.Y. 1976). Given the iconic status of some of these public domain works, it may be difficult to counter the argument that any similarities with later works was due to unconscious copying.

[171] For example, Paul Heald very nicely documented the issues that confront choir directors who have to deal with copyright claims based on minimal changes to public domain music. Paul J. Heald, *Reviving The Rhetoric Of The Public Interest: Choir Directors, Copy Machines, And New Arrangements Of Public Domain Music*, 46 DUKE L.J. 241 (1996).

[172] The character first appeared in A STUDY IN SCARLET (1887).

[173] Post 1923 works include: THE ADVENTURE OF THE SUSSEX VAMPIRE (1924); THE ADVENTURE OF THE THREE GARRIDEBS (1924); THE ADVENTURE OF THE ILLUSTRIOUS CLIENT (1924); THE ADVENTURE OF THE RETIRED COLOURMAN (1926); THE ADVENTURE OF THE LION'S MANE (1926); THE ADVENTURE OF THE BLANCHED SOLDIER (1926); and THE ADVENTURE OF THE THREE GABLES (1926).

ters Sherlock Holmes, Dr. Watson, and the rest, appeared in many pre-1923 works, they are in the public domain. Therefore, I am free to write my own Sherlock Holmes stories based on those characters. However, can I reference fictional events from the post-1923 stories?[174]

Again, the answer here is easy in theory but tricky in practice. The answer depends on whether, by incorporating these events into my novel, I have infringed upon any original expression in the 1925 work. This, in turn, depends on whether those events are sufficiently original. Although facts are not eligible for copyright protection, some ambiguity exists over so-called "created facts," such as fictional events in creative works.[175] Does a single fictional event have enough creativity such that merely by invoking it, I infringe? Even if a single fictional event cannot be protected, what about a collection of such events? Does this begin to approach the plot of the novel? There is some case law that supports protection for aggregations of such fictional events.[176] Thus, there will probably be some ambiguity regarding the elements of later versions that may or may not be incorporated into new creative works.

The recent case *Warner Bros. Entertainment v. X One X Productions* highlights offers some reasons for concern.[177] In that case, the plaintiff owned the copyright in the movie *The Wizard of Oz*. Before the movie was finished, however, promotional photographs were taken of the movie actors in costume (i.e. dressed as Dorothy, the Tin Man, the Scarecrow) on the set of the movie. These photographs were distributed publicly without any copyright notice and therefore passed into the public domain. The defendant in the case extracted images of the characters from the public domain photographs and authorized their use on products such as posters, t-shirts, lunch boxes, etc. Sometimes, these images would be accompanied by other background images (e.g. the Yellow Brick Road) or signature phrases from the underlying book (e.g. "There's no place like home."). In other cases, the defendant authorized the creation of three-dimensional figurines based on the public domain images.

The Eighth Circuit panel in the case held that the defendant could continue selling products containing literal reproductions of the public domain photographs (e.g. posters, t-shirts, and the like). However, the panel enjoined sale of the three-dimensional products as well as the products that combined separate elements, such as the images and the phrases. In reaching this result, the court held that, although the underlying images were in the public domain, the transformation of those images, by either rendering them three-dimensional or combining them with phrases from the books, infringed upon the additional originality contained in the still-copyrighted movies.

The opinion in *X One X* highlights some of the complications and concerns that arise when trying to trace the precise inputs to creative works. While the court was certainly correct that some uses of the public domain images could go so far as to infringe upon the copyright in the film, the court interpreted the right to use the public domain images very narrowly. At the same time, the court advanced a very expansive understanding of the additional protectable originality in the later film. The court attributed nearly all the defendant's creative additions as deriving from additional originality contained in the movie. And it did so without carefully looking at whether these additional elements were sufficiently original to warrant protection, or whether they flowed logically and obviously from the underlying image itself.

For example, it is hard to see how the combination of two public domain elements, the picture of Dorothy and the phrase "There's no place like home" from the underlying book, infringed upon any protectable originality found in the movie. Similarly, it is hard to see how simply turn-

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[174] This was essentially the situation presented in *Pannonia Farms v. U.S.A. Cable*, 2004 WL 1276842, at 9 & n.20 (S.D.N.Y. June 8, 2004). The case is discussed in more detail in the following section.

[175] *See* Justin Hughes, *Created Facts And The Flawed Ontology Of Copyright Law*, 83 NOTRE DAME L. REV. 43 (2007); *CDN v. Kapes*, 197 F.3d 1256 (9th Cir. 1999); *Nash v. CBS*, 899 F.2d 1537 (7th Cir. 1990).

[176] Cite.

[177] 644 F.3d 584 (8th Cir. 2011).

ing the public domain photograph into a three-dimensional figure infringed upon protectable expression from the film. The net effect of the court's decision was to limit use of the public domain materials to narrowly literal reproductions, and to significantly disable others from using such materials in a more creative fashion. Thus, in tracing the provenance of particular aspects of a work, the risk exists that too narrow a definition of the public domain work, and too expansive a definition of the still-protected work, may operate to unduly restrict the ability to creatively re-use and re-imagine the public domain works.

The concerns raised above suggest that courts, when dealing with multiple versions of works, some of which are copyrighted and some of which are not, need to be particularly careful to make sure that third parties have full and free rights to use the materials that have in fact passed into the public domain. Part of this will involve carefully examining the works still under copyright, tracing the elements that are truly new, and making sure that these new elements (whether they be facts, ideas, plots, etc.) are sufficiently original to warrant protection. In making this determination, courts should be particularly attuned to the need to encourage free use of public domain works.

2. The Uncertain Scope of Characters

In a related fashion, there may also be significant uncertainty regarding precisely which features of a fictional character have entered the public domain. Up to now, we have spoken rather loosely about copyright protection for characters, assuming that there is a clear definition of what aspects of a character copyright law protects. Yet this is anything but clear. What, precisely, about a fictional character is protected? What, precisely, enters the public domain when that character passes into the public domain? For visual works, this is perhaps somewhat easier, as we can focus on a particular visual depiction of that character, for example Steamboat Willie. But what about the non-visual aspects of these characters? For example, what about their characteristics and the events in their lives? What about pure literary characters?

To some extent, these uncertainties track the uncertain scope of copyright protection for characters more generally. Although many courts have held that fictional characters can sometimes be protected by copyright, it is not entirely clear what, if anything, about characters can be protected outside of the specific copyrighted works in which they appear. [178] After all, "fictional characters" do not appear as a separate category of works protected under the Copyright Act. And indeed, characters fit somewhat uneasily within the scope of copyright, as they also invoke aspects of trademark law. Many other articles have attempted to address some of these uncertainties, and a comprehensive look at the scope of copyright protection for characters is beyond the scope of this Article.[179]

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[178] *See, e.g.*, Foley, *Fictional Characters, supra note __*, at 932 (describing different standards courts have laid out for protecting characters under copyright).

[179] *See, e.g.*, Kurtz, *Methuselah, supra note __*; Leslie Kurtz, *The Independent Legal Lives of Fictional Characters*, 1986 WISC. L. REV. 429; Helfand, *Mickey Mouse, supra note __*; Kristen Knudsen, Note, *Tomorrow Never Dies: The Protection of James Bond and Other Fictional Characters Under the Federal Trademark Dilution Act*, 2 VAND. J. ENT. L. & PRAC. 13, 23 (2000); Laurie Richter, Note, *Reproductive Freedom: Striking A Fair Balance Between Copyright And Other Intellectual Property Protections In Cartoon Characters*, 21 ST. THOMAS L. REV. 441 (2009); Gregory S. Schienke, Comment, *The Spawn Of Learned Hand-A Reexamination Of Copyright Protection And Fictional Characters: How Distinctly Delineated Must The Story Be Told?*, 9 MARQ. INTELL. PROP. L. REV. 63 (2005); Roger L. Zissu, *Copyright Luncheon Circle: The Interplay Of Copyright And Trademark Law In The Protection Of Character Rights With Observations On Dastar V. Twentieth Century Fox Film Corp.*, 51 J. COPYRIGHT SOC'Y U.S.A. 453 (2004); Mark Bartholomew, *Protecting the Performers: Setting a New Standard for Character Copyrightability*, 41 SANTA CLARA L. REV. 341, 347 (2001); Francis M. Nevins, Jr., *COPYRIGHT + CHARACTER = CATASTROPHE*, 39 J. COPYRIGHT SOC'Y U.S.A. 303 (1992); Dean D. Niro, *Protecting Characters*

Some of these uncertainties may not be relevant to the issue of public domain characters. After all, once a character passes into the public domain, all aspects of that character pass into the public domain. So, whether or not certain aspects of that character might have been protected during the copyright term, we need not concern ourselves about this since it will all pass into the public domain and be free for use by others.

At the same time, the uncertain scope of characters becomes an issue when, as already discussed in the previous section, characters appear in different copyrighted works published at different times. Thus, an early work containing a character may pass into the public domain, while later works with that character remain protected. Thus, in this way, the uncertain scope of character protection will have an impact on precisely what aspects of that character pass into the public domain and at what time. For example, what about fictional events that happen to a character in a later work? What about relationships to other characters? What about changes in that character's personality? If these appear in later works still under copyright, can someone reference these aspects of the character based on the public domain status of the work in which the character first appears?

Much of this ground has been covered in the previous section, so I will not repeat this analysis, other than to note that only the original, copyrightable aspects of the character would be entitled to protection. As the court did in *Silverman*, courts will need to look carefully at how characters have developed over time, and determine what original aspects of a character's delineation are still protected and which have passed into the public domain. There will, thus, be many of the same ambiguities referenced in the earlier section, exacerbated somewhat by the additional ambiguities surrounding the scope of protection for characters in general.

To take a concrete example, consider the character Superman, who first appeared in the first issue of Action Comics in 1938.[180] The copyright in that issue is scheduled to expire on January 1, 2034. When that happens, what aspects of the Superman character will be free for the taking? The particular visual depiction of Superman from that comic will be free for others to use. Similarly, the basic elements of Superman's background (e.g. birth on planet Krypton, sent to Earth by his father because Krypton was about to explode, etc.) were established in that issue, so these would also pass into the public domain. Similarly, the plot of that initial comic would pass into the public domain (i.e. Superman's alter ego Clark Kent, the nature of his superpowers, his relationship to Lois Lane, etc.). Thus, a third-party would be able to build upon these elements.

Through Copyright Law: Paving A New Road Upon Which Literary, Graphic, And Motion Picture Characters Can All Travel, 41 DEPAUL L. REV. 359 (1992); E. Fulton Brylawski, *Protection of Characters--Sam Spade Revisited*, 22 BULL. COPYRIGHT. SOC'Y. 77, 78 (1974).

[180] In fact, a similar character appeared earlier in a short illustrated story by the same authors called "The Reign of Super-Man in 1933." However, this early incarnation did not much resemble the version later published in 1938.

At the same time, the character Superman has undergone significant development in the intervening 80 years. His visual appearance has certainly changed in that time, raising many of the same issues discussed above. Perhaps more importantly, much has happened to him in the intervening 80 years. If a third party were to write a new Superman comic book, would that third party have to return to the Superman story, as it stood in 1938? Or would this third party be able to reference some of the significant events that have occurred in that fictional world since then? Would readers of this third-party work have to selectively "forget" some of these events, in order to appreciate this new work? Again, courts will need to grapple with whether these new elements were sufficiently original to warrant protection and whether the new work infringed upon this originality. Thus, characters present a special case of the issues raised in the preceding section.

Indeed, at least one court has already addressed precisely this issue. In *Pannonia Farms v. U.S.A. Cable*,[181] the U.S. District Court for the Southern District of New York addressed this issue in the context of the characters Sherlock Holmes and Dr. Watson. As mentioned in the previous section, many of the early works containing these characters have passed in the public domain. However, later works containing these characters are still protected by copyright. In *Pannonia*, the court held that, even though the Holmes and Watson characters had passed into the public domain due to the public domain status of the earlier works, the defendant could not use "character traits newly introduced" in the still-protected works. This holding puts increased pressure on courts to determine the precise provenance of character traits and whether they are sufficiently original to warrant protection.[182]

One interesting alternative to carefully tracing the development of characters would be to consider an all-or-nothing rule for fictional characters. What if, instead of the careful parsing of cumulative originality suggested by the analysis in the preceding section, we adopted a rule that said that, once the first work in which a character appears passes into the public domain, that character, and all of its attributes, immediately pass into the public domain?[183] Thus, for example, once Mickey Mouse or Superman pass into the public domain, the public is entitled to full use of all of the various aspects of those characters, even if they are developed in later works? Although those later works would still be protected, they would not prevent a subsequent user from fully incorporating all aspects of the character into a new work.

What would be the benefit of such a view? It would certainly remove much of the uncertainty surrounding the precise scope of the public domain character. Third parties wishing to build upon these characters would not need to worry as much about tracing the particular source of a fact or feature of the character. This would, in turn, greatly expand the ability of third parties to make use of characters that have evolved in significant ways over the years. Similarly, consumers would not have to contend with the difficulty of "forgetting" subsequent events from later works in order to appreciate these new works. Thus, to the extent we are most concerned about facilitating free use of public domain characters, such a blanket rule would certainly encourage these kinds of uses.

There is, admittedly, less doctrinal support for such a result. Conventional copyright analysis would require courts to engage in the careful parsing of additional originality, mentioned above. And indeed, several courts have in effect rejected such an all-or-nothing rule.[184] At the same time,

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[181] 2004 WL 1276842, at 9 & n.20 (S.D.N.Y. June 8, 2004).

[182] *See also Warner Bros. Enter. v. X One X Prod.*, 644 F.3d 584, 596 (8th Cir. 2011) (reaching similar conclusion).

[183] *See* Helfand, *Mickey Mouse*, *supra note* __, at 655.

[184] *See Warner Bros. v. X One X Productions*, No. 10-1743 (8th Cir. July 5, 2011) (isolated public domain pictures of Dorothy, Scarecrow, and Tin Man were not enough to put the entire characters into the public domain); *cf. Siegel v. Warner Bros. Entertainment*, 542 F.Supp.2d 1098 (C.D.Cal.2008) (copyright in early,

courts could interpret the originality requirement for derivative works in a more searching manner when applied to characters. Under such a standard, many of the later changes may not have sufficient additional originality, and thus may reach effectively the same result. Such a result could be justified both by the difficulty of tracing changes as well as the benefit to the public.

Furthermore, copyright owners themselves have in the past made expansive claims of protection based on copyrighted characters. These claims might have the effect of estopping them from now claiming more limited protection. To the extent that copyright owners have argued for a broad understanding of what aspects of a character are protected by copyright, such a broad understanding should also be applied to the question of what passes into the public domain upon expiration of the copyright term.

Thus, in the end, courts will need to carefully consider the precise scope of protection for copyrighted characters.

3. Uncertainty About Public Domain Status

Much of the discussion above has assumed that it is relatively easy to determine whether a work is in the public domain, yet that is not always the case. In fact, in some cases, the public domain status of a work may be highly contested. Uncertainties about the public domain status of a work may considerably restrict the ability of third parties to use or distribute these works with confidence. Moreover, copyright owners will have every incentive to exploit uncertainties in order to continue to collect licensing revenues. If these efforts are successful, they will greatly undercut many of the discussed benefits of the new public domain, e.g. free and instantaneous distribution, re-use and re-casting of iconic works, etc.

For the works passing into the public domain in the decades immediately after 2018, the public domain status of a work will depend on the year of U.S. publication, as the copyright term of works created under the 1909 Act is measured from the date of publication. For many works, the publication date will be relatively easy to determine, as copies of the work will have been distributed to the public with a copyright notice, setting forth the date of publication. Thus, for example, the public domain status of most literary works will be easy to determine. Similarly, many such works will have been registered with the Copyright Office, and thus the publication date will be easy to determine from the registration.

However, for many other works, the publication date will be harder to discern. This is because "publication" is a term of art under the 1909 Act, and courts have adopted definitions of that term that are less than crystal clear. In general, a work is published under the 1909 Act when the copyright owner distributes copies of that work to the public in a manner so as to allow the public to exercise dominion and control over those copies. By contrast, a limited or more restricted distribution of copies to a small group may not constitute publication.[185] Similarly, and perhaps more importantly, a mere public performance or display of a work, without more, may not constitute publication, as it would not involve the distribution of copies to the public.[186]

As a result, for works that were distributed only in a limited fashion or that were merely performed or displayed, the date of publication may be ambiguous. Thus, for example, it may be more difficult to determine precisely when a particular piece of music was "published," if it was primarily performed over radio broadcasts, and if copies of the music were not widely available

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black and white depictions of a Superman-like character not enough to give rise to rights over later, more fully-developed character).

[185] *See, e.g., Academy of Motion Pictures Arts & Sciences v. Creative House Promotions*, 944 (f.2d 1446 (9th Cir. 1991).

[186] *See, e.g., Estate of Martin Luther King, Jr. v. CBS*, 194 F.3d 1211 (11th Cir. 1999).

to the public, without restrictions.[187] Similarly, the publication date of a work of fine art may be difficult to discern, if the copyright owner has only displayed the work in public, but not distributed or authorized copies to be distributed to the public at large. Uncertainty over the publication date can thus result in significant uncertainty over the public domain status of a work. And indeed, a number of important works have been subject to precisely these kinds of disputes.[188]

Robert Brauneis has recently highlighted an example of just this kind of uncertainty regarding "the world's most famous song," *Happy Birthday*.[189] Brauneis undertakes a detailed and painstaking historical analysis of the origins of the song and the subsequent claims of ownership of the copyright. His analysis highlights many of the uncertainties that can often attend any attempt to specifically pin down who wrote a particular work (in this case, both the lyrics and the tune), when it was written, when it was published, and what happened to the copyright afterwards. Nearly all of these uncertainties can be found in the history of *Happy Birthday*. And indeed, Brauneis ultimately concludes that the work is probably in the public domain, despite the fact that the alleged owners of the copyright (a subsidiary of AOL/Time Warner) continue to collect approximately $2 million in annual revenues based on licensing of the song.

We can expect many of these uncertainties to exist for other works as well, not just *Happy Birthday*. Given the length of the current copyright term, the copyright status of works will depend on events and facts that happened nearly 100 years ago. Because there may be poor records and imperfect memories, we can expect a good deal of legal uncertainty surrounding the specific publication date for some works and, therefore, the specific date upon which a work enters the public domain. This is particularly true for works that were not widely distributed to the public or that were only performed.

In a related fashion, parties may attempt to lay claim to ostensibly public domain works by making small changes to a public domain work in an effort to retain or extend copyright, and using the resultant uncertainty to limit free use. For example, Paul Heald has documented this phenomenon in the specific case of choral music.[190] Much choral music is in the public domain. Music publishers, however, routinely distribute and sell public domain choral music with a copyright notice, claiming an existing copyright. These claims are based on relatively minor changes to the arrangements of the particular public domain choral pieces, e.g. fingering suggestions, dynamics, etc. Similar claims could be made for any public domain work, for example by distributing a version with minimal changes and a new copyright notice.

In theory, this should not pose too much of a problem, since the original, unaltered works are in the public domain, and a party wishing to use the work could look for the original instead of relying upon the changed version. In practice, however, this kind of aggressive copyright labeling can have a chilling effect on free use, as it is not entirely clear to most users (who do not follow the details of copyright law) what, precisely is and is not in the public domain. In the context of public domain choral music, Heald carefully documents the ways in which ambiguity about the precise scope of public domain versus copyrighted material can affect the behavior of choir direc-

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[187] *See, e.g.,* Jennifer L. Hall, *Blues And The Public Domain--No More Dues To Pay?*, 42 J. COPYRIGHT SOC'Y U.S.A. 215 (1995) (noting some of the difficulties in determining whether early blues recordings are in the public domain). Note that this is less of a problem with motion pictures, since courts have generally held that the making and distribution of copies to theater operators constituted a publication. *See, e.g., American Vitagraph v. levy*, 659 F.2d 1023 (9th Cir. 1981).

[188] *See., e.g.,* Robert Spoo, Note, *Copyright Protectionism and Its Discontents: The Case of James Joyce's Ulysses in America*, 108 YALE L.J. 633 (1998) (arguing that Ulysses may already be in the public domain).

[189] *See* Robert Brauneis, *Copyright and the World's Most Popular Song*, 56 J. COPYRIGHT SOC'Y U.S.A. 335 (2009).

[190] *See* Paul J. Heald, *Reviving The Rhetoric Of The Public Interest: Choir Directors, Copy Machines, And New Arrangements Of Public Domain Music*, 46 DUKE L.J. 241 (1996).

tors.[191] Similarly, ambiguity about what is in the public domain may have a similar chilling effect on others.[192] This is a particular concern to the extent we expect the range of potential users of public domain works to expand in light of new changes in technology.

To some extent, some of this uncertainty may be unavoidable, and both parties and courts will have to determine precisely when a given work was "published" under the 1909 Act, when additional modifications are sufficiently original to give rise to a new copyright, etc. At the same time, the Copyright Office and the Library of Congress can play an important administrative role in facilitating knowledge and use of new public domain works. Certainly, it would be immensely useful to have a published registry of works that will pass into the public domain as of certain dates.[193] This would greatly reduce the uncertainty that third parties might face over the public domain status of a work. This would also allow third parties to prepare for works passing into the public domain (much as companies in many industries prepare for inventions to go off-patent). Together, these kinds of administrative steps could help third parties make the most use of works passing into the public domain.[194] Such steps are also consistent with the Copyright Office's goal of serving as a repository of legal claims.[195]

In addition, some regulation of unreasonably aggressive copyright claims over public domain works might be appropriate. Federal law does impose certain criminal penalties for fraudulent copyright notices.[196] However, such sanctions are relatively modest, dependent upon the government for enforcement, and limited to copyright notice, not other kinds of expansive claims. Jason Mazzone has suggested that copyright owners should face greater sanctions for fraudulent copyright claims.[197] Some claims of copyright ownership over clearly public domain works might rise to the standard of fraud, and thus warrant similar treatment under Mazzone's proposal. Alternatively, we could imagine a rule that required parties claiming copyright over minimally-altered public domain works to clearly identify what additional original elements are being claimed, or clearly disclaiming the elements that are in the public domain (as in the case of U.S. government works.)

Thus, in the end, a number of administrative steps can be taken to minimize uncertainty over the public domain status of specific works. By reducing this uncertainty, these steps can ensure maximum realization of the benefits of the new public domain.

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[191] *See id.*; *but see* Charles Cronin, *Virtual Music Scores, Copyright And The Promotion Of A Marginalized Technology*, 28 COLUM. J.L. & ARTS 1 (2004) (arguing that publishers of scores deserve some protection).

[192] *See* Jason Mazzone, *Copyfraud*, 81 N.Y.U. L. REV. 1026 (2006) (extensively documenting claims of copyright over public domain works).

[193] The Copyright Office currently maintains a searchable online database for records after 1978. No comparable online database exists for records before that date. Thus, to research the public domain status of a work based on registrations, one must physically visit the Copyright Office or a research library that has a copy of the Catalog of Copyright Entries. The Library of Congress does maintain an on-line catalog, and thus can serve as a resource, although the information in the catalog may not definitely establish public domain status. *See* Mazzone, *Copyfraud*, *supra* note __ (suggesting a government registry of public domain works, along with a symbol to designate public domain status).

[194] *Cf.* Brauneis, *supra note* __ (suggesting a greater role on the part of the Copyright Office to help determine the copyright status of works).

[195] Suggest starting with works about to pass into the public domain in 2019.

[196] *See* 17 U.S.C. § 506(c).

[197] *See* Mazzone, *Copyfraud*, *supra* note __.

4. Anticircumvention Liability

Finally, former copyright owners may be able to limit the practical ability to use public domain works through technical measures backed by anticircumvention liability.[198] In the same year that Congress extended the copyright term, Congress also passed the Digital Millennium Copyright Act of 1998, which created a new cause of action directed against circumvention of technological measures used to control access to copyrighted works.[199] Thus, for example, circumventing the encryption of a movie on a DVD would lead to liability under the DMCA. In addition, trafficking in technologies that facilitated this kind of circumvention would also lead to liability.

Owners of expired copyrights may be able to limit widespread use of works through the DMCA by distributing public domain works bundled with copyrighted content and then protecting these works using technological measures. A third party wishing to use the public domain content could circumvent the technological protection measure, but could conceivably be liable under the DMCA, since he would have obtained access not only to the public domain work, but also the bundled copyrighted content.

To take a concrete example, the film *Gone With the Wind* is expected to pass into the public domain in 2035. Imagine that, after that date, someone wishes to incorporate significant portions of that movie into their own work. If that person purchases a DVD of *Gone With the Wind*, she will need to circumvent the access control technology in order to copy the public domain work. However, that work is very likely bundled with work that is still protected by copyright (e.g. director commentary, later-created documentaries about the making of the film, etc.). Thus, an act of circumvention may give rise to potential liability under the DMCA.

To some extent, this is not an absolute limit on third-party use, but rather a limit on how easy it is to access such works. It would still be possible to access copies that are not subject to such protection (for example, copies of *Gone With the Wind* on videotape). At the same time, this kind of liability imposes a practical hurdle, particularly for works for which there are not many copies in widespread circulation. Moreover, it does so without good reason, since the underlying works are clearly in the public domain. If we want these works to be widely and freely available, then attention should be paid to the practical availability of such works for copying and re-use.

One possible response would be to interpret DMCA liability with an eye toward copyright policy. Some federal courts have limited the reach of the DMCA, applying it only to cases where the act of circumvention implicates a copyright interest.[200] Thus, circumvention that does not meaningfully raise a copyright interest falls outside the scope of the DMCA. Under such a view, circumventing a technological protection measure to gain access to a public domain work might not lead to DMCA liability. Other federal courts, however, have rejected this standard, arguing that it is at odds with the language of the DMCA, which contains no such qualification.[201] Even under the more relaxed standard, the kind of access discussed above does not resemble the kind of completely unrelated access at issue in those cases.

An alternative would be for the Librarian of Congress to exempt acts of circumvention designed to gain access to public domain works. The DMCA authorizes the Librarian of Congress to exempt categories of works from DMCA liability, if such liability hinders legitimate access to such works.[202] Public domain works protected by access control technologies would appear to

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[198] *See* Lawrence Lessig, *Re-crafting a Public Domain*, 18 YALE J.L. & HUMAN. 56, 57 (2006) (highlighting dangers to public domain from access-control technologies).
[199] 17 U.S.C. §1201.
[200] *See Chamberlain Group v. Skylink Tech.*, 381 F.3d 1178 (Fed. Cir. 2004).
[201] *See MDY Industries v. Blizzard Entertainment*, 629 F.3d 928 (9th Cir. 2010), *as amended on den. of reh'g*, __ F.3d __ (9th Cir. 2011).
[202] 17 U.S.C. §1201.

qualify for an exemption. Moreover, such an exemption would remove one possible obstacle standing in the way of more widespread access to public domain works.[203]

Finally, the Library of Congress could play a very important role in ensuring easy digital access to works that have passed into the public domain by, for example, maintaining a publicly accessible repository of digital copies of works that have passed into the public domain. Indeed, the Library of Congress already makes many of the public domain works in its collection available over the Internet. Continuing to do this with recently-expired works would obviate many concerns about the practical access to public domain works, particularly in cases where former copyright owners attempt to restrict use through technological means or through misleading claims of copyright protection.[204]

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Thus, in the end, although there are many potential obstacles facing the new public domain, courts are equipped with the tools to ensure that these obstacles do not stand in the way of a more robust and effective public domain. Some of these tools can be found within the doctrinal frameworks of trademark law and copyright law. These tools can and should be supplemented with a clear understanding of the important role and preemptive scope of copyright law's public domain. In addition, the Copyright Office and Library of Congress can take concrete steps to ensure that knowledge about, and access to, public domain works remains widespread and robust. Together, these steps can ensure that the new public domain will play a more vital and important role in the copyright balance than ever before.

CONCLUSION

This Article has argued that, after 2019, the potential exists for an invigorated and vital new public domain to play an important and immediate role in our cultural landscape and in setting the overall balance in copyright law going forward. Although a number of potential obstacles stand in the way, careful attention by the courts and the Copyright Office to the important role of the public domain can ensure that this new public domain lives up to its promise.

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[203] Even if the circumvention were permitted under the rulemaking, there would still be a practical obstacle, as technologies to engage in circumvention would still be banned under the DMCA's anti-trafficking provisions. 17 U.S.C. §1201.

[204] *See also* Pamela Samuelson, *Mapping the Digital Public Domain: Threats and Opportunities*, 66 LAW & CONTEMP. PROBS. 147 (Winter/Spring 2003) (public initiatives for making public domain materials available).

APPENDIX: WORK PASSING INTO THE NEW PUBLIC DOMAIN