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Unlimited Times: DMCA Anticircumvention Measures on Public Domain Films

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*by Sarah Jordan**

Abstract

The Constitution guarantees that intellectual property will enter into the public domain after a limited time, however the amount of time in which that happens for copyrighted works has been extended numerous times since the writing of the Constitution. While the Digital Millennium Copyright Act (DMCA) was not enacted by Congress to extend copyright protection limits, it has inadvertently granted unlimited protections to public domain films in digital formats. As early films begin to enter the public domain, a select few have the means to provide those films in digital format, but the public does not have the right to exploit those digital films. This article explores the extent of protections on digital public domain films under the DMCA, examines the current system meant to prevent such protections, and offers possible solutions to the problem of digitally protected public domain works.

"The monopoly privileges that Congress may authorize are neither unlimited nor primarily designed to provide a special private benefit. Rather, the limited grant is a means by which an important public purpose may be achieved." – Justice Stevens[1]

I. Introduction

Jane Austen's novels were published between the years of 1811 and 1815, prior to the Berne Convention for the Protection of Literary and Artistic Works (Berne) and Britain's Copyright Act of 1911, which declared that the duration of copyright would be the life of the author plus fifty years.[2] Austen passed away in 1817 and a publisher by the name of Richard Bentley purchased the remaining copyrights to all of Austen's novels.[3]

Nearly 200 years later, the works of Austen have spawned multiple classic film adaptations, about half a dozen modernized adaptations, a few biopics, and at least one film inspired by Austen herself.[4] Her works have been published by nearly every major publishing house multiple times, both individually and as a collection. Her popularity has spawned an international fan fiction phenomenon and a prolific market of books inspired by, adapted from, and building on Austen's novels. For the past thirty years, a new adaptation of *Pride and Prejudice* has been filmed once a decade introducing each new generation to Austen's most beloved work. All of this was made possible because Austen's work has been in the public domain for a very long time.

Jane Austen's story is one example of what it means "to promote the progress of Science and the useful Arts by protecting authors and inventors for limited times."[5] By allowing works to pass into the public domain and allowing the public to freely access them, an entire genre of works has blossomed and

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1. Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 429 (1984).

2. *See* Dan Alex, *Jane Austen Timeline*, JaneAusten.Org (Mar. 25, 2012), http://www.janeausten.org/jane-austen-timeline.asp; Berne Convention for the Protection of Literary and Artistic Works, Sep. 9, 1886, *available at* http://www.wipo.int/treaties/en/ip/berne/trtdocs_wo001.html; Copyright Act of 1911 (U.K.), *available at* http://www.legislation.gov.uk/ukpga/1911/46/pdfs/ukpga_19110046_en.pdf.

3. *See* Alex, *supra* note 2; Statute of Anne, 1710, 8 Ann., c. 19, § 1 (Gr. Brit.) (conveying copyright protection to publishers who owned the rights to works).

4. *Jane Austen*, Internet Movie DataBase, http://www.imdb.com/find?q=Jane+Austen&s=all (last visited Aug. 18, 2012).

5. U.S. Const. art. I, § 8, cl. 8.

continues to thrive. However, as a new class of works, silent films, enters into the public domain, those who would seek to exploit the films that belong to the public are, unfortunately, enabled to effectively reestablish copyright protections in those films by virtue of the Digital Millennium Copyright Act's anticircumvention provisions.

This article begins with a brief look at the evolution of the durational aspect of copyright law with an in-depth look at the DMCA's anticircumvention provisions and gives real-life examples of why the DMCA has created a pressing problem by protecting public domain films under the Copyright Act. Once the article has established a ground work in the law, it will examine the Limited Times provision in the Constitution and discuss how Congress overstepped its Constitutional powers by enacting the DMCA. The ability to protect digital works under the DMCA has essentially given digital restorers a monopoly on public domain films, thereby establishing infinite copyright. The article will then look at derivative works, the copyrightability of those derivations, and how production companies are able to use copyright law to exclusively exploit public domain films through digital means. Finally, the article examines the DMCA's exception provision, which allows the Librarian of Congress (LOC) to assign anticircumvention exceptions to certain classes of works every three years, and offers suggestions to make the exception aspect of the DMCA's anticircumvention provision fairer and to make digital copies of public domain films more freely accessible.

Allowing works to enter into the public domain has always been important. The framers of the U.S. Constitution decided that copyright protection for a limited time was important enough to empower Congress to make laws to that end.[6] Over the years, Congress has amended an earlier statute drafted in 1906, and copyright duration has been extended by some period each time.[7] However, there has always been an end to copyright protection in sight.

II. The Evolution of Duration

A. Copyright Law Overview

In 1787 the founding fathers of the United States drafted the Constitution, dictating the manner in which the country would be governed. The drafters determined that it was important to protect the rights of inventors and authors and so empowered Congress to make laws for that purpose.[8] Since then, Congress has periodically and methodically increased Copyright protections in a number of ways, such as by modifying the types of works protected, duration of protection, and manner of protection.[9]

1. Constitutional Provision of Limited Times and Past Judicial Interpretation

The United States Constitution states that "Congress shall have the power . . . [t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries . . . ."[10] This clause managed to convey both a rigid construction and a malleable scope of protection for authors and inventors. By stating the specific purpose of the clause, to promote the progress of science and useful arts, the drafters conveyed that they wished specifically to protect the rights of inventors and authors beyond the scope of the Statute of Anne, the law of the land they had so recently revolted against.[11] Authors' rights were to be exclusive, which granted a previously unimagined monopoly that did not need to be

6. *Id.*

7. *See generally* 17 U.S.C. § 302(a) (1998) (building on previous extensions such as the Copyright Act of 1906 which doubled the length of copyright to twenty-eight years; the Copyright Act of 1976 increased the duration of copyright to life of the author plus fifty years for works created on or after January 1, 1978; most recently, the Copyright Term Extension Act made copyright length the life of the author plus seventy years).

8. U.S. Const. art. I, § 8, cl. 8.

9. *See* Ralph S. Brown & Robert C. Denicola, Copyright: Unfair Competition, and Related Topics Bearing on the Protection of Works of Authorship; 2010 Statutory and Case Supplement (10th ed. 2010).

10. U.S. Const. art. I, § 8, cl. 8.

11. *See generally* Statute of Anne, 1710, 8 Ann., c. 19, (Gr. Brit.) (conveying to authors, or those who had purchased the work, a fourteen-year term of exclusive rights to publish or re-publish those works).

sold outright for the purpose of publishing.[12]

The first Copyright Act enacted by Congress protected maps, charts, and books for an initial term of fourteen years, similar to the duration of rights under the Statute of Anne, but allowed for a renewal of rights by the author or author's heirs, assignees, or executors for an additional fourteen year term.[13] In 1909, Congress amended copyright law to expand both the type of works to be protected and the duration of protection.[14] The new duration doubled both the initial copyright term and the renewal term, bringing the total possible term of protection to fifty-six years with proper registration and renewal.[15] Congress revisited the Copyright Act in 1976 and made several major changes to the law, including extending the term of copyright protection to the life of the author plus fifty years, which brought U.S. law into line with the Berne Convention and brought the country one step closer to becoming a member country.[16]

The most recent change to copyright duration came in 1998 when Congress enacted the Sonny Bono Copyright Term Extension Act (CTEA).[17] The CTEA extended copyright another 20 years making the term the life of the author plus seventy years. Many believe that the CTEA, introduced by then-Representative Sonny Bono (R-CA), was initiated by the Walt Disney Company, whose copyright protections of its earliest films were due to expire in 1998.[18] This final extension came as a major blow to the community of artists who made a living by exploiting public domain works through the creation of derivative works.[19] In response to this extension, those artists filed suit claiming the CTEA was unconstitutional.[20] The Supreme Court ruled that the CTEA was constitutional because the term of seventy years could be deemed limited as it was not infinite.[21] The Court's interpretation of "limited Times" was quite literal, as the Court referenced dictionaries dating back to the 1780s.[22] However, the Court cited several other reasons, none of which involved Walt Disney, validating the extension of copyright terms.[23]

2. Fair Use Provisions

The idea of fair use first arose in 1841 when Justice Joseph Story attempted to determine whether the Defendants in *Folsom v. Marsh* had created an abridgement of the Plaintiffs' materials, a lawful act at the time of the decision.[24] In his opinion, Justice Story wrote:

> In short, we must often, in deciding questions of this sort, look to the nature and objects of the selections made, the quantity and value of the materials used, and the degree in which the use may prejudice the sale, or diminish the profits, or supersede the objects, of the original work.[25]

These principles are now recognized as three of the four factors used when determining fair use of copyrighted works. Justice Story's test would remain a judicial doctrine until it was incorporated into the Copyright Act of 1976 with the addition of a new factor: the purpose of the

12. *Id*. § 1 (extending copyrights to publishers who had purchased the work, however, under current US law, an author has a bundle of rights that may be licensed to a publisher, but the publisher will not have exclusive copyright in the work).

13. 1 Stat. 124 § 1; 1st Cong., 2d Sess., c. 15 (1790).

14. Copyright Act of 1909, 17 U.S.C. §§ 5, 24 (1909) (current version at 17 U.S.C. § 302 (1998)).

15. *Id*. § 24.

16. Berne Convention for the Protection of Literary and Artistic Works, art. 7(1), Sep. 9, 1886, *available at* http://www.wipo.int/treaties/en/ip/berne/trtdocs_wo001.html#P123_20726.

17. Copyright Term Extension Act, 17 U.S.C. § 302(b) (1998).

18. Helle Sachse, *When Mickey Mouse Goes Public*, 2002 B.C. Intell. Prop. & Tech. F. 103001 (2002), *available at* http://www.bc.edu/bc_org/avp/law/st_org/iptf/headlines/content/2002103001.html.

19. Eldred v. Ashcroft, 537 U.S. 186, 193 (2003).

20. *Id.* at 198.

21. *Id*. at 199-200.

22. *Id*. at 199.

23. *Id*. at 206-07 (citing demographic, economic and technological changes).

24. 9 F. Cas. 342 (C.C.D. Mass. 1841); Ralph S. Brown & Robert C. Denicola, Copyright: Unfair Competition, and Related Topics Bearing on the Protection of Works of Authorship 349 (10th ed. 2010).

25. Folsom v. Marsh, 9 F. Cas. 342, 348 (C.C.D. Mass. 1841).

use.[26]

The Copyright Clause of the Constitution is a perfect example of the founding fathers' desire to balance rewarding those who create with disseminating those creations to the public. While the Constitution expresses this need for balance by limiting the amount of time a creator's work should be protected, Congress took this idea to a new level by adding Justice Story's factors to the statute.[27] Although many people have benefited from this limitation of rights, it is not generally known that the benefits conferred were specifically intended for educational purposes.[28] The fair use exception is now touted by some as a Constitutional right.[29]

One excellent example of an unintended beneficiary of fair use is Paramount Pictures who produced the film *Hugo*, directed by Martin Scorsese.[30] The full story of *Hugo* and its importance to this topic is explored below, but for the purposes of fair use one must look to a specific scene in the film in which two of the main characters are using a textbook to learn about the early days of film. Scorsese's team created a montage using a combination of still photos and clips from motion pictures to convey the narrative of the book.[31] The clips from the motion pictures are used in such quick succession that it is impossible to determine what films they come from and, therefore, whether they are in the public domain. However, any film from the early 1920s would not enter the public domain until sometime after 2020 if the producer of the film had properly registered the work with the Copyright Office and renewed those protections.[32] Scorsese would have been able to use these clips without permission from the production companies because of the fair use exception, though it is possible that some of the clips were also in the public domain.

3. What is the Public Domain?

Outside of copyright protection there is a collection of works that belong to the public. These works are the domain of the public and cannot be protected by copyright. The 1909 Copyright Act stated that:

> [n]o copyright shall subsist in the original text of any work which is in the public domain, or in any work which was published in this country or any foreign country prior to July 1, 1909, and has not been already copyrighted in the United States, or in any publication of the United States Government, or any reprint, in whole or in part, thereof, except that the United States Postal Service may secure copyright on behalf of the United States in the whole or any part of the publications authorized by section 405 of title 39.[33]

This principle continues today. Works that have entered the public domain cannot be protected by copyright.

A work enters the public domain either because copyright protection has expired, the work never existed, or the work was a government document.[34] Many original works which were created prior to the Copyright Act of 1976 are in the public domain if they were published, but not properly registered with the Copyright Office.[35] Once those works have entered the public domain it is nearly impossible to protect them again, but on at

26. *See* 17 U.S.C. § 107.

27. *Id.*

28. H.R. Rep. No. 94-1476, at 61–62 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5660, 5679, 1976 WL 14045 (stating that although the works and uses to which the doctrine of fair use is applicable are as broad as the copyright law itself, generally the discussion of § 107 has centered around questions of classroom reproduction, particularly photocopying).

29. *See* Universal City Studios, Inc. v. Corley, 273 F.3d 429, 458 (2d Cir. 2001) (arguing that the DMCA should be interpreted as prohibiting fair use and therefore violating their Constitutional rights).

30. Hugo (Paramount Productions 2011).

31. *Id.*

32. U.S. Copyright Office, *Circular 15A Duration of Copyright* (2012), http://www.copyright.gov/circs/circ15a.pdf.

33. Copyright Act of 1909, 17 U.S.C. § 8 (1909) (*amended by* 63 Stat. 154 (1949)) (referring to the use of postage stamps in § 405 of title 39).

34. 17 U.S.C. §§ 102, 105, 301-305.

35. U.S. Copyright Office, *Circular 15A Duration of Copyright* (2012), http://www.copyright.gov/circs/circ15a.pdf ("The law automatically gives federal copyright protection to works that were created but neither published nor registered before January 1, 1978.").

least one occasion courts have managed to reinstate copyright protections on works that had legitimately entered the public domain.[36]

In 1994, Congress enacted section 514 of the Uruguay Round Agreements Act (URAA) which restored copyright in works from authors of WTO or Berne member countries that had fallen into the public domain, so long as they complied with certain conditions.[37] Copyright would be restored to works that were still under copyright in the country of origin and were in the public domain in the U.S. because of one of the following reasons: (1) the author failed to comply with formalities of registration; (2) The Copyright Act did not cover the subject matter (i.e. sound recording fixed before Feb. 15, 1972); or (3) the author's country lacked national eligibility, meaning there was no reciprocity between the US and the country of origin at the time.[38] The US had joined the Berne Convention in 1989, but until the URAA had adopted an extremely minimalist approach to compliance.[39]

One of the major requirements of Berne was national treatment, or the notion that member countries should extend copyright to works from other member countries as they would to works from their own.[40] The URAA brought U.S. copyright law in compliance with the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), as several Berne Convention member countries had been questioning US compliance with Berne, but had no way in which to enforce national treatment of their authors' works.[41]

The Uruguay Round created the World Trade Organization (WTO) and TRIPS, both of which established real consequences for countries that were not extending national treatment to Berne member countries.[42] With the threat of tariffs or retaliation, Congress brought the U.S. into line with Berne through the URAA.[43] However, the enactment of the URAA led to outrage by the U.S. public, similar to the response which followed the CTEA. A group consisting of orchestra conductors, musicians, publishers, and others who had previously exploited works that had entered the public domain brought suit against the Attorney General to have the URAA declared unconstitutional.[44]

Golan v. Holder was brought under very similar circumstances as *Eldred*; accordingly, the Supreme Court gave the case similar treatment.[45] The plaintiffs in *Golan* argued that once works enter the public domain, no one, not even Congress, is authorized to reinstate protection.[46] The Supreme Court disagreed and cited several occasions in the history of Copyright Law when Congress had removed works from the public domain.[47] However, the most significant of those examples was the Copyright Act of 1790, in which Congress attempted to unify erratic state laws that did not protect the same types of works.[48] While this action did allow for the protection of works that had previously been in the public domain of certain states, its purpose was in fact to nationalize copyright law.[49] In *Golan*, the Supreme Court essentially decided that the interest of protecting U.S. authors abroad outweighed the interests of the public domain.[50]

The outcome of *Golan* is seen by some as an abuse of Congress's power under the Copyright Clause of the Constitution.[51] The Supreme Court's decision potentially allows Congress to reach even further into the public domain.[52] But the DMCA's anticircumvention provisions have taken steps towards protecting works in the public domain that will become a major issue in coming years.

36. *See, e.g.*, Golan v. Holder, 132 S. Ct. 873, 879-80 (2012).
37. 17 U.S.C. § 104A (2002).
38. *Id.*
39. *Golan*, 132 S. Ct. at 879-80.
40. Berne Convention for the Protection of Literary and Artistic Works, art. 5(1), Sept. 9, 1886, *available at* http://www.wipo.int/treaties/en/ip/berne/trtdocs_wo001.html#P123_20726.
41. *Golan*, 132 S. Ct. at 880 (complaining about the United States' refusal to protect works still under copyright in Mexico when negotiating NAFTA).
42. *Id*. at 881.
43. *Id*.
44. *Id*. at 878.
45. *Id.* at 883-84.
46. *Id.* at 878.
47. *Golan*, 132 S. Ct. at 885.
48. *Id.* at 885-86.
49. *Id.* at 885.
50. *Id.* at 889.
51. *See, e.g.,* Mary LaFrance, *Supreme Court Upheld Constitutionality of Copyright Restoration: Golan v. Holder*, 2012 Emerging Issues 6197 (2012).
52. *Id.*

B. DMCA Anticircumvention Provisions

Congress enacted the Digital Millennium Copyright Act (DMCA) in compliance with the World Intellectual Property Organization's Copyright Treaty (WCT) of 1996.[53] Article 11 of the WCT states that member countries must provide "adequate legal protection and effective legal remedies against the circumvention of effective technological measures that are used by authors in connection with the exercise of their rights under this Treaty or the Berne Convention" and that restrict acts not authorized by the author.[54] Congress implemented the DMCA in 1998, which included the anticircumvention clause, which states that technological protection measures (TPMs) are not to be circumvented,[55] and the anti-trafficking clause, which states that if one manages to circumvent the TPM he is not to share the means of circumvention in any manner.[56]

The problem of public domain works protected by TPMs may not seem like a problem at first blush. The statute clearly states that "[n]o person shall circumvent a technological measure that effectively controls access to a work protected under this title."[57] Public domain films, by their very nature, are not protected under the copyright statute and therefore, circumvention of TPMs to access them is not prohibited by law.[58] However, the issue of derivative works, which is more thoroughly discussed below, creates an entirely new concern. Most public domain works protected by TPMs would be considered derivative works, but the underlying public work is not protected by copyright, and therefore use of that work alone would not infringe the author's rights.[59] But if the derivative work is protected by a TPM then the public domain work is inaccessible and essentially protected by the DMCA.[60]

The next provision in the DMCA creates a three-year exception from the previous anticircumvention provision.[61] This exception is created by the LOC, who determines the type of work excepted in a rule-making process that occurs every three years.[62] Under the statute, the LOC makes a determination "upon the recommendation of the Register of Copyrights, who shall consult with the Assistant Secretary for Communications and Information of the Department of Commerce," that a user of a certain type of copyright works is "adversely affected" by the anticircumvention provision in making non-infringing uses.[63] The statute demands that the LOC's results be published, which is done on the Copyright Office website.[64]

The next provision in the statute makes it clear that the LOC's exception refers only to the anticircumvention of TPMs.[65] The statute states that "[n]either the exception . . . nor any determination made in a rulemaking . . . may be used as a defense in any action to enforce any provision of this title other than this paragraph."[66] Effectively, the exceptions created by the LOC will not apply to any provisions that follow, including the anti-trafficking provision.

The DMCA has two anti-trafficking provisions.[67] The first establishes that no one shall knowingly traffic in any technology that is primarily designed to circumvent access controls, including Content Scramble System (CSS), if that is the primary purpose of the technology.[68] This provision, following as it does the limit on the anticircumvention exception, begs the question: how are those

53. Universal City Studios, Inc. v. Corley, 273 F.3d 429, 437 (2d Cir. 2001); U.S. Copyright Office, The Digital Millennium Copyright Act of 1998: U.S. Copyright Office Summary (1998), *available at* http://www.copyright.gov/legislation/dmca.pdf.

54. World Intellectual Property Organization Copyright Treaty art. 11, Dec. 20, 1996, S. Treaty Doc. No. 105-17, 36 I.L.M. 76.

55. 17 U.S.C. § 1201(a)(1)(A) (2006).

56. *Id.* §§ 1201(a)(2)), 1201(b)(1).

57. *Id.* § 1201(a)(1)(A).

58. *See* 17 U.S.C. § 102 (public domain works not included under protection of copyright statute).

59. 17 U.S.C. § **103(a).**

60. Production companies, such as Flicker Alley, take films in the public domain and convert them to digital versions that automatically have TPMs on them. Flicker Alley, http://www.flickeralley.com/fa_about_01.html (last visited Mar. 25, 2012).

61. 17 U.S.C. § 1201(a)(1)(B).

62. *Id.* § 1201(a)(1)(C).

63. *Id.*

64. § 1201(a)(1)(D); U.S. Copyright Office, *Rulemaking on Anticircumvention* (2011), *available at* http://www.copyright.gov/1201/201088.

65. 17 U.S.C. § 1201(a)(1)(E).

66. *Id.*

67. *Id.* §§ 1201(a)(2)(A)-(C), 1201(b)(1)(A)-(C).

68. *Id.* §1201(a)(2)(A)-(C).

excepted meant to circumvent the TPMs? Before that question can be answered, the second anti-trafficking provision prohibits knowingly trafficking in technology primarily designed to circumvent copy controls.[69] The ability to circumvent, created by the LOC, is now possibly stymied by the inability to procure the technology to do so. Realistically, there are most likely any number of circumvention technologies available on the internet, as it is a global community; however, technically those who provide that technology, even for non-infringing uses excepted by the LOC, open themselves up to liability for allowing someone else to access that technology.[70]

The question of how those whose circumvention is excepted by the LOC are meant to circumvent TPMs is answered in the reverse engineering provision of the statute.[71] This provision states that if a person is able to reverse engineer a circumvention technology, they may use it for non-infringing purposes.[72] Essentially, a user of an excepted type of work may circumvent a TPM to access the work for non-infringing uses, as long as they have reverse engineered the circumvention technology themselves. These provisions are the most important to the present discussion, so it is important to determine how the courts have interpreted them.

Courts have disagreed over a user's ability to circumvent TPMs for fair use purposes.[73] In *Universal v. Corley*, the court stated that owners of DVDs were not barred from using the content for fair use purposes, they were simply not allowed to circumvent the TPMs in order to reach that content.[74] The court went so far as to suggest that users could film their television in order to capture the relevant content.[75] In *United States v. Elcom*, the court suggested that Congress did not ban the act of circumvention, merely the trafficking in, and marketing of, circumvention technology.[76] The court cited 17 U.S.C. § 1201(c)(1), which states that "[n]othing in the statute affects the rights, remedies, limitations, or defenses to copyright infringement, including fair use, under this title."[77] The *Elcom* court had a fair point, except that this provision does not exempt the user from liability for circumvention, it merely provides the user who has circumvented a TPM with a defense.[78]

Furthermore, the anticircumvention provision does not mention fair use or any other rights, remedies, limitations, or defenses, which means that Congress did ban the act of circumventing, but allowed a reasonable defense of the circumvention if the user can prove the act was non-infringing.[79] If Congress had not banned the act of circumvention, then why would the LOC exception be necessary? The exception exempts the user from liability, thereby making the act of circumvention legal.

The general focus of these cases has been the anti-trafficking provisions. It is inherently easier to find and sue those who traffic in technology than those who circumvent TPMs. It does not necessarily mean that one is not liable for circumventing access controls, but it does mean that the act of circumvention is made all the more difficult by a lack of technology. Therefore, the issue of perpetual copyright on public domain films lies not in one's liability for circumventing the TPMs, but in one's ability to circumvent. This issue will become more prevalent in coming years as many early films reach the end of their copyright protections and with the unusual amount of attention early and silent films have received in the media recently.

C. *Hugo*

The movie *Hugo*, based on the children's book *The Invention of Hugo Cabret*, is the story of an orphan who lives inside of the walls of a Paris train station during the 1930s.[80] Through a series of events, Hugo befriends a young girl, Isabelle, whose guardian happens to be

69. *Id.* §1201(b)(1)(A)-(C).
70. *See*, *e.g.*, Universal City Studios, Inc. v. Reimerdes, 111 F. Supp. 2d 294 (S.D.N.Y. 2000).
71. 17 U.S.C. § 1201(f)(1).
72. *Id.*
73. *See* Universal City Studios, Inc. v. Corley, 273 F.3d 429 (2d Cir. 2001); United States v. Elcom, Ltd., 203 F. Supp. 2d 1111 (N.D. Cal. 2002).
74. *Corley*, 273 F.3d at 459.
75. *Id.*
76. *Elcom*, 203 F. Supp. 2d at 1120.
77. *Id.* at 1120-21 (citing 17 U.S.C. § 1201(c)(1)).
78. 17 U.S.C. § 1201(f)(1).
79. *Id.* § 1201(c)(1).
80. Hugo (Paramount Pictures 2011).

the filmmaker Georges Méliès, affectionately called "Papa Georges."[81] When Hugo and Isabelle discover Papa Georges' true identity, they embark on a journey to return the now anonymous filmmaker to his former glory.[82] Ben Kingsley as Georges Méliès is a remarkable likeness to the man himself, and Martin Scorsese does an excellent job of transferring his own love of film onto the screen. Scorsese does so by utilizing clips from dozens of early films including Méliès' own *Trip to the Moon*.[83]

Méliès was a magician who first fell in love with films in 1895 and began making his own films about a year later.[84] Méliès was the first filmmaker to use such techniques as fading, dissolve, and stop-animation in order to create a narrative.[85] His works were often fantastical, and Méliès is considered the father of special effects.[86] Méliès' work has been admired for over a century, but with author Brian Selznick and Martin Scorsese's assistance it has been introduced to a new generation.

Most of Méliès' works entered into the public domain in France sometime around 2008, the same year that a complete collection of his life's works was released on DVD.[87] For a mere sixty-three U.S. dollars, you can own a complete collection of Méliès' public domain films.[88] However, if you circumvent the Content Scramble System (CSS) in order to access and copy the films, you are violating the DMCA.[89] Thanks to Flicker Alley Studios, Méliès' work is once again protected by copyright.

This problem will only worsen with time, as Oscar-winning films *The Artist* and *Hugo* have sparked a renewed interest in silent films. Studios will take advantage of this interest by creating compilations of public domain works for people to have in their homes, which will not only grant derivative work copyrights in the selection and organization of the movies, but will also grant protection to the works under the DMCA in perpetuity. In addition, Méliès' work as used in the movie *Hugo* may not be protected by Scorsese's use, however, it is protected by its transfer to DVD through the anticircumvention law.[90] While this issue has yet to be brought before a court, it is an acknowledged problem that treads very heavily on the limited time protections of the Constitution's Copyright Clause.[91]

III. Limited Times

The Constitution states very clearly that Congress has the power to grant exclusive rights to authors for a limited time.[92] The Supreme Court has interpreted that phrase "limited Times" as the framers knew it to say that so long as authors' rights do not last in perpetuity, they are limited.[93] It has been posited that the "limited Times" restriction is an important factor in the promotion of the progress of science and the useful arts and that public domain works are essential for this progress.[94] To that end, copyrights have always expired and should always expire, thereby allowing all creative works to enter into the possession of the public to be used freely. A problem arises when works that are already in the public domain are suddenly removed and given renewed copyright protection or, worse yet, removed from the public domain without renewed copyright protection.

A. *Eldred v. Ashcroft*

In 1998, Congress enacted the CTEA which extended the copyright term of existing

81. *Id.*
82. *Id.*
83. *Id.*
84. Michael Kaminsky, *Georges Méliès: Mini Biography*, Internet Movie Database, http://www.imdb.com/name/nm0617588/bio (last visited June 14, 2012).
85. *Id.*
86. *Id.*
87. Georges Méliès: First Wizard of Cinema 1896-1913 (Flicker Alley Studios 2008).
88. *See, e.g.*, *George Méliès: First Wizard of Cinema 1896-1913*, Amazon.com, http://www.amazon.com (search "George Méliès: First Wizard of Cinema 1896-1913") (last visited June 12, 2012).
89. 17 U.S.C. § 1201(a)(1)(A).
90. *Id.*
91. Universal City Studios, Inc. v. Reimerdes, 111 F. Supp. 2d 294, 322 n.159 (S.D.N.Y. 2000).
92. U.S. Const. art. I, § 8, cl. 8.
93. Eldred v. Ashcroft, 537 U.S. 186, 199 (2003) (defining "limited" according to early dictionaries).
94. *Id.* at 211-12 (reciting Petitioners' argument that the Copyright Term Extension Act was contrary to Congress's Constitutional power to "promote the progress of Science and Useful Arts").

and future works by twenty years.[95] Eric Eldred and others filed suit against the Attorney General (Janet Reno in the lower courts and John Ashcroft in the Supreme Court) claiming that the CTEA went beyond Congress's powers as dictated by the Copyright clause of the U.S. Constitution.[96] Eldred and company were in the business of creating products and services that built upon public domain works and were now faced with the prospect of waiting another twenty years to restore and exploit works that were on the cusp of entering into the public domain.[97] This meant that the public would have to wait another twenty years to experience and enjoy about ninety-eight percent of works nearing the end of their copyright life.[98]

Congress's decision to extend the allowed copyright term was based on several main factors: extended life expectancy, changes in economics, and technological advances.[99] The primary reason to have copyright last fifty years beyond the life of the author was so the author's heirs might enjoy the fruits of her labor.[100] However, those heirs were now living longer, and over time, economic changes had possibly decreased the value of initial licenses entered into by the authors.[101]

Finally, Congress hoped that advances in technology would spur authors to re-release earlier works thereby sending them into the marketplace for a new generation.[102] This theory worked in practice for those authors who are living, but, ironically, it kept works by deceased authors out of the hands of that same generation for twenty years more than it would have prior to the enactment. It could be argued that the authors' heirs would then have an incentive to re-release those earlier works, but such an incentive is no guarantee. In fact, many heirs do fight viciously to protect their interests in their ancestor's work and it is not until that work has passed into the public domain that affordable copies of the work will abound.[103]

The Supreme Court upheld the CTEA as being within Congress's Constitutional power and US copyright duration is currently the life of the author plus seventy years.[104] While this decision upholding the Act did not technically remove works from the public domain, it did stop works from entering the public domain.[105] The extension also brought U.S. copyright law in line with most European copyright terms, another impetus for Congress to enact the amendment.[106] Around the same time that the CTEA was being passed, Congress passed the DMCA, which also had an effect on authors' limited protections.

B. *Universal City Studios v. Corley*

At the advent of digital technology, the entertainment industry saw the DVD not as a godsend allowing them to disseminate high-quality compact copies of their works, but as a threat to their copyright protections

95. Copyright Term Extension Act of 1998, Pub. L. No. 105-298, 112 Stat. 2827 (codified in sections of 17 U.S.C.).

96. *Eldred*, 537 U.S. at 193.

97. Arlen W. Langvardt & Kyle T. Langvardt, *Unwise or Unconstitutional? The Copyright Term Extension Act, the* Eldred *Decision, and the Freezing of the Public Domain for Private Benefit*, 5 Minn. J. L. Sci. & Tech. 193, 246 (2004) (noting that Eldred was a restorer of old films).

98. *Eldred*, 537 U.S. at 248 (Breyer, J. dissenting) ("[O]nly about 2% of copyrights between 55 and 75 years retain their commercial value.").

99. *Id.* at 206-07 (majority opinion).

100. Sen. Orrin G. Hatch, *Toward a Principled Approach to Copyright Legislation at the Turn of the Millennium*, 59 U. Pitt. L. Rev. 719, 733 (1998).

101. Milne *ex rel*. Coyne v. Stephen Slesinger, Inc., 430 F.3d 1036 (9th Cir. 2005) (explaining that the granddaughter of A. A. Milne sought to terminate Milne's original contract with Slesinger in order to enter into an agreement with the Walt Disney Co. after the enactment of the CTEA).

102. *Eldred*, 537 U.S. at 206–07.

103. Langvardt & Langvart, *supra* note 97, at 246 ("At the same time, many of [the older works], though not cost-effective investments for their current rights-holders, would stand a far better chance of restoration or other revisitation if they were in the public domain."); Robert Spoo, Note, *Copyright Protectionism and Its Discontents: The Case of James Joyce's Ulysses in America*, 108 Yale L.J. 633, 661–62 (1998) (discussing that publishers had been ready to make Ulysses available in public domain versions at the time copyright was set to expire).

104. *Eldred*, 537 U.S. at 186.

105. Walt Disney's *Steamboat Willy* was published in 1928 and was set to enter the public domain in 2003 as the duration of copyright for works owned by a corporation was seventy-five years. Thanks to the CTEA, *Steamboat Willy* is protected until 2023. *See* Museum of Modern Art, The Collection, http://www.moma.org/collection/object.php?object_id=89284 (last visited July 14, 2012).

106. *Eldred*, 537 U.S. at 205–06.

and profits.[107] The film industry was reluctant to move to the newer medium without some assurances that their copyrights would be protected.[108] The answer was CSS, developed in 1996, which encrypted the content on DVDs and could only be unlocked by a key that is found on DVD players.[109] Studios now had a plan to protect content and a licensing scheme that ensured manufacturers of DVD players would comply with this protection plan.[110]

The studios' plans were certain to succeed when the DMCA was enacted in 1998 and DVDs were further protected from possible future piracy.[111] Finally in 1999, Jon Johanssen managed to reverse-engineer a decryption key that allowed him to play CSS-protected DVDs on a Linux operating system, which had previously been impossible.[112] He called the program DeCSS and posted the object code on his website.[113]

Eric Corley, publisher of a magazine geared towards computer hackers called *2600: The Hacker Quarterly*, posted both the DeCSS object and source code on the magazine's website and a comprehensive guide of how to use the code.[114] Universal City Studios and several other film studios sued Corley and two other defendants in 2000 for violating the DMCA anti-trafficking provisions.[115] In the Southern District of New York, Corley argued that CSS prevented consumers from making legitimate use of the DVD.[116] In a footnote, the court admits that there is a risk of limiting access to non-copyright protected works, including public domain works, through technological measures, but in the text of the case the court held that the facts of the case did not pose that risk.[117]

Corley, determined to fight, appealed the decision. A number of amici curiae were filed in his support.[118] One of those briefs was a thoughtful argument from Professor Julie Cohen of Georgetown University Law Center.[119] Writing on behalf of herself and forty-five other intellectual property professors from around the country, she argued that the DMCA oversteps Congress's authority to grant protection to works for a limited time.[120] Professor Cohen had the foresight to imagine works that integrated public domain works and then protected them, thereby giving them perpetual copyright protection.[121] Further, Professor Cohen argues that no part of the Constitution allows Congress to create such technological restrictions on works regardless of originality, duration, or infringement.[122]

The Second Circuit rejected this supposition for two reasons. The main reason is that the argument did not have merit at the time.[123] The court was correct in that, at the time, no issue had been raised that mirrored those facts.[124] The issue was a future concern and therefore could not hold any weight in the current discussion.[125] The second, and possibly more vexing, reason was that the Defendants had relegated the argument to a footnote.[126] The court refused to consider the argument because footnotes are not given appellate consideration

107. Universal City Studios, Inc. v. Corley, 273 F.3d 429, 436 (2d Cir. 2001) (indicating that DVDs were a medium from which multiple copies were easily made and each copy would be as clear as the original).

108. *Id.*

109. *Id.* at 436–37.

110. *Id.* at 437.

111. *Id.*

112. *Id.*

113. *Corley*, 273 F.3d at 438–39 (clarifying that object code is not meant for every layperson to use).

114. *See id.* at 435–36, 439; 2600 News, http://www.2600.com.

115. *Corley*, 273 F.3d at 434–36 (Reimerdes and Kazan settled prior to appeal at the Circuit Court).

116. Eddan Elizafon Katz, *RealNetworks, Inc. v. Streambox, Inc. & Universal City Studios, Inc. v. Reimerdes*, 16 Berkeley Tech. L.J. 53, 62 (2001).

117. Universal City Studios, Inc. v. Reimerdes, 111 F. Supp. 2d 294, 322 n.159 (S.D.N.Y. 2000).

118. *See MPAA DVD Cases Archive*, Electronic Frontier Foundation, https://w2.eff.org/IP/Video/MPAA_DVD_cases/ (last visited July 14, 2012).

119. Brief for Intellectual Property Professors as Amici Curiae Supporting Defendants-Appellants, *Universal City Studios, Inc. v. Corley*, 273 F.3d 429 (2d Cir. 2001) (No. 00-9185), *available at* https://w2.eff.org/IP/Video/MPAA_DVD_cases/20010126_ny_lawprofs_amicus.html [hereinafter Brief for Intellectual Property Professors].

120. *Id.* at pt. 2.

121. Universal City Studios, Inc. v. Corley, 273 F.3d 429, 444–45 (2d Cir. 2001); Brief for Intellectual Property Professors, *supra* note 119, at pt. 2C.

122. Brief for Intellectual Property Professors, *supra* note 119, at pt. 1.

123. *Corley*, 273 F.3d at 445.

124. *Id.*

125. *Id.* (agreeing with the lower court that the concern does not appear to be a problem yet).

126. *Id.* at 444–45.

and an amicus brief can only be helpful in elaborating on properly presented issues.[127]

The circuit court was not persuaded by Corley's various constitutional arguments and affirmed the lower court's decision to enjoin the Defendants from trafficking in the circumvention technology, which included posting the code on their website and linking to the code on other websites.[128] But the lower court and the appellate court were correct in assuming that sometime in the future the technological protection of public domain works would become a problem. As discussed above, the resurgence of classic silent movies has posed a problem of accessing public domain works on DVDs. Those who do have access to the originals may even be able to create a copyright interest in those public domain works by creating derivative works. But those derivative works only acquire partial protection, and the problem is still posed that the parts no longer protected by copyright, when placed on a DVD, are then technically protected by copyright.

IV. Derivative Works

Derivative works are those based on one or more pre-existing works.[129] An author creates a derivative work when she translates, fictionalizes, adapts, abridges, or condenses another copyright-protected or public domain work.[130] Creating a derivative work is one of the rights inherent in copyright.[131] An author may not make a derivative of a copyright-protected work without the permission of the author of the original work.[132] For that reason, making derivative works from public domain works has become a prolific industry.[133] The act of creating derivative works from copyright-protected works is not unheard of, but difficulties can arise in such situations, especially if the authors of the original works are deceased.[134] The phenomenon of creating derivative works from public domain works has given rise to the latest craze of mixing public domain works with unrelated genres, fan fiction, and comic book adaptations.[135] Another product of this practice is modern films incorporating public domain films as part of the narrative.

A. Public Domain Works in Copyrighted Works and Compilations

The public domain is an intangible place made up of works that are not copyright protected because they cannot be copyrighted or because copyright protections have expired.[136] It is becoming a frequent practice for modern authors to take works from the public domain and simply insert them into their original work.[137] The issue with this practice is determining what rights are conferred on the modern author. To answer that question, we must first determine whether or not the author's contribution is creative and more than minimal.[138] In the past, the court in *Maljack Productions v. UAV Corp.* found that using "pan-and-scan" technology to alter a public domain film as well as enhancing the soundtrack meets the *de minimus* degree of creativity required to establish valid copyright.[139] Pan-and-scan

127. *Id.* at 445.

128. *Id.* at 434–35.

129. 17 U.S.C. § 101 (2006 & Supp. 2011).

130. *Id.*

131. David Nimmer & Melville Nimmer, Nimmer on Copyright § 3.01 (Matthew Bender, ed. 2011).

132. *Id*.

133. Langvardt & Langvart, *supra* note 97, at 246 (Eldred was a restorer of old films).

134. *See* SunTrust Bank v. Houghton Mifflin Co., 268 F.3d 1257 (11th Cir. 2001) (illustrating that heirs and estates can be fiercely protective of their ancestor's works- for instance, Margaret Mitchell's heir's estate sued the publisher of a parody derivative work, *The Wind Done Gone*).

135. *See*, *e.g.*, Jane Austen & Seth Grahame-Smith, Pride and Prejudice and Zombies (Quirk Productions, Inc. 2009); Marsha Altman, The Darcys & The Bingleys: A Tale of Two Gentlemen's Marriages to Two Most Devoted Sisters (Sourcebooks, Inc. 2008) (previously posted at fanfiction.net as two separate stories); Nancy Butler & Sonny Liew, Sense & Sensibility Classics (Marvel 2011).

136. *Public Domain*, UCCopyright, http:// copyright.universityofcalifornia.edu/publicdomain.html (last visited Mar. 25, 2012).

137. *See*, *e.g.*, Austen & Grahame-Smith, *supra* note 135 (showing how Grahame-Smith uses segments of Austen's original work verbatim throughout his story); Hugo (Paramount Pictures 2011) (demonstrating that Scorsese inserts several clips from silent films throughout the latter half of the movie).

138. Nimmer, *supra* note 131, § 3.03.

139. Maljack Prods., Inc. v. UAV Corp., 964 F. Supp. 1416, 1426 (C.D. Cal. 1997).

technology is an intelligent program that scans horizontally across a 4:3 aspect ratio image while keeping the action in the middle of the screen.[140] This technology was widespread when films shot for widescreens were being viewed on a standard square television set. While the process of panning-and-scanning seems entirely technical and therefore not copyrightable, it was found that the person whose job it is to pan and scan has a number of options and that his or her decisions meet the creative criteria.[141]

The court in *L. Batlin & Son, Inc. v. Snyder* found that there is a higher standard for determining the copyrightability of contributions and additions to public domain works.[142] The same court later determined that there were two limitations when considering copyrightability of derivative works. Those limitations were:

> 1. To support a copyright the original aspects of a derivative work must be more than trivial. 2. The scope of protection afforded a derivative work must reflect the degree to which it relies on the preexisting material and must not in any way affect the scope of any copyright in this preexisting material.[143]

The Copyright Office used these limitations in determining whether or not colorization of black and white films should be copyrightable, specifically on public domain films.[144] Ralph Oman determined that the only portion of copyrightable work in the colorized derivative would be in the original selection of color, but that the public domain film would remain in the public domain and would be available to others who wished to create their own colorized versions.[145]

Compilations are another type of derivative work that is given copyright protection.[146] Collecting a series of public domain works into one place is another common practice evidenced by complete works books and DVDs. Courts have found that the act of collecting scenes from public domain films was considered enough of a contribution to the original work to be deemed copyrightable.[147]

However, the copyright granted to the derivative work does not also protect the public domain work.[148] The artistic process of panning and scanning is copyrighted, and no other film studio is allowed to copy the results of that process, however, the film itself is still in the public domain and other film studios may use the original and edit and adjust it as they see fit, so long as they do not copy the first derivative work.[149] Depending on the creator, making a compilation of public domain works can either require a great deal of skill and hard work, or it can be an easy way to make money. In either case, the compiler is only guaranteed copyright in his or her selection, coordination, and arrangement of the works.[150] The essential lesson learned from derivative works is that once a work has passed into the public domain, no author should be able to take it out again. Generally, that is the case.

The *Golan* case proved the falsity of this claim, though the works that were removed from the public domain would eventually return upon expiration of copyright protection.[151] In the URAA, the Act whose constitutionality is challenged in *Golan*, Congress made provisions for derivative works made from public domain works that would no longer be in the public domain.[152] The author of the derivative work was allowed to continue to exploit the work

140. Clint DeBoer, *Understanding Widescreen, Letterboxed, and Pan & Scan*, Audioholics Online A/V Magazine, http://www.audioholics.com/education/display-formats-technology/understanding-widescreen-letterboxed-and-pan-scan (last visited Apr. 9, 2012).

141. *Maljack*, 964 F. Supp. at 1426–27.

142. L. Batlin & Son, Inc. v. Snyder, 536 F.2d 488 (2d Cir. 1976); Ralph Oman, *Notice of Registration Decision: Copyright Registration for Colorized Versions of Black and White Motion Pictures*, Copyright Office, *available at* http://www.copyright.gov/history/mls/ML-366.pdf.

143. Oman, *supra* note 142.

144. *Id.*

145. *Id.*

146. Nimmer, *supra* note 131, § 3.03.

147. *Id.*

148. *Id.* § 3.04.

149. *Id.*

150. *Id.*

151. Golan v. Holder, 132 S. Ct. 873, 882 (2012).

152. 17 U.S.C. § 104A(d)(3).

without incurring liability for infringement as long as she paid a fee to the original owner.[153] However, in the case of films that are still in the public domain, the addition of those films to copyrighted films, or the creation of derivative works in digital form has the potential to create a perpetual copyright.

Though the court in *United States v. Elcom* would disagree, stating that "the DMCA does not prevent access to matters in the public domain or allow any publisher to remove from the public domain and acquire rights in any public domain work."[154] The problem with this supposition is that the court in *Elcom* generally spoke of public domain books in electronic format and posited that the digital version was not the only version available to readers.[155] In the case of public domain films, it is not nearly so easy to acquire copies; in many circumstances a compilation DVD of early silent films might be the only access available to a user. In other cases, a DVD of the movie *Hugo* might be the only access a user has to the films of Méliès.

Bringing the book *The Invention of Hugo Cabret* to life as the film *Hugo* required Scorsese to use numerous public domain works throughout the film. The author of the book, Brian Selznick, admits to having seen Méliès's movie *A Trip to the Moon* and hoping to write a book about the artist one day.[156] The result was a children's graphic novel about a young boy who becomes friends with the famous director.[157] It naturally follows that the film adaptation of the book should include clips of original Méliès movies. At one point in the film, Hugo and Isabelle are looking through a book titled *The Invention of Films*, an illustrated guide to movies (circa 1930).[158] Scorsese brings this book to life with a montage of clips from early films. Scorsese's selection and arrangement of the public domain clips creates a derivative work and earns Paramount Pictures the protection of copyright.[159] To copy that montage exactly as it is assembled by Scorsese would be infringement.[160] Each individual clip is free for use, but the montage moves so quickly and the clips are so short that Scorsese has all but guaranteed protection for this particular compilation.

The same principle works for the second montage at the end of the film in which a number of Méliès's films are shown. However, a pivotal scene in the film comes when Hugo, Isabelle, and Mama Jeanne (Jeanne d'Arcy, Méliès' wife) are watching *A Trip to the Moon*. During this scene, we see short clips of the film with shots of character reactions between.[161] The clips might be considered protected according to the standards of the *Maljack* court, because the *Hugo* soundtrack has character commentary playing over the clips, which courts might consider an enhancement of the soundtrack.[162] However, Scorsese and his team did not enhance the original soundtrack, because there was not an original soundtrack in *A Trip to the Moon*; a film made in 1902 would have been released by the studio with a thematic cue sheet for a live musician to play in the theater.[163] This means that the score playing over the film is an original creation of *Hugo* composer Howard Shore, which is copyright protected. Therefore, if one wanted to copy the individual clips of *A Trip to the Moon* they are welcome to do so, but they may not copy the clips with Howard Shore's composition or screenwriter John Logan's script playing over it.

Paramount Pictures can be assured of absolute copyright in the selection, arrangement, and alterations made to the public domain films used in *Hugo*. Even if someone were able to copy the clips used without violating Paramount's copyright in the compilation, the original soundtrack on the clips ensures that the copier would be infringing Paramount's

153. *Id.* § 104A(d)(3)(i)-(ii).

154. United States v. Elcom, Ltd., 203 F. Supp. 2d 1111, 1131 (N.D. Cal. 2002) (internal quotations omitted).

155. *Id.*

156. Brian Selznick, *About Georges Méliès*, The Invention of Hugo Cabret, http://www.theinventionofhugocabret.com/about_georges.htm (last visited Mar. 25, 2012).

157. Brian Selznick, The Invention of Hugo Cabret (Scholastic Press 2007).

158. Hugo (Paramount Pictures 2011).

159. Nimmer, *supra* note 131, § 3.04.

160. *Id*.

161. Hugo (Paramount Pictures 2011).

162. Maljack Prods., Inc. v. UAV Corp., 964 F. Supp. 1416, 1426-27 (C.D. Cal. 1997).

163. Fredrick Hodges, *The Art of Accompanying Silent Films*, Frederick Hodges, http://www.frederickhodges.com/silentfilm.html (last visited Mar. 25, 2012).

copyright.[164] The only way a copier might feasibly access the public domain content without violating Paramount's rights in Scorsese's compilation and original score would be to remove them digitally, which as we know, is illegal under the DMCA.[165]

B. Digital Restoration of Public Domain Works

Digital restoration of public domain works is an incredibly important practice that takes works that are in disrepair and cleans them up for established fans and new generations to enjoy. However, it is not a practice that is profitable by itself.[166] In the past, the work of a restorer might have been protected under the sweat of the brow doctrine, but the Supreme Court's ruling in *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.* established that the hard work undertaken by a restorer to maintain historical accuracy is not enough to give the work copyright protection.[167] In order for one to enjoy copyright in their derivative work, the contribution must be derivative of the original, which is antithetical to the practice of a restorer.[168] A restorer's job is to return a classical work to its original glory. This should not allow for the addition of new soundtrack, pan-and-scan technology, or additional stories. However, digital restorers can combine their efforts with other artists who will add those things, as well as package the product and distribute it for sale.[169] In this way, the minimal contributions made by the restorer are enhanced and protected by the original score of a composer and the digital format of the package.

Flicker Alley Studio is a company that specializes in this process of restoring and creating collections of public domain works and placing those collections on DVD and selling them.[170] Their mission is to bring film history to new audiences.[171] This admirable goal is somewhat spoiled by the exorbitant prices they charge for works that one should be able to access for free.[172] Flicker Alley is able to charge these prices because their works are sold on DVDs and are therefore protected from unauthorized copying by the DMCA anticircumvention provision.[173]

Digital restoration of films is an important aspect of preserving history in the form of early films. In order to promote restoration, absent copyright protection, Congress created the National Film Preservation Foundation.[174] The Foundation is headed by a board composed of prominent members of various motion picture organizations, including Martin Scorsese representing the Director's Guild of America.[175] The purpose of the Foundation is to make early films available for study and research, and to that end, it provides grants around the country to promote film preservation.[176] However, when restoration is done for commercial gain the results are much different, often restricting access to those early films rather than promoting it.

Ideally, the process of restoring public domain films and placing them on DVD should make it easier to freely disseminate these classical films. Even if the restoration companies create derivatives by adding soundtracks, that should not preclude audiences from accessing and legally copying the visual portion of the films. But the CSS protections

164. Nimmer, *supra* note 131, § 3.04.

165. 17 U.S.C. § 1201(a)(1)(A).

166. The National Film Preservation Foundation was founded in order to shoulder some of the cost and to promote the preservation of old films. *See About*, National Film Preservation Foundation, http://www.filmpreservation.org/about (last visited July 14, 2012).

167. Feist Publ'n, Inc. v. Rural Tel. Serv. Co., Inc., 499 U.S. 340 (1991).

168. Nimmer, *supra* note 131, § 3.03.

169. Flicker Alley, *About*, http://www.flickeralley.com/fa_about_01.html (last visited Mar. 25, 2012).

170. Flicker Alley, http://www.flickeralley.com/index.html (last visited Mar. 25, 2012).

171. *Id.*

172. Inaccessibility plays a large role in why the producers of these compilations and derivative works are able to mark up the DVDs so much. The industry of creating these DVDs is not so prolific as to create any competitive pricing and allows the few who take the time to make the DVDs to price them as they see fit.

173. 17 U.S.C. § 1201(a)(1)(A).

174. *About*, National Film Preservation Foundation, http://www.filmpreservation.org/about (last visited July 14, 2012).

175. Library of Congress, *National Film Preservation Board*, A/V Conservation, http://www.loc.gov/film/filmmemb.html (last visited Apr. 9, 2012).

176. *About*, National Film Preservation Foundation, http://www.filmpreservation.org/about (last visited July 14, 2012).

prevent copying of any and all content on the DVD, ensuring that public domain films are essentially copyright protected.[177] Furthermore, the protection of these films appears to be in perpetuity unless the DMCA is amended, overruled as unconstitutional, or the LOC sees fit to exempt the public from liability under the anticircumvention provision for copying such films. Unfortunately, the latter is the most likely and the least effective.

V. Library of Congress Exceptions

At the time Congress was considering the DMCA they recognized the potential issue of limiting fair use access to content for educational and other important social uses.[178] In order to pass the bill that would eventually become the DMCA, the drafters included a provision that empowered the LOC, a non-political presidential appointee, to choose certain categories of content that would be exempted from the anticircumvention provision.[179]

Section 1201(a)(1)(C)-(D) of the Copyright Statute gives the LOC the power to grant exceptions to the anticircumvention provision to certain categories of works.[180] However, the grant lasts only three years, at the end of which the proponents of said categories will have to appeal for an exception again.[181] During the rulemaking, the LOC considers: the availability for use of the works; the availability for use of works for nonprofit; archival, preservation, and educational purposes; the impact that the prohibition on circumvention has on criticism, comment, news reporting, teaching, scholarship, or research; the effect of circumvention on the market value of works; and other factors that the LOC deems appropriate.[182]

A. Rulemaking Efficacy

The first rulemaking by the LOC occurred in 2000, and the most recent rulemaking concluded in 2010.[183] The rulemaking process is a unique investment of power in an official who is not elected.[184] As a nod to valid fair use concerns, the Commerce Committee report stated "[t]he primary goal of the rulemaking proceeding is to assess whether the prevalence of these technological protections, with respect to particular categories of copyrighted materials, is diminishing the ability of individuals to use these works in ways that are otherwise lawful."[185] Therefore, the public is invited to apply to the LOC for an exception every three years, and if that request is denied then the requestors may pursue their application through the Administration Procedure Act.[186]

Currently, there are six exceptions available: (1) circumvention of CSS on legally acquired Motion Pictures for Fair Use; (2) circumvention of protections that prevent certain applications from working on cell phones; (3) work-arounds that allow users to connect cell phones to wireless networks; (4) accessing video games solely for the purpose of testing for security flaws; (5) computer programs protected by a broken or obsolete dongle, a small piece of hardware that allows users to access software they have legally purchased; and (6) circumvention of controls that prevent screen readers so that blind people may use ebooks.[187] The fair use exception is an incredibly important exception for the education industry, but the most socially-conscious and useful exception is the sixth. The sixth exception is also number two on the next list of proposed classes of works.[188] The need for blind people

177. In order to separate the soundtrack from the video one must first be able to deactivate the CSS. While the law prevents the user from circumventing the TPMs the user is unable to separate copyright-protected content from public domain content.

178. H.R. Rep. No. 105-551, pt. 2, at 36 (1998).

179. 17 U.S.C. § 1201(a)(1)(C)-(D).

180. *Id.*

181. *Statement of the Librarian of Congress Relating to Section 1201 Rulemaking*, U.S. Copyright Office, http://www.copyright.gov/1201/docs/librarian_statement_01.html (last visited Mar. 24, 2012).

182. 17 U.S.C. § 1201(a)(1)(C)(i)-(v).

183. *Exception to Prohibition on Circumvention of Copyright Protection Systems for Access Control Technologies*, U.S. Copyright Office, http://www.copyright.gov/1201/ (last visited Mar. 20, 2012).

184. Jeff Sharp, *Coming Soon to Pay-Per-View: How the Digital Millennium Copyright Act Enables Digital Content Owners to Circumvent Educational Fair Use*, 40 Am. Bus. L.J. 1, 43 (Fall 2002).

185. H.R. Rep. No. 105-551, pt. 2, at 37 (1998).

186. Sharp, *supra* note 184, at 44.

187. *Rulemaking on Anticircumvention*, U.S. Copyright Office, http://www.copyright.gov/1201/2010/ (last visited Mar. 25, 2012).

188. *Proposed Classes of Works*, U.S. Copyright

to circumvent TPMs on ebooks in order to enjoy their books has not changed since the LOC released the 2003 list, and one might presume that this need will continue indefinitely.[189]

One could argue that the rulemaking process is a necessary evil considering the ever-changing nature of technology, because in three years' time a new technology might require a new exception to be made. As people find chinks in the armor of TPMs, they will create newer and stronger technologies to work around. However, it is clear that the exception is ephemeral at best, providing a very short term of protection and a waste of resources when parties are required to apply for exception again. The concern of several members of Congress at the inception of the DMCA was:

> [T]hat marketplace realities may someday dictate a different outcome, resulting in less access, rather than more, to copyrighted materials that are important to education, scholarship, and other socially vital endeavors. This result could flow from a confluence of factors, including the elimination of print or other hard-copy versions, the permanent encryption of all electronic copies, and the adoption of business models that depend upon restricting distribution and availability, rather than upon maximizing it.[190]

This legitimate concern was apparently waylaid by the addition of the LOC's exception, but the three-year limitation should have raised an alarm. For example, the report mentions "the elimination of print or other hard-copy versions," which is an excellent reason to maintain exception six for screen readers assisting the blind. It would make more sense to maintain exceptions indefinitely because those types of uses worthy of exception will most likely never be protected again. Changing technology will ensure that only new exceptions will need to be made, and it only makes sense to keep the old ones in place for those who continue to use older technology. Those who circumvent TPMs to allow a screen reader for the blind will only continue to need this exception as more and more books enter the digital domain. However, it is unlikely that the blind will no longer need the exception after three years, so it seems like a waste of time and resources to require them to lobby for that exception every three years.

The onus of the process should be placed on the owners of the content who feel that their TPMs should *not* be circumvented without liability. This reform would require applicants to make their case for a specific class of work. The LOC, with the help of the Register of Copyrights and the Secretary of Communications and Information of the Department of Commerce, could determine that the class is worthy of an exception. The class would then be placed on the exception list until such time as the owners of the digital content appeal to the LOC to have the class of work removed. Digital content owners often have access to large associations that litigate on their behalf and should have no trouble appealing to the LOC every three years.[191]

The ephemerality of the exception also exists in the anti-trafficking provisions.[192] While the Library of Congress's rulemaking exempts those specific classes of works from liability for circumvention TPMs, the rulemaking does not apply to trafficking in circumvention tools.[193] It does not follow that those who are able to circumvent must also traffic in circumvention technologies, but in order for the less technically savvy to take advantage of those legal and fair uses exempted by the LOC, the circumvention technology must be available somewhere. As long as those who are able to reverse engineer are prevented from sharing their work with the public, the general public will be unable circumvent the TPMs. Essentially, what the LOC exception means is that the public is

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Office, http://www.copyright.gov/1201/2011/initial/ (last visited Mar. 25, 2012).

189. *Exception to Prohibition on Circumvention of Copyright Protection Systems for Access Control Technologies*, U.S. Copyright Office, http://www.copyright.gov/1201/ (last visited Mar. 25, 2012).

190. H.R. Rep. No. 105-551, pt. 2, at 36 (1998).

191. For example, the record industry has the RIAA, the movie industry has the MPAA, etc.

192. 17 U.S.C. § 1201(a)(2)(A)-(b)(2)(B).

193. *Id.* § 1201(a)(1)(E).

allowed to reverse engineer a de-encryption code or develop a work around, and then they are allowed to use those tools to access the content on a specific type of work that is going to change in three years.[194]

As of the close of business on February 10, 2012, the date by which all proposed classes are due to the LOC, the only mention of public domain works is made by the Open Book Alliance and refers to literary works in the public domain made available in digital copies.[195] The next rulemaking will conclude in 2016 and the public will have to wait until 2015 before another individual or group might be able to propose an exception for motion pictures in the public domain made available on digital versatile disks.[196] On the positive side, having to wait until 2015 is not a bad thing for US movies in the public domain. If Charlie Chaplin Productions had renewed their copyright on *The Gold Rush* in 1953, the CTEA would have extended copyright protections to the film until 2018.[197] Those films that are still hanging on to copyright protection now would very likely become available by the time of the next rulemaking, which means that companies like Flicker Alley Studios would be able to re-introduce them into the mainstream.

194. Aaron K. Perzanowski, *Evolving Standards & The Future of the DMCA Anticircumvention Rulemaking*, 10 J. Internet L. 1, 20 (April 2007) ("While the DMCA rulemaking can exempt certain classes of works from the anticircumvention provision, Congress vested no authority in the Copyright Office or Librarian of Congress to grant corresponding exceptions from the anti-trafficking provisions.").

195. *Exemption to Prohibition on Circumvention of Copyright Protection Systems for Access Control Technologies*, U.S. Copyright Office, http://www.copyright.gov/1201/ (last visited Mar. 25, 2012).

196. *Id*. The rulemakings occur every three years. The most recent hearings have been held this year and the rulemaking will be concluded in 2013.

197. *The Gold Rush* was made in 1925. Under Copyright law at the time Chaplin had protection for twenty-eight years. The film entered the public domain in 1953 for a lack of renewal, but if it had been renewed, protection would have extended for forty-seven years, and the CTEA added an additional tewnty years which means that *The Gold Rush*'s copyright protection would have expired in 2018. *See The Duration of Copyright*, U.S. Copyright Office, http://www.copyright.gov/circs/circ15a.pdf; *see also*, *The Gold Rush*, Internet Movie DataBase, http://www.imdb.com/title/tt0015864/ (last visited July 14, 2012).

B. Reaching Public Domain Works

There are a few options available to circumvent the potentially perpetual copyright protection of public domain films. The first and most logical option is for the Library of Congress to digitize the films in their possession that are in the public domain. While a director such as Martin Scorsese may have the ability to travel to Washington, D.C. to acquire the footage he needs to incorporate into his movie, this is not a feasible option for many people seeking to exploit public domain films. Having access to those films in a digital form through the Copyright website would simplify the process and avoid issues with TPMs.

However, the protections present on DVDs from those TPMs still theoretically creates perpetual copyright on public domain works, regardless of whether it is necessary to circumvent the TPMs to access the films. The derivative work argument can only carry the authors so far, because it is physically possible to remove a video file from a DVD without touching the audio file, which essentially leaves the derivative work untouched.[198] Being able to circumvent any anti-copying protections in order to use the video from public domain films would solve the problem created by section 1201 of the DMCA.

The ability to reach the video of a public domain film independent of the audio means that films such as *Hugo* are protected as true derivative works, because the public domain films are so inextricably woven into the copyright-protected work that it would not be practical to allow circumvention of CSS in order to extract a few seconds of film from so many places. However, those who restore films and add soundtracks have no such excuse. Therefore, a Library of Congress exception should be made for DVDs of collections that feature public domain films.

VI. Conclusion

The potential for perpetual copyright

198. *How to Extract Video from DVD for Editing*, Metacafe, http://www.metacafe.com/watch/2112386/how_to_extract_video_from_dvd_for_editing/ (last visited Apr. 8, 2012).

on digital versions of public domain films that have been placed on DVDs protected by TPMs is a very real thing. Without modifications to the DMCA, or at least an exception made by the LOC, production companies that add a new sound track to public domain films and sell those films back to the public will have copyright protection not only for the audio aspect of the film, but for the video aspects as well.

Understanding that a large portion of the population will not be able to access the original films makes the need to circumvent TPMs on the DVDs that they are able to access even more important. Users of a DVD that they paid money for have a right to access the public domain video on those DVDs without liability. Furthermore, making the circumventing technology available is an important part of the process. Unfortunately, it would require a modification to the statute that allows an exception for those who traffic in the technology that makes circumvention possible. The best possible solution to avoid the widespread infringement that would most likely occur if these technologies are made available would be to license the technology from a controlled source and for a limited time, such as the Library of Congress.

While the ephemeral exception currently existing at the hands of the LOC needs revamping, the LOC seems to be the key to working around this problem. The Library has hundreds of public domain films on file because of the deposit formality of the 1909 Copyright Act. The Library could utilize the National Film Preservation Foundation to restore and digitize those films to be made available on the internet. But surpassing this singular issue, there is a need for people to access circumvention technology to enjoy their media in non-infringing ways. The Library of Congress could feasibly create an exclusive license with those who reverse engineer those technologies, such as universities who research this media. It is not the responsibility of those who exploit public domain films to make the films available to the public freely, but it is the duty of Congress to make sure that the public has access to public domain films.