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One Hundred and Two Years Later: The U.S. Joins the Berne Convention

by JANE C. GINSBURG* AND JOHN M. KERNOCHAN**

INTRODUCTION

In historic votes on October 5 and October 12, the U.S. Senate and House of Representatives unanimously approved legislation designed to bring U.S. law into compliance with the Berne Convention.¹ The legislation was signed by President Reagan on October 31, 1988. Also signed by the President was a Senate Resolution of October 20 of Ratification of the Berne Convention. Following deposit of the requisite instruments with the World Intellectual Property Organization in Geneva, U.S. adherence to Berne took effect on March 1, 1989.

For the U.S., this momentous step is the culmination of decades of struggle, including many failed attempts by the U.S. over the years to align itself with other developed and developing nations in subscribing to the world's oldest and most extensive treaty protecting the rights of authors. The step was at last achieved in the closing hours of the hectic session of the Congress shortly before the Presidential election. It was achieved, also, in the face of internal political maneuvering that threatened the adherence bills with delay and possible defeat until the last moment.

U.S. Efforts to Join Berne

U.S. ratification came one hundred and two years after the United States' official observer at the initial international conference from which the Convention emerged recommended U.S. participation in the Berne Union. At that time, the U.S. had no international copyright relations. We were, and had long been, a "pirate nation" for whom protection abroad offered fewer attractions than free copying

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1. The Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853 (1988) [hereinafter *Berne Implementation Act*].

at home of foreign, particularly British, works.² There was no general provision protecting foreign works until the Chace Act of 1891.³ Over the intervening century, the U.S. politics of intellectual property changed. From a user and importer of copyrighted works, the U.S. became a producer and leading exporter. The appeal of international protection became correspondingly manifest. There followed a proliferation of bilateral copyright agreements,⁴ but, until the 1950s, no participation in a major multilateral copyright convention.⁵

When the U.S. finally joined a major international convention in 1955, it was not the Berne Convention. At that time, U.S. law fell below many of the substantive minima of protection imposed by the Berne Convention. For example, Berne sets forth a minimum duration of copyright of fifty years,⁶ but U.S. copyright protection endured for only 28 years, unless the proprietor renewed the registration for a second 28-year term.⁷ Berne prohibits imposition of formalities conditioning the enjoyment or exercise of copyright,⁸ but U.S. law at the time required a notice of copyright on published copies and omission of the notice resulted in loss of protection.⁹ Moreover, U.S. law required registration and deposit of works as a prerequisite to a suit for copyright infringement.¹⁰ Beginning in 1928, Berne provided for the author's "moral rights" to claim attribution for his work, and to prevent its alteration or mutilation,¹¹ but the U.S. did not recognize such rights. Rather than amend its law to resolve these and other differences to permit Berne adherence, the U.S. actively promoted the creation of the Universal Copyright Con-

2. See, e.g., Sandison, *The Berne Convention and the Universal Copyright Convention: The American Experience*, 11 COLUM.-VLA J.L. & ARTS 89 (1986); Ringer, *The Role of the United States in International Copyright—Past, Present and Future*, 56 GEO. L.J. 1050 (1968).

3. Act of March 3, 1891, § 13, 22 Stat. 1106.

4. See 4 M. NIMMER, NIMMER ON COPYRIGHT, Appendix 20 (1988), listing countries with which the U.S. has copyright relations, including bilateral arrangements, and the dates of entry into these agreements.

5. Except for the 1910 Buenos Aires Convention, 38 Stat. 1785, T.S. 593 (1911). This treaty provides for copyright relations between the U.S. and most North, Central, and South American nations.

6. Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, revised at Paris, July 24, 1971, art. 7 [hereinafter *Berne Convention*].

7. 17 U.S.C. § 24 (1909), superseded by 17 U.S.C. § 302 (1976) (term of life of author plus 50 years for works created as of 1978).

8. *Berne Convention*, supra note 6, art 5.2.

9. 17 U.S.C. §§ 10, 19 (1909). Under the 1976 Act, §§ 401 and 405, notice was still required, but the copyright owner benefited from a five-year period in which to cure omissions of notice.

10. 17 U.S.C. § 13 (1909). See also 17 U.S.C. § 411 (1976).

11. *Berne Convention*, supra note 6, art. 6bis.

vention (UCC),¹² a new international copyright treaty largely tailored to the peculiarities of U.S. law.

By the late 1980s, however, many U.S. officials and copyright proprietors perceived that remaining outside the Berne Union was at the least inconvenient, and moreover was proving increasingly embarrassing and even detrimental to U.S. copyright interests. Nonmembership was inconvenient because many U.S. copyright industries found the commonly used indirect method of achieving Berne protection costly and onerous. This method involved manipulating the work's country of origin by effecting "simultaneous" publication in a Berne country (usually Canada), thus obtaining "back door" Berne protection.¹³ It was also possible to achieve Berne-level protection in those UCC countries also signatory to the Berne Convention which had merged Berne standards with their domestic law, for the rule of national treatment (according UCC authors the same treatment as nationals) would accord U.S. copyright owners protection coextensive with Berne minima. However, U.S. resort to the UCC and to the "back door" to achieve Berne-level protection without assuming Berne's responsibilities produced considerable resentment, and even threats of retaliation.¹⁴ Moreover, despite occasionally benefiting from Berne, the U.S. had no role in the evolution and management of this premier international pact. In an era of rapid technological change and doctrinal development, the U.S. continued to stand on the outside looking in.¹⁵

Nonmembership in the Berne Convention was embarrassing not only because the U.S. was the only non-Unionist Western country, but also because nonmembership offered one ground of resistance to U.S. trade negotiators seeking to encourage greater respect for U.S. copyrights abroad. If the U.S. so strongly advocated a high level of

12. Provisions of the UCC particularly compatible with U.S. law under the 1909 Act include art. III (formalities) and art. IV (duration). The Universal Copyright Convention, July 24, 1971, 25 U.S.T. 1341, T.I.A.S. No. 7868.

13. *Berne Convention*, *supra* note 6, arts. 5.4b (work will be considered of Berne origin if it is published simultaneously in a non-Berne country and in a Berne country); 3.4 ("simultaneous" publication must occur within 30 days of actual first publication).

14. The capacity for retaliation was illustrated when various EEC Berne members proposed in 1986 to embargo millions of dollars worth of U.S. products unless the Copyright Act's manufacturing clause was eliminated. *See, e.g.*, NATIONAL COMMITTEE FOR THE BERNE CONVENTION, WHY THE UNITED STATES SHOULD JOIN THE BERNE CONVENTION 3 (1987). *See also* Ringer, *supra* note 2, at 1059.

15. *See* 133 CONG. REC. S7369 (daily ed. May 29, 1987) (statement by Sen. Leahy): "... today, and in future years, vital American interests can be fully represented in the international copyright system only if we get off the sidelines and onto the playing field, by joining the Berne Convention."

copyright protection and enforcement by its trading partners, why was the U.S. not a member of the most protective multilateral copyright treaty?¹⁶ Other political considerations also enhanced the attractions of Berne adherence: not only was the UCC less protective than Berne, it was administered by UNESCO, an international agency from which the U.S. had recently withdrawn its support. Moreover, adherence would secure copyright relations with twenty-four additional nations, and would bolster U.S. endeavors to include intellectual property in the General Agreement on Tariffs and Trade (GATT).¹⁷

The latest, and finally successful, U.S. effort to join Berne can be traced to the initiative of the State Department. The Department convened an Ad Hoc Working Group on U.S. Adherence to the Berne Convention¹⁸ to report on the changes in U.S. law required for adherence. The Group's Final Report¹⁹ restricted itself to identifying particular features of U.S. law currently *required* to be changed to achieve compatibility with Berne. It thus focused on U.S. laws as they affected works of foreign origin subject to Berne protection, since Berne "does not require that a member country grant the protections required by the Convention's text to works of which that country is 'the country of origin'."²⁰ In 14 chapters addressed to different aspects of authors' rights, the Working Group determined that particular questioned aspects of U.S. law were substantially legally

16. See, e.g., H.R. REP. No. 609, 100th Cong., 2d Sess. 18 (1988); S. REP. No. 352, 100th Cong., 2d Sess. 4-5 (1988).

17. *Hearings Before the Subcomm. on Patents, Copyrights and Trademarks of the Senate Comm. on the Judiciary* (Feb. 18, 1988) (statement of Ambassador Clayton Yeutter, United States Trade Representative) (available from the Proprietary Rights Comm., Information Industry Ass'n in Washington, D.C.).

18. The Working Group membership included: Irwin Karp, Chairman [Authors League of America]; Norman Alterman [Motion Picture Export Ass'n of America, Inc.]; Jon A. Baumgarten [Ass'n of American Publishers]; Leonard Feist [National Music Publishers Ass'n, Inc.]; Morton David Goldberg [Information Industry Ass'n]; Bella Linden [The Songwriters Guild]; I. Fred Koenigsberg [American Society of Composers, Authors & Publishers]; William Maxwell [Computer & Business Equipment Manufacturers Ass'n]; Gary Roth [Broadcast Music, Inc.]; Hamish R. Sandison [Recording Industry Ass'n of America]; Augustus W. Steinhilber [National School Boards Ass'n]; Robert Wedgeworth [American Library Ass'n]; and *ex officio*, Harvey J. Winter (serving as Executive Secretary) [Department of State]; Donald C. Curran [Former Acting Register of Copyrights]; Lewis Flacks [Copyright Office]; Michael S. Keplinger [Office of Legislation and International Affairs, U.S. Patent and Trademark Office]. Note that the Group members served as individuals; the names of various organizations they represent or are affiliated with are given solely for identification and do not imply endorsement by those organizations of the Final Report.

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

20. *Id.* at 516.

compatible with Berne, including: certain compulsory licenses;²¹ existing exemptions to rights of performance and display;²² and copyright ownership, especially works for hire.²³ The Working Group also judged that U.S. law as a whole afforded adequate equivalents to moral rights. However, the Group found that the following areas of U.S. copyright law were substantially *incompatible* with Berne standards: the jukebox compulsory license;²⁴ domestic manufacturing requirements;²⁵ many aspects of the formalities of notice, registration and recordation;²⁶ certain aspects of duration;²⁷ and (in a lesser degree) retroactivity, and certain exclusions from the subject matter of copyright. Finally, the Working Group concluded that the Berne Convention, as applied to the U.S., was not necessarily self-executing—the provisions of the Convention if ratified need not apply of their own force, but could be made to be effective in the U.S. solely via specific domestic legislation.

Following the Ad Hoc Working Group's Report, legislative proposals were introduced to secure Berne adherence.²⁸ In the hearings and discussions on bills to adhere to Berne, attention centered on: whether or not the Berne Convention was self-executing; moral rights and works for hire; formalities; jukebox licensing; and inclusion of architecture within the subject matter of copyright. The first three subjects were the most intensely debated.

The approach common to virtually all the legislation proposed, and governing the omissions from it, was the "minimalist approach" supported by a preponderance of the interests favoring Berne adherence.²⁹ In recognition of the ease with which even minority opposing

21. These licenses involve cable, sound recordings, and public broadcasting, 17 U.S.C. §§ 111, 115, 118.

22. *Id.* §§ 109, 110.

23. *Id.* §§ 101, 201(b).

24. *Id.* § 116.

25. *Id.* § 601. This became a non-issue because of expiration and non-renewal of the "manufacturing clause."

26. *Id.* §§ 401-12; 205(d).

27. *Id.* § 304(a).

28. In the 99th Congress, a bill drafted by the Copyright Office was proposed and discussed, see *Hearings on S. 1980 Before the Subcomm. on Patents, Copyrights and Trademarks of the Senate Comm. on the Judiciary*, 99th Cong., 2d Sess. (1986) (Chairman, Senator Charles C. Mathias, Jr.). Bills introduced in the 100th Congress included:

S. 1303 (Leahy), 100th Cong., 1st Sess. (1987)

S. 1971 (Hatch), 100th Cong., 1st Sess. (1987)

H.R. 1623 (Kastenmeier), 100th Cong., 1st Sess. (1987)

H.R. 2962 (Moorhead—Administration bill), 100th Cong., 1st Sess. (1987)

H.R. 4262 (Kastenmeier), 100th Cong., 2d Sess. (1988)

29. See, e.g., H.R. REP. NO. 609, *supra* note 16 at 20 ("Philosophy of the [Berne Imple-

interests can block legislation from passage through the intricate Congressional processes, this approach called for making only those changes in existing U.S. law essential to achieve a plausible level of Berne compatibility. In retrospect, and considering how close the whole effort came to being derailed in its closing stages, it would seem the proponents of this approach were right. The price paid was arguably a less than full embracing of the "Spirit of Berne" in its broadest sense. But adherence, the principal goal, was in fact attained. New battles to move U.S. law further toward a fuller acceptance of Berne's wider implications will certainly be fought in the future.

Under the compromises hammered out in the legislative arena, it was early decided that the Berne Convention would not be "self-executing" in the United States. The U.S. Berne Adherence legislation enacted by Congress therefore purports to be the sole source of Berne rights and rules under U.S. law to which claimants may appeal, except when conflict of laws rules otherwise direct and except when, as we will see hereafter, substitutes or "rough equivalents" to Berne provisions may be found in U.S. copyright legislation or in other federal or state statutes, decisions or regulations that now exist or may later be developed.³⁰ This very guarded stance, a key element in the minimalist approach, was essential to U.S. adoption of Berne.³¹

Finally, it is worth observing that the support of major U.S. commercial interests, particularly in the computer field, the film industry, and certain portions of the publishing industry, was essential to secure adherence to the Berne Convention.³² In many Congresses before the 100th, bills urging ratification of the Berne Convention had been proposed.³³ Yet until now, no Berne adherence attempt

menting] Legislation"); 133 CONG. REC. S14552 (daily ed. Oct. 5, 1988) (statement of Senator Leahy upon Senate passage of the Berne legislation).

30. See Berne Implementation Act, §§ 2, 3, 4, 6, 102 Stat. 2853 (1988).

31. Certain of the other incompatibility problems raised by the Ad Hoc Working Group were largely brushed aside as non-essential, such as renewal and duration, and problems of retroactivity. The manufacturing clause became moot. Initial proposals for protecting architecture fell by the wayside. *But see infra* notes 89-99, and accompanying text. Defining "Berne Works" proved complex, but was generally managed without serious controversy. *See infra* note 52.

32. Some artists and arts groups played a minor role in the adherence struggle. Unfortunately, to the extent that they adopted a purist stance, refusing to recognize political realities and the impossibility of going beyond the minimalist position if adherence was to be achieved, their participation also sometimes proved obstructive.

33. See Ringer, *supra* note 2, at 1058, and sources cited therein, especially, GOLDMAN, THE HISTORY OF USA COPYRIGHT LAW REVISION (Studies Prepared for the Subcomm. on Patents, Trademarks and Copyrights of the Senate Comm. on the Judiciary, 86th Cong., 1st Sess.,

had even approached a likelihood of passage. What made the difference this time may well have been the efforts of the majority of U.S. copyright industries.³⁴ Why they in turn pushed for Berne adherence

pursuant to S. Res. 53) Study No.1, at 4 (1960).

34. Many members of these industries formed groups to lobby in favor of Berne adherence. The two principal groups were the National Committee for the Berne Convention (NCBC), and the Committee for Adherence to Berne (CAB).

NCBC members were:

ADAPSO (The Computer Software and Services Industry Ass'n); American Ass'n of School Administrators; American Ass'n of University Professors; American Council on Education; American Library Ass'n; ASCAP (American Society of Composers, Authors & Publishers); Applied Data Research, Inc.; AAUP (Ass'n of American University Presses); Ass'n of Research Libraries; Autodesk, Inc.; Baltimore County Schools; BMI (Broadcast Music Inc.); CBEMA (Computer and Business Equipment Manufacturers Ass'n); Comshare, Inc.; Council for American Private Education; The Data Group Corp.; Deneb Systems, Inc.; The Walt Disney Co.; Distribution Management Systems Corp.; Elsevier Science Publishing Co., Inc.; Gancom, Inc.; Harcourt Brace Jovanovich, Inc.; I.M.R.S., Inc.; Integral Business Systems; IBM (Int'l Business Machines Corporation); IIA (Information Industry Ass'n); Int'l Reading Ass'n; Johns Hopkins University; Management Science America, Inc. (MSA); Music Education Nat'l Conference; Nat'l Clearinghouse for Bilingual Education; Nat'l Commission on Libraries and Information Science; NMPA (Nat'l Music Publishers Ass'n); NSBA (Nat'l School Boards Ass'n); SESAC Inc., Supply Tech, Inc.; TLB, Inc.; Unitech Software, Inc.; U.S. Catholic Conference; United States Council for Int'l Business; Vanguard Atlantic Ltd.; Viewplan, Inc.; VM Personal Computing, Inc.; WOS Data Systems, Inc.; John Wiley & Sons, Inc. Publishers; Ashton-Tate Corp.; Harris Publishing Co.; Hudson Hills Press, Inc.; IPL (Intellectual Property Owners, Inc.); Lotus Development Corp.; MPAA (Motion Picture Ass'n of America); Music Publishers Ass'n of the United States; Peter Norton Computing Members; Intellectual Property Committee.

CAB members were:

ADAPSO; American Electronics Ass'n; American Film Marketing Ass'n; Ass'n of American Exporters and Importers; AT&T; BMG Music (Formerly RCA-Ariola, Int'l); California Council for Int'l Trade; Computer and Business Equipment Manufacturers Ass'n; Consumers for a Sound Economy; Digital Equipment Corporation; Elsevier Science Publishing Co., Inc.; Gulf & Western (Simon & Schuster, Paramount Pictures); Hewlett-Packard Co.; Hasbro Toy Co.; Hudson Hill Press; IBM Corp.; Information Industries Ass'n; Intellectual Property Committee; Intellectual Property Owners; John Wiley & Sons, Inc.; Lotus Software; Motion Picture Ass'n of America; Nat'l Ass'n of Manufacturers; Training Media Distributor Ass'n; Texas Instruments Inc.; Walt Disney Studios.

Members of other intellectual property industries also urged Berne adherence. The following entities formed the Intellectual Property Committee:

Bristol-Myers Co.; E.I. du Pont de Nemours and Co.; FMC Corp.; General Electric Co.; General Motors Corp.; Hewlett-Packard Co.; IBM Corp.; Johnson & Johnson; Merck & Co., Inc.; Monsanto Co.; Pfizer Inc.; and Rockwell Int'l.

See S. REP. NO. 352, *supra* note 16, at 7-8.

Certain portions of the publishing industry, however, displayed considerably less enthusiasm for the Berne Convention. Several magazine publishers formed the "Coalition to Preserve the American Copyright Tradition," principally to prevent Berne adherence from becoming a means toward the recognition and fostering of moral rights in the U.S. Members of this lobbying group were:

most likely stems from the increased recognition of the importance of international consumption, and therefore of international protection, of U.S. copyrighted works.³⁵

The ensuing discussion examines two broad questions concerning the legislation leading to Berne adherence: first, what features of U.S. copyright law have changed in light of Berne adherence; second in those areas of copyright law which Congress failed to change, how does the U.S. law compare with treaty standards?

I. Changes in U.S. Domestic Copyright Law

There are two principal areas in which the new legislation has modified the 1976 Copyright Act: the compulsory license for jukebox performances of nondramatic music, and most importantly, formalities.

A. Jukebox Licensing

Of the four compulsory licenses in the U.S. Copyright Act that took effect in 1978, only one was determined to be incompatible with Article 11(1) of the Berne Convention—the Jukebox License. Compulsory licenses were found to be permitted for cable television under Article 11*bis* (2), and for mechanical recordings under Article 13(1). As to public broadcasting, the Ad Hoc Committee had found it arguable that Article 11*bis* (2) and Article 9(2) permitted this limited type of compulsory licensing.

By contrast, the Jukebox Licensing provisions could not stand in the face of Article 11(1) of the Berne Convention, which states:

Authors of dramatic, dramatico-musical and musical works shall enjoy the exclusive right of authorizing:

Conde Nast Publications, Inc.; Davis Publications, Inc.; Dow Jones & Co., Inc.; Forbes Inc.; McGraw-Hill, Inc.; Meredith Corp.; Newsweek, Inc.; Omni Publications Int'l, Ltd.; Playboy Enterprises Inc.; The Reader's Digest Ass'n, Inc.; Rodale Press, Inc.; Straight Arrow Publishers, Inc.; Time Inc.; Triangle Publications, Inc.; Turner Broadcasting System, Inc.; U.S. News & World Report.

The Magazine Publishers Association also opposed Berne adherence.

35. See, e.g., U.S. INTERNATIONAL TRADE COMM., FOREIGN PROTECTION OF INTELLECTUAL PROPERTY RIGHTS AND THE EFFECT ON U.S. INDUSTRY AND TRADE (Investigation No. 332-245 under Section 332(g) of the Tariff Act of 1930) (February 1988); GENERAL ACCOUNTING OFFICE, INTERNATIONAL TRADE: STRENGTHENING WORLDWIDE PROTECTION OF INTELLECTUAL PROPERTY RIGHTS, GAO/NSIAD-87-65 (April 1987); *Oversight on International Copyrights*, 1984: *Hearing Before the Subcomm. on Patents, Copyrights and Trademarks of the Senate Comm. on the Judiciary*, 98th Cong., 2d Sess. 15 (1984) (report submitted by David Ladd, Register of Copyrights, U.S. Copyright Office: *To Secure Intellectual Property Rights in World Commerce*).

- (i) the public performance of their works, including such public performance by any means of process;
- (ii) any communication to the public of the performance of their works.

Thus Congress undertook to revise the terms of § 116 of the Copyright Act. The new § 116 contemplates that the jukebox operators and the copyright owners will negotiate a voluntary license agreement on terms and rate of royalty payments, division of fees, and designation of agents.³⁶ Negotiations may be remitted to arbitration.³⁷ Licensing arrangements successfully arrived at in this way are “in lieu” of any compulsory determination of such arrangements by the Copyright Royalty Tribunal (CRT).³⁸ Compulsory licensing under the aegis of the CRT remains in effect until arrangements are concluded privately and, if private licensing fails or terminates for some reason, compulsory licensing will provide a “safety net” and will govern, filling any licensing gap that might otherwise occur.³⁹

In essence Congress in the new § 116 has called for and facilitated private licensing between the parties and relegated CRT-controlled compulsory licensing to a back-up role. Whether this revised system will in fact result in successful and enduring private licensing by private collectivities remains to be seen, but it is quite possible that it will, since there is an element of coercion in the background. Of the three major areas of change in U.S. law, this one — building on existing arrangements — was perhaps the least controversial.

B. *Formalities*

1. *Notice*

The most significant change in U.S. copyright law concerns the notice requirement: works published after March 1989 no longer need include a notice of copyright (©, date, name of author or copyright proprietor). Notice remains optional (and for reasons discussed below, advised), but a work will no longer risk falling into the public domain through omission of notice. Moreover, notice is no longer mandatory whatever the origin of the work, be it from the U.S., from other Berne countries, or from countries linked to the U.S. by the UCC or a bilateral arrangement.

The abandonment of mandatory notice completes the 1976 Act's

36. The Berne Convention Implementation Act of 1988, sec. 4, § 116A(c)(1), 102 Stat. 2853, 2856 (1988).

37. *Id.* § 116A(c)(2), 102 Stat. at 2856.

38. *Id.* § 116A(d), 102 Stat. at 2856.

39. *Id.* § 116A(g), 102 Stat. at 2856-57.

considerable relaxation of this formal requirement. Under the 1909 Act, publication without notice could immediately prove fatal. The 1976 Act afforded the copyright proprietor a five-year grace period in which to correct omissions of notice,⁴⁰ but forfeiture of rights remained a threat. Achieving conformity with the Berne Convention thus required a step from the 1976 Act shorter than from its predecessor.

Nonetheless, a few words of caution are in order. While absence of notice no longer will divest the work of copyright protection in the U.S., the Berne Implementation Act provides that presence of notice will defeat a defense of "innocent infringement."⁴¹ A successful defense may result in diminution of the actual or statutory damages awarded the copyright holder.⁴² To avoid this risk, the copyright holder, whether from the U.S. or abroad, should therefore continue to affix notice to all published copies.⁴³

That said, how great is the risk of encountering a successful innocent infringer defense to absence of notice? The 1988 legislation does not explicitly define "innocent infringement." The text does refer to the 1976 Act's provision on statutory damages. This disposition permits a court to reduce the award "in a case where the infringer sustains the burden of proving, and the court finds, that such infringer was not aware and had no reason to believe that his acts constituted an infringement of copyright."⁴⁴ Assuming this reference sets forth the criteria for innocent infringement of a notice-less work

40. 17 U.S.C. § 405(a)(2). However, if notice were omitted from "no more than a relatively small number of copies"; or had been omitted in violation of a written agreement to affix notice, no forfeiture would result. *Id.*, § 405(a)(1), (3).

41. The Berne Convention Implementation Act of 1988, sec. 7, §§ 401(d), 402(d), 102 Stat. 2853, 2857-58 (amending 17 U.S.C. §§ 401, 402).

42. *Id.*

43. Moreover, one should not forget that notice remains necessary to secure or maintain protection in those countries which impose formalities, and which are members of the UCC, but not of Berne. Article III of the UCC permits member countries to require a prescribed form of notice, and to compel registration and deposit of copies prior to suit. Of the twenty-five UCC non-Berne countries, several require compliance with local formalities. These countries include: Colombia, Law No. 86 on Copyright, December 26, 1946, arts. 73, 88; Panama, Administrative Code, part V (arts. 1889-1966) of August 22, 1916, arts. 1906, 1907, 1912, 1915; Venezuela, Law relating to Copyright of November 29 and December 12, 1962, art. 90. See also Paraguay, Law No. 94 concerning the Protection of Scientific, Literary and Artistic Works and the Establishment of the Public Register of Intellectual Rights, of July 5 and 10, 1951, arts. 47, 58 (registration required unless foreign works complied with country of origin formalities: this formality would therefore apply to U.S. works published before March 1989). English translations reprinted in UNESCO, COPYRIGHT LAWS AND TREATIES OF THE WORLD.

44. 17 U.S.C. § 504(c).

after Berne adherence,⁴⁶ the 1988 amendments would seem to set a rather high threshold before the copyright owner's recovery becomes seriously compromised. Indeed, the "not aware and had no reason to believe" standard ought not to excuse most defendants engaged in commercial exploitation of copyrighted works. Those whose business revolves around copyrighted works should be deemed to know the basics of the copyright law,⁴⁶ including the central tenet that works created as of 1978 enjoy federal copyright protection from creation and fixation.⁴⁷ This holds even more so for works created after March 1989, where notice should no longer supply even a confirmatory afterthought. As a result, it may be difficult for most defendants confronting a notice-less copy to meet a "not aware" test, particularly when the test may be interpreted to require that defendant have "acted in complete ignorance of the fact that his conduct might somehow infringe upon the rights of another party."⁴⁸

One might object that this interpretation so constricts the innocent infringer test as to remove any powerful incentive to add notice. Yet, despite its elimination of mandatory notice, Congress did intend to encourage its continued use. We would respond that while Congress sought to encourage notice, that encouragement was not to assume the form of a disguised requirement. The Senate Report asserts that by incorporating an innocent infringer defense to absence of notice,

45. Section 405(b) of the 1976 Act contained a more explicit definition, directly applicable to omissions of notice. This provision, titled "Effect of omission [of notice] on innocent infringers" stated:

[A]ny person who innocently infringes a copyright, [I]n reliance upon an authorized copy or phonorecord from which the copyright notice has been omitted, incurs no liability for actual or statutory damages under section 504 for any infringing acts committed before receiving actual notice that the registration for the work had been made under section 408, if such person proves that he or she was misled by the omission of notice.

But, these elements of innocent infringement may not be relevant in the post-Berne context, because the Implementation Act limits the applicability of § 405(b) to copies published before the effective date of U.S. Berne adherence (§ 7(e)(2)). It seems clear that an innocent infringer defense which resulted in "no liability for . . . damages" (emphasis supplied) would conflict with the Berne art. 5.2 requirement that enjoyment and exercise of copyright not be subject to any formality.

46. See, e.g., *Merrill v. Bill Miller's BBQ Enterprises*, 688 F. Supp. 1172, 1176 (W.D. Tex. 1988) (rejecting innocent infringer defense based on erroneous claim of statutory exemption to public performance right: "In view of the physical and financial size of defendant's restaurant chain, their prior subscription to [a background music service], and the well-developed caselaw interpreting the statute, defendants could not form a reasonable good faith belief that their public performances of copyrighted music were exempt") (emphasis in original).

47. 17 U.S.C. § 102(a).

48. *Original Appalachian Artworks, Inc. v. J.F. Reichert, Inc.*, 658 F. Supp. 458, 464 (E.D. Pa. 1987).

the Berne Implementation Act was "creating a *limited* incentive for notice *which is compatible with Berne*."⁴⁹ The stronger the incentive to affix notice, the greater the risk of conflict with Berne's no-formalities rule, if that incentive is the prospect of insignificant recovery when notice is omitted. Were the actual damages awarded to notice-omitting copyright proprietors significantly reduced, it would be difficult to maintain that compliance with the notice formality is no longer a condition to enjoyment and exercise of copyright.

2. *Registration of Works and Deposit of Copies*

Section 411 of the 1976 Act made registration of a work with the Copyright Office and an accompanying deposit of copies a prerequisite to initiation of any infringement action. On its face, this requirement appears inconsistent with art 5.2 of the Berne Convention, which prohibits subjecting the "enjoyment and exercise" of copyright to "any formality." Although registration does not give rise to the right, it is a condition of its effective exercise. This was the leading view among U.S. copyright experts.⁵⁰ Nonetheless, the Register of Copyrights opposed abandonment of the pre-suit registration requirement. The Register expressed concern that deposits to the great collections of the Library of Congress would diminish were registration completely optional. He also asserted that the registration requirement was not a "formality" in the sense proscribed by Berne, but rather a mere procedural obligation that could be harmonized with the treaty.⁵¹

49. S. REP. NO. 352, *supra* note 16, at 43 (emphasis supplied).

50. See *Final Report*, *supra* note 19, at 565-74. See also Kernochan, *Comments on Discussion Bill and Commentary Prepared for the April 15 Subcommittee Meeting as a Proposed Draft of Implementing Legislation to Permit U.S. Adherence to Berne*, 10 COLUM.-VLA J.L. & ARTS 693, 703 (1986) ("To say that registration is not a condition of copyright (§408) but a prerequisite for suit (§411) is to posit a right that is wholly useless without formalities (because unenforceable)—in effect a right without a remedy, absent formalities. . . . The protestation . . . in § 408 . . . is empty of practical meaning.").

51. See testimony and statements of Ralph Oman, Register of Copyrights and Assistant Librarian for Copyright Services, reprinted in S. REP. NO. 352, *supra* note 16 at 16-25.

These arguments were rejected by the Senate Committee on the Judiciary, see S. REP. NO. 352, *supra* note 16. Practice under the Berne Convention also belies the contentions. Berne has never prohibited establishment of a mandatory system of deposits to the national library; it simply forbids linking the sanction against nondeposit to enforcement of the copyright. Imposition of fines is fully consistent with the treaty.

More significantly, the history of the Berne Convention contradicts the assertion that pre-suit registration is not a formality prohibited as a prerequisite to protection. Contemporaneous documents indicate that prerequisite-to-suit formalities were very much in the drafters' minds. The Berlin revision Report refers to undesirable litigation delays caused by the original Convention's authorization to forum country courts to require production of a certificate

Ultimately, Congress compromised on this question. The Berne implementation legislation no longer requires registration as a prerequisite to initiation of an action alleging infringement of a Berne work of *non-U.S. origin*, but retains the pre-suit requirement for works of U.S. origin (and for non-Berne UCC works, and for works from non-Berne countries with which the U.S. has bilateral copyright arrangements).⁵² This “two tiered” result, in which certain foreigners are in effect favored over U.S. nationals, is possible under the Berne Convention. As noted earlier, that treaty prescribes substantive minima of protection for works from Unionist countries; it does not demand that member countries accord their *own* works treaty-level protection.⁵³ On the other hand, the “two-tiered” solution, according foreign works superior protection, seems politically unstable. One may anticipate that, eventually, even U.S.-works will be absolved from subjection to the pre-suit formality.

While failure to register non-U.S. works from Berne countries no longer impedes initiation of an infringement claim, this does not mean that Unionist copyright proprietors should disregard the option to register. On the contrary, prompt registration remains extremely important. The 1976 Copyright Act, even with the 1988 amendments, retains substantial incentives to registration. These encouragements involve both proof of the copyright claim and remedies. If the work is registered within five years of publication, the certificate of registration will serve as presumptive proof of the identity of the author, the dates of creation and publication, and the validity of the copyright.⁵⁴

attesting to completion of formalities in the country of origin. See Renault, *Records of the Conference Convened in Berlin, October 14 to November 14, 1908*, English translation reprinted in A. BOGSCH, *THE FIRST HUNDRED YEARS OF THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS* 144, 148 (1986). Accord P. WAUWERMANS, *LA CONVENTION DE BERNE (REVISÉE À BERLIN) POUR LA PROTECTION DES OEUVRES LITTÉRAIRES ET ARTISTIQUES* 72-73 (Brussels 1910) (delegate to 1908 conference) (branding a deposit prior to suit rule—such as those then in force in France and in England—a Convention-barred formality rather than a mere condition to court action).

52. Under the Berne Convention Implementation Act, a Berne work of U.S. origin is either a work first published in the U.S.; or simultaneously published in the U.S. and in either a Berne country having a longer copyright term, or in a non-Berne country; or first published in a non-Berne nation when all authors are U.S. citizens, domiciliaries or residents (or, for audiovisual works, when the producer's headquarters are in the U.S.); or an unpublished work whose authors are all U.S. citizens, domiciliaries, or residents (or, for audiovisual works, whose producer's headquarters are in the U.S.); or a pictorial, graphic or sculptural work incorporated in a building or structure located in the U.S. See The Berne Convention Implementation Act of 1988, sec. 4, § 101, 102 Stat. 2853, 2854 (1988).

53. See *Berne Convention*, *supra* note 6, arts. 5.1, 5.3.

54. 17 U.S.C. § 410(c).

In addition, if the work is registered within *three months* of first publication, statutory damages and attorneys' fees become available.⁵⁵ These can prove invaluable to a copyright complainant, particularly in the frequent instances where actual damages (plaintiff's lost sales; defendant's profits) are speculative or otherwise difficult to prove. The public performance right in nondramatic musical compositions presents a good example of the utility of statutory damages. For instance, how does one value an unauthorized performance of ten copyrighted songs over the radio or in a discotheque? Should the value be the cost of a music performance license multiplied by the percentage of the performance rights society's repertory which the ten songs represent? If so, an infinitesimal amount would result. Indeed, were that the measure of damages (or even were the full cost of a license the measure), a music-user might find it more economical to be sued for copyright infringement than to acquire a performance license. Copyright holders seeking to vindicate this right therefore generally seek statutory damages. This permits the court to impose a level of liability in excess of the cost of a performance license, thus encouraging future compliance.⁵⁶ The 1988 amendments further enhance the attractions of early registration by doubling the maximum amount of statutory damages from \$50,000 to \$100,000 per work.⁵⁷

55. *Id.* § 412.

56. *See, e.g.,* Iowa State Univ. Research Found., Inc. v. American Broadcasting Co., 475 F. Supp. 78 (S.D.N.Y. 1979), *aff'd*, 621 F.2d 57 (2d Cir. 1980); Boz Scaggs Music v. KND Corp., 491 F. Supp. 908 (D. Conn. 1980).

57. The Berne Convention Implementation Act of 1988, sec. 10 (amending 17 U.S.C § 504(c)(2)), 102 Stat. 2853, 2860 (1988); *See* 134 CONG. REC. S14554 (daily ed. Oct. 5, 1988) for the *Joint Explanatory Statement on House-Senate Compromise Incorporated in Senate Amendment to H.R. 4262 (Berne Convention Implementation Act of 1988)* which states, with respect to the Implementation Act's doubling of statutory damages: "The new statutory damages will only apply to registrations made on or after the effective date of the Act." *See Joint Explanatory Statement reprinted in* 36 J. COPYR. SOC. 70, 76 (1988).

This statement finds no authority in the text of the Berne Implementation Act, and seems clearly erroneous—most likely an inadvertence or misunderstanding by the joint statement drafters. Section 13 of the Act states that the new legislation takes effect when the treaty enters into force (March 1, 1989); the 1976 Act, as unamended, applies to "any cause of action arising under [the Copyright Act] before the effective date of this [Berne Implementation] Act." The relevant date here is that of alleged infringement. If the claim arises after March 1, 1989, the Berne amendments apply, and the statutory damages range from \$200 to \$100,000. To limit availability of the 1988 amendments' increased damages to works registered after March 1, 1989 is to read the Berne Implementation Act as implying that copyright infringement claims arise from *registration*, rather than from an act violating the § 106 rights. That has not been the case under the 1976 Act (compare 1976 Act, § 301(b)(3): State law continues to apply to "any cause of action arising from undertakings commenced before January 1, 1978").

Moreover, the statement as worded makes no sense. It would defeat the formalities-reduc-

Attorneys' fees offer another significant incentive to registration. Unlike losing parties in most other countries, unsuccessful litigants in the U.S. generally do not pay their opponents' attorneys. Given the comparatively high costs of U.S. legal assistance, the award of attorneys' fees made possible by prompt registration, even if not commensurate with the sums actually charged, supplies a vital benefit.

Finally, two other aspects of registration deserve brief mention in light of U.S. adherence to the Berne Convention. The 1988 amendments, moreover, did not explicitly address these issues. One concerns Customs Service enforcement of the copyright owner's right to exclude imports of piratical copies; the other concerns criminal prosecutions for copyright infringement.

Section 602 of the Copyright Act empowers the copyright owner to prevent the importation of copies or phonorecords acquired outside the United States. The statute also authorizes the United States Customs Service to prevent importation of foreign-acquired piratical copies. Although the Copyright Act does not itself tie the importation remedy to copyright registration, the regulations of the Customs Service now require recordation of certificates of copyright registration as a predicate to prevention of importation of infringing copies.⁵⁸ One may therefore inquire whether these regulations clash with Berne's "no formalities" principle.

A response first demands determination of whether Berne requires or anticipates member countries' extension of importation remedies. The treaty's text supplies an affirmative answer. Article 16 provides for seizure of infringing copies, even those imported from countries in which the work is not, or may no longer be, protected.⁵⁹ However, the text also permits the seizure "to take place in accordance with the legislation of each country." Nonetheless, this reference to local law should probably not be read to suggest tolerance of local copy-

ing purpose of many of the 1988 amendments. If copyright claims depend on registration rather than infringement, then registration becomes a key element of any claim, not merely of claims seeking enhanced damages. Worse, it makes registration mandatory even for proprietors of non U.S.-Berne works. As a result, the U.S. would not be in compliance with Berne standards.

58. 19 C.F.R. § 133.31 - 133.33.

59. Moreover, under the national treatment standard, art. 5.1, Unionist authors enjoy not only the protections specifically provided by the convention (such as importation protection), but those afforded by member countries' domestic law. Because § 602 provides a remedy for infringement of the exclusive distribution right under copyright, (§106(3)), foreign Berne works would be entitled to this remedy. The trend of judicial opinions seems to reject suggestions that § 602 sets forth a special administrative remedy distinct from the usual rights under copyright, *see, e.g.*, *Sebastian International, Inc. v. Consumer Contacts (Pty.) Ltd.*, 847 F.2d 1093 (3d Cir. 1988).

right formalities. Article 5's general proscription of formalities conditioning copyright enjoyment most likely continues to apply. This does not mean the Customs officials may not require foreign Berne claimants to substantiate the identity and ownership of the works at issue; rather, Berne may require that means other than production of a registration certificate suffice to establish the necessary proof.⁶⁰

The role of copyright registration in criminal infringement actions is ambiguous. Section 411(a) of the 1976 statute generally stated that "no action for infringement" might be instituted prior to registration. The requirement thus applied both to civil and to criminal claims. The Act's specific provisions on criminal enforcement carried no independent registration requirement. With amendment of the statute to remove registration as a prerequisite to suit for non-U.S. Berne works, the modification should cover all actions, civil and criminal.

Some question persists regarding criminal claims, however, because of prior Justice Department practices. The Justice Department has occasionally required production of copyright registration certificates before initiating prosecutions for piracy of audiovisual works.⁶¹ To ensure Berne conformity, the Justice Department should probably alter internal procedures to exempt non-U.S. Berne works from this requirement. It could be argued that criminal penalties are enhanced copyright remedies not comprised within the basic copyright protection which must be assured, formality-free, to Unionist works. This contention, however, contradicts the strongly voiced position asserted by U.S. trade negotiators at General Agreement on Tariffs and Trade (GATT) meetings. In their endeavors to obtain agreement on a GATT intellectual property code, U.S. representatives have insisted that minimal protections include criminal penalties.⁶²

60. Cf. C. MASOUE, *GUIDE DE LA CONVENTION DE BERNE* 113 (1978) (indicating modes of proof which local authorities might require for enforcement of importation remedies: these proofs include affidavits by local officials or by representatives of authors; none is as copyright-specific as a certificate of registration).

61. Interview with Crossan Andersen, Esq., former Assistant U.S. Attorney, Director of Anti-Piracy Legal Operations, Motion Picture Ass'n of America, February 7, 1989.

62. U.S. Submission to the Negotiating Group on Trade-Related Aspects of Intellectual Property Rights Including Trade in Counterfeit Goods § IV, Part 8, at 12, 15 ("criminal remedies shall be available for at least trademark counterfeiting and copyright infringement which are willful and commercial and shall include seizure of infringing goods, materials and implements used in their creation, and forfeiture of such articles, imprisonment, and monetary fines") (c. September 1988).

3. *Recordation of Contracts of Transfer*

The 1976 Copyright Act contained an additional prerequisite to suit: if the copyright claimant was not the author, but a transferee of exclusive rights, the Act conditioned initiation of an infringement action upon prior recordation with the Copyright Office of the instrument of transfer.⁶³ While this requirement might enable prospective defendants to ascertain the validity of claimant's chain of title to the work, courts had held that the claimant need record only the document under which he claims a transfer of rights; he need not record all documents tracing the transfer of rights from the original copyright holder through to the present claimant.⁶⁴

The 1988 amendments to the Copyright Act abandon the requirement of pre-suit recordation. As of March 1989, a copyright claimant, whether from a Berne country, from the U.S., or from another country with which the U.S. has copyright relations, no longer need have recorded the instrument of transfer of copyright interests with the Copyright Office before bringing the claim to court.⁶⁵ Of course, once in court the claimant must still prove ownership of the copyright interests sued upon. In addition, recordation continues to serve the purpose of settling rights between conflicting claimants to the same copyright interest: ordinarily, the first-recorded transfer prevails.⁶⁶

C. *Certain Territorial and Transitional Problems Regarding Formalities*

1. *Territorial Reach*

As discussed above, affixation of notice upon publication cancels the defense of innocent infringement. Similarly, substantial benefits devolve from registration within stated periods from first publication. But, what is the relevant place of publication? For example, does the innocent infringement defense apply to notice-less copies of the work acquired outside the U.S.? Does entitlement to statutory damages and attorneys' fees depend on registration within three months of the first U.S. publication, or within three months of first publication, in whatever country that may occur?

63. 17 U.S.C. § 205(d).

64. See, e.g., *Swarovski America Ltd. v. Silver Deer, Ltd.*, 537 F. Supp. 1201 (D. Colo. 1982).

65. See *supra* notes 40-49, and accompanying text.

66. See 17 U.S.C. § 205(e).

a. Notice

In the case of notice, the Act authorizes the affixation of notice "whenever a work protected under this title is published in the United States *or elsewhere* by authority of the copyright owner" (emphasis supplied).⁶⁷ This language had been interpreted under the 1976 Act to require affixation of notice upon a foreign author's first publication abroad. As long as the foreign author was the national or domiciliary of a country with which the U.S. has copyright relations, or first published in such a country, the author automatically was deemed a U.S. copyright owner, and therefore subject to U.S. law requirements, including that of placing notice on copies distributed inside *or outside* the U.S.⁶⁸

This interpretation indicates that non-U.S. copyright proprietors may be susceptible to the post-Berne adherence defense of innocent infringement in a U.S. copyright action, even though plaintiff had not yet distributed the work in the U.S., and the copyright law of the country in which defendant acquired a copy of the work imposed no notice requirement. Suppose, for example, that a French author creates and sells videogames in France, but has not yet sought to exploit the U.S. market. France has no notice requirement, not even the diluted version of an innocent infringer defense. A U.S. national travelling in France observes the game at a trade show in France, perceives that it does not bear a notice, and therefore concludes that no copyright protection is claimed. Purchasing a copy and returning home with it, the U.S. national copies and distributes the videogame. If the above analysis is correct, the U.S. party would assert the innocent infringer defense, and perhaps obtain a diminution of damages.

This conclusion seems troubling. Under the law of the country where our hypothetical defendant acquired a copy of the work, absence of notice did not entitle him to infer absence of protection. This incongruity prompts another review of the U.S. law. The U.S. Copyright Act requires the alleged innocent infringer to prove that (s)he "had no reason to believe that his or her acts constituted infringement of copyright. . . ."⁶⁹ The law of the country where the copy was obtained should bear on the U.S. court's evaluation of

67. 17 U.S.C. § 401(a).

68. See *Hasbro-Bradley v. Sparkle Toys*, 780 F.2d 189 (2d Cir. 1985), discussed critically in Ginsburg, *Recent Developments in United States Copyright Law*, 133 RIDA 110, 146-56 (July 1987).

69. 17 U.S.C. § 504(c)(2).

whether or not defendant “had no reason to believe” the work was protected.⁷⁰

b. Registration

Turning to the statutorily relevant place of first publication with regard to registration, the U.S. Copyright Act speaks of first publication generally; unlike the notice provision, the registration provisions do not specify “in the United States or elsewhere.”⁷¹ One might therefore conclude that, unlike publication for purposes of notice, publication for registration is a purely U.S. territorial matter. The deadlines for obtaining special registration benefits would therefore run from first U.S. publication.

On the other hand, the Act also details that the application for registration shall state “if the work has been published, the date and nation of its first publication.”⁷² This suggests that “first publication” under the U.S. Copyright Act means initial distribution *anywhere in the world*. Indeed, such has been the Copyright Office’s interpretation of the 1976 Act.⁷³ As a result, foreign claimants seeking statutory damages and attorneys’ fees must register the work in the U.S. within three months of actual first publication wherever that may occur; similarly, prima facie evidentiary weight would be accorded a certificate of registration issuing within five years of actual first publication.

Which interpretation of the statutorily relevant place of first publication most assists the foreign claimant? With regard to the evidentiary benefits of registration, if the relevant place of publication is the U.S., foreign claimants first publishing abroad may in fact have more than five years in which to register the work with the U.S. Copyright Office, and still claim the probative value of the registration certificate. In this case, then, limiting the statutorily relevant place of first

70. A similar analysis would apply to the innocent infringer defense in the case of *pre-March 1989* notice-less copies. In that instance, § 405(b) of the 1976 Act would govern. That provision removes liability by a person who can demonstrate “that he or she was misled by the omission of notice.” The law of the place of acquisition of the notice-less copy should be taken into account in assessing whether defendant was “misled.”

71. See 17 U.S.C. §§ 410, 412.

72. *Id.* § 409(8).

73. See U.S. Copyright Office, *Compendium II: Copyright Office Practices* §§ 910, 910.01 (1984). Copyright Practice under the 1909 Act also referred to publication anywhere in the world. The time period for protection (28 years under the 1909 Act; 75 years for anonymous, pseudonymous and works for hire under the 1976 Act) ran from first publication; the Copyright Office considered this date to be that of actual first publication; not first U.S. publication.

publication to the U.S. would afford some benefit to the foreign claimant.

However, the outcome of applying the same rule to the case of statutory damages and attorneys' fees seems much less favorable. Suppose that a book has been published in Germany, but not in the U.S. Unauthorized copies are subsequently distributed in the U.S. While the U.S. courts will certainly entertain an ensuing infringement action, they will not award statutory damages or attorneys' fees. These are not available to proprietors of *unpublished* works, unless the work was registered *prior to its infringement*.⁷⁴ Thus, whether the statutorily relevant place of publication is the U.S. or the place of actual first publication, the advice is the same: to obtain the special remedies of registration, all claimants should register the work with the U.S. Copyright Office immediately after its creation if public release is possible or anticipated. Indeed, limiting the statutorily relevant place of first publication to the U.S. may in fact disserve the foreign claimant. If the work has been published, the claimant enjoys a three-month grace period in which to register, and still claim the statutory remedies, even if infringement of the published work preceded the registration. As the above example shows, however, if the work is not considered "published," no special statutory remedies are available, unless registration preceded the infringement.

Moreover, selecting the place of actual first publication makes most sense in the general scheme of international copyright. It affords a single date from which to calculate the copyright terms of those works for which the author's life does not serve as the measure. Under the 1976 U.S. law, these works are anonymous and pseudonymous works, and works made for hire. Their terms run for 75 years from publication.⁷⁵ Under many foreign laws, the term for anonymous and pseudonymous works runs for a period of at least fifty years from the date of publication as well.⁷⁶ Similarly, in many countries, duration of protection for posthumous works, collective works, and cinematographic works is also timed from first publication.⁷⁷ Be-

74. See 17 U.S.C. § 412(1). See also *NBC Subsidiary (KNCNC-TV) Inc. v. Broadcast Info. Servs. Inc.*, 9 U.S.P.Q.2d 1732 (D. Colo. 1988) (no statutory damages for infringement of unpublished television program).

75. *Id.* § 302(c).

76. See, e.g., *Berne Convention*, *supra* note 6, art. 7.3 (fifty years from authorized public distribution); France, law of March 11, 1957, art. 22 (fifty years; 70 years for musical compositions); Italy, law of April 22, 1941, art. 27 (fifty years); Spain, law of November 11, 1987, art. 27.2 (sixty years).

77. See, e.g., *Berne Convention*, *supra* note 6, art. 7.2 (cinematographic works: fifty years from publication); France, *supra* note 76, arts. 22 (collective works: fifty years), 23 (posthu-

cause it is not always easy to tell when acts amounting to a publication have occurred,⁷⁸ it would seem undesirable to multiply the number of places at which publications relevant to copyright duration occur.⁷⁹

2. *Transitional Issues*

The Berne enabling legislation provides that the 1988 amendments to the U.S. copyright law take effect when ratification of the Berne Convention enters into force (March 1989). The amendments do not apply to claims which arose before March 1989.⁸⁰ Some questions regarding the application of the amendments nonetheless arise. One issue concerns the pre-1989 notice requirement; another involves the pre-1989 registration obligation.

mous works: fifty years; posthumous musical compositions: seventy years); Italy, *supra* note 76, arts. 26.2 (collective works: fifty years), 31 (posthumous works: fifty years, if publication occurs within 20 years of author's death; the law states that the 50 years run from "the first publication wherever it occurs"). *See also* art. 32 (cinematographic works: 50 years from first public exhibition); Spain, *supra* note 76, arts. 27.1 (posthumous works: sixty years from first publication, if that occurs within sixty years from the author's death), 28.2 (collective works: sixty years).

78. *See, e.g.,* *Burke v. NBC*, 598 F.2d 688 (1st Cir. 1979), and *decisions cited therein* (the *Burke* court attempted to discern whether a publication occurred, in U.S. or West Germany, of U.S. author's film broadcast on West German television).

79. One should be aware, however, that even if one selects a uniform starting point for the calculation of copyright duration, so long as there are differences among each country's statutory periods, the copyright periods themselves will not be uniform, because the rule of national treatment results in each country applying its own term. (But note that Berne Convention, art. 7.8 sets forth an exception to the national treatment rule: if the copyright term in the country of origin is shorter than in the country where protection is sought, the shorter term applies.) For example, suppose a collective work, such as a dictionary, is first published in the U.S. in 1990, in France in 1995, in Spain in 2000, and in Italy in 2005. Were one to count terms from each place of publication, the work would be protected in the U.S. till 2065, in France till 2045, in Spain till 2060, and in Italy till 2055. Were the U.S. publication selected as the starting point, the terms would be U.S. 2065; France 2040; Spain 2050; Italy 2040. The objection to calculating duration based on multiple places of "first" publication therefore cannot be disuniformity of resulting copyright term, but rather the difficulties attendant on proving publication in each territory. Multiple reference points inject unnecessary further complication into the international administration of copyrighted works.

Finally, questions arise concerning the 1976 Act's definition of "publication". Like most other copyright laws, U.S. law defines a publication as public distribution of copies. Unlike most other copyright laws, however, the 1976 Act also defines as a publication "the offering to distribute copies or phonorecords to a group of persons for purposes of further distribution, public performance, or public display," 17 U.S.C. § 101. Does this definition apply to acts accomplished wholly outside the U.S.? For example, would a Japanese audiovisual work offered for public exhibition to movie theaters in Japan before March 1989 then be "published", and therefore be subject to U.S. notice requirements? Note that the 1976 Act definition does not require that the offer have been accepted.

80. *See* The Berne Convention Implementation Act of 1988, sec. 13, § 101, 102 Stat. 2853, 2861 (1988).

a. Notice: Work Published Before March 1989; Infringed After March 1989

If the Berne amendments apply to claims arising after March 1, 1989, are pre-March 1989 failures to comply with the prior notice requirement irrelevant so long as the alleged infringing acts occurred after March 1989? This interpretation seems unlikely. Were the only relevant act the alleged infringement, it would not matter when the work was published, nor whether proper notice accompanied the publication. That could mean that the copyright on a work which had lapsed prior to March 1989 through failure to affix or cure the omission of notice would, in effect, be revived by a claim alleging post-March 1989 copying. But under U.S. law, once the work is in the public domain, it must remain there.⁸¹

What of a work published without notice during the five years preceding March 1989? According to the unamended 1976 Act, such a work is not yet in the public domain, but failure to effect adequate cure of the omission within five years will result in loss of copyright. Does the intervening abolition of mandatory notice relieve these copyright proprietors from the obligation to cure the omissions? Here, the Berne Convention Implementation Act offers specific guidance. It provides that the curative measures apply "[w]ith respect to copies and phonorecords publicly distributed by authority of the copyright owner before the effective date of the Berne Convention Implementation Act of 1988 [March 1989]."⁸² Thus, works published before March 1989 must bear the notice, or effect proper cure within five years.⁸³

81. *See Id.*, § 12, 102 Stat. 2853, 2860 (1988) (amendments do "not provide copyright protection for any work that is in the public domain in the United States"); *see also* *United Christian Scientists v. Christian Science Bd. of Directors*, 829 F.2d 1152 (D.C. Cir. 1987).

82. *See Id.*, § 7(e), § 405, 102 Stat. 2853, 2857-58 (1988).

83. Even without this precision, it seems clear that the operative date for application of the notice-curing provisions would be that of first publication. Since, at that time, the work should have borne a notice, the conditions for the omission's cure would continue to apply. Otherwise, the subsistence of copyright in works in this time category would depend not on the copyright holder's acts, but on the infringer's: occurrence of an alleged infringement after March 1989, but before the conclusion of five years from the date of the notice-less publication could buoy up a sinking copyright. By contrast, the non-curing copyright holder not "fortunate" enough to have his work infringed during the five-year period would lose protection. Holding all works published before March 1989 to compliance with the 1976 Act's notice terms yields a more rational outcome.

b. Non-U.S. Berne Work Published (With Notice), But Not Registered, Before March 1989; Infringed After March 1989

If the alleged infringement of a non-U.S. Berne work follows the effective date of the Berne amendments, but the work was published before March 1989, must the work be registered with the Copyright Office prior to initiation of suit? This question highlights an ambiguous area of transition between the 1976 Act and the 1988 amendments. If the relevant date for purposes of notice is that of first publication, should that also be the case for pre-suit registration, or should it be the date of the infringement? With regard to pre-March 1989 unregistered works, unlike contemporaneous notice-less works, the Berne Implementation Act does not explicitly preserve the application of the 1976 Act. Moreover, differences between the purposes and effects of the notice and registration formalities point toward a literal reading of the Implementation Act's designation of the date of infringement. While the 1976 Act required affixation of notice in order to prevent the work from falling into the public domain,⁸⁴ pre-suit registration neither gave rise to nor preserved the copyright. Thus, where application of the 1988 amendments to prior works published without notice could violate the constitutional principle of protection for "limited Times"⁸⁵ by retrieving a work from the public domain, no revival of a lapsed copyright would occur were the 1988 amendments applied to a prior unregistered work.

Moreover, unlike notice, pre-suit registration under the 1976 Act was not a device primarily designed to inform potential defendants of the status of a work's copyright. Registration on the eve of filing the copyright action met the Act's pre-suit obligation.⁸⁶ Indeed, some courts have permitted the action to go forward, even when registration occurs *after* filing the claim.⁸⁷ Such belated execution of the formality belies a meaningful notice-giving function; rather, pre-suit registration may most accurately be viewed as an effective means to

84. See *supra* note 40 and accompanying text.

85. See U.S. CONST., art. I, § 8, cl. 8.

86. See, e.g., 50 Fed. Reg. 46206-08 (Nov. 6, 1985) (copyright office will process expedited "special handling" requests "in cases involving pending or prospective litigation"); 49 Fed. Reg. 39741-42 (Oct. 10, 1984) (same). Courts routinely accept eve of suit registrations. See, e.g., *Twentieth Century Fox Film Corp. v. Dunnnoo*, 637 F.2d 1338 (9th Cir. 1983); *Wales Indus. v. Hasbro-Bradley*, 612 F. Supp. 510 (S.D.N.Y. 1985); *Co-opportunities Inc. v. NBC*, 510 F. Supp. 43 (N.D. Cal. 1981).

87. See, e.g., *Hulex Music v. Santy*, 698 F. Supp. 1024 (D.N.H. 1988); *Financial Information v. Moody's Investors Service*, 599 F. Supp. 994 (S.D.N.Y. 1983).

compel Library of Congress deposits, and to keep copyright records complete, if not fully up-to-date.

II. Some Specific Features of U.S. Copyright Law Remaining Unchanged, Despite Berne Adherence

The 1988 Berne Implementation Act leaves several aspects of the 1976 U.S. Copyright Act untouched. Most notably, the 1988 amendments include no provisions explicitly recognizing authors' "moral rights" to claim attribution of their works and to prevent the alteration or mutilation of their works. In addition, the adapting legislation expands the definition of protected "pictorial, graphic and sculptural works" to include architectural plans and models, yet makes no specific mention of the completed, three-dimensional structure. These omissions may appear inconsistent with Berne requirements: Article 6*bis* of the Convention calls for protection of moral rights; Article 2 lists "works of . . . architecture" and "three dimensional works relative to . . . architecture" among works which "shall enjoy protection in all countries of the union."⁸⁸ Both deserve discussion.

A. *Architectural Works*

Here, Berne standards and U.S. copyright doctrines appear dissonant: the treaty anticipates protection both of representations of architectural works (plans and models) and of the structures themselves. While U.S. law protects the former, its protection of the latter is arguably very limited. The 1976 Copyright Act denies protection to the utilitarian aspects of decorative articles:

Pictorial, graphic and sculptural works . . . shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article . . . shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural

88. There is yet another issue regarding the compatibility of U.S. law with the Berne Convention. Article 18 extends treaty protection to "all works which, at the time of [the treaty's] coming into force [including "in the case of new accessions to the Union"], have not yet fallen into the public domain in the country of origin through expiry of the term of protection." The 1988 amendments to the U.S. copyright law are prospective only; they do not accord protection to works still under copyright in their Unionist countries of origin but which, prior to U.S. adherence, had no coverage here, or whose copyrights expired after an initial U.S. copyright term too short to meet Berne minima. This article does not examine the retroactivity question because the issue has been carefully reviewed in the *Final Report*, *supra* note 19, at 587-95. See also H.R. REP., *supra* note 16, at 51-52.

features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.⁸⁹

This "separability" rule may disqualify most structures, especially those eschewing fanciful, profuse decoration. (As an example of a protectible, separable architectural feature, the legislative reports cite "a gargoyle on a building").⁹⁰ Certainly Bauhaus would not fare well under this test. Moreover, the restrictions on what kind of structures may be copyrighted carry over to the scope of protection of architectural plans. Many courts have held that copying plans is copyright infringement, but that building the structure from the plans is *not* infringement.⁹¹ The basis for the distinction appears to be that while plans are protected as two-dimensional works, the resulting building is not protected (unless it meets the separability test). Constructing the building, therefore, is like carrying out any other unprotected process. For example, copyright protects against unauthorized copying of a book explaining how to repair a car, but copyright does not secure exclusive rights in the exercise of the repair.⁹²

If, under current U.S. copyright law, building the three-dimensional structure from two-dimensional plans is not copyright infringement, what of two-dimensional representations, such as commercially distributed photographs, of completed structures? If the separability rule disqualifies the building from copyright protection, then arguably one may photograph the building as freely as one would photograph a flower or a tree, or any other object in nature. Nonetheless, this result seems to exceed the rationale for the separability rule. The rule exists to prevent copyright from becoming a kind of back-door patent: claimants may not monopolize useful features; if the useful and the decorative cannot be divided, the public domain prevails. Hence, it may make sense to limit protection so that copyright does not hamper a second-comer in constructing a similarly functioning building. Constricting the copyright to permit unauthorized commercial exploitation of images of the structure does not promote the building trades, but simply removes from the architect's control a

89. 17 U.S.C. § 101.

90. H.R. REP. NO. 609, *supra* note 16 at 51; S. REP. NO. 352, *supra* note 16, at 9.

91. *See, e.g., Demetriades v. Kaufman*, 680 F.Supp. 658 (S.D.N.Y. 1988). *But see* Robert R. Jones Assoc., *v. Nino Homes*, 858 F.2d 274, 294 (6th Cir. 1988) ("one may construct a house which is identical to a house depicted in copyrighted architectural plans, but one may not directly copy those plans and then use the infringing copy to construct the house").

92. *See* 17 U.S.C. § 102(a) (copyright does not protect methods and processes).

substantial area of exploitation of purely decorative derivative works.⁹³

Does the separability rule set U.S. copyright law at odds with the Berne Convention? If read to require that the claimed design feature be *physically* separable from the structure's useful aspects, the rule probably would eliminate all but the most baroque or bizarre buildings,⁹⁴ and therefore might well clash with the treaty. But, there may be a more generous notion of separability. The legislative reports to the 1976 Act suggest that if the artistic design of a useful object is "conceptually" separable from the utilitarian purpose, the work may qualify for copyright.⁹⁵ A consistent understanding of "conceptual separability" has so far eluded the courts,⁹⁶ but the notion may have the potential to encompass a broader range of structures. Assume that the courts developed a rule that a design feature is conceptually separable if its appearance was not *compelled* by the useful purpose of the building. In that case, even useful elements in the design might be protected, so long as the arrangement of the useful elements proved arbitrary. For example, the painted steam pipes along the outside of the Pompidou Center in Paris certainly perform a useful purpose. But no canons of construction compel their placement all over the building's exterior. Where the Pompidou Center might fail the physical separability test (one cannot remove the steam pipes and still have a functioning building), it would appear to pass muster under the above proposed conceptual separability rule.⁹⁷

93. Compare Paris Court of Appeals, decision of June 19, 1979, *discussed in* Fremont, *Les droits sur l'image d'un immeuble*, 9 CAHIERS DU DROIT D'AUTEUR 12, 13 (1988) (the individualized reproduction of a house, by means of a photograph, violates the architect's exclusive rights; had the house been captured as part of an overall ensemble, no infringement would have been found).

94. As an example of the latter, the Copyright Office recently registered as a pictorial, graphic, or sculptural work an ice cream stand in the shape of a cup of swirled frozen yogurt. Interview with William F. Patry, Esq., Policy Planning Advisor to the Register of Copyrights, February 9, 1989.

95. See H.R. REP. NO. 1476, 94th Cong., 2d Sess. at 55 (1976).

96. Compare *Kieselstein-Cord v. Accessories by Pearl*, 632 F.2d 989 (2d Cir. 1980) (divided court holds belt buckle conceptually separable on ground that it can serve a purely decorative purpose; these buckles were used not only for holding up pants—useful purpose—but as decorative brooches), with *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2d Cir. 1985) (divided court holds molded shirt forms not conceptually separable) with *Brandir Int'l v. Pacific Cascade Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987) (divided court holds curved metal bicycle rack not conceptually separable on ground that the shape of the rack was influenced by the artist's desire to accommodate the form to bicycles).

97. A recent article extensively reviewing current U.S. copyright doctrine regarding architectural works offers another, well-developed example of "conceptually separable" architectural designs. Shipley, *Copyright Protection for Architectural Works*, 37 S.C.L.B. REV. 393, 430-31 (1986).

Ultimately, it may be too soon to tell whether U.S. copyright law on architectural works conforms to Berne standards. The courts continue to elaborate the separability rule, and they may well evolve a test compatible with treaty norms. In addition, the Copyright Office is studying the question, and may issue recommendations to Congress for further emendation of the Copyright Act to ensure fuller protection of works of architecture.⁹⁸ Finally, one should bear in mind that other legal doctrines may supplement the architect's remedies. Very recently, a trial court held that the unauthorized construction of the interior features of a house copied from plaintiff's house violated state unfair competition law. In that instance, defendant had entered plaintiff's house while it was under construction, had taken photographs and measurements of the interior, and had reconstituted building plans. Defendant then built a substantially identical house—across the street!⁹⁹

B. *Moral Rights*

As mentioned earlier, the Berne Implementation Act includes no explicit recognition of moral rights. Rather, the Act assumes that the extant U.S. protection of rights of attribution and of integrity meet Berne standards. Nonetheless Congress has left room for the domestic law expansion of current protections of moral rights. While Congress' failure to include affirmative dispositions governing moral rights may attract some criticism, particularly from abroad, it is important to recognize that the little that Congress did say was far better for moral rights than what Congress might have said, and almost did say. It is illuminating to review the history leading up to Congress' ultimate position on moral rights, and then to consider how far U.S. law is in fact compatible with Berne.

1. *Legislative History*

The Ad Hoc Working Group considered at some length the compatibility of U.S. law with Article 6*bis* of the Berne Convention, which bestows on authors the rights,

98. Congress, perhaps uncertain of its compliance with Berne standards for architectural works, had requested a Copyright Office study on protection of architectural works. See S. REP. NO. 352, *supra* note 16, at 9.

99. *Demetriades v. Kaufman*, 690 F. Supp. 289 (S.D.N.Y. 1988). In an earlier phase of this case, see *supra* note 91, the court held that defendant had also made illicit copies of the building plans, and that the copying of the plans constituted copyright infringement. On the other hand, neither "reverse engineering" the plans by inspecting the house, nor building the house qualified as copyright infringement.

[i]ndependently of the author's economic rights, and even after the transfer of said rights . . . 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 or reputation.

This same disposition provides for continuance of these rights for at least a minimum period after death, but leaves the means for protection to "the legislation of the country where protection is claimed." The Working Group's Final Report concluded as follows:

Given the substantial protection now available for the real equivalent of moral rights under statutory and common law in the U.S., the lack of uniformity in protection of other Berne nations, the absence of moral rights provisions in some of their copyright laws, and the reservation of control over remedies to each Berne country, the protection of moral rights in the United States is compatible with the Berne Convention.¹⁰⁰

The similarly worded conclusion in its Preliminary Report had evoked dissenting, doubting, and approving comments.¹⁰¹ It was clear that the question of moral rights would present particular difficulties for the marshaling and maintaining of adequate support for the bill. Resolution of the moral rights issue would be critical to the bill's enactment.

A number of bills were introduced in Congress aimed in varying terms at reshaping U.S. law to meet some or all of the several points identified as possibly or necessarily requiring change for Berne adherence.¹⁰² Only one of them, the Kastenmeier bill, H.R. 1623, contained a provision on moral rights. Section 7 of that bill called for insertion in the U.S. Copyright Law of a new section § 106(a) reading as follows:

§ 106a. Moral rights of the author

Independently of the copyright in a work other than a work made for hire, and even after a transfer of copyright ownership, the author of the work or the author's successor in interest shall have the right, during the life of the author and fifty years after the author's death—

100. *Final Report*, *supra* note 19, at 547. Professor Ralph S. Brown has colorfully expressed moral rights advocates' skepticism about the *Final Report*, characterizing its conclusion as "fashion[ing] a loincloth or at least a G-string, that will cover our moral rights nakedness," Brown, *Adherence to the Berne Copyright Convention: The Moral Rights Issue*, 35 J. COPYR. SOC. 196, 204 (1988).

101. See, e.g., *Final Report*, *supra* note 19, Appendix B; Damich, *Moral Rights in the United States and Article 6bis of the Berne Convention: A Comment on the Preliminary Report of the Ad Hoc Working Group on U.S. Adherence to the Berne Convention*, at 655-63; Geller, *Comments on Possible U.S. Compliance with Article 6bis of the Berne Convention*, at 665-81; Kernochan, *Comments of John M. Kernochan*, at 685-91.

102. See *supra* note 28.

- (1) to claim authorship of the work; and
 - (2) to object to any distortion, mutilation, or other alteration of the work that would prejudice the author's honor or reputation.
- The rights conferred by this section shall be referred to in this title as moral rights.¹⁰³

This provision "set the cat among the pigeons", triggering a major reaction. It satisfied neither proponents nor opponents of moral rights. It did not accurately track the language of Article 6*bis* as to the right of integrity.¹⁰⁴ It exempted works for hire. In addition, under § 9 of the bill, a proposed new § 119(a) made the moral rights thus provided freely waivable and assignable. § 119(b) stated too, that absent any contrary contractual provision, or contrary notice at the time of consent to use of a work,

[t]he necessary editing, arranging, or adaptation of the work for publication or use in printed or machine-readable form, in broadcasting, in motion pictures, or in phonorecords, in accordance with customary standards and reasonable requirements of preparing a work for dissemination, shall not constitute an infringement of any of an author's moral rights.

Moral rights proponents saw these provisions as creating illusory rather than real moral rights. Moral rights opponents, roused to consternation by any reference to moral rights, perceived the Kastenmeier bill's provisions as too vague to give guidance, and as an invitation to litigation, despite the extremely diluted nature of the rights actually granted.

In the late stages of development of the Berne legislation, the moral rights provisions were dropped from the Kastenmeier bill, ap-

103. H.R. 1623, 100th Cong., 1st Sess. (1987), 35 PAT., TRADEMARK & COPYRIGHT J. (BNA) 550 (1987).

104. Article 6*bis* of the Berne Convention provides:

- (1) Independently of the author's economic rights, and even after the transfer of said rights, the author shall have the right to claim authorship of the work and to object to any distortion, mutilation, or other modification, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation.
- (2) The rights granted to the author in accordance with the preceding paragraph shall, after his death, be maintained at least until the expiry of the economic rights, and shall be exercisable by the persons or institutions authorized by the legislation of the country where protection is claimed. However, those countries whose legislation, at the moment of their ratification of or accession to this Act, does not provide for the protection after the death of the author of all the rights set out in the preceding paragraph may provide that some of these rights may, after his death, cease to be maintained.
- (3) The means of redress for safeguarding the rights granted by this Article shall be governed by the legislation of the country where protection is claimed.

parently in favor of the position taken by the Ad Hoc Group that U.S. copyright law and other legal doctrines, as they existed and as they were developing, provided an adequate practical equivalent to Berne's Article 6*bis* moral rights. It may be noted that Dr. Bogisch, Director General of the World Intellectual Property Organization (WIPO), the international body charged with administering the Berne Convention, had endorsed this position.¹⁰⁵

The moral rights struggle then shifted to another far more threatening phase—an effort by opponents not only to prevent the enactment of genuine moral rights, but to freeze the U.S. law “equivalents” (relied on as adequate by the Ad Hoc Group) as of the Act's effective date, thus interdicting the future development of moral rights under copyright or other legal theories. A proposal by Senator Hatch would have inserted the following language in various places in the Berne adherence legislation:

(b) No author, or author's successor in interest, independently of the author's economic rights, shall be entitled on and after the effective date of this Act to any moral rights [i.e. of paternity or integrity -Ed.] under any Federal or State statutes or the common law.

(c) Any right of an author, or an author's successor in interest, whether under any provision of Federal or State statutes or the common law that, independently of the author's economic rights, is equivalent to any or all of the moral rights or any part thereof shall not, on and after the effective date of this Act, be expanded or enlarged either by Federal or State statute or by judicial construction.¹⁰⁶

However, the Berne adherence proponents ultimately succeeded in repelling this attack and in securing instead the legislation quoted in the footnote below,¹⁰⁷ which leaves existing U.S. law on moral rights

105. See letter of June 16, 1987 from Dr. Bogisch to Irwin Karp, Esq., *reprinted in pertinent part at* H.R. REP. No. 609, *supra* note 16, at 37. The letter states: “In my view, it is not necessary for the United States of America to enact statutory provisions on moral rights in order to comply with Article 6*bis* of the Berne Convention. The requirements under this Article can be fulfilled not only by statutory provisions in a copyright statute but also by common law and other statutes. I believe that in the United States the common law and such statutes (Section 43(a) of the Lanham Act) contain the necessary law to fulfill any obligation for the United States under Article 6*bis*.”

106. S. 1971, 100th Cong., 1st Sess. (1987).

107. SEC. 3. CONSTRUCTION OF THE BERNE CONVENTION

... (b) CERTAIN RIGHTS NOT AFFECTED. — The provisions of the Berne Convention, the adherence of the United States thereto, and satisfaction of United States obligations thereunder, do not expand or reduce any right of an author of a work, whether claimed under Federal, State, or the common law —

(1) to claim authorship of the work; or

(2) to object to any distortion, mutilation, or other modification of, or other derogatory action in relation to, the work, that would prejudice the author's honor or

“equivalents” in place and allows it to develop, though U.S. courts would be forbidden to look to the Berne Convention to support that growth. In the end, those who favor the further evolution of moral rights in the U.S. may take satisfaction in the knowledge that such an evolution can still take place and that a major disaster—the destruction of such rights and the freezing of their equivalents now and for the future—was averted.

2. *Compatibility of U.S. Moral Rights with Berne Standards*

a. Right of Integrity

Although U.S. copyright law does not recognize an author's specific independent moral rights, the 1976 Copyright Act has assimilated certain features of moral rights under the rubric of economic rights. For example, while the Act affords no right of integrity *per se*, it does provide a basis for objection to alterations of works. Modification creates a “derivative work,” the creation of which is one of the enumerated exclusive rights in § 106.¹⁰⁸ To be sure, the right to make derivative works is considered an economic right, part of the bundle of exploitation rights contained in a “copyright.” Nonetheless, it can arguably be used to protect moral, rather than (or as well as) economic, interests. There is, however, an important limitation: an author who has authorized the creation of a derivative work may no longer object to the grantee's alterations, unless a contract limits

reputation.

SEC. 4. SUBJECT MATTER AND SCOPE OF COPYRIGHTS

a) SUBJECT AND SCOPE—Chapter I is amended—

(3) in section 104 by adding at the end thereof the following:

. . . (c) EFFECT OF BERNE CONVENTION. — No right or interest in a work eligible for protection under this title may be claimed by virtue of, or in reliance upon, the provisions of the Berne Convention, or the adherence of the United States thereto. Any rights in a work eligible for protection under this title that derive from this title, other Federal or State statutes, or the common law, shall not be expanded or reduced by virtue of, or in reliance upon, the provisions of the Berne Convention, or the adherence of the United States thereto. . . .

SEC. 6. PREEMPTION WITH RESPECT TO OTHER LAWS NOT AFFECTED.

Section 301 is amended by adding at the end thereof the following:

“(e) The scope of Federal preemption under this section is not affected by the adherence of the United States to the Berne Convention or the satisfaction of obligations of the United States thereunder.”

Berne Implementation Act, supra note 1.

108. Article 106(2) of the U.S. Copyright law, 17 U.S.C. § 106(2), grants the exclusive right to authorize derivative works. The U.S. Court of Appeals for the Second Circuit has declared that a broadcaster's unauthorized cutting of an audiovisual work violated the exclusive derivative works right. *See Gilliam v. American Broadcasting Companies, Inc.*, 538 F.2d 14 (2d Cir. 1976).

the nature of the alterations permitted, or reserves a right to approve modifications. In other words, under the American copyright statute, the derivative works right, to the extent that it embraces a right of integrity, is waivable and alienable.¹⁰⁹ Moreover, like other rights in the statute which have a right of integrity flavor,¹¹⁰ it is a copyright owner's, and not necessarily an author's, right.

Does the transferability of moral rights interests violate Berne standards? Probably not. The treaty's specification of the independence of the rights of integrity and attribution from economic rights simply ensures that a grant of economic rights does not, of itself, entail a ceding of moral rights. Unlike certain national laws, the Berne Convention does not state that moral rights are "inalienable."¹¹¹ Comparing the Berne text with more strongly worded national provisions, a leading commentator concludes that "there is nothing . . . which prohibits national laws from allowing authors to assign their moral rights either temporarily or permanently."¹¹² If this be so, one may properly argue that the derivative works right provides a measure of moral rights equivalence.

A more significant problem may be that in U.S. law the protection of derivative rights is not likely to afford much benefit to certain kinds of creative contributors to copyrighted works. The reason is that, under the Copyright Act, copyright (and therefore the derivative works right) belongs to the author, but the "author" is not always the actual person who created the work. According to the "works made for hire" rules, the employer, whether a physical or a juridical person, is deemed the "author" of works prepared by em-

109. See, e.g., the remarks of Representative Kastenmeier accompanying his Bill to modify the U.S. copyright law to facilitate U.S. adherence to the Berne Convention, 33 PAT. TRADE-MARK & COPYRIGHT J. (BNA) 555, 558 (1987) (asserting that, according to traditional property rules, all intellectual property rights must be alienable). But see, e.g., 17 U.S.C. § 203(a)(5) (author's right to terminate transfers is inalienable); Horowitz, *The Record Rental Amendment of 1984: A Case Study in the Effort to Adapt Copyright Law to New Technology*, 12 Colum.-VLA J.L. & Arts 31 (1987) (discussing restraints on alienation).

110. See 17 U.S.C. § 115(a)(2) (compulsory license to make phonorecords includes right to make arrangement of nondramatic musical composition, "but the arrangement shall not change the basic melody or fundamental character of the work"); § 110(4) (objection to certain exempted public performances of nondramatic literary or musical material). Only the termination right in § 203, whose exercise is not necessarily related to moral rights, is reserved expressly to the author.

111. Compare France, Law No. 57-298 on literary and artistic property of Mar. 11, 1957, art. 6, official French text in *Journal Officiel de la République Française* (Mar. 14, 1957), English translation reprinted in UNESCO, COPYRIGHT LAWS AND TREATIES OF THE WORLD.

112. S. RICKETSON, THE BERNE CONVENTION: 1886-1986 467 (1987). See also C. MASOUBE, GUIDE DE LA CONVENTION DE BERNE 46-47 (1978) (local courts enjoy under the Berne Convention "some freedom of action" in evaluating the legitimacy of a waiver of moral rights).

ployees in the course of their duties.¹¹³ So too is one who commissions the creation of a work, if the contract provides that the work will be deemed a "work made for hire," and if the work falls within certain categories prescribed in the Act.¹¹⁴

As a result, in the U.S., many creators' rights (if any) to ensure the integrity of their works must come from sources other than the copyright law. Contract law may afford one of these. Even with the status of a "non-author," a creator with sufficient bargaining power may provide contractually for some measure of control over his or her work.¹¹⁵ But, at best, this technique may afford only uncertain security; the rights may not be directly opposable against non-parties to the contract.¹¹⁶

113. See 17 U.S.C. § 101 (defining works made for hire).

114. *Id.* Some recent decisions, however, have raised questions as to whether commissioners of works may not have even broader claims to authorship status. See, e.g., *Aldon Accessories v. Spiegel*, 738 F.2d 548 (2d Cir. 1984), *cert. denied*, 469 U.S. 982 (1985). But see *Dumas v. Gommerman*, 865 F.2d 1093 (9th Cir. 1989) (rejecting work for hire characterization of commissioned works other than those listed in § 101; for all other works, work for hire status requires a creator to have been a "formal, salaried employee."). The U.S. Supreme Court has agreed to hear argument on whether a party commissioning the creation of a work not listed in the work for hire definition of § 101 may nonetheless be deemed an "employer," and therefore an "author." *Community for Creative Non-Violence v. Reid*, 846 F.2d 1485 (D.C. Cir.), *cert. granted*, 109 S. Ct. 362 (1988).

Several recent publications include thorough reviews of the legislative history leading to the adoption of the current definition of "works made for hire." See, e.g., Litman, *Copyright, Compromise, and Legislative History*, 72 CORNELL L. REV. 857, 888-90, 899-901 (1987); Note, *Commissioned Works as Works Made for Hire Under the 1976 Copyright Act: Misinterpretation and Injustice*, 135 U. PA. L. REV. 1281 (1987) (both of these studies conclude that § 101 should be read literally, to exclude from authorship status parties commissioning works other than those listed in § 101).

115. See, e.g., Harmetz, "ABC Cancels 'Reds' After Prohibition on Editing," N.Y. Times, April 17, 1985, at C26, col. 1, regarding film director Warren Beatty's refusal to authorize the television broadcast of an edited version of his film "Reds"; Mr. Beatty's contract granted him absolute control over the final version of the film ("right of final cut").

116. Arguably, the copyright holder's grantee might be subject to the creator's equitable claim, if a court determined that his retention of control in effect amounted to a servitude running with the work. Even assuming the possibility that a court would admit the principle of an equitable servitude on the grantee's exercise of the copyright, several factors may make substantiation of the claim unlikely. First, the creator-copyright holder agreement must clearly manifest an intention to bind subsequent acquirers. Second, the subsequent acquirer must have notice of the limitation. Third, there must be no contrary public policy which would override enforcement of the director's claim. See generally, Chaffee, *The Music Goes Round and Round: Equitable Servitudes and Chattels*, 69 HARV. L. REV. 1250 (1956); Chaffee, *Equitable Servitudes on Chattels*, 41 HARV. L. REV. 945 (1928).

As to the first and second elements, it is improbable that most contracts potentially at issue meet the required level of specificity. With regard to the third factor, the federal copyright law may well preempt the state law equitable claim. The claim amounts to an encumbrance on the exercise of federal rights under copyright, and thus may be held to interfere impermissibly with the federal scheme. Cf. *Vault Corp. v. Quaid Software Ltd.*, 847 F.2d 255, 270

If the work for hire rule compromises certain creators' integrity interests, are U.S. moral rights protections insufficient under Berne? While, as a practical matter, the rule would seem to cut a large swath out of moral rights protections, this result may not contravene the treaty. This is because Berne may well tolerate each member country's designation of authorship status.¹¹⁷ In other words, Berne provides that the "author" shall enjoy moral rights; but Berne does not clearly direct that its signatories rank as "authors" only the physical persons who in fact created the work.

Certain other non-copyright theories may better bolster the integrity interest. For example, the federal unfair competition law (and analogous state laws) may serve to protect the integrity interest of an author's work that has been mutilated by another but attributed to the author.¹¹⁸ Thus, in *Gilliam v. ABC*¹¹⁹ (the "Monty Python" case), the U.S. broadcaster of an English television program had, without the authors' permission, cut 24 of 90 minutes, or more than a quar-

(5th Cir. 1988) (holding preempted a state law authorizing "shrink-wrap licenses" purporting to forbid exercise of rights afforded under a provision of the federal copyright act).

Further objections to persistence of the state claim arise if some states recognize the equitable servitude, but others do not; the grantee could exercise the copyright in some states, but not in others. When exercise of the copyright involves broadcasting, or similar activities simultaneously penetrating many states' borders, to respect the prohibition of one state may mean to refrain from conduct lawful in all or most of the others. In such an instance, the prohibition of the one, or of the few, should probably yield. *See, e.g., RCA Mfg. Co. v. Whiteman*, 114 F.2d 86, 89-90 (2d Cir. 1940). In this case, the court declined to recognize asserted equitable servitude arising out of "not for broadcast" labels on sound recordings. While acknowledging that the Supreme Court of Pennsylvania, in *Waring v. WDAS Broadcasting Station*, 37 Pa. 433, 194 A. 631 (1937), had reached a contrary decision, and that broadcast of the records into Pennsylvania would thus be a tort in that state, the court refused to enter an injunction for the sole benefit of Pennsylvania, when all surrounding territories would not uphold the servitude: "even if it be mechanically possible to prevent any broadcasting through the angle which the state of Pennsylvania subtends at the transmission station, that would shut out points both in front of, and beyond, Pennsylvania. We must therefore choose between denying any injunction whatever—since in our judgment the act is unlawful only in Pennsylvania—or enjoining [defendant] from broadcasting throughout the Union and in Canada in order to prevent a tort in Pennsylvania alone.")

117. *See Final Report, supra* note 19, at 615 & n.3, and authorities cited therein. *But see Ginsburg, Colors in Conflicts: Moral Rights and the Foreign Exploitation of Colorized U.S. Motion Pictures*, 36 J. COPR. Soc'y 81, 86-87 (1988) (suggesting that, at least for audiovisual works, Berne implicitly accords authorship status to the actual, physical creator).

118. Indeed, attribution to the author of another's radical (or particularly inept) alterations may give rise to a defamation claim. *See, e.g., Clevenger v. Baker Voorhis & Co.*, 8 N.Y.2d 187, 168 N.E.2d 643 (1960). And claims based on privacy and publicity protections may also be of use against some alterations, and may indeed represent a promising avenue of future development in relation to attribution and integrity, rooted as they are (along with moral rights) in rights of personality. *See Final Report, supra* note 19, at 555 & n.31, and authorities cited therein.

119. 538 F.2d 14 (2d Cir. 1976).

ter of the program. The U.S. Court of Appeals for the Second Circuit declared that such extensive editing so profoundly altered the character of the work that it would have been inaccurate, indeed deceptive, to attribute the work to the Python authors. This ruling is not based on a copyright infringement theory. The court's discussion addressed the federal unfair competition law prohibiting false representations and false designations of a product or service's origin.¹²⁰ Other courts have also acknowledged that radical cutting of a film for television broadcast may lead to a false designation of origin.¹²¹ But, if the changes to the work are clearly labeled as the product of someone other than the author, it may be argued that there is no deception in the public presentation of the work; if the source of commercial falsehood is removed, the theory goes, the unfair competition—and perhaps the defamation—claims vanish as well.¹²²

Nonetheless, the utility of false representation claims should not be undervalued. As the *Monty Python* court observed, often attempts to label the film to inform the public of unauthorized alterations will not cure the false impression caused by the broadcast. This is especially so when the television viewer has no means to compare the complete work to the broadcast version.¹²³ In fact, a false representation claim may often furnish a viable means to protect the creator's right of integrity in those kinds of works not susceptible to effective disclaimers.¹²⁴

120. See Lanham Federal Trademarks Act § 43(a), 15 U.S.C. § 1125(a) (1982) [hereinafter § 43(a)].

121. See, e.g., *Jaeger v. American Int'l Pictures, Inc.*, 330 F. Supp. 274 (S.D.N.Y. 1971). This decision observes, however, that the concept of false designation can be difficult to apply when the work is the fruit of many authors' labors. Audiovisual works often fit this description.

122. The limitations of the false representation claim flow from the fundamental difference between the goal of this claim and the goal of a moral rights claim. A false representation action seeks to prevent public confusion arising out of false advertising, false source designations, and similar deceptive acts. If the public is given clear notice of the nature of the alterations made to a work, then, arguably, the purveyor has complied with the requirements of the law prohibiting false designations. By contrast, moral rights seek to protect an author's individual creative concerns from harm whatever the nature of the labeling. For a fuller discussion of the difference between a consumer protection claim and a moral rights claim, see Note, *An Author's Artistic Reputation Under the Copyright Act of 1976*, 92 HARV. L. REV. 1490, 1499-1500 (1979).

123. See 538 F.2d at 25, n.13.

124. Because of the difference in theory, claims under § 43(a) or state unfair competition laws may not be effective against mutilations in the case, for example, of a privately-held work. On the other hand, moral rights relief against mutilations which are not publicly disclosed may also be doubtful under French law. See *Buffet v. Fersing*, Paris Court of Appeals, May 30, 1962, 1962 D.Jur. 579, note Desbois; Françon & Ginsburg, *Author's Rights in France: The Moral Right of the Creator of a Commissioned Work to Compel the Commissioning Party to Com-*

b. Right of Attribution

The right of attribution regarding a work neither altered nor mutilated seems more secure under current U.S. legal doctrines, despite an early inhospitable reception at state common law.¹²⁵ The same provision of the federal trademarks and unfair competition law applied by the *Monty Python* court has also been invoked in complaints by authors and other creative contributors that authorship or similar credit was improperly accorded to a third party. These plaintiffs asserted that attributing their work to another constituted a false representation or false designation of origin of goods in interstate commerce. Their claims have succeeded where defendant copied from plaintiff's work, and cast himself as the author,¹²⁶ where one co-author removed the names of his two co-authors, presenting a musical work as his alone,¹²⁷ and where a book's editor failed to acknowledge the full extent of the contribution of one group of authors, conveying the impression that the work was almost entirely the product of a third party.¹²⁸

Does a simple denial of authorship credit, without misattribution to a third party, or without misrepresenting the extent of a co-author's contribution, also constitute a false representation? One might argue that nonattribution inevitably entails falsehood; for example, it can falsely suggest that the author wished to remain anonymous. The Ninth Circuit has characterized nonattribution as "implied reverse passing off;" explicit misattribution or misrepresentation is "express reverse passing off." Both kinds of reverse passing off "involuntarily deprive [the creator] of the advertising value of its name and of the

plete the Work, 9 COLUM.-VLA J.L. & ARTS 381, 392-93 & n.44 (1985).

§ 43(a) may be an imperfect substitute for moral rights for other reasons as well. "Competition" is an express element governing its application. One court has indicated that "competition" between the parties is a prerequisite to invocation of § 43(a). See *Halicki v. United Artists Communications, Inc.*, 812 F.2d 1213 (9th Cir. 1987). Moreover, perhaps unfair competition law cannot reach destruction of a work, nor stand against a copyright owner's waiver. See Krigsman, *Section 43(a) of the Lanham Act as a Defender of Artists' Moral Rights*, 73 TRADEMARK REP. 251 (1983). See generally Verbit, *Moral Rights and § 43(a) of the Lanham Act: Oasis or Illusion?*, 78 TRADEMARK REP. 579 (1988).

The revised version of § 43(a), effective Nov. 16, 1989, does not appear to affect the questions raised in this footnote.

125. See, e.g., *Vargas v. Esquire*, 164 F.2d 522 (7th Cir. 1947).

126. *Marling v. Ellison*, 218 U.S.P.Q. 702 (S.D. Fla. 1982).

127. *Lamothe v. Atlantic Recording Corp.*, 847 F.2d 1403 (9th Cir. 1988).

128. *Dodd v. Ft. Smith School Dist.*, 4 U.S.P.Q.2d 1395 (W.D. Ark. 1987). Cf. *Follett v. New American Library*, 497 F. Supp. 304 (S.D.N.Y. 1980) (upholding author's claim that he was improperly credited as the principal author rather than as one of several authors of the work).

goodwill that otherwise would stem from public knowledge of the true source of the satisfactory product. The ultimate purchaser (or viewer) is also deprived of knowing the true source of the product . . ."¹²⁹ As the law has been developing, one can well hope that the courts will still more clearly enunciate an affirmative (noncontractual) right to compel attribution, in the absence of express misattribution.¹³⁰

In discussing the "equivalents" to the moral rights protections that have led the proponents of Berne adherence to believe that compliance is now adequate, with promise of a continuing favorable evolution, it would be amiss not to mention the utility of the law specifically governing trademarks (as against the more general unfair competition theory discussed above), for trademark registration or recognition can be relevant to both attribution and integrity. The federal administrative body which rules on registration appeals has declared that the name of an author can be registered as a trademark for the works the author produces.¹³¹ The full implications of this have yet to be explored, but they may well bear on the enforcement of rights close or equivalent to moral rights.¹³²

The existing U.S. law as it applies to attribution and integrity will certainly not satisfy the most fervent apostles of moral rights in the U.S. or abroad, but the Ad Hoc Working Group was not disingenuous when it urged, and Congress and the Director of WIPO concurred, that there are real protections in the U.S. for moral right interests, even if these are not identical in theory or in all their ramifications to those hallowed by continental European tradition. For proponents of moral rights in the U.S., adherence to Berne is not the end, it is rather the beginning of new efforts to reform U.S. law.¹³³

129. *Smith v. Montoro*, 648 F.2d 602 (9th Cir. 1981). See also *Lamothe*, *supra* note 127, at n.2 ("defendants did not simply remove all trace of the source of the product, which might itself be actionable as implied reverse passing off").

130. See *Committee for Creative Non-Violence v. Reid*, *supra* note 114 (joint owner of copyright in sculptural work, upon exercising right to reproduce the work, "might be obliged to credit [the sculptor of a portion of the work] as an author of the sculpture") (dictum).

131. *In re Wood*, 217 U.S.P.Q. 1345 (1983).

132. W.M. BORCHARD, *TRADEMARKS AND THE ARTS* (1989), chapter V. And see *id.* preface, pp. iv-v noting that "protections accorded as a matter of course to the makers of industrial products have not been fully accorded to, let alone claimed by, the makers of another kind of product — artistic creation."

133. It has not escaped notice in the U.S. that Berne-member legislation and Berne-member action to enforce rights of integrity range from total absence of effective protection to detailed and thorough regulation. See *Final Report*, *supra* note 19, at 548-51. The U.S. is certainly not in the lowest end of the range and its awareness and activity are certainly grow-

CONCLUSION

As we have seen, U.S. adherence to the Berne Convention, one hundred and two years after the treaty's enactment, occasioned some changes to, and much reflection about, U.S. copyright law. If the risk of barbaric forfeitures for lapses in formalities has been eliminated, both U.S. and foreign copyright holders would nonetheless be well advised, as a practical matter, to take the same steps to protect their works as they did (or should have done) under the 1976 Act. Despite the further shrinkage of the notice and registration formalities, compliance still produces important and valuable benefits.

While the legislative session which produced Berne adherence did not also provide extensively for moral rights, creators may nonetheless anticipate, and work toward, further development in that area. Concerted efforts are needed to shape U.S. moral rights with sensitivity to the special needs and problems of affected industries, without sacrificing the ultimate need to protect the interests of authors of works of the mind. Legislation and court decisions in other countries, such as France, indicate that these kinds of accommodations are possible.¹³⁴

ing. In many ways the concept of moral right is still inchoate, even in "advanced" moral rights nations, with respect to its impact in many practical situations. It may even be hoped that U.S. experience and efforts will help to clarify the emerging issues as they confront the tide of new technology, new media, and new art forms.

134. See, e.g., France, Law No. 85-660 of July 3, 1985, official French text in *Journal Officiel de la République Française [J.O.]* (July 4, 1985), modifying and supplementing Law No. 57-298 on literary and artistic property of Mar. 11, 1957, art. 6.5, J.O. (Mar. 14, 1957), English translation reprinted in UNESCO, COPYRIGHT LAWS AND TREATIES OF THE WORLD, (suspending moral rights claims by joint authors of audiovisual works until establishment of the definitive version); *Champaud v. Editions législatives et administratives*, Cour de cassation, first civil chamber, December 16, 1986, 133 *REVUE INTERNATIONALE DU DROIT D'AUTEUR [RIDA]* 183 (1987) (recognizing the right of the publisher of collective work to edit and alter individual contributions to fit overall design of collective work).