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## COPING WITH THE BERNE CONVENTION

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Can your client freely copy a work that does not have a copyright notice? Prior to March 1, 1989, omission of a copyright notice invalidated the copyright in a work except, for works first published after 1977, in the following situations:

1. The notice was omitted from a relatively small number of distributed copies;
2. The notice was omitted in violation of an express requirement in writing that the copies bear a copyright notice; and
3. The work was registered within five years after publication without notice, and a reasonable effort was made to add notice to all distributed copies.

Thus one was not likely to be liable for copying a work lacking a copyright notice, even though such practice was not to be recommended.

The Berne Convention Implementation Act of 1988 brings the United States, as of March 1, 1989, into the Convention of Literary and Artistic Works, a group of countries that recognizes international copyright protection, commonly known as the Berne Union or the Berne Convention. At the present time, 79 countries belong to the convention, the Soviet Union and the Peoples Republic of China being the most notable exceptions. Each nation belonging to the Berne Convention is required to apply its own copyright laws on works from other member states, and to include certain features in its laws. In joining Berne, the U.S. Congress elected a "minimalist" approach that keeps the old copyright laws intact as far as was deemed possible.

In order to join the Berne convention, the U.S. law had to abandon the requirement of copyright notice on copyrighted works. Under the minimalist approach, the new law excuses copyright notice requirements for works published after March 1, 1989. For earlier public distribution, the old law requiring copyright notices remains in effect. Also, to determine whether a work first published prior to 1978 and republished before March of this year remains protected, pertinent provisions of the 1909 Act must be also be consulted.

The Berne Convention also proscribes formal registration requirements prior to judicial enforcement, so the Copyright Act as amended states "for actions for infringement of copyright in Berne Convention works whose country of origin is not the United States," registration is not required. Thus American claimants that wish to retain both copyright and trade secret protection may seek to avoid the registration requirement (and the associated public deposit in the Library of Congress) by distribution of the work in another Berne country within thirty days of its United States publication, thereby qualifying the work as of foreign origin under the new law.

Following the Rome revision to the Berne Convention in 1928, "moral rights" were added to the requirements, as follows:

Independently of the author's economic rights, and even after the transfer of the ... rights, the author shall have the right ... to object to any distortion, mutilation, or other modification of, or other derogatory action in relation to, the ... work, which would be prejudicial to his honor or reputation.

Congress has done nothing to explicitly include these moral rights in the 1988 Act, but it is generally agreed by international legal scholars as well as the State and Commerce Departments that the present copyright law (together with the Landham Act and other U.S. and state laws relating to libel, defamation, misrepresentation, unfair competition, etc.) satisfy the moral rights requirements of the Berne Convention. How the courts will deal with arguments based on a breach of moral rights remains to be seen, however, in view of pronouncements by

the legislative and executive branches that "the Berne Convention is not "self executing."

The new law also doubles the amount of "statutory" damages as an incentive for foreigners and Americans to register and to make up for inflation since 1976. Further, recordation of a copyright transfer is not required before filing suit for infringements after March 1, 1989. However, it is beneficial to record a copyright transfer for notice giving statutory priority over bona fide purchasers.

In summary, for those desiring to copy works not having a copyright notice, let the copier beware, especially for works first published since February.

Congress enacted the first copyright law in 1790 thus rejecting the French approach of informal grants of copyrights adapted from the Statue of Anne adopted by the English Parliament in 1710 which was later amended to require a visible notice be placed on every copy of a published work. Because the United States did not join the many nations at Berne to consider a multilateral treaty on copyright protection, Congress was under pressure to amend the copyright laws, resulting in the International Copyright Act of 1891. This act extended American copyright protection to foreigners upon the condition that they comply with the requirements of the 1790 Act, and in addition that the published work be of American manufacture.

Acting upon protest by publishers and movie producers to the moral rights clause, the United States created the United Nations Educational, Scientific and Cultural Organization (UNESCO) and ratified the Universal Copyright Convention (UCC) in 1954. The UCC requires that a foreign published work must meet the requirements of a member nation unless the work bears a prescribed copyright notice. Further, any work published first in the United States was required to comply with all domestic formalities.

Several obstacles disappeared with regard to the ratification of the Berne Convention by the United States. First, America withdrew from UNESCO and terminated funding and administrative assistance for the UCC. Second, the United States was more frequently being criticized in its refusal to ratify the Berne Convention, the view of many nations being that the United States was not fully committed to the international protection of copyrights. Third, the Copyright Act of 1976 caused the United States to be more compatible with the Convention. Finally, it is generally agreed by international legal scholars as well as the State and Commerce Departments that the present copyright laws in the United States satisfy the moral rights requirements of the Berne Convention.

There are many substantial benefits for the United States as a member of the Berne Convention, including the establishment of copyright relations with 24 countries with which the United States had no relations with previously, and the elimination of the need for Americans to use the "back door" procedure to get protection under the Berne Convention.

The Berne Convention Act of 1988 makes some basic changes in the copyright law to comply with the Berne Convention. The mandatory requirement of a visible copyright notice is eliminated for works published after March 1, 1989. As an incentive to provide a copyright notice, however, the courts will not give any weight the claim of innocent infringement to defendants who have access to copies bearing the proper copyright notice when awarding damages. The eliminated mandatory copyright notice causes published works to be placed in three categories for intellectual property practitioners: 1) all works published after March 1, 1989 are excused from copyright notice requirements; 2) the mandatory copyright notice is still in effect for works published after January 1, 1978 but before March 1, 1989; and 3) the placement of the copyright notice for works published before January 1, 1978, is still governed by the Copyright Act of 1909.

The requirement that a work must be registered with the United States Copyright Office before filing an infringement action has been lifted on works that do not originate from the United States. American works are still required to be registered before the filing of a suit. Practitioners in intellectual property are advised to encourage their clients to register their works because the cost of registering is small with great benefits.

For both foreign and American copyright claimants, the mandatory requirement of recordation of copyright transfer before an infringement action is lifted. Statutory damages are doubled by the ratification of the Berne Convention Act. The 1988 Act also allows the codification of architectural blueprints as copyrightable subject matter although the protection is not extended to the structure itself. With respect to the moral rights clause, the 1988 Act provides that the provisions of the Convention are not self-executing and not directly enforceable in the courts, leaving the moral rights clause without effect until Congress grants such a right to American authors. Congress felt that because many laws already extend the same protections available under the moral rights clause to authors, the moral rights issue was left for future congresses.

In the past, American authors tried to take advantage of the Berne Union through a "back door" method by simultaneously publishing their works in the United States and a Berne Union country, mostly without success. For example, the movie "The Sting" was denied protection in Thailand because of supposed irregularities between the United States and Canadian versions which were released at the same time. Now that the United States is a part of the Berne Union, the "front door" is open.

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