COPYRIGHT COMMENT

A literary tale

Cynthia S Arato and **Daniel J O'Neill** share a roadmap for copyright and moral-rights protections on works outside their countries of origin


Cynthia S Arato


Daniel J O'Neill

The trustees of the JD Salinger Literary Trust recently obtained court rulings in Germany and Italy against prominent book publishers who published three short stories by the late US author JD Salinger without the trustees' authorisation. The publishers erroneously contended that the three stories had fallen into the public domain in Germany and Italy simply because the works had fallen into the public domain in the US. As a result, they were found to have violated the trustees' copyrights and/or moral rights in the works.

As these cases illustrate, the interplay between US and international copyright law is complex and tricky, and even sophisticated entities can get tripped up when assessing what works are protected in which countries around the world.

Three early stories

The three Salinger stories – *Go See Eddie*, *Once a Week Won't Kill You*, and *The Young Folks* – were published in US literary journals in the 1940s. They fell into the public domain in the US due to noncompliance with certain formal requirements of US copyright law regarding copyright notices and registrations/renewals with the US Copyright Office.[1]

In 2014, the Devault-Graves Agency, a publisher in Tennessee, packaged the three stories together as *Three Early Stories* and sold the volume in the US. Devault-Graves also sought to license the volume to foreign publishers for translation and sale in other countries. Devault-Graves licensed the volume to Piper Verlag GmbH ("Piper") and Gruppo Editoriale Il Saggiatore Srl ("Il Saggiatore") for publication in Germany and Italy, respectively. After expending time, energy, and resources to fully understand the international copyright regime, including consulting with legal counsel both in and outside the US, the trustees concluded that they remained the rightful owners of the copyrights and moral rights in and to the three stories in both Germany and Italy, regardless of the works' public domain status in the US.

The trustees' counsel contacted Piper and Il Saggiatore, explaining why neither they nor Devault-Graves could publish *Three Early Stories* in Germany or Italy without the trustees' consent and asking that they cease and desist from publishing the work. Both Piper and Il Saggiatore challenged the trustees' assertions and refused to cease and desist from publishing the work.

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Judgments

The trustees instituted legal actions against Piper in the Regional Court of Berlin, and against Il Saggiatore in the Milan Court of First Instance. The New York litigation firm Shapiro Arato Bach spearheaded these efforts. Morrison & Foerster and Studio Legale Cunegatti Di Cocco e Associati represented the Trustees in Germany and Italy, respectively.

The trustees prevailed in both cases. In March 2015, the German court issued a Judgment finding that the trustees hold the exclusive rights to the Salinger stories in Germany. Accordingly, the court enjoined Piper from reproducing or selling *Three Early Stories* and ordered it to recall any copies that had already been delivered to bookstores.[2] This past August, the Italian court issued a judgment finding the stories protected in Italy until 2080.[3] The court enjoined Il Saggiatore from exploiting *Three Early Stories* and ordered it to recall and destroy copies already on the market. The court ordered Il Saggiatore to pay the trustees damages and to publish the judgment, at its own expense, in major newspapers and on websites.

Complex web

Both Piper and Il Saggiatore claimed that Devault-Graves had represented to them that the stories could lawfully be published outside the US. Devault-Graves, in turn, purported to rely on a provision of the Berne Convention known as the 'rule of the shorter term', which states that, unless a Berne signatory's internal legislation "otherwise provides", the term of protection afforded a foreign work "shall not exceed the term fixed in the country of origin of the work".[4] Devault-Graves argued that because the stories already had fallen into the public domain in the US, their "term" had expired in their country of origin and they were not entitled to protection in any country that had adopted that Rule.[5]

The German and Italian court rulings establish that the public domain status of the works cannot be assessed simply through the rule of shorter term. Rather, one must assess several other rules and authorities – including other parts of the Convention itself – to determine whether a work is protected outside its country of origin. Given the complex legal analysis that must be undertaken, the German and Italian courts criticised the European publishers for blindly relying on Devault-Graves. The German court commented

that Piper should not have "assume[d] that [Devault-Graves] could have trustworthily assessed and reliably clarified the complex copyright situation in Germany". The Italian court noted that Il Saggiatore failed to "fulfill its diligence duties, having not verified the source of the rights [Devault-Graves] claimed to hold".

Bilateral treaties

The courts first looked at treaties between their respective countries and the US to determine that JD Salinger's stories remain protected in Germany and Italy despite being in the public domain in the US.

Both Germany and Italy have copyright treaties with the US from 1892. These treaties require Germany and Italy to afford US authors the same copyright protections these countries give their own citizens, without regard to the status of the works under US law. As the German court recognised, under Germany's treaty, the existence and extent of any protection in Germany is dictated "exclusively by German law" and "does not depend on whether and, as the case may be, how long the work in question is still protected in the US". Similarly, the Italian court held that Italy's treaty affords US works the full scope of protections available under Italian copyright law "with no exception and no comparison" of each country's copyright term. The court thus deemed the stories' public domain status in the US "irrelevant".

Berne Convention

The courts also considered the Convention. The German court concluded that nothing in Berne could override Germany's 1892 treaty because the Convention "gives priority" to any treaty that gives authors "more extensive rights than those granted by the Convention".[6] Both courts, moreover, found that the Convention independently protects the stories in their countries, despite the works having fallen into the public domain in the US.

The Italian court held that Berne requires all signatories to protect the stories in their own countries "even though [the works] had fallen into public domain in the US" based on the failure to comply with the "formalities"[7] discussed above. The court looked to Article 5 of the Convention, which specifies that "[t]he enjoyment and the exercise of [the] rights [under Berne] shall not be subject to any formality." Based on that article, the court refused to strip the works of copyright protection based on formalities that the Convention prohibits. The German court similarly noted that the stories "also still enjoy copyright protection" under the Berne Convention.

EU protection

The Italian court also found it dispositive that the German court had already held the stories protected under German law. The court explained that once a work is protected in one member of the European Union, it is entitled to "uniform protection" throughout the EU under "the principle of assimilation" dictated by the European Parliament and of the Council and elaborated on by the Court of Justice of the European Union.[8] The court held that the German ruling therefore has "a direct effect" on the Salinger stories' protection in every other EU member as well.

Moral rights

The Italian court held that the publication of the stories in Italy violated Salinger's moral rights. Honoring statements that JD Salinger made during his lifetime, the court acknowledged that the author "for sure would not have wanted the three short stories at issue to be published again, translated and included in a collection," and held that Il Saggiatore wrongfully "contravened the will so overtly indicated by Salinger". The court concluded that the unauthorised exploitation of Salinger's stories "represent[ed] an unlawful utilisation of [his] name, image and fame"– potentially the first decision of its kind under Italian law.

Comment

The rulings in Germany and Italy demonstrate that one cannot assume that a work in one country's public domain can be freely published in other countries as well. Before attempting to publish another person's work outside its country of origin, publishers should carefully analyse each of the potential sources of protection that the German and Italian courts identified. Particularly when works are in the public domain due solely to arcane formalities of US copyright law, they are likely still protected in other countries, as Salinger's stories are.

Footnotes

1. Such "formalities" were required under the US Copyright Act of 1909 and continue in the US to govern works published before 1978. For works published in or after 1978, the US Copyright Act of 1976 dispensed with the formality of registration, and the Berne Convention Implementation Act of 1988 did away with the notice requirement.
2. *Salinger v Piper Verlag GmbH*, Ref No 15 0 62/15, Regional Court of Berlin, Germany (31 March 2015).
3. *Salinger v Gruppo Il Saggiatore SrL*, judgment No 8768/2018, Ordinary Court of Milan (29 August 2018).
4. Berne Convention, art 7(8).
5. Devault-Graves was not a party to the European litigations but sought a judicial declaration in the US that the Salinger short stories were in the public domain abroad, since they were in the public domain in the US. The trustees moved to dismiss that case on the ground, among others, that the court could not render such a ruling without undertaking a separate analysis for each country, as subsequently confirmed by the German and Italian courts. Rather than contest the trustees' motion, Devault-Graves withdrew its lawsuit.
6. Berne Convention, art 20.
7. Berne Convention, art 5(2).
8. Directive 2006/116/EC art. 10(2) (12 Dec 2006); *Sony Music Entertainment (Germany) GmbH v Falcon Neue Medien Vertrieb GmbH*, C-240/07 (20 January 2009).

Cynthia S Arato and Daniel J O'Neill are partners at Shapiro Arato Bach, which Arato co-founded in 2009. They represent and advise entertainment and media companies, major record companies, and prominent artists and writers on intellectual property litigation and media disputes.