

Berne-Compatibility of Formal Declaratory Measures to Enhance Title-Searching

Jane C. Ginsburg

Columbia University School of Law

Purposes of “Formalities” today

1. Create Forfeitures: Put works in public domain (aka “free flow of information”) (offset “too much ©” – low threshold for protection; broad scope of rights; excessive duration) Confiscatory by design

NOT compatible with Berne

Purposes, cont.

2. Assist title-searching and rights-clearance

Goal: promote dissemination **and** compensation
(and/or control)

Voluntary measures pose no Berne problem

But even certain **mandatory** declaratory
measures CAN BE compatible with Berne

Berne art. 5

(2) The **enjoyment** and the **exercise** of these rights [Berne minima and national treatment] shall not be subject to any formality . . .

(3) Protection in the country of origin is governed by domestic law. [“2-tier” OK]

What is a Berne-banned “formality”?

-- “enjoyment”

- Conditions on the **coming into being of rights**
e.g.: Notice; registration; deposit (if tied to ©)
- Conditions on the **maintenance** of rights
e.g. Renewal registration
- Conditions on the **scope** of the rights
e.g. No translation rights unless expressly reserved

“exercise”

= Enforcement

Prerequisites to suit (copyright-specific
declaratory measures or fees)

Limitations on Berne/TRIPs minimum remedies
(actual damages; injunctive relief)

Carrots instead of Sticks?

Incentives to comply with declaratory measures
(notice, registration)

Evidentiary advantages (e.g. 17 USC sec. 410(c))

Remedial advantages (e.g., sec. 412) - “**Berne +**”

[Berne/TRIPs basic remedies – including
injunctions (TRIPS art. 41(1) - may NOT be
conditioned on compliance with declaratory
obligations]

Are Sec 412 remedies really “Berne/TRIPs+”?

TRIPs 41(1): *Members shall ensure* that enforcement procedures as specified in this Part are available under their law so as to permit ***effective action*** against any act of infringement of intellectual property rights covered by this Agreement, including expeditious remedies to prevent infringements and remedies which constitute a deterrent to further infringements.

But compare TRIPs 45(2)

The judicial authorities *shall also have the authority* to order the infringer to pay the right holder expenses, which may include appropriate attorney's fees. *In appropriate cases, Members may authorize the judicial authorities to order recovery of profits and/or payment of pre-established damages even where the infringer did not knowingly, or with reasonable grounds to know, engage in infringing activity.*

If Statutory Damages are “Berne+”

Then the Register of Copyright’s suggestion that grantees be required, as a prerequisite to obtaining statutory damages, to have updated registration information before the infringement occurs **is Berne-compatible**

Other “Berne+” Conditions: Duration

Berne general minimum 7(1): Life+50

Rule of the shorter term 7(8)

If country of origin's term exceeds Berne minimum, then foreign work must get national treatment for CO's Berne-excess term. But >life+50, host state can impose formalities on foreign authors if it imposes them on its own authors. (E.g., requiring EU rightholders to renew for last 20 years of US term OK if US rightholders also have to renew.)

Declaratory Measures going to Copyright Ownership

Berne-banned “formalities” address conditions on **whether** © exists and **how** it is enforced, but NOT on **who** owns rights.

E.g., requirement that transfer is not valid unless in writing and signed is NOT a “formality”

Nor is requirement (of some EU countries’ laws) that rights be separately enumerated in the grant

Berne-compatible PROPOSAL

Amend copyright act to **condition validity of a transfer of exclusive rights** on “note or memorandum of the transfer” in writing and signed by transferor (sec 204(a)) **AND RECORDED BY THE TRANSFEREE**

Where, How, When

Where: Copyright Office **OR** other publicly-accessible registries; so long as “interactive and transparent”

How: Recordation information **MUST** be standardized and uniform

When: Within a month of execution of transfer (cf. 205(d))

Effect of failure to record

No transfer of exclusive rights. Non-recording transferee gets non exclusive rights (“inter partes” not “erga omnes”).

Sanction for non recordation is NOT invalidity of copyright

Recordation and Registration

No mandatory registration by author as condition of protection per Berne 5(2)

But, if author doesn't voluntarily register, and subsequently transfers rights, member State can require transferee, as a **condition of acquisition of rights**, to register in order to start chain of title for recordation (cf. sec. 409(5); Latman Study)