

# ***Golan v. Holder: A Look at the Constraints Imposed by the Berne Convention***

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One hundred and three years after its signing in Berne, Switzerland, after three years of international negotiations to which the United States contributed very little, the United States joined the Berne Convention for the Protection of Literary and Artistic Works.<sup>1</sup> In its initial implementation act, Congress awarded no protection to works that had fallen in the public domain.<sup>2</sup> Indeed, § 12 of the 1988

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1. Berne Convention for the Protection of Artistic and Literary Works, Sept. 9, 1886, as revised at Paris on July 24, 1971, and amended in 1979, S. Treaty Doc. No. 99-27 (1986), available at [www.wipo.int/treaties/en/ip/berne/pdf/trtdocs\\_wo001.pdf](http://www.wipo.int/treaties/en/ip/berne/pdf/trtdocs_wo001.pdf) [hereinafter Berne Convention]. The Berne Convention was originally signed in 1886, following three diplomatic conferences held in Berne, Switzerland, in 1884, 1885, and 1886. A Protocol was added to the Convention at the time of its adoption in 1886, and the Convention itself was later revised six times, in 1896, 1908, 1928, 1948, 1967, and 1971. See generally WORLD INTELLECTUAL PROP. ORG., BERNE CONVENTION CENTENARY 1886–1986 (1986) (discussing the history of the Convention and providing a summary of the discussions as well as the role of each participating country) [hereinafter BERNE CONVENTION CENTENARY].

2. Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853. See also H.R. REP. NO. 100-609, at 52 (1988). The United States’ adhesion to the Convention was effective on March 1, 1989. See *Contracting Parties*, WORLD INTELLECTUAL PROP. ORG., [http://www.wipo.int/treaties/en/ShowResults.jsp?searchwhat=C&country\\_id=179C](http://www.wipo.int/treaties/en/ShowResults.jsp?searchwhat=C&country_id=179C) (last visited Sept. 27, 2011) (listing effective dates of treaties to which the United States is a party).

Act provided that “Title 17, United States Code, as amended by this Act, does not provide copyright protection for any work that is in the public domain in the United States.”<sup>3</sup>

This was challenged as a violation of the Convention provision on retroactive protection of such works.<sup>4</sup> Congress reversed course when it implemented the Uruguay Round results because it knew its failure to implement Article 18 could now be challenged before the World Trade Organization (“WTO”) Dispute Settlement Body.<sup>5</sup> It thus reimplemented the Convention by providing extensive protection to copyright holders and restoring works that had been in the public domain, while providing limited rights to “reliance parties” that had been exploiting those works legally without payment or authorization.<sup>6</sup> This is, at its core, the basis of the challenge that has reached the Supreme Court in *Golan v. Holder*—namely, that restoring protection on public domain works violates the constitutional rights of those reliance parties.

In this Essay, I argue that international rules left Congress wide latitude to implement Article 18.<sup>7</sup> I do not discuss whether the constitutional arguments against the second implementation are well-founded, nor do I consider the importance of the public domain in the copyright pact, matters considered in detail in other contributions to this Roundtable.<sup>8</sup>

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3. Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, § 12, 102 Stat. 2853, 2860.

4. Berne Convention, *supra* note 1, art. 18(1).

5. Elizabeth Townsend Gard discusses the matter in greater detail in her contribution to this Roundtable. See Elizabeth Townsend Gard, *In the Trenches with § 104A: An Evaluation of the Parties’ Arguments in Golan v. Holder As It Heads to the Supreme Court*, 64 VAND. L. REV. EN BANC 199, 204–06 (2011).

6. In 1993, the North American Free Trade Agreement Implementation Act added § 104A to Title 17 of the United States Code. Pub. L. No. 103-182, § 334, 107 Stat. 2057, 2115. In 1994, the Uruguay Round Agreements Act amended § 104A in its entirety. Pub. L. No. 103-465, § 514, 108 Stat. 4809, 4976–81. Section 104A provides for restoration under certain conditions, including a presidential proclamation of eligible countries, and makes enforcement subject to certain formalities, including a notice of intent. 17 U.S.C. § 104A (2006).

7. This Essay is based on amicus briefs submitted by the author both in the Tenth Circuit Court of Appeals and at the Supreme Court. Brief for Professor Daniel J. Gervais as Amicus Curiae in Support of Petitioners, *Golan v. Holder*, No. 10-545 (U.S. June 17, 2011); Brief for Professor Daniel J. Gervais as Amicus Curiae in Support of Affirmance, *Golan v. Holder*, 609 F.3d 1076 (10th Cir. 2010) (No. 09-1234).

8. See Tyler T. Ochoa, *Is the Copyright Public Domain Irrevocable? An Introduction to Golan v. Holder*, 64 VAND. L. REV. EN BANC 123, 144–46 (2011) (assessing the implications of removing works from the public domain); David S. Olson, *A Legitimate Interest in Promoting the Progress of Science: Constitutional Constraints on Copyright Laws*, 64 VAND. L. REV. EN BANC 185 (2011) (arguing that removal of works from the public domain violates the Progress Clause and the First Amendment).

I propose to tackle the subject as follows: In Part I, I begin by considering the origins of Article 18 and lessons that may be gleaned from its negotiating history. In keeping with Article 38 of the Statute of the International Court of Justice, which provides that the “teachings of the most highly qualified publicists of the various nations [may be used] as subsidiary means for the determination of rules of law,” I also look to the literature concerning Article 18.<sup>9</sup> In Part II, I consider whether the fact that the substantive provisions of the Berne Convention were incorporated into the TRIPS Agreement changed the nature or scope of the obligations imposed on the United States, and in particular whether the threat of a trade dispute might warrant a new course of action.<sup>10</sup>

## I. THE BERNE CONVENTION

### A. A Detailed Look at Berne Retroactivity

The United States joined the Berne Convention for the Protection of Literary and Artistic Works in 1989, adhering to its most recent version, the 1971 Paris Act.<sup>11</sup> Article 18 of the Paris Act addresses how member states should implement the Convention at their time of entry.<sup>12</sup> Article 18(1) provides that: “This Convention shall apply to all works which, at the moment of its coming into force, have not yet fallen into the public domain in the country of origin through the expiry of the term of protection.”<sup>13</sup> Article 18(2) goes on to clarify that “[i]f, however, through the expiry of the term of protection which was previously granted, a work has fallen into the public domain of the country where protection is claimed, that work *shall not* be protected anew.”<sup>14</sup> Proponents of a restrictive reading of these

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9. Statute of the International Court of Justice, art. 38(1)(d), June 26, 1945, 59 Stat. 1031, 1060.

10. Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299, 33 I.L.M. 1197, available at [http://www.wto.org/english/docs\\_e/legal\\_e/27-trips.pdf](http://www.wto.org/english/docs_e/legal_e/27-trips.pdf) [hereinafter TRIPS Agreement]. Article 9.1 of the TRIPS Agreement obligates World Trade Organization members, including the United States, to “comply with Articles 1 through 21 of the Berne Convention (1971) and the Appendix thereto.” *Id.* art. 9.1.

11. Berne Convention, *supra* note 1.

12. This scope of protection at implementation is also known as “application in time.” See WIPO Copyright Treaty art. 13, Dec. 20, 1996, S. TREATY DOC. NO. 105-17, 36 I.L.M. 65, available at [http://www.wipo.int/export/sites/www/treaties/en/ip/wct/pdf/trtdocs\\_wo033.pdf](http://www.wipo.int/export/sites/www/treaties/en/ip/wct/pdf/trtdocs_wo033.pdf) [hereinafter WIPO Copyright Treaty] (providing that contracting parties must apply the protections of Berne Convention Article 18).

13. Berne Convention, *supra* note 1, art. 18(1).

14. *Id.* art. 18(2) (emphasis added).

provisions tend to emphasize the “shall” in Article 18(1), but not the “shall not” in Article 18(2). But the Convention clearly establishes the principle of protection of existing works *in some instances only* while also preserving most of the public domain.<sup>15</sup> Taken together, Articles 18(1) and 18(2) provide that a work already in the public domain must be protected anew—that is, removed from the public domain and placed (back) in the exclusive domain of the foreign copyright holder(s)—*only* in the specific circumstance where: (1) that work both remains protected in its country of origin, *and* (2) it is not protected in the country where protection is claimed for a reason *other* than the expiration of a term of protection previously granted (e.g., for failure to comply with a registration requirement).

I read Article 18(2) as support for the public domain and not, as proposed in the World Intellectual Property Organization (“WIPO”) Guide to the Convention, as a mere exception.<sup>16</sup> This view, I suggest, reflects the ordinary meaning of “shall not” used in the provision, and it is buttressed by the fact that exceptions in the Convention typically begin with the phrase (or a variation of the phrase), “it shall be a matter for legislation in the countries of the Union to permit.”<sup>17</sup> An example of the application of this principle would be a country joining the Convention that had a previous term of protection of twenty-eight years.<sup>18</sup> In such a case, a work whose twenty-eight-year term had expired in that country (i.e., was in the public domain) would not be protected anew, even if it were still protected in its country of origin. If, however, the work were still protected in the country of origin and were not protected in the country joining the Convention due to a failure to comply with a formality such as registration, then Articles 18(1) and 18(2) would impose an obligation to protect that work and, accordingly, remove it from the public domain.

The idea that copyright law must be intrinsically balanced is neither revolutionary nor new. In an 1878 speech, Victor Hugo, founder of *Association Littéraire Internationale*—which later became *Association Littéraire et Artistique Internationale* (“ALAI”), the organization that produced the initial draft of the Berne Convention—

15. Dr. Ficsor also refers to Articles 18(1) and 18(2) as a “single principle.” See MIHÁLY FICSOR, GUIDE TO THE COPYRIGHT AND RELATED RIGHTS TREATIES ADMINISTERED BY WIPO AND GLOSSARY OF COPYRIGHT AND RELATED RIGHTS TERMS 99 (2003).

16. *Id.* at 98.

17. See Berne Convention, *supra* note 1, arts. 2(2), 2(4), 2(7), 2<sup>bis</sup>(1), 2<sup>bis</sup>(2), 7(4), 9(2), 10(2), 10<sup>bis</sup>(1), 10<sup>bis</sup>(2), 11<sup>bis</sup>(2), 11<sup>bis</sup>(3), and 14<sup>bis</sup>(2)(c). In this sense, Article 18(2) is much more like Article 10(1), which provides that “[i]t shall be permissible to make quotations from a work which has already been lawfully made available to the public . . .” (emphasis added).

18. As opposed to the Berne Convention minimum of the life of the author plus fifty years. See Berne Convention, *supra* note 1, art. 7(1).

made it plain that copyright law should protect literary property but maintain a public domain in parallel. Hugo believed that if one must choose between the rights of the writer or the rights of the “human spirit,” then the rights of the writer must be sacrificed because the public interest must come before everything else.<sup>19</sup>

In recognition of the very real hardship imposed on parties who relied on their legitimate right to exploit unprotected works,<sup>20</sup> Article 18(3) provides that the above principles “shall be subject to any provisions contained in special conventions to that effect existing or to be concluded between countries of the Union. In the absence of such provisions, the respective countries shall determine, each in so far as it is concerned, the conditions of application of this principle.” Under Article 18(3), Berne Union members thus have two options: making a special convention or determining “conditions.”

On the former option, a special convention such as the TRIPS Agreement could have been used to modify Article 18 or to determine a more precise set of conditions for copyright protection. The TRIPS Agreement was negotiated in the relevant time frame for U.S. implementation of the Berne Convention (that is, between 1987 and 1994).<sup>21</sup> The United States negotiated that moral rights<sup>22</sup> protected under Article 6<sup>bis</sup> of the Berne Convention not be incorporated into the

19. Victor Hugo, Opening Speech at the International Literary Conference (June 17, 1878), available at [http://www.sens-public.org/IMG/pdf/SensPublic\\_VHugo\\_DiscoursCongresInternational.pdf](http://www.sens-public.org/IMG/pdf/SensPublic_VHugo_DiscoursCongresInternational.pdf). The relevant part of the speech reads as follows, in the original French:

Constations la propriété littéraire, mais, en même temps, fondons le domaine public. . . . Le livre, comme livre, appartient à l’auteur, mais comme pensée, il appartient—le mot n’est pas trop vaste—au genre humain. Toutes les intelligences y ont droit. Si l’un des deux droits, le droit de l’écrivain et le droit de l’esprit humain, devait être sacrifié, ce serait, certes, le droit de l’écrivain, car l’intérêt public est notre préoccupation unique, et tous, je le déclare, doivent passer avant nous.

To my knowledge, this is one of the very first times the expression “public domain” was used in relation to copyright.

20. See 1 SAM RICKETSON & JANE C. GINSBURG, INTERNATIONAL COPYRIGHT & NEIGHBOURING RIGHTS: THE BERNE CONVENTION AND BEYOND 333 (2d ed. 2006) (noting the need, under Article 18, “to strike some balance between . . . ‘acquired rights’ or ‘reliance interests’ and the newly recognized rights of the foreign author”).

21. See DANIEL GERVAIS, THE TRIPS AGREEMENT: DRAFTING HISTORY AND ANALYSIS 12–27 (3d ed. 2008).

22. Moral rights are nonpecuniary rights that an (individual) author has in a work because he has created it. The minimalist version contained in the Berne Convention provides that an author (a) may claim authorship even after transferring his economic rights to the work, Berne Convention, *supra* note 1, art. 6<sup>bis</sup>(1); (b) may oppose “any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation,” *id.*; and (c) has the right to be mentioned (provided his name appears on the work) when a work is used in a quotation or “by way of illustration in publications, broadcasts or sound or visual recordings for teaching,” *id.* art. 10.

TRIPS Agreement.<sup>23</sup> It also could have tried to obtain concessions on retroactive protection. It did not even ask. There is no evidence to suggest that this was because either (a) negotiators knew they would not get it or (b) they were afraid that by asking for this flexibility they would have to give up something else.<sup>24</sup> In fact, asking U.S. trading partners, in particular Europeans, to agree to the exclusion of moral rights was not an easy task.<sup>25</sup> Moral rights matter a great deal to most European countries and to others around the world.<sup>26</sup>

The second option, absent a special convention, is to impose “conditions” on domestic implementation of Berne. Here, the Berne Convention imposes no particular limits or requirements on such conditions. A country joining the Berne Convention may decide to offer protection to parties who have relied on a work in the public domain (so-called “reliance parties”), though under the Convention it does not have to do so. Conversely, while the Convention clearly requires that *some* level of protection be given to foreign authors whose works have entered the public domain (other than by expiration of previous copyright), the scope of that protection is essentially left to the discretion of each member state.

In their *Golan* briefs, the United States and others, including the International Publishers Association, argue that Article 18(3) should be interpreted narrowly, and that Berne Convention members should strive to limit the protection of reliance parties as much as possible, because Article 18 establishes a baseline principle that existing works should be protected at the time of adherence to the Convention.<sup>27</sup> I suggest that such a position, which Respondents may see as normatively desirable, actually lacks a textual basis in the Convention and contradicts what the Convention drafters intended. This is for at least two reasons: First, Respondents’ position is hard to reconcile with Article 18(2)’s principle that works “*shall not* be protected anew” if their term of protection has expired. Articles 18(1) and 18(2) read together make clear that, if a work has fallen into the public domain because its term of protection expired either in the

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23. The second sentence of Article 9(1) of the TRIPS Agreement excludes the possibility of raising a violation of Article 6<sup>bis</sup> and other related provisions in the dispute-settlement process of the World Trade Organization. TRIPS Agreement, *supra* note 10, art. 9(1).

24. See Townsend Gard, *supra* note 5, at 206 (arguing that the United States could have negotiated an exception to Berne Article 18 as it did with moral rights).

25. See GERVAIS, *supra* note 21, at 213–18.

26. See 1 RICKETSON & GINSBURG, *supra* note 20, at 171 (finding “substantial compliance” in relation to morals rights).

27. Brief for the Respondents at 46–49, *Golan v. Holder*, No. 10-545 (U.S. Aug. 2011); Brief for the International Publishers Ass’n et al. as Amici Curiae in Support of Respondents at 35–38, *Golan*, No. 10-545 (U.S. Aug. 4, 2011).

work's country of origin or in the country where protection is claimed, then it need not be protected when the Convention enters into force. Article 18(2)'s "shall not" may be read as more than the mere possibility of not applying retroactive protection.<sup>28</sup> Second, a restrictive reading of Article 18 is contrary to the international legal norm that states can do all that is not prohibited by international law.<sup>29</sup> Article 18(3) specifically provides that states can decide which conditions to impose when restoring copyright protection. To hold that the Convention requires any more would render the language of Article 18(3) superfluous.

Indeed, the text of the Convention could be construed to take the diametrically opposite position—that it is desirable to apply retroactive protection *narrowly*. For example, Article 18(2) does more than simply state that a work should not be restored to copyright if its term of protection has expired. Instead, it affirmatively commands member states that such works "*shall not* be protected." One might argue (rightly in my view) that there is little prospect of a case being filed to defend the public domain on the basis of an Article 18(2) violation, but the normative value of the statement remains intact. A similar sentiment against overbroad protection is found in Article 7, which contains a rule known as the "comparison of the terms of protection." Under Article 7, a Berne Convention member country does not have to extend protection to a work no longer protected in its country of origin—for example, if the country of origin has a shorter term.<sup>30</sup> Finally, an expansive application of retroactivity under Berne violates the cardinal principle of copyright that people can use the public domain at will so that the copyright cycle can continue, making copyright "the engine of free expression."<sup>31</sup> Removing works from the public domain goes against this principle and thus should be considered with utmost caution.<sup>32</sup> The argument that Article 18(3)

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28. *But see* FICSOR, *supra* note 15, at 98 ("It is not an obligation to apply the Convention to those works which, at the moment of the coming into force of the Convention, have fallen into the public domain in the country of origin . . . ." (emphasis added)). The "shall not" language may imply more than a possible opt-out.

29. *See, e.g.*, Military and Paramilitary Activities in and Against Nicaragua (Nicar. v. U.S.), 1986 I.C.J. 14, 135 (June 27) (noting that "in international law there are no rules, other than such rules as may be accepted by the State concerned, by treaty or otherwise").

30. Berne Convention, *supra* note 1, art. 7(8) ("[T]he term shall be governed by the legislation of the country where protection is claimed; however, unless the legislation of that country otherwise provides, the term *shall not exceed* the term fixed in the country of origin of the work." (emphasis added)). This principle is also known as "the Rule of the Shorter Term."

31. *Golan v. Gonzales*, 501 F.3d 1179, 1183 (10th Cir. 2007) (citing *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 558 (1985)).

32. *See* Thomas Gordon Kennedy, *GATT-Out of the Public Domain: Constitutional Dimensions of Foreign Copyright Restoration*, 11 ST. JOHN'S J. LEGAL COMMENT. 545, 578 (1996).

must necessarily be interpreted narrowly is therefore highly questionable.

*B. Lessons from Berne's Negotiating History*

The negotiating history of the Berne Convention confirms that member states were meant to have significant leeway in setting the level of retroactive protection afforded to works already in the public domain.<sup>33</sup> Article 14 in the original 1866 text of the Convention—the provision corresponding to Article 18 in the 1971 Paris Act—read as follows: “Under the reserves and conditions to be determined by common agreement, this Convention shall apply to all works which at the moment of its coming into force have not yet fallen into the public domain in the country of origin.”<sup>34</sup> Thus, the original extent of a member state’s obligation under Article 18 was left to be defined in a separate “common agreement.” That agreement was ultimately codified in the Final Protocol of September 9, 1886 (adopted the same date as the original text of the Convention). Paragraph 4 of the Protocol reads:

[1] The common agreement provided for in Article 14 of the Convention is established as follows: [2] The application of the Convention to works which have not fallen into the public domain at the time when it comes into force shall take effect according to the relevant provisions contained in special conventions existing, or to be concluded, to that effect. [3] In the absence of such provisions between any countries of the Union, the respective countries shall regulate, each in so far as it is concerned, *by its domestic legislation*, the manner in which the principle contained in Article 14 is to be applied.<sup>35</sup>

The Final Protocol thus only established a general principle that there should be some retroactive protection, leaving it up to each country to decide how that principle should be applied.<sup>36</sup> The Records of the 1885 Diplomatic Conference (where the parties agreed upon the text of Article 14) are very clear: “As noted below, in connection with the Final Protocol, the implementation of the above Article [14] will be

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33. Article 32 of the Vienna Convention on the Law of Treaties, May 23, 1969, 1155 U.N.T.S. 331, specifically permits use of the negotiating history as an interpretive tool.

34. Berne Convention (original text of Sept. 9, 1866) art. 14 *in* BERNE CONVENTION CENTENARY, *supra* note 1, at 228. All original texts were in French, and the translations here are all from BERNE CONVENTION CENTENARY.

35. Berne Convention, Final Protocol of Sept. 9, 1886 ¶ 4, *in* BERNE CONVENTION CENTENARY, *supra* note 1, at 228 (emphasis added).

36. It is of note that, at the time of the Paris revision, France proposed deletion of the reference to “conditions” in Article 14 and only a limited ability “to adopt transitional measures on the part of new accessions under paragraph 4 of the Closing [Final] Protocol.” 1 RICKETSON & GINSBURG, *supra* note 20, at 336. The proposal was met by German and British opposition “on the ground that, despite the lapse in time, absolute retroactivity might still injure [legitimate reliance] interests.” *Id.*

left to each country of the Union, which will decide on the conditions of retroactivity according to its own laws or specific conventions.”<sup>37</sup>

At the 1908 Revision Conference held in Berlin, Germany, Article 14 became Article 18 and the provisions of the Final Protocol of 1886, as amended in Paris in 1896, were incorporated into a single Article. Because Article 18 essentially took its final form at the 1908 Conference, the discussion on retroactive application at that Conference is illuminating. The Report of that Conference reads in part: “Account had to be taken of the *de facto* situation existing in certain countries at the time the Convention came into force, of the interests of those who might have lawfully reproduced or performed foreign works without their authors’ authorization.”<sup>38</sup> There was thus a clear acknowledgment, over a hundred years ago, that certain third parties might have had legitimate interests in works that would be retroactively protected under the new Convention.

One notable difference between the 1886 version and the current version (adopted in 1908) is that, while the former allowed countries to “regulate, each in so far as it is concerned, *by its domestic legislation*, the manner in which the principle contained in Article 14 is to be applied,” the latter allows countries to “determine, each in so far as it is concerned, the conditions of application” of the principle of restoration.<sup>39</sup> The current text is thus not limited to regulation by legislation; a court, for example, can now determine appropriate conditions for retroactive protection under the Convention. Indeed, the WIPO Guide to the Berne Convention specifically notes that “it is a matter therefore for each member country to decide on the limits of this retroactivity and, in litigation, for the courts to take into account these acquired rights [of reliance parties].”<sup>40</sup>

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37. Records of the Second International Conference for the Protection of Artistic and Literary Works, Convened in Berne September 7 to 18, 1885, in RICKETSON & GINSBURG, *supra* note 20, app. 23 at 136, <http://www.oup.com/uk/booksites/content/9780198259466/15550023> (last visited Sept. 22, 2011). The 1896 Additional Act of the Convention modified Paragraph 4 of the Final Protocol to make it applicable to translations and to “new accessions to the Union.” Berne Convention, Additional Act and Interpretative Declaration of Paris of May 4, 1896, in BERNE CONVENTION CENTENARY, *supra* note 1, at 228.

38. Records of the Conference Convened in Berlin October 14 to November 14, 1908, in RICKETSON & GINSBURG, *supra* note 20, app. 26 at 215, <http://www.oup.com/uk/booksites/content/9780198259466/15550026> (last visited Sept. 22, 2011).

39. Compare Berne Convention, Final Protocol of Sept. 9, 1886 ¶ 4, in BERNE CONVENTION CENTENARY, *supra* note 1, at 228 (emphasis added), with Berne Convention, *supra* note 1, art. 18(3).

40. WORLD INTELLECTUAL PROP. ORG., GUIDE TO THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS 186 (1978).

The much more recent WIPO Copyright Treaty was adopted on December 20, 1996.<sup>41</sup> It was originally conceived as a possible protocol to the Berne Convention, but it eventually became a freestanding instrument.<sup>42</sup> Its application in time<sup>43</sup> mirrors Article 18 of the Berne Convention.<sup>44</sup> The Records of the Diplomatic Conference at which that treaty was adopted contain the following statement from the Conference chairman, discussing possible options for a provision on application in time:

[The chairman] believed that . . . there would be no retroactive effect concerning prior acts[,] and the provisions of the Treaty would not introduce an obligation to countries to change their laws in such a way that prior agreements would be changed. He felt that that was *in most countries probably already constitutionally prohibited*. . . . He acknowledged that revival of rights in some cases would cause practical problems.<sup>45</sup>

The authors of the Berne Convention were undeniably aware of the problems that would be caused by its application to works in the public domain. Article 18 thus grants wide discretion to members to determine the conditions of applying retroactivity.

### C. Lessons from the Literature

The academic commentary on Article 18 confirms that, from the beginning, member states were left with broad implementing discretion. Indeed, as Sam Ricketson reiterated in the second edition of his Berne Convention commentary, Article 18(3) “leave[s] considerable latitude to countries as to how they will implement the principle of retroactivity, enabling them to safeguard any rights which have been acquired in the previous situation where no legal protection applied.”<sup>46</sup> As a result, “wide differences are to be seen in the provisions adopted by member countries.”<sup>47</sup>

Does this latitude relate to the duration of reliance-party measures? It is difficult to conclude from the text of the Convention that any measure adopted under Article 18(3) must be brief—or

41. WIPO Copyright Treaty, *supra* note 12. The United States adhered to the WIPO Copyright Treaty as of March 6, 2002. See *Contracting Parties*, WORLD INTELLECTUAL PROP. ORG., [http://www.wipo.int/treaties/en/ShowResults.jsp?treaty\\_id=16](http://www.wipo.int/treaties/en/ShowResults.jsp?treaty_id=16) (last visited Sept. 22, 2011) (listing contracting parties to the WIPO Copyright Treaty and effective dates).

42. See MIHÁLY FICSOR, THE LAW OF COPYRIGHT AND THE INTERNET 18–19, 122–29 (2002) (describing the development of the Berne Convention).

43. See *supra* note 12 and accompanying text.

44. WIPO Copyright Treaty, *supra* note 12, art. 13.

45. 2 WORLD INTELLECTUAL PROP. ORG., RECORDS OF THE DIPLOMATIC CONFERENCE ON CERTAIN COPYRIGHT AND NEIGHBORING RIGHTS QUESTIONS, GENEVA 1996, at 727 (1999) (emphasis added).

46. 1 RICKETSON & GINSBURG, *supra* note 20, at 342.

47. *Id.*

indeed, even temporary. It must be *transitional*, which is by definition a measure meant to ensure an orderly transition from non-Berne to Berne status. But transitional is not synonymous with brief or short-lived.<sup>48</sup>

William Briggs wrote one of the earliest detailed commentaries on the Berne Convention published in English.<sup>49</sup> Discussing Article 14 (the predecessor to Article 18), Briggs notes:

These qualifications [in the Final Protocol] proceeded from a desire to safeguard vested interests. In the absence of international protection foreign works had at one time been universally looked upon as lawful objects for native reproduction, either in their original form, or by adaptation or translation. Capital had been sunk, labour had been employed in making these valuable reproductions; lawful interests had been thereby created, and a quasi-property had thus been acquired. A State which had tolerated the indiscriminate reproduction of foreign works would hardly be justified in giving an unqualified consent to the principle of retroactivity, without making due provision for the securing of this quasi-property. Hence the rule of Art. 14 was not made absolute, and it was left to each country to regulate by particular agreement or by domestic law the mode in which it should be applied.<sup>50</sup>

Briggs goes on to note that proposals by Belgium and France to remove the flexibility contained in the Final Protocol were defeated at the 1896 Revision Conference.<sup>51</sup> He also quotes the United Kingdom's legislation implementing Berne, providing that "nothing . . . shall diminish or prejudice any rights or interests arising from or in connection with [the production of any work in the United Kingdom prior to the entry into force of the Berne implementation act] which are subsisting and valuable . . . ."<sup>52</sup> Briggs then references a case in which a British court would have been prepared to let a reliance party produce fresh copies of a work *even after the application of the implementing act*, if the reliance party "had not himself recouped for his outlay."<sup>53</sup>

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48. As discussed above, Articles 18(1) and 18(2) of the Berne Convention establish that a work already in the public domain should not be protected anew unless it remains protected in the country of origin *and* fell out of copyright in the country where protection is claimed by reason other than expiration of the term. *See supra* Part I.A. Article 18(3) must be interpreted as conferring latitude to effect its purpose—namely, protecting the legitimate rights of reliance parties for as long as is required. Additionally, proposals to set specific time limits in Article 18(3) were rejected by Berne member states. *See* Arpad Bogsch, *WIPO Views of Article 18*, 43 J. COPYRIGHT SOC'Y U.S.A. 181, 191 (1995) (quoting minutes from the 1884 Berne conference).

49. WILLIAM BRIGGS, *THE LAW OF INTERNATIONAL COPYRIGHT* (1906).

50. *Id.* at 265.

51. *Id.* at 266.

52. *Id.* at 268.

53. *Id.* at 268–69. The case is *Hanfstaengl v. Holloway*, [1893] 2 Q.B. 1 (Eng.). During the 1884 Berne Conference, it was noted that possible protection of reliance parties was not limited to copies in existence at the time of application of the Convention but could also extend to copies "in the process of being completed." BERNE CONVENTION CENTENARY, *supra* note 1, at 92.

Irwin Karp prepared a complete study of the application of Article 18 in the United States.<sup>54</sup> Karp notes, first, that because most European countries adhered to the Convention in the late nineteenth or early twentieth century, the issue of retroactive protection has all but disappeared from policy radars in those jurisdictions.<sup>55</sup> In addition, very few of these European countries had registration systems.<sup>56</sup> Citing the opinion of “many United States and most foreign copyright experts,” Mr. Karp concludes that while the United States had “considerable leeway in fashioning the conditions of retroactivity,” it did not have enough leeway to “deny any degree of retroactivity.”<sup>57</sup> In other words, imposing conditions may not include a complete absence of application of the principle of limited restoration. Yet, any set of conditions under which the principle is applied would be sufficient to meet U.S. obligations under the Convention.

Hence, when the United States adopted a minimalist approach upon joining the Convention by failing to provide *any* retroactive protection, it pushed the boundaries of Article 18(3) too far.<sup>58</sup> The current implementation of Article 18, however, does much more than Berne requires to protect copyright holders (and correspondingly, to reduce the protection of reliance parties). It is a transition from one extreme to another.

Nearly concurrently with Karp’s study, WIPO Director General Arpad Bogsch published his views on Article 18 during the debates on the United States accession to the Berne Convention.<sup>59</sup> In a letter to the Commissioner of Patents and Trademarks, Bogsch notes that the “principle” referred to in Article 18(3) is the one described in Articles 18(1) and 18(2)—that at least some retroactivity be afforded.<sup>60</sup> He also argues that, while a country can impose conditions on the application of the principle, the principle must be applied in some way, thus ruling out a complete absence of retroactivity.<sup>61</sup> With respect to transitions, Bogsch argues that a comment in the negotiating history suggests that Article 18(3) only allows transitional measures.<sup>62</sup> However, even if one accepts this postulate, Article 18(3) conditions

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54. Irwin Karp, *Final Report, Berne Article 18 Study on Retroactive United States Copyright Protection For Berne and Other Works*, 20 COLUM.-VLA J.L. & ARTS 157 (1996).

55. *Id.* at 167.

56. *Id.* at 172.

57. *Id.*

58. *See supra* note 2 and accompanying text.

59. Bogsch, *supra* note 48.

60. *Id.* at 190.

61. *Id.*

62. *Id.*

are *by definition* transitional, in that their purpose is to ensure the switch from non-Berne status to Berne status. As noted above, transitional measures are not necessarily short-lived, though they often will be in practice because reliance parties may stop using certain works over time. But that is the decision of the reliance parties. Certainly, the Convention does not impose any specific time limit here, unlike in Article 13(2).<sup>63</sup> Under the interpretive canon *expressio unius est exclusio alterius*, if Convention negotiators specifically included a two-year period in Article 13(2), it is reasonable to assume that they could have included one in Article 18(3), but chose not to do so. Indeed, Bogsch himself quotes a diplomatic conference record *rejecting* a proposal to restrict the period in which new Berne countries could impose conditions to two years.<sup>64</sup> There is simply no authority to support the conclusion that any member state agreed to a similar mandate that transitional measures be short-lived or limited to two years.<sup>65</sup>

Most other senior scholars seem to share this view that Berne members have a very limited obligation under Article 18. Silke von Lewinski states in her recent book that “countries have some leeway in determining the conditions of application [of Article 18]. However, they must not go as far as *entirely to deny* the application of Articles 18(1) and 18(2) of the Berne Convention.”<sup>66</sup> In the same vein, Professor Paul Goldstein writes: “Article 18(3) of the Berne Convention gives member countries *considerable leeway to meliorate the prejudice suffered* by users when a work they correctly believed was in the public domain is restored to copyright.”<sup>67</sup>

## II. THE TRIPS AGREEMENT

### A. *Retroactivity Obligations Under TRIPS*

There is no doubt that copyright law supports a major export sector of the U.S. economy and that international copyright relations

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63. See Berne Convention, *supra* note 1, art. 13(2) (providing a two-year window for reproduction of certain recorded works).

64. Bogsch, *supra* note 48, at 191.

65. Bogsch refers to a “quite general agreement” that measures taken under Article 18(3) should not be applied for a period of more than two years, but the only precedent he cites is in Article 13(2), which governs recorded musical works—not Article 18(3). *Id.* at 192.

66. SILKE VON LEWINSKI, INTERNATIONAL COPYRIGHT LAW AND POLICY 184 (2008) (emphasis added).

67. PAUL GOLDSTEIN & P. BERNT HUGENHOLTZ, INTERNATIONAL COPYRIGHT: PRINCIPLES, LAW, AND PRACTICE 295 (2d ed. 2010) (emphasis added).

matter.<sup>68</sup> It is similarly clear that the Berne Convention and the TRIPS Agreement are important in this context. Furthermore, it seems reasonable to argue that, wherever possible, an interpretation of U.S. law that conforms to treaties ratified by the U.S. Senate is preferable.<sup>69</sup> This does not imply, however, that where those international instruments leave parties ample flexibility in implementing their obligations, they should be interpreted as giving strict directions.

As noted earlier, Article 18(3) of the Berne Convention provides that the principles stated in Articles 18(1) and 18(2) “shall be subject to any provisions contained in special conventions . . . concluded between countries of the Union.” The TRIPS Agreement could be considered a “special convention” under Article 18(3) if it restricted the United States’ ability to determine appropriate conditions of retroactive protection. But it does not: TRIPS provides that “copyright obligations with respect to existing works shall be solely determined under Article 18 of the Berne Convention (1971).”<sup>70</sup> The TRIPS Agreement also incorporated Article 18 of the Berne Convention by reference.<sup>71</sup> As such, TRIPS does not modify the obligations contained in Article 18.

Could the U.S. negotiators have done it differently? I believe that the answer is yes. As noted above, the United States obtained a significant concession not to have moral rights enforceable in the World Trade Organization. This may be considered a special agreement under Article 18(3).<sup>72</sup> But such exceptions and special conventions must be negotiated. Though the TRIPS Agreement renders the Berne Convention subject to the dispute-settlement mechanism of the WTO, it is a long-standing principle that WTO agreements should not be interpreted to include concessions not explicitly bargained for.<sup>73</sup>

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68. See, e.g., STEPHEN E. SIWEK, WORLD INTELLECTUAL PROP. ORG., THE ECONOMIC CONTRIBUTION OF COPYRIGHT-BASED INDUSTRIES IN USA 6 (2004), available at [http://www.wipo.int/ip-development/en/creative\\_industry/pdf/ecostudy-usa.pdf](http://www.wipo.int/ip-development/en/creative_industry/pdf/ecostudy-usa.pdf). (“[T]otal revenue generated from foreign sales of the core copyright industries is estimated to be at least \$89.26 billion in 2002 . . .”).

69. See *Murray v. Schooner Charming Betsy*, 6 U.S. (2 Cranch) 64, 118 (1804) (“[A]n act of Congress ought never to be construed to violate the law of nations if any other possible construction remains, and consequently can never be construed . . . further than is warranted by the law of nations as understood in this country.”).

70. TRIPS Agreement, *supra* note 10, art. 70.2.

71. *Id.* art. 9.2.

72. See *supra* text accompanying notes 21–26.

73. For example, in discussing an exception invoked by Brazil, the panel noted: “nothing indicates that the failure to remove this clause was something that developing countries

Without a special convention in place to modify Article 18, we must interpret that Article as it stands. This approach leads to recognizing the flexibility contained in Article 18(3). In interpreting the Berne Convention provisions incorporated into the TRIPS Agreement, dispute-settlement panels have referred to the negotiating history of the Convention.<sup>74</sup> Attempts during the negotiations to cabin Article 18 by limiting reliance-party measures to a two-year window failed, as had happened at the Paris Conference of 1896.<sup>75</sup> Taken together with the absence of any statement restricting the scope of Article 18(3) in the Convention, the record suggests that a future WTO panel is unlikely to read significant restrictions into that provision.

This flexible interpretation is consonant with TRIPS. The WTO notes in its “Introduction to TRIPS” that WTO members “issued a special Declaration at the Doha Ministerial Conference in November 2001. They agreed that the TRIPS Agreement does not and should not prevent members from taking measures to protect public health. *They underscored countries’ ability to use the flexibilities that are built into the TRIPS Agreement.*”<sup>76</sup> This is reflected in several provisions of the Agreement itself, including Article 1.1, which provides in part that “Members shall be free to determine the appropriate method of implementing the provisions of this Agreement within their own legal system and practice.”<sup>77</sup> Other examples include Articles 13, 26.2 and 30, which allow members to provide unspecified exceptions in their national laws to copyright, design, and patent rights, respectively.

### B. The Likelihood of a Trade Dispute

ASCAP’s amicus brief in *Golan* asserts that a violation of TRIPS would entail dire consequences in the form of trade-based retaliation.<sup>78</sup> This statement has not been verified empirically. The

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bargained for.” Panel Report, *Brazil — Export Financing Programme for Aircraft*, 43 n.140, WT/DS46/R (Apr. 14, 1999), available at [www.wto.org/english/tratop\\_e/dispu\\_e/46r.pdf](http://www.wto.org/english/tratop_e/dispu_e/46r.pdf).

74. See, e.g., Panel Report, *United States — Section 110(5) of the U.S. Copyright Act*, ¶¶ 6.45–6.47, WT/DS160/R (June 15, 2000), available at [http://www.wto.org/english/tratop\\_e/dispu\\_e/1234da.pdf](http://www.wto.org/english/tratop_e/dispu_e/1234da.pdf) [hereinafter *United States — Copyright Act*].

75. The provision equivalent to Article 18 at the time was Paragraph 4 of the Final Protocol of 1886. See *supra* notes 33–37 and accompanying text.

76. *Understanding the WTO: The Agreements*, WORLD TRADE ORG., [http://www.wto.org/english/thewto\\_e/whatis\\_e/tif\\_e/agrm7\\_e.htm](http://www.wto.org/english/thewto_e/whatis_e/tif_e/agrm7_e.htm) (last visited Aug. 29, 2011) (emphasis added).

77. TRIPS Agreement, *supra* note 10, art. 1.1.

78. See Brief for the American Society of Composers, Authors and Publishers et al. as Amici Curiae in Support of Respondents at 37, *Golan v. Holder*, No. 10-545 (U.S. Aug. 2011) (arguing that excessive exemption of reliance parties from restoration provisions would “expose the United States to trade sanctions pursuant to international trade agreements in which the

United States has lost a number of disputes at the WTO, including two that found U.S. law in violation of TRIPS.<sup>79</sup> The panel reports date back to 2000 and 2002, and neither one has been implemented by the United States.<sup>80</sup> Yet no trade-based sanctions have been applied by the European Union, which won both cases.<sup>81</sup> In fact, since the inception of the WTO on January 1, 1995, the instances of actual trade-based retaliation against *any* country for a WTO violation have been exceedingly rare. The Dispute Settlement Understanding (“DSU”), which governs the WTO dispute-settlement process, makes it clear that other means of solving disputes are preferable.<sup>82</sup>

In sum, while a TRIPS violation might theoretically lead to dispute-settlement proceedings at the WTO—which in turn might lead to trade-based retaliation—this possibility is remote. More importantly, as long as there is some degree of retroactive protection of public domain works, the principle contained in Articles 18(1) and 18(2) of the Berne Convention may be said to have been applied, and thus no TRIPS violation would be found.<sup>83</sup>

### III. CONCLUSION

When the United States joined the Berne Convention, Congress ignored Article 18. There is no doubt that the United States was in violation of its obligations at that point.<sup>84</sup> When joining the WTO and

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United States needs to participate so that American businesses can compete successfully in international markets”).

79. *United States — Copyright Act*, *supra* note 74, ¶ 7.1(b); Appellate Body Report, *United States — Section 211 Omnibus Appropriations Act of 1998*, ¶ 360, WT/DS176/AB/R (Jan. 2, 2002), available at [http://www.worldtradelaw.net/reports/wtoab/us-section211\(ab\).pdf](http://www.worldtradelaw.net/reports/wtoab/us-section211(ab).pdf) [hereinafter *United States — Omnibus Appropriations Act*].

80. A panel report makes a recommendation if it finds that one or more WTO obligations are not complied with, but the implementation of the report is then transferred to the Dispute Settlement Body of the WTO, essentially an assembly of all WTO Members.

81. In the second case, the EU won on one point, namely that sections 211(a)(2) and (b) of the Omnibus Appropriations Act of 1998, Pub. L. No. 105-277, 112 Stat. 2681, violate the national-treatment and most-favored-nation obligations under the TRIPS Agreement. *United States — Omnibus Appropriations Act*, *supra* note 79, ¶ 360. In the first case, the music licensing (“homestyle”) exemption contained in the U.S. Copyright Act (17 U.S.C. § 110(5)(b)) was found to be in violation of TRIPS. *United States — Copyright Act*, *supra* note 74, ¶ 7.1(b).

82. See Understanding on Rules and Procedures Governing the Settlement of Disputes art. 3(7), Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 2, 1869 U.N.T.S. 401 (providing in part that (a) “[t]he aim of the dispute settlement mechanism is to secure a positive solution to a dispute;” (b) “[a] solution mutually acceptable to the parties to a dispute . . . is clearly to be preferred;” and (c) retaliation is a “last resort”).

83. See *supra* Part I.A.

84. As Professor Townsend Gard explains in her article, the official reason for failure to restore works was that Congress required a thorough examination of the issue. Townsend Gard, *supra* note 5, at 204.

the TRIPS Agreement, the United States had to consider the possibility that its nonimplementation of Article 18 would be challenged under the DSU. It then overimplemented Article 18 by restricting the public domain much more than required by Article 18. That provision states that a work already in the public domain should be protected anew *only* where (1) that work remains protected in its country of origin, *and* (2) it is not protected in the country where protection is claimed for a reason *other* than the expiration of a term of protection previously granted (e.g., for failure to comply with a registration requirement).<sup>85</sup>

The risks to U.S. copyright holders of a lesser level of implementation have been exaggerated, as has been the risk of trade-based retaliation if a violation of Berne and/or TRIPS was found. The United States has the necessary leeway to implement its Berne obligations in a way that protects the legitimate interests of both authors and users of copyrighted works.

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85. See *supra* Part I.A.