International Intellectual Property

“Global” Copyright
What is Copyright Law?

• Allows an author of a work to reap the fruits of his or her intellectual creativity for a limited period of time.

• Limitations: does not extend to any idea, [patent], or slogan.
Overview of Copyright Law

• What is a copyright?
  – “work of authorship”
  • v. an invention (patent)
    – Compare with software
    » Is it useful or artistic?
Copyright

• Intent: Artistic
• Test: Fixed in a tangible medium of expression
• Protection: Common law rights; moment of creation
• Duration: Life of author plus 70 years
• Exclusive Rights
• Independent creation issue

Patent

• Intent: Utility
• Test: Nonobvious and Novel
• Protection: Must register within a year
• Duration: 20 yrs
• Exclusive Rights
• No independent creation issue
Overview of Copyright Law

• What is a copyright?
  – “work of authorship”
  • v. an invention (patent)
    – Compare with a Design Patent
      » “[35 U.S.C.] 171 refers, not to the design of an article, but to the design for an article, and is inclusive of ornamental designs of all kinds including surface ornamentation as well as configuration of goods.” In re Zahn, 617 F.2d 261, 204 USPQ 988 (CCPA 1980).
Overview of Copyright Law

• What is a copyright?
  – “work of authorship”
    • v. a trademark (source identifier)
      – Compare with design / drawing
Copyright

- Intent: Artistic
- Test: Fixed in a tangible medium of expression
- Protection: Common law rights at moment of creation
- Duration: Life of the author plus 70 years
- Exclusive Rights
- Independent creation issue

Trademark

- Intent: Source identifier
- Test: used in commerce
- Protection: Common law protection at moment of use... in commerce
- Duration: indefinite
- Exclusive Rights (no “ghost” marks)
- Likelihood of confusion (copying allowed?)
Purpose / Goals of Copyright Law

• Encourage the development of cultural and artistic works.

• Facilitate access to knowledge and entertainment for the public.

• Provide a financial benefit to copyright holders for their works (*quid pro quo*).
“Global” Copyright?

• There is no such thing as an international copyright

• “Golden Rule”: However, member countries that are a part of an international treaty will show the same respect to foreign copyright
International Copyright Treaties

- Berne Convention
- TRIPS
- WIPO Copyright Treaty
International Copyright Treaties

• Berne Convention
  – Oldest and most important
  – Signed in 1886 (with numerous amendments)
  – Ratified by 180 counties
  – Three basic principles:
    • National Treatment (or minimum standards)
    • Automatic Protection
    • Independence of Protection
International Copyright Treaties

• Berne Convention
  – Three basic principles:
    • National Treatment (or minimum standards):
      – Subject Matter
      – Exclusive Rights
      – Duration
Minimum Standards of Protection

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<thead>
<tr>
<th>Subject Matter</th>
<th>U.S.</th>
<th>Berne Convention</th>
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<tr>
<td></td>
<td>Literary, music, dramatic, pantomimes, choreographic; pictorial, graphic, and sculptural works; audiovisual works; sound recordings; architectural works; vessel hauls (exhaustive)</td>
<td>Literary or artistic, whatever the mode or form of expression (example)</td>
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<table>
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<tr>
<th>Exclusive Rights</th>
<th>U.S.</th>
<th>Berne Convention</th>
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<tr>
<td>6 ER (+1): reproduce, derivative works; distribute; Perform publicly, display; perform the work (rights of attribution and integrity = moral rights))</td>
<td>9 ER: translate; adaptations; perform; recite; communicate to public the performance; broadcast; reproductions; as a basis for an audiovisual work; moral rights</td>
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<td>Individual: Life plus 70 Anonymous: 120 years from creation Corporation: 95 years from publication</td>
<td>Individual: Life plus 50 Anonymous: 50 years from publication Audiovisual: 50 years from publication Applied arts or photos: 25 years</td>
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International Copyright Treaties

• Berne Convention

• TRIPS
  – 3 WIPO Principles followed
  – “Most-favored-nation-treatment”
    • Countries cannot discriminate between trading partners
International Enforcement Issues
International Enforcement Issues

• Multinational Litigation
• Customs and Counterfeits
  – Seizure and Destruction
• Parallel Imports / Gray Market Goods
  – IP Exhaustion / First Sale Doctrine
• Remedies
• **Choice of Law**
  – Standing to sue
• **Subject Matter**
  – Moral Rights
Choice of Law

• Hypo:
  – Assume a work that is created in a foreign country by foreign company is reproduced and distributed in the United States. The foreign company seeks relief in a U.S. court. What law applies and how should the case be handled?
Choice of Law- Theories

• Vested Rights Theory
• Most Significant Relationship Theory
• Governmental Interest Analysis
• Choice Influencing Consideration
Choice of Law- Theories

• Vested Rights Theory
  – Restatement (First) of Conflict
  – *Lex Fori*: Courts should apply their own laws
  – Foreign law should only be applied if the right in question was created abroad

• Most Significant Relationship Theory

• Governmental Interest Analysis

• Choice Influencing Consideration
Choice of Law- Theories

• Vested Rights Theory

• Most Significant Relationship Theory
  – Restatement (Second) of Conflicts
  – Is there a determinative statutory choice of law rule?
  – If not, look to the law of the state with the most significant relationship to (1) the occurrence, (2) the parties, and (3) the underlying policies of the law.

• Governmental Interest Analysis

• Choice Influencing Consideration
Choice of Law- Theories

• Vested Rights Theory
• Most Significant Relationship Theory
• Governmental Interest Analysis
  – Needs of the interstate / international system
  – Relevant policies of the forum (compare with “false conflict”)
  – Protection of expectations the author
• Choice Influencing Consideration
Choice of Law - Theories

• Vested Rights Theory
• Most Significant Relationship Theory
• Governmental Interest Analysis
• Choice Influencing Consideration
  – *Lex causae*: allows for courts to make a choice between forum and foreign law
  – Five Factors:
    • Predictability of result
    • Maintenance of interstate and international order
    • Simplification of the judicial task
    • Advancement of the forum's interests
    • The better rule of law
Choice of Law – The Berne Convention

• National Treatment
  – Generally, the principle of national treatment means that under a nation’s laws, a foreigner enjoys no lesser rights and benefits than a citizen of that nation receives, subject to the specific terms of the relevant international conventions.
  – In copyright terms, it means, for example, that a German work for which copyright enforcement is sought in the United States should not be treated differently than a U.S. work.

• Scholars differ on whether this should be interpreted as a choice of law provision or as a non-discrimination policy.
  – E.g. French author sues U.S. company for copyright infringement.
    • Choice of Law Principal – U.S. Law applies
    • Non-discrimination policy – U.S. choice of law principle will apply as it would for any other U.S. author.
Itar-Tass Russian News Agency v. Russian Kurier, Inc., 153 F.3d 82 (2d Cir. 1998)
Itar-Tass Russian News Agency v. Russian Kurier, Inc., 153 F.3d 82 (2d Cir. 1998)

• Russian language weekly Russian Kurier in New York City that had copied and published various materials from Russian newspapers and news agency reports of Itar-TASS.

• Take Note
  – Russia excludes newspapers from its work-made-for-hire law while the U.S. does not.
Ownership – U.S. Law

• Initial Ownership – vests initially in the author or authors of the work
• Work Made for Hire – when author is hired, the employer for whom the work was prepared is considered the author/owner
• Joint Ownership
• Ownership through transfer
  – Compare with Government creation of IP
Ownership – U.S. Law

• The Court separated the issues of ownership and infringement for choice of law analysis
• Treats copyright as a form of property and applies the Restatement (Second) “most significant relationship” test
• Took Berne Convention’s “country of origin test” into consideration:
  1. First publication
  2. Simultaneous Publication – Union country with shortest term of protection
  3. Unpublished work – Union country of domicile
• Applied Russian Law to Ownership (remanded to determine rights of the newspaper company according to Russian law)
Proposed Solution - Ownership

• A series of bright-line rules can produce a more determinative test with an equitable result:

1. Place of author’s nationality

2. Dual Citizenship - Place of Publication
   – If publication is within a country of citizenship, that country’s law applies

3. If still undecided:
   – Multiple citizenships – published outside Union country, unpublished, simultaneous publication within Union countries: significant relationship test
     • Factors to consider: place of permanent domicile, duration of time spent in each country, place of fixation of work, etc.
   – Stateless Authors – Lex Loci Fori – Law of the forum
Infringement – U.S. Law

• Owners of a copyright are granted six exclusive rights that are infringed if acted out by another party
  – Reproduce the work in copies or phonorecords
  – Prepare derivative works based on copyrighted work
  – Distribute copies or phonorecords of copyrighted work
  – Perform the copyrighted work publicly
  – Display the copyrighted work publicly
  – Perform the copyrighted work publicly by means of digital audio transmission (Sound Recordings)
Infringement – U.S. Law

• *Lex loci delicti* – place of the harm
• In *Itar-TASS*, the court held that the place of the tort was clearly in the U.S. and applied U.S. law to the matter of infringement
• Problem: Where exactly is the place of the harm?
  – Where right is violated (e.g. place of performance or display)?
  – Where the right holder is domiciled because their rights are infringed?
  – Where infringer is domiciled/incorporated (e.g. a New York company that publishes a copy through an international affiliate)?
Proposed Solution - Infringement

• Current lex loci delicti approach is too ambiguous as to where the tort or harm takes place

• Rome II – lex loci protectionis
  – Will normally act as forum law but has a broader application that can result in application of foreign law

• Ideally an international arbitration system similar to the UDRP (Uniform Domain-Name Dispute Resolution Policy), especially for widespread infringement on the Internet.
  – Would require more harmonized copyright laws that have not yet been realized
Boosey & Hawkes Music Pubs. v. The Walt Disney Co., 145 F.3d 481 (2d Cir. 1998)
Boosey & Hawkes Music Pubs. v. The Walt Disney Co., 145 F.3d 481 (2d Cir. 1998)

• “Type of Use”: in motion picture; “ASCAP Condition”
  – Does this include video format? Can a license agreement cover “new-uses,” if not expressly claimed?

• *Forum non conveniens* test
  – (1) Whether there exists an alternative forum with jurisdiction to hear the case; and
  – (2) If so, then apply *Gilbert* factors to determine which forum applies.
Boosey & Hawkes Music Pubs. v. The Walt Disney Co., 145 F.3d 481 (2d Cir. 1998)

• Forum non conveniens test
  – (1) Whether there exists an alternative forum with jurisdiction to hear the case; and
  – (2) If so, then apply Gilbert factors to determine which forum applies.
    • Gilbert Factors?
      – Access of proof
      – Availability of witnesses
      – Consideration of “all other practical problems that make trial of a case easy, expeditious and inexpensive.”
      – This is a non-exclusive list!
MORAL RIGHTS
Moral Rights

• Article 6bis:
  – “(1) ... the author shall have the right to claim authorship of the work and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation.”
Moral Rights

• Article 6bis:
  – Separation of moral and economic rights
    • v. IP Exhaustion
  – Attribution rights
    • Author’s name must be included on work; can’t be substituted for another name
  – Protection of integrity
    • Author has a right to object to any distortion (etc) of work; AND / BUT that distortion needs to be prejudicial to the author’s honor
  – Honor or reputation
    • Does it affect the author’s esteem in the public?
  – Waiver of rights
    • In writing, signed by author
Gilliam v. ABC, Inc.,
538 F.2d 14 (2d Cir. 1976)

• Can a licensee, under a valid agreement, make certain changes to a work that does not infringe on the copyright owner’s exclusive rights, but otherwise harms the artistic reputation of the artist?
The Devil’s Advocate
Visual Artists Rights Act (VARA)

• Exclusive rights: “Sect 106” rights, plus the right of attribution and integrity
  – Also known as “moral rights”

• Applies to the physical, tangible thing and limits the actions of the owner of the tangible thing.
Visual Artists Rights Act (VARA)

• What are the moral rights?
• When does it apply?
  – Limited “works of visual art”
• Duration?
  – Life of the author
• Transferability?
  – Not transferrable, but may be waived