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Better Late Than Never: Implementation Of The 1886 Berne Convention

Introduction

On October 31, 1988, President Reagan signed into law H.R. 4262, the Berne Convention Implementation Act¹ (hereinafter "Implementation Act"), observing that:

With 77 countries as members, including most of our trading partners, the Berne Convention features the highest internationally recognized standards for the protection of works of authorship. Our membership will automatically grant the United States copyright relations with 24 new countries and will secure the highest available level of international copyright protection of U.S. artists, authors, and copyright holders.²

The President also explained the significance of this new enactment in concrete economic terms:

The cost to Americans [of not joining the Berne Convention] has been substantial not only in terms of the violation of the property rights of Americans but in terms of our trade balance as well. We've been running a trade surplus of over \$1 billion annually in copyrighted goods, and it would have been much larger had it not been for the pirating of American copyright work. In 1986 alone, the entertainment industry may have lost more than \$2 billion in potential revenue, and our computer and software industries more than \$4 billion in potential revenue.³

These explanations⁴ underscore the reasons that enactment of the

* U.S. Senator (R-Utah). Ranking minority member, Subcommittee on Patents, Copyrights and Trademarks, U.S. Senate Committee on the Judiciary.

1. Berne Convention Implementation Act of 1988, Pub. L. No. 100-658, 1988 U.S. CODE CONG. & ADMIN. NEWS (102 Stat.) 2853 (to be codified at 17 U.S.C. § 116A) (previously H.R. 4262, 100th Cong., 2d Sess. (1988)).

2. Remarks on Signing the Berne Convention Implementation Act of 1988, 24 WEEKLY COMP. PRES. DOC. 1405 (Oct. 31, 1988).

3. *Id.* at 1406.

4. For further evidence on the economic benefits of Berne Convention accession, see *The Berne Convention: Hearings Before the Subcomm. on Patents, Copyrights, and Trademarks of the Senate Comm. on the Judiciary*, 100th Cong., 2d Sess., 70-77 (1988) [hereinafter *Hearings*, 100th Cong.] (statement of Commerce Secretary C. William

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Implementation Act and the subsequent act of accession to the Berne Convention for the Protection of Literary and Artistic Works⁵ (hereinafter "Convention" or "Berne") may well be this decade's most significant advance for American intellectual property law.

The Convention is the oldest and most comprehensive international treaty governing the protection of copyrights. It extends copyright protections beyond our borders to worldwide coverage provided by the 77 current signatories of the multilateral treaty, including 24 countries with which the U.S. currently has no intellectual property agreements.⁶ Moreover, U.S. adherence to Berne may well lead to incorporation of stronger intellectual property protections in the General Agreement on Tariffs and Trade (hereinafter "GATT").⁷

Despite the evident benefits of Berne membership, the United States waited more than 102 years to ratify the treaty. The primary reason for this delay was that U.S. copyright law had, for over a century, been incompatible with the terms of the treaty.⁸ Evolving American law and a diligent bi-partisan congressional effort, however, created a situation where the U.S. could accede to Berne. Enactment of the Implementation Act enabled the United States to take the formal steps to ratify the Convention and join the Berne Union.

I. Brief History Of U.S. Copyright Law and the Convention

A. Early U.S. International Copyright Efforts

Although the United States adopted its first copyright protections in 1790⁹ pursuant to Article I Section 8 of the Constitution,¹⁰ Congress initially provided no protection for works by foreign authors. In fact, this original copyright law specifically excluded foreign authors from its coverage:

. . . nothing in this act shall be construed to prohibit the importation or rendering, reprinting or publishing within the United States, of any map, chart, book or books, written, printed, or published by any person not a

Verity) ("In 1984, [foreign piracy of U.S. copyrighted materials] cost U.S. industries more than \$1.3 billion in only ten countries"). See also *id.* at 92, 258 (statements of revenue generated by exported copyright industries). See generally *U.S. Adherence to the Berne Convention: Hearings Before the Subcomm. on the Judiciary, 99th Cong., 1st & 2d Sess. (1985-86)* [hereinafter *Hearings, 99th Cong.*] (testimony on effect of U.S.'s non-membership in Berne).

5. The Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, 828 U.N.T.S. 221 (1972) (as amended), 102 Stat. 2853, T.I.A.S. No. — (1988).

6. H.R. REP. NO. 609, 100th Cong., 2d Sess. 11 (1988) [hereinafter H.R. REP.]. See also *supra* note 2 and accompanying text.

7. *Hearings, 100th Cong., supra* note 4, at 97-99 (statement of Ambassador Clayton Yeutter, U.S. Trade Representative. See also *infra* notes 55-57 and accompanying text.

8. S. REP. NO. 352, 100th Cong., 2d Sess. 5 (1988) [hereinafter S. REP.].

9. Act of May 31, 1790, ch. 15, 1 Stat. 124 (1790) (current version at 17 U.S.C. §§ 101-810).

10. U.S. CONST. art. I, § 8, cl. 8.

citizen of the United States, in foreign parts or places without the jurisdiction of the United States.¹¹

Secretary of Commerce C. William Verity testified about the implications of this policy:

For most of our first century of nationhood, we were takers. We stole what others created. Nobody could match us in our disdain for the rights of foreign authors such as Dickens, Thackeray, or Gilbert and Sullivan. But we soon learned that our behavior came at a cost as other nations denied our own authors the rights we had denied theirs. When nations behave that way, all of them are net losers.¹²

B. Berne Convention and Its Antecedents

American reluctance to provide copyright protection to foreigners culminated with the decision to refrain from participating in the signing of Berne. Five important conferences had been convened earlier to replace haphazard bilateral and multilateral agreements with a uniform scheme of international copyright protection. First, in 1858, the "Congress of Authors and Artists" met in Brussels and passed resolutions urging the adoption of uniform law at the national level.¹³ Second, the "International Literary Congress" convened in Paris in 1878 and created an international association to focus on issues of international copyright.¹⁴ Third, the International Literary and Artistic Association convened in Berne in 1883 and prepared a draft convention which it presented to the Swiss government.¹⁵ Fourth, based on this document, the Swiss government convened an official diplomatic conference in Berne in 1884, which adopted a revised draft convention.¹⁶ The United States did not participate in the 1884 conference.¹⁷ Fifth, during a second official conference in 1885, twenty nations including the United States sent delegates, who revised the 1884 draft.¹⁸ Switzerland communicated the draft convention to fifty-five nations with an invitation to

11. Act of May 31, 1790, ch. 15, § 5, 1 Stat. 124, 125.

12. *Hearings*, 100th Cong., *supra* note 4, at 72-73.

13. See S. LADAS, *THE INTERNATIONAL PROTECTION OF LITERARY AND ARTISTIC PROPERTY* 71-72 (1938).

14. See *id.* at 73, 74. The Congress ultimately adopted five resolutions: (1) an author's right to his work is not a grant of law, but a type of property which legislatures must guarantee; (2) the author's right to his work runs perpetually; (3) nations may fix a period whereby an author's work enters the public domain, thereby permitting any person to reproduce an author's work; (4) nations should treat domestic and foreign works equally; and (5) an author should receive protection if he complies with the ordinary formalities prescribed by a nation. *Id.* Under the direction of Victor Hugo, the 1878 Congress created the International Literary and Artistic Association. The Association paved the way for international cooperation and subsequent draft conventions. *Id.* See also *Hearings*, 99th Cong., *supra* note 4, at 121-22 (testimony of Donald J. Quigg, Acting Commissioner for Patents and Trademarks).

15. See S. LADAS, *supra* note 13, at 75-76.

16. See *id.* at 76-80.

17. See *id.* at 77.

18. See *id.* at 80-82.

sign the Convention at a final diplomatic conference in Berne in 1886.¹⁹

The original Convention had five primary objectives: first, the promulgation of copyright laws throughout the countries of the world; second, the elimination of artificial timing barriers to international copyright enforcement; third, the abolition of intellectual property protectionism or unnecessary preferences for domestic artists over foreign artists; fourth, the eradication of superfluous and burdensome formalities or procedural barriers to enforcement of legitimate copyrights; and fifth, the promotion of uniform international copyright protection.²⁰ Despite twenty-five years of international negotiation and study, the simple and straightforward document was adopted by only ten nations in 1886.²¹ Since then, however, the Convention has grown into the world's premier multilateral copyright treaty.²²

Although the United States attended the 1885 Berne Conference, it chose to attend the 1886 conference only as an observer and did not sign the Convention.²³ Because United States law did not grant aliens any jurisdiction to protect their copyrights in domestic courts,²⁴ the United States could not meet the terms of Berne.

C. Post-Berne U.S. International Copyright Efforts

After Berne, the U.S. took an important step towards harmony with the new international copyright regime by passing the Chace Act in 1891.²⁵ With this legislation, Congress finally provided copyright protection under American law for foreign authors not resident in the U.S.²⁶ Despite removal of this obstacle to Berne accession, U.S. law remained incompatible with the Convention in other respects. Most notably, at the same time Congress extended copyright protection to foreign authors, it enacted the "manufacturing clause."²⁷ This clause required that certain steps in the production of books and periodicals be performed in the U.S. or Canada.²⁸ Violation of this clause by a foreign manufacturer barred domestic copyright protection of those foreign

19. *See id.* at 82.

20. H.R. REP., *supra* note 6, at 12.

21. S. LADAS, *supra* note 13, at 82-83.

22. *See* H.R. REP., *supra* note 6, at 6.

23. *See* S. LADAS, *supra* note 13, at 82-83.

24. *See supra* notes 9-12 and accompanying text.

25. Act of Mar. 3, 1891, ch. 565, 26 Stat. 1106.

26. This protection to foreign authors was expressly conditioned on reciprocal extension by the author's state to U.S. citizens. 26 Stat. 1110 ("That this 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 . . .").

27. 17 U.S.C. § 601 (1982). Under the terms of the Act of July 13, 1982, Pub. L. No. 97-215, 96 Stat. 178 (codified at 17 U.S.C. § 601), the manufacturing clause expired on June 30, 1986.

28. 17 U.S.C. § 607(a) (1982) (" . . . literary material that is in the English language and is protected under this title is prohibited unless the portions consisting of such material have been manufactured in the United States or Canada").

works.²⁹ The Convention, on the other hand, prohibits a signatory from conditioning an author's enjoyment of rights to a literary work on any such formality.³⁰ Accordingly, instead of joining the Berne Union, the United States sought bilateral and multilateral agreements with other nations to protect intellectual property.³¹

After World War I, the foreign market for United States goods grew rapidly.³² This growth prompted some representatives of copyright interests to suggest that ratification of the Berne Convention would grant American copyright holders workable remedies against foreign piracy.³³ Nonetheless, ratification efforts in this era failed because the task of revising United States copyright law to comply with Berne fell behind other priorities.

The Rome Revision of the Berne Convention³⁴ in 1928 created a major new obstacle to U.S. accession. The Rome Conference added the recognition of the so-called "moral rights" as a new obligation of Berne signatories.³⁵ In essence, this gave authors a right to claim authority over their works and to object to excessive modification of their works

29. 17 U.S.C. § 601(d).

30. Convention, *supra* note 5, at art. 5. In pertinent part, Article 5 states that:

- (1) Authors shall enjoy, in respect of works for which they are protected under this Convention, in countries of the Union other than the country of origin, the rights which their respective laws do now or may hereafter grant to their nationals, as well as the rights specially granted by this Convention.
- (2) The enjoyment and the exercise of these rights shall not be subject to any formality; such enjoyment and such exercise shall be 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 the laws of the country where protection is claimed.

31. These bilateral agreements included treaties with China in 1903, Japan in 1905, Hungary in 1912, and Siam in 1920; multilateral treaties included the Pan American Conventions of 1902 and 1910. S. LADAS, *supra* note 13, at 837-38.

32. According to Secretary of State Cordell Hull in a 1936 memorandum to President Roosevelt,

More than a quarter of a century has elapsed since there was any comprehensive alteration in the law of the United States granting and regulating copyrights. During the period many changes have occurred in the type and scope of the production and distribution of literary and artistic works. The United States is probably the world's largest producer of literary and artistic works These works are known throughout the world and are an important factor in domestic and foreign commerce.

H.R. REP. NO. 2514, 74th Cong., 2d Sess. 2 (1936).

33. See, e.g., *Universal Copyright Convention and Implementing Legislation: Hearings on Executive M, 1st Sess., the Universal Copyright Convention and S.2559, a Bill to Amend Title 17, U.S.C., Entitled "Copyrights" Before a Subcomm. of the Senate Comm. on Foreign Relations and a Subcomm. of the Senate Comm. on the Judiciary, 83d Cong., 1st Sess. 23 (1954)* [hereinafter *Hearings, 83d Cong.*]; Mathews, *Thirty Years of International Copyright*, N.Y. Times, June 26, 1921, § III (Magazine), at 2.

34. Reprinted in S. LADAS, *supra* note 13, at 1156 (full text).

35. Convention, *supra* note 5, at art. 6 *bis*. Article 6 *bis* provides in pertinent part:

- (1) Independently of the author's economic rights, and even after the transfer of the said rights, the author shall have the right to claim authorship of the work and to object to any distortion, mutilation or other modification of,

independent of contractual rights.³⁶ American sentiment for ratification quickly dissipated. Publishers and movie producers voiced apprehensions that moral rights could disrupt existing United States copyright relationships.³⁷ Other legal problems also stood in the way of U.S. accession to Berne. The manufacturing clause,³⁸ incompatible with Berne precepts,³⁹ remained in force. Similarly, as time progressed, United States copyright law grew to include such provisions as the juke-box laws⁴⁰ that conflicted with Berne's compulsory licensing prohibitions.⁴¹

To compensate for the absence of Berne remedies, the United States worked to create a new international copyright protection mechanism under the auspices of the United Nations Educational, Scientific and Cultural Organization (hereinafter "UNESCO"). The Universal Copyright Convention, (hereinafter "UCC")⁴² ratified by the United States in 1954, was the result of this effort.⁴³ The UCC was a compromise system that granted the United States some benefits of uniform international copyright protection while not disrupting America's

or other derogatory action in relation to, the said work, which would be prejudiced to his honor or reputation.

See *infra* note 80.

36. These are generally referred to as the right of paternity and right of integrity, respectively.

37. *Hearings*, 99th Cong., *supra* note 4, at 123 (history in the testimony of D. Quigg, Acting Commissioner for Patents and Trademarks). Although the Senate gave its advice and consent to the Rome text on Apr. 19, 1935, that advice and consent was reconsidered on Apr. 22, 1935 because concurrent revision legislation failed. See *id.*

38. 17 U.S.C. § 601 (1982) (repealed 1986). See *supra* notes 27-29 and accompanying text.

39. See *supra* note 30 and accompanying text.

40. Copyright Act of 1976, 17 U.S.C. § 116 (1982). See *infra* note 142 and accompanying text.

41. Article 11(1) of the Convention guarantees copyright owners the exclusive right over authorizing public performance of their works). See *infra* notes 143-44 and accompanying text.

42. The Universal Copyright Convention, Sept. 6, 1952, 6 U.S.T. 2731, T.I.A.S. No. 3324, 216 U.N.T.S. 132 (as revised July 24, 1971, 25 U.S.T. 1341, T.I.A.S. No. 7868, 493 U.N.T.S. 178), annotated in A. BOGSCH, *THE LAW OF COPYRIGHT UNDER THE UNIVERSAL CONVENTION* 3-150 (1968).

43. "The Universal Copyright Convention is amplifying rather than superseding of the present rights of our citizens The Universal Copyright Convention contains certain simple minimum rights, compliance with which will require no alteration of our own copyright standards." *Hearings*, 83d Cong., *supra* note 33, at 37 (statement of Sydney M. Kaye, member of the U.S. delegation to the Intergovernmental Copyright Conference of 1952); S. ROTHENBERG, *COPYRIGHT LAW: BASIC AND RELATED MATERIALS* 249 (1956) (testimony at 1954 hearings on S.2559, A Bill to Amend Title 17). Similarly, John Schulman of the Authors League of America testified that "the convention takes into account essential differences between the copyright laws in the United States and the systems prevailing in other countries No change will be required in the nature of the works to be protected or the nature of the exclusive rights to be enjoyed under our statute." *Hearings*, 83d Cong., *supra* note 33, at 46 (statement of John Schulman, representing the Authors League of America and the Songwriters Protective Organization), *reprinted in* S. ROTHENBERG, *supra*, at 261.

unique copyright scheme.⁴⁴ As acting Commissioner Donald Quigg of the U.S. Patent and Trademark Office noted in his testimony before the U.S. Senate Subcommittee on Patents, Trademarks and Copyrights in 1985, "The new Universal Copyright Convention (UCC) was intended to be a bridge leading to ultimate adherence to Berne. The UCC established minimum standards that could be a new common denominator among States, both members of the Berne Union and members of the new UCC."⁴⁵

II. Recent Changes Calling for Ratification of Berne

In recent years, the obstacles to joining the Berne Union began to disappear and the incentives for international protection of copyrights began to grow. Five recent changes have pressed the U.S. to reconsider membership in Berne: (1) United States withdrawal from UNESCO, (2) increased international pressure and criticism, (3) growing international piracy of United States copyrighted material, (4) developments in American law removing incompatibilities with Berne, and (5) an emerging consensus that existing domestic law satisfies Berne's moral rights component.

A. United States Withdrawal from UNESCO

In December 1983, Secretary of State George Schultz announced the United States's withdrawal from UNESCO,⁴⁶ the organization that governs the UCC. Although the Department of State concluded that withdrawing from UNESCO would not affect American rights or obligations under the UCC or other UNESCO-sponsored conventions already signed by the United States,⁴⁷ the event had the unintended consequence of reducing the UCC's utility in protecting U.S. copyright interests overseas. As Dr. Arpad Bogsch, Director General of the World Intellectual Property Organization, observed:

Of course, the United States remains a member of the UCC, but the program activities of UNESCO, which are funded by the UNESCO budget and are the consequence of a program which is voted by the General Assembly of UNESCO, are activities in which the United States would have no influence any more, no direct influence.⁴⁸

Donald Curran, Acting Register of Copyrights in 1985, also noted that "the utility of UNESCO as a vehicle for promoting the rights secured by the UCC has been largely abandoned by United States withdrawal from

44. See *Hearings*, 99th Cong., *supra* note 4, at 123-24 (history in the testimony of Donald J. Quigg, Acting Commissioner for Patents and Trademarks).

45. *Id.*

46. See *Hearings*, 99th Cong., *supra* note 4, at 32 (testimony of Elinor Constable, Acting Asst. Secretary of State for the Bureau of Economic and Business Affairs, United States Dept. of State).

47. *Id.*

48. *Id.* at 14.

that organization."⁴⁹

America's diminished ability to influence international copyright law became "a matter of political common sense."⁵⁰ In the words of Mr. Curran, "without a presence in the UNESCO Executive Board and General Conference, [the United States] cannot urge the adoption of copyright programs specifically of importance to [its] copyright interests; [U.S.] failure to contribute to the budget makes it rather awkward to propose new initiatives to deal with current problems of international copyright."⁵¹ Thus, as a result of its withdrawal from UNESCO, the U.S. stood awkwardly on the sidelines with no role in the governing bodies of the two international copyright conventions. The United States, ironically the world's largest producer of copyrighted material, had no role whatsoever in the Berne Convention and a reduced role in the UCC.

B. International Pressure and Criticism

The withdrawal from UNESCO spurred the United States's diplomatic corps to seek aggressively bilateral and multilateral protections for intellectual property. Repeatedly, however, these efforts were rebuffed by nations who reminded U.S. negotiators of America's failure to join Berne.⁵² Even though copyright protections under American law were in many ways more comprehensive than Berne, the conspicuous absence of the United States amongst the Convention's signatory states provided some foreign states with an excuse to avoid stronger bilateral protections. For instance, the Thai government charged the United States with hypocrisy for refusing to cooperate under Berne's international copyright protections during bilateral negotiations aimed at combating massive and rampant piracy of U.S. works in Thailand.⁵³ As Congressman Kastenmeier noted, one of the benefits "frequently pointed to in

49. *Id.* at 113 (response by Donald Curran to question by Senator Mathias on whether United States loses any rights under the UCC by withdrawing from UNESCO).

50. *Id.*

51. *Id.*

52. See *Hearings*, 100th Cong., *supra* note 4, at 93 (statement of Ambassador Clayton Yeutter, U.S. Trade Representative).

53. S. REP., *supra* note 8, at 4-5 (1988); see also 134 CONG. REC. S.14553 (daily ed. Oct. 5, 1988) (statement of Senator DeConcini); *Hearings*, 99th Cong., *supra* note 4, at 708 ("[foreign governments] would have some grounds for questioning the sincerity of U.S. interests in 'adequate and effective' protection for copyrighted works, when we ourselves have not chosen to adhere to the Berne Convention. The issues we would like to focus on in the discussions could be confused if the foreign governments raise the reasons the U.S. had declined to adhere to the Berne Convention") (article in May 31, 1985 issue of PUBLISHERS WEEKLY quoting Michael Hathaway, Deputy General Counsel for the U.S. Trade Representative); *Hearings*, 100th Cong., *supra* note 4, at 93 ("In consultations with the Republic of Korea on copyright matters, the Korean delegation's first question concerned our efforts to join Berne. Too often we have found that our non-adherence to Berne is the basis for foreign resistance to making changes in their own inadequate laws") (statement of Ambassador Clayton Yeutter).

support of United States adherence to the Berne Convention appears to be enhanced political credibility in our global effort to strengthen copyright norms”⁵⁴

In addition, failure to join Berne may have a direct impact on the strength of the U.S. bargaining position during the Uruguay round of the GATT.⁵⁵ There, the U.S. has pressed for the adoption of a code of conduct concerning the protection of intellectual property worldwide, a matter in which American prestige and credibility in protection of intellectual property is at issue.⁵⁶ In sum, ratification of Berne would strengthen America’s bargaining position for accomplishing its international copyright protection policy objectives because “our trade negotiators around the world could insist on these [Berne] standards as those that constitute adequate protection for GATT as well as [for] bilateral purposes.”⁵⁷

C. Growing Piracy of U.S. Copyrighted Material Abroad

As a major exporter of books, sound recordings, motion pictures and computer software, the United States has lost billions of dollars to foreign piracy. In 1986 alone, United States companies engaged in the sale of copyrighted material lost between \$43 billion and \$63 billion because of mushrooming piracy abroad.⁵⁸ Specific examples demonstrate the extent to which rampant piracy occurs in all parts of the world. United States copyright industries lost \$1.3 billion in only ten representative third world developing nations.⁵⁹ In the Middle East, pirated tapes were worth over \$66 million just in 1982 alone.⁶⁰ In fact, pirated cassettes constitute 41-60 percent of the Egyptian market and 90-100 percent of the Saudi Arabian market.⁶¹

In the Pacific Basin, over 140 million units of copied recordings are pirated every year.⁶² In Singapore, for example, police seized 396,837 cassettes during a period of less than one year between 1982 and

54. 133 CONG. REC. H1294 (daily ed. Mar. 16, 1987).

55. *Id.* See also 134 CONG. REC. S14553 (daily ed. Oct. 5, 1988) (statement of Senator DeConcini).

56. S. REP., *supra* note 8, at 4-5. See also *Hearings*, 99th Cong., *supra* note 4, at 98.

57. 133 CONG. REC. H1294 (daily ed. Mar. 16, 1987) (statement of Representative Kastenmeier). See also *Hearings*, 100th Cong., *supra* note 4, at 93 (statement of Ambassador Clayton Yeutter) (“Achieving meaningful results in negotiations requires leverage. In this area, the leverage comes from setting the right example for the rest of the world, and that requires adherence to the Berne Convention”); *Hearings*, 99th Cong., *supra* note 4, at 677 (statement of the Recording Industry Association of America) (“By joining the Berne, the United States would enhance its credibility and thereby strengthen its bargaining position in bilateral and multilateral copyright negotiations”).

58. S. REP., *supra* note 8, at 2.

59. See *supra* note 4.

60. *Hearing on Oversight of International Copyrights Before the Subcomm. on Patents, Copyright, and Trademarks of the Senate Comm. of the Judiciary*, 98th Cong., 2d Sess. 1 (1984) (statement by Senator Leahy) [hereinafter *Hearings*, 98th Cong.].

61. *Id.* at 91.

62. *Id.* at 1.

1983.⁶³ In just nine developing countries, the United States is losing \$128 million in software sales every year.⁶⁴ This piracy problem even extends into Europe, where, for example, officials in West Germany seized over 20,000 pirated videocassettes in only three months during 1983.⁶⁵ Major piracy operations also exist in Spain, Great Britain, the Netherlands, and France.⁶⁶

With the exportation of high technology copyright material, such as computer software and semiconductor chips, the costs inflicted upon United States businesses engaged in the production of copyrighted material directly harms American workers. The loss of American technology means that jobs performed in America can now be performed abroad by America's competitors.⁶⁷ Inadequate copyright protection unfairly undermined America's competitive advantage in high technology fields and impinged on national security.⁶⁸

D. Development of More Compatible American Law

For many years, the presence of a series of compulsory licenses and formalities in U.S. law conflicted with Berne requirements, rendering accession difficult. In recent years, however, United States law has grown more compatible with the Convention. The manufacturing clause⁶⁹ constituted a major compulsory license in U.S. law. By conditioning copyright protection on use of domestic manufacturing processes, United States law directly conflicted with the unconditional guarantees of Berne against formalities that impede an author's enjoyment of rights to a literary work.⁷⁰ The 99th Congress, however, decided after some debate to allow the provision to expire.⁷¹ Thus, Congress enlarged the sphere of compatibility between United States copyright law and the Berne Convention.

Accession to the Convention also became more possible because other provisions of United States copyright law were susceptible to restructuring to comply with the Convention. For instance, because

63. *Id.* at 101.

64. *Hearings*, 99th Cong., *supra* note 4, at 245 (statement of Vico E. Henriques, President, Computer and Business Equipment Manufacturers Association).

65. *Hearings*, 98th Cong., *supra* note 60, at 1.

66. *Id.* at 115.

67. *See Hearings*, 99th Cong., *supra* note 4, at 292-93 (statement of the United States Council for International Business). According to the Council's report, "Copyright piracy undermines the international position of numerous companies in vital United States industries." *Id.* For instance, copyright infringement is the most critical trade barrier to the communications industry. *Id.* at 293.

68. *Id.* ("The impact on some [companies], such as those producing computer software, semi-conductor chips and telecommunications, implicates potential issues of national security . . . [and] [d]rains away the comparative advantage from high technology products developed by the United States and other nations").

69. *See supra* notes 27-29 and accompanying text.

70. *See Hearings*, 99th Cong., *supra* note 4, at 453-54 (Final Report of the Ad Hoc Working Group on U.S. Adherence to the Berne Convention). In particular, *see id.* at 454 n.2 (describing what constitutes a formality).

71. *Id.*

Berne expressly protects works of architecture,⁷² Title 17 easily was changed to add "architectural plans," making it explicit that U.S. law already protected such plans.⁷³ It was similarly easy to avoid conflicts between Berne and works that have already entered into the public domain under U.S. law by providing that the amendments to the copyright law compelled by Berne do not apply retroactively.⁷⁴ The jukebox laws⁷⁵ and mandatory copyright notice provisions⁷⁶ posed more difficult, but far from insuperable, challenges to conform to Berne's requirements.⁷⁷

E. Growing Consensus that Existing Domestic Law Satisfies Berne's Moral Rights Component

As will be discussed later, the primary obstacle to ratification of Berne in recent years has been the difficulty of reconciling U.S. copyright law with the much broader French concept of moral rights.⁷⁸ The 1928 Rome Revision to the Berne Convention expressly recognized certain moral rights of authors.⁷⁹ These so-called moral rights⁸⁰ include the legal right to claim authorship and to object to modifications of a copyrighted work.⁸¹ If interpreted in light of the French moral rights model, these 1928 revisions could disrupt U.S. copyright doctrines and relationships.⁸² For years, this potential conflict created a seemingly insurmountable barrier to Berne ratification.

In a floor statement given shortly before adoption of S.1301,⁸³ the Senate version of the Berne copyright bill, Senator DeConcini aptly summarized the consideration given to the issue of whether American law sufficiently protects moral rights under Berne standards:

There has been debate as to whether these "moral rights" already exist under U.S. laws, or whether new laws must be created ensuring these rights to artists before the U.S. law can become compatible with Berne After careful consideration, the committee report concluded that protection adequate to conform to Berne is provided for under existing

72. Convention, *supra* note 5, at art. 2: ("(1) The expression 'literary and artistic works' shall include . . . works of architecture").

73. 17 U.S.C. § 101 (1982). See S. REP., *supra* note 8, at 8-9.

74. S. REP., *supra* note 8, at 48.

75. Copyright Act of 1976, 17 U.S.C. § 116 (1982). See *infra* note 142 and accompanying text.

76. 17 U.S.C. §§ 408-11, 205, 304 (1982). See *infra* notes 158-61 and accompanying text.

77. See *infra* notes 145-49, 162-79 and accompanying text.

78. See *infra* notes 142-79 and accompanying text.

79. See *supra* notes 34-36 and accompanying text.

80. Article 6 *bis* of the Berne Convention does not employ the term "moral rights." See *supra* note 35. The term "moral rights" often encompasses more than the rights of paternity and integrity covered by the Convention. 2 M. NIMMER, NIMMER ON COPYRIGHT § 8.21 (1987). The Berne Convention distinguishes these rights from the economic rights generally associated with copyright protection.

81. See *supra* note 36 and accompanying text.

82. See, e.g., *supra* notes 34-35 and accompanying text.

83. S.1301, 100th Cong., 1st Sess. (1987).

laws . . . [e]xisting laws have been applied by courts to redress authors for injuries suffered as a result of the violation of their moral rights.⁸⁴

The Committee's agreement on this issue followed upon a broader consensus reached throughout much of the copyright community. International legal scholars, as well as the State and Commerce Departments, developed a consensus through years of consideration that existing United States law is sufficient to satisfy the moral rights requirements of Berne.⁸⁵ This consensus was communicated to Congress in a particularly persuasive manner during a visit by five members of the House of Representatives to Geneva and Paris in late 1987. During consultations with international copyright experts, the Congressmen became aware of the breadth of the consensus that the "U.S. should and can adhere to Berne without making major changes in U.S. law."⁸⁶

The international consultants emphasized that existing U.S. law protects the essential elements of moral rights. For instance, Section 106(2) of the United States Copyright Act⁸⁷ recognizes the right to control modification of a work by giving authors an exclusive right to produce derivative works based on their own previous works.⁸⁸ Also, Section 43(a) of the Lanham Act⁸⁹ protects an author's rights by prohibiting false designation of the origin of literary or artistic works.⁹⁰ Moreover, America's enforcement of common law rights protects various components of the moral rights concept through theories of contract,⁹¹ defamation,⁹² and unfair competition.⁹³ Finally, eight states have

84. 134 CONG. REC. S14553 (daily ed. Oct. 5, 1988).

85. See *Hearings*, 99th Cong., *supra* note 4, at 94-95 (statement of Donald Curran, Acting Register of Copyrights); *id.* at 324 (statement of U.S. Council for International Business).

86. H.R. REP., *supra* note 6, at 9.

87. 17 U.S.C. § 106 (" . . . the owner of copyright under this title has the exclusive rights . . . (2) to prepare derivative works based upon the copyrighted work . . .").

88. 17 U.S.C. § 106(2).

89. 15 U.S.C. § 1125(a) (1982).

90. See *Gilliam v. American Broadcasting Cos.*, 538 F.2d 14, 24 (2d Cir. 1976) (where the right of an author to prevent distortion or truncation of work protected by copyright was at issue, the court described § 43(a) as "the right of the artist to have his work attributed to him in the form in which he created it"). See also 2 M. NIMMER, *supra* note 80, at §§ 8.21[C]-[F] (1987).

91. See *Clemens v. Press Publishing Co.*, 67 Misc. 183, 193-94, 122 N.Y.S. 206, 207-08 (1910) (Seabury, J., concurring), where the judge noted, "Contracts are to be so construed as to give effect to the intention of the parties If the intent of the parties was that the defendant should purchase the rights to the literary property and publish it, the author is entitled not only to be paid for his work but to have it published in the manner in which he wrote it. The purchaser cannot garble it, or put it out under another name than the author's" See also *Granz v. Harris*, 198 F.2d 585 (2d Cir. 1952) (false attribution constituted breach of contract). But see *Nimmer, Implications of the Prospective Revisions of the Berne Convention and the United States Copyright Law*, 19 STAN. L. REV. 499, 520-23 (1966-67).

92. See 2 M. NIMMER, *supra* note 80, at § 8.21 [D] ("Another theory sometimes invoked is that of defamation, where the work falsely attributed to the author is of an inferior quality and consequently damages his reputation") and note 51 therein.

93. *Jaeger v. American International Pictures*, 330 F. Supp. 274, 278 (S.D.N.Y. 1971) (action for garbling and distortion of plaintiff's film) ("Whether or not there is

enacted specific statutes protecting, to a limited degree, moral rights of authors in certain works of art.⁹⁴

In sum, the international copyright community recognized that the American model of copyright protection, although different in some respects from the French model, satisfies the basic requirements of Article 6 *bis* of the Berne Convention.⁹⁵ This recognition opened the door to U.S. accession to Berne without disruption of existing copyright relationships and may well have been the most significant single step toward the Implementation Act and accession to Berne.

III. The 100th Congress's Path to Accession

A. The Political Framework

Although pressure for accession to Berne was building and the climate for ratification was improving, the legislative task of bringing U.S. law into conformity with the treaty remained daunting. Twice before, in 1909 and in 1976, Congress had undertaken major revisions of copyright law and refused to acknowledge the benefits of conformity with Berne.⁹⁶ In 1935, the Senate had actually voted to ratify Berne, only to reverse itself three days later.⁹⁷ Despite the growing consensus on sufficiency of U.S. law to satisfy the moral rights provisions of Berne, important domestic interests continued to harbor concerns that ratification could endanger their existing U.S. copyright arrangements.⁹⁸ Moreover, with larger items on its agenda, Congress is easily distracted from efforts to improve intellectual property law. Mobilized by interests who feared the implications of Berne's moral rights edicts, a few Senators or even a single Senator could indefinitely delay a copyright bill.

The legislative difficulties of preparing for ratification of Berne were compounded by the number of congressional bodies participating in an

any square counterpart in American law of the 'moral right' of artists assertedly recognized on the European continent, there is enough in plaintiff's allegations to suggest that he may yet be able to prove a charge of unfair competition or otherwise tortious misbehavior in the distribution to the public of a film . . . that bears his name but at the same time severely garbles, distorts or mutilates his work").

94. Cal. Civ. Code § 987 (West Supp. 1988); La. Rev. Stat. Ann. §§ 51:2151-2156 (West 1987); Me. Rev. Stat. Ann. tit. 27, § 303 (Supp. 1987-88); Mass. Gen. Laws Ann. ch. 231, § 85S (West Supp. 1988); N.J. Stat. Ann. §§ 2A:24A-1 to 2A:24A-8 (West 1987); N.Y. Arts & Cult. Aff. Law §§ 14.51-.59 (McKinney 1984); Pa. Stat. Ann. tit. 73, §§ 2101-10 (Purdon Supp. 1987); R.I. Gen. Laws §§ 5-62-2 to 5-62-6 (1987).

95. See *Hearings*, 99th Cong., *supra* note 4, at 458 (statement of Ad Hoc Working Group on U.S. Adherence to Berne):

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

96. *Hearings*, 100th Cong., *supra* note 4, at 140-143 (statement of Ralph Oman, Register of Copyrights).

97. *Id.*

98. See, e.g., H.R. REP., *supra* note 6, at 34-39.

accession effort. Process required that both the House and Senate Judiciary Committees (working with the relevant subcommittees of each) approve any copyright bill making the remaining changes necessary to meet Berne's standards, and that the Senate Foreign Relations Committee approve the ratification resolution. Thus, any opponents to the accession effort would have ample opportunities to find a sympathetic congressional ear, magnifying the significance of potential disagreements over issues like moral rights. In short, the 100th Congress faced significant obstacles to Berne ratification.

B. Moral Rights Under Article 6 *bis* of Berne

1. *Scope of the Problem*

At the outset of the 100th Congress, the "moral rights" obstacle remained in the path of legislation to implement the Convention. Like many legal and legislative issues, the battleground of the moral rights issue consisted of words and their definitions. The term "moral rights" had its origins in two French law concepts: the right of paternity (the right to be acknowledged as the author of a particular work) and the right of integrity (the right of authors to object to modifications which prejudice their honor or reputation).⁹⁹

Incorporating the French model of moral rights into U.S. law had the potential to alter drastically current domestic copyright relationships. Expansively interpreted, the right of paternity, for instance, could change or abrogate the work-for-hire doctrine whereby an author receives compensation to produce a work whose copyright is held by the author's employer rather than the author.¹⁰⁰ The right of integrity could complicate the ability of magazine and movie producers to edit a publication or film.¹⁰¹ Instead of editors unilaterally determining what editing changes in a work are necessary to comply with time or space limitations, the author might have the final prerogative to object to editing on the basis of artistic integrity. Needless to say, these prospects troubled many politically powerful entertainment and publishing interests with existing copyright and contractual agreements with authors and artists.¹⁰²

99. For overviews of the history and scope of differing conceptions of moral rights, see Horwitz, *Artists' Rights in the United States: Towards Federal Legislation*, 25 HARV. J. ON LEGIS. 153, 155-58 (1988); Roeder, *The Doctrine of Moral Right: A Study in the Law of Artists, Authors and Creators*, 53 HARV. L. REV. 554, 561-72 (1940). The French concept includes a right to create and publish, or not, and to do so in the form of the author's choice. Roeder, *supra* at 558. In addition, the French concept contemplates a right to modify an artist's own work, that is, a right to make "additions, suppressions and other modifications which the author may deem necessary in order to make the work conform to the state of his intellectual convictions." *Id.* at 565.

100. See *Hearings*, 99th Cong., *supra* note 4, at 102-03.

101. *Id.* at 93.

102. See, e.g., H.R. REP., *supra* note 6, at 34-38 (summary testimony).

2. *Moral Rights in U.S. Courts*

The prospect of changes in U.S. law on the basis of moral rights was a familiar theme in the federal courts. Litigants have often petitioned federal courts to expand U.S. law to match the sweep of the French notion of moral rights. Nevertheless, federal courts have refused to incorporate such an expansive model of moral rights into U.S. copyright law. As the Seventh Circuit Court of Appeals observed in the fountainhead case of *Vargas v. Esquire*,¹⁰³ “the conception of ‘moral rights’ . . . has not yet received acceptance in the law of the United States . . . [w]hat plaintiff in reality seeks is a change in the law of this country to conform to that of certain other countries . . . we are not disposed to make any new law in this respect.”¹⁰⁴

Federal courts resisted incorporation of broad moral rights concepts into the federal common law for several reasons. First, judicial acknowledgment of unfettered moral rights would create apparent conflicts with basic principles of U.S. copyright law. An unconditional right of integrity or paternity, for example, might conflict with the statutory entitlement, under appropriate circumstances, to uncompensated use of works in the public domain.¹⁰⁵ Second, federal courts have refrained from adopting moral rights arguments in the absence of any clear standards defining the bounds of the asserted entitlements. One state court, for instance, faced with a moral rights claim brought by a composer, articulated the difficulty of ascertaining, in the absence of a defining federal law, what standards should govern purported moral rights violations: “Is the standard to be good taste, artistic worth, political beliefs, moral concepts, or what is it to be?”¹⁰⁶ At the very least, a great deal of litigation would be necessary to ascertain the limits of Berne’s moral rights if Congress adopted Berne as U.S. law by an unlimited act of ratification. The specters of fundamental change in United States copyright law and a potential flood of litigation have thus far convinced courts to refuse to adopt *in toto* the French concept of moral rights.

Federal courts, however, have shown some sensitivity to claims predicated upon moral rights-based allegations by applying state and federal laws that adequately protect the basic components of moral rights, namely the right of artists to receive adequate compensation for and retain control over their creative activity. Because of the adequacy of existing protections for creative rights, federal courts have managed to refrain from expanding American common law to include the broader

103. 164 F.2d 522 (7th Cir. 1947).

104. *Id.* at 526 (quoting S. LADAS, *supra* note 13, at 802). See also *Crimi v. Rutgers Presbyterian Church*, 194 Misc. 570, 89 N.Y.S.2d 813 (Sup. Ct. 1949) (action to compel defendant to remove obliterating paints on mural painted on defendant’s wall by plaintiff).

105. *Vargas*, 164 F.2d at 526.

106. *Shostakovich v. 20th Century Fox Film*, 196 Misc. 67, 71, 80 N.Y.S.2d 575, 579 (N.Y. Sup. Ct. 1948), *aff’d*, 275 A.D. 692, 87 N.Y.S.2d 430 (1st Dept. 1949) (accredited author of music used in film has no copyright protection even if author is offended by depictions in film).

French notions of moral rights. In *Geizel v. Poynter Productions*,¹⁰⁷ for instance, an artist urged the court, in the absence of specific contractual provisions preserving artistic integrity, to imply contractual prohibitions on a magazine publisher's ability to alter the artist's drawings. In rejecting the artist's argument, the court observed that "the doctrine of moral right [sic] is not part of the law of the United States [citations omitted], except insofar as parts of that doctrine exist in our law as specific rights—such as copyright, libel, privacy and unfair competition."¹⁰⁸ Similarly, the concurrence in *Granz v. Harris*¹⁰⁹ rejected a moral rights claim but awarded a judgment nonetheless on the grounds that existing common law already entitled the plaintiff to prevent publication of a "garbled version" of his product.¹¹⁰ Thus, existing American law was found sufficient to protect basic rights of artists.

3. Congressional Treatment of the Moral Rights Issue

The above opinions foresaw the compromise that enabled Congress to circumvent the potentially fatal fight over defining the bounds of moral rights. Congress avoided this pitfall by recognizing the emerging consensus among legal scholars that current federal and state laws provide protections for an author's rights sufficient to constitute compliance with Berne.¹¹¹ U.S. laws clearly supply great protection to the basic rights of artists to receive compensation for their creativity and to preserve, by contract or otherwise, the integrity of their works. In essence, these basic rights are the foundation of Berne's moral rights component. Therefore, existing U.S. protections satisfy the basic demands of the Berne Convention's moral rights provisions. This consensus was incorporated directly into S.1301, the Senate version of the Berne Convention copyright bill, through language promising that the implementing amendments would neither expand nor reduce existing copyright protections.¹¹²

At the outset of the legislative process, the Reagan Administration adopted a careful strategy to ensure that adherence to the Convention would not adversely affect the development of American copyright law.

107. 295 F. Supp. 331 (S.D.N.Y. 1968).

108. *Id.* at 340 n.5.

109. 198 F.2d 585 (2d Cir. 1952) (moral rights claim raised where defendant made recordings of plaintiff's singing and sold records without accreditation).

110. *Id.* at 590-91. See also *Edison v. Viva Int'l, Ltd.*, 70 A.D.2d 379, 421 N.Y.S.2d 203 (1st Dept. 1979), in which the court recognized that American judicial decisions have protected the integrity of authors and artists, but never on strictly "moral rights" grounds. *Id.* at 384, 421 N.Y.S.2d at 206. The express grounds on which common law protection has been given include libel, unfair competition, copyright, right to privacy, and tort. *Schoff v. Simon & Schuster*, 6 Misc.2d 383, 387, 162 N.Y.S.2d 770, 774 (Sup. Ct. 1957), *aff'd* 12 A.D.2d 475, 210 N.Y.S.2d 479 (1st Dept. 1957).

111. S. REP., *supra* note 8., at 9-10; H.R. REP., *supra* note 6, at 32-40. See *supra* notes 78-95 and accompanying text.

112. S. REP., *supra* note 8, at 10.

The Administration's bill, S. 1971,¹¹³ employed the same "neither expand nor reduce" language to eliminate the chance that moral rights might creep into the U.S. Code through Berne adherence.¹¹⁴ In addition, S.1971 states that Berne does not create an independent right to paternity or integrity, that Congress need not pass additional legislation to comply with Berne moral rights obligations, and that Berne is not itself a source of judicial relief.¹¹⁵ Thus, the Administration agreed that current U.S. copyright protections satisfied the moral rights component of Berne.

Despite these studied efforts to insulate the Berne implementation legislation from efforts to write new moral rights into U.S. law, pressure in favor of an expansion of U.S. law began to build prior to the hearings in the Senate on S.1301 and S.1971.¹¹⁶ Indeed the hearing itself featured prominent motion picture celebrities requesting such an expansion.¹¹⁷ The noted movie director and producer, Steven Spielberg, stated:

The Berne Treaty, Mr. Chairman, gives voice to this idea that art and the artist are not commodities to be treated like sausage. The Berne treaty gives to the artist a specific standing to object to a defacement of his or her work, and it recognizes moral rights as distinct from economic rights. . . . Our adversaries maintain that United States law is sufficient to qualify for Berne membership. . . . No film fantasy is as outlandish or as blatant as that claim.¹¹⁸

This pressure to adopt expansive moral rights was countered by a draft amendment which proposed to build a high insulating wall between any moral rights concepts and U.S. copyright law.¹¹⁹ Introduced during the hearings, this discussion amendment proposed enactment of a federal preemption on any state that might attempt by court decision to adopt the broad French model of moral rights. Although not actively pursued in subsequent negotiations on the implementation bills, this discussion draft served its purpose by neutralizing the pleas for enhanced moral rights, preserving the delicate compromise built into S.1301 and S.1971. S.1301 continued on the course of guaranteeing that Berne accession would not disrupt existing copyright relationships.

With the hearings complete, the Senate Judiciary Committee proceeded toward a compromise built on the premise that any implement-

113. *Hearings*, 100th Cong., *supra* note 4, at 27.

114. 133 CONG. REC. S.18408 (daily ed. Dec. 18, 1987) (statement by Senator Hatch).

115. *Id.*

116. The Washington Post, Feb. 28, 1988, at G1 (editorial by Director George Lucas).

117. See *Hearings*, 100th Cong., *supra* note 4, at 479-546 (statements of George Lucas and Steven Spielberg).

118. *Id.* at 502 (statement of Steven Spielberg).

119. 134 CONG. REC. S1670-1671 (daily ed. March 2, 1988) (statement by Senator Hatch).

ing legislation should leave undisturbed the delicate balance of rights U.S. law granted to domestic authors and copyright owners.¹²⁰ The Senate therefore effectively rejected any broad notions of incorporating moral rights language into American law and at the same time underscored its belief in the adequacy of current American law in providing protections sufficient to comply with Berne's protections. By means of a very terse comment in the Senate Report accompanying S. 1301 stating that "the 'moral rights' doctrine is not incorporated into the U.S. law by this statute,"¹²¹ the Senate paved the way for accession.

In the wake of the hearings, the leading members of the Senate Patents, Copyrights, and Trademarks Subcommittee entered negotiations on language to maintain the status quo on moral rights.¹²² Those discussions refined the basic compromise embodied in the implementing legislation. These adjustments included additional language to ensure that the Berne Convention would be given effect only under the Copyright Act (Title 17 of the U.S. Code) and relevant provisions of existing federal, state, and common law.¹²³ As the Senate Report explains, S.1301 "makes explicit what is implicit in the foregoing: that the Berne Convention is not directly enforceable in U.S. Courts."¹²⁴ With these slight alterations, in addition to the strongly expressed instruction that Berne is not self-executing,¹²⁵ S.1301 clearly avoided incorporation of the foreign concept of moral rights into American copyright law.

The House Judiciary Committee encountered similar pressures to employ the Berne Convention implementation bill to expand U.S. copyright law. At the outset of the legislative process in the House, Chairman Kastenmeier of the House Subcommittee on Courts, Civil Liberties and the Administration of Justice, which had jurisdiction over the implementation legislation, introduced a bill designed to "raise all the questions that must be asked for the fullest ranges of public and private interests to be aware of what Berne adherence will mean now and tomorrow."¹²⁶ This bill, H.R. 1623,¹²⁷ included many of the expansions which might bring U.S. law closer to the broad French concept of moral rights.¹²⁸

120. 134 CONG. REC. S.14553 (daily ed. Oct. 5, 1988) (statement by Senator DeConcini).

121. S. REP., *supra* note 8, at 10.

122. These negotiations featured primarily Senator DeConcini, the Chairman of the Subcommittee; Senator Hatch, the Ranking Republican on the Subcommittee; and Senator Leahy, the principal author of S. 1301. Several other Senators on the Subcommittee played leading roles in these negotiations and all legislative efforts on the Senate side, including Senator Simpson, Senator Grassley, Senator Kennedy, Senator Heflin, and the Chairman of the Judiciary Committee (Senator Biden) and the Ranking Republican on the Judiciary Committee (Senator Thurmond).

123. S. REP., *supra* note 8, at 39.

124. *Id.*

125. *Id.* at 38.

126. 133 CONG. REC. 1293-94 (daily ed. Mar. 16, 1987).

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

128. *Id.* at §§ 7, 13.

At the initial House Subcommittee hearings, the Magazine Publishers Association and the Coalition to Preserve the American Copyright Tradition, among others, voiced strong opposition to H.R. 1623.¹²⁹ Several witnesses at the hearings suggested that current U.S. law, “especially the common law, [is] fully sufficient to meet our obligations under Berne without the need for federal statutory provisions on the so-called ‘moral right.’ ”¹³⁰

At this juncture, the Chairman and several other members of the Subcommittee travelled to Geneva and Paris to consult with international copyright experts. In particular, these Congressmen were impressed by the statements of Dr. Bogsch.¹³¹

. . . it is not necessary for the United States of America to enact statutory provisions on moral rights in order to comply with Article 6 *bis* of the Berne Convention. The requirements under this Article can be fulfilled not only by statutory provisions in a copyright statute but also by the common law and other statutes.¹³²

As a result of these foreign consultations, Chairman Kastenmeier modified his bill and adopted a strong “minimalist” approach to compliance with the demands of the Berne Convention in H.R. 4262,¹³³ a subsequent version of the implementing legislation. By “minimalist,” Chairman Kastenmeier meant “making only those changes to American copyright law that are clearly required under the treaty’s provisions.”¹³⁴ This decision to pursue the least intrusive course was based on the view that existing American law protected the basic values of moral rights.

Under Chairman Kastenmeier’s leadership, the House resisted further strenuous efforts to incorporate moral rights into H.R. 4262. Accordingly, the moral rights provisions of the House and Senate bills were strikingly similar and House and Senate representatives quickly reconciled the two bills on the moral rights issue. Both the House and Senate agreed to adopt the notion that the implementing bill would neither expand nor reduce the scope of existing U.S. copyright law.

The 100th Congress, however, did not foreclose future Congresses or state legislatures from expanding U.S. intellectual property rights. Already the issue of colorization of black and white movies has prompted several witnesses at congressional hearings to recommend that the U.S. should adopt a right of integrity governing alterations of

129. *Berne Convention Implementation Act of 1987: Hearings on H.R. 1623 Before the Subcomm. on Courts, Civil Liberties, and the Administration of Justice of the House of Representatives Comm. on the Judiciary*, 100th Cong., 1st & 2d Sess. 331-408 (1988) (statements of Coalition to Preserve the American Copyright Tradition and the Magazine Publishers Association).

130. *Id.* at 692 (statement of Barbara Ringer).

131. *See also* text accompanying note 48.

132. H.R. REP., *supra* note 6, at 37.

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

134. H.R. REP., *supra* note 6, at 37.

movies.¹³⁵ Any future debates about the virtues of expanded protections for artists, however, will focus on the merits of such protections. Congress ensured that broad conceptions of moral rights will not indirectly creep into American law by virtue of U.S. adherence to Berne.

C. Self-Execution and Effective Date

The question of self-execution, i.e., whether the terms of a treaty become legally binding upon ratification or upon enactment of subsequent implementing legislation, is an issue that arises with nearly every treaty that passes through the Senate.¹³⁶ Self-execution is particularly relevant in the context of such provisions in the Convention as prohibitions against formalities and compulsory licensing¹³⁷ because Berne's traditional French notion of artistic rights differs from the demands of the U.S. Code.¹³⁸ If these Convention provisions were self-executing, federal courts would be obligated to acknowledge changes in U.S. law that Congress did not enact.

In light of these implications, Congress ensured that Berne would not be self-executing by including two provisions in the implementing legislation. First, both S.1301 and H.R. 4262 expressly state that Berne is not self-executing.¹³⁹ Second, by setting the effective date of the implementing legislation to coincide with the date of accession to the Convention, Congress ensured that the treaty would not take precedence over the implementing legislation by virtue of timing.¹⁴⁰ Otherwise, if the Convention were allowed to become effective ahead of the implementing legislation, courts would arguably be required to honor claims alleging that the treaty changed U.S. law in any suit filed before the implementing legislation took effect.

The language in the Implementation Act thus ensures that U.S. copyright laws would continue to govern all rights under the Berne Convention. In the direct words of the House Judiciary Committee report, "Berne's provisions themselves, and the simple fact of adherence to the Convention, will not in any way affect current law or its future development."¹⁴¹

135. See *Hearings*, 100th Cong., *supra* note 4, at 479-544 (statements of Lucas, Goldman, Spielberg and Directors Guild of America). See generally *Hearings on Colorization before the Subcomm. on Technology and the Law of the Senate Comm. on the Judiciary*, 100th Cong., 1st Sess. (1987).

136. See *Hearings*, 99th Cong., *supra* note 4, at 503 (discussing the distinction between self-executing and non-self-executing treaties and quoting *Whitney v. Robertson*, 124 U.S. 190, 194 (1888)).

137. Convention, *supra* note 5, at arts. 5 and 11.

138. See the jukebox compulsory licensing provision, 17 U.S.C. § 116 (1982) (conflicting with art. 11(1) of Berne); requirements to mark copyrighted material, 17 U.S.C. §§ 408-11 (1982) (conflicting with art. 5(2) of Berne); and compliance with copyright registration requirements as a prerequisite to judicial relief, 17 U.S.C. § 411(a) (1982) (conflicting with art. 5(2) of Berne).

139. S. REP., *supra* note 8, at 38; H.R. REP. *supra* note 6, at 2.

140. S. REP., *supra* note 8, at 28.

141. H.R. REP., *supra* note 6, at 39.

D. Jukeboxes and Other Compulsory Licenses

One aspect of United States law which needed revision to comply with Berne's requirements governed relations between jukebox operators and music copyright holders. Title 17 of the U.S. Code mandates the compulsory licensing of the performance of musical works on coin-operated jukeboxes.¹⁴² Article 11(1) of the Berne Convention prohibits some forms of compulsory licensing, including the jukebox license provisions of current law, in its provision that "[a]uthors of . . . musical works shall enjoy the exclusive right of authorising . . . the public performance of their works." This exclusive right applies to public performances "by any means or process."¹⁴³ Thus, Berne's public performance provisions cover performance by means of recordings. On its face, Article 11(1) conflicts with the jukebox compulsory licensing scheme of Title 17.¹⁴⁴

To remedy this conflict, the Implementation Act replaces the compulsory license in current law with provisions that adequately protect the domestic jukebox industry, but also comply with Berne. The Implementation Act allows copyright owners and jukebox operators to negotiate voluntary licensing agreements.¹⁴⁵ As long as the parties can voluntarily agree on performance rights in jukeboxes, their new licensing agreements will supprecede ratemaking by the Copyright Royalty Tribunal.¹⁴⁶ If the parties cannot agree, the Implementation Act permits the Tribunal to reinstitute a compulsory arrangement.¹⁴⁷ Pending completion of the voluntary negotiations, the terms of the compulsory license remain in place.¹⁴⁸

Mr. Ralph Oman, the Register of Copyrights, testified that by preferring voluntary agreements to a compulsory license, H.R. 4262 would satisfy the demands of Berne. He noted that "[s]ome Berne Union countries do regulate organizations representing authors and copyright proprietors, including the setting of fees."¹⁴⁹ Accordingly, the jukebox compromise embodied in the Implementation Act is analogous to existing arrangements in Berne Union countries.

While concluding that that jukebox licensing provisions required alteration under the public performances provision of Article 11(1), Congress rightly maintained other compulsory licensing schemes in Title 17. The cable compulsory license,¹⁵⁰ for example, is permissible

142. 17 U.S.C. § 116 (1982).

143. Convention, *supra* note 5, at art. 2(1)(i) (emphasis added).

144. See *Hearings*, 99th Cong., *supra* note 4, at 447 (report of the Ad Hoc Working Group on U.S. Adherence to the Berne Convention).

145. S. REP., *supra* note 8, at 33, 41-42.

146. *Id.* at 27.

147. *Id.* at 32-33, 42-43.

148. *Id.* at 33, 42.

149. *Hearings*, 100th Cong., *supra* note 4, at 154.

150. 17 U.S.C. § 111 (1982).

under Article 11*bis* (2) of Berne,¹⁵¹ which permits those compulsory licenses guaranteeing "authors of literary and artistic works" an "equitable remuneration . . . fixed by a competent authority" and having no extraterritorial application and no prejudicial effect on moral rights.¹⁵² Similarly, the mechanical license provided by § 115 of the Copyright Act¹⁵³ survives Article 13(1) of Berne,¹⁵⁴ which allows some compulsory licenses to record specified musical works.¹⁵⁵

E. Formalities

The Convention prohibits signatories from creating "formalities" which might pose obstacles for the "enjoyment or exercise" of rights of authors seeking copyright protection.¹⁵⁶ Formalities typically condition copyright protection on technical administrative rules.¹⁵⁷ Prior to the Implementation Act, U.S. copyright law contained several such procedural provisions, including requirements to mark copyrighted material with a small "c" in a circle,¹⁵⁸ requirements to register copyrighted material as a prerequisite to any enforcing lawsuit,¹⁵⁹ requirements to record a publication with the Library of Congress's Copyright Office before filing an infringement suit,¹⁶⁰ and renewal of registration in order to enjoy a second term of copyright protection.¹⁶¹

The mandatory notice of copyright, the circle "c" marking, falls so clearly within Berne's prohibition on formalities that both Senate and House bills recommended deletion of the requirement. Mandatory notice had been a feature of American copyright law for two centuries.¹⁶² To preserve many of the benefits of notice, H.R. 4262 encourages voluntary affixation of notice markings by instructing courts to disregard any claim of innocent infringement in mitigation of statutory or actual damages in an infringement action.¹⁶³ Innocent infringement

151. For an explanation of this view, see *Hearings*, 99th Cong., *supra* note 4, at 433-34 (report of Ad Hoc Working Group on U.S. Adherence to the Berne Convention).

152. Convention, *supra* note 5, at art. 11 *bis*(2).

153. 17 U.S.C. § 115 (1982 & Supp. 1986).

154. Convention, *supra* note 5, at art. 13(1).

155. See *Hearings*, 99th Cong., *supra* note 4, at 455-57 (final report of Ad Hoc Working Group on U.S. Adherence to the Berne Convention).

156. Convention, *supra* note 5, at art. 5(2), provides as follows:

The enjoyment and exercise of these rights shall not be subject to any formality; such enjoyment and such exercise shall be independent of the existence of the 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 the laws of the country whose protection is claimed.

157. *Hearings*, 99th Cong., *supra* note 4, at 454 (quoting WIPO Glossary of the Terms of the Law of Copyright and Neighboring Rights).

158. See 17 U.S.C. §§ 408-11 (1982).

159. See 17 U.S.C. § 411(a) (1982).

160. 17 U.S.C. § 205(d) (1982).

161. 17 U.S.C. § 304(a) (1982).

162. A mandatory notice requirement was contained in the original U.S. Copyright Statute. See Act of May 31, 1790, *supra* note 9.

163. H.R. REP. *supra* note 6, at 45.

does not act as a bar to copyright liability, but infringers have employed the doctrine to reduce damages upon a showing of unintentional (innocent) infringement.¹⁶⁴ H.R. 4262, however, clarified that the innocent infringement doctrine would not be available if a copyright holder had voluntarily marked the copyrighted work.

The primary controversy over formalities concerned mandatory copyright registration as a prerequisite to an author's right to seek judicial relief for infringement. Under § 411(a) of the 1976 Copyright Act, judicial enforcement of a copyright was not available until an author registered his copyright.¹⁶⁵ To the extent that this registration requirement conditions the exercise or enjoyment of a copyright upon a formality, § 411(a) is incompatible with Article 5(2) of Berne.

Concluding that mandatory registration was incompatible with Berne, the Senate Judiciary Committee recommended that Congress repeal the § 411(a) registration condition.¹⁶⁶ At the same time, however, the Committee strengthened incentives for voluntary registration. First, the Committee preserved the traditional *prima facie* evidentiary value of the certificate of registration, which shifts the burden of proof in an infringement action from the copyright holder to the alleged infringer if a work has been registered.¹⁶⁷ Second, to discourage technical copyright violations, the Committee enhanced relief for infringement of copyrighted works by increasing mandated statutory damages.¹⁶⁸ Third, the Committee retained provisions that shift attorney fees where a copyright holder must defend a registered copyright and prevails.¹⁶⁹ The objective of these incentives for voluntary compliance with registration procedures was to encourage copyright holders to continue to seek registration. This would enable courts to continue to rely on the registration scheme to simplify and otherwise streamline copyright litigation.¹⁷⁰

The Senate Judiciary Committee proposed to eliminate § 411(a) to discourage other nations from imposing onerous formalities on American copyright holders seeking foreign enforcement of their rights. In retaliation for preconditions to enforcement in U.S. courts, foreign governments could require an American copyright holder to endure lengthy waiting periods or to translate a work into a foreign language or to comply with other procedural requirements prior to qualifying for copyright protection. Members of the Senate Judiciary Committee believed that repealing § 411(a) would preempt potential foreign retaliation by preventing foreign governments from using American registration

164. *Fitzgerald Publishing Co. v. Baylor Publishing Co.*, 807 F.2d 1150 (2d Cir. 1986). *See also* 17 U.S.C. § 501(a) (1982).

165. 17 U.S.C. § 411(a) (1982).

166. S. REP., *supra* note 8, at 12-26.

167. *Id.* at 46.

168. *Id.* at 37.

169. *Id.* at 46. *See* 17 U.S.C. § 412 (1982).

170. S. REP., *supra* note 8, at 12-26.

requirements as a ready pretext.¹⁷¹

The House of Representatives Judiciary Committee, on the other hand, maintained the strict "minimalist" approach. Arguing the distinction between rights and remedies, the House Judiciary Committee contended that registration was not a bar to the substantive rights of copyright holders, but only a procedural step—like court filing fees—necessary to enter the courthouse.¹⁷² In other words, failure to register, according to the House Committee, did not cause a "loss of copyrights." Unregistered foreign copyright holders would continue to enjoy and exercise their rights in the U.S. Moreover, registration was necessary to promote efficient litigation practices and to preserve the Library of Congress's ability to acquire new works.¹⁷³

Ironically, this esoteric legal question became the central issue in negotiations between the House and Senate to reconcile S. 1301 and H.R. 4262. At the outset of the legislative process, the moral rights issue loomed as the major threat to Berne Convention ratification, yet in the latter stages of the process, the formalities issue became the primary point of debate between the houses. Ultimately, the House and Senate found a perfect compromise, a middle ground that maintained the spirit of "minimalism" and the virtues of domestic registration while still ensuring that no foreign nation would have cause to impose retaliatory formalities on U.S. copyright holders. The compromise provision¹⁷⁴ does not repeal § 411(a) *in toto*, but still manages to eliminate any formality taint.¹⁷⁵ The Ad Hoc Working Group on Compliance with the Berne Convention paved the way for this compromise when it noted in hearings during the 99th Congress that "Section 411 is . . . not incompatible with Berne to the extent that it requires registration of a work of which the United States is not the country of origin."¹⁷⁶ In other words, so long as a foreign copyright holder does not have to comply with the registration requirement, the United States is free to impose stricter procedural requirements on its own nationals.

The Implementation Act thus contains a two-tiered registration system.¹⁷⁷ American law still requires United States authors to register a copyright prior to judicial enforcement of their rights.¹⁷⁸ United States law will not, however, require foreign authors or copyright holders to register a copyright prior to initiating an infringement action in this

171. *Id.*

172. H.R. REP., *supra* note 6, at 41.

173. *Id.* at 41-42.

174. 102 Stat. 2853 (1988).

175. H.R. REP., *supra* note 6, at 37.

176. *Hearings*, 99th Cong., *supra* note 4, at 473.

177. See 134 CONG. REC. S.14553 (daily ed. Oct. 5, 1988) (statement by Senator DeConcini).

178. S. REP., *supra* note 8, at 24 ("[E]ven without the gatekeeping function of section 411(a), the law gives copyright claimants strong disincentives to come to court without a registration certificate . . .").

country.¹⁷⁹ This new provision clearly satisfies Article 5(2) of Berne. Although the new law imposes harsher registration requirements on United States citizens than on foreign authors, the Act contains benefits making registration an attractive option. Moreover, with the enactment of H.R. 4262, as amended, American law no longer burdens foreign copyrights with additional formalities. No foreign nation therefore can justify imposing formalities on American copyright holders who attempt to enforce their rights abroad.

Conclusion

For years the United States chose to abstain from the important benefits stemming from membership in the Berne Union. Crescendoing international pressure, increased incidence of piracy, and the realization among legal scholars that United States law would not require a massive overhaul to comply with Berne encouraged Congress to ratify the Convention. After extensive hearings during the 99th and 100th Congresses, Congress finally realized that as the world's foremost exporter of copyrighted material, the United States has the most to gain from Berne membership.

Aside from the benefits that will accrue to the American copyright industry, ratification of Berne also strengthened United States credibility and bargaining power in the international community. American negotiators now have a better bargaining position when encouraging other nations to combat piracy and when attempting to achieve further international copyright protections at GATT sessions. As Secretary Verity noted,

all societies ultimately must make a choice: do they wish to be known for encouraging their citizens to apply their creative talents to the production of paintings, music, sculpture, cinema, literature, computer software, or various other works that make our lives so much fuller and richer? Or do they wish to be known as nations that steal what others create?¹⁸⁰

By ratifying Berne, the United States announced its choice to advance the progress of literature and the arts internationally by providing substantial copyright protection to authors and artists of all nations.

179. 134 CONG. REC. S.14554 (Joint Explanatory Statement on Amendment to S.1301) ("It thus avoids creating the undesirable precedent that would buttress other potential or current Berne adherents in arguing that they may impose truly onerous registration requirements on foreign works, including works of U.S. origin, without offending Berne standards").

180. *Hearings*, 100th Cong., *supra* note 4, at 72.

