CHAPTER I

THE DEVELOPMENT OF INTERNATIONAL COPYRIGHT NORMS : EVOLUTION OF THE BERNE CONVENTION AND THE IMPACT OF NEW TECHNOLOGIES ON ITS STANDARDS [5]

History of the private international law of copyright ; development and standards of the international treaties through an analysis of the Berne Convention as the leading international instrument for the protection of authors ; application of Berne Convention standards to new technological modes of exploitation and communication of works of authorship [6].

The invention of the printing press in 1436 made possible the rapid production of multiple copies ; this in turn spawned both the authorized, and unauthorized, publication of works of authorship [7]. Early printers published works of classical Roman authors, as, if not more, often as they disseminated works of contemporary authors [8]. The original pressure for copyright protection thus came not from the authors but from the booksellers [9], whose pecuniary interest in a

5. Grateful acknowledgment to Eleonore Dailly, Columbia Law School, LLM, 1998, for assistance in the preparation of this chapter.

6. I have chosen to focus on the development and standards of the Berne Convention as it has historically proven to be the most significant legal instrument for the international protection of copyright. I will thus not address issues related to the Universal Copyright Convention, signed in 1952 and joined by a majority of the Berne Union members, as well as by a significant number of non-Berne countries, including the United States, because it provided a lower level of protection than the Berne Convention.

7. For a fuller review of the effects of the printing press on copying and publishing, see, e.g., William Briggs, *The Law of International Copyright* 27-28 (1906), S. Stewart, *International Copyright and Neighboring Rights* 15 (1983). On the relationship of the printing press to piracy, see, e.g., Adelstein and Peretz, "The Competition of Technologies in Markets for Ideas : Copyright and Fair Use in an Evolutionary Perspective", 5 *Int. Rev. L. & Econ.* 209, 224 (1985).

8. See, e.g., Elizabeth Eisenstein, *The Printing Press as an Agent of Social Change : Communications and Cultural Transformations in Early Modern Europe* (1979) ; Lucien Febvre and Henri-Jean Martin, *L'apparition du livre* (1971).

9. See, e.g., Feather, "Authors, Publishers and Politicians : The History of Copyright and the Book Trade", 12 *Eur. Int. Prop. Rev.* 377 (1988). The term "bookseller" was synonymous with printer or bookbinder during this period, E. Ploman and L. Hamilton, *Copyright : Intellectual Property in the Information Age* 9 (1980).

published work pirate copies most threatened. They succeeded in obtaining from their respective sovereigns protection in the form of a "privilege" or exclusive right to print and sell a specific author's manuscript for a limited time [10]. The privileges often combined economic monopoly with political censorship : no privilege would issue unless the work earned the sovereign's "approbation" [11]. The system of privileges, moreover, was strictly territorial. Foreign sovereigns having no obligation to honour the privileges accorded by other sovereigns, some localities, notably the Netherlands and Switzerland, became havens for the production and dissemination of pirate editions [12].

The adoption of statutory copyright régimes, in England (1710), the United States (1790), France (1791 and 1793), and the rest of the European continent, vested copyright ownership in authors, but retained the territorial nature of the right, at least with respect to published works [13]. This meant that a work was freely copiable once it crossed an international boundary. To secure protection in countries of which the author was not a national, the author was obliged to effect "first publication" in that country. This in turn led to complicated arrangements to secure simultaneous first publication in several countries [14]. But these arrangements were cumbersome, costly, and not always successful. As the level of worldwide literary and

10. Ploman and Hamilton, *supra* footnote 9, at 9.

11. French books of the seventeenth and eighteenth centuries, for example, routinely bear the mention "avec approbation et privilège du roi". On "privilèges en librairie", see, e.g., Raymond Birn, "The Profits of Ideas : *Privilèges en librairie* in Eighteenth-Century France", *Eighteenth-Century Studies,* 1977, p. 131 ; Marie-Claude Dock, "Privilèges et contrefaçon", XLII *Rev. int. dr. aut.* (hereinafter *RIDA*) 91 (1964) ; H. Falk, *Les privilèges de librairie sous l'Ancien Régime,* Th., Paris 1906 ; Marcel Henrion, "Appoint à l'étude des privilèges de librairies aux XVI^{e} et XVII^{e} siècles", VI *RIDA* 113 (1955) ; Laboulaye et Guiffrey, *La propriété littéraire au XVIII^{e} siècle,* Paris, 1859 ; Malapert, *Histoire abrégée de la législation sur la propriété littéraire avant 1789,* Paris, 1881.

12. See, e.g., Robert Darnton, "The Life Cycle of a Book : The Publishing History of d'Holbach's *Système de la Nature*", *in* Carol Armbruster, ed., *Publishing and Readership in Revolutionary France and America* 15 (1993) (describing publishing activities of "pirate" Swiss press, the Société typographique de Neuchâtel).

13. The US copyright act protects unpublished works, regardless of the author's nationality, see 17 USC, § 104 (1994) ; this appears to codify a common law tradition, see William S. Strauss, "Study 29 : Protection of Unpublished Works", in *Studies Prepared for the Senate Subcomm. on Pat., Trademark, & Copyright of the Comm. on the Judiciary, 86th Cong.,* Comm., Print, 1961.

14. The composer Chopin, for example, endeavoured to protect his works by obtaining simultaneous publication in France, England and Germany.

artistic activity exploded throughout the nineteenth century, and improvements in printing technology rendered works of authorship even more vulnerable to piracy, the need for international copyright protection became correspondingly acute. Authors from different countries attempted to pressure Governments into securing copyright protection on an international scale [15] and more and more countries entered into bilateral copyright protection treaties [16].

A. Early International Copyright Protection

Before the adoption of the Berne Convention in 1886, if Western countries protected foreign works at all, they usually did so on the basis of reciprocity treaties and bilateral agreements. The first international copyright treaties were based on a system of material reciprocity [17]. Reciprocity refers to an agreement between two States by which each of them grants the other's citizen's privileges, on the condition that the exchange of privileges is mutual [18]. Of course, not all Western countries did protect foreign works : the United States is the most notable example of a country that adopted piracy as its international copyright policy. This strategy may have made economic sense throughout the nineteenth century, when the United States was a net importer of copyrighted works. As an example of techniques employed by a country that did elect to protect foreign works, we will consider French international copyright measures.

France first entered into a complex network of treaties, as shown in the chart below [19].

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15. See, e.g., Hamish Sandison, "The Berne Convention and the Universal Copyright Convention : The American Experience", 11 *Colum.-VLA JL & Arts* 89 (1986) (recounting the efforts of Dickens, Trollope and Twain to obtain protection in the United States for English works) ; Ploman and Hamilton, *supra* footnote 9, at 19 (increase throughout the nineteenth century in authors' demands for protection from international piracy).

16. See Sam Ricketson, *The Berne Convention for the Protection of Literary and Artistic Works : 1886-1986* 39 (1987) ; George P. Putnam, "Literary Property : An Historical Sketch", in *The Question of Copyright* 329, 375 (G. Putnam, ed., 1904) (discussing the evolution of international reciprocity treaties).

17. See S. Ladas, *The International Protection of Literary and Artistic Property* 24 (1938). For a country by country description of reciprocity, see Ploman and Hamilton, *supra* footnote 9, at 19.

18. *Black's Law Dictionary* 1270, 6th ed., 1990 ; Marian Nash Leich, "U.S. Practice : Contemporary Practice of the United States Relating to International Law", 83 *Am. J. Int'l. L.* 63, 65 (defining reciprocity).

19. The chart is reproduced, with permission, from Ricketson, *supra* footnote 16, at 38.

This network ultimately proved unsatisfactory, not only because some countries refused to enter into reciprocity treaties, but because some treaty partners failed to abide by the treaties' terms. For example France did not persuade Belgium and Holland, two centres for pirated French works, to enter into a copyright reciprocity treaty [20]. France therefore retreated from the reciprocity strategy and, in 1852, Louis Napoleon promulgated a decree making counterfeiting of any works, foreign or domestic, a crime in France [21].

The French decree of 1852 instituted a system of national treatment for the protection of foreign authors [22]. Under national treatment, as opposed to a reciprocity system, country A grants authors from country B the same protection that country A grants its own authors [23]. It is important to note that a reciprocity element can still govern the application of a convention based on national treatment. For example, country A may give country B's authors the same protection which A's authors receive in country A, conditioned upon the existence of some protection for country A's authors in country B [24]. In its decree however, France adopted a universal approach to copyright protection and granted protection to all foreign authors, whether or not French authors were granted protection in the foreign country from which those authors came [25]. A national treatment system is much easier to administer than a reciprocity system because courts need only interpret their own domestic copyright law [26].

1. The adoption of the Berne Convention

Following the promulgation of the French decree, a trend emerged in Europe for greater protection of the rights of authors. Six years later, in 1858, the first international Congress of Authors and Artists

20. See Ploman and Hamilton, *supra* footnote 9, at 20.
21. See *id*.
22. Some critics believe that the decree was a landmark advancement towards international copyright protection. See *id.*
23. See S. Stewart, *supra* footnote 7, at 38.
24. See W. Briggs, *supra* footnote 7, at 121. As we will see later, this is essentially the approach of the Berne Convention, which in Article 5 of the Paris text of 1971 enunciates the national treatment approach, but requires first publication in a Unionist country in order to receive the Berne Convention's protection.
25. See *id.* at 135.
26. See S. Stewart, *supra* footnote 7, at 41.

met in Brussels[27]. The resolutions the Congress passed laid the groundwork for the writing and drafting of the Berne Convention[28]. A new literary association, initially comprised only of authors and presided over by Victor Hugo, convened in 1878 and adopted five resolutions that eventually became the foundation of the original Berne Convention of 1886. In 1882, the association, later named L'Association littéraire et artistique internationale (ALAI)[29], concluded that the only way to achieve its goal of increased international copyright protection would be to form a Union for the protection of literary property. In 1883, all parties interested in creating such a Union met in Berne and prepared a draft treaty consisting of ten articles, the most important of which provided for national treatment and the absence of formalities as a prerequisite for copyright protection.

Eleven nations met in Berne in 1884, responding to an invitation of the Swiss Government to form an international copyright Union. One significant policy issue arose before a discussion of the draft commenced: the German delegation, in a diplomatic questionnaire, asked whether it might be better to abandon the national treatment principle in favour of a treaty that would codify the international law of copyright and establish a uniform law among all contracting States. Although most participating countries viewed the proposition as a desirable one, they voted against it because it would have required great modifications of their domestic laws, which many countries could not implement all at once. Thus, rejecting a treaty

27. See S. Stewart, *supra* footnote 7, at 41.

28. See S. Ladas, *supra* footnote 7, at 72. The Congress of Authors and Artists met three times (1858, 1861, and 1877) and each time adopted resolutions asking Governments to join together in passing legislation for the international protection of authors. The resolutions they passed in 1858 were:

> "That the principle of international recognition of copyright in favour of authors must be made part of the legislation of all civilized countries."
>
> "This principle must be admitted regardless of reciprocity."
>
> "The assimilation of foreign to national authors [national treatment] must be absolute and complete."
>
> "Foreign authors should not be required to comply with any particular formalities for the recognition and protection of their rights, provided they have complied with the formalities required in the country where publication first took place."
>
> "It is desirable that all countries adopt uniform legislation for the protection of literary and artistic works." *Id.*

See also Ricketson, *supra* footnote 16, at 42-43.

29. See Ricketson, *supra* footnote 16, at 48.

that would institute a uniform law of international copyright, the fourteen participating nations chose to retain the national treatment approach.

The German proposition was nevertheless critical in that it revealed the differing copyright philosophies of the participants: while one group favoured a codified and uniform law of international copyright, another wanted as little unification and as much national independence as possible[30]. These differing philosophical positions became manifest in the ensuing discussions of the substantive provisions of the Berne Convention. For example, countries that favoured a universal law argued that the Convention should protect all authors who published in a Union State regardless of nationality[31].

When the 1884 Conference began, an eighteen article draft awaited the participants. The draft contained all of the basic principles adopted at the 1883 conference: national treatment, abolition of formalities as a prerequisite for copyright protection, recognition of a translation right during the entire term of the copyright and the establishment of an International Bureau of the Union[32]. However, in light of the differing philosophies of international copyright protection, the 1884 draft was changed to protect only authors who were nationals of Union countries and publishers of works published in the Union. In general, in comparison to the pro-author draft adopted at the 1883 Conference, the final draft of 1884 moved away

30. Professor Sam Ricketson divides the differences in ideology into two groups: the universalist, and the pragmatic view. While the universalists wished for a uniform law of copyright to be adopted either through a multilateral convention or through each country's adoption of uniform, general laws applicable to both nationals and foreigners alike, the pragmatists criticized them as unrealistic and utopian. The pragmatists argued that true universality would be impossible in the absence of agreement on the fundamental nature of authors' rights (whether grounded in moral or economic rights). The pragmatists thus focused on the need for compromise and advocated the adoption of a minimal universality to which the largest number possible could adhere. Ricketson underscores that the tension between these conflicting viewpoints strongly influenced the initial and subsequent development of the Berne Convention. The universalists have been responsible for the steady increase in measures to such an extent that the Berne Convention is sometimes viewed as an international code of copyright. On the other hand, the "modifying influence" of the pragmatists has ensured that these changes enjoyed the widest possible support; as a result, these measures often emerged in somewhat diluted form. See *id.* at 39-41.

31. The universalist countries generally included France, Switzerland and Belgium. See *Berne Convention* 90-92 (WIPO ed., 1986) (recording comments and positions of these countries).

32. See *id.* at 83-86.

from the idea of a comprehensive uniform international law of copyright [33].

The draft introduced by the 1885 Conference was even less protective and less universal in scope than the 1884 version. The participants decided to forgo the adoption of universally binding legislation and instead to leave to the individual countries decisions as to the nature and the scope of copyright protection for foreign authors [34]. The underlying rationale was that a flexible international law would permit more countries to accede to the Union, thus increasing membership [35].

The adoption of a comprehensive and universal copyright law was thus sacrificed for a narrower body of rules accepted by a wide array of countries.

In order to further this goal of greater adherence, a number of provisions were amended and replaced by references to national law for provisions that previously constituted the beginning of a uniform codification of international copyright law [36].

This draft was then ratified and signed at the 1886 Conference, which was less a conference than a signing party. Although the Convention did not achieve every goal outlined at the first Congress of 1858, it represented a major step towards international copyright protection. More significantly, despite the diverging philosophies of the participating countries, the 1886 Berne text laid the groundwork for later evolution toward the more universalist ideal expressed in earlier drafts.

2. The 1886 Berne Convention and its successors

The basic structure of the Berne Convention has remained relatively unchanged throughout each of the five revisions. It contains

33. For example, the participants granted each contracting State the right to establish conditions under which works could be freely reproduced in certain types of publications (i.e. scientific ones) and recognized the translation right for ten years only. See Ladas, *supra* footnote 17, at 79.

34. See "Records of the Second International Conference for the Protection of Literary and Artistic Works" in *Berne Convention, supra* footnote 32, at 108.

35. See Ladas, *supra* footnote 17, at 80-81.

36. Among the amended provisions were those concerning translation rights, adaptations, the right of presentation of dramatic and dramatico-musical works, the protection of photographs and choreographic works, and the reproduction of works and in selections intended for instruction and the reproduction of articles of newspapers and periodicals. See Ladas, *supra* footnote 17, at 81.

both substantive minimum standards of protection, as well as a general directive to accord Unionist authors national treatment. Each subsequent revision of the Berne Convention, from 1896 to 1996, has adopted more substantive minimum standards to which Union members must adhere, while retaining a key "pragmatic" feature: the Berne minima apply to a Union member's protection of works from *other* Berne members; no Berne member is obliged to accord its *own* authors treaty-level protection[37].

The original Convention provided an explicit, but not exclusive, list of works to be protected[38]. The Convention also defined the conditions for protection, known as points of attachment, and also specified rules governing the term of protection[39]. Subsequent conferences have amended each of these provisions in order to increase the scope of authors' rights. Among the minimum standards that all member countries were required to recognize, the original Berne Convention first established the translation right[40]; more exclusive rights were added over the course of subsequent revisions[41]. The adoption by members of the World Trade Organization of the agreement on Trade-Related Aspects of Intellectual Property (TRIPs)[42] has further extended the Berne Convention standards to countries beyond the Berne Union who are members of the World Trade Organization[43].

We will consider the Berne minima in more detail at later points in the analysis.

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37. See Berne Convention for the Protection of Literary and Artistic Works (1971 text), 1161 *UNTS* 3, Arts. 5 (1), 5 (3) (hereinafter Berne Conv.).

38. See Berne Convention (1886 text), Art. 4, in *Berne Convention*, *supra* footnote 31.

39. See *id.*, Arts. 2 and 3.

40. See *id.*, Art. 5.

41. For example the exclusive recording right of musical works and the right of authors to authorize the reproduction and public performance of their work by means of a cinematograph were introduced by the Berlin Revision of 1908 (Art. 13 and Art. 14), the moral right to claim paternity of a work and the right to "object to any deformation, mutilation or other modification" of the work as well as the broadcasting right were introduced at the Rome Revision Conference of 1928 (Arts. 6*bis* and 11*bis*), and the droit de suite was added at the Brussels Revision of 1948 (Art. 14*bis*, para. 1). See *Berne Convention*, *supra* footnote 31.

42. Agreement on Trade-Related Aspects of Intellectual Property Rights, including Trade in Counterfeit Goods, 15 April 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, Legal Instrument — Results of the Uruguay Round, Vol. 321, 33 *ILM* 81 (1994).

43. TRIPs does not, however, incorporate Article 6*bis* of the Berne Convention (moral rights). See TRIPs, Art. 9 (1).

B. Berne Convention Points of Attachment and the Impact of New Technologies

The Berne Convention offers expansive criteria for eligibility for protection under the treaty. There are two principal points of attachment: (1) the author is a national or resident of a Berne member nation, or (2) the country of first or "simultaneous" publication (within 30 days of actual first publication) is a Berne member[44]. The Convention thus adopted, while facilitating, the nineteenth-century technique of securing multinational protection through simultaneous "first" publication in the major markets for the work[45]. The Convention also promoted manipulation of points of attachment, in order to enhance the opportunities for authors to be covered under the Convention. Thus, authors from non-Unionist countries could still obtain the Convention's protection so long as they published the work in a Berne country within 30 days of actual first publication[46]. This made it possible, for example, during the long period that the United States remained outside the Berne Union[47], for US works nonetheless to claim Berne nationality through "simultaneous" publication in Canada.

Manipulating the point of attachment was nonetheless not an avenue available to all non-Unionist authors, at least not to those who could not afford to take up residence in a Berne country, or who could not afford simultaneous publication in a Berne country. The Internet, however, may vastly facilitate access to points of attachment, since it appears that posting a work on the Internet may well effect simultaneous publication in all countries where users have Internet access. I reach this conclusion based on the Berne Convention's definition of "published works", set forth in Article 3 (3), which provides that a work will be considered "published" if copies are made available to the public in a manner that satisfies its

44. Berne Convention, *supra* footnote 37, Art. 3.

45. It has also been argued that the use of the notion of publication as a point of attachment of the Berne Convention was meant to serve the interests of the publishers of the Union as authors of non-Unionist countries had no choice but to first publish through them if they wished for their work to be protected under the Convention. See A. Tournier, "La Notion Périmée de publication dans la Convention de Berne", XXXIX-XL *RIDA* 3 (1964).

46. Although the notion of simultaneous publication existed in the 1886 text of the Berne Convention, it was not defined until the Brussels Revision of 1948, when a Finnish proposal for the 30-day grace period was adopted. See Ricketson, *supra* footnote 16, at 193.

47. The United States sent a representative to the 1886 Conference, but did not join the Berne Union until 1989. See *id.* at 922-923.

reasonable needs. A public performance or display do not constitute a publication[48].

1. "Publication" over digital networks

If one interprets "copies" to include temporary reproductions in RAM (a computer's temporary memory), then posting a work on a website makes "copies" available to anyone who accesses the website[49]. Even if one interprets "copies" under Article 3 (3) to mean more permanent embodiments, making a work available on a website might still constitute publication because the downloading public can store the work to a more permanent format, such as hard disk, floppy disk, or printout. This, in turn, would mean that "simultaneous" publication occurs in every country of the world in which there is Internet access. Since over one hundred of these are Berne Union members[50], a work first disclosed on the Internet should automatically qualify for coverage by the Berne Convention, regardless of the nationality of its author.

The second prong of the definition of the act of "publication", the requirement that the copies be "made available to the public in a manner that satisfies its reasonable needs", is also of paramount importance in light of digital transmissions. The Internet culminates the passage from a model of communication of works to a public of passive recipients of a distribution or performance to a model where networks offer primarily interactive consultation of works at the initiative of that very same public[51]. Issues related to the effective-

48. Historically, the exclusion of ephemeral modes of communication from the scope of the notion of publication was explained by evidentiary reasons. It was argued that it would be difficult to assess in which country the first public performance of a work had actually occurred. It has also been argued that as a matter of policy, if access to the protection of the Convention were made too easy for non-Union authors through a broader definition of "publication", there would be no incentive for States to join the Union. For an assessment of these various arguments, see Ricketson, *supra* footnote 16, at 191-192.

49. See, e.g., 17 USC, § 117 (1994), *MAI* v. *Peak*, 991 F. 2d 511 (9th Cir. 1993); Council Directive 91/250 1991 OJ (L. 122) 42, Art. 5; Mihály Ficsor, "Copyright for the Digital Era: The WIPO "Internet" Treaties", 21 *Colum.-VLA JL & Arts* 197, 203-207 (1997).

50. As of June 1998, 131 States were parties to the Berne Convention. See "Contracting Parties of Treaties Administered by WIPO, Berne Convention", <http://www.wipo.org/eng/ratific/e-berne.htm> (visited 13 October 1998).

51. For an illustration of the new environment of communication created by the development of the Internet, see Pierre Trudel, "Quel droit pour le cyberespace?", *Légipresse*, March 1996, n. 129, II, at 10.

ness of the act of "making the works available to the public" and to what constitutes a reasonable quantum to satisfy the needs of such public, previously raised by the advent of cinematographic works [52], assume a new meaning in the digital world as intermediaries are suppressed and access becomes immediate, individual and instantaneous. In effect, the posting of any work on a website can fulfil the "reasonable needs" requirements of publication, and thus qualify the work for the protection of the Berne Convention. But if online availability constitutes "publication", what is/are the concrete point(s) of attachment? Where does publication occur when the work is posted on a website? In the country from which the author posted the work? In the country where the website host server is located? In the country where the user downloads the work? All of these? Determining the situs of publication over digital networks may well call for a clear choice to be made between the multiple points of attachment generated by digital dissemination.

The significance of the concept of "publication" and of specifying the point(s) of attachment is not limited to determining whether a work will be protected by the Berne Convention. "Publication" is also key to the treaty concept of "country of origin", which, as we shall see, will be relevant to certain issues concerning the international protection of works of authorship. We will therefore next consider the Berne Convention concept of "country of origin" and its consequences, before turning to substantive minima imposed by the convention, and the impact upon these minima of new technologies.

2. "Country of origin" and the impact of Internet "publication"

The impact of Internet publication on the Berne Convention's expansive characterization of "country of origin" is especially relevant in two contexts: domestic works, and duration of protection. First, recall that the Berne Convention explicitly excuses Union

52. The fulfilment of the publication requirements in the context of cinematographic works generated much debate around their mode of distribution and as to what constituted reasonable quantum in those circumstances. Was the communication to the distributor of a copy enough or was it necessary to get to the exhibitor stage for publication of the film to occur? As the wording of the definition seems to indicate that it is the availability that matters, commentators had resolved the ambiguity in favour of communication to the exhibitor stage. See Ricketson, *supra* footnote 16, at 184; S. Durrande, "La notion de publication dans les conventions internationales", 111 *RIDA* 73, 106 (1982).

members from according Berne-level protection to its members' *domestic* works of authorship[53]. A Union member meets its Berne obligations if it accords protection consonant with Convention minima to *foreign* Berne-Union works. Arguably, with simultaneous universal publication via the Internet, every work of authorship could be considered a domestic work in each country of the Berne Union. In that event, ironically, Berne Convention minimum standards of protection might never apply, because there will be no foreign works.

Alternatively, one might apply Article 5 (4) of the Convention to conclude that, despite the multiple countries of first publication, the "country of origin" is the country whose term of protection is the shortest. As we shall see, this too, however, creates problems. The problems arise from the Article 7 (8) "rule of the shorter term". According to this rule, if the term in the country of origin is shorter than that of the country of protection, then the country of origin's term applies, rather than term of the country of protection. But if one must apply the Article 5 (4) rule that, in the case of multiple countries of first publication, the "country of origin" is the country whose term is the shortest, then all works will have the shortest term.

These anomalies suggest that the notion of Internet "publication" should be limited to a single Berne Union country : but which one ? One might designate as the country of first publication the country from which the author communicated the work to the server, but this characterization has some disadvantages. First, that country may have little relationship to the work, since the author may upload the work from a modem-equipped computer anywhere in the world (including from countries through which the author is merely travelling). Second, the work is not yet available to the public until it arrives at its place of residence on the website that members of the public will access. This in turn suggests that the country of first publication is the one from which the work first becomes available to the public ; that is, the country in which it is possible to localize the website through which members of the public (wherever located) access the work. This choice, however, is not problem-free, either. Unlike countries of traditional, physical first publication, in which authors or publishers consciously organize the economic centre of the exploitation of their work, the country in which the server that

53. Berne Convention, Arts. 5 (1), 5 (3).

hosts the website is located may be completely indifferent to the author. Moreover, the uploading or downloading web-user may not even be aware of the location of the website or its host server. Not only is the criterion of the physical location of the webserver irrelevant, but the location of the effective business establishment of the website operator may be insignificant to an author's selection of that site to disseminate the work. That is, if the conditions of publication are the same whatever the geographic location of the website operator's business establishment, then that country's relationship to the publication would seem purely fortuitous. Where, by contrast, there is a relationship between the conditions of publishing on a particular website, and the place of the business establishment of the website, then selecting that website implies the same kind of determination as authors make in conventional publishing ; the country of "first publication" should in that instance be the country in which the website operator has its effective establishment.

Where that kind of link is lacking, the country of the website's business establishment might still supply the place of first publication if the author is also a resident of that country, or has some other significant contact with that country. In effect, to determine the place of first publication, we are seeking the country that has the most significant relationship to the act of making the work available to the public for downloading [54].

Alternatively, given the possible difficulty of discerning what country that may be, one might look to the country of the author's residence (or, in the case of a plurality of authors, the country in which the greatest number of co-authors reside). This criterion, however, is not currently present in the Berne Convention ; the 1971 text offers only the country of the author's nationality as a point of attachment [55]. Nonetheless, while interpolating this point of attachment may require adding to the text, rather than simply interpreting it, the author's residence may in many instances supply a point of attachment with a more significant relationship to the exploitation of the work than might more traditional criteria in a digital world. Indeed, as we will see in later chapters concerning choice of forum

54. Cf. 17 USC, § 104 A *(h)* (C) (ii) (when the work has been simultaneously published in two or more countries, the "source country" is the country "with the most significant contacts with the work").

55. See Berne Convention, Art. 5 (4) (the Convention does, however, include the "habitual residence" of the "maker" of a cinematographic work).

and choice of law, the author's residence has an increasingly strong claim both as the place in which multi-territorial copyright infringement disputes should be litigated, and as the country whose law should apply to rule on those disputes.

3. Substantive minima and the impact of new technologies

(a) *Subject matter of copyright*

The Berne Convention protects "literary and artistic works", but it does not instruct member countries how to define these categories. Article 2 (1) lists illustrations of literary and artistic works, but the text does not reveal — beyond stating that the list is not exclusive — how to evaluate a non-listed endeavour. It would therefore be possible for a member country to determine not only that particular kinds of works should be excluded from domestic copyright protection, but that these kind of works, if not listed in the treaty, do not come within the Berne minima of protection. For example, a member State might assert that the utilitarian characteristics of computer programs make them inherently different from traditional literary and artistic works, and that computer programs therefore fall outside the scope of copyright[56]. Or a member State, pointing to Article 2 (5)'s designation of "collections of literary or artistic works", might infer that collections of facts, or other data not constituting a "work", are excluded from mandatory coverage; that state might therefore conclude that it is free to deny protection to compilations of information and databases.

The Agreement on Trade-Related Aspects of Intellectual Property (TRIPs), in its Article 10 (1), however, limits Berne and other World Trade Organization members' freedom to define the subject matter of copyright. That treaty provision obliges World Trade Organization members to protect computer software as literary works within the meaning of the Berne Convention. TRIPs Article 10 (2) further

56. For example, South Korea protects computer programs not by copyright, but by a *sui generis* régime, see 1987 Korean software protection law: Computer Program Protection Act No. 3920, of 31 December 1986 (which entered into force on 1 July 1987), translated in 28 *Copyright* (September 1988). The Republic of Korea became a party to the Berne Convention on 8 August 1996. For a general argument that software should be protected by a *sui generis* régime, rather than by copyright, see Pamela Samuelson, *et al.*, "A Manifesto Concerning the Legal Protection of Computer Programs", 94 *Colum. L. Rev.* 2308 (1994).

requires member countries to protect databases as intellectual creations. Thus, subsequent multilateral accords fill some of the Berne Convention's lacunae as to new technology.

In addition, a new World Intellectual Property Organization copyright treaty (WCT), negotiated in December 1996, and open for ratification, adopts the TRIPs subject matter specifications[57]. The 1996 WCT is characterized as a "special agreement under article 20 of the Berne Convention", which authorizes member countries to conclude accords offering greater protection than does the Berne Convention. This suggests that the 1971 Paris text of the Berne Convention might not of itself mandate coverage of computer programs and databases. Nonetheless, their inclusion in the TRIPs forecloses most Berne members' opportunities to interpret domestic copyright law in a manner that excludes these subject matters.

On the other hand, the Berne Convention does not define the requisite level of originality. Thus, a member country might also exclude many members of a protected class of works, on the ground that even if the Berne Convention does provide for protection for this kind of work as a whole, such protection for particular examples of the work would be incompatible with the member country's determination of the requisite quantum of authorship[58]. Suppose, for example, that a member country protects pictorial and graphic works, but makes no provision for computer-generated graphics. If that country has a highly personalist conception of authorship and copyright, may it refuse protection to a pictorial work from a Berne country when the work was computer-assisted, or computer generated?[59]

Other multilateral accords do not fully resolve the problem of the quantum of human creativity requisite to support a copyright. The

57. See WIPO Copyright Treaty, 20 December 1996, 36 *ILM* 65 (1997); (visited 12 October 1998) <http://www.wipo.org/eng/diplconf/distrib/94dc.htm>, Arts. 3 and 4, and accompanying Agreed Statements, referring directly to TRIPs norms.

58. See, e.g., German Federal Republic, BGH Judgment of 9 May 1985, [1985] CR 22, *Inkassoprogram* (requiring a higher level of originality for computer programs); Article 2 (3) of the 1991 European Community Software Directive effectively "overrules" this decision by requiring EC member countries to apply the "personal intellectual creation" standard of originality, see Council Directive 91/250, 1991 OJ (L 122) 42 (hereinafter "Software Directive").

59. The United Kingdom is one of the few countries, if not the only country, to provide specifically for copyright coverage of computer-generated works. See Copyright, Designs and Patents Act, 1988, Chap. 48 (Eng.).

1991 European Union Software Directive [60], and the 1996 Database Directive [61] both specify a uniform level of originality, requiring that the computer program or database be its author's "personal intellectual creation". This standard is believed to be lower than the traditional Continental requirement that the work bear the "imprint of the author's personality", but higher than the traditional English "skill and labour" approach [62]. Similarly, Article 10 (2) of the TRIPs agreement applies an "intellectual creation" standard to compilations. Thus, within the European Union, and among WTO member nations, one country may not deny another member State's computer programs and databases copyright protection on the ground that these works do not rise to the high level of originality otherwise required of copyrighted works. But these special provisions regarding computer programs and databases do not directly affect the level of creativity demanded of other kinds of works. Moreover, the "personal intellectual creation" standard may require that the creation emanate from a human being ; thus EU and WTO States may exclude computer programs, databases, and indeed any computer-*generated* work, that is not in some way "personal" to a human author [63]. By contrast, a computer-*assisted* work still requires human intervention, and thus should be covered by the "personal intellectual creation" standard, as well, perhaps, as the "imprint of the author's personality" test.

(b) *Rights protected by and exceptions to copyright*

The Berne Convention not only sets out an illustrative list of protected works, it also specifies what rights member countries must protect. According to the 1971 Paris text, these rights are : for literary and artistic works, the right of reproduction (Art. 9 (1)), adaptation (Art. 12), including cinematographic adaptations (Art. 14), and certain broadcasting rights (Art. 11*bis*) ; for literary works, the right

60. Software Directive, *supra* footnote 58, Art. 2 (3).

61. Council Directive 96/9 on the legal protection of Databases, 1996 OJ (L 77) 20, Art. 2 (3) (hereinafter "Database Directive").

62. See generally Jérôme Huet and Jane C. Ginsburg, "Computer Programs in Europe : A Comparative Analysis of the 1991 EC Software Directive", 30 *Colum. J. Transnat'l. L.* 327, 337-340 (1992) (discussing differing standards of copyright originality).

63. See also Sam Ricketson, "People, Not Machines : The Berne Convention and the Changing Concept of Authorship", 16 *Colum.-VLA JL & Arts* 1 (1991) (contending that the Berne Convention assumes that authors will be human).

of public recitation (Art. 11*ter*); for literary, artistic and dramatic works, the right of translation (Art. 8, 11 (2)); for dramatic and musical works, public performance by any means or process, and communication to the public (Art. 11 (1)). As this list makes apparent, the 1971 Paris text does not synthesize the minimum rights, but leaves many gaps.

Similarly, the Paris text sets forth a variety of precise exceptions to protection that member countries may (but are not obliged to) permit, but lacks an overall definition of the boundaries of permissible exceptions[64].

The 1996 WCT endeavours in part to rationalize, synthesize, and simplify both the minimum rights protected, and the permissible exceptions to those rights. The Treaty articulates a new right of public distribution of physical copies, and adopts the TRIPs text affording a rental right in computer programs and phonograms[65]. Most importantly, the WCT synthesizes the right of "communication to the public", applying it to all literary and artistic works, and specifying that the right covers

> "any communication to the public of their works [of authors of literary and artistic works], by wire or wireless means, including the making available to the public of their works in such a way that members of the public may access these works from a place and at a time individually chosen by them"[66].

This definition covers many current, and anticipated, forms of dissemination of works of authorship, including by herzian or cable television, satellite, pay per view, and digital transmissions. For example, suppose an Internet consumer downloaded a musical composition for her personal listening pleasure. There nonetheless is a communication to the public, because the website operator (and perhaps other actors, such as the website host server) has placed

64. Compare Berne Conv., Art. 9 (2) (setting forth a general test for exceptions to the reproduction rights), with Berne Conv., Arts. 11*bis* (2), (3) and 13 (exceptions to broadcasting right and regarding recording of musical works).

65. See WCT, Arts. 6, 7 (setting forth the distribution right, and the rental right for computer programs, phonograms, and in certain limited circumstances, cinematographic works); *id.*, Agreed Statement to Art. 7 (WCT, Art. 7, is "consistent with" TRIPs, Art. 14 (4), which provides for a rental right in computer programs, phonograms, and cinematographic works, but the latter only if commercial rental has led to widespread copying that "impair[s] the exclusive right of reproduction").

66. WCT, Art. 8.

the musical composition on its website, where members of the public may access it at a place (home) and a time (whenever they request it) chosen by them. The WCT definition thus removes any ambiguity subsisting from the 1971 Paris text as to whether a "public performance" or "communication to the public" required simultaneous receipt by the public of the performance or communication [67].

The Berne Convention permits member countries to make exceptions to the reproduction and public performance rights. The terms under which the treaty tolerates performance right exceptions are detailed and confusing. The WCT simplifies the Berne Convention's régime of exceptions by extending the Berne Convention Article 9 (2) provision on exceptions to the reproduction right to exceptions to all the rights granted under the treaty, subject to the same conditions as set forth in Article 9 (2). Thus, WCT Article 10, incorporating the standard set forth in Berne Convention Article 9 (2), confines permissible exceptions to those that apply to "certain special cases", and "that do not conflict with a normal exploitation of the work, and do not unreasonably prejudice the legitimate interests of the author" [68]. The "Agreed statement concerning Article 10" further specifies :

> "It is understood that the provisions of Article 10 permit Contracting Parties to carry forward and appropriately extend into the digital environment limitations and exceptions in their national laws which have been considered acceptable under the Berne Convention. Similarly, these provisions should be understood to permit Contracting Parties to devise new exceptions and limitations that are appropriate in the digital network environment.
>
> It is also understood that Article 10 (2) neither reduces nor extends the scope of applicability of the limitations and exceptions permitted by the Berne Convention." [69]

WCT Article 10 thus serves two purposes : to articulate a general norm for all exceptions to Berne Convention and WCT rights, and to confirm that this norm applies to exceptions in the digital, as well as

67. Ricketson, *supra* footnote 16, at 184.
68. WCT, Art. 10 ; Berne Convention, Art. 9 (2).
69. WCT, Agreed Statement concerning Article 10.

the analogue, environments. But there is some tension between the generalization of the boundaries for exceptions to copyright, and the application of those boundaries to digital media. On the one hand, the agreed statement stresses that member States should be able to create new, digital-specific, exceptions ; on the other, these must not violate the general norm that exceptions may not "conflict with a normal exploitation of the work". Because a "normal exploitation" of a work in the digital environment may be more closely tailored to individual uses than was possible in the analogue world, some long-standing exceptions in many countries' copyright laws, most particularly, private copying exemptions, might now or soon be considered inconsistent with a work's "normal exploitation" [70]. The contours of Berne-compatible exceptions to copyright in the new technological era thus remain to be tested, and may prove quite fluid, if not fugitive.

4. The relationship of substantive minima and the principle of national treatment

As discussed earlier, the Berne Convention combines a régime of substantive minima of protection with the non-discrimination principle of national treatment : member countries must treat works from other member countries as if they were local works. Some doubt may persist, however, as to whether the principle of national treatment applies only to works covered in Article 2 of the treaty, or whether, once a member country has determined to protect a class of works under copyright, it must protect foreign works of the same class, even if the Berne Convention does not clearly mandate their coverage. If a member country does extend copyright to works not included in Article 2 (1)'s illustrative list, or gives a generous interpretation of the categories set forth elsewhere in that article, and chooses to include equivalent foreign works among the beneficiaries, this technique would certainly be fully consistent with the Berne Convention : the minima that text provides by no means prohibit a member country from granting *more* protection than the treaty demands [71].

70. See, e.g., Jane Ginsburg and Yves Gaubiac, "Private Copying in the Digital Environment", in *Liber Amicorum Herman Cohen Jehoram* (1998).
71. See Berne Convention, Art. 19.

(a) *International consequences of expanding domestic copyright subject matter beyond Berne minima*

But, what if the scope or terms of copyright granted these works differ from the traditional copyright régime ? If we assume, for the moment, that the national treatment rule requires treating all foreign works like all local works, even if some of these fall outside Berne subject matter minima, the next question would be whether the protection the host country extends must also remain consistent with Berne minima as to protected rights.

If a Berne member accords copyrighted works fewer rights than those whose protection the treaty requires, one might conclude that the member country has not fulfilled its treaty obligations. However, one might also argue that if the member country has included within the scope of copyright some works whose coverage the treaty does not mandate, then that country may tailor copyright protection without regard to minimum rights. Under this analysis, the most the Berne Convention may require is that the member country accord such works from Union countries the same treatment as the member affords local works of the kind.

Sound recordings present a leading example of this kind of work. The Berne Convention does not cover sound recordings, and most Berne members do not include them within the subject matter of copyright. However, some countries, for example the United States, do provide for copyright protection of sound recordings [72]. On the other hand, the United States does not afford sound recordings the full scope of copyright protection : outside of certain digital transmissions, there is no public performance right in a sound recording [73]. By contrast, the Berne Convention sets forth the public performance right as a minimum right [74]. But if the member country was not obliged in the first place to protect sound recordings, and if therefore the scope of protection granted sound recordings is equally independent of Berne Convention constraints, then that country has not acted inconsistently with its treaty obligations.

In sum, if a Berne member country determines that a work, albeit non traditional, falls within Article 2 criteria, then the Berne member must accord that work the minimum scope of rights set forth in the

72. See 17 USC, § 102 *(a)* (7).
73. See 17 USC, §§ 106 (4) (6), 114.
74. See Berne Convention, Arts. 11, 11*bis*, 11*ter*.

Convention. If, on the other hand, the member country determines that the work does not fall within Article 2 criteria, then the country may accord a foreign work of the same kind the domestic scope of protection, even if that scope falls below Berne minima.

One should note, however, that the last element of this analysis may lend itself to abuse: because the Berne Convention leaves to member countries the interpretation and implementation of Article 2, one may fear that a member country might seek to escape the application of Berne minimum rights by asserting its autonomy in interpreting the scope of Article 2. There are two means to avoid this result. First, one might contend that Article 2, particularly after TRIPs, incorporates an international consensus as to the meaning of its terms. Member countries therefore would not be completely free to interpret the terms in any way they desire. Second, one might argue that once a member country undertakes as a matter of domestic law to include a work within the subject matter of copyright, then it must accord the same works from Berne countries Berne-level protection (even if it does not afford the same level of rights to local works).

What if the divergence between local norms and Berne minima makes the domestic law *more* protective than the Berne Convention, because the domestic law affords rights additional to rights under copyright? Must the Berne member accord other Berne members national treatment as to *extra*-copyright rights? For subject matter that the member country protects in part by copyright, and in part by another legal régime, the Berne Convention would require compatibility with national treatment and minimum standards of protection, with respect to the copyright component. However, to the extent that the local régime of protection covers non-copyright subject matter (and local law has not engaged in an abusively restrictive definition of copyright subject matter), the treaty would not govern the non-copyright features. Similarly, if the local régime protected rights that are different in kind from the Berne Convention's prescribed rights, then the treaty does not mandate national treatment, as to those rights. Thus, the Berne member would not be obliged to grant national treatment with respect either to subject matter that qualifies for copyright under neither Berne norms nor local law, or with respect to rights that are more extensive than those available under copyright.

For example, the 1996 EU Database Directive establishes a two-

track system for compilations : copyright protects original databases, but a new, *sui generis* right to prevent unauthorized extraction, protects non-original databases, and non-original extracted substantial portions [75]. EU Berne Union countries implementing the Database Directive remain subject to Berne standards with respect to regulation of copyrightable databases ; they would not be so subject in their implementation of the copyright-independent "unauthorized extraction" right. EU nations, albeit Berne members, would therefore be free to condition extra-EU extension of the extraction right on demonstration of reciprocal protection by non-EU nations [76].

(b) *Copyright-equivalent rights : international consequences of imposing protection under other legal régimes*

Suppose that instead of granting copyright-like protection to non-copyrightable subject matter, a Berne member nation affords copyright-equivalent protection to works that come (at least in part) within the subject matter of copyright, but makes this protection available under a legal rubric other than copyright. What are the consequences of this label-shifting for foreign Berne Union works ?

Having earlier considered the international impact of *sui generis* protection of productions falling outside the boundaries of copyrightable subject matter, we should also address the international consequences of provisions, such as the US 1992 Audio Home Recording Act [77], that concern private copying of works coming within the subject matter of copyright, but that purport to create a distinct, extra-copyright, régime of protection/compensation.

Providing copyright-like protection by extra-copyright means is not new to the Berne system. A notable and venerable example is the United Kingdom's recourse to a variety of tort doctrines, particularly defamation, to secure a level of protection of moral rights compatible with the Berne standard introduced in the 1928 revision [78]. The

75. See Database Directive, Art. 7 (2).

76. See Database Directive, Art. 11, recital 56. Although the Berne Convention does not mandate national treatment for non-copyrightable works, it is at least arguable that, under Article 10*bis* of the Paris Convention on industrial property, extended by Article 2 (1) of the TRIPs accord, which requires WTO member countries to accord each other protection against unfair competition, EU WTO members must protect databases from other WTO members against unauthorized extraction.

77. 17 USC, Chap. 10.

78. See, e.g, Ricketson, *supra* footnote 16, at 459-462.

United States adopted the same course when it adhered to the Berne Convention in 1989. While the United States and the United Kingdom have been criticized for insufficient solicitude for authors' non-economic interests, the critique has addressed the *substance* of moral rights protection, not the *technique* of supplying that protection by extra-copyright means [79].

From this example, one may conclude that what counts for Berne compatibility is not the form or the label, but the substance of the protection at issue. Let us now invert the proposition. Suppose a Berne Union member elects to afford protection against unauthorized copying or public performance, but purports to do so under a rubric other than copyright. Recourse to a parallel source of legislation should not itself excuse the member country from extending the benefits of that protection to foreign authors and copyright owners. If the objects of special protection are works of authorship within the meaning of Article 2, and if the rights protected are within the scope of the Berne minima, then the principle of national treatment should apply, whatever formal classification the domestic legislation employs.

For example, the US Audio Home Recording Act of 1992 purports, in response to the anticipated private copying of digitally recorded works, to install an extra-copyright régime of technical anticopying standards and royalties derived from levies on recording material. The subject matter the law addresses, predominantly musical compositions, are copyrightable works (as are, in the US scheme, the sound recordings). The law establishes compensatory remedies for copying. Despite its *sui generis* pretensions, the law, I would contend, essentially accords a form of copyright protection. The law's benefits should therefore extend to other Berne Union members. In fact, the 1992 law's rather complicated provisions do appear to apply to Berne members (as well as to other foreign authors and copyright holders entitled to protection in the United States) [80]. Thus, the law is Berne-compatible.

By contrast, national private copying legislation in some other Berne Union countries restricts to local authors, and/or local social-cultural institutions, the distribution of some or all of the sums

79. See, e.g., Adolf Dietz, "The United States and Moral Rights: Idiosyncracy or Approximation — Observations on a Problematical Relationship Underlying U.S. Adherence to the Berne Convention", 142 *RIDA* 222 (1989).

80. See 17 USC, §§ 1001 (7) and 1006.

levied. These measures have been justified as non-copyright "taxes", on the ground that the proceeds do not go entirely, or directly, to authors [81]. To the extent the sums are distributed to authors, I believe we are back in the realm of copyright, whatever the name of the régime, and that the principle of national treatment therefore applies. To the extent the proceeds replenish general social-cultural coffers, the kinship to copyright is attenuated. Nonetheless, authors remain the indirect beneficiaries of this kind of scheme. Moreover, exempting this kind of scheme from national treatment would seem to invite disingenuous recharacterization of the royalties as mere domestic social welfare legislation. (The characterization would be more convincing if the basis for the levy were limited to local works.)

This survey of the relationship of Berne minima to the principle of national treatment shows that once a Berne Union work comes within the scope of minimum subject matter coverage, another Berne member must protect it not only coextensively with local works, but, in the event that local protection falls below Berne minimum rights, must also accord the Unionist work the treaty level of protection. By contrast, if the work falls outside mandatory Berne subject matter, but a member State protects works of that kind under its copyright law, then the member State must accord national treatment to the foreign work, at least to the extent that copyright protections are concerned. The member State need not extend extra-copyright protection to non-copyright subject matter, but neither may it elude the rule of national treatment by relabelling as a *sui generis* or copyright-independent régime rights that afford protection against (or compensation for) unauthorized reproduction or communication of copyrightable works to the public. These principles are likely to prove increasingly significant as digital media open new avenues of exploitation, which some Berne members might be tempted to characterize as falling outside copyright, in order to avoid treating foreign works equally with local productions.

81. See generally Gillian Davies and Michèle E. Hung, *Music and Video Private Copying: An International Survey of the Problem and the Law* 218-221 (1983).