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HOW TO PRACTICE COPYRIGHT LAW INTERNATIONALLY IN PERPLEXING TIMES?

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"When the going gets tough, the tough go shopping."

I. INTRODUCTION

How to practice copyright law internationally at present?[1] To start, I shall give some background on the perspective with which I approach this inquiry. Then I shall touch on some problems that recent developments raise for analyzing issues in cross-border copyright cases. Finally, I shall outline some guidelines for counsel in such cases.[2]

II. MEL'S MARCHING ORDERS

Nimmer on Copyright[3] shepherded U.S. practitioners from the 1909 Act to the 1976 Act. This statutory transition was intended, *inter alia*, to prepare the way for U.S. entry into the Berne Union. At the same time, the international chapter of the *Nimmer* treatise served as a guide for U.S.

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1 Unless otherwise indicated, the term "copyright" will here generically include authors' rights and neighboring or related rights.

2 Practitioners, anticipating or already handling cross-border copyright cases, might well turn to these rules of thumb at once. *See infra* Part IV.

3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT (2013).

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jurists to the Berne-based treaty regime. For example, even before U.S. adherence to the Berne Convention effective in 1989, a leading U.S. court turned to the *Nimmer* treatise for reassurance that it could entertain a suit for copyright infringement abroad, namely in a number of Latin American countries, all granting protection pursuant to the Berne Convention.[4] Further, Professor Melville Nimmer's seminal article on conflicts of copyright and contract laws, an article which he then integrated into the *Nimmer* treatise, initiated U.S. counsel and courts into the penumbra of the Berne regime, where treaty rules give way to choice-of-law quandaries.[5]

Against this background, in the early 1980s, Professors Nimmer and Latman invited colleagues from abroad to contribute to a new treatise. These foreign experts were asked to write chapters on the copyright laws of their respective countries for this pending international and comparative treatise. In 1984, Professor Nimmer considered me to assist him with the draft chapters he had received, but he put me to a test: he asked me to try my hand at editing a draft written by one of the many contributors who did not have English as their mother tongue. A short way into my test edit, I called Mel to suggest, rather anxiously, that the chapter would have to be extensively rewritten to make it readily accessible to busy U.S. lawyers. I also let slip my overall reluctance to recast his learned contributors' drafts as I might find necessary to make them cogent for my colleagues. In response to my qualms, Mel gave me this marching order: *Do it, Paul!*

The contributors had been given a questionnaire in the form of an outline. Most of the questions were based on U.S. copyright law and ultimately formed parallel topics for the national chapters in the international treatise. For example, contributors were asked about formalities based on the U.S. model, but such questions can amount to a non-issue in virtually all Berne member states, which had eliminated formalities pursuant to the Berne provision barring such conditions on protection.[6] This detail repre-

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[4] London Film Prods., Ltd. v. Intercontinental Commc'ns, Inc., 580 F. Supp. 47, 48-50 (S.D.N.Y. 1984) (citing the *Nimmer* treatise as supporting distinct points: "copyright infringement constitutes a transitory cause of action" actionable "in the courts of a sovereign other than the one in which the cause of action arose"; the Berne Convention, found in an appendix to the treatise, could assure protection of the works at issue in the countries whose laws claimants invoked).

[5] Melville B. Nimmer, *Who is the Copyright Owner When Laws Conflict?*, 5 INT. REV. INDUS. PROP. & COMP. LAW [IIC] 62 (1974). *See also* 4 NIMMER & NIMMER, *supra* note 3, § 17.11 (elaborating this choice-of-law analysis); *id.* § 17.05 (discussed *infra* text accompanying note 62).

[6] For the most recent version of this provision, see Berne Convention for the Protection of Literary and Artistic Works, art. 5(2), adopted Sept. 9, 1886, S. TREATY DOC. NO. 99-27, 1161 U.N.T.S. 3 (amended Sept. 28, 1979) (Paris Act) [hereinafter Berne Convention], *available at* http://www.wipo.int/treaties/en/ip/berne/index.html. For prior versions, see Berne Conven-

sented but a minor point in the overall differences that had to be worked out between, on the one hand, the largely U.S. model for the outlined questions and, on the other, the doctrinal structures and operative rules of the laws of copyright and of authors' rights of other countries. A few contributors nonetheless followed the outline point by point, but many deviated from it at some or many points. I asked Mel what to do about their thus honoring the outline in the breach. He answered with this further marching order: *Do the best you can*.

Mel passed away in the Fall of 1985. With his marching orders in mind, I continued editing the draft chapters. Over time I developed a tool box of editorial methods for guiding readers from originally U.S.-based topics for national chapters into the varying tenors of diverse laws. In 1988, the treatise which for many years had been a work in progress, now entitled *International Copyright Law and Practice*,[7] was first published. In its initial annual update in 1989, in time for U.S. entry into the Berne Union, the new treatise included my lead chapter. This chapter provides a step-by-step framework for analyzing copyright protection internationally.[8]

The Berne Convention has been complemented by the TRIPs Agreement[9] and supplemented by the WIPO "Internet" Treaties.[10] Some of these developments have addressed media trends, notably the Internet, that led me to invoke "perplexing times" at the end of the title of this essay. I shall here revisit my editorial methods as well as my framework

tion for the Protection of Literary and Artistic Works, art. 4(2) (Berlin, Rome, and Brussels Acts).

[7] INTERNATIONAL COPYRIGHT LAW AND PRACTICE (Paul Edward Geller ed., 2013).

[8] Paul Edward Geller, *International Copyright: The Introduction*, *available at* http://www.internationalcopyrightguide.com, and *also in* INTERNATIONAL COPYRIGHT LAW AND PRACTICE, *supra* note 7. For a crucial point of departure in the *Nimmer* treatise for my chapter, see *infra* text accompanying note 62. Other notes below will provide a further sampling of sources.

[9] Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 108 Stat. 4809, 869 U.N.T.S. 299 [hereinafter TRIPs Agreement], *available at* http://www.wto.org/english/docs_e/legal_e/27-trips_01_e.htm.

[10] World Intellectual Property Organization (WIPO) Copyright Treaty, Apr. 12, 1997, S. TREATY DOC. NO. 105-17, 2186 U.N.T.S. 152 [hereinafter WCT], *available at* http://www.wipo.int/treaties/en/ip/wct/trtdocs_wo033.html; World Intellectual Property Organization (WIPO) Performances and Phonograms Treaty, Dec. 20, 1996, 36 I.L.M. 76 (1997) [hereinafter WPPT], *available at* http://www.wipo.int/treaties/en/ip/wppt/trtdocs_wo034.html.

chapter in the international treatise, both in addressing reasons for our theoretical perplexity[11] and in proposing practical responses.[12]

III. DO WE SPEAK THE SAME LAW?

In what type of copyright case does counsel or a court have to look to laws abroad or to treaties? Foreign copyright laws and international treaties can come into play in cross-border cases, where a creative work or a related media or data production originating in one country is disseminated into another. Consider a work authored by a national of one country, or first published there, but exploited or enjoyed without authorization in another country, sometimes called the protecting country.[13] Suppose such a hard-copy case: a novel or song is created or first published in one country, and it is marketed in the form of books or disks in another country. Now switch to an Internet case, where exploitation or enjoyment can take place online more or less worldwide. There might then be many protecting countries, possibly hundreds of them. In all such cross-border cases, how should counsel proceed?

A. Translator, Traitor?

Taking a cross-border case, counsel has to start by grasping its issues. Such cases are likely to be governed by laws cast in foreign languages that may provide terms for analyzing issues. We would then do well to take account of the Italian maxim *traduttore, traditore*, that is, put literally into English: translator, traitor! For our purposes, no language can reliably translate all foreign legal terms word for word, and verbal resemblances and even conceptual kinships between terms in different languages can be misleading. Since we translate foreign legal texts all the time, only obviously courting misunderstandings in hard cases, we might render our Italian maxim into this more modest paraphrase: *Translation can be tricky*.[14] Still and all, our problem of translation is endemic and runs deep, being entangled with cultural differences, even among speakers of the same language. As Oscar Wilde quipped, the British "have really everything in

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11 *See infra* Part III.

12 *See infra* Part IV.

13 For analyses of the words of art "protecting country" and "country of origin," respectively, see Geller, *International Copyright: The Introduction*, *supra* note 8, §§ 3[1] and 4[3][b][ii].

14 For further analysis, see Paul Edward Geller, *Legal Transplants in International Copyright: Some Questions of Method*, 13 UCLA Pac. Basin L.J. 199, 209-18 (1994), *available at* http://www.criticalcopyright.com/Geller-Transplants_Intnat_Copr.htm.

common with America nowadays, except, of course, language."[15] Consider, for example, the notions of U.S. "fair use" and of U.K. "fair dealing": these terms sound close in meaning but designate quite different provisions. U.S. fair use limits copyright generally, turning entirely on statutorily enumerated but open-ended criteria of fairness that case law has to construe.[16] U.K. fair dealings are exceptions that the statute defines with specific criteria of pertinent cases, coupled with a general criterion of fairness.[17]

Translation can complicate characterization in any cross-border case. In characterization, counsel and courts formulate issues in legal terms, with which they then focus on the facts of the case.[18] However, to the extent that translation is tricky, there is the risk of miscasting issues and, accordingly, of missing facts in a cross-border case. We naturally start analyzing issues by using our mother tongue, but sooner or later in a cross-border case we may have to take account of foreign laws originally articulated in foreign terms. Recall this problem as it arose early on in editing *International Copyright Law and Practice*: contributors had been sent questions often based on U.S. law, but they had to answer with regard to their own laws that were often differently framed.[19] Though it arises at the threshold of every cross-border case, this problem will also play out at every subsequent level of the case, for example, as counsel talks with a corresponding attorney in a foreign country about issues possibly subject to that other country's law and, ultimately, as the case is argued in court. To start, claimant's counsel has to ascertain what rights to invoke in a cross-border case, but it could be misleading for English-speaking counsel tacitly to assume the tendency of Anglo-American copyright laws to enumerate component rights in restrictive statutory terms. Counsel should rather ask, not only how narrowly, but how broadly to construe foreign

[15] OSCAR WILDE, THE CANTERVILLE GHOST ch. 1 (1882), *available at* http://www.online-literature.com/wilde/canterville-ghost/1.

[16] 17 U.S.C. § 107 (2010), *available at* http://www.copyright.gov/title17/circ92.pdf.

[17] *See, e.g.*, Copyright, Designs and Patents Act 1988, c. 48, §§ 29–30 (as amended), *available at* http://www.legislation.gov.uk/ukpga/1988/48/contents (U.K.) (exceptions for research or private study, criticism or review, and reporting current events).

[18] *I.e.*, what the Europeans often call *qualification*. *See* 1 ERNST RABEL, THE CONFLICT OF LAWS: A COMPARATIVE STUDY 52-72 *passim* (2d ed. 1958). It is often necessary to disentangle different types of issues in characterization, for example, in the field of copyright, by distinguishing infringement from chain-of-title issues. For title issues, see *infra* Part IV.D. Such analysis, sometimes called *dépeçage* or "issue selection," allows different rules drawn from different laws to apply to different types of issues on which the same case may turn. *See* 1 ALBERT A. EHRENZWEIG & ERIK JAYME, PRIVATE INTERNATIONAL LAW 119-21 (1972).

[19] *See supra* text accompanying note 6.

rights nominally corresponding to copyright, especially in researching laws in the civil-law tradition, where authors' rights may be conceptualized in open-ended terms.[20] We just saw that limitations and exceptions to rights, even with similar-sounding labels, differ in operation in moving from U.S. to U.K. law, and we shall soon touch on further variations in defenses available in different copyright laws.[21] Counsel may also look to case law abroad to sharpen the meanings of foreign laws, but should reckon with the caveat that court rulings may have different precedential forces in diverse judicial systems.[22]

Counsel and courts are often enough tempted to characterize issues, not only in their mother tongue, but in terms of *lex fori*, that is, the law of the forum.[23] By succumbing to such a local bias, courts risk imposing the categories and structure of forum law on any resolution of issues possibly subject to foreign laws. I shall later unpack reasons for disfavoring this method, to wit, both the risk of having local policies spill over into other jurisdictions and the risk of letting parties' claims and defenses get lost in the shuffle.[24] To begin to illustrate the problem, return to U.S. fair use: it cannot serve as a catch-all notion in terms of which to understand even apparently convergent doctrines, notably German *freie Benutzung*, that is, free utilization. While fair use serves as a defense to infringement generally, *freie Benutzung* delimits the derivative-work right specifically, pre-

[20] *See, e.g.*, André Lucas & Pascal Kamina, *France* § 1[3], *in* INTERNATIONAL COPYRIGHT LAW AND PRACTICE, *supra* note 7 (synthetically conceptualized rights); Adolf Dietz, G*ermany* § 8[1][b], *in* INTERNATIONAL COPYRIGHT LAW AND PRACTICE, *supra* note 7 (general rights encompass specific component rights "in particular" but not exhaustively); François Dessemontet, *Switzerland* § 8[1][b], *in* INTERNATIONAL COPYRIGHT LAW AND PRACTICE, *supra* note 7 (exclusive author's right illustrated, not delimited, by component rights).

[21] *See supra* text accompanying notes 15–17 and *infra* text accompanying notes 25–28 and 40-44.

[22] *See, e.g.*, Lucas & Kamina, *France*, *supra* note 20, § 1[4] (explaining the weight that French courts give to case law stable over time, *jurisprudence constante*, and to categorically articulated rulings, *arrêts de principe*, from the highest court of appeal, the *Cour de cassation*). Case law also has to be read in the light of underlying trends: for example, foreign law may prove hard to understand for the simple reason that it is in turmoil. *See, e.g.*, *infra* text accompanying notes 47-51 (emerging rights of making available).

[23] *See*, *e.g.*, YVON LOUSSOUARN & PIERRE BOUREL, DROIT INTERNATIONAL PRIVÉ 278-99 *passim* (3d ed. 1988) (explaining the French preference for the terms of *lex fori*, subject to caveats). Upon suit in a home court, a claimant's home law will be forum law, but where suit is brought in a court abroad, claimant's home law and forum law may differ. *See also infra* note 67 (critiquing home-court bias).

[24] *See, e.g.*, *infra* text accompanying notes 73–74 (policy spillovers) and notes 68–72 and 81–88 (loss of causes of action).

cluding a finding of infringement when essential aspects or traits of plaintiff's work are sufficiently attenuated in defendant's later work.[25] For example, as the U.S. Supreme Court has indicated, a parody may be excused as a fair use if, as a transformative work, it qualifies under the criterion of the purpose and character of the use and if it is not disqualified under other criteria, especially that of the effect upon market or value.[26] By contrast, the German Federal Court of Justice reached mixed results concerning a set of parodies of *Asterix* comic strips: only some were found susceptible of qualifying as free utilizations, depending on the extent that, as transformative works, they fell inside or outside infringement criteria that the Court liberalized to avoid constraining artistic freedom.[27] Thus, given a suit for a parody allegedly infringing in the United States and in Germany, counsel could risk mischaracterizing issues in the German case by merely applying the U.S. term "fair use" to it, possibly missing variations in results to which the German analysis of *freie Benutzung* could lead.[28]

To avoid such risks, it is possible to characterize issues in terms of *lex causae*, that is, the law of the claim and, by parity of reasoning, the laws of corresponding defenses. This method comes into play the moment that counsel and courts stop blindsiding themselves by looking only to *lex fori* to understand diverse laws invoked as dispositive in a cross-border case.[29] In many jurisdictions, reference to the *lex causae* constitutes the preferred method of characterization: for example, in the United States, the *Second Restatement of Conflict of Laws* provides that the "classification and interpretation of local law concepts and terms are determined in accordance with the law that governs the issue involved."[30] One might object that this

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[25] Gesetz über Urheberrecht und verwandte Schutzrechte [Act on Copyright and Related Rights] § 24(1) (enacted Sept. 9, 1965, and last amended Dec. 14, 2012), *available, with a link to an earlier version in English, at*, http://www.gesetze-im-internet.de/urhg/BJNR012730965.html (Ger.). For classic commentary on *freie Benutzung*, see EUGEN ULMER, URHEBER- UND VERLAGSRECHT 265-78 *passim* (3d ed. 1980).

[26] *See, e.g.,* Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 590-94 (1994) (remanding for consideration, *inter alia*, of the likely impact on the market for a non-parody version).

[27] The *Asterix Persiflagen* and *Alcolix* decisions, Bundesgerichtshof [BGH] [Federal Court of Justice], March 11, 1993, 1994 GEWERBLICHER RECHTSSCHUTZ U. URHEBERRECHT [GRUR] 191 and 206, *respectively, in English translation*, *in* 25 IIC 610 and 605 (1994) (Ger.) (remanding only some, but not all, of these cases for reconsideration).

[28] For further analysis, see Paul Edward Geller, *A German Approach to Fair Use: Test Cases for TRIPs Criteria for Copyright Limitations?*, 57 J. COPYRIGHT SOC'Y 553, 555-60 (2010).

[29] *See* MARTIN WOLFF, PRIVATE INTERNATIONAL LAW 150-56 (2d ed. 1950).

[30] RESTATEMENT (SECOND) OF CONFLICT OF LAWS § 7(3) (1971).

method risks introducing some circularity into judicial reasoning to the extent that it posits the foreign law that is invoked to govern an issue as the key to the framework for understanding that very issue. There is a simple response to this objection: characterization in terms of *lex causae* only provisionally lays out options for counsel and court to understand potentially conflicting laws; it is not in itself dispositive for resolving issues. For example, using this method in a cross-border parody case, counsel may provisionally formulate defense issues in terms of fair use for the United States and infringement issues in terms of *freie Benutzung* for Germany.[31] Given such a characterization, the court may ask whether and how, in the light of the rationales underlying these diverse but convergent doctrines, U.S. or German law, or both, should apply to the case at bar.[32]

The *lex causae* method may be complemented by the *comparative method* of characterization. This cosmopolitan method tries to reformulate issues in terms common to forum law as well as to all the laws arguably applicable to a case.[33] To use the comparative method in the field of copyright, counsel may turn to the Berne regime for the makings of a common copyright language. In terms followed more or less worldwide, treaty provisions have framed key issues, most notably: What types of works, or other media or data productions, are protected? What rights, as well as limitations and exceptions, are available? For example, the Berne Convention has elaborated a panoply of minimum component rights of copyright, including *inter alia* moral, reproduction, translation, performance, and broadcasting rights, subject to certain exceptions.[34] Thus the Berne regime has provided us with a copyright *lingua franca* in which counsel may begin to reformulate and indeed resolve many, but far from all, issues in cross-border copyright cases.[35] For example, article 11*bis* of the Berne

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[31] *See supra* text accompanying notes 25–28.

[32] Such policy analysis can sometimes help courts to diffuse conflicts of laws. *See infra* text accompanying notes 110–123 *passim* and 156–161.

[33] *See generally* 1 RABEL, *supra* note 18, at 55 (proposing to make the facts of each case "referable indifferently to foreign as well as to domestic substantive law"). *See also* GERHARD KEGEL, INTERNATIONALES PRIVATRECHT 208-15 (6th ed. 1987) (adopting Rabel's "breakthrough" because it frees choice-of-law analysis both of *lex fori* and, progressively, of *lex causae*).

[34] *See* Berne Convention, *supra* note 6, arts. 6*bis*-14 *passim*. Treaty provisions, some more open-ended than others, vary in the margin of discretion that they leave to treaty countries for assuring minimum rights. *See* WILHELM NORDEMANN, KAI VINCK, & PAUL W. HERTIN, INTERNATIONALES URHEBERRECHT UND LEISTUNGSSCHUTZRECHT: KOMMENTAR 12-13 (1977).

[35] Each type of economic right tends to take on converging meanings as it is honed in commerce, while moral rights tend to be controversial, being subject to cultural pushes and pulls. For a critique of Berne moral rights as diplomatic compromises, see HENRI DESBOIS, ANDRÉ FRANÇON, & ANDRÉ KÉRÉVER, LES CONVENTIONS INTERNATIONALES DU DROIT D'AUTEUR ET

Convention has led many countries to treat unauthorized cable retransmissions of work-containing broadcasts as infringing transactions.[36]

B. Treaty Lingua Franca *or National Dialects?*

While the Berne regime continues to be helpful in most cross-border cases, it still leaves us with problems of issue analysis in hard cases. Its default principle, national treatment, entitles a qualified foreign party claiming copyright to be treated as a national claimant in any treaty country where protection is sought.[37] Minimum rights, bolstering national treatment, implicitly come into play when they are implemented in national laws, as they most often are, but need to be expressly invoked in the rare cases in which any such treaty right justifies more extensive protection than does national law. Some commentators have suggested that new treaties, adding new minimum rights to the old Berne regime, have come just in time to equip us for dealing with the issues that online uses are precipitating.[38] Unfortunately, in cursorily reviewing how new "Berne-plus" treaties have so far impacted such issues, I shall provide no such solace to counsel or courts caught in Internet cases. Rather, beyond the old Berne *lingua franca*, I shall note new pitfalls that risk dropping us back among muddled, if not conflicting, national laws.[39]

The TRIPs Agreement applied Berne rights to new types of works, instituted a minimum rental right in limited cases, and clarified the minimum duration of rights in corporate works.[40] Most significantly, in its arti-

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DES DROITS VOISINS 40-41, 53 (1976). For analysis of divergences on point, see Paul Goldstein, *The Norms of Author's Right*, *in* URHEBERRECHT: GESTERN – HEUTE – MORGEN: FESTSCHRIFT FÜR ADOLF DIETZ 57 (Gerhard Schricker et al. eds., 2001).

36 *See, e.g.*, the CAI-Amstelveen decision, Hoge Raad [Supreme Court], Case No. 11 739, Oct. 30, 1981, 1982 Nederlandse Jurisprudentie No. 435, *in English translation in* 14 IIC 431 (1983) (Neth.) (invoking Berne article 11*bis* and holding such cable retransmissions actionable, even if these are made into zones reachable by the broadcasts being retransmitted); Legfelsóbb Bíróság [LB] [Supreme Court], Case No. Pf.III.20.308 (1987), Mar. 31, 1988 (Hung.) (same sense).

37 *See* Berne Convention, *supra* note 6, art. 5(1), (2) last sentence.

38 *See, e.g.*, 1 SAM RICKETSON & JANE C. GINSBURG, INTERNATIONAL COPYRIGHT AND NEIGHBOURING RIGHTS: THE BERNE CONVENTION AND BEYOND, at v (2006) ("'Berne-plus' conditions [. . .] acquired the voice of positive command [. . .] exactly in time with the greatest revolution in information and entertainment since the invention of printing").

39 For further analysis, see Paul Edward Geller, *Rethinking the Berne-Plus Framework: From Conflicts of Laws to Copyright Reform*, 31 EURO. INTELL. PROP. REV. 391 (2009).

40 TRIPs Agreement, *supra* note 9, arts. 10–12. To protect works generally, the TRIPs Agreement, in article 9(1), incorporated all the operative Berne provisions, except article 6*bis* protecting moral rights. To protect related media

cle 13, the TRIPs Agreement took over the test for Berne-compliant limitations and exceptions to the reproduction right, imposing it as a three-step test for delimiting all of copyright. This test harkens back to U.S. fair use, but it is not clear how far it can be transplanted out of its originating legal culture to provide common terms that could reliably frame limitations and exceptions to copyright worldwide. The U.S. fair-use provision, with its application turning on sundry permutations of four open-ended criteria assessed in fact-intensive precedents, leaves copyright open to having its scope erratically cut back in hard cases.[41] The fair-use model could become even more volatile if transplanted, via the TRIPs three-step test, into legal cultures whose judicial methods need not settle their diverse case laws on point in the near term.[42] Nonetheless, some commentators, citing article 13 of the TRIPs Agreement, have called for instituting more "flexible" defenses to copyright, akin to U.S. fair use, outside common-law jurisdictions.[43] Whenever any such shape-shifting doctrinal denizen enters new legal environments, counsel should be aware that native copyrights might risk losing some of their habitual contours.[44]

The WIPO "Internet" Treaties have articulated the so-called umbrella rights of communicating works and of making performances or phonograms available to members of the public.[45] One would hope that these

productions, its article 14 adapted some Rome provisions. *See* Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations, Oct. 26, 1961, 496 U.N.T.S. 43 [hereinafter Rome Convention], *available at* http://www.wipo.int/treaties/en/ip/rome.

41 *See* David Nimmer, *"Fairest of them All" and other Fairy Tales of Fair Use*, 66 LAW & CONTEMP. PROBS. 263 (2003). *But cf.* Pamela Samuelson, *Unbundling Fair Uses*, 77 FORDHAM L. REV. 2537 (2007) (analyzing policy-relevant clusters of decisions in U.S. fair-use jurisprudence).

42 *See, e.g.*, Jonathan Griffiths, *The "Three-Step Test" in European Copyright Law – Problems and Solutions*, 13 INTELL. PROP. Q. 428 (2009) (analyzing vacillating European case law on point and suggesting that the TRIPs-based E.U. three-step test may not reliably guide courts).

43 *See, e.g.*, Bernt Hugenholtz & Martin R.F. Senftleben, Fair Use in Europe: In Search of Flexibilities, Paper, Institute for Information Law, University of Amsterdam (Nov. 2011), *available at* http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1959554 (seeking clues in the TRIPs test for delimiting E.U. copyright). *But cf.* Geller, *A German Approach to Fair Use: Test Cases for TRIPs Criteria*, *supra* note 28, at 561-68 (critiquing the TRIPs test as conflating constitutional limitations, best construed liberally, with exceptions to be construed narrowly).

44 To date, TRIPs dispute-settlement decisions have not filled out reliable parameters for "flexible" limitations and exceptions. *See, e.g.*, W.T.O., Report of the Panel, United States — Section 110(5) of the US Copyright Act, WT/DS160/R, June 15, 2000 (subjecting TRIPs article 13 to case-by-case readings in applying it to minor exceptions under U.S. copyright law).

45 *See* WCT, *supra* note 10, art. 8; WPPT, *supra* note 10, arts. 10 and 14.

WIPO Treaties would have thus facilitated reaching a consensus, or at least a common language, for focusing on online transactions that infringe copyright.[46] However, any such hope loses conviction with a glance at contrasting national statutes that are said to implement the umbrella rights, as well as at varying national case laws on point. The United States has so far relied on its prior statutory enumeration of component rights of copyright as purportedly sufficient bases for meeting its WIPO-Treaty obligations to enforce any umbrella right. In turn, U.S. case law has vacillated in applying its statutorily defined component rights to online transactions, at times construing such rights narrowly to decline enforcement.[47] By contrast, Japan statutorily implemented the umbrella rights as rights of communication and transmission, while it detailed the broad scope of these rights in definitional provisions.[48] Its Supreme Court has applied these provisions to impose direct liability on a service for retransmitting locally televised programs to end-users abroad on demand.[49] For the time being, then, counsel cannot rely on WIPO-Treaty language alone to anticipate the results worldwide in cases of online access.[50] It remains

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[46] For commentary, see MIHÁLY FICSOR, THE LAW OF COPYRIGHT AND THE INTERNET: THE 1996 WIPO TREATIES, THEIR INTERPRETATION AND IMPLEMENTATION chs. 7–8 *passim* (2002).

[47] *Compare* Elektra Entm't Group v. Barker, 551 F. Supp. 2d 234, 239-46 (S.D.N.Y. 2008) (declining to take account of any WIPO-Treaty umbrella right and, accordingly, to consider an action for distribution online, via a file-sharing program, without any requisite offer), *with* Perfect 10, Inc. v. Amazon.com, Inc., 508 F.3d 1146, 1159-69 *passim*, 1168 (9th Cir. 2007) (admitting a case against Google for infringing the display right by communicating thumbnail images to end-users online, although finding fair use in making the thumbnails accessible). *Cf.* Cartoon Network LP, LLP v. CSC Holdings, Inc., 536 F.3d 121, 134-40 (2d Cir. 2008) (refusing an action based on the public-performance right where works were, on each user's demand, stored on a central server and retransmitted to the user), *cert. denied*, Cable News Network, Inc., v. CSC Holdings, Inc., 129 S. Ct. 2890 (2009).

[48] *See* Copyright Act, Act No. 48 of 1970 (as amended through Act No. 121 of 2006), arts. 2(vii)-(ix) *passim* and 23, *available in English translation at* http://www.japaneselawtranslation.go.jp/law/detail/?ft=1&re=02&dn=1&x=0&y=0&co=01&ky=copyright+act&page=20 (Japan).

[49] Supreme Court, 3d Petty Bench, Jan. 18, 2011, K.K. Fuji Television v. K.K. Nagano Shoten (the *Maneki TV* decision), 65 MINSHŪ 121 (Japan) (finding the service to be the principal retransmitting television programs to end-users, though it only allowed each user to connect his or her retransmitter to its facility). *Cf.* Naoya Isoda, *Copyright Infringement Liability of Placeshifting Services in the United States and Japan*, 7 WASH. J.L. TECH. & ARTS 149, 170-99 *passim* (2011) (analyzing the *Cartoon Network* case cited *supra* note 47 and the Japanese case law, including the *Maneki TV* decision).

[50] For further analysis, see Michael Schlesinger, *Legal Issues in Peer-to-Peer Filesharing, Focusing on the Making Available Right*, *in* PEER-TO-PEER FILE

to be seen what global consensus can be reached on the scope of the umbrella rights.[51]

Turn to the European Union. It is trying to harmonize the copyright laws of its member states with copyright directives. The most sweeping of these instruments has been Directive 2001/29/EC of the European Parliament and of the Council on the harmonization of certain aspects of copyright and related rights in the information society.[52] The jury is out on the question: Have the E.U. copyright directives moved Europe toward a copyright discourse more reliable than the old Berne *lingua franca* had previously provided, notwithstanding the diverse copyright traditions of British Imperial Copyright, of French dualist *droit d'auteur*, and of German monist *Urheberrecht*? Outside the European Union, the Swiss bridged the French and German traditions in their last copyright codification,[53] and one group of European academics has tried to pull together common European notions and rules in drafting a proposed European code.[54] At the same time, the Court of Justice of the European Union has started to elaborate case law, albeit in fact-intensive terms, to interpret E.U. copyright directives in disputed matters. Thus counsel cannot yet look to any fully settled case law, much less to any doctrinal consensus, for E.U. law dispositive of key copyright issues subject to harmonization.[55]

Return to the TRIPs Agreement, which sets out parameters for minimum remedies for intellectual property.[56] A court of a TRIPs member should enforce remedies within these TRIPs parameters at least in cases where the member's rights in TRIPs-protected foreign works or produc-

SHARING AND SECONDARY LIABILITY IN COPYRIGHT LAW 43 (Alain Strowel ed., 2009).

51 *Cf.* Geller, *Rethinking the Berne-Plus Framework*, *supra* note 39, at 393-95 (attempting to outline doctrinal bases for such a consensus).

52 2001 O.J. (L 167) 10.

53 *See* Loi fédérale sur le droit d'auteur et les droits voisins du 9 octobre 1992 (RS 231.1) [Federal Act on Copyright and Neighboring Rights of October 9, 1992] (as amended to January 1, 2011), arts. 9-11 and 16, *available at* http://www.admin.ch/ch/f/rs/231_1/index.html (Switz.). *Quaere* whether this statute, reconciling Continental traditions, holds clues for a comprehensive E.U. regulation on copyright.

54 *See* Wittem Group, European Copyright Code, *available at* http://www.copyrightcode.eu/ (encapsulating some E.U. directive rules, but skirting deeper divergences).

55 Furthermore, E.U. jurisprudence risks cutting Europe loose from any prior Berne consensus worldwide. *Cf.* Società Consortile Fonografici (SCF) v. Marco Del Corso, Case C-135/10, Court of Justice of the European Union (C.J.E.U. Mar. 15, 2012), paras. 43–56, *available at* http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=CELEX:62010CJ0135:EN:HTML (opining that key treaty provisions in the Berne regime are not self-executing, even in E.U. member states traditionally treating them as such).

56 TRIPs Agreement, *supra* note 9, Pt. III.

tions are infringed at home. If the court were to adjudicate infringement taking place abroad, not to mention global infringement online, a number of considerations would come into play, such as the court's jurisdiction over parties and infringement abroad, as well as the territorial reach of its relief.[57] However, the TRIPs Agreement does not address such issues in so many words, so that, absent a cross-border instrument such as the E.U. regulation dispositive on point,[58] counsel often has to analyze these issues, as we shall see, court by court and case by case.[59]

C. Why Not Apply the Law We Best Understand?

The Berne Convention may be likened to the DOS operating system for personal computers. However clunky and complicated some Berne provisions might be, the Berne Convention has served as the starting point for most subsequent programs in international copyright.[60] I have just argued that the Berne regime, even "plus" the programs of new treaties, most often leaves us referring back to national laws in cross-border cases.[61] But does the Berne regime provide us with any help in choosing among the conflicting laws that may apply in such cases, notably where there is access online and, possibly, infringement worldwide? The international chapter of the *Nimmer* treatise invokes the Berne regime in setting out the classically territorial approach to such conflicts: "the applicable law is the copyright law of the state in which the infringement occurred."[62] However, facing infringement online, counsel might then have to research, and the court choose among, the "laws of 200 different jurisdictions."[63]

To unpack options here, consider a spectrum of choice-of-law approaches. Some of these would give courts less, and some more, discretion

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[57] We shall see that, usually, forum law governs its own procedures for granting remedies and its own jurisdiction to enforce relief. *See infra* note 108 and text accompanying notes 149–152.

[58] Council Regulation (EC) 44/2001 of 22 December 2000 [hereinafter the Brussels I Regulation], 2001 O.J. (L 12).

[59] *See infra* Part IV.E.

[60] Indeed, quite clunky Berne provisions, notably that for the rule of the shorter term, are incorporated by reference into later treaties. For this rule, see Berne Convention, *supra* note 6, art. 7(8). This rule continues to complicate ascertaining when older works fall into the public domain worldwide. For further analysis, see Geller, *International Copyright: The Introduction*, *supra* note 8, § 5[2].

[61] *See supra* Part III.B.

[62] *See* 4 Nimmer & Nimmer, *supra* note 3, § 17.05[A]. For further analysis, see Eugen Ulmer, Intellectual Property Rights and the Conflict of Laws 6-14 (English translation 1978).

[63] Arpad Bogsch, Comment, WIPO World Forum, Naples, Oct. 18, 1995. This may well be a worst-case scenario, but one fit for testing our guidelines. *See infra* Part IV.

to choose among conflicting laws. At the start of this spectrum, as we just noted, the Berne principle of national treatment ostensibly entails territorially applying the law of each country where infringement may be localized.[64] As we move further along this spectrum, we find a variety of approaches: some civil-law codes set out claim-specific sets of alternative laws among which a court may conditionally choose, sometimes called "cascades" of laws ranging, say, from that of the place of infringement to that of the victim's country; some commentators propose judicial inquiry into the substantively "best" law of the case.[65] Finally, a most discretionary approach would allow a court to mix and match sundry factors to choose the law or laws of countries with some "close connection" to the case. Such factors could include the *loci* of the parties, of their relationships, of their activities and investment, or of markets targeted by their activities.[66] We then have to reckon with diverse choice-of-law approaches that a court could follow, with possibly quite different consequences for outcomes.[67]

A hypothetical case might help to sort out such consequences. Imagine a U.S. national who creatively improvises a mime work, but without fixing it, say, in a choreographic score or on a video recording. Imagine, further, that our author creates her mime work as she performs it live in the United States where, without her consent, a member of her audience,

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64 *See supra* text accompanying notes 62-63. *Cf.* Regulation (EC) 864/2007 of the European Parliament and of the Council of 11 July 2007 on the law applicable to non-contractual obligations (Rome II), arts. 4(1) and 8(1), 2007 O.J. (L 199) (applying "the law of the country in which the damage occurs" for torts generally and "the law of the country for which protection is claimed" for the infringement of intellectual property specifically).

65 *See, e.g.*, François Dessemontet, *Internet, le droit d'auteur et le droit international privé*, 92 (No. 15) Rev. Suisse de Juris. 285 (1996) (proposing a set of choice-of-law alternatives for online infringement); Graeme B. Dinwoodie, *A New Copyright Order: Why National Courts Should Create Global Norms*, 149 U. Penn. L. Rev. 469 (2000) (contemplating the choice of the law best suited to each case in view of global policies).

66 *See* American Law Institute, Intellectual Property: Principles Governing Jurisdiction, Choice of Law, and Judgments in Transnational Disputes § 321(1) (2007) [hereinafter A.L.I. Principles]. *See also* Max-Planck-Group for Conflict of Laws in Intellectual Property (CLIP), Principles for Conflict of Laws in Intellectual Property, art. 3:603(2) (Final Text, Dec. 1, 2011) [hereinafter CLIP Principles], *available at* http http://www.cl-ip.eu/en/pub/home.cfm (proposing a set of somewhat different connecting factors centered on the infringer and infringement).

67 Of course, following a discretionary approach, a court could all too easily apply only its own law simply because it understood such law best. *Cf.* Desbois, et al., Les conventions, *supra* note 35, at 151 (critiquing this trend as "lazy").

also a U.S. national, records it surreptitiously as it is performed and, via a U.S. Internet-service provider, posts the recording online.[68] Such acts are not limited to the author's home country or to any other single jurisdiction, but crossing borders they feed potentially infringing transactions in multiple countries, so that a court, hearing our author's copyright claims, has to ask the conflicts question: Which law or laws should govern these claims? If the court strictly followed the territorial approach, it would apply copyright laws virtually worldwide, effectively country by country of threatened or actual reception; by contrast, if it exercised discretion in choosing the law with the "closest connection" to the case, it could apply only U.S. law, given the following connecting factors: parties who are U.S. nationals, unauthorized recording within the United States, and posting via a U.S. service provider. Unfortunately, full federal copyright in the United States would not protect the mime work at issue if it was neither fixed in "any tangible medium" nor thus fixed without the author's consent.[69] However, many other Berne countries, in which this work posted online might be accessed, do indeed protect unfixed creations, including mime works, with full copyright or authors' rights.[70]

These contrasting outcomes of our hypothetical of the mime author illustrate the policy stakes of moving down the spectrum of choice-of-law approaches. At the start of the spectrum, on the basis of the territorial approach, our hypothetical author would obtain treaty-based national treatment virtually worldwide and, accordingly, protection in most countries.[71] At the other end of the spectrum, as allowed by a more discretion-

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[68] For such a scenario, here updated, see the film DIVA (Jean-Jacques Beineix dir., Lionsgate, 1981).

[69] 17 U.S.C. §§ 101 (2010) (definition of "fixed"), 102(a). For U.S. state laws that may protect unfixed creations, see 2 NIMMER & NIMMER, *supra* note 3, ch. 8C. Of course, neighboring or related rights, or at least anti-bootlegging rights, may be available to live performers, but these are not as strong as full copyright or authors' rights. *See id.*, ch. 8E.; *also* TRIPs Agreement, *supra* note 9, art. 14(1) (adapting provisions of the Rome Convention, *supra* note 40, on performers). *Cf.* Beijing Treaty on Audiovisual Performances, WIPO Doc. AVP/DC/20 (June 24, 2012), *available at* http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=208966 (pending).

[70] For examples of laws without any fixation requirement, see Manoel J. Pereira dos Santos, *Brazil* § 2[1][a], *in* INTERNATIONAL COPYRIGHT LAW AND PRACTICE, *supra* note 7; Lucas & Kamina, *France*, *supra* note 20, § 2[1][a]; Dietz, G*ermany*, *supra* note 20, § 2[1][a]; Gunnar Karnel, *Sweden* § 2[1][a], *in* INTERNATIONAL COPYRIGHT LAW AND PRACTICE, *supra* note 7; Dessemontet, *Switzerland*, *supra* note 20, § 2[1][a].

[71] *See supra* text accompanying note 37. *Cf.* DESBOIS ET AL., LES CONVENTIONS, *supra* note 35, at 150-51 (noting that, in the light of Berne national treatment, the need for the territorial choice-of-law approach becomes all the more acute as the dissemination of works is globalized "by way of waves,"

ary approach, the court, applying only U.S. copyright law, could strip our U.S. author of rights to which national treatment, as assured by the international treaties, would have otherwise entitled her in many other countries where her work is enjoyed. This result would contravene the very rationale of the Berne-based treaty regime which constitutes, in U.S. terms, the "international system" governing copyright protection and choice of law or arguably, in the terms of the civil law, the *ordre public international* to such effect.[72]

Further policy anomalies could ensue. Bear in mind that the move from territorial to discretionary approaches would have courts swing from a set of many laws, dispositive territory by territory, on the one hand, to one single national law, or a few such laws, dispositive worldwide, on the other.[73] With any such swing, local policies, respectively motivating one or a few laws enacted on one or a few territories, would risk spilling over in effects onto other territories and, accordingly, into markets and audiences in the rest of the world that these local laws were neither intended nor enacted to govern.[74]

IV. HOW TO PRACTICE ACROSS BORDERS?

I have elsewhere spoken of "choice-of-law roulette."[75] Wisely or rashly, counsel might be tempted to try their clients' luck by shopping for a favorable forum.[76] Indeed, forum law normally governs a court's choice-of-law approach, as well as its procedures for granting remedies.[77] To ex-

that is, via broadcasting or cablecasting, when this phrase was written in 1976, but *a fortiori* online).

72 *See* RESTATEMENT (SECOND) OF CONFLICT OF LAWS, *supra* note 30, § 6(2)(a); *also id.* §§ 145 and 222 (directing courts to take account, primarily, of any such international system before focusing, secondarily, on any arguably "significant relationship" bearing on the choice of law). *Cf.* Mathias Forteau, *L'ordre public "transnational" ou "réellement international": L'ordre public international face à l'enchevêtrement croissant du droit international privé et du droit international public*, 2011 (No. 1) J. DROIT INT'L 3, 14-20 (reconceptualizing *ordre public international* as based, *inter alia*, on treaties).

73 *See* Paul Edward Geller, *Conflicts of Laws in Copyright Cases: Infringement and Ownership Issues*, 51 J. COPYRIGHT SOC'Y 315, 387-91 (2004).

74 *Cf.* PAUL GOLDSTEIN & P. BERNT HUGENHOLTZ, INTERNATIONAL COPYRIGHT: PRINCIPLES, LAW, AND PRACTICE 139 (2d ed. 2010) (noting that the territorial approach to resolving conflicts of laws allows for legal experimentation in a specific country to remain limited to that country).

75 Geller, *Rethinking the Berne-Plus Framework*, *supra* note 39, at 392.

76 *See infra* Part IV.E.

77 Courts also eschew *renvoi* to foreign choice-of-law rules. For this point, see RESTATEMENT (SECOND) OF CONFLICT OF LAWS, *supra* note 30, §§ 7(2) and 8. For caveats in the civil law, see FERENC MAJOROS, LE DROIT INTERNA-

pand on my gaming metaphor, one might say that some judicial systems set higher stakes than others.[78] How can counsel then hedge clients' bets in cross-border cases? To this end, I shall venture the following guidelines.

A. Map Out Arguable Infringement Worldwide

The first guideline urges claimant's counsel to trace out, on a world map, potentially infringing transactions. This mapping exercise can help to localize, not only infringing aspects of the transactions themselves, but other factors that might impact on how closely a cross-border case is connected to countries whose laws may be argued to apply to it.[79] Provisionally, in the field of copyright, counsel may start by asking where minimum treaty rights seem to be violated from country to country along the paths of unauthorized transactions. For reasons already broached, to deepen and refine analysis, national rights also have to be canvassed to see whether they have been breached.[80]

Our purpose here is to avoid letting claims for relief get lost in the shuffle. A U.S. case is illustrative: the Los Angeles News Service took videos of local riots in 1992. The videos were transmitted to news agencies in New York where, without authorization, they were copied and retransmitted abroad, most notably for televising in Europe.[81] Only U.S. law was invoked as the initial basis of copyright claims, and the trial court, after finding that the unauthorized copies made in New York were infringing under U.S. law, suggested that retransmission was only infringing upon reception abroad, so that foreign laws may govern liability for the retransmission.[82] By contrast, the appellate court next held that, if unauthorized copies were made in the United States, then compensatory relief could be awarded under U.S. law for exploitation abroad, as if the exploitation abroad had taken place at home.[83] Finally, after the case went back to the

TIONAL PRIVÉ 108-09 (3d ed. 1990). For remedies as subject to forum law, see *infra* note 108.

[78] For example, U.S. courts allow lay juries to decide certain issues, often to award high damages, while other judicial systems rely on judges or expert magistrates, more sparing of awards, in civil or commercial cases.

[79] Note that, methodologically, such localization is a threshold step in characterization, because it points to possibly applicable laws in terms of which key issues may eventually be formulated and facts focused upon. For further analysis of characterization, see *supra* Part III.A.

[80] *See supra* Part III.B-C *passim*.

[81] Los Angeles News Serv. v. Reuters Television Int'l, 942 F. Supp. 1265, 1269-71 (C.D. Cal. 1996).

[82] *Id.* at 1269 (stating that the plaintiff "can seek a remedy [. . .] under the applicable foreign law" for televising the videos abroad, notably in Europe).

[83] *Los Angeles News Serv.*, 149 F.3d 987, 991-93 (9th Cir. 1998), *cert. denied*, 525 U.S. 1141 (1999).

trial court and was once again appealed after trial, the appellate court limited what the claimant, after failing to plead foreign laws, could collect for the foreign exploitation.[84]

Had potentially infringing transactions been mapped out globally in this case, claimant's counsel could have better appreciated on which laws to rely as bases for relief. Provisionally, the laws of all the countries up to and, most crucially, at the end of a given transaction, or the laws of countries where key participants are located, are candidates to serve as such bases. In the *Los Angeles News Service* case, not only should counsel have looked to the *loci* of unauthorized reproduction, but to markets to be exploited and audiences likely to enjoy the works at issue. The cases and commentary vacillate about how to fine-tune such localization of infringement and, accordingly, about which countries' laws may ultimately apply to infringement issues if the choice-of-law criterion is the place of infringement.[85] For example, some decisions allow for localizing infringement in preparatory acts in one country even if damages are incurred in another, other decisions favor applying only the law of any country with a market or audience at least targeted by any unauthorized transaction, and still other decisions equivocate.[86]

Whatever the theoretical tensions on point, the practical lesson is clear: At the start of a case, map out potentially infringing transactions worldwide. In the *Los Angeles News Service* case, if claimant's counsel had pled the laws of countries receiving the videos at issue, the court would have been led across the Atlantic, where the videos were to be exploited and enjoyed.[87] Thus counsel would have avoided waiving claims

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[84] *Los Angeles News Serv.*, 340 F.3d 926, 929-32 (9th Cir. 2003) (disallowing actual damages in countries whose laws were not mentioned in the pleadings).

[85] For analysis, see Geller, *International Copyright: The Introduction*, *supra* note 8, § 3[1][b]; Geller, *Conflicts of Laws in Copyright Cases*, *supra* note 73, at 337-55.

[86] *Compare* Sirius Canada Inc. v. CMRRA/SODRAC Inc., 2010 FCA 348 (Fed. Ct. App.) (Can.) (localizing infringement at points of reproduction in Canada to review royalties assessed for Canadian reception, given complex cross-border transactions organizing broadcasts via satellite), *with* Football Dataco Ltd. v. Sportradar GmbH, Case C-173/11, Court of Justice of the European Union (C.J.E.U. Oct. 18, 2012), *available at* http://curia.europa.eu/juris/document/document.jsf?text=&docid=128651&pageIndex=0&doclang=en&mode=req&dir=&occ=first%E2%88%82=1&cid=522782 (localizing infringement "at least" in a country in which members of the public are intentionally targeted by transmissions, even if a web server in another country transmits the infringing materials).

[87] Why did the holdings in the *Los Angeles News Service* case, *supra* notes 81-84, case vacillate so? At the start of the case, the trial court followed a newer U.S. precedent: *Subafilms, Ltd. v. MGM-Pathe Communications Co.*, 24 F.3d 1088, 1094-1099 (9th Cir. 1994) (en banc), *cert. denied*, 513 U.S. 1001

and corresponding remedies, as it ultimately did by failing to localize any infringement abroad. Pleading the laws effective in the countries of reception abroad would have increased options for obtaining monetary awards. Case law in other jurisdictions confirms this need to look beyond forum law in commencing a cross-border case.[88]

B. Analyze Available Grounds for Protection.

The second guideline here calls on counsel to analyze the grounds on which any work or related production at issue may be protected country by country. It cannot be assumed that any work or related production originating in one country will be protected in all the other countries where protection is sought. It is true that, thanks to the Berne-based treaty regime, most creative works, if they do not date back too far in time, are now likely to be protected in most countries.[89] That assurance may hold with lesser force for works at the margins of copyright coverage, such as industrial designs, as well as for other productions such as performances, recordings, broadcasts, etc.[90] Ultimately, counsel should analyze the grounds for protection relied upon in a given country because these grounds may condition the scope of protection available in that country.[91]

To highlight the phases of such analysis, return to our hypothetical of the mime. Recall that, in this hypothetical, a U.S. citizen creatively improvised a mime work live, while a member of her audience recorded this work surreptitiously, later posting it online, all without her consent.[92] According to our first guideline, counsel has to localize infringement in potential protecting countries, here arguably at least in those countries worldwide in which the recorded mime work might be made accessible online.[93] Following our second guideline, counsel, with a list of such protecting countries in hand, also has to list possible grounds of protection in

(1994), *further glossed infra* note 115. The appellate court, in its earlier decision, harkened back to an old U.S. precedent and then, in its later decision, retrenched on this old precedent: *Sheldon v. Metro-Goldwyn Pictures Corp*., 106 F.2d 45, 52 (2d Cir. 1939), *further glossed infra* note 117.

88 *See, e.g.*, Mother Bertha Music, Ltd. v. Bourne Music, Ltd., [1997] Ent. & Media Law Rep. 457 (Ch.) (U.K.), *with extracts in* 29 IIC 612 (1998) (refusing to consider claims for infringement in other countries in a case where claimant had failed to plead the copyright laws of these countries).

89 *See supra* text accompanying note 37 and note 60 and *infra* notes 100 and 104.

90 For further analysis, see Geller, *International Copyright: The Introduction*, *supra* note 8, § 4[1].

91 For further analysis, see *id.* § 5[1]; WILHEM NORDEMANN ET AL., INTERNATIONALES URHEBERRECHT, *supra* note 34, at 11-19 *passim*.

92 *See supra* text accompanying note 68.

93 *See supra* Part IV.A.

each such country, bearing in mind that such grounds may vary in type depending on the approach that any specific national legal system takes to treaties. Some countries implement treaty obligations only in domestic legislation; courts in other countries may apply mandatorily formulated treaty provisions as self-executing.[94] For example, in countries like Israel and Sweden, all grounds for protecting foreign works and productions are found only in domestic provisions.[95] In countries like Brazil and Switzerland, such grounds may be found in domestic and treaty provisions.[96]

In the next stage of analysis, counsel has to match up the work or related production at issue against certain requirements. Usually, three types of such requirements apply, whether a domestic or treaty provision provides the grounds for protection.[97] First, there is the requirement of coverage: the grounding provision must cover the work or production at issue within its terms. Consider, again, our hypothetical of the mime work: under the Berne Convention, which categorizes mime works as "entertainments in dumb show," Berne members must protect such works if they meet domestically imposable conditions, notably sufficient originality or creativity.[98] Second, there is the requirement of meeting at least one criterion of eligibility set out in a grounding provision: the work or related production at issue usually has to have a requisite "point of attachment" to a country with a treaty or comparable relation to the protecting country. For example, our hypothetical mime work meets the criterion of eligibility of being authored by a national of a country, here the United States, with treaty or comparable relations, respectively, to most potential protecting countries worldwide.[99] Third, there is the requirement of timely protection: the work or production at issue must not have irrevocably fallen into the public domain before the grounding provision invoked for protection went into effect between relevant countries. Our mime work, recently created, will not run this risk, but older works and productions do risk having

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[94] *See* Geller, *International Copyright: The Introduction*, *supra* note 8, §§ 3[2]-3[3].

[95] *See* Michael Birnhack, *Israel* § 6[1], *in* International Copyright Law and Practice, *supra* note 7; Karnel, *Sweden*, *supra* note 70, §§ 1[3] and 6[1].

[96] *See* Santos, *Brazil*, *supra* note 70, § 6[1][b][i]; Dessemontet, *Switzerland*, *supra* note 20, § 6[1].

[97] *See* Geller, *International Copyright: The Introduction*, *supra* note 8, § 4.

[98] *See* Berne Convention, *supra* note 6, art. 2(1). Fixation is another domestically imposable condition. *See infra* text accompanying note 103.

[99] *See, e.g.*, Copyright Order (United States), 1953 (amended Oct., 2007) (Isr.); International Copyright Regulation (1994:193, amended 2009:1420) (Swed.); Berne Convention, *supra* note 6, art. 3(1)(a). For further analysis, see Geller, *International Copyright: The Introduction*, *supra* note 8, § 4[2].

thus fallen into the public domain through a lapse of term.[100] This lapse of term need not always be fatal, since prior or retroactive protection may be available in some cases.[101]

Turn to the final stage of this analysis. Assume that all the prerequisites of protection are satisfied for a given country. How much protection will then be available for whatever work or production is to be protected in that country? National laws of protecting countries may govern most, but not necessarily all, of the issues on which the extent of protection turns.[102] For example, in our hypothetical case of the mime work, the issue of fixation was raised, initially as a condition of national protection in the United States. Indeed, the Berne Convention allows member countries, as a matter of national treatment, to apply a condition of fixation to protect works, but few members do so.[103] On some issues which the Berne regime specifies, national treatment may be subject to exceptions, some cutting back on national treatment and others expanding on it.[104] It must then be asked: What grounding provision applies to each issue affecting the extent of protection, especially exceptions to national treatment?[105] In countries not taking treaties as self-executing, domestic law, almost always implementing treaties, applies. In other countries, domestic or treaty provisions, depending on the issue, may apply.[106]

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[100] A lapse of term either in the protecting country or in the country of origin suffices to preclude Berne protection, absent any other intervening arrangement. *See* Berne Convention, *supra* note 6, art. 18.

[101] *See* Geller, *International Copyright: The Introduction*, *supra* note 8, § 4[3]; *also* Paul Edward Geller, *Zombie and Once-Dead Works: Copyright Retroactivity after the E.C. Term Directive*, 18 (no. 2) ENT. & SPORTS L. 7 (2000) (focusing on a special E.U. retroactivity provision and relevant E.U. case law).

[102] Note that this conclusion follows to the extent that the treaty principle of national treatment prompts, or indeed mandates, courts to choose laws territorially to such effect. It need not follow under more discretionary approaches. *See supra* text accompanying notes 65-74.

[103] Berne Convention, *supra* note 6, art. 2(2). For examples of countries that do not apply any requirement of fixation to works, see *supra* note 70.

[104] Depending on the exception, there may be a cut-back of protection to the level of the country of origin, specifically with regard to works of applied art or, more generally, to the term of protection. *See* Geller, *International Copyright: The Introduction*, *supra* note 8, §§ 4[1][c][i] and 5[2]. Or, by contrast, substantive protection may be brought up to the level of minimum rights. *See id.* § 5[4][a].

[105] For analysis of which treaty or domestic provision governs such issues when more than one provision may apply on point, see *id.* § 5[1].

[106] For detailed analysis in one country where case law has extensively analyzed the interplay of domestic and treaty provisions, as these have governed the duration of rights in foreign works, see Dietz, *Germany*, *supra* note 20, § 3[3].

C. Consider Rights in Terms of Remedies

The third guideline directs counsel to look to what clients seek: relief. In our initial pair of guidelines, proposed above, we analyzed how to spot potential protecting countries and then how to analyze protection available in any one of such countries.[107] But an abstract rundown of rights, as well as of limitations and exceptions, fails to tell counsel fully what concrete remedies may be obtained in a given court, especially where the laws of different protecting countries may conflict on issues on which relief may turn.[108] If, as I shall here suggest, counsel analyzes claims and defenses in terms of their remedial consequences, arguments may appear for defusing some conflicts of laws themselves. Further, such analysis can help to focus counsel on clients' stakes in suing or defending in one court or another. Finally, it might help counsel find other avenues for obtaining relief.

Choice-of-law analysis has developed a method for disentangling *true* from *false* conflicts of laws.[109] This method prompts courts to look behind the verbal tenor of arguably conflicting laws and to focus on the concrete results to which these laws lead. Generally speaking, there is a true conflict if a court must choose between conflicting laws because, in the case at bar, the policies motivating these laws, that is, their underlying rationales, compel reaching different results. A false conflict is said to arise if the court need not choose between the different laws invoked in a case to the extent that these laws, read in the light of their respective purposes, need not lead to different results.[110] In addition, once confronted with the complete set of whatever laws may conflict in a case, the court may try to reach "a reasonable accommodation of the laws' conflicting purposes," for example, in fashioning relief.[111] Another approach would have a court choose one or a few laws as initially dispositive of key issues, if not an entire case, and then entertain further arguments in favor of taking ac-

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[107] *See supra* Part IV.A-B.

[108] We touch here on the interface between procedures for providing relief, in principle subject to forum law, and substantive laws that conflict, but on which relief is to be based. Gaps may arise in this interface: notably, an adjudicating court's repertory of remedial procedures need not always include all those which foreign law, were the court to choose such law to govern a claim, would include if the applicable foreign rule were enforced where enacted. *See generally* OLUSOJI ELIAS, JUDICIAL REMEDIES IN THE CONFLICT OF LAWS, chs. 1-6 *passim* (2001) (analyzing gaps at this interface).

[109] For the breakthrough analysis here, see Brainerd Currie, *Notes on Methods and Objectives in the Conflict of Laws*, *in* SELECTED ESSAYS ON THE CONFLICT OF LAWS 177, 181-84 (1963).

[110] For further analysis, see DAVID CAVERS, THE CHOICE-OF-LAW PROCESS 89-90 (1965).

[111] *Id.* at 64.

count of other laws as it considered provisional and then final remedies.[112] However, in terms of my metaphor of choice-of-law roulette, a court, after having made such an initial choice of dispositive law, could foreclose further arguments for applying other laws, effectively responding: *Les jeux sont faits!*[113]

A court normally awards monetary damages under forum law for transactions infringing under that law and harming some market or audience within the court's own territorial jurisdiction.[114] By parity of reasoning, a court would assess monetary awards under the law of each country, other than the forum country, for transactions infringing under that other law and impacting any market or audience within that other country.[115] That is, in a cross-border case, in determining monetary awards available for resulting damages, courts would simply apply the laws respectively applicable where markets were usurped, or audiences prejudiced, country by country. For example, a French court rejected the argument that French law should apply to imposing damages just because the claimant was headquartered in France, and it rather applied Swedish, Dutch, and British laws, respectively, to compensate damages resulting from marketing that had taken place in each of these countries.[116] There are contrary decisions: for example, equitable discretion prompted a U.S. court, and

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[112] *See* A.L.I. PRINCIPLES, *supra* note 66, § 321(2); CLIP PRINCIPLES, *supra* note 66, art. 3:603(3).

[113] *I.e.*, "No more bets!" or, in poker, "The chips are down!" Once a court fastens on one law to govern a set of key issues, if not the entire case, notably in its initial characterization of the issues and facts, this choice of law risks coloring further provisional or final decisions, even foreclosing options open under other laws arguably applicable to the case.

[114] *See, e.g.*, Blue Ribbon Pet Prods., Inc. v. Rolf C. Hagen (USA) Corp., 66 F. Supp. 2d 454, 462-64 (E.D.N.Y. 1999) (holding a party contributorily liable for damages under U.S. law for making or using copies abroad without consent, but with *scienter* of possible U.S. sales); Herscovici c. Sté. Karla et Sté. Krizia, Tribunal de grande instance, 1e ch., Paris, May 23, 1990, 146 REV. INT'LE DU DROIT D'AUTEUR [RIDA] 325 (1990) (Fr.) (localizing illicit copying in Italy and illicit sales in France and awarding damages under French law for the sales).

[115] *Cf.* Subafilms, Ltd. v. MGM-Pathe Commc'ns Co., 24 F.3d 1088 (9th Cir. 1994) (en banc) (refusing to confirm an award under U.S. law to the extent that it applied to marketing abroad, where only U.S. law had been invoked as a basis for relief, and holding that mere authorization in the United States did not constitute an act actionable under U.S. law), *cert. denied*, 513 U.S. 1001 (1994).

[116] SISRO c. Sté. Ampersand Software, Cour d'appel [Intermediate Court], 4e ch., Paris, Feb. 8, 2002, Expertises, No. 259, June 2002, 230 (Fr.); *also* Cass. civ. [Supreme Court], 1re ch., Mar. 5, 2002, JCP 2002 II, 10082, 994, *in English translation in* 34 IIC 701 (2003) (rejecting appeal of this decision while invoking Berne national treatment).

unclear reasoning led a Canadian court, to award damages for copying in its home jurisdiction even when damages were ostensibly incurred abroad.[117] Such precedents could allow a court, on one side of a border, to apply its law to recompense copies made at home and another court, on the other side, to apply its law to recompense sales of these copies on its own territory.[118] More generally, such risks of double recoveries constitute an argument in favor of basing monetary awards on the legal and factual situation in the country of the targeted market or audience.[119]

Turn to injunctive relief by slightly varying our hypothetical of the mime work put online.[120] Assume for the moment that this work, as performed and recorded, is on the verge of being input into a global network from within the United States by a U.S. party. The author, not knowing where reception might take place, at once sues this inputting party in a U.S. court to have him enjoined from disseminating the work worldwide. We have already noted that the mime work at issue, not being fixed with its author's consent, may not be protected under U.S. copyright law, so that we are led to focus on the risk of unauthorized dissemination elsewhere. Suppose that the court makes the following findings: factually, upon posting online, access and damages difficult to compensate would be incurred in countries constituting the lion's share of markets and audiences worldwide; legally, liability would follow under the laws of most of these countries. The court then has both factual and legal bases, including treaty standards common to most countries' copyright laws, for issuing at least a provisional injunction with respect to much, if not all, of the global

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117 *Compare* Sheldon v. Metro-Goldwyn Pictures Corp., 106 F.2d 45, 52 (2d Cir. 1939) (equitably allowing domestic law to serve as the basis for liability for U.S.-made copies marketed abroad, where "plaintiffs made no proof of foreign law"), *with* Hager v. ECW Press, Ltd., [1999] 2 FC 287 (Fed. Ct. 1998) (Can.) ("I do not accept the argument that non-Canadian revenues should not be included. The books were published in Canada, sent from Canada for sale abroad and the revenues were paid to the defendants.").

118 *See* Geller, *International Copyright: The Introduction*, *supra* note 8, § 3[1][b][ii][C]. This prospect of double recoveries could be avoided if different fora had dovetailing approaches to duplicated actions, for example, allowing a prior pending suit always to take precedence over a subsequently filed suit. However, approaches do vary on point. *See infra* note 148.

119 *See, e.g.*, the *Felsberg Transmitter* decision, Bundesgerichtshof [BGH] [Federal Court of Justice], Nov. 7, 2002, 2003 GRUR Int. 470, 2003 GRUR 328, *in English translation in* 35 IIC 977 (2004) (Ger.) (confirming that royalty claims for broadcasts made from Germany into France are to be assessed in the light of the legal situation in France to the extent that the audience was located there).

120 For this hypothetical, see *supra* text accompanying notes 68 and 92.

marketplace.[121] But in countries where the unfixed mime work may not be protected, such as the United States and a few other countries, a critical question arises: Should the injunction spill over to constrain access in such countries? Harder cases may arise, for example, where rights vary in tenor or where equitable defenses or freedom of expression may come to bear differently from country to country.[122] We shall have to come back to such hard cases when we discuss finding a favorable forum to grant appropriate relief.[123]

Outside purely judicial proceedings, other remedies may be available for cross-border infringement, but only a sampling can be ventured here, without fully unpacking the conflicts questions they might raise. For example, treaty provisions may require a country of transit to stop infringing copies, usually in customs proceedings, before the copies reach any intended market.[124] Statutory provisions may allow for stopping the export of devices to circumvent technological safeguards, but it is unsettled what regard must be given to foreign or regional laws.[125] Furthermore, a rightholder may send a notice of allegedly infringing materials to an Internet-

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121 *Compare* Playboy Enters., Inc. v. Chuckleberry Publ'g, Inc., 939 F. Supp. 1032 (S.D.N.Y. 1996) (reformulating an injunction so that it compels either shutting down a website or modifying it to avoid using an infringing trademark in addressing U.S. customers, while noting the success of similar suits in other major markets), *and* Applied Research Sys. Holding N.V. v. Organon, Gerechtshof [Court of Appeals], The Hague, Feb. 3, 1994, *in English translation in* 28 IIC 558 (1997) (Neth.) (applying, in principle, the laws of protecting countries, respectively, to enjoin patent infringement alleged in each of them, while presuming that these laws conformed to common European standards).

122 *Compare* Abend v. MCA, Inc., 863 F.2d 1465, 1479 (9th Cir. 1988) (declining to enjoin the screening of a film based on a protected story, in order to avoid denying "the public the opportunity to view a classic film for many years to come"), *aff'd*, 495 U.S. 207, 236 (1990), *with* the *Germania 3* decision, Bundesverfassungsgericht [BVerfG] [Federal Constitutional Court], June 29, 2000, 2001 GRUR 149 (Ger.) (declining to enjoin the publication of a play, after broadly construing the quotation exception of German copyright law in order to avoid impairing constitutionally protected freedom of art), *further glossed infra* note 159.

123 *See infra* text accompanying notes 157-61.

124 *See* Berne Convention, *supra* note 6, art. 16; TRIPs Agreement, *supra* note 9, arts. 51–60.

125 *See, e.g.*, Nintendo Co., Ltd. v. Playables, Ltd., [2010] EWHC 1932, para. 42 (Ch.) (U.K.) (construing section 296ZD of the U.K. Copyright, Designs and Patents Act, relative to export sales of circumvention devices, as not having extraterritorial effect but rather as applying *per se* to U.K. dealings). *But cf.* Football Ass'n Premier League, Ltd. v. QC Leisure and Karen Murphy v. Media Protection Serv., Ltd., Joined Cases C-403/08 and C-429/08, Court of Justice of the European Union (C.J.E.U. Oct. 4, 2011), paras. 80–89, 105–17, [2012] Fleet St. Rep. 1 (holding it contrary to E.U. freedom of ser-

service provider hosting these materials for access to members of the public. Now, under many laws, such a notice may support a showing of the *scienter* necessary to make that service provider liable for the infringing posting.[126] To escape such liability, the service provider may take down the posting, subject to domestic proceedings for restoring access to it.[127] Encryption, geolocation measures, and related technological safeguards, often coupled with contract, can also control access across borders.[128] However, resulting choice-of-law questions have yet to be thrashed out in the courts.[129]

D. Trace Chain of Title Across Borders

With the fourth guideline, we shift our focus to the vesting and transfer of rights. Standing is needed to sue or to commence other proceedings, and such standing has to be based at least on some color of title. Out of this threshold issue, a series of questions arise to take counsel from the vesting of rights to transfers, whether effectuated contractually or as a matter of law, ultimately through chain of title worldwide.[130] The following all-too cursory survey of resulting issues can merely touch on a few points at which diverse laws may be applicable to any chain of title to rights enforceable in one country or another and, eventually, worldwide.

Standing to sue may be variously characterized as a procedural issue, as a substantive copyright issue, or as a chain-of-title issue, with possibly differing consequences for the choice of law.[131] In any event, to obtain

vices contractually to limit sales of decoders across E.U. borders in order to obtain premium prices).

[126] For further analysis, see Allen N. Dixon, *Liability of Users and Third Parties for Copyright Infringements on the Internet: Overview of International Developments*, *in* PEER-TO-PEER FILE SHARING AND SECONDARY LIABILITY IN COPYRIGHT LAW, *supra* note 50, at 12; Graeme B. Dinwoodie, Rochelle C. Dreyfuss, & Annette Kur, *The Law Applicable to Secondary Liability in Intellectual Property Cases*, 42 N.Y.U. J. INT'L L. & POL. 201 (2010).

[127] *See, e.g.*, 17 U.S.C. § 512(c)–(g) *passim* (2010) (counter-notices to restore online postings).

[128] *See generally* Paul Goldstein, *Copyright and Its Substitutes*, 1997 WIS. L. REV. 865 (pointing out that key policies motivating copyright laws may be put at risk by the use of such self-help measures).

[129] *See, e.g.*, Marketa Trimble, *The Future of Cybertravel: Legal Implications of the Evasion of Geolocation*, 22 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 567 (2012) (analyzing conflicts that some of such measures may raise).

[130] For further analysis, see Geller, *International Copyright: The Introduction*, *supra* note 8, §§ 6[2]-6[3]; Geller, *Conflicts of Laws in Copyright Cases*, *supra* note 73, at 355-86 *passim*.

[131] *See, e.g.*, the *Scientology* decision, Rechtbank [District Court], The Hague, June 9, 1999, [1999] 7 INFORMATIERECHT/AMI 110, *in English translation in* [2000] Euro. Copr. & Design Rep. 83 (Neth.) (applying Dutch law to deter-

standing to assert copyright, it need not always be necessary to prove full chain of title, although a few courts have conflated such standing and ownership of the copyright being asserted.[132] The laws in most Berne countries do apply, or expand upon, Berne provisions that trigger presumptions of an author's or publisher's standing to sue once the name of one or the other appears on a work in appropriate cases.[133] Some laws strengthen Berne presumptions of standing with presumptions of entitlement that arise out of national registrations.[134] Some laws grant collecting societies standing to collect certain copyright royalties, but not entitlements to pocket or divert them.[135]

It is, in principle, easy to anchor the chain of title to copyright. In most cases, copyright initially vests in the flesh-and-blood author of a work.[136] Hard cases do arise, most notably cases of joint or team works or of works made on the job. Different laws deal with such cases differently, sometimes with presumptions or rules allocating rights upon creation among authors or to their principals, sometimes by redefining "author" to include principals. To focus on such initial vesting, which will anchor chain of title, assume *arguendo* that no express contract addresses this issue where a number of creators originate a work together or else where a

mine standing to sue on Dutch copyright and U.S. law to ascertain the extent of any copyright transfer invoked as a basis for suit).

132 *Cf.* Itar-Tass Russian News Agency v. Russian Kurier, Inc., 153 F.3d 82 (2d Cir. 1998) (rejecting the standing of Russian newspapers to sue for infringement of U.S. copyright because, under Russian law chosen to govern copyright ownership, they could not prove factual predicates of such ownership).

133 Berne Convention, *supra* note 6, art. 15. *Compare* the *Bora Bora* decision, Bundesgerichtshof [BGH] [Federal Court of Justice], July 10, 1986, 1986 GRUR 887, *in English translation in* 19 IIC 411 (1988) (Ger.) (holding that names on published copies suffice to trigger Berne standing to sue), *with* Sté. Gare O Loup c. Sté. Jenny Ben Diffuse Faucon, Cour d'appel [Intermediate Court], 4e ch., Paris, Feb. 9, 1995, 166 RIDA 310 (1995) (Fr.) (mooting conflict between U.S. and French definitions of "author" in a case of piracy by allowing a U.S. corporation, exploiting a work in France in its own name, to sue).

134 *See, e.g.*, Circle Film Enters., Inc. v. Can. Broad. Corp., [1959] S.C.R. 602 (Sup. Ct.) (Can.) (holding that a domestic copyright certificate raises presumptions of entitlement overriding those adopted from Berne article 15).

135 *Cf.* the *GEMA/Austro-Mechana* decision, Oberster Gerichtshof [Supreme Court], July 14, 1987, 1988 GRUR Int. 365 (Austria) (while allowing a national statute to empower a domestic society to collect royalties, precluding such law from authorizing that society to use foreign claimants' royalties for the benefit of domestic members).

136 Note that neighboring or related rights in performances may initially vest in performers, with caveats for groups of performers; in recordings, in the recording producers; in broadcasts, in the broadcasters. *Cf.* Rome Convention, *supra* note 40, arts. 4–6 (protecting such parties as if they were initial vestees).

creator originates a work subject to a principal such as an employer. In such cases, choice-of-law decisions vacillate about which law or laws should determine the initial vestee of copyright in resulting works: some decisions apply the law of the source country of the work at issue,[137] and some apply the laws of the protecting countries respectively.[138] Since, in such cases, the work at issue originates out of consensual relationships among multiple parties, I have argued that, whatever law in theory determines "author" as initial vestee, such consensus may at times provide a basis in practice for initially allocating rights among team creators and, where applicable, principals.[139]

What law or laws may apply to a contract transferring copyrights that are effective abroad or even worldwide?[140] The issue may turn on characterization, as illustrated by the case of a French ghost writer who sought relief from such a U.S.-made contract hiring the writer. The court, applying the French rule barring the alienation of French moral rights, ordered the attribution of authorship to the ghost writer throughout France; however, holding terms of payment to be subject to U.S. contract law, it left these terms in effect, despite contrary French law on point.[141] Generally

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137 *See, e.g.*, Itar-Tass Russian News Agency v. Russian Kurier, Inc., 153 F.3d 82, 89-94 (2d Cir. 1998) (applying Russian law to ownership of copyright in a Russian work in a case of U.S. infringement).

138 *See, e.g.*, the *Spielbankaffaire* decision, Bundesgerichtshof [BGH] [Federal Court of Justice], Oct. 2, 1997, 1999 GRUR 152, *in English translation in* 30 IIC 227 (1999) (Ger.) (holding that the law of the protecting country determines authors in whom rights initially vest); Huston c. Turner Entertainment (the *Asphalt Jungle* decision), Cass. civ. [Supreme Court], 1re ch., May 28, 1991, 149 RIDA 197 (1991), *in English translation in* 23 IIC 702 (1992) (Fr.), *followed on remand*, Versailles, Cour d'appel [Intermediate Court], ch. réunies, Dec. 19, 1994, 164 RIDA 389 (1995) (same approach, here for moral rights).

139 *See* Geller, *International Copyright: The Introduction*, *supra* note 8, § 6[2][b][ii]; Geller, *Conflicts of Laws in Copyright Cases*, *supra* note 73, at 363-66. *Cf.* F. Jay Dougherty, *Not a Spike Lee Joint? Issues in the Authorship of Motion Pictures Under U.S. Copyright Law*, 49 UCLA L. Rev. 225, 282-334 *passim* (2001) (analyzing creative contributions to films, reviewing U.S. and foreign laws governing the ownership of copyright in such team works, and proposing that courts allow producers to use contributions upon paying equitable royalties, absent binding contractual provisions on point).

140 Note that, once issues arise with regard to a transfer arguably subject to the law of a federated state, one has to ask whether that law may be a federal or state law. *See, e.g.*, Cohen v. Paramount Pictures Corp., 845 F.2d 851, 854 (9th Cir. 1988) ("the license must be construed in accordance with the purpose underlying [U.S.] federal copyright law"); Rodrigue v. Rodrigue, 218 F.3d 432 (5th Cir. 2000) (holding state law regarding the marital community to be in "compatible combination" with U.S. federal copyright law).

141 Bragance c. Michel de Grèce, Cour d'appel [Intermediate Court], 1re ch., Paris, Feb. 1, 1989, 142 RIDA 301 (1989) (Fr.).

speaking, then, if a rule bearing on contractual alienation is characterized as a copyright rule, as was the French rule here, it may apply territorially as part of the law of the protecting country to validate or invalidate the transfer of such rights as are effective in that country. For example, other author-protective rules, notably terminating transfers, have thus been applied, but only to the extent that the underlying law did not allow other dispositions.[142] If a rule is characterized as a contract rule, it may apply according to any choice-of-law clause freely negotiated into the contract at issue. Or it may apply according to choice-of-law principles applicable absent such contractual choice or to specific rules applicable in special cases.[143] In hard cases, where copyright and contract rules are not easily disentangled, solutions may lie only in equitable compromises.[144]

Rights may be transferred as a matter of law. Consider transfers in inheritance, within a marital community, in the realization of creditors' claims, or in corporate or like reorganizations. The case law is neither plentiful nor settled with regard to the choice of laws applicable to such transfers by law of the copyrights accorded in different countries. For example, inheritance is usually governed by the law of the decedent's home country, subject to caveats that are scattered throughout sparse case law with regard to copyright.[145] Furthermore, priority issues may arise across borders, whether under transfers by contract or by law: for example, different parties may claim rights in the same work under successive trans-

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142 *Compare* Sté. Boosey & Hawkes, Ltd. c. Taverne, Trib. civ., Bayonne, May 16, 1972, *as commented by* Henri Desbois, Note, 25 Rev. Trimestrielle Dr. Com. 624 (1972) (Fr.) (finding an author's transfer of U.K. rights terminated under the U.K. 1911 Act), *with* Redwood Music, Ltd. v. B. Feldman & Co., Ltd., [1979] Rep. Pat. Cases [R.P.C.] 385, 404-06 (Ct. App.) (U.K.), *aff'd sub nom.* Chappell & Co., Ltd. v. Redwood Music, Ltd., [1981] R.P.C. 337 (H.L.) (finding that U.S. authors' estates had contractually transferred reversionary interests in U.K. rights, as allowed by the U.K. 1911 Act).

143 *Compare* Restatement (Second) of Conflict of Laws, *supra* note 30, §§ 186-88 (encapsulating U.S. case law), *with* Council Regulation (EC) 593/2008 of the European Parliament and of the Council of 17 June 2008 on the law applicable to contractual obligations (Rome I), 2008 O.J. (L 177) (governing laws applicable to most E.U. contractual issues).

144 *See, e.g.*, Geller, *International Copyright: The Introduction*, *supra* note 8, § 6[3][c][ii]; Geller, *Conflicts of Laws in Copyright Cases*, *supra* note 73, at 375-81 (exploring such solutions for waivers of moral rights).

145 *Compare* the *Brancusi* case, Oberlandesgericht [OLG] [Court of Appeal], Munich, Sept. 17, 2009, 2009 Kunst u. Recht 198 (Ger.) (applying French law to inheritance issues where the deceased, a Romanian-born sculptor, had been a French national, and German law to decide whether German rights may devolve on heirs), *with* the *Giacometti* case, Cour d'appel [Intermediate Court], 1e ch., Paris, Sept. 23, 1997, 176 RIDA 418 (1998) (Fr.) (invoking Berne article 6*bis* to support applying French law to standing to assert a Swiss sculptor's French moral rights after death).

fers, or opposing creditor's claims may be asserted, say, in bankruptcy. Rare case law on point, usually according priority to the first transfer in time, has sometimes taken account of the fact that few countries have registration systems to record priorities among copyright transfers.[146]

E. Shop for a Favorable Forum

The last guideline here, and the trickiest to follow, presupposes what should already be abundantly clear: While infringement may take place in any one country, suit may at times be best brought in still another jurisdiction.[147] For example, in Internet cases, where infringement may be threatened worldwide, claimant's counsel has pressing interests in suing in a court or a few courts best positioned to grant relief effective in as many countries as possible.[148] But such forum-shopping is risky, necessitating judgment calls based on multiple and often volatile tactical and strategic factors. I shall here briefly revisit some factors that I have already broached, plus a few others.

At the threshold, jurisdiction has to be established. A court needs jurisdiction, not only over parties and subject matter, but to enforce relief. Forum law governs jurisdiction, but the enforcement of one court's orders or awards by other courts may turn on the laws or treaties binding on these other courts.[149] A regulation effective for courts in the European

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146 *See, e.g.*, R. Griggs Group Ltd. v. Evans (No. 2), [2004] EWHC 1088, para. 140 (Ch.) (U.K.) (confirming an initial transferee's copyrights worldwide, as against a later transferee with notice, "[a]bsent some special rule" locally based on registration), *aff'd*, [2005] EWCA Civ 11 (Ct. App.). *But cf.* U.N. Convention on the Assignment of Receivables in International Trade, arts. 26-32, Dec. 12, 2001, 41 I.L.M. 776, *available at* http://www.uncitral.org/uncitral/uncitral_texts/security/2001Convention_receivables.html (pending treaty with choice-of-law provisions bearing on the priority of transfers of rights in copyright royalties, security interests, etc.).

147 Increasingly, fora have been taking jurisdiction over actions for infringement abroad. *See, e.g.*, Lucasfilm v. Ainsworth, [2011] UKSC 39 (Sup. Ct.) (U.K.) (allowing suit in a U.K. court for infringement abroad, while overturning precedents to the contrary).

148 Note that different systems may variously deal with suits duplicating parties and causes of action in different fora. *Compare* Perfect 10, Inc. v. Google, Inc., 2011 FC 348 (Fed. Ct.) (Can.) (declining to stay, for *forum non conveniens*, a suit in Canada for transmissions received in Canada, even given an allegedly parallel U.S. action), *with* Brussels I Regulation, *supra* note 58, art. 27 (given a prior pending action in one member state, a court in another such state may not adjudicate a subsequent action "involving the same cause of action and between the same parties").

149 Few countries are bound by the Hague Convention of 1 February 1971 on the Recognition and Enforcement of Foreign Judgments in Civil and Commercial Matters, Feb. 1, 1971, 1144 U.N.T.S.249, *available at* http://www.hcch.net/index_en.php?act=conventions.text&cid=78. Accordingly, the Hague

Union governs such issues, subject to an increasingly differentiated case law construing how the regulation bears on the availability and enforceability of relief across the Union.[150] Rules governing jurisdiction over parties and subject matters, as well as the reach of relief, can be differently complex in any one federation, say, the United States, than in others with both state and federal courts.[151] Common-law courts, absent provisions to the contrary, have discretion to decline to exercise jurisdiction on the grounds of *forum non conveniens*.[152]

Turn to conflicts of laws. Each court will determine its own approach to choosing among conflicting laws.[153] Taking plaintiff's perspective, suppose, *arguendo*, a pair of deep-pocketed defendants who may be jointly and severally liable for the same allegedly infringing transactions. Suppose, as well, that each of these parties is domiciled in a distinct country, whose courts have jurisdiction over the party and enough of its assets to satisfy the claims brought. Plaintiff, in deciding where to sue at least one of such hypothetically attractive defendants, may ask which court has the choice-of-law approach most favorable to its claims. It would seem that, in shopping for such a favorable forum, counsel need only follow a results-oriented reasoning, canvassing laws that may conflict on key issues and

Conference on Private International Law has its Judgments Project, *with developments available at* http://www.hcch.net/index_en.php?act=text.display&tid=153. For its uncertain application to intellectual property, see Rochelle C. Dreyfuss & Jane C. Ginsburg, *Draft Convention on Jurisdiction and Recognition of Judgments in Intellectual Property Matters*, 77 CHICAGO-KENT L. REV. 1065 (2002).

150 *See* Brussels I Regulation, *supra* note 58. *Compare* eDate Advertising GmbH v. X and Martinez v. MGN, Ltd., Joined Cases C-509/09 and C-161/10, Court of Justice of the European Union (C.J.E.U. Oct. 25, 2011), *available at* http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=CELEX:62009CJ0509:EN:HTML (allowing jurisdiction over a privacy case in a court of the country where the victim has "his centre of interests," but restricting it in countries of access to damages respectively incurred in each of them), *with* Renault SA v. Maxicar SpA & Orazio Formento, Case C-38/98, European Court of Justice (E.C.J. May 11, 2000), 2000 E.C.R. I-2973 (compelling an Italian court to enforce the judgment of a French court for infringement of a French right in designs, though no similar Italian right existed).

151 *See, e.g.*, 28 U.S.C. § 1332 (2012), *available at* http://uscode.house.gov/download/title_28.shtml (diversity of parties); *id.* § 1338(a) (jurisdiction over U.S. copyright suits).

152 *See, e.g.*, Boosey & Hawkes Music Publishers, Ltd. v. Walt Disney Co., 145 F.3d 481, 492 (2d Cir. 1998) (vacating dismissal for *forum non conveniens* upon failure to consider whether any adequate alternative forum was available, while outlining interests at stake in the case that might favor or disfavor exercising jurisdiction, such as location of evidence and witnesses, convenience of trying issues in one proceeding, and readiness to go to trial).

153 *See supra* text accompanying note 77.

anticipating how this or that court may choose among these laws.[154] A court, however, also reasoning backwards from results toward which it leans, may reach decisions that are not so easily predicted, notably if any law it may choose contains open-ended provisions or if its choice-of-law approach is discretionary. Thus apparently clear and authoritative choice-of-law precedents may not always offer reliable guidance to anticipating a court's dispositions among conflicting laws.[155]

Finally, it has to be asked whether any court considered for suit could and would grant the relief sought.[156] Assuming the judicial capacity and willingness to fashion remedies applied for, return to the problem of territorially overreaching injunctive relief.[157] Imagine, for example, an author who had licensed a director to stage her play for access online, only to discover that this licensee's parody-like staging not only went beyond the scope of her license, but would run counter to her creative intentions: asserting her moral right to integrity, she then sues to enjoin the licensee from enabling worldwide access online.[158] Assume that a court takes jurisdiction over this suit: it then faces hard remedial choices: on the one hand, denying the author all relief would leave her claims sounding in moral rights, otherwise strong in many countries, without effect; on the other, acceding to her petition for an injunction with worldwide effect could ignore the licensee's defenses in many countries.[159] For example, the court may consider converging limitations to copyright such as U.S. fair use and German *freie Benutzung* that, along with freedom of expression, could serve as bases for declining to enjoin access to the new staging

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154 *See supra* Part III.C.

155 *See, e.g.*, Heriot v. Byrne, 2008 U.S. Dist. LEXIS 60600, at *17 (N.D. Ill. July 21, 2008) ("The *Itar-Tass* court seemed to leave open the possibility that article 14*bis*(2)(a) of the Berne Convention may obviate the significant relationship choice of law test with respect to cinematographic works.").

156 *See supra* note 108.

157 *See supra* text accompanying notes 120–123.

158 There is another premise here: the author, in licensing the staging, did not waive her moral right to integrity. For further analysis, see *supra* text accompanying notes 141-44.

159 Consider but one country, Germany, whose case law displays tensions on point. *Compare* the *Die Weber* decision, Kammergericht [KG] [Court of Appeal], Berlin, June 21, 2005, *available at* http://openjur.de/u/226399.html (Ger.) (in principle allowing some changes in the licensed staging of a play, but confirming the injunction prohibiting the staging with other changes, notably "murderous fantasies" introduced into the script, as lacking sufficient basis in the parties' understandings or in the play and as thus violating the author's moral rights), *with* the *Germania 3* decision, *supra* note 122 (to protect artistic freedom, declining to enjoin the publication of a play, although it incorporated large passages from Brecht's works, critically and without consent).

in many countries.[160] It is submitted that, in many such cases, a court may accommodate diversely protected interests by tailoring minimally invasive relief.[161]

Before concluding, I shall allow myself a penultimate editorial comment. To my mind, a choice-of-law approach has much to recommend itself to the extent that it minimizes forum-shopping. Here we have another reason for following the Berne-based territorial approach, which would apply the laws respectively effective wherever protection is sought and available: allowing little discretion, it would not encourage forum-shopping and, to that extent, would enhance legal certainty.[162] However, as we have just seen, in especially hard cases, courts may still have to exercise their remedial discretion to accommodate laws in conflict. Such solutions could appear variously equitable in the eyes of different forum-shoppers.[163]

V. CONCLUSION

The Berne Convention has exercised a "more or less gentle and gradual pressure toward harmonization" on copyright laws worldwide since 1886.[164] The United States, however, had been an exception to this trend, joining the Berne Union only belatedly, in 1989.[165] The *Nimmer* treatise introduced U.S. counsel and courts to the Berne regime in advance of this critical juncture. Soon afterward, copyright law itself was to face new challenges.[166]

Globalizing media trends, culminating in the Internet, have since subjected the Berne treaty regime itself to pressures that have been making cross-border copyright cases more and more perplexing. From my present perspective, for which I have Mel Nimmer to thank, I have here raised

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160 *See supra* text accompanying notes 25–32 *passim.*

161 *E.g.*, an order requiring the staging shown online to link back to a version acceptable to the author. For this solution, see Paul Edward Geller, *Beyond the Copyright Crisis: Principles for Change*, 55 J. COPYRIGHT SOC'Y 165, 184-85 (2008), *updated and linked to illustrative examples in* Paul Edward Geller, *Copyright Principles: An Ongoing Inquiry*, principle 3 [hereinafter Geller, *Principles*], *available at* http://www.criticalcopyright.com/principles.htm.

162 *See* Geller, *International Copyright: The Introduction*, *supra* note 8, § 3[1][a][ii].

163 *See supra* text accompanying notes 156–161.

164 ADOLF DIETZ, COPYRIGHT LAW IN THE EUROPEAN COMMUNITY 9 (English translation 1978).

165 There was, however, a great U.S. treatise written on international and comparative copyright early in the twentieth century: STEPHEN P. LADAS, THE INTERNATIONAL PROTECTION OF LITERARY AND ARTISTIC PROPERTY (2 vols. 1938).

166 *See supra* Part II.

problems in choice-of-law methodology that have become more acute in just such cross-border cases.[167] To help practitioners reckon with resulting opportunities and risks, I have also outlined an admittedly provisional set of guidelines for handling such cases.[168] It remains to be seen whether, following these rules of thumb, counsel would often prompt courts to reach more principled decisions.[169]

[167] *See supra* Part III.
[168] *See supra* Part IV.
[169] For speculation on point, see Geller, *Principles*, *supra* note 161, principle 10.