1994

Surveying the Borders of Copyright

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SURVEYING THE BORDERS OF COPYRIGHT*

by JANE C. GINSBURG**

INTRODUCTION

The copyright course I teach at Columbia Law School begins with a survey of what copyright is not: it is not a patent, a trademark, or an object of physical property. Nor, as the course examines a little later on, does copyright protect every object of economic value whose worth might be further enhanced were it to be shielded from unauthorized copying. However, the frontiers between copyright and mere commercial value have never been well defined. Not only may the same item be simultaneously the object of copyright and of other legal rights, but copyright increasingly covers — or is invoked to extend to — products far from the "beaux arts," but that present strong economic claims to security from copying. Digital technology does not initiate this phenomenon, but it accentuates the longstanding pressure on the copyright system to encompass a broad variety of information products.

Ironically, at the same time as new entrants (as well as some old suitors in newfangled, binary garb) are pushing at the borders of the subject matter of copyright, a variety of extra-copyright devices are emerging to ensure the protection of works of authorship. This survey of the placement of copyright's boundaries therefore requires examination also of the frontier between protection granted under the copyright law, and under other laws invoked to prevent unauthorized copying or public performance.

In this presentation, I propose first to outline ways in which the borders of copyright may be drawn . . . or overrun (I). I will consider the boundaries both of subject matter (A), and of rights (B). I will then examine the international consequences of locating the borders in the various ways suggested (II). While many of my examples will feature digital media, much of the analysis that follows would apply to analog media as well.

I. BORDERS: POSITION AND PERMEABILITY

A. Placing Limits on the Subject Matter of Copyright

There are a variety of responses to the problem of the perceived ill-definition of the boundaries of the copyright domain. One reaction would

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*This article is based on a presentation made at the WIPO Symposium on the Future of Copyright and Neighboring Rights, Paris, June 3, 1994.

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retrench and reinforce the walls between copyright and other kinds of creativity or fruits of labor and investment.(1)[1]

A less xenophobic approach would decline to expel as illegal aliens those newer forms of creativity seeking shelter on the copyright shore. Rather, this approach contends that the copyright system, having in fact allowed a variety of immigrants to enter, should seek, to the extent possible, to naturalize them, taking account of adaptations needed to adjust the newcomer to society.(2)

Alternatively, having acknowledged that the borders of copyright — long ago and frequently since permeated — will remain porous, a final approach recognizes that those borders now accommodate a variety of permanent residents. These are creations or fruits of labor and investment that share some characteristics with copyright subject matter, but that cannot avail themselves of full copyright citizenship because in other respects they either fail to meet even expansive copyright criteria, or copyright fails to meet their economic needs. These works may claim some of the benefits of copyright protection, but they will be subject to parallel non copyright regulation as well.(3)

1. Reinforcing the Borders

This approach would secure the purity of copyright by expelling works of low (or no) authorship from the copyright domain. "Quasi creation,"[2] and the fruits of labor and investment may merit protection from unauthorized copying, but that protection should be autonomous. Under this approach, copyright would close its borders to unworthy intruders, leaving them to more appropriate, possibly *sui generis*, protection. Those to be excluded include: computer software, databases and compilations of information, some photographs, sound recordings, and some applied art.

2. Bringing New Entrants Within the Boundaries

Under this approach, copyright would welcome a variety of marginal claimants to protection, so long as they manifested the minimal creativity sufficient to meet a generous standard of originality. But, admission of these works to copyright status does not require uniformity of organization of their copyright regime. Adjustments to the traditional copyright provisions may be made with respect to ownership of copyright, and the scope of rights protected (or scope of exceptions to protection).

A leading example of this approach is the 1991 European Community Software Directive.[3] This text confirms the copyrightability of computer

[1] The numbers given in this and succeeding paragraphs refer to sections immediately following.

[2] See Mireille Buydens, *La protection de la quasi-création* (1993).

[3] Directive 91/250, OJEC n. L. 122/42, May 17, 1991 [hereinafter, "Software Directive"].

programs, but derogates from traditional copyright protection in a variety of ways. The standard of originality is arguably lower than that required in some EC countries for more traditional works.[4] The Directive provides for employer copyright ownership of employee-created software, even though in many member countries employers are not the direct owners of works of salaried creators.[5] The Directive also sets forth several exceptions derogating from the reproduction and derivative works rights, in favor of the interests of users or competitors.[6] Thus, the Directive does set forth a copyright regime, but the system it creates, while easily recognizable to anglo-americans, significantly departs from some continental copyright percepts.

3. Cohabiting with Copyright

This approach concerns works for which copyright provides partial, but inadequate, coverage. Copyright fails to afford sufficient security for the economic interests at stake because copyright protects original authorship, and the work's economic value may reside, at least in part, in unoriginal features. Adequate protection therefore requires either a broadening of copyright beyond the borders of originality, or combining copyright protection with an additional source of protection, such as that afforded by unfair competition law. An important example of the latter technique is the proposed European Community Draft Directive on the protection of databases.[7]

The Draft Directive acknowledges the copyrightability of databases, but only insofar as they manifest originality in their selection or arrangement of data.[8] Unoriginal compilations are not entitled to copyright protection. Similarly, the scope of copyright protection is limited to the substantial copying of original aspects of the database; it is not copyright infringement to extract data independently of its treatment (selection and organization) in the database.[9] However, the Draft Directive further establishes a right to prevent "unauthorized extraction" of data. The extraction right applies to data of any kind original or not. Thus, unauthorized appropriation of data from a database may violate the rights set forth in

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[4] The Directive defines an original work as the author's "personal intellectual creation," art. 1.3. This standard may be more permissive than the "personal imprint of the author" ("l'empreinte personnelle de l'auteur") standard that predominates in most continental copyright systems.

[5] Software Directive, art. 2.3.

[6] Id., arts. 5, 6, 9.

[7] COM(93) 464 final — SYN 393, OJEC No. C 308/1, Nov. 11, 1993 (as modified by the Commission following the examination by the European Parliament of June 23, 1993).

[8] Id., art. 2.3.

[9] Id., art. 6.

the Draft Directive, whether or not the database is copyrightable, and whether or not the extracted data meets originality standards.[10] Here, unfair competition law supplements copyright law, with respect to the same work.

B. Overrunning the Frontier: Using Contract or an Extra-Copyright Regime to Achieve Copyright-Like Results

The focus of this survey of the borders of copyright now shifts from the subject matter that may or may not be covered by copyright, to the scope of protection afforded to works of authorship. To an increasing extent, copyright law is not the only law to secure protection against reproduction and public performance of copyrighted works. Both private parties and states have in a variety of circumstances provided for parallel or substitute protection, by means of extra-copyright doctrine or legislation. Extra-copyright means to achieve copyright ends include contracts (1) and a variety of narrowly-focussed laws, addressing for example private copying, that mirror copyright coverage, but that purport to fall outside copyright (2).

1. Contracts as Copyrights

Traditionally, only a property right, enforceable against third parties, could ensure effective protection for authors (or exploiters), because the author could not control copying once the work was released to the public. But today, computers have to some extent furnished the means to restore control over third party exploitation of a work. If a work is available only "on line," the information provider can know who has access to the work, and can impose by contract the conditions of use. Some of this kind of control may also be imposed on free-standing digital media, such as CD-ROM and diskette, through subscription agreements, encoding, and even insertion of viruses.

If it is true that the author/information provider can effectively control the access and exploitation of the work, then the provider may seek to substitute contractual protection for copyright coverage. By contract, the provider may ensure a broader scope of protection than copyright would afford, for example, by overriding exceptions set forth in the copyright law, such as the right (available in many countries) to make private copies. Moreover, by contract, the information provider may secure protection for material that may not be copyrightable.

From the provider's point of view, contract may therefore prove a more attractive means of obtaining the same, or more, protection than that available under copyright. By outstripping copyright protection, a

[10] Id., chapter III, arts. 10-13.

vigorous contract regime may afford the information provider the incentive to seek, develop, and commercialize information that, under a copyright regime, might not have been worth pursuing. However, from the user's point of view, a contract regime, if it eludes user-rights available under copyright, drives a one-sided bargain for access to information, to the detriment of the balancing of rights set forth under copyright.[11]

2. Copyright Equivalents

Coupling other laws to copyright is not a new development. For example, trademarks law in the U.S., and unfair competition law in many Continental European countries, have long afforded additional protection against some kinds of unauthorized copying. The problems spawned by private copying, however, have prompted additional legislative techniques in a variety of countries. For example, the 1992 U.S. Audio Home Recording Act[12] creates a special regime to compensate creators for private copying of works distributed or transmitted in digital format (as well as to combat certain forms of private copying). While this law addresses unauthorized reproduction, the U.S. Congress distinguished it from the general copyright law, by codifying the Act in a separate chapter of Title 17 (as Congress had previously done in the 1984 Semiconductor Chip Protection Act[13]), and by providing that the new Act's compensatory measures and other sanctions replaced copyright infringement actions.[14]

If member countries of the Berne Convention adopt (as the EC has for software) any of these approaches to defining, or reshaping, the boundaries of copyright, what are the consequences for the structure of the international copyright system?

II. PLACEMENT OF COPYRIGHT BORDERS WITHIN THE BERNE UNION: THE INTERNATIONALIZATION OF COMPETING DEFINITIONS OF THE COPYRIGHT DOMAIN

Each of the approaches reviewed above carries different international consequences.

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11 On the potential substitution of contract for copyright protection, see, e.g., Zentaro Kitagawa, *Computers, Digital Technology and Copyright*, paper presented at the WIPO Symposium on the Future of Copyright and Neighboring Rights, Paris, June 2, 1994 (proposing a contract-based "Copymart" system for the distribution and protection of works in digital media); Jane Ginsburg, *Copyright Without Walls? Speculations on Literary Property in the "Library of the Future"*, 42 Representations 53 (1993).

12 17 U.S.C. §§ 1001-1010.

13 17 U.S.C., chapter 9.

14 17 U.S.C. §§ 1008, 1009.

A. Subject Matter of Copyright

1. Copyright Purified

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 endeavor. 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 kinds of works, if not listed in the treaty, do not come within the Berne minima of protection. However, article 10,1 of the recently-concluded GATT-TRIPS agreement limits Berne and other GATT members' freedom to define the subject matter of copyright, by obliging them to protect computer software as literary works within the meaning of the Berne Convention, and article 10,2 requires member countries to protect databases as intellectual creations.

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 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.[15]

For example, suppose a Berne member, having adopted the first approach outlined above,[16] determined that compilations of data are not literary works. The current text of the Berne Convention does not oblige the member country to include compilations of data (as opposed to compilations of "literary or artistic works"[17]) among the classes of protected works. As a result, under the rule of national treatment, neither local nor foreign Berne Union compilations would receive any copyright protection in that forum. Similarly, foreign and domestic compilations that did not meet the forum's (perhaps unusually high) standard of originality would not be covered.[18]

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15 See, e.g., German Federal Republic, BGH Decision of May 9, 1985, GRUR 1985 at p. 1041, *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 or originality).

16 See Part I, A 1, supra.

17 See Berne Convention, art. 2.5.

18 If adopted, the Database Directive would impose a "personal intellectual creation" standard of originality, see art. 2.3. The Directive would thus limit member countries' ability to exclude databases from copyright by raising

2. Copyright Expanded

Under this approach, the Berne member, rather than retracting the borders of copyright, will have expanded them to take in works not included in article 2.1's illustrative list, or to give a generous interpretation of the categories set forth elsewhere in that article. This technique is 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.[19] Thus, once a member country includes a category of works within copyright, it will protect Unionist works of that kind under copyright as well.

But, what if the scope or terms of copyright granted these works differ from the traditional copyright regime? The analysis will depend on whether the departures from traditional copyright nonetheless remain consistent with Berne minima.

a. Berne-Compatible Divergences

The Berne Convention sets forth not only what kinds of works must be protected, but also what rights must be secured, as well as the kinds of permissible exceptions to protection.[20] The treaty does not, on the whole, define who shall be the copyright owner.[21] Thus, the treaty sets forth minimum rights to be protected, but does not impose standards as to who shall be the owner of those rights.

The EC Software Directive affords an example of a modified copyright regime that remains consistent with Berne standards. The Directive's limitations on the exclusive rights of reproduction and adaptation can be said to fit within article 9.2's authorization to member countries to adopt exceptions that do not conflict with the "normal exploitation" of the work. Alternatively, the Directive's limitations can be justified as means to avoid monopolization of ideas and processes by the software copyright holder. Since the Berne Convention does not protect ideas, limitations of the kind set forth in the Directive would be incompatible.

The Directive also modifies the regime of copyright ownership by derogating from the general copyright law of many EC countries that vests copyright ownership in the physical creator of a work, whatever her employment status. This feature of the Directive is nonetheless consistent

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the requisite level of originality. However, the Directive only applies to electronic compilations, see art. 1.1.

Article 10,2 of the GATT TRIPS agreement applies an "intellectual creation" standard to compilations, without regard to the format of the compilation.

19 See art. 19.

20 See arts. 6bis, 8-14.

21 But see, art. 14bis, regarding cinematographic works.

with the treaty, because the treaty does not impose a general requirement that the human creator of a work be the copyright owner.[22]

b. Divergences Falling Below Berne Minima

If a Berne member accords copyrighted works fewer rights than those whose protection the treaty requires, one might conclude that that 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 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 subject matter of copyright. However, some countries, for example the United States, do provide for copyright protection of sound recordings.[23] On the other hand, the United States does not afford sound recordings the full scope of copyright protection: there is no public performance right in a sound recording.[24] By contrast, the Berne Convention set forth the public performance right as a minimum right.[25] 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.

c. Summary

Thus, the international consequences of broadening copyright boundaries to include works not traditionally within the subject matter of copyright would be as follows:

> — If the member country determines that the 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 Convention.

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[22] But see, e.g., Sam Ricketson, *People or Machines: The Berne Convention and the Changing Concept of Authorship*, 16 Colum.-VLA J. Law & the Arts 1 (1991) (contending that the Berne Convention implicitly designates the human author as copyright owner).

[23] See 17 U.S.C. § 102(a)(7).

[24] See 17 U.S.C. § 106(4).

[25] See Berne Convention, arts. 11, 11 bis., 11 ter.

However, nothing in the Convention prohibits that country from according the work a *different* scope of protection than that granted other kinds of copyrighted works, so long as the specific protection remains consistent with Berne standards.

Moreover, the Convention permits a member country to organize the copyright ownership of the work differently from the traditional ownership regime.

— If 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 incorporates an international consensus as to the meaning of its terms (or at least, some of the terms — as Dr. Ficsor has argued with respect to computer programs).[26] 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).

3. Copyright Plus

For subject matter that the member country protects in part by copyright, and in part by another legal regime, 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 regime 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. Thus, the Berne member would not be obliged to grant national treatment with respect either to subject matter that does not qualify for copyright, or to rights that are more extensive than those available under copyright.

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[26] See Mihály Ficsor, *New Technologies and Copyright: Need for Change, Need for Continuity*, paper presented at the WIPO Symposium on the Future of Copyright and Neighboring Rights, Paris, June 3, 1994.

For example, the EC Draft Database Directive would be subject to Berne standards in its regulation of copyrightable databases; it would not be in its creation and regulation of the copyright-independent "unauthorized extraction" right. Under article 13, EC nations, albeit Berne members, would therefore be free to condition extra-EC extension of the extraction right on demonstration of reciprocal protection by non EC nations.

B. Copyright-Equivalent Rights: International Consequences of Imposing Protection Under Other Legal Regimes

When a Berne member nation affords copyright-equivalent protection to works that come (at least in part) within the subject matter of copyright, but make this protection available under a legal rubric other than copyright, what are the consequences for foreign works? The answer may depend on whether the protection results from contract law (1), or from an extra-copyright regime (2).

1. Substituting Contract for Copyright

Once one departs from copyright territory to consider the international consequences of parallel contract protection, the Berne Convention is no longer at issue. Rather, in the absence of a specific treaty, this question falls within the domain of the international private law of contracts. The general subject of conflicts of law is beyond the scope of this discussion; I will therefore confine this discussion to two observations.

First, in most instances, one may anticipate that the information provider will have imposed a choice of law governing the agreement in its contract with the users. Since the general contracts conflicts of law rule respects the choice of the parties, that may be the end of the issue. However, it is possible to imagine that if the substantive terms of the contract depart drastically from copyright norms (particularly with respect to user rights), those terms may violate the public policy either of the country whose law has been chosen to regulate the contract, or of the forum.

Second, if the parties have not chosen an applicable law, the contract would be "localized" in light of a variety of factors including: the parties' residence (place of business), or nationality; the place of origin of the information; the place of receipt of the information. Each forum is likely to make its own determination of what weight to give these factors. Finally, it remains possible that even after finding the national law applicable to the contract, the forum may find that (foreign) law to violate local public policy, if that law would uphold contractual provisions that are deeply inconsistent with local copyright norms.[27]

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[27] For example, in the U.S., several judicial decisions and academic commentary suggest that anticompetitive contractual conditions on access to or exploita-

2. Extra-Copyright Protection of Copyright Subject Matter

Having earlier considered the international impact of *sui generis* protection of productions falling outside the boundaries of copyrightable subject matter,[28] one should also address the international consequences of provisions, such as U.S. 1992 Audio Home Recording Act, that concerns works coming within the subject matter of copyright, but that purport to create a distinct, extra-copyright, regime of protection.

Providing copyright-like protection by extra-copyright means is not new to the Berne system. A notable and venerable example is the U.K.'s recourse to a variety of doctrines, particularly defamation, to secure a level of protection of moral rights compatible with the Berne standard introduced in the 1928 revision.[29] The U.S. adopted the same course when it adhered to the Berne Convention in 1989. While the U.S. and the U.K. 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.[30]

From this example, one might conclude that what counts for Berne compatibility is not the form of 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 of 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 U.S. Audio Home Recording Act of 1992 purports, in response to the anticipated private copying of digitally recorded works,

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tion of copyrighted works may be invalidated as "copyright misuse." See, e.g., *Lasercomb America, Inc. v. Reynolds*, 911 F.2d 970 (4th Cir., 1990); Phillip Abromats, *Copyright Misuse and Anticompetitive Software Licensing Restrictions*, 52 U. Pitt. L. Rev. 629 (1991); David A. Rice, *Public Goods, Private Contract and Public Policy: Federal Preemption of Software License Provisions Against Reverse Engineering*, 53 U. Pitt. L. Rev. 543 (1992).

28 See II A 3, supra.

29 See, e.g., Sam Ricketson, The Berne Convention for the Protection of Literary and Artistic Property: 1886-1996 § 8.98 (1987).

30 See, e.g., Adolph Dietz, *The United States and Moral Rights: Idiosyncrasy or Approximation — Observations on a Problematical Relationship Underlying U.S. Adherence to the Berne Convention*, R.I.D.A. No. 142, October 1989 at p. 222.

to install an extra-copyright regime 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 U.S. 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 U.S.).[31] 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 levied. These measures have been justified as non-copyright "taxes," on the ground that the proceeds do not go entirely, or directly, to authors.[32] To the extent the sums are distributed to authors, I believe we are back in the realm of copyright, whatever the name of the regime, 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.)

CONCLUSION

The borders of copyright are being at once stretched, and compressed. On the one hand, new entrants, including works expressed in digital media, seek to be counted among the citizens of the copyright world. On the other hand, both private parties through contract, and states, through extra-copyright legislation, seek to complement, or even substitute, extra-copyright means to protect copyrightable works. The international consequences of these border actions vary. The analysis here proposed suggests that Berne members may still enjoy some autonomy in the decision whether or not to include certain kinds of works in the copyright domain, although the GATT-TRIPS agreement imposes considerable limitations on that freedom, with respect to computer software and databases. However, once the work's copyright status is settled, its protec-

31 See 17 U.S.C. §§ 1001(7); 1006.

32 See generally Gillian Davies and Michèle E. Hung, Music and Video Private Copying: An International Survey of the Problem and the Law, 218-21 (1983).

tion against unauthorized copying and public performance should be the same for local and for foreign works, whatever the local legislative label attached to that protection.