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**CONFERENCE ON THE 100TH ANNIVERSARY OF
THE 1909 COPYRIGHT ACT**

**THE 1909 COPYRIGHT ACT IN INTERNATIONAL
CONTEXT**

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Abstract

The passage of the 1909 U.S. Copyright Act was embedded in a significant period of evolution for international copyright law. Just a year before, the Berne Convention had been revised for the second time. This Berlin (1908) Act of the Convention is remembered in particular for the introduction of a broad prohibition against formalities concerning the “exercise and enjoyment” of copyright. 1909 was also just one year before a new copyright bill was brought before the British Parliament. This Copyright Act, finally adopted in December 1911 and which entered into force in July 1, 1912, greatly influenced laws in many countries, including Australia, Canada, Israel, New Zealand, Nigeria, and South Africa.

In this Essay, I situate the Berlin Act within the framework of the evolution of the Berne Convention from 1886 until the current 1971 Act and explore the role played by the United States, not as much as a participant in the Berlin Conference but by the way its actions influenced the actions of others. To this end, I discuss sequentially the emergence and evolution of the Berne Convention, and then two areas worthy of deeper analyses when considered against the backdrop of the 1909 Act, namely the prohibition against formalities and the rule imposing retroactive application of the Convention.

INTRODUCTION

As other Articles in this issue of the *Santa Clara & High Technology Law Journal* demonstrate, 1909 was a momentous year for

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copyright in the United States. The passage of the 1909 Copyright Act was also embedded in a significant period of evolution for international copyright law. Just a year before, the Berne Convention had been revised for the second time.¹ The Berlin (1908) Act of the Berne Convention was important for many reasons: it introduced rules concerning the adaptation of copyrighted works, the protection of “cinematographic works;” a minimum term of protection of 50 years *post mortem auctoris*; rules concerning the “mechanical reproduction” of musical works; and the current text of the provision on retroactive application of the Convention to works existing at the time of its entry into force for countries acceding to the Convention.² It is also at the Berlin Conference that the current broad prohibition against formalities concerning the “exercise and enjoyment” of the rights protected by the Convention, which is mentioned in a number of Articles in this issue, was adopted.³

1909 was also just one year before a new copyright bill was brought before the British Parliament. This Copyright Act, finally adopted in December 1911 and which entered into force in July 1, 1912, greatly influenced laws in many countries, including Australia, Canada, Israel, New Zealand, Nigeria, and South Africa.⁴ It also consolidated a “glorious muddle” of no less than 22 different British statutes passed between 1735 and 1906 and provided a more “intelligible and systematic” structure that survives to this day.⁵

In this Essay, I want to situate the Berlin Act within the framework of the evolution of the Berne Convention from 1886 until the current 1971 Act and explore the role played by the United States, not

1. Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, 126 A.T.S. 1901 [hereinafter Berne Convention (1886)]; revised July 24, 1971, amended Sept. 29, 1979, S. Treaty Doc. No. 99-27 [hereinafter Berne Convention (1971)]. The original 1886 text was revised at Paris in 1896 and then in Berlin in 1908 [hereinafter Berne Convention (1908)]. See WORLD INTELLECTUAL PROPERTY ORGANIZATION, THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS FROM 1886 TO 1986, 19-20, (1986) [hereinafter CENTENARY].

2. See CENTENARY, *supra* note 1, at 144-159. The provision on retroactivity is being challenged in a case currently before the 10th Circuit. See *Golan v. Holder*, 611 F.Supp 2d 1165 (D.Colo. 2009).

3. Berne Convention (1908), art. 4(2). See CENTENARY, *supra* note 1, at 229; See also Sam Ricketson, *The Boundaries of Copyrights: Its Proper Limitations and Exceptions: International Conventions and Treaties*, 3 INTEL. PROP. Q. 56-94 (1999).

4. Copyright Act 1911, 1 & 2 Geo. 5, c. 46 (Eng.). However, this cut both ways. A number of provisions in the 1911 Act were taken from the laws of the self-governing colonies and dominions. See BRAD SHERMAN & LIONEL BENTLY, THE MAKING OF MODERN INTELLECTUAL PROPERTY LAW: THE BRITISH EXPERIENCE, 1760-1911, at 112 & 136-7 (1999).

5. See BENTLY & SHERMAN, *supra* note 4, at 128. The “glorious muddle” metaphor is attributed to Lord Monkswell. See *id.* at 135.

as much as a participant in the Berlin Conference but by the way its actions influenced the actions of others.⁶ To this end, I will discuss, first, the emergence and evolution of the Berne Convention in Part I. Looking at the accomplishments of the Berlin Revision Conference, I then selected two areas worthy of deeper analyses, notably because of their relevance in understanding the differences between the 1909 and 1976 Copyright Acts. In Part II, I thus consider the prohibition against formalities. In Part III, I discuss the rule imposing retroactive application of the Convention. I should note that I could have selected the term of protection, and the linkage between that term and the life of the author instead of a fixed term from the date of creation or publication, but the issue is rather well known in the wake of the *Eldred* case; it is also discussed by other contributors to this issue.⁷

I. THE EVOLUTION OF THE BERNE CONVENTION (1886-1971)

A. The Emergence of 1886 Text of the Berne Convention

The seed of the Berne Convention was sown by the *Association littéraire internationale* (ALI), the predecessor of the present-day *Association littéraire et artistique internationale* (ALAI).⁸ Its first president was the famous French author and human rights campaigner Victor Hugo, perhaps the best known advocate for the Romantic Movement so closely associated with the natural rights foundation of authors' rights. Romantics saw creative works as extensions of their authors.⁹ But they also believed in the power of individuals to influence and shape events—Victor Hugo wrote that “literature was the government of humankind by the human spirit.”¹⁰ More importantly perhaps, during his keynote address to the Congress at which ALI was created, Hugo noted that while a book belongs to its author, ideas ex-

6. The administrative provisions of the Convention were revised in 1979 but the latest substantive changes to the Convention were made at the Paris Revision Conference of 1971. See CENTENARY, *supra* note 1 at 23, 52.

7. See *Eldred v. Ashcroft*, 537 U.S. 186 (2003). See also Paul Bender, *Copyright And The First Amendment After Eldred V. Ashcroft*, 30 COLUM. J.L. & ARTS 349 (2007); William F. Patry, *Fair Use and Statutory Reform in the Wake of Eldred*, 92 Cal. L. Rev. 1639 (2004).

8. See *Association littéraire et artistique internationale*, <http://www.alai.org> (last visited November 4, 2009). The International Literary Association, established at the 1878 Congress (organized by the *Société des gens de lettres*) and now known as the International Literary and Artistic Association (ALAI), was the original proponent of the Berne Convention. See RICHARD R. BOWKER, *COPYRIGHT: ITS HISTORY AND ITS LAW* 314 (1914); CENTENARY, *supra* note 1, at 19; concerning the Association's name change, see CENTENARY, *supra* note 1, at 144.

9. See *Association littéraire et artistique internationale*, <http://www.alai.org> (last visited November 4, 2009).

10. Victor Hugo, *Discours d'ouverture du Congrès littéraire international de 1878* (1878).

pressed in the book belong to humankind.¹¹ Moreover, if one must choose between the rights of the writer or the rights of the “human spirit,” then the rights of the writer must be “sacrificed” because the public interest is the sole preoccupation and must come before everything else.¹² He added that literary property should be “founded” (established) in parallel to the public domain.¹³ Hugo’s explicit exclusion of ideas from the scope of copyright protection is a well established notion in both major (Western) legal systems, and in the TRIPS Agreement.¹⁴ Two examples should suffice. First, § 102(b) of the US Copyright Act¹⁵ excludes from the scope of protection ideas, procedures, processes, systems, methods of operation, concepts, principles, and discoveries. Second, French treatises on copyright (literary and artistic property, that is) typically mention that “*les idées sont de libre parcours*” (ideas should circulate freely) is a fundamental principle of intellectual property protection.¹⁶

Hugo’s contention that, should a conflict arise between the rights of the author and those of “the human spirit,” the latter should prevail, also seems compatible with prescriptive lessons drawn from utilitarian analyses according to which copyright protection should stop once the goal of maximizing welfare—by ensuring that new works are created without stifling the potential for new ones (*i.e.*, should go no further than is required to “promote the progress of science and useful arts”¹⁷)—or indeed economic analyses of copyright that look for a (measurable) optimal protection point at which creation and dissemination of new works is not negated by deadweight and other wel-

11. *Id.*

12. *Id.* This is a rather loose translation. The original speech is as follows:

Le livre, comme livre, appartient à l’auteur, mais comme pensée, il appartient - le mot n’est pas trop vaste - au genre humain. Toutes les intelligences y ont droit. Si l’un des deux droits, le droit de l’écrivain et le droit de l’esprit humain, devait être sacrifié, ce serait, certes, le droit de l’écrivain, car l’intérêt public est notre préoccupation unique, et tous, je le déclare, doivent passer avant nous...Constatons la propriété littéraire, mais, en même temps, fondons le domaine public.

13. *See id.*

14. Agreement on Trade Related Aspects of Intellectual Property Rights, art 9.2, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade organization, Annex 1C, 1869 U.N.T.S 299; 33 I.L.M. 1197 (1994) [hereinafter TRIPS].

15. 17 U.S.C. §102(b) (2006).

16. *See, e.g.* ANDRÉ AND HENRI-JACQUES LUCAS, *TRAITE DE PROPRIETE LITTERAIRE ET ARTISTIQUE*, ¶¶ 28 and 58 (3d ed. 2006). As the authors explain: “C’est un principe fondamental du droit de la propriété intellectuelle que les idées sont en elles-mêmes de libre parcours. La règle a été présentée comme une concession à l’intérêt de la société.” *Id.* at ¶ 28. This may be translated as follows: It is a fundamental principle of intellectual property that ideas are free to use. This rule may be presented as a concession to societal interests.

17. U.S. CONST. art. I, § 8, cl. 8.

fare losses.¹⁸ Hugo's understanding of what was to become the Berne Convention not only incorporated an element of public interest as part of the framework; public interest was and is the Convention's framework.¹⁹

The 1886 text of the Convention arguably met this objective. Its substantive content was minimalist. Its basic premise was to ensure that authors who were nationals of countries that would accede to the new treaty and thus form the "Berne Union" would be protected in all countries of the Union without discrimination according to the well-known principle of national treatment.²⁰ Otherwise, the original Convention only contained a few rights: translation,²¹ and public representation for dramatic and dramatico-musical works.²²

The original text also implicitly included a limited right of reproduction.²³ It referred to "infringing copies," which were "liable to seizure on importation."²⁴ It also contained an explicit, though conditional right of reproduction for newspapers or periodicals, which applied only if specifically asserted by the author.²⁵ More importantly, the 1886 text contained a partial definition of "unlawful reproductions to which this Convention applies," which, interestingly, included "unauthorized indirect appropriations of a literary or artistic work, of various kinds, such as adaptations, musical arrangements, etc., when they are only the reproduction of a particular work, in the same form, or in another form, *without essential alterations, additions, or abridgements, so as not to present the character of a new original work*"²⁶

18. See, e.g., RICHARD A. POSNER AND WILLIAM M. LANDES, *THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW* 233-241 (2003) (Where the authors discuss the optimal duration of copyright protection). *Id.* at 415 (They also note the "danger that the [intellectual property] system would be extended beyond the optimal point, implying the existence of such a point.").

19. See *supra* note 12 and accompanying text.

20. CENTENARY, *supra* note 1, at 119. The Berne "Union" is composed of all countries that are party to the Convention. See Berne Convention (1971), *supra* art. 1. The term "unionist" is used to refer to those countries.

21. Berne Convention (1886), *supra* note 1, at arts., 5, 6, 9(2). See CENTENARY, *supra* note 1, at 228. The term of protection was ten years.

22. *Id.* at arts. 5-6. The term of protection was ten years.

23. The most fundamental right, the right of reproduction, was mostly taken for granted as it were, because it only made it in the Stockholm Convention Revision (Act) of 1967. CENTENARY, *supra* note 1, at 232-234. It is also at the 1967 Revision Conference that the three-step test, to which I return below, made it into the Convention. It had existed in national laws for decades before that, starting with the *Statute of Anne* of 1710 (8 Anne c. 19 (Eng.)).

24. Berne Convention (1886), *supra* note 1, at art. 12(1). See CENTENARY, *supra* note 1, at 228.

25. Berne Convention (1886), *supra* note 1, at art. 7.

26. *Id.* at art. 10 (emphasis added).

One of the ways in which copyright law must be substantially revisited to reestablish a proper balance is the scope of the right of adaptation (or the right to make “derivative works”).²⁷

In other words, apart from a few basic rights, the most important set of provisions of the 1886 text of the Berne Convention dealt with national treatment.²⁸ The Convention also contained exceptions, including one for the reproduction of “articles of political discussion, news of the day or miscellaneous facts”, which could not be prohibited,²⁹ and one for “use in publication for teaching or scientific purposes, or for chrestomathies.”³⁰ Those exceptions, including the only *mandatory* one contained in the Convention (news of the day, facts and “articles of political discussion”), undeniably reflected public interest considerations, particularly freedom of information and the press. In a precursor to debates about the manufacture of tools to circumvent Technical Protection Measures (TPMs), a Protocol to the 1886 text also provided that the manufacture and sale of “instruments for the mechanical reproduction of musical works in which copyright subsists shall not be considered as constituting an infringement of musical copyright.”³¹

B. Berlin and the Addition of New Rights

New minimum rights were added at successive Revision Conferences, starting in Berlin in 1908, partly to mirror the pattern of evolution of forms of exploitation of copyright works invented after 1886.³² A few exceptions were also added but the area of exceptions and limitations in the Convention was mostly left to each country and were considered as unregulated space at the international level.³³

27. In United States copyright law, *see* 17 U.S.C. §106(2); *See also* R. Anthony Reese, *Transformativeness and the Derivative Work Right*, 31 COLUM. J. L. & ARTS 467 (2008).

28. Berne Convention (1886), *supra* note 1, at art. 2.

29. *Id.* at art.7(2). *See also* CENTENARY, *supra* note 1, at 228.

30. Berne Convention (1886), *supra* note 1, at art. 8. This exception only allowed countries to maintain existing exceptions.

31. Berne Convention (1886), *supra* note 1, Final Protocol of September 9, 1886, art. 3, *reprinted in* CENTENARY, *supra* note 1, at 228.

32. *See* CENTENARY, *supra* note 1, at 19-23.

33. Except for the imposition in the TRIPS Agreement of a three-step test used to filter individual exceptions. TRIPS Agreement, *supra* note 14 at art. 13. The test was added to the Berne Convention (art. 9(2)), where it only applies to the right of reproduction, in 1967. *See* P. BERNT HUGENHOLTZ AND RUTH OKEDIJI, *CONCEIVING AN INTERNATIONAL INSTRUMENT ON LIMITATIONS AND EXCEPTIONS TO COPYRIGHT: FINAL REPORT 3* (2008), http://www.iprsonline.org/resources/IntLE_HughenoltzOkediji.pdf (noting that “despite over a century of international norm setting in the field of copyright, L&E’s have largely remained “unregulated space.”). On the three-step test, *see* MARTIN SENFTLEBEN, *COPYRIGHT LIMITATIONS AND THE THREE-STEP TEST* 283-293 (Kluwer Law International 2004); and D.

The Berlin Conference discussed proposals prepared by the host (German) government.³⁴ A key role was reserved, however, for the French government, which saw France as a parent of the Convention owing to the role played by Hugo and Paris-based ALAI; the main Committee Chairman and rapporteur was French law professor Louis Renault.³⁵

The first paragraphs of the Report of the Conference recall the role of ALAI in preparing the “arduous” Berne Conference.³⁶ It notes that “real progress” must be made by unanimous agreement among member States of the Berne Union on “delicate problems” with the aim of determining to what extent one should enact “an international rule which is superimposed on the various national laws, and to what extent it is essential to confine ourselves to referring matters back to them.”³⁷ In a similar vein, it mentions that “agreement implies sacrifices” and the result would thus not “to everyone’s complete satisfaction.”³⁸ While such observations may seem to state rather obvious facts, their inclusion in the report intimates that, although most participants at the Conference were mostly “like-minded” about authors’ rights, there were still very significant disagreements.³⁹

Gervais, *Towards A New Core International Copyright Norm: The Reverse Three-Step Test*, 9 MARQ. INTELL. PROP. L. REV. 1, 1-37 (2005).

34. See CENTENARY, *supra* note 1, at 144. It was standard practice at each such conference to let the host government present proposals. Usually, consultations with a number of other major stakeholders and governments preceded the conference itself. Conferences also met in “sessions” and often tasked committees to prepare reports on specific issues. At Berlin, a special report on mechanical reproduction of music was prepared.

35. See *id.* at 161. Mr. Renault had participated in the Berne Conference as a key member of the French delegation and had been the Head of the French delegation at the 1896 Conference held in Paris. See *id.* at 126,143. He won the Nobel Peace Prize in 1907. Nobelprize.org, Biography of Louis Renault, http://nobelprize.org/nobel_prizes/peace/laureates/1907/renault-bio.html (last visited November 4, 2009).

36. See CENTENARY, *supra* note 1 at 144.

37. *Id.* The unanimous consent rule is still in effect. See Berne Convention (1971), *supra* note 1, at art. 27(3). This probably explains why there will most likely never be another revision (getting the current membership—164 countries as of November 1, 2009 (see www.wipo.int)) to agree on *anything* might prove impossible).

38. CENTENARY, *supra* note 1, at 145.

39. Countries participating in the Conference included the fifteen that had signed the extant text (Belgium, Denmark, France, Germany, Great Britain, Haiti, Italy, Japan, Luxemburg, Monaco, Norway, Spain and Sweden, Switzerland and Tunisia) but also a number of countries that had not at the time adhered to the Convention--most of which did so after the Berlin Conference: Argentina, Chile, China, Colombia, Ecuador, Greece, Guatemala, Liberia, Mexico, The Netherlands, Persia, Peru, Portugal, Romania, Russia, Siam (Thailand), Uruguay and Venezuela. After some diplomatic wrangling, the United States attended, even though it had indicated it was not prepared to adhere, and was represented by Thorvad Solberg, the Head of the Copyright Department at the Library of Congress (previous title of the Register of Copyrights). See BOWKER, *supra* note 8, at 323-4; See also CENTENARY, *supra* note 1, at 145.

The Report notes the broad participation by “non-Unionist” countries and that the “great interest” of the Netherlands, Russia and the United States was especially appreciated.⁴⁰ The U.S. delegate indicated the “sympathy” of his government “for the goal pursued in general by the Berne Union” and testified to his own “personal interest and admiration” for the work of the Union.⁴¹ The careful language (e.g., “in general and “*personal* interest”) made it clear that the United States was not prepared to join, and this had been made clear in informal discussions held before the Conference.⁴²

The main accomplishments of the Berlin Conference have already been mentioned.⁴³ Two of them of particular interest in connection with the 1909 Copyright Act, namely the prohibition against formalities and the rule concerning retroactive application, are discussed below.⁴⁴ Other noteworthy results emerged, however. One could mention in that respect (a) a broader translation right; (b) the removal of the requirement that an author assert her rights in serial novels and short stories; (c) a new right of adaptation for mechanical reproduction and public performance; (d) the right to obtain seizure of illegal adaptations; and (e) a right of reproduction and public performance by cinematography.⁴⁵

On the other side of the norm ledger, Article 13 of the Berlin Act allowed countries to make reservations and impose conditions on the (then new) mechanical reproduction right.⁴⁶ In words that resonate still today, the Report notes that Berne Union members should “not consider only one side of the problem and adopt too rigid a stance.”⁴⁷ To implement flexible norms, a number of delegates preferred to leave the exercise of the right to market mechanisms.⁴⁸ However, the German government was “seeking to safeguard the interests of small manufacturers by protecting them both against the too heavy costs they could face as a result of excessive estimates on the part of the authors and publishers and against the danger of establishment of monopolies in favor of some manufacturers with large amounts of capital

40. CENTENARY, *supra* note 1, at 145. *See also* note 20 *supra* and accompanying text.

41. *Id.*

42. *See id.*; *see also* BOWKER, note 8 *supra*, at 324-5;

43. *See generally* CENTENARY, *supra* note 1; *see also supra* text accompanying note 2.

44. *See infra* Parts II and III, respectively.

45. Berne Convention (1908), *supra* note 1, at arts. 8, 13 and 14. *Not* mentioned here are (a) definitional changes (what is “published” etc.), and (b) administrative provisions.

46. *Id.* at art. 13(2).

47. CENTENARY, *supra* note 1, at 155.

48. *See generally id.* at 156. “Why should phonograph manufacturers not do the same as publishers and negotiate with the composers.” *Id.*

at their disposal.”⁴⁹

The Conference discussed whether copies manufactured under a compulsory license could be exported. A complete ban on the importation of copies from any country where a compulsory license was in place was considered and the “idea” of such a ban was “accepted without difficulty” but was considered “too absolute.”⁵⁰ The drafters chose instead to add the words “all such reservations and conditions shall apply only in the countries which have imposed them” to Article 13(2).⁵¹

II. THE PROHIBITION AGAINST FORMALITIES

A. The United States and the Early Acts of the Berne Convention

It is well known that the United States “finally” joined the Berne family in 1989, 103 years after the initial text of the Convention was adopted in Berne.⁵² Prior to this, the Berne Union members were keenly aware of the absence of the United States from the Convention.⁵³

Works first published abroad, including in the United Kingdom, could be reproduced in the United States without authorization. In fact, the 1790 Copyright Act limited protection to works published in

49. *Id.* (explaining German law already had a compulsory license system in place at the time). As we know, the music industry is now concentrated in the hands of four major companies (Sony Music Entertainment, Universal Music Group, Warner Music Group and EMI). In 2005, the “big four” accounted for 72% of worldwide sales. See IFPI, IFPI releases definitive statistics on global market for recorded music (Aug. 2, 2005), http://www.ifpi.org/content/section_news/20050802.html (last visited Nov. 4, 2009).

50. CENTENARY, *supra* note 1, at 156.

51. Berne Convention (1908), *supra* note 1, at art. 13(2).

52. See Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853. There is a vast amount of commentary on adherence by the U.S., including in this volume. See, e.g., Irwin Karp, *Final Report, Berne Article 18 Study on Retroactive United States Copyright Protection For Berne and Other Works*, 20 COLUM.-VLA J.L. & ARTS 157 (1996); William Patry, *The United States and International Copyright Law: From Berne to Eldred* 40 HOUS. L. REV. 749 (2003); Susan Stanton, *Development of the Berne International Copyright Convention and Implications of United States Adherence*, 13 HOUS. J. INT'L L. 149 (1990); Natalie C. Suhl, *Moral Rights Protection in the United States under the Berne Convention: A Fictional Work?* 12 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1203 (2002); Laura E. Steinfeld, *The Berne Convention and Protection of Works of Architecture: Why the United States Should Create a New Subject Matter Category for Works of Architecture Under Section 102(A) of the Copyright Act of 1976*, 24 IND. L. REV. 459 (1991); Ralph Oman, *The United States and the Berne Union: An Extended Courtship*, 3 J.L. & TECH. 71 (1988); Orrin G. Hatch, *Better Late Than Never: Implementation of the 1886 Berne Convention*, 22 CORNELL INT'L L.J. 171 (1989); Dennis S. Karjala, *United States Adherence to the Berne Convention and Copyright Protection of Information-Based Technologies* 28 JURIMETRICS J. 147 (1988).

53. See *supra* notes 41, 42 and accompanying text.

America by citizens or residents of the United States.⁵⁴ Apparently, this situation was not entirely beneficial to United States authors because foreign works could be reproduced more cheaply.⁵⁵ Moreover, this absence of protection for foreign works in the United States also meant that United States authors could not be protected elsewhere.⁵⁶

Supporting evidence may be found in the bills that authors and publishers who favored protection of foreign works were able to get introduced in Congress almost every year from 1837 until 1890.⁵⁷ However, it was only in 1891 that limited protection of foreign authors was implemented, by the Chace Act.⁵⁸ That Act provided that a work was protected if it had been printed from type set within the United States and two copies of the American imprint were deposited in the Copyright Office on or before the date of first publication anywhere else.⁵⁹ The first requirement came to be known as the “manufacturing clause,” and it would only be phased out in the 1980s.⁶⁰

The Chace Act was based on the principle of reciprocity.⁶¹ A Proclamation issued by President Harrison on July 1, 1891 allowed citizens of Belgium, France, Great Britain and Switzerland access to

54. Copyright Act of 1790, 1 Stat. 124, 125 (1790); *see also* WILLIAM BRIGGS, *THE LAW OF INTERNATIONAL COPYRIGHT* 637 (1906).

55. *See* BRIGGS, *supra* note 54, at 637-638.

56. Mark Twain was routinely published (without consent or payment) in Canada, for example. At one point, he moved to Montreal to establish residency there and protect his copyrights. *See Restoring The Balance: Panel on Contracting and Bargaining*, 28 COLUM. J.L. & ARTS 419, 423 (2005) (comment by Nick Taylor, President, Author’s Guild); *see also Oversight on International Copyrights: Hearing Before the Subcomm. on Patents, Copyrights and Trademarks of the Comm. of the Judiciary*, 98th Cong. 42 (1984) (report of the U.S. Copyright Office).

57. *See* Robert Spoo, *Ezra Pound’s Copyright Statute: Perpetual Rights And The Problem Of Heirs*, 56 UCLA L. REV. 1775, 1785 (2009) (noting that “[i]n response to a petition presented by British authors, Senator Henry Clay introduced a bill in Congress in 1837 that would have recognized British copyrights in the United States. The bill encountered strong opposition from the American book trade and never became law. . . . A series of Anglo-American copyright bills introduced in Congress between 1886 and 1890 met with the same fate. One historian has observed, ‘The publishers of cheap reprint series were against [such legislation], and so too were the increasingly powerful trade unions in the printing industry who feared loss of work if the copyright in imported books were protected under American law.’”) (notes omitted).

58. *See* Chace International Copyright Act of Mar. 3, 1891, ch. 565, 26 Stat. 1106, 1107 (1891) [hereinafter Chace Act]; *see also* BOWKER, *supra* note 8, at 346-370; *see also* Spoo, *supra* note 58, at 1785-87.

59. *See generally* Chace Act, *supra* note 59, at 1107.

60. *See* PAUL GOLDSTEIN, *COPYRIGHT’S HIGHWAY: FROM GUTENBERG TO THE CELESTIAL JUKEBOX* 152 (Stanford Univ. Press 2003) (1994).

61. *See* Chace Act, *supra* note 59, at 26 Stat. 1110 (“[T]his act shall only apply to a citizen or subject of a foreign state when such foreign state or nation permits to citizens of the United States of America the benefit of copyright on substantially the same basis as its own citizens . . .”).

the formalities leading to protection of their works in the United States, subject to the manufacturing clause.⁶²

The manufacturing clause was relaxed in the 1909 Act, which granted automatic protection to foreign-language works of foreign origin by exempting them from the manufacturing requirements and lowered the manufacturing requirements for foreign works in English by providing copyright for 30 days if a copy of the foreign edition was deposited in the U.S. Copyright Office within 30 days of its publication elsewhere.⁶³ Once a copy was deposited, however, the work then had to be reprinted on U.S. soil within the thirty-day window.⁶⁴

The perceived burden of complying with formalities, which would not have been obvious for local foreign authors and publishers, and the strict application of the manufacturing clause, may have been in the minds of the Berne negotiators in Berlin, which resulted in the adoption of the broad ban on formalities.⁶⁵ The Berne Union members went a step further in their condemnation of “piracy” in the United States by adopting a Protocol to the Berne Convention in 1914.⁶⁶ Proposed by the United Kingdom, it was designed as retaliation for the manufacturing clause and allowed Berne members not to protect of U.S. works even if first published in their territory.⁶⁷

62. See BRIGGS, *supra* note 55, at 645. Further proclamations issues extended the same privileges to citizens of many other nations. See also S. LADAS, *THE INTERNATIONAL PROTECTION OF LITERARY AND ARTISTIC PROPERTY* 837-38 (The MacMillan Company 1938); see also Binyomin Kaplan, *Determining Ownership of Foreign Copyright: A Three-Tier Proposal*, 21 *CARDOZO L. REV.* 2045, 2051 (2000).

63. Act of Mar. 4, 1909, ch. 320, 35 Stat. 1075, 1078-80 (1909). The exemption for foreign language works was introduced by an Act of March 3, 1905. Act of March 3, ch 1432, 33 Stat. 1000, 1000 (1905).

64. Act of Mar. 4, 1909, *supra* note 64, at 1079.

65. The Acts of the Berlin Conference do not mention the United States (or formalities in any other country by name for that matter) but most of the examples mentioned during the debates point to the U.S. For example, the Records state: “it is recalled that there was a time not so long ago when, to guarantee a work protection in a foreign country . . . [I]t was necessary to register and often even to deposit that work in the foreign country within a certain time limit.” CENTENARY, *supra* note 1, at 148. As to the difficulty for “non-sophisticated” authors and publishers in complying with the U.S. formalities, see CATHERINE SEVILLE, *THE INTERNATIONALISATION OF COPYRIGHT LAW: BOOKS, BUCCANEERS AND THE BLACK FLAG IN THE NINETEENTH CENTURY* 248 (Cambridge Univ. Press 2006).

66. See CENTENARY, *supra* note 1, at 20.

67. Additional Protocol to the International Copyright Convention on Nov. 13, 1908, signed at Berne, Mar. 20, 1914, 1 L.N.T.S. 243. See PAUL GOLDSTEIN, *INTERNATIONAL COPYRIGHT: PRINCIPLES, LAW, AND PRACTICE* 22 (2001). The Protocol entered into force on April 20, 1915. See William Belanger, *U.S. Compliance with the Berne Convention*, 3 *GEO. MASON INDEPENDENT L. REV.* 373, n3 (1995). The Protocol allowed Berne members to restrict the protection given to “works of authors who are . . . nationals of a . . . non-Union country,” which “fails to protect in an adequate manner the works of authors who are nationals of one of the countries of the Union.” CENTENARY, *supra* note 1, at 229.

The 1909 Act was thus a “step forward” for foreign authors. After all, it was signed into law by a member of the Authors Club (President Roosevelt).⁶⁸ Yet, the lawyer representing the American Copyright League (authors) noted that the “hopes of the friends of copyright will not . . . be fully realized until the manufacturing clause, with the affidavit provision, is repealed and the United States enabled by Congress to join the *family of civilized nations* as a signatory power in the Berlin convention.”⁶⁹

B. The Emergence and Interpretation of Article 5(2)

1. The 1884-1886 text

Article 5(2) of the Berne Convention (1971), which contains the prohibition against formalities, came into being in the very early days of the Convention. In the first draft of the Convention, published in 1884,⁷⁰ the relevant provision read as follows:

Authors who are nationals of one of the Contracting Countries shall enjoy in all the other countries of the Union, in respect of their works, whether in manuscript or unpublished form or published in one of those countries, such advantages as the laws concerned do now or will hereafter grant to nationals.

The enjoyment of the above rights shall be subject to compliance with the conditions of form and substance prescribed by the legislation of the country of origin of the work or, in the case of a manuscript or unpublished work, by the legislation of the country to which the author belongs.⁷¹

The basic intent was to grant to foreign authors the same rights as nationals. This was confirmed by the Drafting Committee, which also clarified the meaning of the expression “conditions of forms and substance,” originally a German proposal, which was changed to “formalities and conditions.”⁷² The Minutes of the First Conference held in Berne in 1884 are very useful to illuminate the meaning of “formalities” and purpose of the prohibition, as can be seen from the following excerpt:

Dr. Meyer: “It is merely a question of noting that the wording proposed by the German Delegation, ‘*conditions of form and sub-*

68. See BOWKER, *supra* note 8, at 371-2.

69. *Id.* at 372 (reference to the “Berlin convention” is to the Berlin Act of the Berne Convention of course) (emphasis added).

70. CENTENARY, *supra* note 1, at 94.

71. *Id.*

72. *Id.*

stance’ has been replaced by the words ‘*formalities and conditions*’, and that the word ‘*formalities*’ being taken as a synonym of the term ‘*conditions of form*’, included, for instance, registration, deposit, etc. ; whereas the expression ‘*conditions*’ , being in our view synonymous with ‘*conditions of substance*’, includes, for instance, the completion of a translation within the prescribed period. Thus the words ‘*formalities and conditions*’ cover all that has to be observed for the author’s rights in relation to his work to come into being (‘*Voraussetzungen*’ in German), whereas the effects and consequences of protection (‘*Wirkungen*’ in German), notably with respect to the extent of protection have to remain subject to the principle of treatment on the same footing as nationals. The President noted that the Conference agreed with Dr. Meyer on the scope of the words ‘*formalities and conditions*’.⁷³

2. The 1896 interpretation

The Report of 1896 Paris Conference, where the prohibition was also discussed, contains a useful statement:

Under the text of the Convention, the enjoyment of copyright *shall be subject to the accomplishment of the conditions and formalities prescribed by law in the country of origin of the work*. The meaning of this provision does not seem to be seriously debatable. As a result of it, the author needs only to have complied with the legislation of the country of origin, to have completed in that country the conditions and formalities which may be required there. He does not have to complete formalities in the other countries where he wished to claim protection. This interpretation, which is in keeping with the text, was certainly in the minds of the authors of the 1886 Convention⁷⁴

3. The adoption of the current text at Berlin

The 1908 Berlin Conference adopted a different version of Article 2. It has survived until now.⁷⁵ The relevant part reads as follows:

The enjoyment and the exercise of these rights shall not be subject to any formality; such enjoyment and such exercise are independent of the existence of protection in the country of origin of the work. Consequently, apart from the provisions of this Convention, the extent of protection, as well as the means of redress afforded to the author to protect his rights, shall be governed exclusively by

73. *Id.* at 94-95.

74. *Id.* at 137 (emphasis in original).

75. Berne Convention (1971), *supra* note 1, at art. 5(2).

the laws of the country where protection is claimed.⁷⁶

To interpret that provision in context, as required under Article 31(1) of the Vienna Convention on the Law of Treaties⁷⁷ and general principles of statutory construction, one must read it together with Article 5(1), which provides that:

Authors shall enjoy, in respect of works for which they are protected under this Convention, in countries of the Union other than the country of origin, the rights which their respective laws do now or may hereafter grant to their nationals, as well as the rights specially granted by this Convention.⁷⁸

The expression “these rights” in Art. 5(2) clearly refers to the “the rights which their respective laws do now or may hereafter grant to their nationals, as well as the rights specially granted by this Convention.”⁷⁹ The Convention thus imposes (a) an obligation to grant national treatment, that is to treat foreign right holders no less favorably than nationals, and (b) an obligation to provide the “rights specially granted by the Convention.”⁸⁰

To understand the scope of the prohibition, the Report of the 1908 Berlin Conference is worth quoting *in extenso*. It begins with a statement that the provision does not apply to domestic authors and then explains the shift from the single formality requirement (in the country of origin) to the no formality formulation existing in Convention text today:

The legislation of the country in which the work is published and in which it is nationalized by the very fact of publication continues to be absolutely free to subject the existence or the exercise of the right to protection in the country to whatever conditions and formalities it thinks fit; it is a pure question of domestic law. Outside the country of publication, protection may be requested in the other countries of the Union not only without having to complete any formalities in them, but even without being obliged to justify that the formalities in the country of origin have been accomplished. This is what results, on the one hand, from a general principle

76. CENTENARY, *supra* note 1, at 149.

77. Vienna Convention on the Law of Treaties, May 23, 1969, 1155 U.N.T.S. 331 (stating “A treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose.”)

78. Berne Convention (1971), *supra* note 1, at art. 5(1).

79. See MIHÁLY FICSOR, GUIDE TO THE COPYRIGHT AND RELATED RIGHTS TREATIES ADMINISTERED BY WIPO AND GLOSSARY OF COPYRIGHT AND RELATED TERMS (2003), §BC-5.6 [hereinafter MIHÁLY FICSOR].

80. See *id.* at §§BC-5.1 and BC-5.2; see also D. Gervais, *China-Measures Affecting the Protection and Enforcement of Intellectual Property Rights*, 103: 3 AM. J. INT’L L. 549, 550 (2009).

which is going to be stated and explained and, on the other, from the deletion of the third paragraph of Article 11 of the 1886 Convention. This Article [. . .] state[s], at the beginning of its paragraph 2, that ‘the enjoyment of these rights shall be subject to the accomplishment of the conditions and formalities prescribed by law in the country of origin of the work’ and, to remove difficulties which had arisen in certain countries, the Paris Interpretative Declaration had emphasized this idea—which was evidently that of the authors of the 1886 Convention—that the protection depends solely on the accomplishment, in the country of origin, of the conditions and formalities which may be required by the legislation of that country. This was already a great simplification which will be appreciated if it is recalled that there was a time not so long ago when, to guarantee a work protection in a foreign country, even by virtue of an international convention, it was necessary to register and often even to deposit that work in the foreign country within a certain time limit. The new Convention simplifies matters still further since it requires no justification. Difficulties had arisen with regard to the production of a certificate from the authority of the country of origin—this production having been considered, occasionally, as the preliminary to infringement action, which caused delays.⁸¹

Unquestionably, the major formalities considered prohibited under art. 5(2) are registration with a governmental authority and deposit of a copy of the work, when they are linked to the existence of copyright or its exercise, especially in enforcement proceedings. Indeed, formal requirement in existence at the time essentially involved registration, deposit (in national libraries) and, in rare cases, translation in a national language within a predetermined period of time.⁸² For many reasons, while it was necessary to respect each country’s ability to impose such requirements, they had to be decoupled from copyright. Deposit is still required for published works in many countries,⁸³ but the sanction for failure to provide free copies to a national library cannot be the removal of copyright.⁸⁴

“Enjoyment” refers to the very existence of the right while “exercise” refers in particular to enforcement.⁸⁵ Article 5(2) does not prevent authors from complying with ordinary (non-copyright-

81. CENTENARY, *supra* note 1, at 148.

82. *See id.*

83. *See* PAUL GOLDSTEIN, INTERNATIONAL COPYRIGHT, 187-189 (2001) (emphasis in original).

84. On this point, U.S. law is compliant. Failure to make copies of a new work available to the Library of Congress does not deprive the author of copyright protection.

85. *See* MIHÁLY FICSOR, *supra* note 81, at §BC-5.8.

specific) formalities (such as a court's rules of procedure). It would be patently incongruous to read art. 5(2) as preventing the mandatory doing of anything. Should authors just have to walk into a courtroom (itself a "formality") without having to file a statement of claim? Not have to deal with foreign publishers and distributors because those are "formalities"? Not have to deal with foreign tax authorities to avoid deductions at source in a foreign country? That is clearly not the intent or meaning of art. 5(2). Those are all normal acts that other copyright holders routinely perform to exploit their copyright works and not—as was made abundantly clear during the adoption and revision of the Convention—"formalities" prohibited under Art. 5(2).⁸⁶

Interestingly, in its pre-1908 incarnation, the provision was arguably derogating from national treatment, though it was clearly not intended as such. Rather, Convention drafters saw it as a simplification of the multiple registration/deposit requirements.⁸⁷ If "pure" national treatment had been applied, it would have been sufficient to grant protection to foreign authors on the condition of accomplishing the same formalities as nationals in every country.⁸⁸ In 1908, the provision was realigned along the principle of national treatment by making it a provision against mandatory formalities while maintaining the meaning of the expression "conditions and formalities" defined in 1884-1886.⁸⁹

The conclusion I suggest can be drawn from the above analysis is that *the two characteristics of prohibited formalities under Article 5(2) are thus that they should be (a) imposed by law and (b) copyright-specific.*

86. For instance the Records of the 1884 Conference note that "formalities," may be taken as a synonym of the term "conditions of form," included, for instance, registration, deposit, etc.; whereas the expression "conditions," being in our view synonymous with "conditions of substance," includes, for instance, the completion of a translation within the prescribed period. See RICKETSON & GINSBURG, note 72 *supra*, at 76. In 1908 an exception to the right of reproduction for newspaper articles was discussed. It was contained in proposed Article 9(2) and the relevant part read as follows: "With the exception of serial novels and short stories, any newspaper article may be reproduced by another newspaper *unless the reproduction thereof is expressly forbidden.*" *Id.* at 203 (emphasis added). It was made clear in the records that for an author to have to assert her rights (to expressly forbid) was not a prohibited formality. See *id.* at 191.

87. See FICSOR, *supra* note 81, at 42.

88. This was in fact the backdrop for the 1884 discussions. In his introductory remarks, the French delegate Louis Renault noted: "A second question is that of the formalities to be complied with for the recognition of rights. Writers and artists are demanding the utmost simplification in this connection. A country recently concluded 25 conventions on literary and artistic property; if its nationals have to comply 25 times with the formalities of registration and deposit, the whole operation becomes overly intricate and costly." RICKETSON & GINSBURG, *supra* note 72, at 61.

89. See *supra* note 81.

4. Article 5(2) in Commentary

The validity of the suggested conclusion just mentioned is confirmed in the latest commentary on the Convention published by the World Intellectual Property Convention (WIPO):

Formalities are any conditions or measures—independent from those that relate to the creation of the work (such as the substantive condition that a production must be original in order to qualify as a protected work) or the fixation thereof (where it is a condition under national law)—without the fulfillment of which the work is not protected or loses protection. Registration, deposit of the original or a copy, and the indication of a notice are the most typical examples.⁹⁰

After a detailed analysis, Professors Ricketson and Ginsburg conclude that the prohibition contained in Article 5(2) applies, with respect to the *existence* of copyright, to “everything which must be complied with in order to ensure that the rights of the author with regard to his work may come into existence,” including a registration requirement.⁹¹ They note that the addition of “exercise” to the prohibition was meant to address the other half of the problem: “An author may be *vested* with copyright, but unable to *enforce* her rights unless she complies with a variety of prerequisites to suit.”⁹² The U.S. registration requirement is specifically mentioned by Ricketson and Ginsburg as a violation of Art. 5(2).⁹³ This explains, in their opinion, why the requirement to register was removed by Congress for basic remedies but not for attorneys’ fees or statutory damages.⁹⁴ They note that Art. 5(2) does not prohibit the establishment of a copyright registration system, nor to giving some legal effect to a certificate of registration, such as *prima facie* evidence status.⁹⁵ The rule, as noted above, is that neither the existence nor the exercise of copyright can be subject to copyright-specific formalities.⁹⁶ Because a plaintiff is ordinarily expected to prove her case, it does not violate the Convention’s prohibi-

90. FICSOR, *supra* note 81, at 41; *See also* WIPO INTELLECTUAL PROPERTY HANDBOOK: POLICY, LAW AND USE 262 (2d ed. 2004) (“[P]rotection is granted automatically and is not subject to the formality of registration, deposit or the like.”).

91. SAM RICKETSON & JANE C. GINSBURG, INTERNATIONAL COPYRIGHT AND NEIGHBOURING RIGHTS: THE BERNE CONVENTION AND BEYOND 325 (2d ed. 2006) (quoting German delegate Meyer).

92. *Id.*

93. *See id.* at 326.

94. *See* Jane C. Ginsburg and John M. Kernochan, *One Hundred and Two Years Later: The U.S. Joins the Berne Convention*, 13 COLUM.-VLA J.L. & ARTS 1, 13-14 (1988).

95. *See* RICKETSON & GINSBURG, *supra* note 93, at 328-9.

96. *See id.* at 326-8.

tion to provide prima facie evidentiary status to a copyright registration.⁹⁷

III. THE RETROACTIVE APPLICATION OF THE BERNE CONVENTION

A. The Retroactive Application Rule

The Berlin Revision Conference adopted an important rule concerning the application in time of the Convention. It provides the following principle: The Convention applies to works which "at the moment of its coming into force, have not yet fallen into the public domain in the country of origin through the expiry of the term of protection" but also provides that if "a work has fallen into the public domain of the country where protection is claimed, that work shall not be protected anew."⁹⁸ Put differently, if a work has fallen into the public domain because its term of protection expired either in the country of origin of the work or in the country where protection is claimed, then it need not be protected when the convention enters into force.⁹⁹

Reading only paragraphs 1 and 2 of Article 18, one could conclude that works that have not fallen into the public domain in their country of origin and are not protected in the country where protection is claimed for a reason other than the expiration of the term of protection previously granted should be protected, that is, removed from the public domain and placed in the exclusive domain of the (new) right holder(s).¹⁰⁰ For example, if a work was protected for the life of the author plus 50 years (the Berne Convention minimum)¹⁰¹ and a country joining the Convention has a previous term of protection of 28 years which it agreed to increase to life + 50 years, then a work still protected in its country of origin but on which the term of 28 years had expired in the country joining the Convention would not

97. That is, it is not a *condition* for the right to exist. See Ficsor, *supra* note 81, at §BC-5.7 (noting that "[i]f registration only has the effect of a rebuttable presumption that the facts registered are valid, it is not such a formality (unless it is applied in a way that, in spite of the original legal regulation, it becomes a *de facto* formality, because, for example, courts only deal with any infringement case if a certificate of registration is presented).").

98. See Berne Convention, *supra* note 1, art. 18(1)-(2).

99. Arguably, a country would in fact be in violation of the Convention because Article 18(2) says "shall not be protected." Berne Convention, *supra* note 1, art. 18(2).

100. If the right holder in a work first published in France were seeking to enforce protection in a U.S. court for an infringement alleged to have taken place in the United States, then the U.S. would be the country where protection is claimed and France would be the country of origin.

101. Berne Convention, *supra* note 1, art. 7.

be protected anew.¹⁰² If, however, the work was still protected in the country of origin and was not protected in the country joining the Convention due to a failure to register it, then Article 18(1) and (2) would impose an obligation to protect that work, that is, remove it from the public domain.¹⁰³ This obviously interferes directly with the interests of parties that have engaged in legitimate dealing with the work in question prior to the application of the Convention.

In recognition of the very real hardship imposed on parties who relied on their legitimate right to exploit an unprotected work, paragraph 3 of Article 18 provides that the above principle “shall be subject to any provisions contained in special conventions to that effect existing or to be concluded between countries of the Union. In the absence of such provisions, the respective countries shall determine, each is so far as it is concerned, the conditions of application of this principle.”¹⁰⁴

Article 18(3) seems self-explanatory: each country decides how to apply retroactive protection. The Convention imposes no limits on such conditions. A country joining the Berne Union may *decide* to limit the protection available to reliance parties but it does not have to do so.¹⁰⁵ It may impose reasonable compensation, but again it does not have to do so.¹⁰⁶ The question is whether the proper metaphor here is that a country limiting the protection available to reliance parties is passing the exam with an “A” instead of a passing grade or whether it is a policy plane overshooting its runway. The Convention hints strongly that *not* restoring protection on works on which protection has expired (“shall not be protected anew”)¹⁰⁷ is sometimes desirable.¹⁰⁸ This is reinforced by Article 7 of the Convention, which contains the rule known as a “comparison of the terms of protection,” according to which a Berne Union member country does not have to

102. Article 18(4) provides that Article 18(1), (2) and (3) apply to “new accessions to the Union,” including the United States as of 1989. Berne Convention, *supra* note 1, art. 18(4). The Berne “Union” is the union of all countries party to the Convention. Berne Convention, *supra* note 1, art. 1.

103. See FICSOR, *supra* note 81, at §§BC-18.6 - 18.7.

104. Berne Convention, *supra* note 1, art. 18(3).

105. According to one view, the term “transitional” indicates that the protection of reliance parties must be temporary in nature. See FICSOR, *supra* note 81, at §BC-18.11. However, as is noted below, proposals to impose a specific time-frame (two years) were rejected.

106. See, e.g., 17 U.S.C. § 104A(d)(3)(A) (2006).

107. Berne Convention, *supra* note 1, art. 18(2).

108. As a basic policy matter, it seems rather odd that a foreign author who registered but whose work is no longer protected because term has expired has no right to seek restoration while an author who failed to comply with formalities would somehow automatically be entitled to restoration.

extend protection to a work no longer protected in its country of origin, for example if the country of origin has a shorter term of protection.¹⁰⁹

It is a cardinal principle of copyright law that people can use the public domain at will.¹¹⁰ This allows the copyright cycle to continue, thus making copyright “the engine of free expression.”¹¹¹ Pulling works out of the public domain goes against this principle, which the Convention itself recognizes, and must thus be considered with utmost caution.¹¹²

The debate about the proper interpretation of Article 18(3) boils down to this question: Should Article 18(3) be interpreted narrowly—and force Berne Union members limit the protection of reliance parties as much as possible—because Article 18 establishes the principle that existing works should be protected at the time of entry into force of the Convention?¹¹³ In trying to identify the right answer one may note, first, that this flies in the face of a core principle of international law, namely, that States can do all that is not prohibited.¹¹⁴ In fact, Article 18(3) *specifically provides* that States can decide which conditions to impose on restoration. Additionally, Article 18(2) imposes a limit on restoration of protection for works which are in the public domain of the country of protection is claimed because a previously granted term of protection has expired. Therefore, the Convention should be read as imposing limited restoration and the allowing States to impose their own conditions on such limited restoration.

109. Berne Convention, *supra* note 1, art. 7(8). The text of the Article also reads as a clear limitation: “the term *shall not exceed* the term fixed in the country of origin.” *Id.* (emphasis added).

110. See HOWARD A. ABRAMS, *THE LAW OF COPYRIGHT* §1.3 (2009) (noting that “While Congress has a broad scope for its discretion, the basic mechanism is constitutionally fixed as the dedication of the work to the public domain upon the expiration of federal statutory protection. If Congress strikes a desirable balance between the interests of authors, publishers, and the public, in the exclusive rights it grants to copyright owners, the copyright system should ‘promote the Progress of Science and useful Arts.’ Thus the copyright system provides a benefit to society that justifies the necessary evils of monopoly pricing and constraints on the use of present works for the creation of newer works.”).

111. *Golan v. Gonzales*, 501 F.3d 1179, 1183 (10th Cir. 2007) (citing *Harper & Row Publishers Inc. v. Nation Enters.*, 471 U.S. 539, 558 (1985)).

112. See Thomas Gordon Kennedy, *GATT - Out of the Public Domain: Constitutional Dimensions of Foreign Copyright Restoration*, 11 ST. JOHN’S J. LEGAL COMMENT. 545, 578 (1996).

113. See *supra* note 103.

114. See *S.S. Lotus (Fr. v. Turk.)*, 1927 P.C.I.J. (ser. A) No. 9, at 31 (Sept. 7) (holding that, in the absence of a prohibitory rule of international law, Turkey could prosecute the captain of a French ship that had collided with, and harmed persons on, a Turkish ship on the high seas).

B. Negotiating history of Article 18

To identify the proper interpretation of Article 18, we can also turn to the negotiating history. This is specifically allowed under Article 32 of the *Vienna Convention on the Law of Treaties*.¹¹⁵

1. The 1886 and 1896 texts

Article 18 was modified twice. The corresponding provision in the original 1866 text of the Convention read as follows: “Under the reserves and conditions to be determined by common agreement, this Convention shall apply to all works which at the moment of its coming into force have not yet fallen into the public domain in the country of origin.”¹¹⁶ The extent of the obligation was thus left to be defined in a separate “common agreement.”¹¹⁷ That agreement is contained in the Final Protocol of September 9, 1886 (adopted in the same date as the original text of the Convention). Paragraph 4 of the Protocol read as follows:

[1] The common agreement provided for in Article 14 of the Convention is established as follows: [2] The application of the Convention to works which have not fallen into the public domain at the time when it comes into force shall take effect according to the relevant provisions contained in special conventions existing, or to be concluded, to that effect. [3] In the absence of such provisions between any countries of the Union, the respective countries shall regulate, each in so far as it is concerned, by its domestic legislation, the manner in which the principle contained in Article 14 is to be applied.¹¹⁸

The Final Protocol thus only established a general principle leaving it up to each country to decide how it should be applied. The Records of the 1885 Diplomatic Conference where the text of Article 14 was agreed upon are also very clear: “As noted below, in connection with the Final Protocol, the implementation of the above Article [14] will be left to each country of the Union, which will decide on the conditions of retroactivity according to its own laws or specific conventions.”¹¹⁹

The 1896 Additional Act of the Convention modified Paragraph

115. Vienna Convention on the Law of Treaties, May 23, 1969, 1155 U.N.T.S. 331.

116. Berne Convention (1866), art. 14, CENTENARY, *supra* note 1, at 228.). All original texts were in the French language. The translations used in this brief are all from the aforementioned book published by the World Intellectual Property Organization (WIPO).

117. *See id.*

118. *Id.*

119. *Id.* at 123.

4 of the Final Protocol to make it applicable to translations and to “new accessions to the Union.”¹²⁰

2.The 1908 (Berlin) text

At the 1908 Berlin Conference, Article 14 became Article 18 and the provisions of the Final Protocol of 1886, as amended in Paris in 1896, were incorporated into a single Article.¹²¹ Because Article 18 essentially took its final form at that Conference, the discussion on retroactive application at that Conference is illuminating. The Report of that Conference reads in part as follows: “Account had to be taken of the *de facto* situation existing in certain countries at the time the Convention came into force, of the interests of those who might have lawfully reproduced or performed foreign works without their authors’ authorization.”¹²² There was thus a clear acknowledgement of legitimate interests existing at the time of application of the Convention.

One interesting difference between the 1886 version and the (current) version adopted in 1908 is that, while the former allowed countries to “regulate, each in so far as it is concerned, *by its domestic legislation*, the manner in which the principle contained in Article 14 is to be applied,” the latter allows countries to “determine, each in so far as it is concerned, the conditions of application” of the principle of restoration.¹²³

The current text is thus not limited to regulation by legislation. A court could determine appropriate conditions, for example. The *WIPO Guide to the Berne Convention* specifically notes that “it is a matter therefore for each member country to decide on the limits of this retroactivity and, in *litigation*, for the courts to take into account these *acquired rights* [of reliance parties].”¹²⁴

3.Application of time of more recent instruments

The application in time provision of the 1996 WIPO Copyright Treaty mirrors Article 18 of the Berne Convention (1971).¹²⁵ The Re-

120. Berne Convention, Additional Act and Interpretative Declaration of Paris of May 4, 1896, CENTENARY, *supra* note 1, at 228.

121. See RICKETSON & GINSBURG, *supra* note 91, at 215-216.

122. CENTENARY, *supra* note 1, at 158.

123. Berne Convention (1886), Final Protocol of September 9, 1886, art. 3, *supra* note 32. Berne Convention (1971) *supra* note 1 (emphasis added).

124. GUIDE, at 186 (emphasis added).

125. World Intellectual Property Organization: Copyright Treaty art. 13, Dec. 20, 1996, 36 I.L.M. 65; see also World Intellectual Property Organization: Performances and Phonograms Treaty art. 22, Dec. 20, 1996, 36 I.L.M. 76.

cords of the Diplomatic Conference, at which that treaty was adopted, contain the following statement from the Conference Chairman, discussing possible options for a provision on application in time:

He [Chairman] believed that that meant that there would be no retroactive effect concerning prior acts and the provisions of the Treaty would not introduce an obligation to countries to change their laws in such a way that prior agreements would be changed. He felt that that was *in most countries probably already constitutionally prohibited* . . . He acknowledged that revival of rights in some cases would cause practical problems.¹²⁶

The World Trade Organization Agreement (WTO) on Trade-related Aspects of Intellectual Property Rights¹²⁷ is also relevant in this context. It could be considered a “special convention” under Article 18(3) if it restricted the United States ability to determine appropriate conditions of retroactive protection.¹²⁸ However, that Agreement provides that “copyright obligations with respect to existing works shall be solely determined under Article 18 of the Berne Convention (1971).”¹²⁹ As such, it does not modify the obligations contained in Article 18. The TRIPS Agreement is nonetheless relevant because it is subject to the dispute settlement mechanism of the WTO. It is a long-standing principle of WTO law that WTO Agreements should not be interpreted to include concessions not explicitly bargained for.¹³⁰ Essentially, trade agreements are bargained for and should not, therefore, be “completed” or amended by interpretation.¹³¹ In addition, in interpreting the Berne Convention provisions incorporated into the TRIPS Agreement, dispute settlement panels referred to the negotiating history of that Convention.¹³² Consequently, because efforts were made during the negotiations to cabin Article 18, for ex-

126. World Intellectual Property Organization, *Records of the Diplomatic Conference on Certain Copyright and Neighboring Rights Questions*, Geneva 1996, Vol. II, 727 (1999) (emphasis added).

127. TRIPS, *supra* note 14. This Agreement was implemented by the Uruguay Round Agreements Act, Pub. L. No. 103-465, 108 Stat. 4809 (codified at 19 U.S.C. §§ 3501-3624 (1994)).

128. See MIHÁLY FICSOR at §BC-18.10.

129. TRIPS, *supra* note 14, art. 70.2.

130. For example, in *Brazil - Export Financing Programme For Aircraft*, in discussing an exception invoked by Brazil, the panel noted: “nothing indicates that the failure to remove this clause was something that developing countries bargained for.” Panel Report, *Brazil - Export Financing Programme for Aircraft*, 43, n.140, WT/DS46/R (Apr. 14, 1999). By contrast, in this case, the failure to remove the exception was clearly intended.

131. See JOHN H. JACKSON, *THE WORLD TRADE ORGANIZATION: CONSTITUTION AND JURISPRUDENCE*, 91-92 (1998)

132. Panel Report, *United States - Section 110(5) of the US Copyright Act*, paras. 6.45-6.47, WT/DS160/R (June 15, 2000).

ample by limiting measures to a two-year window or, as happened at the Paris Conference of 1896, to simply delete it,¹³³ and because those efforts failed and no clear statement restricting the scope of Article 18(3) is contained in the Convention records, a panel is unlikely to “read” significant restrictions into Article 18(3) of the Berne Convention as incorporated into the TRIPS Agreement.¹³⁴

4. Suggested interpretation

The history of Article 18 shows an undeniable awareness of problems caused by the application of the Convention to works in existence at the time of its first application in a country joining the Union, and what seems to be an unlimited discretion of Berne Union members to determine the conditions of application of retroactivity. The Convention does not favour a maximum term of protection in all cases. It specifically imposes a rule of comparison of terms of protection and a prohibition on restoration of copyright for works that have fallen in the public domain in the country where protection is claimed through the expiration of a previously granted term of protection.¹³⁵ A country complies with Article 18 if it chooses any degree of protection of works existing at the time of entry into force.¹³⁶ The only invalid option is a complete denial of the principle of retroactive application. This means, conversely, that a vast amount of discretion may be used to determine the protection of reliance parties.

C. Article 18 in Commentary

I consider it useful to look at learned commentaries on Article 18 to determine the validity of the above suggested interpretation of Article 18.

133. That is, its equivalent provision at the time, namely the Berne Convention for the Protection of Literary and Artistic Works, Final Protocol, para. 4, Sept. 9, 1886.

134. Many dispute-settlement panels have had to interpret conventions, including the Berne Convention, which were incorporated by reference into the TRIPS Agreement (in the case of Berne, by TRIPS art. 9.2). Those panels have paid considerable attention to the negotiating history of Berne and one went as far as to say that “in the absence of any express exclusion in Article 9.1 of the TRIPS Agreement, the incorporation of Articles 11 and 11bis of the Berne Convention (1971) into the Agreement includes the entire *acquis* of these provisions One should avoid interpreting the TRIPS Agreement to mean something different than the Berne Convention except where this is explicitly provided for. This principle is in conformity with the public international law presumption against conflicts, which has been applied by WTO panels and the Appellate Body in a number of cases.”

Panel Report, *United States – Section 110(5) of the US Copyright Act*, paras. 6.63, 6.66, WT/DS160/R (June 15, 2000).

135. Berne Convention, *supra* note 1, art. 7(8) and 18(2), respectively.

136. A complete denial means that the principles contained in Article 18(1) and 2) are not applied. See MIHÁLY FICSOR, *supra* note 81, §§ BC-1.9 and 18.10.

Professor Paul Goldstein of Stanford law School seems to hit the right note when he states that “Article 18(3) of the Berne Convention gives member countries considerable leeway to meliorate any prejudice suffered by users when a work they correctly believed was in the public domain is restored to copyright.”¹³⁷

A number of other commentators offer insights into the interpretation of Article 18.

1. Briggs

One of the earliest detailed commentaries published in English on the Berne Convention was William Briggs’ book entitled *The Law of International Copyright*.¹³⁸ The discussion in the book, which was published prior to the 1908 Revision of the Convention, is based on the original text (1886). He notes:

These qualifications [in the Final Protocol] proceeded from a desire to safeguard vested interests. In the absence of international protection foreign works had at one time been universally looked upon as lawful objects for native reproduction, either in their original form, or by adaptation or translation. Capital had been sunk, labour had been employed in making these valuable reproductions; lawful interests had been thereby created, and a quasi-property had thus been acquired. A State which had tolerated the indiscriminate reproduction of foreign works would hardly be justified in giving an unqualified consent to the principle of retroactivity, without making due provision for the securing of this quasi-property. Hence the rule of Art. 14 was not made absolute, and it was left to each country to regulate by particular agreement or by domestic law the mode in which it should be applied.¹³⁹

Briggs also noted that when the United Kingdom implemented the original text of the Convention,¹⁴⁰ the implementing legislation provided that “nothing in this section [of the International Copyright Act of 1886] shall diminish or prejudice any rights or interests arising from or in connection with [the production of any work in the United Kingdom prior to the entry into force of the Act] which are subsisting

137. PAUL GOLDSTEIN, *INTERNATIONAL COPYRIGHT: PRINCIPLES, LAW, AND PRACTICE* 245 (2001).

138. BRIGGS, *supra* note 55.

139. *Id.* at 265. Briggs also notes that a proposal by Belgium and France to remove the flexibility contained in the Final Protocol at the 1896 Revision Conference was defeated. *Id.* at 266.

140. The UK was one of the first Berne member countries. It joined as of December 5, 1887. See WIPO - Administered Treaties, http://www.wipo.int/treaties/en/ShowResults.jsp?treaty_id=15 (last visited Feb. 6, 2010).

and valuable.”¹⁴¹ He refers to a case in which the court would have been prepared to let a reliance parties produce fresh copies of a work even after the application of the act if “he had not himself recouped for his outlay.”¹⁴²

2.Karp Study

A complete study of the application of Article 18 in the United States was prepared by Irwin Karp.¹⁴³ He noted, first, that because most European countries adhered to the Convention in the late 19th or early 20th century, the issue of retroactive protection has all but disappeared from policy radars in those jurisdictions.¹⁴⁴ In addition, very few of them had registration systems.¹⁴⁵ Then, citing the opinion of “many United States and most foreign copyright experts,” Karp concluded that while the United States had “considerable leeway in fashioning the conditions of retroactivity,” it did not have enough leeway to “deny any degree of retroactivity,” because then the principle is not applied at all.¹⁴⁶ Conversely, any set of conditions beyond complete absence would be “conditions” on the application of the principle.¹⁴⁷ Additionally, the fact that there is no express limitation on the flexibility contained in Article 18(3) of the Convention supports the view that an international dispute-settlement body would be unlikely to read into Article 18(3) limitations that it does not expressly contain.

3.Bogsch Study

Former WIPO Director General Arpad Bogsch published his views on Article 18 during the debates on the United States accession to the Berne Convention.¹⁴⁸ In this letter to the Commissioner of Patents and Trademarks, Dr. Bogsch notes, in agreement with the above, that the “principle” referred to Article 18(3) is the one described in Articles 18(1) and (2).¹⁴⁹ He argues that while a country can impose

141. BRIGGS, *supra* note 55, at 268.

142. *Id.* at 268-69. The case is *Hanfstaengl v. Holloway*, (1893), 2 Q.B. 1 (Eng.). It was mentioned at the first Conference (1884) that the protection of reliance parties that a country could impose was not limited to copies in existence at the time of application of the Convention but extended to copies “in the process of being completed.” CENTENARY, *supra* note 1, at 92.

143. Irwin Karp, *Final Report, Article 18 Study on Retroactive United States Copyright Protection for Berne and Other Works*, 20 COLUM.-VLA J.L.& ARTS 157 (1996).

144. *Id.* at 167.

145. *See id.*

146. *Id.* at 172.

147. *See* MIHÁLY FICSOR *supra* note 81.

148. Arpad Bogsch, *WIPO Views of Article 18*, 43 J. COPYRIGHT SOC.'Y U.S.A. 181, 181 (1995).

149. *See id.* at 190.

conditions on the application of the principle, the principle must be applied in some way, thus negating the possibility of a complete absence of retroactivity.¹⁵⁰ He also argues that Article 18(3) only allows *transitional* measures and cites a comment to that effect in the negotiating history.¹⁵¹

Even if one accepts this postulate, Article 18(3) conditions are by definition transitional in that their purpose is to ensure the transition from non-Berne status to Berne status.¹⁵² Transitional does not necessarily mean short-lived. In fact, Dr. Bogsch quotes a diplomatic conference record showing that a proposal that would have limited the power of a country joining the Berne Union to *decide* within two years whether to impose conditions and then which measures to take was rejected.¹⁵³ Still, without any direct authority to support this view, Dr Bogsch refers to a “quite general agreement” that measures taken under Article 18(3) should not be applied for a period of more than two years.¹⁵⁴ I found no authority to support this conclusion. In fact, the only precedent mentioned in that connection in Dr Bogsch’s letter is Art. 13(2) of the Berne Convention (1971) which specifically mentions a two-year window and a proposal to enshrine a two-year window in the Convention was expressly rejected.¹⁵⁵ Additionally, Article 13(2) works against the point made by Dr Bogsch: if Convention negotiators specifically thought of mentioning the two-year pe-

150. *See id.*

151. *Id.*

152. A “transition” as defined in the Websters Encyclopedic Unabridged Dictionary of the English Language is a “passing from one condition, form, stage, activity, place, etc. to another.” MCKENCHIE ET AL., WEBSTER’S NEW UNIVERSAL UNABRIDGED DICTIONARY 1939 (1979). Even if not limited in time by the restoration statute, it will not be permanent—that is, it will be “temporary”—because it applies to works used by reliance parties at the time of entry into force which either they will stop using or will (in their restored capacity) fall into the public domain, which then makes the transition protection unnecessary.

153. Arpad Bogsch, *WIPO Views of Article 18*, 43 J. COPYRIGHT SOC.’Y U.S.A 181, 191 (1995).

154. *Id.* at 192.

155. At the 1896 Conference, the Records are quite clear, though normatively there was support for the two-year proposal:

To this end it had been proposed stating that ‘countries which have not taken measures within a period of two years will be deemed to have purely and simply accepted the principle of retroactivity.’ ...Nevertheless, doubts arose. It was feared that a fixed time limit might be considered awkward and might dissuade certain States, whose accession to the Union was considered particularly desirable, from doing so. The vast majority of the Committee did not share these fears; however, it did not want to carry on regardless and not take account of the scruples of one of its members.

Id. at 191.

riod in Article 13(2), why not in Article 18(3)?¹⁵⁶ In fact, as noted above, negotiators had the option before them and decided not to take it.¹⁵⁷ I conclude that while the two-year window may well be a valid implementation of Article 18, that term of protection of reliance parties is not mandated by the article or its negotiating history.

D.Application in the United States

The United States has worked hard of late to become the international copyright valedictorian, even though it was considered a pirate nation by many Berne Union members as late as 1914 when a special retaliatory protocol was adopted by the Union to allow them to deny protection to works of U.S. authors even if first published in a Berne country.¹⁵⁸ It could have applied a very limited form of retroactive protection, thus avoiding any trampling of the rights of third (“reliance”) parties—in fact the U.S. did so by not providing for retroactive application when it initially joined Berne.¹⁵⁹ However, Congress quickly changed tracks and opted, first, for restoration of Canadian and Mexican copyrights by adopting section 104A of the Copyright Act.¹⁶⁰ It then decided approximately a year later to severely restrict the rights of reliance parties by extending retroactive protection to all Berne works.¹⁶¹

The United States Congress recognized this degree of flexibility when it joined Berne.¹⁶² The record shows that some in Congress had noted the “sweeping discretion” contained in Article 18(3), even wondering whether there was any form obligation in Article 18 (beyond a statement of principle) to restore protection.¹⁶³ Indeed, the record shows that Article 18 was not the culprit. Nor was the Constitu-

156. Berne Convention (1971), *supra* note 1, at art.13(2) (“Recordings of musical works made in a country of the Union in accordance with Article 13(3) of the Conventions signed at Rome on June 2, 1928, and at Brussels on June 26, 1948, may be reproduced in that country without the permission of the author of the musical work until a date two years after that country becomes bound by this Act.”).

157. BOGSCH, *supra* note 152, at 191.

158. See *supra* note 67 and accompanying text.

159. Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853, 2860 (1988).

160. In Application of the North American Free Trade Agreement, U.S.-Can.-Mex., ch. 17, Oct. 7, 1992, 32 I.L.M. 296, 670.

161. See Uruguay Round Agreements Act, Pub. L. No. 103-465, 108 Stat. 4809, 4976 (1994).

162. H.R. REP. NO. 100-609, *supra* note 166 (The “sweeping discretion” contained in Article 18(3) was noted and members wondered whether there was any form obligation in Article 18 (beyond a statement of principle) to restore protection).

163. H.R. REP. NO. 100-609, pt. 5F, at 51-52 (1987).

tion used as a guiding light.¹⁶⁴ The United States reconsidered its stance on retroactive protection ostensibly because it wanted to address trade concerns and obtain retroactive protection of U.S. works from certain trading partners.¹⁶⁵

CONCLUSION

The international contextualization of the adoption of the 1909 Act sheds a different light both on the exceptionalism prevalent in the U.S. Congress and on the views of major trading partners of the United States.

After 1908, the degree of parallelism between the Convention and United States law increased. The same rights were added, formalities were reduced and the application in time of the Berne Convention was applied much more strictly than required under the Convention rules. However, the lax protection of foreign works applied until the 1980s and the quick transition to a maximalist approach were not caused by perceived obligations under Berne. The realpolitik catalyst was the linkage between trade and intellectual property, and the perceived comparative advantage of the United States in generating and protecting as much as possible valuable innovation and creativity in the form of intellectual property rights.¹⁶⁶

164. KARP, *supra* note 147, at 172 (“Congress paid little, if any, attention, to the Constitutional issues under the First and Fifth Amendment and the Copyright Clause.”).

165. *See id.*; *see also* *General Agreement on Tariffs and Trade (GATT): Intellectual Property Provisions: J. Hearing on H.R. 4894 and S. 2368 Before the Subcomm. on Intellectual Property and Judicial Administration of the H. Comm. on the Judiciary and the Subcomm. on Patents, Copyrights and Trademarks of the S. Comm. on the Judiciary*, 103d Cong. 246-52 (1994).

166. This had profound impacts on the political importance of intellectual property protection and the adoption of stringent legislation, including extremely high statutory damages (*see* 17 U.S.C. §504(c)) and publicly funded enforcement (*see* Prioritizing Resources and Organization for Intellectual Property Act of 2008, Pub. L. No. 110-403, 122 Stat. 4256). But it also affects the nature of the rights concerned by moving them away from a propertization narrative (*see generally* WILLIAM PATRY, *MORAL PANICS AND THE COPYRIGHT WARS* (Oxford Univ. Press 2009)) and towards a regime under which infringement rules are tied to actual damages. *See* Daniel Gervais, *(Re)implementing the Agreement on Trade-Related Aspects of Intellectual Property Rights to Foster Innovation*, 12: 5, J. WORLD INTELL. PROP. 348, 350-51 (2009).