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Retroactivity and Reliance Rights Under Article 18 of the Berne Copyright Convention

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NOTES

Retroactivity and Reliance Rights Under Article 18 of the Berne Copyright Convention

ABSTRACT

This Note addresses the principle of retroactive copyright protection as it applies to new adherents to the Berne Convention for the Protection of Literary and Artistic Works (the Convention). The Note first examines the primary purposes of retroactivity as evidenced by the Convention's history and subsequent revisions. Next, the Note analyzes the language of the retroactivity principle as it appears in the most recent version of the Convention. The Note then discusses problems that may result from the United States recent adherence to the Convention. The author concludes that the current domestic copyright law of the United States violates international obligations under the Convention and may pose serious political problems for the United States in the future.

The Note addresses the problems that may be faced by existing members of the Convention as other nonmember states seek to join the Berne Union. The Note also examines the unique situation of the People's Republic of China, a notorious pirater of literary and artistic works that now is considering adherence to the Convention. The author concludes that existing members of the Convention must be willing to negotiate some degree of retroactive protection for works of new adherents if they are to encourage states such as China to become members of the Berne Union.

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I. INTRODUCTION

The Berne Copyright Convention (the Berne Convention or the Convention)[1] was established in 1886 in response to the need for authors throughout the world to gain universal protection for their creative efforts. The stated objective of the treaty encompassed a strong intent by the represented states to bring within the scope of Convention protection the largest possible number of literary and artistic works. The Conven-

1. Berne Convention for the Protection of Literary and Artistic Works (Paris Revision 1971) [hereinafter Berne Convention], *reprinted in* WORLD INTELLECTUAL PROPERTY ORGANIZATION, GUIDE TO THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS (PARIS ACT, 1971) 177 (1978) [hereinafter WIPO].

tion's explicit prohibition of formalities as a prerequisite to copyright protection evidences this intent.[2] Article 18 of the treaty, which allows for only one method by which works may fall outside the scope of the Convention's protection, provides additional support for this intent.[3] These provisions evidence the continuing view of the members of the Berne Union that authors never should be subjected to forfeiture of copyright except upon the expiration of the prescribed term of protection.

Despite the clear mandates of the Convention, certain states will face unprecedented difficulty in becoming members of the Berne Union. For example, the United States, which became a member of the Berne Convention in 1989 after decades of heated debate, may encounter problems. Despite its professed compliance with the terms of the Convention, the United States may find provisions of its domestic legislation challenged as being at odds with both the letter and the spirit of the Berne Convention.

Other states wishing to become members of the Berne Union may rethink adherence in light of considerations unique to their history and culture. For example, the People's Republic of China, one of only two major powers in the world that has not yet become a party to the Convention,[4] may face this problem. Because China never has had a uniform copyright law and never has been a party to a general copyright agreement, adherence to the Convention likely would result in a vast number of Chinese works being either thrust into, or pulled out of, the public domain both in China and throughout the Berne Union. This situation must be addressed by the existing members of the Convention.

This Note first examines the evolution of the Berne Convention and the goals of the treaty as expressed by the member states. Second, the Note outlines the development of the retroactivity principle as articulated by the original Berne text and as amended by subsequent protocols. The Note then evaluates other important provisions of the agreement in light of the stated goal of the Convention, including the treaty's express prohibition of formalities as a prerequisite to copyright protection. The Note

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2. *See id.* art. 5(2), *reprinted in* WIPO at 181; *see also* Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 1988 U.S.C.C.A.N. (102 Stat.) 2853 [hereinafter BCIA] (codifying Berne Convention article 5 into United States domestic copyright law for works published after 1988).

3. *See* Berne Convention, *supra* note 1, art. 18, *reprinted in* WIPO at 193; *see also infra* Sections III and IV.

4. The former Soviet Union was the only other major power not a party to the Berne Convention. *See* Zachary B. Aoki, Note, *Will the Soviet Union and the People's Republic of China Follow the United States' Ahderence to the Berne Convention?* B.C. INT'L & COMP. L. REV. 207, 207 (1990).

examines the effect of these principles as they relate to the United States recent adherence to the Berne Convention. The author suggests that United States federal law as articulated in the Berne Convention Implementation Act is violative of obligations under the treaty. Consequently, the author urges the United States Congress to alter domestic copyright law to grant retroactivity while enacting provisional measures to protect the reliance rights of United States nationals.

The Note then describes the unique situation of the People's Republic of China with reference to the historical and cultural factors that have contributed to that state's lack of a uniform copyright law. The Note addresses the concerns of Chinese authors as well as nationals of existing Berne member states who have exploited Chinese works in the absence of a legal duty not to do so. Finally, the Note concludes that only by negotiating the application of the retroactivity principle will the present Berne members encourage nonmember states such as China to adhere to both the spirit and the letter of the Convention.

II. HISTORICAL OVERVIEW OF THE BERNE CONVENTION

The original Berne Convention, convened on September 6, 1886, was the product of nearly three decades of discussion and debate concerning the need for global protection of intellectual property. As early as 1858, a Congress on Literary and Artistic Property convened in Brussels, Belgium, at which nearly three hundred delegates from Europe and the United States gathered to express their views.[5] Although the opinions of the delegates sharply diverged in several areas, particularly with regard to the duration of copyright protection, unanimous support existed for the belief that "the principle of international recognition of the property of authors in their literary and artistic works should be enshrined in the legislation of all civilised [sic] peoples."[6] The 1858 Congress constituted the first significant attempt at establishing international protection of lit-

5. For an excellent discussion of the proceedings of the 1858 Brussels Conference on Literary and Artistic Property [hereinafter the 1858 Congress], see SAM RICKETSON, THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS: 1886-1986 41-46 (1987). For a summary of the 1858 Congress, see ANNALES DE LA PROPRIÉTÉ INDUSTRIELLE, ARTISTIQUE ET LITTÉRAIRE (1858) [hereinafter ANNALES]. For the full text and records of the 1858 Congress, see M. ÉDOUARD ROMBERG, COMPTE RENDU DES TRAVAUX DU CONGRÈS DE LA PROPRIÉTÉ LITTÉRAIRE ET ARTISTIQUE (1859). The 1858 Congress passed resolutions providing for national treatment for works of foreign authors, the elimination of formalities as a condition to copyright protection, and the author's rights of reproduction, translation, and performance. *See* RICKETSON, *supra*, at 42-45.

6. RICKETSON, *supra* note 5, at 42 (citation ommitted).

erary and artistic works. The resolutions of the 1858 Congress, although not binding in any legal sense, greatly influenced domestic copyright laws and bilateral treaties among the various states. Most important, the proceedings of the 1858 Congress served as a framework for future international copyright conferences, notably the 1861 and 1877 artistic congresses at Antwerp,[7] the 1878 literary and artistic conferences at Paris,[8] and the annual conferences of the International Literary and Artistic Association[9] at London (1879), Lisbon (1880), Vienna (1881), and Rome

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7. The 1861 Congress, attended by over 1000 artists, emphasized international support for the resolutions of the 1858 Congress. RICKETSON, *supra* note 5, at 45 & n.15. The respective states were encouraged to negotiate and enter into bilateral agreements for the protection of literary and artistic works. *Id.* at 45; LOUIS RIVIÈRE, PROTECTION INTERNATIONALE DES OEUVRES LITTÉRAIRES ET ARTISTIQUES, ÉTUDE DE LÉGISLATION COMPARÉE 143 (1897). For a full record of the proceedings of the 1861 Congress, see E. GRESSIN, COMPTE RENDU DES TRAVAUX DU CONGRÈS ARTISTIQUE D'ANVERS (1862).

The 1877 Congress, convened to commemorate the 300th anniversary of the birth of Rubens, similarly constituted a showing of broad support for the resolutions of the 1858 Congress. RICKETSON, *supra* note 5, at 45-46. This second Antwerp Congress saw the passage of a unanimous resolution requesting that the Institute of International Law draft a universal law relating to artistic works. *Id.* at 46 (citing DARRAS, DU DROIT DES AUTEURS ET DES ARTISTES DANS LES RAPPORTS INTERNATIONAUX 523 (1887)). The Institute, however, never drafted this universal law because of a lack of diligence on the part of the Institute and its appointed study commission. *Id.*

8. The French *Société des gens de lettres* organized the two 1878 Congresses at Paris. Victor Hugo presided over the first of these meetings—the literary Congress—which was attended by representatives from throughout Europe, the United States, and Russia. RICKETSON, *supra* note 5, at 46. The 1878 literary Congress was followed by an artistic Congress in the same city. Both Congresses passed resolutions similar to those of the 1858 Congress regarding national treatment and the elimination of formalities as a prerequisite to copyright protection. *Id.* at 46-47. For a general record of the proceedings, see ASSOCIATION LITTÉRAIRE ET ARTISTIQUE INTERNATIONALE - SON HISTOIRE, SES TRAVAUX (1878-1889) 1-12 (1889) [hereinafter HISTOIRE]. Both Congresses called upon the French government to initiate an international conference for the purpose of formulating a uniform law providing universal protection of intellectual property. RICKETSON, *supra* note 5, at 47. The French government did not act upon this request, and thus such a meeting did not occur until 1883, when the Swiss government called an international conference at Berne. *Id.*

9. The 1878 literary congress established the International Literary Association to promote "[t]he protection of the principles of literary property". RICKETSON, *supra* note 5, at 47 (citing L'UNION INTERNATIONALE POUR LA PROTECTION DES OEUVRES LITTÉRAIRES ET ARTISTIQUES; SON FOUNDATION ET SON DÉVELOPPEMENT. MÉMOIRE 1886-1936 26 (1936)). This group, composed of representatives from over twenty nations, changed its name in 1884 to the International Literary and Artistic Association, now commonly known as ALAI (for the French translation, *l'Association Littéraire et Artistique Internationale*). *Id.* at 48. Since its creation, the ALAI has been a key actor

(1882).

Although earlier conferences sought to achieve the goal of universal protection of intellectual property by ensuring uniformity of national copyright laws, the 1882 ALAI Conference at Rome was the first to focus upon the possibility of a multilateral treaty agreement to meet this aim.[10] Delegates to the Rome Conference voiced unanimous support for a proposal, submitted by Dr. Paul Schmidt of the German Publishers' Guild, which called for the creation of "a union of literary property" to represent the views of authors and publishers alike.[11] Acceptance of the Schmidt proposal prompted the 1883, 1884, and 1885 ALAI Conferences at Berne, which produced the draft agreement adopted in substantial part by the Berne Convention in 1886.[12]

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in the advancement of universal copyright protection. *See generally* Claude Masouyè, *The Role of ALAI in the Development of International Copyright Law*, 14 COPYRIGHT 120 (1978). Between 1879 and 1881, the ALAI Congresses focused, as had other conferences in the past, on the need for international protection of intellectual property. *Id.* at 120-22.

10. RICKETSON, *supra* note 5, at 48.

11. *Id.* at 48-49 (citing HISTOIRE, *supra* note 8, at 122-23).

12. Following the acceptance of the Schmidt proposal at the 1883 Rome Conference, the Swiss government, upon the request of the ALAI, circulated a note to the governments of the various states, providing in part:

> [T]he work of man's genius, once it has seen the light, can no longer be restricted to one country and to one nationality . . . . This is why, after all civilized States have recognised and guaranteed by their domestic legislation the right of writer and of artist over his work, the imperative necessity has been shown of protecting this right in international relations. . . . But regardless of the advantages presented by [past copyright] conventions it must first be recognized [sic] that they are far from protecting the author's rights in a uniform, efficacious, and complete manner. This insufficiency results, without doubt, from the diversity of national laws, which the conventional regimes must necessarily take into account . . . . We therefore see great efforts on [the part of authors, publishers, and others] to secure, on the one hand, universal recognition of the rights of authors without distinction of nationality, and on the other, the desirable uniformity in the principles which govern this matter.

RICKETSON, *supra* note 5, at 54 & n.52 (citing, for the full text of this letter, ACTES DE LA CONFÉRENCE INTERNATIONALE POUR LA PROTECTION DES DROITS D'AUTEUR RÉUNIE À BERNE DU 8 AU 19 SEPTEMBRE 1884 (1884) [hereinafter ACTES 1884]).

The letter further stated that if the idea of an international convention on the matter should meet with the approval of the various states, the Swiss Federal Council would convene a meeting. *Id.* at 55. The result of the Swiss initiative was the Berne Diplomatic Conference of 1884, attended by delegates from ten nations. *Id.* For a detailed discussion of this meeting, see *id.* at 55-59, and sources cited therein. The stated purpose of the Conference was "to constitute a general Union for the protection of the rights of authors in their literary works and manuscripts." *Id.* at 51 (quoting HISTOIRE, *supra* note 9, at 182). At this meeting, the Conference drafted articles dealing with the subjects of na-

Delegates from twelve states[13] attended the Berne Convention, which concluded on September 9, 1886.[14] The Convention served primarily as a formality to approve the agreement negotiated during the 1883, 1884, and 1885 ALAI Berne Conferences. Since 1886, the Convention has been revised or amended on seven occasions: the Paris Revision of 1896, the Berlin Revision of 1908, the Berne Additional Protocol of 1914, the Rome Conference of 1928, the Brussels Revision of 1948, the Stockholm Revision of 1967, and the Paris Conference of 1971.[15] Today, eighty-four states have adhered to some form of the Berne Convention.

Article 1 of the present text of the Convention states: "The countries to which this Convention applies constitute a Union for the protection of the rights of authors in their literary and artistic works."[16] Article 2 delineates the scope of protected works;[17] Article 3 outlines the criteria for eligibility for copyright protection.[18] Article 5 of the agreement accords foreign authors national treatment in the member states and eliminates compliance with formalities as a condition of copyright protection;[19] Article 7 establishes the duration of the term of copyright protection.[20] The remaining articles outline the exclusive rights granted to authors under the Convention—translation,[21] reproduction,[22] public performance/broadcasting,[23] and adaptation.[24]

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tional treatment for foreign authors, translation rights, and infringement proceedings. *See id.* at 51-78.

13. Represented nations included Belgium, France, Germany, Haiti, Italy, Japan, Liberia, Spain, Switzerland, Tunisia, the United Kingdom, and the United States. *Id.* at 79. The delegates from the United States and Japan served only as unofficial observers to the Convention. *Id.* Japan, however, became a party to the convention on July 15, 1899. *Id.* at 79 n.215.

14. *See supra* note 1.

15. For a detailed account of the development of the Berne Convention between 1886 and 1971, see *id.* at 81-125, and sources therein cited.

16. Berne Convention, *supra* note 1, art. 1, *reprinted in* WIPO at 177.

17. *Id.* art. 2, *reprinted in* WIPO at 177-79.

18. *Id.* art. 3, *reprinted in* WIPO at 179-80.

19. *Id.* art. 5, *reprinted in* WIPO at 181-82.

20. *Id.* art. 7, *reprinted in* WIPO at 183-85.

21. *Id.* art. 8, *reprinted in* WIPO at 185.

22. *Id.* art. 9, *reprinted in* WIPO at 185.

23. *Id.* art. 11, *reprinted in* WIPO at 186-88.

24. *Id.* art. 12, *reprinted in* WIPO at 188.

III. The Retroactivity Principle

A. *General Doctrine of Retroactivity*

When one state concludes a copyright agreement with another state, it is clear that the works created or published in either state after the effective date of the agreement will be protected in both states pursuant to the treaty. When, however, works created or published prior to the effective date of the agreement are afforded copyright protection in one state and not the other, problems may arise regarding the recapture of those preexisting works out of the public domain of the other state. This is particularly true when individuals in one state have invested time, money, and effort into exploiting the works of another state's authors in the absence of any legal duty not to do so, or when the term of copyright protection afforded to the works of one state's authors has expired in the other state. Although the exploiting individuals arguably are benefiting from the creative efforts of the authors and should not be entitled to have their interests protected, some scholars emphasize that these persons "have nonetheless acted in good faith in reliance on a given state of affairs, namely that these works were in the public domain and could be used freely."[25]

The retroactivity doctrine seeks to achieve a balance between the newly acquired copyright protection accorded the authors of one state and the reliance interests of previous exploiters of those works in the other state. At a minimum, the doctrine creates a temporary time period during which prior exploiters may continue to use the work to recoup some or all of their investments, after which time the copyright owners are afforded full and exclusive protection under the terms of the Convention.[26]

B. *Development of the Retroactivity Principle Within the Berne Convention*

The Berne member states generally agreed that some measure of retroactive protection was necessary to effectuate the goal of global copyright protection. The extent of this protection, however, was the subject of considerable debate among the contracting states. At the 1883 ALAI Conference at Berne, the represented states adopted a proposal that provided full retroactive protection for works that had "not yet fallen into

25. Ricketson, *supra* note 5, at 665.
26. *Id.* at 666.

the public domain, in the country of origin[27] of the work, at the moment the said Convention enter[ed] into force."[28] Under this proposal, works still protected in the country of origin at the time that state became a party to the Convention would be recaptured out of the public domain and protected anew in all other Berne member states, regardless of the reliance of exploiting individuals in those states. At the 1884 Conference, however, the retroactivity clause underwent amendment to render the grant of full retroactive protection "subject to the reserves and conditions to be determined by common agreement."[29] This common agreement was to be embodied in reservations and stipulations to transitional provisions in special conventions concluded by the member states or in domestic legislation of those states.[30] By retaining control over the implementation of the retroactivity principle, Berne member states could ensure protection of the reliance interests of their respective nationals.

The 1885 Berne Conference accepted the retroactivity principle, as limited by the 1884 amendment, following assurances from the German delegate and the president of the Conference that "the draft convention did not recognise [sic] retrospectivity properly speaking and did not injure the interests of anyone."[31] The Commission report reiterated this sentiment, providing that "the carrying into effect of [the retroactivity principle] is left to each country of the Union which is to determine the conditions of retroactivity according to its own laws or specific conventions."[32] The final provision, which became article 14 of the original

27. *See* Berne Convention, *supra* note 1, art. 5(4), *reprinted in* WIPO at 181. According to this article, the country of origin of a work is 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.

Id.

28. RICKETSON, *supra* note 5, at 667 (quoting Draft Convention, art. 8, *in* ACTES 1884, *supra* note 12, at 8).

29. *Id.* (quoting ACTES 1884, *supra* note 12, at 59).

30. *Id.*

31. *Id.* at 668 (quoting ACTES DE LA 2ME CONFÉRENCE INTERNATIONALE POUR LA PROTECTION DES OEUVRES LITTÉRAIRES ET ARTISTIQUES RÉUNIE À BERNE DU 7 AU 18 SEPTEMBRE 1885 36 (1885) [hereinafter ACTES 1885]).

32. *Id.* (quoting ACTES 1885, *supra* note 31, at 52).

Berne Convention text, read as follows: "Under the reserves and conditions to be determined by common agreement, the present 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."[33]

In the years following the entry into force of the 1886 Berne Convention, authors and publishers throughout the member states began to advocate the abrogation of the reserves and conditions provision of article 14.[34] Because the clause was inserted only as a temporary measure to protect the reliance interests of exploiting individuals until they could recoup their investments, authors argued that, as time passed, the need to protect these reliance interests necessarily must give way to the exclusive rights of the copyright owners.[35] In response to these requests, the French government, in its agenda for the Paris Revision, recommended the elimination of the reserves and conditions provision in all cases except with regard to states newly acceding to the Berne Convention.[36] Furthermore, if a state had failed to adopt transitional measures to protect the reliance interests of its nationals within a year after its accession, the French proposal included a presumption that the acceding state forfeited the opportunity to adopt these measures in favor of the "pure and simple application of [a]rticle 14."[37]

Although some member states approved the French proposal,[38] several other key states, including Britain, rejected the proposed revisions on the ground that, "despite the lapse of time, absolute retroactivity might still injure 'legitimate interests.' "[39] The continued concern about the reliance

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33. *Id.* With regard to the common agreement, paragraph 4 of the Closing Protocol stated:

> 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 stipulations contained in special Conventions existing, or to be concluded, to that effect. In the absence of such stipulations 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.

Id. at 668-69.

34. *Id.* at 669.

35. *Id.*

36. *Id.* (citing ACTES DE LA CONFÉRENCE DE PARIS DE 1896 45-46 [hereinafter ACTES 1896]).

37. *Id.* (quoting ACTES 1896, *supra* note 36, at 46).

38. *Id.* The most significant support for the French proposal came from Belgium and from the French government itself. *Id.*

39. *Id.* (quoting ACTES 1896, *supra* note 36, at 174). The primary opposition came from the German and British delegates. *Id.*

interests of domestic exploiters of foreign works caused the reserves and conditions provision of article 14 to remain in place. The most significant aspect of the Paris Revision concerning article 14 was an addition that specifically applied the retroactivity principle to new accessions to the Berne Union.[40]

C. *Article 18 and the Modern Retroactivity Principle*

1. General Provisions

Despite continued efforts by the ALAI to abolish the reserves and conditions provision, the lack of substantial change in article 14 afforded the Berne member states considerable leeway in protecting the reliance interests of their nationals at the expense of foreign authors and copyright owners. At the Berlin Conference of 1908, article 14 was consolidated into the new article 18.[41] Subsequent revisions of the Convention, however, have retained the power of the respective states to control the application of the retroactivity doctrine. Today, article 18 of the Berne Convention, which embodies the retroactivity principle, provides:

> (1) This Convention shall apply to all works which, at the moment of its coming into force,[42] have not yet fallen into the public domain in the country of origin[43] through the expiry of the term of protection.
> (2) If, 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.
> (3) The application of this principle 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

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40. *Id.* at 669-70. The need for this additional clause of article 14 became increasingly clear, as four states adhered to the Berne Convention between 1886 and the 1896 Paris Revision: Luxembourg (1888), Monaco (1889), Montenegro (1893), and Norway (1896). *Id.* at 670 & n.28.

41. *Id.* at 670 (citing ACTES DE LA CONFÉRENCE DE BERLIN 1908 268 (report of Renault) [hereinafter ACTES 1908]; and S.P. LADAS, THE INTERNATIONAL PROTECTION OF LITERARY AND ARTISTIC PROPERTY 348-52 (1838)).

42. With regard to states already parties to earlier Acts of the Berne Convention, the Convention generally is found to come into force within a time certain after that state's ratification of a succeeding act or revision, or upon the occurrence of a certain event. *See id.* at 672. For states not parties to an earlier Berne Act, the Convention generally is deemed to come into force within a specified period after formal accession to the treaty. *Id.*

43. *See* Berne Convention, *supra* note 1, art. 5(4), *reprinted in* WIPO at 181-82; *see also supra* note 27.

conditions of application of this principle.
(4) The preceding provisions shall also apply in the case of new accessions to the Union and to cases in which protection is extended by the application of Article 7 or by the abandonment of reservations.[44]

2. Expiry of the Term of Protection

Prior to 1886, the degree of copyright protection afforded authors of any given state was limited to specific grants under the legislation of their country of origin and to whatever protection may have been included in bilateral treaties between their country of origin and other states.[45] Extension of copyright protection to works previously unprotected in many Berne member states, because of the absence of domestic copyright laws or bilateral copyright agreements, therefore, was a primary objective of the Berne Convention.[46] If the Convention had not extended the scope of protection in this manner, it likely would have been of very limited significance in 1886, serving only to extend the term of copyright protection of works already protected under domestic laws or other agreements.[47] Paragraphs (1) and (2) of article 18 accomplished this goal of affording international copyright protection to previously unprotected works. These paragraphs have been construed as follows: a work may be removed from Berne Convention protection if, and only if, that work has fallen into the public domain " 'through the expiry of the term of protection' both in the protecting country and in its country of origin."[48] By providing for only one manner through which works could fall into the public domain, the member states ensured that works not previously protected by treaty, as well as those not in compliance with domestic copyright formalities, would remain entitled to the full range of Berne Convention protection.[49]

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44. Berne Convention, *supra* note 1, art. 18, *reprinted in* WIPO at 193.

45. *See* Paul E. Geller, *International Copyright: An Introduction*, *in* 1 INTERNATIONAL COPYRIGHT LAW AND PRACTICE § 4[3][a][i] (Melville B. Nimmer & Paul E. Geller eds., 1990).

46. *Id.*

47. *Id.*

48. Paul E. Geller, *Copyright Protection in the Berne Union: Analyzing the Issues*, 13 COLUM.-VLA J.L. & ARTS 435, 452 (1989). This general principle applies to both unpublished works and works first published before the Berne Convention enters into force in that state. RICKETSON, *supra* note 5, at 671.

49. Article 18 "clearly excludes other cases where a work might have fallen into the public domain, for example, because of failure to comply with the formalities required under the law of the country of origin." RICKETSON, *supra* note 5, at 671 (citing ACTES 1908, *supra* note 41, at 268; and LADAS, *supra* note 41, at 349). When this situation

The general concept of retroactive copyright protection, embodied in the first two paragraphs of article 18, has not been particularly problematic for existing members of the Berne Union. This principle, however, may prove troublesome in the case of the United States accession to the Convention in 1989. Similarly, other states considering adherence to the present text of the Berne Convention, particularly the People's Republic of China, may face problems regarding this aspect of article 18. These potential problems are addressed at length in Sections IV and V.

3. Provisions Contained in Special Conventions

While paragraphs (1) and (2) of article 18 sought to recapture as many works as possible from the public domain and sweep them into Berne Convention protection, paragraph (3) retained for the Berne member states the freedom (and the power) to protect the reliance rights of their nationals. Similar to its precursor, the reserves and conditions clause of the previous article 14, the first clause of paragraph (3) has been construed to authorize member states to enter into bilateral agreements among themselves to condition or limit the application of the retroactivity doctrine. In the relationships between existing Berne member states, however, these bilateral arrangements are no longer needed.[50] This is because article 7, paragraph (8) of the Convention,[51] embodying the so-called rule of the shorter term, covers all cases in which varying terms of protection exist in the country of origin and the protecting state.[52] According to this provision, when the term of copyright protection afforded authors under the domestic legislation of the country of origin is shorter than that afforded under the legislation of the protecting state, the term of the state of origin (the shorter term) applies. In no case, however, may the term of protection granted constitute less than the life of the author plus fifty years.[53] Because article 7 now governs all situations relating to the duration of copyright protection, all agreements between existing Berne member states in this regard have expired.[54] Consequently, the primary significance of paragraph (3) of acticle 18 lies in the second clause of that subsection, as discussed below.

occurs, the copyright owner still may claim full and exclusive protection for the work in other Berne member states under the terms of the Convention. *Id.*

50. *See* WILHELM NORDEMANN ET AL., INTERNATIONAL COPYRIGHT AND NEIGHBORING RIGHTS LAW 162 (R. Livingston trans., 1990).

51. Berne Convention, *supra* note 1, art. 7(8), *reprinted in* WIPO at 184.

52. NORDEMANN, *supra* note 50, at 162.

53. Berne Convention, *supra* note 1, art. 7(1), *reprinted in* WIPO at 183.

54. NORDEMANN ET AL., *supra* note 50, at 162.

If no bilateral agreements are concluded between existing Berne member states, the second clause of paragraph (3) reserves for the respective member states the right to prescribe in their domestic legislation the manner in which the retroactivity principle will be applied to their own nationals. Parties to the Berne Convention have used this provision of article 18 widely to dictate the scope of the retroactive protection and to preserve the reliance rights of domestic exploiters of foreign works. For example, the copyright law of the United Kingdom, although providing for retroactive protection, contains a provision concerning reliance rights under which persons incurring "expense or liability in preparing acts of exploitation not actionable before adherence . . . [are] entitled to compensation for such reliance subject to arbitration, or such acts are not actionable subsequent to adherence."[55]

More recently, Germany utilized its authority under paragraph (3) to regulate retroactivity within its new borders. Prior to the unification treaty of August 31, 1990, authors in the German Democratic Republic received copyright protection for their lifetime plus fifty years, the minimum granted by the Berne Convention.[56] In the Federal Republic of Germany, the term of copyright protection extended for the life of the author plus seventy years.[57] When the Federal Republic of Germany and the German Democratic Republic became one state on October 3, 1990, the treaty of unification expressly provided that the copyright law of the Federal Republic would govern in the unified Germany.[58] If the term of copyright protection granted under the law of the Federal Republic had not yet expired, retroactive protection was granted to all works with terms that, under the copyright law of the German Democratic Republic, already had expired by the time of the unification.[59] A provision in the unification treaty protecting the reliance rights of individuals accompanied this twenty year extension of protection for all East German works. Parties who had begun exploiting works that had fallen into the public domain in the German Democratic Republic prior to July 1, 1990 could continue to exploit them provided that they adequately compensated the copyright owners for their use of the works.[60]

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55. Geller, *supra* note 45, § 4[3][a][i], at 120 n.517.2.

56. Adolf Dietz, *Federal Republic of Germany*, *in* INTERNATIONAL COPYRIGHT LAW AND PRACTICE § 3[2][d] (Melville B. Nimmer & Paul E. Geller eds., 1990).

57. *Id.* § 3[1][a].

58. *Id.* § 1[2].

59. *Id.* § 3[2][d].

60. *Id.*

4. New Accessions to the Union

Paragraph (4) of article 18 specifically provides that when a state becomes a new party to the Berne Convention, retroactive protection shall be granted to works that have the newly adhering state as their country of origin and have not yet fallen into the public domain through the expiration of the term of protection.[61] Accordingly, works that previously may have been in the public domain in Berne member states for reasons other than the expiry of the term of protection (for example, because of the absence of a legal obligation, under domestic copyright law or a bilateral treaty agreement, to protect the foreign works) will become entitled to the full range of Berne protection beginning on the day the accession becomes effective.[62] At the same time, works of authors of existing Berne member states that may have been in the public domain of the newly acceding state for reasons other than the expiry of the term of protection will become entitled to protection in the newly joining state.[63] Although this reading of article 18 may prove disturbing for individuals in the various states who have relied upon the absence of any legal duty not to exploit previously unprotected works, the reserves and conditions clause authorizes the governments of the respective states to protect temporarily these reliance interests. This issue is discussed in greater detail in Sections IV and V.

IV. The Berne Convention and the United States

The United States adherence to the Berne Convention culminated decades of heated debate and discussion. Prior to 1989, United States participation in the Convention was considered highly unlikely because of congressional unwillingness to make the modifications to domestic copyright law deemed necessary for adherence. In particular, United States copyright law directly conflicted with the Convention in two primary respects. First, the notice, deposit, registration, recordation, and renewal requirements of the 1909 and 1976 United States Copyright Acts[64] conflicted with article 5 of the treaty, which provides that "[t]he enjoyment

61. Berne Convention, *supra* note 1, art. 18(4), *reprinted in* WIPO at 193. The Universal Copyright Convention provides for a different result. It excludes from retroactive protection any works unprotected on the date the new accession becomes effective. NORDEMANN ET AL., *supra* note 50, at 163.

62. NORDEMANN ET AL., *supra* note 50, at 162; *see also* Berne Convention, *supra* note 1, art. 29(2)(a), *reprinted in* WIPO at 206.

63. NORDEMANN ET AL., *supra* note 50, at 162.

64. Copyright Act of 1909, §§ 10, 11, and 13; Copyright Act of 1976, Pub. L. No. 94-553, §§ 304, 401, 1976 U.S.C.C.A.N. (90 Stat.) 2541, 2573-77 (prior to amendment).

and the exercise of [copyright] shall not be subject to any formality."[65] Compliance with the Berne Convention would have required the United States to eliminate all statutory formalities for the protection of literary and artistic works.[66] Second, the twenty-eight year period of copyright protection granted authors under the 1909 Act and retained under the 1976 Act for works published prior to January 1, 1978[67]—and even the fifty-six year period received upon proper renewal of copyright in those pre-1978 works[68]—did not conform with the Convention's requirement that all works be protected for the life of the author plus fifty years.[69]

To alter United States domestic law to comply with the mandates of the Berne treaty would have afforded both foreign and domestic authors a more readily attainable and longer term of protection than they received under existing law. This idea was at odds with Congress' perceived purpose of the United States copyright law, which was to grant authors minimum protection as an incentive for them to continue creating works.

When the United States finally adhered to Berne, Congress, to retain complete control over the manner in which the United States complied with the Convention, specifically declined to allow the treaty to be self-executing.[70] The Berne Convention Implementation Act (BCIA)[71] modi-

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65. Berne Convention, *supra* note 1, art. 5(2), *reprinted in* WIPO at 181; *see also Final Report of the Ad Hoc Working Group on U.S. Adherence to the Berne Convention*, 10 COLUM.-VLA J.L. & ARTS 513, 559, 565-66 (1986) [hereinafter *Ad Hoc Report*] (declaring sections 401, 405(a) and 205 (d) of the United States copyright law to be "incompatible with Berne").

66. *Ad Hoc Report*, *supra* note 65, at 572 (Under the Berne Convention, a state "cannot make registration, recordation or deposit a precondition to the enjoyment or exercise of copyright").

67. Copyright Act of 1909, *supra* note 64, § 24 ("The copyright secured by this title shall endure for twenty-eight years from the date of first publication."); Copyright Act of 1976, *supra* note 64, § 302, 1976 U.S.C.C.A.N. at 2572-73.

68. Copyright Act of 1909, *supra* note 64, § 24 (allowing in some cases for the proprietor of a copyright to obtain "a renewal and extension of the copyright in such work for the further term of twenty-eight years"); Copyright Act of 1976, *supra* note 64, § 304, 1976 U.S.C.C.A.N. at 2573-76.

69. Berne Convention, *supra* note 1, art. 7(1), *reprinted in* WIPO at 183.

70. 133 CONG. REC. S 18408, 18410 (daily ed. Dec. 18, 1987) (sectional analysis of S.1971, submitted by Sen. Hatch and Sen. Thurmond) ("Section 2(a)(1) unequivocally states that the Berne Convention is not a self-executing treaty under the laws and Constitution of the United States. Section 2(a)(2) underscores the fact that, therefore, the United States' [sic] obligations under the Berne Convention can be satisfied only by the provisions of domestic law."); *see also Copyright Conference Examines Berne, Registration, and Deposit Requirements*, 37 Pat. Trademark & Copyright J. (BNA) 596 (Apr. 6, 1989); *Ad Hoc Report*, *supra* note 66, at 597 ("If ratified by the United States, the

fied United States domestic copyright law to comply with the minimum requirements of the Convention. For works created after March 1, 1989 (the date upon which the treaty entered into force in the United States), notice and registration of copyright are no longer prerequisites for protection. As the statute now reads, "[w]henever a work protected under this title is pubished in the United States . . . a notice of copyright *may* be placed on publicly distributed copies."[72] Furthermore, "[s]uch registration is not a condition of copyright protection."[73]

The enactment of these provisions into United States copyright law "make[s] it less likely that works first created after March 1, 1989 will unwittingly fall into the public domain in the future."[74] Consequently, the difficulties that may follow United States adherence to the Berne Convention are not the result of actions taken by the Congress in the BCIA, but rather are based upon what Congress refused to do. First, it declined to eliminate compliance with formalities as a prerequisite to copyright protection for all works created prior to March 1, 1989.[75] Similarly, Congress retained the renewal requirement for these works.[76] Fi-

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Berne Convention would not be a self-executing treaty in this country. The protection it stipulates for authors and their successors could only be enforced here to the extent provided by existing U.S. law or by further legislation Congress enacted to implement ratification of the Convention.").

71. *See supra* note 2.

72. 17 U.S.C. § 401(a) (1988) (emphasis added).

73. 17 U.S.C. § 408(a). Congress, however, eliminated only those formalities that were prerequisite to obtaining copyright protection; it did not eliminate other formalities. *See* David M. Spector, *Implications of United States Adherence to the Berne Convention*, 17 AIPLA Q.J. 100, 113 (1989) ("[the BCIA] maintains the requirement of registration prior to the filing of an infringement action for all works except those whose 'country of origin' is a foreign nation adhering to the Berne Convention."). Unlike United States citizens, foreign nationals of states adhering to the Berne Convention are not required to register their copyrights before initiating a lawsuit for infringement. BCIA, *supra* note 2, § 9(b)(1), 102 Stat. at 2859.

Congress also included in the BCIA certain incentives to encourage authors to record their copyrights: "[F]or example, a registration certificate continues to be given prima facie weight in establishing the existence of a valid copyright in infringement litigation. Also, the recovery of statutory damages and attorney's fees from an infringing defendant remains available only in cases involving timely registered works." Spector, *supra*, at 114-15 (citing 17 U.S.C. §§ 410(c), 412).

74. Spector, *supra* note 73, at 118.

75. Jon A. Baumgarten & Christopher A. Meyer, *Effects of U.S. Adherence to the Berne Convention*, 37 Pat. Trademark & Copyright J. (BNA) 462, 464-67 (Mar. 9, 1989).

76. *Id.* at 467. It should be noted, however, that at the time of the writing of this Note, a bill is before Congress that, if passed, would provide for "automatic renewal of copyright in works eligible for renewal between the years 1991 and 2005." 137 CONG.

nally, and perhaps most troublesome, it refused to grant any retroactive copyright protection whatsoever to works created prior to March 1, 1989.[77]

A. *Problems Relating to the Retention of Formalities*

Congressional retention of the formality and renewal requirements for works created prior to the United States accession to Berne is likely to be problematic for both United States nationals and foreign authors. As previously discussed, the Berne Convention has been construed to allow for only one method by which a work could fall outside the scope of Berne protection—upon the "expiry of the term of protection."[78] For United States works created prior to March 1, 1989, however, three ways remain by which works can fall into the United States public domain. First, a work may fall into the public domain immediately upon creation if the author failed to comply with the statutory formalities required by the 1909 Copyright Act[79] or failed to cure the noncompliance within the period specified in the 1976 Copyright Act.[80] Second, a work may fall into the public domain immediately following the first twenty-eight year period of protection if the author, the author's assignee, or the author's statutorily prescribed heirs failed to renew the copyright as required under both the 1909 and 1976 Acts.[81] Third, a work may fall into the public domain upon the expiration of both the first term and the properly renewed second term. Officials in existing Berne member states must consider these facts in determining the degree of copyright protection their governments will afford the works of United States authors.

REC. H 11257, 11260 (daily ed. Nov. 25, 1991) (statement by Rep. Hughes concerning the Copyright Amendments Act of 1991). By abolishing the existing mandate that owners of works copyrighted before January 1, 1978 file a renewal of registration with the Copyright Office to get a second term of protection, the bill would alleviate at least some of the potential for technical forfeiture of copyright presently faced by owners of works registered under the Copyright Act of 1909 and still in their first term of protection.

77. 133 CONG. REC., *supra* note 70, at S 18410 (sectional analysis of S.1971, submitted by Sen. Hatch and Sen. Thurmond) ("Section 2(a)(3) title 17 does not confer copyright protection on any work that is in the public domain in the United States, thus making it clear that neither adherence to the Berne Convention nor the changes to title 17 made by this Act will provide retroactive copyright protection in the United States."); *see also* Geller, *supra* note 45, § 4[3][a][ii].

78. *See* Berne Convention, *supra* note 1, art. 18, *reprinted in* WIPO at 193; *see also* discussion *supra* part III.C.2.

79. *See* Copyright Act of 1909, *supra* note 64, §§ 10, 11, and 13.

80. *See* 17 U.S.C. § 405(a).

81. As stated previously, however, a bill is presently before Congress that, if passed, would eliminate this second scenario. *See supra* note 76.

As previously stated, paragraph (4) of article 18 provides that when a state becomes a new party to the Berne Convention, retroactive protection shall be granted to works that have the newly adhering state as their state of origin and that have not yet fallen into the public domain through the expiry of the term of protection.[82] The question to be determined, then, is whether a United States author's failure to comply with formalities or to renew as required under United States law is tantamount to an "expiry of the term of protection" thus nullifying the obligation of existing Berne member states to recapture the United States work from their public domain and to afford the work the full range of Berne Convention protection.[83]

One scholar has postulated that a literal reading of article 18 "clearly excludes other cases where a work might have fallen into the public domain, for example, because of failure to comply with the formalities required under the law of the country of origin."[84] If this postulation prevails, the result will be an anomalous situation in which United States authors, as well as foreign authors first publishing in the United States, may claim full and exclusive protection for their works in other Berne states while having forfeited entitlement to copyright protection in the United States.

Other scholars have observed that "Article 18(3) gives each member country the right to determine the conditions for application of the general rule of Article 18 within its own borders. Presumably, Berne members will be hesitant to extend copyright protection to United States works which have fallen into the public domain in the United States itself prior to March 1, 1989, regardless of the reason for loss of United States copyright protection."[85] In the absence of immediate action by United States lawmakers to resolve this uncertainty, United States au-

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82. Berne Convention, *supra* note 1, art. 18(4), *reprinted in* WIPO at 193. The Universal Copyright Convention provides for a different result by excluding from retroactive protection, any works unprotected on the date the new accession becomes effective. Universal Copyright Convention, Sept. 6, 1962, art. VII, 6 U.S.T. 2731, 2740; *see also* NORDEMANN ET AL., *supra* note 50, at 163.

83. In many existing Berne member states, a large number of works already will be protected from the public domain because of obligations set by other bilateral and multilateral treaties to which the United States is a party. These treaties include the Universal Copyright Convention, adhered to by the United States in 1952. Universal Copyright Convention, *supra* note 82, 6 U.S.T. at 2731.

84. RICKETSON, *supra* note 5, at 671; *see also* Spector, *supra* note 73, at 118.

85. Spector, *supra* note 73, at 117. The most compelling incentive, of course, for existing Berne members to deny this protection to United States works is the unwillingness of the United States to grant reciprocal treatment to the works of foreign Berne authors. *See infra* part IV.

thors, in addition to being subject to technical forfeiture of copyright in their own state, may be unable to take advantage of article 18 to gain copyright protection for their works abroad. This result clearly defeats the purpose for which the United States joined the Berne Convention—to gain increased international protection for both existing and future United States works.

The problem articulated above is exacerbated because individual authors subjected to technical forfeiture of copyright in the United States under the 1909 and 1976 Acts are virtually powerless to challenge through legal action Congress' retention of these formalities. This situation is the unfortunate result of several factors.

Because a treaty is, by definition, "primarily a contract between two or more independent nations,"[86] only the states themselves may bring action in an international tribunal challenging the denial of rights guaranteed under the treaty.[87] Accordingly, in the absence of state officials' willingness to take up the cause of their nationals in a lawsuit before an international court, private parties are limited only to causes of action available within the national court systems of the various Berne member states.

Relief for private parties attempting to challenge Congress' retention of formalities within the United States federal court system is an unlikely, if not impossible, prospect. Because the Berne Convention is not a self-executing treaty in the United States, authors who first published their works in the United States must look to the implementing legislation [the BCIA], rather than the terms of the Convention, to ascertain their rights.[88] Although the courts of the United States, like all other courts, will attempt to construe an act of Congress as consistent with a provision of a treaty,[89] "if the two are inconsistent, the one last in date

86. Whitney v. Robertson, 124 U.S. 190, 194 (1888).

87. *See* Geller, *supra* note 45, § 3[4], at 68 ("Only national courts ultimately decide international copyright cases between private parties.").

88. "When the stipulations [of a treaty] are not self-executing they can only be enforced pursuant to legislation to carry them into effect." *Whitney*, 124 U.S. at 194. Accordingly, authors who lost copyright protection in the United States because of failure to comply with notice or renewal requirements may not rely directly upon article 5(2) of the Berne Convention, but may bring suit only to enforce their rights under the provisions of the BCIA.

89. "By the Constitution a treaty is placed on the same footing, and made of like obligation, with an act of legislation. Both are declared by that instrument to be the supreme law of the land, and no superior efficacy is given to either over the other. When the two relate to the same subject, the courts will always endeavor to construe them so as to give effect to both, if that can be done without violating the language of either." *Id.*

will control the other."[90] Based upon this rule, a United States federal court probably would find Congress' retention of formalities in the BCIA, enacted after the United States adherence to Berne, to be controlling over the language of acticle 5.

In sum, the retention of formalities in the BCIA most likely will not be struck down as the result of a private action brought in a United States court. That a foreign government would pursue action in an international tribunal solely to challenge the United States retention of formalities as inconsistent with article 5 of the Berne Convention is similarly improbable. These governments, however, probably will incorporate their objections to the formality requirement into the much larger context of a lawsuit questioning the validity of the United States denial of retroactive protection to foreign Berne works pre-existing the date of United States adherence to the Convention.

B. *Problems Relating to the Denial of Retroactivity*

The BCIA specifically "does not confer copyright protection on any work that is in the public domain in the United States, thus, making it clear that neither adherence to the Berne Convention nor the changes to title 17 made by [the BCIA] will provide retroactive copyright protection in the United States."[91] As justification for this complete denial of retroactivity, Congress appears to rely upon the long-controversial third clause of article 18. As one member of Congress has stated: "[T]here seems to be general agreement among those who have examined the question that [a]rticle 18 of the Berne Convention leaves considerable scope to national discretion in dealing with the retroactive protection of the convention."[92] Other legislators have referred to the question of retroactivity as a matter to be determined following, rather than contemporaneously with, adherence to the Berne Convention: "[W]hile Berne contemplates retroactive protection for some foreign works that are in the public domain. . . . [R]etroactivity under Berne appears to establish a 'principle' whose application can be dealt with after a country's adher-

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90. *Id.*; *see also* LOUIS HENKIN ET AL., INTERNATIONAL LAW: CASES AND MATERIALS 164 n.2 (2d ed. 1980) ("Where a treaty and an act of Congress are wholly inconsistent with each other and the two cannot be reconciled, the courts have held that the one later in point of time must prevail." (quoting Memorandum by Secretary of State Charles E. Hughes (Oct. 8, 1921)).

91. 133 CONG. REC., *supra* note 70, at S 18410.

92. 133 CONG. REC. H 1293, 1296 (daily ed. Mar. 16, 1987) (statement by Rep. Kastenmeier).

ence to the [C]onvention."[93]

In addition to offering the rationale articulated above,[94] the Report of the Ad Hoc Working Group on U.S. Adherence to the Berne Convention, although making no official recommendation on the issue, outlines three other possible bases for the complete denial of retroactive protection.[95] One asserted justification is article 7, paragraph (8) of the Berne Convention, which states that "[i]n any case, the term [of protection] shall be governed by the legislation of the country where protection is obtained."[96] Under this theory, some scholars argue that "the 'term' of protection in the forum country—the U.S.—may be 'zero.' "[97] An international tribunal considering the BCIA in light of the spirit and context of the Berne Convention, however, most likely would not find this argument to be particularly persuasive.

A second possibility suggested by the report is that the United States might rely upon the first clause of article 18, paragraph 3, which renders the utilization of article 18, paragraph 1 "subject to any provisions contained in special conventions . . . between countries of the Union."[98] Proponents of this view claim that the Universal Copyright Convention, which clearly excludes retroactive protection for works in the public domain of the state in which protection is sought,[99] constitutes a "special convention" sufficient to justify a member state's deviation from the literal language of article 18.[100] As observed by the report, however, an effective argument is that article 20 of the treaty nullifies the viability of this second possibility because it requires that any special agreements either "grant more extensive rights than the Convention or . . . at least not be contrary to the Convention."[101]

Finally, the report refers to an interesting argument postulated at a

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93. 132 CONG. REC. S 14508, 14509-10 (daily ed. Oct. 1, 1986) (statement by Sen. Mathias).

94. *Ad Hoc Report, supra* note 65, at 593 ("[U]nder the second sentence of Article 18(3), countries are left to 'determine, each insofar as it is concerned,' the conditions under which retroactivity is to be applied. The exact scope of discretion given by this clause is uncertain.")

95. *Id.* at 592-94.

96. Berne Convention, *supra* note 1, art. 7(8), *reprinted in* WIPO at 184.

97. *Ad Hoc Report, supra* note 65, at 594.

98. Berne Convention, *supra* note 1, art. 18(3), *reprinted in* WIPO at 193.

99. *See* Universal Copyright Convention, *supra* note 82, art. VII, 6 U.S.T. at 2740, which states that the protection of the treaty "shall not apply to works or rights in works which, at the effective date of this Convention in a Contracting State where protection is claimed, are permanently in the public domain in the said Contracting State."

100. *Ad Hoc Report, supra* note 65, at 593.

101. *Id.* at 593 n.22.

June 1978 meeting of advisors from the World Intellectual Property Organization at which the concept of retroactivity was discussed.[102] The Ad Hoc Committee sets forth the following argument:

> [P]rior to January 1, 1987, all *unpublished* works were protected in the United States under the common law without regard to nationality. Therefore, there was a 'term of protection which was previously granted' to all such works that 'expired' at the moment they were published without complying with U.S. formalities, manufacturing provisions, or national eligibility requirements. Under this theory, the retroactivity principle would not require the recapture of *any* works from the U.S. public domain. . . . [I]f the U.S. interprets Article 18(2) in this manner, any inconsistency between current United States law and the Berne Convention with respect to retroactivity would be effectively removed.[103]

Despite the creativity of this argument, the Ad Hoc Committee notes at least an informal suggestion by scholars considering the issue that "the history of the Berne Convention and at least the implicit focus of international agreements on the protection of published works do not support this theory."[104]

An additional rationale asserted by both Congress and the Ad Hoc Report for the denial of retroactive protection appears to be based upon the United States Constitution. Proponents of this argument assert that once a work has fallen in the public domain in the United States, the public acquires a property right in the use of the work. This right, in their view, cannot be withdrawn from the public without due process of law. As one member of Congress has stated: "[B]ecause the public domain is precisely what it says it is—the common property of the people to use as they see fit, in or out of commerce—I am strongly disinclined to restore control over this heritage to proprietary interests."[105] These considerations have led United States legislators to reject uniquivocally a blanket grant of retroactivity to foreign works, promising only that if needed, "the means to establish it could be developed on a case-by-case

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102. *Id.* at 592.

103. *Id.* (emphasis in original) (footnote omitted).

104. *Id.*

105. 133 CONG. REC., *supra* note 92, at H 1293 (statement by Rep. Kastenmeier); *see also* 132 CONG. REC., *supra* note 93, at S 14510 (statement by Sen. Mathias):

> [T]he legal dimensions of retroactive application of Berne requires [sic] careful analysis, including a sensitivity to constitutional considerations. Arguments have been advanced which would relieve [Congress] of any obligation to accord retroactive application to foreign works in the public domain. They should be reassessed.

Id.

basis."[106]

The view that withdrawing a work from the public domain violates the United States Constitution may find additional support in the case of *United Christian Scientists v. Christian Science Board of Directors.*[107] In that case, the United States Congress enacted legislation granting copyright protection to a certain work authored by Mary Baker Eddy.[108] As a consequence of this legislation, editions of the work that had previously entered the public domain were to be resurrected and protected anew for a period of seventy-five years.[109] The plaintiffs, United Christian Scientists, brought suit challenging the law on the grounds that its passage violated the Establishment Clause of the First Amendment and the Copyright clause of article I, section 8 of the United States Constitution [which provides that literary and artistic works be given protection "for a limited time" only].[110] The district court hearing the case struck down the law as at odds with the Establishment Clause and thus did not reach the copyright clause issue.[111] At least one scholar analyzing the case, however, has labelled the law "manifestly unconstitutional," and has hypothesized that such a law would violate both the Copyright Clause and the First Amendment to the United States Constitution.[112]

The foregoing arguments might be sufficient domestically in light of the problems preventing authors from testing the validity of the BCIA in the United States courts. It is unlikely, however, that this reasoning would withstand the scrutiny of an international tribunal presented with the issue by a foreign state asserting its rights under the Berne Convention. Articles 27*bis* and 33(1) of the Berne Convention have been construed to "allow or, in some cases, require the International Court of Justice to rule on disputes between adhering countries regarding the 'interpretation or application' or the [C]onvention . . . ."[113] These provisions authorize Berne member states to bring suit against the United

106. 132 CONG. REC., *supra* note 93, at S 14510 (statement by Sen. Mathias).

107. 616 F. Supp. 476 (D.D.C. 1985).

108. *Id.* at 476-77.

109. *Id.* at 477.

110. *Id.* at 476.

111. *Id.*

112. *See* Melville B. Nimmer & David Nimmer, *Constitutional Aspects of Copyright, in* THE LAW OF COPYRIGHT, § 1.05[A], at 1-36.3 n.7. As Professor Nimmer observes, Berne implementing legislation drafted by the United States Copyright Office "would have recaptured public domain works under specified circumstances. Implicitly, the staff of the Copyright Office thus believed such recapture to be constitutional." *Id.* § 1.05[B], at 1-36.5 n.13 (citation omitted).

113. Geller, *supra* note 45, § 1[1], at 8 n.9.

States for perceived violations of the Convention. In the context of this type of lawsuit, United States federal or constitutional law will not stand as a defense to United States noncompliance with the terms of the Convention: "Congress [by passing inconsistent legislation] has the power to violate treaties, but if they are violated, the Nation will be none the less exposed to all the international consequences of such a violation."[114] Accordingly, an international court will look to the propriety of the United States act solely as it relates to the terms of the treaty itself. In this context, the court will construe the treaty "in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose."[115]

Because the United States would not be entitled to assert constitutional arguments before the tribunal, the only serious remaining source of potential justification for United States denial of retroactivity is the reserves and conditions language of article 18, paragraph 3.[116] In this regard, the literal language of article 18, the stated objective of the Convention, and the overwhelming weight of scholarly authority from both the United States and abroad suggest that the position of the United States is untenable.

As one scholar has observed, "[T]here is no basis on which the principle of retroactivity can be completely denied. The conditions and reservations [authorized by clause (3) of article 18] can only be imposed on the 'application of the principle' . . . itself. Thus, it would not be permitted to deny retroactivity altogether in relation to a particular class or classes of works."[117] Most other prominent authorities considering the issue have reached a similar conclusion.[118] Indeed, this interpretation of article 18 appears to be the only one consistent with the Berne Convention's

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114. HENKIN ET AL., *supra* note 90, at 164 n.2 (quoting Memorandum by Secretary of State Charles E. Hughes (Oct. 8, 1921)); *accord* RESTATEMENT (THIRD) OF THE FOREIGN RELATIONS LAW OF THE UNITED STATES § 115(1)(b) (1987) ("[A] rule of international law or a provision of an international agreement is superseded as domestic law does not relieve the United States of its international obligation or of the consequences of a violation of that obligation.").

115. Vienna Convention on the Law of Treaties, May 23, 1969, art. 31(1), 1155 U.N.T.S. 331, 340.

116. RICKETSON, *supra* note 5, at 670-71.

117. RICKETSON, *supra* note 5, at 675.

118. *See* NIMMER & NIMMER, *supra* note 112, § 1.05[A], at 1-36.4 ("[T]he Berne Convention . . . nominally require[s] newly adhering states (such as the U.S.) to accord some retroactive protection to works that are still protected in their countries of origin, even if those works fall in the newly adhering state's public domain.") Accordingly, "we [the United States] would be on firmer ground had Congress chosen to attempt at least token resurrection of some Berne Convention works." *Id.* § 1.05[A], at 1-36.4 n.12.

stated objective of protecting the greatest possible number of literary and artistic creations. As Professor Nimmer has stated in his treatise on the law of copyright: "[A]t least the 'spirit' of the Convention required the United States, upon accession, to resurrect from the public domain at a minimum works of Berne provenance still protected in their countries of origin and not commercially exploited in the United States."[119]

Based upon these factors, an international tribunal probably would find that the United States denial of retroactivity violates its obligations under the Berne Convention. Such a ruling inevitably would contain a finding that article 18 requires the United States to follow the lead of certain existing Berne member states (such as Germany and the United Kingdom) and accompany a blanket grant of retroactivity with legislation consistent with the generally accepted application of the reserves and conditions provision in clause 3 of article 18, to protect temporarily the reliance rights of United States nationals.

By denying retroactive protection altogether, the United States, in effect, is enjoying the best of both worlds. United States nationals may continue to exploit the works of foreign Berne authors while their own works are being pulled out of the public domain and protected in all Berne states utilizing a traditional interpretation of article 18. This anomalous and unfair situation is unlikely to continue unchallenged. In addition, this position may prove to be particularly embarrassing politically for the United States in light of its historical tendency to advocate material reciprocity in other areas of intellectual property. For example, the United States Semiconductor Chip Protection Act of 1984[120] grants protection to the so-called mask works of foreign authors only upon a showing that the foreign state extends national or reciprocal protection to the works of United States nationals or domiciliaries.[121]

Assuming, however, that United States legislators remain unconvinced that their position will be detrimental to the long-term interests of the United States, an even more compelling reason exists for the United States to reconsider its stance on the application of the retroactivity principle. Although the existing members of the Berne Convention likely would not abandon their historical interpretations of article 18 in retaliation for the United States denial of protection, absolutely no reason exists

119. NIMMER & NIMMER, *supra* note 112, § 1.05[A], at 1-36.4.

120. Semiconductor Chip Protection Act of 1984, Pub. L. No. 98-620, § 301, 1984 U.S.C.C.A.N. (98 Stat.) 3347 (codified as amended at 17 U.S.C. § 901 (1988)).

121. 17 U.S.C. § 902(a)(2). Reciprocal treatment is determined by examining whether the foreign state affords protection to United States nationals and domiciliaries "on substantially the same basis as provided in [the SCPA]." *Id.* § 902(a)(2)(B).

why new adherents to the Convention could not rely upon the United States denial of retroactivity as precedent for a similar denial of protection in their own implementing legislation. For example, the People's Republic of China, deemed in 1989 to be one of the two most severe exploiters of United States works in the world, could adopt this position.[122] Because China never has been a party to a general copyright agreement, a great number of United States works presently exist in the Chinese public domain where they are subject to substantial exploitation by Chinese authors.[123] If China, upon adherence to the Berne Convention, should enact language in its domestic legislation denying retroactivity to the works of foreign authors, the vast majority of United States works would remain vulnerable to the whims of Chinese publishers.

V. THE BERNE CONVENTION AND THE PEOPLE'S REPUBLIC OF CHINA

The primary reason for China's nonadherence to the Berne Convention is the traditional refusal of the Chinese government to protect the literary and artistic works of its citizens. For example, China has not enacted any domestic copyright legislation and has not entered into bilateral or multilateral copyright agreements.

A. *History of Chinese Copyright Law Prior to the Communist Revolution*

Ironically, although China invented paper and printing techniques,[124] it has spent most of its long history without any form of protection for intellectual property. The first Chinese copyright law, the Law of Author's Rights of the Great Qing (Law of Qing), was issued in 1910 and consisted of five chapters addressing, respectively: general provisions, duration of protection, filing obligations, limitations on protection, and pen-

122. *Two Worst Copyright Pirates are China and Saudi Arabia, Report Says*, 37 Pat. Trademark & Copyright J. (BNA) 673, 673 (Apr. 27, 1998) (citing report by the International Intellectual Property Alliance). Labelling China one of "the most egregious violators of U.S. copyright laws," the report stated that China is one of twelve nations "responsible for $1.3 billion in lost U.S. sales annually." *Id.*

123. Even when Chinese nationals are obligated to protect United States works pursuant to private contract or clauses contained in a commercial trade or navigation treaties, the lack of effective enforcement mechanisms render these works extremely susceptible to exploitation by Chinese publishers. *See infra* part V.

124. Guo Shoukang, *China and the Berne Convention*, 11 COLUM.-VLA J.L. & ARTS 121, 122 (1986).

alties for infringement.[125] The author's rights, defined as "the exclusive advantages in copying works," were fairly extensive, covering "[l]iterature, painting, calligraphy, photography, sculpture and models," and endured for the lifetime of the author plus thirty years after death.[126] Persons infringing upon the rights of Chinese authors were required to pay a fine of up to four hundred silver dollars, compensate the authors for any injury sustained, and relinquish control of any instruments used to plagiarize the authors' works.[127]

The Law of Qing, which sought to grant extensive copyright protection to Chinese authors, was repealed one year after its issuance when the bourgeois revolution established the Republic of China.[128] In 1915, the new Chinese government promulgated its own copyright law, the Law of Author's Rights of the Northern Warlords (Law of the Warlords), which contained many of the same provisions for protection as the prior Law of Qing.[129] The Law of the Warlords remained in effect until the collapse of that government in 1928, at which time the statute was replaced by the Law of Author's Rights of the Kuomintang Government (Law of the Kuomintang Government).[130]

Although the Law of the Kuomintang Government parallelled the copyright laws of the two preceding governments in several respects, it nevertheless severely limited the rights of Chinese authors by preserving for the Ministry of Internal Affairs the right to refuse copyright protection to any work which "obviously [went] against the doctrines of the Kuomintang."[131] In 1930, the Kuomintang Government further restricted the rights of Chinese authors when it passed an additional Law of Publication imposing a strict censorship system to control the content of published works.[132] The restrictive Law of the Kuomintang Government and its progeny remained in force until the establishment of the

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125. Shen Rengan & Zhong Yingke, CHINA & COPYRIGHT, *excerpts reprinted in* 20 COPYRIGHT 257, 258 (1984); Aoki, *supra* note 4, at 223.

126. Rengan & Yingke, *supra* note 125, at 258.

127. *Id.* at 258-59.

128. *Id.* at 259; Aoki, *supra* note 5, at 223.

129. Rengan & Yingke, *supra* note 125, at 259; Aoki, *supra* note 5, at 223.

130. Rengan & Yingke, *supra* note 125, at 259; Aoki, *supra* note 5, at 223.

131. Rengan & Yingke, *supra* note 125, at 259.

132. *Id.* If the Ministry of Internal Affairs found that the works "include[d] one of the matters which should be prohibited or limited . . . it [could] declare that it prohibit[ed] the sale and dissemination of that work, and if necessary, it [could] detain the work." *Id.* Authors of works which "harmed the interests of the Kuomintang" were subject to threats, persecution, and blacklisting by state officials, in addition to having their works banned from publication. *Id.*

Communist Party of the People's Republic of China in 1949.[133]

B. *Copyright in China After the Communist Revolution*

1. 1949-65

Upon entering power, the Communist Party repealed all prior laws and treaties.[134] The new government of China issued laws, in accordance with Marxist-Leninist philosophy, transferring possession of all property owned by individual citizens to the state bureaucracy.[135] Because copyright laws prevented society from freely making use of authors' works for a time, such laws generally were considered contrary to the socialist philosophy of the new Communist regime.[136] Nevertheless, in 1950 the new government issued a Resolution on the Improvement and Development of Publishing Work (1950 Resolution), which provided that "the publishing industry must respect copyrights and the right to publish and must not allow unlawful reproduction, plagiarism, tampering and other acts."[137] The 1950 Resolution also required the payment of royalties to authors for the use of their works, based "in principle on the nature and quality of the work, the number of [Chinese] characters, and the number of copies printed."[138]

The 1950 Resolution lacked administrative and enforcement procedures to effectuate itself and, thus, proved extremely ineffective in protecting the rights of Chinese authors.[139] Evidence of this ineffectiveness may be found in the so-called Dalian Bookstore incident of 1950. In this

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133. Aoki, *supra* note 5, at 223-24.

134. *Id.* at 225. Accordingly, "China entered the era of the People's Republic without an established system of legal protection for copyright and other rights of authors and with no national consensus on what protections the government should offer." Mark Sidel, *Copyright, Trademark and Patent Law in the People's Republic of China*, 21 TEX. INT'L L.J. 259, 261 (1986); *see also* Aoki, *supra* note 5, at 225.

135. Richard Goldstein, *Copyright Relations Between the United States and the People's Republic of China: An Interim Report*, 10 BROOK. J. INT'L L. 403, 410 (1984). Under this theory, the "renunciation of private property [was] essential to the success of the class struggle and the economic growth of the nation." *Id.* at 411.

136. Natasha Roit, Comment, *Soviet and Chinese Copyright: Ideology Gives Way to Economic Necessity*, 6 LOY. ENT. L.J. 53, 64 (1986).

137. Sidel, *supra* note 134, at 261 (quoting 1 ZHONGYANG RENMIN ZHENGFU FALING HUIBIAN [LAWS AND DECREES OF THE CENTRAL PEOPLE'S GOVERNMENT] 825 (1952) (as translated by Mark Sidel) [hereinafter 1 ZHONGYANG]; *see also* Rengan & Yingke, *supra* note 125, at 261.

138. Sidel, *supra* note 134, at 261 (quoting 1 ZHONGYANG, *supra* note 137, at 824-25).

139. Sidel, *supra* note 134, at 261.

episode, the Dalian Bookstore (the Bookstore) reproduced five thousand copies of a work entitled *The International Situation Since the Korean War* without the permission of the original publisher.[140] The Bookstore then attempted to preserve all future reproduction rights in the book for itself by printing on the copyright page of all copies "First Edition Dalian, All Rights Reserved, No Reproduction Allowed."[141] The original publisher, unable to find a means by which to enforce rights in the work, only could complain to the General Publishing Office in Bejing that the work had been unlawfully copied.[142] Although the General Publishing Office issued a stern letter criticizing the Bookstore, labelling its action "extremely improper," and stating that the Bookstore "should first have contacted the [original] publisher and asked for its agreement," the Bookstore's usurpation of the work resulted in no other penalty.[143]

The Dalian Bookstore incident highlighted the deficiencies in the 1950 Resolution and the need for the Chinese government to provide additional remedies for the infringement of the rights of authors. In response to this inadequacy, the Communist government created a new system whereby publishers and authors would "sign contracts, with their principal contents to include the number of [Chinese] characters in the original manuscript, the due date [for the manuscript], the amount of royalties and other provisions, and [the contracts] shall be signed personally by the publisher . . . and the author."[144] Although these contracts sufficiently regulated the relationship between publishers and authors,[145] they could not control the reproduction of works by third parties. Accordingly, the Communist government established new regulations concerning the remuneration of authors for the use of their works.[146] These regulations,

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140. *Id.*; *see also* Rengan & Yingke, *supra* note 125, at 261.

141. Sidel, *supra* note 134, at 261.

142. *Id.* at 261-62; Rengan & Yingke, *supra* note 125, at 261-62.

143. Sidel, *supra* note 134, at 262. The Bookstore did, however, on its own initiative, offer remuneration to the original publisher for some of the economic harm sustained. *Id.*

144. Sidel, *supra* note 134, at 262 (citing SHEN REN'GAN & ZHONG YINGKE, BANQUANFA QIANTAN [A DISCUSSION OF COPYRIGHT LAW] 107 (1982) (as translated by Mark Sidel) [hereinafter SHEN REN'GAN].

145. *See* Sidel, *supra* note 134, at 262. "Because there were contracts, the rights and duties of authors and publishers were relatively clear and at that time there were relatively few copyright disputes; even though there were some disputes, they were also easily handled through consultation or mediation." *Id.* (quoting SHEN REN'GAN, *supra* note 144, at 108).

146. *See* Rengan & Yingke, *supra* note 125, at 262 (discussing in detail the Draft Provisional Regulations of Author's Remuneration Relating to Books on Literature and Social Sciences); Sidel, *supra* note 134, at 263.

which combined per-word and per-copy royalties, resulted in relatively substantial payments to authors whose works were reproduced by third parties without permission.[147] The royalty system, however, was disbanded in 1958 as Mao Tse-Tung and the Communist party initiated the Anti-Rightist Movement and the Great Leap Forward to accelerate the Chinese conversion to socialism.[148]

2. The Cultural Revolution: 1966-76

From 1966 until 1976, the Communist government of China "madly suppressed and cruelly persecuted the mass of intellectuals,"[149] sending many authors to prison or work camps and torturing or killing others.[150] National policy deemed the creative efforts of authors "a bourgeois desire for personal fame and gain,"[151] and consequently all agencies that had previously regulated the payment of royalties to authors were eliminated.[152] In keeping with its Marxist-Leninist ideology, the state gained a monopoly over all works previously regulated by contract.[153] The state removed even the minimal rights of authors to control the use of their works.[154] Unauthorized reproduction of the works of Chinese authors increased dramatically during this period, as publishing laws passed in 1972 codified the elimination by the government of copyright protection.[155]

3. Authors' Rights in the People's Republic: 1977-Present

Following the death of Mao Tse-Tung in 1977, the leaders of the Cultural Revolution were arrested. The new regime began the slow process of re-establishing copyright protection for the works of Chinese au-

147. *See* Sidel, *supra* note 134, at 263.
148. *Id.*
149. Rengan & Yingke, *supra* note 125, at 262.
150. Sidel, *supra* note 134, at 263.
151. Rengan & Yingke, *supra* note 125, at 267.
152. Sidel, *supra* note 134, at 263-64.
153. *Id.* at 264.
154. *Id.*
155. *See id.* at 264 (citing Regulations on the Recording of Book Editions, ZHONGGUO CHUBAN NIANJIAN 1980 [CHINESE PUBLISHING YEARBOOK 1980] 628 (1981); *National Plan for Unified Numbering of Books*, 2 ZHONGGUO CHUBAN NIANJIAN 1980 [CHINESE PUBLISHING YEARBOOK 1980] 629 (1981) [hereinafter *National Plan*]). These regulations provided that a publisher reprinting the work of another author need only "note the name of the original publisher on the edition or . . . make some other explanation." *National Plan, supra*, at 629 (as translated by Mark Sidel).

thors.[156] The 1977 Directive on Trial Methods for News and Publishing Royalties provided limited compensation for authors through the payment of a one-time royalty based upon the number of Chinese characters in the work and the nature and quality of the published material.[157] In 1980, this legislation was superseded by a law, similar to the 1950 Resolution, that raised all royalty rates and provided for a cumulative payment to authors whose works had been unlawfully reproduced based upon the number of copies printed.[158] Apart from these royalty provisions and the re-emergence of the previous system of publishing contracts, however, the People's Republic remained without a uniform copyright law to protect the works of its authors.

In 1985, a group of Chinese authors and publishers convened to prepare a draft copyright law to remedy the inefficiencies of the existing scheme.[159] At the same time, the Chinese State Council created a regulatory agency, the State Copyright Administration, to supervise copyright protection for all Chinese works of authorship.[160] The result of these efforts was the promulgation in 1990 of the first comprehensive Chinese copyright law, the objective of which is "to protect the copyrights, neighboring rights and interests of authors in literary, artistic, and scientific works."[161] This law extends copyright protection both to works of domestic authors and to works of foreign authors first published within the borders of the People's Republic of China, regardless of the author's nationality.[162] In addition, it accords both moral and economic rights[163] for a period enduring for the lifetime of the author plus fifty years,[164] the same term provided in article 5 of the Berne Convention.[165]

The new Chinese copyright law provides relatively extensive privileges to domestic authors, including a much-needed grant of retroactive protection to all works published in China prior to June 1, 1991 (the

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156. Sidel, *supra* note 134, at 264.

157. *See id.* at 264-65.

158. *Id.* at 265.

159. *China Plans to Enter Realm of International Copyrights*, CHRISTIAN SCI. MONITOR, Aug. 6, 1985, at 2.

160. *Id.*

161. Copyright Law of the People's Republic of China, art. 1, *translated in* 41 Pat. Trademark & Copyright J. (BNA) 45 (Nov. 8, 1990).

162. *Id.* art. 2, *translated in* 41 Pat. Trademark & Copyright J. (BNA) at 45.

163. *Id.* art. 10, *translated in* 41 Pat. Trademark & Copyright J. (BNA) at 45. Moral rights include publication, acknowledgement, attribution, and the right to protect the work from unauthorized alteration. *Id.* Economic rights include publication, performance, distribution, and adaptation. *Id.*

164. *Id.* art. 21, *translated in* 41 Pat. Trademark & Copyright J. (BNA) at 46.

165. Berne Convention, *supra* note 2, art. 5(1), *reprinted in* WIPO at 181.

effective date of the legislation) for which the period of protection specified in the law would not yet have expired.[166] It does not grant, however, any form of protection to works of foreign authors first published in a state other than China.[167] Accordingly, absent China's adherence to the Berne Convention, foreign authors choosing initially to publish their works outside China must continue to rely upon contractual relationships and provisions in treaties not solely related to copyright to prevent unauthorized copying of their works.

C. *History of Chinese Copyright Relations With Other States*

1. Relations Prior to 1949

Although the Chinese government sent representatives to observe the Berlin Revision Conference of the Berne Convention in 1908,[168] China consistently has declined all invitations to enter into international agreements relating specifically to copyright protection. Prior to 1949, however, the Chinese government made minor efforts to address the protection of literary and artistic property through provisions in trade agreements with the United States and Japan.[169] Specifically, the Sino-American (and Sino-Japanese) Trade and Navigation Sequel Treaties of 1903, dealing with commercial relations, each contained a clause recognizing the rights of United States and Japanese authors in China.[170] This protection, however, was subject to fairly significant restrictions.[171] In 1913, the United States government requested that China enter into a bilateral treaty agreement specifically concerning copyright protection for

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166. Copyright Law of the People's Republic of China, *supra* note 161, art. 55, *translated in* 41 Pat. Trademark & Copyright J. (BNA) at 50.

167. Aoki, *supra* note 5, at 227 n.184 ("There is no reference to the rights of foreign works in this draft of the copyright law."); Sidel, *supra* note 134, at 268 ("Until the promulgation of the Chinese copyright law, however, Western practitioners and copyright holders must continue to rely upon contracts to protect copyrights in the P.R.C.").

168. Aoki, *supra* note 5, at 224; Rengan & Yingke, *supra* note 125, at 260; Shoukang, *supra* note 125, at 121.

169. Aoki, *supra* note 5, at 224; Rengan & Yingke, *supra* note 125, at 260.

170. Rengan & Yingke, *supra* note 125, at 260; Aoki, *supra* note 5, at 224 (citation omitted).

171. Rengan & Yingke, *supra* note 125, at 260. Works of United States and Japanese authors were entitled to copyright protection in China only if they met certain conditions: (1) the works must have been prepared specifically for the benefit of the Chinese people or published in Chinese; (2) the works were required to meet registration formalities; (3) similar works of Chinese authors must have been protected in the United States. Additionally, the duration of copyright protection for these foreign works in China was limited to a period of 10 years. *Id.*

literary and artistic works. Representatives for numerous Chinese publishers, however, greatly opposed the agreement and persuaded government officials to reject the United States offer.[172] In 1946, China and the United States entered into the Sino-American Friendly Trade and Navigation Treaty, which, like the 1903 commerce agreement, contained a provision granting limited rights to United States authors.[173] Both treaties, however, were repudiated in 1949 when Mao Tse-Tung and the Communist party came to power.[174] Thus, before the establishment of the People's Republic of China, the Chinese government never became a party to international copyright agreements and did not conclude any bilateral copyright treaties with other states.[175]

2. Relations from 1977 to Present

Following the death of Mao Tse-Tung, the government of China, recognizing the need for technological modernization, repudiated its isolationist policies, and reopened diplomatic relations with other states. In 1979, the United States and China concluded a trade agreement,[176] which, like the earlier commercial treaties, contained a provision of mutual recognition of the rights of authors.[177] In 1980, China became a member of the World Intellectual Property Organization (WIPO), which administers the Berne Convention.[178] The recent willingness of the Chinese government to cooperate with other states, coupled with its newly demonstrated interest in the protection of the rights of authors and the compatibility of the newly promulgated Chinese copyright law with the Berne Convention,[179] indicates that China finally may be ready to join the Convention. The question next to be determined is whether adherence to the Convention would be beneficial to China or problematic

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172. *Id.* at 260-61 (quoting a spokesman for the Chinese publishers to the effect that "participating in an international copyright union externally goes against the principle of equality among countries, internationally hinders the lease of life of education, industry and commerce." *Id.* at 261); Aoki, *supra* note 5, at 224.

173. Rengan & Yinke, *supra* note 125, at 160; Aoki, *supra* note 5, at 224-225.

174. *See* Aoki, *supra* note 5, at 225.

175. Rengan & Yingke, *supra* note 125, at 261.

176. Agreement on Trade Relations, July 7, 1979, U.S.-P.R.C., art. VI(5), 31 U.S.T. 4652, 4658.

177. *Id.*; *see also* Charles E. Miller, *The Development of China's Intellectual Property Law*, 10 N.Y.L. SCH. J. INT'L & COMP. L. 11, 24 (1989).

178. MICHAEL D. PENDLETON, INTELLECTUAL PROPERTY LAW IN THE PEOPLE'S REPUBLIC OF CHINA: A GUIDE TO PATENTS, TRADE MARKS AND TECHNOLOGY TRANSFER 39 (1986).

179. *See supra* Section V(B).

for the existing members of the Berne Convention or both.

3. The Future of Chinese Copyright Relations: Should the People's Republic Adhere to the Berne Convention?

When a state wishing to become a party to the Berne Convention historically has afforded copyright protection to works of its nationals, to works of foreign authors, or to works of both through its domestic legislation, and has adhered to prior international copyright agreements, the retroactive protection granted authors in the acceding state under article 18 presents little difficulty for existing Berne member states. The reason for this lack of difficulty is clear—if the new member state has enacted copyright laws or has entered into treaties, a set period will exist during which works created prior to the state's accession to the Berne Union will fall into the public domain because of the expiry of the granted term of copyright protection. Under article 18, these works are not subject to recapture. Thus, existing member states have no concerns regarding the reliance rights of exploiting nationals.

The unique history of the People's Republic of China, however, will present officials worldwide with an unprecedented problem. Because China has not been a party to any prior international copyright agreements, all Chinese works presently exist in the public domain of nearly all Berne member states. These works legally are subject to exploitation by Berne nationals.[180] If the People's Republic should seek adherence to the Convention, officials in Berne member states would be forced to consider the degree of retroactive copyright protection their governments would afford the pre-existing works of Chinese authors. Crucial to these determinations is an analysis of the effect the decisions might have upon the likelihood of Chinese adherence to the Convention.

As discussed previously, article 18 is susceptible to two possible interpretations, each with very different potential consequences for Chinese adherence. The first of the approaches, embodied in the United States BCIA, is a complete denial of retroactivity for all foreign works, irrespective of the manner in which those works fell into the public domain in their countries of origin. Under this interpretation, citizens of the existing member states would remain free to continue exploiting the works of Chinese authors. Accordingly, China's only remaining incentive to join the Berne Convention would be to gain international protection for

180. As discussed earlier, the rare exceptions to this rule are the relatively few states with which China has concluded treaties of commerce to which clauses mandating reciprocal protection for the works of both states' authors have been appended. *See supra* notes 169-70 and accompanying text.

the future works of Chinese authors. Because this objective could be accomplished by means other than adherence to the Convention,[181] preserving the rights of Chinese nationals to exploit the works of Berne authors, China most likely would not choose adherence to the Convention if faced with this scenario.

A second possible interpretation, based upon a literal reading of the first two clauses of article 18, has been utilized more widely by the present members of the Convention. Chinese works entered the public domain in China because of the lack of a domestic copyright law and not through the expiry of the term of protection. The literal language of the Convention arguably mandates that existing member states withdraw these works from their public domain and protect them for the full Berne term of the life of the author plus fifty years. By enacting provisions in their domestic legislation as authorized by clause 3 of article 18, however, the existing member states still may protect the reliance rights of their respective nationals.

The latter-described interpretation of article 18 clearly is more consistent with the Convention's stated goal of providing international protection for the largest possible number of literary and artistic works. Similarly, this approach is most equitable for all parties involved, because it allows existing Berne members to comply with the letter of the Convention while ensuring that their respective citizens will not suffer undue financial detriment. Finally, because this interpretation would result in both past and future Chinese works being protected abroad, the adoption of the latter approach is more likely to result in Chinese adherence to the Berne Convention.

VI. Conclusions on the Future of the Berne Convention

Although the original Berne Convention was concluded more than a century ago, numerous questions remain to be resolved concerning the application of the Convention to newly adhering states. This circumstance is surprising in light of observations that may be made concerning the relationship between the motivations of the various governments of the world and the stated goal of the Berne Convention.

Indisputably, countless cultural and historical factors merge to shape the domestic legislation of any one state. Only one reason, however, motivates a state to seek adherence to the Berne Convention—to gain

181. Other means include the use of contracts between Chinese authors and foreign publishers, as well as China's present practice of appending clauses relating to copyright protection for Chinese works to treaties of commerce and navigation.

protection for the literary and artistic creations of its respective nationals. This motivation is completely consistent with the explicit, continuing objective of the Berne Convention—to afford international copyright protection to the largest possible number of literary and artistic works.

When a state attempts to circumvent its obligations under the Berne Convention in favor of the proprietary rights of its nationals, the entire Berne scheme of universal copyright protection is placed in serious jeopardy. This precarious position is primarily the result of two considerations. Initially, the violating state runs the risk of imposing additional tension upon the already delicate relations between sovereign states, as Berne members must decide whether to take that state to task in the International Court of Justice, within the General Agreement on Tariffs and Trade, or within a dispute resolution forum established under the proposed Berne protocol. In the long run, and perhaps more important, the violating state sets a dangerous precedent of noncompliance for both existing and future adherents to the Convention.

Realization of the dual ambitions of the individual states and the Convention as a whole depends entirely upon the willingness of the various governments to be flexible in responding to one another's perceived needs and concerns. By negotiating solutions that will be favorable to all parties involved, one may predict that the members of the Berne Union will grow one step nearer to achieving universal protection of literary and artistic works.

*Katherine S. Deters**

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