No. 10-545

In the

SUPREME COURT OF THE UNITED STATES

LAWRENCE GOLAN, ET AL.,

Petitioners,

v.

ERIC H. HOLDER, JR., ATTORNEY GENERAL, ET AL.,

Respondents.

On Writ of Certiorari
To The United Sates Court of Appeals
For The Tenth Circuit

BRIEF OF *AMICUS CURIAE* PROFESSOR DANIEL J. GERVAIS IN SUPPORT OF PETITIONERS

ALAN C. FRIEDBERG
Counsel of Record
PENDLETON, FRIEDBERG, WILSON & HENNESSEY, P.C.
1875 Lawrence Street, 10th Floor
Denver, CO 80202
303-839-1204
afriedberg@penberg.com

Counsel for Amicus Curiae Daniel J. Gervais

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INTEREST OF AMICUS CURIAE[1]

Professor Daniel J. Gervais is an internationally respected expert on intellectual property law, with deep knowledge of international issues relating to intellectual property, including the Berne Convention. Professor Gervais is Professor of Law at Vanderbilt University Law School and Co-Director of Vanderbilt's Technology and Entertainment Law Program. Before joining Vanderbilt, he was Acting Dean and Vice-Dean (Research) at the University of Ottawa (Common Law Section), and taught intellectual property law at various other institutions around the world, and was Visiting Scholar at Stanford Law School. Professor Gervais has written extensively about intellectual property law, having authored or co-authored six books, edited or contributed to twenty-two others, and written forty-two journal publications in the field. His book on the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) is a leading textbook on international intellectual property law and has been cited by the European Court of Justice and a number of national courts.

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[1] Pursuant to Rule 37.6, *amicus* states that no counsel for a party authored this brief in whole or in part, and no person or entity other than *amicus* and his counsel made a monetary contribution to the preparation or submission of this brief. Counsel of Record states that *amicus* Gervais is the author of this brief. Pursuant to Rule 37.3(a), letters of consent to file this brief from petitioners and respondents have been filed with the Clerk of the Court.

Amicus has a compelling interest in this case. He was previously Legal Officer at the General Agreement on Tariffs and Trade (GATT), responsible for the TRIPS negotiations, and Head of the Copyright Projects Section at the World Intellectual Property Organizations (WIPO). As a former officer of international organizations committed to ensuring compliance with international intellectual property agreements, Professor Gervais has an interest in seeing those agreements properly interpreted and applied in the United States and other member states. *Amicus* believes that Congress could have granted a more limited form of retroactive protection to works in the public domain in order to meet its international obligations while respecting the constitutional rights of third parties.

SUMMARY OF ARGUMENT

The Berne Convention leaves member states wide latitude to set the conditions under which works in the public domain receive retroactive copyright protection when they adhere to the Convention. The Convention itself does not mandate that any particular level of protection be granted to such works because, as both the negotiating history and secondary literature recognize, the drafters of the Convention recognized that member states would face implementing constraints in their own countries. Whether or not the United States recognized the flexibility it was left when it joined the Convention, it is clear that Congress could have granted a more limited form of retroactive protection to works in the public domain in order to meet its international

obligations while protecting the constitutional rights of third parties.

ARGUMENT

I. THE BERNE CONVENTION DOES NOT MANDATE THE PRECISE SCOPE OF RETROACTIVE PROTECTION DUE TO WORKS IN THE PUBLIC DOMAIN

The United States joined the Berne Convention for the Protection of Literary and Artistic Works in 1989, adhering to its most recent version, the 1971 "Paris Act." Article 18 of the Paris Act addresses how member states should implement the Convention at their time of entry (also known as "application in time"). Article 18(1) provides that: "This Convention shall apply to all works which, at the moment of its coming into force, have not yet fallen into the public domain in the country of origin through the expiry of the term of protection." Berne Convention for the Protection of Literary and Artistic Works, Art. 18(1), September 9, 1886, *as last revised* at Paris on July 24, 1971, 1161 U.N.T.S. 30 [hereinafter "Berne Convention"]. Article 18(2) goes on to clarify that "[i]f, however, through the expiry of the term of protection which was previously granted, a work has fallen into the public domain of the country where protection is claimed, that work *shall not* be protected anew."[2] *Id.* at Article 18(2), emphasis added. In other words, if a

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[2] Proponents of a very restrictive reading of Article 18(3) tend to emphasize the "shall" in Article 18(1) ("shall apply") but not this second "shall not." The Convention clearly establishes two *equally important principles.*

work has fallen into the public domain because its term of protection expired *either* in the work's country of origin or in the country where protection is claimed, then it need not be protected when the Convention enters into force.

Taken together, Articles 18(1) and 18(2) provide that a work already in the public domain should be protected anew — that is, removed from the public domain and placed (back) in the exclusive domain of the foreign copyright holder(s) — *only* in the specific circumstance where that work both remains protected in its country of origin *and* is not protected in the country where protection is claimed for a reason *other* than the expiration of a term of protection previously granted (*e.g.*, for failure to comply with a registration requirement). Thus, for example, if a work was protected for the life of the author plus fifty years (the Berne Convention minimum, see Article 7) and a country joining the Convention had a previous term of protection of twenty-eight years, then a work still protected in its country of origin but whose twenty-eight-year term of protection had expired in the country joining the Convention would not be protected anew. If, however, the work was still protected in the country of origin and was not protected in the country joining the Convention due to a failure to comply with a formality such as registration, then Articles 18(1) and (2) would impose a limited obligation to protect that work and, accordingly, remove it from the public domain, subject to Article 18(3).

In recognition of the very real hardship imposed on parties who relied on their legitimate

right to exploit unprotected works,[3] Article 18(3) provides that the above principles,

> shall be subject to any provisions contained in special conventions to that effect existing or to be concluded between countries of the Union. In the absence of such provisions, the respective countries shall determine, each in so far as it is concerned, the conditions of application of this principle.

Article 18(3) therefore provides that, in the absence of another implementing agreement between member states, each member country can decide how to apply retroactive protection to works in its public domain.

Under Article 18(3), Berne Union members thus have two options: making a special convention or determining "conditions." On the former, a special convention such as the TRIPS Agreement could have been used to modify Article 18 or determine a more precise set of conditions. The Agreement was negotiated in the relevant time frame for U.S. implementation of the Convention (that is, between 1987 and 1994).[4] The United States asked and

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[3] See 1 Sam Ricketson & Jane C. Ginsburg, INT'L COPYRIGHT AND NEIGHBOURING RIGHTS 333 (2D ED. 2006) (noting the need, under Article 18, "to strike some balance between . . . 'acquired rights' or 'reliance interests' and the newly recognized rights of the foreign author").

[4] See Daniel Gervais, THE TRIPS AGREEMENT: DRAFTING HISTORY AND ANALYSIS, 3D ED., 12-27 (2008).

obtained agreement that moral rights protected under Article 6*bis* of the Berne Convention not be incorporated into the TRIPS Agreement.[5] It could have tried to obtain concessions on retroactive protection. Obtaining that concession from U.S. trading partners, in particular the Europeans, was not an easy task.[6] Moral rights matter a great deal to most European countries and others around the world.[7]

The second option, absent a special convention, is to impose "conditions" on the retroactive protection. Here, the Convention imposes no particular limits (or requirements) on such conditions. A country joining the Berne Convention may decide to offer protection to parties who have relied on a work in the public domain (so-called "reliance parties"), though under the Convention it does not have to do so. Conversely, while the Berne Convention clearly requires that *some* level of protection be given to works by foreign authors whose works have entered the public domain (other than by expiration of previous copyright), the scope of that protection is essentially left to the discretion of each member state.

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[5] The second sentence of Article 9(1) of the Berne Convention excludes the possibility of raising a violation of Article 6*bis* and other related provisions in the dispute-settlement process of the World Trade Organization.

[6] *See* Gervais, note 4, *supra*, 213-218.

[7] See Ricketson & Ginsburg, note 3, *supra*.

The United States likely will argue that Article 18(3) should be interpreted narrowly and that Berne Convention members should strive to limit the protection of reliance parties as much as possible because Article 18 establishes a baseline principle that existing works should be protected at the time of entry. Such a position lacks a textual basis in the text of the Paris Act of the Berne Convention. It is also hard to reconcile with (a) Article 18(2) and the principle that works whose term of protection has expired "*shall not* be protected anew" and (b) the principle of international law that States can do all that is not prohibited. *Military and Paramilitary Activities in and Against Nicaragua (Nicaragua v. United States)*, 1986 I.C.J. 14 (June 27, 1986) ("in international law there are no rules, other than such rules as may be accepted by the State concerned, by treaty or otherwise"). Article 18(3) specifically provides that States can decide which conditions to impose when restoring copyright protection.

Indeed, the text of the Convention could be construed to take the position that it is desirable to apply retroactive protection *narrowly*. For example, Article 18(2) does more than simply state that works whose term of protection has expired should not be retroactively protected: instead, it affirmatively commands member states that such works "*shall not* be protected" (emphasis added), suggesting that a member state may actually violate the Convention by doing so. A similar sentiment against broad protection is found in Article 7 of the Convention, which contains a rule known as the "comparison of the terms of protection": under Article 7, a Berne Convention member country does not have to extend

protection to a work no longer protected in its country of origin — for example, if the country of origin has a shorter term of protection.[8] It is a cardinal principle of copyright law that people can use the public domain at will so that the copyright cycle can continue, making copyright "the engine of free expression." *Golan v. Gonzales*, 501 F.3d 1179, 1183 (10th Cir. 2007). Removing works from the public domain goes against this principle and thus should be considered with utmost caution. *See* Thomas Gordon Kennedy, *GATT-Out of the Public Domain: Constitutional Dimensions of Foreign Copyright Restoration*, 11 ST. JOHN'S J. LEGAL COMMENT 545, 578 (1996). Stating that Article 18(3) must necessarily be interpreted narrowly is thus highly questionable.

II. THE NEGOTIATING HISTORY OF THE BERNE CONVENTION REFLECTS AN INTENT TO PERMIT MEMBER STATES TO IMPLEMENT ARTICLE 18 AS THEY SEE FIT

The negotiating history of the Berne Convention confirms that member states were meant to have significant leeway in setting the level of retroactive protection to be afforded to works already

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[8] Berne Convention (1971), Article 7(8) ("[T]he term shall be governed by the legislation of the country where protection is claimed; however, unless the legislation of that country otherwise provides, the term *shall not exceed* the term fixed in the country of origin of the work") (emphasis added).

in the public domain.[9] Article 14 in the original 1866 text of the Convention — the provision corresponding to Article 18 in the 1971 Paris Act — read as follows: "Under the reserves and conditions to be determined by common agreement, this Convention shall apply to all works which at the moment of its coming into force have not yet fallen into the public domain in the country of origin." Berne Convention (1866), art. 14 *available in* WIPO: BERNE CONVENTION CENTENARY (1886-1986) (1986).[10] Thus, the original extent of a member state's obligation under Article 18 was left to be defined in a separate "common agreement." That agreement was ultimately codified in the Final Protocol of September 9, 1886 (adopted on the same date as the original text of the Convention). Paragraph 4 of the Protocol read as follows:

> [1] The common agreement provided for in Article 14 of the Convention is established as follows: [2] The application of the Convention to works which have not fallen into the public domain at the time when it comes into force shall take effect according to the relevant provisions contained in special conventions existing, or to be concluded, to that effect. [3] In the absence of such provisions between any countries of the Union, the respective countries shall

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[9] Article 32 of the Vienna Convention on the Law of Treaties, May 23, 1969, 1155 U.N.T.S. 331, specifically permits use of the negotiating history as an interpretive tool.

[10] All original texts were in French.

> regulate, each in so far as it is concerned, *by its domestic legislation*, the manner in which the principle contained in Article 14 is to be applied.

Id. at 228. The Final Protocol thus only established a general principle that there should be some retroactive protection, leaving it up to each country to conclude special conventions or to decide how that principle should be applied.[11] The Records of the 1885 Diplomatic Conference where the text of Article 14 was agreed upon are very clear: "As noted below, in connection with the Final Protocol, the implementation of the above Article [14] will be left to each country of the Union, which will decide on the conditions of retroactivity according to its own laws or specific conventions." *Id.* at 123.[12]

At the 1908 Revision Conference held in Berlin, Germany, Article 14 became Article 18 and the

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[11] It is of note that, at the time of the Paris revision, France proposed deletion of the reference to "conditions" in Article 14 and only a limited ability "to adopt transitional measures on the part of new accessions under paragraph 4 of the Closing Protocol." The proposal was met by German and British opposition "on the ground that, despite the lapse in time, absolute retroactivity might still injure 'legitimate [reliance] interests.'" 1 Ricketson & Ginsburg, INT'L COPYRIGHT AND NEIGHBOURING RIGHTS at 336.

[12] The 1896 Additional Act of the Convention modified Paragraph 4 of the Final Protocol to make it applicable to translations and to "new accessions to the Union." Berne Convention, Additional Act and Interpretative Declaration of Paris of May 4, 1896, BERNE CONVENTION CENTENARY, 228.

provisions of the Final Protocol of 1886, as amended in Paris in 1896, were incorporated into a single Article. Because Article 18 essentially took its final form at that Conference, the discussion on retroactive application at that Conference is illuminating. The Report of that Conference reads in part as follows: "Account had to be taken of the *de facto* situation existing in certain countries at the time the Convention came into force, of the interests of those who might have lawfully reproduced or performed foreign works without their authors' authorization." *Id.* at 158. There was thus a clear acknowledgment, over a hundred years ago, that certain third-parties might have legitimate interests existing in works that would be retroactively protected under the new Convention.

One notable difference between the 1886 version and the current version (adopted in 1908) is that, while the former allowed countries to "regulate, each in so far as it is concerned, *by its domestic legislation*, the manner in which the principle contained in Article 14 is to be applied," the latter allows countries to "determine, each is so far as it is concerned, the conditions of application" of the principle of restoration. *Compare* Berne Convention Final Protocol (1886) ¶ 4, *with* Berne Convention (1971), Article 18(3) (emphasis added). The current text is thus not limited to regulation by legislation; a court, for example, can now determine appropriate conditions for retroactive protection under the Convention. Indeed, the WIPO Guide to the Berne Convention specifically notes that "it is a matter therefore for each member country to decide on the limits of this retroactivity and, in litigation, for the

courts to take into account these acquired rights [of reliance parties]." WIPO, GUIDE TO THE BERNE CONVARTISTIC WORKS at 186 (1978).

The much more recent WIPO Copyright Treaty was adopted on December 20, 1996. *See* WIPO Copyright Treaty, Dec. 20, 1996, S. Treaty Doc. No. 105-17 (1997), 36 ILM 65 (1997).[13] Its application in time mirrors Article 18 of the Berne Convention (1971). *See id.*, Article 13. The Records of the Diplomatic Conference at which that treaty was adopted contain the following statement from the Conference Chairman, discussing possible options for a provision on application in time:

> [The Chairman] believed that . . . there would be no retroactive effect concerning prior acts[,] and the provisions of the Treaty would not introduce an obligation to countries to change their laws in such a way that prior agreements would be changed. He felt that that was *in most countries probably already constitutionally prohibited.* . . . He acknowledged that revival of rights in some cases would cause practical problems.

RECORDS OF THE DIPLOMATIC CONFERENCE ON CERTAIN COPYRIGHT AND NEIGHBORING RIGHTS QUESTIONS, GENEVA, 1996, Vol. II, 727 (1999)

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[13] The United States adhered to the WIPO Copyright Treaty as of March 6, 2002.

(emphasis added). Undeniably aware of the problems that would be caused by application of the Convention to works in the public domain at the time of a member country's implementation, Article 18 thus grants wide discretion to members to determine the conditions of application of retroactivity.

III. THE SECONDARY LITERATURE COMMENTING ON THE BERNE CONVENTION ALSO CONFIRMS THE FLEXIBILITY LEFT TO MEMBER STATES

The academic commentary on Article 18 confirms that, from the beginning, member States were left with broad implementing discretion. Indeed, as Sam Ricketson reiterated in the second edition of his Berne Convention commentary (coauthored with Professor Jane C. Ginsburg of Columbia University), Article 18(3) "leave[s] considerable latitude to countries as to how they will implement the principle of retroactivity, enabling them to safeguard any rights which have been acquired in the previous situation where no legal protection applied." 1 Ricketson & Ginsburg, INT'L COPYRIGHT AND NEIGHBOURING RIGHTS at 342. As a result, "wide differences are to be seen in the provisions adopted by member countries." *Id.* It is very difficult to conclude from anything in the text of the Convention that any measure adopted under Article 18(3) must thus be very brief or indeed temporary. It must be *transitional*, which it is by definition as a measure destined to ensure an orderly transition from non-Berne to Berne status, but transitional is not synonymous with brief or short-lived. Because Articles 18(1) and (2) establish two equally important principles, Article 18(3) must

be interpreted as conferring latitude to effect its purpose, namely protect the legitimate rights of reliance parties for as long as is required. Additionally, proposals to set specific time limits in Article 18(3) were rejected by Berne member states.

One of the earliest detailed commentaries published in English on the Berne Convention was William Briggs, THE LAW OF INTERNATIONAL COPYRIGHT (1906) (reprinted 1986). Discussing Article 14 (the predecessor to Article 18), Briggs noted that:

> These qualifications [in the Final Protocol] proceeded from a desire to safeguard vested interests. In the absence of international protection foreign works had at one time been universally looked upon as lawful objects for native reproduction, either in their original form, or by adaptation or translation. Capital had been sunk, labour had been employed in making these valuable reproductions; lawful interests had been thereby created, and a quasi-property had thus been acquired. A State which had tolerated the indiscriminate reproduction of foreign works would hardly be justified in giving an unqualified consent to the principle of retroactivity, without making due provision for the securing of this quasi-property. Hence the rule of Art. 14 was not made absolute, and it was left to each country to regulate by particular

> agreement or by domestic law the mode in which it should be applied.

Id. at 266. Briggs goes on to note not only that proposals by Belgium and France to remove the flexibility contained in the Final Protocol at the 1896 Revision Conference were defeated (*id.* at 267), but that when the United Kingdom implemented the original text of the Convention, its implementing legislation provided that "nothing in this section [of the International Copyright Act of 1886] shall diminish or prejudice any rights or interests arising from or in connection with [the production of any work in the United Kingdom prior to the entry into force of the Act] which are valuable and subsisting" (*id.* at 268). Briggs then referenced a case in which a British court would have been prepared to let a reliance party produce fresh copies of a work even after the application of the Act, if the reliant party "had not himself recouped for his outlay." *Id.* at 268-269.[14]

A complete study of the application of Article 18 in the United States was prepared by Irwin Karp. Irwin Karp, *Final Report, Article 18 Study on Retroactive United States Copyright Protection for Berne and Other Works*, 20 COLUM.-VLA J.L.& ARTS 157 (1996). Mr. Karp noted, first, that because most

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[14] *See Hanfstaengl v. Holloway*, (1893) 2 Q.B. 1. During the 1884 Berne Conference, it was noted that the protection of reliance parties that a country could impose was not limited to copies in existence at the time of application of the Convention but could also extend to copies "in the process of being completed." WIPO: BERNE CONVENTION CENTENARY at 92.

European countries adhered to the Convention in the late nineteenth or early twentieth century, the issue of retroactive protection has all but disappeared from policy radars in those jurisdictions. *Id.* at 167. In addition, very few of them had registration systems. *Id.* at 172. Citing the opinion of "many United States and most foreign copyright experts," Mr. Karp concluded that while the United States had "considerable leeway in fashioning the conditions of retroactivity," it did not have enough leeway to "deny any degree of retroactivity." *Id.* at 172. In other words, imposing conditions may not include a complete absence of application of the principle of limited restoration, because then the principle is not applied at all. Yet, any set of conditions under which the principle is applied would be sufficient to meet U.S. obligations under the Convention.

Hence, when the United States adopted a minimalist approach upon joining the Convention by failing to provide *any* retroactive protection, H.R. Rep. No. 100-609, p. 52 (1988), it pushed the boundaries of Article 18(3) too far. The current implementation of Article 18, however, does much more than is required to comply with Article 18 in protecting copyright holders and thus in reducing the protection of reliance parties. It is a proverbial transition from one extreme to another.

Nearly concurrently with Karp's study, former WIPO Director General Arpad Bogsch published his views on Article 18, during the debates on the United States accession to the Berne Convention. Arpad Bogsch, *WIPO Views of Article 18*, 43 J. COPYR. SOC. 181 (1995). In a letter to the Commissioner of Patents

and Trademarks, Bogsch noted, in agreement with aforementioned commentary, that the "principle" referred to Article 18(3) is the one described in Articles 18(1) and (2). *Id.* at 190. He also argued that while a country can impose conditions on the application of the principle, the principle must be applied in some way, thus negating the possibility of a complete absence of retroactivity. *Id.* Bogsch did argue that a comment in the negotiating history suggests that Article 18(3) only allows transitional measures. However, even if one accepts this postulate, Article 18(3) conditions are *by definition* transitional in that their purpose is to ensure the transition from non-Berne status to Berne status. Transitional does not necessarily mean short-lived or indeed temporary, though they often will be in practice because reliance parties may stop using certain works over time. But that is then their decision. Certainly, the Convention does not impose any specific time limit here, unlike in Article 13(2). Indeed, Bogsch quoted a diplomatic conference record showing that a proposal that would have limited the power of a country joining the Berne Union to decide within two years whether to impose conditions was *rejected*. *Id.* at 191. There is simply no authority to support the conclusion that any similar mandate that transitional measures be short-lived or limited to two years was ever agreed to by member states.[15]

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[15] Bogsch's letter refers to a "quite general agreement" that measures taken under Article 18(3) should not be applied for a period of more than two years, but the only precedent he cites is in Article 18(2), not Article 18(3). Under the interpretive canon *expressio unius est exclusio alterius*, the explicit reference to a time limitation in Article 13(2) actually works against the

Finally, this view that Berne members have a very limited obligation under Article 18 seems to be shared by most other senior scholars. Silke von Lewinski (Max Planck Institute, Munich, Germany) states in her recent book that "countries have some leeway in determining the conditions of application [of Article 18]. However, they must not go as far as entirely to deny the application of Article 18(1) and (2) of the Berne Convention." Silke von Lewinski, INTERNATIONAL COPYRIGHT LAW AND POLICY (2008) at 184. In the same vein, Paul Goldstein (Stanford University) in his newly-released edition of his well-known book co-authored with P. Bernt Hugenholtz (University of Amsterdam), writes: "Article 18(3) of the Berne Convention gives member countries *considerable leeway to meliorate the prejudice suffered* by users when a work they correctly believed was in the public domain is restored to copyright." Paul Goldstein and P. Bernt Hugenholtz, INTERNATIONAL COPYRIGHT 2d (2010) at 295 (emphasis added).

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point made by Bogsch: if Convention negotiators specifically included a two-year period in Article 18(2), it is reasonable to assume that they could have included one in Article 18(3), but chose not to. And, as previously mentioned, this is in fact what history bears out as negotiators considered and expressly rejected a proposal to enshrine a two-year window in Article 18(3).

IV. THE TRIPS AGREEMENT DID NOT ALTER MEMBER STATES' OBLIGATIONS UNDER THE BERNE CONVENTION AND ANY TRADE RETALIATION AGAINST THE UNITED STATES IS UNLIKELY

There is no doubt that copyright law supports a major export sector of the U.S. economy and that international copyright relations matter. It is similarly clear that the Berne Convention and the World Trade Organization Agreement (WTO) on Trade-related Aspects of Intellectual Property Rights (Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299; 33 I.L.M. 1197 (1994) [hereinafter TRIPS Agreement]) are important in this context. Furthermore, it seems reasonable to argue that, wherever possible, an interpretation of U.S. law that conforms to treaties ratified by the U.S. Senate is preferable (*see Murray v. The Charming Betsey*, 6 U.S. (2 Cranch) 64 (1804)). This does not imply, however, that where those international instruments leave parties ample flexibility in implementing its obligations, they should be interpreted as giving strict directions.

As noted earlier, Article 18(3) provides that the principles stated in Articles 18(1) and 18(2) "shall be subject to any provisions contained in special conventions . . . concluded between countries of the Union." The TRIPS Agreement could be considered a "special convention" under Article 18(3) if it restricted the United States' ability to determine appropriate conditions of retroactive protection. But it does not.

That Agreement provides that "copyright obligations with respect to existing works shall be solely determined under Article 18 of the Berne Convention (1971)." *Id.* at Article 70.2. The TRIPS Agreement also incorporated Article 18 of the Berne Convention by reference. *Id.* at Article 9.2. As such, the TRIPS Agreement does not modify the obligations contained in Article 18.

It could have, however. As already noted, the United States obtained a significant concession not to have moral rights enforceable in the WTO and this may be considered a special agreement under Article 18(3).[16] Those exceptions and special conventions must be negotiated. Though the TRIPS Agreement renders the Berne Convention subject to the dispute settlement mechanism of the WTO, it is a long-standing principle that WTO Agreements should not be interpreted to include concessions not explicitly bargained for.[17]

Without a special agreement in place to modify Article 18, we must thus interpret that Article as it stands. This approach leads to the recognition of the flexibilities contained in Article 18(3). In interpreting the Berne Convention provisions incorporated into the

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[16] See the text accompanying notes 4 and 5 *supra*.

[17] For example, in *Brazil - Export Financing Programme for Aircraft*, Case No. WT/DS46 (April 14, 1999), in discussing an exception invoked by Brazil, the panel noted: "nothing indicates that the failure to remove this clause was something that developing countries bargained for" (n.140). By contrast, in this case, the failure to remove the exception was clearly intended.

TRIPS Agreement, dispute-settlement panels have referred to the negotiating history of the Convention.[18] Consequently, failed attempts during the negotiations to cabin Article 18 by limiting measures to a two-year window and, as happened at the Paris Conference of 1896, to delete the reference to available measures,[19] taken together with the absence of any statement restricting the scope of Article 18(3) in the Convention records suggest that a future WTO panel is unlikely to read significant restrictions into that provision.

This flexible interpretation is consonant with TRIPS. The WTO notes in its "Introduction to TRIPS" that WTO Members "issued a special Declaration at the Doha Ministerial Conference in November 2001. They agreed that the TRIPS Agreement does not and should not prevent members from taking measures to protect public health. *They underscored countries' ability to use the flexibilities that are built into the TRIPS Agreement.*"[20] This is reflected in several provisions of the Agreement, including Article 1.1, which provides in part that "Members shall be free to determine the appropriate method of implementing the provisions of this Agreement within their own legal system and

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[18] *See, e.g., United States - Section 110(5) of the U.S. Copyright Act*, Case No. WT/DS160 (June 15, 2000), at §§6.45—6.47.

[19] That is, its equivalent provision at the time, namely Paragraph 4 of the Final Protocol of 1886.

[20] http://www.wto.org/ english/ thewto_e/ whatis_e/ tif_e/ agrm7_e.htm (emphasis added).

practice."[21] Other examples include Articles 13, 26.2 and 30 which allow Members to provide unspecified exceptions in their national laws to copyright, design and patent rights, respectively.

The assertion by the United States and *amici* that a violation of TRIPS would immediately or necessarily entail dire consequences in the form of trade-based retaliation is not verified empirically. The United States has lost a number of disputes at the WTO, including two which found U.S. law in violation of TRIPS.[22] The panel reports date back to 2000 and 2002 and neither one has been implemented by the United States. Yet, no trade-based sanctions have been applied by the European Union, which won both cases.[23]

In fact, since the inception of the WTO on January 1, 1995, the instances of actual trade-based retaliation against *any* country for any WTO violation have been exceedingly rare. The Dispute-Settlement

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[21] TRIPS Agreement, Article 1.1 (1994).

[22] *United States - Section 110(5) of the U.S. Copyright Act*, note 13 *supra*, and *United States of America — Section 211 Omnibus Appropriations Act of 1998*, Case No. WT/DS176 (Jan. 2, 2002).

[23] In the second case, the E.U. only won on one point, namely that ¶¶ 211(a)(2) and (b) of the Omnibus Appropriations Act of 1998 violate the national treatment and most-favored nation obligations under the TRIPS Agreement. In the first case, the music licensing ("homestyle") exemption contained in the U.S. Copyright Act (17 U.S.C. 110(5)(b)) was found to be in violation of TRIPS.

Understanding (DSU), which governs the WTO dispute-settlement process, makes it clear that other means of solving disputes are preferable. A dispute may lead more often to a political outcome. *See* Understanding on Rules and Procedures Governing the Settlement of Disputes, Ann. 2 to the WTO Agreement, in Final Act Embodying the Results of the Uruguay Round of Multilateral Trade Negotiations (Apr 15, 1994), Art. 3.7, 33 I.L.M. 1152 (1994), which provides in part that (a) the aim of the dispute settlement mechanism is to secure a positive solution to a dispute; (b) a solution mutually acceptable to the parties to a dispute is to be preferred; and (c) retaliation is a "last resort."

It is essential to note also that WTO Members may not decide to treat United States works less favorably than those of their own nationals (which would violate the national treatment principle embedded in Article of the TRIPS Agreement) or less favorably than those of other WTO Members, which would violate the most-favored-nation clause in Article 4 of the TRIPS Agreement. Put differently, a country must treat public domain works (and the retroactive protection of same) in a non-discriminatory fashion. This does not apply to the Russian Federation, which is not yet a WTO Member. The Russian Federation has been negotiating its accession for several years and is unlikely to adopt a blatantly non-WTO compatible measure on the eve of its accession.[24]

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[24] *See* Robert Coalson, *Russia's 17-Year Bid To Join The WTO Faces One Last Hurdle*, RADIO FREE EUROPE, May 9, 2011

In sum, while a TRIPS violation might lead to dispute-settlement proceedings at the WTO – which in turn might lead to trade-based retaliation – this possibility is remote. More importantly, as long as there is some degree of retroactive protection of public domain works, the principle contained in Articles 18(1) and (2) of the Berne Convention may be said to be applied and thus no TRIPS violation would be found.

CONCLUSION

Applicable international norms contained in the Berne Convention and the TRIPS Agreement provide that, absent a special convention, which the United States could have tried to negotiate as it did for moral rights, a work in the public domain should be protected anew — that is, removed from the public domain and placed (back) in the exclusive domain of the foreign copyright holder(s) — *only* in the specific circumstance where that work both remains protected in its country of origin *and* is not protected in the country where protection is claimed for a reason *other* than the expiration of a term of protection previously granted (*e.g.*, for failure to comply with a registration requirement). The application if this principle is subject to a very significant degree of flexibility in part due to the need to protect the interests of reliance parties. At international law, there is no requirement that such protection be limited in time. The United States has the ability to implement its

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(http://www.rferl.org/ content/ russia_wto_bid_faces _last_hurdle/24095878.html).

obligations under the Berne Convention and the TRIPS Agreement in a way that protects both the legitimate interests of copyright holders and those of reliance parties, and in accordance with applicable constitutional law.

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Alan C. Friedberg
Counsel of Record
Pendleton, Friedberg, Wilson
& Hennessey, P.C.
1875 Lawrence Street, 10th Floor
Denver, CO 80202
303-839-1204
afriedberg@penberg.com

Counsel for Amicus Curiae
Daniel J. Gervais