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Berne-Forbidden Formalities and Mass Digitization

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BERNE-FORBIDDEN FORMALITIES AND MASS DIGITIZATION

JANE C. GINSBURG*

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This Essay addresses the Berne Convention's prohibition on the imposition of "formalities" on the "enjoyment and the exercise" of copyright,¹ and the compatibility with that cornerstone norm of international endeavors to facilitate mass digitization, notably by means of extended collective licensing and "opt-out" authorizations.² In the Berne context, "enjoyment" means the existence and scope of rights; "exercise" means their enforcement. *Voluntary* provision of copyright notice and of title-searching information on a public register of works and transfers of rights is fully consistent with Berne and should be encouraged. But the Berne Convention significantly constrains member states' ability to impose mandatory formalities on foreign authors. 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.³ Most often, however, member states tend not to impose disabilities on their own authors from which they spare foreign authors, so I will assume that the measures that I examine would in fact bear equally on domestic and foreign authors.⁴

¹ 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 Convention]. 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, 2186 U.N.T.S. 121 (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, 2186 U.N.T.S. 203 (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, 51 I.L.M. 1214 (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.").

² I have elsewhere addressed the Berne compatibility of declaratory measures to enhance title-searching, particularly regarding the recordation of transfers of ownership. See *Formal Constancy*, *supra* note [**](#), at 1611-22.

³ See Berne Convention, *supra* note 1, art. 5(3). In theory, therefore, 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. *Id.* art. 5(4) (defining the "country of origin" of a work).

⁴ The US is an exception, in that it requires works of US origin to be registered as a prerequisite to suit, but does not impose this obligation on non-US works. See 17 USC § 411(a).

I have elsewhere addressed means through which member states may or may not achieve some of formalities' notice-giving and title-searching objectives.⁵ Those means include obligations to record transfers of title to exclusive rights under copyright, and, more controversially, conditioning "Berne+" protection of subject matter, remedies, or rights on front-door compliance with notice and registration formalities, or back-door exercise of opportunities to opt-out of an otherwise applicable and Berne-permissible exception or limitation. In this Essay, I will further develop the question of whether Berne member states may, consistently with article 5(2), achieve the goals of copyright exceptions or limitations by presuming authorization of the copying or communication to the public unless the author opts out of the authorization.

The Essay begins with a brief overview of the history of formalities conditioning the existence and enforcement of copyright, and the policies underlying their prohibition in Berne article 5(2). It then addresses declaratory measures that Berne explicitly authorizes, as well as those of more questionable conformity with treaty norms. Part II takes up the relationship between formalities and copyright exceptions, particularly in light of laws or proposals to facilitate mass digitization through opt-outable presumptions of authorization to digitize and disseminate.

I. EXISTENCE AND ENFORCEMENT

A. *History and Interpretation of the Berne No-Formalities Rule*

Today, article 5(2) of the Berne Convention frames our view of formalities. We think of formalities as obstacles to authors' enjoyment or exercise of their rights, and therefore either deplore them (if we seek authors' effective international protection)⁶ or celebrate them (if we strain to fill the public domain with works of authorship before those works' normal period of copyright expiration).⁷ At their origin, in the pre-copyright days of printing

⁵ See *Formal Constancy*, *supra* note [**](#).

⁶ See, e.g., FINAL REPORT OF THE AD HOC WORKING GROUP ON U.S. ADHERENCE TO THE BERNE CONVENTION 177 (1986) (Comments of John M. Kernochan, Nash Professor of Law, Columbia University), *reprinted in* 10 COLUM.-VLA J.L. & ARTS 513, 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.")

⁷ 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

privileges, formalities such as publishing some kind of notice in the work or recording a copy of the grant with a notary public, served evidentiary purposes; they did not condition the existence or persistence of the exclusive rights granted by the sovereign to the author or printer.⁸ (Though one might think of having to obtain a privilege in the first place a primordial protection-determinative formality.) With the advent of statutory copyright, some national laws required registration or deposit of the work, but, again, not as a prerequisite to the vesting of the right. For example, the 1710 Statute of Anne, the first copyright act, concerned that, “many persons may through ignorance offend against this Act unless some provision be made whereby the property in every such book as is intended by this Act to be secured to the proprietor or proprietors thereof may be ascertained,” required registration of the work with the Stationers Company. The British courts nonetheless concluded that formalities conditioned only the special statutory remedies; common law remedies remained available when the author or proprietor had not registered the work with the Stationers Company.⁹ Other countries, however, notably the U.S., made punctilious compliance with multiple statutory formalities a condition of both the existence and the enforcement of copyright.¹⁰

The role of formalities as barriers to protection arose primarily when authors or publishers sought exclusive rights for territories outside the work’s country of origin. In the international context, an author or rightholder needed first to ascertain if a foreign state protected foreign works at all, and if so, under what conditions. For example, in the absence of a bilateral treaty, some states would not protect foreign works, yet the criteria for characterization of a work as domestic, for example, by “first” publishing a foreign author’s work on the host country’s territory, and in conformity with that country’s formalities, may

Angelopoulos eds., 2011) (advocating formalities as a means to opt *out* of—rather than into—copyright protection).

⁸ See, e.g., Jane C. Ginsburg, *Proto-Property in Literary and Artistic Works: Sixteenth-Century Papal Printing Privileges*, 36 COLUM. J. L. & ARTS 345, 361-62 (2013) (discussing role of formalities in Papal printing privilege system).

⁹ See, e.g., *Blackwell v. Harper* [1740] 2 Atk 93, 26 Eng. Rep. 458; *Beckford v. Hood* [1798] 7 TR 620, 101 Eng. Rep. 1164. The 1793 French Act establishing the exclusive right of reproduction, Law of 19-24 July, 1793, art 6, provided, “Tout citoyen qui mettra au jour un ouvrage, soit de littérature ou de gravure, dansquelque genre que ce soit, sera obligé d'en déposer deux exemplaires à la Bibliothèque nationale ou au cabinet des estampes de la République, dont il recevra un reçu signé par la bibliothèque; faute de quoi, il ne pourra être admis en justice pour la poursuite des contrefacteurs.” French courts ultimately rejected contentions that library deposit of the work was a precondition to the existence of copyright, rather than a limitation on its exercise. See Judgment of Mar. 1, 1834, Cass. crim., 1834 Dev. & Car. 1.65.

¹⁰ Copyright Act of 1790 §§ 3, 4, 1 Stat. 124, 125; *Wheaton v. Peters*, 33 U.S. 591 (1834).

have brought multinational protection within reach.¹¹ Nonetheless, proving timely publication could be complicated, especially when the author sought “first” publication in multiple states.¹² Even with the advent of bilateral treaties dispensing authors from the need to manipulate the place of “first” publication, protection abroad may still have required that the foreign author comply with all formalities imposed on local authors.¹³

Against this background, it is understandable that from the outset of the mid-19th century movement for international copyright, authors advocated the abolition or restriction of formalities. Proper compliance with multiple national formalities 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 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

¹¹ See, e.g., *Routledge v. Low*, LR 3 HL 100 (1868) (US author first published in England and journeyed to Canada for a few days’ stay at the time of publication; Canada being a British colony, and the short visit sufficed to establish Canadian residence, which in turn was deemed British residence, thus conferring British nationality on the work).

¹² See, e.g., *Guichard v. Mori* (1831) 2 Coopers 216 (“[A]n author beyond the sea who desires to secure any privilege here, either to himself or any one to take under him, should publish here immediately . . . Could he come forward several years after publication abroad, and treat an intermediate publication in this country as a piracy, many foreign works would never be published amongst us at all.”). This case is discussed in Ronan Deazley, *Commentary on International Copyright Act 1838*, PRIMARY SOURCES ON COPYRIGHT (1450-1900), http://www.copyrighthistory.org/cam/tools/request/showRecord?id=commentary_uk_1838 [<https://perma.cc/YCD4-5QYL>].

¹³ SAM RICKETSON & JANE C. GINSBURG, *INTERNATIONAL COPYRIGHT AND NEIGHBORING RIGHTS: THE BERNE CONVENTION AND BEYOND* (2d ed. 2006), ¶¶ 1.19, 1.40.

¹⁴ *Id.* ¶¶ 6.83-6.85, 6.102-6.103.

¹⁵ *Id.* ¶¶ 6.86-6.87.

¹⁶ *Id.* ¶¶ 3.12, 6.87.

¹⁷ Berne Convention, *supra* note 1, art. 5(2) (art. 4(2) in the Berlin revision).

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 authors who fail to meet declaratory obligations. Thus, for example, a member state may not subject the

¹⁸ *Id.*

¹⁹ See generally RICKETSON & GINSBURG, *supra* note 13, ¶¶ 6.102-6.104.

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

²¹ RICKETSON & GINSBURG, *supra* note 13, ¶ 6.103 (quoting the German delegate Dr. Meyer at the 1884 Diplomatic Conference).

²² See e.g., STEF F. VON GOMPEL, *FORMALITIES IN COPYRIGHT LAW* 195 (2011).

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.

translation right²⁴ to registering the work or filing a notice of reservation of rights.²⁵

Berne precludes not only formalities that condition the existence of copyright, but also those that freight its “exercise.”²⁶ 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.²⁷ 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.²⁸ 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.

²⁴ Berne Convention, *supra* note 1, art. 8 provides that “Authors of literary and artistic works protected by this Convention shall enjoy the exclusive right of making and of authorizing the translation of their works throughout the term of protection of their rights in the original works.”

²⁵ *Cf.* Treaty for the Safeguarding of Property Rights, Austria-Sardinia, art. III, para. 2, July 14, 1840 (requiring author to reserve and exercise translation rights within six months), available at http://www.copyrighthistory.org/cam/tools/request/showRecord.php?id=record_d_1840 [https://perma.cc/RR32-Z6KE]. 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 (Bernard d'Alteroche ed., 2009).

²⁶ Berne Convention, *supra* note 1, art. 5(2).

²⁷ VAN GOMPEL, *supra* note 22, at 200 (“[I]t 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.”).

²⁸ Arguably, 17 U.S.C. § 512(c)’s 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.

B. Which “Conditions” on the Existence or Enforcement of Rights Does Art. 5(2) Permit?

1. Permissible Conditions

Not every “condition” on the existence or enforcement of protection is a prohibited “formality.” For example, under Berne art. 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. Art. 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 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,²⁹ 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.³⁰ 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 obligation³¹ 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.

²⁹ 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”).

³⁰ *Id.* § 104A(c).

³¹ The details are set out in *id.* § 104A(e).

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 period³² 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. Presumptions of originality arising from timely registration may significantly enhance the author's ability to enforce her rights, particularly if courts would otherwise impose a high burden of proof of the original character of the author's expression.³³

b. Remedial Advantages

Berne's prohibition on formalities requires that 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,³⁴ Berne anticipates

³² 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 ON COPYRIGHT: A COMMENTARY ON THE WCT, THE WPPT, AND THE BTAP at 89, ¶ 7.3.39 (2d ed. 2015).

³³ See, e.g., Paris Court of Appeals, first chamber, decision No. 143/2015 (8 September 2015), reversing Paris Tribunal of Grand Instance decision No. 12/05634 (27 March 2014) (reversing trial court's ruling that plaintiff heir of French author Albert Camus had failed to prove the expressive originality of Albert Camus' unpublished letters).

³⁴ Berne Convention, *supra* note 1, art. 16.

that member states will supply the “means of redress.”³⁵ These are determined by local law,³⁶ but, over and above the national treatment rule, they remain subject to the overall no-formalities proviso.³⁷ By the same token, the TRIPS Accord requires member states to include injunctive relief within the available panoply of remedies;³⁸ TRIPS’ incorporation of the Berne no formalities rule means that member states may not condition remedies on compliance with formalities.

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.³⁹ 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.”⁴⁰ 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.⁴¹ It might follow that conditioning the

³⁵ *Id.* art. 5(2).

³⁶ *Id.*

³⁷ 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, see Sprigman, *supra* note 7, at 555-60. For detailed rebuttal of this contention, see *Formal Constancy*, *supra* note **, at 1593-97.

³⁸ TRIPS, *supra* note 1, art. 41(1).

³⁹ Pub. L. 94-553, tit. I, § 101, 90 Stat. 2583 (1976) (codified as amended at 17 U.S.C. § 412 (2012)).

⁴⁰ FINAL REPORT OF THE AD HOC WORKING GROUP ON U.S. ADHERENCE TO THE BERNE CONVENTION 53 (1986), *reprinted in* 10 COLUM.-VLA J.L. & ARTS 513, 565 (1986).

⁴¹ TRIPS, *supra* note 1, arts. 44(1), 45(2); *see infra* text accompanying notes 59-62.

availability (to local and foreign authors alike) of these remedies on some act of public filing is both Berne- and TRIPS-compatible.

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.⁴² As a result, even optional remedies may not be made subject to compliance with formalities.⁴³ 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." Ultimately, the Berne+ remedies argument 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 duties⁴⁴).

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.⁴⁵ But

⁴² TRIPS, *supra* note 1, arts. 2(2), 9(1).

⁴³ Thanks to Prof. Susy Frankel for this point.

⁴⁴ 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).

⁴⁵ On computer programs, see SILKE VON LEWINSKI, INTERNATIONAL COPYRIGHT LAW AND POLICY 232 (2008):

those gaps have been filled by other treaties that also incorporate the no-formalities proviso.⁴⁶ 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.”

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:

... [T]o 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 provision⁴⁷ 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.⁴⁸ 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

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 RICKETSON & GINSBURG, *supra* note 13, ¶¶ 8.92-.103 (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 (arguing that Berne subject matter includes original compilations of data).

⁴⁶ See treaties cited *supra* note 1.

⁴⁷ For its history, see, for example, RICKETSON & GINSBURG, *supra* note 13, ¶¶ 8.59–8.69.

⁴⁸ See VAN GOMPEL, *supra* note 22, at 170.

sought does not have a special regime for applied art, then 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).⁴⁹ 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 as to duration, and member states may either deny the last twenty years of protection altogether⁵⁰ or impose renewal obligations on foreign works.⁵¹

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.⁵² For pre-1978 works, the U.S. term of protection is ninety-five years from publication, as it is for works made for hire created as of 1978; audiovisual works frequently are works made for hire.⁵³ 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. If the copyright's duration in the country of origin exceeds the Berne minimum, but is less than the U.S. duration,⁵⁴ 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

⁴⁹ See *supra* note 22 and accompanying text.

⁵⁰ See Berne Convention, *supra* note 1, 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").

⁵¹ In the latter event, however, the member state must also require the same of local authors; apart from duration, the rule of national treatment remains as a general background obligation. See RICKETSON & GINSBURG, *supra* note 13, ¶¶ 6.93–97.

⁵² Berne Convention, *supra* note 1, art. 7(2).

⁵³ See 17 U.S.C. §§ 101, 302, 304 (2012).

⁵⁴ For example, under the EU Term Directive, the duration of protection of audiovisual works is seventy 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 seventy years could elapse from the last survivor's death before ninety-five years from publication have run out.

than for the longer term in the host country.⁵⁵ 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. Berne+ 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 on 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"⁵⁶ exceed Berne minima, a member state may neither impose formalities on the availability of the remedy, nor on the scope of the right (apart from duration); "Berne+ right" is as much a misnomer as "Berne+ remedy." The next section, however, will explore the counterarguments to this conclusion.

II. THE RELATIONSHIP OF FORMALITIES TO COPYRIGHT EXCEPTIONS

A. *Berne Art. 10bis(1): A Template for Permissible Opt-Out Formalities?*

One might conceptualize a departure from Berne rights into Berne+ territory through the back door of exceptions. National laws might start from the exceptions and limitations that Berne 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 authors to "opt out" of an exception or limitation by declaring their objection to its application.⁵⁷ Berne article 10bis(1) arguably supplies the template, stating:

⁵⁵ Berne Convention, *supra* note 1, art. 7(8). The United States does not currently apply the rule of the shorter term. *See* 17 U.S.C. § 104(a)-(c).

⁵⁶ Berne Convention, *supra* note 1, art 5(2).

⁵⁷ 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 et al., *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

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*. . . .

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 short 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. The drafting history of the Berne Convention indicates that art. 10bis(1) is a “*lex specialis*,”⁵⁸ 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 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.⁵⁹ Since the 1908 Berlin Revision also established the no-formalities rule, this assertion should carry some weight.

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

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.

⁵⁸ See, e.g., SAM RICKETSON, *THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS*, ¶ 5.85 (1987); Alexander Peukert, *A Bipolar Copyright System for the Digital Network Environment*, 28 HASTINGS COMM. & ENT. L.J. 1, 66 (2005).

⁵⁹ *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].

not to be copyrightable in the first place.⁶⁰ The 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.”⁶¹ 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;⁶² 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.”⁶³ 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.⁶⁴ In historical context, therefore, the article 10bis(1) reservation is better characterized as a declaratory measure intended to bring Berne+ subject matter within the ambit of protection rather than as a condition on the scope of protection.

1. Situations to Which Opt-Out Exceptions Might Apply

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. I underscore that the possibility to opt-out should not be what makes an otherwise impermissible

⁶⁰ For an extended discussion, see *id.* at 249-54.

⁶¹ 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].

⁶² Berne 1896 Paris Revision, *supra* note 61, art. 7.

⁶³ Records of the 1908 Revision Conference, *supra* note 59, at 249 (“Des réclamations se sont élevées de différents côtés dans le sens d’un respect plus grand du droit des journalistes.”)

⁶⁴ 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 59, 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.

exception or limitation Berne-compatible.⁶⁵ If, for example, a member state either denied the translation right or broadly 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).⁶⁶

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 broadcasts of dramatic musical compositions,⁶⁷ could perhaps be made subject to an express reservation condition.⁶⁸ In that case, the reservation would give the author greater rights than Berne requires.

One may nonetheless acknowledge that the Berne-compatibility of a given potential exception may not always be clear, and that ambiguity invites a slide down the slippery slope towards finding an exception Berne-permissible because it allows opting-out. An exception scrutinized under the three-step test—(1) certain special cases, (2) that do not conflict with a normal exploitation of the work, and (3) do not unreasonably prejudice the legitimate interests of the author⁶⁹—and that passed the first two steps, might find its likelihood of satisfying the third step enhanced if the author’s ability to opt out diminished any prejudice otherwise incurred.

For a hypothetical application of the three-step test, first suppose an exception of arguable consistency with Berne norms, for example, digitization

⁶⁵ For assertion of the contrary contention, see Martin Senfleben, *How to Overcome the Normal Exploitation Obstacle: Opt-Out Formalities, Embargo Periods, and the International Three-Step Test*, 1 BERKELEY TECH. L.J. COMMENTARIES 1, 16, <http://btlj.org/data/articles2015/Commentaries/1-berkeley-tech-l-j-comm-0001-0019.pdf> [<https://perma.cc/8H6B-K7X6>].

⁶⁶ 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 22, 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.

⁶⁷ See Panel Report, *United States—Section 110(5) of the US Copyright Act*, ¶ 7.1(a), WT/DS160/R (June 15, 2000)(holding 17 U.S.C. § 110(5)’s exemption of retransmissions of non dramatic 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).

⁶⁸ For the reasons indicated *infra* Section II.A.2, 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.

⁶⁹ Berne Convention, *supra* note 1, art 9(2); TRIPS, *supra* note 1, art 13.

of out-of-print hardcopy books for nonprofit educational purposes.⁷⁰ 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 (non profit education).⁷¹ 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 rightsholder can secure future or derivative exploitations by opting-out; if the author or rightsholder 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.⁷²

⁷⁰ The Court of Justice for the European Union has ruled that libraries may create digital copies of books in their collection in order to display the contents on dedicated terminals located in the libraries, see, CJEU Case C 117/13, *Technische Universität Darmstadt v. Eugen Ulmer KG* (11 September 2014). In the US, library scanning and storage has been ruled fair use where the outputs were limited to data-mining or full-text access for the visually impaired. See *Authors Guild v. Hathi Trust*, 755 F.3d 87 (2d Cir. 2014). The Second Circuit has also ruled scanning and storage even for commercial purposes to be fair use, so long as the output is limited to non copyrightable information or de minimis expression. See *Authors Guild v. Google, Inc.*, 804 F.3d 202 (2d Cir. 2015). By contrast, courts in the EU have held that the scanning and storage of full texts for commercial purposes does not qualify for any of the domestic law exceptions authorized under the 2001 Information Society Directive. See, e.g., *Tribunal de Grande Instance de Paris*, judgment of 18 December 2009, *Editions du Seuil v. Google* (finding that Google Books’ program of scanning and storage violated French copyright law).

⁷¹ Though it is less apparent that the exception is narrow in application, given the potentially substantial numbers of out of print hardcopy books.

⁷² 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 for rightholders, 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 preservation 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

In this scenario, even if the opt-out rendered the exception Berne-compatible, the author must still accomplish a declaratory measure in order to preserve her exclusive rights; on its face, the measure seems a formality conditioning the enjoyment or exercise of her rights. That is, the same declaratory measure that might enable the exception to pass muster under the second and third steps would condemn the exception under the no-formalities rule. On the other hand, if an applicable exception or limitation already diminished her exclusive rights, then failure to comply with the formal measure would not make the author worse off. Compliance will make her better off and therefore will affect the enjoyment of her rights, but the premise of an opt-out structure is that Berne does not require her to be “better off” than the Berne minima (so long as local and foreign authors receive the same level of protection). Accordingly, it would not matter that formalities condition the extent of Berne+ protection.

The success of this argument depends largely on whether one credits the proposition that art. 5(2)’s prohibition stops at Berne minima. We have contended that a Berne+ approach could apply to subject matter, but if Berne does not require protection for that subject matter in the first place, then the Convention as a whole, including its no-formalities rule, does not apply.⁷³ We have also posited a Berne+ approach to duration, but Berne’s provisions on duration depart from the general treaty structure in their adoption of a reciprocity rule. By contrast, we have rejected the Berne+ argument in the context of remedies, where art. 5(2)’s incorporation of local “means of redress” provides a textual basis for concluding that the no-formalities rule extended to remedies more extensive than required by the Convention. Indeed, given Berne’s paucity of specified remedies, if the no-formalities rule did not apply to national means of redress, the rule would be substantially eviscerated. By the same token, art. 5(2)’s incorporation of the local “extent of protection” should be equally subject to the no-formalities rule, whether that extent coincides fully with Berne minima, or exceeds them. The relative lack of substantive Berne minima when the no-formalities rule was adopted in the 1908 Berlin revision,⁷⁴ with the corresponding relegation of core substantive

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.

⁷³ See Berne Convention, *supra* note 1, art. 5(1) (“Authors shall enjoy, in respect of works for which they are protected under this Convention, in countries of the Union other than the country of origin, the rights which their respective laws do now or may hereafter grant to their nationals, as well as the rights specially granted by this Convention.”). It follows that the Berne Convention does not require that authors enjoy either national treatment or conventional minimum rights with respect to works for which they are not protected under the convention.

⁷⁴ The 1908 revision required member states to protect rights of public performance (art. 11), adaptation (art. 12), adaptation of a musical work into a sound recording, with the possibility to condition the right on national compulsory licenses (art. 13), cinematographic

rights, such as the right of reproduction,⁷⁵ to national law, reinforces the conclusion that Berne+ rights may not be conditioned on compliance with formalities, including through the back door of exceptions.

2. Problems of Implementation of Opt-Out Exceptions

Practical considerations furnish additional reasons to be wary of opt-out exceptions. As a preliminary matter, the proposition that the possibility of opting out lets the exception pass steps two and three of the Berne article 9(2)/TRIPS article 13 test ignores the details of the opt-out's implementation. Unlike the article 10bis(1) news reporting exception whose drafters appear to have assumed a simple and uniform means of opting out by publication of a notice in the newspaper,⁷⁶ 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. 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

adaptations (art. 14). The French text of the 1908 Berlin Revision is available at http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=278699 [<https://perma.cc/8JKR-ZMXY>].

⁷⁵ A general right of reproduction was not added to the substantive minima until the 1967 Stockholm revision. See RICKETSON & GINSBURG, *supra* note 13, ¶¶ 11.03-11.19.

⁷⁶ Records of the 1908 Revision Conference, *supra* note 59, 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.

(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.⁷⁷

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-actable exceptions for public performance in religious services, and Berne member state *Y* instituted opt-actable exceptions to the reproduction right for the visually impaired, and Berne member state *Z* provided opt-actable 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-actable 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? Moreover, what consequences to the author if third parties remove the notice from the metadata, and downstream recipients therefore lack notification of the author's reservation of rights?⁷⁸ For works in analog formats, will each member state

⁷⁷ See Victor Nabhan, *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* 94 *Lamy Revue du Droit de l'Immatériel* 35, 36 (June 2013).

⁷⁸ While metadata standards, incorporating information relevant to copyright management exist, *see, e.g.*, standards proposed by the International Press

create a registry of objections? Will there be a centralized registry for opt-outs, perhaps administered by WIPO? The more one contemplates the implementation of national opt-outs, the more apparent their incompatibility with Berne norms.

An author's failure to opt out of a plethora of national exceptions 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 for all concerned.

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, either via a copyright registry or perhaps by means of digital metadata⁷⁹, 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*.⁸⁰ Thus, if the opt-out is what makes the

Telecommunications Council [IPTC] for information embedded in photographs, <https://www.iptc.org/std/photometadata/documentation/GenericGuidelines/index.htm#!Documents/iptccore.htm> [<https://perma.cc/8UKY-UP2E>], many Internet platforms, including Facebook, Instagram, Flickr, Tumblr, Twitter, Pinterest, LinkedIn and Google Photo, practice metadata-stripping, hiding or deleting information identifying the author and concerning the terms of use of the photo. *See, e.g., Social Media Sites Metadata Test Results*, IPTC, <http://www.embeddedmetadata.org/social-media-test-results.php> [<https://perma.cc/WUD5-AAKV>] (IPTC study assessing the extent to which websites remove or modify photo files' metadata). Removal of an opt-out notice might constitute a violation of WIPO Copyright Treaty member states' art. 12 obligation to protect "rights management information" (partially implemented in U.S. law at 17 U.S.C. sec. 1202), but the high burden of proof of intent to facilitate infringement makes the outcome of an enforcement action uncertain. Moreover, such an action adds insult (and costs) to injury: it puts authors in the position of having to enforce the protection of a rights-reservation notice that they should not have been obliged to provide in the first place.

⁷⁹ Indeed, authors should be encouraged to provide rights-management information, and technologists should help authors achieve that end.

⁸⁰ 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

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, such as those to render out-of-print works more accessible, that prompted adoption of the exception because a prospective-only exception will not apply to older works.

3. Policy Objections

Opt-out formalities are problematic 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 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

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*, ALAI.ORG (January 2006), <http://www.alai.org/assets/files/resolutions/creative-commons-licenses.pdf> [<https://perma.cc/9ZMP-QRWX>] (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.); *Consideration for Licensors and Licensees*, CREATIVE COMMONS, https://wiki.creativecommons.org/index.php?title=Considerations_for_licensors_and_licensees [<https://perma.cc/7JD6-6AL8>] ("Remember the license may not be revoked. Once you apply a CC license to your material, anyone who receives it may rely on that license for as long as the material is protected by copyright and similar rights, even if you later stop distributing it.")

increasingly like the trap for the unwary that rightly brought formalities into disrepute.

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.⁸¹ 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 should not save the exception from Berne-incompatibility.

B. *Reconciling the No-Formalities Rule with Other Policy Objectives: Mass Digitization*

In light of all the above objections, is there nonetheless a Berne-compatible means to enable mass digitization in the absence of specific authorization by the authors or rightholders? Several countries have essayed variations on opt-out authorizations, but they have confined their application to domestic works, hence avoiding conflicts with Berne norms.⁸² Might it nonetheless be possible, consistently with Berne, to implement a default authorization for non commercial digitization of out-of-print hardcopy works from other Berne Union states, or to authorize cross-border dissemination of works digitized in the country of origin?

⁸¹ See, e.g., Pamela Samuelson & Tara Wheatland, *Statutory Damages in Copyright Law: A Remedy in Need of Reform*, 51 WM. & MARY L. REV. 439, 454-55 (2009) (“The prompt registration requirement for statutory damages has not become a meaningful inducement to registration for all authors who value copyright protection, but rather a substantial boon to major copyright industry players—the commercial exploiters of copyrighted works whose rights largely derive from the Act’s work for hire rules or assignments from authors ‘Little guy’ authors thus, in theory, have the same strong legal rights as major copyright industry players, but effectively no way to get relief when their rights are infringed.”); 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.”)

⁸² See, e.g., France, Loi no 2012-287 du 1er mars 2012 relative à l’exploitation numérique des livres indisponibles du XXe siècle (1) [Law 2012-287 of Mar. 1, 2012 on the Digital Exploitation of Unavailable Books of the Twentieth Century], JOURNAL OFFICIEL DE LA RÉPUBLIQUE FRANÇAISE [J.O.] [OFFICIAL GAZETTE OF FRANCE], Mar. 2, 2012, p. 3986, (effective as of the publication of décret n°2013-182 of Feb. 27, 2013 on the application of articles L.134-1 to L.134-9 of the Code of intellectual property); art. L. 134-1 specifies that the law applies only to books published in France before 2001.

The EU Orphan Works Directive⁸³ suggests one approach. It authorizes public educational establishments, libraries, museums and broadcasters to reproduce and communicate to the public works whose rightowners cannot be identified or located notwithstanding a diligent search. A diligent search in the work's country of first publication or broadcast will suffice to allow use throughout the EU.⁸⁴ Thus, while the exception is EU-wide, to benefit from the exception, the user need comply with only a single member state's law. However, while the Orphan Works Directive simplifies the transnational application of an exception, it does not present a problem of compliance with formalities because it does not include an opt-out mechanism. Indeed, a work may, at the time of first publication, have followed all formal steps, but with the passage of time, rightholder-location information may have fallen out of date. Nonetheless, the Directive's technique of reducing search costs by designating the country of origin as the locus of a search of community-wide validity may furnish one element in the construction of a Berne-compatible multi-territorial mass digitization program.

Suppose, for example, that a national law authorized the digitization of out-of-commerce works first published in hardcopy in that state before 2000 (a date that roughly corresponds to the pervasive availability of many kinds of works in digital form). The law designated the national library to publish lists of works that the library ascertained were out of commerce, and gave authors and rightholders six months following the lists' publication to object to third party digitization. After six months, third parties may digitize and disseminate the works,⁸⁵ including beyond national borders. An author resident in that state (but who failed to make a timely objection) brings an infringement action based on the communication of the digitized work to a neighboring state. While Berne norms do not apply to authors who reside in the Berne Union state in which the alleged infringement occurred (assuming that country was also the country of the work's first publication),⁸⁶ they do apply to non resident Berne Union authors who allege that an infringing act (communication of the digitized copy) took place in a different Berne member state.

The first question in this instance would be whether under the law of the state in which the alleged infringement occurred (i.e., the state in which a communication was received or an offer to communicate the work was directed⁸⁷), the act would be infringing, or instead would qualify for a local

⁸³ Directive 2012/28/EU of the European Parliament and of the Council of 25 March 2012 on Certain Permitted Uses of Orphan Works, 2012 O.J. (L 299).

⁸⁴ Id. ¶¶ 3(3); 4.

⁸⁵ The hypothetical law is inspired by the French law of March 1, 2012, *supra* note 81.

⁸⁶ See Berne Convention, *supra* note 1, art. 5(3) ("Protection in the country of origin is governed by domestic law.").

⁸⁷ The infringement, the making available of the digitized work, arguably occurs both in the country from which the offer to communicate the work is made and in the country to

(Berne-compatible) copyright exception. If in the country of exploitation, the exception would not apply in the absence of an opt-out, the next question would be whether the opt-out in the country of origin would be effective in the country of exploitation, and would therefore bring the exception within Berne norms. If other Berne Union states credited country of origin opt-outs, rather than imposed their own conditions, many of the practical implementation issues discussed above would be alleviated. There remain two significant questions: first, whether an opt-out can sanitize uses that otherwise would conflict with a normal exploitation of the work or otherwise would unreasonably prejudice the legitimate interests of the author or rightholder; second whether the opt-out, even if consonant with the three-step test, is an impermissible formality under art 5(2). As we have seen, the interrelationship of the two questions advises much caution, lest a proliferation of opt-out exceptions ultimately shift international copyright from the Union-wide property right that vests upon creation (as envisioned ever since the 1908 Berlin Revision), into a series of declaratory obligations whose non effectuation sets the default to non protection.

Arguably, if other Berne Union countries credit the country of origin opt-out, they are not themselves imposing formalities, they simply are giving effect to a formality that Berne entitles the country of origin to impose. Nonetheless, we still encounter the problem that the author will not preserve exclusive rights outside the country of origin unless she fulfills a declaratory obligation. Other Berne Union countries thus would indirectly be conditioning the exercise of rights on compliance with formalities. As the French high court has recognized,⁸⁸ Berne's tolerance of *domestic* formalities is limited to the country of origin. The article 5(2) principle of the independence of international protection from the existence of protection in the country of origin necessarily renders fulfillment of country of origin formalities irrelevant to the existence of international protection. If other Berne member States denied protection to foreign works on the ground of non compliance with formalities in the foreign work's country of origin, then the domestic formalities would take on international effect, and this is a result plainly inconsistent with the Berne Convention. Indeed, it was precisely to prevent domestic formalities from compromising international protection that the Berlin revisers added what became article 5(2), establishing the independence

which the work is communicated. See, e.g., Jane C. Ginsburg, *Where Does the Act of "Making Available" Occur?*, in RESEARCH HANDBOOK ON EU INTERNET LAW 191 (Andrej Savin & Jan Trzaskowski eds. 2014). If the court applies the latter characterization, then the law of the country of receipt will apply. See, e.g., *Editions du Seuil*, *supra* note 70.

⁸⁸ Soc. Eds. Montparnasse v. Gaumont Columbia Tristar Home Video, Court of Cassation, First Civil Chamber, decision of 17 December 2009, Juris-Data No. 2009-050769; Communication Commerce Électronique, July-August 2010 p. 13, note Yves Gaubiac pp 10-12 (rejecting application in France of U.S. renewal formality as a prerequisite to a work's qualification for restoration of copyright under Berne art. 18(1)).

of international protection from the existence of protection in the country of origin.

Thus, if the opt-out, even if permissible for purposes of the three step test, were deemed a formality in the sense of art 5(2), then it would not be possible to structure a transnationally effective Berne-compatible mass digitization program that relied on opting out of national exceptions.⁸⁹ But if Berne prohibited all cross-border effect of a mass digitization program, even for non profit educational purposes, unless the authors affirmatively consented to the use, then the number of works enrolled might be less than desirable, or the transactions costs of obtaining wider consent too daunting. Hence the appeal of an opt-out approach, shifting the burden of objection to the author. Under what circumstances, then, might an opt-out system escape condemnation under article 5(2)?

The answer may turn on the object of the opt-out. If to preserve her rights, the author must opt-out of the application of a measure that goes to the existence or scope of protection, the opt-out should be deemed an impermissible formality under art 5(2). If, by contrast, the opt-out goes to a presumption of grant of an exclusive or non exclusive license, then that measure might not violate art. 5(2). I have argued elsewhere that declaratory measures concerning transfers of ownership are not “formalities” in the prohibited Berne sense.⁹⁰ If the national law were structured to presume a transfer of digitization rights to a local collecting society, which would in turn issue licenses to qualifying users, then it would fall outside art. 5(2).⁹¹ This technique appears unproblematic for authors who have already authorized local collecting societies to administer their rights of reproduction and/or communication to the public, particularly if the presumed grant of rights yielded revenue (potentially state-paid) from the licensee’s exercise of the digitization rights.

But if an author is not a member of the relevant collective management society, how can that society grant her digitization rights? This is where the

⁸⁹ *But see* Johann Axhamm & Lucie Guibault, *Cross-Border Extended Collective Licensing: A Solution to Online Dissemination of Europe’s Cultural Heritage?*, *Final Report for EuropeanaConnect*, INSTITUTE FOR INFORMATION LAW RESEARCH PAPER 2012-19 at 46, Aug. 2011, http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2001347 (arguing that in the context of opt outs for extended collective licenses – discussed *infra* – if the limitation complies with the three-step test, it should also be deemed permissible under Berne art. 5(2)).

⁹⁰ See, *Formal Constancy*, *supra* note **, at 1611-22; RICKETSON & GINSBURG, *supra* note 13, ¶ 6.105 (national author-protective requirements, such that transfers of title be in writing and signed by the author, are not “formalities”).

⁹¹ By contrast, a presumption of implied license to users at large to engage in mass digitization seems a state expropriation of rights, and essentially equivalent to an unremunerated exception.

“extended collective licensing” (“ECL”) technique comes into play.⁹² As the US Copyright Office has described it, “When the collective negotiates a license with a particular user that license is automatically extended – by operation of law – to all of the rights owners for those works, regardless of whether they belong to the collective organization or not. All copyright owners are entitled to receive a share of the royalties that the collective receives from its licensees. In some countries, copyright owners may be allowed to opt out of some uses of their works or demand individual remuneration if they believe that they are entitled to a larger share of the royalties for the use of their works.”⁹³ If local legislation so empowers it, when the collective negotiates with a local institutional user, such as a museum, school or a library, to authorize digitization of the works it represents, the corpus will include the works of local authors who have not specifically authorized the collective to grant those rights.

The transnational effect of ECL licenses so far has been limited to reciprocal agreements among collectives in the countries that have adopted ECL measures,⁹⁴ and it appears the Berne-conformity of such agreements has not been challenged. To the extent ECL measures resemble mandatory collective licensing, that is, “national law requirements that copyright licensing be carried out exclusively by a collecting society (with little freedom for the author to resist this),” it has been argued that the latter is not the kind of condition on exercise of rights that article 5(2) targets.⁹⁵ In general, apart from specifying the independence of moral rights even after the transfer of economic rights, and barring certain actions by second-level co-authors of a cinematographic work against the work’s “maker”,⁹⁶ Berne does not intervene in author-

⁹² According to a 2011 Copyright Office study, LEGAL ISSUES IN MASS DIGITIZATION: A PRELIMINARY ANALYSIS AND DISCUSSION DOCUMENT, at 34-36, the application of ECLs has so far not extended to mass digitization, though there may be some prospect for such an extension. See MEMORANDUM OF UNDERSTANDING: KEY PRINCIPLES ON THE DIGITISATION AND MAKING AVAILABLE OF OUT-OF-COMMERCE WORKS, available at http://ec.europa.eu/internal_market/copyright/docs/copyright-info/20110920-mou_en.pdf [<https://perma.cc/9CN6-PG3J>].

⁹³ LEGAL ISSUES IN MASS DIGITIZATION, *supra* note 92, at 35.

⁹⁴ The Extended Collective Licenses regime of the Nordic countries are limited to domestic exploitations, but the collecting societies have reciprocal agreements with collecting societies in other states. See, e.g., Thomas Riis and Jens Schovsbo, *Extended Collective Licenses and the Nordic Experience: It's a Hybrid but is it a Volvo or a Lemon?*, 33 COLUM. J.L. & ARTS 471, 473-76 (2010).

⁹⁵ See RICKETSON & GINSBURG, *supra* note 13, at para. 6.105 & n.322.

⁹⁶ Berne Convention, *supra* note 1, art. 6bis (“(1) *Independently of the author's economic rights, and even after the transfer of the said rights, the author shall have the right to claim authorship of the work and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor*”).

exploiter relationships. “The rationale and effect of” national rules designating entities to exercise the author’s licensing of rights “are profoundly different from public-protective formalities, such as notice or registration, or copyright-specific litigation hurdles, which seek to shield the public from authors’ claims. In the former instance, the formal rules tell us *who* is entitled to enforce a copyright whose existence the rules do not call into question. In the latter instance, the formalities limit *any* claimant’s enforcement, and may destroy the copyright altogether.”⁹⁷

One might posit national legislation in Country *A* that presumes a transfer of both domestic and foreign rights in works of local origin to the collecting society, subject to an opt-out. Country *A*’s collecting society then could enter into reciprocal agreements with similarly-empowered collecting societies in Countries *B* and *C* (etc.), or Country *A*’s society could exercise those rights itself, for example, by authorizing the making available from Country *A* to Countries *B* and *C* of works digitized in Country *A* under *A*’s extended collective license.⁹⁸ An author from Country *A* who did not opt out of the presumption of transfer would be deemed to have transferred her rights to the Country *A* collective not only for exploitations of the digitized work in Country *A*, but also for Countries *B* and *C* (etc.). Had author *A* directly authorized a co-contractant in Country *A* to license rights in her work throughout the Berne Union, there is little doubt under general principles of private international law, that Countries *B* and *C* would recognize the grant (though local norms in *B* and *C* might restrict the scope of the grant, for example to decline to give local effect to a purported transfer of moral rights⁹⁹). Whether Country *B* recognizes author *A*’s transferee as the holder of rights for Country *B* is a matter of Country *B*’s private international law rules.

or reputation.” (emphasis added)); art. 14bis(2)(3) (rights of co-authors other than screenwriters, composers and principal directors against maker of cinematographic work).

⁹⁷ RICKETSON & GINSBURG, *supra* note 13, at para. 6.105.

⁹⁸ These speculations do not intend to minimize the practical challenges of creating such collecting societies, particularly in countries, such as the U.S., in which collecting societies are both less pervasive than elsewhere, for example in the European Union, and operate under considerable antitrust constraints. For further, and skeptical, discussion of those challenges, see Pamela Samuelson, *Extended Collective Licensing to Enable Mass Digitization: A Critique of the U.S. Copyright Office Proposal*, available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2683522 at 2-8. For a more sanguine view, see U.S. COPYRIGHT OFFICE, REPORT ON ORPHAN WORKS AND MASS DIGITIZATION 82-105 (June 2015), <http://copyright.gov/orphan/reports/orphan-works2015.pdf> [<https://perma.cc/Q8FN-NQ48>]

⁹⁹ See, e.g., AM. LAW INST., INTELLECTUAL PROPERTY - PRINCIPLES GOVERNING JURISDICTION, CHOICE OF LAW AND JUDGMENTS IN TRANSNATIONAL DISPUTES § 314 (2008) (law of country for which rights are transferred determines the scope of the transfer); Cour de cassation, première chambre civile [Cass. 1e civ.], May 28, 1991, Bull. civ. I, No. 172 (Huston v. La Cinq) (Fr.) (French law applies to determine the assignability of moral rights).

If Country *B* would recognize an arms-length transaction in Country *A* transferring rights for Country *B*, would it also recognize a presumption of transfer? Country *B*'s copyright-contract law may or may not entertain presumptions of transfer in the ECL context, and by the same token, may determine what acts rebut the presumption of transfer (and its copyright-contract law or its private international law may determine whether a country of origin opt out preserves the author's rights in Country *B*), but because these questions go neither to the existence nor the enforcement of copyright protection, they do not implicate the Berne no-formalities rule.

Thus, an ECL regime establishing an opt-outable presumption of transfer of digitization rights in out-of-commerce works to a collecting society in the country of origin, paired with reciprocal agreements among collecting societies in other Berne Union states whose legislatures have also authorized ECL regimes should enable educational and cultural institutions in each participating state to digitize local works and communicate them to other participating states. With such a network of reciprocal agreements, licenses obtained from the collective by local educational and cultural institutions should entitle those institutions to access not only local but also foreign works digitized under the ECL licenses. Under an alternative structure, the country of origin collective would license rights for foreign uses as well. Those licenses would entitle local educational and cultural institutions to make local works available to foreign users, but local users who wished to access foreign works then would be obliged to obtain licenses from each foreign collective.

Is this distinction, between a Berne-objectionable regime of opt-outable exceptions and a Berne-compatible regime of opt-outable presumptions of transfers, unpersuasively formalistic? In this context, is there any meaningful distinction between a license presumed in law and an exception? Any difference would not rest on availability of compensation because the exception could require remuneration, and the license might be free of charge. But there are practical differences. First, as we have seen, whether an opt-out may enable an otherwise Berne-prohibited exception to pass the three-step test is highly controversial. Second, as we have also seen, national law exceptions may vary both in scope and in implementation, and complying with different opt-out mechanisms may trip up many authors. National ECL opt-outs might also vary, but if it suffices to comply with the requirements in the country of origin for the author to withhold her work from local or foreign digitization and dissemination, it becomes possible to avoid the complexities and pitfalls of multiple national opt-out regimes.

CONCLUSION

Requiring the author to opt-out of a restriction on the scope of her exclusive rights violates the Berne Convention's prohibition on subjecting "the enjoyment and the exercise" of her rights to compliance with formalities. The prohibition applies even when a member state provides rights that exceed the

conventional minimum scope of rights. This Essay has analyzed the practical and policy issues that underlie this conclusion. By contrast, Berne does not bar opt-out measures that pertain to the administration of authors' rights by collective management organizations, particularly in the context of extended collective licenses. In this instance, the opt-out notice does not affect the existence and scope of the author's rights. Rather, it goes to the licensing and management of authors' rights, whatever their content or extent. Berne generally leaves unaddressed issues going to ownership, transfer and licensing of authors' rights; member states may fill that gap, including by mandating or presuming the exclusive or nonexclusive grant of the author's rights to a collective management organization. Two considerations will determine the effectiveness of those organizations' grants of rights for territories beyond the works' countries of origin. First, whether the author's actual or presumed grant to the collective management organization included extraterritorial rights. Second, whether the copyright-contract and private international law rules of the countries for which the author granted rights will recognize the validity of the grant, particularly if the licensor's authority to exercise the author's rights in foreign states (including by means of reciprocal agreements with equivalent organizations in other states) derives from a presumption of transfer from authors who are not members of the licensing organization.