

INTERNATIONAL COPYRIGHT: THE INTRODUCTION

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TABLE OF ABBREVIATIONS¹

*Courts*²

BGH	<i>Bundesgerichtshof</i> (Federal Court of Justice) ³
BVerfG	<i>Bundesverfassungsgericht</i> (Federal Constitutional Court) ⁴
CA	<i>Cour d'appel, Corte di Appello</i> , etc. (Court of Appeal) ⁵
Cass.	<i>Cassation</i> or <i>Cassazione</i> (Supreme Court) ⁶
Cir.	Circuit Court of Appeal ⁷
C.J.E.U.	Court of Justice of the European Union ⁸
D.	U.S. Federal District Court ⁹
ECtHR	European Court of Human Rights
LG	<i>Landgericht</i> (District Court) ¹⁰
OLG	<i>Oberlandesgericht</i> (High Regional Court) ¹¹
Trib.	<i>Tribunal</i> , etc. ¹²
U.S. or S. Ct.	U.S. Supreme Court

Sources

AMI	<i>AMI, Informatierecht, Tijdschrift voor auteurs-, media- en informatierecht</i> (AMI Information Law, Journal for Copyright and Information Law)
C.M.L.R. Copyright	<i>Common Market Law Reporter</i> <i>Copyright</i> , also previously published in French as <i>Le Droit d'Auteur</i> (Author's Right) (WIPO)
UNESCO Copr. bull.	<i>Copyright bulletin</i> (UNESCO)
Dir. aut.	<i>Il Diritto di autore</i> (Author's Right)
E.C.D.R.	<i>European Copyright and Design Reports</i>

¹ For abbreviations and other sources in specific jurisdictions, see the tables and bibliographies in the chapters that follow this one.

² For Commonwealth jurisdictions, standard citations, indicating courts, are given for most decisions; otherwise, along with reporters cited, courts are indicated in references.

³ In Germany, the final court of appeal on most issues.

⁴ In Germany, the final court of appeal on constitutional issues.

⁵ Notably in France, Belgium, or Italy, an intermediate court which retries issues of fact and of law appealed from lower trial courts. An abbreviation "corr." or "com." indicates a criminal or commercial chamber; otherwise, a civil chamber is signified.

⁶ In France or Italy, the final court of appeal. An abbreviation "crim.," "com.," or "civ." indicates a criminal, commercial, or civil chamber.

⁷ In the U.S. federal system, a court of appeal from district courts within a specific judicial region, the circuit, encompassing many districts.

⁸ Previously the European Court of Justice, abbreviated: E.C.J.

⁹ In the U.S. federal system, a trial court within a district, with other abbreviations specifying its location, for example, "S.D.N.Y." for Southern District of New York.

¹⁰ In Germany, a trial court with a district.

¹¹ In Germany, an intermediate court which retries issues of fact and of law appealed from lower trial courts. "KG" indicates the Berlin intermediate court.

¹² First-instance trial court, unless otherwise specified.

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E.C.R.	<i>European Court Reports</i>
E.C.H.R.	<i>Reports of the European Court of Human Rights</i>
Ent. L. Rev.	<i>Entertainment Law Review</i>
E.I.P.R.	<i>European Intellectual Property Review</i>
F.S.R.	<i>Fleet Street Reports of Industrial Property Cases from the Commonwealth and Europe</i>
GRUR Int.	<i>Gewerblicher Rechtsschutz und Urheberrecht—Internationaler Teil</i> (Industrial Property and Copyright Law—International Part)
I.I.C.	<i>International Review of Intellectual Property and Competition Law</i> ¹³
Industrial Property	<i>Industrial Property</i> , also previously published in French as <i>La Propriété Industrielle</i>
J. Copr. Soc’y	<i>Journal of the Copyright Society of the USA</i> ¹⁴
J.C.P.	<i>Juris-Classeur Périodique</i> ¹⁵
JIPITEC	<i>Journal of Intellectual Property, Information Technology and Electronic Commerce Law</i>
N.I.R.	<i>Nordiskt Immateriellt Rättsskydd</i> (Nordic Intellectual Property)
O.J.	<i>Official Journal of the European Union</i>
P.I.	<i>Propriétés intellectuelles</i> (Intellectual Properties)
SIC	<i>Revue du droit de la propriété intellectuelle, de l’information et de la concurrence</i> ([Swiss] Review of Intellectual Property, Information, and Competition Law)
RIDA	<i>Revue Internationale du Droit d’Auteur</i> (International Review of Author’s Right)
W.I.P.R.	<i>World Intellectual Property Report</i>

¹³ Previously published as the *International Review of Industrial Property and Copyright Law*, but still abbreviated: I.I.C.

¹⁴ Previously published as the *Bulletin of the Copyright Society of the USA*, and abbreviated: Bull. Copr. Soc’y.

¹⁵ Initials at the end of this cite indicate specific editions: “E.” for *Entreprise*, “G” for *Générale*, etc.

§ 1 How to Consult the Treatise?

[1] What are Cross-Border Copyright Cases?

We shall here speak of “copyright laws” as those recognizing copyrights or, as formulated in most of these laws, authors’ rights in works.¹ Such laws often also accord neighboring or other copyright-related rights in other media or data productions, like performances, recordings, broadcasts, databases, etc.² A regime of treaties conditions the application of such laws to cases of works or related productions that cross borders. We shall start by defining such cases and by outlining a framework for analyzing issues they raise.³

Imagine a *cross-border case* in our field. A work arises in country O: the work is authored in country O, by one of its nationals, or initially released to the public there; this work is next disseminated, without the author’s consent, into another country P. To take a classic example, a novel is written and first published in country O in the form of books that, without authorization, are reprinted and sold in another country P. In a more complex case, this work arising in country O is made available to members of the public in many countries, say, countries P, Q, R, etc., often online.⁴

Imagine, in turn, that a claimant of copyright in our border-crossing work sues for infringement. Map arguably infringing transactions: in the simple case, a transaction starts in one country O to end in another country P; in the complex case, transactions disseminate the work at issue into a number of other countries, P, Q, R, etc. Assume, provisionally, that the copyright law of each of these jurisdictions would govern the claims asserted for any act to be remedied there. This perspective is set out to frame analysis, while positions that deviate from it will be treated later.⁵ At the threshold, the following notions call for definition:

- *Relevant law*: Law relevant here encompasses a country’s copyright and related laws that protect works and related media or data productions. Albeit differently in diverse legal orders, such law extends to the country’s treaty obligations: for our purposes, these are obligations to protect foreign authors, performers, and producers and, correlatively, foreign works and related

¹ Unless otherwise indicated, the law treated here is current, as published, to April 1, 2018.

² Our term “production” here corresponds to the French notion of *prestation*, which includes services such as, for example, an artist furnishes in performing a work publicly or a producer provides in recording the performance, in compiling a database, etc.

³ For a model of analysis, see § 1[2] *infra*. On formulating issues and disposing of conflicts of laws in cross-border cases generally, see § 1[3] *infra*.

⁴ For a concise review of the methodology elaborated here, see P.E. Geller, “How to Practice Copyright Law Internationally in Perplexing Times?,” 60 J. Copr. Soc’y 167 (2013).

⁵ For the spectrum of approaches to determining which laws govern cross-border cases of copyright infringement, see § 3[1] *infra*. For choice-of-law approaches to determining which parties may assert or hold copyrights effective abroad, see §§ 6[2] and 6[3] *infra*.

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productions.⁶ Return to our classic example: a national in country O authors a work in which copyright is colorably infringed in country P or, in a harder case, also in countries Q, R, etc. A court, considering the claims of the author from country O, has to ask whether, and how, to protect the work or any other such production at issue in countries P, Q, R, etc. To this end, the court has to choose between or among arguably applicable laws.⁷

- *Protecting country versus forum country:* A protecting country is one where relief for an act would take effect, say, as follows: Given our author from country O, suppose that, in country P, copies of her work were illicitly marketed. Country P would be a protecting country if an injunction could stop such marketing there or if a monetary award could compensate for damages or profits resulting there.⁸ Now, often enough, suit is brought in a court of country P to obtain relief for acts taking place on the spot there: once that court takes jurisdiction over this suit, country P will also be the forum country for the case. However, change our hypothetical a bit: assume a suit brought in country F for infringement taking place abroad, say, in countries P and Q: in that event, country F is the forum country, where suit goes forward, while countries P and Q may be protecting countries. In such cross-border cases, a claimant has to ask to whether a court in one country may take jurisdiction over any suit for acts taking place outside that forum country.⁹
- *Foreign works or productions:* A work or related production is foreign relative to our protecting country P if it is created or made by a national of another country. It may also be considered to be foreign relative to this country P if it is first published in another country or has some other such factor connecting it to another country as specified by treaty or legislation.¹⁰ In any event, in our hypothetical, a work was created by a national of country O, and it is therefore foreign relative to country P where relief is sought against exploitation.¹¹

⁶ For an overview of the different ways that treaty obligations may enter into diverse legal orders, see § 3[2][a] *infra*.

⁷ Private international law governs jurisdiction and the choice of law in such civil cases, in which private parties raise claims against other such parties across borders. Public international law governs actions with public bodies across borders, notably nation-states: it encompasses, for example, administrative and trade laws. See E. Ulmer, *Intellectual Property Rights and the Conflict of Laws*, 4–5 (English trans., Kluwer, 1978).

⁸ For further analysis of the protecting country, see §§ 3[1][a][i] and 3[1][b][i][B] *infra*.

⁹ For further analysis, see § 6[1] *infra*.

¹⁰ Authorship by a national of a country, as well as first publication in a country, satisfy criteria to make the work or production eligible for protection in another country. For such criteria, see § 4[2] *infra*. If a work or related production has the requisite connection to a specific country, it may also be said to “originate” in that country. Such origination may trigger specific rules, usually under copyright treaties. For the definition of any country of origin, see § 4[3][b][ii] *infra*.

¹¹ Special rules may apply to mixed cases, for example, where a work by a home author is first published abroad or a work by a foreign author is first published at home. For such rules, see §§ 3[2][b] and 5[4][a][ii] *infra*.

This framework chapter explains how, often on treaty grounds, domestic laws protect foreign works and productions. Most importantly, the Berne or Rome Convention may come into play here, as may other treaties, notably the Universal Copyright Convention, the Agreement on Trade-Related Aspects of Intellectual Property Rights, and the WIPO “Internet” Treaties.¹² As explained below, sometimes treaty provisions are implemented in domestic laws, and sometimes they are directly enforced in disputes between private parties by local courts.¹³ Compliance with TRIPs standards may be adjudicated by its members, public entities like nation-states, under the aegis of the World Trade Organization.¹⁴ Jurisdictions adhering to other copyright treaties may bring disputes before the International Court of Justice.¹⁵

Even more or less federated jurisdictions vary in their approaches to treaty obligations: most implement them, but not always thoroughly.¹⁶ For example, the United States of America largely adapts treaty provisions in its federal copyright law which, effective throughout the nation, may preempt comparable legal actions arising under local state laws.¹⁷ The European Union is a federation in progress: within the European Economic Area, and largely across and even at points beyond the European internal market, the E.U. legal order takes over treaty obligations, as its laws govern an increasingly large and complex spectrum of copyright and related issues.¹⁸ The

¹² Hereinafter, respectively: Berne, Rome, U.C.C., and TRIPs; the WIPO Copyright Treaty: W.C.T.; the WIPO Performances and Phonograms Treaty: W.P.P.T.

¹³ See § 3[2][a] *infra*.

¹⁴ Abbreviated: the W.T.O. On TRIPs disputes, see § 5[5][b][ii] *infra*.

¹⁵ See Berne, Art. 27bis (Brussels), Art. 33(1) (Paris); U.C.C., Art. XV (Geneva, Paris); Rome, Art. 30. See, generally, W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar* (International Copyright and Neighboring Rights: Commentary), 21–22 (Intro., Rem. 40) (Werner-Verlag, 1977) (explaining the historical reluctance to resort to this court). *N.b.* each page cite here to this treatise is followed by a parenthetical cite to a corresponding paragraph or group of paragraphs in all editions. See also, with the same authors, *Droit d'auteur international et droits voisins* (J. Tournier, trans., Bruylant, 1983) (in French); and with G. Meyer as a further coauthor, *International Copyright and Neighboring Rights Law: Commentary with special emphasis on the European Community* (R. Livingston, trans., VCH Publ., 1990) (in English).

¹⁶ A sizable exception lies in the Federative Republic of Brazil, which applies precisely formulated treaty provisions as self-executing. See, e.g., *Zeneca Ltd. c. Director, Instituto Nacional de la Propriedade Industrial*, VJF RJ, 9a Reg. (9th Federal Court, Rio de Janeiro) (Brazil), no. 970.003.260-4, July 30, 1997 (Valéria de Albuquerque), *Diário Oficial do Estado: Rio de Janeiro*, Aug. 18, 1997, 36, in partial English trans. in 29 I.I.C. 74 (1998), note G.S. Leonardos (as discussed in § 3[3][a][i] *infra*).

¹⁷ See, generally, United States, Copyright Act, 17 U.S.C. § 301(a) (preempting “all legal or equitable rights” under state laws “that are equivalent” to federal copyright). See also *Sam Francis Found. v. Christies, Inc.*, 784 F.3d 1320 (9th Cir. 2015) (U.S.), *cert. denied*, 136 S. Ct. 795 (2016) (setting aside California *droit de suite* insofar as incompatible with the U.S. Commerce Clause). Compare § 6[3][a] *infra* (noting U.S. state laws usually applicable to contractual issues), with § 6[3][b][ii] *infra* (noting rare federal preemption of contract laws).

¹⁸ For further analysis, see §§ 3[3][a][ii][A] and 5[1][c] *infra*. The European Union (E.U.) superseded the European Community (E.C.) effective December 1, 2009, pursuant to the Treaty on European Union (T.E.U.) and to the Treaty on the Functioning of the European Union (T.F.E.U). The Court of Justice of the European Union (C.J.E.U.) then took the place of the European Court of Justice (E.C.J.). The

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E.U. framework chapter of this treatise should be consulted when considering European copyright issues.¹⁹

[2] A Model for Analyzing Protection Abroad

How to analyze whether, to what extent, and in what regards a work or related production from one country is protected in another? We shall here offer a model for such analysis by outlining its basic steps in a hypothetical example of cross-border copyright infringement. Sections 3 through 5 of this chapter will systematically explain how to resolve the issues arising at each of these steps in succession. Section 6 will explain issues of jurisdiction and of chain of title worldwide.

Suppose that a U.S. citizen writes a poem creative enough to be protected by copyright under any country's law. The poet authorizes the first publication of her text simultaneously in the United States and in Canada. However, without the poet's consent, the text of the entire poem is afterwards used verbatim as the lyrics of a song, and a recording is made in Israel of the song as publicly performed in Israel, while resulting disks are sold both there and in Japan. What analysis do we have to go through to determine whether, and to what extent, the poem is protected in Israel and in Japan?

At the initial stage of analysis, discussed in Section 3 below, we consider a pair of questions: In what country or countries is protection to be claimed? On what grounds is it available there? At the threshold, we have to localize any protecting country, effectively the country or countries in which relief is sought against infringement.²⁰ For our hypothetical poet, Israel and Japan are possible protecting countries: the former was a place of performance and recording, and both the former and the latter are places of sales. The next question leads to itemizing possible grounds for protection in each such protecting country. In Israel, the only grounds available are found in domestic copyright legislation, including domestic copyright orders concerning foreign works and productions.²¹ In Japan, the law recognizes the primacy of any treaty provision binding Japan with regard to authors' or neighboring rights. Japan is bound, *inter alia*, by the Berne Convention and other treaties with the United States. The poet may then invoke treaty provisions as grounds for protecting her work in Japan.²²

European Free Trade Association (EFTA) and the Union form the European Economic Area (E.E.A.). There is also an EFTA Court.

¹⁹ E. Derclaye, "The European Union and Copyright," herein (hereinafter: "European Union"). On the extension of E.U. law to E.E.A. member states on copyright issues, see *id.*, herein, at §§ 1[1][b][iii], 1[2][e][iii], 2[2][d], and 3[1][d]. E.U. law may come to bear on laws of a non-E.E.A. member state, often pursuant to E.U. agreements with that country.

²⁰ *N.b.*, as already indicated in § 1[1] *supra*, this question does not ask in what court to sue, but rather what laws may apply to suit. On jurisdiction in cross-border cases, see § 6[1] *infra*; for caveats to forum shopping, see § 6[1][b][i] *infra*.

²¹ See M. Birnhack, "Israel," herein, at § 6[1] (hereinafter: "Israel").

²² See T. Ueno, "Japan," herein, at §§ 6[2] and 6[3] (hereinafter: "Japan").

In the next stage of analysis, explained in Section 4 below, we have to determine whether the foreign work or production at issue meets the requirements for protection. Any provision providing some ground for the protection of this work or production, here called a *grounding provision*, may impose the following three types of such requirements: First, the work or production at issue must be covered by this provision: for example, all copyright grounding provisions will cover our hypothetical poem as a “literary work.”²³ Second, it must display a factor meeting at least one criterion of eligibility, notably by showing that the work or related production at issue is appropriately “connected” back to at least one of a number of countries. For example, for our poem, either its author has to be a national of a country with which Israel or Japan has a treaty or comparable relationship, as each does with the United States, or it has to be first published in such a country, say, Canada.²⁴ Third, protection must be timely: the work or production must not have irrevocably fallen into the public domain before the grounding provision invoked for protection went into effect. Older works will, of course, run the risk of having thus fallen into the public domain, but this need not always be fatal, since retroactive protection may be available in some cases.²⁵

Turn to the final stage of analysis, treated in Section 5 below. Assume that the prerequisites of protection are satisfied by our hypothetical poem and poet in a given country. What, then, will be the extent of protection in that protecting country? On most issues affecting the extent of protection, the national law of that country should, in principle, be dispositive. However, any ensuing national treatment may be subject to specific exceptions that the treaties allow on limited issues that they themselves indicate. Some of these exceptions may curtail national treatment, sometimes precluding protection altogether; other exceptions may bolster protection beyond that accorded under national law.²⁶ It must then be asked: What law or treaty governs each issue affecting the protection of our poem, especially exceptions to national treatment? In Israel, the applicable provisions will all be found within domestic law, including legislation implementing treaties. By contrast, in Japan, domestic law or treaties, notably the Berne Convention, may govern protection of the poem.²⁷

Section 6 below considers questions of jurisdiction and of chain of title worldwide. Suppose, to extend our hypothetical example, that a recording of the poem was posted on the internet without consent. The poet may then consider suing in a court able to

²³ Only the taking of the poem is at issue in our hypothetical. There is no question of the taking either of any performance of the poem or of any recording or broadcast of such a performance. For analysis of such mixed cases, see § 4[1][c][ii][B] *infra*.

²⁴ For such eligibility criteria, see § 4[2] *infra*.

²⁵ On varying retroactivity schemes, see § 4[3][a] *infra*.

²⁶ For example, depending on the exception to national treatment, there could be a possible cut-back of protection under national law to the level of the country of origin of the work at issue. See §§ 4[1][c][i][A] and 5[2] *infra*. Or such protection could be brought up to the level of treaty minimum rights were it not already there. See § 5[4][a][i] *infra*.

²⁷ *N.b.* some treaty provisions, notably Berne provisions, may at times prevail over others. See § 5[1][b] *infra*.

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block unauthorized online access to the work and thus to stop infringement from spreading to many countries. To start, we then have to ask when a court in one country may take jurisdiction over actions for infringement threatened or taking place in at least one other country.²⁸ Further, we need to know who may presumptively have standing to sue in any cross-border case of infringement and, if need be, how to analyze chain of title to the rights on which standing may turn, eventually worldwide.²⁹ Finally, we pursue this analysis in considering which law or laws may apply to contractual transfers of rights effective across borders.³⁰

[3] How to Research and Resolve Key Issues?

We just set out a model for analyzing how a work or related production from one country may be protected in another. But how to spot key issues on which a suit, seeking copyright or related protection in a cross-border case, may turn? We shall here (a) consider such issues as are more or less common to many laws, (b) indicate how to characterize issues under diversely conceived laws of copyright or of authors' rights, and (c) how to defuse or decide conflicts between such laws.

[a] Inquire into Issues Locally or Globally?

Cross-border cases prompt us to lift our sights beyond the horizon of home law. For example, creators and other right-holders may want economic gains maximized worldwide. Creators themselves may want to control the aesthetic, reputational, or other moral fates of their works or performances far from home. Enterprises may want to know what rights might be profitably acquired or licensed in many countries at once. How, then, to approach issues likely to be subject to foreign laws that may bear on such concerns?

Start with the law of any one country where protection or a license is sought. Its national law, including its treaties, may come into play to protect a foreign work or production.³¹ A synopsis starting each chapter on such a law in this treatise serves as an index to issues under that law, and footnotes cross-reference to related issues in other chapters on other laws.³² Consider, for example, the overall issue of who may initially hold rights in a work: in U.S. law, the notion of "works made for hire" pulls together a cluster of underlying issues that European-based laws often unpack in more differentiated terms.³³ These laws may allocate rights differently in joint works, audiovisual works, and collective works, among others, using such devices as vesting

²⁸ See § 6[1] *infra*.

²⁹ See § 6[2] *infra*.

³⁰ See § 6[3] *infra*.

³¹ For legislative texts, see <http://www.wipo.int/wipolex/en/>. For treaty developments, see <http://www.wipo.int/treaties/en/> and http://www.wto.org/english/docs_e/legal_e/27-trips_01_e.htm.

³² For specialized periodicals, other treatises, and online news services and blogs in the field, see this and other chapters herein, in their respective tables of abbreviations, bibliographies, and footnotes.

³³ For further analysis, see § 6[2][b] *infra*.

provisions, presumed transfers of exploitation rights, standard production contracts, and limitations on moral rights.³⁴

There will, mercifully, be no need to learn a new set of notions, much less a new logic, with each copyright law from country to country. Whatever the differences between such laws, they have not arisen merely out of idiosyncratic lawmaking in one country and in another. We shall see national copyright laws develop in response to the same media challenges worldwide and within largely overlapping legal cultures.³⁵ Internationally, these laws have benefited from the “more or less gentle and gradual pressure toward harmonization” that the Berne Convention has exercised since the end of the nineteenth century.³⁶ Copyright laws display a wealth of family ties, so that increasing acquaintance with some of them will prove useful for addressing many issues in terms common to all of them. That said, we shall be on the watch for divergences among sundry laws along a number of fault-lines in current legislation and case law.³⁷

[b] Frame the Issues in Terms of What Laws?

How to formulate the issues key to any cross-border copyright case? While analyses might differ because of diverse doctrines and methods used on one side or the other of jurisdictional borders, outcomes may converge at many points in our field.³⁸ Counsel and courts would then do well to move beyond purely local perspectives from which foreign copyright laws appear as exotic creatures, if only to minimize the risk of letting claims and defenses fall between the cracks between different laws. At the threshold of a cross-border case, counsel may well consider pleading, not only home law, but foreign laws.³⁹

At such junctures, counsel and courts face the problem of characterization.⁴⁰ As in all cases, they have to formulate claims and defenses, and accordingly issues, in legal terms that fit the facts before them. In a cross-border case, once counsel begins to unpack claims or defenses, the court may focus on any issue as arguably subject to conflicting laws. But if counsel and the court characterize issues only in terms of the

³⁴ For background, see E. Ulmer, “Rechtsvergleichung und Grundlagenforschung im Urheberrecht und gewerblichen Rechtsschutz” (Comparative Law and Basic Research in Copyright and Industrial Property), GRUR Int. 1968, 1, 4–5.

³⁵ For the common historical roots, see § 2[1] *infra*.

³⁶ A. Dietz, *Copyright Law in the European Community*, 9 (English trans., Springer, 1978).

³⁷ For further analysis, see §§ 2[1][c] and 2[2] *infra*.

³⁸ Compare E. Rabel, “Private Laws of Western Civilization: Part IV. Civil Law and Common Law,” 10 *Louisiana L. Rev.* 431 (1950) (generally distinguishing the methods of common and civil laws, but mentioning copyright convergence), with P.E. Geller, “Legal Transplants in International Copyright: Some Questions of Method,” 13 *U.C.L.A. Pacific Basin L.J.* 199 (1994) (specifically gauging such convergence).

³⁹ For methods to resolve conflicts between such laws, see § 1[3][c] *infra*.

⁴⁰ *I.e.*, in European terms, the problem of *qualification*. See E. Rabel, *The Conflict of Laws: A Comparative Study*, vol. 1, 47 *et seq.* (Univ. of Michigan Press, 2d ed., 1958); C. Godt, “The Functional Comparative Method in European Property Law,” *European Property L.J.* 2013, no. 2, 73.

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law of the forum, *lex fori*, they risk blind-siding or skewing analysis that has to disentangle the very issues on which foreign laws may come to bear.⁴¹ Suppose, hypothetically, that a U.S. national creatively improvises a mime work in the United States, without fixing it in tangible form, while another U.S. party records this work as performed and posts the recording online without the mime’s consent, making it accessible worldwide.⁴² While U.S. law does not accord full statutory copyright in this improvisational but unfixed work, many other copyright laws do protect full authors’ rights in such a work, whether it has been fixed or not.⁴³ Characterization purely in U.S. terms could lead both counsel and the court to ignore viable foreign claims and defenses.⁴⁴

The cosmopolitan *lex causae* method comes into play as counsel and courts start looking beyond home law.⁴⁵ The U.S. *Second Restatement of Conflict of Laws* contemplates the analysis of “local law concepts and terms [. . .] in accordance with the law” considered to govern “the issue involved.”⁴⁶ If, as in our model broached above, infringement is alleged in Israel or in Japan, a court adjudicating claims to be remedied in each of these countries would characterize infringement issues in terms of Israeli or Japanese copyright law, respectively.⁴⁷ This claim-centered method calls for a court to ask how, in the light of the doctrinal rationales and policy aims of each law invoked in the case at bar, this law should operate in the case and, thus, how it could conflict or not with other laws.⁴⁸ The results of this method may be consolidated by the *comparative* method, which characterizes issues in terms found common to at least some, if not all, of the laws applicable to the case at bar.⁴⁹ Most importantly, the copyright treaties, in their growing panoply of minimum rights coupled with

⁴¹ Jurisdictions vary in their tendency to follow or resist this temptation to apply home law. *See, e.g.*, F. Majoros, *Le droit international privé*, 107 (Presses Univ. de France, 3d ed., 1990) (noting the tendency of French courts to start with home notions in characterizing claims arguably subject to foreign laws, but arguing that they should take basic notions of arguably applicable foreign laws into account).

⁴² For further elaboration of this hypothetical, see §§ 3[1][a][i], 3[1][b][i][B], and 3[1][b][iii][B] *infra*.

⁴³ *See* § 2[2][a][i] *infra*. Full copyright in the improvisational work has to be distinguished from neighboring rights in the mere performance. *See* § 4[1][c][ii][B] *infra*.

⁴⁴ For methods to avoid ignoring claims in infringement cases, see § 3[1][b][i][A] *infra*; in copyright-transfer cases, §§ 6[2] and 6[3] *infra*.

⁴⁵ *See* M. Wolff, *Private International Law*, 153–166 (Oxford Univ. Press, 2d ed., 1950).

⁴⁶ American Law Institute, *Restatement (Second) of Conflict of Laws*, vol. 1, § 7(3) (1971).

⁴⁷ *See* § 1[2] *supra*.

⁴⁸ *See* A. Ehrenzweig, “Characterization in the Conflict of Laws: An Unwelcome Addition to American Doctrine,” in K. Nadelmann, A. Von Mehren, and J. Hazard (eds.), *XXth Century Comparative and Conflicts Law: Legal Essays in Honor of Hessel E. Yntema*, 395 (Sijthoff, 1961).

⁴⁹ *See, generally*, E. Rabel, *The Conflict of Laws: A Comparative Study*, vol. 1, 54–56 (Univ. of Michigan Press, 2d ed., 1958) (proposing the method of making the facts “referable indifferently to foreign as well as to [the] domestic substantive law” of the forum).

exceptions, provide us with a copyright *lingua franca* for thus analyzing issues in the field.⁵⁰

[c] How to Defuse or Decide Conflicts of Laws?

Return to our hypothetical of a work put online, potentially worldwide, without authorization.⁵¹ Would a court, in a suit for infringement here, have to choose among the “laws of 200 different jurisdictions”?⁵² This question dramatizes conflicts of laws, here of copyright and at times other laws, endemic in cross-border cases. This chapter will illustrate how to defuse such conflicts in easy cases, while setting out approaches to choosing dispositive laws in hard cases. Let us start with key turning points in the theory of conflicts of laws, but only to get our bearings for practice.⁵³

Classic commentary, in the nineteenth century, formulated choice-of-law rules in terms of categories of claims.⁵⁴ For example, in principle, such rules would apply the law of the place of the harm to tort claims, the law chosen by the parties to contract claims, and so forth. The characterization of claims or defenses, following this approach, calls for analysis, often called *dépeçage*, that peels apart key issues as subject to this or that choice-of-law rule.⁵⁵ In cross-border cases of copyright infringement, we may distinguish such issues, to start, as: Which country’s or countries’ copyrights or related rights may be violated, subject to the copyright-conflicts regime? Or which defenses or other rights may be asserted, at times subject to some other conflicts regime?⁵⁶

Modern commentators have critiqued classically proposed choice-of-law rules. Their critique highlights how such rules, to the extent mechanically followed out, risk inconsistently serving the interests that different states may have in applying this or that law in any cross-border case.⁵⁷ The term “interests” here means, not actual stakes that parties have in any given suit, but policy aims that could reasonably be achieved if this or that law disposed of an overall type of issue or case as a whole.⁵⁸ In theory,

⁵⁰ See, e.g., §§ 2[1][c][ii] through 2[3][b] *passim* and 5[4][a] *infra* (outlining history and present state of Berne-plus minimum rights).

⁵¹ See § 1[3][b] *supra*.

⁵² Arpad Bogsch, Spoken Comment, WIPO World Forum, Naples, Oct. 18, 1995.

⁵³ For background, see P.E. Geller, “International Intellectual Property, Conflicts of Laws, and Internet Remedies,” 10 *Journal of Intellectual Property Rights* (NISCAIR), vol. 133 (2005).

⁵⁴ For the key to the classic approach, see F.C. von Savigny, *A Treatise on the Conflict of Laws*, 50–70 and 132–233 *passim* (Wm. Guthrie, trans., T.&T. Clarke, 2d ed., 1880).

⁵⁵ On the continuing relevance of *dépeçage*, see A. Ehrenzweig and E. Jayme, *Private International Law*, vol. 1, 119–121, and vol. 3, 9 (Oceana, 1972 [vol. 1], 1977 [vol. 3]).

⁵⁶ Compare § 3[1] *infra* (infringement issues, generally), and § 3[1][b][iii][C] *infra* (privacy and free-expression issues as arising in defenses specifically), with § 6[2] *infra* and § 6[3] *infra* (ownership issues).

⁵⁷ For the pioneer critique, see B. Currie, “Notes on Methods and Objectives in the Conflict of Laws” (1959 Duke L.J. 171), in *Selected Essays on the Conflict of Laws*, 177 (Duke Univ. Press, 1963).

⁵⁸ See, generally, G. Alexander, “The Concept of Function and the Basis of Regulatory Interests under

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the modern critique could lead courts to choose the law which, among competing laws, such interests of the forum state would lead them to apply or, absent any such home interest, the law or laws which would follow on balance from such interests of other states. In practice, in struggling with ever-harder cases, courts tend to shift from classic choice-of-law rules to their respective variations on interest analysis.⁵⁹ In metaphorical terms, if the forum state has a dog in any fight between conflicting laws, a judge might favor that dog.⁶⁰

Such forum favoritism, in more and more frequent cases, proves inadequate for settling conflicts of laws satisfactorily in an increasingly globalized world.⁶¹ In response, the U.S. *Second Restatement of Conflict of Laws* contemplates that any "international system" effective in a given field should control choosing laws in any cross-border case within that field.⁶² In the civil law, overriding considerations of *ordre public international* comparably direct courts faced with conflicts of laws: treaty aims figure among such considerations that may guide the choice of laws.⁶³ In the field of copyright, the Berne Convention, repeatedly revised and in tandem with later treaties, has constituted the international system or *ordre public*, what we shall here call the *Berne-plus treaty regime*, globally effective in the field of copyright.⁶⁴ Nonetheless, courts may find themselves without decisive guidance by any one

Functional Choice-of-Law Theory: The Significance of Benefit and the Insignificance of Intention," 65 Virginia L. Rev. 1063 (1979) (arguing that correct conflicts analysis optimizes, not only specific benefits under laws it applies, but the general benefit of allocating the authority to make laws among states).

⁵⁹ See, generally, L. Brilmayer, "Hard Cases, Single Factor Theories, and A Second Look at The Restatement 2d of Conflicts." 2015 Univ. of Illinois L. Rev. 1969 (doubting whether this methodological shift can generate more certain outcomes in the cases and opting for "flexibility").

⁶⁰ See, e.g., S.R. Symeonides, "Revolution and Counter-Revolution in American Conflicts Law: Is There a Middle Ground?," 46 Ohio State L.J. 549 (1985) (critiquing this default position, while seeking a more balanced and reliable approach to elaborating it across jurisdictional borders).

⁶¹ See, generally, P. Berman, "Towards a Cosmopolitan Vision of Conflict of Laws: Redefining Governmental Interests in a Global Era," 153 Univ. of Pennsylvania L. Rev. 1819 (2005) (arguing against blindly applying forum law and looking to international considerations in choosing laws).

⁶² American Law Institute, *Restatement (Second) of Conflict of Laws*, vol. 1, § 6(2)(a) (1971). See also *id.*, §§ 145 and 222 (directing courts to take account, primarily, of any overriding "international system" before focusing, secondarily, on any "significant relationship" bearing on choice of law).

⁶³ See, e.g., M. Forteau, "L'ordre public 'transnational' ou 'réellement international': L'ordre public international face à l'enchevêtrement croissant du droit international privé et du droit international public" ("Transnational" or "Really International" Public Policy: International Public Policy Faced with Increasingly Entangled Private and Public International Laws), *J. du Droit International (Clunet)* 2011, no. 1, 3, at 14–20 (considering *ordre public international* based on treaties, among other sources, as controlling choice of law).

⁶⁴ See also § 3[1][a][i] *infra* (explaining role of this regime in resolving conflicts of copyright laws). Many jurisdictions adjust their choice-of-law rules in the light of this regime. See, e.g., Regulation (EC) 864/2007 of 11 July 2007 of the European Parliament and of the Council on the law applicable to non-contractual obligations (Rome II), Art. 8(1), O.J. 2007 L 199 ("the law of the country for which protection is claimed" for claims sounding, *inter alia*, in copyright); Japan, Law No. 10 of 1898, as amended June 21, 2006 (Act on the General Rules of Application of Laws), Art. 17 (governing such claims by laws effective where foreseeable results of tortious conduct arise).

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overriding treaty regime when, in hard cases that we shall illustrate, laws outside any single overriding regime come into play.⁶⁵ At such junctures, courts may have no recourse but to the toolkit of choice-of-law methods developed over time.⁶⁶

To illustrate analytic tools useful in a cross-border case, assume some tension between laws of different states. Counsel and court would do well to pursue the following inquiries:

- *Datum or choice of law*: A mixed matter of fact and law, technically called a *datum*, may serve as a predicate for applying a rule or remedy upon the resolution of a conflict of laws.⁶⁷ Of necessity, to determine what predicate has to be established, a court has to unpack the arguably applicable laws in a case, among which it is to choose.⁶⁸ We shall below encounter examples of such *data* in standards of remuneration, agency or employment relations, contractual dealings, etc.⁶⁹
- *True or false conflict of laws*: Set aside, for a moment, the nomenclatures of laws in tension. What outcome do these laws functionally compel in a given case? If they inexorably lead to diverging results, the court has a *true* conflict of laws to resolve; if they allow for converging results, the court may face only a *false* conflict, without urgent consequences in the case at bar.⁷⁰ That is, there is no need to choose among the laws of states that lack interests in the outcome of the case, leaving applicable the law of any state with a requisite interest. If states whose laws are thus applicable in the case share interests in reaching

⁶⁵ See, generally, § 3[1][a][iii] *infra* (outlining “dimensions” of such conflicts). See, e.g., § 3[1][b][iii][C] *infra* (tension between treaty regime for copyright and overriding privacy and free-expression norms). But see G. Teubner and A. Fischer-Lescano, “Regime-Collisions: The Vain Search for Legal Unity in the Fragmentation of Global Law,” 25 Michigan J. International Law 999, 1017–1045 *passim* (2004) (doubting that laws may be coherently chosen to resolve such cases, including those in cross-border copyright cases, and hoping for substantive transnational solutions to deal with them).

⁶⁶ See, generally, R. Michaels and J. Pauwelyn, “Conflict of Norms or Conflict of Laws?: Different Techniques in the Fragmentation of International Law,” 22 Duke J. Comparative & International Law 349, 357–374 *passim* (2012) (looking to such methods to deal with conflicts of laws, even in hard cases).

⁶⁷ See, generally, B. Currie, “On the Displacement of the Law of the Forum” (58 Columbia L. Rev. 964 [1958]), in *Selected Essays on the Conflict of Laws*, 3, 69–74 (Duke Univ. Press, 1963) (distinguishing such an inquiry from that into dispositive laws or relief).

⁶⁸ See, e.g., T.W. Dornis, “‘Local Data’ in European Choice of Law: A Trojan Horse from across the Atlantic?,” 44 Georgia J. International & Comparative Law 305 (2015–2016) (analyzing how to consider local standards to help resolve cross-border conflicts of laws consistently with the goals at stake in the regime of laws in question).

⁶⁹ See, e.g., §§ 3[1][b][ii][C] *infra* (standards of remuneration for monetary awards); § 6[2][c][i] *infra* (heir as author’s agent to exercise *post mortem* moral rights); § 6[3][a][i] *infra* (author’s employment to make works); § 6[3][a][ii] *infra* (standards for contractual transactions); § 6[3][c][ii] *infra* (standards for waiver of moral rights).

⁷⁰ See B. Currie, “Notes on Methods and Objectives in the Conflict of Laws” (1959 Duke L.J. 171), in *Selected Essays on the Conflict of Laws*, 177, 181–184 (Duke Univ. Press, 1963).

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much the same result, the court should effectuate that result.⁷¹

- *Policies overriding states' local interests:* Where states bind themselves by treaties, as they do in the field of copyright as to key issues, treaty provisions may dictate the choice of law. In any event, states adhere to any treaty for policy-determined interests that, to some extent, they hold in common. Such converging interests, motivating the treaty regime, may compel a specific resolution of a conflict of laws.⁷²
- *Remedies to finesse conflicts:* Law suits consummate in judicial relief, so that a court, facing any residually true conflict of laws, may finally ask: How to tailor remedies in order to realize underlying interests optimally or at least to impair them minimally?⁷³
- *Decide or diffuse tensions:* To see the gist of these inquiries, go back to our metaphorical dog fight: How may a court best disengage querulous hounds? We shall argue: by sharing any tasty bone of contention or by removing it from the fray.⁷⁴

§ 2 How to Understand the Issues?

[1] How Have Issues Arisen Historically?

How to analyze issues in cross-border copyright cases? We shall start with issues emerging (a) in pre-copyright regimes, (b) in classic copyright laws, and (c) in current developments.¹ We shall in turn ask: What issues are now common to national laws, whether of copyright or of authors' rights?² How have international treaties come to frame such issues globally? Pursuant to what principles?³

[a] Pre-Copyright Institutions

Paper and printing were invented in China by the tenth century, while movable type cast in metal came to be used in Europe in the fifteenth century.⁴ The printing press

⁷¹ See, generally, P.K. Westen, "False Conflicts," 55 California L. Rev. 74 (1967) (unpacking the large range of meanings of "false conflicts" and methods for clarifying them).

⁷² See, generally, K. Lipstein, *Principles of the Conflict of Laws, National and International*, 66 (Nijhoff, 1981) (indicating that treaties may limit choice of law).

⁷³ Compare D. Cavers, *The Choice-of-Law Process*, 64 (U. of Michigan Press, 1965) (proposing the "reasonable accommodation of the laws' conflicting purposes"), with Wm. F. Baxter, "Choice of Law and the Federal System," 16 Stanford L. Rev. 1, 17–22 (1963) (taking account of laws that, in conflict, are motivated by interests risking impairment if not applied).

⁷⁴ See, e.g., § 3[1] *infra* (infringement issues); § 6[2] *infra* (initial ownership and chain-of-title issues); and § 6[3] *infra* (contractual transfer issues).

¹ For further analysis, see P.E. Geller, "Copyright History and the Future: What's Culture Got to Do with It?," 47 J. Copr. Soc'y 209, 210–235 (2000).

² See § 2[2] *infra*.

³ See § 2[3] *infra*.

⁴ See L. Febvre and H.-J. Martin, *The Coming of the Book: The Impact of Printing, 1450–1800*, chs. 1–2 (D. Gerard, trans., Humanities Press, 1976).

precisely and rapidly captured new information, which the book trade spread along with nascent national literature and art.⁵ European elites, for example, in the Church and universities, struggled with Royal powers over authority to censor or at least channel the new information flows.⁶ Printers and book sellers, organizing to avoid competition, asserted claims over their publications.⁷

Moving into the sixteenth century, Venice, an early printing center, granted exclusive privileges to publish specific texts and images.⁸ In applying himself for such a monopoly, one author invoked his “long vigils and efforts” to create his works, for which he sought compensation.⁹ Somewhat later, the French Crown imposed state-directed censorship and granted privileges, largely to Parisian publishers to print and sell books, as well as to Parisian theaters to perform plays.¹⁰ By contrast, in England, where the royal bureaucracy was more limited, the English Crown charged the local printers’ and book sellers’ association in London, the Stationers’ Company, with policing publications the Crown or censors had not authorized.¹¹ This Company also secured its members’ monopolies in texts they claimed on its register.¹²

Despite these efforts, by the seventeenth century, it had become clear that the sovereigns of Europe could not tame the growing commerce in books. The French provinces, not favored with royal monopolies liberally granted in Paris, harbored renegade printers and peddlers of unauthorized editions.¹³ In Germany, not yet politically centralized, publishers tried to develop trade arrangements in the context of

⁵ See W.M. Ivins, Jr., *Prints and Visual Communication*, ch. 2 (MIT Press, 1953); E.L. Eisenstein, *The Printing Press as an Agent of Change*, 62–129 (Cambridge Univ. Press, 1979).

⁶ See H.A. Innis, “The Bias of Communication,” in *The Bias of Communication*, 33, 55–58 (Univ. of Toronto Press, 1951).

⁷ See W. Bappert, *Wege zum Urheberrecht*, 178–216 (Klostermann, 1962); L. Febvre and H.-J. Martin, *The Coming of the Book: The Impact of Printing, 1450–1800*, chs. 5 and 7 (D. Gerard, trans., Humanities Press, 1976).

⁸ See P.F. Grendler, “The Roman Inquisition and the Venetian Press, 1540–1605,” 1975 *J. Modern History* 48; C. Witcombe, *Copyright in the Renaissance: Prints and the Privilege in Sixteenth-Century Venice and Rome*, chs. 2–4 (Brill Academic Publ., 2004).

⁹ Ariosto’s Application for a Printing Privilege (1515), in L. Bently and M. Kretschmer (eds.), *Primary Sources on Copyright (1450–1900)*, under Italy, at <http://www.copyrighthistory.org/>.

¹⁰ See, e.g., A.-C. Renouard, *Traité des droits d’auteurs* (Treatise on Copyright), vol. 1, 29 *et seq.*, 62 *et seq.*, and 109 *et seq.* (Jules Renouard et Cie., 1838) (starting with the Royal preemption of the Sorbonne’s prerogatives over publishing); also M.-C. Dock, *Étude sur le droit d’auteur*, 66–109 *passim* (L.G.D.J., 1963) (tracing Royal privileges for theaters).

¹¹ See C. Hill, *The Century of Revolution, 1603–1714*, 30–31 (Norton, 1961); also L.R. Patterson, *Copyright in Historical Perspective*, 36–41 and chs. 5–6 (Vanderbilt Univ. Press, 1968).

¹² See B. Kaplan, *An Unhurried View of Copyright*, 5 (Columbia Univ. Press, 1967); L.R. Patterson, *Copyright in Historical Perspective*, 46–64 (Vanderbilt Univ. Press, 1968).

¹³ See L. Febvre and H.-J. Martin, *The Coming of the Book: The Impact of Printing, 1450–1800*, ch. 7 (D. Gerard, trans., Humanities Press, 1976); R. Darnton, *The Literary Underground of the Old Regime*, 122, 183–185 (Harvard Univ. Press, 1982).

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book fairs to discourage pirating from region to region.¹⁴ Printers in the Netherlands and some Swiss municipalities, flourishing free of censorship, produced books extensively smuggled into more regulated European countries.¹⁵ The English Crown, to implement the Stationers' authority, granted them powers of search and seizure, allowing them to search homes, workshops, and storehouses for illicit presses and unlicensed copies that they would seize or destroy.¹⁶ Nonetheless, piracy cropped up even within more easily policed English shores.¹⁷

In the ensuing "great debate" concerning "literary property," basic copyright issues began to take modern form.¹⁸ Bear in mind that emergent nation-states had trouble policing print privileges in peripheral regions well beyond capitals.¹⁹ Furthermore, the old privileges coupled with censorship left increasingly literate publics calling for more open access to less costly editions.²⁰ Finally, mercantilist laws favoring some entrepreneurs over others no longer satisfied the rising demand for "*promulgated established laws*, not to be varied in particular cases," allowing individuals to read, work, and trade freely.²¹ The English Stationers had presaged a solution: allocate to private parties rights to control "copies" in order to avoid "[a]narchical publication" on

¹⁴ See M. Vogel, "Deutsche Urheber- und Verlagsrechtsgeschichte zwischen 1450 und 1850" (German Copyright and Publishing Law: History between 1450 and 1850), *Archiv für Geschichte des Buchwesens* 1978, 2.

¹⁵ See E.L. Eisenstein, *The Printing Press as an Agent of Change*, 142–145, 416–420, and 646–647 (Cambridge Univ. Press, 1979); R. Darnton, *The Literary Underground of the Old Regime*, 148 *et seq.* (Harvard Univ. Press, 1982).

¹⁶ See A. Johns, *The Nature of the Book: Print and Knowledge in the Making*, 128–136 (Univ. of Chicago Press, 1998); L.R. Patterson, *Copyright in Historical Perspective*, ch. 3 (Vanderbilt Univ. Press, 1968); B. Kaplan, *An Unhurried View of Copyright*, 3–5 (Columbia Univ. Press, 1967).

¹⁷ See, e.g., A. Johns, *Piracy: The Intellectual Property Wars from Gutenberg to Gates*, chs. 2–3 and 6–7 (Univ. of Chicago Press, 2009) (recounting how Scottish and Irish publishers introduced unauthorized editions into the English market).

¹⁸ Compare C. Hesse, "Enlightenment Epistemology and the Laws of Authorship in Revolutionary France, 1777–1793," 30 *Representations* 109 (1990) (Continental ideological cross-currents), with M. Rose, *Authors and Owners: the Invention of Copyright*, chs. 4–7 (Harvard Univ. Press., 1993) (British doctrinal and judicial disputes).

¹⁹ Compare M.-C. Dock, *Etude sur le droit d'auteur*, 115 *et seq.* (L.G.D.J., 1963) (Paris versus French provinces), with M. Vogel, "Urheberrecht in Deutschland zwischen Aufklärung und Vormärz" (Copyright in Germany between Enlightenment and pre-1848), *Buchhandelsgeschichte* 1989, 96 (North versus South of Germany).

²⁰ See, e.g., Diderot, *Sur la liberté de la presse* (On the Freedom of the Press), 50 and 67 (1763; J. Proust, ed., Éditions Sociales, 1964) (usually cited as *Lettre sur le commerce de la librairie* [Letter on the Book Trade]) (for authors' property rights); J. Locke, Memorandum on the 1662 Act (1693), under United Kingdom, at <http://www.copyrighthistory.org/> (against monopoly pricing of books).

²¹ J. Locke, *Second Treatise of Government*, 29 (1698, 1764; C.B. Macpherson, ed., Hackett Publ. Co., 1980). For background, see J. Hughes, "Locke's 1694 Memorandum (and more incomplete copyright historiographies)," 27 *Cardozo Arts & Entertainment L.J.* 555 (2010).

an open media marketplace.²² It would be a short step to a modern law of copyright assuring private rights enforceable before “courts of ordinary jurisdiction.”²³

[b] Classic Copyright Statutes

In time, control shifted outwards to publishers and to authors.²⁴ In France, in the sixteenth century, pleadings in one French case had already prophetically claimed: “the author of a book is altogether its master and as such may freely dispose of it.”²⁵ By the mid-eighteenth century, Oliver Goldsmith observed that authors “no longer depend on the Great for subsistence, they have no other patrons but the public, and the public, collectively considered, is a good and generous master.”²⁶ When, in that century, privileges on La Fontaine’s *Fables* lapsed in France, his granddaughters petitioned the King’s Council for his rights. They, not the prior Parisian publisher, were held to have inherited all rights in the work, implying that these were the author’s rights.²⁷ The French Crown started vesting printing privileges in authors themselves.²⁸

The British Parliament enacted the Statute of Anne “for the Encouragement of Learning” in 1710.²⁹ The Statute of Anne granted each author, or “assigns,” the exclusive right to “print [. . .] books” for fourteen years, with another right of equal term vesting in any author alive at the end of the initial term.³⁰ But the courts still had to confront the very issue which had plagued printing privileges: Who, if anyone, had rights in a work upon the lapse of all rights under the statute? Ever protective of their position in the trade, London booksellers, previously protected by so-called Stationers’

²² B. Kaplan, *An Unhurried View of Copyright*, 6–7 (Columbia Univ. Press, 1967).

²³ Diderot, *Sur la liberté de la presse*, 43 (1763; J. Proust, ed., Éditions Sociales, 1964) (usually cited as *Lettre sur le commerce de la librairie* [Letter on the Book Trade]).

²⁴ Compare L.R. Patterson, “Free Speech, Copyright, and Fair Use,” 40 *Vanderbilt L. Rev.* 1 (1987) (United Kingdom and United States), with C. Hesse, *Publishing and Cultural Politics in Revolutionary Paris, 1789–1810*, ch. 2 (Univ. of California Press, 1991) (France).

²⁵ Simon Marion’s plea on privileges (1586), in the *Muret* case before the *Parlement* of Paris, March 15, 1586, in L. Bently and M. Kretschmer (eds.), *Primary Sources on Copyright (1450–1900)*, under France, at <http://www.copyrighthistory.org/>, and quoted in M.-C. Dock, *Etude sur le droit d’auteur*, 78–79 (L.G.D.J., 1963).

²⁶ *The Citizen of the World and the Bee*, 233–234 (1860; Everyman’s Library, London, 1934). But see P. Prescott, “The Origins of Copyright: A Debunking View,” [1989] *E.I.P.R.* 453 (hypothesizing that a copyright statute was enacted in response to the common market achieved across Great Britain at the start of eighteenth century).

²⁷ See M.-C. Dock, *Etude sur le droit d’auteur*, 70–79, 118–121 (L.G.D.J., 1963). But see L.R. Patterson, *Copyright in Historical Perspective*, 47–49 (Vanderbilt Univ. Press, 1968) (Stationer’s copyright reverted to the Stationers’ Company on the death of a member or the marriage of his widow outside the Company).

²⁸ See M.-C. Dock, *Etude sur le droit d’auteur* (A Study on Copyright), 127 *et seq.* (L.G.D.J., 1963); R. Darnton, *The Literary Underground of the Old Regime*, 186–190 (Harvard Univ. Press, 1982); B. Edelman, *Le sacre de l’auteur* (The Consecration of the Author), 90–104 and 237–294 (Seuil, 2004).

²⁹ 8 Anne, ch. 19 (1710), in L. Bently and M. Kretschmer (eds.), *Primary Sources on Copyright (1450–1900)*, under United Kingdom, at <http://www.copyrighthistory.org/>.

³⁰ See L.R. Patterson, *Copyright in Historical Perspective*, ch. 7 (Vanderbilt Univ. Press, 1968).

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copyrights, sued provincial publishers who undercut their prices after copyright had lapsed under the Statute of Anne.³¹ The London booksellers asserted copyrights at common law that purportedly continued beyond any statutory term, while provincial publishers in turn argued that, beyond the statutory term, there was only the public domain. In 1774, the House of Lords heard the case of *Donaldson v. Becket*, after which the position restricting copyright to statutory terms prevailed.³²

In France, in the throes of revolution, the National Assembly enacted authors' rights in the Laws of 1791 and of 1793.³³ The legislative record deemed such rights to be "the most legitimate" and "the most personal of properties," while it acknowledged that culture turned on competition that "excites emulation" and "develops talent."³⁴ The French Law of 1791 recognized authors' rights to control the public performance of their works live, but it did so in terms later construed to include the control of showing works in newer media, from radio through the internet.³⁵ The French Law of 1793 extended such rights, with telling generality, to any "production of the mind or genius," in particular recognizing authors' rights to control the disposition of embodiments of their works and fixing the term of rights at ten years after each author's death. For the next century and a half, these laws of the Revolution, each hardly more than a page long, remained the dispositive French copyright statutes, serving as a workable basis for judicial lawmaking.³⁶

In the United Kingdom, the Statute of Anne had left engravings and theatrical pieces, for example, to be protected by further enactments. Starting in the nineteenth century, the United Kingdom consolidated its copyright legislation with an eye to developments on the European Continent, notably the formation of the Berne Convention.³⁷ This consolidation also laid the basis for the elaboration of copyright

³¹ See B. Kaplan, *An Unhurried View of Copyright*, 12–16 (Columbia Univ. Press, 1967); M. Rose, *Authors and Owners: the Invention of Copyright*, ch. 5 (Harvard Univ. Press, 1993).

³² *Donaldson v. Becket*, (1774) Hansard, 1st ser., 17 (1774), 953, in L. Bently and M. Kretschmer (eds.), *Primary Sources on Copyright (1450–1900)*, under United Kingdom, at <http://www.copyrighthistory.org/>. For critical accounts, see M. Rose, *Authors and Owners: the Invention of Copyright*, ch. 6 and Appendix B (Harvard Univ. Press, 1993); R. Deazley, "The Myth of Copyright at Common Law," 62 *Cambridge L.J.* 106 (2003).

³³ Law of January 13/19, 1791, and Law of June 19/24, 1793, in L. Bently and M. Kretschmer (eds.), *Primary Sources on Copyright (1450–1900)*, under France, at <http://www.copyrighthistory.org/>. For background, see B. Edelman, *Le sacre de l'auteur* (The Consecration of the Author), 337–378 (Seuil, 2004); C. Hesse, *Publishing and Cultural Politics in Revolutionary Paris, 1789–1810*, ch. 3 (Univ. of California Press, 1991).

³⁴ Le Chapelier, *Rapport sur la Pétition des Auteurs dramatiques dans la Séance du Jeudi 13 janvier 1791* (Report on the Petition of Dramatic Authors), 9 and 16 (L'Imprimerie Nationale, 1791), in L. Bently and M. Kretschmer (eds.), *Primary Sources on Copyright (1450–1900)*, under France, at <http://www.copyrighthistory.org/>.

³⁵ See, e.g., M.-C. Dock, *Etude sur le droit d'auteur*, 143–154 (L.G.D.J., 1963) (recounting how this law was enacted after lobbying by the playwrights).

³⁶ See A. Lucas and P. Kamina, "France," herein, at § 1[1] (hereinafter: "France").

³⁷ See B. Sherman and L. Bently, *The Making of Modern Intellectual Property Law: The British*

laws throughout the British Empire and in the independent states growing out of it.³⁸ In stray cases in the course of the nineteenth century, French judges began to fashion relief for what over time emerges as moral right, amplifying the law of authors' rights.³⁹ In that century, more and more nation-states began to develop their own laws of copyright or authors' rights.⁴⁰

[c] Theory and Practice to Date

How, with copyright laws proliferating in different forms, to grasp issues key to cross-border cases? More or less comparable concepts and problems have been shaping these laws, so that such issues may now often be cast in common terms. To sort these issues out, we shall here outline (i) how diverse copyright doctrines were sought in already settled areas of law and (ii) how copyright lawmakers have since responded to the challenges of increasingly global media.

[i] Diverse Justifications in Theory

Copyright might well be said to be a right or a bundle of rights in search of a doctrine. The classic British and French copyright statutes were enacted during a time of great intellectual ferment. During this time, from the seventeenth into the nineteenth centuries, distinct doctrinal bases, ranging from property to personality theories, were proposed to justify and structure copyright and authors' rights. We can here only briefly touch on notions that have since been guiding practice as it has grappled with copyright issues over centuries.⁴¹

By the end of the seventeenth century, a theory of *property* in products of mind began to crystallize. Enlightenment thinkers, most notably John Locke, posited that property arose in goods in which labor was invested.⁴² Diderot made the jump to arguing that authors obtained freely alienable property in the works of their minds, much as farmers did in land they tilled and its crops.⁴³ Adam Smith himself contemplated granting a temporary economic right in "a new book" to provide

Experience, 1760–1911, 111–140 *passim* (Cambridge Univ. Press, 1999).

³⁸ See J. Griffiths, "United Kingdom," herein, at § 1[2].

³⁹ See S. Strömholm, *Le droit moral de l'auteur* (Author's Moral Right), vol. I, pt. 1, 118 *et seq.* (Norstedt & Soners Forlag, 1966).

⁴⁰ For examples, see M. Gruenberger, "Germany," herein, at § 1[3] (hereinafter: "Germany"); M. Ficsor, "Hungary," herein, at § 1[2][a]; "Japan," herein, at § 1[1].

⁴¹ For further analysis, see P.E. Geller, "Must Copyright Be For Ever Caught Between Marketplace and Authorship Norms?," in B. Sherman and A. Strowel (eds.), *Of Authors and Origins: Essays in Copyright Law*, 159 (Clarendon Press, 1994), abridged as "Toward an Overriding Norm in Copyright: Sign Wealth," RIDA 1994, no. 159, 3 (with trans. in French and Spanish); A. Strowel, *Droit d'auteur et copyright: Divergences et convergences*, 35–129 *passim* (Author's Right and Copyright: Divergences and Convergences) (Bruylant/L.G.D.J., 1993).

⁴² See J. Locke, *Second Treatise of Government*, ch. 5 (1698, 1764; C.B. Macpherson, ed., Hackett Publ. Co., 1980).

⁴³ See Diderot, *Sur la liberté de la presse* (On the Freedom of the Press), 42 (1763; J. Proust, ed., Éditions Sociales, 1964) (usually cited as *Lettre sur le commerce de la librairie* [Letter on the Book Trade]).

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incentives “to its author” as the state would for entrepreneurs who undertook any risky “experiment, of which the public is afterwards to reap the benefit.”⁴⁴

Toward the end of the eighteenth century, a rather different theory started from the truism that authors, through creative works, addressed the public. For Immanuel Kant, each author could appoint a media entrepreneur, at the time usually a book publisher, as an exclusive *agent* to market her work publicly.⁴⁵ Kant then formulated the right, initially the author’s and contractually the media entrepreneur’s mandate, to restrain third parties from remarketing the work. However, only the author, while alive, could require the fidelity of her published work to its original text. Later, moral rights began to be judicially enforced on the basis of the author’s *personal* stakes in her work. Any media entrepreneur retained the *fiduciary duty* of acting as intermediary between author and public.⁴⁶

The nineteenth century saw many doctrinal variations that we can only sample here.⁴⁷ At its start, the French commentator Renouard argued for economic rights to allow authors to obtain such *remuneration* on the marketplace as is due them by “natural equity” for the works they contribute to society.⁴⁸ German commentators differed on how to subordinate such copyright, alienable to publishers or impresarios, to authors’ moral rights that they drew from *personality rights* available to natural persons to protect names, self-expression, and like interests.⁴⁹ At the end of the century, U.S. jurists Warren and Brandeis invoked common-law copyright as one basis of the right of *privacy* that included authors’ rights to disclose their works.⁵⁰ We shall

⁴⁴ A. Smith, *An Inquiry Into the Nature and Causes of the Wealth of Nations*, vol. 2, 754 (1791; Edwin Cannan, *et al.*, eds., Liberty Fund, 1981).

⁴⁵ See I. Kant, “Von der Unrechtmässigkeit des Buchernachdruckes” (On the Illegality of Reprinting Books), *Berlinische Monatschrift* 1785, no. 5, 403, in L. Bently and M. Kretschmer (eds.), *Primary Sources on Copyright (1450–1900)*, under Germany, at <http://www.copyrighthistory.org/>, and in English trans. in “On the wrongfulness of unauthorized publication of books,” in M. Gregor (ed./trans.), *Practical Philosophy*, 23 (Cambridge Univ. Press, 1996).

⁴⁶ For different views of this line of copyright doctrine, see B. Edelman, *Le sacre de l’auteur* (The Consecration of the Author), 295 *et seq.* (Seuil, 2004); S. Strömholm, *Le droit moral de l’auteur* (Author’s Moral Right), vol. I, pt. 1, 185–196 (Norstedt & Soners Forlag, 1966).

⁴⁷ For an overview, see A. Strowel, *Droit d’auteur et copyright: Divergences et convergences* (Author’s Right and Copyright: Divergences and Convergences), 91–121 (Bruylant/L.G.D.J., 1993).

⁴⁸ A.-C. Renouard, *Traité des droits d’auteurs* (Treatise on Copyright), vol. 1, 434 (Jules Renouard et Cie., 1838).

⁴⁹ Compare O. Gierke, *Deutsches Privatrecht* (German Private Law), vol. 1, 756–765 (Duncker & Humblot, 1895) (proposing a synthesis of copyright and personality rights), with J. Kohler, *Urheberrecht an Schriftwerken* (Copyright in Writings), 439 *et seq.* (Enke, 1907), and *Kunstwerkrecht*, 137 *et seq.* (Enke, 1908) (distinguishing between copyright and personality rights).

⁵⁰ See S. Warren and L. Brandeis, “The Right of Privacy,” 4 *Harvard L. Rev.* 193, 198 *et seq.* (1890). Compare R. Deazley, “The Myth of Copyright at Common Law,” 62 *Cambridge L.J.* 106, 129–132 (2003) (questioning the origins of common-law copyright), with M. Rose, “Genteel Wrath: Pope v. Curl (1741),” in *Authors in Court: Scenes from the Theater of Copyright*, ch. 2 (Harvard Univ. Press, 2016) (showing early privacy concerns motivating copyright claims against the unauthorized publication of letters).

see the debate on such sources of copyright and authors' rights sharpen as creations are released into an increasingly media-saturated society.⁵¹

[ii] Common Issues Emerging in Practice

Perennial theories of copyright and authors' rights have just been reviewed.⁵² But they have not always guided lawmaking practice, being rather incessantly challenged by technological progress. Real property offers only some vague analogy as it has been historically hedged by easements for cross-boundary transport or power lines, by restrictions for safety or ecological integrity, and by other such limitations.⁵³ Traditionally, in the field of copyright, issues have been seen evolving along distinct dimensions: on the one hand, what matters to protect; on the other, what rights to enforce, subject to defenses.⁵⁴ We shall here quickly trace historic shifts in response to such issues and later outline current developments on point.⁵⁵

The media have been ever-more thoroughly *industrialized* over time. Jurists have had to rethink copyright criteria of protectability as they faced new media like photography, sound recording, and the cinema. In principle, courts began to eschew criteria of aesthetic merit for deciding whether to accord copyright in productions rendered and released in such forms.⁵⁶ They also asked whether a photograph merely copied a model within a setting, whether the cinema captured no more than a play acted out according to a prior script, and so forth for other means of recording. In the nineteenth century, the further inquiry arose: If such new productions introduced new substance into a prior work, what copyright could any earlier author claim in the prior setting, script, etc., as against what later authors claimed as their creative input into any further, though arguably derivative, work?⁵⁷ In addition, industry designed more and more products, ultimately computer software with its user-interfaces, not only to be

⁵¹ Compare A. Drassinower, *What's Wrong with Copying?*, ch. 2 (Harvard Univ. Press, 2015) (finding the basis, in personal expression to the public, for author's rights, economic and moral), with A. Troller, "Réflexions sur 'l'Urheberpersönlichkeitsrecht'" (Reflections on Authors' Rights of Personality), *Le Droit d'Auteur*, 1960, 304, 318–319 (distinguishing general tort rights in personality from author's special economic and moral rights).

⁵² See § 2[1][c][i] *supra*.

⁵³ See, generally, M. Horwitz, *The Transformation of American Law, 1780–1860*, ch. 3 *passim* (comparing U.S. and U.K. trends).

⁵⁴ See, generally, P.E. Geller, "Dissolving Intellectual Property," in Y. Gendreau (ed.) *Intellectual Property: Bridging Aesthetics and Economics*, 1 (Éditions Thémis, 2006), also in [2006] E.I.P.R. 139, and translated in GRUR Int. 2006, 273 (German), P.I. 2006, 4 (French), and I.P. (CASS IP Center), 2007, no. 18, 17 (Chinese) (outlining the doctrinal crisis along these dimensions).

⁵⁵ See § 2[2] *infra*.

⁵⁶ See, e.g., *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1903) (Holmes, J.) ("It would be a dangerous undertaking for persons trained only in the law to constitute themselves judges of the worth of" a work); France, Intellectual Property Code, Art. L. 112-1 (making protection by authors' rights independent "of the kind, form of expression, merit or intended use" of a work).

⁵⁷ Compare B. Edelman, *Le droit saisi par la photographie* (Law arrogated by photography), 48–83 *passim* (Bourgeois, new ed., 1980) (explaining how legal theory sorted out authorship in such cases), with M. Rose, "Creating Oscar Wilde: *Burrow-Giles v. Sarony* (1884)," in *Authors in Court: Scenes from the*

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functionally efficient but also appealing to consumers.⁵⁸ New issues arise, notably: Should copyright, or else weaker but related rights, protect technical achievements, and who should be vested with the latter rights?⁵⁹ These issues have become all the harder to resolve with the rise of computer-generated productions.⁶⁰

Copyright law has addressed *market uses* well enough, but not *mass uses*. Pirates early on reset print and undersold publishers with close copies, usurping markets for specific works.⁶¹ In response, courts granted property-like remedies, seizing infringing copies and devices, enjoining illicit copying and sales, and awarding damages or profits.⁶² To avoid such sanctions, commercial users had to negotiate contracts with authors, their successors in interest, or their agents for exploiting economic rights. Or authors sought relief for moral prejudice arising from misattributions of their contributions or from impairments of the integrity of their respective works.⁶³ Courts began to enforce moral rights, while disentangling criteria for their violation from claims made under laws of trademark, unfair competition, or cultural property.⁶⁴ Well into the twentieth century, the market paradigm began to be outflanked by end-users

Theater of Copyright, ch. 4 (Harvard Univ. Press, 2016) (illustrating ambivalences in practice in a pioneer photography case).

⁵⁸ See, generally, J.H. Reichman, "Legal Hybrids Between the Patent and Copyright Paradigms," 94 *Columbia L. Rev.* 2432, 2434–2504 *passim* (1994) (tracing the rise of rights in products synthesizing know-how and new forms). But see B. Sherman and L. Bently, *The Making of Modern Intellectual Property Law: The British Experience, 1760–1911*, chs. 8–10 *passim* (Cambridge Univ. Press, 1999) (recounting how codification obfuscated matters).

⁵⁹ See, e.g., A. Dietz, "Copyright in the Modern Technological World: A Mere Industrial Property Right?," 39 *J. Copr. Soc'y* 83 (1991) (outlining a differentiated system of rights, reserving copyright for clearly creative works and recognizing neighboring or related rights with shorter terms for other productions, in order to avoid copyright "inflation").

⁶⁰ Compare, J. Grimmelmann, "There's No Such Thing as a Computer-Authored Work—And It's a Good Thing, Too," 39 *Columbia J. Law & Arts* 403 (2016) (tracing how issues of protectability and authorship develop as computers are increasingly used in creating works), with S. Colton and G. Wiggins, "Computational Creativity: The Final Frontier?," in L. de Raedt, *et al.* (eds.), *Proceedings of the European Conference on AI*, 21 (ECAI, 2012) (questioning whether, and how, computers might progress toward "creating" on their own).

⁶¹ Compare A. Johns, *Piracy: the Intellectual Property Wars from Gutenberg to Gates*, ch. 2 *passim* (Univ. of Chicago Press, 2009) (British Isles and U.S.), with C. Hesse, *Publishing and Cultural Politics in Revolutionary Paris, 1789–1810*, 215–218 (Univ. of California Press, 1991) (France).

⁶² See, e.g., H.T. Gómez-Arostegui, "What History Teaches Us About Copyright Injunctions and the Inadequate-Remedy-At-Law Requirement," 81 *So. California L. Rev.* 1197 (2008) (explaining U.K. copyright remedies before damage awards were fully recognized in the nineteenth century); A.-C. Renouard, *Traité des droits d'auteurs* (Treatise on Copyright), vol. 2, 390–439 *passim* (Jules Renouard et Cie., 1838) (illustrating remedies in France at much the same time).

⁶³ Compare B. Kaplan, *An Unhurried View of Copyright*, 16 *et seq.* (Columbia Univ. Press, 1967) (exploring the development of the derivative-work right in Anglo-American jurisprudence), with S. Strömholm, *Le droit moral de l'auteur* (Author's Moral Right), vol. I, pt. 1, 118 *et seq.* (Norstedt & Soners Forlag, 1966) (tracing the emergence of moral rights on the European Continent, to start judicially and only later in legislation).

⁶⁴ Compare *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003) (denying relief under unfair-competition or trademark law for releasing news videos without the original distributor's

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who copy and circulate protected matters *en masse*, making judicial recourse costly.⁶⁵ Let us compare profit-seeking entrepreneurs to elephants or more predatory beasts, and individual users to more modest but countless mice.⁶⁶ Claimants can pursue the bigger beasts that market copies openly or aggregate contents online, publicly exploiting creations on large scales.⁶⁷ But it is harder to trap the smaller rodents, like private users, say, file-sharers in hidden networks, more discreetly gnawing away at profits.⁶⁸ Hence the issue still with us: How to remedy such massive loss of control over creations?⁶⁹

For some time, claimants responded to this shift from market to mass uses with *collective management*. For example, in the mid-nineteenth century, a composer heard his music performed at a Parisian café to attract clients. In the ensuing legal fracas, an organization was formed, as an agent for authors and publishers, to monitor such public performances and to collect royalties for them.⁷⁰ In the twentieth century, end-users came to dispose of ever-more powerful devices for privately copying and disseminating works and related productions.⁷¹ Increasingly diverse organizations have been instituted from country to country to act as right-holders' agents to collect and disburse copyright revenues drawn from sources running from public performances to levies on private-copying devices.⁷² At the start of the twenty-first century, already complex and opaque plumbing systems for channeling resulting revenues

name placed on them), *with* Cass., 1e ch. civ. (France), Jan. 30, 2007, RIDA 2007, no. 212, 249, in English trans. in [2007] E.C.D.R. 205 (precluding Victor Hugo's heirs from asserting moral rights to bar a sequel to *Les Misérables*, a "monument of world literature").

⁶⁵ For further analysis, see P.E. Geller, "Reprography and Other Processes of Mass Use," 38 J. Copr. Soc'y 21 (1990), also in French and Spanish trans. in RIDA 1992, no. 153, 3.

⁶⁶ For this metaphor, see P. Swire, "Elephants and Mice Revisited: Law and Choice of Law on the Internet," 153 Univ. of Pennsylvania L. Rev. 1975, 1978–1980 (2005).

⁶⁷ See, generally, A. Strowel, *Quand Google défie le droit: Plaidoyer pour un Internet transparent et de qualité* (When Google challenges the law: Plea for a fair Internet), 59–136 *passim* (De Boeck & Larcier, 2011) (critiquing aggregators' usurpation of protected materials). See, e.g., *Stichting Brein v. Ziggo BV*, C.J.E.U., 2nd ch., June 14, 2017, Case C-610/15, paras. 35–38, [2017] E.C.D.R. 374 (holding that a file-sharing platform, the Pirate Bay, by knowingly facilitating access, with indexing, sorting files, a search engine, etc., but without inputting works, plays "an essential role" in infringement, subject to liability).

⁶⁸ On the shift of file-sharing to virtual-private networks, see S. Larsson, *et al.*, "Law, Norms, Piracy and Online Anonymity—Practices of de-identification in the global file sharing community," J. of Research in Interactive Marketing, 2012, no. 4, 260.

⁶⁹ For a pioneer analysis, see P. Biddle, *et al.*, "The Darknet and the Future of Content Distribution," in J. Feigenbaum (ed.), *Digital Rights Management Workshop 2002*, 155 (Springer, 2003).

⁷⁰ For historical background, see <https://societe.sacem.fr/en/history>. In the late eighteenth century, the French S.A.C.D. already collected authors' royalties for theatrical performances. See J. Boncompain, "Le droit d'être auteur" (The Right to be an Author), in *La révolution des auteurs: 1777–1793* (The Revolution of the Authors: 1777–1793), 7 (S.A.C.D., 1984).

⁷¹ See B. Sherman and L. Wiseman, "Copyright: When Old Technologies Were New" in B. Sherman and L. Wiseman (eds.), *Copyright and the Challenge of the New*, 1, 5–10 (Kluwer, 2012).

⁷² For detailed analyses, see D. Gervais (ed.), *Collective Management of Copyright and Related Rights* (Kluwer, 3d ed., 2015).

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worldwide have been complicated by digital networks aggregating and otherwise exploiting creations.⁷³ We now face the issue: How, contractually or technologically, to channel fair shares of ensuing cash flows to creators and their successors?⁷⁴

There is now a turn towards *technological enforcement*. Unfortunately, our patchwork of copyright laws often fails to provide adequate criteria for rapid judgment calls we have to make, for example, to post, to hyperlink, or to remove contents online licitly.⁷⁵ As if to provide fast and firm decisions on point, technological devices, along with automated systems, now monitor, administer, and restrict uses in digital media, with remedies available against attempts to circumvent such measures.⁷⁶ Nonetheless, in such media, creators still risk shrinking remuneration for their contributions, as returns from online uses do not get back into their pockets or as their creations simply hemorrhage into the nether regions of the internet.⁷⁷ At the same time, technological safeguards raise myriad issues, notably the uncertain nexus they predicate with infringement,⁷⁸ risks that they block allowable contents,⁷⁹ anti-competitive abuses,⁸⁰ and threats to privacy.⁸¹

⁷³ See, generally, Group of Latin American and Caribbean Countries (GRULAC), "Proposal for Analysis of Copyright Related to the Digital Environment," WIPO SCCR/31/4, Dec. 1, 2015, at http://www.wipo.int/edocs/mdocs/copyright/en/sccr_31/sccr_31_4.pdf (global analysis of copyright management).

⁷⁴ See, generally, § 6[3][a][ii] *infra* (broaching copyright-contract provisions to assure authors and performers of "equitable remuneration"). See, e.g., Berklee Institute of Creative Entrepreneurship, "Fair Music: Transparency and Money Flows in the Music Industry" Report, July 14, 2015, at https://www.berklee.edu/news/fair_music_report (critical analysis of the allocation of copyright revenues in the music business).

⁷⁵ See, e.g., the *Thumbnails III* decision, BGH (Germany), Sept. 21, 2017, paras. 61–71, ZUM 2018, 123 (outlining the duties of operators of automated search-engines); *GS Media BV v. Sanoma Media Netherlands BV*, C.J.E.U., 2nd ch., Sept. 8, 2016, Case C-160/15, paras. 46–55, [2016] E.C.D.R. 421 (calling on for-profit users to assess whether a posting is licit before linking to it); *Lenz v. Universal Music Corp.*, 815 F.3d 1145 (9th Cir. 2016) (U.S.) (calling for a good-faith finding of an illicit use before noticing a takedown).

⁷⁶ Compare Z. Efroni, *Access-Right: The Future of Digital Copyright Law*, ch. 8 (Oxford Univ. Press, 2010) (proposing to calibrate technological safeguards with copyright limitations), with A. Peukert, "A Bipolar Copyright System for the Digital Network Environment," 28 *Hastings Communications & Entertainment L.J.* 1 (2005) (contemplating parallel systems of copyright administration).

⁷⁷ See, e.g., L. Dowthwaite, R.J. Houghton, and R. Mortier, "How relevant is copyright to online artists? A qualitative study of understandings, coping strategies, and possible solutions," *First Monday*, May 2, 2016, at <http://firstmonday.org/ojs/index.php/fm/article/view/6107> (surveying authors and performers who find copyright laws of little help against takings and lack of attribution online).

⁷⁸ Compare *Nintendo Co. Ltd. v. PC Box Srl*, C.J.E.U., 4th ch., Jan. 23, 2014, Case C-355/12, para. 38, [2014] E.C.D.R. 90 (calling for judicial inquiry into proper functions of technological measures case by case), with *Stevens v. Kabushiki Kaisha Sony Computer Entertainment*, 2005 HCA 58, paras. 45–47 (Australia) (trying "to avoid an overbroad construction which would extend the copyright monopoly rather than match it").

⁷⁹ See, generally, G. Westkamp, "Digital Rights Management, Internet Governance and the Autopoiesis of Modern Copyright Law," 7 *Contemporary Issues in Law* 318 (2005) (analyzing difficulties of automating copyright notions that predicate subtle judgment calls). See, e.g., U.C.-Berkeley School of Law and the American Assembly, "The Takedown Project: Collaborative research on Internet takedown

[2] How to Focus on Issues in Diverse Laws?

Conventional wisdom distinguishes between the laws of copyright and of authors' rights. However, as we have suggested, issues key to cross-border copyright cases may often be appropriately understood as arising in interrelated families of such laws.⁸² We shall here sort out such issues (a) in marking off the protected core of works from other productions and (b) in assessing the scope of rights in representative laws.

[a] How to Distinguish Protected Matters?

National and regional laws, along with international treaties, typically accord copyright in what they designate as "works." Lawmakers have faced problems, on the one hand, of coordinating rights of industrial property with copyright in works and, on the other, of devising related rights in other media and data productions.⁸³ We shall here (i) unpack the criteria of the copyright-protected core within works and (ii) trace the borderlines between that core and other productions protected by other rights of intellectual property.

[i] The Creative Core Within Authors' Works

We all tend to presuppose some consensus on the meaning of "works" under different copyright laws.⁸⁴ It does not, however, always suffice to match a purported work with some statutory or treaty list of different categories of protected works; especially at the margins of such categories, courts need *criteria* of protectability to assess infringement.⁸⁵ In easy cases, one might well assume that these criteria are comparable from legal culture to culture; unfortunately, in hard cases, we see courts improvise on them in trying to discern the copyright-protected cores of new works.⁸⁶

Formalities, such as the deposit of hard copies of works, once often indispensable to copyright, are no longer widespread conditions of protection. In the mid-nineteenth century, a French court simply ruled that then-current deposit provisions did not apply to a live sermon, which had been transcribed and printed without the author's consent,

law and policy," at <http://takedownproject.org/> (linking to analyses worldwide).

⁸⁰ See, e.g., A. Daly, "E-Book Monopolies and the Law," 18 *Media & Arts L. Rev.* 350 (2013) (interoperability and uses obstructed); R.L. Vinelli, "Bringing Down the Walls: How Technology is Being Used to Thwart Parallel Importers Amid the International Confusion Concerning Exhaustion of Rights," 17 *Cardozo J. of International and Comparative Law* 135 (2009) (markets artificially segmented).

⁸¹ See, generally, J. Cohen, "Pervasively Distributed Copyright Enforcement," 95 *Georgetown L.J.* 1 (2006) (analyzing risks to privacy from systematically monitoring copyright uses).

⁸² See §§ 1[3][b] and 2[1][c][i] *supra*.

⁸³ See § 2[1][c][ii] *supra*.

⁸⁴ For the meaning of this term in the major treaties, see § 4[1][a] *infra*.

⁸⁵ For this truism applied in analyzing the treaty protection of copyright and of neighboring rights, see §§ 4[1][b] and 4[1][c][ii] *infra*.

⁸⁶ See, e.g., *Lucasfilm v. Ainsworth*, [2008] EWHC 1878 (Ch) (U.K.), para. 73 ("factual issues [. . .] are essentially the same as those arising in the UK claim," except "the US 'functionality' or 'utilitarian' point" concerning designs), *affirmed and reversed in part*, [2009] EWCA Civ 1328 and [2011] UKSC 39 (discussed in § 6[1][b][i] *infra*).

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in order to protect this unfixed work.⁸⁷ From the start of the twentieth century, the Berne Convention has prohibited adhering countries from predicating its protection on any formality such as deposit or registration, while still allowing the option of requiring fixation for protection.⁸⁸

As the law moved beyond conditions like deposit, even often fixation, issues of protectability became more volatile. Copyright statutes only alluded to protected subject matters in more or less broad categories of works. Thus, it was left to the trial courts to determine what, case by case, qualified for protection and what, inside any given work, was susceptible of infringement.⁸⁹ Exceptionally, in the United States, while judges grant or deny preliminary injunctions, a jury may be called upon to decide ultimate questions of protectability and infringement. In other common-law traditions and in the civil law, operating without a civil jury, judges have full powers to resolve all such issues, relying on experts as they see fit. Accordingly, the interplay between trial-court findings of protection or infringement, on the one hand, and appellate review, on the other, may vary from judicial system to system.⁹⁰

As indicated above, the copyright criteria of protectability became more expansive over time.⁹¹ At the outset, takings less clear-cut than close copying rarely constituted actionable infringement.⁹² Nonetheless, as trade in books became increasingly globalized, authors started to claim rights in translations of their works. Ultimately, the law recognized the author's right to stop others from deriving other works from her own, not only from translating but, for example, from adapting a literary work for the stage or to film, and so forth.⁹³ Liability, however, could not be indiscriminately imposed for transforming a work, at least not without restricting the possibilities for creating new works and thereby undercutting the basic rationale for copyright itself.⁹⁴

⁸⁷ *Marle c. Lacordaire*, Trib. corr. Lyon, June 10, 1845, *affirmed*, CA corr. Lyon, July 17, 1845, Dalloz 1845, II, 128.

⁸⁸ For this development, see §§ 4[1][a] and 5[3] *infra*.

⁸⁹ Compare B. Kaplan, *An Unhurried View of Copyright*, 9 *et seq.* (Columbia Univ. Press, 1967) (development of Anglo-American case law), with I. Cherpillod, *L'objet du droit d'auteur* (The Subject Matter of Copyright), 15 *et seq.* (CEDIDAC, 1985) (development of European doctrine).

⁹⁰ Compare "France," herein, at §§ 1[4] and 8[1][a] (noting that courts review, at the highest level of appeal, only findings of law, though at times overturning these for insufficiently specified factual findings), with E. Schwartz, "United States," herein, at § 8[1][a] (hereinafter: "United States") (outlining varying standards of review on appeal of infringement findings by judge or jury).

⁹¹ See § 2[1][c][ii] *supra*.

⁹² See R. Deazley, *Re-Thinking Copyright: History, Theory, Language*, ch. 2 (Edward Elgar, 2006); B. Kaplan, *An Unhurried View of Copyright*, 16 *et seq.* (Columbia Univ. Press, 1967).

⁹³ For historical overviews, see L. Bently, "Copyright and Translations in the English Speaking World," 12 *Translatio: FIT Newsletter* 491 (1993); P. Goldstein, "Adaptation Rights and Moral Rights in the United Kingdom, the United States and the Federal Republic of Germany," 14 *I.I.C.* 43, 46–55 *passim* (1983).

⁹⁴ For comparative analyses, see P.E. Geller, "*Hiroshige vs. Van Gogh*: Resolving the Dilemma of Copyright Scope in Remediating Infringement," 46 *J. Copr. Soc'y* 39, 44–53 (1998); I. Cherpillod, *L'objet du droit d'auteur*, 56–184 *passim* (CEDIDAC, 1985).

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Some courts therefore came to disentangle unprotectible “facts,” “ideas,” “themes,” “methods,” etc., from the “form” or “expression” protected within a work: for example, story lines, harmonic structures, compositional schema, etc., may remain unprotected. Others draw this line in terms of allowing the “free utilization” of ideas, themes, etc., in a sufficiently distinct “creative” work.⁹⁵

Some rough and ready criteria of protectability, arising out of some provisional consensus, may be ventured for copyright.⁹⁶ Anglo-American case law has increasingly rejected any criterion of mere effort: in U.S. terms, “the sweat of the brow” does not suffice.⁹⁷ E.U. case law has more closely settled on criteria such as “the author’s own intellectual creation” for ascertaining what copyright may protect.⁹⁸ No work is disqualified from protection just because it repeats traits of others, at least if the author creatively introduces matter beyond that taken from any other work.⁹⁹ A court may, this writer has submitted, inquire into the protected core of a work at issue by focusing on the individuality of its manifestly significant texture or configuration in context.¹⁰⁰ Decisions on point often remain muddled: some courts precipitously presume, on finding such ostensibly creative materials in one part of a work, that taking of any part infringes.¹⁰¹ Other courts, arguably with greater wisdom, decline to protect routine

⁹⁵ For further analysis, see P.E. Geller, “A German Approach to Fair Use: Test Cases for TRIPs Criteria for Copyright Limitations?,” 57 J. Copr. Soc’y 553, 554–560 (2010).

⁹⁶ For comparative analyses, see B. Sherman, “The Concept of a Copyright Work,” 12 Theoretical Inquiries in Law 99 (2011); E. Judge and D. Gervais, “Of Silos and Constellations: Comparing Notions of Originality in Copyright Law,” 27 *Cardozo Arts & Entertainment L.J.* 375 (2010).

⁹⁷ See, e.g., *CCH Canadian Ltd. v. Law Society of Upper Canada*, 2004 SCC 13 (Canada) (protecting a compilation of judicial cases, showing non-trivial “skill and judgment” in its headnotes, case summaries, topical index, editing, etc.); *Feist Publications, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340 (1991) (denying copyright in a laborious telephone directory, lacking minimal “creativity” in its alphabetical listings).

⁹⁸ Compare *Eva-Maria Painer v. Standard Verlags GmbH*, C.J.E.U., 3rd ch., Dec. 1, 2011, Case C-145/10, paras. 87–94, [2011] E.C.D.R. 297 (holding this criterion met by “making free and creative choices” in taking photographs), with *Football Association Premier League Ltd. v. QC Leisure and Karen Murphy v. Media Protection Services Ltd.*, C.J.E.U., Grand ch., Oct. 4, 2011, Joined Cases C-403/08 and C-429/08, para. 98, [2012] E.C.D.R. 127 (doubting that it would be met by sporting events “subject to the rules of the game, leaving no room for creative freedom”).

⁹⁹ For further analysis, see G. Karnell, “Die Doppelschöpfung als urheberrechtliches Problem” (Repeated Creation as a Copyright Problem), in F. Dessemontet (ed.), *Mélanges Joseph Voyame*, 149 (Payot, 1989).

¹⁰⁰ P.E. Geller, “Must Copyright Be For Ever Caught Between Marketplace and Authorship Norms?,” in B. Sherman and A. Strowel (eds.), *Of Authors and Origins: Essays in Copyright Law*, 159, 178–199 *passim* (Clarendon Press, 1994), abridged as “Toward an Overriding Norm in Copyright: Sign Wealth,” *RIDA* 1994, no. 159, 3, at 35–95 *passim* (with trans. in French and Spanish).

¹⁰¹ Compare *Authors Guild v. Google, Inc.*, 804 F. 3d 202, 223 (2d Cir. 2015) (U.S.) (contemplating infringement only if “a coherent” and ostensibly creative “block” of the work were taken), with *Infopaq International A/S v. Danske Dagblades Forening*, E.C.J., 4th ch., July 16, 2009, Case C-5/08, para. 50, [2009] E.C.R. I-6569 (opining that “the cumulative effect” of aggregated extracts risked reflecting “the originality of the work in question”).

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themes or patterns with copyright, and they may now hesitate to protect computer-generated contents.¹⁰²

Do current criteria lead to much the same outcomes? It would seem so in the most ordinary and easy cases, but not necessarily in hard cases. At times, outcomes turn less on express differences in legal criteria than on often-implicit judgments of policy or, still less clearly, of taste.¹⁰³ To start, as next indicated, within many jurisdictions, alternative regimes of protection may be available in some types of borderline cases, such as designs, recordings, or databases.¹⁰⁴ Further, where courts find striking creativity in a work, some may be ready to protect it with “thick copyright” against paraphrase or adaptation; by contrast, where they find only minimal creativity, their protection may be “thin,” as they hesitate to grant injunctive relief, except against close copying.¹⁰⁵ Finally, courts may vary in assessing whether aggregating isolated elements of works constitutes infringement to the extent that such elements are mixed, sometimes transformatively, into another work.¹⁰⁶

[ii] Designs; Other Media or Data Productions

What to do in hard cases that we have spotted outside any provisional consensus on the copyright-protected core of works?¹⁰⁷ To avoid gaps in protection, statutes, sometimes coupled with treaties, have provided other rights, sometimes rights of industrial property and sometimes copyright-related rights.¹⁰⁸ Nonetheless, at distinct points, the borders of major fields within intellectual property risk blurring and at times overlapping.¹⁰⁹

¹⁰² See, e.g., *Albano Carrisi c. Michael Jackson*, CA Milan (Italy), Oct. 12, 1999, Dir. aut. 2000, 127, in English trans. in [2000] E.C.D.R. 424 (denying protection for routine musical themes and rhythms), with *Telstra Corporation Pty. Ltd. v. Phone Directories Company Pty. Ltd.*, [2010] FCAFC 149 (Australia) (not protecting a largely computer-generated telephone directory).

¹⁰³ See, e.g., E. Ulmer, *Urheber- und Verlagsrecht* (The Law of Author's Right and Publishing), 276 (Springer-Verlag, 3d ed., 1980) (noting that, in hard infringement cases, “literary and artistic evaluations are not to be avoided”).

¹⁰⁴ See § 2[2][a][ii] *infra*.

¹⁰⁵ Compare D. Gervais, “The Derivative Right, or Why Copyright Law Protects Foxes Better than Hedgehogs,” 15 *Vanderbilt J. Entertainment and Technology Law* 785, 836–854 *passim* (2013) (proposing to refine infringement analysis), with P.E. Geller, “*Hiroshige vs. Van Gogh*: Resolving the Dilemma of Copyright Scope in Remediating Infringement,” 46 *J. Copr. Soc’y* 39, 51–56 (1998) (proposing to tailor remedies).

¹⁰⁶ See, e.g., the *Perlentaucher* (Pearl Diver) decision, BGH (Germany), Dec. 1, 2010, GRUR 2011, 134, in English trans. in 42 *I.I.C.* 978 (2011) (setting out criteria for such assessment), *on remand*, OLG Frankfurt a.M., Nov. 1, 2011, ZUM 2012, 146 and 152 (sorting out which abstracts from book reviews, aggregated on a literary website, were infringing *vel non*).

¹⁰⁷ See §§ 2[1][c][ii] and 2[2][a][i] *supra*.

¹⁰⁸ For analysis of the treaty-determined coverage as between copyright and industrial property, see § 4[1][c] *infra*.

¹⁰⁹ See, generally, J.H. Reichman, “Legal Hybrids Between the Patent and Copyright Paradigms,” 94 *Columbia L. Rev.* 2432, 2453–2465 (1994) (mapping variably overlapping boundaries between copyright and design laws).

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At the edges between copyright and industrial property, courts vacillate in cases of so-called utilitarian works.¹¹⁰ Some laws may put them to the task of disentangling “aesthetic” or “artistic” features to protect with copyright in designs.¹¹¹ E.U. harmonization has excused them from sorting out such coverage with that of any special design right, allowing both to accumulate relative to any design work.¹¹² Case law from E.U. member states shows courts still experimenting with criteria on point, apparently finding that of creativity insufficient in itself for according copyright in design cases.¹¹³ Courts also struggle to abstract functionalities out of any creative core of computer programs.¹¹⁴

In some hard cases of text or images without creative elaboration, courts may find grounds outside statutory copyright law for fashioning minimal relief.¹¹⁵ Such cases may, for example, involve programmatic materials like bare formats for television programs or plans for conceptual art, snappy but short titles or mere visual patterns, routinely ordered data-sets, etc. Recourse may then be had, most notably, to claims for unjust enrichment or unfair competition, as well as on publicity rights, trademarks, etc.; however, some laws may disallow bringing such “other” claims from serving as substitutes for copyright actions.¹¹⁶ General tort laws may also come into play to protect reputational interests in some media productions, especially when moral rights are not available.¹¹⁷

¹¹⁰ For treaty dimensions of cases of industrial designs, of computer programs, and of semiconductor chips, see § 4[1][c][i] *infra*.

¹¹¹ See, e.g., *Star Athletica, LLC v. Varsity Brands, Inc.*, 136 S. Ct. 1823 (April 24, 2017) (U.S.) (asking whether aesthetic features form a creative and thus protectible artistic work, once they are imaginatively separated from the useful article at issue).

¹¹² See, generally, L. Bently, “The Return of Industrial Copyright?,” [2012] E.I.P.R. 654 (pointing out tensions in E.U. efforts to harmonize national laws on point).

¹¹³ Compare *Metalco S.p.A. c. City Design S.p.A.*, Cass. civ., sez. I (Italy), Nov. 13, 2015, No. 23292, *Foro Italiano*, 2016, 2, I, 562, in English trans. in 47 I.I.C. 859 (2016) (unpacking diverse criteria, including salient form, audience response, professional recognition, etc.), with the *Geburtstagszug* (Birthday Train) decision, BGH (Germany), Nov. 13, 2013, GRUR 2014, 175, in English trans. in 45 I.I.C. 831 (2014) (in theory, applying the same criterion of creativity to design works as to others, but in practice calling for their artistic or some such achievement, as appreciated in qualified circles).

¹¹⁴ Compare *Oracle America, Inc. v. Google, Inc.*, 750 F.3d 1339, 1354 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 2887 (2015) (protecting “structure, sequence, and organization” of programming interfaces), with *SAS Institute Inc. v. World Programming Ltd.*, [2013] EWCA Civ 1482 (U.K.) (finding no creative “form of expression” in the emulation of functionalities in claimant’s software).

¹¹⁵ For national and international sources of such protection, see, respectively, §§ 3[2][b] and 4[1][c][iii] *infra*.

¹¹⁶ Compare *Gree v. DeNA*, no. 2012 (Ne) 10027, Hanrei Jiho (no. 2165) 42 (Intellectual Property High Court, 4th Div., Aug. 8, 2012) (Japan), in English trans. at http://www.ip.courts.go.jp/app/files/hanrei_en/707/000707.pdf (precluding any action in tort where neither unfair competition nor copyright infringement was found in replicating stock visual themes in electronic games), and *Briar Patch, Ltd. v. Phoenix Pictures, Inc.*, 373 F.3d 296, 306–307 (2d Cir. 2004) (U.S.), *cert. denied*, 544 U.S. 949 (2005) (preempting relief for unjust enrichment by taking texts as functionally equivalent to copyright).

¹¹⁷ See, e.g., the *Collection Schlumpf* decision, CA Paris, 1e ch. (France), May 25, 1988, *Dalloz* 1988,

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A further key distinction is drawn. Creative works are protected by copyright, that is, in most laws, authors' rights. Other specified types of media productions are protected by other, variously formulated copyright-related rights.¹¹⁸ Consider, hypothetically, the recording of a performance of a musical work in the public domain, say, a symphony by Mozart just as it was originally scored. While a few laws still confusingly speak of recognizing "copyright" in the resulting master recording, internationally called a *phonogram*, most laws protect media productions such as performances, phonograms, and broadcasts with "neighboring" or similarly labeled rights.¹¹⁹ Insofar as these productions lack creativity requisite for copyright, rights in them are of lesser scope and *a fortiori* normally subject to copyright limitations.¹²⁰

Some countries, including E.U. member states, also extend copyright-related rights to cover a variety of other types of productions. These most notably include such rights in audiovisual recordings or "first fixations on film," that is, what are sometimes called *videograms*, as well as *sui generis* rights in database contents.¹²¹ Other related rights protect, for example, non-creative photographs here dubbed *snapshots*, new and critical editions of public-domain works, materials from the press, sporting events, etc. In any event, absent proof that a media or data production satisfies copyright criteria of protectability, it may rather qualify for protection by a related right if it falls under a statutory scheme to that effect.¹²²

[b] How to Assess the Relative Scope of Different Rights?

We have seen laws of copyright and of authors' rights based on mutating mixes of perennial theories.¹²³ Against that background, we shall here analyze the varying scope of rights among such laws by asking: (i) Which moral or economic rights are likely to prevail in hard cases, now more frequent online? (ii) How long do rights last, in whom do they initially vest, and how may they be transferred? (iii) To what extent

542, note B. Edelman (accepting a family's tort claims both to keep its name in the title of an automobile museum it had founded and to correct some changes made in its original arrangement of the museum itself).

¹¹⁸ See, e.g., World Intellectual Property Organization, *WIPO Glossary of Terms of the Law of Copyright and Neighboring Rights*, no. 164 (WIPO, 1980) ("neighboring" or "connected," now extending to "related," rights).

¹¹⁹ For further analysis of this nomenclature, confirmed in treaties, see § 4[1][c][ii] *infra*.

¹²⁰ See, e.g., the *Metall auf Metall* decision, BVerfG (Germany), May 31, 2016, GRUR 2016, 690, in English trans. in 48 I.I.C. 343 (2017) (declining, in the light of constitutionally protected freedom of art, to prohibit sampling from recordings for creative purposes).

¹²¹ See, e.g., "European Union," herein, at § 4[2][e][i][B] (directive providing for "related" rights in videograms, among other media productions) and at § 4[2][f][ii] (directive providing for *sui generis* rights in database contents).

¹²² For analysis of protection of such "other matters" across borders, absent treaty coverage, see § 4[1][c][iii] *infra*.

¹²³ See § 2[1][c][i] *supra*.

are rights subject to exceptions, overriding limitations, or other defenses? At points, we shall return to issues that we just noted as now emerging in practice.¹²⁴

[i] Which Rights Prevail Over Others in Hard Cases?

Copyright and authors' rights, along with related rights, remain fluid. Not only have lawmakers worldwide been adapting such rights to new media, but the European Union has been "harmonizing" many national laws in the field.¹²⁵ Merely to convey some sense of developing issues for right-holders and users, we shall here ask which rights may often prevail over others when tensions arise between them. Traditionally, tensions have dramatically arisen when authors invoked moral rights to control the fate of works in which economic rights were alienated. Recently, we have seen quite different tensions plague efforts to define and enforce rights online.¹²⁶

Anglo-American statutes tend to enumerate a "bundle" of diverse rights under copyright "pluralistically." In English-speaking jurisdictions, privacy interests in controlling the disclosure of works could historically be said to fall under common-law copyright.¹²⁷ Without prejudice to any self-standing privacy right, a right of initial disclosure is now often folded into the economic rights enumerated in copyright statutes. The main pair of moral rights, namely to attribution of one's authorship and to integrity of one's work, may often be recognized in statutory terms, or relief for them may be furnished under different headings.¹²⁸ However, copyright law may in rare cases preclude remedies for such rights as it does not itself delimit in so many words.¹²⁹ Otherwise, the courts have the task of crafting equitable remedies to resolve tensions between rights.¹³⁰

Laws of authors' rights have traditionally been distinguished as based on "dualist" or "monist" doctrines.¹³¹ It has nonetheless become increasingly questionable whether such theoretical considerations continue to dictate practical consequences with any

¹²⁴ See § 2[1][c][ii] *supra*.

¹²⁵ See §§ 3[3][a][ii][A] and 5[1][c] *infra*.

¹²⁶ See § 2[1][c][ii] *in fine supra*.

¹²⁷ See, e.g., *Prince Albert v. Strange*, [1849] EWHC Ch J20 (U.K.) (providing relief against the disclosure of art works made and held in private).

¹²⁸ See, e.g., *Agence France Presse v. Morel*, 2014 U.S. Dist. LEXIS 112436 (S.D.N.Y., Aug. 13, 2014) (U.S.) (awarding damages for the removal of copyright-management information that effectively attributed authorship to the work at issue).

¹²⁹ See, e.g., *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003) (ruling that trademark law requiring a designation of "origin" on products could not form any basis for requiring the attribution of corporate "authorship" of works with lapsed copyrights).

¹³⁰ *But see, e.g., Sweeney & Camps (The Estate of James Joyce) v. MacMillan Publishers Ltd. & Rose*, [2001] EWHC Ch 460 (critiquing a claim sounding in unfair competition as grounds for remedies to assure the integrity of a work).

¹³¹ See H. Desbois, *Le droit d'auteur en France* (Author's Right in France), 275–277, 469–470 (Dalloz, 3d ed., 1978); E. Ulmer, *Urheber- und Verlagsrecht* (The Law of Author's Right and Publishing), 109–115, 354 *et seq.* (Springer-Verlag, 3d ed., 1980). *N.b.* this distinction is quite different from that, unpacked in § 3[2][a] *infra*, between approaches to coordinating domestic and treaty laws.

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strict logic.¹³² Consider the classic question: What if an author invoked her moral right to respect for the integrity of her work to stop a media firm from adapting that work pursuant to the contractual transfer of economic rights?¹³³ A dualist approach allows courts to enforce moral rights to the prejudice of economic rights, even to those contractually alienated, but courts may occasionally disallow the abusive exercise of moral rights purely for economic profit.¹³⁴ A monist approach entitles authors to control unspecified future uses of their works, especially those bearing on their personal interests, while courts may have to resolve residual tensions between moral and economic rights subject to contracts.¹³⁵ Other jurisdictions, following neither approach strictly, have reached their own solutions in hard cases.¹³⁶

We saw copyright law instituted in the right to print and sell resulting copies, and authors' rights initially emerge in the right to perform plays live.¹³⁷ The E.U. Court of Justice has illustrated how unwieldy any corresponding distinction has become between "material" and "immaterial" exploitation. On the one hand, this court, among others, has deemed the distribution of copies to take place when digitized works are downloaded from the internet.¹³⁸ On the other, it has unpacked varying criteria of actionable communication, notably that of reaching some "new public" or of using "a different means of transmission."¹³⁹ No consensus has crystallized worldwide to settle the scope of any such "umbrella" right to control at least the making of protected

¹³² Compare B. Edelman, *Droits d'auteur, droits voisins* (Author's Rights, Neighboring Rights), 64–65, 160–162, 322–323 (Daloz, 1993) (noting 1985 changes in French law weakening dualism), with M. Grünberger, *Das Interpretenrecht* (Performer's Rights), 44–57 (Heymanns Verlag, 2006) (asking how far monism extended from German authors' to performers' rights).

¹³³ See, e.g., § 6[3][c][ii] *infra* (detailed analysis of this issue).

¹³⁴ Compare the *Asphalt Jungle* decision, *Huston c. Turner Entertainment*, Cass., 1e ch. civ. (France), May 28, 1991, RIDA 1991, no. 149, 197, in English trans. in 23 I.I.C. 702 (1992) (prohibiting the dissemination of a colorized version of a classic *film noir* on the basis of film authors' moral right to integrity, notwithstanding contracts alienating their economic rights) (discussed in §§ 3[2][b], 4[2][a][ii], and 6[2][b][i] *infra*), with Cass., 1e ch. civ., May 14, 1991, RIDA 1992, no. 151, 272, note P. Sirinelli (precluding author from abusively asserting moral right merely to contest insufficient royalties).

¹³⁵ See, e.g., the *Die Weber* (The Weavers) decision, KG, Berlin (Germany), June 21, 2005, ZUM-RD, 2005, 381 (enjoining some changes, ostensibly shocking the court, in a current adaptation of an older play as violating its integrity, but permitting other changes given prior oral modifications of a standard license of the theatrical production).

¹³⁶ See, e.g., the *Tokimeki memoriaru* (Thrilling Memorial) decision, Hanrei Jiho (no. 1740) 78 (Supreme Court, 3rd Petty Bench, Feb. 13, 2001) (Japan), in English trans. at <http://www.softic.or.jp/en/cases/> (disallowing memory cards changing videogame characters, story development, etc., upon finding them to violate the integrity of the game).

¹³⁷ See § 2[1][b] *supra*.

¹³⁸ *UsedSoft GmbH v. Oracle International Corp.*, C.J.E.U., Grand ch., July 3, 2012, Case C-128/11, [2012] E.C.D.R. 368. See also *Spedidam c. société iTunes*, Cass., 1e ch. civ. (France), Sept. 11, 2013, JurisData no. 2013-018957 (interpreting downloads as subject to licenses to exploit "published" phonograms); *Entertainment Software Association v. SOCAN*, 2012 SCC 34, para. 10 (Canada) (considering downloads as reproductions, not as telecommunications).

¹³⁹ Compare *SBS Belgium NV v. SABAM*, C.J.E.U., 9th ch., Nov. 19, 2015, Case C-325/14, paras. 21–34, [2016] E.C.D.R. 74 (finding that sending encrypted transmissions to stations alone does not in

contents available to members of the public online.¹⁴⁰ Such unsettled rights more and more often have to be vindicated by relief that relies on the complex technological controls of exploitation in global cyberspace.¹⁴¹

[ii] Duration of Rights? In Whom Vested? How Alienable?

We can now refine the conventional wisdom which merely contrasts laws of “copyright” with laws of “authors’ rights.” As already noted, families of affinities and differences characterize such bodies of law, illustrating a variety of legislative and jurisprudential approaches.¹⁴² We shall here touch only on U.S., French, and German laws as they bear on the duration of rights, as well as on the vesting and alienability of rights.¹⁴³ The principles that these laws illustrate with regard to the entitlements of creators over time may be found, in different combinations and permutations, in other laws as well. We can here only indicate, to unpack later, how this very variety can complicate sorting out worldwide chain of title and, accordingly, who may pocket resulting copyright revenues.¹⁴⁴

How long should rights last? Responses vary in national laws, sometimes reflecting shifts in theories of rights and sometimes in practical considerations: here are some typical paradigms. Anglo-American copyright statutes now have rights running from initial publication only in special cases, having largely shifted, under Berne influence, to the general rule of life-plus terms for the rights of flesh-and-blood authors.¹⁴⁵ French author’s rights are subject to dual and radically different treatments: economic rights are statutorily limited in time; moral rights have no such term at all, although they are often treated in different manners before and after an author’s death.¹⁴⁶

itself reach any “new public”), *with* VCAST Ltd. v. RTI SpA, C.J.E.U., 3rd ch., Nov. 29, 2017, Case C-265/16, paras. 48–50, [2018] E.C.D.R. 157 (presuming, in a case of a cloud service relaying content online, that retransmissions by new means may be “communications to different publics” than those authorized).

¹⁴⁰ For further analysis, in the light of the treaty minimum right on point, see § 5[4][a][i][B] *infra*. For a comparative analysis from a U.S. perspective, see U.S. Copyright Office, “The Making Available Right in the United States” (Register of Copyrights, Feb. 2016), at https://www.copyright.gov/docs/making_available/making-available-right.pdf.

¹⁴¹ *See, e.g.*, § 3[1][b][iii][B] *infra* (illustrating how, as the “umbrella” right is spread more widely, direct and indirect infringement may be variably conflated from jurisdiction to jurisdiction, making the choice of laws dispositive of such relief online all the harder).

¹⁴² *See* § 1[3][a] *supra*.

¹⁴³ *See also* F. Dessemontet, “Switzerland,” herein, at §§ 4[2][a] and 7[1] (hereinafter: “Switzerland”) (legislatively pulling together Continental European approaches to coordinating economic and moral rights).

¹⁴⁴ *See* §§ 6[2] and 6[3] *infra*.

¹⁴⁵ *See, generally*, “United States,” herein, at §§ 3[1], 3[2], 6[4], 7[1][b], and 7[3] (treating transitional issues for economic rights and indicating that pluralism among U.S. non-copyright analogues to moral rights often leaves their duration uneven). *See also* § 5[3][a] *infra* (coordinating prior U.S. initial and renewal terms with the Berne life-plus term).

¹⁴⁶ *See, generally*, “France,” herein, at §§ 3[1] and 7[3] (dualism in limited duration of economic rights and “perpetual” moral rights). *But see, e.g.*, *Société des Films Marceau et Vadim c. Société des*

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German author's right, doctrinally one monolithic right with economic or moral components, has one statutorily indicated unitary term, but caveats may arise as the term nears its end.¹⁴⁷ Unfortunately, as we shall see, international efforts to harmonize the duration of rights remain complicated by diverging retroactivity rules and the residual rule of the shorter term.¹⁴⁸

Who obtains rights when a work or related production arises? U.S. law tolerates the fiction of corporate "authors" initially owning copyright in "works made for hire." Under laws of authors' rights, in principle, authors, flesh-and-blood creators of works, or flesh-and-blood artists delivering performances, respectively, have rights vest in themselves. However, works and related productions increasingly arise in ever-more variegated groupings, and national laws have long experimented with allocating rights in response.¹⁴⁹ For example, since the French Laws of 1791 and 1793 started to measure the term of economic rights by the life of the "author," most laws have vested rights in authors identified by reference to the natural persons creating works.¹⁵⁰ Nonetheless, many laws have adopted some writer-for-hire fiction or recognized collective or other team works, like audiovisual works: the employer, editor or publisher, or producer may then initially hold economic rights in such works, though without necessarily acquiring any status of "author."¹⁵¹ Effectively, initial vesting is often caught between the analytic difficulties of focusing on what to protect, on who contributed the protectible core of a work, and on who may best exploit rights.¹⁵²

How may economic rights be transferred or moral rights waived? The alienability of rights is subject to different approaches, ranging from contractual freedom to detailed regulation. In theory, U.S. copyright, at least in its economic components, is in principle fully alienable, but it is nonetheless subject to statutory provisions that

Gens de Lettres, Cass., 1e ch. civ. (France), Dec. 6, 1966, RIDA 1967, no. 53, 15 (denying an authors' professional society standing to assert moral right in the eighteenth-century French literary classic *Les liaisons dangereuses*).

¹⁴⁷ See, generally, "Germany," herein, at §§ 3[1], 7[1], and 7[3] (only statutory exception to monism affects standing to assert the right of revocation after death). But see, e.g., OLG Stuttgart (Germany), Oct. 6, 2010, ZUM 2011, 173 (refusing effect, after three-quarters of the *post mortem* term had run, to an architect's moral right, but rather allowing the partial demolition of a building he designed), *affirmed by dismissing appeal*, BGH, Nov. 9, 2011, GRUR 2012,172.

¹⁴⁸ See §§ 4[3][a] and 5[2] *infra*.

¹⁴⁹ See L. Bently and L. Biron, "Discontinuities between legal conceptions of authorship and social practices," in M. van Eechoud (ed.), *The Work of Authorship*, 237 (Amsterdam Univ. Press, 2014).

¹⁵⁰ *N.b.* the French Supreme Court early on honored this principle in the breach when it accorded the French State rights in the *Dictionnaire* of the Academy: *Bossange c. Monardier*, Cass., Aug. 8, 1793, reported in A.-C. Renouard, *Traité des droits d'auteurs* (Treatise on Copyright), vol. 2, 222–224 (Jules Renouard et Cie., 1839).

¹⁵¹ Compare "Japan," herein, at § 4[1][b] (employers considered as authors), and M. van Eechoud, "Netherlands," herein, at § 4[1][b] (different types of employer ownership), with "France," herein, at § 4[1][b][i] (collective works).

¹⁵² See, respectively, § 2[2][a][i] *supra* (comparatively analyzing criteria of protectability) and § 6[2][b] *infra* (outlining legal solutions).

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terminate contractual transfers on complex conditions.¹⁵³ French law, considering economic and moral rights quite distinctly, allows for the contractual transfer of economic rights, subject in France to statutorily imposed provisions for certain transactions, but it does not allow for the contractual alienation of moral rights.¹⁵⁴ German law only empowers authors to contract away rights of use to other parties, and it conditions their ability to alienate their rights to exploit unforeseen media, entitlements to remuneration, and moral rights.¹⁵⁵ Thus, as explained below, conflicts of laws may arise on the levels of rights to be transferred and of instruments transferring rights, and these levels do get entangled in hard cases.¹⁵⁶

Complex mechanisms, as already noted, have evolved for clearing copyright claims and uses and for channeling resulting revenues worldwide.¹⁵⁷ However, these mechanisms cannot be globally justified without resolving issues such as we just raised, most notably: how to assess multiple creators' contributions to team works or performances; how to govern transfers of rights from country to country; etc. It should not then be surprising that the allocation by collective-management organizations of foreign claimants' royalties has rarely been subject to judicial review.¹⁵⁸ Long-standing courses of dealing of such organizations have begun to be thus investigated in attempts to correct diversions of copyright revenues due creators.¹⁵⁹ Corresponding practices in digital networks, often automated and lacking transparency, also call for such scrutiny.¹⁶⁰

[iii] Limitations and Exceptions? Other Defenses?

Legislative style can be critical to delimiting rights. For example, the U.S. Copyright Act enumerates rights in a closed bundle, and it exempts fair use in open-ended terms.¹⁶¹ It may at times be difficult for a plaintiff to convince a U.S. court that infringement should be actionable in a media situation that the legislators did not

¹⁵³ See "United States," herein, at § 4[3][c].

¹⁵⁴ See "France," herein, at §§ 4[2], 4[3], and 7[4].

¹⁵⁵ See "Germany," herein, at §§ 4[2], 4[3], and 7[4].

¹⁵⁶ See §§ 6[2][c] and 6[3] *infra*.

¹⁵⁷ See § 2[1][c][ii] *supra*.

¹⁵⁸ See, e.g., the *GEMA/Austro-Mechana* decision, Oberster Gerichtshof (Supreme Court) (Austria), July 14, 1987, GRUR Int. 1988, 365, 368 (an exception illustrating the rule) (discussed in §§ 3[4][b][ii] and 6[2][a] *infra*).

¹⁵⁹ See, e.g., the *Verlegeranteil* (Publishers' Share) decision, BGH (Germany), April 21, 2016, GRUR 2016, 596, in English trans. in 48 I.I.C. 98 (2017) (barring collective-management procedures from forwarding authors' royalties to publishers) (also noted in § 6[2][a] *in fine infra*).

¹⁶⁰ See, generally, C. Cooke, *Dissecting The Digital Dollar*, pt. 1: 35–46 and pt. 2: 61–69 (Music Managers Forum, 2015), at <http://emuinsights.com/digitaldollar/> (analyzing how the sedimentation of contracts, oligopolistic players, "black box" effects, etc., obfuscate the bases and channeling of royalty shares).

¹⁶¹ See United States, Copyright Act, 17 U.S.C. §§ 106 and 107.

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anticipate or to which such elastic defenses arguably extend.¹⁶² By contrast, Continental European laws have traditionally conceptualized authors' rights flexibly, while detailing panoplies of specific exceptions.¹⁶³ It remains unclear to what extent E.U. harmonization precludes continuing recourse to this civil-law method within European copyright laws.¹⁶⁴

Defenses to copyright and related claims may arise out of sources other than copyright law itself. To start, as in every law suit, defenses may be based on often-entangled considerations of procedure or equity. For example, the U.S. Supreme Court refused to confirm that injunctions should be given as a matter of course, even when claims of intellectual property are vindicated.¹⁶⁵ Equitable defenses, strictly speaking creatures of the Anglo-American common law, may be available in the civil law, but counsel may find them lurking under different doctrinal labels and subject to diverse case-by-case analyses.¹⁶⁶ Further, criteria of proportionality may condition relief for copyright, especially in the face of defenses based on overriding human rights.¹⁶⁷ Finally, antitrust or competition law may, in some cases, constrain the overreaching assertion of copyright or related rights.¹⁶⁸

Human rights, notably freedom of expression, motivate some copyright limitations. For example, the idea/expression distinction, as well as doctrines of free utilization and

¹⁶² See, e.g., *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417 (1984) (holding no liability for home taping).

¹⁶³ See, e.g., Directive 2001/29/EC of the European Parliament and of the Council on the harmonization of certain aspects of copyright and related rights in the information society, Arts. 2–6, O.J. 2001 L 167 (following this model in harmonizing rights).

¹⁶⁴ See, e.g., *Svensson v. Retriever Sverige AB*, C.J.E.U., 4th ch., Feb. 13, 2014, Case C-466/12, paras. 36–41, [2014] E.C.D.R. 119 (reasoning that each harmonized right has its scope set within limits subject to E.U. construction) (further referenced in §§ 3[1][b][i][A] and 5[1][c][i] *infra*).

¹⁶⁵ *eBay, Inc. v. MercExchange*, 547 U.S. 388, 392–393 (2006) (in a patent case, but including copyright in its holding). See, e.g., *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578 n. 10 (1994) (opining that “the goals of the copyright law [. . .] are not always best served by automatically granting injunctive relief” but that courts may well limit themselves to “an award [. . .] for whatever infringement is found”).

¹⁶⁶ See, generally, J. Dufaux, “Equity and French Private Law,” in R.A. Newman (ed.), *Equity in the World's Legal Systems: A Comparative Study*, 245 (Bruylant, 1973) (explaining that common-law notions of equity often correspond in functions to general principles of the civil law, for example, that prohibiting abuse of right). See, e.g., the *Thumbnails I* decision, BGH (Germany), April 29, 2010, GRUR 2010, 628 (affirming the refusal to grant relief on grounds akin to equitable estoppel in a case where an author posted her art works online while optimizing hits, thus facilitating the reposting of her works).

¹⁶⁷ Compare *Scarlet Extended SA v. SABAM*, C.J.E.U., 3rd ch., Nov. 24, 2011, Case C-70/10, paras. 50–54, [2012] E.C.D.R. 54 (precluding any open-ended order to filter online contents that risked disproportionately impairing users' privacy or freedom of information), with *UPC Telekabel Wien GmbH v. Constantin Film Verleih GmbH*, C.J.E.U., 4th ch., March 27, 2014, Case C-314/12, paras. 55–57, 63–64, [2014] E.C.D.R. 166 (allowing an intermediary, though subject to court order, some discretion in compliance, albeit within specified parameters, including a procedure for users to challenge relief as impairing their interests).

¹⁶⁸ For examples, see “European Union,” herein, at § 3[2].

fair use, delimit actionable infringement.¹⁶⁹ Furthermore, human rights may justify departing from the conventional wisdom that specific copyright exceptions are to be construed narrowly: for example, in Germany, the publication of a play, though extensively quoting Brecht's plays, could not be enjoined because constitutionally assured "freedom of art" compelled applying the quotation exception liberally.¹⁷⁰ In other cases, freedom of expression may be invoked, *inter alia*, to focus infringement analysis more precisely and as a defense to monetary liability.¹⁷¹

What if technologically implemented copyright safeguards, like claimants' self-help or internet filters, impacted more than specific creations put to obviously illicit uses?¹⁷² Such measures might then risk skewing how networks systematically function and, in the process, threaten privacy, freedom of expression, or open communication.¹⁷³ Courts may then ask how to police such measures to have them proportionally protect copyright while complying with overriding limitations motivated by human rights.¹⁷⁴ As discussed below, such considerations may come to bear on choosing laws in cases of cross-border infringement.¹⁷⁵

[3] The Framework of International Treaties

To complete our framework of analysis, we need to step back in time briefly again. Initially national copyright laws could not fully protect authors and media interests in a marketplace that kept expanding to international dimensions. The accelerating globalization of the media soon made it imperative to assure copyright protection across borders. We shall here outline (a) the origins of such protection and (b) its basic principles.

[a] Historical Origins of the Framework

Copyright laws were hardly instituted before they proved inadequate. In the eighteenth century, books were smuggled across close European borders on pack

¹⁶⁹ For further analysis, see § 2[2][a][i] *supra*.

¹⁷⁰ The *Germania 3* decision, BVerfG (Germany), June 29, 2000, GRUR 2001, 149. *But see, e.g.*, the *Tank Man II* decision, Constitutional Court (Slovak Republic), Sept. 30, 2014, Case II US 647/2014, in English trans. in 46 I.I.C. 729 (2015) (rejecting a constitutional defense of freedom of expression, for an unconsented and non-creative use of a wrongly attributed photograph in news coverage, given ease of licensing and attribution).

¹⁷¹ *See, e.g.*, Cass., 1^e ch. civ. (France), May 15, 2015, P.I. 2015, 281, note A. Lucas, in English trans. in [2016] E.C.D.R. 81 (ruling that, to assess monetary liability, a court had to evaluate the creativity of plaintiff's photographs that had been recast in a painting, while weighing defenses of the artist's freedom of expression, as well as arguable parody).

¹⁷² On such technological enforcement measures, see § 2[1][c][ii] *supra*.

¹⁷³ For a pioneer analysis, see L. Solum and M. Chung, "The Layers Principle: Internet Architecture and the Law," 79 *Notre Dame L. Rev.* 815 (2004).

¹⁷⁴ For current analysis, see C. Geiger and E. Izyumenko, "The Role of Human Rights in Copyright Enforcement Online: Elaborating a Legal Framework for Website Blocking," *American Univ. International L. Rev.* 43 (2016).

¹⁷⁵ For further analysis and examples, see §§ 3[1][a][ii], 3[1][b][ii], 3[1][b][iii][B], and 3[1][b][iii][C] *infra*.

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animals.¹⁷⁶ In the nineteenth century, by clipper ship and soon enough by cable, English novels quickly crossed the Atlantic to be published in the United States without consent.¹⁷⁷ That century saw three types of responses to such commerce: the last, a multilateral-treaty regime, ultimately provided the current framework for copyright laws worldwide.

The first response, that of protecting only domestic works, bore traces of the media mercantilism of the sixteenth and seventeenth centuries. While it protected domestic authors, as well as their publishers and impresarios, it allowed pirates abroad to exploit foreign works freely on national territory. This response began to lose favor once media entrepreneurs began to understand that their interests lay in assuring consistent copyright protection upon which they could rely in ever-larger markets.¹⁷⁸ Furthermore, domestic authors and their publishers came to realize that they were placed at a disadvantage when they had to compete at home with cheaper pirate editions of foreign works on which no royalties had to be paid.¹⁷⁹

The second response, reciprocal protection between pairs of countries, started as truces in trade wars. For example, France, confronted with rampant Belgian piracy in the mid-nineteenth century, only agreed to a new overall commercial treaty with Belgium if the treaty guaranteed foreign authors' rights.¹⁸⁰ More generally, as that century proceeded, various pairs of countries granted each other *material reciprocity* as to copyright, in which one country extended only as much national protection to works from another country as received by its home works in that country. Some countries went on to grant each other *formal reciprocity*, in which national protection was granted to works from a given country if home works received some acceptable minimal level of protection in that country.¹⁸¹ This last type of reciprocity was soon to dominate in international copyright, but only after a period in the mid-nineteenth century during which most European countries entered into all sorts of bilateral arrangements that were subject to a variety of regimes.¹⁸²

¹⁷⁶ See R. Darnton, *The Literary Underground of the Old Regime*, 128–132, 183–184 (Harvard Univ. Press, 1982).

¹⁷⁷ See W. Briggs, *The Law of International Copyright*, 40–41 (Stevens & Haynes, 1906). See also A. Johns, *Piracy: The Intellectual Property Wars from Gutenberg to Gates*, 295–302 (Univ. of Chicago Press, 2009) (examining ever-faster reprinting technologies and publishers' responses).

¹⁷⁸ See, e.g., S. Ladas, *The International Protection of Literary and Artistic Property*, vol. 1, 27–28 (Macmillan, 1938) (noting that the French Decree of March 28, 1852, made piracy of even foreign works on French territory a crime, in order to discourage piracy generally by protecting works, French or foreign, in a market as large as France).

¹⁷⁹ For further historical analysis, see D. Saunders, *Authorship and Copyright*, chs. 6–7 *passim* (Routledge, 1992).

¹⁸⁰ See S. Ladas, *The International Protection of Literary and Artistic Property*, vol. 1, 25–26 (Macmillan, 1938).

¹⁸¹ For a nineteenth-century formulation, see W. Briggs, *The Law of International Copyright*, 131–136 (Stevens & Haynes, 1906).

¹⁸² See S. Ladas, *The International Protection of Literary and Artistic Property*, vol. 1, 44–67 (Macmillan, 1938).

The third response, multilateral protection, was far more thoroughgoing. It addressed a theoretical problem arising out of the premise: Copyright protects the fruits of one's most intimate labors.¹⁸³ Why not then allow foreign authors, as some courts did, to bring actions on home ground for infringement of domestic rights in their works, like any other tort suit for an invasion of one's property or person?¹⁸⁴ There were also the practical problems both of procedures to ascertain material reciprocity in cross-border cases and of elaborating a web of bilateral arrangements on that basis over the growing trading areas of the imperial European powers.¹⁸⁵ What if a number of countries were to enter an international convention assuring each other's nationals of comparable protection under each other's copyright laws at home, as well as in their colonies, of works originating within their respective jurisdictions? Given such formal reciprocity, enough countries could then supersede the currently cumbersome welter of bilateral arrangements with a global copyright regime.¹⁸⁶

In the course of the nineteenth century in Europe, the idea of a worldwide, multilateral copyright union began to take hold.¹⁸⁷ After decades of meetings and deliberations, initially between groups of authors and publishers and then at a diplomatic level, the Berne Convention finally constituted such a union in 1886. Protection was to be assured throughout the Berne Union according to simple principles, albeit with caveats that would be whittled away only partially in subsequent revisions.¹⁸⁸

[b] National Treatment and Minimum Rights

The Berne Convention has, since its inception in 1886, served as the matrix for the treaty regime in the field of copyright. This multilateral agreement, along with subsequent treaties, have provided for *national treatment* with regard to any qualifying work or production. Most crucially, each treaty country has to grant the author of any qualifying work the same treatment as it does to its own authors, subject only to exceptions the treaty text specifies.¹⁸⁹ Within each country adhering to a treaty, such

¹⁸³ For an overview of such foundational theories of copyright, see § 2[1][c][i] *supra*.

¹⁸⁴ Compare A.-C. Renouard, *Traité des droits d'auteurs* (Treatise on Copyright), vol. 2, 205–206 (Jules Renouard et Cie., 1839) (noting, at the start of the nineteenth century, French protection of foreign authors for their works first published in France), with R. Deazley, *Re-Thinking Copyright: History, Theory, Language*, ch. 3 (Edward Elgar, 2006) (explaining how, in the nineteenth century, U.K. courts sometimes invoked common-law copyright as a basis for protecting foreign works).

¹⁸⁵ On residual reciprocity arrangements and procedures, see § 3[2][c] *in fine infra*.

¹⁸⁶ See W. Briggs, *The Law of International Copyright*, 126–127 (Stevens & Haynes, 1906).

¹⁸⁷ For further analysis, see G. Boytha, "Fragen der Entstehung des international Urheberrechts" (Questions on the Emergence of International Copyright), in R. Dittrich (ed.), *Woher kommt das Urheberrecht und wohin geht es?* (Where does Copyright Come From and Where is it Going?), 181 (Manz, 1988).

¹⁸⁸ On the legal status of the Berne Union, see W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 10–11, 27–28 (Intro., Rems. 15–18; Berne Art. 1, Rem. 2) (Werner-Verlag, 1977).

¹⁸⁹ See H. Desbois, A. Françon, and A. Kéréver, *Les conventions internationales du droit d'auteur et*

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foreign claimants are now treated much the same way as domestic claimants. This solution has allowed for national flexibility, while tending to make copyright protection internationally reliable.¹⁹⁰

National treatment has been hedged with limited exceptions. On the one hand, some exceptions have complicated matters by cutting back on national treatment on a few key points. For example, under the rule of the shorter term, the protecting country may cut back its national term to that provided in the country of origin of the work at issue.¹⁹¹ On the other hand, altogether different types of exceptions have simplified matters by supplementing and harmonizing national laws. For example, at the start of the twentieth century, the Berne Convention eliminated national formalities, such as deposit or registration, as preconditions for protecting Berne works.¹⁹² Thus, Berne claimants no longer had to research and satisfy such formalities, an onerous task on a worldwide scale, before making works public within the Union.¹⁹³

At the time of the formation of the Berne Union, there was a concern to equalize levels of protection that, under national treatment, could vary from country to country. At the end of the nineteenth century, this concern gave rise to the movement to institute a “universal law of copyright” set forth in “a single code, binding throughout the world.”¹⁹⁴ Instead, starting with a modest translation right, which was in stages made unconditional, the Berne Convention called on adhering countries to provide ever-more comprehensive *minimum rights*.¹⁹⁵ Such rights now assure claimants of minimum terms of protection and of control worldwide, not only of reproduction and translation, but of various forms of communication to the public.¹⁹⁶ In principle, these rights only apply to any work or production eligible for protection outside its country of origin, providing a kind of floor for the protection of foreign treaty-qualifying matters.¹⁹⁷ Effectively, minimum rights have often been incorporated into members’ domestic laws outright, since it remains politically difficult to grant rights to foreigners but not to nationals.¹⁹⁸ As well, bridging varying copyright theories, Berne drafters, in

des droits voisins (The international conventions on copyright and neighboring rights), para. 8 (Daloz, 1976).

¹⁹⁰ See P.E. Geller, “Legal Transplants in International Copyright: Some Questions of Method,” 13 U.C.L.A. Pacific Basin L.J. 199 (1994).

¹⁹¹ On the rule of the shorter term, see § 5[2] *infra*. For the cut-back in the protection of design works, see § 4[1][c][i][A] *infra*.

¹⁹² On residual formalities in the international system, see § 5[3] *infra*.

¹⁹³ See S. Ladas, *The International Protection of Literary and Artistic Property*, vol. 1, 269–275 (Macmillan, 1938).

¹⁹⁴ W. Briggs, *The Law of International Copyright*, 162 (Stevens & Haynes, 1906).

¹⁹⁵ See H. Desbois, A. Françon, and A. Kéréver, *Les conventions internationales du droit d’auteur et des droits voisins*, paras. 10–37 *passim* (Daloz, 1976).

¹⁹⁶ For elaboration of Berne and other minimum rights, see § 5[4][a] *infra*.

¹⁹⁷ Berne, Art. V (1886), Art. 4(1) (Berlin, Rome, Brussels), Art. 5(1) (Paris).

¹⁹⁸ See S. Ladas, *The International Protection of Literary and Artistic Property*, vol. 1, 187–189 (Macmillan, 1938).

formulating minimum rights, have furnished common terms of a *lingua franca* for copyright practice.¹⁹⁹

The Berne Convention has thus served as the model for elaborating further treaties in the field.²⁰⁰ The Rome Convention was concluded in 1961 to assure neighboring rights in performances, sound recordings, and broadcasts. What we shall here call *sequel treaties* incorporated Berne and Rome provisions, while amplifying on their minimum rights. As part of the W.T.O. Agreement of 1994, the TRIPs Agreement at least tracked most Berne and Rome provisions, while filling in sundry gaps in the treaty regime for intellectual property, most notably with enforcement provisions.²⁰¹ Concluded in 1996, the WIPO “Internet” Treaties, on Berne and Rome models, introduced minimum rights *inter alia* to control online uses. Other treaties are being concluded to fill out this treaty regime.²⁰²

Professor Ernst Rabel said of law addressing cross-border cases: “It urgently requires sanctuaries from chaos.”²⁰³ In the field of copyright, the Berne Union served that function for over a century, but less and less systematically. Most European countries now follow the lead of the European Union in governing their copyright relations *inter se*; trade fora may hear disputes between or with jurisdictions.²⁰⁴ Increasingly, the building blocks of the Berne-plus treaty regime, territorial nation-states, have had their borders made porous, and their laws undercut, by digitally networked media. Still, pending some new transterritorial dispensation, we have only the Berne-plus regime as our default framework of global analysis.²⁰⁵

§ 3 What Grounds Exist for Protection Abroad?

[1] Under What Laws May Protection be Adjudicated?

In a cross-border case, a work or related production, arising in one country, is disseminated without authorization into another country or more globally.¹ Here we have to ask: (a) Which copyright law or laws, or other laws, may apply to ensuing

¹⁹⁹ On the need for a common set of terms to characterize claims internationally, see § 1[3][b] *supra*.

²⁰⁰ On the impact of this regime on the choice of law in cross-border copyright cases, see § 1[3][c] *supra* and § 3[1][a][i] *infra*.

²⁰¹ On how TRIPs compliance may be tested in the W.T.O. forum, see § 5[5][b][ii] *infra*.

²⁰² On the Marrakesh VIP Treaty, see § 5[4][a][i][B] *in fine infra*.

²⁰³ E. Rabel, *The Conflict of Laws: A Comparative Study*, vol. 1, 97 (Univ. of Michigan Press, 2d ed., 1958).

²⁰⁴ See, respectively, §§ 3[3][a][ii][A] and 5[1][c] *infra* (E.U. relations); §§ 3[3][a][iii] and 5[5] *infra* (trade disputes).

²⁰⁵ Compare H.G. Ruse-Khan, *The Protection of Intellectual Property in International Law*, ch. 14 *passim* (Oxford Univ. Press, 2016) (analyzing this regime in the context of public international law), with P.E. Geller, “Rethinking the Berne-Plus Framework: From Conflicts of Laws to Copyright Reform,” [2009] E.I.P.R. 391 (showing how this regime guides reform in response to ever-more frequent private cases subject to conflicts of laws).

¹ For strict definitions of such cases and of underlying notions, see § 1[1] *supra*.

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claims? (b) Where to seek protection, and how to take account of applicable laws in disposing of the case? Subsections following this one will outline grounds on which to base protection abroad.²

[a] Which Laws Apply to Cross-Border Infringement?

In such cross-border cases, one or many copyright laws may govern infringement claims.³ Other types of laws may also come into play, for example, those of privacy or freedom of expression. At the threshold, distinct questions then arise: (i) How far should the Berne-plus treaty regime constrain the choice of copyright laws? Or may other approaches, allowing courts greater discretion to resolve conflicts of copyright laws, be followed as to infringement claims? (ii) What other choice-of-law approaches may guide applying other types of laws, notably as bases for defenses?⁴

[i] Copyright Laws of Protecting Countries? Or Else?

To clarify our default position here, start with a purely local case, only to turn quickly to cross-border cases. Suppose that a national of a given country sues on a domestic claim in a local court, to wit, for infringement at home of her copyright in a work she authored and first published in her own country. By hypothesis, this country is, at the same time, the forum country for suit, the protecting country where infringement allegedly takes place, and the country of origin of the work at issue. The home court would quite simply apply home copyright law to this domestic claim, anticipating the treaty principle of national treatment, which is decisive for most issues that foreign works raise.⁵

Now switch to cross-border cases of concern to us here. A work arises in one country, only to end up accessible in others without authorization. A court, taking our cross-border case, should ask: Which copyright law or laws should it choose to govern any infringement at issue? The Berne-plus treaty regime now obligates almost all countries to accord national treatment to a foreign author's qualifying work, subject only to specified exceptions.⁶ For example, pursuant to that principle, China has to treat a French author of a protected work like a Chinese author as to copyright in China, and France has to treat a Chinese author like a French author in France. Thus, the treaty principle of national treatment, focusing on the condition of foreign nationals, entails the default approach at one pole of the choice-of-law spectrum in the field of copyright: apply the law of the country where protection is sought, *lex loci*

² For domestic and treaty grounds for protection, see, respectively, §§ 3[2] and 3[3] *infra*; on interpreting such grounds, § 3[4] *infra*.

³ Remuneration may in some cases be claimed under legally imposed license schemes, notionally replacing infringement awards. See § 3[1][b][i][A] *in fine infra*.

⁴ On laws applicable to the vesting and transfers of, and thus to worldwide chain-of-title to, rights respectively exercisable in different countries, see §§ 6[2] and 6[3] *infra*.

⁵ Compare Berne, Art. 5(3) (Paris) ("Protection in the country of origin is governed by domestic law."), with *id.*, Art. 5(1) (national treatment, subject to specified exceptions).

⁶ For the requisites for such qualification, see § 4 *infra*; for the extent of ensuing national treatment, § 5 *infra*.

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protectionis.⁷ From this point on, increasing latitude would be allowed courts in choosing copyright laws, as any of the more open-ended approaches, proposed along the choice-of-law spectrum, were followed.⁸ For example, given multiple laws arguably applicable to a case, some academics look to the law of the country with the “closest” connection to the case.⁹ This connection could turn on some discretionary mix of factors: the *situs* of the parties, of this or that act along the path of infringement, etc.¹⁰

A more complex hypothetical will illustrate how national treatment could be undercut as a court shifted from the one choice-of-law approach to the other. Imagine a U.S. national who creatively improvises a mime work as she performs it live in the United States, but without fixing it, say, by scoring it on paper. Imagine, too, that, without her consent, a U.S. national in her audience records her work as performed and, via a U.S. internet service, posts the recording online.¹¹ Such potentially infringing acts are not limited to the United States in that the posting makes the work available to members of the public in many countries at once. In this case, quite different results could ensue if the court followed one or the other of the choice-of-law approaches which we just broached as falling at opposite poles of a spectrum. Unavoidably, if the laws of protecting countries applied, the court could have hundreds of laws, at least those of receiving countries worldwide, among which to choose to govern infringement.¹² But what if, to consider the alternative, the court merely applied the law of the country with which the conduct at issue in our case seems to have the purportedly closest connection? There are only U.S. parties, and the creation of the work, as well as its recording and posting online without consent, occurred within the United States. If only U.S. law governed our mime’s suit, her work would not be protected at all by full copyright for lack of fixation in “any tangible medium”

⁷ See E. Ulmer, *Intellectual Property Rights and the Conflict of Laws*, 6–14 (English trans., Kluwer, 1978); S.J. Schaafsma, “The hidden conflict-of-law-rule in the Berne and Paris principle of national treatment,” in A. Kamperman Sanders (ed.), *The Principle of National Treatment in International Economic Law*, 300 (Edward Elgar, 2014).

⁸ See, e.g., F. Dessemontet, “Internet, le droit d’auteur et le droit international privé” (Internet, Copyright, and Conflicts of Laws), *Revue suisse de jurisprudence* 1996, 285, at 291–292 (proposing “cascading” alternative choice-of-law rules, each applying according to specified conditions that, in the aggregate, determine which rule is favored over others).

⁹ See American Law Institute, *Intellectual Property: Principles Governing Jurisdiction, Choice of Law, and Judgments in Transnational Disputes*, § 321 (2007); European Max-Planck-Group for Conflict of Laws in Intellectual Property (CLIP), *Principles for Conflict of Laws in Intellectual Property*, Art. 3:603 (Dec. 1, 2011).

¹⁰ This writer has characterized any such discretionary approach as leading to “choice-of-law roulette”: P.E. Geller, “Rethinking the Berne-Plus Framework: From Conflicts of Laws to Copyright Reform,” [2009] E.I.P.R. 391, at 392.

¹¹ This hypothetical was introduced above to illustrate characterization in cross-border cases: § 1[3][b] *supra*. It is elaborated below: §§ 3[1][b][i][B] and 3[1][b][iii][B] *infra*.

¹² Depending on the case and relief sought, fewer laws may be dispositive. Compare § 3[1][b][ii][B] *infra* (injunctive orders), with § 3[1][b][iii][C] *infra* (monetary awards).

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with due consent.¹³ By contrast, most other Berne countries, where this work is accessible without consent, grant full authors' rights in unfixed but creatively improvised works.¹⁴ Applying only U.S. copyright law to our case would impermissibly strip the U.S. claimant of rights otherwise hers under treaty-required national treatment.¹⁵

Does the Berne-plus treaty regime indeed constrain choice of law here?¹⁶ Recall the default case that this regime initially addresses: infringement of some right in a qualifying foreign work or production inside the forum state.¹⁷ Article 5 of the Berne Convention, or any comparable treaty provision, then imposes national treatment, so that logically it would lead to applying domestic copyright law, subject only to caveats irrelevant for our analysis here, but discussed below.¹⁸ Now complicate our case: infringement partially or altogether arises outside the territory of the forum state, as in the foregoing hypothetical of internet access to a U.S. work potentially worldwide. As stressed at the outset above, courts best take account of globally overriding considerations in defusing or deciding conflicts of laws that endemically arise in cross-border cases.¹⁹ In the field of copyright, the Berne-plus regime constitutes the global system of law, effectively its *ordre public international*: hence the source of its compelling public policy. Imposing the principle of national treatment, this regime favors applying the copyright or related laws of protecting countries, respectively, to cross-border infringement.²⁰ Thus, the Berne-plus regime, even if not binding on a

¹³ See United States, Copyright Act, 17 U.S.C. § 101 (definition of "fixed") and § 102(a) (conditioning protection on fixation of the work at issue in some medium "now known or later developed").

¹⁴ See, generally, § 2[2][a][i] *supra* (historically and comparatively considering the fixation requirement) and § 4[1][a] *infra* (indicating treaty parameters on point). See, e.g., the *David Copperfield* decision, CA Paris, 3e ch. (France), Dec. 20, 1996, RIDA 1997, no. 173, 351, at 355–356 (protecting a U.S. magician's act by French author's rights, without calling for fixation).

¹⁵ For the treaty origin and function of national treatment, see § 2[3][b] *supra*.

¹⁶ *N.b.* the legal order of a country determines how treaty obligations come into play there. See § 3[2][a] *infra*.

¹⁷ For further analysis, see J. Blomqvist, *Primer on International Copyright and Related Rights*, 47–50 (Edward Elgar, 2014); J. Fawcett and P. Torremans, *Intellectual Property and Private International Law*, ch. 12 (Oxford Univ. Press, 2d ed., 2011).

¹⁸ Copyright treaties may allow for exceptions either cutting back or bolstering national treatment, but without changing the analysis set out here. See §§ 4[1][c][i][A], 5[2], and 5[4] *infra*. A key Berne exception, the rule of the shorter term cutting back on national treatment, reconfirms that applicable law remains "the legislation of the country where protection is claimed." See §§ 5[2] and 5[3][a][i] *infra*. In addition, other exceptions, bolstering national treatment with minimum rights, avoid conflicts of laws by rendering applicable laws more uniform. See § 5[4][a][i] *infra*. Where the work at issue originates in the protecting country, only that country's copyright law applies. See § 5[4][a][ii] *infra*.

¹⁹ See § 1[3][c] *supra*.

²⁰ National treatment also sets aside the option of *renvoi*, in that it leads to applying only the substantive copyright law of the protecting country to infringement issues, not any choice-of-law rule in such law. See J. Blomqvist, *Primer on International Copyright and Related Rights*, 49–50 (Edward Elgar, 2014); J. Fawcett and P. Torremans, *Intellectual Property and Private International Law*, 678–679 (Oxford Univ. Press, 2d ed., 2011).

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court adjudicating infringement abroad, should still control its choice of copyright laws in cross-border cases.²¹ We shall soon see courts follow this treaty-bound choice-of-law approach, thus minimizing shopping for other fora that might try more opportunistic approaches.²² At the same time, we shall see how this default approach minimizes spillovers of copyright laws beyond territories where they were intended to apply.²³

[ii] How May Other Types of Laws Come into Play?

In cases of cross-border infringement, as we just argued, the Berne-plus treaty regime may constrain the choice of applicable copyright laws.²⁴ In these and other cases, conflicts between such laws may at times be complicated by the interplay with other types of laws that are subject to different choice-of-law approaches. To start, as we shall repeatedly see, regionally, most notably in the European Union, supranational law may override purely national copyright laws on a growing range of issues.²⁵ Further, as we have already indicated, copyright claims may encounter distinct types of defenses: some may be based on laws of human rights, with their own choice-of-law approaches.²⁶ Finally, toward the end of this chapter, we shall analyze still further tensions with laws concerning the ownership and transfer of rights effective abroad and, thus, chain of title worldwide.²⁷

Focus on an action where a copyright claim comes into play with another type of law. At such a juncture, as already noted, issue analysis or *dépeçage* has to sort out distinct questions:²⁸ On the one hand, are the laws invoked dispositive of the same or different issues, say, liability for infringement, as distinct from duties under a contract? On the other hand, assuming that the laws invoked would be dispositive of the same issue, is any choice of relevant law subject to the same or different conflicts regimes?

²¹ See, e.g., *London Film Productions Ltd. v. Intercontinental Communications, Inc.*, 580 F. Supp. 47 (S.D.N.Y. 1984) (U.S.) (contemplating Berne national treatment in a case of infringement taking place in Latin American countries belonging to the Berne Union, though the United States was not a Berne country at the time of the suit) (discussed in § 6[1][b][ii] *infra*); also *Subafilms, Ltd. v. MGM-Pathe Communications Co.*, 24 F.3d 1088, 1094–1098 (9th Cir. 1994) (en banc) (U.S.) (invoking interests in respecting the “international regime” in its conflicts analysis) (discussed in § 3[1][b][ii][C] *infra*).

²² See, generally, F.K. Juenger, “Forum Shopping, Domestic and International,” 63 *Tulane L. Rev.* 553, 559–574 *passim* (1989) (after noting that “the very purpose of the classical conflicts system was the prevention of forum shopping,” assessing how varying choice-of-law approaches, among other circumstances, forestall or prompt forum shopping).

²³ See § 3[1][b][i][B] *infra*.

²⁴ See § 3[1][a][i] *supra*.

²⁵ See, e.g., § 3[1][b][iii][A] *in fine infra* (E.U. law nominally favors source-country law in some E.U. cases); § 3[3][a][ii][A] *infra* (E.U. principle of non-discrimination as to laws governing claims of E.U. nationals); § 5[1][c] *infra* (E.U. legal order between treaties and member states); § 6[3][b][ii] *infra* (E.U. mandatory rules trump some contractual rules).

²⁶ See § 2[2][b][iii] *supra*.

²⁷ See §§ 6[2] and 6[3] *infra*.

²⁸ See §§ 1[3][b] and 1[3][c] *supra*.

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For example, in a case where the work at issue is recast, may copyright claims, notably to control any ensuing derivative work, be countered by defenses drawn from the law of privacy or freedom of expression? In particular, copyright, at least considered as a bundle of economic rights, may be doctrinally distinguished from privacy rights or from freedom of expression, often considered as personality or even human rights.²⁹ Ultimately, different choice-of-law approaches may be appropriate for these diverse types of laws: while copyright laws have long been chosen in the light of the Berne-plus treaty regime, privacy rights or freedom of expression are not subject to any similarly crystallized international regime.³⁰ In cases where such personality or human rights are invoked, many approaches pull the choice of law, if not toward the law of the place of the harm, then toward the law of the claimant's home state.³¹ Regional laws and international treaties are also more or less silent with regard to ordering copyright and these other types of laws, often of constitutional significance.³²

What if there is no international system or *ordre public international* encompassing all the diverse types of laws in tension in a case? As suggested at the outset, a court has tools to resolve the issue or case at hand, for example, by finding only one state with decisive interests in applying its laws or by fashioning relief to defuse conflicts of laws.³³ We can here only anticipate differences among some of such solutions with the misleadingly static metaphor of horizontal as opposed to vertical dimensions of the usually dynamic interplay among the laws in question. In cases of cross-border infringement, copyright laws from different countries may conflict horizontally, so to speak, insofar as they are all the same type of laws, none "higher" than another to the extent that no overriding regime or compelling public policy gives any of them arguable precedence. The same metaphor may help to understand the tensions between copyright laws and laws governing transfers of copyrights, both types of laws being originally and largely instituted by specific states for local private transactions.³⁴ By contrast, copyright laws may conflict vertically with privacy laws or constitutionally imposed freedom of expression that tend to represent "higher" law or more compelling

²⁹ See S. Warren and L. Brandeis, "The Right to Privacy," 4 Harvard L. Rev. 193 (1890); F. Rigaux, "La liberté de la vie privée" (Right to privacy), Rev. Internationale de Droit Comparé, 1991, 539.

³⁰ For further analysis, see L. Helfer and G. Austin, *Human Rights and Intellectual Property: Mapping the Global Interface*, ch. 1 (Cambridge U. Press, 2011).

³¹ See, e.g., Switzerland, Loi fédérale sur le droit international privé du 18 décembre 1987 [LDIP] (Federal Law on Jurisdiction and Choice of Law of Dec. 18, 1987), Art. 139.1(a) (applying, at the victim's choice, the law of the country of his or her residence to torts violating personality rights and foreseeably causing harm there).

³² Compare Regulation (EC) no. 864/2007 of the European Parliament and of the Council of 11 July 2007 on the law applicable to non-contractual obligations (Rome II), Art. 1.2(g), O.J. 2007 L 199, 40 (excluding from its own scope such conflicts of laws as apply to claims of "privacy and rights relating to personality, including defamation"), with the European Convention on Human Rights (4 Nov. 1950), Arts. 8–10 (in Europe, a source of law for arguments in hard cases such as broached here).

³³ See § 1[3][c] *in fine supra*.

³⁴ See, e.g., § 6[3][c][i] *infra* (laying out parameters for sorting out false from true conflicts between copyright and contract laws).

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policies that may weigh heavily on case-by-case solutions.³⁵ Note that our metaphor here of spatial dimensions may take on somewhat different meanings within federations, like the United States, and within the E.U. legal order.³⁶

[b] How to Dispose of Conflicts of Laws in Infringement Cases?

What laws govern cross-border cases of copyright infringement? To begin to solve this problem, we propose to ask: (i) Where does infringement colorably take place, and which laws arguably apply to it? As inquiry proceeds, it sometimes becomes possible to reach simple solutions for complex conflicts of laws case by case. To this end, we shall (ii) focus on choosing laws crucial for tailoring remedies within a global perspective and (iii) apply this method to cross-border telecommunication, notably online.

[i] How to Localize Infringement in Cross-Border Cases?

At the threshold of a cross-border case, we urge counsel for any copyright claimant to trace out all colorably infringing courses of conduct on a world map. This mapping exercise will help to locate factors evidencing how closely such cross-border conduct is connected to countries whose laws may be argued to apply to it. We shall here explain (A) how to follow out conduct worldwide as it tends to trigger liability under copyright laws from country to country and (B) how to localize acts insofar as they serve as connecting factors that call for applying specific laws.

[A] Map Colorably Infringing Conduct Worldwide!

It has become harder to localize copyright-relevant acts as the media have progressed. In the past, within a patchwork of national markets, courts easily spotted where copies crossed borders to be sold in another country or where performances were staged there.³⁷ With increasingly networked media, protected materials are so rapidly and broadly disseminated across borders that acts can call for relief in many places in rapid succession or all at once. We propose this pair of guidelines for any claimant at the threshold of an apparently cross-border case: First, map any colorably infringing course of conduct worldwide; second, consider pleading the copyright laws

³⁵ See, e.g., § 3[1][b][iii][C] *infra* (a hypothetical case providing a paradigm for resolving such tensions case by case). See also the *Metall auf Metall* decision, BVerfG (Germany), May 31, 2016, GRUR 2016, 690, in English trans. in 48 I.I.C. 343 (2017) (outlining the dimensions of the interplay between German copyright and constitutional laws, as well as with relevant E.U. laws, while directing courts to liberalize the conditions for sampling and remixing recorded sounds otherwise protected by copyright-related rights).

³⁶ Compare A. Colangelo, "Absolute Conflicts of Law," 91 *Indiana L.J.* 719, 754–766 *passim* (2016) (illustrating dimensions of hard cases of conflicts from a U.S. perspective), with C. Joerges, P. Kjaer, and T. Ralli, "A New Type of Conflicts Law as Constitutional Form in the Postnational Constellation," 2 *Transnational Legal Theory* 153, 155–156 (2011) (also unpacking the "diagonal" dimension of E.U. conflicts and giving further cites).

³⁷ For a pioneer analysis, see A. Troller, *Das internationale Privat- und Zivilprozeßrecht im gewerblichen Rechtsschutz und Urheberrecht* (Private International Law and Procedure in Industrial Property and Copyright), 31–34 (Verlag für Recht und Gesellschaft, 1952).

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of countries such conduct might impact. As suit proceeds, the court may need to be properly shown, if need be with expert testimony, how foreign laws may apply to the case.³⁸

A U.S. case is illustrative. The Los Angeles News Service took videos of local riots in 1992.³⁹ The videos were transmitted to New York news agencies which, without authorization, copied them there and retransmitted them abroad, most notably for televising in Europe. Only U.S. law was invoked in the pleadings, and the trial court, after finding unauthorized copies made in New York infringing under U.S. law, suggested that retransmission was only infringing upon reception abroad.⁴⁰ The trial court's decision to refuse actual damages for foreign exploitation, upon claimant's failure to plead foreign law, was ultimately affirmed.⁴¹ Had the claimant here mapped out the entire course of conduct at issue, it would have been prompted to plead the laws effective in countries of reception abroad. It would have thus avoided reducing its options for obtaining monetary awards.⁴²

How to spot where conduct, once mapped as crossing borders, may be infringing under law or laws abroad? As already explained, different laws may variously disentangle works protected by copyright from productions protected only by neighboring or other copyright-related rights.⁴³ Return to the news video at issue in the *Los Angeles News* case: depending on whether it is found to constitute a creative work or else a mere recording of events, one country's law may protect it by copyright, and another's only by a narrower copyright-related right, if at all. More generally, in some countries, media or data productions may be protected by such related or *sui generis* rights, if at all; in other countries, such contents may be protected only by tort claims, albeit with weaker relief.⁴⁴ Furthermore, copyright and such related rights may be available in foreign works and productions on quite different conditions. Thus, on the

³⁸ A comparable rule of thumb is advisably followed when initially vested and contractual entitlements to foreign copyrights or related rights are at issue: plead and show all relevant copyright-vesting and transfer laws pertinent along any chain of title across borders. See §§ 6[2] and 6[3] *infra*.

³⁹ *Los Angeles News Service v. Reuters Television Internat'l*, 942 F. Supp. 1265, 1269–1271 (C.D. Cal. 1996).

⁴⁰ *Id.* at 1269 (stating that the plaintiff “can seek a remedy [. . .] under the applicable foreign law” for televising the videos abroad, notably in Europe).

⁴¹ *Los Angeles News Service v. Reuters Television Internat'l*, 340 F.3d 926 (9th Cir. 2003), *qualifying* 149 F.3d 987 (9th Cir. 1998), *cert. denied*, 525 U.S. 1141 (1999).

⁴² Why, in this case, did the holdings vacillate so? At the start of the case, the trial court followed a newer U.S. precedent on point: *Subafilms, Ltd. v. MGM-Pathe Communications Co.*, 24 F.3d 1088, 1094–1099 (9th Cir. 1994) (en banc) (discussed § 3[1][b][ii][C] *infra*). The appellate court harkened back to an older U.S. precedent and then retrenched on this precedent: *Sheldon v. Metro-Goldwyn Pictures Corp.*, 106 F.2d 45, 52 (2d Cir. 1939) (critiqued § 3[1][b][ii][C] *infra*).

⁴³ See § 2[2][a] *supra*.

⁴⁴ For further analysis, see § 2[2][a][ii] *supra* and § 4[1][c][iii] *infra*.

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margins of copyright, subject matters may variously be protected in different countries.⁴⁵

In addition, for quite different reasons, rights may diverge in nature and scope from country to country, along the path of colorably infringing conduct.⁴⁶ Start with the distribution right that we may see “exhausted” upon the initial sale or comparable disposition of any copy or other embodiment of protected contents. Under most laws, with local variations, this right may no longer be asserted in such an item already licitly marketed on national territory; in regional cases, it may be unavailable after such disposition anywhere in a larger area, notably within the European internal market; in some cases, it is ineffective for the item upon its licit sale anywhere in the world.⁴⁷ To complicate matters further, different laws need not fully converge in providing rights in works or related productions as they are conveyed by telecommunication networks, occasionally subjecting such transactions to the distribution right, exhausted in some cases but not in others.⁴⁸ Under E.U. law at least, a work or related production openly posted online may be freely recommunicated, notably via linking otherwise deemed to make such protected matters accessible to the public.⁴⁹ We shall later outline how rights of communication, or of making available to members of the public online, may be diversely violated, or not, in the course of cross-border transmissions.⁵⁰

Finally, as already noted, the panoply of exceptions and limitations to copyright and related rights may be differently formulated from country to country.⁵¹ Thus, even where a given act is ostensibly infringing under the laws of many countries, it has to be asked what defenses may apply in each specific country. We can only schematically touch on such complex variations here: fair use is statutorily recognized in the United States, as well as in an increasing number of other countries, while narrower

⁴⁵ Designs and sound recordings are notable examples. For further analysis, see, respectively, §§ 4[1][c][i][A] and 4[1][c][iii][A] *infra*.

⁴⁶ On the varying scope of national rights, see § 2[2][b] *supra*. On minimum treaty rights, limiting such variation of rights, see § 5[4][a] *infra*.

⁴⁷ For further analysis, see R. Hilty, “ ‘Exhaustion’ in the Digital Age,” in I. Calboli and E. Lee (eds.), *Research Handbook on Intellectual Property Exhaustion and Parallel Imports*, 64 (Edward Elgar, 2016); S. Ghosh, *The Implementation of Exhaustion Policies: Lessons from National Experiences*, Issue Paper 40 (ICTSD, 2013), at <http://www.ictsd.org/downloads/2014/01/the-implementation-of-exhaustion-policies.pdf>.

⁴⁸ *Compare* *UsedSoft GmbH v. Oracle International Corp.*, C.J.E.U., Grand ch., July 3, 2012, Case C-128/11, [2012] E.C.D.R. 368 (holding licensed downloads of software for payment to exhaust the distribution right) (as discussed in § 2[2][b][i] *in fine supra*), with *Capitol Records, LLC v. ReDigi, Inc.*, 934 F. Supp. 2d 640, 651, 654–656 (S.D.N.Y. 2013) (U.S.) (finding the first-sale defense inapplicable to files generated by illicit reproduction and then marketed online).

⁴⁹ See *Svensson v. Retriever Sverige AB*, C.J.E.U., 4th ch., Feb. 13, 2014, Case C-466/12, paras. 26–28, [2014] E.C.D.R. 119 (further referenced in § 2[2][b][iii] *supra* and § 5[1][c][i] *infra*).

⁵⁰ See § 3[1][b][iii] *infra*.

⁵¹ See § 2[2][b][iii] *supra*.

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exceptions take on miscellaneous sizes and shapes worldwide.⁵² In addition, otherwise exempted uses, such as private copying and the public broadcasting of recordings, may be subject to legally imposed license schemes, triggering liability for remuneration in some countries, but not in others. There is also a growing trend in some jurisdictions to construe certain copyright limitations or exceptions broadly when privacy or freedom of expression would risk being impaired.⁵³

[B] What Connecting Factors Make Laws Applicable?

How to move from mapping colorably infringing conduct to choosing laws on which to base relief? Courts and commentators often speak of *connecting factors* that, once localized in a country, call for applying this or that law to a specific issue in a case.⁵⁴ Think back to the spectrum of approaches to choosing laws in the field of copyright: the treaty-bound approach posits the connecting factor of an infringing act; more open-ended approaches allow for volatile mixes of this and other connecting factors.⁵⁵ All such approaches, however, come up against the question: Where, along any course of allegedly infringing conduct crossing borders, to localize connecting factors that lead to choosing laws of diverse countries coherently? As illustrated below, distinct options lie in looking to factors at the source of any conduct at issue, in the so-called country of origin, on the one hand, and to factors where conduct ultimately threatens or results in prejudice, on the other.⁵⁶ We shall here consider how, in theory, to localize such factors while fashioning copyright relief consonant with different states' interests at stake in the cases. Counsel seeking concrete paradigms for copyright practice are referred to the analyses that immediately follow here.⁵⁷ Factors for the choice of laws outside our field, but relevant in some copyright cases, will also be broached.⁵⁸

We shall argue that any connecting factor for applying a country's copyright law may be best found in an imminently or actually *completed act* of infringement in that country.⁵⁹ This criterion calls for localizing conduct insofar as it generates objective risks of actionable harm within specific markets or audiences, without considering any subjective intention, specifically to exploit a market or to address an audience. Return

⁵² For differing patterns of laws on point, see national chapters herein, at § 8[2].

⁵³ For an illustrative analysis in cross-border cases, see § 3[1][b][iii][C] *infra*.

⁵⁴ These factors are to be distinguished from those satisfying eligibility criteria for protecting foreign works or productions, as discussed in § 4[2] *infra*.

⁵⁵ See § 3[1][a][i] *supra*.

⁵⁶ See, e.g., § 3[1][b][iii][A] *in fine infra* (noting that, while specific E.U.-wide laws may call for applying laws of countries where the conduct at issue originates to cross-border cases, they may have monetary awards assessed pursuant to laws of countries of reception).

⁵⁷ See §§ 3[1][b][ii] and 3[1][b][iii] *infra*.

⁵⁸ See, e.g., § 3[1][b][iii][C] *infra* (illustrating authors' claims versus users who are themselves creators with privacy interests); § 6[3][c][i] *infra* (sorting out authors' and entrepreneurs' copyright and contractual claims).

⁵⁹ *N.b.* this factor is proposed here purely for choice-of-law, not jurisdictional, purposes. *But see* § 6[1] *infra* (outlining criteria for taking jurisdiction in cross-border copyright cases).

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to our imaginary case of the mime work which a U.S. national improvises live in the United States: she finds her work recorded and posted online by a U.S. party, via a U.S. internet service, for access worldwide, all without her consent.⁶⁰ While such unauthorized U.S. recording and posting unleashes access to the mime's work in other countries worldwide, it may leave her with no basis for relief for copyright as such under U.S. law, given her failure to fix her work as required by that law.⁶¹ We propose to tie the choice of law to connecting factors that are comprised of infringing acts insofar as these are imminently or actually completed: in our hypothetical, these factors arise in many countries, everywhere the mime's work could be enjoyed, risking or causing harm to her potential market or audience.⁶² Turn to cases of hard copies: even given copies or offers conveyed from one country to another, infringement would be best localized only in that other country whose market or audience was likely to be prejudiced.⁶³ By contrast, where instances of a work or production display little chance of causing actionable harm, reception in a given country need not lead to the application of local law.⁶⁴

As already explained at the outset here, any choice-of-law approach may be justified insofar as it helps courts to realize interests that diverse states functionally have at stake in any given type of cross-border case.⁶⁵ In that light, it is here argued, the selection of the law of the protecting country, *lex loci protectionis*, should optimally lead to applying the copyright law effective where damages or undue profits might or do arise, namely *lex loci damni*.⁶⁶ To focus our argument, suppose conduct incoming relative to a country in that it potentially or actually impacts this country's market or

⁶⁰ For analyses of this hypothetical in somewhat different contexts, see §§ 1[3][b] and 3[1][a][i] *supra* and § 3[1][b][iii][B] *infra*.

⁶¹ See United States, Copyright Act, 17 U.S.C. § 101 (definition of "fixed") and § 102(a) (conditioning protection on fixation of the work at issue in some medium "now known or later developed"). *N.b.* fixation is not typically required of works as protected in most copyright laws. See § 2[2][a][i] *supra*.

⁶² See, e.g., *Cartier International AG v. British Sky Broadcasting Ltd.*, [2016] EWCA Civ 658, paras. 95–97 (U.K.) (reasoning that network intermediaries' acts were completed, not on any upload of challenged contents, but on providing access to these contents and thus risking reception in the U.K. market).

⁶³ Compare *Luar Music Corp. v. Universal Music Group, Inc.*, 861 F. Supp. 2d 30, 39–40 (D.P.R. 2012) (U.S.) (without any illicit copy made or distributed within the United States, but rather only a work emailed to and exploited within Mexico, rejecting an action for infringement of U.S. copyright), with *Dimensione Direct Sales Srl v. Knoll International SpA*, C.J.E.U., 4th ch., May 13, 2015, Case C-516/13, paras. 29–35, [2015] E.C.D.R. 223 (holding that advertising in German, characterized as offers and soliciting purchases from Italy for delivery in the German market, may infringe the German distribution right).

⁶⁴ See, e.g., *Design Data Corp. v. Unigate Enterprise, Inc.*, No. 14-16701 (9th Cir., Feb. 9, 2017) (allowing a claim for a download of software in the United States, assuming enough U.S. impact to infringe U.S. copyright, but rejecting a claim for importing, from China, software outputs of infringing software that, under U.S. law, were not infringing).

⁶⁵ See § 1[3][c] *supra*.

⁶⁶ *N.b.*, in the field of copyright, we shall speak of *undue profits* arising from the illicit use of the protected core of a work or related production.

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audience: to that extent this country has state interests in having its own copyright law enforced in the case. Otherwise, if conduct outgoing relative to that country, leaving its home market or audience untouched, led to applying its law to acts abroad, policies motivating its law could unnecessarily spill over beyond its borders into other jurisdictions. We can here only broach state interests typically at stake in copyright cases, such as enhancing creation, promoting the dissemination of resulting works and related productions via the media, and optimizing their enjoyment and feedback by users. Such interests are most crucially realized by law as policy goals when creations hit the marketplace and audience of a given country. Hence the rationale for applying the copyright law effective there, where indeed remedies will take effect.⁶⁷

Consider distinct types of cases in which laws, varying considerably from country to country, risk entering acute conflicts. On the one hand, imagine that a European producer of a database sued a U.S. party who had misappropriated significant contents from its database and sold access to these contents online and thus potentially worldwide. If the court indiscriminately applied only an E.U. database law to the entire case, indeed to access worldwide, it could justify granting more protection to data than U.S. and many other laws would provide at home, given their legislative decisions declining to protect mere database contents outside any creative compilation.⁶⁸ However, applying the database laws of E.U. member states only where access was threatened or took place in these states, a court would apply such law only in countries whose interests had ostensibly motivated instituting the law.⁶⁹ On the other hand, it would be inappropriate to impose stronger moral rights of one country on acts affecting the audience for a work in another country with weaker moral rights.⁷⁰ For example, no German moral right applied to the failure to name the author of a work painted on a piece of the Berlin Wall gifted to the United Nations in New York City.⁷¹

⁶⁷ For state interests at stake in the formation of the Berne-plus treaty regime, see § 2[3] *supra*; for their recapitulation for purposes of guiding choice of law and fashioning relief, § 3[1][b][ii][A] *infra*.

⁶⁸ *But see* § 4[1][c][iii] *infra* (noting differing data-protection regimes in only the European internal market and some other countries).

⁶⁹ *See, e.g.*, *Football Dataco Ltd. v. Sportradar GmbH*, C.J.E.U., 3rd ch., Oct. 18, 2012, Case C-173/11, [2013] 1 C.M.L.R. (29) 903 (contemplating the application of the database law of the country “at least” where data at issue was being made available online and accordingly receivable) (also noted in § 3[1][b][iii][A] *infra*).

⁷⁰ *But see, e.g.*, *Eisenman v. Qimron*, C.A. 2790/93 (Supreme Court) (Israel), 54(3) P.D. 817 (2000) (applying moral right to credit for authorship under Israeli law with regard to a book published largely in the United States), in English trans. in [2001] E.C.D.R. 73. For critical analysis, see N. Wilkof, “Copyright, Moral Rights and the Choice of Law: Where Did the *Dead Sea Scrolls* Court Go Wrong?,” 38 *Houston L. Rev.* 463 (2001).

⁷¹ The *Staatsgeschenk* (State Present) decision, BGH (Germany), May 24, 2007, GRUR 2007, 691. A caveat is in order here: moral rights here followed the Berne-plus treaty regime for choice-of-law, but they could be argued to follow that for personality rights. For further analysis of this alternative choice-of-law approach for personality rights, see § 3[1][a][ii] *supra*.

[ii] How to Sort out Applicable Laws in View of Relief?

Return to our pair of guidelines for analyzing cross-border infringement:⁷² First, map out colorably infringing conduct worldwide; second, contemplate pleading the copyright laws of all the countries that such conduct might impact. Admittedly, this exercise could leave many conflicts open among diverse laws, given the different choice-of-law approaches surveyed above.⁷³ We shall here (A) outline a method for courts to dispose of such conflicts in crafting remedies. We shall ask how to do so (B) in imposing injunctive relief and (C) in assessing monetary awards.

[A] Disposing of Conflicts in Tailoring Remedies

Classically, courts and commentators have disfavored the “extraterritorial” imposition of any “national law.”⁷⁴ The Berne-plus treaty regime has come to favor applying the copyright law of each protecting country to infringement occurring “within” that country. We have just argued for choosing the law of such a country to govern relief for infringing conduct, wherever commenced, insofar as it risks or ends up causing prejudice within its territory.⁷⁵ Nonetheless, as potentially infringing acts increasingly and more rapidly cross borders, ultimately online, courts face the possibility that, following this approach, multiple copyright laws may come to bear on any given case. How, in theory, to address conflicts of laws that may ensue?⁷⁶ How, in practice, to fashion relief accordingly?⁷⁷

Start from our guidelines, just broached, of mapping transactions worldwide and of unpacking laws arguably applicable to a case.⁷⁸ We have already critiqued any judicial discretion to choose laws by reference to connecting factors so variegated or vaguely defined that they lead courts to unreliable patterns of decisions.⁷⁹ Rather, as stressed here early on, only with all arguably applicable laws in mind, optimally because the parties have invoked them in their pleadings, may a court knowingly exercise its inherent discretion to tailor remedies with an eye to defusing ensuing conflicts.⁸⁰ Such

⁷² See § 3[1][b][i] *supra*.

⁷³ See § 3[1][a] *supra*.

⁷⁴ E. Ulmer, *Intellectual Property Rights and the Conflict of Laws*, 10–11 (English trans., Kluwer, 1978).

⁷⁵ See § 3[1][b][i][B] *supra*.

⁷⁶ *N.b.* distinguish the choice and application of law across borders from the issuance of an order with effects abroad, say, restraining or compelling conduct elsewhere than in the territorial jurisdiction where a court issues the order. See, generally, N. Park, “Equity Extraterritoriality,” 28 *Duke J. Comparative & International Law* 99 (2017) (proposing criteria to limit such orders). See, e.g., § 6[1][b][ii] *infra* (illustrating how a court may decline to rule in a cross-border copyright case on grounds of *forum non conveniens*).

⁷⁷ See also P.E. Geller, “How to Practice Copyright Law Internationally in Perplexing Times?,” 60 *J. Copr. Soc’y* 167, 182–192 (2013) (concisely stating the methods set out here).

⁷⁸ See § 3[1][b][i] *supra*.

⁷⁹ See § 3[1][a][i] *supra*.

⁸⁰ See § 1[3][c] *in fine supra*.

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discretion should respect public policies crucial in the field of copyright, notably those forming *l'ordre public international* of the Berne-plus treaty regime. This regime aims at protecting copyright "in as effective and uniform a manner as possible," while "taking into account differences in national legal systems."⁸¹ With globalization, we increasingly see single courts entertain the possibility of granting remedies for infringement in many countries at once.⁸² Here we shall consider parameters for thus providing relief across borders, eventually online.⁸³

How may a court elude a briar-patch of laws in tension? In easy cases, as just reiterated, a court may reach much the same results.⁸⁴ Facts could constitute infringement under most applicable laws, notably as would most unauthorized exploitation of close copies of creative works.⁸⁵ Laws may converge in effect, as when treaties impose clear-cut minimum rights or, more and more often in the European internal market, as copyright laws are increasingly harmonized.⁸⁶ In harder cases, we shall see distinct types of laws invoked, for example, where across borders a work is excerpted or recast, to start privately, only to be publicly posted online in creative garb.⁸⁷ Even then, overriding policies, in tandem with equity or proportionality, may allow diverse laws to be accommodated by tailoring remedies to reach some proportional or, at least, minimally invasive solution.⁸⁸ Hence inquiries such as: Would freedom of expression or privacy allow creative uses risking negligible harms? How far, accordingly, to enjoin cross-border infringement or grant monetary awards?⁸⁹

⁸¹ Berne, Preamble (Paris); TRIPs, Preamble. *See also* W.C.T., Art. 14; W.P.P.T., Art. 23 (contemplating "effective action" and "expeditious remedies").

⁸² *See, e.g.*, *KK Sony Computer Entertainment v. Van Veen*, (2006) 71 Intellectual Property Reports 179 (High Court) (New Zealand) (entertaining claims for violations of local, Hong Kong, and U.K. copyright laws, while noting the inconvenience of separate suits abroad); *Boosey & Hawkes Music Publishers, Ltd. v. Walt Disney Co.*, 145 F.3d 481, 492 (2d Cir. 1998) (U.S.) (retaining foreign copyright claims to avoid splintering the action into many suits abroad).

⁸³ On online cases specifically, see § 3[1][b][iii][B] *infra*.

⁸⁴ *I.e.*, given a "false" rather than "true" conflict of laws. *See* § 1[3][c] *in fine supra*.

⁸⁵ For overviews of consensus on such points, see §§ 2[2][a][i] and 2[2][b] *supra*.

⁸⁶ For further analysis of such E.U. cases, see § 3[1][b][iii][A] *in fine infra*.

⁸⁷ For such a hard case, see § 3[1][b][iii][C] *infra*.

⁸⁸ *See, e.g.*, O.F. Afori, "Proportionality—A New Mega Standard in European Copyright Law" 45 I.I.C. 889 (2014) (reviewing E.U. copyright case law on point). *But see* H.G. Ruse-Khan, "Overlaps and Conflict Norms in Human Rights Law: Approaches of European Courts to Address Intersections with Intellectual Property Rights," in C. Geiger (ed.), *Research Handbook on Human Rights and Intellectual Property*, 70 (Edward Elgar, 2015) (differentiating methods of harmonious construction and of proportionality analysis).

⁸⁹ *See, e.g.*, *Ashby Donald c. France*, ECtHR, 5th sect., Jan. 10, 2013, App. 36769/08, para. 30, [2013] E.C.H.R. 287 (considering, but not ruling upon, the argument that a copyright infringement action could not interfere with defendants' freedom of expression as long as it were limited to "obtaining compensation for the impairments" to the plaintiffs' interests in any work at issue) (discussed in § 6[1][b][i] *infra*).

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There remains an apparent conundrum to finesse at the heart of our proposal.⁹⁰ Actions on copyright, along with defenses to them, turn on laws of substance, chosen pursuant to conflicts analyses just broached.⁹¹ Remedies are fashioned according to procedures at least partially subject to forum law, according to conventional wisdom honored at best in the breach.⁹² In fact, substantive copyright laws, as well as treaties, often come with their own panoplies of remedial provisions, only refined by forum procedures, notably for enforcement on the spot.⁹³ Courts do tailor relief, whatever its sources of law, to effectuate the substantive aims of whatever rights are to be vindicated in suit.⁹⁴ Residual tensions will subsist in practice: hence the forum-shopping rules of thumb, along with caveats, entertained below.⁹⁵

[B] Injunctive Orders: Where to Stop Infringement?

At the threshold of a suit on copyright, a copyright plaintiff often seeks injunctive relief. An order may be sought to constrain conduct, notably by seizing copies or by otherwise stopping defendant's infringement-generating acts. If petitioned for injunctive relief on short notice, a court might have little taste, much less time, for studying foreign laws arguably applicable to a cross-border case, and it may well look to forum law if the home market or audience at least is threatened by conduct at issue. But what if this market is but one among many addressed worldwide at once, as in many internet cases?⁹⁶ Suppose that the court takes sufficient jurisdiction to impose injunctive relief at least provisionally.⁹⁷

Courts could issue orders for markets or audiences, whether at risk or impaired, insofar as the laws of corresponding countries converge in remedial consequences that the orders would effectuate. Assume, to start, that a U.S. party is, without due authorization, about to release literal or slavish copies of a work from the United States into numerous other countries where the work is protected.⁹⁸ Plaintiff at once petitions a U.S. court to enjoin this U.S. defendant at home from thus circulating the work

⁹⁰ See, generally, O. Elias, *Judicial Remedies in the Conflict of Laws*, chs. 1–6 *passim* (Hart, 2001) (analyzing gaps at the interface between choice-of-law rules and remedial options).

⁹¹ See §§ 3[1][a] and 3[1][b][i][B] *supra*.

⁹² See, generally, T. Main, "The Procedural Foundation of Substantive Law," 87 *Washington Univ. L. Rev.* 801 (2010) (arguing for "matching" procedural rules, as feasible in any forum, with applicable substantive laws of which such rules are conditions).

⁹³ See, e.g., TRIPs, Part III (analyzed in § 3[3][a][i] *infra*). See also § 5[4][b][ii] *infra* (explaining that national treatment need not require identical procedures with those of the protecting country, but only relief indispensable to enjoying its substantive rights).

⁹⁴ See, e.g., *Christian Liffers v. Producciones Mandarin*, C.J.E.U., 5th ch., March 17, 2016, Case C-99/15, paras. 24–27, [2016] E.C.D.R. 361 (setting aside a forum preclusion of cumulative economically and morally based awards in order to effectuate rights).

⁹⁵ See § 6[1][b][i] *infra*.

⁹⁶ On such cases specifically, see § 3[1][b][iii] *infra*.

⁹⁷ For analysis of such jurisdiction, see § 6[1] *infra*.

⁹⁸ Compare *Levitin v. Sony Music Entertainment*, 101 F. Supp. 3d 376 (S.D.N.Y. 2015) (U.S.) (allowing suit, despite sufficient U.S. license, for infringement in diverse countries abroad), *with* *Los*

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abroad, notably in major markets and audiences, under the laws respectively effective in each. Assume, further, that the claimant establishes its standing to sue to obtain such an injunction in those countries whose markets or audiences could be impacted by the pending, but unauthorized, release of the work.⁹⁹ Assume, finally, that the court makes the following pair of findings: factually, absent an injunction preventing the threatened reception of the work at issue, irreparable damages would be incurred in E.U. member states, as well as in countries like Brazil and China at least; legally, the course of conduct at issue, if completed by impending access, would violate the copyright laws of these states.¹⁰⁰ The court then has both factual and legal bases for provisionally suspending the release or reception of the work into the lion's share of the global marketplace. More generally, it may make such orders to forestall violations pending evidence for or against potential liability under the laws in play.¹⁰¹

Defenses to injunctive relief, though variable law by law, as explained above, may be raised.¹⁰² Consider the example, already broached here, of a suit brought to stop the worldwide marketing, not of close copies of a given work, but of a creatively transformed work.¹⁰³ Plaintiff may assert its economic right to enjoin the unauthorized exploitation of any such derivative work or invoke the moral right of integrity to obtain comparable relief from personal prejudice threatened by the recast work. However, in refusing access to defendant's work, even on the basis of such rights, a court might well eclipse copyright limitations, or even freedoms of expression or information, that would justify declining to block access altogether to the new work.¹⁰⁴ By contrast, suppose a differently complex case where suit is brought for posting a number of works online, but some of these are protected, and some have fallen into the public domain, under laws of some countries, but not others.¹⁰⁵ In such a case, a court may

Angeles News Service v. Reuters Television Internat'l, 340 F.3d 926 (9th Cir. 2003) (as discussed in § 3[1][b][i][A] *supra*).

⁹⁹ For analysis of such standing and chain of title in cross-border cases, see § 6[2] *infra*.

¹⁰⁰ See, generally, K. Florey, "Big Conflicts, Little Conflicts," 47 Arizona State L.J. 683, 746 (2015) (proposing, in appropriate cases, to apply "the median or typical law of the several jurisdictions that may be involved rather than one that is an outlier").

¹⁰¹ See, e.g., Dish TV India Ltd. v. Gulf DTH LLC, Oct. 24, 2016, FAO (OS) 271/2016, paras. 15 and 22 (Delhi Division Bench) (India), at lobis.nic.in/ddir/dhc/PNJ/judgement/25-10-2016/PNJ24102016FAOOS2712016.pdf (for "[t]he law of each municipal jurisdiction [. . .] to be respected [. . .] the sweep of the injunction must be complete") (prior jurisdictional ruling noted in § 6[1][b][i] *infra*); KK Sony Computer Entertainment v. Van Veen, (2006) 71 Intellectual Property Reports 179 (High Court) (New Zealand) (enjoining devices facilitating infringement at home and abroad).

¹⁰² See § 2[2][b][iii] *supra*.

¹⁰³ See § 3[1][a][ii] *supra*; also § 3[1][b][iii][C] *infra*.

¹⁰⁴ Compare *Abend v. MCA, Inc.*, 863 F.2d 1465, 1479 (9th Cir. 1988) (U.S.) (equitably declining to enjoin screening a film based on a protected story, in order to avoid denying "the public the opportunity to view a classic film for many years to come"), *affirmed*, 495 U.S. 207, 236 (1990), and the *Germania* 3 decision, BVerfG (Germany), June 29, 2000, GRUR 2001, 149 (overturning an injunction stopping the publication of a play because it could impair "freedom of art") (discussed in § 2[2][b][iii] *supra*).

¹⁰⁵ See, e.g., the *Project Gutenberg* decision, LG Frankfurt a.M. (Germany), Feb. 9, 2018, no. 2-03 O 494/14 (as glossed and linked in § 3[1][b][iii][B] *in fine infra*).

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refine its relief in stages: it could provisionally staunch the hemorrhaging worldwide of materials protected in many countries, while later hedging its injunction in the light of differentially applicable defenses.¹⁰⁶ Or, as illustrated below in online cases, the court may accommodate diversely protected interests by tailoring minimally invasive relief.¹⁰⁷

How to assure compliance with relief sought across borders? Counsel does well to detail any injunctive order it proposes, so that the court can easily double-check both the extent to which laws invoked in the case support the overall relief in question and how effectively the court can police compliance.¹⁰⁸ In very specific cases, special treaty or more local provisions may provide for rather specific injunctive remedies that, though with cross-border effects, may not predicate multiple laws to justify them. For example, Article 16 of the Berne Convention or those of the E.U. Border-Control Regulation, may call for the seizure of illicit copies, notably by customs authorities at borders.¹⁰⁹ Some statutory provisions may be read to apply to the unauthorized making available, at home or abroad, of works online.¹¹⁰ Some may justify stopping the export of devices to circumvent technological safeguards against infringement.¹¹¹

[C] Monetary Awards: Where Has Prejudice Occurred?

In a suit for infringement, a claimant often seeks damages or other monetary awards, notably profit shares. As indicated above, the Berne-plus treaty regime favors weaving a globally coherent fabric of remedies and thus avoiding overlapping or inconsistent

¹⁰⁶ Compare P.E. Geller, "Hiroshige vs. Van Gogh: Resolving the Dilemma of Copyright Scope in Remediating Infringement," 46 J. Copr. Soc'y 39, 62–63 (1998) (arguing for tailoring injunctions in cases of creatively recast works), with M. Lemley and E. Volokh, "Freedom of Speech and Injunctions in Intellectual Property Cases," 48 Duke L.J. 147 (1998) (arguing against injunctions in copyright cases, with an eye to free-speech considerations raised in defamation jurisprudence).

¹⁰⁷ See §§ 3[1][b][iii][B] and 3[1][b][iii][C] *infra*.

¹⁰⁸ For analysis of such factors as they bear on jurisdiction over cross-border cases, see § 6[1] *infra*.

¹⁰⁹ It is questionable whether goods merely in transit to other countries may be so seized. See, e.g., *Martin Blomqvist v. Rolex SA*, C.J.E.U., 2nd ch., Feb. 6, 2014, Case C-98/13, [2014] E.C.D.R. 129 (confirming the seizure at border of illicit goods ordered online from abroad but entering another state to complete a sale within it).

¹¹⁰ Compare Australia, Copyright Act, Sec. 115A(1) (allowing injunctions to compel intermediaries to block access to any online source "outside Australia" which "infringes" or "facilitates" infringement, with "the primary purpose" of doing so, "whether or not in Australia") (applied in case law noted in § 3[1][b][iii][B] *infra*), with United States, Copyright Act, 17 U.S.C. § 512(j)(1)(B)(ii) (authorizing orders to block access to an off-shore server, but without specifying any condition that a U.S. audience access contents).

¹¹¹ See, e.g., *Nintendo Co. Ltd. v. Playables Ltd.*, [2010] EWHC 1932 (Ch) (U.K.), paras. 40–42 (applying provision against export sales of circumvention devices *per se* to U.K. dealings). *But see* *Football Association Premier League Ltd. v. QC Leisure and Karen Murphy v. Media Protection Services Ltd.*, C.J.E.U., Grand ch., Oct. 4, 2011, Joined Cases C-403/08 and C-429/08, paras. 86–89, [2012] E.C.D.R. 127 (holding it contrary to E.U. freedom of services to limit sales of decoders across E.U. borders).

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awards.¹¹² To this end, we shall here argue, courts best apply copyright laws effective in countries where markets or audiences have been harmed or undue profits have been made. Factual criteria of losses or gains in a country, for example, standards of remuneration in its marketplace, could provide *data* for evaluating damages or profits.¹¹³

Courts tend to localize infringing acts at home if some market or audience is prejudicially impacted within their own jurisdiction.¹¹⁴ By parity of reasoning, courts ought not base awards on their home laws for acts infringing under laws of the other countries where damages are effectively incurred or profits realized. For example, in the U.S. case of an award of two million dollars, about half attributable to marketing the Beatles' *Yellow Submarine* in the United States and about half to marketing abroad, the court held that U.S. copyright law, the only law invoked at trial, could not support the latter half of the award because no completed predicate act of infringement had been alleged as occurring inside the United States.¹¹⁵ Comparably, a French court rejected the argument that French law should apply to imposing damages just because the claimant was headquartered in France, and it rather applied Swedish, Dutch, and British laws, respectively, to award damages incurred by acts occurring in the markets of each of these countries.¹¹⁶

How to grant monetary awards even-handedly for cross-border infringement? An old U.S. decision, for doubtful equitable reasons, had based such relief on U.S. law alone for copies made in the United States but exploited abroad.¹¹⁷ Now consider an equally flawed decision in the case of a book published in Canada but sold in the

¹¹² This *desideratum* of avoiding potentially conflicting awards should be distinguished from that of avoiding disproportionate awards. For further analysis, see § 3[1][b][iii][A] *in fine supra*; for an example, § 3[1][b][iii][C] *infra*.

¹¹³ On the *datum* in conflicts analysis generally, see § 1[3][c] *in fine supra*.

¹¹⁴ See, e.g., *Blue Ribbon Pet Prods., Inc. v. Rolf C. Hagen (USA) Corp.*, 66 F. Supp. 2d 454, 462–464 (E.D.N.Y. 1999) (U.S.) (holding that a party may be contributorily liable for monetary awards under U.S. law for having had copies made abroad with *scienter* that such copies might be infringing under U.S. law and sold in the U.S.); *Herscovici c. Sté. Karla et Sté. Krizia*, Trib. gr. inst., Paris (France), May 23, 1990, RIDA 1990, no. 146, 325 (localizing illicit copying in Italy and illicit sales in France and awarding damages under French law for the sales).

¹¹⁵ *Subafilms, Ltd. v. MGM-Pathe Communications Co.*, 24 F.3d 1088, 1094–1098 (9th Cir. 1994), *cert. denied*, 513 U.S. 1001 (1994). *Compare* *Design Data Corp. v. Unigate Enterprise, Inc.*, No. 14-16701 (9th Cir., Feb. 9, 2017) (allowing claim for U.S. download of program, but not of unprotectible software outputs), and *Datacarrier S.A. v. WOCCU Services Group, Inc.*, 120 U.S.P.Q.2d 1684 (W.D. Wis. 2016) (U.S.) (holding that mere U.S. authorization of software use in Latin American networks did not fall under U.S. law).

¹¹⁶ *SISRO c. Sté. Ampersand Software*, CA Paris, 4e ch. (France), Feb. 8, 2002, *Expertises* 2002, no. 259, 230, *appeal rejected*, Cass., 1e ch. civ. (Supreme Court), March 5, 2002, J.C.P. 2002 II, 10082, 994, in English trans. in 34 I.I.C. 701 (2003). See also *Mariage Frères c. Bouqdib*, CA Paris, 5e ple.: 1e ch., Dec. 1, 2015, P.I. 2016, 233, note A. Lucas (applying Singaporean copyright law, given marketing of French works in Singapore).

¹¹⁷ *Sheldon v. Metro-Goldwyn Pictures Corp.*, 106 F.2d 45, 52 (2d Cir. 1939), *affirmed*, 309 U.S. 390 (1940) (noting that “plaintiffs made no proof of foreign law”). *But see, e.g., Los Angeles News Service*

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United States: a Canadian court, applying only Canadian copyright law, while distinguishing U.S. fair-use precedents that may have excused U.S. exploitation, awarded claimant shares of profits from both Canadian and U.S. sales.¹¹⁸ By contrast, on these facts, a U.S. court could have applied U.S. law to the U.S. sales, imposing duplicative monetary relief if it found liability for the U.S. sales or else no relief at all if U.S. precedents were held to have excused liability for the U.S. sales. Comparably overlapping or inconsistent awards may be avoided by imposing monetary liability under the laws, respectively, of each country for which cross-border conduct is actionable and incoming and in which it endangers or actually harms a market or audience or gains undue profits.¹¹⁹ Conceivably, a court could, while referring to forum law, assess a monetary award for infringement abroad, but only insofar as the tenor of this law converged with that of such a protecting country in relevant effects in the case.¹²⁰ Any apparent conflict of laws would, to that extent and assuming cross-border facts properly sorted out, turn out to be a false conflict.¹²¹

In civil suits, many countries impose statutory damages or other special monetary awards, notably for harm or prejudice difficult to measure or for particularly egregious infringement.¹²² Such awards may be justified by invoking the international public policy that prompts the TRIPs Agreement to call for “remedies which constitute a deterrent to further infringements.”¹²³ There is only sparse case law which extraterritorially imposes such special awards under the law of a single country in order to

v. Reuters Television Internat’l, 340 F.3d 926 (9th Cir. 2003) (deviating from this precedent, with mixed results) (discussed in § 3[1][b][i][A] *supra*).

¹¹⁸ Hager v. ECW Press, Ltd., [1999] 2 Federal Court of Canada Reports 287, 312–19, 323 (1998) (“I do not accept the argument that non-Canadian revenues should not be included. The books were published in Canada, sent from Canada for sale abroad and the revenues were paid to the defendants.”). *But see* the *Tariff 22* decision, *SOCAN v. Canadian Assoc. of Internet Providers*, 2002 FCA 166, para. 181 (Canada), *modified*, 2004 SCC 45 (recognizing that, absent the correct localization of cross-border conduct, there is a “potential” for “double” recovery).

¹¹⁹ *See, e.g.*, *Corbello v. DeVito*, No. 2:08-cv-00867-RCJ-PAL (D. Nev. Aug. 3, 2016) (rejecting arguments legally to adjust “the precise contours of copyright protection under the laws of the relevant nations” to U.S. standards where monetary awards were sought for the markets exploited in such other countries); *Micro Data Base Sys., Inc. v. State Bank of India*, 177 F. Supp. 2d 881, 886–87 (N.D. Ind. 2001) (U.S.) (limiting damages under U.S. copyright law to the use of unlicensed software within the United States).

¹²⁰ *See, e.g.*, Court of Appeal, Athens (Greece), Decision No. 761/2016, *Legal Tribune* 2016, II, 854 (awarding unjust enrichment to Greek actors for the showing of a film including their performances outside the contractual terms of their Greek authorization, specifically in Albania whose E.U.-compliant copyright law has the same tenor as Greek law on point).

¹²¹ For the relation of this to other analytic tools for defusing conflicts, see § 1[3][c] *in fine supra*.

¹²² For a critical overview, see P. Samuelson, P. Hill, and T. Wheatland, “Statutory Damages: A Rarity in Copyright Laws Internationally, But for How Long?,” 60 *J. Copr. Soc’y* 529 (2013).

¹²³ TRIPs, Art. 41(1). For further analysis of the relevant provisions, see T. Dreier, “TRIPs and the Enforcement of Intellectual Property Rights,” in F.-K. Beier and G. Schricker (eds.), *From GATT to TRIPs: The Agreement on Trade-Related Aspects of Intellectual Property Rights*, 248 (Wiley-VCH, 1996).

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adjust monetary liability for damages incurred in any other country.¹²⁴ We have already critiqued attempts to dispose of multi-country cases with but one dispositive law: this tactic could risk imposing stringent or even punitive awards of one country on infringement in others that would not otherwise impose such an onerous sanction for infringement culminating on its territory.¹²⁵ Rather, following the approach proposed here, a court may impose any special award under one country's law by looking to the impact of the conduct at issue only within its territory. Where special awards apply country by country in cross-border cases, they may accumulate with such globally deterrent effects as the TRIPs Agreement contemplates. However, it seems arbitrary to impose any significant monetary award where evidence fails to show that infringement actually resulted in roughly corresponding prejudice.¹²⁶ As indicated below, it remains uncertain whether any disproportionate judgment could be enforced in a foreign infringer's home jurisdiction.¹²⁷

This entire analysis takes on another complexion when criminal or like sanctions are sought for cross-border copyright infringement. Criminal procedures and copyright penalties are variable among jurisdictions, and case law is too sparse to guide resolving tensions among laws on point. A court may well apply local criminal law for infringement that starts abroad but tends to consummate in the penally sanctionable marketing of copies or reception at home.¹²⁸ More rarely, some courts, while calling for a sufficient showing of a domestically defined violation, might take account of actionable harm abroad in imposing any criminal sanction, albeit questionably if no foreign law is applied to the case at bar.¹²⁹ In any event, a court may be justifiably

¹²⁴ See, e.g., *Nat'l Football League v. PrimeTime 24 Joint Venture*, 131 F. Supp. 2d 458, 479 (S.D.N.Y. 2001) (U.S.) (finding that infringement by capturing work-carrying signals in the United States and transmitting the works abroad was "knowing or at least reckless" and awarding statutory damages for such acts under U.S. law), *on remand from* 211 F.3d 10 (2d Cir. 2000), *cert. denied*, 532 U.S. 941 (2001).

¹²⁵ See §§ 3[1][a][i] and 3[1][b][i][B] *supra*.

¹²⁶ U.S. courts seem to be leading others down this punitive path. Compare *Spanski Enters. v. Telewizja Polska S.A.*, No. 17-7051 (D.C. Cir., March 2, 2018) (U.S.) (confirming an award of statutory damages of millions of dollars without any showing of significant, even if only unmeasurable, prejudice), with *Olawska Telewizja Kablowa (OTK) v. Stowarzyszenie Filmowcow Polskich (SFP)*, C.J.E.U., 5th ch., June 21, 2012, Case C-367/15, paras. 19–33 *passim*, [2017] E.C.D.R. 324 (after the Polish Constitutional Court precluded triple damages, equivocating on whether an award of twice normal royalties might correspond *grosso modo* to actual damages plus enforcement costs).

¹²⁷ See § 6[1][b][i] *in fine infra*.

¹²⁸ See, e.g., *Criminal Proceedings Against Donner*, C.J.E.U., 4th ch., June 21, 2012, Case C-5/11, paras. 27–28, [2015] E.C.D.R. 404 (allowing a criminal proceeding for infringement under German law for marketing Italian-made furniture to German customers); *Cass. crim. (Italy)*, Dec. 23, 2009, *Foro Italiano* 2010, III, 2, 136 (holding the organizers of the Swedish website Pirate Bay subject to criminal liability under Italian law given a receiving public in Italy).

¹²⁹ Compare the *Tonträgerpiraterie durch CD-Export* (Sound-Recording Piracy through CD Export) decision, BGH (Germany), March 3, 2004, GRUR 2004, 421, and in English in 36 I.I.C. 370 (2005) (localizing acts of exportation from within to outside Germany as locally infringing within Germany under civil German copyright provisions and applying German criminal provisions to such acts), with *Regina v. AFC Soccer*, 22 Canadian Patent Reporter (4th) 369 (Man. Prov. Ct. 2002) (Canada) (assessing

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reluctant to apply criminal or like sanctions under local copyright law if it finds no clearly prohibited act of exploitation taking place under that law.¹³⁰ Extradition for criminal prosecution of copyright infringement abroad may, however, predicate some act that, though not necessarily infringement, constitutes a crime at home.¹³¹

[iii] Which Laws Govern Cross-Border Telecommunications?

Telecommunication media stretch the notion of territoriality to the breaking point. They take protected works and related productions across national and regional borders, even worldwide, almost instantaneously. In that event, conflicts tend to arise, not only among copyright laws of different countries, but also with quite different laws, including those of human rights. We shall here (A) analyze conflicts of laws in broadcast through network cases and consider (B) relief in internet cases and (C) defenses in intranet cases.

[A] What Conflicts, From Broadcast to Network Cases?

Factually, focus on key differences between simple broadcast cases and complex network cases. On the one hand, a broadcaster actively transmits to passive receivers within a single country or within a reception zone including a few other countries. On the other hand, in computerized networks, multiple parties can interactively communicate with each other among potentially myriad points worldwide. Legally, resulting cross-border communication of copyright-protected contents starts out, in one type of case or the other, subject to the Berne-plus treaty regime. As explained above, this regime provides the default approach for choosing applicable copyright laws, but not necessarily all applicable laws.¹³²

Consider a North American case of broadcasts, eventually coupled with networked transmissions.¹³³ Radio services, with studios collaborating back and forth across the U.S.-Canadian border, organized programs broadcast via satellite and at times ground-transmitters to subscribers, who themselves chose recorded music, among other contents, to enjoy on their receivers.¹³⁴ No injunctive relief was sought, but only royalties purportedly due pursuant to Canadian law from the services for reproductions

a fine under domestic law by taking account, *inter alia*, of the extent of illicit sales abroad, some online).

¹³⁰ See, e.g., the *Guiliano* decision, Cass. crim. (France), Nov. 29, 2011, Bull. crim. no. 240 (declining to apply French criminal law to a translation of a French article into Italian, which did not seem to be published in France and where the website hosting the translation addressed Italians).

¹³¹ See, e.g., *Ortmann v. United States of America*, [2017] NZHC 189 (New Zealand) (finding no basis for the extradition of file-sharing organizers under local copyright law, but rather in their deceptive procurement of digital files, domestically sanctionable as criminally taking property).

¹³² See § 3[1][a][i] *supra*.

¹³³ U.S. case law has vacillated on point. Compare *Nat'l Football League v. PrimeTime 24 Joint Venture*, 211 F.3d 10 (2d Cir. 2000), *cert. denied*, 532 U.S. 941 (2001) (applying U.S. copyright law to the U.S. retransmission of signals, received in Canada), with *Allarcom Pay Television, Ltd. v. General Instrument Corp.*, 69 F.3d 381, 387 (9th Cir. 1995) (declining to apply U.S. law to the U.S. unscrambling of transmissions received in Canada).

¹³⁴ For analysis of a content-originating network spread across borders, albeit one not releasing materials to the public, see § 3[1][b][iii][C] *infra*.

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they made while transmitting copyright-protected contents to their subscribers, as well as for the communications themselves. Canadian law was not applied to reproduction taking place in the United States, though that reproduction was prompted at times from Canada, while royalties due for reception itself in Canada were confirmed.¹³⁵ In accord with the default choice-of-law approach, monetary awards were thus assessed pursuant to law effective in the market or audience reached by the transactions at issue.¹³⁶

E.U. law hedges this approach for issues that it specifies. The E.U. Satellite/Cable Directive has defined “communication to the public by satellite” as taking place “solely” in the E.U. member state of uplinking.¹³⁷ Under this country-of-origin fiction, authorization to transmit a work or related production from one E.U. source country is supposed to legitimate transmission to all of them.¹³⁸ Nonetheless, a recital of the Satellite/Cable Directive calls for compensation to be evaluated with an eye to that due for transmitting to the “actual” or “potential audience” in any given country.¹³⁹ Accordingly, a court may look to standards of remuneration legally or customarily established in any country whose market is impacted, as it assesses monetary awards for reception there.¹⁴⁰ Generally, E.U. instruments tend to defuse potential conflicts of laws by harmonizing European laws in more and more fields of law, progressively including copyright law.¹⁴¹ To the extent that harmonized E.U. law takes hold in a

¹³⁵ *Sirius Canada Inc. v. CMRRA/SODRAC Inc.*, 2010 FCA 348, paras. 41–48 (Canada), *leave to appeal to the Supreme Court denied*, 2011 CanLII 65578.

¹³⁶ *See* § 3[1][b][ii][C] *supra*.

¹³⁷ Council Directive 93/83/EEC of 27 September 1993 on the coordination of certain rules concerning copyright and rights related to copyright applicable to satellite broadcasting and cable retransmission (hereinafter: the Satellite/Cable Directive), Art. 1(2), O.J. 1993 L 248 (also imposing conditions of the broadcaster’s “control and responsibility” in “an uninterrupted chain of communication” from uplink via satellite to reception and a safeguard clause including any broadcast “transmitted” or “commissioned” in any E.U. member state).

¹³⁸ *See also* *TSR v. Métropole Télévision*, Tribunal Fédéral (Supreme Court) (Switzerland), Jan. 12, 2010, ATF 136 III 232 (localizing in France broadcasts relayed by satellite into Switzerland from France, even with advertisements addressed to Swiss audiences, all the while stressing the E.U.-compliant law that Switzerland has on point).

¹³⁹ Satellite/Cable Directive 93/83/EEC, Recital 17, O.J. 1993 L 248. *N.b. data*, for example, current royalty rates, may come into play here. *See, generally*, § 1[3][c] *in fine supra* (explaining any *datum* in conflicts analysis as a predicate for applying a rule of law). *See, e.g.*, § 3[1][b][ii][C] *supra* (distinguishing between laws defining infringement and such *data* relevant to evaluating awards).

¹⁴⁰ *See, e.g.*, the *Felsberg Transmitter* decision, BGH (Germany), Nov. 7, 2002, GRUR Int. 2003, 470, and in English trans. in 35 I.I.C. 977 (2004) (mandating the assessment of royalty claims for broadcasts made from Germany into France in the light of the legal situation in France, where much of the audience was located).

¹⁴¹ *See, generally*, *eDate Advertising GmbH v. X; Olivier Martinez and Robert Martinez v. MGN Ltd.*, C.J.E.U., Grand ch., Oct. 25, 2011, Joined Cases C-509/09 and C-161/10, para. 68, [2011] E.C.R. I-10269 (declining to call for an E.U.-wide “conflict-of-laws rule,” while disfavoring law that would impose more stringent conditions of operation on an “electronic commerce service” than does its source country) (also discussed in § 6[1][a] *infra*). *See, e.g.*, *DailyMotion S.A. c. Delta TV Programs s.r.l.*, Trib. Turin (Italy), Jan. 24, 2018, no. 342/2018 (within such parameters, sorting out laws applicable to a French online service making works accessible in Italy, to wit, for ensuing copyright claims, Italian law).

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field, courts may in theory apply the law of some E.U. source country without misapplying laws of different member states.¹⁴² Otherwise, in practice, the default law governing infringement remains at least that of the country whose audience or market is at risk or harmed.¹⁴³ E.U. case law disfavors applying the law of any source country, especially one outside the European internal market, to harm resulting within it.¹⁴⁴ Were that approach followed, a pirate could “upload from the least protective country possible.”¹⁴⁵

[B] Internet: Relief Against Infringers or Intermediaries?

Internet cases prove to be hard conflicts cases. On the one hand, in such a case, it is tempting to search for but one law to apply across cyberspace.¹⁴⁶ On the other hand, the Berne-plus treaty regime, as argued above, calls for courts to apply the copyright laws of each of the countries in which infringement is to be remedied.¹⁴⁷ To start, it could prove hard to find any predictably “closest” connection of online conduct to any one country: such factors as parties, their respective preparatory acts, etc., might well be moving targets scattered across a globally distributed and interactive network.¹⁴⁸ Further, as just suggested, courts could encourage pirate havens if they applied some source country’s possibly permissive law rather than looking to laws effective in countries where infringing conduct threatens or impacts markets or audiences prejudicially.¹⁴⁹ Finally, even when courts have in the past referred to multiple factors in choosing copyright laws in cross-border cases, they now tend to revert to the default position of applying the laws of countries with impending or actual access to content at issue.¹⁵⁰ Refining the foregoing analyses, this writer will here ask how to apply such

¹⁴² See, e.g., *Nintendo Co. Ltd. v. BigBen Interactive GmbH*, C.J.E.U., 2nd ch., Sept. 27, 2017, Joined Cases C-24/16 and C-25/16, paras. 98–111, [2018] E.C.D.R. 70 (where unitary design law applies in E.U. member states, localizing infringement, for choice-of-law purposes, at the putative origin of prejudice-generating conduct).

¹⁴³ See, e.g., *Football Dataco Ltd. v. Sportradar GmbH*, C.J.E.U., 3rd ch., Oct. 18, 2012, Case C-173/11, [2013] 1 C.M.L.R. (29) 903 (as discussed in § 3[1][b][i][B] *supra*).

¹⁴⁴ See, e.g., *L’Oréal SA v. eBay International AG*, C.J.E.U., Grand ch., July 12, 2011, Case C-324/09, paras. 61–62, [2011] E.C.R. I-6011 (reasoning that, unless a web posting in a “third State,” outside the European Union could violate intellectual-property law within the Union, any “obligation to comply with the EU intellectual property rules” would be undercut).

¹⁴⁵ J. Ginsburg, “Global Use/Territorial Rights: Private International Law Questions of the Global Information Infrastructure,” 42 *J. Copr. Soc’y* 318, 322–23 (1995). See also P. Schonning, “Internet and the Applicable Copyright Law: A Scandinavian Perspective,” [1999] *E.I.P.R.* 45 (favoring application of the law of the country of access or reception).

¹⁴⁶ See G.B. Dinwoodie, “Developing a Private International Intellectual Property Law: The Demise of Territoriality?,” 51 *William & Mary L. Rev.* 711, 774–784 (2009).

¹⁴⁷ See § 3[1][a][i] *supra*.

¹⁴⁸ See, generally, A.-L. Barabasi, *Linked: How Everything Is Connected to Everything Else and What It Means*, ch. 5 (Plume, 2002) (shifting hubs in such networks).

¹⁴⁹ See § 3[1][b][iii][A] *in fine supra*.

¹⁵⁰ Compare *Emilio Pucci c. H&M Hennes & Mauritz*, CA Paris, 5e ple.: 2e ch. (France), Dec. 4, 2015, P.I. 2016, 235, note A. Lucas (applying French law to contents accessible on a website which

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of these laws as allow relief that would, in easy cases, accord with some maximally extensive consensus among them or, in hard cases, minimally intrude on interests at stake in the case at bar.¹⁵¹

How, applying multiple laws across cyberspace, to tailor remedies to such effect? Think back to our example of a mime who improvises a work live.¹⁵² This mime's work is bootlegged in a recording which a member of her audience makes and posts online without her consent. Suppose, elaborating our hypothetical, that the posting at issue fails to acknowledge the mime's authorship or truncates her work as it appears online. Whether or not she sues on her economic rights under copyright, she may assert her author's moral rights of attribution or of integrity, but these rights vary in strength from legal culture to culture and thus among the laws arguably applicable to her case.¹⁵³ While, as already suggested, a court may consider provisionally imposing injunctive relief that falls within treaty standards, notably for economic rights that are followed in the lion's share of the countries whose markets risk harm, it might prove harder to do so for moral rights that are more highly differentiated relative to diverse audiences.¹⁵⁴ The court could face a Solomonian dilemma here: on the one hand, refusing relief altogether could open an author's moral rights to violation worldwide; on the other, leaning toward one or another of applicable laws could arbitrarily favor or disfavor underlying authors' personal interests at stake in one country or another.¹⁵⁵ The court could entertain a motion to order a party to filter out any illicit posting territorially, for example, by geoblocking access, though such measures may in many cases prove ineffective, if not illegal.¹⁵⁶ Or it could seek to fine-tune a minimally invasive remedy: this writer has contemplated an order to have the site attribute authorship and link to the work as the author puts it online.¹⁵⁷

It might, often enough, facilitate relief to bring a network intermediary into a cross-border copyright suit. Internet services are like elephants all too visible in

addressed the French public and awarding damages incurred in France), and *Copiepresse c. Google*, CA Brussels (Belgium), May 5, 2011, paras. 17–20, *Intellectuele rechten / droits intellectuels* 2011, 265 (applying Belgian law to web postings accessible in Belgium and limiting relief accordingly).

¹⁵¹ See, generally, § 1[3][c] *supra* (outlining the overall framework for choosing among arguably applicable laws). See, e.g., § 3[1][b][ii] *supra* (setting out paradigms for injunctive and monetary relief in cases of conflicts of copyright laws).

¹⁵² See §§ 1[3][b], 3[1][a][i], and 3[1][b][i][B] *supra*.

¹⁵³ For examples, see national chapters herein, at § 7.

¹⁵⁴ See § 3[1][b][ii][B] *supra*.

¹⁵⁵ See, e.g., L. Solum and M. Chung, "The Layers Principle: Internet Architecture and the Law," 79 *Notre Dame L. Rev.* 815, 910–914 (2004) (illustrating the dilemma with the choice between law allowing open communication and that policing racist speech online).

¹⁵⁶ See, e.g., *Spanski Enters. v. Telewizja Polska S.A.*, No. 17-7051 (D.C. Cir., March 2, 2018) (U.S.) (applying U.S. law to find infringement in the unauthorized U.S. reception of works made available on a Polish website without geoblocking). *But see* § 5[4][a][i][B] *infra* (noting that E.U. law now precludes some geoblocking).

¹⁵⁷ See P.E. Geller, "Beyond the Copyright Crisis: Principles for Change," 55 *J. Copr. Soc'y* 165, 184–186 (2008).

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cyberspace, while end-users themselves, notably those sharing files, are like mice playing, hidden at ground level, in online fields.¹⁵⁸ But what law or laws to apply when legislative provisions and decisions vacillate in subjecting arguable intermediaries to remedies, depending on a miscellany of the most diverse factors? These could include some predicate act of infringement, the inducement or enablement of such acts, precautionary measures forestalling them, controlling contents, profit-seeking, *scienter*, etc.¹⁵⁹ To answer this question, a court would have to sort out whether, and how, any network intermediary is implicated in cross-border copyright infringement and, especially, in resulting damages. It would most fully focus on pertinent factors in the light of varying tort laws, copyright statutes, network regulations, and other such laws applicable from country to country in an online case.¹⁶⁰ A court may finesse this task by invoking forum law as a basis for ordering internet services to disable unauthorized access to users within its own territorial jurisdiction, even to contents from sources abroad.¹⁶¹ It seems questionable, however, to spread the “umbrella” right of making available, under home law, wide enough to justify imposing relief on an arguable intermediary insofar as it furnishes access to users abroad.¹⁶² Overreaching regimes could try to short-circuit divergent analyses of *direct versus indirect* roles of intermediaries by subjecting them to increasingly strict liability for infringing acts in which they are more or less specifically implicated.¹⁶³ Internet services themselves

¹⁵⁸ See P. Swire, “Elephants and Mice Revisited: Law and Choice of Law on the Internet,” 153 Univ. of Pennsylvania L. Rev. 1975, 1978–1980 (2005) (as cited in § 2[1][c][ii] *supra*).

¹⁵⁹ For information and analyses, see Stanford Center for Internet and Society (CIS), World Intermediary Liability Map (WILMap), at <http://wilmap.law.stanford.edu/>; G.B. Dinwoodie (ed.), *Secondary Liability of Internet Service Providers* (Springer, 2017).

¹⁶⁰ Compare P.A. De Miguel Asensio, “Internet Intermediaries and the Law Applicable to Intellectual Property Infringements,” JIPITEC 2012, no. 3, 350 (surveying conflicts of laws on point), with G.B. Dinwoodie, R. Dreyfuss, and A. Kur, “The Law Applicable to Secondary Liability in Intellectual Property Cases,” 42 N.Y.U. J. of International Law and Politics 201, 216–234 (2009) (proposing “a global norm with respect to global intermediaries”).

¹⁶¹ See, e.g., *Roadshow Films Pty. Ltd. v. Telstra Corp. Ltd.*, [2016] FCA 1503, paras. 26–49 (Australia) (ordering internet services to block foreign sites that have “the primary purpose [. . .] to infringe, or to facilitate the infringement of, copyright”), followed, *Universal Music Australia Pty. Ltd. v. TPG Internet Pty. Ltd.*, [2017] FCA 435, paras. 76–77 (blocking such access to stop “users from infringing copyright” on home ground), with *The Football Association Premier League Ltd. v. British Telecommunications PLC*, [2017] EWHC 480 (Ch) (U.K.), paras. 15, 38(iv), 59, and 65 (blocking programs as streamed, and “inherently likely to infringe,” from “offshore” servers, with unknown “overall traffic [. . .] worldwide”).

¹⁶² See, generally, § 2[2][b][i] *in fine supra* and § 5[4][a][i][B] *infra* (finding no consensus on the scope of this right). See, e.g., *KK Fuji Television v. KK Nagano Shoten (Maneki TV)*, 65 Minshu 121 (Supreme Court, 3rd Petty Bench, Jan. 18, 2011) (Japan), in English trans. at http://www.courts.go.jp/app/hanrei_en/detail?id=1090 (allowing full relief, under Japanese copyright law, against a local service for inputting broadcast programs into its system in Japan so that, on individual users’ demands but without right-holders’ consent, programs were transmitted online to users abroad).

¹⁶³ See, generally, G. Frosio, “The Death of ‘No Monitoring Obligations’: A Story of Untameable Monsters,” JIPITEC 2017, no. 3, 199 (analyzing trends toward strict liability). *But see, e.g., Botelho Ltda. v. Google Brasil Internet Ltda. (Orkut decision)*, STJ, 3a T. (High Court of Appeals, 3rd Panel) (Brazil),

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might be tempted to avoid liability under multiple laws by simply blocking access more globally than applicable laws would require.¹⁶⁴

These issues are further complicated as network intermediaries become susceptible to claimants' self-help measures in cross-border cases. Most notably, to maintain defenses against infringement, internet services may have to take down contents specified in notices that claimants send them.¹⁶⁵ But tensions may arise, for example, if a takedown is demanded of contents that are posted in the United States where copyright has lapsed, are accessible worldwide, and are alleged to violate rights in Europe, if not elsewhere.¹⁶⁶ While here the release of some works to the public within the country of posting may be licit, some takedown outside it may legitimately preclude access to potential viewers elsewhere, but it might not stop the migration of contents to leakier locales.¹⁶⁷ Suppose, by contrast, that a takedown of a work is unjustified under the law of a specific country of potential access: such a takedown could itself trigger liability in that country if it violated an author's moral right by threatening to impair her reputation there.¹⁶⁸ Such unintended consequences, including global takedowns on local notices, whatever the applicable laws, prompt the question: How could relief, whether self-help or judicial orders or awards, meet criteria of proportionality in cross-border cases?¹⁶⁹ Any territorially far-flung relief, including self-help, if it is submitted, ought to call for showing at least the clear risk of widespread and irreparable prejudice, and monetary awards ought to be based on actual harm or

REsp. 1.512.647, May 13, 2015 (Luis Felipe Salomão) (declining to assess damages on a service provider that lacks any structural, profit-seeking, or knowing role in infringement).

¹⁶⁴ See C. Donaldson, "Beyond the DMCA: How Google Leverages Notice and Takedown at Scale," *Landslide* (ABA) 2017, vol. 10, no. 2; C. Marsden, *Net Neutrality: Towards a Co-regulatory Solution*, ch. 4 (Bloomsbury Academic, 2010).

¹⁶⁵ For such defenses to copyright, allowing for freedom of expression, see § 2[2][b][iii] *supra*. For analysis of conflicts of laws implicating freedom of expression itself, see § 3[1][a][ii] *supra* and § 3[1][b][iii][C] *infra*.

¹⁶⁶ See, e.g., the *Project Gutenberg* decision, LG Frankfurt a.M. (Germany), Feb. 9, 2018, no. 2-03 O 494/14, in English trans. at <https://cand.pglaf.org/germany/gutenberg-lawsuit-judgement-EN.pdf> (imposing relief on a U.S.-based internet archive for making works, fallen into the U.S. public domain, accessible in Germany where they were still protected).

¹⁶⁷ See, e.g., *Delta TV Programs s.r.l. c. Google Inc.*, Trib. Turin (Italy), April 7, 2017, no. 1928/2017 (on finding YouTube access to Latin American telenovelas in Italy illicit, and while taking account of overspill via possibly blockable foreign access, awarding damages for delays in takedown). *But see* § 5[4][a][i][B] *infra* (noting E.U. law now precluding some geoblocking in the European internal market).

¹⁶⁸ See, e.g., *Whyte PotterMäl v. Topdawg Entertainment Inc.*, 2016 QCCQ 11725 (Canada) (on default, awarding damages for a takedown which, upon notice under U.S. law, was also effective in Canada, violating Canadian rights).

¹⁶⁹ Compare P. Savola, "Proportionality of Website Blocking: Internet Connectivity Providers as Copyright Enforcers," *JIPITEC* 2014, no. 2, 116 (E.U. criteria), with D. Lindsay, "Website Blocking Injunctions to Prevent Copyright Infringements: Proportionality and Effectiveness," [2017] *Univ. New South Wales Law J.* 1507 (U.K., Australian, and Singaporean analyses).

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undue profits.¹⁷⁰ Comparable parameters also need to be developed for automated self-help measures filtering out colorably infringing uses online.¹⁷¹

[C] Intranets: Defenses of Privacy or Free Expression?

How to choose laws to govern more or less closed cross-border networks? Start with the actual case of Raymond Queneau's poetry in detachable pieces. A team of French researchers made this work available on a local intranet, where they collaborated to remix its components creatively. They were sued for copyright infringement, but the French court, finding that they had tried to firewall their intranet, excused their uses as "private."¹⁷² Imagine that such collaborators recast a work creatively without consent, but within a firewalled intranet stretching from France to Germany and even to the United States. But posit that all these researchers do not all know each another personally, so that their hypothetical intranet does not clearly fall under the cover of their rights to privacy. What copyright law or laws, or others, should a court apply to dispose of our case with its French connections as well as connecting factors across the Rhine and the Atlantic?¹⁷³

Ostensibly complicated conflicts of laws may prove unavoidable in our case. The *Queneau* decision just cited does not represent settled law in France, leaving some intranet uses there possibly infringing.¹⁷⁴ By contrast, across the Rhine, under German copyright law, authors may not generally stop others from drawing further works from their own works in private, but only from exploiting resulting derivative works.¹⁷⁵ In addition, the German limitation of free utilization may allow publicly disseminating creatively transformed works; similarly, across the Atlantic, the U.S. limitation of fair use empowers courts to excuse such transformative uses.¹⁷⁶ To complicate matters still more, laws other than copyright laws may well be implicated in creation online: in our hypothetical case, the online collaborators could find defenses in their personal or human rights, notably their privacy rights to be left alone within their intranet and in

¹⁷⁰ For further analysis, see §§ 3[1][b][iii][B] and 3[1][b][ii][C] *supra*.

¹⁷¹ For critical analysis, see G.B. Dinwoodie, "Private Ordering and the Creation of International Copyright Norms: The Role of Public Structuring," *J. of Institutional and Theoretical Economics*, 2004, 161, at 169–170.

¹⁷² *Queneau c. Boue*, Trib. gr. inst., réf., Paris (France), June 10, 1997, at http://www.legalis.net/spip.php?page=jurisprudence-decision&id_article=107, in English trans. in [2000] E.C.D.R. 343.

¹⁷³ For further analysis, see P.E. Geller, "The Celestial Jam Session: Creative Sharing Online Caught in Conflicts of Copyright Laws," [2015] E.I.P.R. 490, or, in French trans., in Carine Bernault, *et al.* (eds.), *Mélanges en l'honneur du Professeur André Lucas*, 367 (LexisNexis, 2014).

¹⁷⁴ See S. Miannay et J.-F. Casile, "Nouvelles technologies de l'information et de la communication et anciens instruments de régulation: l'exemple d'Internet en France" (New information and communication technologies and old legislative instruments: the case of the internet in France), *Politique et Sociétés* 1999, no. 18, 61, at 76–80.

¹⁷⁵ Germany, Gesetz über Urheberrecht und verwandte Schutzrechte (Law on Copyright and Related Rights), § 23.

¹⁷⁶ Compare *id.*, § 24, with United States, Copyright Act, 17 USC § 107 (2010). For further analysis of cases and doctrine on point, see P.E. Geller, "A German Approach to Fair Use: Test Cases for TRIPS Criteria for Copyright Limitations?," 57 *J. Copr. Soc'y* 553 (2010).

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their freedom of expression.¹⁷⁷ Ultimately, the distinction between the private and public spheres might work out differently depending on a claimant's perspective: private individuals forming nodes of a network may, under certain conditions, constitute members of the public for a copyright claimant, while these members may themselves assert their own privacy rights in other regards.¹⁷⁸

We have already stressed the difficulty of finding any one overriding international order to guide resolving conflicts among laws of radically different types.¹⁷⁹ Nonetheless, as suggested from the start, courts may try to tailor remedies case by case to accommodate diverse interests at stake in tensions between such laws, here copyright law versus human rights.¹⁸⁰ Posit that, in our case, suit is brought before a French court to bar collaborators from accessing and reworking claimant's work within their quasi-private intranet which, by hypothesis, stretches from France to Germany and the United States. Whatever the different approaches these countries follow in such cases, were a French court to enjoin collaboration in France, if not more broadly, it could frustrate French interests by precluding any French contribution to the brainchild that our networked cross-border project would convey.¹⁸¹ Arguably, with regard to refusing the injunction sought across the intranet at issue, the court faces a false conflict among the national laws in play, and this conclusion would be supported by international public policy. Most crucially, an injunction stopping intranet sharing could globally splinter online collaboration, impairing creative exchanges that globally compelling policies, now emerging, would foster.¹⁸² One may, however, ask whether a market-dominant internet service, especially insofar as it is automated, is estopped from invoking any such consideration.¹⁸³

¹⁷⁷ For further analysis, see § 2[2][b][iii] *supra*.

¹⁷⁸ See, generally, J. Cohen, *Configuring the Networked Self: Law, Code, and the Play of Everyday Practice*, ch. 5 (Yale Univ. Press, 2012) (distinguishing meanings of "privacy").

¹⁷⁹ See § 3[1][a][ii] *supra*.

¹⁸⁰ See § 1[3][c] *supra*.

¹⁸¹ The French State has argued that a copyright infringement action could not interfere with defendants' freedom of expression as long as it were limited to "obtaining compensation for the impairments" to authors' rights: *Ashby Donald v. France*, ECtHR, 5th sect., Jan. 10, 2013, App. 36769/08, para. 30, [2013] E.C.H.R. 287 (discussed in § 6[1][b][i] *infra*).

¹⁸² Compare L. Helfer, "Toward a Human Rights Framework for Intellectual Property," 40 UC Davis L. Rev. 971, 1006–1007 and 1011–1012 (2007) (highlighting goal of "the free exchange and circulation of [. . .] cultural expressions"), and J.H. Reichman and R. Okediji, "When Copyright Law and Science Collide: Empowering Digitally Integrated Research Methods on a Global Scale," 96 Minnesota L. Rev. 1362, 1479 (2012) (goal of enabling "digitally integrated, field-specific [research] communities that span the world").

¹⁸³ See, generally, T. Wu, "Machine Speech," 161 Univ. of Pennsylvania L. Rev. 1495 (2013) (explaining that freedom of expression typically concerns communication among rather decentralized human subjects).

[2] What Grounds for Protection are Available in Domestic Law?

We have urged claimant's counsel, at the threshold of a cross-border case, to list the countries in which infringement may be localized.¹⁸⁴ Methodically, counsel should next list, for each of these possible protecting countries, all the grounds on which protection may be available for any foreign work or production at issue. We shall here outline how, in the domestic law of such a country, such grounds may (a) apply directly or indirectly from a treaty, (b) arise unilaterally in principle or in legislation, (c) be recognized on the basis of reciprocity with another country, or (d) be specified in such provisions as implement treaty obligations. We shall unpack self-standing treaty grounds after that.¹⁸⁵

[a] Impacts of Treaty Provisions?

A foreign work or production is most often protected in another country because some treaty requires it.¹⁸⁶ But treaty obligations to provide such protection are variously "included" in different national laws and, sometimes, in regional legal orders.¹⁸⁷ Return to our hypothetical case at the start of this chapter, in which relief for copyright infringement is sought both in Japan and in Israel.¹⁸⁸ A claimant may invoke a copyright treaty binding Japan to the extent that, on its own terms, a treaty provision compels protecting a foreign work or production in Japan. But the claimant may not assert any such treaty in Israel, though many copyright treaties binding Japan also bind Israel, but may plead only Israeli legislation as grounds for protection. This difference arises because of the different ways in which treaty obligations take effect within Japanese and Israeli laws.¹⁸⁹

Nomenclature varies for analyzing how treaty provisions may apply. Such provisions may, most notably, be said to be self-executing, or directly effective or applicable, or not. To begin to sort out the varying criteria for such application *vel non*, we have to draw a basic distinction. There are *intrinsic* and *extrinsic* reasons why a treaty provision may be applied on its own terms or else is to be implemented by domestic legislation. On the one hand, intrinsic reasons for applying a treaty provision arise within treaty terms themselves if these provide clear, sufficient, and mandatory instructions to a court for resolving an issue in a case without any legislative instruction.¹⁹⁰ Examples abound where, finding Berne or other fairly explicit treaty

¹⁸⁴ See § 3[1][b][i] *supra*.

¹⁸⁵ See § 3[3] *infra*.

¹⁸⁶ For definitions of a "foreign" work or production and the "protecting" country, see § 1[1] *supra*.

¹⁸⁷ On the regional legal orders of the European Union and of the Cartagena Decision 351 in South America, see § 3[3][a][ii] *infra*.

¹⁸⁸ See § 1[2] *supra*.

¹⁸⁹ See W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 10 and 14–17 (Intro., Rems. 15 and 30–35) (Werner-Verlag, 1977).

¹⁹⁰ See, e.g., *In re Ekmekdjian v. Sofovich*, C.S.J.N. (Supreme Court) (Argentina), July 7, 1992, El Derecho 148–338 (holding a treaty provision to be self-executing "when addressed to a factual situation on which it can be operative without the need for Congress to enact legislation or to create institutions

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provisions to be formulated in such terms, courts have applied these provisions as self-executing, so that they sufficed to provide grounds for protecting foreign authors' rights.¹⁹¹ On the other hand, extrinsic reasons against applying a treaty provision arise from the legal order of the country or region where protection is sought, no matter how the provision is formulated. Most notably, a constitution may preclude a court from acting on the basis of any treaty text alone, prompting lawmakers to implement treaty obligations in domestic law.¹⁹²

This rough-and-ready distinction often, but not always, allows for sorting out treaty provisions that apply on their own or not to a case. Of course, any legal provision has to be interpreted both within its own textual context and within the legal order where any case arises. To sort out the parameters of legal orders, commentators have distinguished, albeit in an increasingly misleading shorthand, between such "monist" and "dualist" orders.¹⁹³ Start with monist orders: there, treaty provisions, if applicable to cases on their own clear and compelling terms, are deemed part of domestic law, absent legislation to the contrary. In that event, the obligations that such treaty provisions purport to impose internationally on adhering parties, even down to private claimants, may be said, metaphorically, to flow directly into domestic law. By contrast, in a typical dualist legal order, treaties and domestic laws are held apart as distinct, so that any treaty, even though ostensibly applicable on its own terms, has to be implemented in domestic legislation. Gray areas may arise, notably where lawmakers, though not constitutionally compelled to do so, choose to implement otherwise clear-cut treaty obligations in supervening statutes or regulations.¹⁹⁴ Crucially, the European Union resists characterization as a distinctly monist or dualist legal order, rather variously incorporating, or at times insulating itself against, treaty obligations.¹⁹⁵ As we shall repeatedly see, within the so-called E.U. legal order, treaty obligations may ambivalently reach down into the laws of member states themselves.¹⁹⁶

When may domestic law then provide grounds for copyright protection in a given country? To start, in any jurisdiction, general principles or reciprocity conditions may provide such grounds without reference to any treaty. Further, where a legal order disfavors having treaty provisions applied on their own, treaty obligations may be

for the execution of the international rule" in question).

¹⁹¹ For a classic example, see § 4[2][b][iii] *infra*.

¹⁹² For further analysis, see § 3[4][a] *infra*.

¹⁹³ See J. Crawford, *Brownlie's Principles of Public International Law*, ch. 3 *passim* (Oxford Univ. Press, 8th ed., 2013).

¹⁹⁴ For illustrative examples, see § 3[2][d] *infra*.

¹⁹⁵ See R. Wessel, "Reconsidering the Relationship between International Law and EU Law: Towards a Content-Based Approach?," in E. Cannizzaro, P. Palchetti, and R. Wessel (eds.), *International Law as Law of the European Union*, 7 (Brill/Nijhoff, 2011).

¹⁹⁶ See, e.g., § 3[3][a][ii][A] *infra* (introduction to the E.U. legal order); § 3[4][a] *infra* (interpreting treaties subject to the E.U. legal order); § 5[1][c] *infra* (primacy of the E.U. legal order relative to treaties for E.U. parties).

satisfied by domestic implementing legislation.¹⁹⁷ Finally, however extensively any treaty may apply on its own terms, lawmakers may still enact domestic provisions affecting the protection of foreign works or productions. Such domestic provisions may variably specify or amplify or even supersede treaty provisions. Otherwise, as we shall soon detail, treaties may provide grounds for protection on their own terms.¹⁹⁸

[b] Unilaterally Granted Protection

A country may unilaterally protect foreign works or productions, independently of treaty or other such conditions. It may do so even though it adheres to a treaty on point by merely providing treatment more favorable than the treaty requires.¹⁹⁹ The country may simply grant such protection as a matter of principle, or it may explicate its position in domestic legislative provisions. For example, exceptionally generous in this regard, Hong Kong expressly protects all works and performances pursuant to a codified “open-qualification” system.²⁰⁰

Domestic copyright law may carve out specific classes of works or productions to protect unilaterally. For example, the United States protects all unpublished works, no matter what the nationality of their authors.²⁰¹ Many countries protect works or related productions by all residents or other such national claimants, much as they extend other private rights to such parties.²⁰² Or a country may protect any foreign work first published on its territory or related productions appropriately originating there, though often such protection follows from treaty obligations.²⁰³ Under a retroactivity provision discussed below, E.U. law may protect any foreign work or production protected in one such state on July 1, 1995.²⁰⁴

¹⁹⁷ *N.b.*, whether or not a treaty provision, as self-executing, reaches down to govern private disputes, it may still bind an adhering public entity, notably states, in their relations with each other. The TRIPs Agreement provides a key example in the field of intellectual property, in that it governs disputes between W.T.O. members for non-compliance with its provisions. For further analysis, see §§ 3[3][a][i] and 5[5][b][ii] *infra*.

¹⁹⁸ See § 3[3] *infra*.

¹⁹⁹ For this treaty option in the field of copyright, see § 5[1][a] *infra*.

²⁰⁰ See Hong Kong, Copyright Ordinance, §§ 177–178 and 201. *But see id.*, §§ 180 and 276 (allowing some cut-back in H.K. protection absent adequate protection of H.K. claims).

²⁰¹ See United States, Copyright Act, 17 U.S.C. § 104(a).

²⁰² *But see, e.g.*, the *Evening with Marlene Dietrich* decision, BGH (Germany), April 21, 2016, GRUR 2016, 1048, in English trans. in 48 I.I.C. 353 (2017) (refusing neighboring rights for an ex-German singer on grounds of nationality alone, given that she had switched to U.S. citizenship before the performance at issue) (discussed in §§ 3[4][b][ii] and § 5[4][b][i] *in fine infra*). See also § 4[2][a][i] *infra* (noting that stateless residents may be protected as nationals).

²⁰³ See, *e.g.*, Berne, Art. 5(3) (Paris) (providing that any Berne author, not a national of protecting country, is entitled to national treatment in the country of origin of the work at issue, usually the country of first publication). *N.b.*, national requirements of “first publication” may sometimes be more liberal than those imposed by treaty. See § 4[2][b][ii] *infra*; also § 4[3][b][ii] *infra* (on the definition of the “country of origin”).

²⁰⁴ See § 4[3][a][i][C] *in fine infra*.

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Foreigners' moral rights may be unilaterally recognized in some countries. Significantly, French statute recognizes the principle that: "no violation may be made of the integrity, nor [of the attribution] of the authorship, of [foreign] works."²⁰⁵ For example, a U.S. film director and a screen writer, under French law alone, successfully invoked their rights to maintain the integrity of their *film noir*, obtaining relief against the showing of a colorized version in France.²⁰⁶ Comparable positions may be found in other laws according moral rights to foreign authors; some also assure moral rights of limited scope to foreign performers.²⁰⁷ However, decisions are sparse, and early holdings hedged, in performers' cases.²⁰⁸

Some economic interests in work-like productions may be unilaterally protected by tort law. Consider, for example, a brief title of a work or a rudimentary data-set, each lacking creativity in its formulation. In rare cases already broached, remedies may be fashioned against the tortious misappropriation of such productions at the margins of copyright.²⁰⁹ In that event, there may be no need to meet the specific requisites for protecting a foreign work or production by copyright or any related right.²¹⁰ Note, however, that such relief usually calls for proof of independent elements, for example, misleading advertising or other such "unjust" or "unfair" conduct, above and beyond simple copying and exploitation.²¹¹

²⁰⁵ France, Intellectual Property Code, Art. L. 111-4(2).

²⁰⁶ The *Asphalt Jungle* decision, *Huston c. Turner Entertainment*, Cass., 1e ch. civ. (France), May 28, 1991, RIDA 1991, no. 149, 197, in English trans. in 23 I.I.C. 702 (1992), *followed on remand*, CA Versailles, chs. réunies, Dec. 19, 1994, RIDA 1995, no. 164, 389 (also discussed in §§ 4[2][a][ii] and 6[2][b][i] *infra*).

²⁰⁷ *See, e.g.*, Germany, Gesetz über Urheberrecht und verwandte Schutzrechte (Law on Copyright and Related Rights), §§ 121(6) and 125(6) (unilaterally protecting foreign authors' and performers' moral rights, respectively).

²⁰⁸ *See, e.g.*, the *Zauberflöte* (Magic Flute) decision, BGH (Germany), Nov. 20, 1986, paras. 16–17, GRUR 1987, 814 (declining to protect a foreign performer's moral right without any clear violation of such right, in order to avoid it serving as a substitute for economic copyright) (also noted in § 4[3][a][i][A] *infra*).

²⁰⁹ Compare § 2[2][a][ii] *supra* (considering recourse here to tort law from a comparative perspective), with § 4[1][c][iii] *infra* (from a treaty perspective).

²¹⁰ *N.b.*, some statutes specifically providing for such rights, as against unfair competition, may require some treaty relationship with a foreign country before protecting claims of nationals from that country. Such a requirement is usually fulfilled when both the protecting country and the claimant's country adhere to the Paris Convention for the Protection of Industrial Property or to the TRIPs Agreement, but it may not always have to be fulfilled to obtain protection under general tort law. *See, e.g.*, the *SWOPS* decision, BGH (Germany), April 2, 1971, GRUR 1971, 517, in English trans. in 2 I.I.C. 423 (1971) (holding that the German Civil Code protects a foreign claimant's trade name in Germany without any treaty relationship with claimant's country).

²¹¹ *See, e.g.*, the *Mitsurei 27* decision, *Korea Motion Picture Export-Import Co. v. KK Fuji Television*, 65–9 Minshu 3275 (Supreme Court, Dec. 8, 2011) (Japan), in English trans. in 45 I.I.C. 720 (2014) and at http://www.courts.go.jp/app/hanrei_en/detail?id=1284 (refusing relief for unfair competition without any such showing, in the case of a foreign work unprotected by treaty for lack of diplomatic recognition) (also noted under § 4[2][a] *infra*).

[c] Reciprocally Granted Protection

A pair of countries may reciprocally protect each other's works or related productions, notably those made by each other's nationals. To the extent not based on any treaty, reciprocal protection may be recognized in any of a variety of domestic measures, for example, a specific legislative provision, a general provision in a civil code, or an executive proclamation.²¹² Reciprocity may also be confirmed, for example, by an exchange of diplomatic notes or another such arrangement between countries that is not, strictly speaking, a treaty. Such reciprocity remains operative today in rare cases, notably on the margins of copyright not subject to any treaty.²¹³

In the field of copyright, *formal* reciprocity has largely superseded *material* reciprocity.²¹⁴ Formal reciprocity is said to apply when a protecting country, finding that sufficient protection is assured for its works or related productions in another country, accords national treatment relative to works or productions from that other country. Material reciprocity applies insofar as the protecting country only protects a foreign work or production originating in another country to the extent that comparable works or productions originating in the protecting country are protected in that other country.²¹⁵ On specific issues still subject to material reciprocity, it may become necessary to compare rights effectively granted, or regimes implemented, under the laws of the different countries in question. It remains doubtful that any such comparison should take account of rates of remuneration available for given uses.²¹⁶

Procedurally, how is reciprocity assessed? Often, but not always, the relevant provisions of the protecting country indicate some mechanism for this purpose. For example, the United States may, through executive proclamation, extend U.S. copyright to "works" by authors of another country, or first published there, on the finding that this country extends to such U.S. works "copyright protection on substantially the same basis as" it does to its authors or first-published works.²¹⁷ Otherwise, a court may have to make the appropriate determination, which would be easier for purposes of according formal rather than material reciprocity, because no

²¹² On treaty-based reciprocity, see § 2[4][b] *supra* and § 3[3] *infra*.

²¹³ On such marginal fields generally, see § 4[1][c][iii] *infra*.

²¹⁴ For this history, see § 2[3] *supra*.

²¹⁵ Such reciprocity may also insinuate itself into the treatment of specific issues, especially where treaty provisions so provide. *See, e.g.*, § 4[1][c][i][A] *infra* (Berne allows limited material reciprocity in cases of design works); § 5[2] *infra* (Berne and U.C.C. allow material reciprocity in their respective rules of the shorter term); and § 5[4][c][ii] *infra* (reservations with regard to varying remuneration under Rome licenses).

²¹⁶ For example, Berne provides for reciprocity for *droit de suite* entitling visual artists to share in the proceeds of the resale of art objects they create, but such reciprocity need not turn on effective royalty rates. *See, generally*, Berne, Art. 14*ter*(2) (Paris) (requiring extension of *droit de suite* only if "country to which the author [claiming the right] belongs" provides such a right). *See, e.g.*, the *Les Parallèles* decision, BGH (Germany), June 23, 1978, GRUR Int. 1978, 470, in English trans. in 10 I.I.C. 769 (1979) (as discussed in § 5[4][b][ii] *infra*).

²¹⁷ *See* United States, Copyright Act, 17 U.S.C. § 104(b)(6). *N.b.* the term "works" here, pursuant to U.S. nomenclature, could include sound recordings.

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equivalency between protection in the protecting country and in the claimant's country would have to be found.²¹⁸ It will later be asked whether, and on what points, supervening E.U. legislation may affect these approaches on specific points.²¹⁹

[d] Laws Implementing Treaty Protection

As indicated above, domestic laws may variously satisfy treaty obligations.²²⁰ On the one hand, some countries have to implement all treaty provisions legislatively because the pertinent legal order of each, often crystallized in a constitution, does not allow courts to apply such provisions directly to cases at bar. On the other hand, a country may implement selected treaty provisions, even provisions that it may apply as self-executing, in order to specify just how these are to take effect in the cases. We shall here deal with such national implementation and consider below how the E.U. legal order subsumes treaty obligations.²²¹

Consider, to start, jurisdictions that typically implement treaty provisions. There the legislature may itself enact statutes to carry out international obligations or options, or it may delegate such tasks to the executive. Thus, for example, many British-derived and Scandinavian legal orders require that all treaty obligations be satisfied in domestic provisions.²²² Furthermore, in a country such as the United States, where a treaty constitutionally may have the force of law, the legislators may still decide to codify treaty obligations, thereby clarifying or reinforcing their effect, even superseding treaty provisions themselves.²²³ For example, U.S. copyright legislation implements Berne and TRIPs obligations, ostensibly precluding Berne and TRIPs provisions from being self-executing.²²⁴

²¹⁸ See, e.g., Juzgado de lo Mercantil no. 9 (Commercial Court) Madrid (Spain), March 8, 2010, Westlaw JUR 2010, no. 324524 (awarding protection to U.S. citizens for their performances on the condition that the United States protect Spanish citizens with regard to performances on the same terms as it does U.S. citizens).

²¹⁹ See, e.g., § 4[3][a][i][C] (touching on the extent to which retroactive E.U. protection extends to foreign works or productions); § 5[2][b][ii] (explaining how application of the E.U. rule of the shorter term may undercut protection for foreign works or productions).

²²⁰ See § 3[2][a] *supra*.

²²¹ See, respectively, § 3[3][a][ii][A] *infra* (E.U. authority on point), § 3[4][a] *infra* (treaty construction at E.U. and national levels), and § 5[1][c] *infra* (tensions between E.U. and treaty terms).

²²² For examples, see B. Sherman, "Australia," herein, at §§ 6[1] and 6[2]; D. Gangjee, "India," herein, at § 6[1][b]; "Israel," herein, at § 6[1], and O.-A. Rognstad, "Sweden," herein, at § 1[3].

²²³ But see, e.g., J. Dratler, Jr., *Intellectual Property Law: Commercial, Creative, and Industrial Property*, vol. 1, § 1.09[3][c], at 1-103 *et seq.* (1998) (critiquing U.S. judicial treatment of intellectual property treaties in this regard).

²²⁴ See, e.g., *Elsevier B.V. v. UnitedHealth Group, Inc.*, No. 09-2124, 2010 U.S. Dist. LEXIS 3261 (S.D.N.Y. Jan. 14, 2010) (refusing to consider whether U.S. legislation implementing Berne adherence legitimately continued to subject exceptional remedies, such as statutory damages or attorney's fees, even for Berne claimants, to formalities such as registration).

Consider, in turn, countries that in principle directly apply treaty provisions that may be read as self-executing.²²⁵ Nonetheless, even such a country may specify or amplify the effect of a treaty provision in domestic legislation that supersedes the treaty provision by implementing or going beyond it. For example, Germany extends national treatment with regard to the right against the illicit reproduction and distribution of sound recordings protected under the Geneva Convention, although that treaty does not clearly require such national treatment.²²⁶ Or such a country may implement a treaty provision set out in terms that are not clearly mandatory: for example, some countries have implemented the U.C.C. rule of the shorter term, but some have applied it without any such statutory instruction.²²⁷ Provisions, such as Germany's, affirming that a country will protect foreign claimants pursuant to the "content" of any of its treaties, if merely declaratory, do not necessarily eclipse treaty provisions.²²⁸

[3] What Grounds for Protection are Available in Treaty Provisions?

As analyzed, only in some countries are treaties fully implemented in domestic law.²²⁹ Often enough, in the field of copyright, treaty provisions may assure protection by applying on their own terms. We shall here survey (a) trade agreements, (b) multilateral treaties on copyright, (c) those on neighboring rights, and (d) bilateral treaties.²³⁰ Later we shall analyze which treaty provision is dispositive when many bear on a given issue.²³¹

[a] Trade Institutions and Instruments

Trade arrangements have extended to intellectual property for decades. Many of their provisions call for protecting copyright or related rights across borders. But they do not always do so in the same terms, nor in predicating the same procedures, as do the classic treaties in the field. We shall here distinguish: (i) the global TRIPs Agreement, (ii) the European Union and the Andean Community, and (iii) lesser trade arrangements.

²²⁵ See § 3[2][a] *supra*.

²²⁶ See, e.g., the *Frank Sinatra* decision, OLG Hamburg (Germany), April 29, 1999, ZUM 1999, 853, in English trans. in [2001] E.C.D.R. 94, *followed*, OLG Hamburg, Dec. 14, 2000, GRUR-RR 2001, 73 (confirming national treatment relative to reproduction and distribution rights in Geneva-protected phonograms).

²²⁷ See § 5[2][a] *infra*.

²²⁸ Germany, Gesetz über Urheberrecht und verwandte Schutzrechte (Law on Copyright and Related Rights), § 121(4) (2015).

²²⁹ See §§ 3[2][a] and 3[2][d] *supra*.

²³⁰ Footnotes may mention pending treaties, as well as largely superseded or some otherwise obsolete treaties.

²³¹ See §§ 5[1][b] and 5[1][c] *supra*.

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[i] **The W.T.O.: the TRIPs Agreement**

The TRIPs Agreement binds W.T.O. members, thus most countries in the world.²³² Its provisions incorporate or track most Berne and Rome provisions, while filling many gaps left in the international regime of intellectual property at the end of the twentieth century.²³³ We shall here ask: Which, if any, TRIPs provisions could on their own terms suffice as grounds for protecting copyright or related rights in national courts? Later we shall outline how such provisions set out parameters for compliance at times tested in the W.T.O. forum.²³⁴

W.T.O. provisions are generally supposed to govern trade measures of public entities like nation-states. By contrast, TRIPs provisions, many drawn from Berne and Rome provisions with originally different functions, call for fresh analysis with regard to their own specific applicability in cases in which private parties assert their rights.²³⁵ Indeed, Article 1(1) of the TRIPs Agreement allows W.T.O. members “to determine the appropriate method of implementing” its provisions “within their own legal system and practice,” much of which has applied most Berne and Rome provisions as self-executing.²³⁶ Of course, to the extent that a W.T.O. member implements its obligations in its own legislation, TRIPs provisions may be domestically superseded, as explained above.²³⁷

In theory, there seems to be little reason why treaty provisions, once incorporated into the TRIPs Agreement, should lose their original power to furnish grounds for rights of intellectual property in many countries.²³⁸ In effect, some courts have directly applied specific TRIPs provisions, albeit in rare cases: for example, after Brazil adopted the W.T.O. Agreements, a Brazilian court did so to preempt earlier patent legislation on points at issue.²³⁹ Furthermore, one clear TRIPs intention is to have the

²³² For W.T.O. members, bound by the TRIPs Agreement, see https://www.wto.org/english/thewto_e/whatis_e/tif_e/org6_e.htm.

²³³ The Marrakesh Agreement of 1994, which established the World Trade Organization (W.T.O.), includes the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs) in its Annex 1C.

²³⁴ See § 5[5][b][ii] *infra*.

²³⁵ See, generally, T. Cottier and K.N. Schefer, “The Relationship Between World Trade Organization Law, National and Regional Law,” 1 J. International Economic Law 83 (1998) (arguing for TRIPs self-execution after reviewing cases and commentary on point).

²³⁶ See, e.g., Records of the Conference Convened in Paris, 1971, in World Intellectual Property Organization, *1886—Berne Convention Centenary—1986*, 221 (WIPO, 1986) (contemplating that jurisdictions allowing treaties to be “self-executing” could forgo “implementing legislation” by having applicable treaty provisions apply directly).

²³⁷ See § 3[2][d] *supra*. TRIPs effects within the E.U. legal order are addressed below. See §§ 3[3][a][ii][A], 3[4][a], and 5[1][c] *infra*.

²³⁸ See P. Katzenberger, “TRIPs and Copyright Law,” in F.-K. Beier and G. Schrickler (eds.), *From GATT to TRIPS: The Agreement on Trade-Related Aspects of Intellectual Property Rights*, 59, 71–72 (Wiley-VCH, 1996).

²³⁹ *Zeneca Ltd. c. Director, Instituto Nacional de la Propriedade Industrial*, VJF RJ, 9a Reg. (9th Federal Court, Rio de Janeiro) (Brazil), no. 970.003.260-4, July 30, 1997 (Valéria de Albuquerque),

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most recent Berne obligations to protect private claimants, as well as most of such Rome obligations, made binding on W.T.O. members not yet adhering to the corresponding treaties. To that end, TRIPs provisions, modeled on Berne or Rome provisions self-executing on their face, may apply to the extent that local legal orders allow. The fact that the TRIPs Agreement incorporates Berne and Rome eligibility criteria confirms this argument.²⁴⁰

In practice, however, many TRIPs provisions may not lend themselves to such direct application on their own terms. For example, Article 6 of the TRIPs Agreement merely bars raising exhaustion issues within TRIPs dispute-settlement proceedings.²⁴¹ Article 13 of the TRIPs Agreement, addressed to adhering parties, ostensibly as instructions for lawmaking, purports to subject copyright limitations and exceptions to a three-step test that includes criteria so open-ended as to make self-execution problematic.²⁴² Part III of the TRIPs Agreement, contemplating a wide range of national enforcement procedures, both civil and criminal, poses special problems of interpretation insofar as its provisions vacillate in specificity and grammar from point to point.²⁴³ As if anticipating these swings in tenor, Article 41 starts out by obligating members in open-ended language to “ensure” enforcement procedures “as specified,” and ends by disclaiming the obligation to institute any special “judicial system.”²⁴⁴ By contrast, some TRIPs enforcement provisions state that authorities “shall” provide, and thus claimants enjoy, remedies outlined in terms arguably sufficient for self-execution for some purposes in some legal orders.²⁴⁵ In most cases, these like other TRIPs provisions are implemented in domestic legislation, avoiding any need to assess their applicability in their own terms.²⁴⁶

Diário Oficial do Estado: Rio de Janeiro, Aug. 18, 1997, 36, in partial English trans. in 29 I.I.C. 74 (1998), note G.S. Leonardos.

²⁴⁰ For these TRIPs eligibility criteria, see § 4[2] *infra*.

²⁴¹ See J. Malbon, C. Lawson, and M. Davison, *The WTO Agreement on Trade-related Aspects of Intellectual Property Rights: A Commentary*, 171–180 (Edward Elgar, 2014).

²⁴² For critical analysis of this test, see §§ 5[4][a][i][C] and 5[5][b][ii][A] *in fine infra*.

²⁴³ See, e.g., Tribunal Fédéral (Supreme Court) (Switzerland), Aug. 11, 2009, part 5.2, SIC 2010, 86 (finding Article 41 of the TRIPs Agreement insufficiently clear and detailed to be self-executing for the purposes invoked in the case at bar).

²⁴⁴ Compare Report of the W.T.O. Panel, China—Measures Affecting the Protection and Enforcement of Intellectual Property Rights, WT/DS362/R, Jan. 26, 2009, para. 7.507 (noting that TRIPs incorporates Berne and other minimum treaty rights, for which it provides enforcement measures as “substantive obligations that are not simply matters of national discretion”), with *id.*, para. 7.669 (as discussed in § 5[5][b][ii][A] *infra*).

²⁴⁵ See, e.g., Johnson & Son Inc. v. Clorox Argentina, C.N.F. Civ. & Com., Sala II (National Court of Federal Civil & Commercial Appeals) (Argentina), April 30, 1998, note M. Emery, *El Derecho*, no. 9523, June 16, 1998 (holding procedural TRIPs, Art. 50, to be self-executing) (discussed in § 5[5][b][i] *in fine infra*).

²⁴⁶ See § 3[2][d] *supra*.

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[ii] Regional Trade-Based Legal Orders

Regional trade unions encompass many nation-states at once. In such quasi-federal legal orders, copyright and related rights, and thus the protection of foreign works and related productions, may become subject to increasingly uniform law. We shall here focus on such law (a) in the European Union, as well as (b) in the Andean Community.

[A] The European Union

The European Union is increasingly bringing European countries under its supra-national law.²⁴⁷ E.U. Directives increasingly harmonize member states' copyright laws that the E.U. Court of Justice ever-more widely construes. The European Union has led member states into treaties in the field of copyright, starting with the TRIPs Agreement. Furthermore, the European Union has the authority to conclude any treaty falling under key E.U. areas of concern or E.U. rules.²⁴⁸ The E.U. Court of Justice, considering such treaties, as well as others whose terms these incorporate, has deemed them to fall within the E.U. legal order.²⁴⁹ Does this order itself provide any ground for protecting "foreign" works or productions?

Any national of an E.U. or E.E.A. member state obtains national treatment in any other such state as to copyright or related rights.²⁵⁰ In its *Phil Collins* judgment, the European Court of Justice held that the E.U. principle of non-discrimination precludes any member state from discriminating against nationals of other such states in according these rights.²⁵¹ Invoking this principle, European claimants may avoid the exceptions to national treatment that the Berne-plus treaty regime allows, notably those restricting the copyright protection of foreign designs and imposing the rule of the shorter term.²⁵² Such E.U.-based national treatment may have far-reaching consequences for retroactive protection under the E.U. Term Directive, as explained in due course.²⁵³

²⁴⁷ *I.e.*, within the European Economic Area and largely across and even at points beyond the European internal market. *See* § 1[1] *in fine supra*.

²⁴⁸ *Compare* Re Marrakesh Treaty, Opinion 3/15, C.J.E.U., Grand ch., Feb. 14, 2017, paras. 122–130, [2018] E.C.D.R. 183 (affirming exclusive E.U. authority as to the Marrakesh VIP Treaty which "may affect" E.U. rules harmonizing copyright law) (also noted in §§ 3[4][a] and 5[4][a][i][B] *in fine infra*), with Re EU-Singapore Free Trade Agreement, Opinion 2/15, C.J.E.U., Full Court, May 16, 2017, paras. 130 and 305 (confirming full E.U. authority as to intellectual-property provisions of a free-trade agreement, but drawing distinctions as to concluding some rather different provisions).

²⁴⁹ *See, e.g.*, *Società Consortile Fonografici (SCF) v. Marco Del Corso*, C.J.E.U., 3rd ch., March 15, 2012, Case C-135/10, paras. 36–56 *passim*, [2012] E.C.D.R. 276 (as noted in §§ 3[4][a] and discussed in 5[1][c][i] *infra*); *Daiichi Sankyo Co. Ltd. v. DEMO Farmakon*, C.J.E.U., Grand ch., July 18, 2013, Case C-414/11, paras. 53–62 (as noted in § 3[4][a] *infra*).

²⁵⁰ *I.e.*, previously under E.C. Treaty, Art. 12, now under T.F.E.U., Art. 18, and E.E.A. Agreement, Arts. 4 and 6.

²⁵¹ *Phil Collins v. Imtrat Handelsgesellschaft mbH*, E.C.J., Oct. 20, 1993, Joined Cases C-92/92 and C-326/92, [1993] 3 C.M.L.R. 773 (also discussed in §§ 4[3][a][i][C] and 5[1][c][i] *infra*).

²⁵² On exceptions to national treatment, *see* §§ 4[1][c][i][A], 5[2], and 5[4] *infra*.

²⁵³ *See* § 4[3][a][i][C] *infra*.

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Issues may arise with regard to protecting E.U. claimants abroad and, as well, non-E.U. claimants in Europe. Increasingly, the European Union itself, often with member states in tow, is bound by copyright and related treaties. We shall see E.U. case law stress the obligation of any E.U. member state to construe its laws on point in accord both with E.U. law and with treaty obligations.²⁵⁴ We shall also later treat how copyright and related treaties apply within the E.U. legal order for the purpose of protecting non-E.U. claimants' works or related productions.²⁵⁵

[B] The Andean Community

The Andean Community, commenced in 1969, now brings some countries in South America together into a trade union.²⁵⁶ The Cartagena Decision 351, reached on December 17, 1993, codifies copyright provisions with direct effect in these Andean member states.²⁵⁷ The Court of Justice of the Andean Community hears claims of noncompliance with Community law and construes such law upon references from national courts.²⁵⁸

In the field of copyright, member states of the Andean Community may and do vary their laws in amplifying on the substantive provisions of the Cartagena Decision 351.²⁵⁹ Transitional provisions of the Decision 351 retain longer terms of rights previously in effect in any member state, while they apply the Decision 351 to works not previously protected in any member state, subject to the reliance interests of third parties.²⁶⁰ The Decision 351 references and incorporates language from the Berne and Rome Conventions and confirms treaty obligations in the field.²⁶¹

[iii] Other Trade Arrangements and Agreements

Among myriad trade arrangements touching on intellectual property, the TRIPs Agreement retains its crucial role globally, as indicated above.²⁶² Other trade treaties typically call for implementation by domestic legislation, with consequences for

²⁵⁴ See §§ 3[4][a] and 5[1][c][i] *infra*.

²⁵⁵ See § 5[1][c][ii] *infra*.

²⁵⁶ *N.b.* Mercosur, the *Mercado Común del Sur*, constitutes another trade zone in most of South America.

²⁵⁷ Cartagena Decision 351, Régimen Común sobre Derecho de Autor y Derechos Conexos (Common Regime of Copyright and Neighboring Rights), Gaceta Oficial del Acuerdo de Cartagena, X-No. 145, Dec. 21, 1993, available in English translation at <http://www.sice.oas.org/trade/junac/decisiones/Dec351e.asp>.

²⁵⁸ For comparative analysis, notably with regard to intellectual property, see K. Alter and L. Helfer, *Transplanting International Courts: The Law and Politics of the Andean Tribunal of Justice*, ch. 5 *passim* (Oxford Univ. Press, 2017).

²⁵⁹ For critical analysis, see A. Cerda Silva, "Copyright Convergence in the Andean Community of Nations," 20 *Texas Intellectual Property J.* 429 (2012).

²⁶⁰ Cartagena Decision 351, Arts. 58–60.

²⁶¹ See, e.g., *id.*, Arts. 19 *et seq. passim* (Berne); *id.*, Arts. 33 *et seq. passim* (Rome).

²⁶² See § 3[3][a][i] *supra*; also § 5[5][b] *infra*.

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private claimants best researched under national laws.²⁶³ At most, such trade treaties set or incorporate standards that may come into play in more focused disputes arbitrated between adhering parties and, in some cases, with private claimants, as explained below.²⁶⁴

[b] Copyright Conventions and Treaties

The Berne Convention, we have seen, frames the treaty regime in the field of copyright.²⁶⁵ For now we shall review multilateral treaties providing grounds for protecting copyright or related rights.²⁶⁶ As we proceed, treaties covering foreign works or related productions with industrial property will be indicated.²⁶⁷ We shall also later consider which treaty provisions prevail in cases of tension with other provisions.²⁶⁸

[i] The Berne Convention

The Berne Convention, originally concluded in 1886, has been repeatedly revised in a series of “acts.”²⁶⁹ Each revised Berne Act has brought with it expanded coverage and more extensive minimum rights.²⁷⁰ Most countries now adhere to the latest of these Berne Acts, the Paris Act,²⁷¹ or are bound by sequel treaties that incorporate most provisions of this act, along with their own provisions.²⁷² Thus, copyright relations are now most often at least governed by the Berne Convention, in its Paris Act perhaps complemented by some later treaty.²⁷³

²⁶³ Most notably, the North American Free Trade Agreement (NAFTA) tends to speak of what adhering parties “shall” or “may” do, rather than directly positing private parties’ rights of intellectual property. See NAFTA, Arts. 1701 *et seq.*

²⁶⁴ See § 5[5][a] *infra*.

²⁶⁵ See § 2[3] *supra*.

²⁶⁶ The Marrakesh VIP Treaty, specifically delimiting such protection to benefit the visually disabled, will be treated later. See § 5[4][a][i][B] *in fine infra*.

²⁶⁷ Treaties concerning industrial property, most notably the Paris Convention, may protect, most notably, designs or trademarks that lie at or beyond the margins of copyright coverage. On overlaps between industrial property and copyright, see §§ 4[1][c][i] and 4[1][c][iii] *infra*.

²⁶⁸ See § 5[1][b] *infra*; also §§ 3[4][a] and 5[1][c] *infra* (interplay of the E.U. legal order with copyright and related treaties).

²⁶⁹ After the initial Berne Act of 1886, completed by the Additional Act of Paris of 1896, the following acts were concluded: the Berlin Act of 1908, supplemented by the Additional Protocol of Berne of 1914; the Rome Act of 1928; the Brussels Act of 1948; and the Stockholm Act of 1967, completed in the Paris Act of 1971. Only the administrative provisions of the Stockholm Act of 1967, in Articles 22 through 38, went into effect between those countries adhering to it. All the provisions of the Stockholm Act, both substantive and administrative, were incorporated into the Paris Act of 1971, some with certain modifications.

²⁷⁰ On Berne coverage, see § 4[1][a] *infra*; on Berne minimum rights, see § 5[4][a][i][A] *infra*.

²⁷¹ For the Berne text and adherences, see <http://www.wipo.int/treaties/en/ip/berne/index.html>.

²⁷² See TRIPs, Art. 9(1); W.C.T., Art. 1(4). *But see* TRIPs, Art. 9(2) (excluding Berne Article 6*bis*). On the TRIPs Agreement, see § 3[3][a][i] *supra*. On the WIPO Copyright Treaty, see § 3[3][b][ii] *infra*.

²⁷³ For analysis of Berne primacy relative to other copyright treaties, see § 5[1][b][i] *infra*.

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Historically, successive Berne Acts could complicate relations between Berne countries. The following remarks address residual cases in which it might still prove necessary to clarify such relations. A work is here considered to be “from” a Berne country when it displays a specified factor connecting it to that country so that it satisfies a criterion of eligibility for Berne protection.²⁷⁴ Generally speaking, where a pair of Berne countries has adhered to Berne Acts in common, the most recent act binding both of them governs such Berne protection as each has to provide for works from the other.²⁷⁵ However, under Article 34(1) of the Paris Act, a country joining the Berne Union for the first time after that Paris Act entered into force may adhere only to that Act, not to any earlier act. Article 32(2) of the Paris Act then obligates such a newly adhering member to apply its provisions in all its relationships with senior Berne countries.²⁷⁶ At the same time, Article 32(2) acknowledges that senior members not yet bound by the Paris Act need not apply its provisions.²⁷⁷

But which Berne Act, if any, governs the obligations of a senior member toward a junior member adhering only to a later act to which the senior member has not yet itself adhered? For example, which Berne Act, if any, should a relatively senior member, only adhering to the Berne Union at the level of an earlier act, apply to U.S. works after the United States, a relatively junior member, became a party only to the Paris Act?²⁷⁸ This senior member and this junior member, neither a party to any Berne Act in common, had effectively not entered into any treaty with each other, and no Berne provision obligates the senior member in so many words to protect works from the junior member at all. This gap in express Berne language has left open distinct analyses, both here relegated to footnotes, with regard to the senior member’s obligations to the junior member, given the lack of privity between them: on the one hand, the reciprocity analysis²⁷⁹ and, on the other, the Union analysis.²⁸⁰

²⁷⁴ For analysis of such criteria of eligibility, see § 4[2] *infra*.

²⁷⁵ Berne, Art. 27 (Brussels, Rome), Art. 32(1) (Paris). Many countries had placed reservations on their obligations under earlier Berne Acts to which they adhered. On such reservations, see § 5[4][c][ii] *infra*.

²⁷⁶ This construction is only fully codified in Article 32(2) of the Paris Act, but it can be argued to have been implicit in earlier acts. *See, generally*, W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 149 (Berne Art. 32, Rem. 2) (Werner-Verlag, 1977) (arguing that the new provisions clarify the obligations between any two adhering countries no matter what Berne Act is a colorable candidate for governing their relationship).

²⁷⁷ But a senior member has the option under Article 32(2)(ii) of the Paris Act, even when it does not adhere to this Act, of applying it to the junior member at its discretion. For further analysis, see G. Karnell, “Die verschiedenen Fassungen der Berner Übereinkunft: Ihre Geltung im Verhältnis der Verbandsländer zueinander” (The Various Texts of the Berne Convention: their Effectiveness in the Relations of the Union Members to Each Other), *GRUR Int.* 1968, 25, 31–32.

²⁷⁸ For a country which does not deem its treaties to be self-executing, the question is somewhat different. It is not a matter of applying a Berne Act directly in domestic cases, but rather of implementing it with domestic legislation. *See* § 3[2][d] *supra*. Thus, the applicable Berne Act will determine the tenor of this implementing legislation or, where the tenor is not clear, help to construe it. *See* § 3[4][a] *infra*.

²⁷⁹ Even absent adherence of a senior and junior member to any Berne Act in common, the senior member may still protect works from the junior member by virtue of the *reciprocity* which would arise

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[ii] The WIPO Copyright Treaty

The WIPO Copyright Treaty came into force starting on March 6, 2002.²⁸¹ It incorporates operative Berne provisions, as well as some TRIPs provisions, by referring to such provisions or by adopting their language, albeit with occasional textual twists.²⁸² The WIPO Copyright Treaty thus serves as a sequel treaty in the Berne-plus regime, setting out new minimum rights and calling for relief against the circumvention of technological safeguards. The most innovative of its provisions address the internet and other digital media.²⁸³

[iii] The Universal Copyright Convention

Drawn up in Geneva, effective starting in 1955, and revised in Paris in 1971, the Universal Copyright Convention²⁸⁴ was to apply to non-Berne works.²⁸⁵ Under Article IX(4) of its 1971 Paris Act, the 1952 Act applies between any two adhering countries unless both become parties to the 1971 Act.²⁸⁶ Since most U.C.C. countries are now bound by higher Berne-plus instruments, the Universal Copyright Convention most often retains only a residual significance in rare cases, often enough, of older U.S. works.²⁸⁷

as works from the senior member were protected by the junior member. Arguably, a senior member, in granting such protection, need only accord national treatment to the works from the junior member, but not necessarily minimum rights. On reciprocity, see § 3[2][c] *supra*; on Berne minimum rights, § 5[4][a][i][A] *infra*.

²⁸⁰ Article 24 of the pre-Paris Acts contemplated further revisions to “perfect the system of the Union.” Accordingly, in entering the Berne Union, a senior member could foresee revised acts applicable to new junior members. Arguably, the senior member was then bound to treat newly adhering junior members like third-party beneficiaries of any earlier Berne Act to which it had adhered, but it need not hold to any later act that did not bind both members in common. For further analysis, see W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 148–149 (Berne Art. 32, Rem. 2) (Werner-Verlag, 1977).

²⁸¹ For the W.C.T. text and adherences, see <http://www.wipo.int/treaties/en/ip/wct/index.html>.

²⁸² See M. Ficsor, *The Law of Copyright and the Internet: The 1996 WIPO Treaties, their Interpretation and Implementation*, 51–61 (Oxford Univ. Press, 2002).

²⁸³ See § 5[4][a][i][B] *infra*.

²⁸⁴ For U.C.C. texts and adherences, see the UNESCO website: <http://portal.unesco.org>.

²⁸⁵ See § 5[1][b][i] *infra*.

²⁸⁶ The same provision, however, allows any adhering country unilaterally, by giving due notice, to allow other U.C.C. countries to apply the 1971 Act to works of its nationals or to works first published in its territory. See H. Desbois, A. Françon, and A. Kéréver, *Les conventions internationales du droit d'auteur et des droits voisins*, para. 211 (Daloz, 1976).

²⁸⁷ Care must be exercised in some of these cases because protection under the U.C.C. may have been subject to provisions that differ slightly in formulation from parallel Berne provisions. See, e.g., § 5[2] *infra* (regarding the rule of the shorter term); § 5[3] *infra* (regarding formalities).

[iv] The Inter-American Conventions

A number of multilateral treaties have bound various American countries and, at times, countries outside the Americas.²⁸⁸ These treaties became largely inoperative in the second half of the twentieth century, as they were superseded by the Berne Convention most importantly. The inter-American conventions have thus had only a residual importance for older works in the Americas.²⁸⁹

[c] Neighboring Rights Conventions and Treaties

Neighboring rights protect performances, recordings, and broadcasts.²⁹⁰ Complementing copyright treaties, other multilateral treaties assure such related rights. The Rome Convention protects all three types of productions, while the TRIPs Agreement also protects them, albeit in narrower provisions.²⁹¹ Of the other treaties in the field, the WIPO Performances and Phonograms Treaty and the Geneva Phonograms Convention are also currently important. A further treaty, assuring rights in audiovisual productions, has been pending for some time.²⁹² Older treaties protecting broadcasters have been largely superseded by subsequent developments.²⁹³

[i] The Rome Convention

The Rome Convention is key to the protection of neighboring rights internationally.²⁹⁴ The movement to extend Berne protection to performing artists before World War II never gained full support within the Berne Union.²⁹⁵ This movement rather resulted in

²⁸⁸ These include the Convention of Montevideo of 1889 and the so-called Pan-American Conventions, most notably those of Buenos Aires of 1910, Havana of 1928, and Washington of 1946. For further analysis of their interrelationships, see A. Rinaldo, "The Scope of Copyright Protection in the United States under Existing Inter-American Relations," 22 Bull. Copr. Soc'y 417 (1975).

²⁸⁹ Prior to the U.C.C., for example, the Convention of Buenos Aires may have provided grounds for protecting U.S. works in much of Latin America, as well as for protecting Latin American works in the United States. See M. Emery, "Argentina," herein, at §§ 6[2] and 6[4]; M. Santos, "Brazil," herein, at § 6[2]; "United States," herein, at §§ 5[8][b] and 6[2][a].

²⁹⁰ Exact coverage will depend on how a court traces the line between works protected by copyright and media productions protected by neighboring rights. On drawing this line, see § 2[2][a] *supra*. On the coverage of the conventions and treaties concerning neighboring or related rights, see § 4[1][c][ii] *infra*.

²⁹¹ See § 5[5][b][i] *infra*.

²⁹² The Beijing Treaty on Audiovisual Performances. For text and adherences, see <http://www.wipo.int/treaties/en/ip/beijing/>. For critical analysis, see G. Pessach, "The Beijing Treaty on Audiovisual Performances—The Return of the North?," 55 Idea 77 (2014).

²⁹³ The Convention Relating to the Distribution of Programme-Carrying Signals Transmitted by Satellite was concluded in Brussels on May 21, 1974. For text and adherences, see <http://www.wipo.int/treaties/en/ip/brussels/>. The European Agreement on the Protection of Television Broadcasts was concluded in Strasbourg on June 22, 1960. For the text, see <http://conventions.coe.int/Treaty/en/Treaties/Html/034.htm>. For background on another treaty under study, see Timeline of WIPO negotiations on a Treaty for the Protection of Broadcasting Organizations, at <http://keionline.org/copyright/wipobroadcasting/timeline>.

²⁹⁴ For the Rome text and adherences, see <http://www.wipo.int/treaties/en/ip/rome/index.html>.

²⁹⁵ See S. Ladas, *The International Protection of Literary and Artistic Property*, vol. 1, 426–429, 494–497, 627–630 (Macmillan, 1938).

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the Rome Convention which, drawn up in 1961, extends national treatment and minimum rights to qualifying performers, phonogram producers, and broadcasting organizations.²⁹⁶ Rome countries have thus been obligated to institute neighboring or comparable, but differently labeled, rights in performances, sound recordings, and broadcasts, while some adhering parties have also elaborated, outside Rome coverage, copyright-related rights in other media productions, for example, in audiovisual recordings, new editions, databases, etc.²⁹⁷ The Rome Convention, like any other treaty assuring neighboring or related rights across borders, provides grounds for protecting only such types of productions as it enumerates.²⁹⁸

[ii] The WIPO Performances and Phonograms Treaty

The WIPO Performances and Phonograms Treaty entered into force starting on May 20, 2002.²⁹⁹ It references the Rome Convention, at points elaborating and amplifying on Rome and TRIPs provisions.³⁰⁰ Notably, it introduces new minimum rights and other provisions, specifically with regard to technological safeguards, to protect performances and sound recordings on the internet and in other digital media.³⁰¹ Like prior treaties on point, it hedges national treatment as applying “with regard to the exclusive rights” it specifically grants and “to the right to equitable remuneration” for which it provides.³⁰²

[iii] The Geneva Phonograms Convention

Dating from 1971, the Geneva Convention³⁰³ addressed the piracy of sound recordings.³⁰⁴ However, most Geneva countries are now bound by higher Rome or TRIPs standards in this regard. The Geneva text calls for the protection of sound recordings produced in adhering countries “against the making of duplicates without the consent of the producer and against the importation of such duplicates,” without detailing the source or scope of such protection.³⁰⁵ Some countries have expressly

²⁹⁶ On Berne and Rome national treatment, see § 5[4][b][i] *infra*.

²⁹⁷ For analysis of further examples at the borderlines with copyright or with neighboring rights, see § 2[2][a][ii] *in fine supra* and § 4[1][c][ii][B] *infra*.

²⁹⁸ For analysis of options for protecting subject matters falling outside treaty coverage, see § 4[1][c][iii] *infra*.

²⁹⁹ For the W.P.P.T. text and adherences, see <http://www.wipo.int/treaties/en/ip/wppt/index.html>.

³⁰⁰ See M. Ficsor, *The Law of Copyright and the Internet: The 1996 WIPO Treaties, their Interpretation and Implementation*, 51–61 (Oxford Univ. Press, 2002).

³⁰¹ On these rights, see § 5[4][a][i][B] *infra*.

³⁰² W.P.P.T., Art. 4. On resulting national treatment, see § 5[4][b][i] *infra*.

³⁰³ Convention for the Protection of Producers of Phonograms Against Unauthorized Duplication of Their Phonograms (hereinafter: Geneva).

³⁰⁴ For the Geneva text and adherences, see <http://www.wipo.int/treaties/en/ip/phonograms/index.html>.

³⁰⁵ Geneva, Art. 3.

implemented obligations to provide national treatment to Geneva claimants with regard to specified rights.³⁰⁶

[d] Bilateral Agreements

Bilateral copyright treaties typically obligate a pair of countries to protect works authored by each other's nationals or related productions made by such nationals. Such treaties have especially been needed where one or both of a pair of countries had not adhered to the Berne Convention or subsequent multilateral treaties.³⁰⁷ They may also govern issues not expressly or fully treated in multilateral treaties, such as precise modes of retroactive protection or wartime extensions of terms of rights.³⁰⁸

Historically, the United States, under the Chace Act of 1891, concluded many such treaties with other countries or made other arrangements with similar effect. Indeed, in many cases of U.S. works that predate the Universal Copyright Convention, such arrangements often formed express bases of protection.³⁰⁹ For example, the bilateral agreement into which the U.S. entered with Germany in 1892 has been considered in German case law testing the overall relationship between multilateral and bilateral treaties in the field of copyright.³¹⁰ The U.S.-German Agreement treaty not only covered works protected by copyright but also expressly mentioned photographs which, in Germany at the time of the treaty, were protected by rights more akin to neighboring rights.³¹¹ However, such a bilateral treaty need not extend to other neighboring or related rights that it does not expressly mention.³¹²

It is crucial not to confuse bilateral copyright treaties with arrangements between countries that cannot, on their own terms, provide grounds for protection. Some bilateral agreements, largely concerning trade, investment, culture, etc., may include copyright provisions; however, such provisions do not usually call for protection for

³⁰⁶ See, e.g., "Germany," herein, at § 6[1][c][ii] (regarding law implementing Geneva national treatment and case law confirming it); "Japan," herein, at § 9[1][a][ii] *in fine* (more extensive rights in phonograms extended to Geneva claimants, although the Convention might not so require).

³⁰⁷ On the primacy of most multilateral over bilateral treaties, usually subject to any greater protection that these may provide on specific points, see § 5[1][b] *infra*.

³⁰⁸ On retroactive protection, see § 4[3][a][i] *infra*; on agreements to extend wartime extensions of terms, see § 5[1][b][i] *in fine infra*; on such extensions in relation to the rule of the shorter term, see, respectively, §§ 5[1][b][i] *in fine* and 5[2][a][i] *infra*.

³⁰⁹ The Ex-Soviet Union also entered into many bilateral copyright treaties, although it remains unclear whether all these treaties continue to bind all the successor states of the ex-Soviet Republics. The United States has reconfirmed its bilaterals with many successor states of ex-Soviet republics. See E. Schwartz, "Recent Developments in the Copyright Regimes of the Soviet Union and Eastern Europe," 38 J. Copr. Soc'y 123 (1991).

³¹⁰ On this case law, see §§ 4[3][a][ii], 4[3][b][i], 5[1][b][ii], and 5[2][b] *infra*.

³¹¹ See W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 9, 34 (Intro., Rem. 10; Berne Art. 2/2bis, Rem. 3) (Werner-Verlag, 1977).

³¹² See, e.g., the *Bob Dylan* decision, BGH (Germany), Nov. 14, 1985, in English trans. in 18 I.I.C. 418, 422-433 (1987) (holding the U.S.-German Agreement of 1892 inapplicable when a U.S. performer invoked it to benefit from neighboring rights recognized in the German Act of 1965).

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private claims in self-executing terms.³¹³ A variety of arrangements may merely confirm reciprocity as to copyright, for example, exchanges of diplomatic notes, executive declarations, or other such proceedings, with varying effects. As explained above, such effects have to be determined country by country and sometimes case by case.³¹⁴

[4] How to Read and Plead Grounding Provisions for Protection?

We have just surveyed grounds, notably domestic and treaty provisions, for protecting foreign works or related productions.³¹⁵ How to read such provisions in order to determine on what grounds, and how much, protection is available in a given cross-border case? Consider such provisions as they arise (a) in domestic laws, especially as these implement treaty obligations, and (b) in treaties themselves applying on their own terms. This inquiry will be detailed with regard to specific issues in further subsections below.³¹⁶

[a] Domestic or Regional Grounding Provisions

For many countries, as already noted, some nationally constitutional or supranational legal order, like the E.U. legal order, may metaphorically be said to act as a buffer between international treaties and domestic law.³¹⁷ A jurisdiction subject to any such legal order may have to implement treaty obligations in domestic provisions; others, though not so bound, may choose to implement, and thus to supersede, treaty provisions with domestic legislation. While such ensuing provisions may then have to be invoked before a court as grounds for protecting foreign works or productions, they may often be best understood in the light of treaty obligations they implement.³¹⁸

Most notably, British and Scandinavian jurisdictions may preclude a claimant from invoking treaty provisions as grounds for any private right. The British approach to this effect has been adopted in countries ranging from Canada through Australia and India, while historically courts in the United Kingdom itself have vigorously applied the principle that U.K. law, enacted to implement obligations under any copyright treaty, should be construed to give full effect to rights for which the treaty provides.³¹⁹

³¹³ See § 3[3][a][iii] *supra*. But see, e.g., *New York Chinese TV Programs, Inc. v. U.S. Enterprises, Inc.*, 954 F.2d 847 (2d Cir. 1992) (U.S.) (holding that the 1946 Treaty of Friendship, Commerce and Navigation between the United States and Taiwan still assures U.S. copyright in Taiwanese works).

³¹⁴ See § 3[2][c] *supra*.

³¹⁵ See §§ 3[2] and 3[3] *supra*. For definitions of a “foreign” work or production and the “protecting” country, see § 1[1] *supra*.

³¹⁶ See, e.g., § 3[4][a][ii][A] *supra* and § 5[1][c] *infra* (interpretation within the E.U. legal order), §§ 5[4][a][i][C] and 5[4][b] *infra* (interpreting minimum treaty rights and national treatment), § 5[5][b][ii][A] (interpretation within TRIPs dispute settlement).

³¹⁷ See § 3[2][a] *supra*.

³¹⁸ See, generally, W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 16 (Intro., Rem. 33) (Werner-Verlag, 1977) (proposing to interpret statutes in the light of the treaties they implement).

³¹⁹ See, generally, *British Horseracing Board v. William Hill*, [2005] EWCA Civ 863, para. 8 (noting

The British approach to reading implementing legislation in the light of copyright treaties is followed, with local variations, in other countries in the same legal culture.³²⁰ For example, Canadian courts have read the Canadian Copyright Act in the light of Berne provisions cast both in English and in French.³²¹

What about the European Union and its member states?³²² In theory, in the E.U. legal order, treaty provisions fall along a complex spectrum of effects: at one pole, some may apply directly; at the other, some have to be implemented in legislation.³²³ In practice, for purposes of this chapter, we need only focus on how such conceivably varying consequences specifically affect E.U. or member states' treaty obligations within the field of copyright and related rights.³²⁴ To start, the E.U. Court of Justice has declared that some pertinent treaties, notably the TRIPs Agreement and the WIPO "Internet" Treaties, incorporating prior treaty provisions in the field, have no direct effects within the E.U. legal order, while it affirmed its authority to construe such provisions.³²⁵ Further, domestic copyright laws of E.U. states must be elaborated subject to the E.U. legal order itself, though they ought optimally be formulated within the parameters of copyright-treaty obligations.³²⁶ Finally, pending full harmonization

that, when construing statutes that implement treaty texts, courts tend to work "directly" from such text, "without bothering with the UK legislation". See, e.g., *Norowzian v. Arks* (No. 2), [1999] EWCA Civ 3018 (construing U.K. notion of "film" broadly in compliance with the Berne Convention); *Rickless v. United Artists Corp.*, [1988] 1 Queen's Bench Reports 40 (construing U.K. law to effectuate Rome obligations).

³²⁰ See, e.g., *Super Cassette Industry Ltd. v. Entertainment Network (India) Ltd.*, 2004 (29) Patents and Trademarks Cases 8 (Delhi Division Bench) (India) (allowing for filling legislative gaps by reference to international conventions); *Allen & Hanburys Ltd. v. Controller of Patents Designs and Trade Marks*, [1997] 1 Irish Law Reports Monthly 416, [1997] F.S.R. 1 (High Court) (Ireland) (reading TRIPs provision to preclude compulsory license in domestic statute prohibiting licenses "at variance" with treaty obligation).

³²¹ See, e.g., *Milliken & Co. v. Interface Flooring Systems (Can.), Inc.*, (1993) 52 Canadian Patent Reporter (3d) 92 (Fed. Ct.), *affirmed*, (1994) 58 Canadian Patent Reporter (3d) 157 (Fed. C.A.) (holding Berne text in French to be dispositive because it led to "the interpretation of the Act most consistent with the original version of the Convention").

³²² *Quaere* to what extent this analysis applies within the European Economic Area and through or beyond the European internal market. See § 1[1] *in fine supra*.

³²³ See F. Martines, "Direct Effect of International Agreements of the European Union," *European J. International Law* 2014, 129.

³²⁴ *N.b.* E.U. criteria of treaty impacts within the E.U. legal order need not have quite the same meanings as comparable national criteria have historically had, at least before falling under that order. See E. Cannizzaro, "The Neo-monism of the European Legal Order," in E. Cannizzaro, P. Palchetti, and R. Wessel (eds.), *International Law as Law of the European Union*, 35, 54–56 (Brill/Nijhoff, 2011).

³²⁵ See, respectively, *Società Consortile Fonografici (SCF) v. Marco Del Corso*, C.J.E.U., 3rd ch., March 15, 2012, Case C-135/10, paras. 36–56 *passim*, [2012] E.C.D.R. 276 (extending C.J.E.U. purview to Rome and, arguably, Berne Conventions) (as noted in § 3[3][a][ii][A] *supra* and discussed in § 5[1][c][i] *infra*), and *Daiichi Sankyo Co. Ltd. v. DEMO Farmakon*, C.J.E.U., Grand ch., July 18, 2013, Case C-414/11, paras. 53–62 (confirming C.J.E.U. authority to construe TRIPs patent provisions) (also noted in § 3[3][a][ii][A] *supra*).

³²⁶ Compare *Martin Luksan v. Petrus van der Let*, C.J.E.U., 3rd ch., Feb. 9, 2012, Case C-277/10,

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on point, E.U. laws may suffer from residual dissonances that leave European authorities with the task of avoiding gaps in treaty protection.³²⁷ In any event, C.J.E.U. treaty interpretations to this or other effects, since keyed to the E.U. legal order, need not be persuasive outside member states.³²⁸

The situation in the United States is quite differently ambiguous. In theory, venerable U.S. authorities in principle confirm: “Where fairly possible, a United States statute is to be construed so as not to conflict with international law or with an international agreement of the United States.”³²⁹ In practice, however, in statutorily implementing Berne obligations, the U.S. Congress made clear its intent to leave the Berne Convention without any self-executing force in the United States.³³⁰ At the same time, the U.S. Senate acknowledged both the courts’ exclusive power to decide “the question of whether a treaty is self-executing” and the courts’ responsibility of enforcing “appropriate domestic law” to protect the rights of Berne claimants.³³¹ Thus, although the U.S. Copyright Act now purportedly precludes any “reliance upon [. . .] the provisions of the Berne Convention” by private claimants, it ought not be read to compel an ostrich-like refusal by the courts to consult any Berne text at all.³³²

The question then remains open: To what extent, for purposes of resolving a given issue within U.S. law, may a court treat the Berne Convention, if not any comparable

para. 62, [2013] E.C.D.R. 125 (when an international “agreement allows, but does not require, a Member State to adopt a measure which appears to be contrary to European Union law, the Member State must refrain from adopting such a measure”) (noted, as to substance, in § 6[3][b][ii] *in fine infra*, with *AKM v. Zürs.net Betriebs GmbH*, C.J.E.U., 8th ch., March 16, 2017, Case C-138/16, para. 21, [2017] E.C.D.R. 314 (interpreting E.U. directive “in conformity with [Berne] provision, pursuant to the Court’s consistent case-law”).

³²⁷ See, generally, M. Montañá i Mora “The Practical Consequences of the CJEU Judgment of 18 July 2013 Changing Its Doctrine on the Respective Competences of the EU and its Member States to Apply the TRIPS Agreement: Have We Seen the Tip of the *Daiichi* Iceberg Yet?,” 48 I.I.C. 784 (2017) (analyzing such dissonances in E.U. patent laws). See, e.g., § 5[1][c][ii] *infra* (arguing for “a belt-and-suspenders approach” to applying E.U. or treaty grounds for protecting foreign works or related productions).

³²⁸ For example, the E.U. Court may read more discretion into treaty terms than into E.U. law to minimize tensions between treaty standards and the E.U. legal order. See, e.g., *Re Marrakesh Treaty*, Opinion 3/15, C.J.E.U., Grand ch., Feb. 14, 2017, paras. 112–129, [2018] E.C.D.R. 183 (reasoning that legislative discretion, under a proposed treaty, is constrained by an E.U. directive) (also noted in § 3[3][a][ii][A] *supra* and § 5[4][a][i][B] *in fine infra*).

³²⁹ American Law Institute, *Restatement (Third) of Foreign Relations*, vol. 1, § 114 (1987), following *Murray v. The Charming Betsey*, 6 U.S. 2 Cranch 64 (1804). See, e.g., G. Austin, “The Berne Convention as a Canon of Construction: Moral Rights After *Dastar*,” 61 *New York University Annual Survey of American Law* 111 (2005) (unpacking, on this basis, parameters for construing Berne notions of authorship and moral rights within U.S. law).

³³⁰ See § 3[2][d] *supra*.

³³¹ Senate Comm. on the Judiciary, *The Berne Implementation Act of 1988*, S. Rep. No. 100-352, 100th Cong., 2d Sess., 38 (Comm. Print 1988).

³³² United States, Copyright Act, 17 U.S.C. § 104(c). See also J. Dratler, Jr., *Intellectual Property Law: Commercial, Creative, and Industrial Property*, vol. 1, § 1.09[3][c], 1-103 *et seq.* (1998) (critiquing U.S. judicial analyses denying self-execution).

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treaty text, as self-executing? Whatever its finding on point, the court may still need to consult the Berne text as a guide in choosing between “the Copyright Act, other federal and state statutes, and common law precedents” as the “appropriate” U.S. law to implement Berne provisions.³³³ This analysis would not be quite the same for the TRIPs Agreement given that the United States joined the World Trade Organization only by way of a congressional-executive agreement.³³⁴ In any event, the U.S. constitution arguably limits the power of the courts to expand copyright entitlements generally by way of judicial construction.³³⁵

[b] Treaty Provisions as Grounds for Protection

Many legal orders allow treaty provisions to serve alone as grounds for judicial decisions. A court may then apply a treaty provision directly to a case to the extent that the terms of the provision are sufficiently mandatory and precise to decide a given issue without further instruction from domestic legislation.³³⁶ In that event, a copyright claimant may invoke such treaty provisions as constituting self-standing grounds for protecting foreign works or productions. We shall here ask how to interpret any treaty provision to such effect (i) as it refers to domestic laws and (ii) in treaty contexts.³³⁷

[i] Treaties Referring to Domestic Laws

Start with a protecting country where a treaty may have effect on its own terms. In the field of copyright, the basic treaty principle of national treatment will largely determine protection.³³⁸ But how may a treaty, thus providing for national treatment, apply on its own terms if its effects turn on the national law which it would itself lead to applying? The treaty succeeds at this task by containing obligatory and specific enough rules of referral that allow “each country where protection is claimed to provide its own answer [as to scope of national treatment], within such limits as may be laid down [in the convention].”³³⁹

³³³ Senate Comm. on the Judiciary, The Berne Implementation Act of 1988, S. Rep. No. 100-352, 100th Cong., 2d Sess., 38 (Comm. Print 1988). This language suggests that the “appropriate” law may include any law on which the U.S. Congress relied in reaching its judgment that U.S. law complied with Berne standards.

³³⁴ See Uruguay Round Agreements Act of Dec. 8, 1994, Sect. 102 (Pub. L. 103-465, 108 Stat. 4809) (U.S. law to prevail in conflict with W.T.O. provisions and, therefore, with TRIPs provisions).

³³⁵ See, e.g., *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 456 (1984) (citing U.S. Constitution to justify refusal to construe statute as basis for extending U.S. copyright to home-taping, leaving the task of fashioning rights to U.S. Congress in cases of technological innovation).

³³⁶ For a framework of analysis, see § 3[2][a] *supra*.

³³⁷ On specifically interpreting minimum rights *cum* exceptions, the scope of national treatment, and TRIPs provisions, see, respectively, §§ 5[4][a][i][C], 5[4][b], and 5[5][b][ii][A] *infra*.

³³⁸ See, e.g., Berne, Art. 5(1) (Paris); Rome, Art. 2; TRIPs, Art. 3(1); W.C.T., Art. 3; W.P.P.T., Art. 4 (providing for national treatment as to copyright and to neighboring rights, as analyzed in § 5[4][b][i] *infra*).

³³⁹ C. Masouyé, *Guide to the Berne Convention*, 5 (WIPO, 1978).

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Consider, in the Paris Act of the Berne Convention, this model grounding provision: “Authors shall enjoy, in respect of works for which they are protected under this Convention, in countries of the Union other than the country of origin, the rights which their respective laws do now grant or may hereafter grant to their nationals, as well as the rights specially granted by this Convention.”³⁴⁰ We shall here do no more than indicate where Berne rules of referral to national law come into play and where treaty terms are dispositive for issues which such rules raise. To start, this Berne provision contemplates the protection of “works” that Article 2 lists but that the law of the protecting country may further specify, notably by applying its own criteria of protectability.³⁴¹ Further, this Berne provision compels the protection of such a work if it satisfies any of the many eligibility criteria that Articles 3 and 4 of the Paris Act define for works “protected under this Convention.”³⁴² In addition, it indicates where its protection is to take effect, that is, “in countries of the Union other than the country of origin,” and Article 5 then defines “country of origin.”³⁴³ Finally, rights subject to national treatment are left to the “respective laws” of each Berne country to assure.³⁴⁴

Treaties may then vary in how precisely they specify their own key notions. Turn to treaty terms that have to be understood, not with reference to national laws, but within the parameters of their own texts. For example, the Berne Convention has, with increasing precision, defined the term “publication” which, as we shall see, plays distinct roles in its operation.³⁴⁵ More generally, copyright treaties may variously set out minimum rights that bolster national treatment, formulating these rights and corresponding exceptions in more or less categorical terms.³⁴⁶ Some treaty provisions on point may be clearly *imperative* and apply regardless of the tenor of national law, as do Berne provisions establishing many minimum rights. Other treaty provisions set more or less precise standards for protection while allowing adhering parties some *discretion* in complying with these standards.³⁴⁷ A few treaty provisions may leave still other rights altogether *optional*, as the Berne Convention does for the resale-

³⁴⁰ Berne, Art. 5(1) (Paris Act).

³⁴¹ For further analysis, see § 4[1][a] *infra*.

³⁴² For further analysis, see § 4[2] *infra*.

³⁴³ On this definition, see § 4[3][b][ii] *infra*. For other rules of referral to the law of the country of origin, relevant for deciding specific issues, see §§ 4[1][c][i][A] and 5[2] *infra*.

³⁴⁴ For the parameters of national treatment, see § 5[4][b] *infra*.

³⁴⁵ On “first” publication as a factor called for in criteria of eligibility and in the definition of the country of origin, see, respectively, §§ 4[2][b][ii] and 4[3][b][ii] *infra*.

³⁴⁶ See, generally, W. Hoffmann, *Die Berner Uebereinkunft zum Schutze von Werken der Literatur und Kunst*, 12–14 (Springer, 1935) (distinguishing between “rigid” and both “half-rigid” and “non-rigid” Berne provisions, but expressing skepticism that less than “rigidly” self-executing provisions might be subject to uniform construction).

³⁴⁷ On discretion in construing and implementing most minimum rights, as coupled with exceptions, see § 5[4][a][i][C] *infra*.

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royalty right in art objects.³⁴⁸ Accordingly, as we shall next outline, many treaty provisions have to be read in context case by case.³⁴⁹

[ii] Interpreting Treaty Terms in Context

The Vienna Convention contemplates interpreting a treaty “in accordance with the ordinary meaning” of “the terms of the treaty in their context and in the light of its object and purpose.”³⁵⁰ Within the Berne-plus regime, this overall method would lead us to read successive treaty texts in the light of aims like enhancing creation and promoting cultural commerce among nations.³⁵¹ Do decision-makers then have to undertake the Sisyphean task of construing such copyright treaties as we have seen elaborated in the face of wave upon wave of media changes?³⁵² The Vienna Convention need not apply to agreements reached before it went into effect, like the Berne and Rome Conventions.³⁵³ Nonetheless, its rules may guide judicial readings of prior treaties even when it is not binding, as they have done in copyright cases.³⁵⁴ We shall here broach specific questions of method in hard cases.³⁵⁵

To start, can the meaning of a treaty provision be locked in once and for all, beyond the vagaries of the cases? In theory, it may be desirable always to look for clear and stable meaning exclusively within the close context of the treaty provision in question. This approach, favored in the commentary, has the advantage of discouraging adhering parties from going off on their own national tangents in construing their international obligations.³⁵⁶ In practice, in cases where meaning is not obvious on the face of a treaty provision nor within its immediate context, it may be necessary to resort to ever larger contexts in order to interpret the provision cogently. For example, with a

³⁴⁸ On this *droit de suite* in international copyright, see § 5[4][b][ii] *infra*.

³⁴⁹ See § 3[4][b][ii] *infra*.

³⁵⁰ Vienna Convention on the Law of Treaties, Art. 31(1) (hereinafter: “Vienna Convention”), at http://legal.un.org/ilc/texts/instruments/english/conventions/1_1_1969.pdf.

³⁵¹ See, generally, Berne, Preamble (Paris) (“the desire to protect, in as effective and uniform a manner as possible, the rights of authors”); U.C.C., Preamble (Paris) (“encourage the development of literature, the sciences and the arts [. . .] [and] facilitate a wider dissemination of works of the human mind”).

³⁵² See, e.g., § 2[1][c][ii] *supra* (tracing copyright issues emerging in media trends); §§ 3[1][b][i][B] and 3[1][b][ii][A] *supra* (outlining Berne-plus policies operative in the choice of law to govern relief for infringement). See also § 6[3][c][i] *infra* (sorting out such policies operative in the choice of law to govern copyright contracts).

³⁵³ Vienna Convention, Art. 4 (providing that, itself in force on January 27, 1980, it applies only to treaties subsequently binding on an adhering party).

³⁵⁴ See, e.g., the *Evening with Marlene Dietrich* decision, BGH (Germany), April 21, 2016, GRUR 2016, 1048, in English trans. in 48 I.I.C. 353 (2017) (following Vienna rules in construing a prior treaty in that they codify preexisting customary international law) (also discussed in § 5[4][b][i] *in fine infra*).

³⁵⁵ See also, e.g., § 5[5][b][ii][A] *infra* (noting cases in which the TRIPs Agreement is to be interpreted in accord with the Vienna Convention).

³⁵⁶ See, generally, S. Ricketson, “The Shadow Land of Berne: A Survey of the Hidden Parts of the Berne Convention—Part I,” [1988] E.I.P.R. 197, 200 (“to depart too far from the text of the Convention can lead one into some very uncertain and uncharted waters”).

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repeatedly revised treaty such as the Berne Convention, it may help to look, not merely to one Berne Act, but to the role of this text in the series of Berne Acts it caps off.³⁵⁷ Such a wide-ranging method could also be used where a prior text, notably a Berne provision, is incorporated into a later treaty, like a WIPO Treaty.³⁵⁸ Absent any such incorporation, prior context may be less helpful in reading a copyright-relevant provision, for example, specific to a trade treaty.³⁵⁹

Further, how should successive provisions be applied to cases where they seem to contradict each other? Notwithstanding the old maxim, *lex posterior derogat legi anteriori*, prior law gives way to later law, we shall see prior Berne provisions prevail over later law.³⁶⁰ In the event of tensions between successive treaties, or a treaty and a later statute, it is preferable to construe the texts in question by giving them optimum effectiveness, that is, *effet utile*.³⁶¹ If that approach fails, notably where a self-executing treaty provision appears to contradict subsequently enacted domestic law, some commentators favor reconstruing, not the treaty provision, but the domestic law.³⁶² The Austrian Supreme Court faced just such tensions: on the one hand, German claims were made to Austrian blank-tape royalties pursuant to Berne national treatment; on the other, a local copyright-management organization invoked a domestic copyright statute to justify its diverting royalties due foreign claimants to the benefit of domestic claimants.³⁶³ The court avoided a direct conflict with national treatment by giving a new sense to local law.³⁶⁴

In that light, how may legal texts preceding a treaty help to understand a provision of this treaty in a given case? The Vienna Convention allows references to deliberations leading up to a treaty and to any consensus later arising among treaty parties.³⁶⁵ The German Federal Court of Justice asked whether the hedged Rome provision for national treatment justified protecting U.K. performances of a famous singer against unauthorized posting online. The Court looked back, not only to

³⁵⁷ See, generally, W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 21 (Intro., Rem. 39 *in fine*) (Werner-Verlag, 1977) (explaining this method, with caveats).

³⁵⁸ See, e.g., M. Ficsor, *The Law of Copyright and the Internet: The 1996 WIPO Treaties, their Interpretation and Implementation*, 431–442 (Oxford Univ. Press, 2002) (thus interpreting terms incorporated from Berne into the W.C.T.).

³⁵⁹ For TRIPs analyses on point, see § 5[5][b][ii][A] *infra*.

³⁶⁰ See § 5[1][b][i] *infra*.

³⁶¹ See F. Majoros, *Les conventions internationales en matière de droit privé* (The international conventions on private international law), vol. 1, 233–258 (A. Pedone, 1976).

³⁶² See W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 15–16 (Intro., Rem. 33) (Werner-Verlag, 1977).

³⁶³ The *GEMA/Austro-Mechana* decision, Oberster Gerichtshof, July 14, 1987, GRUR Int. 1988, 365 (also discussed in § 6[2][a] *infra*).

³⁶⁴ But see, e.g., W. Dillenz, *Materialien zum österreichischen Urheberrecht* (Materials on Austrian Copyright), 451 *et seq.* (Manz'sche, 1986) (subsequent legislative amendment to preclude the Austrian Supreme Court's Berne-compliant reading).

³⁶⁵ Vienna Convention, Arts. 31 and 32.

deliberations culminating in the Rome Convention, but to the more dynamic but prior Berne principle of national treatment: then it extended such treatment to the domestic making-available right which the Rome text had not contemplated.³⁶⁶

Finally, turn to developments subsequent to the conclusion of a treaty. Start with clarifications that treaty parties later accept, for example, the Agreed Statements reached upon concluding the WIPO “Internet” Treaties. Such texts crystallize any consensus regarding the meaning of provisions internal to the treaties and may serve as “decisive sources of interpretation.”³⁶⁷ Settled case law of treaty parties, cogently elucidating shared treaty principles or terms, may also be persuasive.³⁶⁸ It is theoretically controversial to read a treaty on the basis of the subsequent practice of treaty parties.³⁶⁹ Yet this method may prove the only one available in hard cases.³⁷⁰

§ 4 Are the Requirements for Protection Met?

[1] Is the Work or Other Production at Issue Covered?

Our analysis, to this point, leaves us with distinct lists: on the one hand, a list of protecting countries;¹ on the other, lists, one for each such country, of grounding provisions for the protection of foreign works or productions.² We next have to ask whether, in any such provision, three types of requirements are met: First, is what is at issue covered (a) as a “work,” (b) if so, what type of work, or (c) as another type of production, like a design, performance, etc.? Second, does this work or production satisfy any eligibility criterion?³ Third, is its protection timely?⁴

[a] Defining Covered “Works”

Grounding provisions for protection by copyright or authors’ rights refer to what they cover as “works.” National laws employ marginally different turns of phrase here, like “works of the mind” or “works of authorship,” while the Berne phrase is “literary

³⁶⁶ The *Evening with Marlene Dietrich* decision, BGH, April 21, 2016, GRUR 2016, 1048, in English trans. in 48 I.L.C. 353 (2017) (also discussed in § 5[4][b][i] *in fine infra*).

³⁶⁷ M. Ficsor, *The Law of Copyright and the Internet: The 1996 WIPO Treaties, their Interpretation and Implementation*, 63 (Oxford Univ. Press, 2002).

³⁶⁸ See, e.g., § 4[2][b][iii] *infra* (illustrating how, in cases of Chaplin’s film *The Gold Rush*, a Swiss judicial interpretation of Berne “publication” was followed in Germany).

³⁶⁹ See, generally, P. Reuter, *Introduction to the Law of Treaties*, 96–97 (J. Mico and P. Hagenmacher, trans., Kegan Paul, 1995) (implying that subsequent practice is to be relied upon only after other sources for construction are exhausted).

³⁷⁰ See, e.g., W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 81 (Berne Art. 9, Rem. 4) (Werner-Verlag, 1977) (refining the open-ended exception to the Berne reproduction right by looking to subsequent legislative experiments of Berne countries).

¹ On localizing infringement in protecting countries, see § 3[1][b][i] *supra*.

² For grounding provisions in domestic law and treaties, see, respectively, §§ 3[2] and 3[3] *supra*.

³ For the full range of eligibility criteria and how to satisfy each type, see § 4[2] *infra*.

⁴ On continuous or retroactive protection to the time of infringement, see § 4[3] *infra*.

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and artistic works.”⁵ Following the Berne approach, protecting countries may, but need not, require a work to be fixed in material form before protecting it.⁶ However, most laws do not impose any such requirement of fixation, but only that of “originality” or, more rigorously put, some “creativity” attracting copyright.⁷ But what margin of discretion do the treaties leave to each protecting country to construe the protected core of a foreign work? Recall that national case laws vary somewhat in applying criteria of protectability.⁸

To start, the Berne term “work” is minimally defined by the initial Berne provisions which describe works that the Berne Convention covers.⁹ Accordingly, treaty language, though it vaguely suggests criteria of protectability, cannot spare the trial court the task of construing such criteria in applying them, nor deny it discretion in doing so.¹⁰ Thus, while treaty language may provide guidance, the case law of the protecting country more specifically indicates both how to find sufficient originality for copyright and what creative core of a work to protect.¹¹ In effect, when a foreign media or data production is at issue, subject to a treaty text, the law of the protecting country is dispositive of whether it is to be protected as a work by copyright.¹² The application of any other national law but that of the protecting country to this issue would violate treaty principles, notably national treatment.¹³

⁵ See France, Intellectual Property Code, Art. L. 111-1; United States, Copyright Act, 17 U.S.C. § 102(a); Berne, Arts. 1 and 2(1) (Rome, Brussels, Paris); W.C.T., Preamble.

⁶ See Berne, Art. 2(2) (Paris). Nonetheless, this option was arguably more restricted in prior Berne Acts, which only referred to the fixation of choreographic and pantomime works.

⁷ See, e.g., the *David Copperfield* decision, CA Paris, 3e ch. (France), Dec. 20, 1996, RIDA 1997, no. 173, 351, at 355–356 (protecting a U.S. magician’s act with French author’s rights, without calling for fixation but presuming creativity).

⁸ See § 2[2][a][i] *supra*.

⁹ See, generally, F. Ostertag, “La protection des disques étrangers en Suisse” (The protection of foreign recordings in Switzerland), *Le Droit d’Auteur*, 1940, 41, at 43 (arguing that the judge is bound to apply the Berne definition, admittedly “a little vague,” of a “work”). See also D. Vaver, “The National Treatment Requirements of the Berne and Universal Copyright Conventions,” 17 *I.I.C.* 578, 590 *et seq.*, 721 *et seq.* (1986) (comparable argument with regard to both Berne and the U.C.C.).

¹⁰ See W. Hoffmann, *Die Berner Uebereinkunft zum Schutze von Werken der Literatur und Kunst*, 52–53 (Springer, 1935). See also W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 32 (Berne Art. 2/2bis, Rem. 1) and 171–172 (U.C.C. Art. I, Rems. 3–4) (Werner-Verlag, 1977) (concluding that Berne and the U.C.C. do not replace such domestic criteria as originality and creativity).

¹¹ See, generally, C. Masouyé, *Guide to the Berne Convention*, 17–18 (WIPO, 1978) (“the question of originality, when prescribed, is a matter for the courts” to decide).

¹² See, e.g., the *Game Boy* decision, Oberster Gerichtshof (Supreme Court) (Austria), Dec. 17, 1991, GRUR Int. 1992, 677, in English trans. in 24 *I.I.C.* 531 (1993) (refusing to protect a Japanese videogame as a “work” under the Berne Convention, for failure to show creativity meeting domestic criteria).

¹³ Compare *Bridgeman Art Library, Ltd. v. Corel Corp.*, 25 F. Supp. 2d 421, 425–27 (S.D.N.Y. 1998), *reconsidered*, 36 F. Supp. 2d 191, 195–197 (S.D.N.Y. 1999) (U.S.) (ultimately applying the law of protecting country to decide protectability), with *Sté. Panek c. Sté. IBM Corp.*, Trib. gr. inst. Paris, 3e ch. (France), May 16, 1997, Rev. droit de propriété industrielle, 1997, no. 77, 46 (applying U.K. criterion of

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Treaty language may nonetheless help in hard cases. Treaty premises of reciprocity would be undercut by the erratic variation of criteria of protectability, from country to country.¹⁴ To parry this threat, the Berne Convention reinforced the global consensus that, as already noted, focuses on the creative core to be protected within works.¹⁵ For example, Article 14(2) of the Berne Convention, in its early Berlin Act, allowed a court to limit inquiry into originality and creativity in a motion picture to the “stage effects” and “the combination of incidents [it] presented,” while subsequent revisions opened up judicial inquiry into other potentially creative cinematographic elements.¹⁶

Databases and computer programs raise comparable issues. Berne language leads to applying criteria of protectability to “the selection and arrangement” of collections of works.¹⁷ The TRIPs Agreement, followed by the WIPO Copyright Treaty, confirms this approach for “[c]ompilations of data or other material,” in whatever form.¹⁸ The Berne premise of authorship allows the term “works” to refer to computer programs if these are somehow creative.¹⁹ Furthermore, Berne language precludes limitations of such coverage to any “mode or form of [. . .] expression.”²⁰ The TRIPs Agreement and WIPO Copyright Treaty confirm this approach.²¹

[b] Effects of Listing Types of Works

International treaties, notably the Berne Convention, set out lists of different types of “protected” works.²² These lists, largely incorporated into national laws with slightly different flourishes, illustrate, most often non-exhaustively, what copyright

originality to determine French protection for purported U.K. work), *critiqued*, H.-J. Lucas, Note, J.C.P. E. 1998, 1256 (“This detour must be condemned [. . .] [as] contrary to the [Berne] Convention”).

¹⁴ See F. Ostertag, “La protection des disques étrangers en Suisse” (The protection of foreign recordings in Switzerland), *Le Droit d’Auteur* 1940, 41, at 42. On the differences and relations between material reciprocity and the formal reciprocity underpinning the Berne-based treaty regime, see §§ 2[3][a] and 3[2][c] *supra*.

¹⁵ See § 2[2][a][i] *supra*.

¹⁶ See, generally, H. Desbois, A. Françon, and A. Kéréver, *Les conventions internationales du droit d’auteur et des droits voisins*, paras. 48 and 59 (Dalloz, 1976) (confirming that, in Article 2(1), the Brussels Act finally treats a cinematographic work like any other work).

¹⁷ Berne, Art. 2(3) (Brussels), Art. 2(5) (Paris). See, generally, W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 34–35 (Berne Art. 2/2bis, Rem. 4) (noting national variation of criteria for compilations).

¹⁸ TRIPs, Art. 10(2); W.C.T., Art. 5. See, e.g., C. Correa, “TRIPs Agreement: Copyright and Related Rights,” 25 I.I.C. 543, 546 (1994) (according to one interpretation, Berne already covered compilations of data); M. Ficsor, *The Law of Copyright and the Internet: The 1996 WIPO Treaties, their Interpretation and Implementation*, 483–484 (Oxford Univ. Press, 2002) (indicating the broad coverage confirmed by TRIPs as well as W.C.T. provisions).

¹⁹ See D. Vaver, “The National Treatment Requirements of the Berne and Universal Copyright Conventions,” 17 I.I.C. 578, 603–607 (1986).

²⁰ Berne, Art. 2(1) (Rome, Brussels, Paris). See H. Desbois, A. Françon, and A. Kéréver, *Les conventions internationales du droit d’auteur et des droits voisins*, paras. 21–22 (Dalloz, 1976).

²¹ TRIPs, Art. 10(1); W.C.T., Art. 4. See § 4[1][c][i][B] *infra*.

²² See Berne, Art. 2 (Paris); U.C.C., Art. I (Paris).

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covers. But these lists, it will here be explained, do not now generally make much difference for copyright in foreign works, but now rather in specific cases outlined below.²³ These lists were developed for sundry historical reasons and, especially in earlier Berne Acts, could have had significant impacts.²⁴ They may differ, with marginally varying effects, in self-executing treaty provisions and in domestic implementing legislation.²⁵ Where reciprocity or a bilateral treaty merely assures national treatment, the domestic list of the protecting country may come into play.²⁶

Here we touch on a delicate, but rare question: What impact on protection if the type of work at issue is ostensibly omitted from a treaty list of works?²⁷ Suppose that a type of work is not conventionally labeled in terms of any category used in a Berne or sequel list of “protected” works. National treatment will, of course, require coverage if the work meets domestic criteria of protectability, especially that of creativity.²⁸ It is submitted that, along with national treatment, the claimant may enjoy minimum rights with regard to any “unlisted” but domestically protected work.²⁹ In most cases, the work at issue can be easily recharacterized as falling within at least one of the categories set out in any applicable list: most works will be expressed in one or a number of literary, musical, or artistic media that all such lists recapitulate. Indeed, the Berne list has been updated in repeated revisions, introducing new categories such as cinematographic works, that is, audiovisual works, and the TRIPs Agreement and WIPO Copyright Treaty have also expanded the scope of the Berne list.³⁰ In any event, minimum rights are almost always implemented in domestic laws, so that national treatment will to that extent bring these rights with it.³¹

²³ See, e.g., § 4[1][c][i][A] *infra* (designs); § 4[1][c][ii] *infra* (sound recordings and other such media productions). See also § 4[1][c][iii] *infra* (further coverage outside copyright).

²⁴ See, e.g., H. Desbois, A. Françon, and A. Kéréver, *Les conventions internationales du droit d'auteur et des droits voisins*, paras. 10–11 (Daloz, 1976) (noting that there was no obligation to protect every type of work in the 1886 list); W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 34–35 (Berne Art. 2/2bis, Rems. 3 and 6) (Werner-Verlag, 1977) (questioning whether any obligation to accord minimum rights in works set out in the Berne list arose in the Berlin or later Acts).

²⁵ On this distinction between grounds of protection, see § 3[2][a] *supra*. *N.b.* lists of protected matters may differ between treaties and national implementing legislation only if the differences leave treaty protection intact. For further analysis, see § 5[1][a] *infra*. For example, some domestic laws may expand on such protection by according “copyright” in productions, like “phonograms,” not necessarily constituting “works” in all laws. For further analysis, see § 4[1][c][ii][A] *in fine*.

²⁶ *But see, e.g.*, the U.S.-German Agreement of 1892 (speaking of “works” and “photographs,” the latter term covering snapshots not necessarily qualifying as “works”).

²⁷ The Universal Copyright Convention appears to require protection of all types of works it lists plus those otherwise protected by copyright in the protecting country. See A. Bogsch, *The Law of Copyright Under the Universal Convention*, 8 (Sijthoff, 3d ed., 1968).

²⁸ On criteria of protectability, see § 4[1][a] *supra*. On the further requirement of eligibility by some specified national connection, see § 4[2] *infra*; on that of timeliness of protection, § 4[3] *infra*.

²⁹ On minimum rights, see § 5[4][a][i] *infra*.

³⁰ On this broadening of coverage, see § 4[1][a] *supra*.

³¹ On the usual implementation of such rights, see § 5[4][a][ii] *in fine infra*.

That said, we need to consider this question at a theoretically more basic level. Some commentators argue that only if a type of work is named on the Berne list is it protected by Berne minimum rights.³² However, this reading, based on the historical association of certain rights with certain types of works, for example, performance rights with dramatic and musical works, seems strained in practice now that digital technology leads to the convergence of media.³³ Furthermore, the language of the Paris Act of the Berne Convention, incorporated by the TRIPs Agreement, does not clearly limit the obligation to accord minimum rights to any exhaustively enumerated list of works.³⁴ Accordingly, whether or not a type of work may be squeezed into a category on a treaty list, it seems sufficient for a protecting country to protect it as a “work” by copyright for it to attract Berne minimum rights.³⁵

Some rather different Berne provisions nominally allow the exclusion of certain subject matters from coverage, albeit in what may be read as disguised limitations or exceptions.³⁶ Article 2(8) of the Paris Act of Berne declares that the “news of the day” need not be protected, ostensibly to the extent that news items tend to lack protectability because they are devoid of originality or creativity.³⁷ Articles 2(4) and 2*bis* of the Paris Act of Berne allow an adhering country to protect or not, depending on what its national law specifies, otherwise protectible legal, legislative, and administrative texts officially made or translated, as well as political speeches and those made in legal proceedings, and to limit the protection of other speeches against use in the press.³⁸

³² See, e.g., W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 32–35 *passim* (Berne Art. 2/2*bis*, Rems. 2–3 and 6) (Werner-Verlag, 1977) (stressing that the production at issue must, at the threshold, be found to be a “work” itself attracting copyright).

³³ See B. Edelman, “L’oeuvre multimédia, un essai de qualification” (The Multimedia Work, an Attempt at Characterization), *Recueil Dalloz Sirey* (chronique), 1995, no. 15, 109; P.E. Geller, “The Universal Electronic Archive: Issues in International Copyright,” 25 *I.I.C.* 54, 57–58 (1994).

³⁴ See, e.g., Report of the W.T.O. Panel, China—Measures Affecting the Protection and Enforcement of Intellectual Property Rights, WT/DS362/R, Jan. 26, 2009, paras. 7.104–7.119 *passim* (assessing the extension of minimum Berne rights generally in “works of creative authorship,” with variations only pursuant to the specific formulation of each such right).

³⁵ See J. Blomqvist, *Primer on International Copyright and Related Rights*, 81–84 (Edward Elgar, 2014).

³⁶ See H. Desbois, A. Françon, and A. Kéréver, *Les conventions internationales du droit d’auteur et des droits voisins*, paras. 167–168 (Dalloz, 1976). On limitations and exceptions generally, see § 5[4][a][i] *infra*.

³⁷ See, e.g., the *Tank Man II* decision, Constitutional Court (Slovak Republic), Sept. 30, 2014, Case II US 647/2014, para. 35, English trans. in 46 *I.I.C.* 729 (2015) (thus interpreting Berne Article 2(8), while noting that the commentary generally treats it as setting out a “pseudo limitation” rather than an exception) (also noted in § 2[2][b][iii] *supra*).

³⁸ See also Berne, Art. 2*bis* (Rome), Art. 2(2) *in fine* (Brussels) (only relative to translations of legal, legislative, and administrative texts), and Art. 2*bis* (Brussels).

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[c] At the Margins: Designs; Other Productions

We have seen national copyright laws respond diversely to subject matters at the margins of the field.³⁹ On the one hand, they vacillate in protecting designs and technologies taking shape as creative works; on the other, related rights, weaker than copyright, protect performances and other media or data productions.⁴⁰ We shall here sort out coverage of the following: (i) designs, computer programs, and integrated circuits; (ii) performances, phonograms, and broadcasts; and (iii) other miscellaneous productions.

[i] Industrial Designs; Computer Code and “Chips”

Distinct treaty regimes have classically protected intellectual property internationally.⁴¹ The Paris Convention does so for industrial property, with rights *inter alia* in foreign designs and technologies. The Berne Convention only conditionally extends copyright in foreign designs incorporated in works and does not mention computer programs. Moreover, the Paris and Berne regimes, considered together, fail to coordinate fully the treatment of foreign claims in such hybrid matters.⁴² Rather, these risk falling sporadically on one side or the other of the divide between industrial property and copyright. We shall here outline how such regimes cover (A) designs, (B) computer programs, and (C) integrated circuits.

[A] Design Works

What type or types of protection may be available to protect a foreign design in a given country? This question can be crucial: copyright may last longer than industrial property that may be subject to formalities broached below.⁴³ Three alternative responses are possible under domestic and treaty laws: both forms of protection, copyright and some special design right, concurrently; some conditional mix of both; or one but not the other.⁴⁴ The Berne Convention has made successive, but only partially successful attempts to put some order internationally into this welter of diverse national approaches to applying, or not applying, copyright to designs.⁴⁵ The

³⁹ On the copyright-protected core of works, with its wavering margins, see § 2[2][a][i] *supra*.

⁴⁰ On ambivalent copyright in designs, software, etc., as well as copyright-related rights in other productions, see § 2[2][a][ii] *supra*.

⁴¹ *But compare* TRIPs, Arts. 9–14 (copyright and neighboring rights), *with id.*, Arts. 25–38 (rights in designs, patents, and integrated-circuit designs).

⁴² See J.H. Reichman, “Charting the Collapse of the Patent-Copyright Dichotomy: Premises for a Restructured International Intellectual Property System,” 13 *Cardozo Arts & Entertainment L.J.* 475 (1995).

⁴³ See § 5[3][b] *infra*.

⁴⁴ For country-by-country analyses, see the chapters on national laws herein, at § 2[4][c]; E. Derclaye (ed.), *The Copyright/Design Interface: Past, Present and Future* (Cambridge Univ. Press, 2018).

⁴⁵ For this history, see S. Ricketson and J. Ginsburg, *International Copyright and Neighbouring Rights: The Berne Convention and Beyond*, vol. 1, paras. 8.59 *et seq.* (Oxford Univ. Press, 2006).

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TRIPs Agreement and WIPO Copyright Treaty incorporate the latest Berne provision, that in its Paris Act, with regard to copyright claims in foreign designs.⁴⁶

The Berne Convention includes what it calls “works of applied art” in the list of works which Article 2 enumerates as protected. Then it considers these works along with “industrial designs and models” in conditioning Berne protection of what we shall generically call *design works*.⁴⁷ Its Brussels Act, in Article 2(5), mandated protecting such works by copyright subject to a condition of reciprocity: no Berne copyright would be available in any such work if, in its country of origin, it were protected only by some other right, like a special design right.⁴⁸ This former solution left open the possibility that a design work protected in its country of origin solely by industrial property would not be protected at all in another Berne country lacking any regime of industrial property to protect it. To fill this gap, while maintaining the condition of reciprocity, the Berne Convention, in Article 2(7) of its Paris Act, requires that a design work, when at issue in a protecting country without industrial property in designs, be deemed to be an “artistic work” there and protected as such by copyright.⁴⁹

The pertinent Berne provision does not govern copyright in designs within the country of origin of any work at issue.⁵⁰ In any protecting country, it may, but need not, be implemented by domestic provisions to condition copyright protection of any design work.⁵¹ On the one hand, domestic law will control results in a country where treaties are implemented by local law, notably those in the British and Scandinavian traditions.⁵² On the other hand, where the pertinent Berne provision is applied as a self-executing provision, courts may well reach different responses to the following question from case to case: Is the foreign design at issue protected by copyright law in its country of origin? For example, applying the Berne provision on point, a Belgian court accorded Belgian copyright in furniture designed by the U.S. nationals Charles

⁴⁶ Unlike Berne and these successor treaties, the Universal Copyright Convention does not expressly attempt to coordinate copyright with design rights, but leaves the issue to national treatment. See W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 39–40 (Berne Art. 2/2bis, Rem. 13) and 171–172 (U.C.C. Art. I, Rem. 4) (Werner-Verlag, 1977).

⁴⁷ *I.e.*, creative works possibly “applied” in the “industrial” fabrication of often-useful, but sometimes aesthetically appealing articles, on the basis of “models,” plans, code, etc. For definitions of these terms quoted in the text and this note, see World Intellectual Property Organization, *WIPO Glossary of Terms of the Law of Copyright and Neighboring Rights*, nos. 9, 72, 156 (WIPO, 1980).

⁴⁸ The country of origin of a work is, generally, that of its first publication or that where its author is a national if it is unpublished. On determining the country of origin more specifically in a variety of special cases, see § 4[3][b][ii] *infra*.

⁴⁹ Article 2(7) of the Paris Act is “[s]ubject to the provisions of Article 7(4),” assuring that “works of applied art in so far as they are protected as artistic works” obtain a minimum copyright term of “twenty-five years from the making of the work.”

⁵⁰ On this principle governing when treaty provisions rights apply, see § 5[4][a][ii] *infra*.

⁵¹ On the implementation versus direct application of treaty provisions, see § 3[2][a] *supra*.

⁵² See, *e.g.*, the *Mini Maglite* decision, Supreme Court (Sweden), *Nytt Juridiskt Arkiv* 2009, 159 (confirming that Swedish copyright law protected the functional design of a flashlight of U.S. origin, on the basis of local criteria of protection).

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and Ray Eames upon finding that the design works at issue were protected by copyright in the United States, the country of origin.⁵³ In another such case, a French court refused to accord French copyright in designs for sunglasses originating in the United States for failure to meet U.S. criteria for protecting designs with copyright.⁵⁴

In any case subject to this Berne solution, what must a claimant show about copyright in the country of origin with regard to the design at issue? Absent frequent adjudication of such copyright, it could prove hard to find case law for assessing protectability in the country of origin of the claimed work. In that event, a court may try to give *effet utile* to the Berne provision by taking account of how statutory language or at least the doctrine approaches design works in the country of origin.⁵⁵ If, however, there is case law on point, it will be relevant for deciding whether any work like that at issue is protected “solely” by industrial property as a design, or concurrently or in the alternative by copyright, in the country of origin.⁵⁶

These Berne issues do not arise for any E.U. or E.E.A. national seeking protection in any member state, as explained above.⁵⁷ Under the E.U. principle of non-discrimination, such authors obtain full national treatment in member states for copyright in design works they create.⁵⁸ In addition, the European Union has established distinct regimes of industrial property in unregistered and in registered designs, while somewhat harmonizing criteria of copyright-protectible matter in designs.⁵⁹

[B] Computer Programs

Article 10(1) of the TRIPs Agreement and Article 4 of the WIPO Copyright Treaty in principle compel protecting “computer programs [. . .] *as*” the Berne Convention protects “literary works.” Those provisions couple this weasel word “as,” here italicized, with caveats precluding any disqualification of computer programs for such protection on the pretext that, in TRIPs terms, they are set out in “source or object code,” or else, in more abstract WIPO words, they take on any specific “mode or form”

⁵³ Sté. Vitra Collections c. S.A. C&M Cadsana, Trib. de 1^e instance, 4^e ch., Brussels (Belgium), Oct. 6, 1995, Ing.-Cons. 1996, 124. *But see, e.g.*, Henri Studio Inc. c. B.V.B.A. Bouw Remie De Witte, Trib. Ghent (Belgium), Jan. 10, 1996, *Revue de droit commercial* 1997, 33, note M.P. Sender (rather applying the Berne provision on national treatment).

⁵⁴ S.A. Decathlon c. Sté. Oakley, CA Paris, 4^e ch., Jan. 24, 1997, J.C.P. E. 1999, 369.

⁵⁵ On thus construing treaty provisions generally, see § 3[4][b][ii] *supra*.

⁵⁶ *See, generally*, J.H. Reichman, “Design Protection and the New Technologies: The United States Experience in a Transnational Perspective,” 30 *Industrial Property* (Part I) 220, (Part II) 257 (1991) (surveying uneven legislation on point).

⁵⁷ *See* § 3[3][a][ii][A] *supra*.

⁵⁸ *See, e.g.*, *Tod’s SpA and Tod’s France SARL v. Heyraud SA*, E.C.J., June 30, 2005, Case C-28/04, [2005] E.C.R. I-5781, [2005] E.C.D.R. 457 (holding that the E.U. principle of non-discrimination precluded France from applying Berne Art. 2(7) to bar copyright in a design originating in Italy, which may not have protected the design at issue with copyright).

⁵⁹ *See* “European Union,” herein, at § 4[3][c]. *See also* § 2[2][a][ii] *supra* (noting persisting differences in such criteria of protectability as applied in case law).

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of “expression.” However, if computer programs were merely “literary” works, albeit highly prosaic and obscurely coded, like instructions in esoteric languages for operating appliances, industrial property would arguably not be available in them. It remains unclear how to deal with their mix both as technology and as text, much less as images like flow-charts.⁶⁰

Treaty fiat, such as we just quoted, might only confuse the analysis of protectability issues we have already broached.⁶¹ To start, computer programs represent one of a number of hybrid creatures that the law of intellectual property has not yet fully tamed.⁶² Like industrial designs, computer programs often serve utilitarian functions, implying that industrial property, notably patents or like rights, may conditionally protect their functional aspects in appropriate cases.⁶³ Further, computer programs often find their way from code into diverse embodiments that, on the surface, risk falling under different categories in terms of the Berne list of works: for example, screen displays or other features of user interfaces might qualify, *inter alia*, as “cinematographic,” that is, audiovisual, works.⁶⁴

[C] Integrated Circuits

Layout designs of integrated circuits, embodied in semiconductor chips, may be protected by *sui generis* rights. The TRIPs Agreement, binding most countries, spells out the minimum requirements for the protection of foreign layout designs, and allows domestic formalities like registration.⁶⁵ Under many laws, such designs, independently of any computer program that they incorporate, may not be protected cumulatively by both copyright and such rights.⁶⁶ Case law on enforcement of these *sui generis* rights is sparse.⁶⁷

⁶⁰ *But see* M. Ficsor, *The Law of Copyright and the Internet: The 1996 WIPO Treaties, their Interpretation and Implementation*, 475–479 (Oxford Univ. Press, 2002) (arguing against treating computer programs like design works under Berne provisions).

⁶¹ *See* § 2[2][a][ii] *supra*.

⁶² *See* J.H. Reichman, “Legal Hybrids Between the Patent and Copyright Paradigms,” 94 *Columbia L. Rev.* 2432 (1994).

⁶³ *See, generally*, R. Knights and C. Redinger, “Patent Eligibility of Software Patents in the U.S. and Europe: A Post-Alice Consideration,” *Landslide* (ABA) (2015), vol. 8 (no. 1) (comparing U.S. and E.U. conditions of patentability for software-related technologies).

⁶⁴ *See, e.g.*, *Bezpečnostní softwarová asociace v. Ministerstvo kultury*, C.J.E.U., 3rd ch., Dec. 22, 2010, Case C-393/09, paras. 38–51, [2011] E.C.D.R. 70 (finding no computer program as such “expressed” in a user interface, while admitting possible protection of the interface by copyright to the extent that it was not “dictated by” any “technical function”).

⁶⁵ TRIPs, Arts. 1(3) and 35–38 (incorporating eligibility criteria and provisions of the Washington Treaty on Intellectual Property in Respect of Integrated Circuits, concluded on May 26, 1989). For the text of the Washington Treaty, see http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=295136.

⁶⁶ *See* T. Dreier, “Development of the Protection of Semiconductor Integrated Circuits,” 19 *I.I.C.* 427, 456 (1988). *See also* L. Radomsky, “Sixteen Years after the Passage of the U.S. Semiconductor Chip Protection Act: Is International Protection Working?,” 15 *Berkeley Technology L.J.* 1049 (2000) (analyzing rights in the light of industry practice).

⁶⁷ *See, e.g.*, *Altera Corp. v. Clear Logic, Inc.*, 424 F.3d 1079 (9th Cir. 2005) (U.S.) (vindicating the

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[ii] Performances, Phonograms, and Broadcasts

A work can be exploited in such media productions as performances, recordings, broadcasts, etc. While creative works are covered by the Berne Convention and other treaties, specified media productions, conceptually distinct from such works, are covered by the Rome Convention and other treaties that have been canvassed above.⁶⁸ How to disentangle what is covered by provisions that furnish grounds for copyright protection, on the one hand, from coverage by such provisions for neighboring or related rights, on the other? We shall here (a) sort out how these provisions apply despite confusing nomenclature and (b) illustrate ensuing coverage with hypothetical examples.⁶⁹

[A] Coverage of Specified Media Productions

Return to the basic distinction, drawn above, between creative works and media productions like performances, recordings, or broadcasts.⁷⁰ On the one hand, as just explained, grounding provisions for copyright cover works that meet domestic criteria of originality or creativity.⁷¹ On the other hand, grounding provisions for neighboring or related rights cover specifically designated media or data productions that can, but need not always, disseminate creative works. We shall here focus on neighboring rights in performances, sound recordings, and broadcasts, for which treaty coverage is rather complete worldwide, though some nomenclature is not globally consistent. In English we commonly speak of the act of “recording” human performances, naturally occurring sounds, etc., and then of the resulting “master recording,” historically called the *first fixation*, of such contents. The word of art *phonogram* is most strictly applied to such fixations of sounds alone, with “copies” or “duplicates” being marketed in disks, tapes, etc.⁷² Case law now recognizes that the digital recording of sounds may be treated as resulting in phonograms, with or without generating hard copies.⁷³

The coverage of any such media production varies with the grounding provision invoked to protect it. Since multilateral treaties structure neighboring rights internationally, let us start with their coverage. A live performance or sound recording, independently of any creative work either conveys, falls under the Rome Convention,

sui generis right upon holding that defendant’s chip was substantially identical to plaintiff’s chip because it retained the same physical organization).

⁶⁸ Compare §§ 3[3][b] (copyright), with 3[3][c] *supra* (neighboring rights).

⁶⁹ On which treaty provisions on point applies in cases of tensions between them, see § 5[1][b] *infra*.

⁷⁰ See § 2[2][a] *supra*.

⁷¹ See § 4[1][a][i] *supra*.

⁷² See, generally, J. Malbon, C. Lawson, and M. Davison, *The WTO Agreement on Trade-related Aspects of Intellectual Property Rights: A Commentary*, 266–272 (Edward Elgar, 2014) (clarifying senses of “recording” and “phonogram” in TRIPs and related treaties).

⁷³ See, e.g., *Spedidam c. société iTunes*, Cass., 1^e ch. civ. (France), Sept. 11, 2013, JurisData no. 2013-018957 (confirming that Rome and W.P.P.T. coverage of “phonograms” does not depend on any tangible medium of fixation, like disks or cassettes, but extends to digitally coded data).

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the TRIPs Agreement, or the WIPO Performances and Phonograms Treaty.⁷⁴ Each of these treaties assures rights in live performances that present works, or in some cases simply staged routines or folklore, by acting, dancing, singing, playing instruments, or other such personal rendition.⁷⁵ They also assure neighboring rights in the first authorized fixations of works, but only as aurally performed, or first fixations of sounds alone, in either event effectively master sound recordings, that is, phonograms, but not necessarily rights in any film or other audiovisual soundtrack.⁷⁶ Phonograms may also come under the Geneva Convention which allows for protecting them by copyright, neighboring rights, or other rights.⁷⁷ Similarly, over-the-air broadcasts, even if not conveying works, may be covered by Rome, TRIPs, or special broadcast treaties.⁷⁸ Or, as already explained, there may be the option of protecting such media productions unilaterally or by virtue of reciprocity.⁷⁹

At the level of national laws, diverging nomenclatures may raise questions of coverage. On the one hand, some laws vary their labels for what others call “neighboring rights,” for example, protecting what they call “copyright” in sound recordings.⁸⁰ On the other hand, most countries protect live performances, phonograms, and broadcasts with what, consistently with international usage, they call “neighboring,” “connected,” or like related rights. Sometimes, but not always, the differences in the nomenclature for copyright-related rights in such media productions correspond to differences in the duration and scope of protection of these rights.⁸¹ In

⁷⁴ Rome, Arts. 2–5, 9; TRIPs, Art. 14; W.P.P.T., Arts. 2–3, and Agreed Statements concerning Arts. 2(b) and 3(2).

⁷⁵ Compare W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 277–280, 308–309 (Rome Art. 3, Rems. 1–4; Art. 9, Rem. 1) (Werner-Verlag, 1977) (noting that Rome coverage of performances may be nationally expanded to include those of stage or like routines unprotected by copyright), with M. Ficsor, *The Law of Copyright and the Internet: The 1996 WIPO Treaties, their Interpretation and Implementation*, 596 (Oxford Univ. Press, 2002) (noting that the W.P.P.T. also covers performances of folklore by its own terms).

⁷⁶ See, e.g., *Re: Sound v. Motion Picture Theatre Associations of Canada*, 2012 SCC 38 (Canada) (holding that the exclusion of recordings as incorporated in film soundtracks was consistent with Rome obligations but that, “if a pre-existing sound recording is extracted from a soundtrack accompanying a cinematographic work, it once again attracts the protection offered to sound recordings”).

⁷⁷ Geneva, Art. 1. See § 3[3][c][iii] *supra*. But see W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 346 (Geneva Art. 1, Rems 1–2) (Werner-Verlag, 1977) (noting that, in the Geneva text, “phonogram” covers the “aural fixation,” effectively the master sound recording, of “a performance or other sounds,” excluding audiovisual recordings, while it speaks of “duplicates” of this recording).

⁷⁸ Rome, Arts. 2–3, 6; TRIPs, Art. 14. See §§ 3[3][a][i] and 3[3][c] *supra*.

⁷⁹ See §§ 3[2][b] and 3[2][c] *supra*.

⁸⁰ See, e.g., United States, Copyright Act, 17 U.S.C. § 106(4)–(6) (not subjecting “sound recordings,” protected by “copyright,” to any general right to perform “publicly”); *id.*, § 1101(a) (providing copyright remedies against the “unauthorized” fixation, marketing of resulting fixations, or communication to the public of “live musical performances”).

⁸¹ See, e.g., W. Nordemann, “The Principle of National Treatment and the Definition of Literary and Artistic Works,” *Copyright 1989*, 300, at 304–305 (noting variations in whether national laws call

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theory, one could question whether the term “works,” as found in the Berne Convention or other treaties, covers such subject matters, notably phonograms or related productions, even though a few domestic laws still call them “works” or recognize what they call “copyrights” in them.⁸² In practice, countries using any such eccentric terminology for rights in performances, recordings, etc., may well implement their treaty obligations in domestic legislation that expressly sorts out coverage in so many words.⁸³

[B] Works Disentangled from Media Productions

In principle, the copyright protection of any work may not be impaired by the protection of neighboring or related rights in any media or data production.⁸⁴ Hence, at the threshold of any inquiry into coverage, we need to distinguish any work from any performance, recording, or telecommunication in which this work is embodied or released to the public. Inquiry here has to determine whether the content at issue meets domestic criteria of originality and creativity that allow for protecting works by copyright or authors’ rights.⁸⁵ If the content does meet these criteria, it attracts copyright, that is, such rights as would be accorded any author, whether under domestic or treaty provisions. Even then, copyright protection may only be complemented by protection by neighboring or related rights in any media production conveying the work.⁸⁶

Consider this hypothetical: To start, a writer creates a poem. Further, a composer sets this text to music creatively as a song, and musicians and a singer, together in a jazz group, creatively improvise on the song in the course of their performance, notably by varying text, melodic lines, chord structures, and rhythms. Finally, a phonogram producer records the jazz version arising as the group creates and performs it, all at the same time, but neither the producer nor its technicians creatively reprocess this version in any way. Assume that each of these parties consents to what those further down the line do here and to the producer’s marketing of any resulting phonogram to the public worldwide. It would not suffice to ask how such contents or

recordings “works” or not, without or with qualifications, and protect them with “copyrights” as such, by “copyright” akin to “neighboring” rights, or only by such “related” rights).

⁸² Compare D. Vaver, “The National Treatment Requirements of the Berne and Universal Copyright Conventions,” 17 I.I.C. 578, 598–601 and 725–727 (1986) (arguing against coverage by Berne or U.C.C. of productions not meeting any definition of a “work” implicit in the Convention), with W. Nordemann, “The Principle of National Treatment and the Definition of Literary and Artistic Works,” Copyright 1989, 300 (arguing for the possible Berne or U.C.C. coverage of a sound recording where it is treated as a “work” in the law of a protecting country).

⁸³ See § 3[2][d] *supra*.

⁸⁴ See, e.g., Rome, Art. 1 (“Protection granted under this Convention shall leave intact and shall in no way affect the protection of copyright in literary and artistic works. Consequently, no provision of this Convention may be interpreted as prejudicing such protection.”); W.P.P.T., Art. 1(2) (tracking this language).

⁸⁵ On the criteria of the protected core of any work, see § 2[2][a][i] *supra*. On treaty indication of such criteria, but their elaboration in domestic law, see § 4[1][a] *supra*.

⁸⁶ *I.e.*, subject to the primacy of copyright. See § 5[1][b][ii] *infra*.

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contributors are conventionally or legally designated to know how to protect any work or media production at issue here. For example, an original and creative improvisation by jazz “performing artists,” though taking off from prior works, might well generate a further, albeit derivative, work.⁸⁷

The following distinction may help to sort out coverage and rights in our hypothetical: On the one hand, the poem and song may each constitute a work attracting copyright, as may the jazz version itself insofar as it is a work creatively derived from the song. On the other hand, the jazz group’s live performance of the song, whether this rendition is creative or not, may be protected by a neighboring right, as may be the phonogram producer’s recording.⁸⁸ This distinction could have manifold consequences for the scope of protection, notably for licensing the respective contributions of the poet, composer, jazz group, and producer. Suppose that the producer releases the phonogram to the public, and a broadcaster wants to broadcast it to the public: the broadcaster needs to obtain the authors’ consent, including that of the jazz group insofar as its version is creative. But the broadcaster may need no consent from the jazz group as a group of performers, nor from the producer of the phonogram, but need only pay them royalties.⁸⁹

[iii] Miscellanea: Snapshots, Videograms, Databases, Etc.

Go on to further media or data productions that have not just been canvassed.⁹⁰ These might include, for example, snapshots, videograms, database contents, etc. If not found original or sufficiently creative to attract copyright, such productions may be protected by copyright-related rights that, outside the European internal market, vary considerably from country to country. However, without a multilateral treaty to cover such a foreign media or data production, it may not be protected in most countries.⁹¹ At best, protection abroad may be unilateral or based on reciprocity, on bilateral or regional treaties, or on E.U. grounds.⁹²

Consider, to start, photographs lacking originality or minimal creativity: snapshots, quite simply. In general, national laws do not extend copyright to protect such “mere” or “simple” photographs or “photographic pictures.”⁹³ A few statutes do rather grant

⁸⁷ See W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 280 (Rome Art. 3, Rems. 6) (Werner-Verlag, 1977).

⁸⁸ But, for the minority approach of designating this right as a “copyright” in a few countries, see § 4[1][c][ii][A] *in fine supra*.

⁸⁹ On the Rome license to broadcast recorded performances against remuneration, see § 5[4][a][i] *infra*.

⁹⁰ On designs, see § 4[1][c][i] *supra*; on performances, phonograms, and broadcasts, see § 4[1][c][ii] *supra*.

⁹¹ The Vienna Agreement for the Protection of Type Faces and their International Deposit never entered into effect. Also, in connection with the WIPO Treaties, an effort was made, but failed, to include provisions to protect database contents. See P. Samuelson, “The U.S. Digital Agenda at WIPO,” 37 *Virginia J. of International Law* 369, 418–427 (1997).

⁹² For such grounds, see, respectively, §§ 3[2][b], 3[2][c], and 3[3][a][ii][A] *supra*.

⁹³ For further analysis, see Y. Gendreau, *La protection des photographies en droit d’auteur français*,

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weaker copyright-related rights in even cursorily or mechanically taken snapshots without creativity, but neither Berne nor any other international convention covers such photographs by its own terms. Rarely, national implementation may assure copyright-related rights in any foreign snapshot meeting some requisite criterion of eligibility.⁹⁴ Under the E.U. principle of non-discrimination, E.U. photographers may also obtain national treatment as to such rights.⁹⁵ Reciprocity or a bilateral treaty, notably the U.S.-German Agreement of 1892, may cover “photographs” and thus snapshots.⁹⁶

A comparable approach may be followed for other such media or data productions.⁹⁷ Some laws accord related rights in videograms, that is, master recordings of visual contents, whether or not accompanied by sounds and whether or not creative.⁹⁸ Furthermore, E.U. member states, along with other countries outside Europe, provide *sui generis* rights in the informational contents of databases on specified conditions.⁹⁹ Diverse other productions are also protected, some in some countries and some in others, for example, new and critical editions of public-domain works, materials from the press, typographical formats, technical plans, sporting events, etc. However, absent some special basis of protection, notably in reciprocity or E.U. grounds, such productions risk falling between the cracks of the treaty framework.¹⁰⁰

Of course, if any such production met criteria of original and creative contents protected within “works,” Berne or another copyright treaty would cover such works.¹⁰¹ Only in rare tort actions, broached above, may unilateral protection of limited scope be available for very specific foreign claims in non-original matters that

américain, britannique et canadien (Copyright Protection for Photographs in French, American, British, and Canadian Law), 47–82 *passim* (L.G.D.J., 1994).

⁹⁴ See, e.g., Sweden, International Copyright Regulation, Secs. 5, 10, and 23 (granting related “rights in photographic pictures” on stated conditions).

⁹⁵ On such national treatment, see § 3[3][a][ii][A] *infra*.

⁹⁶ See W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 8–9 (Intro., Rem. 10) and 34 (Berne Art. 2/2bis, Rem. 3) (Werner-Verlag, 1977).

⁹⁷ *I.e.* productions not classifiable as performances, phonograms, or broadcasts. On these categories, see § 4[1][c][ii] *supra*.

⁹⁸ Outside the E.U. regime of related rights, such audiovisual productions have most often been protected only for claimants qualifying in the countries nationally granting them. The Beijing Treaty on Audiovisual Performances is intended to fill this gap somewhat by internationally assuring minimum rights in “audiovisual fixations” of performances. For text and adherences, see <http://www.wipo.int/treaties/en/ip/beijing/>.

⁹⁹ See, e.g., Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases, Art. 11, O.J. 1996 L 077 (extending *sui generis* database rights to enterprises with requisite European headquarters).

¹⁰⁰ See, e.g., P. Goldstein and P.B. Hugenholtz, *International Copyright: Principles, Law, and Practice*, § 4.2.2.2. at 108–110 (Oxford Univ. Press, 3d ed., 2013) (doubting that the TRIPs Agreement, as incorporating the Paris Convention, covers database contents).

¹⁰¹ For designs that, although creative works, may only be conditionally protected under the Berne Convention, see § 4[1][c][i][A] *supra*.

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no copyright treaty covers.¹⁰² In any event, the E.U. principle of non-discrimination applies to rights in such productions as are made by nationals of member states.¹⁰³

[2] Does the Work or Production Satisfy Any Eligibility Criterion?

A foreign work or production has to meet a *criterion of eligibility* to be protected by copyright or a related right outside its home country.¹⁰⁴ Such a criterion is commonly said to be satisfied if the work or production at issue displays a “factor” which “connects” it to a specified jurisdiction.¹⁰⁵ Such criteria will here be canvassed as calling for (a) personal factors like nationality and (b) geographical factors like place of first publication.¹⁰⁶

[a] Nationality of Author or Other Maker

We shall here (i) indicate how different types of grounding provisions set out so-called personal factors, each of which may meet a criterion making a foreign work or production eligible for protection by copyright or related rights. Such grounding provisions for copyright protection itself typically include the factor of an author’s nationality, but without necessarily defining the term “author.” We shall then have to (ii) resolve the problem of defining any author whose national status at least justifies protecting a foreign work.¹⁰⁷

[i] Alternative Personal Factors

Generally, a grounding provision may set out some criterion of eligibility satisfied by nationality. Such a criterion focuses on the natural or legal person authoring or

¹⁰² See § 3[2][b] *in fine supra*. A claimant may also invoke Article 2 of the TRIPs Agreement, which incorporates Article 10*bis* of the Paris Convention.

¹⁰³ See, generally, § 3[3][a][ii][A] *infra* (on resulting national treatment).

¹⁰⁴ *N.b.*, in rare cases, where there is unilateral protection under a general principle or provision of law, no specific grounding provision and, therefore, no criterion of eligibility need come into play. See § 3[2][b] *supra*.

¹⁰⁵ *Caveat*: This term, a *connecting factor*, has distinct senses. Here it signifies a fact that meets a criterion making a foreign work or production eligible for protection. In conflicts analysis, however, it designates a fact that so connects a territorial jurisdiction to an issue that its law is chosen to govern that issue. For example, the *situs* of tortious conduct itself, especially as completed in resulting harm, may determine which country’s tort law is dispositive of any ensuing tort claim. See § 3[1][b][i][B] *supra*.

¹⁰⁶ *N.b.* the TRIPs Agreement incorporates Berne eligibility criteria for works and Rome criteria for performances, phonograms, and broadcasts, as the WIPO Copyright Treaty does for works and the WIPO Performers and Phonograms Treaty for performances and sound recordings. Of course, in the TRIPs Agreement and the WIPO “Internet” Treaties, the incorporated eligibility criteria are satisfied by the connecting factors they designate, but only relative to jurisdictions adhering to each, respectively.

¹⁰⁷ *Caveat*: Treaty protection may, for diplomatic reasons, be exceptionally denied to a work or production ostensibly satisfying an eligibility criterion. See, e.g., the *Mitsurei 27* decision, Korea Motion Picture Export-Import Co. v. KK Fuji Television, 65-9 Minshu 3275 (Supreme Court, Dec. 8, 2011) (Japan), in English trans. in 45 I.I.C. 720 (2014) and at http://www.courts.go.jp/app/hanrei_en/detail?id=1284 (refusing to protect a film ostensibly satisfying some Berne criterion of eligibility, to wit, with nationals of North Korea, which Japan had not diplomatically recognized) (also noted under § 3[2][b] *supra*).

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making a work or else delivering a performance or making some other production at issue. That person has to be a national of some country which the provision specifies or, if a legal person or entity, may at least be headquartered in the country. The English usage of “national” here corresponds to the French term *ressortissant*, which may include parties like refugees “under the jurisdiction” of the country in question.¹⁰⁸

Some domestic laws unilaterally protect works or related productions by authors or makers who are residents of the protecting country itself.¹⁰⁹ Furthermore, an E.U. or E.E.A. national who authors a work, delivers a performance, or makes some other media or data production obtains full national treatment as to rights in that work or production in other member states.¹¹⁰ As often codified in E.U. legislation, it may suffice to obtain such treatment for the claimant to be headquartered in a member state.¹¹¹ As explained below, retroactive protection under E.U. law may be available on other bases in rare cases.¹¹²

Other copyright grounding provisions call for an author who is a national of a country with which the protecting country has some reciprocity or treaty relationship. For example, the bilateral U.S.-German Agreement of 1892 refers to authors who are “citizens” of the United States or German “subjects.”¹¹³ The Berne Convention has expanded the author’s role: Article 3(1)(a) of its Paris Act qualifies a work, whether unpublished or wherever published,¹¹⁴ for protection if it is created by an author who is a “national” of a Berne country, and Article 3(2) assimilates non-Berne authors who are “habitual” residents of a Berne country to such nationals.¹¹⁵ Article 4 of the Paris Act also extends protection, absent any requisite author, to a cinematographic work

¹⁰⁸ See, generally, Convention relating to the Status of Refugees (Geneva, July 28, 1951) and Convention relating to the Status of Stateless Persons (New York, Sept. 28, 1954) (respectively confirming that, with regard to intellectual property among other rights, a refugee or stateless person is to be treated as the “national” of the country in which he has established residence).

¹⁰⁹ See § 3[2][b] *supra*.

¹¹⁰ See, generally, § 3[3][a][ii][A] *supra* (noting the extension of this principle in the European Economic Area). See, e.g., *Phil Collins v. Imtrat Handelsgesellschaft mbH*, E.C.J., Oct. 20, 1993, Joined Cases C-92/92 and C-326/92, [1993] 3 C.M.L.R. 773 (as discussed in § 3[3][a][ii][A] *supra* and in §§ 4[3][a][i][C] and 5[1][c][i] *infra*).

¹¹¹ See, e.g., Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases, Art. 11, O.J. 1996 L 077 (as to database rights). See also the *BBC International* decision, OLG Munich (Germany), June 30, 2011, ZUM 2012, 54 (allowing an E.U. affiliate of a U.S. broadcaster to assert a neighboring right in Germany).

¹¹² See § 4[3][a][i][C] *in fine infra*.

¹¹³ See “Germany,” herein, at § 6[3].

¹¹⁴ Prior to and including its Brussels Act, the Berne Convention only protected a work with an author who was a national of a Berne country if that work was “unpublished” altogether or it had been “first published” in a Berne country. See Berne, Art. 4(1) and 5 (Rome, Brussels). See also § 4[2][b][ii] *infra* (on Berne “first publication”).

¹¹⁵ See H. Desbois, A. Françon, and A. Kéréver, *Les conventions internationales du droit d’auteur et des droits voisins*, para. 126 (Daloz, 1976) (suggesting that, in the case of multiple residences, any one of them might count as a factor needed for eligibility).

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produced by a “maker” with its “headquarters” or “habitual residence” in a Berne country.¹¹⁶ The TRIPs Agreement incorporates these Berne criteria of eligibility by reference, as does the WIPO Copyright Treaty.¹¹⁷ The Universal Copyright Convention qualifies works by nationals from U.C.C. countries for protection.¹¹⁸

Eligibility criteria for neighboring rights vary according to the production at issue.¹¹⁹ The Rome Convention, oddly, does not protect a performance on the basis of the national status of any performing artist. It rather calls for protecting a performance if it takes place in a Rome country or if it is either recorded in a Rome-protected phonogram or, absent such recording, carried by a Rome-protected broadcast.¹²⁰ The Rome Convention in turn allows for the protection of a phonogram or of a broadcast if the producer of the phonogram, or if the organizer of the broadcast, is a national of a Rome country, say, if it is headquartered there.¹²¹

The TRIPs Agreement incorporates Rome criteria of eligibility for performances, phonograms, and broadcasts, respectively.¹²² The WIPO Performances and Phonograms Treaty fills a Rome gap in protecting performances delivered by, as well as phonograms made by, “nationals” of adhering parties.¹²³ Otherwise, albeit with caveats, this WIPO “Internet” Treaty also incorporates the Rome criteria for performers and for producers of phonograms.¹²⁴ The Geneva Phonograms Convention requires that the producer of the phonogram at issue be a national of an adhering country.¹²⁵

¹¹⁶ See C. Masouyé, *Guide to the Berne Convention*, 30–31 (WIPO, 1978) (stating that the factual features such as the place of headquarters of a “maker” like “a film production company” were picked “in order to avoid all dispute about the nationality of legal entities, as well as to make clear that the ‘maker’ for this purpose may be such an entity”).

¹¹⁷ TRIPs, Art. 1(3); W.C.T., Art. 3. See also *id.*, Art. 17 and Agreed Statements concerning Art. 3 (including the European Union as an adhering intergovernmental organization).

¹¹⁸ U.C.C., Art. II (Geneva, Paris) (also allowing any adhering country to assimilate authors domiciled there to “its own nationals”). See also A. Bogisch, *The Law of Copyright Under the Universal Convention*, 13–16 (Sijthoff, 3d ed., 1968) (arguing that a U.C.C. country must protect a work authored by a national from another U.C.C. country, even though the work is first published within its territory).

¹¹⁹ *N.b.*, by notice to the organization administering the treaty in question, Rome eligibility criteria, also as incorporated by TRIPs and the W.P.P.T., may be restricted by adhering parties for purposes of their according protection. See § 4[2][b][i] *infra*.

¹²⁰ Rome, Art. 4. See also § 4[1][c][ii] *supra* (distinguishing “performance” and thus “performer” from “work” and “author”).

¹²¹ Rome, Arts. 5(1)(a) and 6(1)(a). See also Rome, Art. 3(c) (defining the producer of phonograms as the person or entity that “first fixes” sounds in a master recording).

¹²² TRIPs, Art. 1(3).

¹²³ W.P.P.T., Art. 3(1).

¹²⁴ W.P.P.T., Art. 3(2)–(3). But see M. Ficsor, *The Law of Copyright and the Internet: The 1996 WIPO Treaties, their Interpretation and Implementation*, 601–605 (Oxford Univ. Press, 2002) (doubting that W.P.P.T. protection extends to performances carried by any broadcast, since the W.P.P.T. does not cover broadcasts).

¹²⁵ Geneva, Art. 2. See also Geneva, Art. 1(b) (defining the producer of phonograms as the person or

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[ii] The Problem of Defining “Author”

What law defines the term “author” when eligibility for protection turns on the criterion of a putative author’s nationality? Unfortunately, neither Berne provisions nor other treaty grounding provisions define this key term expressly.¹²⁶ Often by default, the author in question tends to be determined by the law of the protecting country.¹²⁷ The reasons for this rule of thumb, along with proposed deviations from it, will here be analyzed.¹²⁸

This problem arises in a restricted range of cases. With some exceptions, all copyright laws consider as an author of a work any natural person who actually creates what copyright protects: the writer of text; the composer of music; and so on.¹²⁹ Exceptions arise unevenly from country to country: some, but not all, laws at times accord the status of an author, not only to flesh-and-blood creators, but to legal entities, for example, those employing actual creators, directing creative contributors to team works, like software or audiovisual works, or producing such works.¹³⁰ Accordingly, cross-border cases where laws differ on point may raise the problem of defining the term “author,” especially when protection is sought under some international treaty rather than under national law dispositive for defining the term “author.”¹³¹ Illustrating how authors may thus be domestically determined, French law defined a U.S. film director and screenwriter as authors when it unilaterally protected their moral right to maintain the integrity of their *film noir* against colorization.¹³²

Where laws conflict with regard to any putative “author,” the default approach, defining this term by the law of the protecting country, keeps issue analysis focused.¹³³ In following this approach, a court avoids splitting such issues as often turn on who is taken as the author of the work at issue, notably the issue of eligibility of the work

entity that “first fixes” sounds in a master recording). *But see* § 4[2][b][i] *in fine infra* (on a special case in which this criterion may be replaced by another turning on the place of first fixation).

¹²⁶ *See, generally*, C. Masouyé, *Guide to the Berne Convention*, 11 (WIPO, 1978) (noting that this gap in the Berne text avoids confrontation between countries with opposing provisions on point).

¹²⁷ *See, generally*, W. Hoffmann, *Die Berner Uebereinkunft zum Schutze von Werken der Literatur und Kunst*, 47–49 (Springer, 1935) (implying that, absent an international definition in the Berne Convention, such national law defines the term “author”).

¹²⁸ This problem need not arise when establishing standing to sue for infringement. Courts may often presume that the person named as author, or the enterprise named when exploiting a work, has such standing. For further analysis, see §§ 5[3][b] and 6[2][a] *infra*.

¹²⁹ For some consensus on what creative “core” is protected in works, see § 2[2][a] *supra*.

¹³⁰ On who, under varying laws, may initially own rights in such cases, see § 6[2][b] *infra*.

¹³¹ On such grounds of protection, whether unilateral or reciprocal, arising in the implementation of treaty obligations, or in treaties themselves, see § 3[2][a] *supra*.

¹³² The *Asphalt Jungle* decision, *Huston v. Turner Entertainment*, Cass., 1^e ch. civ. (France), May 28, 1991, RIDA 1991, no. 149, 197, in English trans. in 23 I.I.C. 702 (1992), *followed on remand*, CA Versailles, chs. réunies, Dec. 19, 1994, RIDA 1995, no. 164, 389 (also discussed in § 3[2][b] *supra* and § 6[2][b][i] *infra*).

¹³³ On issue analysis, that is, *dépeçage*, in cross-border cases for purposes of conflicts analysis, see § 1[3][c] *supra*.

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for protection and that of vesting rights in this work.¹³⁴ Furthermore, this approach keeps outcomes in the cases consistent, whether the work is protected on the grounds of an international treaty, where the principle of national treatment calls for treating domestic and foreign authors alike, or on the grounds of national law alone.¹³⁵ If, however, we pass to the alternative approach, defining “author” by the law of any supposed “source country,” we find ourselves without altogether stable criteria for identifying any such country.¹³⁶ It can be hard to localize any single *situs* of authorship in many cases, for example, in international coproductions, the collaboration of creators through global networks, etc.¹³⁷ Even the Berne definition of any “country of origin” applies unevenly.¹³⁸

Another approach, finding authors only in flesh-and-blood creators, has the advantage of simplicity. From its inception, as the commentators point out, Berne drafters contemplated only natural persons as “authors.”¹³⁹ The E.U. Court of Justice has implicitly adopted this reading in requiring “intellectual creation” in copyright works.¹⁴⁰ It gains support from Article 6*bis* of the Berne Convention, which provides for minimum moral rights that are only properly vested in flesh-and-blood creators.¹⁴¹ However, the Berne text as a whole does not logically preclude the possibility of defining a legal entity as an “author” or of initially vesting rights in such an entity.¹⁴²

¹³⁴ *Compare* *Moussus c. ABC News Intercontinental Inc.*, Cass., 1^e ch. civ. (France), April 10, 2013, RIDA 2013, no. 238, 409, in English trans. in 44 I.I.C. 856 (2013) (pursuant to Berne national treatment, applying the law of the protecting country to determine the flesh-and-blood creator as the author in whom rights vest), and the *Spielbankaffaire* decision, BGH (Germany), Oct. 2, 1997, GRUR 1999, 152, in English trans. in 30 I.I.C. 227 (1999) (holding that the laws of protecting countries respectively determine the authors of an audiovisual work and who initially holds rights in it).

¹³⁵ On how the principle of national treatment constrains the choice of laws applicable to cross-border infringement generally, see § 3[1][a][i] *supra*.

¹³⁶ See, e.g., J. Ginsburg, “International Copyright: From a ‘Bundle’ of National Copyright Laws to a Supranational Code?,” 47 J. Copr. Soc’y 265, 283–285 (2000) (vacillating with regard to the “country of origin,” admitting that this Berne notion is difficult to apply in internet cases, and then invoking the even-more open-ended notion of the country with “the most significant relationship” to creation).

¹³⁷ For critical analysis and such hard cases, see, respectively, §§ 6[2][b][i] *in fine* and 6[2][b][ii] *infra*.

¹³⁸ For the possibly changing meaning of “country of origin,” see § 4[3][b][ii] *infra*.

¹³⁹ See W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 35–36 (Berne Art. 2/2*bis*, Rem. 7) and 182 (U.C.C. Art. II, Rem. 5) (Werner-Verlag, 1977); D. Vaver, “The National Treatment Requirements of the Berne and Universal Copyright Conventions,” 17 I.I.C. 578, 593 (1986).

¹⁴⁰ See, e.g., *Infopaq International A/S v. Danske Dagblades Forening*, E.C.J., 4th ch., July 16, 2009, Case C-5/08, [2009] E.C.R. I-6569, para. 34 (referring to “the general scheme of the Berne Convention” to this effect).

¹⁴¹ See, generally, B. Edelman, “Applicable Legislation Regarding Exploitation of Colourized U.S. Films in France: The ‘John Huston’ Case,” 23 I.I.C. 629, 638–642 (1992) (arguing for vesting moral rights in the natural person who creates the work at issue).

¹⁴² Arguably, in allowing for a possibly corporate “maker” of a cinematographic work under Article 4(a), as well as for the presumption of transfer of rights under Article 14*bis*(2)(b) in favor of such a film

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Berne provisions rather give conflicting signals: for example, they impose minimum terms based on the author's lifetime, but contain special minimum terms without reference to such a lifetime.¹⁴³ While incorporating Berne provisions, the TRIPs Agreement clarifies the running of minimum terms "calculated on a basis other than the life of a natural person."¹⁴⁴

The Berne-plus treaty regime backs up the default approach of defining the term "author" by the law of the protecting country.¹⁴⁵ To start, the Berne *desideratum* of favoring flesh-and-blood creators coincides with treating the natural person creating a work as an author vested with moral rights.¹⁴⁶ Further, the Berne Convention and sequel treaties include references to the law of the country of origin only in expressly limited exceptions and, in all other cases, require national treatment subject to minimum rights.¹⁴⁷ Finally, the treaty regime does not support the source-country approach to the extent that the definition of "author" is not included among those exceptional issues for which the law of the country of origin, the prime candidate for the source country, is dispositive.¹⁴⁸

[b] Place of Publication, Fixation, or Emission

We shall here (i) unpack criteria of eligibility for protection that turn on so-called geographical factors. We shall then consider (ii) how treaties define that of the place of any requisite first publication, the most important of these factors, and (iii) how the courts have interpreted this notion.

[i] Alternative Geographical Factors

A work or related production, metaphorically, is sometimes said to have a given "nationality." Most notably, a work or production may be first published, a performance delivered, a master recording made, or broadcast emitted in a given country, satisfying an eligibility criterion specific to that subject matter. Consider, for example,

maker, the Paris Act of Berne *a contrario* confirms that only a natural person may be the "author" of such a work. For analysis of Berne Article 14*bis* as allocating author's rights, see §§ 6[2][b][ii] and 6[3][b][ii] *in fine infra*.

¹⁴³ On these minimum terms and other minimum rights, see § 5[4][a][i][A] *infra*.

¹⁴⁴ TRIPs, art. 12.

¹⁴⁵ For alternative frameworks of analyses, see G. Koumantos, "Private International Law and the Berne Convention," Copyright 1988, 415; G. Boytha, "Some Private International Law Aspects of the Protection of Authors' Rights," Copyright 1988, 399.

¹⁴⁶ See A. Dietz, "The Concept of Author under the Berne Convention," RIDA 1993, no. 155, 2.

¹⁴⁷ Compare S. Ricketson, *The Berne Convention for the protection of literary and artistic works: 1886–1986*, paras. 5.52–5.53 (Kluwer, 1987) (making this point), with S. Ricketson and J. Ginsburg, *International Copyright and Neighbouring Rights: The Berne Convention and Beyond*, vol. 2, paras. 20.08 *et seq.* (Oxford Univ. Press, 2006) (equivocating on point).

¹⁴⁸ Indeed, if the law of the country of origin defined the term "author," the determination of the country of origin would become circular in cases where it turned on the identity of an author. See § 4[3][b][ii] *infra*.

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domestic provisions for unilateral protection:¹⁴⁹ they often apply to works first published within the protecting country itself.¹⁵⁰

Under the Berne Convention, a work first published in a Berne country qualifies for protection in other Berne countries.¹⁵¹ Such publication, which may be simultaneous subject to a grace period, allows for “back-door” Berne protection of a work by a non-Berne author in the Berne Union.¹⁵² Absent authorship by a Berne national or such first publication, the Paris Act of the Berne Convention extends protection to any architectural work erected in a Berne country or to any artistic work incorporated in a structure erected in such a country.¹⁵³ Such publication or incorporation in a fixture, as specified by the Paris Act, satisfies a criterion of eligibility under the TRIPs Agreement and the WIPO Copyright Treaty, respectively.¹⁵⁴ Under the Universal Copyright Convention, any work first published in any U.C.C. country will be protected in any other U.C.C. country.¹⁵⁵

The Rome Convention adopts a variety of geographical criteria of eligibility.¹⁵⁶ A performance is protected if it takes place in a Rome country or is recorded in a Rome-protected phonogram or, absent such recording, is carried by a Rome-protected broadcast.¹⁵⁷ A phonogram is protected if it is first fixed or published in such a Rome country,¹⁵⁸ and a broadcast is protected if it is transmitted from such a Rome country.¹⁵⁹ The TRIPs Agreement incorporates these eligibility criteria for perfor-

¹⁴⁹ For this and other conditions of unilateral protection, see § 3[2][b] *supra*.

¹⁵⁰ *N.b.*, inside its own country of origin, usually where it is first published, a work will not be protected by Berne minimum rights. See §§ 4[3][b][ii] and 5[4][a][ii] *infra*.

¹⁵¹ Berne, Arts. 5 and 6(1) (Brussels), Art. 3(1)(b) (Paris).

¹⁵² On first or simultaneous Berne publication, subject to a grace period in some cases, see §§ 4[2][b][ii] *in fine* and 4[2][b][iii] *infra*.

¹⁵³ Berne, Art. 4(b) (Paris).

¹⁵⁴ TRIPs, Art. 1(3); W.C.T., Art. 3, and Agreed Statements concerning Art. 3.

¹⁵⁵ U.C.C., Art II(1) (Geneva, Paris). See A. Bogisch, *The Law of Copyright Under the Universal Convention*, 12–14 (Sijthoff, 3d ed., 1968) (noting that, although the point is not “entirely clear,” a work first published in a U.C.C. country ought to be protected in another U.C.C. country, even if the author is a national of that other country).

¹⁵⁶ For the personal criteria under the Rome Convention, see § 4[2][a][i] *supra*.

¹⁵⁷ Rome, Art. 4. See, e.g., the *Doors* decision, BGH (Germany), Feb. 18, 1993, GRUR 1993, 550, GRUR Int. 1993, 699, and in English in 26 I.I.C. 305 (1995) (performer, a citizen of the U.S., not a Rome country, obtains protection in Germany against bootlegged recording of his performance taking place in Sweden, a Rome country).

¹⁵⁸ Rome, Art. 5(1)(b)–(c) (phonograms). See Rome, Art. 5(2) (deems “first” to include “simultaneous” publication within 30 days), and Art. 5(3) (allows an adhering country, upon giving due notice, not to protect phonograms on the basis of the place of first publication or, alternatively, of first fixation). See also Rome, Art. 17 (allows an adhering country, by due notice, to protect phonograms exclusively on the basis of the place of first fixation if, as of October 26, 1961, it posited only that criterion of eligibility).

¹⁵⁹ Rome, Art. 6(1)(b) (broadcasts). *But see* Rome, Art. 6(2) (allows any protecting country, upon giving due notice, to require a broadcasting organization to be located in the same country as the transmitter of the broadcast at issue, that is, to disqualify a broadcasting organization with offices and

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mances, phonograms, and broadcasts, respectively.¹⁶⁰ The WIPO Performances and Phonograms Treaty, albeit with caveats, also incorporates such Rome criteria for performances and phonograms.¹⁶¹ The Geneva Phonograms Convention only exceptionally allows countries to protect phonograms on the basis of the place of first fixation.¹⁶²

[ii] Defining the Requisite “First Publication”

We here use the term “publication” as a word of art in criteria of eligibility for protecting foreign works or related productions. This usage should not be confused with other meanings of this or cognate terms like “making public” and “making available to [members of] the public” that may be used for other purposes.¹⁶³ Where a country’s domestic law, whether or not implementing treaty obligations, protects works or productions by reference to “publication,” the country may use its own definition of this notion or either incorporate or simply presuppose the treaty definition.¹⁶⁴

Successive acts of the Berne Convention have refined the notion of “publication.”¹⁶⁵ Neither the display of an artistic work nor the building of an architectural work, nor the performance or telecommunication of works, suffices to constitute any publication qualifying for Berne protection.¹⁶⁶ Copies or exemplars of the work at issue, as the Paris Act clarifies, have to be made sufficiently available, with the author’s or successor’s consent, “to satisfy the reasonable requirements of the public, having regard to the nature of the work.”¹⁶⁷ Copies published, pursuant to the Berne

studios located in one country from claiming Rome rights, for example, in broadcasts from a transmitter on high ground just over the border).

¹⁶⁰ TRIPs, Art. 1(3).

¹⁶¹ W.P.P.T., Art. 3, and Agreed Statements concerning Art. 3. *See also* M. Ficsor, *The Law of Copyright and the Internet: The 1996 WIPO Treaties, their Interpretation and Implementation*, 601–605 (Oxford Univ. Press, 2002) (explaining that the relevant definitions in W.P.P.T. Article 2 must be applied in construing eligibility criteria under Article 3, but that it is doubtful that W.P.P.T. protection extends to performances carried by any broadcast, since the W.P.P.T. does not cover broadcasts).

¹⁶² Geneva countries protecting sound recordings on the basis of the place of first fixation as of October 29, 1971, may continue to apply this criterion, instead of that turning on nationality, conditionally on giving due notice: Geneva, Art. 7(4). For the more usual Geneva criterion of the national status of the producer, see § 4[2][a][i] *in fine supra*.

¹⁶³ *N.b.* the Berne term “publication” is also used in determining the Berne “country of origin.” *See* § 4[3][b][ii] *infra*.

¹⁶⁴ On such protection, whether unilateral or pursuant to implementing legislation, see §§ 3[2][b], 3[2][d], and 3[4][a] *supra*.

¹⁶⁵ Berne, Art. 4(4) (Rome, Brussels), Art. 3(3) (Paris).

¹⁶⁶ *But see* H. Desbois, A. Françon, and A. Kéréver, *Les conventions internationales du droit d’auteur et des droits voisins*, para. 123 (Daloz, 1976) (arguing that the distribution of copies of a musical score into the hands of performers playing in public contributes to a Berne publication, as does the distribution of a film for projection in public).

¹⁶⁷ *See, generally*, W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 46–47 (Berne Art. 4, Rems. 2) (Werner-Verlag, 1977) (opining that,

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definition, arguably need not make the work at issue readable on their face, “whatever may be the means of manufacture of the copies.”¹⁶⁸ Variations between the Berne and Rome definitions of “publication” have not been understood to make any difference for their criteria of eligibility for protection.¹⁶⁹ Berne or Rome publication may arguably take place via downloads of copies, whether or not these are “hard copies” in any traditional sense.¹⁷⁰

As will next be seen, with increasingly rapid media and transport, courts early on had to decide whether a publication should be deemed “first” when copies of a work were made accessible to the public in different countries in rapid succession.¹⁷¹ To avoid this problem, “first” was taken to mean “simultaneous” publication in a Berne and non-Berne country, subject to a grace period introduced in the Brussels and Paris Acts of the Berne Convention, with this meaning from that Paris Act incorporated into the TRIPs Agreement and the WIPO Copyright Treaty.¹⁷² A work is there deemed to satisfy the criterion of first publication when it is published simultaneously in a Berne country and a non-Berne country if its publication in the one takes place within 30 days of publication in the other.¹⁷³ The Universal Copyright Convention does not define when a publication is “first” for purposes of satisfying any criterion of eligibility.¹⁷⁴

with consent, a mere offer of copies to the public might qualify). *See, e.g.*, the *Eileen Gray* decision, OLG Karlsruhe (Germany), Sept. 22, 1993, GRUR 1994, 283, at 285 (reasoning that putting one lamp on sale, when the design is not mass produced, suffices to constitute Berne publication).

¹⁶⁸ Berne, Art. 4(4) (Brussels), Art. 3(3) (Paris). Some authorities have argued that “copies” here, *exemplaires* in the French text, may include some reworkings of the work at issue. *See, generally*, W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 47 (Berne Art. 4, Rems. 3) (Werner-Verlag, 1977) (suggesting that publishing a close adaptation may “publish” the original). *See, e.g.*, the *Lara’s Daughter* decision, BGH (Germany), April 29, 1999, GRUR 1999, 984, GRUR Int. 1999, 884, and in English trans. in 31 I.L.C. 1050 (2000) (holding first publication of a translation of *Doctor Zhivago* in a Berne country sufficient for assuring Berne protection).

¹⁶⁹ Compare Rome, Art. 3(d) (“the offering of copies of a phonogram to the public in reasonable quantity”), with U.C.C., Art. VI (Geneva and Paris Acts) (defining “publication” as taking place only with “copies of a work from which it can be read or otherwise visually perceived [emphasis added],” and requiring “the reproduction [of the work] in tangible form”). *See also* TRIPs, Art. 1(3), W.C.T., Art. 3, and W.P.P.T., Art. 3 (incorporating Berne and Rome criteria of eligibility, respectively, for works, on the one hand, and performances and phonograms, on the other).

¹⁷⁰ *See, e.g.*, *Spedidam c. société iTunes*, Cass., 1e ch. civ. (France), Sept. 11, 2013, JurisData no. 2013-018957 (interpreting downloads as subject to licenses to exploit “published” phonograms). *See also* *Entertainment Software Association v. SOCAN*, 2012 SCC 34, para. 10 (Canada) (considering downloads as reproductions, not as telecommunications).

¹⁷¹ *See* § 4[2][b][iii] *infra*.

¹⁷² Berne, Art. 4(3) (Brussels); Art. 3(4) (Paris), incorporated by TRIPs, Art. 1(3); W.C.T., Art. 3, and Agreed Statements concerning Art. 3.

¹⁷³ *But see* W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 49 (Berne Art. 4, Rem. 8) (Werner-Verlag, 1977) (raising a doubt whether a non-Berne author could benefit from the 30-day grace period introduced in the Brussels Act).

¹⁷⁴ *See* A. Bogsch, *The Law of Copyright Under the Universal Convention*, 15–16 (Sijthoff, 3d ed., 1968) (opining that publications must occur inside a U.C.C. country before or on the same day as outside

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[iii] Analyzing First or Simultaneous Publication

Distinct issues may arise as courts consider whether publication suffices to make a work eligible for Berne protection. On the one hand, a court may have to decide which Berne Act to apply, given the progressive refinement of the definition of “first publication” over time, as just outlined.¹⁷⁵ On the other hand, it may have to interpret the applicable definition under diverse factual circumstances, for example, in cases of film distribution rather than of book “publication” or in cases of some audience or readership smaller than the “public” at large.¹⁷⁶

Start with the threshold issue in a pair of cases of a classic work: *The Gold Rush*, authored by Charlie Chaplin, had been exploited without consent in Switzerland and in Germany in the 1960s. Chaplin was a British subject, eligible for protection under the Brussels Act of the Berne Convention applicable in both the Swiss and German cases at the time of the alleged infringement.¹⁷⁷ Even given an author who was a national of a Berne country, however, the Brussels Act also required first or simultaneous publication of the work at issue in the Berne Union before protecting it.¹⁷⁸ Hence the preliminary issue: Which Berne Act defined such “publication” here, the Brussels Act, with its grace period of 30 days for “simultaneous” publication, or else the earlier Berlin Act, without any grace period?¹⁷⁹ To resolve this issue, both the Swiss and German courts applied the earlier Berlin Act because it had been in effect in 1925 at the time of alleged publication. Such a ruling takes account for third parties’ reliance on legal consequences ensuing from the date of publication forward.¹⁸⁰

Turn to the key factual issue in the Chaplin cases: How to analyze Berne first publication when it unfolds over time and space, rather than taking place all at once? In 1925, after a preview screening of *The Gold Rush* in Hollywood, film prints had been distributed for projection to the public both in New York City, then outside the Berne Union, and in Toronto, Canada, a Berne member. The Berne definition of “publication,” requiring hard copies and disqualifying performances, as just explained, made clear that any gap in real time between screenings in New York and in Toronto could not have been decisive.¹⁸¹ The Swiss decision formulated the following test of first publication, which it found met in the case: “The only important point is whether

and pointing out that the special 30-day grace period mentioned elsewhere in the U.C.C. expressly serves a very distinct purpose from that of satisfying any criterion of eligibility).

¹⁷⁵ See § 4[2][b][ii] *supra*.

¹⁷⁶ *N.b.* such issues may not only arise when publication serves as a factor in a criterion of eligibility, but also when it serves to identify a country of origin. See § 4[3][b][ii] *infra*.

¹⁷⁷ Swiss *Gold Rush* case, Tribunal Fédéral (Supreme Court), Nov. 3, 1970, ATF 96 II 412, here cited in its English trans. in 2 I.I.C. 315 (1971); German *Gold Rush* case, BGH, May 19, 1972, GRUR Int. 1973, 49, here cited in its English trans. in 4 I.I.C. 245 (1973).

¹⁷⁸ See § 4[2][a][i] *supra*.

¹⁷⁹ See § 4[2][b][ii] *in fine supra*.

¹⁸⁰ See also § 4[3][b][ii] *in fine infra* (reliance considerations support looking to the definition of the “country of origin” in effect at the time of publication).

¹⁸¹ See § 4[2][b][ii] *supra*.

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in distributing the film in the two countries the owner proceeded in a single transaction, rather than in separate actions.”¹⁸² The German decision distinguished case law requiring “a special center of distribution” for publishing books, while it analyzed the public release of films transactionally, noting that it entailed “a much smaller number of copies.”¹⁸³ Further case law has since varied in adapting transactional analysis to the publication of texts in comparable cases.¹⁸⁴

Some courts have had to ask: How large a “public” must be reached for Berne publication to take place? For example, a novel by Solzhenitsyn had initially been circulated as *samizdat* or clandestine writing in the Soviet Union, and it was later publicly released in France, before Russian adherence to the Berne Union. The German Federal Court of Justice found that the *samizdat* distribution could not have satisfied the Berne criterion of “reasonable requirements of the public” because it could not have had “sufficient opportunity for attracting the public” at large, leaving the subsequent French publication as the “first,” qualifying for Berne protection.¹⁸⁵ Later case law has followed this reasoning, though it could be argued to make the criterion in question depend on the very phenomenon it is supposed to measure: the extent of the distribution needed for publication.¹⁸⁶

[3] Is Protection of an Older Work or Production Still Timely?

Consider a foreign work or production in time. If it predates any grounding provision for protection in a country, whether a domestic or treaty provision, we need to ask: (a) Is it retroactively protected under this grounding provision? Or was it already protected when this provision, now relied upon, went into effect? To respond to this question, we have to ask: (b) Have the requirements of any prior grounding provision, effective to date, been met?

[a] Establishing Retroactivity or Prior Protection

Let us detail our case. Protection is now claimed for an older work or production in a given country. Distinct reasons may allow for protecting the work or production even if it arose before the date any provision now invoked to protect it went into effect.¹⁸⁷

¹⁸² Swiss *Gold Rush* case, Tribunal Fédéral (Supreme Court), Nov. 3, 1970, ATF 96 II 412, here cited in its English trans. in 2 I.I.C. 315, 321 (1971).

¹⁸³ German *Gold Rush* case, BGH, May 19, 1972, GRUR Int. 1973, 49, here cited in its English trans. in 4 I.I.C. 245, 249 (1973).

¹⁸⁴ See, e.g., *Edgar Rice Burroughs Inc. v. Beukenoord, Springboard-Video B.V.*, Gerechtshof (Court of Appeal) Amsterdam (Netherlands), Dec. 28, 2000, here cited in its English trans. in [2001] E.C.D.R. 184, at 189 (finding it “unlikely that ‘simultaneous’ [publication] in 1912 meant ‘at the same time,’ what with the poor means of transport and communication available at that time”).

¹⁸⁵ The *August Fourteen* decision, BGH, April 16, 1975, GRUR Int. 1975, 361, here cited in its English trans. in 7 I.I.C. 134, 137 (1976).

¹⁸⁶ See, e.g., *Erofeeva c. Editions Albin Michel*, CA Paris, 5e ple.: 2e ch. (France), Nov. 27, 2009, P.I. 2010, 731, note A. Lucas (reaching much the same result).

¹⁸⁷ I.e., when the grounding provision went into force in the protecting country; however, if a treaty provision is applied, no earlier than when the treaty initially binds the country specified in its criterion

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(i) Such a grounding provision applies retroactively in the case. Or (ii) one or many prior provisions furnished grounds for protection up to the date that the current provision took effect. In particular, we should confirm that the term of protection is still running at the time protection is sought.¹⁸⁸

[i] May a Grounding Provision Apply Retroactively?

A country might be reluctant to start abruptly protecting a foreign work or production which has already fallen into its public domain. For one thing, users in this country may have already relied on the prior public-domain status of such an older work or production. We shall unpack the following alternatives that may ensue in that event: (a) by default, no retroactive protection at all; or else (b) conditional retroactivity, as granted under the Berne provision on point, or (c) E.U. super-retroactivity, leading to new or revived rights in many European countries.¹⁸⁹

[A] No Retroactivity: the Default Rule

Assume a work or production already protected under a prior domestic law or treaty. Logically, like the baton passed from one runner to another carrying it forward in a relay race, this work or production is in turn protected under any succeeding new law or treaty, subject to its conditions. However, under the default rule of non-retroactivity, if the work or production fell into the public domain before the new law or treaty became effective, the new law or treaty would not protect it anew. Generally, this rule keeps public-domain materials free for use; correspondingly, it is indispensable for understanding exceptions to it, namely retroactivity schemes, explained below.¹⁹⁰

The default rule of non-retroactivity may be applied to a variety of issues on which the timeliness of protection may turn. For example, protection might be sought for a work under a provision granting unilateral protection on the basis of first publication in the protecting country. In older laws and treaties, “first” publication in one country had to be literally first or simultaneous relative to publication anywhere else, while newer laws and treaties allow for “simultaneous” publication to take place in one country within the grace period of 30 days from publication elsewhere.¹⁹¹ Thus, in the case of the opera *Tosca*, published at dates close together at the turn from the nineteenth to the twentieth century both in Italy and in Germany, both bound by the Berne Convention at the time, the court held that the 30-day grace period instituted in Germany over a half-century later could not retroactively apply to the earlier publication. It stressed this rationale for disfavoring retroactivity: “domestic exploiters

under which the work or production is eligible for protection. On criteria of eligibility, see § 4[2] *supra*.

¹⁸⁸ *E.g.*, most importantly, that the rule of the shorter term has not already cut off protection. See § 5[2] *infra*.

¹⁸⁹ For a case-based analysis of these approaches, see P.E. Geller, “Zombie and Once-Dead Works: Copyright Retroactivity after the E.C. Term Directive,” *The Entertainment and Sports Lawyer* (ABA), 2000, vol. 18, no. 2, 7.

¹⁹⁰ See §§ 4[3][a][i][b] and 4[3][a][i][C] *infra*.

¹⁹¹ See also § 4[2][b] *supra* (analysis of notions of “first” and “simultaneous” publication as they have evolved from older to newer Berne Acts).

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of foreign works [. . .] ought to be able to rely on the general principle that protection hitherto unavailable according to national law will not find grounds in a later enactment.”¹⁹²

Consider domestic law, reciprocity decrees of a pair of countries, or treaties other than the Berne Convention that do not incorporate Berne provisions. Such instruments do not normally provide express language on point, leaving the default rule of non-retroactivity applicable unless the legislation, doctrine, or case law of the protecting country clearly allows for some form of retroactivity.¹⁹³ Quite expressly, the Universal Copyright Convention, in its Article VII, adopts the default rule, excluding its application “to works or rights in works which [. . .] are permanently in the public domain” at its effective date for an adhering country.¹⁹⁴ Neither the Rome Convention, recognizing neighboring rights in performances, phonograms, or broadcasts, nor the Geneva Phonograms Convention applies retroactively by its own terms.¹⁹⁵ However, implementing legislation may give a treaty retroactive effect.¹⁹⁶

[B] Conditional Retroactivity: the Berne Model

When is Berne retroactivity most needed now? Most typically, it will be invoked upon the adherence of a country to the Berne Convention, before which works originating there often had no prior protection in the Berne Union.¹⁹⁷ For example, when China joined the Berne Union on October 15, 1992, it had a wealth of works for which it needed protection to commence abroad. Under its Article 18, the Berne Convention may apply to protect such preexisting works retroactively, subject to distinct conditions. This Berne model has been incorporated into other treaties, notably into the TRIPs Agreement and the WIPO “Internet” Treaties.¹⁹⁸ National laws

¹⁹² The *Puccini I* decision, BGH (Germany), July 1, 1985, GRUR Int. 1986, 802, 803 (also discussed in § 4[3][b][ii] *infra*). *N.b.*, whatever the merit of this reasoning, this case has since been held, under E.U. law, to have been wrongly decided. See § 4[3][a][i][C] *infra*.

¹⁹³ See, e.g., *Twin Books Corp. v. Walt Disney Co.*, 877 F. Supp. 496, 499 (N.D. Cal. 1995) (U.S.) (refusing to apply retroactively a Presidential proclamation concerning a bilateral agreement with Austria), *rev'd on other grounds*, 83 F.3d 1162 (9th Cir. 1996).

¹⁹⁴ U.C.C., Art. VII (Geneva, Paris). See, generally, A. Bogensch, *The Law of Copyright Under the Universal Convention*, 83 (Sijthoff, 3d ed., 1968) (“The cause of non-protection is irrelevant.”).

¹⁹⁵ See Rome, Art. 20; Geneva, Art. 7(3). See, e.g., the *Zauberflöte* (Magic Flute) decision, BGH (Germany), Nov. 20, 1986, GRUR 1987, 814 (holding that the Rome Convention does not apply retroactively in Germany to a performance with a requisite connection to Austria but predating adherence of Germany and Austria).

¹⁹⁶ See, e.g., the *Tonträger aus Drittstaaten* (Phonograms from Third States) decision, BGH (Germany), March 29, 2007, GRUR Int. 2007, 610, GRUR 2007, 502 (confirming German protection of phonograms under the Geneva Convention, starting on January 1, 1966, when the German Copyright Act of 1965 first went into effect).

¹⁹⁷ But see, e.g., W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 123–124 (Berne Art. 18, Rems. 3–4) (Werner-Verlag, 1977) (noting that retroactivity may also apply upon the lapse of reservations, for example, with regard to translation rights in Japan at the end of 1980).

¹⁹⁸ TRIPs, Arts. 9(1), 14(6), and 70(2); W.C.T., Art. 13; W.P.P.T., Art. 22(1). But see W.P.P.T., Art.

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implementing the Berne Convention or sequel treaties may effectuate this model strictly, or they may make it more liberal.¹⁹⁹

Berne retroactivity opens a “window” through which an older work or production may be recouped out of the public domain of a Berne country where it was not previously protected. A pair of key conditions frame this window: they apply on the later of the dates on which a Berne Act becomes effective either for the country in which protection is sought or for the country of origin of the work at issue.²⁰⁰ On the one hand, under Berne Article 18(2), the work at issue must not then have fallen into the public domain of the protecting country for the specific reason that “the term of protection [. . .] previously granted” in the protecting country had lapsed there. On the other hand, Article 18(1) provides that the work at issue must not have fallen into the public domain of its country of origin for the specific reason that “the term of protection” provided in the country of origin had lapsed there.²⁰¹ But we shall quickly see Article 18(3) allow Berne members to attenuate the rigor of these conditions.²⁰²

Historical context illuminates this model. Starting in 1886, when the Berne Union was being formed, many works were not yet protected in initially adhering countries.²⁰³ The number of works protected within the Union would have then been quite limited unless the Convention were extended to foreign works formerly not protected in Berne members, notably due to lack of treaties to this effect. Further, soon after the formation of the Union, it was made clear that the protection of any Berne-qualifying work was not to be conditioned on satisfying any threshold formality, like registration or deposit.²⁰⁴ Berne protection was granted for a qualifying foreign work even if it had been previously excludable because of a failure to satisfy a formality, whether in its country of origin or in a protecting country. Hence retroactive Berne protection except

22(2) (allowing the retroactive application of performer’s moral rights to be limited). *See, generally*, M. Ficsor, *The Law of Copyright and the Internet: The 1996 WIPO Treaties, their Interpretation and Implementation*, 567–579, 646–647 (Oxford Univ. Press, 2002) (confirming the incorporation of Berne Article 18 into the W.C.T. and W.P.P.T. and explaining the W.P.P.T. rule for performers’ moral rights).

¹⁹⁹ *See* Berne, Art. 18(3), last sentence.

²⁰⁰ We shall here speak in terms of a Berne Act and a preexisting work, although our analysis may apply to TRIPs or WIPO Treaty retroactivity, or to that under national implementing legislation, with regard to a preexisting work, performance, phonogram, etc.

²⁰¹ On the definition of the “country of origin,” see § 4[3][b][ii] *infra*. The Berne retroactivity provision here incorporates, in a rather stringent form, the Berne rule of the shorter term, discussed in § 5[2][a][iii] *infra*. However, the case law does not always apply this condition of retroactivity in that form, as discussed in § 5[3][a] *infra*.

²⁰² *See also* Gaumont c. Editions Montparnasse et Lobster Films, Cass., 1e ch. civ. (France), Dec. 17, 2009, RIDA 2010, no. 224, 427, in English trans. in 42 I.I.C. 607 (2011) (as discussed in § 5[3][a] *infra*).

²⁰³ For historical background, see § 2[3][a] *supra*.

²⁰⁴ *See, e.g.*, Records of the Conference Convened in Berlin, 1908, in World Intellectual Property Organization, *1886—Berne Convention Centenary—1986*, 148 (WIPO, 1986) (noting the need to eliminate the requirement of showing, upon the threshold of an infringement suit, prompt compliance with formalities in the country of initial publication).

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where a work fell into the public domain by virtue of “the expiry of the term of protection” in the protecting country or in the country of origin.²⁰⁵

Consider examples illustrating how Article 18 of the Berne Convention leads to retroactive protection, at times quite generously. For example, this provision obligated Germany to protect works of an Estonian author, though these works had been created before Estonia had adhered to the Berne Convention, effectively on October 26, 1994, assuming no lapse of copyright in either Germany or any country of origin by that date.²⁰⁶ The Berne model of retroactivity prompted the United States, albeit only after TRIPs adherence, to institute a scheme for restoring U.S. copyright, sometimes with extended terms, in “qualifying” foreign works that, though still protected in their respective “source countries,” had fallen into the U.S. public domain before its Berne adherence, *inter alia*, for failure to comply with prior U.S. formalities, sometimes resulting in a U.S. lapse of term.²⁰⁷ We shall consider below whether Article 18 requires another treaty country to protect an older U.S. work even after it dropped into the U.S. public domain for failure to renew U.S. copyright.²⁰⁸

Berne retroactivity may indeed be made more favorable.²⁰⁹ Article 18(3) of the Berne Convention, to this effect, may be read in close context with Articles 19 and 20. These provisions reserve “greater protection” under domestic law and “more extensive rights” under “special” agreements, as explained below.²¹⁰ Suppose a work originating in a newly joining Berne member but already protected in an older member unilaterally or by virtue of domestically recognized reciprocity. Any such protection, if more favorable than Berne’s, especially in its national treatment of term, could be read to fall under Article 18(3) upon Berne adherence of the new member, obviating any need to invoke retroactivity.²¹¹ Or consider a work already protected by prior agreement: for example, when the United States joined the Berne Union on March 1,

²⁰⁵ *Quaere* whether such retroactive protection may arguably be subject to formalities to the extent that the term of protection may depend on formalities such as U.S. renewal procedures. On the U.S. renewal term subject to formalities from a Berne perspective, see § 5[3][a] *infra*. On the Berne bar to formalities in the protecting country, see § 5[3][b] *infra*.

²⁰⁶ The *Lepo Sumera* decision, BGH (Germany), March 29, 2001, GRUR 2001, 1134, ZUM 2001, 989 (also holding it to be irrelevant that the newly independent Estonia had never declared continuity of membership in the U.C.C. when breaking away from the Soviet Union in 1991). *But see* the *Briefe aus Petersburg* (Letters from St. Petersburg) decision, OLG Cologne (Germany), Sept. 23, 2011, ZUM 2011, 924 (protecting works by a Russian author deceased in 1942, although his Soviet copyrights had lapsed by 1993, while noting that Russia had retroactively restored copyrights in suppressed works and instituted terms of life plus 70 years) (also noted in § 5[2] *infra*).

²⁰⁷ *See* United States, Copyright Act, 17 U.S.C. § 104A.

²⁰⁸ *See* § 5[3][a] *infra*.

²⁰⁹ *See, generally*, W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 124 (Berne Art. 18, Rem. 5) (Werner-Verlag, 1977) (noting that the conditions framing Berne retroactivity are not obligatory and, referring to context, that a Berne country may accord more favorable retroactivity).

²¹⁰ *See* §§ 5[1][a] and 5[1][b][i] *infra*.

²¹¹ On such grounds of protection, see §§ 3[2][b] and 3[2][c] *supra*.

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1989, many U.S. works had still-ongoing protection, with full national treatment, in other Berne members under prior bilateral treaties.²¹² Such a treaty, if more favorable than Berne, especially in its national treatment without exceptions, could be argued to fall under Article 18(3) as well. Alongside that of the bilateral treaty, Berne protection may accordingly start upon Berne adherence of a new member like the United States. There is case law apparently to the contrary.²¹³

Reliance interests may be similarly handled. For example, before it joined the Berne Union on October 15, 1992, China had not protected most foreign works, and most works of Chinese origin had not been previously protected in most other countries. Thus, upon China's adherence, qualifying Berne works in China, as well as qualifying Chinese works in other Berne countries, were recouped out of public domains virtually worldwide, although users may to this point have relied on the prior public-domain status of such works. Article 18(3) of the Berne Convention allows adhering countries to enter into special agreements with each other, or to make domestic law, that could accommodate resulting reliance interests.²¹⁴ Treaty provisions or domestic statutes or regulations, often transitional provisions, may be consulted for measures on point.²¹⁵

[C] Super-Retroactivity: E.U. Resuscitated Rights

European developments call for analyses of retroactivity quite different from those just set out.²¹⁶ E.U. harmonization, coupled with E.U. non-discrimination, has had results that may be dramatized in terms of a pair of macabre metaphors. First, many works and related productions had been, so to speak, buried alive in the public domains of member states, but they have now been resuscitated. Second, some works and productions had never been protected in E.U. member states, or they had truly fallen dead into the public domains of these states, but rights in these works have since been resurrected. We shall speak, in both regards, of E.U. super-retroactivity.²¹⁷

²¹² On such bilateral agreements generally, see § 3[3][d] *supra*.

²¹³ *See, e.g.*, the *Tarzan* decision, BGH (Germany), Feb. 26, 2014, GRUR Int. 2014, 610 (declining to apply the Berne Convention to a U.S. work in which U.S. copyright had lapsed, while allowing continuing effect to the prior U.S.-German Agreement pursuant to Berne Article 20(2) but not Article 18(3)) (also discussed in § 4[3][b][i] *in fine infra*). *Quaere* to what extent this holding, to the extent generally followed, would undercut our metaphor of a relay race used here. The non-application of Berne retroactivity could deprive claimants of Berne minimum rights, while more favorable unilaterally or bilaterally based national treatment continued.

²¹⁴ *See* K. Deters, "Retroactivity and Reliance Rights Under Article 18 of the Berne Copyright Convention," 24 *Vanderbilt J. of Transnational Law* 971 (1991).

²¹⁵ *Compare* United States, Copyright Act, 17 U.S.C. §§ 104A(c) *et seq.* (calling for a notice to be filed in the U.S. Copyright Office or served on reliance parties to enforce restored copyright against such parties), *with* Directive 2006/116/EC of the European Parliament and of the Council of 12 December 2006 on the term of protection of copyright and certain related rights (codified version) (hereinafter: the Term Directive), Art. 10(3), O.J. 2006 L 372 (exempting acts of exploitation performed before a specified date).

²¹⁶ *See, respectively*, § 4[3][a][i][A] *supra* (default position: no retroactivity) *and* § 4[3][a][i][B] *supra* (conditional Berne retroactivity).

²¹⁷ E.U. retroactivity may apply at least through E.E.A. member states. *See* §§ 1[1] *in fine* and 3[3][a][ii][A] *supra*.

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How can a work or related production be buried alive in the public domain? Recall the non-discrimination principle which, under the *Phil Collins* judgment, requires each E.U. member state to grant national treatment to claimants from other such states as to copyright and neighboring rights.²¹⁸ Up to this judgment in 1993, E.U. member states had most often applied the Berne rule of the shorter term to works by authors from other member states, cutting back domestic terms to any shorter term provided in the country of origin of any work at issue.²¹⁹ For example, the German Federal Court of Justice applied this rule to hold that the opera *Tosca*, originating in Italy circa 1900 and authored by the Italian composer Puccini who died in 1924, fell into the German public domain by the end of 1980, cutting the longer German term of life plus 70 years back to the shorter Italian term.²²⁰ Effectively overturning such holdings, the European Court of Justice has since confirmed that the principle of non-discrimination applies back in time to any E.U. claimant such as Puccini, even if he died before the E.C. or E.U. Treaty bound his home country and the protecting country: accordingly, the rule of the shorter term could not be permissibly applied in prior cases of such E.U. authors.²²¹ Thus, in that light, it may be said that the German Federal Court of Justice had buried Puccini's *Tosca* alive in the German public domain by impermissibly refusing it the full German term. Rather, in principle, *Tosca* remained protected in Germany to 1995.²²²

We now come to how E.U. super-retroactivity revived rights in many older works and productions.²²³ Article 10(2) of the E.U. Term Directive, in relevant part, provides for this super-retroactivity as follows: "The terms of protection provided for in this Directive shall apply to all works and subject matter which were protected in at least one Member State" on July 1, 1995, "pursuant to national provisions on copyright or related rights."²²⁴ The Term Directive generally provides that copyright in any

²¹⁸ *Phil Collins v. Imtrat Handelsgesellschaft mbH*, E.C.J., Oct. 20, 1993, Joined Cases C-92/92 and C-326/92, [1993] 3 C.M.L.R. 773 (also discussed in § 3[3][a][iii][A] *supra* and in § 5[1][c][i] *infra*).

²¹⁹ On the Berne rule of the shorter term, see § 5[2][a][ii] *infra*.

²²⁰ The *Puccini I* decision, BGH, July 1, 1985, GRUR Int. 1986, 802 (also discussed on different points in § 4[3][a][i][A] *supra* and in § 4[3][b][ii] *infra*).

²²¹ *Land Hessen v. Ricordi & Co. Bühnen- und Musikverlag GmbH*, E.C.J., June 6, 2002, Case C-360/00, para. 31, [2002] E.C.R. I-5089 (confirming German copyright, with its full term, in Puccini's opera *La Bohème*, while stressing the requirement of placing E.U. nationals "in a situation governed by Community law [. . .] on a completely equal footing").

²²² *N.b.*, reliance considerations may be argued to constrain monetary awards for infringing such "resuscitated" copyrights. See, e.g., the *Beatles Double CD* decision, BGH, Dec. 18, 1997, GRUR 1998, 568; the *Bruce Springsteen* decision, BGH, April 23, 1998, GRUR 1999, 49, GRUR Int. 1999, 62 (contemplating awards for usage only after it became foreseeable, arguably in the early 1990s, that these rights could be asserted once again).

²²³ See also K. Jorna and M. Martin-Prat, "New Rules for the Game in the European Copyright Field and Their Impact on Existing Situations," [1994] E.I.P.R. 145 (on retroactive effects of the E.U. directives generally, including the Term Directive); D. Bradshaw, "The E.C. Copyright Duration Directive: Its Main Highlights and Some of its Ramifications for Businesses in the UK Entertainment Industry," [1995] Ent. L. Rev. 171 (on the Term Directive with specific examples).

²²⁴ Term Directive, Art. 10(2), O.J. 2006 L 372 (also applying, arguably in the alternative, its

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qualifying work lasts for the life of its author plus 70 years, while it specifically provides other extended terms for copyright-related rights in diverse categories of media productions.²²⁵ By force of habit, one might look only to an author's home country to see whether copyright subsisted on July 1, 1995, in order to qualify her for the directive-extended term. However, benefiting from the E.U. principle of non-discrimination, an E.U. claimant may invoke her copyright or related right subsisting in any member state at that time.²²⁶ Consider, for example, the painting *Broadway Boogie-Woogie*, created by the Dutch artist Mondrian and shown in the United States shortly before he died in 1944. Copyright expired in Mondrian's works in the Netherlands at the end of 1994 when the then-effective Dutch term of life plus 50 years lapsed. But his copyrights were effective in Germany on July 1, 1995, with the German term of life plus 70 years, thanks to E.U. non-discrimination. In E.U. member states, including the Netherlands, copyright in *Broadway Boogie-Woogie* was revived pursuant to E.U. super-retroactivity.²²⁷

The following points illustrate questions that may arise concerning such retroactivity in limited cases:²²⁸

- *Reliance interests*: Article 10(3) of the Term Directive states that this directive applies "without prejudice to any acts of exploitation performed" before July 1, 1995, and leaves it up to each E.U. member state to adopt provisions to protect reliance interests, that is, as it puts it, the "acquired rights of third parties."
- *Non-discrimination in time*: In principle, once a state becomes an E.U. member, it has to respect the E.U. principle of non-discrimination even with regard to rights it has accorded from before the date of such membership.²²⁹ For example, Spain assumed such an obligation on January 1, 1986: its then-current copyright term of life plus 80 years has since been deemed to have extended in Spain to works by a then-dead author from another E.U. member,

extended terms to "works and subject matter [. . .] which meet the criteria for protection under Directive 92/100/EEC").

²²⁵ *Id.*, Art. 1(1). *See also id.*, Art. 3–6 (related rights). *See also* Directive 2011/77/EU of the European Parliament and of the Council of 27 September 2011 amending Directive 2006/116/EC on the term of protection of copyright and certain related rights, O.J. 2011 L 265 (extending the term of rights in phonograms).

²²⁶ *I.e.*, the author's E.U. nationality qualifies her for such national treatment in any E.U. member state. *See* § 4[2][a][i] *supra*.

²²⁷ Distinguish such revival from any issue turning on the Berne country of origin of the work in question. *See* § 4[3][b][ii] *infra*.

²²⁸ For further analysis, see C. Angelopoulos, "The Myth of European Term Harmonisation: 27 Public Domains for the 27 Member States," 43 I.I.C. 567 (2012).

²²⁹ *See, generally*, § 3[3][a][ii][A] *supra* (explaining this principle, also effective within the E.E.A.). *See, e.g.*, Land Hessen v. Ricordi & Co. Bühnen- und Musikverlag GmbH, E.C.J., June 6, 2002, Case C-360/00, para. 26, [2002] E.C.R. I-5089 (noting that copyright in the work at issue, originating *circa* 1900 by Puccini, deceased in 1924, "was still producing its effects as regards the persons claiming under [. . .] Puccini when the EEC Treaty entered into force").

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as it would have been to a work by a Spanish author deceased before December 7, 1987.²³⁰ By the same token, reference may be made to this prior Spanish copyright term to protect other E.U.-authored works with directive-extended terms.²³¹

- *Varying regimes in mid-1995:* In stray cases, copyright laws with varying criteria of protectability, or varying term-relevant categories, had been in effect among member states. Such variance could make it hard to tell whether a work or related production, no longer protected in at least one E.U. member state under one such law, was still protected in any other under a somewhat different law on July 1, 1995, as would have been necessary to trigger E.U. super-retroactivity.²³² For example, at that time, criteria of protectability or terms of protection may have fluctuated among E.U. member states for designs, given the overlap of copyright with design rights, or for works hard to distinguish from related productions, say, photographic works from mere snapshots.²³³
- *Non-E.U. works and productions:* As already repeatedly illustrated, the E.U. non-discrimination principle extends to works by E.U. authors and to related productions made by E.U. performers or producers.²³⁴ Albeit without the benefit of that principle, a work not so authored, or a production not so made, may still be protected in E.U. member states with a directive-extended term if, pursuant to Article 10(2) of the Term Directive, it is still protected in one such state on July 1, 1995. Consider recordings made of performances by the U.S. artist Bob Dylan and publicly released in the United States: these did not qualify for protection in Germany, notably under any treaty, starting from the time of their release. Nonetheless, Article 10(2) of the Term Directive compelled Germany to protect them, with the directive-extended term, once the United Kingdom, another E.U. member state, protected them on July 1,

²³⁰ Tribunal Supremo (Supreme Court) (Spain), April 13, 2015, no. 177/2015, Repertorio Aranzadi Jurisprudencia 2015, no. 1192 (protecting the works of G.K. Chesterton, who had died in 1936) (also discussed in §§ 5[2][b][ii] and 5[3][b] *infra*).

²³¹ See, e.g., OLG Hamburg (Germany), March 3, 2004, ZUM-RD 2004, 303 (reviving German copyright in a photograph in which the prior German copyright had lapsed in 1968 and in which Spanish copyright continued to be effective after Spain joined the European Community, now the Union).

²³² See, e.g., *Montis Design BV v. Goossens Montis Design BV v. Goossens Meubelen BV*, C.J.E.U., 3rd ch., Oct. 20, 2016, Case C-169/15, paras. 32–37, [2017] E.C.D.R. 213 (confirming that, under E.U. law, copyright in any design work, extinguished in its E.U. member state of origin for prior failure to satisfy design-related formalities, was not revived, on the premise that no copyright protected the design in any member state on July 1, 1995).

²³³ On the diverse conditions for protecting designs by industrial property or copyright, see § 4[1][c][i][A] *supra*. On the distinction between copyright in photographic works and related rights in mere snapshots generally, see § 4[1][c][iii] *supra*.

²³⁴ See, generally, § 3[3][a][ii][A] *supra* (noting the extension of this principle within the European Economic Area). See, e.g., *Phil Collins v. Imtrat Handelsgesellschaft mbH*, E.C.J., Oct. 20, 1993, Joined Cases C-92/92 and C-326/92, [1993] 3 C.M.L.R. 773 (as discussed in §§ 3[3][a][ii][A] and 4[3][a][i][C] *supra* and in § 5[1][c][i] *infra*).

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1995.²³⁵ It will be asked below whether or not the rule of the shorter term may apply in such a case.²³⁶

- *Already running terms; wartime extensions:* Article 10(1) clarifies that the Term Directive may not shorten any term running on July 1, 1995, in a member state. Subject to that condition, implementation of the Directive may supersede some wartime term extensions previously instituted in member states, as indicated below.²³⁷ Some courts may distinguish between a wartime extension preserved as running on July 1, 1995, and one that may have been, so to speak, swallowed up in a longer term then instituted.²³⁸

[ii] Prior Provisions as Grounds for Protection to Date

Turn to provisions that may furnish grounds for protection abroad until needed, for example, for authorizing exploitation or for suing for infringement. As indicated above, only in expressly regulated cases will a work or related production, once fallen into the public domain of a country, be pulled out of it to be retroactively protected.²³⁹ There may, however, be no need to invoke such retroactivity, which will be subject to conditions and might trigger reliance issues, if an older foreign work or production has been protected, from the moment it arose, by different provisions seamlessly over time.²⁴⁰ We have seen such transitions, proceeding from one grounding provision to another, bring to mind a relay race, in which the protection of a foreign work or production is passed, like the racers' baton, from an earlier to a later provision. We shall here consider distinct cases of such transitions.²⁴¹

²³⁵ Sony Music Entertainment (Germany) GmbH v. Falcon Neue Medien Vertrieb GmbH, E.C.J., Grand ch., Jan. 20, 2009, Case C-240/07, paras. 23–25, [2009] E.C.R. I-263 (stressing the need to construe the directive uniformly).

²³⁶ See § 5[2][b][ii] *in fine infra*.

²³⁷ See, generally, § 5[1][b][i] *in fine infra* (indicating wartime extensions allowable under Berne or more favorable treaty provisions); § 5[2][a][i] *infra* (outlining the relation of these extensions and others to the rule of the shorter term). See, e.g., Cass. crim. (Italy), Dec. 29, 2009, Dir. aut. 2010, 207 (refusing to add in any wartime extension, given legislation extending term pursuant to the E.U. directive on point in the mid-1990s).

²³⁸ See, e.g., the *Monet* decision, Cass., 1e ch. civ. (France), Feb. 27, 2007, RIDA 2007, no. 212, 287 (where works, already dropped into the French public domain, were retroactively protected anew given a longer term of copyright in them running in Germany on July 1, 1995, not tacking prior French wartime extensions onto any such new term).

²³⁹ See § 4[3][a][i][A] *supra*.

²⁴⁰ On prior domestic or treaty provisions either furnishing grounds protection until some Berne Act comes into play or dealing with residual reliance interests at that point, see § 4[3][a][i][B] *in fine supra*.

²⁴¹ For analysis of whether the requirements of each of any series of grounding protection is met, one after another, see § 4[3][b][i] *infra*; for analysis of which treaty provisions prevail, when they are in tension, notably as to term, see § 5[1][b] *infra*; on the treaty rule of the shorter term, able to break off protection in time, § 5[2] *infra*.

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As explained above, the Berne Convention has been revised in a series of Berne Acts concluded across the twentieth century.²⁴² An older work could then very well have been initially protected by an earlier Berne Act until a subsequent Berne Act came into effect to protect it. For example, in the Swiss case of the silent-film classic *The Gold Rush*, as discussed above, the work at issue had been published in 1925, and suit was brought for infringement taking place in the 1960s under the Brussels Act of Berne by virtue of its author's British citizenship.²⁴³ The Swiss Federal Court could avoid inquiry into retroactivity by confirming that *The Gold Rush* had been protected under the prior Berlin Act and then the Rome Act of the Berne Convention up to the moment that the Brussels Act came into effect in Switzerland for British works. This holding turned on the finding that *The Gold Rush* had indeed been first published in Canada in 1925, this pursuant to the Berlin Act then in effect. This fact allowed for protection under successive Berne Acts applicable to the work from 1925 forward up to the time of infringement.²⁴⁴

As already noted, the Universal Copyright Convention does not apply retroactively.²⁴⁵ Rather, it assures U.C.C. protection of a work predating U.C.C. adherence only if that work was not yet in the public domain of the protecting country.²⁴⁶ Crucial U.C.C. provisions, however, reserve rights "acquired" under "existing conventions or arrangements": these may assure prior protection until a U.C.C. act takes effect.²⁴⁷ Consider cases illustrating how such a provision may operate, specifically those of works created by U.S. nationals before U.C.C. protection began to be available for them in other countries. To this point, to protect U.S. works, the United States relied on a variety of different arrangements with some other countries, for example, diplomatic assurances of reciprocity or bilateral or regional treaties.²⁴⁸ Thus, one of these pre-U.C.C. arrangements would have had to provide a basis for prior protection to keep U.S. works from permanently falling into the public domain in any of these countries before the Universal Copyright Convention took effect between the United States and that country. Or, in the alternative, a U.S. work would have had to have been

²⁴² See § 3[3][b][i] *supra*.

²⁴³ Swiss *Gold Rush* case, Tribunal Fédéral (Supreme Court), Nov. 3, 1970, ATF 96 II 412, here cited in its English trans. in 2 I.I.C. 315 (1971) (discussed in § 4[2][b][iii] *supra*).

²⁴⁴ See also § 4[3][b][ii] *in fine infra* (reliance considerations also support looking to the definition in effect at the time of the "publication" at issue).

²⁴⁵ See § 4[3][a][i][A] *supra*.

²⁴⁶ However, once the Berne Convention preempts U.C.C. protection for a given class of works, say, U.S. works, the Berne retroactivity provision goes into effect for any of such works in a Berne protecting country. For the operation of this provision, see § 4[3][a][i][B] *supra*.

²⁴⁷ U.C.C., Arts. XVIII and XIX (Geneva, Paris). See also §§ 4[3][b][i], 5[1][b], and 5[2] *infra* (further considering issues of primacy between differing treaty provisions, most notably concerning the rule of the shorter term).

²⁴⁸ On such grounds generally, see §§ 3[2][c] and 3[3][d] *supra*. For specific U.S. arrangements, see U.S. Copyright Office, "International Copyright Relations of the United States," Circular 38A, at <http://www.copyright.gov/circs/circ38a.pdf>.

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protected unilaterally in a given country or else by virtue of first publication in a Berne country such as Canada.²⁴⁹

Such issues arose in French and German cases of U.S. silent-film classics, but with different outcomes. Buster Keaton had authored and first published a number of such works in the United States during the 1920s. However, U.S. copyrights in each of these works had lapsed upon failure to renew them at the end of their first 28-year U.S. terms. Should other countries stop protecting them, under the rule of the shorter term, when they fell into the U.S. public domain?²⁵⁰ The French court applied that rule, ostensibly in its U.C.C. form, dropping Keaton's silent films into the French public domain once these were no longer protected in the United States.²⁵¹ By contrast, the German court held that, under the U.S.-German Agreement of 1892, Keaton, deceased in 1966, had "acquired" the right to a life-plus German term. Accordingly, his works were still protected in Germany at the date his case arose.²⁵²

[b] Recurring Procedures of Analysis in Certain Cases

Consider an older work or production originating in one country. We have just seen how successive provisions may be invoked as grounds for its protection in another country, if need be finessing the need to invoke retroactivity in cases of old works. To confirm such protection to date, it may then be necessary to undertake the following types of recurring inquiries for each of such provisions: (i) whether its requirements have been satisfied, including the requirement of timely protection, notably with a term of rights still running; (ii) what role the so-called country of origin of a given work or production may have in satisfying such requirements over time.

[i] Meeting Requirements Under Successive Provisions

Go back to our metaphor of a relay race. Either the copyright baton is dropped: the work or production at issue falls into the public domain; in that event, the provision invoked to protect it anew may in appropriate cases apply retroactively, on conditions set out above.²⁵³ Or protection is relayed forward: a foreign work or production may still be protected on prior grounds at the moment of transition when any new provision comes into play to assure protection in the future, eliminating any need to invoke retroactivity, as just explained.²⁵⁴ Thus, for an older work or production, it may be

²⁴⁹ See, generally, §§ 3[2][b] and 4[2][b][i] *supra* (respectively, on unilateral and so-called back-door Berne protection). See, e.g., *Swiss Gold Rush* case, Tribunal Fédéral (Supreme Court), Nov. 3, 1970, ATF 96 II 412, in English trans. in 2 I.I.C. 315 (1971) (as discussed in § 4[2][b][iii] *supra*).

²⁵⁰ For analysis of the rule of the shorter term, see § 5[2] *infra*; of effects of U.S. failure to renew, § 5[3][a] *infra*.

²⁵¹ French *Keaton* decision, S.A. Galba Films c. M. Friedman, CA Paris, 1e ch., April 24, 1974, RIDA 1975, no. 83, 106, in English trans. in 7 I.I.C. 130 (1976), *affirmed*, Cass., 1e ch. civ., Dec. 15, 1975, RIDA 1976, no. 88, 115 (also discussed in §§ 5[2][a][ii] and 5[3][a] *infra*).

²⁵² German *Keaton* decision, BGH, Jan. 27, 1978, GRUR Int. 1979, 50, in English trans. in 10 I.I.C. 358 (1979) (also discussed in §§ 4[3][b][i] and 5[2][a][i] *infra*).

²⁵³ See § 4[3][a][i] *supra*.

²⁵⁴ See § 4[3][a][ii] *supra*.

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necessary, not only to invoke different grounding provisions succeeding each other in time, but to determine whether, and how, each such provision or set of provisions has picked up and carried protection further, eventually to the moment of exploitation or infringement. We shall later explain the “country of origin,” a technical notion often crucial in following out protection over time.²⁵⁵

To confirm protection along the way, the work or production at issue has to be rematched with the requirements of each grounding provision invoked one after another over time. Each such provision, as here discussed, typically has three types of requirements: first, coverage of the matter at issue; second, meeting any eligibility criterion; and, third, timely protection.²⁵⁶ In a series of such provisions invoked as grounds for protection one after another over time, it cannot be assumed that each such provision will impose all these requirements in the same way. Generally, multilateral treaties elaborately articulate fields of coverage, eligibility criteria, and provisions regarding timely protection, only exceptionally allowing for conditional retroactivity. More specifically, a bilateral arrangement or the E.U. principle of non-discrimination may allow only the author’s nationality to meet its eligibility criterion triggering national treatment for works.²⁵⁷ Bear in mind that, if a treaty provides grounds for protecting a foreign work or production in a given country, the claimant receives national treatment subject to treaty-specified exceptions. The work at issue may then also meet some conditions of protection under applicable national copyright law, for example, as sufficiently creative. However, as explained below, some exceptions may curtail national treatment, notably cutting back any domestic term to that applicable in the country of origin.²⁵⁸

To see how, for older works, it can become critical to meet the distinct requirements of each of a series of grounding provisions for protection, turn back to cases of classic films. For example, in the Swiss case of Charlie Chaplin’s *Gold Rush* and in the German case of Buster Keaton’s films, we saw different series of treaty provisions invoked to assure seamless protection over time.²⁵⁹ For that purpose, earlier treaty provisions were held to have protected the films at issue starting from the time when they were released, and later treaty provisions were held to have continued protection up to the time of eventual infringement. In the Swiss *Gold Rush* case, successive Berne Acts served as grounds for protection *seriatim*;²⁶⁰ in the German *Keaton* case, the U.S.-German Agreement of 1892 initially assured national treatment for the film author Buster Keaton, followed by the later Universal Copyright Convention, but without prejudice to the right Keaton had acquired to a national term of protection

²⁵⁵ See § 4[3][b][ii] *infra*.

²⁵⁶ See, respectively, §§ 4[1], 4[2], and 4[3][a] *supra*.

²⁵⁷ See §§ 3[3][a][ii][A] and 3[3][d] *supra*.

²⁵⁸ See § 5[2][a] *infra*. See also § 4[1][c][i][C] *supra* (possible cut-back on national treatment of designs).

²⁵⁹ See § 4[3][a][ii] *supra*.

²⁶⁰ Tribunal Fédéral (Supreme Court), Nov. 3, 1970, ATF 96 II 412, here cited in its English trans. in 2 I.I.C. 315 (1971) (discussed in §§ 4[2][b][iii] and 4[3][a][ii] *supra*).

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under the prior bilateral treaty.²⁶¹ If we were to follow out grounds for protection of works of U.S. authors in Germany to the present, we would find the prior bilateral treaty still operative, with the Universal Copyright Convention eclipsed by the Berne Convention on March 1, 1989, as it has been in most other U.C.C. countries.²⁶² For example, in Japan, Berne protection was claimed in nine of Chaplin's films: terms running under prior Japanese law effective upon the release of each film carried protection forward to points where longer terms under newer law took over.²⁶³

In cases of older works, courts may at times have to consider earlier and later provisions that, invoked as successive grounds for protection effective one after the other over time, are not necessarily fully consonant with each other.²⁶⁴ Consider how the German Federal Court of Justice has dealt with tensions among the U.S.-German Agreement of 1892, the Universal Copyright Convention effective between the United States and Germany from 1955 to 1989, when Berne took over, and domestic and, arguably, E.U. laws. In its prior *Keaton* decision, we saw this court confirm the right which, under the bilateral treaty, an author had "acquired" to a term of life plus 50 years instituted in 1934, noting that third parties had relied on that term when dealing in the works at issue over decades.²⁶⁵ In subsequent cases, U.S. writers' claims in older works were asserted: Jack London's claims in his story *White Fang*, first published in 1905, before his death in 1916; and Edgar Rice Burroughs' claims in his *Tarzan* series, with publication from 1912, before his death in 1950. Claimants argued that, pursuant to national treatment under the bilateral treaty, the successor to each author's rights would have benefited from an extension of the German copyright term to life plus 70 years effective starting in 1965. The court rejected these arguments, rather holding to the German term of life plus 50 years, as acquired and relied upon under the bilateral treaty.²⁶⁶

²⁶¹ BGH, Jan. 27, 1978, GRUR Int. 1979, 50, in English trans. in 10 I.I.C. 358 (1979) (also discussed in § 4[3][a][ii] *in fine supra* and § 5[2][a][i] *infra*).

²⁶² See, e.g., Zorro Productions Inc. c. Co.Ge.Di International S.p.A., Cass. civ., sez. I (Italy), Jan. 3, 2017, no. 32, pt. 2.2, at <http://www.ilcaso.it/giurisprudenza/archivio/16558.pdf> (holding the U.S.-Italian Agreement of 1892 still in effect, even after the United States joined the Berne Union, in which Italy was an original member) (discussed in § 5[2][a][i] *infra*).

²⁶³ YK Art Station v. Roy Export Co., Hanrei Jiho (No. 2064) 120 (Supreme Court, 1st Petty Bench, Oct. 8, 2009).

²⁶⁴ For systematic analysis of this problem, see § 5[1] *infra*.

²⁶⁵ BGH, Jan. 27, 1978, GRUR Int. 1979, 50, in English trans. in 10 I.I.C. 358 (1979) (also discussed in § 4[3][a][ii] *in fine supra* and § 5[2][a][i] *infra*). For critical analysis, see E. Ulmer, "The Term of Protection for Works of American Origin in the Federal Republic of Germany," 10 I.I.C. 287, 292–294 (1979).

²⁶⁶ The *Wolfsblut* (White Fang) decision, BGH, Jan. 27, 1978, GRUR 1979, 52, in English trans. in 10 I.I.C. 363 (1979); the *Tarzan* decision, BGH, Feb. 26, 2014, GRUR Int. 2014, 610 (citing the *Wolfsblut* decision).

[ii] Settling the Meaning of the “Country of Origin”

The notion of the *country of origin* is critical both to the Berne retroactivity rule and to exceptions to national treatment that are explained elsewhere in this chapter.²⁶⁷ This notion may accordingly have to be applied in recurring inquiries into whether or not protection is available at all, how long it lasts, or its scope. Berne provisions define this notion most precisely, so that other treaty provisions or regional or domestic law may predicate corresponding definitions, as indicated below.²⁶⁸

The country of origin of a work is generally defined to be, if the work at issue is unpublished, the country of which its author is a national or, if it is published, its country of first publication.²⁶⁹ Berne revisions adopted and then amplified this general definition, by supplementing it with special definitions: the most important applies to those cases in which there is “simultaneous” publication rather than clearly “first” publication. Under the Rome Act of the Berne Convention, “simultaneous” publication, sometimes understood as taking place on the same day, has been liberally construed in the case law, as explained above.²⁷⁰ In the Berne Brussels and Paris Acts and in both U.C.C. Acts, “simultaneous publication” is deemed to occur when publications in different countries occur within 30 days of each other.²⁷¹

In the event a work is simultaneously published both inside and outside the Berne Union, the Berne country of origin will be the country found within the Berne Union or, if two or more countries of such publication are found in the Union, in that country granting the shortest term of protection.²⁷² The Paris Act of the Berne Convention specifies that, for works of Berne nationals first published outside the Union, without simultaneous publication in any Berne country, the country of origin is that of which the author is a national.²⁷³ Given simultaneous publication in two U.C.C. countries, the Universal Copyright Convention treats, as the country of origin, that country

²⁶⁷ On the Berne retroactivity rule, see § 4[3][a][i][B] *supra*. On the exception possibly restricting the protection of design works, see § 4[1][c][i][A] *supra*. On the rule of the shorter term, restricting national treatment to a shorter term granted in the country of origin, see § 5[2] *infra*. On minimum rights, possibly expanding national treatment, see § 5[4][a][ii] *infra*.

²⁶⁸ See, e.g., § 5[2][b][ii] *infra* (outlining how E.U. law now instructs member states to apply the Berne notion for purposes of the rule of the shorter term). *But see* M. Walter, “Term Directive” § 1, in M. Walter and S. von Lewinski (eds.), *European Copyright Law: A Commentary*, 499, 590 (Oxford Univ. Press, 2010) (indicating why this notion was shifted to “the country of which the rightholder is a national” in Article 7(2) of the E.U. Term Directive, which concerns related rights subject to its Article 3). See also A. Bogsch, *The Law of Copyright Under the Universal Convention*, 51–52 (Sijthoff, 3d ed., 1968) (proposing to adapt the Berne notion of a “country of origin” for purposes of U.C.C. rules);

²⁶⁹ Berne, Art. 4(3) (Rome, Brussels), Art. 5(4) (Paris); U.C.C., Art. IV(4) (Geneva, Paris). See, e.g., CA Paris, 4e ch. (France), May 22, 2002, RIDA 2002, no. 194, 320 (considering Germany as a Berne “country of origin” when a concerto by Rachmaninoff, a Russian national, was first published there).

²⁷⁰ See §§ 4[2][b][ii] and 4[2][b][iii] *supra*.

²⁷¹ Berne, Art. 4(3) (Brussels), Art. 3(4) (Paris); U.C.C., Art. IV(6) (Paris).

²⁷² Berne, Art. 4(3) (Rome, Brussels), Art. 5(4)(a)–(b) (Paris).

²⁷³ Berne, Art. 5(c) (Paris). On the meaning of “national” in Berne, see § 4[2][a][i] *supra*.

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granting the shortest term or, for a work of a U.C.C. national first published in a non-U.C.C. country, the country of which its author is a national.²⁷⁴

Berne sets out still further special definitions for works not necessarily protected by virtue of an author's national status or the place of first publication. The Paris Act provides that, if not first or simultaneously published in the Berne Union, a cinematographic work will be deemed to have its country of origin in that country of the Union where its "maker" has its "headquarters or his habitual residence," without regard for the nationalities of possible authors of the work.²⁷⁵ Both the Brussels and Paris Acts provide that any architectural, sculptural, or artistic work erected or made into a fixture of real property in a country of the Union finds its country of origin in the country where it is so erected or fixed, on the premise that, if such a work lacks multiple iterations or "copies," it can have no first or simultaneous publication in the Union.²⁷⁶

To determine which definition of the "country of origin" applies to the facts of a given case, it is indispensable to keep firm hold of the distinction between the country to which the work at issue is connected or attached to make its author eligible for protection, on the one hand, and its country of origin, on the other.²⁷⁷ Professor Eugen Ulmer drew this distinction as follows:

"[T]he first question is that of connecting factors. It is only if protection under the convention is accorded pursuant to the rules concerning connecting factors that the question arises concerning what country of the Union is the country of origin; from the response found to that [second question] flow certain consequences bearing on the content and extent of protection."²⁷⁸

First, to obtain protection in a given protecting country, the work or production at issue has to be matched against possible copyright grounding provisions to see whether it is covered and satisfies a criterion for eligibility under at least one of these provisions. Thus, in the *Gold Rush* case, at the time that infringement took place in

²⁷⁴ U.C.C., Art. IV(5)–(6) (Geneva, Paris).

²⁷⁵ Berne, Art. 5(4)(c)(i) (Paris). *See also* H. Desbois, A. Françon, and A. Kéréver, *Les conventions internationales du droit d'auteur et des droits voisins*, para. 134 (Daloz, 1976) (noting that authors' nationalities are not taken into account since they are likely to be numerous in the case of a cinematographic work and therefore likely to complicate the task of identifying the country of origin).

²⁷⁶ Berne, Art. 4(5) (Brussels), Art. 5(4)(c)(ii) (Paris). *See also* W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 61 (Berne Art. 5, Rem. 8) (Werner-Verlag, 1977) (stating that the country of origin of such a work, if it is first or simultaneously published in a Berne country, for example, by a distribution of graphic reproductions, will be that Berne country).

²⁷⁷ On the distinction between the country to which a work has any "connecting factor" satisfying a criterion of eligibility, on the one hand, and its "country of origin," on the other, see § 4[2] *supra*. In many instances, these conceptually distinct notions will in fact refer to one and the same country, but in some instances they may not.

²⁷⁸ E. Ulmer, "Points de rattachement et Pays d'origine dans le système de la Convention de Berne" (Connecting factors and Country of origin in the system of the Convention of Berne), N.I.R. 1967/36, 208, 214.

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Switzerland, the fact that Chaplin was a British subject justified eligibility under the Brussels Act of the Berne Convention to which Switzerland adhered along with the United Kingdom.²⁷⁹ Second, once it is clear on which Berne or other grounding provision a claimant may rely in the case at hand, its corresponding definition of the country of origin may come into play in determining timely protection or to trigger any exception to national treatment, notably as to term.²⁸⁰

With changing facts or law, especially over time, this method may give rise to hard cases.²⁸¹ Consider, for example, the case of coauthors who are nationals of different adhering countries, along with that of simultaneous publication in different adhering countries. The commentary suggests this solution in the case of coauthors: by analogy with the rules regarding simultaneous publication, the country of origin for a joint work with coauthors from different adhering countries should be that according to the shortest term.²⁸² However, where this term is the same in a case of coauthorship or simultaneous publication, there may in theory be two or more countries of origin, though in practice legal results may be much the same in most cases, notably when the rule of the shorter term is applied.²⁸³

Start with a country of origin as determined by the Berne Act effective at the time of initial publication of the work at issue. Reliance on legal consequences weighs against letting that country of origin later shift to another country over time.²⁸⁴ Consider, for example, Germany and Italy both bound by the original 1886 Act through the current Paris Act: for an opera published in Italy by an Italian composer at the start of the twentieth century, the country of origin remains Italy under the Berne Act in effect at that time.²⁸⁵ Similarly, where an author changes nationality or a related status over time, residence at the time of first publication may count to determine the

²⁷⁹ Swiss *Gold Rush* case, Tribunal Fédéral (Supreme Court), Nov. 3, 1970, ATF 96 II 412, here cited in its English trans. in 2 I.I.C. 315 (1971); German *Gold Rush* case, BGH, May 19, 1972, GRUR Int. 1973, 49, here cited in its English trans. in 4 I.I.C. 245 (1973) (both cases more fully explained in § 4[2][b][iii] *supra*).

²⁸⁰ See § 4[3][a] *supra* and § 5[2][a] *infra*.

²⁸¹ See M. Walter, "Term Directive" § 2.5, in M. Walter and S. von Lewinski (eds.), *European Copyright Law: A Commentary*, 499, 594–596 (Oxford Univ. Press, 2010).

²⁸² See W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 60–61 (Berne Art. 5, Rem. 8) (Werner-Verlag, 1977).

²⁸³ See, generally, § 5[2] *infra* (on the rule of the shorter term). But see § 4[1][c][i][A] *supra* (results may still vary when applying the Berne rule conditioning the protection of design works, given that the rule turns on the tenor of the law protecting designs in the country of origin of the work at issue, not on any term of protection).

²⁸⁴ See W. Nordemann, "De la détermination du pays d'origine selon la Convention de Berne" (in English trans.: Determining the country of origin according to the Berne Convention), RIDA 1984, no. 121, 3.

²⁸⁵ The *Puccini I* decision, BGH (Germany), July 1, 1985, GRUR Int. 1986, 802, 804 (discussed in §§ 4[3][a][i][A] and 4[3][a][i][C] *supra*).

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country of origin.²⁸⁶ But absent a common Berne Act at the time of such a fact, the earliest act effective in the case may define the country of origin.²⁸⁷

§ 5 How Much Protection May be Available?

[1] Which Grounding Provision Prevails?

What if the requirements are met for protecting a foreign work or production in a given country?¹ As a general rule, national treatment ensues, that is, protection pursuant to the domestic law of this protecting country.² But national treatment may be subject to diverse exceptions, depending on the provision that furnishes grounds for protection. Suppose that the requirements of more than one such grounding provision are met: Which provision prevails? We shall here treat such tensions between (a) domestic and treaty provisions, (b) those of different treaties, and (c) the E.U. legal order and treaties. With these tensions sorted out, we can turn to exceptions either cutting back on national treatment or bolstering it.³

[a] Between Domestic and Treaty Provisions

As explained above, some countries, notably jurisdictions in the British and Scandinavian traditions, enact domestic law to implement all treaty obligations.⁴ In that event, where only domestic statutory or regulative provisions may provide grounds for protection, there can be no open contradiction between these and treaty provisions. If the terms of such domestic provisions were to display ambiguities or potential inconsistencies in a given case, it would be necessary, we have seen, to settle their meanings with an eye to having these terms themselves satisfy any treaty obligations that they had been intended to implement.⁵ Were there any tension between these treaties themselves, the court could have to construe domestic law according to the treaty hierarchy we shall soon outline.⁶

²⁸⁶ See H. Desbois, A. Françon, and A. Kéréver, *Les conventions internationales du droit d'auteur et des droits voisins*, para. 133 (Daloz, 1976).

²⁸⁷ See, e.g., the *Tarzan* decision, BGH (Germany), Feb. 26, 2014, GRUR Int. 2014, 610 (following this approach when, upon first publication, Berne did not bind both the protecting country, Germany, and that satisfying any eligibility criterion, the United States) (discussed in § 4[3][b][i] *in fine supra*).

¹ For analysis of the three types of requirements to be fulfilled, see § 4 *supra*.

² *Caveats*: The “normal” cases presuppose that no wild conflicts analysis undercuts Berne-plus treaty principles. See § 3[1][a][i] *supra*. National treatment also varies in scope at its margins. See § 5[4][b] *infra*.

³ Compare § 5[2] *infra* (cut-back in the term of protection), with § 5[4][a] *infra* (minimum rights bolstering national treatment). See also § 4[1][c][i][A] *supra* (cut-back in copyright protection of design works); § 5[3][c] *infra* (rare derogations to national treatment).

⁴ See § 3[2][a] *supra*.

⁵ See § 3[4][a] *supra*.

⁶ See § 5[1][b] *infra*.

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By contrast, many countries consider key provisions of copyright treaties as, on the whole, self-executing.⁷ In such countries, there is always the possibility that a work might qualify for protection both under a domestic grounding provision and under one or more treaties. In that event, one or more domestic or treaty provisions may arguably apply to the same issue in a case, possibly dictating different approaches to exceptions to national treatment. In Article 19 of its Paris Act, the Berne Convention allows an adhering country to grant “greater protection” than any Berne provision would on any given issue.⁸ For example, if a work qualifies for unilateral protection in a country, it may be protected without any Berne exception cutting back on national treatment. On such a point, the more protective domestic law applies.⁹

Berne Article 19, incorporated by reference into the TRIPs Agreement and the WIPO Copyright Treaty, furnishes a model for resolving tensions between domestic law and treaties in the field.¹⁰ What is a court to do if a country, after adhering to a Berne Act or sequel treaty, enacts domestic legislation which cuts back on Berne or comparable protection?¹¹ The legal order of that country, notably its constitution, should tell its courts whether to apply only domestic legislation or any more favorable treaty provision. It may be preferable to construe the provisions in apparent tension so that they apply harmoniously to the case at bar.¹²

Under Berne Article 19, what could “greater” or “lesser” protection mean? A clear case lies in the duration of protection, since it is typically measured in years. Where it is a matter of any right subject to any limitation or exception, the interpretation of “more” or “less” protection becomes more delicate. Some limitations, favoring freedom of expression, may benefit creators, whom the Berne-plus treaty regime is intended to protect. The protective impact of any such constraint on rights may have to be assessed case by case.¹³

⁷ For a review of such treaties, see § 3[3] *supra*.

⁸ See, generally, W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 124–125 (Berne Art. 19, Rems. 1–2) (Werner-Verlag, 1977) (confirming the discretion of a Berne country to grant greater protection to a Berne-qualifying work than the applicable Berne Act itself requires).

⁹ On unilateral protection, see § 3[2][b] *supra*.

¹⁰ TRIPs, Art. 9; W.C.T., Art. 1(4).

¹¹ See, generally, W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 15–17 (Intro., Rems. 33–35) (Werner-Verlag, 1977) (distinguishing between the case where domestic law inadvertently contradicts a treaty provision and should be construed to avoid the contradiction, on the one hand, and the case where domestic law is expressly made to override the treaty provision on the other).

¹² For such construction, see § 3[4][b][ii] *supra*.

¹³ For further analysis and examples, see §§ 2[2][b][iii] and 3[1][b][iii][C] *supra* and § 5[4][a][i][C] *infra*.

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[b] Between Convention or Treaty Provisions

Copyright treaties are said to fall into a “hierarchy.”¹⁴ A treaty situated higher up in this hierarchy in principle prevails over a treaty below it on any given issue. Unless the higher treaty provides otherwise, its provisions will effectively supersede those below it if both bear on the same issue in a case. Thus, tensions between treaties are to a large extent avoided, and optimally only one approach to exceptions to national treatment ought to apply.¹⁵ Here tensions will be considered (i) between Berne or sequel provisions and others and (ii) between those of other treaties, respectively.

[i] Berne/TRIPs/WIPO Provisions Prevail

The Berne Convention stands at the top of the putative hierarchy of copyright treaties. Just as domestic law ought not override Berne obligations, other treaty provisions ought not either.¹⁶ To challenge Berne primacy, one might be tempted to invoke the principle of *lex posterior derogat legi anteriori*, that is, subsequent law derogates from prior law.¹⁷ However, under Article 20 of the Berne Convention, adhering countries may only “enter into special agreements among themselves” insofar as these “grant to authors more extensive rights” than do Berne provisions or are “not contrary” to Berne provisions.¹⁸

The TRIPs Agreement and the WIPO “Internet” Treaties, as sequel treaties, elaborate on Berne and Rome rights.¹⁹ Thus, to the extent that the TRIPs Agreement imposes Berne obligations on non-Berne countries, it prevails over less protective copyright treaties.²⁰ By contrast, Article 14 of the TRIPs Agreement assures rights in performances, phonograms, and broadcasts, but these rights do not consistently rise to the levels of Rome neighboring rights. Merely filling in specific gaps in the international scheme of neighboring rights, TRIPs Article 14 may not then prevail over prior, more protective Rome provisions, but it would prevail, for example, over less

¹⁴ *But see* F. Majoros, *Les conventions internationales en matière de droit privé* (The international conventions on private international law), vol. 2, 50–53 (A. Pedone, 1980) (doubting that any “static hierarchy” among treaties can be established once and for all, especially with regard to choice-of-law options, given the variability of laws that might come into conflict).

¹⁵ But, on the shifting meaning of the “country of origin,” a notion critical for applying most of the exceptions to national treatment, see § 4[3][b][ii] *supra*.

¹⁶ For the analysis relative to domestic law and Berne, see § 5[1][a] *supra*.

¹⁷ *See* Vienna Convention, Art. 30 (setting out rules for ordering successive treaty provisions in accord with this principle). *But see* § 3[4][b][ii] *supra* (proposing, rather, where possible, to construe away tensions among successive provisions).

¹⁸ *See, generally*, W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 5–9 (Intro., Rems. 5–10) (Werner-Verlag, 1977) (concisely reviewing such special agreements).

¹⁹ TRIPs, Arts. 9 and 14; W.C.T., Art. 1(4), W.P.P.T., Arts. 6 *et seq.*, 11 *et seq.*, 15 *et seq.*

²⁰ *See* P. Katzenberger, “TRIPs and Copyright Law,” in F.-K. Beier and G. Schriker (eds.), *From GATT to TRIPs: The Agreement on Trade-Related Aspects of Intellectual Property Rights*, 59, 66–68 (Wiley-VCH, 1996).

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protective Geneva provisions.²¹ In any event, Article 2(2) of the TRIPs Agreement declares that its substantive provisions shall not “derogate from existing obligations,” *inter alia*, under the Berne and Rome Conventions, so that only more protective TRIPs provisions would prevail over corresponding Berne or Rome provisions.²²

These sequel treaties presuppose ongoing Berne protection, quite unlike the U.C.C. relation to such protection. As the TRIPs Agreement does, the WIPO Copyright Treaty incorporates and complements Berne provisions, albeit a bit differently.²³ By contrast, the Universal Copyright Convention has served as a “second-best” alternative to the Berne Union. Berne primacy was confirmed in U.C.C. provisions that mandated retaliation for violating this primacy.²⁴ A Berne member may not substitute U.C.C. for Berne protection in any case of a work of Berne origin.²⁵ In any event, U.C.C. terms no longer apply to a work once the Berne Convention protects it.²⁶

The primacy of the Berne Convention gives way to another domestic or treaty provision only issue by issue.²⁷ For example, the Spanish composer Albéniz invoked the French-Spanish Treaty of 1889, coupled with a diplomatic exchange of 1957 concerning wartime extensions of copyright terms.²⁸ The Berne Convention, governing the overall copyright relation between France and Spain, was held to be supplemented by the diplomatic exchange, so that the claimant’s French copyright term was lengthened by the wartime extension.²⁹ It remains to be seen how, as just asked, issue analysis may manage tensions with limitations or exceptions to rights.³⁰

²¹ See A. Kéréver, “The Protection of copyright and neighbouring rights in the TRIPs Agreement signed in Marrakesh,” UNESCO Copr. Bull. 1994, no. 4, 3.

²² On TRIPs jurisprudence construing Berne provisions, see § 5[5][b][ii][A] *infra*.

²³ See M. Ficsor, *The Law of Copyright and the Internet: The 1996 WIPO Treaties, their Interpretation and Implementation*, 418–425, 590–594 (Oxford Univ. Press, 2002).

²⁴ See U.C.C., Art. XVII and Appendix Declaration Relating to Article XVII (Geneva, Paris). Under this Appendix Declaration in its Paris form, if a Berne member, absent notice to UNESCO in the case of a developing country, left the Berne Union, other Berne members could cease U.C.C. protection for works with this country as a Berne country of origin.

²⁵ See, e.g., A. Bogsch, *The Law of Copyright Under the Universal Convention*, 113–116 (Sijthoff, 3d ed., 1968) (noting that U.C.C. Article XVII precludes a prior Berne text from being superseded by a later U.C.C. text).

²⁶ See, e.g., § 5[3][a] *infra* (noting U.C.C. and Berne treatment of a work of U.S. origin in which the prior U.S. term lapsed for failure to fulfill U.S. formalities).

²⁷ See also § 1[3][c] *supra* (issue analysis generally to defuse conflicts); § 4[3][a][i][B] *supra* (tensions in applying Berne retroactivity); § 5[1][a] *supra* (in applying domestic law versus Berne provisions); § 5[2][a][i] *infra* (overriding the Berne rule of the shorter term).

²⁸ For analysis of laws and treaties on point, see C. Masouyé, “Les prorogations de guerre” (in English trans.: The Wartime Extensions), RIDA 1954, no. 3, 49, RIDA 1954, no. 4, 81, RIDA 1955, no. 9, 83, RIDA 1957, no. 15, 109, RIDA 1958, no. 20, 59. But for later E.U. law superseding some wartime extensions, see § 4[3][a][i][C] *in fine supra*.

²⁹ *Ciganer c. SACEM*, Cass., 1e ch. civ., Oct. 9, 1979, RIDA 1980, no. 103, 151. See also *K.K. Matsudera v. King Features Syndicates, Inc.*, 51 Minshu 2714 (Supreme Court, 1st Petty Bench, July 17, 1997) (Japan), in English trans. at <http://www.softic.or.jp/en/cases/popeye.html> (confirming current Berne

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[ii] Tensions Between Diverse Instruments

As just seen, the Berne Convention or a sequel treaty generally prevails over any other to the extent that it is equally or more protective on a given issue.³¹ But account may nonetheless have to be taken of the following questions: Which treaty concerning neighboring rights prevails over another such treaty in any case of tension? Which treaty prevails in such a case as between a treaty concerning copyright, on the one hand, and a treaty concerning neighboring rights, on the other? In what cases may the Universal Copyright Convention still come into play?

As between treaties concerning neighboring rights, the provision providing for the strongest protection would ostensibly apply, on the analogy with Berne primacy or on the basis of treaty terms themselves.³² Thus, in cases where only neighboring rights apply, Rome remains the instrument of choice, since it guarantees national treatment and strong minimum rights, while the TRIPs Agreement provides for somewhat limited versions of these minimum rights.³³ The WIPO Performances and Phonograms Treaty, applying without derogation to the Rome Convention and without prejudicing protection under other treaties, could only apply to supplement protection under such treaties.³⁴ The Geneva Phonograms Convention, only assuring some form of protection against piracy, applies in the last resort.³⁵

In principle, neighboring or related rights may be neither construed nor applied to prejudice copyright.³⁶ Indeed, György Boytha warned that proliferating related rights, with potentially “conflicting legal effects,” introduced “the risk of *disharmony*” into international copyright.³⁷ The assurances the Berne Convention gives to authors, as well as their successors in interest, could be invoked so that claims based on copyright would not be prejudiced by overlapping neighboring rights. Specifically, there is the problem of allocating out slices of the entire “cake” of royalties that are paid for using a work, on the one hand, and any recording of a performance of that work, on the

protection for U.S. works, Popeye comics, first published in 1929, while adding wartime extensions to copyright terms pursuant to the U.S.-Japanese peace treaty).

³⁰ See § 5[1][a] *in fine supra*. See also § 5[4][a][i] *infra* (inquiring into the impact of the Marrakesh VIP Treaty, which imposes specific exceptions on the Berne-plus regime, and how to construe these and other treaty limitations generally).

³¹ See § 5[1][b][i] *supra*.

³² See, e.g., Rome, Art. 22 (agreement granting “more extensive rights” prevails); Geneva, Preamble and Art. 7(1) (not to “limit or prejudice the protection otherwise secured”); W.P.P.T., Art. 1(1) (no derogation to Rome).

³³ On Rome and TRIPs minimum neighboring rights, see §§ 5[4][a][i][B] and 5[5][b][i] *infra*.

³⁴ See M. Ficsor, *The Law of Copyright and the Internet: The 1996 WIPO Treaties, their Interpretation and Implementation*, 590–594 (Oxford Univ. Press, 2002).

³⁵ For further analysis, see V. de Sanctis, “Some general considerations on the recent Geneva Convention for the protection of phonograms,” *Copyright* 1972, 111.

³⁶ See § 4[1][c][ii][B] *supra*.

³⁷ G. Boytha, “Interrelationship of Conventions on Copyright and Neighboring Rights,” *Acta Juridica Academiae Scientiarum Hungaricae* 1983, 403, at 413.

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other.³⁸ Where, for example, a song is performed and then recorded and the recording is broadcast to the public, royalties will be due on copyright in the song and on neighboring rights in the performance and recording.³⁹ Ideally, treaty principles should control claimants' respective shares of royalties in such cases.⁴⁰

U.C.C. provisions only conditionally prevail over prior treaty provisions.⁴¹ They leave unaffected both Berne provisions and "[r]ights in works acquired," notably under any other treaty, before any U.C.C. effective date.⁴² For example, in German cases already discussed, U.C.C. protection was subject to the right U.S. authors had "acquired" in their works under the U.S.-German Agreement of 1892.⁴³ The Berne Convention supersedes the Universal Copyright Convention relative to any given work it protects, as just explained.⁴⁴

[c] Between E.U. Law and Treaty Provisions

Could any tension arise between E.U. law and any copyright treaty binding the European Union itself or an E.U. member state? In principle, E.U. law confirms treaty obligations to extend copyright and related protection both to E.U. and non-E.U. claimants. Nonetheless, we have to consider caveats that may apply (i) in cases with only E.U. claimants and (ii) in any case with a non-E.U. claimant.⁴⁵

[i] As to E.U. Member States and Claims

For E.U. claimants, E.U. law may often prove more protective than any copyright treaty, as already indicated.⁴⁶ In the *Phil Collins* case, the E.U. principle of non-discrimination was held to entitle any national of a member state to full national

³⁸ See, e.g., P.E. Geller, "The Proposed EC Rental Right: Avoiding Some Berne Incompatibilities," [1992] E.I.P.R. 4, at 7–8 (noting that copyright could be prejudiced if related rights in videograms formed a pretext for siphoning off revenues otherwise due to authors of cinematographic works). See also G. Pessach, "The Beijing Treaty on Audiovisual Performances—The Return of the North?," 55 *Idea* 77 (2014) (questioning whether such related rights might even benefit audiovisual performers).

³⁹ On voluntary and non-voluntary licenses to this effect, see § 4[1][c][ii][B] *supra* and § 5[4][a][i][B] *infra*.

⁴⁰ See § 2[1][c][ii] *supra*.

⁴¹ See U.C.C., Arts. XVIII and XIX (Geneva, Paris).

⁴² See A. Bogsch, *The Law of Copyright Under the Universal Convention*, 125 *et seq.* (Sijthoff, 3d ed., 1968); A. Rinaldo, "The Scope of Copyright Protection in the United States under Existing inter-American Relations," 22 *Bull. Copr. Soc'y* 417, 425 *et seq.* (1975).

⁴³ For these cases, considered together, see § 4[3][b][i] *supra*. For the impact on the rule of the shorter term, see § 5[2][a][i] *infra*. For further analysis, see J. Drexler, "Duration of Copyright Protection Accorded U.S. Authors in the Federal Republic of Germany—Changes Due to the U.S. Accession to the Berne Convention," 22 *I.I.C.* 27, 45–46 (part one) (1991), 22 *I.I.C.* 204, 211–218 (part two) (1991).

⁴⁴ See § 5[1][b][i] *supra*. On Berne retroactivity, see § 4[3][a][i] *supra*. On Berne treatment of pre-1978 U.S. works in this regard, see § 5[3][a] *infra*.

⁴⁵ Analyses here may apply in the European internal market. See § 1[1] *in fine*.

⁴⁶ E.E.A. claimants may benefit from non-discrimination within the European Economic Area. See § 3[3][a][ii][A] *supra*.

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treatment relative to copyright or related rights in other member states.⁴⁷ Such non-discrimination may then result in equal or greater protection for E.U. claimants than does the Berne Convention or other treaties in the field. In particular, it short-circuits any treaty exception cutting back on national treatment, especially the rule of the shorter term. Accordingly, as to national treatment, no tension arises with treaty obligations.⁴⁸

But, in an E.U. member state, may any copyright treaty provide self-standing grounds for claiming treaty minimum rights, above and beyond simple national treatment? The question arises out of the increasing European role in the field: the Community, now superseded by the Union, bound itself by the TRIPs Agreement, and it next adhered to the WIPO “Internet” Treaties. More decisively, the E.U. Court of Justice has confirmed that the European Union may alone conclude further treaties in the field, effectively with the E.U. member states in tow, and the E.U. Court has increasingly asserted its own authority to construe the terms of such treaties.⁴⁹ Its case law suggests that, within the E.U. legal order, the TRIPs Agreement and WIPO Treaties, along with Berne or Rome provisions these incorporate, may not suffice, on their own terms, to assure rights of private parties.⁵⁰

We have here a problem of ordering E.U. and other treaty obligations. In the best of all possible worlds, this problem may be envisaged in theory but finessed in practice. On the one hand, the European Union may not “stand in the way of the obligations of the Member States” to comply with copyright treaties binding each of such states.⁵¹ On the other hand, if no copyright treaty sufficed, on its own terms, to provide private parties with grounds of protection, how would treaty obligations, like those of the TRIPs Agreement or the WIPO Treaties, be met in member states where these obligations still lacked full legislative implementation?⁵² Since, as just reiterated, E.U.

⁴⁷ Phil Collins v. Imtrat Handelsgesellschaft mbH, E.C.J., Oct. 20, 1993, Joined Cases C-92/92 and C-326/92, [1993] 3 C.M.L.R. 773 (discussed in §§ 3[3][a][ii][A] and 4[3][a][i][C] *supra*).

⁴⁸ For the option of providing greater protection, see §§ 5[1][a] and 5[1][b][i] *supra*. For analysis of the rule of the shorter term, see § 5[2] *infra*; for another rule allowing a cut-back in the protection of design works, see § 4[1][c][i][A] *supra*.

⁴⁹ For further analysis, see §§ 3[3][a][ii][A] and 3[4][a] *supra*.

⁵⁰ See, e.g., Società Consortile Fonografici (SCF) v. Marco Del Corso, C.J.E.U., 3rd ch., March 15, 2012, Case C-135/10, paras. 36–56 *passim*, [2012] E.C.D.R. 276 (as noted in §§ 3[3][a][ii][A] and 3[4][a] *supra* and in § 5[1][c][ii] *infra*). See also Martin Luksan v. Petrus van der Let, C.J.E.U., 3rd ch., Feb. 9, 2012, Case C-277/10, paras. 54–67, [2013] E.C.D.R. 125 (holding that E.U. law controls how member states may implement Berne options in national legislation) (noted, as to substance, in § 6[3][b][ii] *in fine infra*).

⁵¹ Società Consortile Fonografici (SCF) v. Marco Del Corso, C.J.E.U., 3rd ch., March 15, 2012, Case C-135/10, para. 50, [2012] E.C.D.R. 276. See also Commission v. Ireland, E.C.J., March 19, 2002, Case C-13/00, paras. 14–20, [2002] E.C.R. I-2943 (concluding that it fell “within the scope of Community competence” to assume “responsibility” for “due performance” under the Berne Convention).

⁵² See, generally, J.-S. Bergé, “Les mots de l’interaction: compétence, applicabilité et invocabilité (à propos de CJUE, 21 déc. 2011, ATAA, aff. C-366/10—CJUE, 15 mars 2012, SCF, aff. C-135/10—CE, 11 avril 2012, GISTI, req. no. 322326) (Interaction Terms: Jurisdiction, Applicability, and Invocability [re

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claimants benefit from national treatment within the E.U. legal order as to copyright and related rights, this question would above all concern treaty minimum rights.⁵³ In theory, in E.U. member states, such copyright treaties as the European Union enters, arguably with treaty provisions these incorporate, operate through, and by virtue of, the E.U. legal order itself.⁵⁴ In practice, the E.U. Court, as well as members' courts, have to construe treaty terms and E.U. law harmoniously, hopefully without prejudice to treaty minimum rights.⁵⁵ In any event, the E.U. Court provides the last European recourse for deciding any such treaty question.⁵⁶

[ii] Vis-à-vis Non-E.U. Countries and Claims

Turn now to non-E.U. claimants. Before joining the European Community, now the Union, E.U. member states adhered to the Berne Convention and manifold other treaties.⁵⁷ Not only do such states still remain bound by all these treaties *vis-à-vis* non-E.U. countries and thus non-E.U. claimants, but E.U. law itself precludes prejudicing rights arising under prior treaties with third-party countries.⁵⁸ In principle, E.U. adherence to later treaties, like the TRIPs Agreement and the WIPO "Internet" Treaties, also obligates member states to comply with their provisions that assure the rights of private claimants from other countries.⁵⁹ Nonetheless, for reasons just broached, the question arises: May non-E.U. claimants still find self-standing grounds of protection in copyright or related treaties binding any E.U. state which had historically applied provisions of such treaties on their own terms?⁶⁰

CJEU Cases . . .], *J. du Droit International* (Clunet) 2012, no. 3, 1005, at 1012–1014 (noting differences in national legislative contexts of copyright treaties among E.U. member states).

⁵³ On such treaty minimum rights, see § 5[4][a] *infra*.

⁵⁴ See, generally, A. Rosas, "The Status in EU Law of International Agreements Concluded by EU Member States," 34 *Fordham International L.J.* 1304, 1329–1330 (2011) (mentioning the TRIPs incorporation of copyright-treaty provisions by reference, so that these become applicable in the E.U. legal order even if they do not themselves bind the Union).

⁵⁵ Compare *Infopaq International A/S v. Danske Dagblades Forening*, E.C.J., 4th ch., July 16, 2009, Case C-5/08, para. 34, [2009] E.C.R. I-6569 (interpreting E.U. directive in the light of "the general scheme of the Berne Convention"), with *Tribunal Supremo* (Supreme Court) (Spain), April 13, 2015, no. 177/2015, *Repertorio Aranzadi Jurisprudencia* 2015, no. 1192 ("[i]n the ambit of the European Union," applying Berne prohibition of formalities to works of U.K. writer) (as discussed in § 4[3][a][i][C] *supra* and in §§ 5[2][b][ii] and 5[3][b] *infra*).

⁵⁶ See, generally, H.-J. Lucas, "La Cour de justice européenne respecte-t-elle les conventions internationales sur le droit d'auteur et les droits voisins?" (Does the E.U. Court of Justice Respect the International Conventions on Copyright and Neighboring Rights?), in C. Bernault, *et al.* (eds.), *Mélanges en l'honneur du Professeur André Lucas*, 555 (LexisNexis, 2014) (critiquing C.J.E.U. case law in this regard).

⁵⁷ For a review of such treaties, see § 3[3] *supra*.

⁵⁸ T.F.E.U., Art. 351(1) (reserving "rights and obligations arising from [prior] agreements [. . .] between one or more Member States on the one hand, and one or more third countries on the other").

⁵⁹ See F. Martines, "Direct Effect of International Agreements of the European Union," *European J. International Law* 2014, 129, at 132–136.

⁶⁰ See § 5[1][c][i] *supra*.

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For non-E.U. claimants seeking treaty-assured copyright or related protection within E.U. member states, we offer the following rule of thumb: Base claims on provisions that the European Union or any member state enacts to implement treaty obligations or, absent such legislation, on treaty provisions themselves, as these operate within the E.U. legal order.⁶¹ Such a belt-and-suspenders approach to pleading E.U., domestic, and treaty provisions, as well as invoking the E.U. legal order, reflects tensions within that order itself with regard to copyright treaties, especially as they protect non-E.U. claimants. On the one hand, national laws vary markedly among E.U. states in how they protect foreign claimants' rights, ranging from laws with full implementing legislation to laws with at most declaratory references to copyright treaties themselves.⁶² On the other hand, the E.U. Court of Justice has already held that, within the E.U. legal order, private claimants may not rely on at least certain copyright treaties as providing self-standing grounds for rights.⁶³ But E.U. law precludes prejudicing rights arising under treaties ratified with non-E.U. countries before E.U. treaties became binding and, arguably, under treaties concluded under E.U. auspices.⁶⁴ Thus, if relying on treaty grounds of protection in an E.U. state without implementing legislation, a non-E.U. claimant could prudently also invoke E.U. law that indeed predicates treaty-based rights.⁶⁵ Failure to give Berne or Rome provisions effect within the E.U. legal order could prompt charges of TRIPs non-compliance.⁶⁶

⁶¹ For domestic and treaty grounds for protection, see, respectively, §§ 3[2] and 3[3] *supra*.

⁶² *N.b.* not all of these treaties obviously fall within the E.U. legal order, for example, the U.S.-German Agreement of 1892. *See, e.g.,* the *Tarzan* decision, BGH (Germany), Feb. 26, 2014, GRUR Int. 2014, 610 (considering alternative treaty, German, and E.U. provisions as bearing *vel non* on the protection of a U.S. work) (discussed in § 4[3][b][i] *in fine supra*).

⁶³ *See* Società Consortile Fonografici (SCF) v. Marco Del Corso, C.J.E.U., 3rd ch., March 15, 2012, Case C-135/10, paras. 36–56 *passim*, [2012] E.C.D.R. 276 (as noted in §§ 3[3][a][ii][A] and 3[4][a] *supra* and discussed in § 5[1][c][i] *supra*). *But see, e.g.,* the *Evening with Marlene Dietrich* decision, BGH (Germany), April 21, 2016, GRUR 2016, 1048, in English trans. in 48 I.L.C. 353 (2017) (avoiding the issue of whether a U.S. singer may rely on TRIPs or W.P.P.T. provisions alone in the field of E.U.-harmonized copyright law) (discussed in § 3[4][b][ii] *supra* and § 5[4][b][i] *in fine infra*).

⁶⁴ *See, generally,* T.F.E.U., Art. 351(1) (reserving “rights and obligations arising from [prior] agreements” with “third countries”). *See, e.g.,* Directive 2006/116/EC of the European Parliament and of the Council of 12 December 2006 on the term of protection of copyright and certain related rights (codified version), Art. 7, O.J. 2006 L 372 (speaking of “[p]rotection vis-à-vis third countries [. . .] without prejudice to the international obligations”). *See also* § 5[2][b][ii] *infra* (discussing this issue in the context of the rule of the shorter term).

⁶⁵ *See, generally,* M. Walter, “Term Directive” § 2.1, in M. Walter and S. von Lewinski (eds.), *European Copyright Law: A Commentary*, 499, 591–592 (Oxford Univ. Press, 2010) (noting that, in mentioning protection pursuant to “international obligations,” the Term Directive “presupposes the further existence of corresponding national rules and international treaties” that effectuate such obligations throughout the field of copyright, albeit differently in different E.U. member states, respectively, pending E.U. legislation on point).

⁶⁶ On such risks that E.U. member states run in participating in the E.U. legal order, see M. Ličková, “European Exceptionalism in International Law,” 19 *European J. of International Law* 463, 475–490 *passim* (2008). On consequences of TRIPs non-compliance, see § 5[5][b][ii] *infra*.

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The TRIPs Agreement had given rise to an argument for expanded E.U. protection of non-E.U.-based claims. Recall the holding that each E.U. member state must accord full national treatment to E.U. nationals with regard to copyright and related rights.⁶⁷ If E.U. national treatment fell under TRIPs most-favored-nation treatment, it would trigger the far-reaching consequence of obligating E.U. members to accord full national treatment to the nationals of all W.T.O. members.⁶⁸ However, since the European Union is a W.T.O. member itself, entitled to liberalize trade within the European internal market faster than with other W.T.O. members, it makes little sense to speak of its own member states as granting most-favored-nation treatment to each other.⁶⁹ In any event, the European Union has notified the World Trade Organization of E.U. instruments pursuant to TRIPs Article 4(d), ostensibly to qualify for the exception to TRIPs most-favored-nation treatment in that provision.⁷⁰

[2] Has Protection Lapsed Under the Rule of the Shorter Term?

The rule of the shorter term may, in appropriate cases, cut back on national treatment with regard to the duration of rights. We shall here ask: (a) When, and in what form, may the rule of the shorter term apply in any given case? (b) How to identify the work and terms subject to the rule in certain hard cases?

[a] When, and in What Form, to Apply the Rule?

The rule of the shorter term allows reducing the duration of rights, *grosso modo*, as follows: first, find the term of protection for the foreign work at issue in the domestic law of the protecting country; second, find the term for the “same” work in the law of its country of origin; third, compare these terms: protection then lasts as long as the shorter of the two terms.⁷¹ Domestic or treaty law may decide whether, and how, this rule applies in a case. Hence our inquiries: (i) What law conditions the rule? (ii) In what form does it apply?

[i] Conditions for Applying the Rule or Not

Domestic law may determine whether, and how, to impose the rule of the shorter term.⁷² For example, country by country, implementing legislation may, or may not,

⁶⁷ See, e.g., *Phil Collins v. Imtrat Handelsgesellschaft mbH*, E.C.J., Oct. 20, 1993, Joined Cases C-92/92 and C-326/92, [1993] 3 C.M.L.R. 773 (as discussed in §§ 3[3][a][ii][A], 4[3][a][i][C], and § 5[1][c][i] *supra*).

⁶⁸ For such treatment specifically, see TRIPs, Art. 4. On the TRIPs Agreement generally, see § 5[5][b] *infra*.

⁶⁹ See, e.g., *Oberster Gerichtshof (Supreme Court) (Austria)*, Jan. 19, 2010, in English trans. in 41 I.I.C. 593 (2010) (rejecting the claim that, if Austria excused court bonds for claimants from E.U. member states following the E.U. non-discrimination principle, it had to do so for claimants from other W.T.O. members on the basis of most-favored-nation treatment).

⁷⁰ See, e.g., Notification to W.T.O. pursuant to TRIPs, Art. 4(d) (Dec. 1995).

⁷¹ For the definition of the “protecting country,” see § 1[1] *supra*; for that of the country of origin, see 4[3][b][ii] *supra*.

⁷² For the distinction between implementing treaty provisions in domestic law and applying treaty provisions directly, see § 3[2][a] *supra*. For analysis of how domestic or treaty law may short-circuit the

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provide for the rule, or it may condition its application. Or, case by case, courts may interpret it in the light of national law or doctrine when deciding how to apply it, or declining to apply it.⁷³ A prior bilateral agreement, notably with the United States, may assure unconditional national treatment and, thus, a full national term of copyright, notwithstanding any rule of the shorter term.⁷⁴ The E.U. principle of non-discrimination requires member states to grant national treatment to each other's nationals.⁷⁵ This principle precludes such states from applying the rule of the shorter term to E.U. nationals' copyright or related claims.⁷⁶

If not implemented in domestic legislation, the rule of the shorter term applies in a treaty provision, usually in its Berne form, absent contrary domestic law.⁷⁷ For example, the TRIPs Agreement and the WIPO Copyright Treaty incorporate the operative provisions of the Paris Act of the Berne Convention and, thus, the rule of the shorter term as found there.⁷⁸ Adjustments may, in increasingly rare cases indicated above, prove necessary where local laws, either in the protecting country or in the country of origin, provide for special, notably wartime, extensions of terms.⁷⁹ By parity of reasoning, a court should take account of extensions of term applicable in the country of origin of the work at issue.⁸⁰ There has been debate in the commentary

treaty rule of the shorter term by providing more favorable treatment to authors, see, respectively, §§ 5[1][a] and 5[1][b] *supra*.

⁷³ See, e.g., the *Die Fledermaus* decision, Théâtre Royal de la Monnaie c. Chavanne et Josef Weinberger Ltd., CA Brussels (Belgium), March 10, 1970, RIDA 1971, no. 67, 176 (applying the rule, but with a domestic definition of the "country of origin," and thus favorably to the copyright claimant in the case). *But see* § 5[2][b][ii] *infra* (outlining how E.U. law now instructs member states to apply the rule on specific conditions, for example, using the Berne definition of the "country of origin").

⁷⁴ See, e.g., the *Keaton* decision, BGH (Germany), Jan. 27, 1978, GRUR Int. 1979, 50, in English trans. in 10 I.I.C. 358 (1979) (as discussed in §§ 4[3][a][ii] *in fine* and 4[3][b][i] *supra*); Zorro Productions Inc. c. Co.Ge.Di International S.p.A., Cass. civ., sez. I (Italy), Jan. 3, 2017, no. 32, pts. 2.2–2.3, at <http://www.ilcaso.it/giurisprudenza/archivio/16558.pdf> (holding that the U.S.-Italian Agreement of 1892, "still in effect," requires national treatment, with a full Italian term in a work dating back to 1919, by a U.S. author deceased in 1958, so that the rule of the shorter term "was suspended") (also noted in § 4[3][b][i] *supra*).

⁷⁵ See, generally, 3[3][a][ii][A] *supra* (noting the extension of this principle within the European Economic Area). See, e.g., *Phil Collins v. Imtrat Handelsgesellschaft mbH*, E.C.J., Oct. 20, 1993, Joined Cases C-92/92 and C-326/92, [1993] 3 C.M.L.R. 773 (as discussed in §§ 3[3][a][ii][A], 4[1][c], 4[3][a][i][C], and 5[1][c][i] *supra*).

⁷⁶ See, e.g., the *Albert Londres* decision, CA Paris, 4e ch. (France), Sept. 30, 2002, RIDA 2002, no. 194, 371 (declining to apply the Berne rule of the shorter term in the light of the *Phil Collins* judgment).

⁷⁷ The U.C.C. rule may have applied transitionally to a work, until Berne protection, with its rule, took over. See §§ 4[3][a][ii] and 4[3][b][i] *supra*.

⁷⁸ On applying TRIPs provisions as self-executing, see § 3[3][a][i] *supra*. On determining which Berne or U.C.C. Act applies, see § 3[3][b] *supra*. On the primacy of Berne and TRIPs provisions in cases of tensions, see § 5[1][b][i] *supra*. On differences in the Berne and U.C.C. rules, see §§ 5[2][a][ii] and 5[2][b][i] *infra*.

⁷⁹ See, generally, § 4[3][a][i][C] *in fine supra* (setting out caveats to counting wartime extensions in E.U. cases); § 5[1][b][i] *in fine supra* (explaining their application in the case of a bilateral agreement).

⁸⁰ See, e.g., the *Briefe aus Petersburg* (Letters from St. Petersburg) decision, OLG Cologne

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about whether the rule may be applied right by right.⁸¹ The rule of the shorter term seems applicable only to economic rights, but not to moral rights.⁸²

Neighboring or related rights are more rarely subject to the rule of the shorter term. Article 7(2) of the E.U. Term Directive mandates E.U. member states to apply the rule, as it reformulates it, both to copyright in specified non-E.U. works and to neighboring or related rights in specified non-E.U. media productions such as performances, recordings, and broadcasts; however, the scope of this provision may be quite limited, as will soon be seen when the E.U. form of the rule is more fully discussed.⁸³ In the field of neighboring rights, Article 16(1)(a)(iv) of the Rome Convention only expressly allows adhering countries to make a reservation that would allow them to apply a rather hedged rule of the shorter term to the rights that performers and phonogram producers have pursuant to Article 12 to remuneration for the broadcasting or communication of sound recordings to the public.⁸⁴

[ii] Berne and U.C.C. Formulations of the Rule

We shall here generally distinguish Berne and U.C.C. forms of the rule of the shorter term. Bear in mind that Berne provisions should prevail over U.C.C. provisions where Berne requirements for protection are fulfilled for protecting a given work.⁸⁵ Specific caveats in special cases will be discussed below.⁸⁶

How does treaty language allow some measure of discretion in applying the rule of the shorter term?⁸⁷ This rule was introduced to permit Berne members to compensate

(Germany), Sept. 23, 2011, ZUM 2011, 924 (applying the full German term to works by a Russian author who had died in 1942, given Russia's special extension of term for suppressed works with rehabilitated authors, coupled with normal Russian terms of life plus 50 years and later of 70 years, thus equal to the German term).

⁸¹ Compare A. Bogisch, *The Law of Copyright Under the Universal Convention*, 55–56 (Sijthoff, 3d ed., 1968) (admitting the possibility of applying the rule right by right), with B. Ringer and L. Flacks, "Applicability of the Universal Copyright Convention to Certain Works in the Public Domain in Their Country of Origin," 27 Bull. Copr. Soc'y 157, 185 (1980) (critical of this position).

⁸² The initial Berne Act of 1886 included the rule of the shorter term, well before the Rome Act of 1928, in Article 6bis, introduced moral rights, without limiting them in time. Subsequent Berne Acts, in Article 6bis(2), call for them to last "at least until the expiry of the economic rights." See § 5[4][a][i][A] *infra*. National laws vary in thus setting the duration of moral rights or letting them last longer. See § 2[2][b][ii] *supra*. Insofar as they are protected unilaterally, they may be subject to national treatment. See § 3[2][b] *supra*.

⁸³ See § 5[2][b][ii] *infra*.

⁸⁴ On Rome reservations, see § 5[4][c][ii] *infra*.

⁸⁵ See § 5[1][b] *supra*. But Berne protection may be predicated on prior U.C.C. protection, which may have impacted the applicable term. See §§ 4[3][a][ii] and 4[3][b][i] *supra*.

⁸⁶ See, respectively, § 5[2][b][i] *infra* (analyzing cases where the work at issue is differently characterized in the protecting country and in the country of origin); § 5[2][b][ii] *infra* (sorting out cases where an E.U. member state, with any extended term, is a protecting country or a country of origin); § 5[3][a] *infra* (analyzing terms subject to the formality of renewal in a country of origin).

⁸⁷ For examples of such discretion, see § 5[2][a][i] *supra*. On controversy regarding the pre-Paris forms of the Berne rule, see W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und*

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for shorter terms of protection that other members still maintained.⁸⁸ The Paris Act of the Berne Convention declares that the rule of the shorter term is to apply “unless the legislation,” of the protecting “country otherwise provides,” but it does not limit this option to express legislative implementation.⁸⁹ This provision could be argued to allow, not only for declining to impose the rule altogether, but for liberalizing how it applies, whether by express statute or as a matter of case law.⁹⁰ It would arguably suffice thus to grant authors more favorable protection.⁹¹

The Universal Copyright Convention states that “[n]o country shall be obliged to” apply the rule of the shorter term as set forth there, but at the same time it leaves unclear both whether and how the rule has to be nationally implemented to be effective.⁹² Some countries, such as Germany and Italy, have confirmed in domestic statutory provisions that they will apply the rule to U.C.C.-protected works just as it is formulated in the Universal Copyright Convention.⁹³ However, without any such legislative mandate, the French court in the *Keaton* case had no difficulty at all applying the rule to U.C.C. works, albeit in obliquely referring to the rule as it had evolved in French law.⁹⁴ This decision makes clear that, however desirable a statutory position might be for knowing when to apply the U.C.C. rule, the prevailing copyright doctrine or case law of a country may serve to put it into effect or not.⁹⁵ It is therefore prudent to assume that the U.C.C. rule will apply, as formulated, unless the law of the protecting country varies this formulation or decides not to apply it all.⁹⁶

In applying either the Berne or U.C.C. rule of the shorter term, results may vary because of differences in the terms to be compared or in the country of origin.⁹⁷ The

Leistungsschutzrecht: Kommentar, 69–70 (Berne Art. 7, Rem. 4) (Werner-Verlag, 1977).

⁸⁸ The rule of the shorter term may not be invoked to undercut rights to Berne terms of protection, typically life plus 50 years, that have been imposed as minimum rights, gradually equalizing the duration of copyright in the Berne Union. See § 5[4][a][i][A] *infra*.

⁸⁹ Berne, Art. 7(8) (Paris).

⁹⁰ See W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 69 (Berne Art. 7, Rem. 4) (Werner-Verlag, 1977).

⁹¹ On this Berne possibility, see §§ 5[1][a] and 5[1][b][i] *supra*.

⁹² U.C.C., Art. IV(4) (Geneva, Paris). See A. Bogsch, *The Law of Copyright Under the Universal Convention*, 53 (Sijthoff, 3d ed., 1968).

⁹³ See, e.g., the *Tarzan* decision, BGH (Germany), Feb. 26, 2014, GRUR Int. 2014, 610 (analyzing the interplay between German extensions of term and its statutory approach to the U.C.C. rule of the shorter term) (discussed in § 4[3][b][i] *in fine supra*).

⁹⁴ *S.A. Galba Films c. M. Friedman*, CA Paris, 1e ch., April 24, 1974, RIDA 1975, no. 83, 106, in English trans. in 7 I.I.C. 130 (1976), *affirmed*, Cass., 1e ch. civ., Dec. 15, 1975, RIDA 1976, no. 88, 115 (also discussed in § 4[3][a][ii] *in fine supra* and in § 5[3][a] *infra*).

⁹⁵ See E. Ulmer, Note to French *Keaton* case, 7 I.I.C. 132, 133–134 (1976).

⁹⁶ See H. Desbois, A. Françon, and A. Kéréver, *Les conventions internationales du droit d’auteur et des droits voisins*, para. 99 (Daloz, 1976); W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 199–200 (U.C.C. Art. IV, Rem. 7) (Werner-Verlag, 1977).

⁹⁷ For the definition of this country, see § 4[3][b][ii] *supra*.

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Berne Convention states that “the term shall be governed by the legislation of the country where protection is claimed,” but that this term shall “not exceed the term fixed in the country of origin of the work.”⁹⁸ The Universal Copyright Convention contemplates a comparison of the term in the protecting country with the term in the country of origin, which will be considered as lapsed when it was not renewed in that country for failure to fulfill formalities.⁹⁹ For example, in the French *Keaton* case, there was no longer U.C.C. protection in France once U.S. copyright had not been renewed in the works at issue in the United States, their country of origin.¹⁰⁰ Consequences of these and further variations in the rule, notably in its E.U. form, will be discussed below.¹⁰¹

[b] Special Problems of Method in Applying the Rule

Problems can arise in applying the rule of the shorter term, notably (i) in characterizing the work at issue in the laws both of the protecting country and of the country of origin and (ii) in applying the rule as between an E.U. member state and a non-E.U. country.

[i] Classes of Works; the “Zero Term” Work

Initially, we proposed to apply the rule of the shorter term to the “same” work.¹⁰² The Berne rule calls for comparing the duration of copyright in the work at issue in the protecting country with that for the same work as if it were at issue in its country of origin. However, the U.C.C. rule may make it a hypothetical work in the same “class” as that occupied by the work at issue in the country of origin.¹⁰³ But what does the notion of “class” mean where, in rare cases, the work at issue may be characterized as falling into a class in its country of origin such that it is unprotected there? As we shall now illustrate, such a case may arise under the Berne as well as the U.C.C. rule.¹⁰⁴

Consider a hypothetical case: A Swede compiles a cookbook verbatim out of recipes which appeared in nineteenth-century texts now wholly in the public domain. Under Swedish law, such a compilation may be protected by copyright if it is sufficiently

⁹⁸ Berne, Art. 7(2) (Rome, Brussels), Art. 7(8) (Paris).

⁹⁹ U.C.C., Art. IV(4)(b) (Geneva, Paris). For further analysis, see A. Bogisch, *The Law of Copyright Under the Universal Convention*, 54–55 (Sijthoff, 3d ed., 1968).

¹⁰⁰ S.A. Galba Films c. M. Friedman, CA Paris, 1e ch. (France), April 24, 1974, RIDA 1975, no. 83, 106, in English trans. in 7 I.I.C. 130 (1976), *affirmed*, Cass., 1e ch. civ., Dec. 15, 1975, RIDA 1976, no. 88, 115 (also discussed in § 4[3][a][ii] *in fine supra* and in § 5[3][a] *infra*).

¹⁰¹ See § 5[2][b] *infra*.

¹⁰² See § 5[2][a] *supra*.

¹⁰³ U.C.C., Art. IV(4)(a) (Geneva, Paris).

¹⁰⁴ This notion of the “class” of work was introduced out of a concern to avoid the arguable consequence, under the U.C.C. rule of the shorter term, of refusing protection when the work at issue had never been protected by statutory copyright because of an initial failure to comply with formalities in its country of origin, as was possible in the United States at the time the U.C.C. protection initially arose. *N.b.*, this possibility just does not exist in the Berne Union, where protection outside the country of origin may no longer turn on formalities. See § 5[3][a] *infra*.

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creative or else under the “catalog” rule by a database right with a shorter term.¹⁰⁵ Suppose that, after first publication of this cookbook in Sweden, another publisher has the cookbook translated, printed, and sold in Japan, but without due authorization. Assume, for purposes of our hypothetical, that the court characterizes the cookbook as a “work” under Japanese law, that is, as a sufficiently original compilation of materials in the public domain to be protected by Japanese copyright. In Article 7 of the Paris Act, now applicable between Japan and Sweden, the Berne Convention provides for a minimum term of life plus 50 years, as well as for the rule of the shorter term, but only for “works.” To focus our inquiry, further assume that, under Swedish law, the compilation does not qualify as a work protected by copyright and, as well in our case, its short-termed database right has expired. Must the court choose between the life-plus Japanese term and the shorter term once granted by Swedish law, but now lapsed?¹⁰⁶

The Berne Convention offers an easy answer to this question. The Berne rule of the shorter term states that “the term shall be governed by the law of the [protecting] country.”¹⁰⁷ This language suggests that the court ought to look to the law of the protecting country, Japanese law in our hypothetical example, to assess whether the cookbook is indeed a “work” protected by copyright. This reading would then preclude the court from second-guessing whether, under the law of the country of origin, Swedish law in our hypothetical, one might characterize and protect the cookbook merely as a “catalog” or like data-set protected by a right with a far shorter duration than it would be as a work.¹⁰⁸ This construction has the advantages of all national treatment, notably simplicity and reliability in its reference to dispositive law, and it also avoids contradicting the principle that Berne protection is independent of protection in the country of origin.¹⁰⁹

The U.C.C. rule of the shorter term complicates matters. It calls for comparing the term for the work at issue in the protecting country with a term that the country of origin sets, “not necessarily” for “the particular work in question,” but for “the class

¹⁰⁵ See, e.g., Supreme Court (Sweden), *Nytt Juridiskt Arkiv* 1995, 256 (protecting with copyright a set of simple listings of electronic equipment, in a decision critiqued for failing to apply the weaker “catalog” right).

¹⁰⁶ See also §§ 2[2][a] and 4[1][c] *supra* (explaining and illustrating such differential characterization of creative works and of related, but non-creative, productions).

¹⁰⁷ Berne, Art. 7(2) (Rome, Brussels), Art. 7(8) (Paris).

¹⁰⁸ See W. Hoffmann, *Die Berner Uebereinkunft zum Schutze von Werken der Literatur und Kunst*, 133–134 (Springer, 1935). See also W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 34 (Berne Art. 2/2bis, Rem. 3) (Werner-Verlag, 1977) (stating that a court cannot arbitrarily draw a work out of the Berne classification to preclude protecting it) and *id.*, at 34–35 (Rem. 4) (the decision to protect a compilation turns on a finding of originality solely on the basis of domestic law).

¹⁰⁹ See, respectively, § 2[3][b] *supra* (explaining the historical rationale for national treatment); § 5[3][a] *infra* (illustrating the independence of Berne protection of a work from its status in its country of origin).

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of work to which the particular work belongs.”¹¹⁰ This procedure raises the specter of the “zero term” work: one looks to the law of the country of origin and characterizes the work at issue as falling into a class of works which that country does not protect at all, thus placing the term at zero.¹¹¹ But we would thus run the risk of mischaracterizing the work at issue to the extent that the law, whether of the protecting country or of its country of origin, is unsettled as to its “class.”¹¹²

[ii] Between an E.U. Member and a Non-E.U. State

E.U. developments raise special issues concerning the rule of the shorter term: Whether, and how, to apply this rule to an E.U. work or related production outside Europe? When, and how, to apply the E.U. form of the rule to any non-E.U. work or production for which protection is sought in an E.U. state?¹¹³

Start with a work authored by an E.U. national or a related production made by an E.U. national. Recall that, pursuant to so-called E.U. super-retroactivity, such a work or related production may have been recouped out of the public domains of E.U. states.¹¹⁴ Furthermore, any such work or production is at the same time exempted from application of the rule of the shorter term in E.U. states even if it could be argued to have fallen into the public domain of any E.U. state because of prior application of this rule. This is the case because the E.U. principle of non-discrimination precludes any E.U. state from applying this rule against any E.U. national.¹¹⁵ For example, once Spain joined the European Community on January 1, 1986, it could no longer apply the rule to a work by any E.U. author.¹¹⁶

¹¹⁰ A. Bogisch, *The Law of Copyright Under the Universal Convention*, 54 (Sijthoff, 3d ed., 1968) (also pointing out some reasons why introducing the word “class” here did not necessarily make the U.C.C. comparison of terms easier, as it “had been said” it might).

¹¹¹ *But see* B. Ringer and L. Flacks, “Applicability of the Universal Copyright Convention to Certain Works in the Public Domain in Their Country of Origin,” 27 Bull. Copr. Soc’y 157, 193–194 (1980) (suggesting, first, to find the proper “class” in the protecting country and, second, to find a “class” corresponding to that one in the country of origin).

¹¹² *See, generally*, § 4[1][c][i][A] *supra* (raising a comparable problem under the Berne rule of reciprocity with regard to designs). *See, e.g.*, the *Eames Lounge Chair* decision, OLG Frankfurt (Germany), March 19, 1981, GRUR 1981, 739, in English trans. in 13 I.I.C. 777 (1982) (finessing the U.C.C. argument that a design work by U.S. designers, Charles and Ray Eames, fell into a class of works unprotected in the United States, its country of origin).

¹¹³ These analyses may at least apply to E.E.A. claimants and within the European Economic Area, following the Term Directive. *See* § 1[1] *in fine supra*.

¹¹⁴ *See* § 4[3][a][i][C] *supra*.

¹¹⁵ *See, generally*, § 3[3][a][ii][A] *supra* (noting the extension of this principle within the European Economic Area). *See, e.g.*, *Phil Collins v. Imtrat Handelsgesellschaft mbH*, E.C.J., Oct. 20, 1993, Joined Cases C-92/92 and C-326/92, [1993] 3 C.M.L.R. 773 (as discussed in §§ 3[3][a][ii][A], 4[3][a][i][C], and 5[1][c][i] *supra*). *See also* Term Directive 2006/116/EC, Art. 7(1)–(2), O.J. 2006 L 372 (formulating the rule of the shorter term in accord with the E.U. principle of non-discrimination).

¹¹⁶ *See, e.g.*, Tribunal Supremo (Supreme Court) (Spain), April 13, 2015, no. 177/2015, Repertorio Aranzadi Jurisprudencia 2015, no. 1192 (protecting the works of U.K. writer G.K. Chesterton to the end of a longer Spanish term) (also discussed in § 4[3][a][i][C] *supra* and in § 5[3][b] *infra*).

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Turn to the issue: How would an E.U. work be subject to the rule of the shorter term in a non-European protecting country? Assume that this work had been pulled out of the public domain of its E.U. country of origin due to super-retroactivity, as explained above.¹¹⁷ What should be the term in this E.U. country of origin relevant for applying the Berne rule of the shorter term in a non-European protecting country? Third parties could have relied on whatever shorter term had initially been effective in the E.U. country of origin upon, say, first or simultaneous publication there, especially if that term had already lapsed, with a fall into the public domain. We have seen this problem arise in determining the country of origin when laws or facts change over time: a prior operative fact, subsequently relied upon, could be invoked.¹¹⁸ Any subsequent running of an extended term in the E.U. country of origin would then not count in applying the rule of the shorter term.¹¹⁹

Another cluster of issues arises for protecting non-E.U. works or productions in any E.U. member state. Bear in mind that the E.U. Term Directive mandates E.U. member states to apply specific forms of the rule of the shorter term.¹²⁰ To start, its Article 7(1) calls for this rule to apply to a work both with a non-E.U. national as author and with a non-E.U. country of origin in the Berne sense.¹²¹ Further, this Article 7(1) then cuts short the term in the country of origin at its “date of expiry,” while Berne language refers to that term as “fixed in the country of origin of the work.”¹²² Finally, Article 7(2) hedges the application of the rule of the shorter term to productions protected by related rights. The following issues may accordingly be distinguished:

- *E.U. or Berne form of the rule:* In an E.U. protecting country, should a court apply the E.U. rule of the shorter term, specifically in a form set by Article 7(1) of the Term Directive, or else in its corresponding Berne form if Berne provisions also apply to a work? In principle, it should make no difference which form of the rule is applied: the E.U. rule, and by the same token a national rule implementing the Term Directive, may not result in any less protection than is available pursuant to prior treaty obligations, and thus prior Berne obligations, to non-E.U. countries, as already explained.¹²³
- *E.U. rule relative to Rome neighboring rights or to other related rights:* In what cases, if any, may the rule of the shorter term, as set out in Article 7(2)

¹¹⁷ Compare § 4[3][a][i][A] *supra* (non-retroactivity as default position), and § 4[3][a][i][B] *supra* (conditioning Berne retroactivity, *inter alia*, on a form of the rule of the shorter term), with § 4[3][a][i][C] *supra* (novelty of E.U. super-retroactivity).

¹¹⁸ See § 4[3][b][ii] *supra*.

¹¹⁹ For analogous analyses, see § 4[3][b][i] *supra*.

¹²⁰ Term Directive 2006/116/EC, Art. 7, O.J. 2006 L 372.

¹²¹ For the Berne definition of the “country of origin,” see § 4[3][b][ii] *supra*.

¹²² See Berne, Art. 7(2) (Rome, Brussels), Art. 7(8) (Paris). For a case in which such a difference in formulation could make a difference in results, see § 5[3][a] *infra*.

¹²³ See § 5[1][c][ii] *supra*. See also Term Directive 2006/116/EC, Recital 23, O.J. 2006 L 372 (“comparison of terms should not result in Member States being brought into conflict with their international obligations”).

of the Term Directive, apply to the terms of neighboring or related rights in performances, recordings, broadcasts, or other such productions? This provision stipulates that this rule should take effect “without prejudice to international obligations,” at least referring to Rome, TRIPs, and WIPO-Treaty provisions that assure minimum terms for such rights.¹²⁴ Ostensibly, for Rome-protected productions, it merely confirms the limited rule which Article 16(1)(a)(iv) of the Rome Convention specifies.¹²⁵ In other cases, any relevant treaty concerning neighboring or related rights, or implementing legislation, would have to be consulted on point.¹²⁶

- *Where protection subsisted in a given E.U. state on October 29, 1993, pursuant to treaty:* Article 7(3) of the Term Directive allows any E.U. member state to continue any term of protection longer than that resulting from the rest of Article 7, but effective on October 29, 1993, “in particular pursuant to [any] international obligation.” This provision effectively details the principle that the E.U. rule of the shorter term may not be applied to cut short rights to terms acquired under or by virtue of *prior* treaties. Thus, national terms already running for foreign works or productions cannot be cut back.¹²⁷
- *Where protection subsisted in one E.U. state on July 1, 1995:* We have already discussed E.U. super-retroactivity.¹²⁸ It arises pursuant to Article 10(2) of the Term Directive which, without reference to any rule of the shorter term, mandates E.U. member states to apply terms “provided for” in that directive to any work or production “protected in at least one” E.U. state on July 1, 1995.¹²⁹ Any such longer protection resulting in the case of a non-E.U. work or production then seems to escape the rule of the shorter term.¹³⁰

[3] What are the Effects of Formalities on Protection?

A work originating in one country will now almost never be barred from protection in another for failure to meet any formality. Let us nonetheless consider the odd cases

¹²⁴ For these terms, see §§ 5[4][a][i] and 5[5][b][i] *infra*.

¹²⁵ On this limited Rome rule, see § 5[2][a][i] *supra*. On the varying scope of national treatment and reservations in the Rome Convention and other treaties concerning neighboring or related rights, see § 3[3][c] *supra* and §§ 5[4][c] and 5[5][b][i] *infra*.

¹²⁶ See M. Walter, “Term Directive” §§ 3.5–3.6, in M. Walter and S. von Lewinski (eds.), *European Copyright Law: A Commentary*, 499, 602–607 (Oxford Univ. Press, 2010).

¹²⁷ See, e.g., the *Frank Sinatra* decision, OLG Hamburg (Germany), April 29, 1999, ZUM 1999, 853, in English trans. in [2001] E.C.D.R. 94 (holding that national legislation which implements the Geneva Phonograms Convention, providing for simple national treatment, precludes applying any rule of the shorter term) (noted in § 3[2][d] *supra*).

¹²⁸ See § 4[3][a][i][C] *supra*.

¹²⁹ *N.b.* E.U. super-retroactivity thus differs from Berne retroactivity, the provision for which incorporates a stringent form of the Berne rule of the shorter term. See § 4[3][a][i][B] *supra*.

¹³⁰ See, e.g., *Sony Music Entertainment (Germany) GmbH v. Falcon Neue Medien Vertrieb GmbH*, E.C.J., Grand ch., Jan. 20, 2009, Case C-240/07, paras. 30–37, [2009] E.C.R. I-263 (after confirming E.U. super-retroactivity to protect U.S. recordings, not applying the E.U. rule of the shorter term) (also discussed in § 4[3][a][i][C] *in fine supra*).

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where formalities may arguably come into play as preconditions of protection or, more frequently, as the bases for certain entitlements. They then have to be considered (a) in the country of origin in very rare cases and (b) in the protecting country in a larger number of cases.¹³¹

[a] In the Country of Origin, Notably U.S. Renewal

The Berne Convention, like its sequel treaties, such as the TRIPs Agreement and the WIPO Copyright Treaty, does not allow the protection of works to turn on formalities. In particular, under a long-standing Berne provision, the “enjoyment” and “exercise” of copyright “shall not be subject to any formality” and “shall be independent of the existence of protection in the country of origin of the work.”¹³² Nonetheless, we shall here touch on stray cases in which attention must be paid to formalities imposed by a country of origin.¹³³

Let us sort out the distinct types of formalities arguably relevant in a country of origin. To start, rarely if ever now, when protecting unilaterally or pursuant to reciprocity or an old treaty, a country may require compliance with formalities of the country of origin.¹³⁴ Exceptionally, as just explained, the Universal Copyright Convention, not usually applied today, allows adhering countries to cease protecting works of U.S. origin upon the failure to fulfill renewal formalities in the United States.¹³⁵ Furthermore, the Berne Convention, when it prohibited requiring compliance with any formality in the country of origin, fell a bit short of its goal of assuring protection free of “all ties of dependence with the country of origin.”¹³⁶ We have already discussed distinct cases on point: on the one hand, design works;¹³⁷ on the other, retroactivity, if not the rule of the shorter term.¹³⁸

Consider, in this last regard, a work which, first published in the United States before January 1, 1978, obtained a term of U.S. copyright subject to renewal. That is, if renewal formalities had not been fulfilled for such a work, U.S. protection had previously lapsed at the end of a first term of 28 years; upon renewal, a second term

¹³¹ *N.b.*, in cases of old works, especially U.S. works, some formality may be key to assuring protection until Berne retroactivity takes over. See § 4[3][a][ii] *supra*.

¹³² Berne, Art. 4(2) (Berlin, Rome, Brussels), Art. 5(2) (Paris). See also § 5[3][b] *infra* (on the Berne bar to formalities in the protecting country). But see § 4[1][c][i][A] *supra* (noting that design rights may be conditioned on deposit or registration).

¹³³ Such formalities must be distinguished from those imposed by the law of the protecting country but fulfilled territorially in the country of origin. See, e.g., “United States,” herein, at § 5[4][a][i] *in fine* (U.S. notice on copies published abroad before March 1, 1989).

¹³⁴ On unilateral and reciprocal protection, see § 3[2] *supra*. On the virtually obsolete treaties, in which this condition may be found, see § 3[3][b][iv] *supra*.

¹³⁵ See § 5[2][a][ii] *in fine supra*.

¹³⁶ H. Desbois, A. Françon, and A. Kéréver, *Les conventions internationales du droit d’auteur et des droits voisins*, para. 24 (Daloz, 1976).

¹³⁷ See § 4[1][c][i][A] *supra*.

¹³⁸ See §§ 4[3][a][i] and 5[2][a] *supra*.

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of 28 years started running.¹³⁹ Will the Berne Convention, notwithstanding its bar to formalities, allow a Berne country to withhold protection from a pre-1978 work of U.S. origin because of a failure to fulfill formalities necessary to obtain a U.S. renewal? Note, at the outset, that the old double term of U.S. copyright was a living fossil: it dated back to the Statute of Anne, with continuing effect in a progressively smaller number of cases in the United States pursuant to the transitional provisions of the 1976 Copyright Act and subsequent amendments.¹⁴⁰ In the modern Berne system this double term has been an anomaly, and it would be artificial to try to read the operative Berne provisions, that is, either the retroactivity provision or the rule of the shorter term, as if they were written with this anomaly in mind. Distinct cases will here be considered: where Berne retroactivity is invoked, and where the Berne rule of the shorter term is applied.¹⁴¹

Start with Berne retroactivity, explained above.¹⁴² Turn to the film *His Girl Friday*, first published in the United States in 1940 and dropped into the U.S. public domain in 1967 for failure to renew U.S. copyright, while its director Howard Hawks, a U.S. national, died in 1977. The French Supreme Court relied on Article 5(2) of the Berne Convention, setting out the Berne bar to formalities, when it precluded denying Berne protection on the basis of Berne Article 18(1) because of any failure to meet the U.S. formality of renewal: it rather protected this work in France.¹⁴³ The court's reasoning, however, assumed its very conclusion: Article 18 is the window to Berne protection, so that, if a work does not make it through the window in time, not meeting either of its conditions, no other Berne provision, including Article 5(2) barring formalities, may assure Berne protection of that work.¹⁴⁴ Furthermore, the term "expiry" in Berne Article 18(1) on its face seems to refer to any fall into the public domain at the end of a copyright term, without excluding any such fall due to a failure to meet formalities in the country of origin. Indeed, the United States itself conditions its own statutory implementation of Berne retroactivity to exclude any foreign work fallen into the public domain of its "source" country, even for failure to meet formalities there.¹⁴⁵ Return to our U.S. film: as argued above, Berne Article 18(3) would have to be

¹³⁹ On the U.S. renewal scheme, see "United States," herein, at §§ 3[2][a] and 4[3][b]. On the U.S. scheme restoring copyright in foreign works fallen into the public domain, *inter alia* for failure to renew, see *id.*, at § 6[4].

¹⁴⁰ See "United States," herein, at § 5[5][c].

¹⁴¹ For quasi-official treatments of these issues, see Letter of A. Bogsch, WIPO, Oct. 10, 1995, reprinted in 43 J. Copr. Soc'y 181 (1995); Letters of Robert Stoll, U.S. Patent and Trademark Office, Nov. 23, 1998, and of Shozo Uemura, WIPO, Dec. 17, 1998, reprinted in 46 J. Copr. Soc'y 87 (1998).

¹⁴² See § 4[3][a][i][B] *supra* (noting that, while Berne retroactivity arguably took account of the Berne bar to formalities as threshold conditions of copyright such as deposit and registration, it did not do so for formalities on which continuing terms depended).

¹⁴³ *Gaumont c. Editions Montparnasse et Lobster Films*, Cass., 1e ch. civ. (France), Dec. 17, 2009, RIDA 2010, no. 224, 427, in English trans. in 42 I.I.C. 607 (2011).

¹⁴⁴ See A. Lucas, "Chroniques," P.I. 2010, 733.

¹⁴⁵ See, e.g., *Alameda Films S.A. de C.V. v. Authors Rights Restoration Corp.*, 331 F.3d 472 (5th Cir. 2003) (U.S.) (confirming that U.S. copyright could not be retroactively restored in pre-1947 film works

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invoked to allow a domestic French approach to retroactivity more favorable than a strict reading of the prior Berne conditions would justify.¹⁴⁶

Consider, as well, Berne Article 18(2), which also conditions Berne retroactivity: the term of protection in the work at issue may not have lapsed in the protecting country for any reason before Berne applies to the work at all. Note that, our film *His Girl Friday* would have dropped into the public domain in France under the Universal Copyright Convention well before U.S. entry into the Berne Union: France would have applied the U.C.C. rule of the shorter term to this film, just as it did to Buster Keaton's films, ceasing French protection.¹⁴⁷ Distinguish, however, the current Berne rule of the shorter term: "the term shall be governed by the legislation of the country where protection is claimed," without exceeding "the term fixed in the country of origin of the work."¹⁴⁸ That is, this Berne rule predicates the duration of copyright established *de jure* in both protecting country and country of origin, but not necessarily any term set *de facto* because of a party's failure to fulfill formalities. What U.S. term, for a pre-1978 work of U.S. origin, is pertinent for the Berne rule here? This writer proposes the first plus second terms, thus 56 years, as allowed by pre-1978 U.S. law, if only to avoid a forfeiture of rights due to formalities.¹⁴⁹ This result seems compelled once Article 18 of the Berne Convention is satisfied and a work protected without regard to formalities.¹⁵⁰

These considerations are subject to a number of caveats. To start, they deviate from some nationally eccentric readings, broached above, of the rule of the shorter term.¹⁵¹ Further, where Berne is self-executing, the minimum life-plus-50-year term will often, but not always, serve as a floor to any term resulting from Berne rules.¹⁵² Finally, as discussed above, Article 7 of the E.U. Term Directive formulates the rule of the shorter term somewhat differently than the Berne text does.¹⁵³ That said, implementing

not protected in Mexico, their source country, for failure to satisfy a pre-1947 registration requirement there), *cert. denied*, 540 U.S. 1048 (2003).

¹⁴⁶ See § 4[3][a][i][B] *supra*. *N.b.* E.U. super-retroactivity may also come into play. See § 4[3][a][i][C] *supra*.

¹⁴⁷ S.A. Galba Films c. M. Friedman, CA Paris, 1e ch., April 24, 1974, RIDA 1975, no. 83, 106, in English trans. in 7 I.I.C. 130 (1976), *affirmed*, Cass., 1e ch. civ., Dec. 15, 1975, RIDA 1976, no. 88, 115 (applying the U.C.C. rule to Buster Keaton's films, given his failure to renew U.S. copyright) (as discussed in §§ 4[3][a][ii] *in fine* and 5[2][a][ii] *supra*).

¹⁴⁸ Berne, Art. 7(8) (Paris).

¹⁴⁹ The historical rationale for this reading lies in the original concern for varying legislation on point, both within the Berne Union and outside it, as well as the ban on formalities imposed soon after. See H. Desbois, A. Françon, and A. Kéréver, *Les conventions internationales du droit d'auteur et des droits voisins*, paras. 8–9 and 24–25 (Daloz, 1976).

¹⁵⁰ *But see* Montis Design BV v. Goossens Montis Design BV v. Goossens Meubelen BV, C.J.E.U., 3rd ch., Oct. 20, 2016, Case C-169/15, [2017] E.C.D.R. 213 (as noted in § 4[3][c][i][C] *supra*).

¹⁵¹ See §§ 5[2][a][i] and 5[2][b][i] *supra*.

¹⁵² *N.b.*, some Berne minimum terms are relatively short, for example, for cinematographic works and, in some cases, design works. See § 5[4][a][i][A] *infra*.

¹⁵³ See §§ 5[1][c][ii] and 5[2][b][ii] *supra*.

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legislation should, in principle, be construed in accord with the correct effect of the Berne rule, subject to its minimum terms.¹⁵⁴

[b] In the Protecting Country: Notice, Procedures, Etc.

The Berne Convention has long barred formalities as conditions of the “enjoyment” or “exercise” of copyright in protecting countries.¹⁵⁵ Residual formalities, like the deposit or registration of works, then hardly ever now come into play for determining whether or not a foreign work or production is protected.¹⁵⁶ Nonetheless, as we shall see here, notices may prove useful on copies released to the public, as may specific procedures for enforcement or remuneration or for benefiting from exceptions.¹⁵⁷

Distinguish the Berne bar to formalities from U.C.C. or other treaty-based notices that once excused formalities as conditions of protection.¹⁵⁸ U.C.C. notices are often used, but they are altogether optional for the simple reason that formalities now virtually never serve as preconditions to protection. The notices in question normally include the year of first publication and the name of the right-holder placed next to some treaty-specified language or symbol on copies.¹⁵⁹ A complex case illustrates how the Berne bar to formalities may operate within the E.U. legal order: G.K. Chesterton, a British author who had died in 1936, had not complied with the old Spanish requirement of registration conditioning protection upon first publication of his work: the Berne bar to formalities nonetheless exempted him from Spanish formalities.¹⁶⁰ An Argentine case turned on notice: the authorized publisher of a Spanish translation of the Russian work *Dr. Zhivago*, which was not protected as a Berne work, placed the U.C.C. notice on its edition to avoid satisfying Argentine registration requirements for translations.¹⁶¹

¹⁵⁴ On such construction, see § 3[4][a] *supra*.

¹⁵⁵ Berne, Art. 4(2) (Berlin, Rome, Brussels), Art. 5(2) (Paris) (also making such protection “independent” of that in any “country of origin”).

¹⁵⁶ For a run-down of such systems, of residual importance above all for the protection of works in their countries of origin, see 23 Cahiers de Propriété Intellectuelle 5 (2011).

¹⁵⁷ On exceptions to minimum rights, including Marrakesh-VIP exceptions procedurally implemented, see § 5[4][a][i][B] *infra*. On standing to sue, often triggered by notices, see § 6[2][a] *infra*.

¹⁵⁸ *N.b.* notices to excuse formalities need not take effect in any country of origin. See, e.g., U.C.C., Art. III (Geneva, Paris) (clarifying that the U.C.C. notice need not excuse formalities in a country for “works first published in its territory or works of its nationals wherever published,” but that “there shall be legal means of protecting without formalities the unpublished works of nationals of other Contracting States”).

¹⁵⁹ The form of this information, as well as any accompanying reservation or symbol, varies slightly from treaty to treaty. See, e.g., Buenos Aires, Art. 3; U.C.C., Art. III(1) (Geneva, Paris) (for works); Rome, Art. 11; Geneva, Art. 5 (for phonograms).

¹⁶⁰ Tribunal Supremo (Supreme Court) (Spain), April 13, 2015, no. 177/2015, Repertorio Aranzadi Jurisprudencia 2015, no. 1192 (also discussed in §§ 4[3][a][i][C] and 5[2][b][ii] *supra*).

¹⁶¹ In re S.A. Editorial Noguera, S.C.J.N. (Supreme Court) (Argentina), May 16, 1962, Fallos 252–262.

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Standing to sue may be triggered by notices put on copies released to the public.¹⁶² To facilitate standing to bring “infringement proceedings in the countries of the Union,” the Berne Convention provides for optional notices.¹⁶³ When someone’s name appears as the author’s on a “work in the usual manner,” an issue for the court to decide, he or she is to be rebuttably presumed an author of that work.¹⁶⁴ Such standing is, in the alternative, given to the “publisher whose name appears on the work” if the author cannot be identified: in that event the publisher is presumed, in the absence of proof to the contrary, “to represent the author.”¹⁶⁵ Further Berne provisions allow the “competent authority” of a country to exercise rights in works like those of folklore,¹⁶⁶ as well as naming the “maker” of a cinematographic work.¹⁶⁷ In the *Dr. Zhivago* case, the publisher successfully argued that a U.C.C. notice raised a presumption of ownership sufficient for it to call for the Argentine action.¹⁶⁸

Some works or related productions, notably designs, may be protected by industrial property conditionally on formal procedures like registration or deposit. As explained above, the Berne Convention very specifically governs how a protecting country may cut back on copyright in foreign design works on its own.¹⁶⁹ Nonetheless, though industrial property may cover a design, the Berne bar to formalities may be invoked to prevent any formal procedure from serving as a precondition of copyright in a foreign Berne-qualifying work incorporating the design.¹⁷⁰ Rarely, laws granting

¹⁶² For this and other bases for standing to sue, see § 6[2][a] *infra*.

¹⁶³ Berne, Art. XI (1886), Art. 15 (Rome, Brussels, Paris). See W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 119–120 (Berne Art. 15, Rems. 2–4) (Werner-Verlag, 1977) (reading “infringement proceedings” broadly).

¹⁶⁴ Berne, Art. 15(1) (Rome, Brussels, Paris). See, e.g., the *Bora Bora* decision, BGH (Germany), July 10, 1986, GRUR 1986, 887, in English trans. in 19 I.I.C. 411 (1988) (holding that the mention of names on printed copy of song apart from copyright notice, without specifying contributions to song by each named party and after first publication of the song, sufficed to trigger Berne right to maintain suit).

¹⁶⁵ Berne, Art. 15(2) (Rome, Brussels), Art. 15(3) (Paris). Arguably, this provision may apply to collective works, works for hire, or other such works as may lack natural persons as authors in countries where they are made and published, so that the named corporate “author” who published the work would at least have standing in other countries that only allow for authors who are natural persons. See also § 4[2][a][ii] *in fine supra* (varying meaning of “authors”).

¹⁶⁶ See Berne, Art. 15(4) (Paris) (allowing the “competent authority” of a Berne country to represent the unknown author, ostensibly a national, of an unpublished work). See also H. Desbois, A. Françon, and A. Kéréver, *Les conventions internationales du droit d’auteur et des droits voisins*, paras. 147–149 (Daloz, 1976) (explaining the background of this provision).

¹⁶⁷ See Berne, Art. 15(2) (Paris) (without expressly assuring the producer of standing). But see W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 118 (Berne Art. 15, Rem. 1) (Werner-Verlag, 1977) (seemingly implying that the maker does have standing to sue on being properly named).

¹⁶⁸ In re S.A. Editorial Nogue, S.C.J.N. (Supreme Court) (Argentina), May 16, 1962, Fallos 252–262.

¹⁶⁹ See § 4[1][c][i][A] *supra*.

¹⁷⁰ See, e.g., *Cassina v. Sedeti, Hoge Raad* (Supreme Court) (Netherlands), May 26, 2000, NJ 2000, 671 (declining to apply any Benelux formality to any foreign Berne-qualifying work, given the Berne bar to formalities and 25-year minimum term for designs).

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related rights akin to industrial property impose formalities on protection, sometimes within and sometimes outside any treaty regime.¹⁷¹ In stray cases, formalities deriving from industrial property may still be invoked to challenge copyright or related rights, notably in designs.¹⁷²

Distinguish between impermissible formalities for substantive protection and permissible formalities that any foreigner needs to fulfill to bring a civil suit in a country.¹⁷³ While U.C.C. notices on copies excuse compliance with any formality that serves as a “condition of copyright,” as just indicated, they do not bear on “procedural requirements” for obtaining “judicial relief.”¹⁷⁴ The United States in principle eliminated formalities as preconditions of copyrights, but has retained some of these formalities as preconditions for suing on copyright and for certain remedies, largely for “United States works.”¹⁷⁵ U.S. courts have tended to restrict the impact of these residual formalities, especially with regard to foreign claimants.¹⁷⁶ Still, one may question whether they contravene the Berne bar to formalities.¹⁷⁷

Remuneration formalities may include lodging claims to be paid by a royalty tribunal or a collective-management organization, for example, under a legally imposed or comparable license scheme.¹⁷⁸ However, the E.U. Court of Justice, invoking the Berne bar to formalities, rejected a condition compelling right-holders to opt-out of a scheme to make out-of-print books public, subject to the payment of royalties.¹⁷⁹ In any event, claimants usually have to file notices with internet services or oversight authorities to have infringing uses blocked online or to have infringing

¹⁷¹ On such related rights, notably in layout designs of integrated circuits and technical plans, etc., see, respectively, §§ 4[1][c][i][C] and 4[1][c][iii] *supra*.

¹⁷² See, e.g., *Montis Design BV v. Goossens Montis Design BV v. Goossens Meubelen BV*, C.J.E.U., 3rd ch., Oct. 20, 2016, Case C-169/15, paras. 38, 40–41, [2017] E.C.D.R. 213 (refusing to consider the Berne bar to formalities as precluding the lapse of copyright in design works for failure to satisfy a formality in any country of origin) (noted in § 4[3][a][i][C] *supra*).

¹⁷³ For further analysis, see § 5[4][b][ii] *infra*.

¹⁷⁴ See U.C.C., Art. III(3) and (5) (Geneva, Paris) (last paragraph allowing formalities as preconditions for renewing copyright).

¹⁷⁵ See “United States,” herein, at §§ 5[3][a], 5[4], and 5[8].

¹⁷⁶ See, e.g., *Moberg v. 33T, LLC*, 666 F. Supp. 2d 415 (D. Del. 2009) (holding that posting a work online does not “publish” it for purposes of rendering it a “United States work” subject to registration as a condition for suing for infringement of copyright).

¹⁷⁷ See M. Trimble, “Punitive Damages in Copyright Infringement Actions under the US Copyright Act,” [2009] E.I.P.R. 108, at 110.

¹⁷⁸ See, generally, W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 59 (Berne Art. 5, Rem. 7) (Werner-Verlag, 1977) (opining that the requirement of such formal procedures would not fall afoul of the Berne bar to formalities as long as only royalties were at stake).

¹⁷⁹ *Soulier v. Premier ministre*, C.J.E.U., 3rd ch., Nov. 16, 2016, Case C-301/15, paras. 50–51, [2017] E.C.D.R. 415.

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end-users disconnected from online access.¹⁸⁰ Notices or procedures may prove occasionally unavoidable for users to benefit from exceptions.¹⁸¹

[4] How Far does Protection Extend Once it is Assured?

Exceptions to national treatment discussed above, like the rule of the shorter term, may determine whether or not there will be protection at all.¹⁸² If protection is assured, how far will it extend? We shall here break this question down into the following issues: (a) How and when may minimum rights go beyond national treatment? (b) How may national treatment itself be delimited by definition? (c) When may protection be subject to special derogations?

[a] When, and How Far, do Minimum Rights Apply?

Multilateral treaties assuring copyright or neighboring rights provide for minimum rights. Such rights represent exceptions to national treatment insofar as they may in theory enlarge protection under domestic law. Minimum rights, however, tend to merge with national treatment in practice as they prompt jurisdictions to implement them for both domestic and foreign claimants. We shall here ask: (i) What minimum rights, coupled with exceptions, are available? (ii) When may they apply and for whose benefit?

[i] What Minimum Rights are Provided?

Minimum rights developed as the Berne Convention was revised and as sequel treaties incorporated and expanded on such Berne rights.¹⁸³ Treaty provisions for minimum rights above all set standards for implementation in domestic legislation or mandate courts to enforce such rights where such provisions are taken as self-executing and their implementation proves inadequate.¹⁸⁴ The following analysis will outline (a) Berne minimum rights and (b) other such treaty rights and exceptions. It will, as well, ask: (c) How to construe pertinent treaty provisions.¹⁸⁵

[A] Berne Minimum Rights, Hedged

As already explained, Berne early on instituted the minimum rights, on the one hand, to protection free of formalities and, on the other, to standing presumptively triggered by putting notice of the author's or representative's name on embodiments or

¹⁸⁰ On such procedures, see § 2[1][c][ii] *in fine supra*.

¹⁸¹ See, e.g., Berne, Art. 10*bis*(1) (Paris) (allowing notices, reserving rights, to defeat the exemption for press, broadcast, and other media to disseminate "articles published in newspapers or periodicals on current economic, political or religious topics" or made public in "broadcast works"). See also § 5[4][a][i][B] *in fine infra* (glossing the Marrakesh VIP Treaty which calls for procedurally implementing exceptions to benefit the visually impaired).

¹⁸² See §§ 5[2] and 5[3] *supra*. See also § 4[1][c][i][A] *supra* (exception to the national treatment of design works).

¹⁸³ For the history of national treatment and minimum rights, see § 2[3][b] *supra*.

¹⁸⁴ On implementation versus self-execution of treaty provisions, see § 3[2][a] *supra*.

¹⁸⁵ On treaty construction generally, see § 3[4][b] *supra*; on TRIPs construction, § 5[5][b][ii] *infra*.

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copies.¹⁸⁶ These rights are complemented by the right to the seizure of “infringing copies of a work” at any border, if this work is protected in the country of seizure, but even if the copies come “from a country where the work is not protected, or has ceased to be protected.”¹⁸⁷ Though often dubbed “procedural,” these minimum rights apply, as stressed elsewhere here, pursuant to the choice-of-law rules for substantive copyright.¹⁸⁸

Berne also assures authors’ minimum rights, more obviously “substantive” in tenor. At the outset, the initial Berne Act established, albeit conditionally, a minimum right of translation, later freed from its conditions.¹⁸⁹ After some struggle, the Brussels Act instituted the minimum term of the author’s life plus 50 years, with shorter terms specified for designated classes of works, and the Paris Act amplified some terms.¹⁹⁰ Since the Rome Act, Article *6bis* has provided for Berne moral rights, starting with rights to the attribution of authorship and to relief for prejudicial modifications of a work.¹⁹¹ The Brussels Act requires relief for any other prejudicial act (*atteinte*) directed at a work and calls for moral rights to last at least as long as economic rights.¹⁹²

After successive Berne Acts amplified on them, the Paris Act crystallized minimum economic rights to control translation and reproduction, as well as adaptation,

¹⁸⁶ On freedom from formalities generally, see § 5[3] *supra*; on standing in particular, § 5[3][b] *supra* and § 6[2][a] *infra*.

¹⁸⁷ Berne, Art. 16 (Rome, Brussels, Paris). *But see, e.g.*, Koninklijke Philips Electronics NV v. Lucheng Meijing Industrial Co. Ltd. and Nokia Corp. v. Her Majesty’s Commissioners of Revenue and Customs, C.J.E.U., 1st ch., Dec. 1, 2011, Joined Cases C-446/09 and C-495/09, [2012] European Trade Mark Reports 13 (questioning whether goods merely in transit to other countries may be so seized).

¹⁸⁸ *See, generally*, § 3[1][b][ii][A] *supra* (stressing that forum law on procedure is subject to substantive laws to be chosen in cross-border cases). *See, e.g.*, § 5[4][b][ii] *infra* (distinguishing national treatment as to diverse procedures); § 6[2][a] *infra* (considering rules of standing as substantive).

¹⁸⁹ Adaptation and translation rights prompted vigorous debate at the time. *See* Records of the Conferences Convened in Berne, 1884 and 1885, in World Intellectual Property Organization, *1886—Berne Convention Centenary—1986*, 91–92, 96–98, and 120–122 (WIPO, 1986).

¹⁹⁰ *See* Berne: Art. 7(1) (Brussels, Paris) (to 50 years counted from that of death); Art. 7(4) (Brussels), 7(3) (Paris) (50 years from that of publication or public availability for works without known authors); Art. 7(2) (Paris) (at least 50 years from that of public availability or making for cinematographic works); Art. 7(4) (Paris) (25 years from that of making for photographic works and design works protected as artistic works); Art. 7(7) (Paris) (allowing any member bound by the Rome Act to maintain shorter terms on adhering to the Paris Act).

¹⁹¹ *N.b.*, Berne revisions did not unpack the full range of moral rights, notably only presuming the most basic privacy right to control initial disclosure, while conditioning the right to integrity on proof of potential harm to the author, not to the work. For critical analysis, see H. Desbois, A. Françon, and A. Kéréver, *Les conventions internationales du droit d’auteur et des droits voisins*, paras. 53 and 175 (Dalloz, 1976).

¹⁹² *But see* W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 64 (Berne Art. *6bis*, Rem. 1) (Werner-Verlag, 1977) (tracing how, from the Brussels to the Paris Act, ever-stricter obligations to provide at least a life-plus term for moral rights were hedged).

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arrangement, and other alterations.¹⁹³ Economic rights are further adumbrated to control such acts as the following: for dramatic, dramatico-musical, and musical works, public performance and communication to the public of such performances; for literary works, public recitation and communication to the public of such recitations.¹⁹⁴ Further rights allow for controlling the broadcasting of works or other such communication to the public, the communication of the broadcast work to the public by wire or by rebroadcast by another organization, or the communication of the broadcast work to the public by loudspeaker or like devices.¹⁹⁵ Finally, rights assure the control of cinematographic adaptation and reproduction, as well as minimum economic rights in ensuing cinematographic works.¹⁹⁶

Limitations and exceptions hedge Berne minimum rights. The Paris Act does make it “permissible” to quote a licitly disclosed work compatibly with “fair practice,” to the extent justified by purpose, and upon due attribution of source and author.¹⁹⁷ More often, the Berne text makes it “a matter for the legislation” of Union members to fashion limitations and exceptions, albeit within parameters set out for specific rights.¹⁹⁸ Significantly, for almost a century, the Berne Convention worked well enough without enumerating any minimum right of reproduction, which was introduced only in its 1971 Paris Act in open-ended terms. This right was hardly made more precise by allowing it to be delimited in “special cases,” prejudicing neither “normal exploitation” nor “the legitimate interests of the author.”¹⁹⁹ The Berne text also indicates that copyright may be subject to some legally imposed licenses against equitable remuneration.²⁰⁰ The range of discretion for construing limitations and exceptions will be discussed below.²⁰¹

¹⁹³ *Respectively*, Berne, Arts. 8, 9, and 12 (Paris).

¹⁹⁴ *Respectively*, Berne, Arts. 11, 11*ter* (Paris).

¹⁹⁵ Berne, Art. 11*bis* (Paris).

¹⁹⁶ *Respectively*, Berne, Arts. 14, 14*bis* (Paris).

¹⁹⁷ *Compare* Berne, Art. 10 (Paris) (in the French version, legitimating quotes in conformity with *bons usages*, to the extent justified by purpose, and with due attribution), *with* Berne, Art. 10 (Brussels) (allowing “short” quotes from the press and excerpts in pedagogical or learned publications).

¹⁹⁸ *See, e.g.*, Berne, Art. 7(4) (Paris) (exclusion of official texts), *id.*, Art. 2*bis* (certain speeches), *id.*, Art. 10(2) (illustrative and pedagogical uses), *id.*, Art. 10*bis* (use of journalistic articles or of works incidentally caught in news reports); *id.*, Art. 11*bis*(3) (broadcasters’ ephemeral recordings). *See also* § 4[1][b] *in fine supra* (exclusion of “news of the day” not an exception, but a limitation on Berne coverage of creative works).

¹⁹⁹ Berne, Art. 9(2) (Paris). *See, generally*, World Intellectual Property Organization, *1886—Berne Convention Centenary—1986, 196–197* (WIPO, 1986) (discussing illustrative examples both of permissible exceptions, notably for private use, and of conditions, notably that of obtaining equitable remuneration).

²⁰⁰ *See, e.g.*, Berne, Art. 11*bis*(2) (Paris) (broadcasting and related communication rights); *id.*, Art. 13 (re-recording musical works).

²⁰¹ *See* § 5[4][a][i][C] *infra*.

[B] Other Treaty Rights and Exceptions

Other multilateral treaties, in the wake of Berne revisions, have elaborated on minimum rights, with more or less definite carve-outs.²⁰² The Rome Convention has provided for minimum rights for performers, phonogram producers, and broadcasters in the productions they respectively generate.²⁰³ As developed in the Berne and Rome Conventions, minimum rights have been incorporated and elaborated in the TRIPs Agreement, albeit sometimes in hedged terms, and into the WIPO “Internet” Treaties, along with new minimum rights, while the Marrakesh VIP Treaty has lately specified new exceptions.²⁰⁴

The Rome Convention tailors its minimum rights with complex caveats and exemptions or licenses that can be crucial for exploiting neighboring rights.²⁰⁵ Since its inception, however, domestic laws have often amplified on Rome minimum rights, so that it may be asked whether national treatment now affords greater protection.²⁰⁶ The Rome Convention set the minimum term of its neighboring rights at 20 years, though implementing statutes now often provide longer terms, in any event counted from the end of the year of performance, initial recording, or broadcast, respectively.²⁰⁷ Performers have the right to embody their live performances in first fixations, as well as hedged rights both to broadcast or communicate publicly any such performance, except one already licitly broadcast or made from a fixation, and to reproduce any unauthorized fixation.²⁰⁸ Producers of phonograms have the right to reproduce their sound recordings, and performers and these producers share remuneration that arises out of legally imposed licenses for broadcasting or otherwise communicating publicly released phonograms to the public.²⁰⁹ Broadcasting organizations have the rights to

²⁰² The Universal Copyright Convention, largely superseded in most cases today, provides for rudimentary minimum rights to “adequate and effective protection,” notably “to authorize reproduction by any means, public performance and broadcasting,” to minimum terms, to avoid certain formalities, and to control translation, subject to possible licenses: U.C.C., Arts. I, IV *et seq.* (Paris).

²⁰³ On distinguishing between the subject matters of copyright and of neighboring rights, see § 4[1][c][ii] *supra*.

²⁰⁴ For further analysis regarding the WIPO and Marrakesh VIP Treaties, see J. Blomqvist, *Primer on International Copyright and Related Rights*, 205–215 (Edward Elgar, 2014).

²⁰⁵ For further analysis, see W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 300–325 *passim* (Rome, Arts. 7–15) (Werner-Verlag, 1977).

²⁰⁶ For further analysis, see § 5[4][b][i] *in fine infra*.

²⁰⁷ Rome, Art. 14.

²⁰⁸ Rome, Art. 7, subject to Art. 19. *But see, e.g.,* the *Evening with Marlene Dietrich* decision, BGH (Germany), April 21, 2016, GRUR 2016, 1048, in English trans. in 48 I.I.C. 353 (2017) (allowing waiver, by consent to fixation, only of Rome minimum rights under Article 7, not of national treatment pursuant to Article 2) (discussed in § 3[4][b][iii] *supra* and § 5[4][b][i] *in fine infra*).

²⁰⁹ Rome, Arts. 10 and 12 (granting discretion to vary the remuneration entitlement nationally). *N.b.*, a performer only has the minimum Rome right to control reproducing a fixation made of a live performance without specific consent or for purposes different from those authorized, while the phonogram producer who is authorized to fix a live performance has the minimum Rome right to control reproducing the authorized fixation.

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control the fixation, the reproduction of specified fixations, and the rebroadcasting and certain other communications to the public of their broadcasts.²¹⁰

The TRIPs Agreement and WIPO “Internet” Treaties presuppose Berne and Rome rights.²¹¹ We shall later elaborate on how the TRIPs Agreement both elaborates and constrains Berne and Rome minimum rights.²¹² The WIPO Copyright Treaty incorporates and expands on Berne minimum terms of copyrights; the WIPO Performances and Phonograms Treaty does the same for Rome/TRIPs neighboring rights.²¹³ The WIPO Copyright Treaty assures distribution rights in works, as well as rental rights in computer programs, cinematographic works, and works embodied in phonograms, while the WIPO Performances and Phonograms Treaty does so for phonograms.²¹⁴ The WIPO Treaties differentially, albeit marginally, expand the scope of the reproduction right, subject to caveats for transitory copies; the Copyright Treaty introduces the so-called umbrella right of communication, including making available online to members of the public, while the Performances and Phonograms Treaty adopts only the later component of this right.²¹⁵ But it does recognize performers’ moral rights both to be credited as contributing to “aural” performances, where such credits are feasible, and to relief against such changes in performances, even those recorded, as would be prejudicial to their reputations.²¹⁶

Technological safeguards, under the WIPO “Internet” Treaties, are not, strictly speaking, subject to minimum rights, but to domestically implemented regulation.²¹⁷ The pertinent treaty provisions call for “adequate legal protection and effective legal remedies against” the circumvention of “effective technological measures” and against the tampering with “rights-management information.”²¹⁸ But the treaties only generically indicate what technological measures are to be thus protected, notably those used “in connection with the exercise” of rights to restrict acts neither “authorized” by the

²¹⁰ Rome, Art. 13.

²¹¹ See, e.g., TRIPs, Art. 9(1), and W.C.T., Art. 1(4) (incorporation of Berne provisions by reference); TRIPs, Art. 14 and W.P.P.T., Art. 1(1) (non-derogation from Rome rights).

²¹² See § 5[5][b][i] *infra*.

²¹³ See, e.g., W.C.T., Art. 9 (removing the Berne restriction on the minimum Berne term of copyright in photographs); W.P.P.T., Art. 5 (assuring moral rights of performers), Art. 17 (assuring 50-year terms of rights in performances and in phonograms, respectively).

²¹⁴ W.C.T., Arts. 6–7; W.P.P.T., Arts. 8–9, 12–13. *N.b.*, the rental right need not apply in cases of cinematographic works if the reproduction right is not impaired, nor in cases of works embodied in phonograms and of phonograms themselves given a prior law imposing remuneration for rental.

²¹⁵ W.C.T., Arts. 1, 8; W.P.P.T., Arts. 2, 6–7, 10, 11, 14. See also Agreed Statements Concerning W.C.T., Arts. 1(4) and 8, and W.P.P.T., Arts. 7, 11, and 16 and 15 (attempting to specify the levels of consensus, or of disagreement, regarding the application of these rights in cases of electronic storage, of providing hardware necessary for communications to the public, etc.). For further analysis, see § 2[1][c][iii] *supra* and § 5[4][a][i][C] *infra*.

²¹⁶ W.P.P.T., Art. 5.

²¹⁷ See M. Ficsor, *The Law of Copyright and the Internet: The 1996 WIPO Treaties, their Interpretation and Implementation*, 549–563 (Oxford Univ. Press, 2002).

²¹⁸ W.C.T., Arts. 11–12, 14; W.P.P.T., Arts. 18–19, 23.

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right-holder nor “permitted by law,” while they only somewhat detail protected rights information and acts to be restricted in its regard.²¹⁹ Unfortunately, as indicated above, such open-ended criteria have not sufficed to forestall abuses of technological safeguards, for example, overblocking access, anti-competitive abuses, and threats to privacy.²²⁰ It may be asked how to regulate technological safeguards further to minimize their globally intrusive use and to avoid their overriding local copyright limitations and exceptions.²²¹ Given their tendency to segment the European internal market, E.U. law prohibits some geoblocking measures online.²²²

Like the Berne Convention, sequel treaties set out exceptions in tandem with minimum rights. Most generally, Article 13 of the TRIPs Agreement, adapted from criteria for the Berne reproduction right and as recodified in the WIPO Copyright Treaty, proposes a three-step test for all “limitations or exceptions to exclusive rights.”²²³ This test, accommodating U.S. fair use, purports to confine such parameters “to certain special cases which do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the right holder.” The criterion of “normal exploitation” presupposes at least a paradigmatic market to illustrate the posited normalcy, while “legitimate interests of the right holder” refers to parties whose interests need not always converge. It remains unclear how to construe this pair of criteria in hard cases when media markets are in rapid flux or when authors and entrepreneurs squabble over diminishing revenues.²²⁴

The Marrakesh VIP Treaty hems in treaty-based rights at special points. It would have adhering parties authorize certain measures to help the blind or otherwise visually impaired persons to access textual or illustrated works already licitly made available to the public.²²⁵ Accordingly, agencies could furnish only such persons, notably by non-commercial dissemination, with gratuitous or low-cost copies or access they can enjoy; cross-border exchanges are subject to complex conditions.²²⁶ Legislation would

²¹⁹ *Id.*

²²⁰ See § 2[1][c][ii] *supra*.

²²¹ See J.H. Reichman, P. Samuelson, and G.B. Dinwoodie, “A Reverse Notice and Takedown Regime to Enable Public Interest Uses of Technically Protected Copyright Works,” 22 *Berkeley Technology L.J.* 981 (2007).

²²² Regulation (EU) 2018/302 of the European Parliament and of the Council of 28 February 2018 on addressing unjustified geo-blocking and other forms of discrimination based on customers’ nationality, place of residence or place of establishment within the internal market, O.J. 2018 L 60 I. Article 1.5 of this regulation disclaims its affecting “rules applicable in the field of copyright and neighbouring rights.” On the E.U. “portability” regulation, see § 6[3][b][ii] *infra*.

²²³ On these Berne provisions, see § 5[4][a][i][A] *in fine supra*.

²²⁴ For a construction limiting this three-step test, see § 5[4][a][i][C] *infra*.

²²⁵ Marrakesh Treaty to Facilitate Access to Published Works for Persons who are Blind, Visually Impaired, or otherwise Print Disabled, effective September 30, 2016. For text and adherences, see <http://www.wipo.int/treaties/en/ip/marrakesh/>.

²²⁶ For theory and practice, see L. Helfer, M. Land, R. Okediji, and J.H. Reichman, *The World Blind Union Guide to the Marrakesh Treaty: Facilitating Access to Books for Print-Disabled Individuals* (Oxford Univ. Press, 2017).

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implement Marrakesh provisions, optimally mandating the requisite measures and coupling them with corresponding limitations or exceptions to rights.²²⁷ Hopefully, national measures, especially those touching cross-border exchanges, would be internationally coordinated.²²⁸

[C] Construing Minimum Rights, as Delimited

We have already set out general methods for interpreting treaties as grounds of protection.²²⁹ How are treaty provisions for minimum rights, along with their limitations and exceptions, to be read? Lawmakers, even judges where treaty provisions are self-executing, have some discretion in applying minimum rights, subject to Berne primacy.²³⁰ We shall here do no more than broach some guidelines for construing such rights in hard cases.²³¹

Minimum rights, as Professor Sam Ricketson aptly wrote, have arisen “in a piecemeal way, usually in response to particular contemporary needs and pressures, and without any attempt at systematic organization.”²³² Still, over the last century, such Berne rights increasingly furnished a *lingua franca* for understanding creators’ rights in internationally common terms; by contrast, the WIPO “Internet” Treaties allow their rights to control online access to be eccentrically characterized in national terms.²³³ Inevitably, as local courts tinker with this umbrella right case by case, its scope is being pushed and pulled every which way by the winds of domestic and regional doctrines and needs, while being conflated at points with notions of indirect liability borrowed from tort law.²³⁴ Given the global reach of the internet, the aims of the Berne-plus treaty regime would rather, as already noted, favor construing rights

²²⁷ Prior E.U. harmonization entails parameters within the European Union for making such conforming law. *See* Re Marrakesh Treaty, Opinion 3/15, C.J.E.U., Grand ch., Feb. 14, 2017, [2018] E.C.D.R. 183 (as noted in §§ 3[3][a][ii][A] and 3[4][a] *supra*).

²²⁸ For critical analysis, see M. Trimble, “The Marrakesh Puzzle,” 45 I.I.C. 768 (2014). On construing this treaty, see § 5[4][a][i][C] *infra*.

²²⁹ *See, respectively*, § 3[4][a] *supra* (domestically implemented treaties) and § 3[4][b] *supra* (self-executing treaty texts).

²³⁰ On self-execution of treaty provisions *vel non*, see § 3[2][a] *supra*; on Berne primacy, § 5[1][b][i] *supra*.

²³¹ *See also* § 5[1][c] *supra* (interpreting away some tensions between the E.U. legal order and copyright treaties).

²³² S. Ricketson, *The Berne Convention for the protection of literary and artistic works: 1886–1986*, para. 8.5 (Kluwer, 1987).

²³³ *See, generally*, M. Ficsor, *The Law of Copyright and the Internet: The 1996 WIPO Treaties, their Interpretation and Implementation*, 496–500, 628–629 (Oxford Univ. Press, 2002) (speaking of “the principle of relative freedom of legal characterization” in interpreting the so-called umbrella right).

²³⁴ *See, generally*, P.B. Hugenholtz and S. van Velze, “Communication to a New Public? Three Reasons Why EU Copyright Law Can Do Without a ‘New Public’,” 47 I.I.C. 797 (2016) (critiquing erratic construction of umbrella right in E.U. case law). *See, e.g.*, §§ 2[1][c][ii], 2[2][b][i] *in fine*, and 3[1][b][iii] *supra* (further analysis and examples).

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consistently to assure reliable and proportional relief in cross-border cases.²³⁵ We have already outlined the history of reconceptualizing copyright and related rights in terms of new media emerging from print to telecommunications over the centuries.²³⁶ Courts may perhaps start to acquit themselves of this task for the umbrella right by focusing relief on online modes of exploitation predictably prejudicing creators.²³⁷

Treaty minimum rights may be interpreted within variable margins. On the one hand, such margins get larger as rights are formulated in more generic or open-ended notions. On the other, the scope of rights may be narrowed as they are coupled with corresponding exceptions and limitations.²³⁸ Such scope may not be reinflated on the basis of the venerable maxim in favor of construing rights generously and exceptions strictly, since case law has taken this old saw out of the copyright toolbox.²³⁹ Furthermore, the Berne Convention sets out a mandatory paradigm of permissible uses, notably fair and proportionate quotation coupled with references to the source and author of any excerpt, so that ensuing parameters for rights may complement other such treaty criteria.²⁴⁰ The WIPO Copyright Treaty allows further play in the interpretation of its own terms and, arguably, of treaty provisions it incorporates from the wider Berne-plus regime. Indeed, its rights may be recalibrated with limitations and exceptions as lawmakers reconsider the roles of ensuing entitlements in “the digital network environment.”²⁴¹ By contrast, the Marrakesh VIP Treaty provides for only very specific exceptions, not obviously self-executing, to treaty minimum rights in quite special cases.²⁴² The very specificity of such provisions mitigates against their providing any model for framing copyright as a whole more tightly.²⁴³

The three-step test, set out in Article 13 of the TRIPs Agreement, purports to trace parameters for copyright limitations and exceptions. But this TRIPs test need not apply to all constraints on copyright scope, to start because the TRIPs Agreement itself reserves certain limitations of copyright. Its Article 6 leaves intact the first-sale or

²³⁵ See §§ 2[3][b] *in fine* and 3[1][b][iii][A] *supra*.

²³⁶ See § 2[1] *supra*.

²³⁷ See, generally, P.E. Geller, “Rethinking the Berne-Plus Framework: From Conflicts of Laws to Copyright Reform,” [2009] E.I.P.R. 391 (setting out scope of right). See, e.g., P.E. Geller, “The Celestial Jam Session: Creative Sharing Online Caught in Conflicts of Copyright Laws,” [2015] E.I.P.R. 490 (distinguishing acts best not enjoined).

²³⁸ For further analysis, see H.G. Ruse-Khan, *The Protection of Intellectual Property in International Law*, 487–492 (Oxford Univ. Press, 2016); Z. Efroni, *Access-Right: The Future of Digital Copyright Law*, 321–337 (Oxford Univ. Press, 2010).

²³⁹ For further analysis, see § 2[2][b][iii] *supra*.

²⁴⁰ See T. Aplin and L. Bently, “Displacing the Dominance of the Three-Step Test: The Role of Global, Mandatory Fair Use,” in W. Ng, *et al.* (eds.), *Comparative Aspects of Limitations and Exceptions in Copyright Law* (Cambridge Univ. Press, 2018).

²⁴¹ W.C.T. Agreed Statement Concerning Article 10.

²⁴² On this treaty, see § 5[4][a][i][B] *in fine supra*.

²⁴³ *But see* M. Kaminski and S. Yanisky-Ravid, “The Marrakesh Treaty for Visually Impaired Persons: Why a Treaty was Preferable to Soft Law,” 75 *Univ. of Pittsburgh L. Rev.* 255, 297–299 (2014) (arguing that the Marrakesh paradigm is instructive for new treaty exceptions).

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exhaustion doctrine, while its Article 9(2) confirms the exclusion of ideas and procedures from protectible matters, both out of textual reach of the subsequently formulated three-step test. Furthermore, these limitations, along with overriding constitutional limitations arising out of human rights, help to define copyright itself.²⁴⁴ Such overriding limitations of copyright fall outside the three-step test, leaving only statutory exceptions to copyright subject to this test.²⁴⁵ Finally, even in cases of such exceptions, the TRIPs three-step test, with its vague criteria, seems fit to be construed only case by case.²⁴⁶

[ii] When May Minimum Rights Apply?

There are three ways that minimum rights may apply. To start, they may be directly available pursuant to convention provisions. Further, they may be available by virtue of the TRIPs principle of most-favored-nation treatment. Finally, they are most often simply incorporated into domestic law, subject to national treatment.

To start, a minimum right may be enforced where a court applies the treaty provision recognizing the right directly to a case.²⁴⁷ For example, a German composer's minimum Berne right of reproduction, under the Paris Act, was successfully invoked in Austria against the private copying of sheet music for educational purposes, a use which Austrian copyright law would ostensibly have allowed had strict national treatment prevailed.²⁴⁸ Most countries are now bound by the Paris Act of the Berne Convention, so that its minimum rights will be available where Berne provisions apply as self-executing; comparably, a sequel treaty, incorporating or amplifying on Berne provisions, may so apply.²⁴⁹

However, minimum rights need not apply in a case where the protecting country is the country of origin of the work at issue. In that event, notably where the claimant is a national of the protecting country or first publication occurs there, the claimant may only enjoy national treatment, but not minimum rights, on the basis of any treaty

²⁴⁴ On defenses arising out of definitional and constitutional limitations, including limits arising out of human rights, notably freedom of creation and expression, see § 2[2][b][iii] *supra*.

²⁴⁵ For further analysis, see P.E. Geller, "A German Approach to Fair Use: Test Cases for TRIPs Criteria for Copyright Limitations?," 57 J. Copr. Soc'y 553, 561–568 (2010).

²⁴⁶ See, e.g., Report of the Panel, United States—Section 110(5) of the US Copyright Act, WT/DS160/R, June 15, 2000 (as discussed in § 5[5][b][ii][A] *infra*).

²⁴⁷ On distinguishing among legal orders by the extent to which they allow or disallow treaty provisions to apply directly to cases in their own terms, see §§ 3[2][a] and 3[4] *supra*.

²⁴⁸ The *Ludis Tonalis* decision, Wiener Urtext Edition Musikverlag v. Pleyer, Oberster Gerichtshof (Supreme Court), Jan. 31, 1995, GRUR Int. 1995, 729, note W. Dillenz. See also *Ciné Vog Films c. CODITEL*, Trib. 1e instance, 2e ch., Brussels (Belgium), June 19, 1975, RIDA 1975, no. 86, 124 (Article 11*bis* secures French claimant's right to control cable-retransmission of televised work in Belgium, even though domestic law has no such right).

²⁴⁹ On the elaboration of substantive minimum rights over time, see § 5[4][a][i] *supra*. On applying TRIPs provisions on the level of private suits, see § 3[3][a][i] *supra*; on its substantive provisions, § 5[5][b][i] *infra*. For possible, but rare reservations on Berne obligations, see § 5[4][c][ii] *infra*.

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provision alone.²⁵⁰ For example, the Italian Constitutional Court held that an Italian photographer was not entitled to claim moral rights directly under the Berne Convention for his photographs in Italy, the Berne country of origin of the photographs.²⁵¹ This rule follows from the more general principle that a treaty normally obligates each adhering party only relative to claimants from other such parties.²⁵²

Arguably, the TRIPs principle of most-favored-nation treatment may require the application of minimum rights in rare cases where other treaties do not directly apply. Most-favored-nation treatment, in principle, obligates a W.T.O. member to grant all other W.T.O. members' nationals "any advantage, favour, privilege or immunity" that it grants to at least one W.T.O. member's nationals.²⁵³ Consider, for example, minimum rights under the WIPO Copyright Treaty: if countries X and Y adhere to the WIPO Copyright Treaty and if both belong to the World Trade Organization along with country Z, country X may have to grant claimants satisfying TRIPs criteria of eligibility relative to country Z the same minimum rights under the WIPO Copyright Treaty as it would to claimants relative to country Y. This principle, however, is subject to complex exceptions.²⁵⁴

Finally, and most often, minimum rights may effectively be available pursuant to national treatment under domestic law that implements the rights. For example, an author may not invoke a minimum right, say, any moral right under Article 6*bis* of the Berne Convention, but only domestic British implementing legislation to have any minimum right enforced in the United Kingdom, as in other countries where treaties are not applied as self-executing.²⁵⁵ In any event, no matter what their approach to treaties, most countries revise their legislation to implement the minimum rights of any treaty they ratify, and courts may refer to treaty texts in construing such domestic

²⁵⁰ Berne, Art. 4(1) (Rome, Brussels), Art. 5(1) and (3) (Paris). On determining the country of origin, see § 4[3][b][iii] *supra*.

²⁵¹ *Toscani c. Total S.p.A.*, Corte Costituzionale, No. 48, March 15, 1972, Dir. aut. 1972, 192. See also *Fabris c. Loudmer*, CA Orleans, ch. sol. (France), June 22, 1995, *Dalloz-Sirey* 1995, inf. rap. 213 (holding that copyright in painting of Maurice Utrillo, a French national, is subject to French law, not to minimum Berne rights and related exceptions).

²⁵² It has therefore been argued that minimum rights may, by implication, not be available to Berne nationals raising claims in their home country, even where the country of origin of the work at issue may be a foreign country, notably by virtue of first publication abroad. See W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 56–57 (Berne Art. 5, Rem. 3) (Werner-Verlag, 1977).

²⁵³ See, generally, J.H. Reichman, "Universal Minimum Standards of Intellectual Property Protection under the TRIPs Component of the WTO Agreement," 29 *The International Lawyer* 345, 349–350 (1995) (noting just how hedged this principle is in its TRIPs form but that it might nonetheless have extensive prospective impacts).

²⁵⁴ See, e.g., TRIPs, Art. 4(d) (conditionally allowing a W.T.O. member to withhold most-favored-nation treatment for rights deriving from international agreements in the field which went into force prior to the TRIPs Agreement, if these are notified to the TRIPs Council). See also § 5[1][c][ii] *in fine supra* (discussion in the E.U. context).

²⁵⁵ See § 3[2][d] *supra*.

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implementing provisions when applying them, as explained above.²⁵⁶ Furthermore, a party benefiting from national treatment in a country under one treaty may invoke a minimum right incorporated from another treaty into domestic statute.²⁵⁷

[b] The Definitional Scope of National Treatment

National treatment has its limits. For example, Berne national treatment is only obligatory relative to rights falling within some consensus defining “copyright” or, more generally, “authors’ rights” in most laws; Rome national treatment only to that extent assures performers’ and certain producers’ “neighboring” or “related” rights. It thus becomes necessary to consider (i) how to construe such notions as they appear in grounding provisions and (ii) what rights or entitlements may lie inside or outside their scope.²⁵⁸

[i] Relative to Copyright or Neighboring Rights

We have seen copyright laws respond to rapidly progressing media with proliferating rights.²⁵⁹ But when is any specific, newly instituted right or entitlement subject to national treatment? In any response to this question, as Professor Ulmer clarified, “the terminology used and the classification given by the national law remain irrelevant.”²⁶⁰ Otherwise, an international obligation could be undone by national lawmakers who simply manipulated the nomenclature of domestic law.²⁶¹ Rather, since copyright law is unavoidably in flux, it seems advisable to construe national treatment dynamically.²⁶²

The Berne Convention, and therefore the TRIPs Agreement and the WIPO Copyright Treaty incorporating Berne provisions, prospectively set out the obligation to grant national treatment with regard to copyright. These Berne and sequel treaty texts compel each adhering country to extend, not just national rights already effective

²⁵⁶ See § 3[4][a] *supra*. See, e.g., the *Serafino* decision, Trib. Rome (Italy), May 30, 1984, Dir. aut. 1985, 68, 74–75, note M. Fabiani (also treated in § 6[3][c][ii] *infra*) (rejecting the defense, to claims for violation of the right to integrity, that a film work was televised without any change in tenor, but merely interrupted, the court noted that Article 6*bis* was expressly amended in the Brussels Act to forestall possible prejudice, not only due to changes within a work itself, but due to making it public in some derogatory fashion).

²⁵⁷ See, e.g., the *C.A.I. Amstelveen* decision, Hoge Raad (Supreme Court) (Netherlands), Oct. 30, 1981, NJ 1982, 435, in English trans. in 14 I.I.C. 431 (1983) (enforcing the Berne minimum right under Article 11*bis*, as incorporated into the Dutch copyright statute, which applied to a U.S. work by virtue of U.C.C. national treatment).

²⁵⁸ For analysis of whether national treatment applies to any right arising from a contract-relevant rule found in a copyright law, see § 6[3] *infra*.

²⁵⁹ See § 2[1][c][ii] *infra*.

²⁶⁰ E. Ulmer, “The ‘Droit de Suite’ in International Copyright Law,” 6 I.I.C. 12, 21–22 (1975).

²⁶¹ See, e.g., P. Goldstein and P.B. Hugenholtz, *International Copyright: Principles, Law, and Practice*, § 4.2.1 at 104–105 (Oxford Univ. Press, 3d ed., 2013) (analyzing economic reasons for evading treaty obligations to provide national treatment).

²⁶² See P.E. Geller, “New Dynamics in International Copyright,” 16 *Columbia-VLA J. Law & Arts* 461 (1992).

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when the pertinent treaty text binds any country, but such rights as the country may later grant.²⁶³ Thus, any Berne-based definition of copyright or authors' rights subject to national treatment adapts to the experiments of adhering parties as they try out such new rights or elaborate prior rights over time. The roles of Berne minimum rights have to be highlighted here: originally, they were largely introduced to equalize any inequalities that might result from national treatment. But they have later prompted lawmakers to incorporate them into domestic law along with further rights, all in turn subject to national treatment.²⁶⁴

Historically understood, Berne minimum rights make up some, but not necessarily all, of the rights that, from law to law, constitute copyright or authors' rights. That is, this writer submits, Berne minimum rights may be construed liberally as filling in some, but not necessarily all, of the Berne conception of copyright subject to national treatment.²⁶⁵ Under such this construction, if national law develops a novel entitlement or remedy corresponding to a creative elaboration of a Berne or sequel minimum right to meet the challenge of new media, that entitlement falls within the overall definition of copyright subject to national treatment.²⁶⁶ Even where lawmakers develop rights not yet anticipated in express Berne or subsequent treaty language, measuring them against such dynamic criteria may still result in subjecting them to national treatment on the premise that the Berne revision process, had it been brought up to date, would have included them. For example, rights fashioned to meet digital challenges, notably in the WIPO Treaties, fall within copyright in the Berne conception if they fill "casuistic gaps" among specific Berne minimum rights.²⁶⁷

It remains an open question whether national treatment may always be comparably construed for neighboring rights as for copyright. Not only do these related rights have varying scopes for different subject matters, but they are tied to cryptic caveats in treaty texts.²⁶⁸ It has been astutely suggested that, since Rome provisions assuring neighboring rights bound countries to enact them in the future, it might at their inception have seemed unnecessary to use broad Berne language to formulate any corresponding principle of national treatment with regard to such rights.²⁶⁹ Rome

²⁶³ See Berne, Art. 5(1) (Paris), Art. 4(1) (Rome, Brussels).

²⁶⁴ For further analysis, see §§ 2[3][b] and 5[4][a][ii] *supra*.

²⁶⁵ See, generally, A. Kéréver, "La règle du 'traitement national' ou le principe de l'assimilation" (in English trans.: The Rule of national treatment or the principle of assimilation), RIDA 1993, no. 158, 75, at 91–93 (rejecting any simple equation between minimum rights and those subject to national treatment).

²⁶⁶ For examples, see § 5[4][b][ii] *infra*.

²⁶⁷ See, e.g., M. Ficsor, *The Law of Copyright and the Internet: The 1996 WIPO Treaties, their Interpretation and Implementation*, 494–495 (Oxford Univ. Press, 2002).

²⁶⁸ See, e.g., Rome, Art. 2(2) (fashioning differing minimum rights in performances, phonograms, and broadcasts, with national treatment "subject to" such treaty-granted rights *cum* exceptions); TRIPs, Art. 3(1) (also varying minimum neighboring rights according to the type of production protected, with national treatment ostensibly only "in respect of" such rights); W.P.P.T., Art. 4(1) (tracking TRIPs language).

²⁶⁹ See G. Boytha, "Interrelationship of Conventions on Copyright and Neighboring Rights," Acta

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national treatment has since been persuasively read in line with the original Berne principle of national treatment to entitle a Rome-qualifying claimant to a right domestically instituted to control online uses, clearly outside original Rome minimum rights.²⁷⁰ The TRIPs Agreement and WIPO Performers and Phonograms Treaty, however, vary slightly in language on point.²⁷¹

[ii] At the Margins: Remuneration; Remedies

National treatment, whether relative to copyright or to neighboring rights, does not indiscriminately include every entitlement with any passing incidence on such rights. The treaties, especially the Berne Convention and sequel treaties, give some guidance to finding the outer reaches of national treatment in this regard. We shall contrast the limited national treatment that Berne reserves for *droit de suite*, a quasi-copyright entitlement sometimes classed within authors' rights, with the full national treatment due for rights more clearly falling into the copyright bundle. Within the European Union, as noted above, the E.U. principle of non-discrimination, now buttressed by increasing harmonization, avoids this problem.²⁷²

The margins of national treatment are illustrated by *droit de suite*. This resale-royalty right entitles artists or other authors to receive shares of the proceeds from the resale of original embodiments of their works, such as paintings, limited-edition prints, sculptures, manuscripts, etc.²⁷³ In the Berne Convention, Article 14*bis* of the Brussels Act, now Article 14*ter* of the Paris Act, was introduced to extend *droit de suite* "only if legislation in the country to which the author belongs" recognizes such an entitlement and "to the degree permitted by the country where this protection is claimed." Thus, each Berne country providing some form of *droit de suite* has to grant it to Berne-qualifying authors only if a corresponding right exists in that other country as to the nature of the entitlement, but not as to details of its implementation. This obligation, it has been held, arises even when the material terms of the regime of *droit de suite* in the claimant's country, such as rate schedules, collection procedures, allocations, etc., differ from those in the protecting country.²⁷⁴ Somewhat differently, as explained below, the Rome Convention expressly hedges national treatment as to some royalties accruing from modes of communication which it stipulates as licensed for phonograms or broadcasts to the public.²⁷⁵

Juridica Academiae Scientiarum Hungaricae 1983, 403, at 422.

²⁷⁰ The *Evening with Marlene Dietrich* decision, BGH (Germany), April 21, 2016, GRUR 2016, 1048, in English trans. in 48 I.I.C. 353 (2017) (also discussed in § 3[4][b][ii] *supra*).

²⁷¹ See M. Ficsor, *The Law of Copyright and the Internet: The 1996 WIPO Treaties, their Interpretation and Implementation*, 605–616 (Oxford Univ. Press, 2002).

²⁷² See § 3[3][a][ii][A] *supra*.

²⁷³ See, e.g., D. Vaver, "The National Treatment Requirements of the Berne and Universal Copyright Conventions," 17 I.I.C. 719–720 (1986) (distinguishing *droit de suite*, from copyright, insofar as it is not "a right to exclude or to receive compensation on use").

²⁷⁴ See the *Les Parallèles* decision, BGH (Germany), June 23, 1978, GRUR Int. 1978, 470, in English trans. in 10 I.I.C. 769, 772 (1979).

²⁷⁵ See § 5[4][c][ii] *in fine infra*.

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Let us generalize our inquiry: Should entitlements to remuneration, ostensibly falling under the rubric of copyright or of neighboring rights, be extended pursuant to national treatment? In that event, any qualifying claimant, invoking national treatment, could benefit from such entitlements without regard to corresponding regimes in any country of origin. A number of distinctions have to be drawn here, to start, that between treaty provisions that are legislatively implemented and self-executing treaty provisions that remain to be construed.²⁷⁶ For example, some domestic implementing legislation does not grant even treaty claimants all entitlements to remuneration for uses of works or related productions, notably that for library loans of books.²⁷⁷ Such authors' entitlements to state-provided funds channeled through public-library systems for loans of works may be distinguished from remuneration rights funded by exploiting parties or users.²⁷⁸ In countries that deem Berne and other treaty provisions to be self-executing, a claimant may perhaps more easily argue that any such right to draw remuneration from uses of protected materials, for example, from private copying, is a copyright or like entitlement subject to national treatment.²⁷⁹ In such a case, a country would have to point to features differentiating the right in question from copyright or neighboring rights, as understood in the Berne-plus treaty regime, to justify withholding the right or royalties from treaty claimants; otherwise, it would have to grant national treatment.²⁸⁰ That said, remuneration achieved through locally applicable copyright-contract provisions may fall outside national treatment.²⁸¹

The distinction between rights and remedies, questioned above for purposes of choosing laws, frames another perspective on the limits of national treatment.²⁸² Suppose that suit were brought in a jurisdiction other than that where infringement occurred, that is, outside any protecting country: national treatment need not compel procedurally identical measures of enforcement as would be available in any protecting country.²⁸³ A more measured view of national treatment requires only relief

²⁷⁶ For these distinctions, see § 3[2][a] *supra*.

²⁷⁷ See, e.g., U.K. Public Lending Right Scheme 1982 (S.I. 1982/719), Art. 5, as amended (extending entitlement only to E.E.A. claimants).

²⁷⁸ *N.b.*, the first-sale or exhaustion doctrine may preclude the exercise of copyright in licitly purchased copies of works lent out by libraries, thus taking remuneration for such lending out of the scope of national treatment.

²⁷⁹ Compare F. Melichar, "Deductions Made by Collecting Societies for Social and Cultural Purposes in the Light of International Copyright Law," 22 I.I.C. 47, 56–59 (1991) (arguing against national treatment for any entitlement generating royalties without regard to actionable exploitation), with M. Möller, "Copyright and the New Technologies—the German Federal Republic's Solution?," [1988] E.I.P.R. 42, 43 (arguing that rights to remuneration from exploitation or use fall within "the core and the essence of the [Berne] Convention").

²⁸⁰ See, e.g., *Sad Najwyzszy* (Supreme Court) (Poland), Sept. 16, 2009, I CSK 35/09, OSN 2010, no. 11, heading 81 (confirming national treatment with regard to remuneration for specified uses of audiovisual works or of performances).

²⁸¹ For conflicts analysis of such standard provisions, see § 6[3][c][i] *infra*.

²⁸² See § 3[1][b][ii][A] *supra*.

²⁸³ On choice of law in such a suit, see § 3[1][a] *supra*; on jurisdiction, see § 6[1] *infra*.

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indispensable to enjoying such substantive rights as are subject to national treatment, along with treaty minimum rights.²⁸⁴ There have indeed been, since the inception of the Berne Union, minimum procedural rights which give some, although not a complete, indication of the kinds of relief substantively indispensable to copyright.²⁸⁵ This approach is confirmed by the TRIPs Agreement, which now amplifies the panoply of remedies that W.T.O. countries must accord, albeit with permissible variations.²⁸⁶

By the same token, Berne national treatment does not impact procedures that may generally affect the access of claimants to the courts under forum law.²⁸⁷ To test the limits of national treatment in this regard, consider the example of a hypothetical suit brought before a German court for infringement in the United States.²⁸⁸ The German court could not award attorneys' fees for infringement in the United States pursuant to the U.S. Copyright Act for the simple reason that the only procedures for awarding attorneys' fees in any German suit lie in its own purely procedural law, quite independently of any copyright statute.²⁸⁹ That is, remedies such as attorneys' fees, lying outside most national copyright statutes, are considered to fall outside those rights definitionally subject to national treatment.²⁹⁰

[c] Remaining Permissible Derogations of Protection

There are a few points, beyond those specified above,²⁹¹ on which a country may derogate from national treatment or minimum rights.²⁹² These derogations, triggered

²⁸⁴ *But see* G. Boytha, "Some Private International Law Aspects of the Protection of Authors' Rights," Copyright 1988, 410 (suggesting that national treatment requires the forum country to grant all remedies available in the protecting country).

²⁸⁵ *See* Berne, Art. 16(3) (Rome, Brussels, Paris) ("seizure" of infringing copies, for which a minimum Berne right is provided, "shall take place in accordance with the legislation of each country," without specifying whether this is either a protecting or forum country).

²⁸⁶ *See* TRIPs, Art. 41 (obligating members to "ensure" enforcement procedures but without any obligation to institute any special "judicial system"). *See also* WIPO Copyright Treaty, Arts. 11, 12, and 14, and WIPO Performances and Phonograms Treaty, Arts. 18, 19, and 23 (contemplating "effective" and "expeditious remedies" to protect markets against pirates in cyberspace as well).

²⁸⁷ *See, e.g.,* Murray v. British Broadcasting Corp., 906 F. Supp. 858, 862–863 (S.D.N.Y. 1995) (U.S.) (holding that Berne national treatment is not pertinent to considering motion to dismiss for *forum non conveniens* based on procedural argument).

²⁸⁸ On exercising jurisdiction over infringement taking place outside the forum country, see § 6[1] *infra*.

²⁸⁹ Germany, Zivilprozeßordnung (Code of Civil Procedure), §§ 91 *et seq.* (authorizes courts to award costs and expenses, including attorneys' fees, in civil suits generally). *See also* W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 59 (Berne Art. 5, Rem. 7) (Werner-Verlag, 1977) (noting that the Berne bar to formalities does not apply to requirements in the German Code of Civil Procedure for foreigners filing suit in Germany).

²⁹⁰ This construction eliminates most tensions between the Berne bar to formalities and U.S. legislation implementing Berne protection, which still predicates some very special procedural advantages and remedies on formalities. *See* "United States," herein, at §§ 5[3][a] and 5[4][b].

²⁹¹ *See also* § 4[1][c][i][A] *supra* (cutting back on such treatment for design works); § 5[1][b][i] *supra* (mandating retaliation for dropping out of Berne Union while adhering to the U.C.C.); § 5[2] *supra*

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by giving notice to designated international bodies and effective country by country, will here be considered under the following headings: (i) retaliation, (ii) reservations, and (iii) licenses. Pursuant to the Marrakesh VIP Treaty, its special exceptions in favor of the visually handicapped may also curtail treaty rights, as indicated above.²⁹³

[i] Retaliation against Non-Members

As already explained, an author from a non-Berne country may obtain Berne protection if his work is first or simultaneously published in a Berne country.²⁹⁴ Since 1914, under Article 6 of all the succeeding Berne Acts, adhering countries may retaliate against such a non-Berne country ostensibly to prompt it to grant reciprocal protection to Berne authors.²⁹⁵ Upon finding that the non-Berne author's home country fails to protect the works of the Berne country's nationals "in an adequate manner," it may give notice to the Director General of WIPO that it will "restrict" specified rights accorded to nationals of the non-Berne country. This notice will be retransmitted to all the countries of the Union, each of which may then also similarly restrict the rights of authors of this non-Berne country. The TRIPs Agreement also allows such a notice to be given to the TRIPs Council, with the same effect as between W.T.O. members.²⁹⁶ The WIPO Copyright Treaty applies the Berne provision *mutatis mutandis*.²⁹⁷

[ii] Specific Reservations Still in Effect

The revised Berne Acts, to different degrees, have permitted adhering countries to give notice of reservations excusing them from specified obligations.²⁹⁸ A country's reservations under a specific Berne Act only extend to a subsequently binding Act if that country properly maintains them by express notice upon adherence to that subsequent Act. The range of such reservations has over time been progressively restricted, and many adhering countries have abandoned prior reservations.²⁹⁹ For example, many countries have relinquished the translation reservation, which allowed a country to terminate the minimum Berne right of translation into a given language ten years after first Berne publication of the work at issue in the original language if, during that period in the Berne Union, no authorized translation in that language had been published.³⁰⁰ Rarely do countries still take advantage of this reservation,

(cutting back on the national duration of rights under the rule of the shorter term); § 5[3] *supra* (allowing some formalities and procedural rights); § 5[4][b] *supra* (definitional limits to national treatment).

²⁹² On notification to limit TRIPs most-favored-nation treatment, see § 5[4][a][ii] *supra*.

²⁹³ See § 5[4][a][i][B] *in fine supra*.

²⁹⁴ See § 4[2][b][i] *supra*.

²⁹⁵ See H. Desbois, A. Françon, and A. Kéréver, *Les conventions internationales du droit d'auteur et des droits voisins*, para. 58 (Daloz, 1976).

²⁹⁶ TRIPs, Art. 3(1) *in fine*.

²⁹⁷ W.C.T., Arts. 1(4), 3.

²⁹⁸ Berne, Arts. 25(3) and 27(2) (Rome, Brussels), Arts. 28(1)(b), 30(2), and 33(2) (Paris).

²⁹⁹ See H. Desbois, A. Françon, and A. Kéréver, *Les conventions internationales du droit d'auteur et des droits voisins*, paras. 12, 16, 29, 40, 54, 189 (Daloz, 1976).

³⁰⁰ See W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistung-*

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although normally only for terminating the right for translations into the language or languages in general usage in the country in question.³⁰¹

The Rome Convention allows for rather complex reservations which, once triggered by proper notice, change certain criteria of eligibility otherwise provided to benefit from its provisions or limit the effect of certain minimum rights it otherwise assures.³⁰² Most notably, Article 16(1) of the Rome Convention allows members to derogate from specified obligations (a) to pay foreign claimants remuneration under Article 12 for the broadcasting or communication of recorded performances to the public³⁰³ or (b) to assure rights under Article 13(d) relative to the communication of television broadcasts to the public for fees.³⁰⁴ The TRIPs Agreement also allows for Rome “conditions, limitations, exceptions and reservations” relative to its neighboring rights and, in particular, prescribes notice to the TRIPs Council to trigger any reservation.³⁰⁵ The WIPO Treaty on Performances and Phonograms similarly allows such derogations to be noticed to the Director General of WIPO to such effect.³⁰⁶

[iii] Licenses in Favor of Developing Countries

The 1971 Paris Acts of both the Berne Convention and the Universal Copyright Convention allow developing countries to avail themselves of legally imposable, but specifically hedged licenses.³⁰⁷ Each developing country, to exercise or renew this option, must periodically give notice to WIPO under Berne provisions, or to UNESCO under the U.C.C. provisions.³⁰⁸ The TRIPs Agreement and the WIPO Copyright

sschutzrecht: Kommentar, 76–78 (Berne Art. 8, Rems. 4–5) (Werner-Verlag, 1977).

³⁰¹ *But see, e.g.*, Judgment no. 4118, 1993, Supreme Court (Turkey), 11th Tribunal, *as commented*, A. Kéréver, “Chronique de Jurisprudence” (Review of Case Law), RIDA 1995, no. 163, 145, at 173 (holding that the unauthorized translation of a French work into Turkish was not actionable, since it took place after the 10-year term of the translation right allowed by the Turkish reservation under the Brussels Act of Berne).

³⁰² Rome, Arts. 5(3), 6(2), 16, and 17.

³⁰³ *N.b.*, a Rome country may derogate, *inter alia*, from its obligation to provide remuneration under Article 12 relative to phonograms produced by a national of another Rome country, this by cutting the extent and term of the remuneration entitlement back to that effective in the other Rome country, thus imposing a rule of the shorter term relative to this entitlement. On the rule of the shorter term generally, see § 5[2] *supra*.

³⁰⁴ *See* W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 326–328 (Rome Art. 16, Rems. 1–7) (Werner-Verlag, 1977). *See also* R. Dittrich, “The Practical Application of the Rome Convention,” 26 Bull. Copr. Soc’y 295 (1979) (analyzing complex impact of reservations on Rome rights).

³⁰⁵ TRIPs, Arts. 3(1) *in fine*, 14(6). On invoking TRIPs as self-executing grounds of private rights before national courts, see § 3[3][a][i] *supra*. On the substantive TRIPs provisions, see § 5[5][b][i] *infra*.

³⁰⁶ W.P.P.T., Art. 15(3). *See* M. Ficsor, *The Law of Copyright and the Internet: The 1996 WIPO Treaties, their Interpretation and Implementation*, 637–638 (Oxford Univ. Press, 2002).

³⁰⁷ For historical background, see S. Ricketson and J. Ginsburg, *International Copyright and Neighbouring Rights: The Berne Convention and Beyond*, vol. 2, ch. 14 (Oxford Univ. Press, 2006).

³⁰⁸ Berne, Appendix, Art. I (Paris); U.C.C., Art. *Vbis* (Paris).

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Treaty incorporate the Berne license scheme by reference, but without expanding on its terms.³⁰⁹ Given the complexity and resulting disuse of these licenses, there have been calls for a new regime.³¹⁰

Under complex conditions, competent authorities of developing countries may grant non-exclusive and non-transferable licenses to nationals to translate works already published, but not available in the language proposed for translation; however, these licenses may only be granted for “the purpose of teaching, scholarship or research.”³¹¹ Licenses are similarly available to reproduce and publish works not otherwise available in the developing country, but only at a price “reasonably related to that normally charged in the country for comparable works” and only for “use in connection with systematic instructional activities.”³¹²

[5] How May Trade Arrangements Impact Protection?

Under the classic Berne treaty regime, private claimants typically resort to judicial actions against other private parties to vindicate copyright or related rights. We shall here (a) outline how public national or regional authorities, and at times even private claimants, may initiate trade actions for failures to comply with treaty obligations to enforce such rights, and (b) introduce the TRIPs Agreement as the chief instrument under which public authorities may bring such actions.³¹³

[a] Trade Provisions on Intellectual Property

To understand why intellectual property, including copyright and neighboring rights, now figures into trade treaties, consider the following distinction: On the one hand, treaties such as the Berne Convention are largely instruments of *private international law*. Such law assures private parties of rights that they may assert against each other across borders by recourse to courts. On the other hand, trade arrangements such as the TRIPs Agreement are above all instruments of *public international law*. Such law may obligate public entities, like a nation-state or regional union, to maintain private rights of intellectual property.³¹⁴

Hence the key reason for buttressing the Berne-plus treaty regime with trade arrangements. Treaties setting out private international law work to the extent that private suits can be relied upon to protect treaty-articulated private rights. What if,

³⁰⁹ TRIPs, Art. 9(1); W.C.T., Art. 1(4).

³¹⁰ For a critical analysis and proposals, see A. Cerda Silva, “Beyond the Unrealistic Solution for Development Provided by the Appendix of the Berne Convention on Copyright,” 60 J. Copr. Soc’y 581 (2013).

³¹¹ Berne, Appendix, Art. II(5) (Paris); U.C.C., Art. Vter(3) (Paris).

³¹² Berne, Appendix, Art. III(2)(a)–(b) (Paris); U.C.C., Art. Vquater(1)(a)–(b) (Paris).

³¹³ For an overview both of copyright treaties and of trade arrangements, including E.U. instruments, from the standpoint of private claimants, see § 3[3] *supra*.

³¹⁴ Other instruments, besides trade treaties, may also serve this function. *See, e.g.*, Convention on Cybercrime, Art. 10 (concluded under the auspices of the Council of Europe, 2001), at <http://conventions.coe.int/Treaty/en/Treaties/Html/185.htm> (obligating parties to adopt “legislative and other measures” to criminalize acts of infringement).

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however, entire jurisdictions fail to adhere to treaties, legislators to enact adequate laws, judges to provide adequate relief, or police to enforce laws thoroughly? Recourse may then be needed to supranational procedures, eventually coupled with cross-border sanctions, at a minimum to encourage public authorities to settle differences on point.³¹⁵ Trade agreements, as a matter of public law, may be invoked against a sovereign state or region itself: upon findings of non-compliance, trade reprisals or monetary awards may be forthcoming against the sovereign. But such procedures might fall short of their aims, for example, given doubts about decision-making,³¹⁶ refusals to rectify non-compliance pursuant to findings,³¹⁷ and cross-sector retaliation.³¹⁸

Besides the TRIPs Agreement, trade arrangements concerning intellectual property range from regional instruments, notably the North American Free Trade Agreement,³¹⁹ to lesser regional and bilateral treaties designated with an alphabet soup of acronyms such as FTAs and BITs.³²⁰ Under some of these trade arrangements, a private claimant may engage arbitration proceedings against an adhering party itself, a public entity like a nation-state, for impairing the private claimant's treaty-assured rights, including those sounding in intellectual property, and thus prejudicing its commercial interests.³²¹ It remains unclear how treaty-articulated rights, normally formulated to provide discretion in national implementation, can provide parameters for assessing harms to commercial interests, such as investment prospects, that usually turn on market contingencies.³²²

³¹⁵ See, generally, A. Otten, "Implementation of the TRIPs Agreement and Prospects for its Further Development," 1 J. International Economic Law 523, 527 (1998) (contemplating, optimally, "bilateral, 'out of court', settlement of disputes").

³¹⁶ See, e.g., T. Payosova, G.C. Hufbauer, and J. Schott, "The Dispute Settlement Crisis in the World Trade Organization: Causes and Cures," PIIE Policy Brief no. 18-5 (Peterson Institute for International Economics, 2018) (raising procedural and formal problems, like the politics of appellate appointments, confusing *obiter dicta* in decisions, etc.); M. Koskeniemi and P. Leino, "Fragmentation of International Law? Postmodern Anxieties," Leiden J. International Law 2002, 553, at 571-574 (noting substantive blind-spots relative to W.T.O. disputes with non-trade stakes and ensuing risks of non-compliance).

³¹⁷ For further analysis, see E. Lee, "Measuring TRIPs Compliance and Defiance: The WTO Compliance Scorecard," 18 J. Intellectual Property Law 401 (2011).

³¹⁸ See, e.g., § 5[5][b][ii][B] *infra* (setting out instances of such threatened retaliation).

³¹⁹ Abbreviated: NAFTA. For its copyright provisions, see NAFTA, Arts. 1701 *et seq.*

³²⁰ For an overview, see L. Liberti, "Intellectual Property Rights in International Investment Agreements: An Overview," OECD Working Papers on International Investment no. 2010/01 (OECD Publ., 2010), at https://www.oecd-ilibrary.org/finance-and-investment/intellectual-property-rights-in-international-investment-agreements_5kmfq1njz135-en.

³²¹ See, e.g., *Eli Lilly and Co. v. Govt. of Canada*, International Centre for Settlement of Investment Disputes, Case No. UNCT/14/2, Final Award, March 16, 2017 (dismissing a private party's claims against Canada for its courts' invalidation of claimant's patents, in purported non-compliance with NAFTA standards, and thus denying actionable damages), at <https://www.italaw.com/sites/default/files/case-documents/italaw8546.pdf>.

³²² For further analysis, see R. Okediji, "Is Intellectual Property 'Investment'?: *Eli Lilly v. Canada* and the International Intellectual Property System," 35 Univ. Pennsylvania J. International Law 1121 (2014); H.G. Ruse-Khan, "Protecting Intellectual Property under BITs, FTAs, and TRIPs: Conflicting Regimes

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Private claimants may petition their own local authorities to represent their grievances in trade fora. However, when separate countries attempt trade reprisals on their own, they risk working at cross-purposes, if not violating international trade law. One challenge to such U.S. proceedings has been brought before the World Trade Organization without significant success.³²³ Local proceedings may also be brought to stop trade in infringing goods at borders.³²⁴

[b] TRIPs Provisions and Dispute Settlement

Here we shall focus on the TRIPs Agreement (i) as the chief trade instrument setting standards for intellectual property worldwide and (ii) as the global forum for settling disputes between members with regard to compliance with such standards.

[i] TRIPs Provisions on Rights and Enforcement

The Agreement on Trade-Related Aspects of Intellectual Property, one of many agreements concluded under the aegis of the World Trade Organization in 1994, binds most of the countries in the world.³²⁵ This TRIPs Agreement settled standards, developed over the last century, for rights and remedies in the field of intellectual property, including copyright and neighboring rights.³²⁶ In the W.T.O. forum, entire jurisdictions worldwide may challenge each other with regard to their respective compliance with these standards.³²⁷

The incorporation of copyright into the TRIPs Agreement expanded upon Berne, if not, Rome standards.³²⁸ Article 2(2) of the TRIPs Agreement in principle precludes construing substantive TRIPs provisions to derogate from “existing obligations” under the Berne and Rome Conventions. Article 9(1) of the TRIPs Agreement then incorporates the provisions from the 1971 Paris Act of the Berne Convention concerning economic rights, and subsequent TRIPs provisions proceed to follow a “Berne-plus” approach by supplementing these Berne provisions on selected issues and by assuring “quasi-Rome” neighboring rights.³²⁹

Consider key examples of how the TRIPs Agreement amplifies on Berne or Rome rights. While covering all Berne works, it clarifies that computer programs are

or Mutual Coherence?,” in K. Miles and C. Brown (eds.), *Evolution in Investment Treaty Law and Arbitration*, 485 (Cambridge Univ. Press, 2011).

³²³ See Report of the Panel, United States—Sections 301–310 of the Trade Act of 1974, WT/DS152/R, Dec. 22, 1999.

³²⁴ For examples, see § 3[1][b][ii][B] *in fine supra*.

³²⁵ Hereinafter, respectively: TRIPs and W.T.O. For links to official background materials on TRIPs, see http://www.wto.org/english/tratop_e/trips_e/trips_e.htm.

³²⁶ On the TRIPs Agreement, as including provisions concerning copyright and neighboring rights that are self-executing in some countries, see § 3[3][a][i] *supra*.

³²⁷ For details, see § 5[1][b][ii] *infra*.

³²⁸ For overviews of these conventions, see §§ 3[3][b][i] and 3[3][c][i] *supra*. On Berne primacy, see § 5[1][b][i] *supra*. On minimum rights, see § 5[4][a] *supra*.

³²⁹ For further commentary on Berne- and Rome-based TRIPs standards, see J. Malbon, C. Lawson, and M. Davison, *The WTO Agreement on Trade-related Aspects of Intellectual Property Rights: A Commentary*, 241–274 (Edward Elgar, 2014).

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protected as such “literary works” and databases as “compilations” if these are sufficiently original, and it recognizes rental rights in at least computer programs and cinematographic works.³³⁰ Varying Rome rights somewhat, TRIPs establishes minimum rights against bootlegging live performances, coupled with rights against the piracy of sound recordings, as well as rental or rental-remuneration rights in such recordings, all for a minimum term of 50 years, as well as specified rights in broadcasts for 20 years.³³¹ National treatment is assured in copyright and, with caveats yet to be tested, in TRIPs-specified neighboring rights.³³² We have already analyzed TRIPs most-favored-nation treatment.³³³

Protection, though in theory assured by domestic or treaty law, would in practice be ineffective if judges or other authorities failed to provide and enforce effective remedies. Articles 41 *et seq.* of the TRIPs Agreement broadly formulate procedural and remedial standards for the enforcement of intellectual property in domestic courts and at national borders.³³⁴ An Argentine court has held that Article 50 of the TRIPs Agreement, which governs provisional remedies for infringement in some detail, is “directly operative” in domestic law, but this conclusion might not often ensue in most local laws.³³⁵ A more basic flaw undermines this entire scheme: the TRIPs Agreement proposes to restate remedial parameters for copyright norms elaborated for old markets of hard copies, but remedies are now needed in a newly networked world.³³⁶

[ii] TRIPs Dispute Settlement and Retaliation

The TRIPs Agreement enables W.T.O. members to bring each other to task for failing to comply with its provisions. TRIPs panels, with recourse to the W.T.O. Appellate Body, consider disputes in this regard, and any failure to cure non-compliance may trigger retaliation.³³⁷ These procedures raise a pair of issues: (A) How may TRIPs provisions be interpreted in such disputes? (B) What measures of retaliation are permitted?

³³⁰ TRIPs, Arts. 10–11 (though rental rights are not mandatory for cinematographic works absent widespread copying). *See also* TRIPs, Arts. 35 *et seq.* (protecting designs of integrated circuits in line with Washington Treaty).

³³¹ TRIPs, Art. 14. *See also* § 4[3][a][i][B] *supra* (comparing Berne and TRIPs retroactivity).

³³² TRIPs, Arts. 1(2), 3. *See, generally*, § 5[4][b][i] *in fine supra* (analyzing national treatment relative to copyright and that relative to neighboring rights).

³³³ *See* §§ 5[1][c][ii] *in fine* and 5[4][a][ii] *supra*.

³³⁴ *See* T. Dreier, “TRIPs and the Enforcement of Intellectual Property Rights,” in F.-K. Beier and G. Schricker (eds.), *From GATT to TRIPS: The Agreement on Trade-Related Aspects of Intellectual Property Rights*, 248 (Wiley-VCH, 1996).

³³⁵ *Johnson & Son Inc. v. Clorox Argentina, C.N.F. Civ. & Com., Sala II* (National Court of Federal Civil & Commercial Appeals) (Argentina), April 30, 1998, note M. Emery, *El Derecho*, no. 9523, June 16, 1998. *But see, e.g.*, *Tribunal Fédéral* (Supreme Court) (Switzerland), Aug. 11, 2009, part 5.2, SIC 2010, 86 (as noted in § 3[3][a][i] *in fine supra*).

³³⁶ For further analysis, see P. Yu, “Why Are the TRIPs Enforcement Provisions Ineffective?,” 18 *J. Intellectual Property Law* 479 (2014).

³³⁷ For the disputes, see http://www.wto.org/english/tratop_e/trips_e/trips_e.htm.

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[A] Construing Treaty Standards in Disputes

What lessons to draw from TRIPs panels as they submit public entities, like nation-states, to treaty-based rulings? In principle, they differently formulate and resolve copyright issues than do domestic courts in suits between purely private parties.³³⁸ Nonetheless, though TRIPs readings are made largely in the light of public law, notably trade law, they often take account of treaty texts, *inter alia* Berne or Rome provisions, that the TRIPs Agreement incorporates or tracks, and these assure private rights.³³⁹ Furthermore, to understand TRIPs provisions, decision-makers may more easily interpret such incorporated Berne and Rome provisions, fashioned in transparent diplomatic conferences, than TRIPs provisions worked out in opaque negotiations.³⁴⁰

Other pressures nudge TRIPs readings toward the convergence of public and private considerations. The Appellate Body has confirmed that the Vienna Convention, the normal guide for treaty interpretation in both public and private cases, is to guide TRIPs panels in their work.³⁴¹ The Berne-plus treaty regime of private international law, to the extent incorporated into TRIPs provisions, obligates W.T.O. members to implement TRIPs rights to assure private parties of rights in which they may freely trade across borders.³⁴² At the same time, the W.T.O. regime of public international law has to promote a dynamically growing global marketplace, and the TRIPs Agreement tries to further such public policies by optimizing the protection of intellectual property worldwide.³⁴³ TRIPs panels have recognized the need to “avoid interpreting the TRIPs Agreement to mean something different from the Berne [or Rome] Convention except where this is explicitly provided for.”³⁴⁴

The TRIPs Agreement, as already noted, was built upon the Berne-plus treaty regime, but without fully consolidating this foundation.³⁴⁵ As already noted, among

³³⁸ See, e.g., C. Wadlow, “The Beneficiaries of TRIPs: Some Questions of Rights, *Ressortissants* and International *Locus Standi*,” *European J. International Law* 2014, 59, at 80–82 (analyzing how far, and on whose behalf, a TRIPs claimant may raise issues).

³³⁹ See M. Kennedy, *WTO Dispute Settlement and the TRIPs Agreement: Applying Intellectual Property Standards in a Trade Law Framework*, 218–220 (Cambridge Univ. Press, 2016).

³⁴⁰ For sources of the TRIPs text, see D. Gervais, *The TRIPs Agreement: Drafting History and Analysis* (Sweet & Maxwell, 4th ed., 2012). For further access, see http://www.wto.org/english/tratop_e/trips_e/trips_e.htm.

³⁴¹ See Report of the W.T.O. Appellate Body, AB-1997-5, India—Patent Protection for Pharmaceutical and Agricultural Chemical Products, WT/DS50/AB/R, Dec. 19, 1997, para. 43.

³⁴² On reading Berne and other such provisions pursuant to the Vienna Convention, see § 3[4][b][ii] *supra*. On construing minimum treaty rights and exceptions in particular, see § 5[4][a][i][C] *supra*. On how treaty law bears on contractual commerce in rights, see § 6[3][c][i] *infra*.

³⁴³ For critical analyses, see H. Ullrich, “TRIPs: Adequate Protection, Inadequate Trade, Adequate Competition Policy,” 4 *Pacific Rim Law and Policy J.* 153, 184 *et seq.* (1995); J.H. Reichman, “Universal Minimum Standards of Intellectual Property Protection under the TRIPs Component of the WTO Agreement,” 29 *The International Lawyer* 345, 346–347 (1995).

³⁴⁴ Report of the Panel, United States—Section 110(5) of the US Copyright Act, WT/DS160/R, June 15, 2000, para. 6.66.

³⁴⁵ See § 5[5][b][i] *supra*.

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Berne and Rome provisions, whether in their original text or as incorporated into the TRIPs Agreement, some are mandatory, some may be construed with varying degrees of discretion, and some are altogether optional.³⁴⁶ Note, too, that the TRIPs Agreement has not yet incorporated the latest treaties in the field, notably the WIPO Copyright Treaty and the WIPO Performances and Phonograms Treaty, responsive to recent media developments such as the internet.³⁴⁷ For these reasons, the TRIPs Agreement, incorporating Berne provisions, while taking Rome provisions as models, might sooner or later display gaps when panels are asked to consider new and hard cases. TRIPs panels may then face the choice: either decline jurisdiction, while invoking the lack of any express mandate to fill such gaps, or take jurisdiction and construe TRIPs provisions, if need be, to fill such a gap.³⁴⁸

Strict construction may be appropriate in different types of cases. To start, it may be called for in cases where the TRIPs provisions invoked in disputes are not modeled after broad Berne or Paris provisions, such as those providing for national treatment. For example, in its initial TRIPs decision, reading Article 70 *in fine*, specially instituted to govern applications for pharmaceutical patents pending the grace period for developing countries, the W.T.O. Appellate Body rejected interpreting this provision in the light of any broad notion of “legitimate expectations.”³⁴⁹ Further, strict construction may be needed to preserve “[d]eference to local law” in cases where international TRIPs standards have to be adapted to national legal regimes and conditions.³⁵⁰ For example, a W.T.O. panel considered the complaint that China had run afoul of Article 61 of the TRIPs Agreement, which requires criminal penalties for the willful infringement of copyright on a commercial scale. The panel found China within the range of permissible discretion under this provision when it fashioned its penalties on point in line with its own overall criminal system and its own circumstances of enforcement.³⁵¹ Finally, strict construction would seem called for in any case of a non-violation complaint to the effect that a measure only indirectly “impaired” a

³⁴⁶ See § 3[4][b][i] *in fine supra*.

³⁴⁷ On minimum rights under these and other treaties, see § 5[4][a][i] *supra*.

³⁴⁸ For a framework of analysis, see P.E. Geller, “Intellectual Property in the Global Marketplace: Impact of TRIPS Dispute Settlements?,” 29 *The International Lawyer* 99 (1995), translated in *GRUR Int.* 1995, 935 (German), and in C.M. Correa (ed.), *Propiedad Intelectual en el GATT*, 171 (Ciudad Argentina, 1997) (Spanish).

³⁴⁹ Report of the W.T.O. Appellate Body, AB-1997-5, India—Patent Protection for Pharmaceutical and Agricultural Chemical Products, WT/DS50/AB/R, Dec. 19, 1997.

³⁵⁰ J.H. Reichman, “Securing compliance with the TRIPs Agreement after *US v India*,” 1 *J. International Economic Law* 585, 596 (1998). *But see* T. Cottier and K.N. Schefer, “The Relationship Between World Trade Organization Law, National and Regional Law,” 1 *J. International Economic Law* 83, 87, n. 14 (1998) (arguing for a broader application of the GATT criterion of “legitimate expectations” in TRIPs cases).

³⁵¹ Report of the W.T.O. Panel, China—Measures Affecting the Protection and Enforcement of Intellectual Property Rights, WT/DS362/R, Jan. 26, 2009, paras. 7.494–7.681 *passim*. For further analysis, see M. Kennedy, *WTO Dispute Settlement and the TRIPs Agreement: Applying Intellectual Property Standards in a Trade Law Framework*, 161–170 (Cambridge Univ. Press, 2016).

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TRIPs “benefit” without violating an express TRIPs obligation.³⁵² Strict construction of the textual basis for such a non-violation claim would avoid abusing the “lawmaking power” that would seem to have to be exercised in adjudicating the claim.³⁵³

By contrast, basic principles of copyright treaties may be subject to broad construction. The W.T.O. Appellate Body has taken this approach in considering the Paris Convention on industrial property, as it was incorporated into the TRIPs Agreement, as was the Berne Convention.³⁵⁴ At issue was U.S. law which precluded or obstructed claimants from registering or enforcing trade names and trademarks for businesses the Cuban government had expropriated. The Appellate Body ruled that the TRIPs provision incorporating the Paris provision on trade names was to be understood in its “ordinary meaning”: the incorporated provision was read into the TRIPs Agreement without caveats.³⁵⁵ The challenge to the U.S. law in question was based on the principle of national treatment, which was, not only incorporated by reference in Articles 2(1) and 9(1) of the TRIPs Agreement, but reinscribed, albeit in a somewhat different form, in its Article 3(1), along with the TRIPs principle of most-favored-nation treatment set out in its Article 4. The Appellate Body stressed that the principle of national treatment thus constituted the foundation of the international regime of intellectual property, but gave the benefit of the doubt to bureaucratic attempts to mitigate the impacts of the challenged U.S. law: it nonetheless still found the principle violated by this law.³⁵⁶

Readings may be mixed where decisions turn on fact-intensive findings. Consider Article 13 of the TRIPs Agreement, which confines “limitations or exceptions” of copyright “to certain special cases which do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the right holder.”³⁵⁷ How to interpret this three-step test which, set out in diplomatic language, evokes broad criteria of fair use that have been refined in endemically fact-intensive common-law precedents, notably of U.S. law, but that have only analogues in the civil law?³⁵⁸ A TRIPs panel had to assess whether a pair of purportedly minor exceptions

³⁵² TRIPs, Art. 64(2) (referencing Agreement establishing the WTO, Art. XXIII:1(b)).

³⁵³ See, generally, R. Hudec, “Dispute Settlement,” in J. Schott (ed.), *Completing the Uruguay Round: A Results-Oriented Approach to the GATT Trade Negotiations*, 180, 196 (Peterson Institute for International Economics, 1990) (speaking of that power as able “to impose new quasi-obligations, by a process of logically extending the sense, purpose, and policy” underlying an obligation).

³⁵⁴ Report of the W.T.O. Appellate Body, AB-2001-7, United States—Section 211 Omnibus Appropriations Act of 1998, WT/DS176/AB/R, Jan. 2, 2002.

³⁵⁵ *Id.*, paras. 339–341.

³⁵⁶ *Id.*, paras. 268, 296, 319, 354, 356, and 357. See also Report of the W.T.O. Panel, European Communities—Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs, WT/DS290/R, March 15, 2005, paras. 7.235–7.249 and 7.252 (finding non-compliance with TRIPs, Art. 3(1) and finessing issues under TRIPs, Art. 2(1)).

³⁵⁷ For further analysis of the three-step test, see §§ 5[4][a][i][B] *in fine* and 5[4][a][i][C] *supra*.

³⁵⁸ Compare P.E. Geller, “A German Approach to Fair Use: Test Cases for TRIPs Criteria for

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under U.S. copyright law, which exempted distinct modes of playing of music in public places, complied with these criteria.³⁵⁹ The panel held that one such exemption, allowing the amplification of music only by “homestyle” equipment, did so comply, after finding risks of impairment threatened in only negligible markets.³⁶⁰ But it held that the other exemption, allowing amplification without restriction in public, violated Article 13, given greater potential economic prejudice and lack of any licensing scheme.³⁶¹

[B] Channeling Retaliation for Non-Compliance

Filing a complaint with the World Trade Organization hopefully suffices to prompt compliance. If it does not, the dispute-settlement process is drawn out in stages to encourage compromises.³⁶² Or else, after a decision, a settlement by way of a compromise may be reached: for example, when one U.S. exception for publicly playing music was found to violate TRIPs provisions, the United States agreed to settle claims with payment into a fund to benefit complainants’ nationals.³⁶³

Absent either compliance or settlement, the non-complying country may be subject to retaliation: the complainant, after succeeding in showing non-compliance but failing to obtain compliance or a timely and satisfactory settlement, may request authorization from the Dispute Settlement Body to suspend obligations, or to withdraw trade concessions, that have been extended under some W.T.O. agreement.³⁶⁴ Retaliatory measures are optimally “temporary measures” applied in the same sector as that affected by the non-compliance justifying them, as well as “equivalent” in effect to “the nullification or impairment” effectuated by such non-compliance.”³⁶⁵

Copyright Limitations?,” 57 J. Copr. Soc’y 553, 561–568 (2010) (arguing that constitutionally based limitations of copyright are not subject to this TRIPs test), with M. Ficsor, “How Much of What? The ‘Three-Step Test’ and its Application in Two Recent WTO Dispute-Settlement Cases,” RIDA 2002, no. 92, 111 (critiquing the TRIPs test and proposing to measure non-compliance, *inter alia*, by impairment with economically significant uses).

³⁵⁹ See M. Kennedy, “Blurred Lines: Reading TRIPs with GATT Glasses,” 49 J. of World Trade 735, 743–755 (2015); L. Helfer, “World Music on a U.S. Stage: A Berne/TRIPs and Economic Analysis of the Fairness in Music Licensing Act,” 80 Boston Univ. L. Rev. 93 (2000).

³⁶⁰ Report of the Panel, United States—Section 110(5) of the US Copyright Act, WT/DS160/R, June 15, 2000, paras. 6.213–6.219 and 6.269–2.272.

³⁶¹ *Id.*, paras. 6.198–6.211 and 6.252–6.266.

³⁶² See, e.g., R. Okediji, “TRIPs Dispute Settlement and the Sources of (International) Copyright Law,” 49 J. Copr. Soc’y 585, 626–634 (2001) (focusing on the dispute concerning Section 110(5) of the U.S. Copyright Act, which involved protracted arbitration and other procedures concerning damages, compliance, etc.).

³⁶³ See Notification of a Mutually Satisfactory Temporary Arrangement, United States—Section 110(5) of the US Copyright Act, WT/DS160/23, June 26, 2003.

³⁶⁴ See, generally, A. Subramanian and J. Watal, “Can TRIPs Serve as an Enforcement Device for Developing Countries in the WTO?,” 3 J. International Economic Law 403, 410–415 (2000) (noting the possibility of suspending private intellectual property rights).

³⁶⁵ See W.T.O. Dispute Settlement Understanding, Art. 22.

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From the perspective of the classic Berne treaty regime, retaliation across W.T.O. sectors may well represent an anathema.³⁶⁶ For example, though risking to undercut Berne primacy, a W.T.O. member could decline to meet Berne or other such treaty obligations in response to W.T.O. non-compliance outside the TRIPs sector.³⁶⁷ Issue has been joined in the commentary with regard to the potential impact of such retaliation on the W.T.O. trade regime as a whole, as well as on the parameters limiting W.T.O. members who may resort to it.³⁶⁸ Unfortunately, in a globalized world, it might not prove easy to discriminate only against works or media productions appropriately connected to any one targeted W.T.O. member, since many works or productions have multi-country origins.³⁶⁹ Nonetheless, such retaliation measures, though only threatened, have met with occasional success: for example, a W.T.O. member as large as Brazil drew this broad sword out of its scabbard and pointed it at the United States, only to resheath it upon settlement.³⁷⁰

§ 6 In Which Court to Sue? Who Has Rights?

[1] What Jurisdiction in a Cross-Border Case?

Will a court take a cross-border copyright case?¹ Neither treaties concerning intellectual property nor other international instruments are globally dispositive on point.² Rather, the law of the forum normally determines a court's jurisdictional and

³⁶⁶ See, e.g., H. Ullrich, "Technology Protection According to TRIPs: Principles and Problems," in F.-K. Beier and G. Schriker (eds.), *From GATT to TRIPs: The Agreement on Trade-Related Aspects of Intellectual Property Rights*, 357, 377–378, 393, 397 (Wiley-VCH, 1996) (criticizing the potentially disruptive effects on the treaty regime of such retaliation).

³⁶⁷ On Berne primacy in the hierarchy of copyright treaties, see § 5[1][b][i] *supra*.

³⁶⁸ Compare S. Rajec, "The Intellectual Property Hostage in Trade Retaliation," 76 *Maryland L. Rev.* 169 (2016) (critical in the light of a few attempts), and F.M. Abbott, "Cross-Retaliation in TRIPs: Options for Developing Countries," ICTSD Issue Paper No. 8 (International Centre for Trade and Sustainable Development, April 2009) (skeptical in advance), with S. Basheer, "Turning TRIPs on Its Head: An IP 'Cross Retaliation' Model For Developing Countries," 3 *The Law and Development Rev.* 140 (2010) (more sanguine).

³⁶⁹ Recall that the TRIPs Agreement compels protecting Berne-eligible works and Rome-eligible media productions. See TRIPs, Art. 1(3). However, the criteria of eligibility for protecting such works and productions are met by places of first publication, performance, etc., as well as the nationality of authors, performers, producers, etc. See § 4[2] *supra*. Suppose retaliation only against the United States: Would it allow for not protecting a cinematographic work first published in the United States, but directed by a French national?

³⁷⁰ Compare Summary, United States—Subsidies on Upland Cotton, Dispute DS267 ("On 8 March 2010, Brazil notified the DSB that [. . .] Brazil would suspend [. . .] the application to the United States of certain concessions or obligations under the TRIPs Agreement"), with Office of the United States Trade Representative, "U.S., Brazil Agree on Framework Regarding WTO Cotton Dispute," Press Release, June 17, 2010 ("Today Brazil's Ministers reached a decision [. . .] which would avert the imposition of [. . .] possible countermeasures on intellectual property rights").

¹ For the definition of such cases, see § 1[1] *supra*.

² For the Judgments Project of the Hague Conference on Private International Law, see <https://www.hcch.net/en/projects/legislative-projects/judgments>. For the New York Convention on the Recognition and Enforcement of Foreign Arbitral Awards, see <http://www.newyorkconvention.org/>.

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choice-of-law approaches.³ We shall here touch on jurisdiction over civil suits for cross-border infringement (a) under the codified European approach and (b) under others, notably that of the common law.⁴

[a] The Codified European Approach

Courts of E.U. member states take jurisdiction over most cross-border cases pursuant to the so-called Brussels *Ibis* Regulation.⁵ Courts of specified E.U. and EFTA member states comparably take jurisdiction pursuant to the revised Lugano Convention,⁶ which may be interpreted in the light of decisions applying the Brussels Regulation.⁷ We shall here highlight Brussels provisions relevant in cross-border copyright cases.⁸

To obtain preliminary injunctive relief, a Brussels claimant may apply “to the courts of a Member State for such provisional, including protective, measures as may be available under the law of that Member State, even if the courts of another Member State have jurisdiction as to the substance of the matter.”⁹ Suppose that a course of infringing conduct originates in one E.U. member state but is consummated in another such state, with the defendant located in that latter country or, at the very least, with damages threatened or resulting there. A claimant may petition for an injunction to stop such conduct, for example, in one member state, say, at the source of the conduct, while pursuing the case in chief in another such state. This Brussels provision has to be construed consistently with related provisions that provide more or less binding

³ On accommodating a forum’s remedial procedures to its choice of substantive laws, see § 3[1][b][ii][A] *in fine supra*. For caveats to forum shopping that follow from differing approaches to jurisdictional as well as remedial and conflicts issues, see § 6[1][b][i] *infra*. On presumptive standing to sue for cross-border infringement, see § 6[2][a] *infra*. On chain of title to support such standing, see §§ 6[2][b] and 6[2][c] *infra*.

⁴ *N.b.*, courts are reluctant, as a matter of principle, to take jurisdiction to enforce foreign criminal laws. *See, generally*, J. Crawford, *Brownlie’s Principles of Public International Law*, ch. 21 *passim* (Oxford Univ. Press, 8th ed., 2013) (noting caveats to this principle). *But see, e.g.*, *de Fontbrune v. Wofsy*, 838 F.3d 992 (9th Cir. 2016) (U.S.) (enforcing a foreign court’s quasi-penal award for violating a civil injunctive order, while distinguishing it from a penal sanction issued in a strictly criminal prosecution).

⁵ *I.e.*, Regulation (EU) 1215/2012 of the European Parliament and of the Council of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (recast as Brussels *Ibis*), O.J. 2012 L 351, recodifying, largely effective Jan. 10, 2015, Council Regulation (EC) 44/2001 of 22 December 2000, O.J. 2001 L 12, superseding, largely effective March 1, 2002, the Brussels Convention of 27 September 1968, O.J. 1972 L 29.

⁶ Lugano Convention of 30 October 2007 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, O.J. 2009 L 147, superseding the Lugano Convention of 16 September 1988, O.J. 1988 L 319.

⁷ *See, e.g.*, *IBS Technologies (PVT) Ltd. v. APM Technologies S.A.*, [2003] All ER (Ch. D) 105 (U.K.) (limiting U.K. jurisdiction under the Lugano Convention according to the *Shevill* judgment, which construed Brussels language).

⁸ For non-E.U. approaches to jurisdiction, notably in the common law, see § 6[1][b] *infra*.

⁹ Brussels *Ibis* Regulation (EU) 1215/2012 (recast), Art. 35, O.J. 2012 L 351.

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parameters for eventual relief.¹⁰ Subject to ensuing constraints, any E.U. national court may give effect across much of Europe to preliminary orders.¹¹

Turn to the general Brussels rule: civil suit may be brought against any person “domiciled” in an E.U. member state, “whatever [that person’s] nationality,” in a court of that state.¹² A proviso to this rule allows such suit to be brought in a court of an E.U. state where any one of a number of co-defendants is domiciled for claims “so closely connected that it is expedient to hear and determine them together to avoid the risk of irreconcilable judgments resulting from separate proceedings.”¹³ For example, the E.U. Court of Justice confirmed the jurisdiction of a court to proceed on claims brought against one domestic newspaper and four foreign newspapers for respectively infringing an author’s rights in photographs under similar, but not identical, domestic and foreign copyright laws.¹⁴ Under a special rule, a suit for a tort, including copyright infringement, may be litigated in a given country with regard to damages, or arguably other such bases of relief, that risk arising or do arise there.¹⁵ This rule may apply to claims for royalties payable under a statutory copyright provision: ostensibly these are deemed to recompense harm within the country instituting the provision.¹⁶ Special rules may apply to contractually payable royalties.¹⁷

¹⁰ See, generally, *Van Uden Maritime BV v. Firma Deco-Line*, E.C.J., Nov. 17, 1998, Case C-391/95, [1998] E.C.R. I-07091 (such “granting of provisional or protective measures [. . .] is conditional on, *inter alia*, the existence of a real connecting link between the subject matter of the measures sought and the territorial jurisdiction” where “those measures are sought”). See, e.g., *Solvay SA v. Honeywell Fluorine Products Europe BV*, C.J.E.U., 3rd ch., July 12, 2012, Case C-616/10, paras. 48–51 (holding that provision limiting jurisdiction over patent validity to a court in the state of patent registration need not preclude another court from granting a provisional cross-border injunction if it did not have to rule finally on such validity).

¹¹ See, e.g., *Stichting Brein v. Google Inc.*, No. C/08/492901 / KG ZA 15-1085, Gerechtshof (Court of Appeal) The Hague (Netherlands), Oct. 5 and Nov. 6, 2015, in English trans. in [2016] E.C.D.R. 286 and 299 (ordering “immediately enforceable” discovery “within the European Union” of an online service’s data relevant to infringement claimed in the Netherlands).

¹² Brussels *Ibis* Regulation (EU) 1215/2012 (recast), Art. 4(1), O.J. 2012 L 351. Persons not nationals of a member state where they are domiciled are governed by the rules of jurisdiction applicable to nationals of that state: *id.*, Art. 4(2). Defendants not domiciled in any such state are subject to the jurisdiction of the courts of any such state as governed by that state’s law: *id.*, Art. 6 (cross-referencing conditions in subsequent regulation provisions).

¹³ *Id.*, Art. 8(1).

¹⁴ *Eva-Maria Painer v. Standard Verlags GmbH*, C.J.E.U., 3rd ch., Dec. 1, 2011, Case C-145/10, paras. 80–84, [2011] E.C.D.R. 297.

¹⁵ Brussels *Ibis* Regulation (EU) 1215/2012 (recast), Art. 7(2), O.J. 2012 L 351 (a “person domiciled” in one E.U. member state may be sued “in matters relating to tort, delict or quasi-delict” in another E.U. state “where the harmful event occurred or may occur”).

¹⁶ See, e.g., *Austro-Mechana v. Amazon EU*, C.J.E.U., 1st ch., April 21, 2016, Case C-572/14, paras. 43–53, [2016] E.C.D.R. 375 (favoring jurisdiction in the country where the harm in question would arise from any “unauthorised copy” for which royalties are statutorily payable).

¹⁷ See, e.g., *Falco Privatstiftung and Rabitsch v. Weller-Lindhorst*, E.C.J., April 23, 2009, Case C-533/07, paras. 40 and 54–55, [2009] E.C.R. I-03327 (reasoning that a suit for royalties under a license

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Hence the Brussels rule of thumb: relief is generally more fully available against a defendant in his or her home court and limited if sought elsewhere, notably where damages might be or are incurred. The *Shevill* ruling, in a case of an alleged libel by a French newspaper, allowed a French court, sitting in the E.U. defendant's home country, to exercise "jurisdiction to hear the action for damages for all the harm caused by the unlawful act," whether inside or outside France.¹⁸ But it limited jurisdiction so that any court outside such an E.U. state of domicile may award only damages threatened or suffered in the forum country itself, where "the defamatory publication was distributed," but not elsewhere.¹⁹ However, in its *eDate/Martinez* ruling, the E.U. Court of Justice distinguished a case in which an online disclosure of information was alleged to violate personality rights, such as rights to privacy and to one's good name.²⁰ The E.U. Court allowed jurisdiction for recovering "all of the damage caused" by such disclosure in the state where the victim has "his centre of interests," notably where he or she resides, exercises a profession, etc.²¹ In such cases, it also ruled, jurisdiction may lie in the courts in each of the countries of access, but only for damages respectively incurred in each of these countries.²²

Suits for copyright infringement may go forward on the basis of the *Shevill* ruling. For example, in France, a British author and performer sued non-French parties for copying or making his songs available online without his consent. In this case, the E.U. Court of Justice accepted but limited the French court's jurisdiction to adjudicating damages resulting only in France, without requiring infringing acts at issue to be "directed to" France.²³ Comparably, the E.U. Court admitted jurisdiction in an Austrian court over a suit against a German defendant for damages incurred in Austria as a result of posting photos on a German website without consent or attribution of authorship.²⁴ In a harder case, a German court entertained an action against a French defendant for conveying photographs to a publisher within France, but it could do so only as to damages thus caused in Germany.²⁵

to sell recordings is to be brought in the place of performance of the "characteristic obligation" under the license).

¹⁸ *Shevill v. Presse Alliance SA*, E.C.J., March 7, 1995, Case C-68/93, para. 25, [1995] E.C.R. 415.

¹⁹ *Id.*, para. 31.

²⁰ *eDate Advertising GmbH v. X; Olivier Martinez and Robert Martinez v. MGN Ltd.*, C.J.E.U., Grand ch., Oct. 25, 2011, Joined Cases C-509/09 and C-161/10, [2011] E.C.R. I-10269 (also noted in § 3[1][b][iii][A] *in fine supra*).

²¹ *Id.*, paras. 48–49.

²² *Id.*, para. 51.

²³ *Pinckney v. KDG Mediatech*, C.J.E.U., 4th ch., Oct. 3, 2013, Case C-170/12, paras. 39–45, [2013] E.C.D.R. 393 (mentioning "the principle of territoriality" and "applicable substantive law"). *See also* Assoc. Théâtre Royal c. Sté. Coca-Cola, 1e ch. civ. (France), Oct. 18, 2017, P.I. 2018, 63, obs. Lucas (allowing jurisdiction given risk of damage in France, though the public at large is not addressed).

²⁴ *Pez Hejduk v. EnergieAgentur, NRW GmbH*, C.J.E.U., 4th ch., Jan. 22, 2015, Case C-441/13, paras. 32–37, [2015] E.C.D.R. 191 (noting that jurisdiction need not turn on deliberately or directly addressing the forum jurisdiction: access suffices).

²⁵ *Hi Hotel HCF SARL v. Uwe Spoering*, C.J.E.U., 4th ch., April 3, 2014, Case C-387/12, paras.

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The Brussels regime conditionally facilitates enforcement across the borders of E.U. member states. A court in one such state is obligated to enforce an order or judgment reached in compliance with Brussels provisions in another such country without reviewing the order or judgment on the merits.²⁶ However, this obligation, under Chapter III of the Brussels *Ibis* Regulation, is subject to evolving procedural conditions and exceptions that, as largely developed in the case law, are most notably intended to protect the integrity of judicial processes throughout member states.²⁷

One caveat applies to intellectual property, albeit outside copyright and related rights. Exclusive jurisdiction lies over “proceedings concerned with the registration or validity of patents, trade marks, designs, or other similar rights” in the courts of the E.U. state of “deposit or registration.”²⁸ However, in the Berne Union, copyright arises directly *ex lege* upon the creation of the work in perceptible form, as explained above.²⁹

The Brussels regime follows the civil law in restricting courts’ discretion to dismiss suits. Subject to specific caveats, it rather requires the court initially hearing claims to adjudicate those it finds subject to its jurisdiction.³⁰ In this, E.U. courts differ from common-law courts that, as explained below, may decline to exercise jurisdiction over cross-border suits for reasons such as judicial integrity or efficiency.³¹

37–40, [2014] E.C.D.R. 472. *But see* the *Hi Hotel II* decision, BGH (Germany), Sept. 24, 2014, GRUR Int. 2015, 375 (critiquing factual and legal bases of proof of such causation).

²⁶ *See, e.g.*, Renault SA v. Maxicar SpA & Orazio Formento, E.C.J., May 11, 2000, Case C-38/98, [2000] E.C.R. I-2973, [2000] E.C.D.R. 415 (compelling an Italian court to recognize and enforce the judgment of a French court for infringement of a French right, even though no such Italian right existed).

²⁷ *See, e.g.*, Roche Nederland BV v. Frederick Primus, E.C.J., July 13, 2006, Case C-539/03, paras. 37–38, [2006] E.C.R. I-06535 (seeking to avoid multiplying bases of jurisdiction, undermining legal certainty, and forum shopping). *See also* Denilauler v. Couchet Frères, E.C.J., May 21, 1980, Case 125/79, [1980] E.C.R. 1553 (holding that preliminary orders are enforceable subject to conditions such as giving due notice to parties).

²⁸ Brussels *Ibis* Regulation (EU) 1215/2012 (recast), Art. 24(4), O.J. 2012 L 351. *See, e.g.*, Gesellschaft für Antriebstechnik mbH & Co. KG (GAT) v. Lamellen und Kupplungsbau Beteiligungs KG (Luk), E.C.J., July 13, 2006, Case C-4/03, [2006] E.C.R. I-6509 (not allowing jurisdiction in a German court to adjudicate the validity of French patents). *See also* M. Trimble, “GAT, Solvay, and the Centralization of Patent Litigation in Europe,” 26 *Emory International L. Rev.* 515 (2012) (analyzing the impact of subsequent case law on this limitation of jurisdiction).

²⁹ *See* § 5[3][a] *supra*. *But see* § 4[1][c][i][A] *supra* (noting that copyright may at times give way to design rights conditioned on deposit or registration).

³⁰ *See* Brussels *Ibis* Regulation (EU) 1215/2012 (recast), Arts. 27–31, O.J. 2012 L 351. *But see, e.g., id.*, Art. 31(2) (calling for a stay of any so-called torpedo action filed first in one court to preclude any action from being more appropriately adjudicated in a forum contractually chosen by the parties).

³¹ *See* § 6[1][b][ii] *infra*. *See, e.g.*, Owusu v. N.B. Jackson, E.C.J., March 1, 2005, Case C-281/02, paras. 41–46, [2005] E.C.R. I-1383 (to preserve “legal certainty” and protection of E.U. nationals, precluding discretion, for reasons of *forum non conveniens*, to decline taking a case brought in a U.K. court against U.K. and Jamaican parties).

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[b] Other Approaches; the Common Law

We just saw the Brussels *Ibis* Regulation codify jurisdictional rules for cross-border cases brought to courts of E.U. member states.³² The common law rather allows any court discretion, notably on grounds of *forum non conveniens*, either to stay such an action or to dismiss it. In the light of varying forum laws on jurisdiction, we shall here touch (i) on some caveats for forum shopping and (ii) on common-law discretion in exercising or declining jurisdiction.³³

[i] Some Caveats for Forum Shopping

Counsel, shopping for a forum in a cross-border case, would do well to ask: At the threshold, would a court take jurisdiction over the suit to be brought? Assuming so, how would it choose among conflicting laws to govern issues likely to arise? Also, what forum procedures, say, for gathering and weighing evidence, for tailoring remedies, even for joining civil and criminal actions, etc., could influence outcomes? Looking beyond judgment, a plaintiff could also seek a court that would best enforce remedies it obtained. Suppose, for example, that a defendant resides, is headquartered, or has assets in the forum country. An injunction could be easily policed, or a monetary award readily collected, there. Otherwise, it should be asked whether relief granted there could be enforced elsewhere. Hence the following caveats to forum shopping.³⁴

Nothing ought to be taken for granted about how a court will act in a cross-border copyright case.³⁵ Even courts in E.U. member states, empowered to issue orders enforceable by courts in other such states, may be reluctant to impose remedies on their own for transactions that consummate abroad.³⁶ Nonetheless, the U.K. Supreme Court did find foreign claims justiciable in the United Kingdom, specifically those for copyright infringement taking place outside the European Union, namely in the United States under U.S. law.³⁷ The court concluded that neither E.U. instruments nor

³² See § 6[1][a] *supra*.

³³ *N.b.* most civil-law jurisdictions follow codified approaches that constrain judicial discretion. For another example besides the E.U. approach, see T. Kono, "Recent Judgments in Japan on Intellectual Property Rights, Conflict of Laws and International Jurisdiction," in J. Drexler and A. Kur (eds.), *Intellectual Property and Private International Law—Heading for the Future*, 229 (Hart, 2005).

³⁴ For further analysis, see P.E. Geller, "How to Practice Copyright Law Internationally in Perplexing Times?," 60 *J. Copr. Soc'y* 167, 196–199 (2013).

³⁵ For a systematic but critical analysis, see B. Ubertazzi, "Intellectual Property Rights and Exclusive (Subject Matter) Jurisdiction: Between Private and Public International Law," 15 *Marquette Intellectual Property L. Rev.* 357 (2011); also her *Exclusive Jurisdiction in Intellectual Property* (Mohr Siebeck, 2012).

³⁶ See, generally, § 6[1][a] *supra* (outlining orders to be enforced in other E.U. member states). See, e.g., Cass. civ., sez. I (Italy), May 29, 2015, No. 11225, *Massimario del Foro Italiano* 2015, 351 (confirming an Italian court's refusal to enjoin infringement abroad, but noting possible recourse to instruments such as the Brussels Regulation allowing for judicial enforcement and oversight abroad).

³⁷ *Lucasfilm v. Ainsworth*, [2011] UKSC 39, paras. 105–110, [2011] E.C.D.R. 473 (allowing a U.K. court to hear claims against a U.K. author for infringing U.S. copyright by selling, in the United States, Star-Wars paraphernalia the author had designed and in which he had transferred copyright to claimants).

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underlying policies precluded taking jurisdiction in the case.³⁸ Other U.K. courts have also shown themselves ready to apply foreign laws to such cases and to tailor remedies accordingly.³⁹ In other fora that look to the British tradition, jurisdictional criteria are developing in this sense as well.⁴⁰

Federal systems may vary in allocating jurisdiction among federal and provincial or state courts. For example, criteria for jurisdiction differ in Canadian and U.S. courts, not only from those codified for E.U. Courts, but from one neighboring federal system to the other. A Canadian court, assuming that jurisdictional requisites are satisfied, notably relative to the parties to a suit, may provide relief in a cross-border case that displays “a real and substantial connection” to Canada as the forum territory.⁴¹ Courts in the United States have personal jurisdiction over defendants from other states or foreign countries who, if properly served, have contacts with the forum territory that are sufficient under constitutional and statutory criteria.⁴² U.S. federal courts may have subject-matter jurisdiction, *inter alia*, given adverse parties of diverse citizenship who are otherwise subject to their personal jurisdiction or over actions arising under federal legislation like the U.S. Copyright Act⁴³ or, arguably, under U.S. treaties.⁴⁴

³⁸ *Id.*, paras. 53–109 *passim*.

³⁹ *See, e.g.*, Sony/ATV Music Publishing LLC v. WPMC Ltd., [2015] EWHC 1853 (Ch), paras. 2 and 96–124 *passim* (considering, but rejecting, the U.S. defense of fair use in a case of U.S. infringement); Griggs Group Ltd. v. Evans (No. 2), [2004] EWHC 1088 (Ch), paras. 68–83 *passim*, 140–141 (given foreign laws, holding it consistent with comity to impose an equitable assignment of copyrights worldwide), *affirmed*, Griggs Group v. Raben Footwear, [2005] EWCA Civ 11 (discussed in § 6[2][c][ii] *infra*).

⁴⁰ *See, generally*, R. Garnett, “Enhanced Enforcement of IP Rights in Transnational Cases in Australia,” 27 *Australian Intellectual Property J.* 114 (2017) (reviewing such approaches). *See, e.g.*, Gulf DTH LLC v. Dish TV India Ltd., Aug. 30, 2016, CS (OS) 3355/2015, para. 57 (Delhi High Court (India), at lobis.nic.in/ddir/dhc/SMD/judgement/05-09-2016/SMD30082016S33552015.pdf (exercising jurisdiction over Indian defendant for transactions in other Asian as well as African countries) (relief upheld on appeal noted in § 3[1][b][iii][B] *supra*); KK Sony Computer Entertainment v. Van Veen, (2006) 71 *Intellectual Property Reports* 179 (High Court (New Zealand) (taking jurisdiction over claims under local, Hong Kong, and U.K. copyright laws, with New Zealand defendant served at home).

⁴¹ *See, e.g.*, Research in Motion Limited v. Atari Inc., 2007 CanLII 33987, paras. 33–35 (Ont. S.C.) (evoking this criterion, while hearing claims with extraterritorial reach, some possibly subject to U.S. law). *See also* Equustek Solutions Inc. v. Google Inc., 2015 BCCA 265, para. 41, *affirmed*, 2017 SCC 34 (allowing jurisdiction in Canada to issue a provisional order against third party with cross-border effects, given risks of infringement in Canada). *But see* § 6[1][b][i] *in fine infra* (noting that other courts may refuse to enforce such far-reaching relief if they find it contrary to international or home policy or law).

⁴² *But see, e.g.*, Triple Up Ltd. v. Youku Tudou Inc., 235 F. Supp. 3d 15 (D.D.C. 2017) (U.S.) (declining to exercise personal jurisdiction over website operator for copyright infringement where it was accessible in the United States, but in Chinese, with uneven geoblocking, and without significant “effects” in U.S. market). *But see* § 5[4][a][i][B] *supra* (noting that E.U. law precludes some geoblocking).

⁴³ *Compare* 28 U.S.C. § 1332 (diversity), with 28 U.S.C. § 1338(a) (U.S. copyright). *See, e.g.*, Rundquist v. Vapiano SE, 798 F. Supp. 2d 102, 129–133 (2011) (D.D.C. 2011) (U.S.) (given claims for U.S. infringement, exercising “supplemental subject matter jurisdiction” over claims for infringement abroad); Armstrong v. Virgin Records, Ltd., 91 F. Supp. 2d 628, 630–638 (S.D.N.Y. 2000) (U.S.)

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Assume arguable jurisdiction in more than one court. To shop fora effectively, counsel does well to canvass laws to be invoked, and specify relief sought, in some detail. Only then can judicial proclivities be specifically appraised with an eye to the outcomes contemplated and feasible in suit. It is accordingly crucial to ask, as already outlined above for cross-border copyright cases: What approach might a court follow in dealing with conflicts of laws?⁴⁵ Each court will tend to apply what it characterizes as its own “procedural” law: for example, U.S. courts may issue far-reaching discovery orders and impose high monetary awards, especially in jury trials.⁴⁶ To put this inquiry more broadly, counsel has to take account of how conflicts of laws in theory may have different resolutions in practice in the light of any given court’s repertory of procedures and remedies.⁴⁷

What need and chances for execution of one jurisdiction’s injunctive order within another? The ease or difficulties of such enforcement tend to differ case by case, often because the place where an act is most effectively stopped, or assets seized, is not within the obvious reach of the court.⁴⁸ Legal bases for an order, or defenses to it, may nominally differ as well: nonetheless, in easy cases, with comity or equities favoring judicial cooperation, a claimant may persuade a court to recharacterize, in functionally common terms, such bases as justify enforcing relief ordered from abroad.⁴⁹ But in hard cases, where local appreciations of overriding law or policy differ, foreign orders may be refused effect, if not countermanded.⁵⁰

(holding that a claim of U.S. infringement allowed “pendent jurisdiction over claims arising under foreign law,” while noting diversity among the parties).

⁴⁴ See 28 U.S.C. § 1331. The case law does not confirm that a case of copyright infringement abroad is subject to federal jurisdiction just because it involves claims arising under a U.S. treaty, though federal concerns arise in construing such treaties. See, e.g., *De Bardossy v. Puski*, 763 F. Supp. 1239, 1245–1246 (S.D.N.Y. 1991) (U.S.) (declining to take the case, given failure to plead the jurisdictional provision and to argue federal concerns).

⁴⁵ See § 3[1] *supra*.

⁴⁶ Compare G. Sant, “Court-Ordered Law Breaking: U.S. Courts Increasingly Order the Violation of Foreign Law,” 81 *Brooklyn Law Review* 181 (2015) (critiquing U.S. orders to compel foreign disclosure of information), with P. Samuelson, P. Hill, and T. Wheatland, “Statutory Damages: A Rarity in Copyright Laws Internationally, But for How Long?,” 60 *J. Copr. Soc’y* 529 (2013) (highlighting comparatively high U.S. civil awards), and M. Trimble, “Punitive Damages in Copyright Infringement Actions under the US Copyright Act,” [2009] *E.I.P.R.* 108 (analyzing punitive effects of such awards).

⁴⁷ On accommodating forum remedial procedures to the choice of substantive laws, see § 3[1][b][ii][A] *in fine supra*. For further analysis, see O. Elias, *Judicial Remedies in the Conflict of Laws*, chs. 1–6 *passim* (Hart, 2001).

⁴⁸ *N.b.* this reach has to be both legal, as across federated jurisdictions, and factual, as in the difference between targeting large companies, like online-service providers, versus scattered individuals, like file-sharers.

⁴⁹ See, e.g., *de Fontbrune v. Wofsy*, 838 F.3d 992 (9th Cir. 2016) (imposing a nominally criminal fine for the violation of an injunction under French law, likening it to a civil contempt order under U.S. law, while allowing expert declarations on foreign law).

⁵⁰ See, e.g., *Google LLC v. Equustek Solutions Inc.*, No. 5:17-cv-04207-EJD (N.D. Cal., San Jose, Nov. 2, 2017) (enjoining the enforcement of a Canadian order calling on a U.S. internet service to delist

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Turn to the enforcement of monetary awards like damages or profit shares. U.S. law, itself providing for statutory damages in copyright cases, quite uniquely may have lay juries assess awards that might appear excessive from foreign perspectives.⁵¹ The European Court of Human Rights has admitted that a monetary award or sanction in a copyright case could be disallowed if it threatened “freedom of expression” by exceeding some level this court did not fully specify.⁵² For that reason or others likely to be of a more equitable nature, an exceedingly advantageous money judgment could prove unenforceable in many jurisdictions.⁵³

[ii] Declining Jurisdiction as Inconvenient

Under the common law, a court may, in its discretion, decline to exercise jurisdiction. It may do so in refusing to adjudicate a cross-border case as a whole or, more specifically, to issue a particular order with effects abroad.⁵⁴ The court, finding itself an “inconvenient forum” for taking the case altogether, may dismiss it or else stay the action pending the outcome of another case with the same parties and cause in a more “convenient” forum.⁵⁵ Consider, for example, a U.S. case where a U.K. plaintiff sued in a U.S. court for copyright infringement taking place in Latin America: the U.S. defendant moved to dismiss for *forum non conveniens*, but the court rejected any suggestion that it could not make adequate inquiry into possibly applicable foreign copyright laws.⁵⁶ Effectively, the ease or difficulty of ascertaining foreign copyright laws with sufficient precision to rule soundly in any given case could vary, depending on the specific issues raised in the case.⁵⁷ Indeed, only after getting some taste of the

certain search results globally, while invoking U.S. law that privileged the provision of such data).

⁵¹ See, e.g., *Lucasfilm v. Ainsworth*, [2009] EWCA Civ 1328, para. 9 (U.K.) (noting: “Lucasfilm has obtained a default judgment for trade mark and copyright infringement in California against him in the sum of US \$20m. That sum sounds strange to English ears given that he only sold about US\$ 14,500 worth.”), *affirmed and reversed in part*, [2011] UKSC 39.

⁵² *Ashby Donald c. France*, ECtHR, 5th sect., Jan. 10, 2013, App. 36769/08, paras. 26–29, [2013] E.C.H.R. 287. For a comparative analysis, see M. Trimble, “Public Policy Exception to Recognition and Enforcement of Judgments in Cases of Copyright Infringement,” 40 I.I.C. 642 (2009).

⁵³ See, e.g., *Schlenzka & Langhorne c. Fountaine Pajot S.A.*, Cass., 1e ch. civ. (France), Dec. 1, 2010, Bull. civ. 2010 I, no. 248 (allowing lower court’s refusal to enforce a U.S. punitive award found to be disproportionate relative to actual damages for contractual breach and product defects).

⁵⁴ See, generally, N. Park, “Equity Extraterritoriality,” 28 *Duke J. Comparative & International Law* 99, 162–179 *passim* (2017) (analyzing parallel and distinct considerations in declining such a suit and in limiting relief effective abroad in cross-border cases).

⁵⁵ Compare *Dr. Sade v. Prof. Schamai*, C.A. 11416-09-10 (Tel-Aviv, District) (Israel) (unreported, 2013) (confirming Israeli forum as inconvenient where the author of the article at issue resided in the United States and the article was published there), with *TS Production LLC v. Drew Pictures Pty. Ltd.*, [2008] FCAFC 194 (Australia) (admitting parallel Australian and U.S. suits and staying that in its own forum, pending determination of who held U.S. and Australia copyrights, respectively, in the same work).

⁵⁶ *London Film Productions Ltd. v. Intercontinental Communications, Inc.*, 580 F. Supp. 47, 49–50 (S.D.N.Y. 1984).

⁵⁷ See, e.g., *World Film Services, Inc. v. RAI Radiotelevisione Italiana S.p.A.*, 50 U.S.P.Q. 2d 1187 (S.D.N.Y. 1999) (U.S.) (refusing to dismiss claims that “arise under both U.S. and Italian intellectual

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laws possibly applicable to the case at bar can the court determine whether any of these laws would resist sure-handed or fair application.⁵⁸

A court may reject a motion to dismiss for *forum non conveniens* if there is no adequate alternative forum in which to bring suit. If there is any plausible alternative forum, a U.S. court must then weigh private and public interests at stake in its exercising jurisdiction or not.⁵⁹ For example, the interests in judicial integrity and efficiency mitigate against allowing a multiplicity of suits: in particular, a single court, on the spot where defendant's conduct is most focused, might better hear and try claims and coordinate relief for cross-border infringement than could different courts, each facing territorially isolated acts of infringement. Nevertheless, U.S. courts have declined to exercise jurisdiction over claims of infringement that allegedly crossed borders: not only were foreign courts found to be adequate alternative fora, but they were also conveniently situated to adjudicate and enforce pertinent claims.⁶⁰ However, where suit is brought for infringement only of locally effective rights, there may be a judicial tendency to favor pursuing it in a local forum.⁶¹

As already explained, a court grants relief following its own procedures, but optimally to effectuate substantive rights vindicated in a case.⁶² Often, the adequacy of a forum in a case of cross-border infringement may, in the final analysis, turn on the adequacy of the remedies that it can provide. A court may easily enforce relief against a party in the forum country if that is where the party is headquartered and mainly does business.⁶³ By the same token, a court may refrain from exercising jurisdiction where

property law," while noting that "[t]here is no reason to believe that this Court will be unable to apply Italian copyright law as necessary").

⁵⁸ What is a court to do when it is faced with a petition for a preliminary injunction on short notice, without time to review exotic laws? For proposals, see § 3[1][b][ii][B] *supra*.

⁵⁹ *See, e.g.*, *Byrne v. BBC*, 132 F. Supp. 2d 229, 237–238 (S.D.N.Y. 2001) (refusing to dismiss where the moving party failed to show balance of factors in support); *Boosey & Hawkes Music Publishers, Ltd. v. Walt Disney Co.*, 145 F.3d 481, 492 (2d Cir. 1998) (vacating dismissal upon failure to consider any alternative forum, while outlining interests at stake in favor of jurisdiction, such as location of evidence and witnesses, convenience of trying all issues in one proceeding, and readiness to proceed to trial).

⁶⁰ *See, e.g.*, *Wallert v. Atlan*, 141 F. Supp. 3d 258, 280–282 (S.D.N.Y. 2015) (dismissing action for copyright infringements abroad, *inter alia*, given alternative French forum with access to evidence and difficulties of enforcing any eventual judgment abroad); *Televisa, S.A. v. Koch Lorber Films*, 382 F. Supp. 2d 631, 634 (S.D.N.Y. 2005) (staying U.S. suit for infringement when proceedings on "the essential dispute," namely over "the ownership" of rights in Buñuel films, could be properly resolved in a concurrent suit in France, where "significant parties, evidence, witnesses" were located).

⁶¹ *See, e.g.*, *Halo Creative & Design Ltd. v. Comptoir Des Indes, Inc.*, 816 F.3d 1366 (Fed. Cir. 2016) (U.S.) (finding abuse of discretion in the dismissal of a U.S. suit on U.S. copyright and other rights just because defendants resided in Canada, given no showing of redress available in Canada nor of any infringement taking place there).

⁶² *See* §§ 3[1][b][ii][A] and 5[4][b][ii] *supra*.

⁶³ *See, e.g.*, *London Film Productions Ltd. v. Intercontinental Communications, Inc.*, 580 F. Supp. 47, 50 (S.D.N.Y. 1984) (U.S.) (reasoning that allowing actions before either South American or British courts "would raise questions [. . .] regarding the enforceability of a resulting judgment" against the New York defendant).

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the case primarily calls for an injunction requiring on-the-spot oversight in a foreign country.⁶⁴ Considerations of comity may mitigate against enjoining an action abroad, especially if it is not much the same action as that already subject to home jurisdiction.⁶⁵ Comity may, but need not, prompt a court to enforce a foreign judgment.⁶⁶

[2] Who has Standing to Sue? Chain of Title Worldwide?

A claimant must have standing to sue or else prove chain of title to rights sued upon. The “anchors” for any chain of title to copyrights or related rights, as it stretches worldwide, are authors or other parties vested with rights; “links” in such a chain are forged by transfers of rights. The following questions have to be disentangled at such junctures: (a) Who may have standing to sue? (b) In whom do rights initially vest? (c) How are rights transferred by law? Only then shall we ask: How may copyright or related rights be transferred by contract?⁶⁷

[a] From Presumptive Standing to Proof of Entitlement

In easy cases, authors may sue on copyrights respectively vested in them, or performers or media producers on their related rights, if they have not already transferred the rights sued upon.⁶⁸ To proceed in hard cross-border cases, parties to a suit need to assert domestic and often foreign laws that risk entering into conflicts with regard to such vesting and transfer.⁶⁹ At the threshold of such cases, claimants may find it expeditious to show mere standing to sue on the rights in question, pending proof of chain of title to these rights. Indeed, in a cross-border case, standing is less likely to be subject to any complex conflict of laws than is chain of title, for the simple reason that fewer laws may come into play on point.⁷⁰

⁶⁴ See, e.g., *Zenger-Miller, Inc. v. Training Team, GmbH*, 757 F. Supp. 1062, 1071 (N.D. Cal. 1991) (U.S.) (“Lastly, an injunction issued by a German court would be more effective than one issued by this court, since a German court would be able to exercise its supervisory power with respect to conduct within its geographical reach.”).

⁶⁵ See, e.g., *TS Production LLC v. Drew Pictures Pty. Ltd.*, [2008] FCAFC 194 (Australia) (declining to restrain parties from pursuing U.S. action on common underlying facts); *Computer Assocs. Int’l v. Altai, Inc.*, 126 F.3d 365, 371–372 (2d Cir. 1997) (U.S.) (confirming refusal to enjoin suit on French copyright in France after suit on U.S. copyright in U.S. was not successful).

⁶⁶ See, e.g., *Louis Feraud Internat’l v. Viewfinder*, 489 F.3d 474 (2d Cir. 2007) (U.S.) (remanding for more precise determinations of whether, and on what grounds, the French judgments at issue should be denied enforcement in the U.S. as repugnant to U.S. policy).

⁶⁷ See § 6[3] *infra*.

⁶⁸ On first vesting, see § 6[2][b][i] *infra*.

⁶⁹ See, e.g., *Scotch & Soda B.V. v. Esprit Europe B.V.*, No. C/09/510096 / HA ZA 16-500, *Rechtbank* (District Court) The Hague (Netherlands), July 12, 2017 (refusing to issue an injunction effective in E.U. member states insofar as claimant failed to show that it held copyrights for these states).

⁷⁰ *N.b.* some courts conflate standing with chain of title. See, e.g., *Itar-Tass Russian News Agency v. Russian Kurier, Inc.*, 153 F.3d 82 (2d Cir. 1998) (U.S.) (not allowing a suit for infringement of U.S. copyright in a Russian newspaper once, under a convoluted conflicts analysis, proof of ownership of copyright became difficult) (discussed in § 6[2][b][i] *infra*).

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Let us outline how to show such standing as may be triggered under the following types of laws:

- *Treaty provisions:* Article 15 of the Berne Convention, as explained above, allows for notices that trigger presumptions of standing to bring infringement suits.⁷¹ Other Berne provisions, as indicated below, apply the law of the protecting country to designate who may presumptively exercise economic rights in cinematographic works, that is, audiovisual works, or moral rights after an author's death.⁷²
- *National laws:* Some domestic laws implement or even amplify upon treaty-based presumptions of standing by providing for comparable presumptions that arise out of notices, pleadings, or registrations.⁷³ Laws vary on whether, beyond any initial vestee, only assignees or, as well, exclusive licensees may sue for infringement.⁷⁴
- *Judicial rulings:* Some courts may expand upon treaty or statutory notices, notably to allow claimants publicly marketing works under their own names, without challenge over time, to assert standing against infringers.⁷⁵ Otherwise, they may require claimants to show chain of title qualifying them to proceed under national laws.⁷⁶

It seems myopic to argue that standing, at least in cross-border copyright cases, raises purely procedural issues, subject only to forum law.⁷⁷ We just outlined

⁷¹ See § 5[3][b] *supra*.

⁷² See, respectively, §§ 6[2][b][ii] and 6[3][b][iii] *in fine infra* (Berne Art. 14*bis* on chain of title in cinematographic works), and § 6[2][c][i] *infra* (Berne Art. 6*bis*(2) on the exercise of moral rights after an author's death).

⁷³ Compare OLG Frankfurt (Germany), Aug. 22, 2017, ZUM-RD 2017, 651 (applying a statutory presumption to assure only procedural rights of an exclusive licensee named in publicly marketing copies), and *Tolkien Estate Limited v. Saltalamacchia*, [2016] FCA 944, paras. 4 and 8 (Australia) (accepting, on the basis of statutory presumptions, a dead foreign author's estate as claimant), with *Circle Film Enterprises, Inc. v. Can. Broadcasting Corp.*, [1959] Supreme Court of Canada Reports 602 (holding that a domestic copyright certificate raises a presumption of entitlement).

⁷⁴ For further analysis, see J. de Werra, "Can Exclusive Licensees Sue for Infringement of Licensed IP Rights? A Case Study Confirming the Need to Create Global IP Licensing Rules," 30 *Harvard J. Law & Technology* 189 (2017).

⁷⁵ See, e.g., *Emilio Pucci c. H&M Hennes & Mauritz, CA Paris*, 5e ple.: 2e ch. (France), Dec. 4, 2015, P.I. 2016, 235, note A. Lucas (presuming that an Italian corporation, consistently marketing a work in France in its own name, had standing to sue for infringement there); *Sté. Charly Acquisitions Ltd. c. M. Gerd X*, Cass., 1e ch. civ., Nov. 14, 2012, no. 11–15.656, *Dalloz* 2013, 402 (extending presumption to neighboring rights).

⁷⁶ See, e.g., *Sad Najwyzszy* (Supreme Court) (Poland), Sept. 15, 2011, CSK 572/10, unpublished (requiring claimants to show the vesting of rights pursuant to Polish law, as well as their subsequent acquisition of these rights).

⁷⁷ See, generally, § 3[1][b][ii][A] *supra* (mooting the conundrum of procedure versus substance in conflicts analysis); also § 5[4][b][ii] *supra* (analyzing the scope of national treatment with regard to ostensibly procedural rules).

presumptions of standing that facilitate bringing a judicial action, notably to have the illicit release of protected contents enjoined at the start of suit. Such prompt relief protects copyright and related rights substantively: accordingly, as explained above, the rules supporting it apply within the laws of protecting countries.⁷⁸ A court may refer to the copyright law of the forum jurisdiction for a rule of standing to sue on copyright where infringement is alleged to take place within its own jurisdiction.⁷⁹ In any event, if the laws invoked as applicable to issues of standing or of entitlement lead to much the same result in a given case, there may be no true conflict of laws to address.⁸⁰ To rebut any presumption of standing, a party may attack claimant's chain of title to the rights it asserts.⁸¹

In no event does standing to sue for monetary relief suffice to entitle a party to pocket monetary awards. The Berne Convention speaks of according a publisher standing to "represent" an unnamed author, suggesting that the publisher may take monetary awards only in trust for that author.⁸² To take another example, national law sometimes authorizes a collective-management organization to sue for royalties, but the organization does not necessarily thus acquire any authorization to dispose of these royalties at will.⁸³ Indeed, the treaty principle of national treatment has been held to preclude authorizing a domestic collective-management organization from using foreign claimants' royalties for the benefit of domestic members.⁸⁴

⁷⁸ See, generally, § 3[1][a][i] *supra* (reasoning that the Berne-plus treaty regime entails this choice-of-law approach). See, e.g., W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 118–119 (Berne Art. 15, Rem. 1) (Werner-Verlag, 1977) (arguing that the Berne minimum right of standing, though dubbed "procedural," may trump forum law imposing a heavier burden of proof).

⁷⁹ See, e.g., the *Scientology* decision, Rechtbank (District Court) The Hague (Netherlands), June 9, 1999, AMI 1999/7, 110, note Koelman, in English trans. in [2000] E.C.D.R. 83 (holding that, while U.S. law governed a copyright license made in the United States, Dutch law governed standing to sue for infringement of Dutch copyright); the *Alf* decision, BGH (Germany), June 17, 1992, GRUR 1992, 697, in English trans. in 24 I.I.C. 539 (1993) (holding that, though U.S. law may govern the license at issue, German law empowered an exclusive licensee to sue for infringement of German copyright).

⁸⁰ On true and false conflicts of laws, see § 1[3][c] *in fine supra*.

⁸¹ For analysis of such chain of title, see §§ 6[2] and 6[3] *infra*.

⁸² See Berne, Art. 15(3). The publisher may, of course, prove its contractual entitlement to what were originally an author's rights, for example, to receive a monetary award. See W. Nordemann, K. Vinck, and P. Hertin, *Internationales Urheberrecht und Leistungsschutzrecht: Kommentar*, 120 (Berne Art. 15, Rem. 5) (Werner-Verlag, 1977).

⁸³ See, generally, A. Strowel, "The European 'Extended Collective Licensing' Model," 34 *Columbia J. Law & Arts* 665 (2011) (raising the problem of distributing royalties, collected by local management organizations, to foreign claimants). See, e.g., the *Verlegeranteil* (Publishers' Share) decision, BGH (Germany), April 21, 2016, GRUR 2016, 596, in English trans. in 48 I.I.C. 98 (2017) (not allowing such an organization to divert royalties from authors to publishers).

⁸⁴ The *GEMA/Austro-Mechana* decision, Oberster Gerichtshof (Supreme Court) (Austria), July 14, 1987, GRUR Int. 1988, 365 (also discussed in § 3[4][b][ii] *supra*).

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[b] Anchoring Chain of Title in the Initial Vestee of Rights

It is often easy to anchor the chain of title to copyright or related rights worldwide. In all countries, copyrights typically arise in authors, and related rights in performers or producers. In some hard cases, some laws may define terms like “author” to refer to parties other than actual creators. True conflicts of laws may then arise, and courts occasionally take distinct choice-of-law approaches on point. We shall here consider (i) initial vesting in cases generally and (ii) managing conflicts in hard cases specifically.

[i] The Problem of Determining the Initial Vestee

To keep our bearings, let us unpack the general rule: A copyright vests in the flesh-and-blood author of what this right protects in a given work. A neighboring right vests in the artist delivering a performance live; some other related right vests in the producer of the recording, broadcast, etc., it makes.⁸⁵ Only in exceptional cases, where such vesting rules differ from country to country, can any conflict of laws arise with regard to the first holder of copyright or of any related right at the start of any chain of title worldwide. Analytically, this issue of determining any initial vestee of rights is distinct from that of defining “authors” or others satisfying eligibility criteria for protection.⁸⁶ After outlining theoretical options for choosing laws to determine initial vestees of copyright or related rights, we shall essay practical solutions in hard cases.⁸⁷

The case law, more often than not, determines initial vestees by the laws of protecting countries.⁸⁸ Anglo-American precedents followed this default approach, for example, applying U.S. or Canadian law to define “author” for purposes of protection in the United States or Canada.⁸⁹ However, in the *Itar-Tass* case, a leading U.S. court applied the law of some “source” country of the work at issue to find the initial “owner” of copyright.⁹⁰ European case law is more settled: for example, after some vacillation, French decisions now tend to apply the law of the protecting country, normally France in the cases at bar, for determining the initial vestees of authors’ rights

⁸⁵ See, generally, J. Blomqvist, *Primer on International Copyright and Related Rights*, 101–105 (Edward Elgar, 2014) (explaining definitions of such holders of neighboring rights under Rome, Art. 3, and sequel treaties).

⁸⁶ On defining the “author” for purposes of applying eligibility criteria, see § 4[2][a][iii] *supra*.

⁸⁷ See § 6[2][b][ii] *infra*.

⁸⁸ *I.e.*, the law effective where relief sought would take effect against infringement. See § 3[1] *supra*.

⁸⁹ Compare *Autoskill, Inc. v. Nat’l Educ. Support Sys., Inc.*, 994 F.2d 1476, 1487–1490 (10th Cir. 1993) (U.S.) (applying U.S. law in favor of a Canadian corporation as to the authorship of a work for hire), with *Setana Sport Limited v. 2049630 Ontario Inc. (Verde Minho Tapas & Lounge)*, 2007 FC 899 (Canada) (finding no showing, pursuant to Canadian law, of any author entitled to sue).

⁹⁰ *Itar-Tass Russian News Agency v. Russian Kurier, Inc.*, 153 F.3d 82, 89–94 (2d Cir. 1998) (applying Russian law to the issue of ownership of a Russian work in a case of U.S. infringement). *But see, e.g.*, *Heriot v. Byrne*, 2008 U.S. Dist. LEXIS 60600, at *17 (N.D. Ill., July 21, 2008) (U.S.) (questioning the *Itar-Tass* “choice of law test” at least “with respect to cinematographic works,” given a Berne provision on point).

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and of performers' neighboring rights.⁹¹ Most notably, in the *Huston* case, where French law applied to protect the moral rights of a U.S. film director and of a U.S. screenwriter, French law defined these film contributors as authors vested with moral rights.⁹² German courts have consistently applied the law of Germany, as the protecting country, to the initial ownership of German rights.⁹³

As just noted, these choice-of-law approaches come into play only in hard cases. Let us scope out the problem these raise, however exceptionally: ultimately that of anchoring chain of title worldwide. To start, before resolving any conflict of laws, a court would have to disentangle complex factual and legal issues, for example, in identifying authors in a creative team or the principal in a complex agency relation.⁹⁴ Further, its overall solution would optimally allocate rights consistently with any underlying consensus or course of dealing that such parties have formed or followed, whether in one country or a number of them.⁹⁵ Finally, in its decision, it would best avoid troubling the default rule, reliably determining flesh-and-blood authors and performers initially vested with rights in most cases.⁹⁶

[ii] Hard Cases: Joint, Team, and Employees' Works

Turn to the hard cases of vesting rights, susceptible to conflicts of laws. Such cases tend to arise when any work or related production is made by more than one person, or when it originates in creators subject to principals, like employers. It will here be argued that, however "author" or any other initial vestee is defined in theory, it is often possible to anchor chain of title consistently across borders in practice. To focus on the hard cases, consider the following key examples of how rights first vest differently from country to country in the following classes of works:

- *Joint or collaborative works:* In principle, rights initially vest in the coauthors of a joint work. But different laws may apply diverse criteria of joint works,

⁹¹ See, e.g., *Moussus c. ABC News Intercontinental Inc.*, Cass., 1e ch. civ. (France), April 10, 2013, RIDA 2013, no. 238, 409, in English trans. in 44 I.I.C. 856 (2013) (invoking Berne national treatment and applying the law of the protecting country, here of France, to determine the flesh-and-blood creator, even if an employee, as the author in whom rights vest); *Henry c. Culture Press*, Cass., 1e ch. civ. (France), June 19, 2013, RIDA 2013, no. 238, 415, in English trans in [2014] E.C.D.R. 116 (on the basis of Rome national treatment, applying French law to confirm live performers as initial vestees of neighboring rights in their performances as recorded).

⁹² The *Asphalt Jungle* decision, *Huston c. Turner Entertainment*, Cass., 1e ch. civ. May 28, 1991, RIDA 1991, no. 149, 197, in English trans. in 23 I.I.C. 702 (1992), followed on remand, CA Versailles, chs. réunies, Dec. 19, 1994, RIDA 1995, no. 164, 389 (also discussed §§ 3[2][b] and 4[2][a][ii] *supra*).

⁹³ See, e.g., the *Spielbankaffaire* decision, BGH, Oct. 2, 1997, GRUR 1999, 152, in English trans. in 30 I.I.C. 227 (1999) (holding that the law of the protecting country determines authors and, thus, the initial vestees of rights).

⁹⁴ *I.e.*, we have a problem of *dépeçage* here. See, generally, § 1[3][c] *supra* (on such issue analysis to defuse conflicts of laws). See, e.g., § 3[1][a][ii] *supra* (in infringement cases); § 4[2][a][ii] *supra* (to define "author" for different purposes); § 6[2][c] *infra* (transfers by law); § 6[3] *infra* (transfers by contract).

⁹⁵ On this *desideratum* for resolving conflicts of copyright and contract laws, see § 6[3][c][i] *infra*.

⁹⁶ On this rule, see § 4[2][a][ii] *supra*.

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with coauthors on occasion differently identified. Some criteria focus on the final work itself, asking whether materials that authors contributed to it have become sufficiently interdependent, say, as exploitable only in one work.⁹⁷ Other laws focus on the process by which the work was created, for example, in the authors' creative collaboration, while a few require their common intention.⁹⁸ Laws also vary in the rights they grant coauthors.⁹⁹

- *Collective, audiovisual, and other team works:* A collective work is typically defined as one in which many authors' contributions so fuse together that they cannot be separately identified. Some countries initially vest at least economic if not moral rights in the principal who produces and releases such a work to the public.¹⁰⁰ Special rules usually apply to audiovisual works, in which rights may vest in the producer or director, or in both, or in other members of the creative team as well.¹⁰¹ Or works developed by teams may have rights allocated in them according to other locally varying rules, including those applicable to works made in employment relations.¹⁰²
- *Works made on the job:* Laws also do not uniformly treat commissioned or employed authors' works. Many do not clearly distinguish between, on the one hand, vesting rights as a matter of copyright law and, on the other, allocating them as a matter of contract law. For example, German law vests all rights in a work made on the job in the flesh-and-blood author of the work, but allows an employer to use this work, effectively as a licensee, consistently with the underlying "service or employment relationship."¹⁰³ By contrast, U.S. law has

⁹⁷ See, e.g., Germany, Gesetz über Urheberrecht und verwandte Schutzrechte (Law on Copyright and Related Rights), § 8(1) (calling for two or more authors jointly to create a work in which their contributions cannot be separately exploited).

⁹⁸ See, e.g., United States, Copyright Act, 17 U.S.C. § 101 (definition of "joint work") (calling for two or more authors to prepare a work with the intention to merge their contributions "into inseparable or interdependent parts of a unitary whole").

⁹⁹ See, e.g., *Levitin v. Sony Music Entertainment*, 101 F. Supp. 3d 376 (S.D.N.Y. 2015) (U.S.) (distinguishing U.S. law, which entitles a joint owner of copyright to license uses, from different rules abroad). *N.b.* many laws call for coauthors to consent together to uses of their joint work, while allowing for relief against "bad-faith" hold-outs.

¹⁰⁰ See, e.g., France, Intellectual Property Code, Art. L. 113-2(3) (defining a collective work as that created "on the initiative" of the producer who releases it under her name and in which the "personal contributions" of its "diverse authors" meld into its projected "whole").

¹⁰¹ See, generally, P. Kamina, *Film Copyright in the European Union*, ch. 4 (Cambridge Univ. Press, 2d ed., 2016) (explaining the rules applicable in E.U. member states). *But see, e.g.*, 16 Casa Duse, LLC v. Merkin, 791 F.3d 247 (2d Cir. 2015) (U.S.) (refusing to deem the director to be a film author, even one among many).

¹⁰² See, e.g., Directive 2009/24/EC of the European Parliament and of the Council of 23 April 2009 on the legal protection of computer programs, Art. 2 (allocating copyrights in computer programs to "natural" or "legal" persons designated by law, employment terms, or contract).

¹⁰³ See Germany, Gesetz über Urheberrecht und verwandte Schutzrechte (Law on Copyright and Related Rights), § 43 (imposing statutory provisions on transfers of authors' rights "to the extent" that no contrary consequence ensues from "the terms or nature" of the principal-agent "relationship").

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copyright in a work “made for hire” vest initially in the employer or other principal, defined as “author,” absent agreement to the contrary.¹⁰⁴

In such hard cases, we just saw different choice-of-law rules come into play.¹⁰⁵ To apply the law of any supposed source country, courts would need stable criteria for identifying that country. But we have repeatedly found any such reliable criterion wanting for the “country of origin,” especially in cases where facts change over time.¹⁰⁶ It has here rather been proposed to apply the laws of protecting countries to define the term “author” for all purposes, if only to avoid splitting the cluster of issues normally subject to such laws.¹⁰⁷ Where such laws occasionally differ in their rules for vesting rights, notably in cases of many authors creating together or with a principal, a court may posit different initial holders of rights country by country and then ask: How to allocate rights to anchor chain of title in any one vestee or set of vestees working together? This writer proposes to allocate rights according to the consensus reasonably imputable to the parties to the transactions generating the work or production at issue. Admittedly, this approach shifts the choice-of-law problem to that of finding law appropriate to transactions key to creation or production.¹⁰⁸

In all the hard cases here, works are made either by many contributing creators, often in agency relations with a principal, or by a single author working for a principal.¹⁰⁹ The moment that such parties come together to create a work, they agree or at least would reasonably reach some consensus regarding their respective rights in this work. Suppose that this agreement allocates rights in the projected work, for example, in the case of a joint work, among its multiple creators or, in the other cases, between the creator or creators and any principal. This agreement, if enforceable under the law freely chosen to apply to it, should govern who initially holds which rights in the work, for the simple reason that it would most reliably effectuate the parties’ expectations.¹¹⁰ If there is no formal contractual provision binding such parties on point, then a court would be thrown back on inferring such a term from their agreement read as a whole or from such consensus as may reasonably be attributed to them. This proposed solution would apply across the board to all the hard cases canvassed here,

¹⁰⁴ See, e.g., United States, Copyright Act, 17 U.S.C. § 201(b) (considering “the author” of “a work made for hire” to be “the employer or other person for whom the work was prepared,” vesting copyright in this principal absent written agreement to the contrary).

¹⁰⁵ See § 6[2][b][i] *supra*.

¹⁰⁶ See §§ 4[2][a][ii], 4[3][b][ii], and 6[2][b][i] *supra*.

¹⁰⁷ See § 4[2][a][ii] *supra*.

¹⁰⁸ See, e.g., Tribunal Fédéral (Supreme Court) (Switzerland), Sept. 8, 2014, SIC 2015, 57 (stressing the law of the country governing the transaction where the parties disputed concluding any contract).

¹⁰⁹ The author of a commissioned work is, under most laws, the actual creator. In such a case, chain of title worldwide may turn on construing the scope of any transfer of rights to which the author agrees in accepting terms of commissioning her to create. See, e.g., *Griggs Group v. Raben Footwear*, [2005] EWCA Civ 11 (U.K.) (confirming that such a contract implied the transfer of copyrights worldwide to the commissioning party) (discussed in § 6[2][c][ii] *infra*).

¹¹⁰ For the laws applicable to copyright contracts, see § 6[3][b] *infra*.

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without the need for different rules for analytically distinct, but often-overlapping, categories of works, such as collective or audiovisual works or works made on the job.¹¹¹

What if the transactions leading to the creation of a work are not centered in any one country? Such a case might arise, for example, when a cinematographic work is coproduced in different countries, say, by producers headquartered in these different countries. In such a case, any approach vesting rights under the law of a supposed “country of origin” or “source country” risks both incurring uncertainty, given the variable options for localizing any such country, and ignoring any contractual consensus that may arise out of another country or countries.¹¹² Consistently with the solution proposed here, Article 14*bis*(2)(a) of the Berne Convention rather provides that “[o]wnership of copyright in a cinematographic work shall be a matter for legislation in the country where protection is claimed.”¹¹³ This ostensible choice-of-law rule may lead to designating a presumptive owner of copyright with standing to sue, albeit variably from one country to another, but subject to intervening transfers.¹¹⁴ In most cases of team works, contractual arrangements among the parties creating the work, including authors and performers, as well as producers, control the allocation of rights.¹¹⁵ Our consensus approach would respect any valid contractual provision or course of dealing that anchored chain of title in the work by allocating worldwide rights to one party.¹¹⁶ Moral rights may resist contractual alienation but remain subject

¹¹¹ For a convergent analysis, see J. Maseda Rodríguez, “Reflections on the Law Applicable to Initial Ownership of Employed Authors’ Economic Rights,” RIDA 2009, no. 222, 56.

¹¹² For example, any attempt to vest copyright in the “author” by referring to the definition of that term in any “country of origin” could be circular if such a country were established by an author’s nationality. On determining the country of origin, see § 4[3][b][ii] *supra*. Referring to the definition in the country where the “maker” or producer is headquartered could be problematic for joint producers, each headquartered in a different country. Reference to definitions turning on other factors, like first publication, would not necessarily take account of underlying contracts.

¹¹³ *N.b.*, this result would affect the allocation of rights in the coproduced audiovisual work, not eligibility criteria to protect any such work pursuant to any treaty, such as an author’s national status or a producer’s place of business. On such criteria, see § 4[2] *supra*; on the impact of Berne Article 14*bis* on transfers, see § 6[3][b][ii] *in fine infra*. For further analysis, see M. Ferrara-Santamaria, “Le régime juridique des oeuvres cinématographiques après la révision de Stockholm” (in English trans.: Legal treatment of cinematographic works after the Stockholm revision [of Berne]), RIDA 1968, no. 56, 84, at 86–91.

¹¹⁴ See, e.g., the *Spielbankaffaire* decision, BGH (Germany), Oct. 2, 1997, GRUR 1999, 152, in English trans. in 30 I.L.C. 227 (1999) (holding that laws of the protecting countries respectively determine initial vestees of copyright in an audiovisual work), *on remand*, OLG Munich, Jan. 10, 2002, ZUM 2003, 141. See also § 6[2][a][i] *supra* (unpacking the range of provisions allowing for standing to sue).

¹¹⁵ On varying regimes for audiovisual productions, see § 6[3][b][ii] *in fine infra*.

¹¹⁶ Consider, for example, a stray joint creator, say, of a prior screenplay, who did not sign any written production contract for a film. Her consensus with the rest of the creative team may be inferred in the light of her reasonably inferred expectations. For further analysis, see F.J. Dougherty, “Not a Spike Lee Joint? Issues in the Authorship of Motion Pictures Under U.S. Copyright Law,” 49 U.C.L.A. L. Rev. 225 (2001).

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to remedial accommodation with contractually acquired economic rights, as explained below.¹¹⁷

Suppose that colleagues from the four corners of the earth, via the internet or an intranet, collaboratively created a work.¹¹⁸ In such a case, as in that just considered of the cinematographic work coproduced across borders, it would be futile to look for any single originating or source country whose law could sensibly govern the initial allocation of rights in the work. A court could, as in the case of a coproduced film work, respect the online creators' expectations more closely by asking how the consensus bringing the creators together would, after any presumptive first vesting of rights, most reasonably control the initial allocation of rights in the work. What if there were no decisive evidence of the parties' shared understanding and acceptance of that putative allocation of rights? In that very hard case, the court could apply common standards for allocating rights in most, if not all, the creators' home countries.¹¹⁹ It may be asked how far these standards arise by such a consensus and to what extent public policy supports them.¹²⁰

[c] Transfers as a Matter of Law; Priorities for Third Parties

After initial vesting, copyrights or related rights may be transferred in multifarious transactions. As these cross borders, distinct laws may bear on chain of title, eventually worldwide. Conflicts of laws that might put title into question at such junctures are here only broached to alert counsel to possible lines of research. We shall here illustrate the choice of laws (i) to govern copyright transfers effectuated as a matter of law and (ii) to settle priorities between these or contractual transfers of the same or overlapping rights. Only after that will conflicts of laws applicable to contractual transfers of copyright be specifically considered.¹²¹

[i] Transfers on Death, Marriage, Foreclosures, Etc.

Many types of transfers of copyright or related rights may be effectuated as a matter of law. Such transfers may most notably take place by virtue of inheritance, within marital communities, in corporate reorganizations, in foreclosures on security interests, or in bankruptcy. In cross-border cases, complex conflicts of laws may arise between, on the one hand, the copyright laws assuring rights subject to such transfers and, on the other, the laws to which these transfers are themselves subject. There may

¹¹⁷ See §§ 6[2][c][i] and 6[3][c][ii] *infra*. For another approach, see D. Thum, "Who Decides on the Colours of Films on the Internet? Drafting of Choice-of-Law Rules for the Determination of Initial Ownership of Film Works vis-à-vis Global Acts of Exploitation on the Internet," in J. Drexl and A. Kur (eds.), *Intellectual Property and Private International Law—Heading for the Future*, 265 (Hart, 2005).

¹¹⁸ For an intranet hypothetical raising infringement issues, see § 3[1][b][iii][C] *supra*.

¹¹⁹ See A. Metzger, "Transnational Law for Transnational Communities: The Emergence of a Lex Mercatoria (or Lex Informatica) for International Creative Communities," *JIPITEC* 2012, no. 3, 361.

¹²⁰ See, e.g., A. Guadamuz, "Viral Contracts or Unenforceable documents? Contractual Validity of Copyleft Licenses," [2004] E.I.P.R. 331 (inquiring into how terms allowing the incorporation of prior into new software have acquired *de facto* and *de jure* force).

¹²¹ See § 6[3] *infra*.

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also be tensions between laws triggered by death or the breakdown of marriages, businesses, etc., and laws governing instruments such as wills or contracts intended to preserve some order despite death or group breakdown. We shall here illustrate approaches to choice-of-law issues that, in the field of copyright, may be clustered under the topics of inheritance, of marriage, and of foreclosures on creditors' claims.¹²²

What if an author, or performer, dies? Distinguish between copyright laws that govern the nature and vesting of a foreign creator's rights, subject to succession upon death, and the law that governs such succession itself. On the one hand, the copyright law of each country whose rights are asserted after death may govern, *inter alia*, which rights may then be transferred to successors and, conditionally, who may transfer such *post mortem* rights.¹²³ For example, Anglo-American provisions for copyright reversions after specified terms, provisions often operative despite prior contractual transfers, may specify how resulting interests pass in or out of the author's estate.¹²⁴ On the other hand, the default choice-of-law rule for succession upon death has rights transferred to heirs or other such successors under the law of the decedent's home country, notably that of domicile or residence on death.¹²⁵ For example, a U.S. court held that U.S. copyright in the late playwright Brecht's works passed to such a successor under the law of East Germany, his last country of domicile.¹²⁶

When moral rights are asserted, it becomes harder to distinguish between laws recognizing such rights, on the one hand, and the law governing the devolution of such rights upon death, on the other. Personal to each author and to that extent inalienable, moral rights may be deemed to be, rather than owned or transferred as would be property, merely exercised by authorized parties after the author's death. The Berne

¹²² On characterizing issues and analysis disentangling them, generally, see §§ 1[3][b] and 1[3][c] *supra* and, for examples of ensuing *dépeçage* in complex cases, §§ 3[1][a][ii] *supra* and § 6[3] *infra*.

¹²³ See, e.g., the *Bronzeskulptur* decision, OLG Munich (Germany), Sept. 17, 2009, GRUR-RR 2010, 161 (applying German law to the question of whether German rights may pass to heirs, while applying French law to succession issues, such as the interpretation of the testamentary instrument, where the decedent, Brancusi, a Romanian-born sculptor, had lived and worked in France up to his death).

¹²⁴ For analysis of such reversions overriding contracts, see § 6[3][a][i] *infra*. For analysis of resulting reversionary interests subject to *post-mortem* succession, see L. Tritt, "Liberating Estates Law from the Constraints of Copyright," 38 Rutgers L.J. 109 (2006); K. Cavalier, "Potential Problems with Commonwealth Copyright for Posthumous Poets and Other Dead Authors," 52 J. Copr. Soc'y 225 (2005).

¹²⁵ See, e.g., Regulation (EU) No. 650/2012 of the European Parliament and of the Council of 4 July 2012 on jurisdiction, applicable law, recognition and enforcement of decisions and acceptance and enforcement of authentic instruments in matters of succession (Brussels IV), Art. 21, O.J. 2012 L 201 ("Unless otherwise provided for in this Regulation, the law applicable to the succession as a whole shall be the law of the State in which the deceased had his habitual residence at the time of death.").

¹²⁶ *Brecht v. Bentley*, 185 F. Supp. 890, 893 (S.D.N.Y. 1960). See also *Fundación Gala-Salvador Dalí, Visual Entidad de Gestión de Artistas Plásticos (VEGAP) v. Société des auteurs dans les arts graphiques et plastiques (ADAGP)*, C.J.E.U., 3rd ch., April 15, 2010, Case C-518/08, para. 36, [2010] E.C.D.R. 263 (reasoning that, where specific E.U. law is silent on point, normal choice-of-law rules would apply to cross-border claims, notably to inherit or assert rights effective outside the decedent's home country).

§ 6[2][c][i] INTERNATIONAL COPYRIGHT LAW AND PRACTICE INT-208

Convention sets out the arguable choice-of-law rule to the effect that the moral rights it contemplates “shall be exercisable by the persons or institutions authorized by the legislation of the country where protection is claimed.”¹²⁷ Construing this provision broadly in any case where a deceased author’s moral right is asserted outside her home country, a court may ask whether, and how, the copyright or other law of any protecting country may call for reference back to rules that, arguably under the author’s home law, govern the delegation of authority to exercise moral rights.¹²⁸ Indeed, whatever the law of the protecting country, many courts revert to the default rule of simply applying the appropriate law of an author’s home country to designate parties authorized to assert her moral rights after death.¹²⁹ However, case law may at times display some ambivalence on point.¹³⁰

In a case of marriage, diverse issues may arise with regard to choosing laws to govern the fate of copyrights or related rights, notably upon dissolution. For example, in the United States, it remains undecided whether federal copyright law or state law allocates U.S. copyright interests between U.S. spouses at least.¹³¹ Beyond such purely local uncertainties, we may ask how a court should characterize a foreign author’s rights, especially moral rights, for purposes of marital allocation. The case of French rights is instructive: seminal French case law had held that, given the inalienability of moral rights, copyright as such fell outside the marital community.¹³² However, French statute now allocates, pursuant to the default law of matrimonial regimes, such copyright interests as accrue from the economic exploitation of works during

¹²⁷ Berne, Art. 6*bis*(2) (Paris). *N.b.*, in a country not applying treaty terms as self-executing, implementing legislation may be consulted. *See, e.g.*, Canada, Copyright Act, Art. 14.2(2)–(3) (having moral rights “pass” by testamentary instrument or else under the law of succession applicable to “property,” arguably that effective in the decedent’s home country).

¹²⁸ It is submitted that such reference does not entail *renvoi* to the choice-of-law rules of the decedent’s home country, nor indeed to any of its laws as such, but rather enables the court to assess a *datum* needed as a predicate for applying the rule dispositive of the issue at hand, here the deceased author’s authorization to exercise a moral right. On the *datum* in conflicts analysis generally, see § 1[3][c] *in fine supra*.

¹²⁹ *See, e.g.*, Taro Ko v. K.K. Nishin Hodo, Hanrei Jiho (No. 1936) 140 (Tokyo District Court, May 31, 2004) (Japan) (applying Japanese law to define the rights of a dead Chinese poet, including any moral right, as violated in Japan, and Chinese law to the devolution of the authority to exercise moral right); the *Carmina Burana* decision, President Rechtbank (District Court) Amsterdam (Netherlands), Feb. 24, 1992, AMI 1992/6, 112 (declining to apply Dutch requirements for designating a successor, while applying German law to decide who may exercise a dead German composer’s moral rights in the Netherlands).

¹³⁰ Compare CA Paris, 1e ch. (France), Sept. 23, 1997, RIDA 1998, no. 176, 418, with note by A. Kéréver, *id.*, at 315 (sorting out heirs of the Swiss sculptor Giacometti, resident in France at his death, as to standing to assert, and rights to exercise, his moral rights), with Erofeeva c. Editions Albin Michel, CA Paris, 5e ple.: 2e ch., Nov. 27, 2009, P.I. 2010, 731, note A. Lucas (applying Russian law to determine who may invoke a deceased Russian author’s moral right).

¹³¹ Compare *In re Marriage of Worth*, 195 Cal. App. 3d 768 (1987) (U.S.) (applying state law), with *Rodrigue v. Rodrigue*, 218 F.3d 432 (5th Cir. 2000) (U.S.) (finding state law to be in “compatible combination” with federal policy, otherwise controlling).

¹³² *See the Lecocq* decision, Cass., ch. civ. (France), June 25, 1902, Dalloz 1903, I, 5, note A. Colin; the *Jamin-Canal* decision, Cass., ch. civ. (France), May 14, 1945, Dalloz 1945, 285, note H. Desbois.

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marriage.¹³³ Suppose that copyrights worldwide are considered in dissolving a marriage: Should moral rights in many countries impact the allocation of economic rights or interests arising in these countries? At a minimum, a court may avoid some tensions among pertinent laws here, it is submitted, by looking to the model just broached: Allocate equitably entitlements to revenues actually or potentially earned from copyright exploitation during marriage.¹³⁴

What if a party changes its legal form or becomes insolvent? Arguably, the home law of a legal entity governs its capacity to change form or to transfer assets to a successor entity, subject to the transferability of copyright interests themselves.¹³⁵ What law or laws apply to any foreclosure on copyright assets in the realization of security interests or to the allocation of such assets of a defaulting debtor in bankruptcy proceedings?¹³⁶ Procedurally, in cross-border bankruptcy matters, a main proceeding may sometimes be brought in one jurisdiction, notably where the bankrupt debtor is headquartered, and ancillary proceedings started elsewhere, notably where assets at issue are located.¹³⁷ In theory, choice-of-law approaches to foreclosures, as well as to other such reallocations of copyright assets as a matter of law, may vary among jurisdictions; in practice, bankruptcy decisions often turn on the exercise of discretion.¹³⁸ In any event, the failure to perfect a security interest in copyright assets risks leaving

¹³³ France, Intellectual Property Code, Art. L. 121-9(2).

¹³⁴ On such judicial accommodation generally, see § 1[3][c] *supra*. For examples in infringement cases, see §§ 3[1][b][ii][B], 3[1][b][iii][B], and 3[1][b][iii][C] *supra*. For the example of contracts and moral rights, see § 6[3][c][ii] *infra*.

¹³⁵ *But see, e.g.*, *Films by Jove, Inc. v. Joseph Berov*, 341 F. Supp. 2d 199, 208–211 (E.D.N.Y. 2004) (U.S.) (refusing to enforce a Russian directive which, based on transfers from one state entity to another, asserted ownership of U.S. rights to exploit films); the *Lepo Sumera* decision, BGH (Germany), March 29, 2001, GRUR 2001, 1134, ZUM 2001, 989 (allowing a composer or his heirs to terminate transfers of a defunct Soviet copyright agency).

¹³⁶ For further analysis, see S. Bariatti, "The Law Applicable to Security Interests in Intellectual Property Rights," 6 J. of Private International Law 395 (2010); I. Sato, "Study on Governing Law on Security Rights in Intellectual Property," 22 IIP Bulletin 1, at 6–12 (2013), at https://www.iip.or.jp/e/e_summary/pdf/detail2012/e24_18.pdf; N. Farid, "The Fate of Intellectual Property Assets in Cross-Border Insolvency Proceedings," 44 Gonzaga L. Rev. 29 (2008/09).

¹³⁷ *See, generally*, UNCITRAL Model Law on Cross-Border Insolvency (1997), at http://www.uncitral.org/uncitral/en/uncitral_texts/insolvency/1997Model.html (providing guidelines, to be implemented in national legislation, for coordinating local procedures with those abroad in cross-border bankruptcies). *See also* Regulation (EU) 2015/848 of the European Parliament and of the Council of 20 May 2015 on insolvency proceedings (recast), O.J. 2015 L 141 (superseding prior regulation governing most E.U. cross-border bankruptcies).

¹³⁸ *See, e.g.*, *Jaffé v. Samsung Electronics Co. (In re Qimonda)*, 737 F.3d 14 (2013) (4th Cir. 2013) (U.S.), *cert. denied*, 135 S. Ct. 66 (2014) (where a main German proceeding terminated licenses of U.S. patents pursuant to the German Insolvency Code, ruling that an ancillary U.S. proceeding correctly refused to effectuate such termination, applying rather the U.S. Bankruptcy Code which allowed certain licenses of U.S. intellectual property to be preserved, after balancing competing stakeholders' interests, U.S. public policy, and comity). *See also* A. Duggan and N. Siebrasse, "The Protection of Intellectual Property Licenses in Insolvency: Lessons from the Nortel Case," 4 Penn State J. Law & International Affairs 489 (2015) (comparing U.S. and Canadian statutory and case laws on point).

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creditors little recourse when a copyright assignee or even a licensee goes bankrupt.¹³⁹ To begin to sort out possible conflicts of laws here, turn next to the issue: How to give priority to one of a pair of competing transfers of the same or overlapping interests?¹⁴⁰

[ii] Given Transfers of the Same Right, Which Prevails?

Given earlier and later transfers of the same or overlapping copyrights or related rights, which transfer prevails? The choice of laws applicable to this question remains unsettled for successive transfers of rights effective in different countries.¹⁴¹ A default rule for such transactions may be found in the maxim *nemo dat quod non habet*: once one alienates an interest, one no longer has it to grant. That is, the first transfer of the same exclusive right to one party in time has priority over any subsequent attempt to transfer it to another party.¹⁴² However, this default rule has exceptions that most notably arise out of special recordation schemes available only in some countries. To focus on the choice of laws on point, assume that each transfer in question is, in itself, valid.¹⁴³

A U.K. decision illustrates how the default rule may itself escape conflicts of laws, albeit with a caveat. A party X had commissioned a work under a British contract in which the author had impliedly granted X copyrights worldwide.¹⁴⁴ However, the author in turn expressly assigned copyrights worldwide to a third party Y, and the commissioning party X brought suit in a U.K. court to confirm its rights worldwide as against Y. Not only did the court invoke the British variant of the default rule in favor of X's claim, but it considered that rules of other laws led to much the same result, so

¹³⁹ *Compare* Société de développement des entreprises culturelles (SODEC) c. Société Radio-Canada (SRC), 2014 QCCS 951 (Canada) (finding no copyright assigned to a bankrupt licensee of a television series in Quebec by a contract subject to French law, nor any creditor's security interest in copyright appropriately secured), *with* Supreme Court (Sweden), *Nytt Juridiskt Arkiv* 2005, 510 (allowing a bankruptcy estate to sell copies owned by a bankrupt party, subject to royalties due the author pursuant to the Swedish rule protecting authors' unassigned rights against attachment).

¹⁴⁰ *See* § 6[2][c][ii] *infra*.

¹⁴¹ *See, generally*, T. Hartley, "Choice of Law Regarding the Voluntary Assignment of Contractual Obligations under the Rome I Regulation," 60 *International & Comparative Law Quarterly*, 29, 49–56 (2011) (finding, in the Rome I Regulation, no adequate solution to the problem of prioritizing competing transfers of rights). *But see, e.g.*, United Nations Convention on the Assignment of Receivables in International Trade, Art. 30, at http://www.uncitral.org/uncitral/uncitral_texts/security/2001Convention_receivables.html (in pending treaty, not yet effective, provision on the choice of laws applicable to such priority).

¹⁴² The terms of successive transfers over time have to be analyzed to see just where they may conflict. For example, the mere consent given to use a work non-exclusively may not preclude any such subsequent consent. *Quaere* whether, and under what conditions, a non-exclusive license of a right remains unaffected by a subsequent assignment of the right. *See, e.g.*, United States, Copyright Act, 17 U.S.C. § 205(e) (specifying such conditions).

¹⁴³ On choosing laws validating contractual transfers, see § 6[3][b] *infra*.

¹⁴⁴ On any author creating a work subject to some agency relation with a principal, see § 6[2][b][ii] *supra*.

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that the case brought no true conflict of laws to address.¹⁴⁵ On that basis, the court equitably compelled the third party Y to release to the commissioning party X all the copyrights Y claimed in the work worldwide.¹⁴⁶ The court also stated the caveat that this relief applied without prejudice to the priority rules based on national recordation.¹⁴⁷

What if, among competing transfers of copyright or related rights, some eventually forming chain of title worldwide, one or some instruments are recorded in one or many local facilities? In that event, a court may have to resolve conflicts of laws that could well turn on nationally varying recordation schemes, coupled with rules governing the consequences of recording.¹⁴⁸ Some countries maintain facilities for recording copyright transactions specifically, and some have facilities to record property transfers generally, while many impose rules that put third parties on constructive notice of recorded transfers and accordingly govern priorities.¹⁴⁹ Such recordation schemes are especially key to preserving the priority of security interests that may arise out of instruments that trigger transfers of rights, notably upon the failure to pay a debt pursuant to contract, coupled with the fulfillment of foreclosure formalities.¹⁵⁰ The default rule prioritizing the first valid transfer in time may then be exceptionally subject to locally specific rules that give priority to a transfer effectuated pursuant to an instrument properly recorded before other such instruments, as well as relative to transfers not previously recorded.¹⁵¹ Given varying recordation schemes country by country, each designed in the light of local conditions, it seems prudent to anticipate that courts so apply pertinent laws as to confine the priority effects of domestic recordation only to national rights, that is, territorially.¹⁵²

¹⁴⁵ For the analysis of true and false conflicts of laws, as well as exercising remedial discretion to defuse true conflicts, see § 1[3][c] *in fine supra*.

¹⁴⁶ *Griggs Group Ltd. v. Evans* (No. 2), [2004] EWHC 1088 (Ch), paras. 53–61 (also noted in § 6[1][b] *supra*), *affirmed*, *Griggs Group v. Raben Footwear*, [2005] EWCA Civ 11.

¹⁴⁷ *Griggs Group Ltd. v. Evans* (No. 2), [2004] EWHC 1088 (Ch), paras. 140–141.

¹⁴⁸ Of course, recordation may not supersede the overriding condition of validity of the transactions in question. *See, e.g., The Kid* decision, Cass., 1e ch. civ. (France), May 28, 1963, RIDA 1963, no. 41, 134 (holding that a fraudulent and thus invalid transfer, though recorded first in France, did not take priority over another transfer of French rights valid under U.S. contract law).

¹⁴⁹ For examples of such recording facilities and related rules of priority, see national chapters herein, at §§ 4[2][d] and 5[2].

¹⁵⁰ Compare L. Brennan, "Financing Intellectual Property Under Revised Article 9: National and International Conflicts," 23 *Comm/Ent* 313 (2001) (discussing potential conflicts between state commercial laws, contemplating local recordations, and federal U.S. copyright law, allowing recordation in the U.S. Copyright Office), with D. Vaver, "Can Intellectual Property be Taken to Satisfy a Judgment Debt?," 6 *Banking & Finance L. Rev.* 255 (1991) (explaining how, in Canada, provincial laws may apply differently than federal law on point).

¹⁵¹ Of course, recordation may provide evidence of a first transfer in time, satisfying the default rule of priority. *N.b.*, under some laws, the terms of the transfer may be critical for recordation to put parties on constructive notice of the transfer. *See, e.g., United States, Copyright Act*, 17 U.S.C. § 205(d) (requiring the prevailing transfer to have been taken "for valuable consideration or on the basis of a binding promise to pay royalties").

¹⁵² *See also* § 6[2][c][i] *in fine supra* (choice of laws in cross-border bankruptcies).

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Consider a hard priority case which in fact arose outside any local recordation scheme and, in turn hypothetically, within such a scheme. Suppose a prior “senior” transfer of rights, say, an assignment of worldwide or regional rights from A to B, and a later “junior” transfer of some of these rights from B to C. Our default rule of first in time does not easily help us choose the law or laws to govern the consequences of the termination of any such senior transfer for the junior transfer. Among cases that address successive transfers of national rights, some decisions hold that termination of the senior transfer brings the junior transfer to an end.¹⁵³ Consider, by contrast, this German case: in 1960 a U.S. composer had transferred worldwide rights in one of his works to A, a California music publisher, who in 1961 granted European rights exclusively to B, who in 1962 sublicensed German and Austrian rights to C. The German Federal Court of Justice, applying only German law, held that, though in 1986 A and B contractually terminated the senior grant of rights for Europe, C’s junior sublicense remained in effect for Germany and Austria.¹⁵⁴ It may be asked what principle or policy transcending local concerns, effectively what *ordre public international*, could justify having local law alone control this result. Bear in mind that it impacted, not merely the fate of rights in the local jurisdiction, but chain of title across multiple borders, to wit, from California to Austria.¹⁵⁵ Given a local recording scheme, could results differ if A and B’s termination agreement were recorded but C’s sublicense were not? National law governing the local scheme would have to be consulted as to the effects of such recording on domestic rights.¹⁵⁶

[3] What Rules Apply to a Contract Transferring Rights Abroad?

Copyright laws tend to be applied to infringement issues country by country: this we shall call the *copyright-conflicts regime*.¹⁵⁷ By contrast, contract laws, absent overriding considerations, tend to be applied contract by contract: this we shall call the *contract-conflicts regime*. In any case of a cross-border copyright contract, it then has to be asked:¹⁵⁸ (a) Which issues are subject to resolution under laws applicable

¹⁵³ See, e.g., *Stewart v. Abend*, 495 U.S. 207 (1990) (holding that, given the reversion, back to the successor of the author, of U.S. copyright in a story previously subject to a transfer authorizing the adaptation of the story in the film *Rear Window*, prior transfers of rights to exploit the film no longer have effect).

¹⁵⁴ The *Take Five* decision, BGH, July 19, 2012, Case I ZR 24/11, GRUR 2012, 914.

¹⁵⁵ See, e.g., the *Hi Hotel II* decision, BGH (Germany), Sept. 24, 2014, paras. 47–50, GRUR Int. 2015, 375 (explaining that such a principle or policy would have to justify deeming a German copyright-contract rule sufficiently mandatory to override an arguably applicable foreign contract rule) (as noted in § 6[3][c][i] *infra*).

¹⁵⁶ See, e.g., *Sté. Canal Plus c. Sté. Thames Television Ltd.*, CA Versailles, ch. com. (France), June 20, 2000, RIDA 2001, no. 187, 231, note A. Kéréver (holding that provisions of an exclusive license which precluded unconsented sublicensing, though not mentioned in excerpts of that senior license noted in the French recordation facility for audiovisual works, were enforceable against junior sublicenses).

¹⁵⁷ For this regime, see § 3[1][a][i] *supra*.

¹⁵⁸ *N.b.*, in such cases, parties are well advised to plead and show all relevant laws properly. See, generally, §§ 3[1][b][i][A] and 6[2][a] *supra* (illustrating, respectively, consequences of failure to plead foreign laws colorably governing cross-border infringement and chain of title).

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pursuant to the copyright-conflicts regime and (b) which, pursuant to the contract-conflicts regime? In hard cases, the question may arise: (c) Which law or laws to apply when both regimes come into play?¹⁵⁹

[a] Copyright Conflicts: Laws of Protecting Countries

Posit a California contract transferring copyrights worldwide in a U.S. film work to its producer.¹⁶⁰ The copyright-conflicts regime governs how far the effect of this contract depends on diverse rules drawn from the national copyright laws according the rights it transfers. One may ask, for example: Will the French principle precluding the alienation of authors' moral rights restrict the producer in adapting the U.S. film work for exploitation in France?¹⁶¹ This question takes the general form: Does any author's right relevant to contractual transfer so clearly fall within the scope of copyright that it is subject to national treatment? Distinct sets of examples will be examined: (i) rights to have contractually alienated copyrights revert to authors and (ii) rights arising out of contract-relevant copyright rules protecting authors.¹⁶²

[i] Reversionary Interests and Termination Rules

Campbell Connelly & Co. Ltd. v. Noble illustrates the analysis needed to separate out copyright from contractual issues. In this case a U.K. court had to decide what law disposed of the issue: Could an assignment of "the full copyright for all countries" in a song effectively convey U.S. renewal copyright?¹⁶³ The court immediately referred to U.S. law to ascertain "the precise nature [emphasis added] of that to which it [the contract] is claimed to apply," since that law would establish whether U.S. renewal copyright by definition was susceptible of transfer at all.¹⁶⁴ The court held U.S. law, that of the country defining the right in question, to be dispositive of the assignability of that right, all the while finding that the "agreement was a purely English contract and must be interpreted according to English law."¹⁶⁵

¹⁵⁹ On characterizing such distinct issues and disentangling them, see §§ 1[3][b] and 1[3][c] *supra* and, for examples of ensuing *dépeçage* in complex cases, §§ 3[1][a][ii] and 6[2] *supra* and, especially in copyright-contract cases, § 6[3][c][i] *infra*.

¹⁶⁰ *N.b.*, for most purposes, U.S. state laws include contract law, so that, were California law chosen by the parties for this contract, it would apply to most, if not all, purely contractual issues. *But see* § 6[3][b][ii] *infra* (noting rare preemption of such state law).

¹⁶¹ *See, e.g.*, the *Asphalt Jungle* decision, *Huston c. Turner Entertainment*, Cass., 1e ch. civ. (France), May 28, 1991, RIDA 1991, no. 149, 197, in English trans. in 23 I.I.C. 702 (1992), *followed on remand*, CA Versailles, chs. réunies, Dec. 19, 1994, RIDA 1995, no. 164, 389 (holding that a U.S. film-production contract could not alienate U.S. film authors' French moral right, which they could invoke to preclude the showing in France of a colorized U.S.-made film) (discussed in §§ 4[2][a][ii] and 6[2][b][i] *supra*).

¹⁶² For the analysis of the extent of national treatment generally, see § 5[4][b] *supra*.

¹⁶³ (1963) 1 Weekly Law Reports 252 (High Court, Chancery).

¹⁶⁴ *Id.*, at 255.

¹⁶⁵ *Id.*, at 254. For further analysis of this case and contractually related U.S. renewal issues, see R. Stone, "Problems of International Film Distribution: Assignment and Licensing of Copyright and the Conflict of Laws," [1996] Ent. L. Rev. 62, at 65–73. On U.S. renewal copyright generally, see "United States," herein, at §§ 4[3][b] and 5[5][c].

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A comparable analysis accounts for decisions concerning old British reversionary interests.¹⁶⁶ The U.K. Copyright Act of 1911 provided that an author's transfers of U.K. copyright were terminated 25 years after death and that authors could not alienate their interests in rights to the further 25-year terms reverting to their estates.¹⁶⁷ Statutory provisions for such reversionary interests continue to have effect by virtue of still-operative rules in Canada and by virtue of transitional provisions in many countries that were once part of the British Empire.¹⁶⁸ Applying the original U.K. provision as setting out a copyright and not a contract rule, diverse courts have held it to be dispositive of whether or not authors could contractually transfer U.K. reversionary interests. A French court applied this U.K. provision to a transfer by the French composer Ravel of worldwide rights in an orchestration, terminating the transfer insofar as it affected ownership of the U.K. right reverting to Ravel's estate.¹⁶⁹ In the *Redwood* cases, U.K. courts had a more complex task because, while the 1911 Act did not allow an author to alienate this reversionary interest *inter vivos*, it did allow the author's estate to transfer the resulting right.¹⁷⁰ Estates of U.S. authors had executed transfers which, it was finally held, conveyed U.K. reversionary rights by broad language referring to worldwide rights, but not by language merely referring to U.S. renewal rights.¹⁷¹

Turn to distinct types of reversions under U.S. copyright law: that of transferred rights after the termination of any transfer under present U.S. law, and that of the renewal term instituted under prior U.S. law.¹⁷² Under U.S. law, authors may terminate contractual transfers of U.S. copyright, and their termination rights may not in principle be contractually alienated, though they may not be asserted in the case of a work made for hire, arising out of an agency relation.¹⁷³ Consider the hypothetical

¹⁶⁶ For further analysis, applying to comparable Spanish interests as well, see P. Torremans and C. García Castrillón, "Reversionary Copyright: A Ghost of the Past or a Current Trap to Assignments of Copyright?," [2012] *Intellectual Property Quarterly* 77.

¹⁶⁷ See, e.g., United Kingdom, Copyright Act 1911, Sec. 5(2) ("[A]ny agreement entered into by [the author] as to the disposition for such reversionary interest shall be null and void."). *But see* United Kingdom, Copyright, Designs and Patents Act 1988, Schedule 1, para. 27(2) (while giving continuing effect to the termination of contracts previously subject to the 1911 Act, now ostensibly allowing the author to deal in the expectancy in the reverting right to the residual 25-year term).

¹⁶⁸ See, e.g., *Anne of Green Gables Licensing Authority Inc. v. Avonlea Traditions Inc.*, 2000 CanLII 22663, paras. 73–92 (Ont. Sup. Ct.) (Canada) (tracing how U.K. law transitioned to Canadian law on point, with termination subject to assignee's notice, not found in the case).

¹⁶⁹ Sté. Boosey & Hawkes, Ltd. c. Taverne, Trib. civ. Bayonne, May 16, 1972, *commented*, H. Desbois, Note, *Revue trimestrielle de droit commercial* 1972, 624, 627.

¹⁷⁰ *Redwood Music Ltd. v. B. Feldman & Co. Ltd.*, [1979] Reports of Patent Cases 385 (Court of Appeal), *affirmed sub nom.* *Chappell & Co., Ltd. v. Redwood Music, Ltd.*, [1981] Reports of Patent Cases 337 (House of Lords).

¹⁷¹ *Redwood Music Ltd. v. B. Feldman & Co. Ltd.*, [1979] Reports of Patent Cases 385, 404–406.

¹⁷² United States, Copyright Act, 17 U.S.C. §§ 203 (effective at the start of 1978) and 304(c) (for prior rights still running at the start of 1978), respectively.

¹⁷³ See, generally, § 1[3][c] *in fine supra* (explaining that such a relation would constitute a *datum* for

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case of a free-lance German songwriter who, in Germany, specifically grants a publisher the exclusive right to exploit a song she alone has authored, that is, one not “made for hire,” transferring the right worldwide for the full term of rights in all countries. Suppose that this German author complies with U.S. formalities so that this transfer of U.S. rights is terminated and sues the German publisher or its U.S. transferees for infringement for their continued U.S. exploitation of her song: Should her German publishing contract provide these parties with a defense to her suit? Following the copyright-conflicts regime, the answer would be negative, on the premise that U.S. copyright law defines the right of termination as inalienable for any German as for a U.S. author. However, by parity of reasoning, U.S. reversions, whether effectuated under the present termination rule or the prior renewal rule, only impact transfers of U.S. rights, not transfers of foreign rights.¹⁷⁴

There remain some stray reversion issues not fully subject to the foregoing analysis. The U.S. scheme for restoring copyright in foreign works that have fallen into the U.S. public domain, notably for failure to comply with formalities, effectuates a rather different type of reversion by vesting the restored copyright, for its newly extended term, in “the author or initial rightholder of the work as determined by the law of the source country of the work.”¹⁷⁵ If this restoration, like any extension of copyright terms effectuated under the E.U. Term Directive, is subject to the still-effective contractual rights of transferees, then issues regarding the allocation of rights for new terms will ultimately turn on contracts that original authors or initial vestees have made.¹⁷⁶ There then remains the further question: To what extent, for these purposes, should such contracts be at all subject to the law of the country granting the extended term, at least as to issues of transferability, or otherwise subject to the law applicable to the contract itself?¹⁷⁷ Assuming the normal treatment of contractual transfers, rights to the extended terms would follow chain of title; moreover, where reversion takes place only under contractual provisions, then the dispositive law for determining the validity, construction, and operation of these provisions should be the law applicable

conflicts analysis, not a law to be applied). *But see, e.g.*, *Ennio Morricone Music Inc. v. Bixio Music Group Ltd.*, No. 1:16-cv-08475 (S.D.N.Y., Oct. 6, 2017) (unnecessarily treating such an issue as subject to a conflict of laws when deciding whether a U.S. termination rule applied).

¹⁷⁴ *See, e.g.*, *OLG Dusseldorf (Germany)*, April 24, 2007, ZUM-RD 2007, 465 (holding U.S. reversion inapplicable to transfers of German rights). *See also* *Redwood Music Ltd. v. Bourne*, (1995) 63 *Canadian Patent Reporter* (3d) 380 (Ont. Gen. Div.) (Canada) (to such effect for Canadian copyrights).

¹⁷⁵ *United States, Copyright Act*, 17 U.S.C. § 104A(b). *See, e.g.*, *Películas y Videos Internationales, S.A. de C.V. v. Harriscope of Los Angeles, Inc.*, 302 F. Supp. 2d 1131, 1135 (C.D. Cal. 2004) (U.S.) (failing to distinguish clearly whether, under the law of Mexico, the source country, economic rights vested in an “assignee,” treated as an “author,” or by virtue of assignment itself).

¹⁷⁶ *See, e.g.*, the *Ave Maria* decision, Cass., 1e ch. civ. (France), June 21, 1961, RIDA 1961, no. 33, 108 (holding a wartime extension of term to vest in the assignee of the author, as if part of the overall term of the copyright originally assigned).

¹⁷⁷ *See, e.g.*, the *Colette* decision, CA Paris, 4e ch. (France), April 12, 2002, RIDA 2002, no. 194, 315 (applying laws of the protecting countries, respectively, to determine whether rights in extended terms are transferable).

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to the contract itself.¹⁷⁸ For example, a British court stood ready to apply U.K. law to enforce “a term in a contract which deals with copyright throughout the universe” and which, subject to “an express English [choice-of-] law clause,” would have such copyrights revert upon material breach of the contract.¹⁷⁹

[ii] Moral Rights; Other Author-Protective Rules

Copyright-contract rules intended to protect authors or performers do not in themselves create rights subject to national treatment irrespective of their agreements.¹⁸⁰ One authoritative commentator looks to “the legal nature of the right as imprinted by the law of the protecting country” when assessing whether that right, under copyright, may be contractually alienated or waived, notably by a foreign creator.¹⁸¹ But theories of “the legal nature” of this or that right are often mixed up in practical policy decisions, especially when lawmakers institute copyright-contract rules to resolve local tensions between authors’ and entrepreneurs’ interests.¹⁸² To illustrate issue analysis here, we shall compare and contrast such rights, especially moral rights, with those arising out of typical examples of copyright-contract rules to protect economic interests. Criteria for deciding whether to have foreign claimants benefit from such rules, especially in hard cases, will be discussed after that.¹⁸³

Consider, to start, a French case in which a ghost writer petitioned a French court to apply a pair of French copyright-contract rules to a U.S.-made contract.¹⁸⁴ Only one, but not the other rule, was chosen as dispositive, illustrating the distinction between such rules as apply by right and those such as apply as a matter of contract law. On the one hand, the court disallowed the ghost writer’s contractual waiver of the moral right of attribution, but rather enforced the French rule prohibiting the alienation of French moral rights: an order was issued to name her as author on any future French edition. Now, moral rights are considered as more or less inalienable across diverse domestic copyright laws, as confirmed in international treaties, so that they may be plausibly argued to apply in the face of contractual terms to the contrary, given the

¹⁷⁸ On chain of title, see §§ 6[2][b] and 6[2][c] *supra*. On further copyright-contract provisions favoring creators, see § 6[1][a][iii] *infra*. On policy considerations in hard cases, see § 6[3][c][i] *infra*.

¹⁷⁹ *Crosstown Music Co. v. Rive Droite Music Ltd.*, [2010] EWCA Civ 1222, para. 58, [2011] E.C.D.R. 106.

¹⁸⁰ In what follows, we shall use the term “authors” to include comparable claimants, notably performers, where the copyright-contract rule in question so provides.

¹⁸¹ E. Ulmer, *Intellectual Property Rights and the Conflict of Laws*, 46 and Appendix, Rules, Art. F(1)(a) (English trans., Kluwer, 1978).

¹⁸² Compare G. Boytha, “National Legislation on Authors’ Contracts in Countries Following Continental European Legal Traditions,” Copyright 1991, 198 (stressing that the Continental European approach favors authors), with D. De Freitas, “Copyright Contracts,” Copyright 1991, 222 (explaining that, in the Anglo-American view, suitable copyright-contract terms will evolve in commerce, assuming free negotiation).

¹⁸³ See § 6[3][c][i] *infra*.

¹⁸⁴ *Bragance c. Michel de Grèce*, CA Paris, 1e ch., Feb. 1, 1989, RIDA 1989, no. 142, 301. For commentary, see B. Edelman, Note, *J. du Droit international* 1989, 1012.

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“nature” of such authors’ rights enforceable, as French case law confirms, country by country.¹⁸⁵ On the other hand, the court treated the reformation of terms of payment as raising purely contractual issues and let such terms stand in the U.S. contract, which to that extent it effectively held to be governed by U.S. contract law.¹⁸⁶ In that light, we shall later consider the French provision which protects the moral right of integrity in audiovisual works by precluding modifications under ostensibly contractual conditions not necessarily found outside France.¹⁸⁷

Switch to economic rights that may normally be contractually transferred, albeit sometimes locally subject to more or less detailed copyright-contract rules. On the one hand, rules of form or of narrow construction may favor creators, often by precluding contractual transfers of rights for uses that are not expressly specified or foreseeable. On the other hand, rules of substance may purport to assure such parties of “equitable” economic terms in contractual transfers of rights, notably terms of remuneration or of reformation. For example, German and Dutch laws provide complex sets of rules to such effect: on the model of analogous French rules, these also purport to govern their own application to foreign claimants or transactions.¹⁸⁸ But should any such copyright-contract rule, favoring creators but not in theory defined as part and parcel of their rights akin to copyright, apply as a mandatory rule overriding any choice of law by the parties to the contract at issue?¹⁸⁹ In such an inquiry, a court may in practice also have to ask: Do standards determining the “equity” of terms, for example, current royalty rates, turn, not on any choice of law, but rather on some foreign *datum*, say, on trade practice local to the contract or parties?¹⁹⁰ An online contract, especially if proposed on a take-it-or-leave-it basis across multiple borders, may not be amenable to analysis localized to that extent. Rather, in such a case, a widely applied rule, like that of narrow construction, may offer a commonly acceptable solution.¹⁹¹

¹⁸⁵ See, e.g., the *Asphalt Jungle* decision, *Huston c. Turner Entertainment*, Cass., 1e ch. civ. (France), May 28, 1991, RIDA 1991, no. 149, 197, in English trans. in 23 I.I.C. 702 (1992), *followed on remand*, CA Versailles, chs. réunies, Dec. 19, 1994, RIDA 1995, no. 164, 389 (discussed in §§ 4[2][a][ii] and 6[2][b][i] *supra*).

¹⁸⁶ For further analysis, see A. Kéréver, “La règle du ‘traitement national’ ou le principe de l’assimilation” (in English trans.: The Rule of ‘national treatment’ or the principle of assimilation), RIDA 1993, no. 158, 75, 89 *et seq.*

¹⁸⁷ See § 6[3][c][ii] *infra* (also treating other cases where moral rights are asserted to override contractual alienation).

¹⁸⁸ See W. Nordemann, “A Revolution of Copyright in Germany,” 49 J. Copr. Soc’y 1041 (2002); J. Ginsburg and P. Sirinelli, “Private International Law Aspects of Authors’ Contracts: The Dutch and French Examples,” 39 Columbia J. Law & Arts 171 (2015).

¹⁸⁹ See § 6[3][b] *infra*.

¹⁹⁰ See, generally, A. Ehrenzweig and E. Jayme, *Private International Law*, vol. 1, 83–85, vol. 3, 9–11 (Oceana, 1972 [vol. 1], 1977 [vol. 3]) (observing that a foreign standard of equity may be noticed as a transactional fact by a court). See also § 1[3][c] *in fine supra* (indicating the role of the *datum* in conflicts analysis generally).

¹⁹¹ See, e.g., *Agence France Presse v. Morel*, 934 F. Supp. 2d 547, 559–564 (S.D.N.Y. 2013) (U.S.)

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In cross-border cases, how to deal with domestic statutes that set out copyright-contract rules economically favoring creators, especially those with their own choice-of-law provisions? Consider, for example, Sections 32 and 32a of the German Copyright Act, which provide for remuneration and other advantages for authors, and to a lesser extent for performers, with regard to contracts transferring economic rights.¹⁹² The subsequent Section 32b in turn purports to impose alternative conditions on applying either of these provisions: on the one hand, either provision applies to the extent that significant acts of copyright use within Germany are covered by the contract at issue; on the other, either provision applies if German law would be applicable to that contract in the absence of the parties' choice of law. This formulation ostensibly submits German copyright-contract provisions to the very regimes that we are here trying to disentangle: on the one hand, the territorial copyright-conflicts regime; on the other, the contract-conflicts regime. A German forum may well apply such heterogeneous conditions in the alternative, not only to local transactions, but also in favor of E.U. creators.¹⁹³ It could also be argued that such regimes should benefit other creators pursuant to any forum principle favoring a weaker party to a transaction.¹⁹⁴ It will here be submitted that their applicability should, following global interest analysis, be limited to local claimants.¹⁹⁵

[b] Contract Conflicts: the Law of the Contract

Generally, the contract-conflicts regime tends to apply one contract law to any one agreement. Assume that such a "proper" law of the contract is determined by the parties to a contract or by a court and that contractual issues are clearly disentangled from others.¹⁹⁶ That law should then govern these contractual issues, without regard to national rights under copyright that the agreement at issue transfers. Consider then (i) the choice-of-law rules determining the law of the contract and (ii) typical cases of copyright contracts to illustrate issues that such law may govern.

[i] Party Choice of Contract Law; Other Principles

We shall here only touch on typical choice-of-law approaches that key jurisdictions follow in adjudicating contractual issues. The European Union has enacted the

(reading Twitter terms of service narrowly to avoid implying that, in posting his work online, an author licensed its use to others).

¹⁹² Germany, Gesetz über Urheberrecht und verwandte Schutzrechte (Law on Copyright and Related Rights), §§ 31 *et seq.* and 79(2).

¹⁹³ See, generally, A. Peukert, "Protection of Authors and Performing Artists in International Law—Considering the Example of Claims for Equitable Remuneration Under German and Italian Copyright Law," 35 I.L.C. 900 (2004) (arguing that any copyright-contract provision protecting authors or performers in any E.U. member state has to be applied in favor of all E.U. authors or performers from other such states).

¹⁹⁴ See P. Katzenberger, "Protection of the Author as the Weaker Party to a Contract under International Copyright Contract Law," 19 I.L.C. 731 (1988).

¹⁹⁵ See § 6[3][c][i] *infra*.

¹⁹⁶ On such issue analysis and ensuing *dépeçage*, generally, see §§ 1[3][b] and 1[3][c] *supra* and, for further examples, §§ 3[1][a][ii], 6[2][c], and 6[3][a] *supra* and § 6[3][c][i] *infra*.

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so-called Rome I Regulation on the law applicable to such contractual obligations as it specifies.¹⁹⁷ Thus, like many civil-law jurisdictions, it has codified choice-of-law rules for contracts, leaving relevant principles of general law to guide courts in deciding or defusing conflicts of laws that these rules do not cover.¹⁹⁸ The *Second Restatement of Conflict of Laws* recapitulates rules that U.S. case law has developed on point but may further elaborate over time.¹⁹⁹

Parties may, as a matter of principle, choose the contract law to govern their agreement.²⁰⁰ Hard cases arise when parties dispute whether they concluded any contract at all or, even when they admit some agreement between themselves, they disagree about which law should govern their contract.²⁰¹ In the default case, where there is no clear and valid choice of law by the parties, the contract-conflicts regime typically dictates applying the contract rules of the law “local,” or “most closely connected,” to the parties or to any underlying transaction.²⁰² For example, in the European Union, the Rome I Regulation normally governs any contract, if it is not otherwise subject to party choice of law or to any special rule, by the law of the country of the party who is to render the “characteristic performance.”²⁰³ Where, as online, an agreement proves hard to localize, issues may be argued to be subject to widely applied rules, notably that of narrow construction for copyright grants.²⁰⁴

¹⁹⁷ Regulation (EC) 593/2008 of the European Parliament and of the Council of 17 June 2008 on the law applicable to contractual obligations (Rome I), O.J. 2008 L 177.

¹⁹⁸ See, e.g., T. Kono, “Recent Judgments in Japan on Intellectual Property Rights, Conflict of Laws and International Jurisdiction,” in J. Drexl and A. Kur (eds.), *Intellectual Property and Private International Law—Heading for the Future*, 229 (Hart, 2005) (example of relevant code-based analyses in another civil-law jurisdiction).

¹⁹⁹ American Law Institute, *Restatement (Second) of Conflict of Laws*, vol. 1, §§ 186–188 (1971) (1988 Revisions).

²⁰⁰ See, generally, Rome I Regulation (EC) 593/2008, Art. 3(1), O.J. 2008 L 177 (imposing, absent countervailing factors, “the law chosen by the parties”); American Law Institute, *Restatement (Second) of Conflict of Laws*, vol. 1, § 186 (1971) (1988 Revisions) (favoring party choice).

²⁰¹ See, generally, A. Ehrenzweig and E. Jayme, *Private International Law*, vol. 3, 30 *et seq.* (Oceana, 1972 [vol. 1], 1977 [vol. 3]) (supporting such choice of laws as validate the parties’ agreements). *But see*, e.g., Tribunal Fédéral (Supreme Court) (Switzerland), Sept. 8, 2014, SIC 2015, 57 (without the parties’ express choice of law, applying the law of the home state of the party holding rights to transfer).

²⁰² See Rome I Regulation (EC) 593/2008, Art. 4, O.J. 2008 L 177 (setting out factors for localizing laws applicable to distinct types of contracts absent effective party choice); American Law Institute, *Restatement (Second) of Conflict of Laws*, vol. 1, §§ 187–188 (1971) (1988 Revisions) (moving from party choice to localization criteria for determining applicable law).

²⁰³ Rome I Regulation (EC) 593/2008, Art. 4(2), O.J. 2008 L 177. See, generally, P.A. De Miguel Asensio, “The Law Governing International Intellectual Property Licensing Agreements (A Conflict of Laws Analysis),” in J. de Werra (ed.), *Research Handbook on Intellectual Property Licensing*, 312 (Edward Elgar, 2013) (analyzing how to apply the Rome scheme to contracts licensing or otherwise dealing in intellectual property).

²⁰⁴ Compare § 6[2][b][ii] *in fine supra* (proposing this general approach to consensually allocating rights in works made online), with § 6[3][a][ii] *supra* (specifically focusing on narrow construction).

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The law applicable to a contract by default, that is, if the parties fail to agree on any effective choice-of-law clause, may turn on the contractual issue in question.²⁰⁵ The commentary supports applying contract rules of only one law to as many contractual issues as feasible in a given case, for example, to issues of form, substance, performance, etc.²⁰⁶ Most authorities favor treating the requirement of a writing, not as an evidentiary or procedural rule of the forum, but as a formal or substantive rule, subject to the law of the contract.²⁰⁷ In particular, the law of the country where the contract is concluded may sometimes govern whether the contract must be reduced to writing or meet other formal requirements.²⁰⁸ In any event, the contract-conflicts regime, whether operative through a choice-of-law clause or codified rules, governs only the choice of laws applicable to contractual issues.²⁰⁹ By the same token, the copyright-conflicts regime, notably determining laws applicable to infringement, may not be set aside by any choice-of-law provision.²¹⁰

Beyond contractual aims, such as freedom of choice and the reliability of transactions, the choice of contract laws sometimes gives way to other public policies. The E.U. Rome I Regulation allows an “overriding mandatory provision,” codifying public policy in either the forum country or the country of performance, to prevail over chosen or default contract law.²¹¹ It also provides that contract law may be set aside if its “application is manifestly incompatible with the public policy (*ordre public*) of

²⁰⁵ On characterizing issues in cross-border cases generally, see § 1[3][b] *supra*.

²⁰⁶ Compare E. Rabel, *The Conflict of Laws: A Comparative Study*, vol. 1, 100–101 (Univ. of Michigan Press, 2d ed., 1958) (favoring the application of “one convenient law” to the entire contract “so far as feasible” and warning that “a contract should not be split on *a priori* grounds”), with A. Ehrenzweig and E. Jayme, *Private International Law*, vol. 1, 119–121, vol. 3, 9 (Oceana, 1972 [vol. 1], 1977 [vol. 3]) (favoring the consideration of some issues together to see whether they may appropriately be governed by one law, while expressing reservations toward dictating one law as “applicable to the entire transaction”).

²⁰⁷ See American Law Institute, *Restatement (Second) of Conflict of Laws*, vol. 1, § 141 (1971) (1988 Revisions); E. Rabel, *The Conflict of Laws: A Comparative Study*, vol. 1, 50–52 (Univ. of Michigan Press, 2d ed., 1958).

²⁰⁸ See, e.g., Rome I Regulation (EC) 593/2008, Art. 11, O.J. 2008 L 177 (governing issues of form by the law governing the contract “in substance” or that effective at the *situs* either of conclusion or of the parties). See also European Max-Planck-Group for Conflict of Laws in Intellectual Property (CLIP), *Principles for Conflict of Laws in Intellectual Property*, Art. 3:504 (Dec. 1, 2011) (following this approach in cases of contracts dealing in intellectual property, albeit with slight variations).

²⁰⁹ See, generally, Rome I Regulation (EC) 593/2008, Art. 12, O.J. 2008 L 177 (enumerating the types of contractual issues subject to the laws that an effective choice-of-law clause or codified choice-of-law rules may make applicable to a contract and governing only any arguable overlap with procedural laws, not substantive laws of another field).

²¹⁰ See, e.g., *Zenger-Miller, Inc. v. Training Team, GmbH*, 757 F. Supp. 1062 (N.D. Cal. 1991) (U.S.) (refusing to read a choice-of-law clause as compelling a choice of copyright law). See also § 3[1][a][i] *supra* (on treaty basis of the copyright-conflicts regime) and § 6[3][c][i] *infra* (globally accommodating it with the contract-conflicts regime).

²¹¹ See Rome I Regulation (EC) 593/2008, Art. 9, O.J. 2008 L 177 (specifying how the court may set contract law aside only after taking account of the “nature and purpose” and “the consequences” of applying a mandatory rule *vel non*).

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the forum.”²¹² The *Second Restatement of Conflict of Laws*, encapsulating U.S. law, conditions the party choice of contract law by reference to matters of “fundamental policy.”²¹³ Below we shall propose a method for disentangling copyright from contractual issues and accommodating policies motivating copyright *cum* contract rules.²¹⁴

[ii] Forms; Construction; Terms Set by Law

As noted above, the contract-conflicts regime determines which contract law governs the resolution of issues that a court characterizes as contractual.²¹⁵ There are various sources for contract rules: for example, civil and commercial codes, as well as the common law, impose requirements for written instruments, language for specific types of contracts, modes of interpretation, reformation, etc. Copyright laws vary considerably in ignoring, presupposing, or setting out such rules or in supplementing general rules with special copyright-contract rules. Treaty, regional, or federal law, however denominated, may also have to be considered.²¹⁶

Start with issues of form. Specific rules may, for example, call for a writing to transfer copyright. Or rules may require each right to be specifically mentioned in order for it to be transferred or, at least, language reasonably understood to such effect. Following the approach just proposed, with regard to such issues, the contract-conflicts regime applies the law of the contract, for example, that chosen by the parties or, absent choice, that of the country of characteristic performance or that effective where the contract was concluded or the parties located.²¹⁷ The case law tends to confirm this approach, even though it may result in not applying rules of form that have author-protective functions, for example, inhibiting the author from making hasty and ill-considered transfers or protecting the author as the weaker bargaining partner.²¹⁸

Consider this case: A French comic-strip artist authorized an English artists’ agency, by an agreement of uncertain tenor, to exploit his works in the United Kingdom, and

²¹² *Id.*, Art. 21.

²¹³ American Law Institute, *Restatement (Second) of Conflict of Laws*, vol. 1, § 187(2)(b) (1971) (1988 Revisions).

²¹⁴ See § 6[3][c][i] *infra*.

²¹⁵ See § 6[3][b][i] *supra*.

²¹⁶ Compare *Corporate Web Solutions Ltd. v. Vendorlink B.V.*, Rechtbank (District Court) Midden (Netherlands), No. HA ZA 14-217, March 25, 2015, *Computerrecht* 2015, 128 (reading the U.N. Convention on Contracts for the International Sale of Goods broadly to cover immaterial goods, in this case an online license of software reconstrued as a “sale” on the basis of the E.U. case law), *with Vault Corp. v. Quaid Software Ltd.*, 847 F.2d 255, 268–270 (5th Cir. 1988) (U.S.) (holding that U.S. state law, imposing software-licensing terms, was preempted by federal law).

²¹⁷ See § 6[3][b][i] *supra*.

²¹⁸ See, e.g., the *Hi Hotel II* decision, BGH (Germany), Sept. 24, 2014, para. 43, *GRUR Int.* 2015, 375 (holding that French law governed any contract concluded in France for taking photographs there) (as noted in § 6[3][c][i] *infra*); *Wegman c. Sté. Elsevier Science*, CA Paris, 4e ch. (France), June 2, 1999, *RIDA* 2000, no. 183, 302 (holding that U.K. law governed the form of a contract for U.K. performance, notably by a publisher located there).

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the agency conveyed rights to a British party who reconveyed rights to another third party, as did this and subsequent parties, in a series ending in a grant of rights to issue a second edition in France. The author argued that, under French law which requires a publishing contract to mention such rights expressly, the original agreement did not support authorizing any third party to grant rights for second editions in France.²¹⁹ But the French court applied the British rule, which required no such special mention, to the initial contract between the French author and the British agency.²²⁰ This contract was then held to be sufficient to grant subsequent parties the rights in French second editions.²²¹

Issues of form may shade into issues of interpretation, even into giving a contract effects that its terms do not fully compel. Suppose, for example, that a U.S. national writes a hit song, but then, in a U.S. contract concluded without a choice-of-law clause, assigns copyright in the song worldwide to a U.S. publisher, irrevocably for all media, known or unknown. Different countries have rules that could lead to restrictively construing or reforming this formally open-ended transfer to exploit the hit in unknown media: for example, some laws presume a contract not to transfer rights to exploit works in given media if the contract does not expressly specify these rights or media, and others may narrow the scope of transfers in following comparable rules. If a court treats construction as a contractual issue subject to party choice, it may apply U.S. law to our hypothetical contract concerning the hit song, since U.S. parties concluded the contract locally.²²² If all arguably applicable rules tend to functionally equivalent relief, there is no true conflict of laws, as explained above, and that result ensues.²²³

When some copyright or related law seems to require or preclude specified terms for copyright contracts, we have to ask: Does any rule to such effect apply, not like those of copyright law country by country, but rather as a contract rule contract by contract, or else as a mandatory rule of the forum?²²⁴ Consider French statutory provisions which, serving as a model for other laws, entitle authors to share in optimally negotiated, equitable proportions of copyright revenues.²²⁵ Note that, pursuant to one

²¹⁹ On such rules and publishing contracts, see “France,” herein, at §§ 4[2][b], 4[2][c], and 4[3][c][i].

²²⁰ This case, of course, predated the Rome I Regulation, discussed in § 6[3][b][i] *supra*. Ostensibly, the British agent was rendering the “characteristic performance” under the contract at issue, thus justifying the application of U.K. contract law.

²²¹ *I.P.C. Magazines Ltd. et Sté. Syndication International c. Guy Mouminoux*, CA Lyon, 1e ch., March 16, 1989, RIDA 1990, no. 144, 227.

²²² *Compare* *Agence France Presse v. Morel*, 769 F. Supp. 2d 295, 303 (S.D.N.Y. 2011) (U.S.) (requiring assent to clear terms to imply a license and finding online terms insufficient to impose such a license on an author), *with* *Boosey & Hawkes Music Publishers, Ltd. v. Walt Disney Co.*, 145 F.3d 481, 487 (2d Cir. 1998) (U.S.) (favoring “neutral principles of contract interpretation rather than solicitude for either party”).

²²³ *See* § 1[3][c] *in fine supra*.

²²⁴ For those ostensibly applying as copyright rules, see § 6[3][a][ii] *supra*.

²²⁵ France, Intellectual Property Code, Art. L. 131–4.

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of this set of French provisions, a lump-sum payment may suffice “for the assignment of rights by or to a person or enterprise established abroad.”²²⁶ This provision suggests, *a contrario*, that the aim of the rule requiring proportional remuneration calls, not for regulating foreign contractual transactions, but only for protecting domestic claimants at home. This reasoning, it will be argued, may extend to many national provisions purporting to set terms for copyright transfers, *inter alia*, in the fields of publishing, public performances, and audiovisual production: these may govern only local contracts.²²⁷ By contrast, notably to consolidate the European internal market, mandatory provisions of E.U. and member states’ laws may invalidate specified copyright-contract terms, notwithstanding any contract law that parties have chosen to govern the agreement in question.²²⁸

The Berne Convention, in Article 14*bis*(2) of its Paris Act, addresses audiovisual-production contracts, but its somewhat confused formulation is not obviously self-executing.²²⁹ To start, it confirms the discretion of the protecting country to have its law, pursuant to the copyright-conflicts regime, vest the “[o]wnership of copyright” in authors or producers of cinematographic works. Further, film authors, in undertaking to contribute their creative components to the making of such an audiovisual work, may give rise to a presumption of their consent to economic exploitation by its producer, optionally by way of a writing for such undertakings: such rules, concerning the form of transactions, would seem best governed by the contract-conflicts regime.²³⁰ Finally, according to Article 14*bis*(3), these provisions are not necessarily “applicable to” potentially major creative contributors to any audiovisual work, that is, neither “to authors of scenarios, dialogues and musical works” nor “to the principal director.”²³¹ In any event, E.U. law determines how, to the extent open-ended, Berne Article 14*bis*(2)–(3) may be implemented in member states.²³²

²²⁶ *Id.*, Art. L. 132–6 (second para.). *But see* H. Desbois, A. Françon, and A. Kéréver, *Les conventions internationales du droit d’auteur et des droits voisins*, para. 136 (Dalloz, 1976) (distinguishing this type of contractual law, applied if chosen by the parties, from others arguably violating *ordre public international*).

²²⁷ *See* § 6[3][c][i] *infra*.

²²⁸ *See, e.g.*, Regulation (EU) 2017/1128 of the European Parliament and of the Council of 14 June 2017 on cross-border portability of online content services in the internal market, Art. 7 (to enable consumers to access online contents as if these were available within their own member states, even when they travel elsewhere in the European internal market, invalidating certain contractual provisions to the contrary). *See also* § 5[4][a][i][B] *supra* (noting E.U. law that precludes some geoblocking).

²²⁹ *See* G. Koumantos, “Remarques sur l’application de l’article 14*bis* de la Convention de Berne (Stockholm)” (in English trans.: Remarks on the application of article 14*bis* of the Berne Convention (Stockholm)), RIDA 1969, no. 61, 27 (critiquing these provisions as resisting any cogent application at all).

²³⁰ *See* A. Françon, “Les droits sur les films en droit international privé” (in English trans.: Film rights in private international law), RIDA 1972, no. 74, 5.

²³¹ For another approach to initially allocating rights in audiovisual and other team works, see § 6[2][b][ii] *supra*.

²³² *See, e.g.*, *Martin Luksan v. Petrus van der Let*, C.J.E.U., 3rd ch., Feb. 9, 2012, Case C-277/10,

[c] Cases Subject to Both Conflicts Regimes

We have just broached tensions between the copyright-conflicts and contract-conflicts regimes. The former exerts centrifugal forces on any transfer of copyrights or related rights, tending to apply such diverse national laws to the transfer as govern rights it purports to convey. The latter exerts centripetal forces on any such contractual transfer, tending to govern any contract by one central law, the proper law of the contract, optimally that freely chosen by the parties. Here we shall (i) explain overriding principles and policies that may guide resolving such tensions and (ii) propose solutions for illustrative hard cases, notably of waivers of moral rights.²³³

[i] Overriding Principles and Policies

Assume a hard case where copyright and contract regimes enter into tensions. Copyright laws above all govern issues of infringement liability, while contract laws may govern issues of transfer.²³⁴ These diverse types of law cannot strictly speaking “conflict” for purposes of resolving such distinct issues, but they may push and pull on any solution, or issues might get scrambled, leading to different overall results in the same case.²³⁵ We have, for example, considered cases where copyright law in theory precludes the contractual alienation of specific entitlements, like a reversionary interest in copyright or a moral right to compel attribution of authorship or respect for the integrity of a work.²³⁶ In practice, a court may sometimes finesse doctrinal imbroglios, as indicated above, by sorting out false from true conflicts of laws or by defusing residual tensions with appropriate remedies.²³⁷ We shall here consider false and true conflicts between copyright and contract laws and, immediately below, remedial solutions for tensions with moral rights.²³⁸

Consider a case that illustrates how the threshold analysis factoring out false conflicts may prove useful. The Brazilian composer Antonio Carlos Jobim sought to assert renewal copyrights in the United States after having assigned U.S. copyrights in

[2013] E.C.D.R. 125 (precluding the initial vesting of a film director’s rights in a producer, any irrebuttable presumption of the transfer of such rights to the producer, and any transfer of inalienable entitlements to statutory remuneration).

²³³ On these tensions, see R. Plaisant, “L’exploitation du droit d’auteur et les conflits de lois” (The exploitation of copyright and conflicts of laws), RIDA 1962, no. 35, 73, at 101.

²³⁴ See, generally, §§ 1[3][b] and 1[3][c] *supra* (explaining such *dépeçage* or issue analysis in comparative and conflicts analyses). See, e.g., § 3[1][a][ii] *supra* (*dépeçage* of issues of infringement of copyright or related rights, as distinct from issues of defenses based on other laws); § 6[2][b] *supra* (distinguishing issues of vesting); § 6[2][c] (issues of transfer by law); § 6[3][a] *supra* (rules favoring creators).

²³⁵ See, e.g., M. Nimmer, “Who is the Copyright Owner When Laws Conflict?,” 5 I.I.C. 62 (1974) (speaking in such terms).

²³⁶ See, e.g., § 6[3][a] *supra* (reversionary interests); § 6[3][b] *supra* (inalienability of moral rights, along with other author-protective copyright-contract rules).

²³⁷ See, generally, § 1[3][c] *in fine supra* (overview of such methods). See, e.g., § 3[1][b] *supra* (infringement cases).

²³⁸ See § 6[3][c][ii] *infra*.

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certain songs to a Brazilian music publisher. The court in the United States ruled in favor of Jobim, citing U.S. case law which required express contract terms to convey renewal rights and noting that “United States renewal copyright reflects a vital policy of United States copyright law.”²³⁹ This ruling was questionable since the contract at issue not only involved Brazilian parties, but it provided for submitting disputes to a Brazilian forum, both factors favoring the choice of Brazilian law.²⁴⁰ If, however, the U.S. court had inquired into applicable Brazilian law and policy, it would have encountered the Brazilian rule of restrictive construction that, in the interest of protecting authors, would have also precluded any transfer of a specific right absent clear contract terms to that effect.²⁴¹ The court could have asked, as suggested above, whether the same result could have thus been reached on the basis of a false conflict, rather than rushing to apply forum law without regard for the policy interests of other jurisdictions.²⁴²

Turn now to true conflicts likely to arise as national legislators make copyright laws, including contract-relevant rules, while focused on largely local parties and interests.²⁴³ As illustrated above, in binding themselves by an international treaty, countries may limit judicial discretion to weigh competing local policies in addressing conflicts of laws.²⁴⁴ The Berne Convention, the key treaty conditioning the choice of copyright laws, may be examined to see whether its aims may also guide the choice of copyright-contract laws as well.²⁴⁵ In the Berne Convention, Article 2(6) of its Paris Act confirms that Berne “protection shall operate for the benefit of the author and his *successors in title* [emphasis added].” The drafters of this clause recognized that, with the sole exception of moral rights and *droit de suite*, Berne rights are normally transferable to contractual successors.²⁴⁶ Significantly, *droit de suite* is the only

²³⁹ *Corcovado Music Corp. v. Hollis Music, Inc.*, 981 F.2d 679, 684–685 (2d Cir. 1993).

²⁴⁰ *See, generally*, M. Nimmer and D. Nimmer, *Nimmer on Copyright*, § 9.06[A][2] (LexisNexis/Bender, annually updated) (“it is unreasonable, in this writer’s view, to subject a contract written in Portuguese, negotiated and executed in Brazil, providing that it shall be governed by local law, and by its terms intending to be all-inclusive, to an American rule of construction”).

²⁴¹ *N.b.*, the 1973 Copyright Act in effect in Brazil at the time of this case had the same rule favoring restrictive construction of the author’s contractual transfers of copyright.

²⁴² *See* § 1[3][c] *in fine supra*.

²⁴³ *See, generally*, A. Dietz, *Copyright Law in the European Community*, 190 *et seq.* (English trans., Springer, 1978) (noting that copyright-contract laws of different countries often represent nationally specific compromises between conflicting interests of authors, media entrepreneurs, and the public).

²⁴⁴ *See* § 3[1][a][i] *supra*.

²⁴⁵ The convention assured the interests of contractual successors from the start. *See, generally*, Berne, Art. II (1886) (“[a]uthors [. . .] or their lawful representatives” shall enjoy national treatment). *See, e.g.*, G. Boytha, “Fragen der Entstehung des international Urheberrechts” (Questions on the Emergence of International Copyright), in R. Dittrich (ed.), *Woher kommt das Urheberrecht und wohin geht es?* (Where does Copyright Come From and Where is it Going?), 181, 197–199 (Manz, 1988) (noting that the original Berne Act accommodated publishers’, not authors’, interests).

²⁴⁶ *See* General Report on the Work of the Brussels Diplomatic Conference for the Revision of the Berne Convention, 1948, in World Intellectual Property Organization, *1886—Berne Convention Centenary—1986*,

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copyright-like economic entitlement which the Berne Convention refrains from subjecting to full national treatment, but which it makes inalienable.²⁴⁷ *A contrario*, this writer submits, national treatment is to be granted with all due regard for the contracts allowing authors' successors to enjoy other Berne economic rights.²⁴⁸

In hard copyright-contract cases, a court may ask how to accommodate national interests in the light of such international considerations. Not only, as just argued, does Berne language discourage blind-siding any contractually based choice of contract law, but the structure of its copyright protection, applicable to foreign works, does as well. Recall that Berne obligations do not normally concern works in their respective countries of origin: thus Berne national treatment does not appear to be a plausible ground for applying local contract rules, concerning only domestic creation or exploitation, to transactions taking place across borders.²⁴⁹ Moreover, it would undercut the Berne assurance to contractual successors, notably pursuant to contracts made outside the protecting country, to have national treatment bring with it fetters to alienability that the protecting country normally applies to local copyright contracts.²⁵⁰ Such an approach would impermissibly impose the protecting country's interests and policies concerning local creator-media relationships on copyright contracts that were intended to govern the creation or exploitation of works inside other countries with different interests and policies.²⁵¹

Return to our distinction: On the one hand, the copyright-conflicts regime governs resolving a contractual issue in favor of a foreign author only when the national law of the protecting country expressly makes a contractually relevant right itself definitionally inalienable as one of the author's rights.²⁵² On the other hand, where treaty-compelled national treatment does not thus dictate results, the contract-conflicts regime comes into play, but only to control the choice of laws for resolving contractual

179 (WIPO, 1986). *See, e.g.*, *Griggs Group v. Raben Footwear*, [2005] EWCA Civ 11, para. 4 (U.K.) (citing this Berne language as supporting its decision) (discussed in § 6[2][c][ii] *supra*).

²⁴⁷ On the exclusion of *droit de suite* from full national treatment, see § 5[4][b][ii] *supra*.

²⁴⁸ *But see* P. Katzenberger, "Urhebersverträge im Internationalen Privatrecht und Konventionsrecht" (Copyright Contracts in Private International Law and the Conventions), in *Urhebervertragsrecht: Festgabe für Gerhard Schrickler* (Copyright-Contract Law: Essays in Honor of Gerhard Schrickler), 225, 246–248 (C. Beck, 1995) (questioning whether the conventions impact the choice of laws to govern copyright contracts).

²⁴⁹ For the Berne principle of national treatment, see § 2[3][b] *supra*. For the definition of the country of origin, see § 4[3][b][ii] *supra*.

²⁵⁰ *See generally* H. Desbois, A. Françon, and A. Kéréver, *Les conventions internationales du droit d'auteur et des droits voisins*, para. 136 (Daloz, 1976) ("The exploitation of rights is not to be confused with their definition. Thus, we submit, the law of the protecting country does not properly determine the term of contracts or the mode of remunerating authors; it is up to the parties, expressly or not, to choose the law they find appropriate [. . .]").

²⁵¹ *See, e.g.*, the *Hi Hotel II* decision, BGH (Germany), Sept. 24, 2014, paras. 47–50, GRUR Int. 2015, 375 (reasoning that no compelling principle or public policy, effective across borders, justified deeming a German copyright-contract rule sufficiently mandatory to override the French rule normally applicable to a contract concluded in France for performance there).

²⁵² *See* § 6[3][a][ii] *supra*.

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issues, either by reference to the agreement of the parties or to some rule of more or less mandatory character.²⁵³ We have sampled copyright-contract rules that, without defining ensuing rights as authors' or performers' rights by nature, purport to allocate economic interests fairly as between such claimants and local media industries.²⁵⁴ It is submitted that, if not specifically mandated to impose such national rules to contracts concluded abroad, courts need not so apply them for lack of obviously compelling international policies to such effect. Thus such rules would tend to be limited in effect to the local, or at most regional, parties whose transactions they were intended to regulate.²⁵⁵

[ii] Moral Rights and Contracts

How to disentangle the copyright-conflicts and contract-conflicts regimes in the hard cases where moral rights are invoked against contractually acquired economic rights, notably the right to adapt a work? Article *6bis* of the Berne Convention suggests that moral rights remain the author's after the conveyance of all economic rights, but it does not definitively preclude moral rights from being contractually impaired.²⁵⁶ Indeed, domestic case laws, even statutes at points, allow for the consensual waiver of moral rights in appropriate circumstances, even in countries where these rights are ostensibly deemed contractually inalienable.²⁵⁷ It will here be argued that courts may in some cases remedially accommodate moral rights with contractually acquired economic rights.²⁵⁸

But what does "accommodation" mean in this context?²⁵⁹ Judges have repeatedly had to resolve tensions between the theoretically inalienable character of moral rights and the practical exigencies of contractual transactions.²⁶⁰ This they have often done by crafting remedies for violations of moral rights that minimally impair the legitimate claims of the holders of economic or contractual rights. For example, in the now-classic *Whistler* case, the artist Whistler had painted a portrait of Lord Eden's

²⁵³ See § 6[3][b][i] *supra*.

²⁵⁴ See § 6[3][b][ii] *supra*.

²⁵⁵ *But see, e.g.*, J. Ginsburg and P. Sirinelli, "Private International Law Aspects of Authors' Contracts: The Dutch and French Examples," 39 *Columbia J. Law & Arts* 171, 191–193 (2015) (proposing complex choice-of-law rules here, rather than case by case analysis).

²⁵⁶ See, generally, S. Ladas, *The International Protection of Literary and Artistic Property*, vol. 1, 599–600 (Macmillan, 1938) (noting "the intention of the Convention [. . .] to leave this question [of waiver of moral rights under Article *6bis*] to the determination of the law of each country").

²⁵⁷ Compare "France," herein, at §§ 7[2] and 7[4] (noting waiver only in cases), with "Germany," herein, at §§ 7[1] and 7[4] (indicating statutory openings for judicially balancing of authors' and transferees' interests), and "Switzerland," herein, at §§ 4[2][a] and 7[4] (outlining guidelines in copyright statute and civil code to such effect).

²⁵⁸ For analysis disentangling false from true conflicts of laws and defusing residual conflicts remedially, see § 1[3][c] *in fine supra*.

²⁵⁹ For examples in infringement cases, see §§ 3[1][b][ii][B], 3[1][b][iii][B], and 3[1][b][iii][C] *supra*; in chain-of-title cases, §§ 6[2][b][ii], and 6[2][c][ii] *supra*.

²⁶⁰ In the chapters herein on national laws, see §§ 2[3], 4[2], and 7.

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wife on commission but then refused to deliver it: the French court only conditionally allowed Whistler to exercise his moral right to control disclosure of his work.²⁶¹ Whistler could withhold the portrait from the Edens, but he had to make the initial model unrecognizable for purposes of future displays, to make restitution of all payments received, and to pay damages for non-delivery.²⁶² If moral rights are by nature a creature of judge-made law, the process of judicially reconciling them with contractually acquired rights may be considered as part and parcel of their definition.²⁶³

Judicial accommodation may employ remedial devices that take account of the parties' reasonable expectations. For example, German copyright law conditions the moral right of integrity by allowing such modifications of a work as the author could not in good faith refuse.²⁶⁴ The German Federal Court of Justice dealt differently with each of a pair of cases on point: in both, it found that the integrity of theatrical works had been impaired as a result of modified stagings. In one case, the court allowed the modifications, made a half-century after the original staging, finding them to fall within the bounds of good faith; in another case, it barred modifications reducing the original play "to a more or less meager skeleton of" itself.²⁶⁵ Italian courts have dealt with the televising of motion pictures interrupted by "spot" advertising commercials that, as film creators claimed, violated their moral rights of integrity. One first-instance trial court ordered spot commercials to be timed so that both the televisioner's exploitation rights and the film creators' moral rights would be minimally impaired. It tried remedially to reconcile the foreseeable "demands of commercializing a film and the respect for the unity of a work."²⁶⁶

Suppose that a U.S. playwright agrees, in an agreement subject to California contract law, to have his play adapted into a motion picture. But the playwright later brings suit for a violation of his right to integrity when the motion picture is shown in

²⁶¹ William Eden c. Whistler, Cass., March 14, 1900, Dalloz 1900, I, 63.

²⁶² *Id.* See S. Strömholm, *Le droit moral de l'auteur* (Author's Moral Right), vol. I, pt. 1, 283 (Norstedt & Soners Forlag, 1966) ("Thus the Supreme Court tried to find a formula that allowed for safeguarding both the personal interests of the artist and the force of contracts.").

²⁶³ See, generally, J. Dufaux, "Equity and French Private Law," in R.A. Newman (ed.), *Equity in the World's Legal Systems: A Comparative Study*, 245 (Bruylant, 1973) (explaining that Anglo-American notions of equity correspond in functions with such general principles of civil law as abuse of right).

²⁶⁴ Germany, Gesetz über Urheberrecht und verwandte Schutzrechte (Law on Copyright and Related Rights), § 39.

²⁶⁵ Compare the *Oberammergau Passion Play* decision, BGH (Germany), Oct. 13, 1988, GRUR 1989, 106, note U. Loewenheim (applying the German Copyright Act, which permits modifications the author may not in good faith refuse, and allowing modifications in the set design for a play), with the *Maske in Blau* decision, BGH, April 29, 1970, GRUR 1971, 35, note E. Ulmer, in English trans. in 2 I.I.C. 209 (1971) (allowing for creative discretion in staging a play, but not to the point of allowing modifications that reduce the work "to a more or less meager skeleton of" its original version).

²⁶⁶ The *Serafino* decision, Trib. Rome (Italy), May 30, 1984, Dir. aut. 1985, 68, at 74–75, note M. Fabiani, *reversed in part*, CA Rome, Oct. 16, 1989, Dir. aut. 1990, 98. The first-instance trial court took notice of the fact that the "networks" principally made money from the "spot" commercials accompanying the otherwise free televising of motion pictures and tried to resolve tensions "between the demands of commercializing a film and the respect for the unity of a work."

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Germany in a creatively adapted version which he now finds objectionable. Would California or German standards apply in ascertaining whether the adaptation had been made in such good faith as would allow its performance in Germany in the face of the integrity claim? There might be some intuitive sense in which most judges understand notions like “good faith,” but that sense would still have to be particularized in the light of the laws specifically relevant to each case.²⁶⁷ Thus, in our hypothetical case, California standards of construction and performance should influence how the parties may in good faith understand and comply with their contract, while German law governs moral rights. Note that the California law of contracts and the German law of moral rights need not be considered to be in conflict in this case for the simple reason that they apply to quite different aspects of the case. Any standard of California law could serve only as a transactional fact relevant to the judicial accommodation of moral rights, arising under German law.²⁶⁸

Consider, in turn, the French moral right of integrity, which, codified as inalienable, benefits foreign as well as national creators as a matter of French law.²⁶⁹ To assure respect for the integrity of an audiovisual work, Article L. 121–5 of the French Intellectual Property Code precludes modification of an audiovisual work once a “final version” has been made of it by the “common accord” of the producer and director, along with other coauthors.²⁷⁰ A court may characterize this particularly French rule precluding the modification of the “final version” of an audiovisual work as fashioned to regulate French transactions concerning such works.²⁷¹ In theory, for reasons already explained, the court need not apply this rule in so many words to audiovisual works produced outside France in countries where, in practice, the rule is not thus in force.²⁷² However, the court may take notice of comparable procedures, whether legal

²⁶⁷ See, generally, B. Dutoit, “Good Faith and Equity in Swiss Law,” in R.A. Newman (ed.), *Equity in the World’s Legal Systems: A Comparative Study*, 307, 310–317 (Bruylant, 1973) (considering “good faith” as an attitude of “reciprocal trust and consideration in the light of the purpose of the legal norm” guiding the parties’ conduct, so that its sense in any given case can only be clarified by referring to applicable laws).

²⁶⁸ See, generally, A. Ehrenzweig and E. Jayme, *Private International Law*, vol. 1, 83–85, vol. 3, 9–11 (Oceana, 1972 [vol. 1], 1977 [vol. 3]) (observing that a foreign standard of equity or fairness may be noticed as such a fact by a court). See also § 1[3][c] in *fine supra* (indicating the role of such a *datum* in conflicts analysis generally).

²⁶⁹ See, generally, § 3[2][b] *supra* (explaining the unilateral protection of foreign creators’ moral rights). See, e.g., the *Asphalt Jungle* decision, *Huston v. Turner Entertainment*, Cass., 1^e ch. civ. (France), May 28, 1991, RIDA 1991, no. 149, 197, in English trans. in 23 I.I.C. 702 (1992), *followed on remand*, CA Versailles, chs. réunies, Dec. 19, 1994, RIDA 1995, no. 164, 389 (as discussed in §§ 4[2][a][ii] and 6[2][b][i] *supra*).

²⁷⁰ See also France, Intellectual Property Code, Art. L. 113-7 (presuming “coauthors” of an audiovisual work to include the director, any screenwriter, notably of any screenplay, dialogue, etc., and any soundtrack composer or lyricist, while recognizing the authorship of any creator of any underlying work).

²⁷¹ For background of the rule as codified, see B. Edelman, *Droits d’auteur, droits voisins* (Author’s Rights, Neighboring Rights), 59 (Daloz, 1993).

²⁷² See § 6[3][c][i] *supra*.

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or customary, in which foreign film authors invoking their French moral rights may have participated at home.²⁷³ In the light of such a *datum*, it could craft remedies for such rights to the extent that they were not already exercised, delegated, or waived.²⁷⁴

Moral rights remain somewhat of a wild card in the deck of rights dealt out to authors and performers worldwide. Most notably, following diverse theories of the relationship of moral to economic rights, the right to integrity may vary in alienability.²⁷⁵ Nonetheless, actual practices in which parties engage in exercising moral and economic rights may illuminate how to short-circuit conflicts of laws on point in cross-border cases. For example, a court may take account of the fact that a moral right is hedged by home law or delegated or waived by contract or in a course of dealing local to the parties.²⁷⁶ This approach, just illustrated, allows judges more consciously, and perhaps more consistently, to do what they often do implicitly: equity. They may thus fashion relief while defusing some conflicts of laws.²⁷⁷

²⁷³ *N.b.* procedures in which a film director decides on a final edit, the so-called director's cut, or even decides on the final version.

²⁷⁴ On the *datum* in conflicts analysis generally, see § 1[3][c] *in fine supra*.

²⁷⁵ On such theories and practice, see §§ 2[1][c][i] and 2[2][b] *supra*.

²⁷⁶ *See, e.g.*, *Fahmy v. Jay-Z*, D.C. No. 2:07-cv-05715-CASPJW (9th Cir. 2018) (U.S.) (confirming, in the light of Egyptian law and contract, that the transfer of a U.S. derivative-work right was not burdened by any Egyptian author's moral right effective in the case).

²⁷⁷ On this method of choice of law, see § 1[3][c] *in fine supra*.