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# Updating the Berne Convention for the Internet Age: Un-Blurring the Line Between United States and Foreign Copyrighted Works

## INTRODUCTION

John Naughton, notable journalist and academic, has asserted that “[common sense] should also revolt at the idea that doctrines about copyright that were shaped in a pre-Internet age should apply to a post-Internet one.”<sup>1</sup> And yet, in crucial aspects of international law, this is the situation in which the world finds itself today. The Berne Convention for the Protection of Literary and Artistic Works (the “Berne Convention” or the “Convention”) is one of the most important multinational agreements concerned with copyright law, but it has not been amended since September 28, 1979.<sup>2</sup> Although the internet technically existed in an early and limited form at that time,<sup>3</sup> its use did not become popular and widely available to the public until it was privatized in the 1990s.<sup>4</sup> Because of this timing, the Berne Convention does not reflect any of the practical possibilities for the creation and dissemination of copyrighted works that the internet has made possible, let alone the explosion of creative content and the changing attitudes toward authorship, sharing, and copyright that those realized possibilities have brought about.<sup>5</sup>

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1. JOHN NAUGHTON, FROM GUTENBERG TO ZUCKERBERG: WHAT YOU REALLY NEED TO KNOW ABOUT THE INTERNET 255 (2012).

2. Berne Convention for the Protection of Literary and Artistic Works, Sept. 28, 1979, S. TREATY DOC NO. 99-27 [hereinafter *Berne Convention*].

3. JANET ABBATE, INVENTING THE INTERNET 183 (1999). “At the start of the 1980s, the Internet—still under military control—consisted of a mixture of operational and research networks, many still experimental . . . . In the late 1970s, only a dozen or so computer science departments were connected to the ARPANET.”; Although conventions of usage formerly held that “internet” should be capitalized, it has become common and acceptable to leave it lowercase (*see, e.g.*, Philip B. Corbett, *It’s Official: The ‘Internet’ Is Over*, N.Y. TIMES (June 1, 2016), <https://www.nytimes.com.erl.lib.byu.edu/2016/06/02/insider/now-it-is-official-the-internet-is-over.html>). I have chosen to leave the word lowercase throughout this paper except in instances where it is capitalized in quoted material.

4. ABBATE, *supra* note 3, at 199.

5. These trends have included phenomena like the rampant peer-to-peer file sharing of the early 2000s via platforms like Grokster, Torrent, and Limewire; the rise of internet blogging and vlogging; and the current availability of social media platforms that allow people to fairly easily share their own written thoughts, photographs, artwork, songs, and videos (and those of others) with hundreds, thousands, or millions of people around the world.

This absence of internet context in the Berne Convention makes it especially difficult to map international law onto evolving notions on (1) the publication of copyrighted works and (2) the countries of origin of those works.<sup>6</sup> United States courts have clumsily grappled with these notions while applying the U.S. laws that were meant to bring the Berne Convention into effect domestically and, as a result, have either had to ignore the plain language of the Berne Convention's implementation or ignore its core purposes in order to come to what seemed like logical outcomes. The United States is no doubt not the only country to have struggled with these applications (though even if it were, the example of the United States could cast a long shadow in terms of international effects).<sup>7</sup> Updating the Berne Convention to acknowledge and account for an internet-centric, worldwide society would help alleviate these struggles. Modifying the Convention's definitions of publication and country of origin would be especially helpful.

This paper will start, in Part I, by giving further historical background on the Berne Convention and the internet. Part II will then explain specific problems that the Convention-internet disconnect has caused—in other words, specific reasons why the Convention should be updated. These reasons center around *Moberg v. 33T LLC* and *Kernal Records Oy v. Mosley*, a pair of U.S. court cases that particularly exemplify the intractable decision between advancing the Berne Convention's purposes or advancing its implementation language (advancing both being difficult or impossible).<sup>8</sup> Part III will propose changes that could be adopted to update the Convention by identifying elements that updated definitions of publication and country of origin could include. Part IV will examine how the updates could be made through direct amendment of the Berne Convention or other avenues. Part IV will also address the fact that the Convention is not self-executing and explore the limited mechanisms built into the convention to persuade member states to write the Convention's

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6. The terms "country" and "state" are used interchangeably throughout this paper. They are both intended to mean sovereigns on the world stage (like the United States of America or the Republic of India) and not political subdivisions within those sovereigns (like Texas or Idaho).

7. Although I have not been able to find specific legal cases from other countries exemplifying this phenomenon, sources do indicate that the internet problem has received attention internationally. See, e.g., JØRGEN BLOMQVIST, PRIMER ON INTERNATIONAL COPYRIGHT AND RELATED RIGHTS 52-53 (2014). "[A]s regards the dissemination of works and objects of related rights on the *internet*, quite some discussion has taken place, also under the auspices of WIPO, but no general agreement seems to have emerged as to which law is to be considered applicable."

8. *Moberg v. 33T LLC*, 666 F. Supp. 2d 415, 417 (D. Del. 2009); *Kernal Recs. Oy v. Mosley*, 794 F. Supp. 2d 1355, 1360 (S.D. Fla. 2011).

principles into their domestic law. The paper will finish with a brief conclusion.

## I. THE BERNE CONVENTION IS OUT OF DATE

The Berne Convention was first conceived in a world where the telephone was still new,<sup>9</sup> and while it has been updated since then, it has not yet fully accounted for the technological revolution brought about by the advent of the internet.<sup>10</sup> An auxiliary treaty to the Berne Convention, the World Intellectual Property Organization Copyright Treaty, which was created in 1996 and entered into force in 2002, was meant to address some of the challenges that advancing technology has brought to the copyright table, but this treaty was not designed to address the specific problems laid out in this paper and does not mention the internet.<sup>11</sup>

### A. *History and Purposes of the Berne Convention*

The Berne Convention for the Protection of Literary and Artistic Works started out as the 1886 Berne Act and has moved through several iterations since then, culminating most recently with the Paris Act as amended in 1979.<sup>12</sup> The Convention created a union of countries dedicated to advancing its purposes and grew out of the desire of those countries “to protect, in as effective and uniform a manner as possible, the rights of authors in their literary and artistic works.”<sup>13</sup> The categories of works covered by the Convention are extensive:

[E]very production in the literary, scientific and artistic domain, whatever may be the mode or form of its expression, such as books, pamphlets and other writings; lectures, addresses, sermons and other works of the same nature; dramatic or dramatico-musical works; choreographic works and entertainments in dumb show; musical

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9. Alexander Graham Bell’s patent for the telephone was filed on February 14, 1876. Science Reference Section, Library of Congress, *Who is Credited with Inventing the Telephone?* LIBRARY OF CONGRESS (Nov. 19, 2019), <https://www.loc.gov/everyday-mysteries/item/who-is-credited-with-inventing-the-telephone/>.

10. *Berne Convention*, *supra* note 2. The Berne Convention was created in 1886 and last updated in 1979.

11. World Intellectual Property Organization Copyright Treaty, Dec. 20, 1996, S. TREATY DOC NO. 105-17. Some of the topics addressed by this treaty include copyright protection for computer programs and preventing circumvention of technological protection measures that shield computer software from unauthorized copying.

12. Paul Goldstein & P. Bernt Hugenholtz, *International Copyright: Principles, Law, and Practice* 156-57 (3d ed. 2013).

13. *Berne Convention*, *supra* note 2.

compositions with or without words; cinematographic works to which are assimilated works expressed by a process analogous to cinematography; works of drawing, painting, architecture, sculpture, engraving and lithography; photographic works to which are assimilated works expressed by a process analogous to photography; works of applied art; illustrations, maps, plans, sketches and three-dimensional works relative to geography, topography, architecture or science.<sup>14</sup>

The rights protected by the Convention (with exclusivity tempered by certain exceptions)<sup>15</sup> include the right to reproduce a work;<sup>16</sup> the right to translate a work;<sup>17</sup> and, depending on the type of work, rights of public performance,<sup>18</sup> broadcast,<sup>19</sup> recitation,<sup>20</sup> adaptation, arrangement, alteration,<sup>21</sup> enforcement,<sup>22</sup> etc.

An international convention on this subject was necessary in the first place since copyright law is constrained by the principle of extraterritoriality; the copyright law of one country cannot, by itself, have effect on acts of infringement undertaken in another country. Historically, without treaties or other international law to regulate infringement across borders, infringers of works produced in a foreign country could plagiarize with impunity.<sup>23</sup> The Berne Convention was an effort to alleviate this problem and provided a powerful vehicle for creators of copyrightable works to seek protection for those works internationally. Throughout its revisions, the Convention has sought to give creators stronger rights by raising the minimum standards of protection which signatory countries must provide to creators' works and by reducing the formalities with which creators must comply to receive that protection.<sup>24</sup>

One minimum standard that the Convention regulates is the length of a copyright's term. The countries of the world adopt different terms or

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14. *Id.* at art. 2.

15. *Id.* at art. 10, art. 10*bis*.

16. *Id.* at art. 9.

17. *Id.* at art. 8.

18. *Id.* at art. 11.

19. *Id.* at art. 11*bis*.

20. *Id.* at art. 11*ter*.

21. *Id.* at art. 12.

22. *Id.* at art. 15.

23. See, e.g., *When Charles Dickens Fell out with America*, BBC (Feb. 14, 2012), <https://www.bbc.com/news/magazine-17017791>. "In 1842, there were no international copyright laws so Americans could read Dickens's works for free in pirated editions. Once Dickens saw how popular he was in the US, he realised he could virtually double his income if his American fans started paying a going rate for his work. 'I am the greatest loser alive by the present law,' he complained in letters home."

24. GOLDSTEIN & HUGENHOLTZ, *supra* note 12, at 156-57.

time periods for which their copyright protections last. The Berne Convention creates uniformity in this area by requiring its member countries to grant to most copyrighted works a copyright term of at least fifty years (although countries may grant longer terms if they choose).<sup>25</sup> This requirement provides creators with a fairly long minimum term of protection upon which they can rely in most countries of the world.

The Convention also regulates copyright formalities. Copyright formalities are the formal steps or requirements with which the creator of a work must comply to receive copyright protection. Under the United States Copyright Act of 1909, for example, the creator of a literary work was required, among other requirements, to affix a copyright notice to the published text or forfeit copyright protection.<sup>26</sup> This required inclusion of the copyright notice was a formality. Other formalities might require creators to register their works with the government before they receive copyright protection or before they can sue to enforce those copyrights. Formalities can be undesirable because they make copyright protection difficult to get, and if the protection is difficult to get, the copyright scheme will not provide the incentives for further innovation and advancement that are the goals of copyright law in the first place.<sup>27</sup> Formalities are especially undesirable on the international stage, though, since each country could potentially have its own unique maze of bureaucratic, linguistic, and arbitrary barriers standing between a creator and the acquisition of copyright protection in that country. The Berne Convention eliminates this problem by requiring that, in the Berne Union's member countries, the "enjoyment and the exercise of [the rights guaranteed in the Convention] shall not be subject to any formality."<sup>28</sup> This limit on formalities gives creators a guarantee that obtaining copyright protection for their works will be straightforward. Importantly, though, this rule has an exception; member countries of the Convention are still allowed to impose formality requirements on domestic works, just not foreign ones: "Protection in the country of origin is governed by domestic law."<sup>29</sup>

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25. *Berne Convention*, *supra* note 2, at arts. 7(1), 7(6).

26. II PETER S. MENELL ET AL., *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE*: 2020, at 509 (2020).

27. *Id.*; U.S. CONST. art. I, § 8, cl. 8.

28. *Berne Convention*, *supra* note 2, at art. 5(2).

29. *Berne Convention*, *supra* note 2, at art. 5(3).

Today, almost every country of the world is a member of the Berne Convention,<sup>30</sup> so its scope is far-reaching, and its correct application is crucial.

*B. A Brief History of the Rise of the Internet*

The genesis of the internet began with the invention of packet switching in the early 1960s.<sup>31</sup> Packet switching provided a method for transmitting data that would eventually make large networks like the ARPANET possible.<sup>32</sup> The ARPANET, a military network, and its predecessors were born out of a desire to have a robust communications network in the event of nuclear war,<sup>33</sup> but the ARPANET also became a means of undertaking and sharing research.<sup>34</sup> Although the ARPANET itself had predecessors, it is often considered the predecessor to the internet. The ARPANET's first nodes were installed at four locations in the Western United States in 1969.<sup>35</sup>

In the late 1970s, around the time of the Berne Convention's last amendment, "only a dozen or so computer science departments were connected to the ARPANET,"<sup>36</sup> but "[o]ver the course of the 1980s, the balance shifted away from military involvement and toward academic research."<sup>37</sup> Eventually, as the ARPANET became obsolete and faced retirement, new private networks became the backbones of the burgeoning internet.<sup>38</sup> As further networks were added, the internet came to look more like what we are familiar with today.<sup>39</sup> In short, "it took a series of transformations over the course of the 1980s and the early 1990s to turn the Internet into a popular form of communication."<sup>40</sup>

The timing of the internet's rise is at odds with the Berne Convention, but so, too, is its nature. Copyright law, as its name implies, seeks to regulate the ways and scenarios in which creative works may be copied.

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30. *Contracting Parties > Berne Convention [Total Contracting Parties: 181]*, WORLD INTELLECTUAL PROPERTY ORGANIZATION, [https://wipolex.wipo.int/en/treaties/ShowResults?search\\_what=C&treaty\\_id=15](https://wipolex.wipo.int/en/treaties/ShowResults?search_what=C&treaty_id=15) (last visited Feb. 22, 2023).

31. ABBATE, *supra* note 3, at 7–8.

32. *Id.*

33. *Id.* at 8–10.

34. *Id.* at 46.

35. *Id.* at 64.

36. *Id.* at 183.

37. *Id.*

38. *Id.* at 194–200.

39. *Id.* at 200.

40. *Id.* at 182.

The internet, on the other hand, along with the computers that use it, is an engine of unregulated copying:

The digital computer is, essentially, a copying machine. That's not because it was *designed* to make copies but because it actually works by continually making copies of bitstreams, manipulating them and moving them from one internal register to another. Copying is also an intrinsic part of most interactions with the Internet. When you click on a web link, for example, what happens is that the server on which the requested page resides dispatches a copy of the page—encoded as ones and zeroes—across the Net. When your computer receives the bits, it copies them faithfully into its video RAM, which then enables the machine to display the page on your screen. So the very act of viewing a web page actually requires making a perfect copy of it. Copying is to digital computing, therefore, as breathing is to animal life—in that one cannot exist without the other.<sup>41</sup>

As computers and the internet have become ubiquitous, copying has also become so. As the United States Register of Copyrights has noted, “the same features making digital technology a valuable delivery mechanism—the ability to quickly create and distribute near-perfect copies of works on a vast scale—also carry the potential to enable piracy to a degree unimaginable in the analog context.”<sup>42</sup> These considerations illustrate how crucial it is for copyright schemes to account for contemporary technology, especially when those schemes are subscribed to by most of the world's countries and when they could affect the copyright protections available to billions of people.

## II. REASONS WHY THE BERNE CONVENTION SHOULD BE UPDATED: PROBLEMS CREATED BY THE INTERPLAY OF THE BERNE CONVENTION AND THE INTERNET

The troubles with the outdated Berne Convention addressed in this paper center on a few of the definitions within the Convention. These definitions, when applied in United States courts, have led to undesirable results. As will be further explained in the analyses of the cases addressed below, these definitions have given U.S. courts the option of unfairly conscripting foreign works into the category of U.S. works, subjecting their creators to U.S. copyright formalities. To reject this choice, courts

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41. NAUGHTON, *supra* note 1, at 244.

42. U.S. Copyright Off., Section 1201 Rulemaking: Eighth Triennial Proceeding to Determine Exemptions to the Prohibition on Circumvention: Recommendation of the Register of Copyrights 4 (2021).



must engage in questionable twisting of the statutory text that implements the Berne Convention in the United States. Both outcomes are unsuitable.

The definition of published works in the current Berne Convention is as follows:

[W]orks published with the consent of the authors, whatever may be the means of manufacture of the copies, provided that the availability of such copies has been such as to satisfy the reasonable requirements of the public, having regard to the nature of the work. The performance of a dramatic, dramatico-musical, cinematographic or musical work, the public recitation of a literary work, the communication by wire or the broadcasting of literary or artistic works, the exhibition of a work of art and the construction of a work of architecture shall not constitute publication.<sup>43</sup>

A further definition is provided for simultaneous publication: “A work shall be considered as having published simultaneously in several countries if it has been published in two or more countries within thirty days of its first publication.”<sup>44</sup>

The Convention defines country of origin thus:

The country of origin shall be considered to be:

- (a) In the case of works first published in a country of the Union, that country; in the case of works published simultaneously in several countries of the Union which grant different terms of protection, the country whose legislation grants the shortest term of protection;
- (b) In the case of works published simultaneously in a country outside the Union and in a country of the Union, the latter country;
- (c) In the case of unpublished works or of works first published in a country outside the Union, without simultaneous publication in a country of the Union, the country of the Union of which the author is a national, provided that:
  - (i) When these are cinematographic works the maker of which has his headquarters or his habitual residence in a country of the Union, the country of origin shall be that country, and
  - (ii) When these are works of architecture erected in a country of the Union or other artistic works incorporated in a building or other structure located in a country of the Union, the country of origin shall be that country.<sup>45</sup>

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43. *Berne Convention*, *supra* note 2, at art. 3(3).

44. *Id.* at art. 3(4).

45. *Id.* at art. 5(4).

As mentioned above, two particular United States court cases highlight the pitfalls attendant to applying the outdated Berne Convention to international copyright infringement via the internet. The first of these cases, *Moberg v. 33T LLC*, was a case of first impression—it was the first time that a U.S. court was asked to rule on whether a work distributed (and possibly published) through the internet should be considered a United States work under the statutes that implement the Berne Convention in the United States.<sup>46</sup> The court in the second case, *Kernal Records Oy v. Mosley*, was tasked with a similar question, having virtually no precedent on which to rely other than *Moberg*.<sup>47</sup> It decided, however, to take a different approach.<sup>48</sup> *Kernal Records* was appealed to the Eleventh Circuit, and some of its reasoning was overturned, but the overall result of the case was upheld on procedural grounds,<sup>49</sup> and the district court opinion still helps highlight the difficulties of applying the Convention's current definitions. In addition, the appellate result in the case does not foreclose courts in other circuits from following a similar approach to the district court's when faced with similar controversies, especially in relation to the district court's reasoning that was not abrogated. *Moberg* did not proceed beyond the district court level. The district court in each case came to a different result in applying the U.S. implementation of the Berne Convention, but both results were problematic: one put the purposes of the Convention ahead of its plain language, and the other put the plain language ahead of its purposes.

#### A. *The Case of Moberg v. 33T LLC*

This case centers on a series of photographs that Swedish photographer, Hakan Moberg, created in 1993.<sup>50</sup> In 2004, the photographs were first made available to the public on a German website that functioned as an online art shop, offerings works for sale as canvas prints.<sup>51</sup> The photographs were properly attributed to Moberg on this site.<sup>52</sup> At some point after this but before December of 2007, five of Moberg's

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46. *Moberg v. 33T LLC*, 666 F. Supp. 2d 415, 417 (D. Del. 2009).

47. *Kernal Recs. Oy v. Mosley*, 794 F. Supp. 2d 1355, 1360 (S.D. Fla. 2011).

48. *Id.* at 1365.

49. *Kernel Recs. Oy v. Mosley*, 694 F. 3d 1294, 1296 (11th Cir. 2012). The reason for the spelling discrepancy between the district court opinion and that of the Court of Appeals for the Eleventh Circuit (*Kernal* versus *Kernel*) is unclear; it is reflected in the official reports of the cases.

50. *Moberg*, 666 F. Supp 2d at 417–18.

51. *Id.* at 418.

52. *Id.*

photographs were posted without authorization on three websites that offer website design templates.<sup>53</sup> Two of the sites were owned by 33T LLC, a Delaware limited liability company, and by Cedric Leygues, a French citizen.<sup>54</sup> The third site was owned by Erwan Leygues, also a French citizen.<sup>55</sup> These three parties, the LLC and the two French citizens, are the defendants of the case. The photographs were displayed on the sites during at least the period between December of 2007 and March of 2008, and although some were taken down after Moberg's attorney demanded that the defendants cease their use, others were still displayed up until the time that Moberg filed his complaint alleging violation of the United States Copyright Act and the Digital Millennium Copyright Act of 1998 in September of 2008.<sup>56</sup>

The defendants' main argument against the infringement claims, at least the one most thoroughly addressed by the court, is somewhat daring. First, they claimed that, under the United States statutes that implement the Berne Convention, *Moberg's* photographs qualified as United States works instead of foreign works.<sup>57</sup> The relevant statutory provision, 17 U.S.C. § 101, read at the time (as quoted by the court's opinion): "[A] work is a 'United States work' only if—(1) in the case of a published work, the work is first published— . . . (B) simultaneously in the United States and another treaty party or parties whose law grants a term of copyright protection that is the same as or longer than the term provided in the United States."<sup>58</sup> The defendants asserted that it is "well settled that Internet publications are published everywhere simultaneously, regardless of the location of the server hosting the website" and that the photographs, first posted on a German website and resultingly published simultaneously in the United States, were thus United States works.<sup>59</sup> Second, the defendants asserted that since the photographs were United States works, they were subject to 17 U.S.C. § 411(a), requiring that, in order for a court "to have subject matter jurisdiction over a plaintiff's Copyright Act claim for an alleged infringement of a 'United States work,' the work must be registered according to the provisions in the Copyright Act."<sup>60</sup> This

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53. *Id.*

54. *Id.*

55. *Id.*

56. *Id.*

57. *Id.* at 419.

58. *Id.* The court notes that Germany is a treaty party that grants a term of copyright protection that is the same as the term provided by the United States. *See id.* at 419 n.7.

59. *Id.* at 419.

60. *Id.*

requirement was a formality that the United States had retained for its domestic works, even though the Berne Convention disallowed such formalities for foreign works.<sup>61</sup> Since the photographs were, in the defendants' view, United States works because of their internet publication and since Moberg had not registered the photographs in the United States, the defendants argued that dismissal of the lawsuit was required.

On one hand, this argument seems counterintuitive. Why, practically speaking, should artistic works that were produced in Europe by a Swede and published on a German website "count" as United States works just because of the nature of the internet? One professor described this "hopeful invocation of simultaneous publication" as "audacity" and "formalities imperialism."<sup>62</sup> On the other hand, the argument is logically formulated, and it does seem to apply the relevant statutes naturally. This is the cognitive dissonance that the court found itself dealing with as it analyzed the defendants' arguments.

The court responded, first, by rejecting the defendants' assertion that it is "well settled" that publications on the internet are published simultaneously everywhere in the world.<sup>63</sup> It then cited a law review article, one of the few authoritative sources on the subject that either party could produce, to challenge whether Moberg's photographs were even published in the first place.<sup>64</sup> The court encapsulated the issue of the case (whether the photographs were United States works) into two main questions: "(1) whether the posting of plaintiff's photographs on the Internet is considered 'publishing,' and, if so, (2) whether 'publishing' on the Internet causes the photographs to be published in the country where the internet site is located or in every country of the world simultaneously."<sup>65</sup> Under the U.S. Copyright Act at the time, publication was defined in 17 U.S.C. §101 thus:

[T]he distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending. The offering to distribute copies or phonorecords to a group of persons for

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61. Berne Convention, *supra* note 2, at art. 5(3).

62. Jane C. Ginsburg, *Borderless Publications, the Berne Convention, and U.S. Copyright Formalities*, THE MEDIA INSTITUTE (Oct. 20, 2009), <https://www.mediainstitute.org/2009/10/20/borderless-publications-the-berne-convention-and-u-s-copyright-formalities/>.

63. *Moberg*, 666 F. Supp 2d at 420.

64. *Id.* at 420–21. The court cited Thomas F. Cotter, *Toward a Functional Definition of Publication in Copyright Law*, 92 MINN. L. REV. 1724 (2008).

65. *Moberg*, 666 F. Supp 2d at 421.

purposes of further distribution, constitutes publication. A public performance or display of a work does not itself constitute publication.<sup>66</sup>

This language was effectively the U.S. domestic implementation of the Berne Convention's definition of publication.<sup>67</sup> On the surface, this definition of publication seems to apply to Moberg's posting of his photographs on the internet. After all, by posting on the gallery's site, he was effectively offering to distribute copies of his works to them for purposes of further distribution. Even under the Berne Convention's definition, which differs in some respects from the U.S. statutory one, many people would likely consider Moberg's photographs to have been published through their posting.

However, the court ignored these simple textual applications, choosing instead to rule that "as a matter of U.S. statutory law the photographs were not published simultaneously in the United States,"<sup>68</sup> basing this conclusion more on a normative application of the Berne Convention's purposes than on the textual definitions.<sup>69</sup> The court stated that the idea that publishing a work online "automatically, instantaneously, and simultaneously causes that work to be published everywhere in the world, so that the copyright holder is subjected to the formalities of the copyright laws of every country which has such laws is contrary to the purpose of the Berne Convention."<sup>70</sup> Further, the court pointed out that "the transformation of plaintiff's photographs into United States works simply by posting them on the Internet could allow American citizens to infringe on foreign copyrighted works without fear of legal retribution since the majority of foreign works are never registered in America."<sup>71</sup> These are valid, compelling concerns, but observers may question whether these concerns should be enough to outweigh the clear application of the law. This court decided that they were, but whether that was the correct choice remains unclear.

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66. *Id.*

67. *Berne Convention*, *supra* note 2, at art. 3(3) ("[W]orks published with the consent of the authors, whatever may be the means of manufacture of the copies, provided that the availability of such copies has been such as to satisfy the reasonable requirements of the public, having regard to the nature of the work. The performance of a dramatic, dramatico-musical, cinematographic or musical work, the public recitation of a literary work, the communication by wire or the broadcasting of literary or artistic works, the exhibition of a work of art and the construction of a work of architecture shall not constitute publication.").

68. *Moberg*, 666 F. Supp. at 422.

69. *Id.* at 422–23.

70. *Id.* at 422.

71. *Id.* at 423.

*Moberg* is a case decided rightly on the morals but perhaps wrongly on the merits. While ruling in favor of *Moberg* seems instinctually “right” under the circumstances, it also seems like an incorrect application of the law. The judge put the purposes of the Berne Convention ahead of its plain language and the plain language of the U.S. implementing statute. If judges in the United States or anywhere else in the world feel the need to contradict the plain language of the Berne Convention to advance its purposes, the language clearly needs some revision.

*B. The Case of Kernal Records Oy v. Mosley*

Parallel to *Moberg* lies a case in which a court faced a similar question and opted for the opposite result. But this outcome is not without problems of its own. In this case, a company named Kernal Records Oy had acquired rights in a sound recording and musical composition called “Acidjazzed Evening” (“AJE”), which had been produced electronically on a vintage computer by Glenn Rune Gallefoss, a Norwegian citizen.<sup>72</sup> Kernal Records Oy subsequently sued Timothy Z. Mosley (known professionally as Timbaland) and two associated LLCs (the defendants of the case), alleging that they had copied AJE to create a new composition titled “Do It.”<sup>73</sup> Like in *Moberg*, the defendants here claimed that the copyrighted work in question was a United States work and that it had not been registered prior to the filing of a suit in compliance with 17 U.S.C. § 411.<sup>74</sup> This argument, though, purported to bestow United States work status on AJE through a different, even more far-reaching prong of 17 U.S.C. § 101.<sup>75</sup> The photographs in *Moberg* had arguably been U.S. works because they were published simultaneously in the United States and another treaty party (Germany) whose law grants a term of copyright protection longer than the term provided in the United States, thus qualifying the photographs as U.S. works under prong (B) of § 101’s definition of “United States work.”<sup>76</sup> The defendants in *Kernal Records* argued instead that AJE qualified as a U.S. work under prong (C) of § 101, which treats as U.S. works any works published simultaneously in the United States and a foreign nation that is not a party to an international agreement.<sup>77</sup> If the posting of AJE on the internet counted as publication in all countries

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72. *Kernal Recs. Oy v. Mosley*, 794 F. Supp. 2d 1355, 1358 (S.D. Fla. 2011).

73. *Id.*

74. *Id.*

75. *Id.* at 1358–59.

76. *Moberg*, 666 F. Supp 2d at 419.

77. *Kernal Recs. Oy*, 794 F. Supp. 2d. at 1358–59.

connected to the internet, the argument ran, then AJE was automatically published simultaneously in the United States and in any internet-connected foreign country that wasn't party to a treaty at the time, thus making it a U.S. work.<sup>78</sup> Under this line of reasoning and this understanding of internet publication, this prong could potentially be used in all cases of internet publication to convert foreign works into U.S. works, as long as some countries remain non-signatories to international agreements.

The court, like the court in *Moberg*, broke the issue down into two parts when considering this argument: (1) whether the work was first published on the internet, and (2) whether publication on the internet constituted simultaneous worldwide publication, such that AJE would be subject to the registration requirement.<sup>79</sup> Unlike the court in *Moberg*, though, this court answered both questions in the affirmative.

On the publication issue, there was some confusion in the evidentiary record about whether AJE had originally been published on a website or whether it had been published in the form of a "disc magazine" (a magazine embedded and distributed on computer discs) and uploaded to the internet later.<sup>80</sup> The plaintiff claimed the latter type of publication, but the court ruled that the plaintiff had not provided enough evidence in this regard and that vague deposition testimony would be interpreted to indicate internet publication.<sup>81</sup> In making this determination, the court relied on the same U.S. statutory definition of publication as that examined in *Moberg*, with the opposite result, determining that the sharing of AJE through an online magazine constituted publication.<sup>82</sup> The court did take the opportunity in the analysis to distinguish this case from *Moberg*, noting that the photographs in *Moberg* were only viewable on the internet while the sound recording of AJE was available for downloading and copying.<sup>83</sup> As an aside, these facts are not as useful in distinguishing the cases as they could be, since the photographs in *Moberg* must have been downloadable or copyable on some level; indeed, the cause of action in that case pertained to copying and re-use of the photographs.<sup>84</sup>

On the issue of simultaneous global publication, the court declined to follow *Moberg*'s example, asserting that the *Moberg* judge's "contextual

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78. *Id.*

79. *Id.* at 1360.

80. *Id.* at 1360–62.

81. *Id.*

82. *Id.* at 1363–64.

83. *Id.* at 1364.

84. *Moberg v. 33T LLC*, 666 F. Supp. 2d 415, 418 (D. Del. 2009).

and policy-driven analysis is reasonable and sound, but is, in our opinion, wholly untethered to the actual statutory and treaty language that governs this dispute.”<sup>85</sup> The court then explained that it would apply the common usage of the word “simultaneous” to conclude that “there can be little dispute that posting material on the Internet makes it available at the same time—simultaneously—to anyone with access to the Internet.”<sup>86</sup> It also noted that nothing in the copyright statute applying the Berne Convention in the United States suggested congressional intent to exempt internet publications from simultaneity, presuming that, since the statute had been updated in 1998, Congress would have been aware of how the internet functions and could have made a change if it so chose.<sup>87</sup> All this is to say that the court did consider “publishing AJE on a website in Australia [to be] an act tantamount to global and simultaneous publication of the work, bringing AJE within the definition of a ‘United States work’ under § 101(1)(C) and subject to § 411(a)’s registration requirement.”<sup>88</sup>

The main virtue of *Kernal Records Oy* is its commonsense application of the law to the facts; its main vice is the undesirable outcome of that application. It seems unfair for the defendants to be able to make unauthorized use of the plaintiff’s work with impunity just because the plaintiff did not comply with the copyright formalities of a country across the globe from the one where the recording was “actually” published. Despite the court’s protestations to the contrary,<sup>89</sup> it is foreseeable that similar decisions by United States courts could give unscrupulous people carte blanche to infringe foreign works, especially if foreign courts are unable to address the parties or actions at issue due to jurisdiction issues. It is important to note, as mentioned above, that some of the court’s reasoning here was overturned on appeal, particularly its interpretations of the vague evidence of internet publication.<sup>90</sup> But there is nothing to guarantee that in another case, one with more persuasive evidence of internet publication, the same inequitable result would not be reached, either in the 11th Circuit or in another Circuit that decides to follow its reasoning. Some observations of the 11th Circuit Court of Appeals in its

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85. *Kernal Recs. Oy*, 794 F. Supp. 2d. at 1365.

86. *Id.* at 1366.

87. *Id.* at 1366–67.

88. *Id.* at 1368.

89. *Id.* at 1367–68.

90. *Kernal Recs. Oy v. Mosley*, 694 F.3d 1294, 1296, 1306–09 (11th Cir. 2012). The overall outcome of the case was upheld because the Court of Appeals for the 11th Circuit noted that *Kernal Records Oy* had plenty of opportunities to obtain registration during the course of the litigation but did not.



appellate decision on *Kernal Records Oy* do aid in an understanding of publication that is more consistent with the Berne Convention's purposes, and these observations are noted below in Part III along with other recommendations for revisions to the Berne Convention's definitions.

### C. Takeaways from the Two Problematic Cases

The rise of the internet has caused a decoupling between the purposes of the Berne Convention and the language of its definitions, which may have been precise enough in the past, but which today cause interpretive issues. Courts today must choose between giving effect to the purposes of the Convention or giving effect to its language.

This decoupling of purpose and language has given United States courts the opportunity to sweep what should be foreign works into the United States work category. Even though one district court has chosen not to, there is little guarantee that others will make the same decision. This copyright "imperialism" subjects these converted United States works to United States formalities, to the disadvantage of their creators.<sup>91</sup> The landscape of United States copyright law has, admittedly, changed slightly since *Moberg* and *Kernal Records Oy*. Creators of United States works are no longer required to register their works before they can sue to enforce rights in those works; however, they still have to register them if they want certain important benefits at trial—they cannot collect statutory damages or attorney's fees if their works are not registered.<sup>92</sup> So although registration is not per se required, any copyright holder hoping to get maximum protection for their work, and maximum repayment for infringement, will still have to register. In this way, registration is still, to some extent, a de facto formality in the United States, one that is imposed on foreign creators if their works are declared United States works.

### III. WHAT CHANGES NEED TO BE MADE? REVISIONS TO THE BERNE CONVENTION

The difficulties in *Moberg* and *Kernal Records Oy* resulted, in large part, from the Berne Convention's definitions of publication and country of origin, and it would be productive for changes to the Convention to focus on those definitions. Suggesting complete replacement definitions would go beyond the scope of this paper. However, it is possible to here

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91. Ginsburg, *supra* note 62.

92. 17 U.S.C. § 412.

suggest some language and elements that it would be productive for updated Convention definitions to include. While the suggestions made here are mainly drawn by analogy from United States law, they could be applied by courts in other countries as well.

First, an updated definition of publication could more effectively account for internet dissemination of copyrighted works by identifying which types of copies are relevant to determining that an internet posting is a publication. After all, anything available on the internet is copied to a certain extent just to reach your computer.<sup>93</sup> The definition could also explain what types of postings should “count” as publications, since some internet distributions are actually quite limited.<sup>94</sup>

Second, various considerations could help make the definition of country of origin more useful. We have seen in *Moberg* and *Kernal Records Oy* that, in an internet context, where many countries (perhaps all countries) could be considered the country of origin of a work, the purposes of the Berne Convention can easily be defeated since each of those many countries can impose its own domestic formalities in granting copyright protection to even technically foreign works. To remedy this problem, the definition needs to be made narrower so that only the countries with the appropriate relationship to the work can qualify as countries of origin. Several different considerations could figure into this updated, narrowed definition. One consideration would be the intended audience of a copyrighted work posted on the internet. Another consideration, related to intended audience, might be the language of the work, if any. Another might be a test to identify which country or countries have the “most significant relationship” to the copyrighted work.

#### *A. Updating Publication: Types of Copies, Types of Posts*

##### *1. What types of copies qualify?*

The current Berne Convention provides that “works published with the consent of the authors, whatever may be the means of manufacture of the copies,” are published “provided that the availability of such copies has been such as to satisfy the reasonable requirements of the public, having regard to the nature of the work.”<sup>95</sup> But “the reasonable

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93. See NAUGHTON, *supra* note 1, at 244.

94. *Kernal Recs. Oy*, 694 F.3d at 1304–06.

95. *Berne Convention*, *supra* note 2, at art. 3(3).

requirements of the public”<sup>96</sup> is not a cohesive concept. As *Moberg* and *Kernal Records Oy* demonstrate, different members of the public have different ideas about what types of copies (and the directly related question of what types of availability) meet the requirements of publication in the internet context. An updated definition could helpfully explain more fully what kinds of copies qualify in this publication paradigm. After all, as has already been established, a computer makes a copy and makes that copy available to the user just by accessing a website.<sup>97</sup> It seems unlikely that this type of copy should “count,” but what type should? The district court in *Kernal Records Oy* may have been onto something when it distinguished between internet content that was viewable and internet content that was downloadable.<sup>98</sup> The difficulty here is that even much content that is technically only viewable could be captured by copying and pasting or by a screenshot. This is the nature of the internet.

An updated definition could try to parse out some of these considerations in the context of internet publishing and decide what types of works qualify as published based on how “copyable” they are. On the one hand, it might include language specifying that “only works made available for the end-user to download generate copies in a manner that qualifies as publication.” On the other hand, it might specify that “any internet posting that could potentially be captured or copied by an end user in any way generates copies in a manner that qualifies as publication.” A more middle-of-the-road approach stipulating certain classes of qualifying and non-qualifying copyability would also be possible. In any case, some specificity would be helpful. As things stand, courts are left in a limbo of uncertainty while making these determinations, and they are given flexibility that might lead to abuse.

## 2. *What types of posts qualify?*

An updated definition of publication should also consider that not all internet posts are created equal, especially in terms of their reach. The 11th Circuit was very careful to note this when considering *Kernal Records Oy* on appeal.<sup>99</sup> It noted that just as the mailing of a pamphlet to only a few people as an advance distribution before mailing it to many people later likely would not qualify as publication, emailing a work to a few people

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96. *Id.*

97. See NAUGHTON, *supra* note 1, at 244.

98. *Kernal Recs. Oy*, 794 F. Supp. 2d at 1364.

99. *Kernel Recs. Oy*, 694 F. 3d at 1304–06.

likely would not qualify as publication, even though email is a distribution through the internet.<sup>100</sup> Other limited distribution channels operating through the internet also do not offer complete public access, including peer-to-peer networks and password-restricted websites.<sup>101</sup> If a work is posted on a website that is password protected and only available to a few people, it probably shouldn't count as published. Similarly, if a work is posted on a website that is geo-blocked to only allow access from within a certain country, then that work likely should be considered as published only in the country where the limited publication occurred and not in every country that has access to the internet.

An updated definition could helpfully draw distinctions between different methods of internet distribution (e.g., email, message boards, private websites, public websites, and so on) and how those methods might be limited in terms of geographic scope or practical access. One relevant consideration would be the number of people to whom a posting would be made available by a particular method. It would be difficult to suggest fully specific language here, since there is much potential for debate about which methods of distribution and which audience sizes should indicate publication or a lack thereof, but the updated definition could include language to this effect: "An internet posting made through limited distribution method X, Y, or Z, to a sufficiently limited audience, shall not qualify as a publication."

*B. Updating Country of Origin: Intended Audience and "Most Significant Relationship"*

*1. Intended audience*

This concept stems from the commonsense notions that just because a work is available all over the world, it does not mean that it is of interest all over the world or that everyone in the world was intended to see it. Even in the age of the global internet, it seems likely that many content creators post their works to the internet with the intention that only a small, specific audience will ever see them. If a woman in Ohio posts gardening tips applicable to the midwestern United States on her blog, intending to help other gardeners in her geographical region, it is certainly possible that an internet user in Estonia or Japan or Tahiti could come across the posting. But it is also unlikely that they will see the post, practically

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100. *Id.*

101. *Id.* at 1305-06.

speaking, or that they will care to interact with the post; the content is simply not very applicable or accessible to them. And although the woman in Ohio might be thrilled to learn that someone in another country viewed her content, this occurrence was likely not her goal in making the posting, and she probably didn't intend it or even think about its possibility beforehand. In a situation like this, foreign internet users are not the intended audience of the work. An updated Berne Convention could recognize this paradox that the internet creates: the unlimited potential audience versus the limited practical audience. A definition of country of origin that accounts for the intended audience could help keep courts from arbitrarily designating foreign works as domestic when, in reality, the vast majority of citizens in that court's country may have no interest in the work. One can speculate that few American citizens had an interest in *AcidJazzed Evening*, and the United States was thus likely not the work's intended audience. So, one must ask, why should the United States be able to make crucial determinations about the work's copyright status?

Language considerations could be particularly helpful to courts in determining the intended audience of certain types of copyrighted works—those that involve written or vocalized words.<sup>102</sup> United States trademark law can provide, through analogy, some insight here. United States trademark law and copyright law are not identical in many respects. United States trademark law, notably, can have extraterritorial applicability at times while U.S. copyright law generally cannot. Yet this very difference might provide an insight about language that may be relevant, by analogy, to the context of copyright and the intended audience of transnational works that exist in textual form. In *Cecil McBee v. Delica Company*, the Court of Appeals for the First Circuit took special note of the language a Japanese clothier's website was written in when considering the affect that the website might have on American consumers.<sup>103</sup> The court stated:

Delica's website, although hosted from Japan and written in Japanese, happens to be reachable from the United States just as it reachable from

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102. Language considerations do put these works (e.g., books, articles, blog posts, films, lyrics, etc.) in a different basket than works that do not necessarily involve words (e.g., images, photographs, instrumental music, etc.), but this distinction is more practical than legal. Language can be a helpful shorthand for deciphering the cultural considerations that underly an identification of intended audience, but other cultural considerations could come into play when considering the intended audience of a work without words.

103. 417 F. 3d 107 (1st Cir. 2005). The trademark of the Japanese company was identical to the name of an American jazz musician, and he sued, arguing that jurisdiction was appropriate under the Lanham Act. The Lanham Act does allow for jurisdiction over foreign defendants under certain circumstances. *See, e.g., Sterling Drug, Inc. v. Bayer AG*, 14 F.3d 733 (2d Cir. 1994).

other countries. That is the nature of the Internet. The website is hosted and managed overseas; its visibility within the United States is more in the nature of an effect, which occurs only when someone in the United States decides to visit the website. To hold that any website in a foreign language, wherever hosted, is automatically reachable under the Lanham Act so long as it is visible in the United States would be senseless. The United States often will have no real interest in hearing trademark lawsuits about websites that are written in a foreign language and hosted in other countries.<sup>104</sup>

The First Circuit's reluctance to closely consider foreign websites in the trademark context implies this question in the copyright one: why should the U.S. be interested in regulating copyrighted works in a language that isn't relevant to the vast majority of United States users? True, automatic translation of webpages, at least in a mechanical, imprecise fashion, is nowadays an easy-to-use tool of web-browsing, and it will likely only continue to get better as technology evolves. But just because someone *can* translate a foreign language webpage with a click, it does not mean that many people will or that those people will be the target audience of the work. In addition, many works posted to the internet in certain formats do not lend themselves to automatic translation (PDFs, for example). If most of a country's inhabitants cannot or will not read content on a website, it makes little sense for that country to impose its copyright regime on that content.

Admittedly, this concept isn't completely airtight. In a globalizing world, there will always be expatriates, descendants of immigrants, and just plain enthusiasts in many countries who will be interested in works originating in other countries. Globalization means cross-pollination of cultures, nationalities, and languages. There are, of course, people in the United States who can read Japanese and who can function as an audience for a Japanese website. Even so, this concept of intended audience is squishy and allows for some weighing. The presence of three million Japanese speakers in the United States might very well render the United States one of the intended audiences of a Japanese-language work produced in Japan. The presence of three hundred Japanese speakers might not.

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104. *Id.* at 123.

## 2. *Most significant relationship doctrine*

U.S. law suggests another principle that could be helpfully incorporated into an updated definition of country of origin. The Second Restatement of Conflict of Laws posits that “the interests of the parties in a thing are determined, depending on the circumstances, either by the ‘law’ or by the ‘local law’ of the state which, with respect to the particular issue, has the most significant relationship to the thing and the parties . . . .”<sup>105</sup> This concept of the “most significant relationship” gives some leeway for both flexibility and specificity in identifying which country’s law is most relevant to a particular object (like a copyright), and it could usefully be imported into the country of origin context. Factors associated with a “most significant relationship” test could help in narrowing country of origin back to a manageable single country or cluster of countries. A number of U.S. cases have applied the “most significant relationship” principle in establishing which country’s law should apply in determining issues of ownership of copyrighted material.<sup>106</sup>

In *Itar-Tass Russian News Agency v. Russian Kurier, Inc.*, a Russian news agency sued a United States newspaper publisher that had reprinted several hundred of the agency’s articles in the United States without permission.<sup>107</sup> In the court’s attempt to apply the principles of the Berne Convention to the facts at hand, it concluded that, to resolve issues with respect to ownership of the involved copyrights, it would, consistent with usual property rules, need to determine which state had the “most significant relationship” to the works and the parties.<sup>108</sup> In this determination, it considered two factors: (1) the nationality of the creators of the works and (2) the state where the works were first published.<sup>109</sup> Since the creators here were Russian, and the works were first published in Russia, the court was able to determine that Russian law was the “appropriate source of law to determine issues of ownership of rights” as well as the country of origin under the Berne Convention (although it acknowledged that these countries might not be the same in every case).<sup>110</sup>

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105. Restatement (Second) of Conflict of Laws § 222 (Am. L. Inst. 1971).

106. See, e.g., *Itar-Tass Russian News Agency v. Russian Kurier, Inc.*, 153 F.3d 82 (2d Cir. 1998); *Bridgeman Art Libr., Ltd. v. Corel Corp.*, 25 F. Supp. 2d 421 (S.D.N.Y. 1998); *Shaw v. Rizzoli Int’l Publs., Inc.*, 1999 U.S. Dist. LEXIS 3233 (1999); *Rudnicki v. WPNA 1490 AM*, 2009 U.S. Dist. LEXIS 115236 (2009); *Corbello v. Devito*, 844 F. Supp. 2d 1136 (D. Nev. 2012).

107. *Itar-Tass*, 153 F.3d at 84.

108. *Id.* at 90.

109. *Id.*

110. *Id.* at 90–91.

The two factors that aided this court in determining the country with the “most significant relationship” to a set of copyrighted works could be incorporated into a “most significant relationship” test to help applicers of an updated Berne Convention to determine the country of origin for internet-published works. Other United States cases, discussed in the following paragraphs, have applied the same framework as *Itar-Tass Russian News Agency* and further show the utility of this test in a variety of factual scenarios involving multiple countries. They also identify other factors that could helpfully be incorporated into the test.

In *Bridgeman Art Library, Ltd. v. Corel Corp.*, a British company engaged in selling high-quality color transparencies and digital images that reproduced well-known works of art sued a Canadian corporation that also marketed digital images of some of the same works.<sup>111</sup> The British company claimed that the Canadian corporation wouldn’t have been able to acquire certain images without copying the British company’s works.<sup>112</sup> To determine which country’s law applied for purposes of ownership, the court undertook the same analysis as the court in *Itar-Tass Russian News Agency*, naming as “most significant relationship factors” (1) the nationality of the authors, (2) the place of initial publication, and (3) the country of origin.<sup>113</sup> The court noted that, in relation to the first factor, most of the photographs at issue were produced either by freelance photographers employed by the British-based company or by the museums owning the original works of art (most of which are in the United Kingdom).<sup>114</sup> The court also noted that, for the second factor, the photographs were first published in the United Kingdom and concluded that the United Kingdom was the country with the most significant relationship to the works.<sup>115</sup> In this case, like in *Itar-Tass Russian News Agency*, the court was able to use the test to narrow down which of several countries was most relevant to the works at issue.

In *Shaw v. Rizzoli International Publications, Inc.*, a number of institutional and natural-person plaintiffs, based in or living in the United States and foreign countries, filed suit against an Italian corporation that had created an exhibit of Marilyn Monroe photographs and memorabilia

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111. *Bridgeman*, 25 F. Supp. 2d at 423–24.

112. *Id.*

113. *Id.* at 425 (The inclusion of this third factor does illustrate the fact that, in existing jurisprudence, there is not an exact match-up between the country of origin and the state with “most significant relationship.”).

114. *Id.* at 426. The fact that the photographs at issue were not all created by the same actor in the same place illustrates the flexibility of this factor and the test.

115. *Id.*



in Italy and published several books and catalogues linked to the exhibit.<sup>116</sup> The plaintiffs claimed that their works, “including photographs, sketches and text, were wrongfully published by the defendants in the Rizzoli publications.”<sup>117</sup> The court followed *Itar-Tass Russian News Agency*, noting the nationalities of the authors and the places of first publication.<sup>118</sup> It also considered as a factor, though, the place of residence of the plaintiffs asserting rights in the suit, not just their place of nationality.<sup>119</sup> Creators’ place(s) of residence is thus another factor that could be incorporated into the “most significant relationship” test.

In *Rudnicki v. WPNA 1490 AM*, a Polish radio news correspondent residing in Belgium and providing news broadcasts for a radio station in Poland and a Chicago-area radio station in the United States sued another Chicago-area radio station for rebroadcasting the news reports he created for the station in Poland.<sup>120</sup> The Court applied the factors from *Itar-Tass Russian News Agency* to determine that the relevant law was Poland’s, but it noted as part of this analysis that, “though he resides in Belgium, the author is a Polish national, and the works were first broadcast and intended for public consumption in Poland.”<sup>121</sup> Here, then, along with the nationality of the author and the country where the works were first published, the court hinted at another factor—the intended consuming public.<sup>122</sup>

As shown by the cases above, the factors that could be part of a “most significant relationship” test include (1) the nationalities of the creators of the works; (2) the state(s) where the works were first published (this factor’s utility in determining country of origin would depend on having an improved working definition of publication); (3) the place of residence of the creators of the works (which could trump the nationality of the creators, depending on the circumstances); and (4) the state or states containing the public intended to consume the work. These factors have proved helpful in assessing which country’s law should apply in many distinct situations involving distinct compositions of countries and actors. They could also help in determining which country or countries should be considered to be a copyrighted work’s country(s) of origin. Other factors might be incorporated into the test as needed, especially if caselaw or code

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116. *Shaw v. Rizzoli Int’l Publs., Inc.*, 1999 U.S. Dist. LEXIS 3233, at \*4–\*7 (1999).

117. *Id.* at \*2.

118. *Id.* at \*15.

119. *Id.* at \*17.

120. *Rudnicki v. WPNA 1490 AM*, 2009 U.S. Dist. LEXIS 115236, at \*1–\*4 (2009).

121. *Id.* at \*7.

122. *Id.*

law from other countries have insight to offer in this area. A factor test is much more free-wheeling and unpredictable than a concrete definition of country of origin, but as things stand under the current Berne Convention, a factor test could actually lend itself to a much more precise determination than is available now, allowing courts to select a single country or set of countries as the “country of origin” instead of every single country that has access to the internet and is also a member of the Berne Convention Union.

### *C. Summary of Updates*

To help prevent undesirable outcomes like those in *Moberg* and *Kernal Records Oy*, the Berne Convention’s definitions of publication and country of origin could be changed to better account for the context of the internet. The updated definition of publication could specify which types of actual copies qualify as copies for publication purposes. It could also address different types of internet posts and methods of internet distribution (taking account of audience sizes) and specify which of these categories do or do not count as publications. The updated definition of county of origin could provide domestic actors (including courts) with more flexible, purpose-driven guidelines to help them identify country of origin by narrowing the concept into a manageable and meaningful classification. These guidelines could be based on factors including intended audience and language as well as the factors of the “most significant relationship” test identified above.

## IV. HOW CAN THE CHANGES BE MADE?

### *A. Revising the Berne Convention*

The Berne Convention explicitly considers its own revision, providing that conferences for this very purpose will be held in the countries that are parties to the treaty.<sup>123</sup> The requirements for amending the Convention pose quite a high bar, though; the Convention states that, save for amendments to a handful of articles related to the administration of the union of countries that oversee the treaty, “any revision to this Act, including the Appendix, shall require the unanimity of the votes cast.”<sup>124</sup> This unanimity requirement is the major reason that the Convention has

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123. *Berne Convention*, *supra* note 2, at arts. 27(1)–(2).

124. *Id.* at art. 27(3).

not been updated more recently.<sup>125</sup> On the other hand, the Convention has been revised multiple times in the past, so the challenge is apparently not insurmountable.

Customary international law could potentially provide an alternative avenue for addressing the problems laid out in this paper if appropriately updated definitions of publication and country of origin in the copyright context were reflected in the state practice of enough countries and recognized as binding by those countries. But coordination problems and differences of opinion and interpretation would likely make revision through this method even more difficult than it would be through formal revision of the Berne Convention.

### *B. Adoption in the United States and Other Countries*

Even if the Berne Convention were revised, it would need to be implemented by the various state parties. Some countries will not recognize any treaty or convention as self-executing and will require domestic legislation on the subject before that country's courts can enforce the treaty.<sup>126</sup> Even countries that recognize some treaties as self-executing might require such legislation; the United States, for example, takes the position that "while treaties 'may comprise international commitments . . . they are not domestic law unless Congress has either enacted implementing statutes or the treaty itself conveys an intention that it be 'self-executing' and is ratified on these terms.'"<sup>127</sup> If a revised and updated Berne Convention were anything like its predecessor, it would likely not be considered self-executing under this standard. The 1979 version of the Convention includes many instances of language identifying "matter[s] for legislation in the countries of the Union" to address,<sup>128</sup> which seems to suggest a lack of any intention that the Convention be considered self-executing. Indeed, the court in *Kernal Records Oy* asserted

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125. See Sam Ricketson, *The International Framework for the Protection of Authors: Bendable Boundaries and Immovable Obstacles*, 41 COLUM. J.L. & ARTS 341, 348-49 (2017), which also identifies other factors blocking reform: "the increased numbers involved today in any multilateral negotiation; the continuing and significant division between developed and developing countries; and the changing technological, social, and economic environments in which matters relating to the protection of authors' rights now arise."

126. Michael P. Van Alstine, *Federal Common Law in an Age of Treaties*, 89 CORNELL L. REV. 892, 904 (2004). "In many countries, the transformation of international treaty obligations into local law requires additional an additional legislative act by domestic lawmaking institutions." *Id.*

127. *Medellin v. Texas*, 552 U.S. 491, 505 (2008) (citing *Igartua-De La Rosa v. U.S.*, 417 F.3d 145, 150 (1st Cir. 2005)).

128. See, e.g., *Berne Convention*, *supra* note 2, at arts. 2(2), 2(4), 7(4), 9(2), 14(2)(a).

that “the Berne Convention has no effect on U.S. law unless Congress so provides.”<sup>129</sup>

The hope would be that, if an updated Berne Convention were produced, the state parties would follow through by making the necessary domestic laws to bring it into effect. After all, “it cannot be disputed that the very object of an international agreement, according to the intention of the contracting Parties, may be the adoption by the parties of some definite rules creating individual rights and obligations and enforceable by the national courts.”<sup>130</sup> The current version of the Berne Convention codifies this obligation thus: “Any country party to this Convention undertakes to adopt, in accordance with its constitution, the measures necessary to ensure the application of this Convention.”<sup>131</sup> Beyond this exhortation, though, the Convention has no teeth to encourage states to comply and execute the treaty in their domestic laws. Presumably, the updated Convention would include similar language, so compliance could be a problem.

*C. Motivation for Updating the Convention and Executing the Updates:  
A Human Rights Angle*

Many means of motivation could be suggested for encouraging countries to engage in revision of the Convention and execution of the resulting changes in law. I briefly highlight just one here that seems particularly compelling. This motivation stems from international protection of human rights, “a substantive field of international law . . . that has consistently gained in significance as we enter further into the twenty-first century.”<sup>132</sup>

The Universal Declaration of Human Rights states that “[e]veryone has the right to the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author.”<sup>133</sup> Although this Declaration was not binding law at its inception and may yet not be in some respects, its provisions carry much weight on the world stage and “[i]ndeed, several commentators have concluded that the Universal Declaration [of Human Rights] has become, *in toto*, a part of binding, customary international law.”<sup>134</sup> Similar language in the

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129. Kernal Recs. Oy v. Mosley, 794 F. Supp. 2d 1355, 1367 (S.D. Fla. 2011).

130. Jurisdiction of the Courts of Danzig, Advisory Opinion, 1928 P.C.I.J. (ser. B) No. 15.

131. *Berne Convention*, *supra* note 2, at art. 36.

132. Steven M. Barkan et al., *Fundamentals of Legal Research* 475 (Tenth Edition, 2015).

133. G.A. Res. 217 (III) Art. 27(2), Universal Declaration of Human Rights (Dec. 10, 1948).

134. *Filartiga v. Pena-Irala*, 630 F.2d 876, 883 (2d Cir. 1980).

International Covenant on Economic, Social and Cultural Rights states that “the States Parties to the present Covenant recognize the right of everyone . . . To benefit from the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author.”<sup>135</sup> This Covenant has wide participation across the globe with 171 state parties and four nonratifying signatories.<sup>136</sup> These two important sources of international law thus identify as either a universal human right or an economic/social/cultural right a bundle of entitlements, one of which closely resembles a copyright. And, importantly, this right, as expressed in these sources, is not limited by geography or formalities.

These documents and the consensus principles that they may represent do not create an obligation for any country to protect the rights of foreigners, being more focused on the protections that governments should provide for their own citizens. However, countries’ willingness to enshrine copyright as a human right in this manner should give state actors pause as they consider how the current state of things allows copyright “imperialism”<sup>137</sup> like that exemplified in *Kernal Records Oy*. This principle alone is not enough to strictly obligate changes to the Berne Convention or to international understandings of copyright principles. Yet the existence of this right in the broad form identified here might motivate countries to at least consider how principles of fairness, common sense, and restraint could be better incorporated into the existing international copyright framework through amendments like those proposed in this paper.

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135. G.A. Res 2200A (XXI), International Covenant on Economic, Social and Cultural Rights (Dec. 16, 1966).

136. *Status of Ratification Interactive Dashboard*, UNITED NATIONS HUMAN RIGHTS OFFICE OF THE HIGH COMMISSIONER, <https://indicators.ohchr.org/> (last visited Feb. 23, 2023). The United States is one of the four states that has signed the covenant but not ratified it.

137. Ginsburg, *supra* note 62.

## CONCLUSION

If it is to truly protect the rights of copyright holders the world over, a global copyright scheme requires precision in its terms. Due to the rise of the internet and the resulting decoupling of the Berne Convention's purposes from its language, it no longer fulfills that requirement in its current form. An update to the Convention and an international understanding of what is necessary to protect creators from imperialistic formalities would help resolve this problem. Specifically, the problem could be addressed by updating the Berne Convention's definition of publication to account for different types of copies and different types of internet distribution and by updating the Convention's definition of country of origin to account for intended audience and "most significant relationship" principles.

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