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“With untired spirits and formal constancy”*: Berne-Compatibility of Formal
Declaratory Measures to Enhance Title-Searching

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* Shakespeare, Julius Caesar, II, I.

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“WITH UNTIRED SPIRITS AND FORMAL CONSTANCY”*: BERNE-COMPATIBILITY OF FORMAL DECLARATORY MEASURES TO ENHANCE COPYRIGHT TITLE-SEARCHING

*Jane C. Ginsburg***

I. INTRODUCTION

Formalities are back in fashion. Their acolytes fall into two camps, reflecting their different objectives. For formalities, which we shall define as conditions on the existence or enforcement of copyright, can divest authors of their rights, or instead enhance authors’ exploitation of their works by alerting their audiences to the authors’ claims. For one camp, formalities’ confiscatory consequences, once perceived as barbaric,¹ are to be celebrated.² The more works from their authors’ rights untimely ripped, cast into the public domain, or amputated in their enforcement, the better. Formalities can supply the cure for all copyright’s ills, from over-inclusive subject matter, to over-strong rights and remedies, to over-long duration. Worried that copyright’s low originality threshold embraces shopping lists and such? A notice requirement will flush out such unworthy scribblings. Scared of strike suits from obscure authors emerging from the woodwork to claim the latest hit song, blockbuster film, or bestselling novel as the fruit of their own inspiration? Locking the courthouse door to the unregistered, or precluding statutory damages, will keep them and their contingency-fee’d counsel back behind the wainscoting where they belong. Distressed that copyright’s term just keeps going and going and going? Imposing a renewal obligation early and often will ensure that only those works whose proprietors truly “care” about them will get the full copyright term. That copyright-divesting or -disabling formalities tend in practice to penalize

* Shakespeare, Julius Caesar, II, 1.

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1 *Comments of John M. Kernochan* (1986), reprinted in *Final Report of the Ad Hoc Working Group on U.S. Adherence to the Berne Convention*, 10 COLUM.-VLA J.L. & ARTS 513 app. B at 685, 689 (1986) (“The present sanction of forfeiture, in particular, is barbaric in its impact (i.e., it may wipe out the entire value of years of creative effort); it is disproportionate to any ends served and should be done away with.”)

2 See, e.g., Christopher Sprigman, *Reform(aliz)ing Copyright*, 57 STAN. L. REV. 485 (2004); James Gibson, *Once and Future Copyright*, 81 NOTRE DAME L. REV. 167, 168 (2005) Lawrence Lessig, *Re-Crafting a Public Domain*, 18 YALE J.L. & HUMAN. 56 (2006); Martin Skladany, *Unchaining Richelieu’s Monster: A Tiered Revenue-Based Copyright Regime*, 16 STAN. TECH. L. REV. 131 (2012); cf. Séverine Dusollier, *(Re)Introducing Formalities in Copyright as a Strategy for the Public Domain*, in OPEN CONTENT LICENSING: FROM THEORY TO PRACTICE 75 (Lucie Guibault & Christina Angelopoulos, eds. 2011) (advocating formalities as a means to opt *out* of—rather than into—copyright protection).

individual creators far more than corporate copyright owners³ does not dissuade the forces of formalities, for authorship has little purchase with these advocates of the formality-fed public domain.

A second camp enlists formalities to populate not the public domain, but the public record.⁴ Notice, registration, and recordation, as declaratory measures, inform the public of the author's claims and, by facilitating rights clearance, help the author disseminate and derive compensation from her work. I prefer to call title-searching information “declaratory measures” rather than “formalities” because only “formalities,” in their Berne Convention sense (as we shall see), entail the loss of copyright or truncation of its scope or the limitation of remedies. The aspirations of the second camp tend toward information rather than confiscation, but many may be concerned that only the threat of the latter will impel provision of the former.⁵

The perceived need to give title-searching measures teeth by penalizing authors who fail to declare or to register their claims allows the rhetoric of reformalization to conflate formalities' two distinct goals. Recognizing that the “good cop” face of formalities tied to title searching may attract more followers than the “bad cop” function of expropriating authors, some reformalizers may offer the kinder, gentler rationale of reducing search costs in support of declaratory obligations whose nonfulfillment will confiscate the copyright.⁶ Not all the laments about high transactions costs,

3 Julia D. Mahoney, *Lawrence Lessig's Dystopian Vision*, 90 VA. L. REV. 2305, 2329–30 (2004) (reviewing LAWRENCE LESSIG, *FREE CULTURE: HOW BIG MEDIA USES TECHNOLOGY AND THE LAW TO LOCK DOWN CULTURE AND CONTROL CREATIVITY* (2004)):

What Lessig neglects to mention is that all formalities impose burdens, and that those burdens are experienced most keenly by the inexperienced and uneducated. While it is by no means definite that the costs of more formalities would outweigh the benefits, Lessig should at least acknowledge that corporate copyright holders are likely to have a much easier time negotiating the system than the lone individual creator, and that a turn to more formalities could bestow an advantage on none other than the ‘Big Media’ interests Lessig abhors.

Niva Elkin-Koren, *What Contracts Cannot Do: The Limits of Private Ordering in Facilitating a Creative Commons*, 74 FORDHAM L. REV. 375, 383 n.27 (2005) (noting formalities “could actually discriminate against individual creators who are unable to carry the burden of legal counseling and registration.”); Brad A. Greenberg, *More Than Just a Formality: Instant Authorship and Copyright's Opt-Out Future in the Digital Age*, 59 UCLA L. REV. 1028, 1048–50 (2012) (discussing costs to individual creators of complying with registration formalities).

4 See, e.g., STEF VAN GOMPEL, *FORMALITIES IN COPYRIGHT LAW* (2011); Jane C. Ginsburg, *The U.S. Experience with Mandatory Copyright Formalities: A Love/Hate Relationship*, 33 COLUM. J.L. & ARTS 311, 316 (2010).

5 See, e.g., VAN GOMPEL, *supra* note 4, ¶ 1.3, at 12 (excluding purely voluntary measures from consideration “because they can produce limited effects only, given that their compliance relies on goodwill and proactivity on the part of authors and copyright owners”); David Fagundes, *Crystals in the Public Domain*, 50 B.C. L. REV. 139, 178–80 (2009) (positing “orphan works issue” as “an information problem that blocks the functioning of well-defined entitlements” and proposing as solution “mak[ing] availability of the full panoply of copyright remedies . . . contingent on compliance with registration, notice, and recordation provisions,” such that “[a]uthors who fail to comply would still enjoy copyrights, but these rights would be enforceable only through a default license so that infringers could use the work so long as they pay a nominal statutory fee”). *But see* Ginsburg, *supra* note 4, at 346 (claiming “[a]n efficient registration system may provide its own best incentive” but noting “we are not likely to enjoy such a centralized system unless it is adequately staffed and supported by government funding.”).

6 See, e.g., Lessig, *supra* note 2, at 70–71:

[I]f permission is required, then we need a way to know from whom that permission must be secured. Yet the abolishment of formalities has removed any easy possibility of knowing. A work is protected

however, withstand analysis. For even were authors easily found and negotiations simplified, the real problem for many enthusiasts of formalities is having to transact at all, when, in their view, the object of the proposed transaction should not, or should no longer, be protected in the first place.⁷

This Article addresses the Berne Convention’s prohibition on the imposition of “formalities” on the “enjoyment and the exercise” of copyright,⁸ and the compatibility with that cornerstone norm of declaratory measures to enhance title-searching. In the Berne context, “enjoyment” means the existence and scope of rights; “exercise” means their enforcement. *Voluntary* provision of title-searching information on a public register of works and transfers of rights is fully consistent with Berne and should be encouraged. But may a member state impose sanctions or disabilities on foreign authors for failure to supply that information? I specify “foreign authors,” because the Berne Convention’s minimum substantive norms (including the no-formalities rule) do not apply to domestic authors in the work’s country of origin.⁹ So, in theory, the United States could go back to punishing its own authors by re-enacting notice and registration requirements whose non observance will deprive the work of protection or render any rights unenforceable. But this theory breaks down under two pressures. One is political, for a member state may not long treat its own creators much worse than foreigners. The other is practical, as digital media facilitate manipulation of a work’s country of origin through remote first publication in a country less benighted than the author’s residence.¹⁰ Most of the prescriptions this Article offers will therefore apply equally to U.S. and to foreign works.

Part II of this Article will address conditions on the existence or enforcement of rights. It concludes that “formalities” prerequisite to the initial attachment or persistence of protection, or that limit the scope of minimum rights or the availability of remedies, violate the norms of

whether or not you can identify who the owner is; it is a felony to use that work in certain ways, even if there is no one to ask for the permission to use it.

See also Gibson, *supra* note 2, at 227–28:

Perhaps most important, registration could help lower troublesome search costs. Consider that a potential licensee of a work must incur the expense of identifying and tracking down the copyright owner before licensing negotiations can even begin. If the copyright owner’s name and address are not readily available, these search costs might prove prohibitive, even when the copyright owner would gladly have issued the license for a reasonable price, or for free. If the law required authors to include their names in a copyright notice and record any subsequent assignments of copyright in a public registry, these costs could be avoided or significantly reduced. (footnote omitted)

⁷ [Cross-reference to Fred von Lohman’s contribution to this Symposium on the “dark matter of the internet”]

⁸ *See* Berne Convention for the Protection of Literary and Artistic Works art. 5(2), Sept. 28, 1979, S. Treaty Doc. No. 99-27 [hereinafter Berne]. Similar prohibitions exist in other multilateral conventions to which the United States is a party, *see, e.g.*, Agreement on Trade-Related Aspects of Intellectual Property art. 9(1), Apr. 15, 1994, 1869 U.N.T.S. 299 [hereinafter TRIPS] (“Members shall comply with Articles 1 through 21 of the Berne Convention (1971) and the Appendix thereto.”); WIPO Copyright Treaty art. 1(4), Dec. 20, 1996 (extending protection to computer programs and databases: “Contracting Parties shall comply with Articles 1 to 21 and the Appendix of the Berne Convention.”); WIPO Performances and Phonograms Treaty art. 20, Dec. 20, 1996 (extending protection to sound recordings and certain performances: “The enjoyment and exercise of the rights provided for in this Treaty shall not be subject to any formality.”); *see also* Beijing Treaty on Audiovisual Performances art. 17, June 24, 2012 (extending protection to audiovisual fixations of performances and certain unfixed performances: “The enjoyment and exercise of the rights provided for in this Treaty shall not be subject to any formality.”).

⁹ *See* Berne, *supra* note 8, art. 5(3).

¹⁰ *Id.* art. 5(4) (defining the “country of origin” of a work).

Berne and subsequent multilateral instruments. By contrast, it may be permissible to condition Berne+ subject matter or rights on compliance with declaratory measures. The Berne+ path, however, risks descending into controversies of characterization, as one contender’s “plus” proves another’s “minimum” norm.

Part III of this Article will consider declaratory measures regarding ownership of rights under copyright. The Berne Convention generally does not cover copyright ownership, and one may urge that conditions on *who* may enjoy or exercise rights are a matter distinct from disabilities imposed on existence or enforcement in general. Accordingly, requiring transferees to provide information pertaining to the transfer of rights, and imposing sanctions for noncompliance, should be Berne-compatible. Specifically, I propose making the validity of a transfer of copyright depend on the transferee’s recordation in the Copyright Office of the contract or “a note or memorandum of the transfer”¹¹ containing sufficient information to permit third parties to ascertain who owns what rights in the work.¹² Part III then endeavors to resolve some of the practical problems a mandatory recordation of transfer obligation might engender. These include time limits for recording the transfer, gaps in the title-searching record, and effect on transfers of rights in non-U.S. works when the United States is one of the territories covered by the grant.

II. EXISTENCE AND ENFORCEMENT

A. HISTORY AND INTERPRETATION OF THE BERNE NO-FORMALITIES RULE

From the outset of the mid-19th century movement for international copyright, authors advocated the abolition or restriction of formalities. In the 19th century, to obtain protection at home and abroad, an author would have needed to comply with the formalities of each country in which he sought protection—assuming the country of which the author was not a national extended any protection at all to foreign claimants.¹³ Proper compliance was cumbersome, costly, and often unsuccessful, hence authors’ demand as early as the first international Congress aimed at securing authors’ rights, held in Brussels in 1858, that authors be protected in all countries so long as they satisfied whatever formalities their home countries imposed. The 1886 and 1896 versions of the Berne Convention adopted this approach.¹⁴

In practice, however, it turned out to be difficult to prove to foreign authorities that the author had complied with the country of origin’s formalities.¹⁵ As a result, the 1908 Berlin revision prohibited the imposition of formalities on foreign authors altogether, although member states

11 *Cf.* 17 U.S.C. § 204(a) (validity of a transfer dependent on writing signed by transferor). While the transferee could record the entire contract, concerns for confidentiality of information concerning price and non-copyright aspects of the agreement might warrant recording something less than the entire contract—so long as the document contains information essential to rights-clearance. *See* Copyright Office policy decision on recordation of documents, part 3. “redaction of documents” <http://www.copyright.gov/fedreg/2005/70fr44049.html>; 37 C.F.R. 201.4(c)(2); Copyright Office Compendium II Copyright Office Practices, sec 1610.

12 17 U.S.C. § 205 permits, but does not require recordation of contracts of transfer.

13 Sam Ricketson and Jane C. Ginsburg, *INTERNATIONAL COPYRIGHT AND NEIGHBORING RIGHTS: THE BERNE CONVENTION AND BEYOND* (2006) [hereinafter “Berne Book”], ¶¶ 1.19, 1.40.

14 *Id.* ¶¶ 6.102–103, 6.83–6.85.

15 *Id.* ¶¶ 6.86–6.87.

remained free to require that domestic authors affix notice, register claims, and/or deposit copies with local authorities.¹⁶ And, to ensure that an author’s failure to carry out domestic formalities—with a consequent loss of protection in the country of origin—would not affect the availability of international protection, the Berlin revisers specified that “apart from the provisions of this Convention, the extent of protection, as well as the means of redress afforded to the author to protect his rights, shall be governed exclusively by the laws of the country where protection is claimed.”¹⁷ The effect of this language was to confer copyright throughout the Berne Union, automatically and upon creation, on every Convention-covered work created by an author who was a national of a Berne Union member state, or first published within a member state. The no-formalities rule thus fundamentally undergirds the Berne Convention system of universal international authors’ rights.

But what are “formalities” in the Berne sense? Article 5(2) declares that “the enjoyment and the exercise of these rights shall not be subject to any formality.”¹⁸ Although earlier texts refer to “conditions and formalities,” it has long been understood that the term “any formality” encompasses both “formal and material conditions” on the existence or enforcement of rights.¹⁹ “These rights” are “the rights which the[] respective laws [of the countries of the Union] do now or may hereafter grant to their nationals, as well as the rights specially granted by this Convention.”²⁰ Thus, a foreign author is entitled to national treatment in Berne member states (but without having to comply with any formalities the state may impose on its own authors), as well as to any additional Convention-guaranteed rights, even if these are not afforded to local authors.

The “enjoyment” of local or Berne minimum rights extends to “everything which must be complied with in order to ensure that the rights of the author with regard to his work may come into existence’. These would include such requirements as registration, the deposit or filing of copies, the payment of fees, or the making of declarations.”²¹ In addition to the initial attachment of protection (since 1908 automatic upon creation for authors from other Berne member states), the concept of “enjoyment” of copyright would include the persistence of protection for the minimum Berne term of copyright; obligations to register and renew copyrights thus would fall under the prohibition.²² The scope of rights (including any limitations or exceptions) also comes within the “enjoyment” of Berne and national rights.²³ A member state may neither condition the initial attachment of copyright on compliance with formalities nor subsequently deny coverage of particular rights to

16 *Id.* ¶¶ 3.12, 6.87.

17 Berne, *supra* note 8, art. 5(2) (art. 4(2) in the Berlin revision).

18 *Id.*

19 *See generally* Berne Book ¶¶ 6.102-6.104.

20 Berne, *supra* note 8, art. 5(1).

21 Berne Book ¶ 6.103, quoting the German delegate Meyer at the 1884 Diplomatic Conference, *Actes* 1884.

22 *See e.g.*, VAN GOMPEL, *supra* note 4, at 195.

23 In addition to art 5(1)’s command that “Authors shall enjoy” rights under national law and under Berne minima, Berne arts. 11, 11bis, 11ter, 12 and 14bis all provide that “authors shall enjoy” the specific minimum rights to public performance, adaptation and cinematographic works.

authors who fail to meet declaratory obligations. Thus, for example, a member state may not make the adaptation right²⁴ subject to registering the work or filing a notice of reservation of rights.

Berne precludes not only formalities that condition the existence of copyright, but also those that freight its “exercise.”²⁵ Without the second prohibition, an author might be *vested* with copyright, but unable to *enforce* her rights unless she complies with a variety of prerequisites to suit or to availability of remedies.²⁶ Copyright-specific conditions on access to judicial process or to injunctive relief (including seizure and destruction of infringing articles) or to actual damages therefore contravene Berne norms. By contrast, general litigation obligations, such as payment of filing fees, or general procedural or evidentiary requirements, while they may affect the enforcement of a copyright claim, are not “formalities” in the Berne sense so long as they apply to all actions, whatever the subject matter.²⁷ Beyond these general observations, specific issues concerning the Berne-compatibility of declaratory obligations that condition the enforcement of rights warrant fuller development in the next Section.

B. DECLARATORY OBLIGATIONS GOING TO THE ENFORCEMENT OF RIGHTS

1. *Permissible conditions*

Not every “condition” on the existence or enforcement of protection is a prohibited “formality.” For example, under Berne article 3, a work will not be protected in the Union unless its author’s nationality or its place of first publication meets the condition of being a Berne member state. Article 2(2) allows member states to make fixation in material form a condition of protection. Once a work does qualify for protection under the Convention, however, member states may not impose declaratory or other conditions precedent to the enjoyment or exercise of domestic and conventional rights. With this possible exception: with respect to works still under copyright in their countries of origin, but in the public domain in a newly-acceding member state (or still under copyright in the new member state, but in the public domain in other member states), article 18(1) requires member states to restore the copyrights in these works, but article 18(3) allows member states to determine “the conditions of application of [the restoration] principle.”

A member state may not decline to restore copyrights in qualifying foreign works in the local public domain: article 18(3) makes clear that the restoration principle must be applied. But that

24 Berne, *supra* note 8, art. 12 provides that “Authors of literary or artistic works shall enjoy the exclusive right of authorizing adaptations, arrangements and other alterations of their works.”

25 Berne, *supra* note 8, art. 5(2).

26 Van Gompel, *supra* note 4, ¶ 5.3.2, at 200 (“it seems that the word ‘exercise’ was added so as to elucidate that the prohibition did not only cover constitutive formalities, but also formalities that are prerequisites to sue.”).

27 Arguably, the 17 U.S.C. § 512(c) system of notice and takedown could be considered a “formality” because notice is a prerequisite to relief. Nonetheless, the argument is unpersuasive because the information that § 512(c)(3) requires is not a condition precedent to seeking relief akin to the § 411 pre-suit registration obligation, but corresponds to what one would have to prove in court. The requirements that, in a civil action, the author prove that she is the author, that she created the work, that she published it on a particular date, and that the work is original, are not “formalities,” but are the facts in issue. Berne art. 5(2) does not dispense the author from proving those facts in the proceeding that will determine if she is entitled to relief. It means that the author need not register a document attesting to those facts before she can even initiate a procedure to seek relief (at which she will have to prove the facts). Transposed to § 512(c)(3), the facts in the notice are the facts that must be pleaded to obtain the temporary restraining order-like remedy of a takedown. They are the procedure, they are not a screen barring the author from access to the process.

provision grants member states considerable latitude to determine *how* to restore copyright in formerly public domain foreign works. “Conditions” on the implementation of restoration might well include declaratory obligations. For example, section 104A of the U.S. copyright law reinstates copyright automatically,²⁸ but protects “reliance parties” who had exploited the work in good faith before its restoration, by requiring restored copyright owners to file a “Notice of Intent to Enforce Restored Copyright” in the Copyright Office or by service on the reliance party.²⁹ In other words, before she may enforce her copyright against a reliance party, the author or copyright owner of a formerly public domain work must comply with a detailed declaratory obligation³⁰ in order to put reliance parties on notice of the restored owner’s claims. By virtue of article 18(3), this declaratory obligation, albeit a significant limitation on the enforcement of copyright, seems fully compatible with Berne norms.

2. *Incentives versus Obligations: Rewarding the Effectuation of Declaratory Measures by Offering Litigation or Remedial Enhancements*

If Berne prohibits the imposition of sanctions for noncompliance with declaratory obligations, another approach might be to substitute carrots for sticks. Authors who comply with registration or other requirements might enjoy evidentiary advantages or qualify for additional remedies.

a) Evidentiary advantages

Evidentiary advantages might provide meaningful incentives to authors or rightholders to register their works and record transfers of rights, thus facilitating title searching. For example, according presumptive probative value to the publicly-recorded information if the registration or recordation is made within a certain period³¹ may encourage compliance with these declaratory measures. Making timely registration *prima facie* evidence of a work’s originality, thus placing the burden on the defendant to prove lack of authorship, may further stimulate registrations.³²

28 See 17 U.S.C. § 104A(a)(1)(A) (“Copyright subsists, in accordance with this section, in restored works, and vests automatically on the date of restoration”).

29 *Id.* § 104A(c).

30 The details are set out in *id.* § 104A(e).

31 See, e.g., 17 USC §§ 410(c) (certificate of registration serves as *prima facie* proof of information there recorded, if registration is effected within five years of publication), 412 (statutory damages and attorneys fees available only if work registered before infringement occurred, “unless . . . registration is made within three months after the first publication of the work”). See [1993] COPYRIGHT, 142, 154; ¶¶ 73–76 (permissibility of laws giving registration information the effect of a rebuttable presumption of the correctness of the information). Reinbothe & von Lewinski indicate that measures to “facilitate proof of authorship” are not prohibited formalities. See Jörg Reinbothe & Silke von Lewinski, THE WIPO TREATIES 1996 at 61, ¶¶ 27 (2002).

32 There may be extra-copyright incentives as well, see, e.g., *Nat’l Peregrine, Inc. v. Capitol Fed. Sav. & Loan Ass’n of Denv.* (*In re Peregrine Entm’t, Ltd.*), 116 B.R. 194, 197, 201–02 (C.D. Cal. 1990) (finding that “a security interest in a copyright [must be] perfected by an appropriate filing with the United States Copyright Office,” rather than “a UCC-1 financing statement filed with the relevant secretary of state,” because “any state recordation system pertaining to interests in copyrights would be preempted by the Copyright Act.”). *But see* Alice Haemmerli, *Insecurity Interests: Where Intellectual Property and Commercial Law Collide*, 96 COLUM. L. REV. 1645, 1680–95 (1996) (criticizing *In re Peregrine* for conflating security interests in copyright-related receivables with such interests in copyrights themselves); see also Patrick R. Barry, Note, *Software Copyrights as Loan Collateral: Evaluating the Reform Proposals*, 46 HASTINGS L.J. 581, 589–90 (1995) (“The second part of [*In re Peregrine*’s] ruling, which holds that security interests in accounts receivable can only be perfected by recordation with the Copyright Office, is more questionable and has been criticized by commentators.”).

b) Remedial advantages

Berne's prohibition on formalities requires that the basic copyright remedies, such as injunctive relief and actual damages, remain available to foreign authors who have not locally registered their works or undertaken other locally-imposed declaratory measures. Although the Berne Convention itself specifies no remedies other than border seizures of infringing copies,³³ Berne anticipates that member states will supply the "means of redress."³⁴ These are determined by local law,³⁵ but, over and above the national treatment rule, they remain subject to the overall no-formalities proviso. It has been suggested that Berne does not in fact require member states to include injunctive relief within their remedial arsenals, and that member states might therefore condition that remedy on compliance with declaratory measures, leaving undeclaring authors with some form of equitable remuneration in lieu of injunctions.³⁶

This contention ignores a great deal, notably copyright history, the text of the Berne Convention, and the explicit requirement of the Agreement on Trade Related Aspects of Intellectual Property (TRIPS) that member states provide injunctive relief from copyright infringement.³⁷ First, Berne's delegation to member states' laws to provide the means of redress occurred against a background of widespread (probably universal) domestic provision of injunctive relief. Indeed orders prohibiting reproduction and distribution, backed up by confiscation of infringing books (and even type fonts), date to the earliest days of copyright and before. For example, the first international copyright treaty, the Convention between the Kingdom of Sardinia and the Austrian Empire, of 22 May 1840, mandated:

over and above the penalties pronounced against infringers by the laws of the two States, the sequester and destruction of the copies of the infringing articles, as well as the molds, the prints, the copper plates, the lithographing stones, and all other objects employed to commit the infringement, shall be ordered.³⁸

The first copyright act, the British Statute of Anne (1710) provided that the "offender or offenders shall forfeit such Book or Books and all and every sheet or sheets being part of such Book or Books to the proprietor or proprietors of the copy thereof who shall forthwith damask and make waste paper of them."³⁹ And before copyright, sixteenth-century Papal printing privileges systematically charged the executing magistrates to confiscate books printed, sold, or imported without the author's or publisher's permission.⁴⁰

33 Berne, *supra* note 8, art. 16.

34 *Id.* art. 5(2).

35 *Id.*

36 Sprigman, *supra* note 2, at 555-60.

37 TRIPS, *supra* note 8, arts. 41(1), 44(1), 46.

38 Conv. Austro-Sarda, art. XVI ("Oltre le pene pronunciate contro ai contraffattori dalle leggi dei due Stati, si ordinerà il sequestro e la distruzione degli esemplari e degli oggetti contrafratti, e così pure delle forme, stampe, dei rami, delle pietre, e degli altri oggetti adoperati per eseguire la contraffazione;"). On the Austro-Sardinian Convention in general, see Laura Moscati, *Il caso Pomba-Tasso e l'applicazione della prima convenzione internazionale sulla proprietà intellettuale*, in *MÉLANGES EN L'HONNEUR D'ANNE LEFEBVRE-TEILLARD* 747, 754-57 (Paris 2009).

39 The Statute of Anne, 1710, 8 Ann., c. 19, § 2.

40 See generally Jane C. Ginsburg, *Proto-Property in Literary and Artistic Works: 16th Century Papal Printing Privileges*, 36 COLUM. J.L. & ARTS 345 (2013).

Second, while Berne does not specify remedies, it does impose detailed conditions on the availability of compulsory licenses. A member state may not substitute an equitable compensation remedy for actual damages or injunctive relief unless, with respect to the reproduction right, the remedy passes the “three-step test”⁴¹ or, with respect to certain communications to the public, meets the criteria of article 11bis(2). Were injunctive relief not the norm, there would be no need to specify when a member state may substitute a monetary remedy. The TRIPS Agreement has generalized the application of the three-step test to limitations on rights not already addressed in the Berne Convention.⁴² The third step (the limitation “does not unreasonably prejudice the legitimate interests of the author”) may permit a member state to limit relief to equitable remuneration,⁴³ but only if the remedy is limited to “certain special cases” that “do[] not conflict with a normal exploitation of the work.”⁴⁴ It would be perverse, to say the least, were noncompliance with formalities to qualify as a “special case” under the three-step test, thus enabling member states to evade the no-formalities rule by making nonfulfillment of formalities the gateway to compulsory licensing. This gambit thus has the “merit” of violating not one but two Berne norms.

Finally, even if Berne did not presume the default remedy of injunctive relief, TRIPS clearly obliges member states to provide for injunctions. In addition to requiring compliance with articles 1–21 of the Berne Convention (thus including the no-formality rule),⁴⁵ TRIPS specifies:

Members shall ensure that enforcement procedures as specified in this Part are available under their law so as to permit effective action against any act of infringement of intellectual property rights covered by this Agreement, including expeditious remedies to prevent infringements and remedies which constitute a deterrent to further infringements.⁴⁶

41 Berne, *supra* note 8, art. 9(2) (setting forth the test: 1) “certain special cases” which 2) “does not conflict with a normal exploitation of the work” and 3) “does not unreasonably prejudice the legitimate interests of the author”).

42 TRIPS, *supra* note 8, art. 13; *accord* Panel Report, *United States—Section 110(5) of the US Copyright Act*, ¶¶ 6.80–81, WT/DS160/R (June 15, 2000) [hereinafter Section 110(5) Panel Report] (“[N]either the express wording nor the context of Article 13 or any other provision of the TRIPS Agreement supports the interpretation that the scope of application of Article 13 is limited to the exclusive rights newly introduced under the TRIPS Agreement” and thus “appl[ying] Article 13 of the TRIPS Agreement to the rights provided under Articles 11(1) and 11 bis(1) of the Berne Convention (1971) as incorporated into the TRIPS Agreement.”)

43 See Section 110(5) Panel Report, *supra* note 42, ¶ 6.229 (finding “prejudice to the legitimate interests of right holders reaches an unreasonable level if an exception or limitation causes or has the potential to cause an unreasonable loss of income to the copyright holder” and citing WIPO Guide to the Berne Convention for proposition that “where there would be serious loss of profit for the copyright owner, the law should provide him with some compensation (a system of compulsory licensing with equitable remuneration).” (quoting WORLD INTELLECTUAL PROP. ORG., GUIDE TO THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS (PARIS ACT, 1971) ¶ 9.8 (1978))).

44 See Section 110(5) Panel Report, *supra* note 42, ¶¶ 6.112, .183, which finds that article 13’s treatment of “certain special cases” “requires that a limitation or exception in national legislation should be clearly defined and should be narrow in its scope and reach” and that:

[A]n exception or limitation to an exclusive right in domestic legislation rises to the level of a conflict with a normal exploitation of the work . . . if uses, that in principle are covered by [the exclusive right owned] but exempted under the exception or limitation, enter into economic competition with the ways that right holders normally extract economic value from that right to the work . . . and thereby deprive them of significant or tangible commercial gains.

See also TRIPS, *supra* note 8, art. 13 (using conjunctive “and” when listing test elements).

45 TRIPS, *supra* note 8, art. 9(1).

46 *Id.* art. 41(1).

The “enforcement procedures as specified in this Part” include “order[ing] a party to desist from an infringement.”⁴⁷ TRIPS provides for two other remedies related to injunctive relief: border control of piratical copies⁴⁸ and destruction of infringing articles.⁴⁹ As a result, if ever there had been any ambiguity as to a member state’s power to condition the availability of injunctive relief on fulfillment of formalities, TRIPS forecloses any such option. Arguably, TRIPS merely requires that member states’ courts *have* authority to impose injunctions, not that they in fact *exercise* that authority. Textual sophistry aside, given the objectives of the TRIPS Agreement to “ensure” effective enforcement of intellectual property rights, to read TRIPS as merely giving member States an option, rather than imposing an obligation, to provide for injunctive relief seems self-defeating.⁵⁰ “[S]hall have authority” allows member states to apply their general criteria for awarding injunctive relief (for example, conditioning the remedy on a showing of inadequacy of monetary relief⁵¹), but those criteria cannot be so restrictive as routinely to result in the denial of injunctions, otherwise member states could eviscerate TRIPS’ mandate to provide for injunctive relief.⁵² By the same token, a member state may not systematically withhold injunctive relief simply because the author or rightholder has not complied with copyright formalities, otherwise it would reintroduce through the back door a restriction barred by TRIPS’ incorporation of Berne norms.

47 *Id.* art. 44(1) (“The judicial authorities shall have the authority to order a party to desist from an infringement . . .”).

48 *Id.*:

. . . , *inter alia* to prevent the entry into the channels of commerce in their jurisdiction of imported goods that involve the infringement of an intellectual property right, immediately after customs clearance of such goods. Members are not obliged to accord such authority in respect of protected subject matter acquired or ordered by a person prior to knowing or having reasonable grounds to know that dealing in such subject matter would entail the infringement of an intellectual property right.

49 *Id.* art. 46:

In order to create an effective deterrent to infringement, the judicial authorities shall have the authority to order that goods that they have found to be infringing be, without compensation of any sort, disposed of outside the channels of commerce in such a manner as to avoid any harm caused to the right holder, or, unless this would be contrary to existing constitutional requirements, destroyed. The judicial authorities shall also have the authority to order that materials and implements the predominant use of which has been in the creation of the infringing goods be, without compensation of any sort, disposed of outside the channels of commerce in such a manner as to minimize the risks of further infringements.

50 *See, e.g.*, DANIEL GERVAIS, *THE TRIPS AGREEMENT: DRAFTING HISTORY AND ANALYSIS* ¶¶ 2.510, .529 (4th ed. 2012) (summarizing article 41(1)’s “shall ensure” mandate as “insist[ing] on the effectiveness of action, including expeditious remedies to prevent infringement,” and explaining that “a systematic refusal . . . to apply [required judicial] powers may constitute nullification or impairment”). *See also id.* ¶ 2.540 (addressing TRIPS article 44(2) permission to limit remedies to monetary relief in the case of remedies against governments; TRIPS’ toleration of sovereign immunity from injunctive relief underscores the general mandate to provide injunctive relief against non-government infringers); TRIPS, *supra* note 8, art. 31 (with respect *solely* to patents, authorizes “adequate remuneration” in certain highly detailed instances of “use by the government or of third parties authorized by the government.”).

51 *See, e.g.*, *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 391 (2006) (discussing criteria for awarding injunctive relief).

52 Thanks to Prof. Susy Frankel for this point.

- c) Other “incentives”: remedies in excess of TRIPS minima, such as statutory damages and attorney’s fees

If Berne and TRIPS preclude conditioning express or implicit conventional minimum remedies on fulfillment of formalities, might member states create incentives for compliance with declaratory measures by subjecting additional remedies to a compliance obligation? In other words, might there be a category of Berne+ remedies for which imposition of formalities would be permissible? When the United States joined the Berne Convention in 1989, it retained the provision in the Copyright Act that limited availability of statutory damages and attorney’s fees to works which had been registered before the infringement occurred.⁵³ This provision was thought to afford meaningful incentives to registration that are “compatible with Berne since it deals with certain specific remedies rather than the ability to obtain redress at all.”⁵⁴ In general, the argument holds that remedies that exceed the protections mandated by international instruments are not subject to the Berne minima no-formalities rule. So long as the member state requires its own authors to comply with any declaratory obligations, then imposing the same obligations on foreign authors remains consistent with the rule of national treatment. Berne neither addresses nor, arguably, assumes availability of statutory damages and attorney’s fees; TRIPS includes these measures among its specified remedies, but it does not require member states to provide them.⁵⁵ It might follow that conditioning the availability (to local and foreign authors alike) of these remedies on some act of public filing is both Berne- and TRIPS-compatible.

Berne- and TRIPS-compatibility, however, should turn on assessment whether the “plus” remedies are in fact extra frills, or instead are necessary to effective enforcement of copyright. TRIPS article 41(1) provides: “Members shall ensure that enforcement procedures as specified in this Part are available under their law so as to permit *effective* action against any act of infringement of intellectual property rights covered by this Agreement” (emphasis added). One might contend that, given the high costs of litigation and the difficulty (and cost) of proving actual damages, a copyright claimant cannot as a practical matter *effectively* enforce her rights in the United States without the prospect of statutory damages and attorney’s fees. The claim, which may well be plausible, would benefit from empirical demonstration.

In the absence of such a showing, these remedies remain optional under TRIPS. Notably, TRIPS article 45(2) provides that “members may authorize the judicial authorities to order recovery of profits and/or payment of pre-established damages even where the infringer did not knowingly, or with reasonable grounds to know, engage in infringing activity.” Contrasting article 41(1) (“members shall ensure”) with article 45(2) (“may authorize the judicial authorities”), it does not appear that TRIPS mandates the availability of statutory damages (“pre-established damages”). Non-U.S. authors may have a somewhat stronger, but ultimately unsuccessful, claim that attorney’s fees figure among the minimum remedies that TRIPS member states must afford. Article 45(2) also

53 Pub. L. 94-553, Title I, § 101, 90 Stat. 2583 (1976) (amended 1990, 2005, and 2008; current version at 17 U.S.C. § 412 (2006)).

54 *Final Report of the Ad Hoc Working Group on U.S. Adherence to the Berne Convention*, 10 COLUM.-VLA J.L. & ARTS 513, 565 (1986).

55 TRIPS, *supra* note 8, arts. 44(1), 45(2); *see infra* text accompanying notes 59–62.

states that “the judicial authorities shall also have the authority to order the infringer to pay the right holder expenses, which may include appropriate attorney's fees.” The “have the authority” language echoes that of article 44(1), which I have said, together with article 41(1) *requires* member states to provide for formality-free injunctive relief.⁵⁶ But while article 45(2) may oblige member states to award court costs to a prevailing plaintiff, the award of attorney’s fees remains permissive (“*may include*” (emphasis supplied)).

The non-mandatory character of these remedies, however, does not necessarily mean that a member state that chooses to include them may also condition them on compliance with formalities. Structurally, one may contend that all of the TRIPS provisions pertaining to copyright, whether substantive or remedial, are subject to the overarching no-formalities rule by virtue of TRIPS’ incorporation of Berne’s norms.⁵⁷ As a result, even optional remedies may not be conditioned on compliance with formalities.⁵⁸

At first blush, TRIPS’ text might rebut such a conclusion. Under TRIPS article 9(1), “Members shall comply with Articles 1 through 21 of the Berne Convention.” TRIPS article 2(2) specifies, “Nothing in Parts I to IV of this Agreement shall derogate from existing obligations that Members may have to each other under . . . the Berne Convention.” If TRIPS creates a *new* obligation or, in the case of statutory damages and attorney’s fees, a new option, how do attendant formalities “derogate” from *existing* duties? Similarly, the requirement to “comply with” the Berne Convention may not mean that the cited articles of the Berne Convention condition TRIPS substantive norms that fall outside the scope of the Berne Convention. Berne article 5(1) establishes that the duty of national treatment does extend to new rights and remedies that TRIPS member states implement in their national laws, because the Berne norm covers “the rights which [Union members’] respective laws do now or *may hereafter grant* to their nationals.”⁵⁹ Thus, a TRIPS member could not, for example, provide formality-free statutory damages to its own authors while requiring foreign authors to have registered their works as a prerequisite to obtaining that remedy. But if the TRIPS member imposes the formal prerequisite on local and foreign rightholders alike, it is not clear that it will have “failed to comply with” articles of a treaty that do not incorporate optional remedies.⁶⁰

Ultimately, however, arguments based on the optional or mandatory character of the remedy under TRIPS miss the mark. As discussed earlier, Berne does not explicitly incorporate *any* remedies, other than border seizures. The “existing [Berne Convention] obligation” from which TRIPS does not derogate, pertains not to any particular remedy, but to a member state’s remedial scheme as a whole. We have posited that member states may not condition the basic remedy of injunctions (nor, for that matter, actual damages) on compliance with formalities because such a limitation would effectively eviscerate the no-formalities rule: a right cannot be “exercised” if it cannot be enforced.

56 See *supra* note 47.

57 TRIPS, *supra* note 8, arts. 2(2), 9(1).

58 Thanks to Prof. Susy Frankel for this point.

59 Berne, *supra* note 8, art. 5(1) (emphasis added).

60 By contrast, protection for the additional copyright subject matter of TRIPS’ article 10 (computer programs and databases) cannot be conditioned on formalities, because article 10(1) explicitly treats software as Berne subject matter, and article 10(2) adopts the “intellectual creations” formula from Berne article 2(5), thus also arguably inserting original databases into Berne, rather than establishing them as outside Berne.

But nothing in the Berne text authorizes distinctions among types of “exercise” that cannot be subjected to compliance with formalities. On the contrary, Article 5(2) equates “enjoyment and exercise” of Berne minima and national treatment rights with “the extent of protection, as well as the means of redress.” Member states’ freedom to determine the “means of redress,” including by devising remedies additional to the basic forms of monetary and injunctive relief, does not entitle them to selective adherence to the no-formalities rule. Suppose, for example, that a member state provided expedited judicial or administrative process for copyright infringement claims, but only if the rightholder had registered the work before the alleged infringement occurred. This procedural advantage, albeit innovative and perhaps unique to that member state, is nonetheless a “means of redress.” The Berne+ remedies argument thus rests on a fundamental fallacy. Article 5(2) does not distinguish between traditional or basic remedies and additional, unusual, or new remedies: all remedies come within “the means of redress.” Under this reading, there is no such thing as a Berne+ remedy, and therefore no basis to impose formalities on the availability of some remedies but not others.

C. OTHER BERNE+ APPROACHES

If there are no Berne+ remedies on which to condition compliance with declaratory measures, are there nonetheless other aspects of copyright to which a Berne+ approach might apply? For example, conditions on Berne+ subject matter, duration, and rights might all fall outside the no-formality rule (assuming, for purposes of the rule of national treatment, that local authors also incurred the same duties⁶¹).

1. *Subject matter*

Article 2 of the Berne Convention sets out the subject matter that member states must protect. Notably absent are sound recordings. And Berne’s coverage of computer programs and databases is arguably ambiguous.⁶² But those gaps have been filled by other treaties that also incorporate the no-formalities proviso.⁶³ There are, however, two categories of article 2 works that are susceptible to Berne-compatible declaratory obligations. Article 2(4) provides, “it shall be a matter for legislation in the countries of the Union to determine the protection to be granted to official texts of a legislative, administrative and legal nature, and to official translations of such texts.”

61 Berne+ subject matter, rights, and remedies that come within the ambit of the TRIPS Agreement remain subject to national treatment and MFN obligations. See Susy Frankel, *Challenging TRIPS-Plus Agreements: The Potential Utility of Non-Violation Disputes*, 12 J. INT’L ECON. L. 1023, 1031–32 (2009).

62 On computer programs, see SILKE VON LEWINSKI, INTERNATIONAL COPYRIGHT LAW AND POLICY ¶ 7.13, at 232 (2008):

The question of whether computer programs are covered as ‘works’ under the Berne Convention and, consequently, benefit from national treatment and minimum rights, is not easy to answer; indeed, for some time after the emergence of computer programs, views were quite divergent and no authentic interpretation could be ascertained.

(footnotes omitted). See also 1 Berne Book, *supra* note 13, ¶¶ 8.92–103, at 491–97 (arguing that computer programs fall within Berne subject matter both on first principles and as a matter of state practice). On databases, see *id.* ¶¶ 8.88–91, at 489–91 (arguing that Berne subject matter includes original compilations of data).

63 See treaties cited *supra* note 8.

Berne thus permits member states to exclude official texts altogether from the subject matter of copyright: the phrase “determine the protection” may also be understood to authorize the coverage of official texts, but subject to various conditions, such as declaratory obligations.

Article 2(7) allows member states:

. . . to determine the extent of the application of their laws to works of applied art and industrial design and models, as well as the conditions under which such works, designs and models shall be protected. Works protected in the country of origin solely as designs and models shall be entitled in another country of the Union only to such special protection as is granted in that country to designs and models; however, if no such special protection is granted in that country, such works shall be protected as artistic works.

This rather convoluted provision⁶⁴ allows member states to separate works of applied art from other artistic works and to prescribe a distinct (non-copyright) regime in which formalities might feature.⁶⁵ Article 2(7) derogates from the general conventional rule of independence of international protection from the existence of protection in the country of origin, because article 2(7) provides that if the country of origin protects applied art only under a non-copyright regime, then Union countries may similarly restrict the protection of the foreign work of applied art. Thus, if the country of origin covers a work of applied art only by means of a design patent (hence, through a mandatory registration system), other Berne members may also require that the work be registered (and comply with other prerequisites). But, if the country of origin protects applied art under copyright or if the Berne member where protection is sought does not have a special regime for applied art, the Berne member must accord formality-free copyright protection to the work of applied art. As a result, whether Berne members may impose formalities on works of applied art depends on the nature of protection in the country of origin.

2. Duration

We have noted that formalities, such as renewal registrations, that condition the duration of copyright during the Berne minimum term violate article 5(2).⁶⁶ But member states might institute mandatory renewal obligations after the lapse of the Berne minimum term. Thus, a member state with a life+70 term might condition domestic and foreign authors’ enjoyment of the extra twenty years on a renewal filing. Moreover, if the term of protection in the country of origin is shorter than the term in the country of protection (for example, life+50), then the rule of national treatment does not apply, and member states may either deny the last twenty years of protection altogether⁶⁷ or impose renewal obligations on foreign works, so long as they also required the same of local authors.⁶⁸

64 For its history, see, for example, 1 Berne Book, *supra* note 13, ¶¶ 8.59–69, at 453–69.

65 See VAN GOMPEL, *supra* note 4, ¶ 5.1.2.2, at 170.

66 *Supra* text accompanying notes 18–24.

67 See Berne, *supra* note 8, art. 7(8) (“however, unless the legislation of that country otherwise provides, the term shall not exceed the term fixed in the country of origin of the work”).

68 The rule of national treatment remains as a general background obligation. See 1 Berne Book, *supra* note 13, ¶¶ 6.93–.97, at 312–18.

Consider the following concrete example. The Berne minimum term for cinematographic works is fifty years from first making available to the public with the consent of the author.⁶⁹ For pre-1978 works, the U.S. term of protection is 95 years from publication, as it is for works made for hire created as of 1978; audiovisual works frequently are works made for hire.⁷⁰ If a Berne member state's domestic duration for cinematographic works does not exceed the Berne minimum, the United States could, consistently with Berne, withhold protection for the remaining forty-five years altogether, or condition protection on fulfilment of a renewal obligation in the United States, subject to the rule of national treatment. If the copyright's duration in the country of origin exceeds the Berne minimum, but is less than the U.S. duration,⁷¹ the Berne Convention calls for the rule of the shorter term: unless the host state's legislation provides otherwise, the foreign work will be protected for the length of the term in the country of origin, rather than for the longer term in the host country.⁷² As a result, the United States could require a renewal registration for protection to apply between expiration in the country of origin and expiration of the United States' ninety-five-year term, or it could simply deny protection for the remainder of the U.S. term. For that matter, Congress could, consistently with Berne, require initial and renewal registrations of U.S. and foreign audiovisual works fifty years (the Berne minimum) following their first publication or making available to the public.

3. *Rights*

At first blush, one might conclude that, given both the breadth of the Berne minimum substantive rights (as supplemented by TRIPS, the WIPO Copyright Treaty (WCT), and the WIPO Performances and Phonograms Treaty (WPPT)) and the principle of national treatment, there are no Berne+ substantive rights whose exercise might be conditioned by an obligation to comply with declaratory measures. As our analysis of "Berne+ remedies" indicates, even if the "extent of protection, as well as the means of redress"⁷³ exceed Berne minima, a member state may neither impose formalities on the availability of the remedy, nor on the scope of the right; "Berne+ right" is as much a misnomer as "Berne+ remedy." But some might conceptualize an expansion of Berne rights into Berne+ territory through the back door of exceptions. National laws might start from the exceptions and limitations that Berne either mandates or permits member states to impose, and then might provide that the otherwise permissible exception or limitation would not apply if the author or rightholder undertook a prescribed declaratory measure. In effect, this approach would allow

69 Berne, *supra* note 8, art. 7(2).

70 *See* 17 U.S.C. §§ 101, 302, 304 (2006).

71 For example, under the EU Term Directive, the duration of protection of audiovisual works is 70 years from the death of the last survivor of the director, the screenwriter, or the composer of the score. Council Directive 93/98/EEC, of 29 October 1993 Harmonizing the Term of Protection of Copyright and Certain Related Rights, art. 2(2), 1990 O.J. (L 290) 9, 11. It is conceivable in a given case that 70 years could elapse from the last survivor's death before 95 years from publication have run out.

72 Berne, *supra* note 8, art. 7(8). The United States does not currently apply the rule of the shorter term. *See* 17 U.S.C. § 104(a)–(c).

73 Berne, *supra* note 8, art 5(2). *See* discussion *supra* text accompanying note 62.

authors to “opt out” of an exception or limitation by declaring their objection to its application.⁷⁴ Berne article 10bis(1) arguably supplies the template, stating:

It shall be a matter for legislation in the countries of the Union to permit the reproduction by the press, the broadcasting or the communication to the public by wire of articles published in newspapers or periodicals on current economic, political or religious topics, and of broadcast works of the same character, *in cases in which the reproduction, broadcasting or such communication thereof is not expressly reserved*. . . . (emphasis added)

In other words, the reservation from the exception in effect *expands* the author’s rights to cover uses which otherwise would permissibly have limited the scope of the reproduction and communication rights.

Is the express reservation opt-out then a Berne-compatible declaratory measure that might apply to other otherwise permissible national law exceptions? The most abrupt answer is “no” because declaratory measures still condition the “extent of protection”: whether formalities come in at the front end (the availability of the right) or at the back end (the applicability of an exception), they still shape the scope of protection. A less curt answer is “probably not.” A predecessor version of the article 10bis(1) reservation was introduced in the original 1886 Berne Act (in then-article 7), and carried over in the 1908 Berlin Revision (then-article 9(2)), whose *travaux* explicitly state that the reservation option was not a formality.⁷⁵ Since the 1908 Berlin Revision also established the no-formalities rule, this assertion should carry some weight. The simplest interpretation characterizes the reservation as “lex specialis,”⁷⁶ a sui generis provision that, although it may derogate from the default no-formalities norm, does not create a basis for generalization into a technique for instituting declaratory measures.

A slightly longer answer would emphasize the context in which article 9(2) of the Berlin Revision arose. Although today the provision (now article 10bis(1)) looks like an opt-out from a limitation on the scope of the rights of reproduction and communication to the public, and therefore arguably like a condition on the scope (enjoyment) of Berne minimum rights, at the time of the provision’s drafting, it operated more like a condition on the protection of Berne+ subject matter. At that time, the subject matter the provision addressed —“any article published in a newspaper or periodical”—was widely believed not to be copyrightable in the first place.⁷⁷ The

⁷⁴ This approach differs from the one advocated by the Copyright Principles Project, which would render an unregistered work more subject to the fair use defense than a work whose copyright had been registered. See Pamela Samuelson & Members of the CPP, *The Copyright Principles Project: Directions for Reform*, 25 BERKELEY TECH. L.J. 1175, 1200 (2010) (“Unregistered works would still be protected by copyright law against exact or near-exact copying that would cause commercial harm, but fair uses might well be broader as to such works.”). This proposal violates Berne article 5(2) because it makes the scope of copyright dependent on registration: failure to comply with the registration formality means that the work will be subject to greater incursions on exclusive rights than registered works would be.

⁷⁵ *Rapport Présenté à la Conférence au Nom de sa Commission* (Louis Renault, Président et Rapporteur), in UNION INTERNATIONALE POUR LA PROTECTION DES ŒUVRES LITTÉRAIRES ET ARTISTIQUES, ACTES DE LA CONFÉRENCE REUNIE A BERLIN DU 14 OCTOBRE AU 14 NOVEMBRE 1908 AVEC LES ACTES DE RATIFICATION, 240 (Bureau de L’Union Internationale Littéraire et Artistique 1910) [hereinafter Records of the 1908 Revision Conference].

⁷⁶ See, e.g., SAM RICKETSON, *THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS: 1886–1986*, ¶ 5.85, at 224 (1987); Alexander Peukert, *A Bipolar Copyright System for the Digital Network Environment*, 28 HASTINGS COMM. & ENT. L.J. 1, 66 (2005).

⁷⁷ For an extended discussion, see Records of the 1908 Revision Conference, *supra* note 75, at 249–54.

original Berne act of 1886 excluded “the news of the day” and “mere items of press information” from the Convention’s subject matter (this exclusion persists in article 2(8) of the current text). Further, the 1886 Berne and 1896 Paris Revision texts denied coverage to articles “of political discussion.”⁷⁸ The existence of international copyright protection for anything published in a newspaper was thus both questionable and controversial, as the evolution of the text in 1896 and 1908 reveals. The 1896 revision clarified that newspaper serializations of novels were fully protected;⁷⁹ the need to safeguard serials attests to the taint periodical publication must have had on works that would otherwise seem amply copyrightable. The 1908 *travaux* allude to journalists’ contentions that their writings deserved “greater respect.”⁸⁰ Berlin Act article 9(2) thus was a compromise measure to provide copyright protection to otherwise excluded subject matter, provided the rightholder (generally the publisher) reserved the rights.⁸¹ In context, therefore, the article 10bis(1) is better characterized as a declaratory measure intended to bring Berne+ subject matter within the ambit of protection than as a condition on the scope of protection.

Taking article 10bis(1) out of context, for the sake of argument, how might its express reservation approach be generalized to import declaratory measures into the scope of rights? It is important to bear in mind that this technique cannot impose conditions on Berne minimum rights, else it will fail under the general article 5(2) prohibition. Thus, any exception or limitation from which an author might opt-out by means of an express reservation must be an exception or limitation which is *already* Berne-compatible. The possibility to opt-out should not be what makes an otherwise impermissible exception or limitation Berne-compatible. If, for example, a member state either denied the translation right or subjected it to compulsory licensing (an exception or limitation plainly inconsistent with the three-step test) unless the author expressly reserved translation rights, then the author would not enjoy Berne and TRIPS minimum protection without complying with declaratory obligations. That in turn would violate article 5(2).⁸²

By contrast, a member state exception that applied equally to domestic and foreign authors and did pass the three-step test, for example, the retransmission in bars and restaurants of radio

78 Convention for the Creation of an International Union for the Protection of Literary and Artistic Works art. 7, Sept. 9, 1886, 12 Martens (2nd) 173; Additional Act Modifying the International Copyright Convention of 9 September 1886 art. 7, Apr. 5, 1896, 24 Martens (2nd) 758 [hereinafter Berne 1896 Paris Revision].

79 Berne 1896 Paris Revision, *supra* note 78, art. 7.

80 Records of the 1908 Revision Conference, *supra* note 75, at 249 (“Des réclamations se sont élevées de différents côtés dans le sens d’un respect plus grand du droit des journalistes.”)

81 It seems to have been assumed that the reservation would have been made by means of a notice in the newspaper or periodical upon initial publication, *see* Records of the 1908 Revision Conference, *supra* note 75, at 253 (quoting German delegation proposal). It is unlikely that the drafters envisioned further formalization of the reservation through some kind of governmental filing in the country of origin, much less in multiple countries: such a requirement would have too closely resembled the multiple formalities rejected from the outset of the Berne Union.

82 Moreover an exception as broad as the one posited here would fail the “special case” criterion of the three-step test. *See* VAN GOMPEL, *supra* note 4, at 191 (“Berne Union states may not go as far as introducing overly broad exceptions of limitations that would have the effect of subjecting the enjoyment or the exercise of the right as such to situation-specific formalities,” because to do so “would oppose the first of the three steps, according to which an exception or limitation can only be imposed in certain specific cases.”) But one could imagine a succession of more discrete exceptions, each individually a “special case,” but which cumulatively subjected the enjoyment of the right to compliance with formalities. *See* discussion *infra*.

broadcasts of dramatic musical compositions,⁸³ could perhaps be made subject to an express reservation condition.⁸⁴ In that case, the reservation would give the author greater rights than Berne requires. This type of condition, even if permissible, seems unlikely to garner enthusiasm among the advocates of “reformatizing” copyright, because it would give copyright owners more protection, where the goal of the reformatizers is to reduce protection.

That said, one may acknowledge that the Berne-compatibility of a given potential exception may not always be clear. A cynical forecaster might therefore anticipate that the condition’s potential application to exceptions of uncertain Berne-compatibility could make the condition attractive to those who would cut back copyright protection. Inventive advocacy can expand the zone of otherwise Berne-compatible exceptions, soon joined on the slippery slope by exceptions deemed Berne-compatible *because* they can be opted-out of. Ultimately, the exclusive rights default could shift to a system of exceptions from which rightholders must reserve in order to retrieve exclusive rights.

Here’s how the argument would go: first suppose an exception of arguable consistency with Berne norms, for example, digitization of out-of-print hardcopy books for nonprofit educational purposes. Second, give authors or their successors in title the opportunity to oppose the digitization and dissemination of their books. Third, apply the three-step test as follows: step one: the class of works covered by the exception constitutes a “special case” because the class is (arguably) well-defined both as to the works covered (out-of-print books) and as to the use (nonprofit education). Step two: there is no “conflict with a normal exploitation of the work” because an out-of-print book isn’t being exploited, and because the author or rightholder can secure future or derivative exploitations by opting-out; if the author or rightholder doesn’t opt-out, that must mean there is no actual or potential market for the work, or that the author or rights holder doesn’t “care” about exploiting it. Step three: the exception does not unreasonably prejudice the legitimate rights of the author because the opt-out enables the author to avoid all prejudice, unreasonable or otherwise.⁸⁵

Is this application of the three-step test consistent with Berne norms? As a preliminary matter, the proposition that the possibility of opting out lets the exception pass steps two and three of the

83 See Section 110(5) Panel Report, *supra* note 42, ¶ 7.1(a), holding the 17 U.S.C. § 110(5) exemption of retransmissions of nondramatic musical compositions to violate the three-step test, but finding the application of the exemption to dramatic musical compositions to be compatible with the three-step test.

84 For the reasons indicated *supra* note 74, any such reservation should be a one-time declaration; the author should not be obliged to file reservations in each country whose national law allows authors to opt out of Berne-permissible exceptions.

85 Member states can satisfy the third step by providing compensation, or equitable remuneration, for the permitted use, but in our hypothesis there may be no need to compensate the author for uses she was neither making nor licensing.

I do not wish to imply that an exception for non-profit educational digitization of out-of-print books could not pass the three-step test; on the contrary, such an exception, conditioned on the beneficiary’s performance and documentation of a diligent search, may well be permissible under Berne. *Cf.* Directive 2012/28/EU, of the European Parliament and of the Council of 25 October 2012 on Certain Permitted Uses of Orphan Works, arts. 2(1), 6(1), 2012 O.J. (L 299) 5, 9–10 (requiring member states to “provide for an exception to the right of reproduction and the right of making available to the public . . . to ensure that [certain public-interest organizations] are permitted to use orphan works contained in their collections in [certain educational and preservative ways]” and providing that “[a] work or a phonogram shall be considered an orphan work if none of the rightholders in that work or phonogram is identified or . . . located despite a diligent search for the rightholders having been carried out and recorded . . .”). But ruling the exception Berne-compatible *because* it offers an opt-out, is highly problematic, and might well violate Berne if the opt-out substituted for a diligent search.

Berne article 9(2)/TRIPS article 13 test ignores the details of the opt-out's implementation. Unlike article 10bis(1), which creates a supra-national news reporting exception whose opt-out may be implemented uniformly throughout the Berne Union, the three-step test allows member states to tailor national exceptions to their own needs, and not all Union members' needs or policies need be the same.

Thus, member states' exceptions may vary widely, as may the means they provide for opting out. The proliferation of national opt-outable exceptions imposes an increasing burden on foreign authors to ascertain the existence and scope of the local exceptions and to take the steps necessary to avoid their application.⁸⁶ An author's failure to opt out of a plethora of national exceptions

86 Recent Canadian legislation offers a good example of the problems of opt-outable exceptions. Section 30.04 of the "Copyright Modernization Act," S.C. 2012, c. 20, provides:

30.04 (1) Subject to subsections (2) to (5), it is not an infringement of copyright for an educational institution, or a person acting under the authority of one, to do any of the following acts for educational or training purposes in respect of a work or other subject-matter that is available through the Internet:

- (a) reproduce it;
- (b) communicate it to the public by telecommunication, if that public primarily consists of students of the educational institution or other persons acting under its authority;
- (c) perform it in public, if that public primarily consists of students of the educational institution or other persons acting under its authority; or
- (d) do any other act that is necessary for the purpose of the acts referred to in paragraphs (a) to (c).

...

(4) Subsection (1) does not permit a person to do any act described in that subsection in respect of a work or other subject-matter if . . .

- (b) a clearly visible notice — and not merely the copyright symbol — prohibiting that act is posted at the Internet site where the work or other subject-matter is posted or on the work or other subject-matter itself.

Professor Victor Nabhan has questioned the compatibility of this provision with Berne article 5(2), and has also emphasized difficulties of implementation: many Internet sites enumerate permitted uses, but do not list prohibited uses (the prohibition of uses falling outside the authorized list should be implicit); Prof. Nabhan reads the Canadian text to require specific prohibition; the failure of these websites to set out a distinct prohibition of educational uses would therefore mean that the website author has not properly opted-out of the exception. See Victor Nabhan, *L'influence des usages sur le droit des exceptions - Canada : prise en compte par la loi des nouveaux usages et consécration par la jurisprudence d'un droit à l'exception en faveur de l'utilisateur* in *L'EFFECTIVITE DES EXCEPTIONS AU DROIT D'AUTEUR ET AUX DROITS VOISINS : LES USAGES, LA LOI, LA REGULATION* (Lamy, *forthcoming* 2014).

The tension with Berne anti-formality norms becomes all the more apparent when one considers the practical impact were other countries to enact similar opt-out exceptions. Suppose, for example, in addition to Canada's requirement that the author of an Internet-available work specifically prohibit reproduction or communication to the public (etc.) "for educational or training purposes", that Berne member state X established out-outable exceptions for public performance in religious services, and Berne member state Y instituted opt-outable exceptions to the reproduction right for the visually impaired, and Berne member state Z provided opt-outable exceptions to all exclusive rights for purposes of promoting mass digitization of out-of-print works. If, as in Canada, a general copyright notice did not suffice to effect the opt-out, it would seem that authors or right holders would be obliged, on a continuing basis, to ascertain what opt-outable exceptions each member state has enacted, and to object specifically to the permitted use. In addition to the content of the objection, the manner of communicating the opt-out also may become unduly complicated. For example, for Internet-available content, must the author continually update her website and the work's metadata to add specific objections as member states add to their panoply? For works in analog formats, will each member state create a registry of objections? Will there be a centralized registry for opt-outs, perhaps administered by

through their related formalities may simply reflect limited resources, rather than a rational evaluation of the impact of the exception on her future exploitation of the work. The more complicated the opting-out, the less persuasive the empirical assumption underlying scope-conditioning formalities, that authors do not make the necessary declarations because they do not “care” about how their works are exploited. Multiple diverse national opt-outs also impose a burden on users to determine whether, where, and to what extent unauthorized copyright-implicating acts may be permissible. Thus, rather than decreasing the title-searching transaction costs, this variant on formalities could in practice make them more onerous.

Moreover, exceptions can vary over time as well as between member states. Even if a one-time declaration at the initial public disclosure of a work may not seem unreasonably burdensome,⁸⁷ either via a copyright registry or perhaps by means of digital metadata,⁸⁸ what of exceptions that member states enact after the work is disseminated? In such cases, the implementation of the opt-out appears especially daunting. Even if the member state provides an effective means for authors to take exception, such a system would demand that authors remain constantly on guard for the loss of rights throughout the world as new exceptions come into force—a degree of vigilance that is even more demanding than registration *ab initio*.⁸⁹ Thus, if the opt-out is what makes the exception Berne-permissible, then perhaps the exception cannot apply to works created before the exception’s enactment. But if prospective-only opt-out requirements alleviate the unfairness that would result from requiring old works to carry new declarations, prospectivity also seems to undermine the local policy concerns that prompted adoption of the exception because a prospective-only exception will not facilitate owner-identification and rights-clearance of older works.

Rights+ formalities are undesirable for three other reasons as well. First, even leaving aside the plausibility of its premises, allowing the possibility of an opt-out to bear on the outcome of the three-step test is particularly problematic in light of the first step. The essence of the opt-out proposal is

WIPO? The more one contemplates the implementation of national opt-outs, the more apparent their incompatibility with Berne norms.

87 It seems the drafters expected that the opt-out from the news reporting exception would take the form of a declaration in the pages of the newspaper upon its publication. *See supra* note 79.

88 Indeed, authors should be encouraged to provide rights-management information, and technologists should help authors achieve that end.

89 For example, if the opt-out were contained in the copy’s metadata, the author cannot retrieve already-dispersed copies to amend their metadata, and (constantly) altering the metadata for new copies would simply cause confusion among users. This difficulty has already been noted with respect to metadata for opting out of copyright protection; transposing the opt-out from protection to exceptions (in effect, requiring the author to opt-in to full copyright protection), would appear to pose the same problem. *Cf.* Association Littéraire et Artistique Internationale (ALAI), *Memorandum on Creative Commons Licenses* (2006), <http://www.alai.org/en/resolutions-and-positions.html>:

While [the author] can cease to offer the work herself with the license, or can offer a more restrictive CC license directly from her website, she will probably not be able to stop the circulation of copies previously accompanied by prior terms of the license. In that case, it would seem that different versions of CC licenses with regard to the same work might simultaneously be in force.

http://wiki.creativecommons.org/Before_Licensing#What_if_I_change_my_mind.3F:

Creative Commons licenses are non-revocable. This means that you cannot stop someone, who has obtained your work under a Creative Commons license, from using the work according to that license. You can stop offering your work under a Creative Commons license at any time you wish; but this will not affect the rights associated with any copies of your work already in circulation under a Creative Commons license.

that, so long as the class is narrowly defined, the opt-out may satisfy (or override) the second two “steps” and the first step’s “special case” limitation itself may be eluded through a series of individually well-defined exceptions. Taken separately, each exception might constitute a “special case.” But in the aggregate the exceptions would significantly erode the formally exclusive right. This incremental approach to the first step would thus eviscerate the test, effectively allowing significant incursions on authors’ rights, so long as they are accomplished piecemeal through the back door of exceptions.

Second, the more complicated the implementation of the opt-out, the more it resembles the multiple formalities banned from the outset of the Berne Convention. As discussed above, integrating the opt-out into the three-step test opens the door to the enactment of a variety of member state-specific exceptions and requirements—not necessarily congruent, coordinated, or even consistent—which risk unduly burdening authors (and users) and seem increasingly like the “trap for the unwary” that rightly brought formalities into disrepute.⁹⁰

Third, large and/or sophisticated copyright owners may understand the need systematically to opt out of exceptions and might have the means to undertake the necessary declarations. Smaller copyright owners and individual authors may not understand the opt-out regime (nor, depending on how it was implemented, be in a position to assume its burdens). The opt-out therefore would perpetuate, and aggravate, the disparate impact that formalities systems already wreak on individual creators.⁹¹ As a general proposition, an exception should pass three-step muster on its own merits; if it does not, then, as this analysis has shown, adding an opt-out feature will not save the exception from Berne-incompatibility.

III. OWNERSHIP

A. DECLARATORY DUTIES PERTAINING TO COPYRIGHT OWNERSHIP ARE NOT BERNE-BANNED “FORMALITIES”

Berne article 5(2) prohibits formalities that limit the “enjoyment or exercise” of copyright. It does not address declaratory measures concerning ownership of rights. Yet those measures may be the most pertinent to title-searching. If I am correct that Berne bars measures that condition *how* a right is exercised, but not *who* exercises it, then member states may achieve many of the positive, rights clearance-facilitating, goals of formalities, without violating international norms.⁹² Moreover, member states may apply not only carrots but also sticks to encourage compliance with ownership-related formal or declaratory obligations, by making the validity of a transfer of rights contingent on fulfilling those obligations.

⁹⁰ [Cross-reference to Jule Sigall’s contribution to the symposium]

⁹¹ Note that a declaratory condition on a *user’s* exercise of an exception, such as an obligation to document a diligent search in order to qualify for an “orphan works” limitation, *see* Directive 2012/28/EU of the European Parliament and of the Council of 25 March 2012 on Certain Permitted Uses of Orphan Works, art. 3(5), 2012 O.J. (L 299) 5, 9, would not be a “formality” in the sense of Berne article 5(2) because the beneficiary of the exception, not the author or right holder, incurs the declaratory obligation.

⁹² *Accord* Melville B. Nimmer, *Implications of the Prospective Revisions of the Berne Convention and the United States Copyright Law*, 19 STAN. L. REV. 499, 544 (1967).

For example, many (probably most) member states deny effect to transfers of exclusive rights that are not in writing and signed by the author or other transferor. Commentators agree that this author-protective constraint is not a Berne-forbidden “formality.”⁹³ Similarly, national copyright-contract rules that, for example, condition the validity of a transfer of particular rights on the specific mention of future new technology rights,⁹⁴ or on separately stating and providing proportional remuneration for each mode of exploitation,⁹⁵ are formal protections of the author as the weaker party, and are not “formalities” in the Berne sense.⁹⁶

In addition to mandating a signed writing to effectuate the transfer, U.S. copyright law seeks to encourage recordation of transfers through a combination of evidentiary advantages and prospective invalidity in the event of conflicting transfers: the first-filing bona fide purchaser for value prevails over the earlier transferee.⁹⁷ I would more boldly posit going beyond the hypothesis of conflicting transfers to make the validity of the transfer itself contingent on the transferee’s recordation of the contract or “a note or memorandum of the transfer.”⁹⁸ While a duty to record a transfer of exclusive rights performs a more public-regarding function (to facilitate rights clearance) than does the requirement of a signed writing, in neither case does the sanction of invalidity deprive the author of copyright protection (on the contrary, in some instances it may have the effect of returning the rights to her).

B. IF CONDITIONING THE VALIDITY OF THE TRANSFER ON ITS RECORDATION IS BERNE-PERMISSIBLE, IS IT A GOOD IDEA?

Of all the declaratory measures (whether or not they are “formalities” in the Berne sense), the one most likely to facilitate rights-clearance is recordation. The debate over “orphan works” has shown that the most important impediment to finding right owners is the lack of a reliable chain of title.⁹⁹ A work may have been registered, and its registration renewed, but compliance with those formalities does little good if there is no record of subsequent changes in ownership. An invalidity

93 See, e.g., VAN GOMPEL, *supra* note 4, ¶ 5.3.2.2, at 204 (These requirements essentially determine the way in which the author can legally transfer his copyright. Rather than affecting the enjoyment or the exercise of copyright, therefore, they establish the extent to which the author can exploit his rights. As much as the Berne Convention permits contracting states to preclude the assignment of copyright or create certain presumption of assignment, it allows them to establish the condition under which copyright can be assigned, including the requirements of form relating to the validity of a contract.); 1 Berne Book, *supra* note 13, ¶ 6.105, at 326–27.

94 See, e.g., CODE DE LA PROPRIÉTÉ INTELLECTUELLE art. L131-6 (Fr.); Gesetz über Urheberrecht und verwandte Schutzrechte (Urheberrechtsgesetz) [Copyright Act], as amended, § 31a (Ger.).

95 See, e.g., CODE DE LA PROPRIÉTÉ INTELLECTUELLE arts. L131-3 (each right granted must be the object of explicit mention and delimited as to scope, purpose, place and duration), L131-4 (requirement of proportional participation in revenues from the grant) (Fr.).

96 See, e.g., VAN GOMPEL, *supra* note 4, ¶ [must find pincite].

97 17 U.S.C. § 205(c) (“recordation as constructive notice”); (d) (“priority between conflicting transfers”). Recordation statutes of this kind are hardly unique to copyright; they figure importantly in transfers of real property and chattels. See generally BENITO ARRUNADA, INSTITUTIONAL FOUNDATIONS OF IMPERSONAL EXCHANGE: THEORY AND POLICY OF CONTRACTUAL REGISTRIES (2012), reprinted in THOMAS W. MERRILL & HENRY E. SMITH, PROPERTY: PRINCIPLES AND POLICIES 905 (2d ed. 2012).

98 Cf. 17 U.S.C. §§ 204(a) (transfer not valid unless “an instrument of conveyance, or a note or memorandum of the transfer, is in writing and signed by the owner of the rights conveyed ...”), 205(c) (setting minimum requirements for recorded document to provide constructive notice to public).

99 See U.S. COPYRIGHT OFFICE, REPORT ON ORPHAN WORKS 26-34 (2006) (describing obstacles to title searching).

sanction for noncompliance with an obligation to record transfers of exclusive rights¹⁰⁰ would appear to furnish a strong, Berne-compatible incentive to the creation of reliable title-searching records,¹⁰¹ but how would it work? Devilish details in the implementation of the duty include: costs and deadlines, gaps in the title-searching record, and the application of the requirement to works of non-U.S. origin.

1. *Practical concerns*

a) Cost

At the moment, the cost of recording a document in the Copyright Office is \$105 for one document, and an additional \$30 for each group of 10 documents.¹⁰² This fee may not daunt transferees who are commercial actors, but one should inquire whether there is a class of transferees for whom the fees are a disincentive to recordation. If recordation is a prerequisite to validity of the transfer, it may be necessary to introduce some flexibility into the fee schedule. Current realities in the Copyright Office sound another somber note: not all recordation records are digitized or searchable online.¹⁰³ For the recordation records to perform their desired rights-clearing function, they must be fully accessible. Moreover, the information to be recorded should be standardized and should clearly identify the works at issue and the rights transferred. Fairness, too, may require a well-functioning recordation system before a transferee incurs the risk of invalidity for failure to record.¹⁰⁴

100 Some states make recordation a condition of the validity of transfer of title to automobiles. *See, e.g.*, N.C. GEN. STAT. ANN. § 20-72(b)

In order to assign or transfer title or interest in any motor vehicle registered under the provisions of this Article, the owner shall execute in the presence of a person authorized to administer oaths an assignment and warranty of title on the reverse of the certificate of title in form approved by the Division, including in such assignment the name and address of the transferee; and no title to any motor vehicle shall pass or vest until such assignment is executed and the motor vehicle delivered to the transferee.

101 A more modest sanction, making recordation a prerequisite to suit, would run afoul of Berne article 5(2) because it would be a pre-condition to enforcement. The 1976 Copyright Act's original section 205(d) included a pre-suit recordation obligation, which was eliminated when the United States joined Berne. *See Final Report of the Ad Hoc Working Group on U.S. Adherence to the Berne Convention*, 10 COLUM.-VLA J.L. & ARTS 513, 566 (1986) (“[w]ith respect to works of foreign origin, section 205(d) is incompatible with Berne, since it requires recordation as a prerequisite to suit and thereby may affect the exercise of copyright”); S. Rep. No. 100-352, at 26 (1988). Ironically the more draconian sanction, invalidating the transfer, appears more consistent with Berne than a sanction that preserves the transfer but deprives the non-recording transferee of standing to sue.

102 <http://www.copyright.gov/document.html> (calculating fees for recording documents in the copyright office).

103 *See* Copyright Office Circular 12 at 6.

104 Whether recordation should remain centralized in the Copyright Office, or be distributed across a variety of databases is beyond the scope of this Article. Cf. Pamela Samuelson & Members of the CPP, *The Copyright Principles Project: Directions for Reform*, 25 BERKELEY TECH. L.J. 1175, 1203–05 (2010) (recommending “networked and interoperable private registries”).

b) Timing

If the validity of the transfer will turn on its recordation, how much time may elapse until the transferee records?¹⁰⁵ And what is the event that starts the clock running? Execution of the transfer would seem a normal starting point, but “execution” may not mean the same thing as signing an agreement. As the Copyright Office’s inquiry into “Gap Grants” revealed, agreements to transfer rights may be entered into before the work has been created. The Office determined that the grant was not “executed” until the work which was the object of the transfer of rights came into being.¹⁰⁶ By the same token, the recordation obligation should vest at the date of conclusion of a transfer respecting an extant work, or, for grants in anticipation of a work’s creation, at the date of creation.

As for deadlines, section 205(d) allows a grace period of one month for transfers executed in the United States, and two months for transfers executed abroad, before a first-filing subsequent bona fide transferee will be awarded title despite the prior transfer. Similar deadlines might apply to the validity of the transfer in general (not just in the case of conflicting transfers). But it will be important to ensure that judicial interpretation of the recordation prerequisite to validity does not dilute the duty’s prescriptive force. Inconsistent case law under the section 204(a) requirement of a signed writing serves as a warning. Some courts construing that obligation perceive the writing simply as a confirmation of an oral agreement which effectively transferred the rights, and therefore tolerate even years of delay before the agreement is reduced to writing. Others, correctly applying the statutory language, rule that there is no transfer without a writing, and therefore demand closer contemporaneity between the agreement and its expression in writing.¹⁰⁷

2. *Gaps in the record*

a) Initial registration

The invalidity sanction attaches to failure to record transfers of title to exclusive rights. A title search-aiding record of a transfer requires a starting point to evidence the initial title holder from whom the chain of title springs. But an obligation to record initial title looks like a registration requirement, a formality that does run afoul of Berne if the sanction for noncompliance divests or disables the copyright. It may nonetheless be possible to achieve registration without punishing authors. Recall that the sanction for non-recordation burdens not the initial title holder (the author), but the grantee. If the author has voluntarily registered the copyright in the work, then the starting point will be in place. In the absence of an initial registration, the grantee should effect both the

105 See generally Alan Latman, *The Recordation of Copyright Assignments and Licenses*, Copyright Study No. 19 (1958), reprinted in 1 STUDIES ON COPYRIGHT 761, 766-74 (1963) (addressing grace periods under the 1909 Act and proposals for reform).

106 At issue was the terminability under § 203 of the 1976 Act of agreements concluded before the effective date of the 1976 Act with respect to works created thereafter. See United States Copyright Office, *Analysis of Gap Grants Under the Termination Provisions of Title 17* (Dec. 7, 2010), <http://www.copyright.gov/reports/gap-grant-analysis.pdf>.

107 Compare *Barefoot Architect, Inc. v. Bunge*, 632 F.2d 822 (3d Cir. 2011); 3 Melville B. Nimmer & David Nimmer, NIMMER ON COPYRIGHT § 10.03[A][3] at nn. 20–22 (Rev. Ed. 2009) (treating § 204(a) as a mere statute of frauds, not affecting the validity of the transfer), with *Konigsberg Int’l Inc. v. Rice*, 16 F.3d 355, 357 (9th Cir. 1994) (treating § 204(a) as more than a statute of frauds, but a requirement for validity); *Pamfiloff v. Giant Records, Inc.*, 794 F. Supp. 933, 936–37 (N.D. Cal. 1992) (same); 2 PATRY ON COPYRIGHT § 5:106 (“Although [§ 204(a)] is occasionally referred to as a Statute of Frauds provision, this is an incomplete description.”).

registration and the recordation of transfer.¹⁰⁸ The Copyright Act and current Copyright Office practices enable this gap-filling by the transferee: Section 409(5), which details the contents of the registration form, provides: “if the copyright claimant is not the author, [the claimant shall include] a brief statement of how the claimant obtained ownership of the copyright.”¹⁰⁹

So long as the transfer remains unrecorded (and assuming no supervening recorded conflicting transfer) the grantee would not be an “owner” of copyright. But the signed writing could be treated as effecting a nonexclusive license, much as a nonexclusive license may be inferred from conduct or oral agreement.¹¹⁰ Because the license is in writing, however, it would survive a subsequent recorded transfer of exclusive rights, while an unwritten nonexclusive license would be extinguished.¹¹¹ Arguably, since a recordation record that did not disclose the existence of a prior nonexclusive license could mislead the purchaser as to the effective scope of the rights granted, it would be more consistent with the present proposal were the persistence of a nonexclusive license against a subsequent grant of exclusive rights to be conditioned on the license’s recordation. But a purchaser may protect herself by requiring the transferor to warrant the absence of exclusive and nonexclusive licenses.¹¹² And because a nonexclusive licensee lacks standing to sue,¹¹³ the non-recordation of a nonexclusive license does not prejudice users. The nonexclusive licensee would be obliged to join the copyright-retaining licensor to the infringement action, but, at least assuming an initial

108 See Latman, *supra* note 105, at 776-77:

[I]t has been suggested that the present system of registering copyright claims be dropped in favor of a more elaborate approach to the recordation of transfers of copyright. The key to an effective recording system is its completeness, and ideally all links in a chain of title should be placed on record. In the absence of a basic registry system, identifying the work, the first owner of the copyright, the date from which the term is computed, and other pertinent information, the recording of transfers would often fail to identify the work covered by the transfer, the term of copyright, and especially the derivation of the transferee’s claim to ownership. On the other hand, it may be contended that it is asking too much of an assignee not only to record his own assignment but also to register the initial claim and to record any intervening assignments.

109 Registration forms, available on the Copyright Office website, provide further detail, *see, e.g.*, Form TX, instructions for filling out “space 4”:

Transfer: The statute provides that, if the copyright claimant is not the author, the application for registration must contain “a brief statement of how the claimant obtained ownership of the copyright.” If any copyright claimant named in space 4 is not an author named in space 2, give a brief statement explaining how the claimant(s) obtained ownership of the copyright. Examples: “By written contract”; “Transfer of all rights by author”; “Assignment”; “By will.” Do not attach transfer documents or other attachments or riders.

110 *See, e.g.*, *Effects Associates v. Cohen*, 908 F.2d 555, 558–59 (9th Cir. 1990).

111 *See* 17 U.S.C. § 205(e).

112 *See, e.g.*, PERLE & WILLIAMS ON PUBLISHING LAW § 2.06 (Mark A. Fisher et al., eds., 2010 Supp.) (“Writer has not previously . . . encumbered” the rights conveyed).

113 17 U.S.C. § 501(b) (owners of copyright have standing to sue); a non-exclusive licensee is not an “owner” *see, e.g.*, *Sybersound Records, Inc. v. UAV Corp.*, 517 F.3d 1137, 1144 (9th Cir. 2008):

Under copyright law, only copyright owners and exclusive licensees of copyright may enforce a copyright or license. Therefore, third party strangers and nonexclusive licensees cannot bring suit to enforce a copyright, even if an infringer is operating without a license to the detriment of a nonexclusive licensee who has paid full value for his license.

(citations omitted)

registration or prior recordation of transfer, the public will be on notice of who owns the relevant rights.

b) Transfers by operation of law

Even with a recordation prerequisite to the validity of a transfer, other gaps in the chain of title may result from transfers by operation of law. Examples of such transfers include: divorce; inheritance by intestate succession, and perhaps by will;¹¹⁴ corporate mergers, acquisitions, restructuring;¹¹⁵ and involuntary transfers in bankruptcy proceedings.¹¹⁶ The regimes governing these transfers may include their own recordation requirements; perhaps those records could be linked to copyright records. Failing that, it would be desirable to consider the circumstances under which it would be appropriate to impose an additional burden of copyright recordation on the trustee in bankruptcy, testamentary executor, and other transferees by operation of law. In any event, the duty to record would continue to bind one who acquires exclusive rights from the transferee.

Authors' statutory reversion rights pose an instance akin to transfers by operation of law. The present Copyright Act recognizes the important public interest in knowing whether an author has reclaimed her rights under the section 203 termination provision (as well as under the section 304(c) and (d) extended renewal termination rights), because the Act requires authors (or others qualified to terminate) to record in the Copyright Office a copy of the notice of termination "before the effective date of termination, as a condition to its taking effect."¹¹⁷ Thus, recordation is already a condition of the validity of the statutory reversion.

What of contractual reversions, such as provided in out-of-print clauses or as the parties may in any event agree at some time after the execution of the transfer? Or for that matter, what of a time-limited grant of rights? In the last case, the recordation of the initial grant will show its duration, which should put the public on notice that after that time (assuming no subsequent grant), the rights have returned to the author. But with respect to reversions of rights initially granted for the full term of copyright, should a recordation obligation condition the author's retrieval of her rights?¹¹⁸ The public interest in knowing who owns the rights does not wane with the change in the legal basis of

114 17 U.S.C. § 201(d)(1); *see, e.g.*, *Worldwide Church of God v. Philadelphia Church of God, Inc.*, 227 F.3d 1110, 1114 (9th Cir. 2000) (finding bequest of all real and personal property sufficient to transfer copyright); *Forster Music Publishers Inc. v. Jerry Vogel Music Co.*, 62 U.S.P.Q. (BNA) 142 (S.D.N.Y. 1944) (applying state law of intestate succession to copyright under 1909 Act).

115 *See, e.g.*, *U.S. Home Corp. v. R.A. Kot Homes, Inc.*, 563 F. Supp. 2d 971, 975 (D. Minn. 2008) (holding that corporate merger transferred copyright by "operation of law" under § 204(a) "without any 'further act or deed' on the part [of] the surviving company"); *cf.* *Cincom Systems v. Novelis Corp.*, 581 F.3d 431, 432 (6th Cir. 2009) (finding infringement on copyright by surviving corporate entity following merger with licensee of copyright, where license was non-assignable; noting that "[f]ederal common law governs questions with respect to the assignability of a patent or copyright license").

116 *See* 17 U.S.C. § 201(e) (permitting involuntary transfer under bankruptcy laws); *Advance Magazine Publishers, Inc. v. Leach*, 466 F. Supp. 2d 628, 636 (D. Md. 2006) (in federal copyright law, "transfers by operation of law are expressly limited to voluntary transfers, except in bankruptcy proceedings."). *See also* *Kunkel v. Jasin*, 420 F. App'x 198, 200 (3d Cir. 2011) (a debtor in bankruptcy may not register a copyright in his own name; since the author's copyright passed to the bankruptcy estate, only the estate may register the copyright.)

117 17 U.S.C. §§ 203(a)(4)(A); 304(c)(4)(A), (d)(1).

118 Or for a negotiated reversion occurring before the expiration of the duration of the grant covering less than the full term of copyright.

the reversion. On the other hand, the recordation obligation, posited in its initial guise, did not divest authors - if anything, the author retained whatever rights her transferee failed to record. Given the remedial role of reversion, we might be reluctant to make the author's rights depend on recordation. In fact, however, we already impose such an obligation with respect to statutory termination rights, where the author's moral claims to reversion may be even more compelling than for contractual reversions, precisely because statutory reversions are designed to make up for authors' generally weaker bargaining position.¹¹⁹ Nonetheless, lest authors' incipient reversionary interests in current contracts be frustrated by failure to record the reversioning of the rights, any mandatory obligation that contractual reversions be recorded should be purely prospective, applicable only to contracts executed after the effective date of a statutory amendment imposing recordation as a condition of the validity of the grant.¹²⁰

3. *Application to Berne works of non-U.S. origin*

Finally, how would a recordation obligation apply to transfers of U.S. rights in works of non-U.S. origin? By virtue of the Berne Convention and other multilateral instruments, a Berne Union author, upon the work's creation or first publication anywhere in the Berne Union, initially owns the copyright in the work in every other Berne Union country.¹²¹ So a French author owns the U.S. rights in her work from the outset, long before she may in fact exploit them (if ever). Under what circumstances should a U.S. recordation obligation apply to the French author's transfer of rights for a territory that includes the United States? If the transferee is a U.S. resident, the U.S. recordation obligation should apply (with respect to the transfer of U.S. rights), just as it would for a transfer of U.S. rights from a U.S. author. If the transferee is not a U.S. resident, and if the transfer covers multiple territories, recordation as a prerequisite to validity might seem more problematic from a practical perspective. That said, anyone acquiring U.S. rights, whether local or foreign, ought already, as part of due diligence, to be consulting the recordation of title in the Copyright Office;

119 See *id.* § 203(a)(5) (“Termination of the grant may be effected notwithstanding any agreement to the contrary”); § 304(c)(5) (same).

120 To the extent that the principal contractual reversion results from “out of print” clauses, the gradual disappearance of these clauses from digital-age publishing contracts, see *The Future of Electronic Publishing: A Panel Discussion*, 25 COLUM. J.L. & ARTS 91, 112 (2002) (statement of Lois F. Wasoff, Vice President & Corporate Counsel, Houghton Mifflin Company, Chair, Copyright Committee, Association of American Publishers) (hypothesizing that “we are going to start to see ‘out of print’ clauses being replaced by ‘minimum revenue’ clauses” in which “if the publisher is generating less than a certain amount of revenue, the author can demand the rights back”); Stephen Manes, *Surfing and Stealing: An Author's Perspective*, 23 COLUM.-VLA J.L. & ARTS 127, 132 (1999):

Authors are beginning to demand and receive radically changed out-of-print clauses that allow the author to demand a reversion of rights in any year that the sales figures or dollar volume from the book fail to reach a particular level, or by simply doing what hardcover publishers are smart enough to do with their paperback sublicenses: limiting the licenses to a fixed period.

Cf. Lionel Bently & Jane C. Ginsburg, “*The Sole Right . . . Shall Return to the Authors*”: *Anglo-American Authors' Reversion Rights from the Statute of Anne to Contemporary U.S. Copyright*, 25 BERKELEY TECH. L.J. 1475, 1554 n.382 (2010) (observing “publishers, rather than authors, appear to have had the most to gain from allowing the author to recapture her copyright” in order to reduce, among other things, “the expenses of . . . business tax on inventory items[] and costs of warehousing and concomitant efforts for ‘tighter inventory control,’” burdens that are less significant in the digital context (citations omitted)), may moot the problem. If the re-vesting of rights follows a rescission of the agreement, the rescission might be treated as a new contract which the parties should record.

121 Berne, *supra* note 8, arts. 3, 5(1).

requiring that the acquirer in turn record does not seem a significant additional burden. In any event, the current Copyright Act contemplates foreign transferees because it allows them an additional month before a subsequent bona fide acquirer's recordation can preempt their transfer.¹²² But there is a difference between recordation to negate the risk of conflicting transfers and recordation as a condition of the validity of the transfer of the U.S. rights¹²³ ab initio. The latter approach may place too high a burden on foreign transferees, particularly if their imminent likelihood of exploiting the U.S. rights is at best inchoate, or if the work has not already been the object of a Copyright Office registration. A middle course would be to require a foreign transferee whose grant explicitly covers the United States to effect the recordation.

IV. CONCLUSION

One critic of international copyright norms has complained that the claim “Can't do it because it's a Berne violation” is “an all-too-common refrain to torpedo numerous ideas for improving or modernizing our copyright system.”¹²⁴ The Berne Convention and related treaty obligations may constrain the implementation of good ideas for the copyright system (so far as the ideas apply to Union authors). Happily, however, our treaty obligations also frustrate efforts to implement *bad* ideas that would expropriate (foreign) authors.

“Formalities” in the Berne sense of prohibited conditions on the existence, scope, and exercise of copyright, are bad ideas because they further confiscatory policies, deny the dignity of creation, and confine copyright to its economic dimension.¹²⁵ Declaratory measures, which advance the considerable public benefit of establishing and maintaining chains of title, not only are good ideas “for improving . . . our copyright system,” they also are consistent with our international obligations.¹²⁶ The principal measure this Article proposes, conditioning validity of transfer of copyright on recordation of a note or memorandum of the transfer, is Berne-compatible because, while Berne protects the interests of successors in title, it does not regulate the means by which one *becomes* a successor in title. That is for the member state whose law governs the transfer.

122 17 U.S.C. § 409(5).

123 While a contract transferring multiterritorial rights may as a whole be governed by the law chosen by the parties, or in the absence of a choice of law, by the law of the country with the closest connection to the contract, *see, e.g.*, American Law Institute, American Law Institute: INTELLECTUAL PROPERTY—PRINCIPLES GOVERNING JURISDICTION, CHOICE OF LAW AND JUDGMENTS IN TRANSNATIONAL DISPUTES § 315(1)(2) (2008), the laws of the countries for which the rights are transferred will apply to determine the validity of the transfers, *id.* § 314; *Corcovado Music Corp. v. Hollis Music, Inc.*, 981 F.2d 679 (2nd Cir. 1993). *See also* PAUL GOLDSTEIN & BERNT HUGENHOLTZ, INTERNATIONAL COPYRIGHT 151 (2d ed. 2010) (arguing that local recording systems and priority rules receive “primacy over conflicting contract terms” on the grounds of “deference to local judgments in the efficient operation of a title priority system” and “absence of universal treaty agreements governing priorities”).

124 Edward Lee, *Copyright, Death, and Taxes*, 47 WAKE FOREST L. REV. 1, 3 (2012) (citing, inter alia, Jane C. Ginsburg, *The U.S. Experience with Mandatory Copyright Formalities: A Love/Hate Relationship*, 33 COLUM. J.L. & ARTS 311 (2010)).

125 [Cross-reference to Niva Elkin-Koren's contribution to this Symposium]

126 By contrast, the “new-style formalities” proposal advanced by Sprigman not only would penalize authors but also relies upon the tendentious assertion that the Berne Convention does not require injunctive relief. Sprigman, *supra* note 2, at 558–59. As discussed above, *supra* notes 41–52 and accompanying text, this runs counter to both the background norms of copyright and the mandate of Berne and TRIPS.

Reliable title records benefit both the public and authors by reducing search costs and facilitating mutually beneficial transactions. Moreover, by easing the flow of information about copyright ownership, Berne-compatible declaratory obligations could - without penalizing authors - alleviate the ills that purportedly justify calls for the return of confiscatory formalities. Rights of ostensibly little value to their owners—because they relate to works that are only minimally original, or too obscure, or too old—are much less problematic if their owners can readily be found and the rights easily acquired. Were rights-clearance no longer to impose high transactions costs, the remaining impetus for reformalizing copyright would plainly emerge: for copyright reformalizers, “new-style” or otherwise, the fault lies not in copyright’s alleged unmanageability, but in the current contours of copyright itself.