'Dang' That Renewal Copyright Law

Law360, New York (March 14, 2012, 5:00 PM ET) –

The Sixth Circuit recently issued a rare decision addressing ownership of renewal copyrights — in some of country singer Roger Miller's songs: Roger Miller Music Inc. v. Sony/ATV Publishing LLC, Case No. 10-5363, 2012 (6th Cir. Feb. 22, 2012). It is worth a read if you have occasion to wrestle with renewal copyright issues.

Renewal copyrights are unquestionably tedious business. Not long ago we handled a case involving issues of renewal copyrights dating from Germany prior to World War II. See Cambridge Literary Properties Ltd v. W. Goebel Porzellanfabrik GmbH. & Co. KG.,510 F.3d 77 (1st Cir. 2007), cert. denied, 129 S.Ct. 58 (2008). The case took 65 years to bring and eight years to resolve!

Under the original Copyright Act, an author of a work enjoyed monopolistic power over a work he authored or created for a period of 14 years that was renewable for another 14-year period, for a total of 28 years. See 3 Melville Nimmer and David Nimmer, Nimmer On Copyright, § 9.01, et seq. (2011 ed.). Congress eventually deemed this period too short, and in 1909, it doubled the time period for both the original and "renewal" periods, extending each to 28 years.

Later, in 1976, Congress revised the Copyright Act to expand the original copyright period for future works to the life of the author, plus a renewal period of 50 years. For many works already in existence, Congress extended the overall copyright period for 95 years. Consequently, a composer of a song first published prior to 1978 owned all rights to it for 95 years — the original period of 28 years, and the renewal period of 67. Later, in the Sonny Bono Copyright Term Extension Act Congress extended the renewal period to 70 years after the death of the author.

But why have a renewal period at all? Why not just have one copyright period? Well, many authors assign the copyrights in their works to others. That and licensing specific use of their works are the principal ways authors make money on their creations. Songwriters, for example, regularly assign their copyrights to music publishers for a sum of money to get the benefit of certain cash payment (rather than deal with the uncertainty of royalty payments).

Congress, apparently feeling quite paternalistic, believed that economic necessity too often compelled starving artists to make improvident, irreversible decisions regarding their copyrights, conveying away all of their interests before the artists (or the market) knew the true value of the works. Congress was especially concerned about instances where artists' improvident decisions adversely affected their families, depriving the families of commercial successes that perhaps the authors did not initially anticipate.

Consequently, Congress modified the copyright laws to prevent an author from conveying away his copyright interests in both the original copyright period and the renewal period unless, first, the author expressly states he is conveying his renewal interests, and second, he survives to the renewal period. If the author reaches the renewal period, his earlier express conveyance of the

renewal copyright is binding. But if the author dies before the original term concludes, his copyrights revert to his family — even if he had previously intended to convey them to a third party. At least that is generally the case.

The Sixth Circuit braved this thorny thicket in Roger Miller. At issue in that case was whether Roger Miller, the author of such songs as "King of the Road," "You Can't Roller Skate In A Buffalo Herd" and "Dang Me," properly assigned his interest in the renewal copyrights to his songs to Sony, or whether Sony infringed Miller's copyrights in those songs by producing recordings of them after Miller's death in 1992.

As with the resolution of many cases, timing is important. At issue were songs Miller copyrighted in 1964. Miller died in 1992, the 28th year of the original copyright period. Shortly before Miller died, he applied for the renewal copyrights for the 1964 songs and assigned them to Sony. The question before the Sixth Circuit was whether the renewal copyrights went to Sony or reverted to Miller's family.

It was clear that the Copyright Act allows an author to assign his rights in a renewal copyright of a work if the author survived the original term, whether the assignment took place before or after the renewal period began. And historically, it was also clear that if he died before the renewal period began, his assignment of his renewal rights was ineffective. But the language of 17 U.S.C. § 304 applicable to this case could be read to be inconsistent with that proposition.

The statute is certainly not a model of clarity. What if the author died during that last year, before the renewal period began, after applying for and assigning the renewal copyright? Would the assignee enjoy the renewal copyright, or would the renewal copyright revert to the author's family, as historically happened by statute? Enter Roger Miller.

In its decision, which included a review of the circuitous procedural history of the case, the Sixth Circuit determined that 17 U.S.C. § 304(a)(2)(A) controlled. But the statute's lack of clarity forced the court to study the relevant House Report. The court concluded, with the help of the report, that Congress intended that such assignments made during the 28th copyright year could be effective.

Because Miller had applied for the copyright renewal and assigned it to Sony during the 28th year, the interest in the renewal copyright was properly conveyed to Sony and did not revert to his family upon his death, even though Miller did not survive to the renewal period. The renewal application and assignment trumped the death benefits to Miller's family the renewal period usually provides.

Therefore, because Sony owned the renewal copyrights in Roger Miller's songs, Sony could not be liable for infringement; owners, even co-owners of copyrights, cannot be liable for infringement. Based on this reasoning, the Sixth Circuit reversed the district court's decision enjoining Sony from further use of these songs and reversed the award to the Miller's family for infringement of over $900,000, as well.

Is there a useful takeaway from this decision? Its applicability, given the changes in the

Copyright Act, is certainly limited. But there is a lesson: Be extra careful when dealing with renewal copyrights of older works. Just because "That's the Way It's Always Been," does not mean that's the way it is now, "Dern Ya."

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