

# UIC REVIEW OF INTELLECTUAL PROPERTY LAW



U.S. COPYRIGHT LAW, STATUTORY DAMAGES, AND BERNE CONVENTION NATIONALITY

GREGORY GERARD GREER

ABSTRACT

This paper answers the question, “Should the formality of filing with the United States (U.S.) Copyright Office by foreigners be required in order for works produced by foreigners to receive statutory damages?” To this end, this paper will demonstrate that the relevant separate topics (as explored in each chapter of this paper), when individually presented, cannot answer the question posed; however, when combined, as Aristotle said, “The whole is greater than the sum of its parts.” This paper argues that registration by foreign copyright owners should not be required, in line with the Berne Convention, of which the U.S. has been a member since 1989. This issue—the formality of registration with the U.S. Copyright Office not being required by foreigners in order to be eligible to receive statutory damages—was addressed by the Second Circuit in 2009 in *Football Ass’n Premier League v. Youtube, Inc.* This paper also explores a missed opportunity in the Fourth Circuit in 2005—*Greer v. Krause Publications, Inc.*—that could have been the first opportunity to address this issue, four years before the *Football* case.



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DEDICATION

This research paper is dedicated to my parents, Ralph Stephen Greer (1931–2022; The George Washington University Law School, Class of 1968, Order of the Coif, First in Class) and Charlotte Dudley (1934–2021; mother of five children) (see Figure 1).

Mr. Greer would like to thank the ongoing friendship over the last twenty-three years with Hironobu Tsukamoto, Esq., co-representative of Nagashima Ohno & Tsunematsu NY LLP, in New York City, New York, which, at one time, was the only major Japanese law firm in the United States. “GGG” and “HT” worked together at Nagashima Ohno & Tsunematsu after Nagashima & Ohno and Tsunematsu Yanase & Sekine merged in 2000 to become Japan’s largest and arguably most esteemed law firm. HT and GGG have seen a lot together over the last quarter-century. HT is a graduate of Kyoto University’s LLB and University of Chicago’s LLM and a member of the New York State Bar.

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Mr. Greer would finally like to thank Professor Steve Charnovitz, Associate Professor of Law, The George Washington University Law School, BA, Yale College, JD, Yale Law School, MPP, Kennedy School of Government at Harvard University, who advised Mr. Greer on the original research paper this article is based on.

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\* © 2023 Gregory Gerard Greer served seven years as a Federal Civilian Employee at the United States Department of Agriculture’s National Agricultural Statistics Service prior to acceptance to the 1998 Japan Exchange & Teaching (JET) program where Mr. Greer worked for one year in Iwaki, Fukushima, Japan, then was hired by Japan’s largest law firm Nagashima & Ohno in 1999. Mr. Greer has since graduated a British law degree and will be graduating a second LLM (in International Law) at The George Washington University Law School in Washington, D.C.



**Figure 1: My parents, Ralph Stephen Greer, and Charlotte Dudley, are photographed here in June 1953 on Graduation Day at the United States Military Academy at West Point, where they both married the same day.**

## INTRODUCTION

The research method for this paper was internet-based—that is, searching the internet for explanations for each individual topic. Chapter 1 explains U.S. copyright law. Chapter 2 explains copyright infringement under U.S. copyright law. Chapter 3 analyses and compares U.S. copyright infringement and the Berne Convention. Chapter 4 examines the Berne Convention in relation to nationality. Chapter 5 discusses “turning Japanese” and a potential missed opportunity before the Fourth Circuit in relation to the formality of registration with the U.S. Copyright Office vis-à-vis eligibility for statutory damages. Chapter 6 concludes the paper.

## CHAPTER 1: U.S. COPYRIGHT LAW

What is U.S. copyright law in 2023? *Ab initio*, it should be noted that, in 2023, “[t]here is a degree of overlap between [the legal protections afforded to] design ..., copyright, and trademark, and the rights are not mutually exclusive.”<sup>1</sup> Both copyright protection and design patent protection are possible when “an ornamental feature of an article of manufacture can be separated from the underlying useful article.”<sup>2</sup> Also, both copyright protection and trademark protection are possible when “there is a copyrightable work acting as a source identifier[.]for example[,] logos and product packaging.”<sup>3</sup> Therefore, copyright has potential protection within all the intellectual property categories with the exception of trade secret law. (The intent behind trade secret law is that only the owner actually knows the trade secret,<sup>4</sup> the opposite of the public disclosure requirements of copyright, patent, and trademark law).<sup>5</sup>

American copyright law can trace its roots to the late 15th century and the printing press.<sup>6</sup> As the use of printing presses grew, “authorities sought to control the publication of books by granting printers a near-monopoly on publishing [the ability]

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<sup>1</sup> *Copyright Laws and Regulations USA 2023*, ICLG (Oct. 18, 2022), <https://iclg.com/practice-areas/copyright-laws-and-regulations/usa>.

<sup>2</sup> *Id.*

<sup>3</sup> *Id.*

<sup>4</sup> Lawrence Goodwin & Stacy Grossman, *Trade Secrets*, N.Y. CITY BAR LEGAL REFERRAL SERVICE (Dec. 2018), <https://www.nycbar.org/get-legal-help/article/intellectual-property/trade-secrets/#:~:text=In%20general%2C%20a%20trade%20secret,to%20protect%20the%20trade%20secret> (“In general, trade secret protection confers owners the right to prevent the information lawfully within their control from being disclosed, acquired or used by others without their consent in a manner contrary to honest commercial practice.”); *Frequently Asked Questions: Trade Secrets*, WIPO, [https://www.wipo.int/trademarks/en/trademarks\\_faqs.html#:~:text=What%20are%20the%20rights%20conferred%20by%20trade%20secrets%3F](https://www.wipo.int/trademarks/en/trademarks_faqs.html#:~:text=What%20are%20the%20rights%20conferred%20by%20trade%20secrets%3F) (last visited July 20, 2023).

<sup>5</sup> Victor Memo Campos, *Who Says There’s No Disclosure Requirement for All Intellectual Property Law Subjects: The Case for the Existence of Disclosure Requirements in Copyright and Trademark Law?*, LAW SCHOOL STUDENT SCHOLARSHIP 190, 193 (2013), [https://scholarship.shu.edu/cgi/viewcontent.cgi?article=1190&context=student\\_scholarship](https://scholarship.shu.edu/cgi/viewcontent.cgi?article=1190&context=student_scholarship).

<sup>6</sup> *Copyright Timeline: A History of Copyright in the United States*, ASSOC. OF RESEARCH LIBRARIES, <https://www.arl.org/copyright-timeline/#:~:text=The%20history%20of%20American%20copyright,monopoly%20on%20publishing%20in%20England> (last visited Mar. 1, 2023) (hereinafter *Copyright Timeline*).

to publish [] in England.”<sup>7</sup> The Licensing Act of 1662 cemented copyright monopoly in England and established a register of licensed books to be administered by the Stationers’ Company—a group of printers with the authority to censor publications.<sup>8</sup>

The Licensing of the Press Act of 1662 ended in 1695 and allowed the government to arrest control from the Stationers’ Company.<sup>9</sup> In 1710, English Parliament enacted the Statute of Anne to address the concerns of English booksellers and printers.<sup>10</sup> This Act gave authors copyright ownership for a term of 14 years and, assuming the author was alive upon expiration, made copyright renewable for another 14 years.<sup>11</sup>

By protecting the interests of authors and preventing a monopoly controlled by booksellers, the Statute of Anne created a book sellers’ public domain for literature where a copyright owner no longer controlled a work’s use after the term limits expired or if the work was sold.<sup>12</sup> Though the Statute of Anne created author copyright, there was only a marginal benefit since sale to a publisher was necessary if the author was to be compensated for their work.<sup>13</sup>

In the 300+ years since the passage of the Statute of Anne, U.S. law has broadened the scope of copyright by changing the term limits of copyright protection and addressing new technologies.<sup>14</sup> According to the U.S. Copyright Office, “Copyright is a type of intellectual property that protects original works of authorship as soon as an author fixes the work in a tangible form of expression.”<sup>15</sup> A work is fixed when it is in “any tangible medium of expression, now known or later developed, from which [the work] can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”<sup>16</sup> Further, “there are a lot of different types of works, including paintings, photographs, illustrations, musical compositions, sound recordings, computer programs, books, poems, blog posts, movies, architectural works, [and] plays.”<sup>17</sup>

In addition to the fixation requirement, there is an originality requirement.<sup>18</sup> In *Feist v. Rural*, the U.S. Supreme Court held that “the requisite level of [originality and] creativity is extremely low; even a slight amount will suffice.”<sup>19</sup> Nonetheless, “some works do not meet that low standard. For example, the white pages section of a phone book does not have enough creativity to be copyrightable.”<sup>20</sup> Independent creation is

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<sup>7</sup> ALLEN KENT & HAROLD LANCOUR, COPYRIGHT: CURRENT VIEWPOINTS ON HISTORY, LAWS, LEGISLATION (1972).

<sup>8</sup> *Id.*

<sup>9</sup> *Id.*

<sup>10</sup> *Copyright Timeline*, *supra* note 6.

<sup>11</sup> *Id.*

<sup>12</sup> *Id.*

<sup>13</sup> *Id.*

<sup>14</sup> See generally Jane C. Ginsburg, *The U.S. Experience with Copyright Formalities: A Love/Hate Relationship*, 33 COLUM. J. L. & ARTS 311 (2010), [https://scholarship.law.columbia.edu/cgi/viewcontent.cgi?article=2625&context=faculty\\_scholarship](https://scholarship.law.columbia.edu/cgi/viewcontent.cgi?article=2625&context=faculty_scholarship).

<sup>15</sup> *What is Copyright?*, U.S. COPYRIGHT OFFICE, <https://www.copyright.gov/what-is-copyright/> (last visited Mar. 1, 2023) (hereinafter *What is Copyright?*).

<sup>16</sup> 17 U.S.C. § 102 (2023).

<sup>17</sup> *Id.*

<sup>18</sup> *Obtaining Copyright Protection*, FORSGREN FISHER MCCALMONT DEMAREA TYSVER LLP, <https://www.bitlaw.com/copyright/obtaining.html> (last visited Mar. 1, 2023).

<sup>19</sup> *Feist Publications, Inc., v. Rural Telephone Service Co.*, 499 U.S. 340, 345 (1991).

<sup>20</sup> *Copyrightability*, UNIV. OF MI. LIB. (Feb. 20, 2023), <https://guides.lib.umich.edu/copyrightbasics/copyrightability>.



just that: you did it by yourself—that is, you did not copy it.<sup>21</sup> However, “[t]here are some things ... that are not creative, [such as] titles, names, short phrases, and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering, or coloring; and mere listings of ingredients or contents.”<sup>22</sup> Further, “copyright protects expression, and never ideas, procedures, methods, systems, processes, concepts, principles, or discoveries.”<sup>23</sup>

A work is fixed when it is captured (either by an author or under the author’s authority) in a sufficiently permanent medium such that the work can be perceived, reproduced, or communicated for more than a short time. For example, a work is fixed when you write it down or record it.

The U.S. Constitutional basis for copyright law can be found in Article 1, Section 8, Clause 8 of the Constitution.<sup>24</sup> Congress passed the first federal copyright statute in 1790, President George Washington signed it into law,<sup>25</sup> and, since then, it has been continually updated.<sup>26</sup> The moment an individual creates an original work and fixes it (e.g., snaps a picture, writes a story, or records something musical), they are the author and the owner.<sup>27</sup>

U.S. copyright law provides copyright owners with exclusive rights to reproduce their work in copies or phono records; prepare derivative works based upon their original work; distribute copies or phonorecords of their work to the public by sale or other transfer of ownership or by rental, lease, or lending; perform their work publicly if it is a literary, musical, dramatic, or choreographic work, a pantomime, or a motion picture or other audiovisual work; and display their work publicly if it is a literary, musical, dramatic, or choreographic work, a pantomime, or a pictorial, graphic, or sculptural work.<sup>28</sup> Exclusive rights also applies to the individual images of a motion picture or other audiovisual work and, if the work is a sound recording, public performances by means of a digital audio transmission.<sup>29</sup>

However, certain statutory exceptions exist.<sup>30</sup> Exceptions include fair use<sup>31</sup> (i.e., how copyrighted resources can be used in scholarship, research, comment, criticism, teaching, and news reporting<sup>32</sup>); library use<sup>33</sup> (i.e., specific exceptions for libraries and

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<sup>21</sup> Steve Vondran, *What Constitutes “Independent Creation” in Copyright Law?*, VONDRAN LAW (Aug. 4, 2019), <https://www.vondranlegal.com/what-constitutes-independent-creation-in-copyright-law>.

<sup>22</sup> *What is Copyright?*, *supra* note 15.

<sup>23</sup> *Id.*

<sup>24</sup> U.S. Const. art I, § 8, cl. 8.

<sup>25</sup> Kevin R. Davis, *Copyright Act of 1790 (1790)*, THE FREE SPEECH CENTER (2009), <https://www.mtsu.edu/first-amendment/article/1030/copyright-act-of-1790>.

<sup>26</sup> *See Copyright Timeline*, *supra* note 6.

<sup>27</sup> *Copyright in General*, U.S. COPYRIGHT OFFICE, <https://www.copyright.gov/help/faq/faq-general.html#:~:text=Copyright%20exists%20from%20the%20moment,%2C%20section%20%E2%80%9C%20Registration.%E2%80%9D> (last visited Mar. 1, 2023).

<sup>28</sup> 17 U.S.C. § 106 (2023).

<sup>29</sup> *Id.*

<sup>30</sup> 17 U.S.C. § 107.

<sup>31</sup> *Copyright and Scholarship: Fair Use*, Boston College Libraries (Feb. 16, 2022), <https://libguides.bc.edu/copyright/fairuse#:~:text=The%20fair%20use%20of%20a,%2C%20scholarship%20or%20research>.

<sup>32</sup> *Id.*

<sup>33</sup> 17 U.S.C. § 108.

archives<sup>34</sup>); right of sale<sup>35</sup> (i.e., the right to resell or lend copies of copyrighted works that have been purchased<sup>36</sup>); face-to-face teaching<sup>37</sup> (i.e., how copyrighted resources can be used in the classroom<sup>38</sup>); online teaching (i.e., how copyrighted resources can be used in an online environment); and reproduction for the blind or people with disabilities<sup>39</sup> (i.e., how accessible copies can be made for blind or other people with disabilities<sup>40</sup>).

Statutory licenses (AKA compulsory licenses) also place limitations on the Copyright Act and relate to certain uses of musical compositions, sound recordings, cable programming, and satellite programming.<sup>41</sup> A statutory license is a “license that allows the use of copyrighted materials without the explicit permission of the copyright owner. In exchange, a royalty is paid to the copyright holder.”<sup>42</sup>

The focus of this paper is on U.S. copyright law, statutory damages, and the Berne Convention; thus, copyright length (i.e., how long a U.S. copyright lasts) is not discussed here.

Importantly, although

“[c]opyright exists automatically in an original work of authorship once it is fixed in a tangible medium, [] a copyright owner can take steps to enhance the protections of copyright, the most important of which is registering the work. [Though] registering a work is not mandatory, for U.S. works, registration (or refusal) is necessary to enforce the exclusive rights of copyright through litigation.”<sup>43</sup>

Almost exclusively, one cannot make a copyright law claim in any state court: U.S. copyright law is solely a federal issue.<sup>44</sup> However, in *Penguin (USA) Group Inc. v. American Buddha*, “[t]he United States Court of Appeals for the Second Circuit [] []

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<sup>34</sup> *Copyright and Fair Use*, OREGON STATE UNIVERSITY (Mar. 15, 2023), <https://guides.library.oregonstate.edu/copyright/libraries#:~:text=Title%2017%2C%20section%20108%20of%20use%20just%20like%20everyone%20else.>

<sup>35</sup> 17 U.S.C. § 109(a).

<sup>36</sup> *Copyright for Libraries: First Sale Doctrine*, AM. LIB. ASSOC. (June 27, 2022), [https://libguides.ala.org/copyright/firstsale#:~:text=The%20%E2%80%9Cfirst%20sale%E2%80%9D%20doctrine%20\(purchased%20it%2C%20you%20own%20it.](https://libguides.ala.org/copyright/firstsale#:~:text=The%20%E2%80%9Cfirst%20sale%E2%80%9D%20doctrine%20(purchased%20it%2C%20you%20own%20it.)

<sup>37</sup> 17 U.S.C. § 110(1).

<sup>38</sup> *Face-to-Face Classroom Exemption*, BYU, <https://copyright.byu.edu/face-to-face-classroom-exemption> (last visited Mar. 1, 2023).

<sup>39</sup> 17 U.S.C. § 121.

<sup>40</sup> *The Chafee Amendment: 17 U.S.C. 121 & 121A*, NATIONAL LIBRARY SERVICE FOR THE BLIND AND PRINT DISABLED, <https://www.loc.gov/nls/about/organization/laws-regulations/copyright-law-amendment-1996-pl-104-197/> (last visited Mar. 2, 2023).

<sup>41</sup> U.S. COPYRIGHT OFFICE, CIRCULAR NO. 75, THE LICENSING SECTION OF THE COPYRIGHT OFFICE (Sept. 2022), <https://www.copyright.gov/circs/circ75.pdf>.

<sup>42</sup> *Compulsory License*, LEGAL INFORMATION INSTITUTE, CORNELL LAW SCHOOL (Jan. 2022), [https://www.law.cornell.edu/wex/compulsory\\_license#:~:text=Compulsory%20license%20is%20a%20statutorily%20paid%20to%20the%20copyright%20holder.](https://www.law.cornell.edu/wex/compulsory_license#:~:text=Compulsory%20license%20is%20a%20statutorily%20paid%20to%20the%20copyright%20holder.)

<sup>43</sup> U.S. COPYRIGHT OFFICE, CIRCULAR NO. 1, COPYRIGHT BASICS (Sept. 2021), <https://www.copyright.gov/circs/circ01.pdf>.

<sup>44</sup> *1844. Copyright Law – Preemption of State Law*, U.S. DEPARTMENT OF JUSTICE (Jan. 17, 2020), <https://www.justice.gov/archives/jm/criminal-resource-manual-1844-copyright-law-preemption-state-law.>

asked [the New York Court of Appeals] a question regarding the scope of long-arm jurisdiction [] in the context of a federal copyright infringement action,”<sup>45</sup> and “the Indiana Supreme Court has found that state courts may ... hear cases involving the Copyright Act if the claims are raised first in a counterclaim.”<sup>46</sup> This dispositive issue of whether a state can decide on copyright claims appears to be in a state of circuit split and ripe for decision from the U.S. Supreme Court.<sup>47</sup>

Without copyright registration, financial recovery is limited to actual damages<sup>48</sup> and can be nominal or difficult to prove.<sup>49</sup> If a copyright is registered, the owner is entitled to statutory damages and attorneys’ fees. Statutory damages range from \$750 to \$30,000. In cases of willful infringement, the amount can be up to \$150,000.<sup>50</sup> Though “courts find willful infringement in just two percent of cases where plaintiffs obtain a favorable verdict.”<sup>51</sup>

This chapter has introduced the basics of U.S. copyright law without delving into the ultra-extreme complexities of the U.S. copyright law spectrum. The intent was to introduce the basic concept of what U.S. copyright is and draw a clear picture (pun intended).

## CHAPTER 2: U.S. COPYRIGHT INFRINGEMENT

“[C]opyright infringement occurs when a copyrighted work is reproduced, distributed, performed, publicly displayed, or made into a derivative work without the permission of the copyright owner.”<sup>52</sup> Further, “[c]opyright infringement occurs when the violating party exercises any of the creator’s exclusive rights to the work without permission.”<sup>53</sup> Note, “[t]his includes all manners of distribution (selling, broadcasting, performing, etc.), adaptation or other copying of the work.”<sup>54</sup> There is a wide spectrum

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<sup>45</sup> *Penguin (USA) Group Inc. v. American Buddha*, 16 N.Y.3d 295, 299-300 (Ct. App. N.Y. 2011).

<sup>46</sup> *Copyright Counterclaim May Proceed in State Court*, BALOUGH LAW OFFICES, LLC (Dec. 7, 2013), <https://www.balough.com/copyright-counterclaim-may-proceed-in-state-court/>.

<sup>47</sup> Emily Ostertag, *Website Terms of Service – Enforceable or Preempted?*, WHITE & CASE LLP (Oct. 20, 2022), <https://www.whitecase.com/insight-our-thinking/website-terms-service-enforceable-or-preempted>.

<sup>48</sup> Patrick Boland, *Copyright Infringement: Recovery of Actual Damages*, DCBA, <https://www.dcba.org/mpage/vol301117art3> (last visited Mar. 10, 2023).

<sup>49</sup> *Id.*

<sup>50</sup> *What Are Statutory Damages and Why Do They Matter?*, COPYRIGHT ALLIANCE (June 28, 2023), [https://copyrightalliance.org/faqs/statutory-damages-why-do-they-matter/#:~:text=Statutory%20damages%20are%20usually%20between,to%20be%20willful%20\(intentional\)](https://copyrightalliance.org/faqs/statutory-damages-why-do-they-matter/#:~:text=Statutory%20damages%20are%20usually%20between,to%20be%20willful%20(intentional)).

<sup>51</sup> Ben Depoorter, *Copyright Enforcement in the Digital Age: When the Remedy is the Wrong*, 66 UCLA L. REV. 400, 400 (2019), [https://repository.uchastings.edu/cgi/viewcontent.cgi?article=2722&context=faculty\\_scholarship](https://repository.uchastings.edu/cgi/viewcontent.cgi?article=2722&context=faculty_scholarship).

<sup>52</sup> *Definitions: What is Copyright Infringement?*, U.S. COPYRIGHT OFFICE, <https://www.copyright.gov/help/faq/faq-definitions.html#:~:text=What%20is%20copyright%20infringement%3F,permission%20of%20the%20copyright%20owner> (last visited Jan. 27, 2023).

<sup>53</sup> Chauncey Crail & Cassie Bottorff, *What is Copyright Infringement? Everything You Need to Know*, FORBES (Aug. 16, 2022), <https://www.forbes.com/advisor/business/what-is-copyright-infringement/#:~:text=Copright%20infringement%20occurs%20when%20the.other%20copying%20of%20the%20work>.

<sup>54</sup> *Id.*

of what constitutes copyright infringement. Examples include illegally downloading music files, uploading someone else's copyrighted material to an accessible web page, downloading licensed software from an unauthorized site, modifying and reproducing someone else's creative work without making significant changes, recording a movie in a theater, distributing a recording of a TV show or radio broadcast, including someone else's photographs on a website without permission, publishing or posting a video with a copyrighted song to a company website, and selling merchandise that includes copyrighted images, text or logos.<sup>55</sup>

With the advent of the internet in the 1990s, the issue of copyright infringement and digital media was addressed by the Digital Millennium Copyright Act of 1998 (DMCA). Importantly, "[t]he DMCA lays out a procedure for removing online material found to be in violation of a copyright without going to court."<sup>56</sup> The process "starts by sending a notice to the violator's internet service provider (ISP) or the business that hosts web pages online such as Comcast, Google, WordPress, etc."<sup>57</sup> The DMCA updated the U.S. Copyright Act to address copyright protections on the internet and to comply with international copyright law—the World Intellectual Property Organization (WIPO) Copyright Treaty and the WIPO Performances Phonograms Treaty.<sup>58</sup>

The No Electronic Theft (NET) Act 1997 "was passed to help prosecute [v]iolators who copy, share or distribute software, games, movies, music and other intellectual property via electronic means."<sup>59</sup> "Violators may face fines and jail."<sup>60</sup> "The maximum fine is \$250,000 and the maximum prison sentence is three years."<sup>61</sup>

The Family Entertainment and Copyright Act of 2005 is a two-part legislation. First, the Artist's Rights and Theft (ART) Prevention Act section "adds new criminal penalties for unauthorized recording or filming of motion pictures in a theater."<sup>62</sup> It is intended to stop bootlegging and unauthorized distribution of 'pre-release commercial works.'<sup>63</sup> Second, the Family Movie Act of 2005 establishes limitations on the exclusive rights of copyright holders to prohibit the marketing of and home use of devices intended to edit out scenes of sex, violence, and profane obscenity from motion picture DVDs.<sup>64</sup> This creates a "safe harbor" from copyright and trademark infringement liability for movie filtering technology—such as that currently sold by ClearPlay—that skips over dialogue and scenes deemed offensive but does not create a fixed copy of the altered version.<sup>65</sup>

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<sup>55</sup> *Id.*

<sup>56</sup> *Id.*

<sup>57</sup> *Id.*

<sup>58</sup> See U.S. COPYRIGHT OFFICE, THE DIGITAL MILLENNIUM COPYRIGHT ACT OF 1998. U.S. COPYRIGHT OFFICE SUMMARY (Dec. 1998), <https://www.copyright.gov/legislation/dmca.pdf>.

<sup>59</sup> *Copyright Infringement*, MANDOUR & ASSOCIATES, <https://www.mandourlaw.com/copyright-infringement/> (last visited Mar. 11, 2023).

<sup>60</sup> *Id.*

<sup>61</sup> *Id.*

<sup>62</sup> ROBIN JEWELER, CONGRESSIONAL RESEARCH SERVICE, NO. RS22042, THE FAMILY ENTERTAINMENT AND COPYRIGHT ACT OF 2005 (May 20, 2005), <https://www.everysreport.com/reports/RS22042.html>

<sup>63</sup> *Id.*

<sup>64</sup> *Id.*

<sup>65</sup> *Id.*

Originality is integral to U.S. copyright law since, “[t]o establish ownership of a valid copyright, a plaintiff must demonstrate that the work is original, and that it is subject to legal protection.”<sup>66</sup> Copyright law protects original works of authorship that exist or could exist in a “tangible medium of expression.”<sup>67</sup> The U.S. Supreme Court has held that originality is a constitutional requirement in copyright law, and it requires independent creation plus a modicum of creativity.<sup>68</sup> However, certain works are not subject to copyright protection, such as logos, business names, or brand names, which might be subject to trademark protection, are not subject to copyright protection, and processes or systems, which might be subject to patent protection and are not subject to copyright protection, and information that is generally known to the public, such as statutes, court decisions, public materials, and other general ideas and concepts, are not subject to copyright protection.<sup>69</sup>

Copyright infringement could be a criminal offense if the alleged infringer’s conduct meets two elements: (1) the defendant acted willfully and (2) the defendant sought commercial advantage or private financial gain.<sup>70</sup> Since this paper focuses on statutory damages, statutory damages are the only remedy discussed here. According to 17 U.S. Code § 504(c)(2), “[i]n a case where the copyright owner sustains the burden of proving, and the court finds, that infringement was committed willfully, the court in its discretion may increase the award of statutory damages to a sum of not more than \$150,000.”<sup>71</sup>

However, it should be pointed out that “[c]opyright owners are eligible [to receive] statutory damages [only] when they register their work with the U.S. Copyright Office ... within three months of publication of the work, or ... before the infringement starts.”<sup>72</sup> Factual copying can be proven by direct or circumstantial evidence, and direct evidence is rare since there is usually no direct evidence of factual copying; therefore, circumstantial evidence is usually relied on.<sup>73</sup> Circumstantial evidence can include proof of access and evidence of a probative similarity between the works or a striking similarity between the works.<sup>74</sup>

This chapter has provided an explanation of what U.S. copyright infringement is, how copyright infringement can happen, and what a plaintiff needs to prove infringement. Also introduced were the basics of statutory damages, modern U.S.

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<sup>66</sup> *What are the Elements of a Copyright Infringement Claim?*, BONA LAW, <https://www.bonalaw.com/insights/legal-resources/what-are-the-elements-of-a-copyright-infringement-claim> (last visited Mar. 13, 2023).

<sup>67</sup> *Id.*

<sup>68</sup> *Id.*

<sup>69</sup> *Id.*

<sup>70</sup> *Id.*

<sup>71</sup> 17 U.S.C. § 504 (2023).

<sup>72</sup> *What are Statutory Damages and Why do They Matter?*, COPYRIGHT ALLIANCE, <https://copyrightalliance.org/faqs/statutory-damages-why-do-they-matter/#:~:text=Statutory%20damages%20are%20usually%20between,to%20be%20willful%20intentional> (last visited Mar. 13, 2023) (hereinafter *What are Statutory Damages*).

<sup>73</sup> *Anatomy of a Copyright Infringement Case: Elements of a Copyright Infringement Claim*, FASTHOFF LAW FIRM PLLC (Nov. 27, 2016), <https://www.fasthofflawfirm.com/anatomy-copyright-infringement-case-elements-copyright-infringement-claim/#:~:text=Direct%20evidence%20of%20copying%20is,evidence%20to%20show%20factual%20copying>.

<sup>74</sup> *Id.*

copyright laws (the DMCA, the NET, the Family Entertainment and Copyright Act 2005, and the ART Prevention Act) and the tests used by the courts.

### CHAPTER 3: COPYRIGHT INFRINGEMENT AND THE BERNE CONVENTION

Foreign (i.e., non-U.S.) copyright holders may bring an action for copyright infringement in U.S. courts without having to obtain registration from the U.S. Copyright Office.<sup>75</sup> U.S. citizens, however, must still obtain registration to bring a lawsuit.<sup>76</sup> The Southern District of New York (SDNY) has held that, although the U.S. Copyright Act does not require registration of foreign works to bring an infringement lawsuit, the Act does not apply to the recovery of statutory damages,<sup>77</sup> except in the case of live broadcasts.<sup>78</sup>

The SDNY appears to have sided with the House Report accompanying implementation of § 412 and created new law to this effect:

**“Section 412. Registration As Prerequisite To Certain Remedies**

The need for section 412 arises from two basic changes the bill will make in the present law.

(1) Copyright registration for published works, which is useful and important to users and the public at large, would no longer be compulsory, and should therefore be induced in some practical way.

(2) The great body of unpublished works now protected at common law would automatically be brought under copyright and given statutory protection. The remedies for infringement presently available at common law should continue to apply to these works under the statute, but they should not be given special statutory remedies unless the owner has, by registration, made a public record of his copyright claim.”<sup>79</sup>

The Berne Convention for the Protection of Literary and Artistic Works (commonly known as “the Berne Convention”) was adopted in 1886.<sup>80</sup> The impetus for the Berne Convention was that “[i]t was difficult for creators to protect their rights in

<sup>75</sup> Jonathan Osder, *Why Foreign Companies Should Register Copyrights in the U.S.*, DONAHUE FITZGERALD LLP (2020), <https://donahue.com/resources/publications/copyrights-registered-u-s/>.

<sup>76</sup> See 17 U.S.C. § 411 (“no civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made.”).

<sup>77</sup> Jeffrey Cadwell, *Don't Get Berned – An Important Limitation on Enforcement of Foreign Copyrights Under U.S. Law*, THETMCA.COM (Aug. 8, 2017), <https://www.thetmca.com/dont-get-berned-an-important-limitation-on-enforcement-of-foreign-copyrights-under-u-s-law/#:~:text=Courts%20have%20affirmed%20that%20although%20the%20Copyright%20Act.633%20F.%20Supp.%202d%20159%2C%20162-63%20%28S.D.N.Y.%202009%29.>

<sup>78</sup> *Registration of Foreign Works is Required to Collect Statutory Damages*, BUCHANAN INGERSOLL & ROONEY PC (Apr. 5, 2011), <https://www.biprc.com/registration-of-foreign-works-is-required-to-collect-statutory-damages>.

<sup>79</sup> H.R. REP. NO. 94-1478, at 158 (1976), <http://digital-law-online.info/misc/HRep94-1476.htm> (full report available in original format at [https://www.copyright.gov/history/law/clrev\\_94-1476.pdf](https://www.copyright.gov/history/law/clrev_94-1476.pdf)).

<sup>80</sup> Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, as revised at Paris on July 24, 1971 and amended in 1979, S. Treaty Doc. No. 99-27 (1986), <https://www.wipo.int/treaties/en/ip/berne/> (hereinafter Berne Convention).



other countries during that time because there were no international standards or procedures in existence.”<sup>81</sup> And “[the] Berne Convention sought to address this issue by establishing a variety of policies to protect the intellectual property rights and copyrights of creators.”<sup>82</sup>

While a half-dozen or so copyright-related treaties exist (e.g., the Buenos Aires Convention (1913), Universal Copyright Convention via the Geneva Act (1955) and the Paris Act (1974), the International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations (AKA the Rome Convention) (1964), the Agreement on Trade-Related Aspects of Intellectual Property Rights (AKA TRIPS) (1995), the WIPO Copyright Treaty (2002), the Marrakesh VIP Treaty (2016), the Anti-Counterfeiting Trade Agreement (not yet fully ratified), the Berne Convention is “[t]he oldest and most important [copyright] treaty ... ratified by more than 160 countries.”<sup>83</sup>

Other copyright-related treaties are narrower in scope or serve specific issues only, might be signed by fewer members, and serve overall intellectual property law schemes, such as setting minimum standards, and some treaties have *de facto* been overridden by later treaties. The Berne Convention stands firm as the authoritative international copyright treaty in full force in over 160 countries.<sup>84</sup>

“[T]he U.S. ... joined the Berne Convention more than a century after it was drafted.”<sup>85</sup> However, Congress “explicitly made the Berne Convention non-self-executing through the Berne Convention Implementation Act of 1988.”<sup>86</sup> This “means that the Berne Convention has no legal effect in the courts of the U.S.; [o]nly the laws passed by Congress to conform U.S. law to the Berne Convention carry any weight.”<sup>87</sup> The Berne Implementation Act may be regarded as “‘a minimalist approach’ [amendments to] the [U.S.] Copyright Act only where there is a clear conflict with the express provisions of the Berne Convention [House Report on the Implementation Act of 1988 § (III)(C)].”<sup>88</sup> However, it is arguable that Article 5 of the Berne Convention already presents a clear conflict. Article 5(2) of the Berne Convention states, “The enjoyment and the exercise of these rights shall not be subject to any formality.”<sup>89</sup> Clearly, registration for statutory damages is a formality because it requires the positive act of actually filing a document with the U.S. Copyright Office. Requiring foreigners to register with the U.S. Copyright Office to be eligible for statutory damages in the event of copyright infringement is an affront to Article 5(2) of the Berne Convention.

Was the ruling by the SDNY correct? Should the SDNY have overruled Congress and pointed out the U.S.’s commitments under the Berne Convention? Would another

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<sup>81</sup> *The Berne Convention: Meaning and Application*, TUTORIALS POINT, <https://www.tutorialspoint.com/the-berne-convention-meaning-and-application> (last visited July 16, 2023).

<sup>82</sup> *Id.*

<sup>83</sup> *Copyright Compliance in the Digital Workplace*, WHITEPAPERS <https://www.rightsdirect.com/wp-content/uploads/sites/6/2023/01/Compliance-in-the-Digital-Workplace.pdf> (last visited July 20, 2023).

<sup>84</sup> *Id.*

<sup>85</sup> Osder, *supra* note 75.

<sup>86</sup> *Id.*

<sup>87</sup> *Id.*

<sup>88</sup> *Id.*

<sup>89</sup> Cadwell, *supra* note 77.

district court in another federal circuit have ruled differently? Why consider the live broadcast exception only and not an exception for all foreign works for all types of copyrights?

Would another district court in another circuit hold differently from the SDNY? Is this issue ripe for a circuit split and subsequent final decision by the U.S. Supreme Court on whether the U.S. is in compliance with the Berne Convention?

Though the facts were different, the Seventh Circuit did touch upon this issue in *Rudnicki v. WPNA*<sup>90</sup> in 2008—just before the Second Circuit touched upon it in 2009.<sup>91</sup> Therefore, including the *Football* case, after the Seventh Circuit’s decision in *Rudnicki*, this makes two federal circuits that have sided with Congress to not allow statutory damages for unregistered items.

In order for the Berne Convention (or any treaty) to be binding on U.S. courts, the treaty would have to be self-executing.<sup>92</sup> However, the Berne Convention is not self-executing:<sup>93</sup>

“[t]he doctrine of non-self-executing treaties, as developed by the Supreme Court in the nineteenth century, struck an appropriate balance between competing rule of law and separation of powers principles. However, the modern doctrine of non-self-executing treaties, created by courts and commentators in the latter half of the twentieth century, distorts that balance. The root of the problem is the ‘intent thesis,’<sup>94</sup> [which] holds that the intent of the treaty makers determines whether a treaty is self-executing or non-self-executing. This proposition is widely accepted among courts and commentators.”<sup>95</sup>

Further, while the U.S. is free to make any treaty non-self-executing, that does not relieve the U.S. of any obligations it has as a party to a treaty.<sup>96</sup>

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<sup>90</sup> See generally *Rudnicki v. WPNA* 1490 AM, 580 F. Supp. 2d 690 (N.D. Ill. 2008) (explaining the Plaintiff purported copyright holder filed a copyright infringement suit against defendants, a radio station and others, alleging that they infringed his copyrights on various radio addresses).

<sup>91</sup> See generally *Football Ass’n Premier League v. Youtube, Inc.*, 633 F. Supp. 2d 159 (S.D.N.Y. 2009). Plaintiffs brought a putative class action for copyright infringement under the Copyright Act of 1976, 17 U.S.C.S. § 101 et seq. *Id.* Defendants moved for judgment on the pleadings, dismissing plaintiffs’ claims for statutory damages on foreign works that had not been registered with the U.S. Copyright Office, and their claim for punitive damages. *Id.*

<sup>92</sup> *Treaties Under International and US Law*, JUSTIA (June 2022), <https://www.justia.com/international-law/treaties-under-international-and-us-law/#:~:text=Treaties%20and%20other%20international%20agreements%20take%20direct%20legal,US%20law%20without%20additional%20legislation%20to%20implement%20it.>

<sup>93</sup> See Marty Schwimmer, *Berne Doesn’t Seem to be Self-Executing*, THE TRADEMARK BLOG (Jan. 20, 2010), <https://www.schwimmerlegal.com/2010/01/berne-doesnt-seem-to-be-self-executing.html>.

<sup>94</sup> David Sloss, *Non-Self-Executing Treaties: Exposing a Constitutional Fallacy*, 36 U.C. DAVIS L. REV. 1, 4 (2002), <https://digitalcommons.law.scu.edu/cgi/viewcontent.cgi?article=1281&context=facpubs>.

<sup>95</sup> *Id.*

<sup>96</sup> See *ArtII.S2.C2.1.4 Self-Executing and Non-Self-Executing Treaties*, LEGAL INFORMATION INSTITUTE, CORNELL LAW SCHOOL, <https://www.law.cornell.edu/constitution-conan/article-2/section-2/clause-2/self-executing-and-non-self-executing-treaties> (last visited Apr. 15, 2023).



If taken at face value, the issue becomes: what was the intent of the signees of the Berne Convention at the time of signing? Reading the WIPO Berne Notification No. 121, the intent seems prosaic:

**“Accession by the United States of America”<sup>97</sup>**

The Director General of the World Intellectual Property Organization (WIPO) presents his compliments to the Minister for Foreign Affairs and has the honor to notify him of the deposit by the Government of the United States of America, on November 16, 1988, of its instrument of accession to the Berne Convention for the Protection of Literary and Artistic Works of September 9, 1886, as revised at Paris on July 24, 1971, and amended on October 2, 1979.

The United States of America has not heretofore been a member of the International Union for the Protection of Literary and Artistic Works (“Berne Union”), founded by the Berne Convention.

In accordance with Article 29(2)(a) of the Berne Convention, as revised at Paris on July 24, 1971, and amended on October 2, 1979, the said Convention will enter into force, with respect to the United States of America, on the date indicated in the said instrument of accession, that is, on March 1, 1989.

The United States of America will belong to Class I for the purpose of establishing its contribution towards the budget of the Berne Union.

November 17, 1988.”

This announcement welcomes the U.S.’s “accession,” and it appears that the U.S. and the preexisting members intended to be bound by the Berne Convention and nothing else. However, on the matter of the U.S.’s intent, the question becomes, “Why did the United States wait 103 years to join the Berne Convention?”<sup>98</sup> The answer to that question is provided in the article of the same name: prior to joining, the U.S. was uninterested in engaging with the world copyright stage, except in certain situations favorable to it. Joining the Berne Convention (following a modernization of U.S. copyright law) made clear the U.S.’s intent to join the world copyright stage—albeit with certain stipulations.<sup>99</sup> By refusing to make the Berne Convention self-executing, the U.S. appears to express its wish to maintain a certain degree of control over its obligations by taking “[t]his very guarded stance.”<sup>100</sup> So, the issue now becomes, are you allowed, under international law, to enter into international treaties and cherry-pick what you accede to?

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<sup>97</sup> *Berne Notification No. 121*, WIPO (Nov. 17, 1988), [https://www.wipo.int/treaties/en/notifications/berne/treaty\\_berne\\_121.html](https://www.wipo.int/treaties/en/notifications/berne/treaty_berne_121.html).

<sup>98</sup> Jonathan Bailey, *Why Did the United States Wait 103 Years to Join the Berne Convention?*, PLAGIARISM TODAY (May 13, 2021), <https://www.plagiarismtoday.com/2021/05/13/why-did-the-united-states-wait-103-years-to-sign-the-berne-convention/>.

<sup>99</sup> *Id.*

<sup>100</sup> Jane C. Ginsburg & John M. Kernochan, *One Hundred and Two Years Later: The U.S. Joins the Berne Convention*, 13 *COLUM.-VLA J. L. & ARTS* 1, 6 (1988), [https://scholarship.law.columbia.edu/cgi/viewcontent.cgi?article=4813&context=faculty\\_scholarship](https://scholarship.law.columbia.edu/cgi/viewcontent.cgi?article=4813&context=faculty_scholarship).

The terms “international convention” and “treaty” are effectively synonymous,<sup>101</sup> so the Berne Convention can be regarded as a treaty. As such, guidance on whether member states can cherry-pick what they accede to must be sought from the Vienna Convention on the Law of Treaties:<sup>102</sup> the “principal authoritative source of the law of treaties ... [I]t provides a comprehensive set of rules on how treaties are formed, how they operate, and how they may be terminated or suspended ... the Convention is sometimes referred to as the ‘treaty on treaties.’”<sup>103</sup>

Although the U.S. signed the Vienna Convention in 1970, the Senate never ratified it.<sup>104</sup> This appears to be another example of the U.S. wanting to maintain a certain degree of control over its obligations. Notwithstanding the U.S. not being a member of the Vienna Convention, the Vienna Convention is a United Nations document and the U.S. is one of the five permanent members of the United Nations Security Council.<sup>105</sup> Therefore, it is reasonable to assume that the Vienna Convention, at a minimum, represents customary international law (i.e., “a general practice accepted as law”<sup>106</sup>), and it appears that the U.S. accepts some of the Vienna Convention as customary international law.<sup>107</sup> As a permanent member, the U.S. has surely voted on matters that in some way or another relate to the Vienna Convention and hence *de facto* accedes to it.

Thus, the issue becomes does the Vienna Convention allow for cherry-picking of obligations by treaty-member states? The closest analogy to the term “cherry-picking” in the Vienna Convention appears to be “reservation.”

According to Article 2(1)(d) of the Vienna Convention, “‘reservation’ means a unilateral statement, however phrased or named, made by a State, when signing, ratifying, accepting, approving or acceding to a treaty, whereby it purports to exclude or to modify the legal effect of certain provisions of the treaty in their application to that State.” In other words, the time for declining any provisions within a treaty is at the time of signing, by making a specific reservation.

Did the U.S. make a reservation regarding the first sentence of Article 5(2) of the Berne Convention, “The enjoyment and the exercise of these rights shall not be subject to any formality”?<sup>108</sup> According to the Senate Consideration of Treaty Document 99-27,

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<sup>101</sup> LORI FISLER DAMROSCH & SEAN D. MURPHY, INTERNATIONAL LAW, CASES AND MATERIALS, 113 (7th ed. 2020).

<sup>102</sup> See Vienna Convention on the Law of Treaties, *opened for signature* May 23, 1969, 1155 U.N.T.S. 331, [https://treaties.un.org/pages/ViewDetailsIII.aspx?src=TREATY&mtdsg\\_no=XXIII-1&chapter=23&Temp=mtdsg3&clang=en](https://treaties.un.org/pages/ViewDetailsIII.aspx?src=TREATY&mtdsg_no=XXIII-1&chapter=23&Temp=mtdsg3&clang=en).

<sup>103</sup> DAMROSCH & MURPHY, *supra* note 101, at 114.

<sup>104</sup> Vienna Convention on the Law of Treaties, U.S. DEPARTMENT OF STATE, <https://2009-2017.state.gov/s/l/treaty/faqs/70139.htm#:~:text=Is%20the%20United%20States%20a%20party%20to%20the.given%20its%20advice%20and%20consent%20to%20the%20treaty> (last visited Mar. 14, 2023).

<sup>105</sup> *The UN Security Council*, COUNCIL ON FOREIGN AFFAIRS (Feb. 28, 2023), <https://www.cfr.org/background/un-security-council#:~:text=The%20Security%20Council%20has%20five.are%20not%20afforded%20veto%20power>.

<sup>106</sup> *Customary Law*, ICRC, <https://www.icrc.org/en/war-and-law/treaties-customary-law/customary-law> (last visited Mar. 14, 2023).

<sup>107</sup> See *International Section, Treaty Interpretation*, NATIONAL OCEANIC AND ATMOSPHERIC ADMINISTRATION, U.S. DEPARTMENT OF COMMERCE (Oct. 4, 2022), <https://www.noaa.gov/treaty-interpretation>.

<sup>108</sup> Berne Convention, *supra* note 80, at art 5(2).

no reservations (AKA cherry-picking) were made at the time of sending to the U.S. Senate;<sup>109</sup> in fact “Without reservation” and “Ordered to be reported without amendment favorably” are noted<sup>110</sup> (see Figure 2).

### **Actions: Senate Consideration of Treaty Document 99-27**

Sort by  ▼

Date	Senate Actions
10/20/1988	Resolution of advice and consent to ratification agreed to in Senate by Division Vote.
07/14/1988	Reported by Mr. Pell, Committee on Foreign Relations, with printed report - Ex.Rept. 100-17. Without reservation.
07/13/1988	Committee on Foreign Relations. Ordered to be reported without amendment favorably.
07/11/1988	Committee on Foreign Relations. Hearings held.
06/20/1986	Referred to the Committee on Foreign Relations.
06/18/1986	Received in the Senate.

**Figure 2: Senate Consideration of Treaty Document 99-27  
(the Berne Convention)**

Where is the U.S.’s reservation against Article 5(2), or any reservation about any article within the Berne Convention? Based on the Vienna Convention, the U.S. did not make any reservations when it signed the Berne Convention and the full text—part and parcel—is what the U.S. signed up for when President Reagan himself signed the Berne Convention Implementation Act of 1988.<sup>111</sup> Or was it? Article 30 of the Berne Convention allows for making reservations (i.e., cherry-picking), in so far as it limits but does not ban reservations:

**“1. Limits of possibility of making reservations; 2. Earlier reservations; reservation as to the right of translation; withdrawal of reservation**

(1) Subject to the exceptions permitted by paragraph (2) of this Article, by Article 28(1)(b), by Article 33(2), and by the Appendix, ratification or accession shall automatically entail acceptance of all the provisions and admission to all the advantages of this Convention.

<sup>109</sup> *Senate Consideration of Treaty Document 99-27*, CONGRESS.GOV, <https://www.congress.gov/treaty-document/99th-congress/27?s=1&r=26> (last visited Mar. 14, 2023).

<sup>110</sup> *Id.*

<sup>111</sup> Reagan Library, *President Reagan Signing the Berne Convention Implementation Act of 1988 on October 31, 1988*, YOUTUBE (May 23, 2018), <https://www.youtube.com/watch?v=t5QL0vuQtiw>.

(2)(a) Any country of the Union ratifying or acceding to this Act may, subject to Article V(2) of the Appendix, retain the benefit of the reservations it has previously formulated on condition that it makes a declaration to that effect at the time of the deposit of its instrument of ratification or accession.”

Without making a reservation, which members are expected to make if they have one, members “shall automatically entail acceptance of all the provisions and admission to all the advantages of this Convention.”<sup>112</sup> Is the U.S. domestic theory of non-self-executing treaties so powerful that it *de facto* and *de jure* overrides its treaty obligations?

An interesting analogy to the Berne Convention is the Jay Treaty of 1794 between the U.S. and the United Kingdom (“U.K.”).<sup>113</sup> This treaty is regarded as an in-between treaty; some in Congress regard it as self-executing and others see it as non-self-executing.<sup>114</sup> The treaty was non-self-executing since “[t]he actual reason behind the U.S. Congress Slave Trade Act was in fulfillment of America’s obligation [to] the Treaty of Amity, Commerce, and Navigation, between His Britannic Majesty and the United States of America, commonly known as the Jay Treaty.”<sup>115</sup> That is to say, a domestic U.S. law had to be enacted to actually give effect to the non-self-executing treaty.

The issue of self-executing versus non-self-executing appears to rely on whether funds will be expended from the U.S. Treasury, which requires Congressional approval.<sup>116</sup> Whether the Jay Treaty is self-executing or non-self-executing, the Jay Treaty imposed the obligation of neutrality on both the U.S. and the U.K.<sup>117</sup> The U.K. violated its neutrality obligation when it aided the American Confederacy during the American Civil War.<sup>118</sup> This set the stage for a compensation claim by the U.S. against the U.K., resulting in the Alabama Claims<sup>119</sup> and subsequent Treaty of Washington.<sup>120</sup> The ensuing arbitration in Geneva, Switzerland, saw the U.K. pay \$15,500,000 in gold

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<sup>112</sup> *Id.*

<sup>113</sup> See Treaty of Amity, Commerce, and Navigation, Between His Britannic Majesty, and the United States of America [Jay Treaty], U.S.-Gr. Brit., Nov. 19, 1794. See *Milestones in the History of U.S. Foreign Relations: John Jay’s Treaty, 1794–95*, OFFICE OF THE HISTORIAN, FOREIGN SERVICE INSTITUTE, U.S. DEPARTMENT OF STATE, <https://history.state.gov/milestones/1784-1800/jay-treaty> (last visited Mar. 15, 2023).

<sup>114</sup> David Sloss, *The New ALI Restatement and the Doctrine of Non-Self-Executing Treaties*, THE FEDERAL LAWYER (Oct./Nov. 2017), <https://www.fedbar.org/wp-content/uploads/2017/10/NonSelfExecuting-Treaties-pdf-1.pdf>.

<sup>115</sup> Sebastiane Ebatamehi, *The Hypocrisy of U.S. Congress’ Anti-Slavery Bills You Didn’t Learn in School*, THE AFRICAN EXPONENT (Aug. 12, 2020), <https://www.africanexponent.com/post/7767-the-hypocrisy-of-us-congress-anti-slavery-bills-you-didnt-learn-in-school>.

<sup>116</sup> See *Id.*

<sup>117</sup> Thomas Ladenburg, *Chapter 6: Neutrality and the Jay Treaty*, in THE FEDERALIST ERA. SSEC AMERICAN HISTORY SERIES 24 (1989), [https://www.digitalhistory.uh.edu/teachers/lesson\\_plans/pdfs/unit3\\_6.pdf](https://www.digitalhistory.uh.edu/teachers/lesson_plans/pdfs/unit3_6.pdf).

<sup>118</sup> GROSVENOR PORTER LOWREY, ENGLISH NEUTRALITY: IS THE ALABAMA A BRITISH PIRATE? 32 (1863), [https://digitalcommons.cedarville.edu/cgi/viewcontent.cgi?article=1085&context=pamphlet\\_collection](https://digitalcommons.cedarville.edu/cgi/viewcontent.cgi?article=1085&context=pamphlet_collection).

<sup>119</sup> William W. Park, *Swords into Plowshares: A Pilgrimage for the CSS Alabama*, in 37 ARBITRATION INTERNATIONAL 515, 515 (2021), [https://scholarship.law.bu.edu/cgi/viewcontent.cgi?article=2170&context=faculty\\_scholarship](https://scholarship.law.bu.edu/cgi/viewcontent.cgi?article=2170&context=faculty_scholarship).

<sup>120</sup> *Id.*

to the U.S.<sup>121</sup> Worth noting, “Senator Charles Sumner of Massachusetts, the chairman of the U.S. Senate Foreign Relations Committee, originally wanted to ask for \$2 billion in damages, or alternatively, the ceding of Canada to the United States.”<sup>122</sup> The point is that the U.S. is fully aware of and empowered, with the utmost zeal, in incurring treaty obligations to its benefit.

In a notable 1988 article (coauthored by esteemed copyright scholar Jane C. Ginsburg) on the matter of formalities and statutory damages, it is pointed out that “[t]here are two principal areas in which the new legislation [the Berne Convention Implementation Act of 1988] has modified the 1976 Copyright Act: the compulsory license for jukebox performances of nondramatic music, and most importantly, formalities.”<sup>123</sup> Formalities being highlighted as *the most important* change.

This chapter began with a discussion of the registration requirements for foreign and U.S. nationals regarding eligibility for statutory damages. The discussion then moved to U.S. copyright law and the Berne Convention, including analysis of the U.S.’s treaty obligations in general and in relation to the Berne Convention in particular. This chapter identified that the U.S. seems to have cherry-picked its obligations in not waiving the requirement for registration by foreigners with the U.S. Copyright Office in order for them to be eligible for statutory damages in the event of copyright infringement.

#### CHAPTER 4: THE BERNE CONVENTION AND NATIONALITY

What does the Berne Convention say about nationality? According to Article 3(2) of the Berne Convention, “Authors who are not nationals of one of the countries of the Union, but who have their habitual residence in one of them, shall, for the purposes of this Convention, be assimilated to nationals of that country.”<sup>124</sup> Therefore, in reading this alone, if an author has their habitual residence in a Berne Convention member country, for purposes of the Berne Convention, the author is a national of that country.

As will be established in Chapter 5, the author of this essay, Gregory Gerard Greer, was a U.S. citizen/national in 1991, then a Japanese resident from 1998 to June 2004. Mr. Greer was considered “habitually resident” in Japan. However, one can interpret “Authors who are not nationals of one of the countries of the Union” to mean Mr. Greer was a national of one of the Berne member countries (i.e., the U.S.) in 1991, and that Mr. Greer could not also be a national of Japan pursuant to Article 3(2) of the Berne Convention from 1998 to 2004. In other words, Article 3(2) of the Berne Convention does not apply to Mr. Greer.

To borrow from trusts and wills law, which often draws from civil procedure, one can have both a domicile and a residency.<sup>125</sup> Further, according to the International

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<sup>121</sup> *Id.*

<sup>122</sup> Helen Hegener, *The Alabama Claims*, NORTHERN LIGHT MEDIA (Apr. 19, 2020), <https://northernlightmedia.wordpress.com/2020/04/19/the-alabama-claims/>.

<sup>123</sup> Ginsburg & Kernochan, *supra* note 100.

<sup>124</sup> Berne Convention, *supra* note 80, at art 3(2).

<sup>125</sup> *What’s the Difference Between Personal Income Tax Residency vs Domicile?*, BROTMAN LAW, <https://www.sambrotman.com/personal-income-tax-residency-california/residency-vs-domicile#:~:text=What's%20the%20Difference%20between%20Residency,state%20becomes%20your%20tax%20home> (last visited Apr. 15, 2023).

Law Commission, “[d]ual nationality is ... the consequence of conflicts of laws.”<sup>126</sup> Mr. Greer’s domicile might have been the U.S. state of Maryland because Mr. Greer owned property there, but Mr. Greer’s residency was Japan. Mr. Greer arguably had dual nationality and hence a viable claim to Article 3(2) of the Berne Convention. Indeed, thanks to the 1971 and 2003 Conventions between Japan and the U.S.,<sup>127</sup> Mr. Greer was not required to file any U.S. state income tax return because Mr. Greer was not resident in any U.S. state while resident in Japan.<sup>128</sup> Additionally, since Mr. Greer’s salary was well under the then roughly \$80,000 foreign earned income threshold, he was not liable for any federal income tax.<sup>129</sup> Further, Mr. Greer, as an Alien Resident Card holder, was allowed to use the Japanese citizens’ queue whenever returning from a foreign country to Japan. Mr. Greer, as a resident of Japan, was able to own a bank account in Japan and use a *inkan shoumeisho* (personal signature seal)<sup>130</sup> registered and recorded with the local city hall,<sup>131</sup> enabling Mr. Greer to engage in all the normal business transactions of any Japanese citizen. Mr. Greer was issued a Japanese National Health Insurance Card stating Mr. Greer was covered under Japan’s National Health Insurance system as a Japanese resident (see Figure 3). After another four years (i.e., after 10 years of good behavior while a temporary resident) in Japan, Mr. Greer would have been eligible for permanent residency in Japan.<sup>132</sup>

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<sup>126</sup> United Nations, YEARBOOK OF THE INTERNATIONAL LAW COMMISSION 1954, VOL. II 85, para. 212 (1954), [https://legal.un.org/ilc/publications/yearbooks/english/ilc\\_1954\\_v2.pdf](https://legal.un.org/ilc/publications/yearbooks/english/ilc_1954_v2.pdf).

<sup>127</sup> Convention for the Avoidance of Double Taxation and the Prevention of Fiscal Evasion with Respect to Taxes on Income, U.S.-Japan, Mar. 8, 1971, 23 U.S.T. 967, <https://www.irs.gov/pub/irs-trty/japan.pdf> (noting that the 1971 Convention was superseded by the 2003 Convention).

<sup>128</sup> Convention for the Avoidance of Double Taxation and the Prevention of Fiscal Evasion with Respect to Taxes on Income, *supra* note 127.

<sup>129</sup> *Foreign Earned Income Exclusion*, I.R.S. (Nov. 14, 2022), <https://www.irs.gov/individuals/international-taxpayers/foreign-earned-income-exclusion>.

<sup>130</sup> Toshihiko Yamamoto, *Do You Need an Inkan (Seal, Name Stamp) to Buy a Property in Japan?*, YAMAMOTO PROPERTY ADVISORY (June 12, 2019), <https://www.toshihikoyamamoto.jp/do-you-need-inkan/>.

<sup>131</sup> *See How to Start Life in Japan. Residence Registry and Other Procedures*, JAPAN FORWARD (Mar. 24, 2022), <https://japan-forward.com/how-to-start-life-in-japan-residence-registry-and-other-procedures/> (Local city halls are intrinsic to life in Japan).

<sup>132</sup> *How to Get Permanent Residence (PR) in Japan*, CONTINENTAL (Mar. 22, 2023), <https://continental-immigration.com/hsp/english/how-to-get-permanent-residence-in-japan/#:~:text=Stay%20in%20Japan%20for%20at%20least%2010%20years&text=Be%20careful%20when%20you%20have%20considered%20by%20the%20Immigration%20Bureau>.



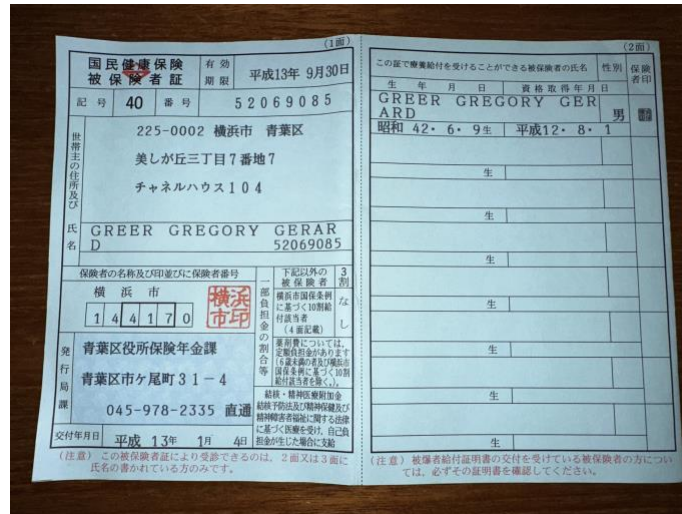


Figure 3: Gregory Gerard Greer Japan National Health Insurance Card

The foregoing shows that Mr. Greer was a Japanese resident, not a U.S. resident. The issue now turns to whether, on this basis, Article 3(2) of the Berne Convention applies to Mr. Greer. Mr. Greer argues that Article 3(2) of the Berne Convention does apply.

Nowhere in the Berne Convention does it declare that if one is a dual national, one *cannot* avail themselves of their *current* nationality. In an attempt to reach a definitive and authoritative answer on this matter—that is, whether Article 3(2) of the Berne Convention applies to Mr. Greer—the author contacted WIPO, which administers the Berne Convention.<sup>133</sup> WIPO’s response (including Mr. Greer’s/the author’s initiating “ticket”/inquiry) is reproduced below.

Re: [Ticket#6023029556] WIPO Contact Form: Copyright and Related Rights (05.04.2023 05:51:04)

Inbox

Contact Center <contact.center@wipo.int>

Wed, Apr 5, 1:13 AM (1 day ago)

to me

Dear Gregory,

Thank you for contacting us.

WIPO's [role](#) in the field of copyright consists in assisting governments in developing IP laws and standards and in providing a discussion forum for our [Member States](#). Please note that WIPO has no operational role in the enforcement of IP rights. As IP protection falls under national legislation, relevant enforcement provisions are taken

<sup>133</sup> WIPO-Administered Treaties, WIPO, <https://www.wipo.int/treaties/en/> (last visited Apr. 15, 2023).

at the national level. Accordingly, since your case concerns a private legal matter, [WIPO](#) is unfortunately not in a position to assist you. We suggest you consult a practicing IP lawyer or your [national IP office](#) for assistance with your case.

You may find the following information useful:

- In the majority of [countries](#), and according to the [Berne Convention](#), copyright protection is obtained automatically without the need for registration or other formalities. Most countries nonetheless have a system in place to allow for the voluntary registration of works. Such voluntary registration systems can help solve disputes over ownership or creation, as well as facilitate financial transactions, sales, and the assignment and/or transfer of rights. Please note that WIPO does not offer any kind of copyright registration service
- [FAQs on Copyright](#)
- [Understanding Copyright and Related Rights](#)
- [WIPO Lex](#) database for information on current laws in a given country

Thank you for your understanding.

Best regards,

Annaig

Contact Center | World Intellectual Property Organization | T.+41 22 338 9111 | [www.wipo.int](http://www.wipo.int) | Monday to Friday from 8 a.m. to 6 p.m. (CET)

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**Women and intellectual property**  
Accelerating innovation and creativity  
**World Intellectual Property Day**  
April 26, 2023  
[wipo.int/ipday](http://wipo.int/ipday) #WorldIPday

05/04/2023 06:00 - Gregory Greer wrote:

**Topic:** Copyright and Related Rights

**Sub-topic:** Copyright and Related Rights

**Question:** In 1991, I owned the copyright to a picture in the U.S. and I was a U.S. citizen/national. From 1998 to 2004, I was habitually resident in Japan. While in Japan, a publisher infringed my copyright in the U.S. and made over one million copies of my picture.



Yes, I was a U.S. citizen/national in 1991 and to this day, but can I take advantage of Article 3(2) of the Berne Convention and claim (or choose? or be assimilated to?) Japanese nationality and make a claim as a Japanese national?

**Attachment:** ICL Writing Assignment - Gregory Gerard Greer - Spring 2023\_v0-5.pdf (883696KB)

**First name:** Gregory

**Last name:** Greer

**Company/Organization:** The George Washington University Law School

**Phone number:** +1-301-335-2053

**E-mail address:** [gregorygerardgreer@gmail.com](mailto:gregorygerardgreer@gmail.com)

**ID:** 281849

**Time Stamp:** 05.04.2023 05:51:04

**Recipient:** [contact.center@wipo.int](mailto:contact.center@wipo.int)

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“...since your case concerns a private legal matter, WIPO is unfortunately not in a position to assist you” is exactly the Mr. Greer was expecting. (It is worth mentioning that Mr. Greer subsequently contacted two intellectual property law firms in the U.S., as recommended by WIPO, but neither firm responded. Perhaps this question was over their heads? Counsel was sought, payment was offered, and even then, two U.S.-based intellectual property law firms did not, or could not, respond.)

The answer as to whether Article 3(2) of the Berne Convention applies to Mr. Greer, or any other similarly situated individual, has yet to be adjudicated in the U.S. court system. Similar to how the U.S. cherry-picks what it wants to follow from a treaty, it appears Article 3(2) may or may not apply to Mr. Greer—and that is exactly the decision a federal court would need to make. At the time of writing, Article 3(2) of the Berne Convention does not apply to Mr. Greer (or any other individual similarly situated).

No U.S. federal court has ruled on Article 3(2) of the Berne Convention. Article 3(2) remains an open question in the U.S., and arguably falls within the arena of conflict of laws.<sup>134</sup> Nonetheless, for the purposes of this paper, Mr. Greer declares his Japanese nationality from 1998 to 2004 under Article 3(2) of the Berne Convention. Any reading of this Article 3(2) as not applying to Mr. Greer is a matter of *personal opinion*, not a *matter of law*—“[t]hat which is determined or ascertained through the use of statutes, rules, court decisions, and interpretations of legal principles.”<sup>135</sup> This issue is ripe for judicial review.

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<sup>134</sup> *Conflict of Laws*, LEGAL INFORMATION INSTITUTE, CORNELL U. LAW SCHOOL (Aug. 2022), [https://www.law.cornell.edu/wex/conflict\\_of\\_laws](https://www.law.cornell.edu/wex/conflict_of_laws).

<sup>135</sup> *Matter of Law*, WEST’S ENCYCLOPEDIA OF AMERICAN LAW, <https://www.encyclopedia.com/law/encyclopedias-almanacs-transcripts-and-maps/matter-law> (last visited Apr. 15, 2023).

## CHAPTER 5: TURNING JAPANESE

In 1980, the English pop music group the Vapors produced the song “Turning Japanese.”<sup>136</sup> The song begins quite appropriately with “I’ve got your picture”<sup>137</sup>—a copyright-protected item from the moment it is snapped.<sup>138</sup>

In 1991, while a student at the University of Maryland, College Park, Gregory Gerard Greer (the author of this paper) formed the sole proprietorship Montgomery Banknotes and ran an ad in *Coins* magazine<sup>139</sup> (see Figure 4). The ad (see Figure 5) ran for six months. One hundred or so orders were received, allowing for a little income and some unique tax deductions.

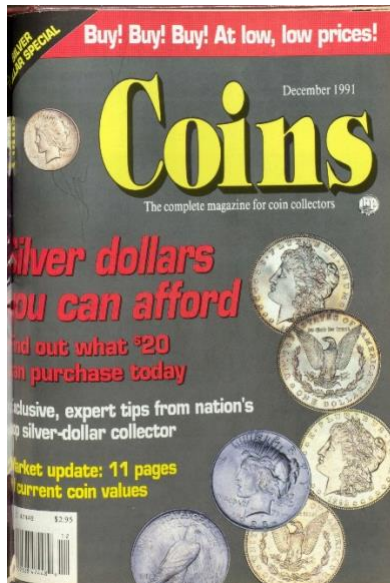


Figure 4: *Coins* Magazine Cover Page (December 1991)

<sup>136</sup> *The Vapors - Turning Japanese*, YOUTUBE (Dec. 23, 2011), <https://www.youtube.com/watch?v=IWWwM2wwMww>.

<sup>137</sup> *Id.*

<sup>138</sup> Kevin Urrutia, *The Importance of Copyright for Businesses*, VOY MEDIA (Feb. 28, 2023), <https://voymedia.com/the-importance-of-copyright-for-businesses/>.

<sup>139</sup> See *infra* Figure 4. At the time, *Coins* magazine was published by Krause Publications, Inc.

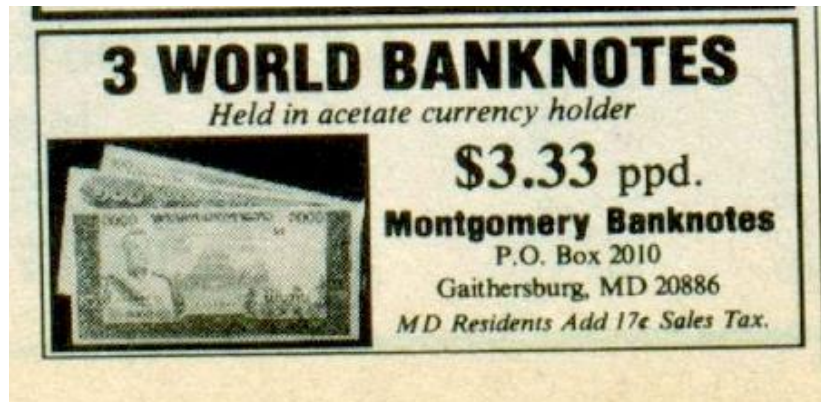


Figure 5: Montgomery Banknotes' One-Inch Ad on Page 100 of *Coins Magazine*

In 1998, Mr. Greer was accepted to the 1998 Japan Exchange and Teaching Program,<sup>140</sup> after which he was hired by Japan's then-largest law firm, Nagashima & Ohno (now Nagashima Ohno & Tsunematsu).<sup>141</sup> Mr. Greer returned to the U.S. in 2001, though his visa for residence in Japan was still valid until June 9, 2004 (see Figure 6).



Figure 6: Gregory Gerard Greer Alien Resident Card, Proving Residency Status Until June 9, 2004

<sup>140</sup> JAPAN EXCHANGE AND TEACHING PROGRAM, <https://jetprogramusa.org/> (last visited Mar. 15, 2023).

<sup>141</sup> NAGASHIMA OHNO & TSUNEMATSU, <https://www.noandt.com/> (last visited Mar. 15, 2023).

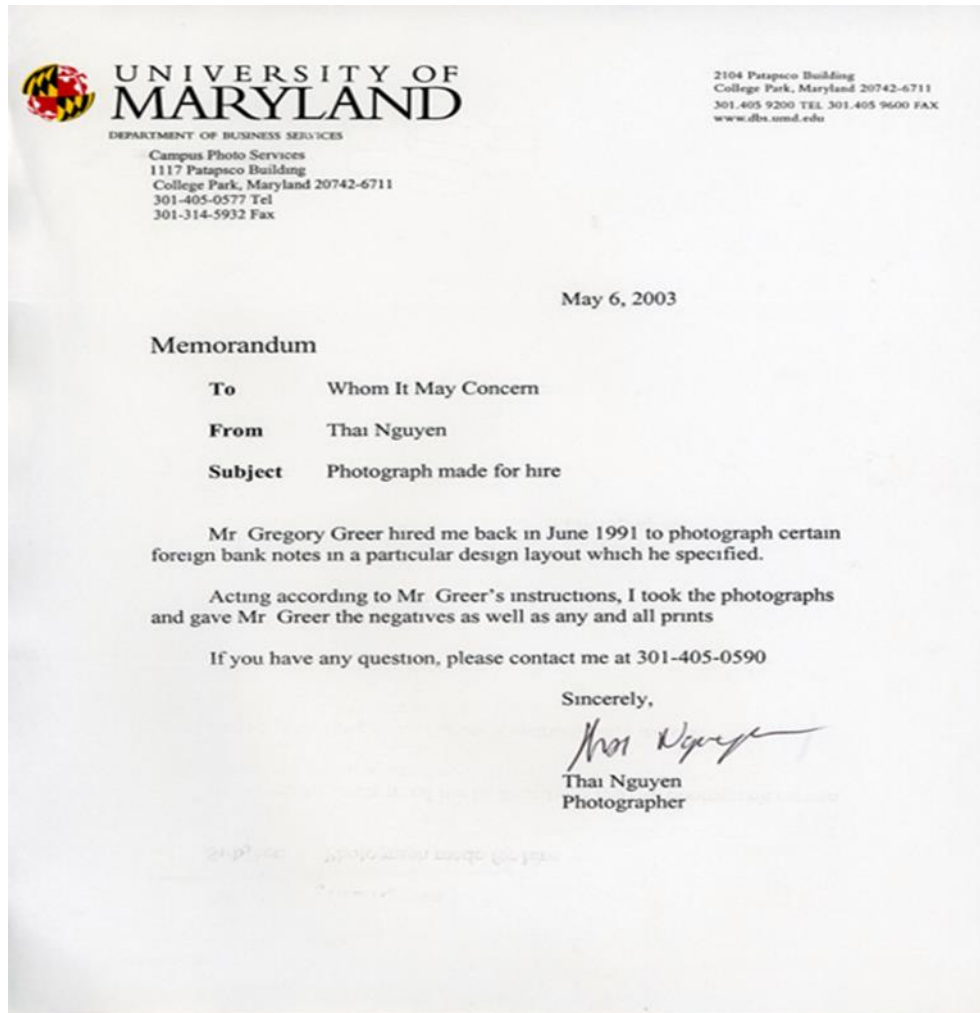
Mr. Greer was “habitually resident” in Japan from 1998 to 2004; therefore, according to Article 3(2) of the Berne Convention, he was a Japanese national.<sup>142</sup> For the purposes of the Berne Convention, Mr. Greer had turned Japanese.

In 2002, while perusing hobby magazines at a Tower Records store in Rockville, Maryland,<sup>143</sup> Mr. Greer noticed the picture that he had commissioned on a work-made-for-hire basis (see Figure 7)—and which had been used in the aforementioned ad run in *Coins* magazine (see Figure 5)—appeared in three separate publications: *World Coin News*, *Numismatic News*, and *Bank Note Reporter* (see Figures 8 to 13; infringed picture indicated with a red circle). All three publications were published by Krause Publications, the publisher of *Coins* magazine.

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<sup>142</sup> Berne Convention, *supra* note 80, at art 3(2).

<sup>143</sup> Tower Records, 1601B Rockville Pike (Congressional Plaza), Rockville, MD; see *Goodbye Tower Records* (illustration), <https://www.flickr.com/photos/whatafarce/315221029> (last visited Mar. 15, 2023) (this store has since closed).



**Figure 7: Confirmation of Work Made for Hire**

Note: Mr. Greer, as the sole proprietor of Montgomery Banknotes, hired the University of Maryland Photography Shop and secured a signed, written agreement in advance of the work starting. This work made for hire resulted in the author's creation of the picture "3 World Banknotes" (see Figure 14) in 1991. The above confirmation of work made for hire was sourced by Mr. Greer and formed part of his submissions to the Fourth Circuit in *Greer v. Krause Publications*.





Figure 8: World Coin News Cover Page



Figure 9: Infringing Page in World Coin News



Figure 10: Numismatic News Cover Page



Figure 11: Infringing Page in Numismatic News



Figure 12: Bank Note Reporter Cover Page

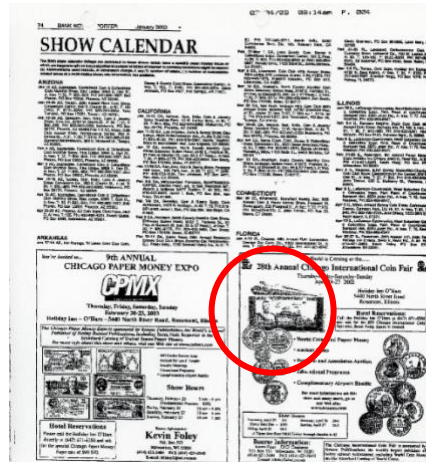


Figure 13: Infringing Page in Bank Note Reporter

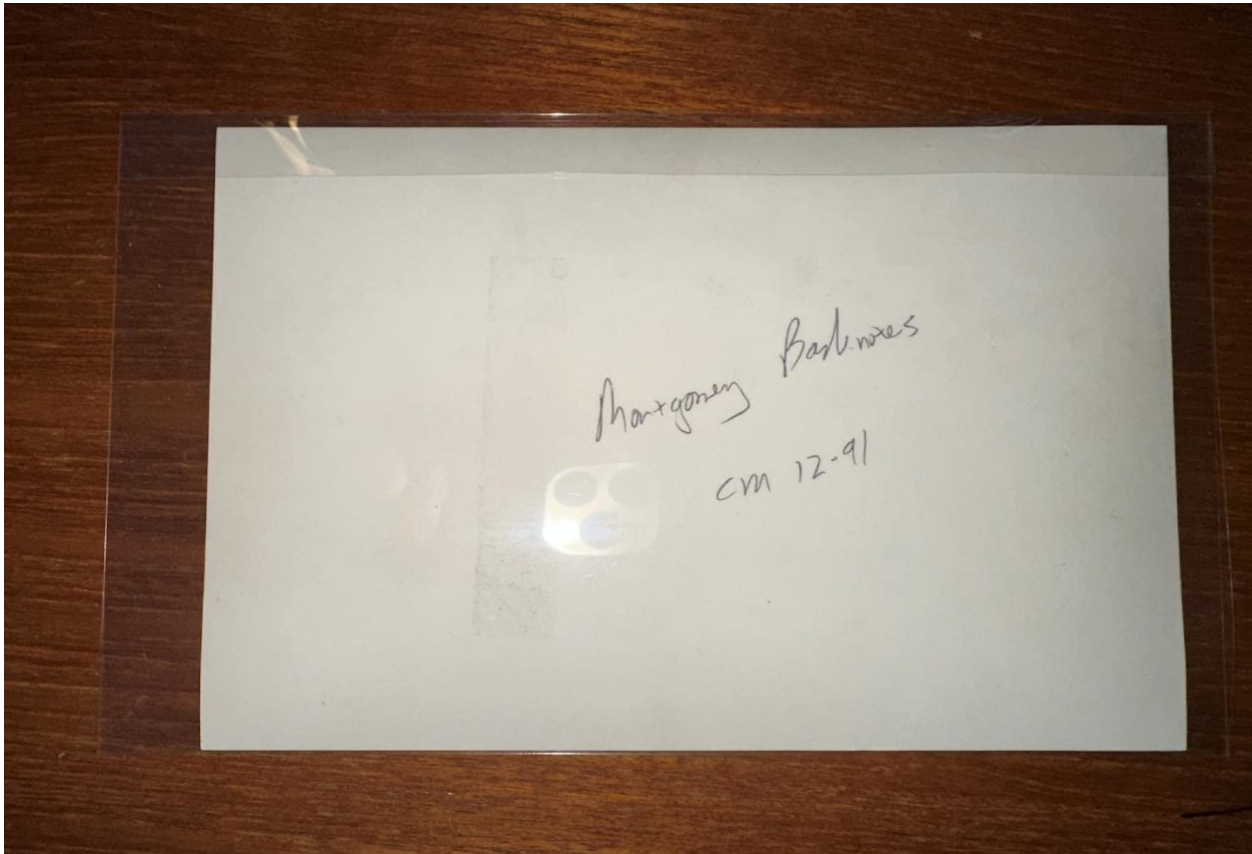
Figure 14 shows the original 5” x 7” picture commissioned by Mr. Greer on a work-made-for-hire basis. This was a carefully selected batch of Southeast Asian bank notes (the top note from Laos, the middle note from Cambodia, and the bottom note from Indonesia). Notice how the acetate currency holder is reflected. The intent was to show “3 World Banknotes” “[h]eld in acetate currency holder” (see Figure 5).



**Figure 14: The Commissioned (Work Made for Hire) Picture, Titled “3 World Banknotes”**

Figure 15 shows the back of the hardcopy printed picture, which was eventually retrieved from the infringing publisher (as part of a settlement).





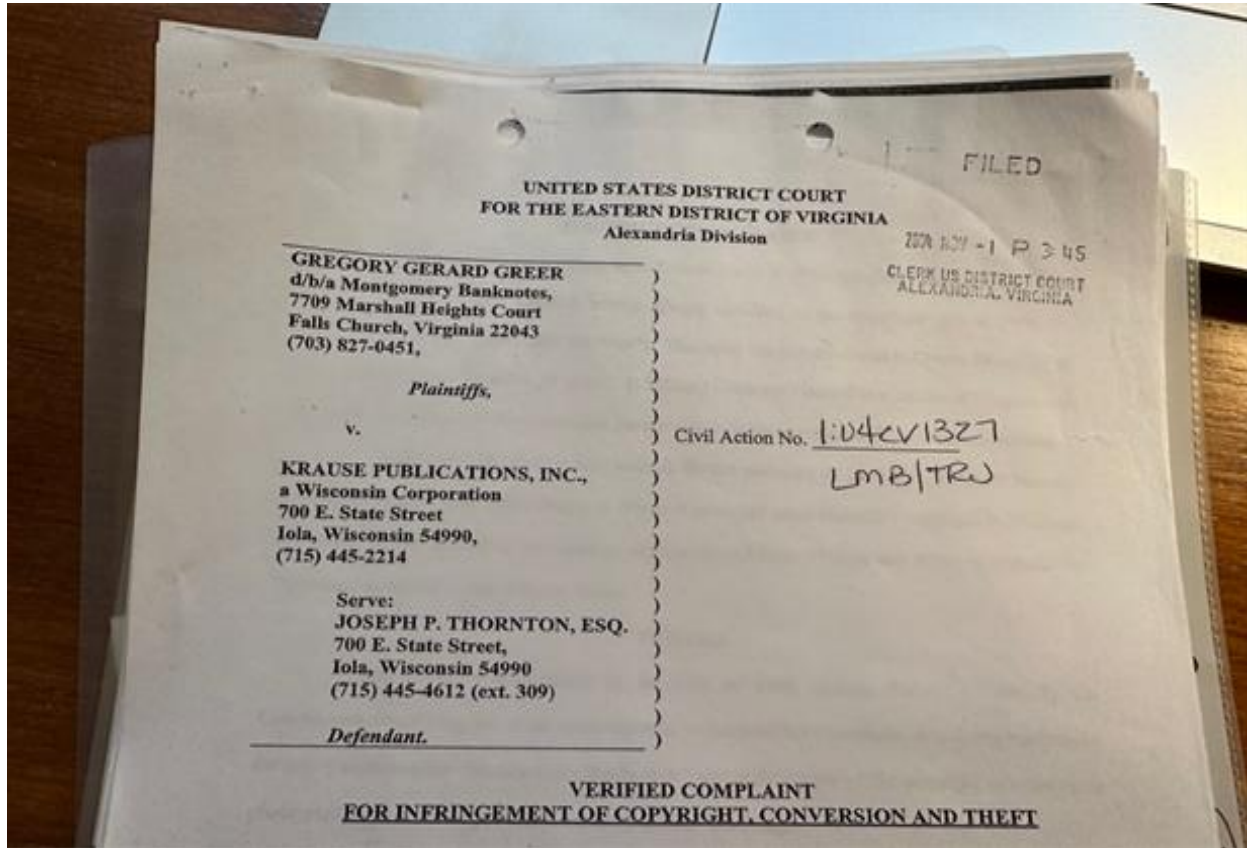
**Figure 15: Opposite/Reverse Side of the Commissioned (Work Made for Hire) Picture “3 World Banknotes”**

An employee of the infringing publisher had handwritten “Montgomery Banknotes” and “12-91” on the back of the picture. This shows that the publisher knew this picture was owned by Montgomery Banknotes—the sole proprietorship of Mr. Greer.

Mr. Greer sought counsel in the U.S. and sued Krause Publications in the Eastern District of Virginia’s “rocket docket”<sup>144</sup> (see Figure 16).

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<sup>144</sup> See, e.g., R. H. Glover, *Rocket Docket*, 29 TRIAL 45 (Apr. 1993), <https://www.ojp.gov/ncjrs/virtual-library/abstracts/rocket-docket#:~:text=The%20U.S.%20District%20Court%20for,and%20rigid%20limits%20on%20discovery>.



**Figure 16: Title Page of Submission Filed by Mr. Greer (in November 2004) in the U.S. District Court for the Eastern District of Virginia**

Krause Publications did not defend the case and lost by default.<sup>145</sup> All the “normal” issues of U.S. copyright law were pursued, save for statutory damages; because Mr. Greer had never imagined a situation akin to Krause Publications stealing his picture and making over one million copies of it in three of its publications, Mr. Greer had never registered the picture with the U.S. Copyright Office, and Mr. Greer had failed to notice the original infringement within three months as required by U.S. copyright law.<sup>146</sup> Mr. Greer did file the requisite registration to be eligible to file the federal lawsuit as a U.S. citizen, as required by U.S. copyright law<sup>147</sup> (see Figure 17).

<sup>145</sup> Greer v. Krause Publications, Inc., No. 1:2004cv01327 (4th Cir. E.D. Va. 2004).

<sup>146</sup> See *What Are Statutory Damages*, *supra* note 72.

<sup>147</sup> Cadwell, *supra* note 77.

**CERTIFICATE OF REGISTRATION**

This Certificate issued under the seal of the Copyright Office in accordance with title 17, United States Code, attests that registration has been made for the work identified below. The information on this certificate has been made a part of the Copyright Office records.

**SHORT FORM VA**  
For a Work of the Visual Arts  
UNITED STATES COPYRIGHT OFFICE

Registration Number: **VA 1-217-139**

Effective Date of Registration: **JAN. 17, 2003**

Application Received: **1-17-2003**

Deposit Received: **1-17-03** Two

Fee Received: **1-17-03**

Examined By: *JHA*

Correspondence:

**OFFICIAL SEAL**

*Marybeth Peters*  
REGISTER OF COPYRIGHTS  
United States of America

**TYPE OR PRINT IN BLACK INK DO NOT WRITE ABOVE THIS LINE**

<b>1</b> Title of This Work  Alternative title or title of larger work in which this work was published	<b>1</b> <b>3 WORLD BANKNOTES</b>
<b>2</b> Name and Address of Author and Owner of the Copyright  Nationality or domicile Phone fax and email	<b>2</b> <b>Gregory Gerard Greer</b> <b>152 Congressional Lane #159</b> <b>Rockville, Maryland 20852</b> Phone (301) 335 2053 Fax (301) 493 5114 Email <b>gregorygerardgreer@yahoo.com</b>
<b>3</b> Year of Creation	<b>3</b> <b>1991</b>
<b>4</b> If work has been published, Date and Nation of Publication	<b>4</b> a Date <u>October</u> <u>1</u> <u>1991</u> (Month day and year all required) Month Day Year b Nation <b>USA</b>
<b>5</b> Type of Authorship in This Work Check all that this author created	<b>5</b> <input type="checkbox"/> 3-Dimensional sculpture <input checked="" type="checkbox"/> Photograph <input type="checkbox"/> Map <input type="checkbox"/> 2-Dimensional artwork <input type="checkbox"/> Jewelry design <input type="checkbox"/> Text <input type="checkbox"/> Technical drawing
<b>6</b> Signature  Registration cannot be completed without a signature	<b>6</b> I certify that the statements made by me in this application are correct to the best of my knowledge Check one <input checked="" type="checkbox"/> Author <input type="checkbox"/> Authorized agent <b>X</b> <i>Gregory Greer</i>
<b>7</b> Name and Address of Person to Contact for Rights and Permissions Phone fax and email	<b>7</b> <input checked="" type="checkbox"/> Check here if same as #2 above  Phone ( ) Fax ( ) Email
<b>8</b> Certificates will be mailed in windows envelope to this address	<b>8</b> Name <b>Gregory Gerard Greer</b> Number/Street/Apt <b>152 Congressional Lane, #159</b> City/State/ZIP <b>Rockville, MO 20852</b>
	<b>9</b> Deposit Account # _____ Name _____  Complete this space only if you currently hold a deposit account in the Copyright Office

DO NOT WRITE HERE Page 1 of \_\_\_\_\_ pages

17 U.S.C. § 506(e). Any person who knowingly makes a false representation of a material fact in the application for copyright registration provided for by section 409 or in any written statement filed in connection with the application shall be fined not more than \$2,500.

June 1998—100-000 U.S. GOVERNMENT PRINTING OFFICE: 1999-454-679/54

Figure 17: Copyright Registration for the Commissioned (Work Made for Hire) Picture “3 World Banknotes”

Therefore, under “normal” U.S. copyright law, statutory damages were lost. There were three unique infringements—one in *Numismatic News*, the second in *Bank Note*

*Reporter*, and the third in *World Coin News*—the infringements were clearly willful,<sup>148</sup> and willful infringement carries a potential of \$150,000 per occurrence. Therefore, the potential penalty could amount to \$450,000 in statutory damages pursuant to U.S. copyright law.

What about Mr. Greer’s status as a Japanese national?<sup>149</sup> This was a case before the Fourth Circuit in the Eastern District of Virginia’s “rocket docket”<sup>150</sup> in 2004/2005—four years before the SDNY decided in the *Football* case that registration for statutory damages was not required in order to receive statutory damages for live broadcasting (i.e., where the foreign work is being simultaneously recorded in the country of broadcast while being broadcast in the U.S.).<sup>151</sup> Why is it that live broadcasting gets an exception and impossibility (i.e., often, it is virtually impossible for a foreign national living outside the U.S. to know that their work is being infringed in the U.S. until they actually come to the U.S. and see it in a bookstore or other physical forum)? Why is the only exception live broadcasting? Would the Eastern District of Virginia have taken a different view in 2005, when ruling on *Greer v. Krause Publications*, if the matter of Mr. Greer’s (potential) foreign citizenship and the consequent issue of impossibility were raised?

Perhaps the Fourth Circuit would have ruled differently in 2005 had Mr. Greer’s attorneys read the Berne Convention. Perhaps Mr. Greer’s attorneys would have made a Berne Convention-based argument for Mr. Greer’s status as a Japanese citizen, as per Article 3(2). What a lost chance. What a missed opportunity. Had this argument been made, and had the Fourth Circuit accepted Mr. Greer as a foreigner, perhaps it would have ruled that photographs, the same as live broadcasting, are exempt from the registration requirement due to impossibility—that is, it was virtually impossible for Mr. Greer to know that Krause Publications was infringing his copyright because none of the three magazines in which the infringement was occurring were sold in Japan. Also, since copyright law overlaps with trademark law,<sup>152</sup> perhaps a trademark-like claim of impossibility was in order. That unique picture was arguably a source-identifying logo<sup>153</sup> of Montgomery Banknotes, because:

[t]rademarks function as a designation of source or origin. See 15 U.S.C. § 1127 (defining “trademark” to include “any word, name, symbol, or device, or any combination thereof — (1) used by a person ... to identify and distinguish his or her goods ... from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown”).<sup>154</sup>

Additionally,

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<sup>148</sup> *Id.*; see also *supra* Figures 9, 11, and 13 of this paper for the willful infringements.

<sup>149</sup> See *supra* Figure 6. As previously discussed in this chapter, Mr. Greer had been habitually resident in Japan from 1998 to 2004, though his visa for residence in Japan was valid until June 9, 2004.

<sup>150</sup> Glover, *supra* note 144.

<sup>151</sup> Cadwell, *supra* note 77; *Football Ass’n Premier League v. Youtube, Inc.*, 633 F. Supp. 2d 159 (S.D.N.Y. 2009).

<sup>152</sup> See *Copyright Laws and Regulations USA 2023*, *supra* note 1.

<sup>153</sup> *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 925 F. Supp. 2d 1067, 1072–73 (C.D. Cal. 2012).

<sup>154</sup> *Id.* at 1072.



[a]s the Trademark Trial and Appellate Board has explained:  
*The salient question is whether the designation in question, as used, will be recognized in and of itself as an indication of origin for this particular product. That is, does this component or designation create a commercial impression separate and apart from the other material appearing on the label?*<sup>155</sup>

Due to the fact that Mr. Greer was in Japan (where none of the three infringing magazines were available), it was impossible for him to see the initial infringement within three months. This follows the logic of the famous Chartreuse monks' case.<sup>156</sup> In that case, "the French government [in 1903] appropriated the Grande Chartreuse, and the monks were exiled to Tarragona, Spain where they reestablished their eponymous liqueur manufactory. The French government sold the monks' distillery at the Grand Chartreuse, along with the Chartreuse trademark, to a group of private investors."<sup>157</sup> In other words, it was impossible for the monks to enforce their trademark, Chartreuse.

What if, instead of a trademark, it was copyright at issue, and the expelled monks had been from the U.S. in 1988 and, upon return to the U.S. in 2023, informed the U.S. Copyright Office that it was impossible to register their copyright with the U.S. Copyright Office, same as it was impossible to enforce their trademark in France? One surefire answer to this question is a personal request to the President of the U.S., who has overriding authority via presidential proclamation.<sup>158</sup> The happy ending to that story is that only two monks knew the *true* formula of Chartreuse liqueur and, same as with the Coca-Cola formula, only two people alive today know that trade secret.<sup>159</sup>

Returning to Mr. Greer's case, what an argument that would have been—a foreigner claiming a waiver of the usual registration requirements on the basis of impossibility, and so claiming eligibility for statutory damages for over one million instances of proven copyright infringement. If nothing else, the argument alone would surely have been powerful ammunition at the settlement table. Unfortunately, that argument was never made as Mr. Greer's attorneys did not think to read the Berne Convention (despite knowing that Mr. Greer had just returned to the U.S. after nearly three years of residing in Japan and that his status as a Japanese visa holder was still valid).

A lesson learned from this incident—and advice to counsel—is to ask your clients if they have any foreign connection. Justice Ginsburg thoroughly discussed the Berne Convention in *Golan*<sup>160</sup> for a Berne Convention-related copyright law matter. If your client has been living overseas and has been habitually resident outside the U.S., then, for the purposes of the Berne Convention, your client might be a foreign national and

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<sup>155</sup> *Id.*

<sup>156</sup> Charles Cronin, *Lost & Found: Intellectual Property of the Fragrance Industry; From Trade Secret to Trade Dress*, UNIVERSITY OF SOUTHERN CALIFORNIA LAW SCHOOL LEGAL STUDIES WORKING PAPER SERIES 178 (2015), <https://law.bepress.com/cgi/viewcontent.cgi?referer=&httpsredir=1&article=1312&context=usclwps-lss>.

<sup>157</sup> *Id.*

<sup>158</sup> 17 U.S.C. § 104 (2023).

<sup>159</sup> *Id.*

<sup>160</sup> See *Golan v. Holder*, 565 U.S. 302, 306-35 (2012) (Ginsburg, J., opinion).

might have an argument for exemption from the filing requirement for statutory damages, even for copyright items other than live broadcasting. This issue has only been ruled on by the SDNY (Second Circuit) and the Northern District of Illinois (N.D.Ill.; Seventh Circuit).

Another federal circuit may take another view, and the resulting circuit split would make this issue ripe for review by the U.S. Supreme Court. This is not thinking outside the box; the Berne Convention is well entrenched in U.S. copyright law. The Berne Convention is definitely worth arguing in all the federal circuits where this precise issue would be a case of first impression (i.e., every federal circuit except the SDNY and the N.D.Ill.), setting the stage for a circuit split. In fact, assuming that either the *Football* case<sup>161</sup> or the *Rudnicki* case<sup>162</sup> was decided exactly the same, *Greer v. Krause Publications*<sup>163</sup> could have been the first decision on this issue, and the *Rudnicki* and *Football* cases would have been that circuit split. The plaintiffs in the *Rudnicki* and *Football* cases might have had a ripe appeal ready for the U.S. Supreme Court to rule on. This issue is still a potential circuit splitter and is still an argument worth making.

#### CONCLUSION

This paper covered five standalone topics: U.S. copyright law, U.S. copyright infringement, U.S. copyright law alongside the Berne Convention, the Berne Convention and nationality, and a potential missed opportunity before the Fourth Circuit in relation to the formality of registration with the U.S. Copyright Office. The author's intent was to show how the explanatory power of each topic, when explored in isolation, is limited. Taking these five topics as a whole, however, and teasing the interrelationships between these topics, we see a different picture—academically and literally. The literal picture was the author's creation, “3 World Banknotes” (see Figure 14), made on a work-made-for-hire basis (see Figure 5), that was later infringed in three separate publications, of which over one million copies were circulated.

As previously discussed, Mr. Greer was not eligible for statutory damages; common law damages were the only remedy available, and that remedy was successful. Immediately after filing *Greer v. Krause Publications*, Krause offered a settlement of \$X.<sup>164</sup> Thanks to the true rocket docket nature of the Eastern District of Virginia, the case was over in three months, and Greer won without the other side defending the case. Greer had sued for \$1 million (i.e., \$1 per each unlicensed copy of the picture printed). A court does not just hand over such an amount; the winner must prove to the court that the amount is justified. How does one prove that someone making one million copies of a picture equals \$1 million in value? Even if full statutory damages had been awarded, the amount—at most—would have been \$450,000; however, due to lack of registration, Mr. Greer was not eligible for statutory damages. After losing the case, Krause doubled its settlement offer to \$2X. Mr. Greer was advised by his attorney

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<sup>161</sup> See generally *Football Ass'n Premier League*, 633 F. Supp. 2d 159.

<sup>162</sup> See generally *Rudnicki v. WPNA* 1490 AM, 580 F. Supp.2d 690 (N.D. Ill. 2008).

<sup>163</sup> See *Greer v. Krause Publications, Inc.*, No. 1:2004cv01327 (4th Cir. E.D. Va. 2004).

<sup>164</sup> *Id.* Mr. Greer signed a confidentiality agreement not to disclose the settlement amount. “X” = the (confidential) settlement amount initially offered by Krause Publications. *Id.*

to accept this offer and end the matter. Mr. Greer countered and offered to accept \$2.5X, which Krause accepted.

What would the outcome have been had Mr. Greer's Japanese citizenship and waiver of registration for statutory damages been argued? As the 2009 *Football* case in SDNY had not yet been heard, the issue of formalities and the waiver of statutory damages would have been a case of first impression for the entire U.S. federal judiciary, including the Fourth Circuit. Settlement of something near \$450,000 (rather than the much lower amount of \$2.5X), at least a six-figure number, would have been likely. Krause had lost and the only issue was by how much. That was the time to argue full statutory damages based on the waiver of formalities for foreign nationals. Now that the Second and Seventh Circuits have decided that only live broadcasting qualifies, it will be much harder to make an argument for a waiver (of formalities for foreign nationals) in pursuit of statutory damages for anything other than live broadcasting. Nonetheless, this argument could still be made in another federal circuit. If your client has a similar case—that is, they were outside the U.S. and habitually resident in another country, and it was impossible for them to know their work was being infringed in the U.S. at the time—you might have an argument to make.

In trademark law, a close cousin of copyright law, provisions for impossibility have been made. Why not the same allowance for U.S. statutory damages for U.S. copyright law? In international law, impossibility is allowed in relation.<sup>165</sup> The Berne Convention is a treaty, and it is time for the U.S. formality of registration by foreigners to be completely waived for all formalities, including statutory damages. Perhaps now is the time for a presidential proclamation<sup>166</sup> ordering the waiver of the registration requirement by foreigners to enable them to be eligible for statutory damages in the U.S. in the event of copyright infringement. That would surely be well received by all foreigners to the U.S.—friend or foe—and the U.S. would move closer toward the international player it aspires to be. Now is the time.

After communication with Ralph Oman, Mr. Greer's first professor at The George Washington University Law School in the Fall 2021 term, Professor Oman, Register of Copyrights from 1985 to 1994, had the following comment on this article:

“Berne is not self-executing in the United States. The statute rules. The U.S. Congress, the Library of Congress, and, presumably, the U.S. Copyright Office would strenuously oppose a weakening of the Section 412 incentive to timely registration. Statutory damages are an ‘extra’ benefit not mentioned in the Berne Convention or offered in any other Berne Convention member country; therefore, the U.S. has leeway in this regard.”

Ralph Oman  
Register of Copyrights, 1985 to 1994  
Pravel, Hewitt, Kimball and Kreiger Professorial Lecturer in Intellectual  
Property and Patent Law, The George Washington University Law School

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<sup>165</sup> Vienna Convention, *supra* note 104.

<sup>166</sup> See 17 U.S.C. § 104(b)(6) (2023).