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### Formalities in copyright law: an analysis of their history, rationales and possible future

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## Chapter 2

# The Role and Functions of Formalities in Intellectual Property Law

As explained in Chapter 1, this book starts from the hypothesis that formalities may play a useful role in addressing the challenges that copyright is facing today. These challenges, which have been outlined above, rise from the need to establish legal certainty over copyright claims, improve rights clearance and enhance the free flow of information. It must be understood that the degree to which formalities can cater to these needs hinges largely on how they are shaped. Depending on the aims to be achieved, the lawmaker must choose which type(s) of formalities shall be imposed and what their legal consequence(s) shall be. Those two specifications determine to a great extent what role and functions formalities may eventually fulfil.

This chapter tests the above hypothesis by identifying, classifying and describing the role and functions that formalities may play in addressing the various challenges in copyright law. To this end, an analysis is made of twentieth-century and current US copyright formalities and a comparison is drawn with formalities in other fields of intellectual property law, namely, in patent, design and trademark law.

The reason for studying US copyright formalities is that they take different forms and have only fairly recently been abolished or recast so as to fit the requirements of the Berne Convention. Many of the twentieth-century US copyright formalities can still be found, albeit with different legal effects, in contemporary US copyright law. In contrast with most European countries, where copyright formalities were abolished already in the beginning of the twentieth century, the US experience with copyright formalities can therefore supply more and better information about their role and functions. The statutory materials that are analyzed here are the federal US Copyright Acts of 1909<sup>58</sup> and 1976,<sup>59</sup> as amended, inter alia, by the 1988 Berne

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<sup>58</sup> Act of 4 March 1909, 60<sup>th</sup> Cong., 2<sup>nd</sup> Sess. (in: Copyright Enactments 1963, at 64-86). In 1947, the provisions of the 1909 Act, as amended, were laid down in Title 17 of the United States Code [17 USC] by Public law 281, 80<sup>th</sup> Cong., 1<sup>st</sup> Sess., c. 391 (in: Copyright Enactments 1963, at 102-121).

<sup>59</sup> Copyright Revision Act of 19 October 1976, Pub. L. 94-553, 90 Stat. 2541, as amended by the Act of 1 October 1977. This Act became effective on 1 January 1978.

Convention Implementation Act.<sup>60</sup> It should be noted that this chapter concentrates purely on the role and functions of formalities, not on the historical reasons for their change or abolition. These reasons are examined in Chapter 3 below.

A comparison with formalities in other areas of intellectual property can further our insight into the role and functions of copyright formalities, given that these too have intangible, intellectual subject-matter as their object. The fields of law that are chosen for this purpose are patent, design and trademark law, because these are the most important areas of intellectual property law. Studying these areas allows us to extend our analysis of the role and functions of formalities beyond the jurisdiction of the United States. This chapter examines patents, designs and trademarks law in France,<sup>61</sup> the Netherlands,<sup>62</sup> Germany,<sup>63</sup> the United Kingdom<sup>64</sup> and US federal law.<sup>65</sup> In addition, it looks into the European Patent Convention,<sup>66</sup> the Community Trade Mark Regulation<sup>67</sup> and the Community Designs Regulation.<sup>68</sup> Again, it must be

<sup>60</sup> Berne Convention Implementation Act of 31 October 1988, Pub. L. No. 100-568, 100<sup>th</sup> Cong., 2<sup>nd</sup> Sess., 102 Stat. 2853. This Act became effective on 1 March 1989.

<sup>61</sup> French Intellectual Property Code, legislative (L) and regulatory (R) parts, as amended, containing rules on designs and models (book V), patents (book VI) and trademarks (book VII).

<sup>62</sup> Kingdom Act of 15 December 1994, containing rules with respect to patents, as amended [Dutch Patents Act 1995]; Benelux Convention concerning Intellectual Property (Trademarks and Designs) of 25 February 2005, as amended [Benelux Convention on Intellectual Property 2005]; Implementing Regulations to the Benelux Convention on Intellectual Property (Trademarks and Designs) of 1 June 2006 [Implementing Regulations under the Benelux Convention on Intellectual Property].

<sup>63</sup> Patents Act of 16 December 1980, BGBl. 1981 I at 1, as amended [German Patents Act]; Ordinance on Patent Procedures before the German Patent and Trade Mark Office of 1 September 2003, BGBl. I at 1702, as amended [German Patent Ordinance]; Act on the protection of trade marks and other signs of 25 October 1994, BGBl. I at 3082, as amended [German Trade Marks Act]; Ordinance Implementing the Trade Marks Act of 11 May 2004, BGBl. I at 872, as amended [German Trade Mark Ordinance]; Act on the legal protection of designs and models of 12 March 2004, BGBl. I at 390, as amended [German Designs Act]; Ordinance Implementing the German Designs Act of 11 May 2004, BGBl. I at 884, as amended [German Designs Ordinance].

<sup>64</sup> Patents Act 1977, c. 37, as amended [UK Patents Act 1977]; Trade Marks Act 1994, c. 26, as amended [UK Trade Marks Act 1994]; Registered Designs Act 1949, c.88, as amended [UK Registered Designs Act 1949]; Registered Designs Rules, Statutory Instrument 2006, no. 1975 [UK Registered Designs Rules 2006].

<sup>65</sup> Title 35 of the United States Code on Patents [35 USC]; Trademark Act of 1946 (Lanham Act), Public law 79-489, c. 540, approved 5 July 1946, 60 Stat. 427, currently laid down in Chapter 22 of Title 15 of the United States Code on Commerce and Trade [US Trademark Act 1946; 15 USC]; Title 37 of the Code of Federal Regulations on Patents, Trademarks, and Copyrights [37 CFR]. In the US, there is no specific regime to protect designs. Designs can either be protected by design patents (35 USC §§ 171 to 173) or by copyright law (17 USC § 1301 et seq.).

<sup>66</sup> Convention on the Grant of European Patents of 5 October 1973 as revised by the Act revising Article 63 EPC of 17 December 1991 and the Act revising the EPC of 29 November 2000 [European Patent Convention]; Implementing Regulations to the European Patent Convention as adopted by decision of the Administrative Council of the European Patent Organisation of 7 December 2006 [Implementing Regulations to the European Patent Convention].

<sup>67</sup> Council Regulation (EC) no. 207/2009 of 26 February 2009 on the Community trade mark, *OJ L* 78/1 of 24 March 2009 [Community Trade Mark Regulation]; Commission Regulation (EC) no.

emphasized that our focus is on the role and functions of formalities only. Since the objective of this book is not to propose an actual implementation of formalities, but rather to study the legal-theoretical boundaries of their possible reintroduction, no detailed analysis of the procedural aspects of formalities shall be made.

This chapter first describes the system of formalities, from which their role and functions are afterwards distilled. It therefore starts with providing an outline of the types of formalities that are common in intellectual property law (para. 2.1) and follows with an examination of their nature and legal consequences (para. 2.2). This provides the groundwork for the subsequent exploration of the role and functions of formalities (para. 2.3). The latter shall be scrutinized in detail. In order to determine to what extent formalities may help to address the three challenges identified above, the various functions of formalities shall be grouped into five general categories.

## 2.1 The Different Types of Formalities

Formalities in intellectual property law can take various forms. The most prominent examples are registration, renewal, recordation of transfers or assignments of rights, deposit and notice requirements. This section identifies and describes these types of formalities as they are currently laid down in patent, design and trademark law and have been imposed in twentieth-century and current US copyright law.

### 2.1.1 REGISTRATION

One example of formalities that is very common in intellectual property law is the requirement to register intellectual property. In patent law, for example, a patent is granted only after a patent application has been filed, examined and approved by a patent office (or other registering authority) and on condition that the patent grant is published in a register that is open for public inspection.<sup>69</sup> Likewise, trademark law typically requires the registration of a trademark in a public register.<sup>70</sup> The same

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2868/95 of 13 December 1995 implementing the Community Trade Mark Regulation, *OJ L* 303/1 of 15 December 1995, as amended [Community Trade Mark Implementing Regulation].

<sup>68</sup> Council Regulation (EC) no. 6/2002 of 12 December 2001 on Community designs, *OJ L* 3/1 of 5 January 2002, as amended [Community Designs Regulation]; Commission Regulation (EC) no. 2245/2002 of 21 October 2002 implementing the Community Designs Regulation, *OJ L* 341/28 of 17 December 2002, as amended [Community Designs Implementing Regulation].

<sup>69</sup> See e.g. art. L 611-1 in conjunction with art. L 612-1 et seq. French Intellectual Property Code; art. 24 et seq. Dutch Patents Act 1995; art. 34 et seq. German Patents Act; sec. 14 et seq. UK Patents Act 1977; 35 USC § 111 et seq. and art. 75 et seq. European Patent Convention.

<sup>70</sup> See e.g. art. L 712-1 et seq. French Intellectual Property Code; art. 2:2 of the Benelux Convention on Intellectual Property 2005; art. 4 German Trade Marks Act (recognizing that a trademark can also be acquired by the use of a sign in the course of trade); sec. 2 UK Trade Marks Act 1994 (indicating that this Act does not affect the law relating to passing off, protecting signs that acquired a reputation by use in trade) and art. 6 Community Trade Mark Regulation. US federal trademark protection arises

applies to the acquisition of a design right, which normally is subject to the registration of the filing or deposit of a design with the relevant registering authority.<sup>71</sup> Patent, design and trademark laws do not rely on a 'plain' registration of title. Applications must typically be accompanied by a representative description or a representation of the invention, design or mark and other relevant information, e.g., as to the goods or services for which a trademark is to be registered (see para. 2.3.2.1 below).

Registration requirements have also been provided for, and are still laid down, in US copyright law. Although neither the 1909 nor the 1976 Copyright Acts required registration as a condition to protection, no action for copyright infringement could be instituted until after the work had been registered with the Copyright Office.<sup>72</sup> In addition, the Copyright Act of 1976 stated that, unless a work was registered within three months after first publication, no award of statutory damages or attorney's fees could be made for any pre-registration infringement.<sup>73</sup> In 1989, upon the US implementation of the Berne Convention, the latter rule was maintained for all works, but the rule that registration is a condition to sue for copyright infringement was altered so as to relate to US works only.<sup>74</sup> These rules still apply at present.

### 2.1.2 RENEWAL

For most intellectual property rights, registration must be periodically renewed in order to prolong their protection. Intellectual property law therefore designates specific moments in time at which right holders must take affirmative steps to prevent the extinction of their rights. In patent law, periodic maintenance fees must usually be paid to continue enjoying protection for the maximum statutory term of 20 years.<sup>75</sup> In trademark law, protection may endure indefinitely as long as the trademark is being used, but the registration must be renewed after each successive

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from the use in commerce of a trademark. Registration is therefore not required, but is encouraged by providing several advantages to trademark registrants. See para. 2.2.3 below.

<sup>71</sup> See e.g. art. L 511-9 et seq. French Intellectual Property Code; art. 3:5 of the Benelux Convention on Intellectual Property 2005; art. 27(1) German Designs Act; sec. 1 UK Registered Designs Act 1949 and art. 35 et seq. Community Designs Regulation.

<sup>72</sup> See sec. 12 US Copyright Act 1909, 17 USC § 13 (1947) and 17 USC § 411 (1976). Even though registration was not constitutive of copyright, registration before or within five years after the first publication of a work repaired an omission of notice, thus avoiding loss of copyright under the 1976 Copyright Act (see para. 2.1.5 below). See 17 USC § 405(a)(2) (1976).

<sup>73</sup> 17 USC § 412 (1976).

<sup>74</sup> See sec. 9 of the Berne Convention Implementation Act 1988.

<sup>75</sup> In several countries, it concerns annual maintenance fees, sometimes to be paid after a certain period (e.g., three or four years) after the filing date. See e.g. art. L 612-19 in conjunction with art. L 613-22 French Intellectual Property Code; arts 61 and 62 Dutch Patents Act 1995; art. 17 in conjunction with art. 20(1) under 3 German Patents Act; sec. 25 UK Patents Act 1977; and art. 86 European Patent Convention. In the US, maintenance fees must be paid 3.5 years, 7.5 years and 11.5 years after the date of issuance of the patent. See 35 USC § 41(b).

period of ten years.<sup>76</sup> The protection of registered designs commonly terminates after five years, but the registration may be renewed for four successive periods of five years.<sup>77</sup>

Renewal registration was also a key constituent of the 1909 US Copyright Act. Following an initial statutory term of protection of twenty-eight years from the date of first publication with copyright notice (see para. 2.1.5), the author or copyright owner could obtain a second statutory term of protection of twenty-eight years by applying for renewal registration with the Copyright Office within one year prior to the expiration of the initial term.<sup>78</sup> Although, in theory, registration of the copyright in the initial term was not required, in practice, it was essential to form the basis of a renewal registration.<sup>79</sup> In default of renewal registration, the 1909 Act stated that the copyright would terminate and the work would enter the public domain.<sup>80</sup>

The 1976 US Copyright Act abolished the renewal registration and provided for a single term of the life of the author plus fifty years, but only for works created on or after 1 January 1978.<sup>81</sup> Accordingly, renewal registration remained necessary for continuing the copyrights in works that were still in their first term on that date. For these works, the Act extended the renewal term from twenty-eight to forty-seven years.<sup>82</sup> In 1992, renewal registration became optional and works that were still in their first term on that date were automatically renewed.<sup>83</sup> Since 1998, copyright is protected for seventy years after the author's death or, for certain works, for ninety-five years after first publication or 120 years after creation. Moreover, the automatic renewal term has been extended from forty-seven to sixty-seven years.<sup>84</sup>

<sup>76</sup> See e.g. art. L 712-1 in conjunction with art. L 712-9 French Intellectual Property Code; art. 2:9 Benelux Convention on Intellectual Property 2005; art. 47 German Trade Marks Act; secs 42 and 43 UK Trade Marks Act 1994; sec. 9 US Trademark Act 1946 (15 USC § 1059); and arts 46 and 47 Community Trade Mark Regulation.

<sup>77</sup> See e.g. art. L 513-1 French Intellectual Property Code; art. 3:14 Benelux Convention on Intellectual Property 2005; art. 28 German Designs Act; sec. 8 UK Registered Designs Act 1949; and arts 12 and 13 Community Designs Regulation.

<sup>78</sup> Sec. 23 of the US Copyright Act 1909; 17 USC § 24 (1947).

<sup>79</sup> See Ringer 1960, at 579, indicating that original registration can be made 'as late as the last year of the first term'. Since renewal registration must be made within one year prior to the expiration of the initial term, this assumes that the two may be completed at – or around – the same time.

<sup>80</sup> Sec. 23 of the US Copyright Act 1909; 17 USC § 24 (1947).

<sup>81</sup> 17 USC § 302(a) and (b) (1976). For anonymous works, pseudonymous works and works made for hire, the law lays down fixed terms. See 17 USC § 302(c) (1976).

<sup>82</sup> 17 USC § 304(a) (1976). The total term of protection for was thus fixed at seventy-five years. This follows a tendency to extend the renewal term of subsisting copyrights. Starting in 1962, the renewal term was repeatedly extended so as to keep copyrights whose renewal term would otherwise expire in force until a general revision of US copyright law has been enacted. The 1976 US Copyright Act finally extended the renewal terms of subsisting copyrights to endure for a term of seventy-five years from the date copyright was originally secured. See 17 USC § 304(b) (1976).

<sup>83</sup> Copyright Renewal Act of 26 June 1992, Pub. L. No. 102-307, 102<sup>nd</sup> Cong., 2<sup>nd</sup> Sess., 106 Stat. 264.

<sup>84</sup> Sonny Bono Copyright Term Extension Act of 27 October 1998, Pub. L. No. 105-298, 105<sup>th</sup> Cong., 2<sup>nd</sup> Sess., 112 Stat. 2827.

## 2.1.3 RECORDATION

Closely associated with the registration requirement is the requirement of recording transfers of rights. Most intellectual property laws relying on registration encourage right owners to register an assignment, grant or conveyance of their rights, so as to keep the registers up-to-date. While most laws on trademarks, patents and designs do not require a recordation of transfers of intellectual property, the majority orders that as long as a transfer has not been entered on the registers, it has no legal effect against third parties.<sup>85</sup> Sometimes however an exception applies if a third party had knowledge of the transfer.<sup>86</sup> Other laws state that, until such time as the transfer has been entered on the registers, a successor in title cannot invoke the transferred right or enforce it in a legal proceeding.<sup>87</sup> Alternatively, certain laws establish priority in relation to a recordation of assignments. If an assignment is recorded, the assignee is protected against earlier unrecorded transfers of rights. However, if he fails to do so within a certain period, a subsequent recorded transfer will take priority.<sup>88</sup> Also, a few laws order that, unless a transfer is recorded, the transferee of an intellectual property right shall not be awarded costs in an infringement proceeding.<sup>89</sup>

The 1909 US Copyright Act also instructed the Register of Copyrights to record assignments of copyright and issue certificates thereof to any person so requesting. Any assignment of copyright not recorded within three months after its execution in the US, or six months after its execution outside the US, was void as against any subsequent purchaser or mortgagee in good faith whose assignment had been duly recorded.<sup>90</sup> The 1976 US Copyright Act contained similar rules.<sup>91</sup> As a novelty, it also made recordation a condition to sue for anyone claiming to be the right owner

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<sup>85</sup> See e.g. in patent law: art. L 613-9(1) French Intellectual Property Code and arts 64(2) and 65(3) Dutch Patents Act 1995; in trademark law: art. L 714-7 French Intellectual Property Code, art. 2:33 Benelux Convention on Intellectual Property 2005, sec. 25(3)(a) UK Trade Marks Act 1994 and art. 23 Community Trade Mark Regulation; and in designs law: art. L 513-3 French Intellectual Property Code, art. 3:27 Benelux Convention on Intellectual Property 2005 and art. 33(2) Community Designs Regulation.

<sup>86</sup> See e.g. art. L 613-9(2) French Intellectual Property Code (with respect to patents), sec. 25(3)(a) UK Trade Marks Act 1994, art. 23(1) Community Trade Mark Regulation and art. 33(2) Community Designs Regulation.

<sup>87</sup> See e.g. art. 28(2) German Trade Marks Act; art. 17(6) Community Trade Mark Regulation; and art. 28 under (b) Community Designs Regulation. See also art. 30(3) German Patents Act, stating that as long as a transfer of title has not been recorded, the former patentee remains subject to the rights and obligations as provided for in the law. Pursuant to sec. 19(5) UK Registered Designs Act 1949, no unrecorded documents of assignment are accepted as evidence of title in court proceedings.

<sup>88</sup> See e.g. in patent law: sec. 33 UK Patents Act 1977 and 35 USC § 261; and in trademark law: sec. 10(a)(4) US Trademark Act 1946 (15 USC § 1060).

<sup>89</sup> See e.g. sec. 68 UK Patents Act 1977; and sec. 25(4) UK Trade Marks Act 1994.

<sup>90</sup> Secs 44 and 45 of the US Copyright Act 1909; 17 USC §§ 30 and 31 (1947).

<sup>91</sup> See 17 USC § 205 (1976). See, in particular, 17 USC § 205(e) (1976), as to the priority between two conflicting transfers of ownership, and 17 USC § 205(f) (1976), as to the priority between a conflicting transfer of ownership and a non-exclusive licence.

by virtue of a transfer of copyright. Yet, after recordation, legal action could always be instituted on a cause of action arising before recordation.<sup>92</sup> When the US joined the Berne Convention, the requirement that recordation of assignment be obtained before instituting an infringement action was eliminated altogether.<sup>93</sup> Now, the law merely provides that recordation may give constructive notice of the facts stated in the recorded document and priority in case of conflicting assignments.<sup>94</sup>

#### 2.1.4 DEPOSIT

Another formality commonly applied in intellectual property law, although usually not in isolation, is that of deposit. In patents, designs and trademarks law, the requirement to deposit a sample of a design, trademark or invention can be an integral part of the application for registration. If necessary for identification or clarification purposes, for example, a registering authority can invite a patent applicant to supply a model or sample to accompany the specification of an invention for which protection is sought.<sup>95</sup> Likewise, in designs and trademarks law, registration is often preceded by a deposit of a graphic representation (e.g., a drawing or photograph) or a specimen of the relevant design or trademark.<sup>96</sup> Hence, in intellectual property law, deposit is often closely linked to and sometimes even inseparable from registration.

Similarly, under the 1909 US Copyright Act, deposit and registration were very much tied together.<sup>97</sup> Following publication with copyright notice, the Act required two complete copies of the best edition of a work to be promptly deposited with the

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<sup>92</sup> 17 USC § 205(d) (1976).

<sup>93</sup> See sec. 5 of the Berne Convention Implementation Act 1988.

<sup>94</sup> 17 USC § 205(c), (d) and (e).

<sup>95</sup> See e.g. 35 USC § 114 and sec. 16 German Patent Ordinance. For specific inventions e.g. those involving (the use of) biological material, deposit is typically required. See e.g. art. L 612-5 French Intellectual Property Code; art. 25 Dutch Patents Act 1995; art. 34(8) German Patents Act; sec. 125A UK Patents Act 1977; and rule 31 Implementing Regulations to the European Patent Convention.

<sup>96</sup> See e.g. in trademark law: art. R 712-3 French Intellectual Property Code, art. 2:5 Benelux Convention on Intellectual Property 2005 in conjunction with rule 1.1 Implementing Regulations under the Benelux Convention on Intellectual Property, art. 8(1) German Trade Marks Act in conjunction with secs 7 to 13 German Trade Mark Ordinance, sec. 32(2)(d) UK Trade Marks Act 1994, 37 CFR § 2.51 et seq. (US) and art. 26 Community Trade Mark Regulation in conjunction with rule 3 Community Trade Mark Implementing Regulation; and in designs law: arts L 512-2 and R 512-3 French Intellectual Property Code, art. 3:9 Benelux Convention on Intellectual Property 2005 in conjunction with rule 2.1 Implementing Regulations under the Benelux Convention on Intellectual Property, art. 11(2) German Designs Act in conjunction with secs 6 and 7 German Designs Ordinance, sec. 4 UK Registered Designs Rules 2006 and art. 36(1)(c) Community Designs Regulation in conjunction with arts 1(1)(c) and 4 Community Designs Implementing Regulation.

<sup>97</sup> See Kaplan 1958, at 357-358. See also sec. 10 of the US Copyright Act 1909 and 17 USC § 11 (1947), which refer to registration 'including the deposit of copies'.

Copyright Office.<sup>98</sup> This deposit was to be accompanied by a ‘claim of copyright’, which, in all likelihood, referred to an application for registration.<sup>99</sup> If the copies were not promptly deposited, the Register of Copyrights could, at any time after the publication of the work, demand that the copyright owner deposit them. In default of the deposit of copies of the work within three months of the demand,<sup>100</sup> the right owner would be liable to a fine and the copyright would become void.<sup>101</sup> Moreover, the Act provided that until the deposit and registration had been complied with, no legal action could be maintained for infringement of copyright in the work.<sup>102</sup>

The 1976 US Copyright Act distinguished more clearly between deposit required for registration purposes and deposit for the use or disposition of the US Library of Congress.<sup>103</sup> The former was an essential part of and had to be observed to complete the registration (see para. 2.1.1). However, in practice, the library deposit could be used for the same purpose.<sup>104</sup> To satisfy the library deposit, two complete copies of a work needed to be deposited with the Copyright Office within three months after the date of publication in the United States.<sup>105</sup> The Register of Copyrights could at any time after publication demand that the required deposit be made, but failure to do so no longer rendered the copyright void.<sup>106</sup> Rather, it made the copyright owner liable to a fine and payment of the reasonable cost of acquiring the copies.<sup>107</sup>

In substance, the library deposit remained unchanged when the US joined the Berne Convention in 1989.<sup>108</sup> Thus, the owner of a copyright in a work published in

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<sup>98</sup> Sec. 12 of the US Copyright Act 1909; 17 USC § 13 (1947). For certain works e.g. contributions to periodicals for which special registration was requested and works of foreign origin, only one copy had to be deposited. For the latter type of works, this rule was introduced in 1914. See Amendatory Act of 28 March 1914, 63<sup>rd</sup> Cong., 2<sup>nd</sup> Sess. (in: Copyright Enactments 1963, at 91-92).

<sup>99</sup> What the ‘claim of copyright’ exactly referred to is unclear, but there was at least some indication that it signified an application for registration. See Kaplan 1958, at 357-358.

<sup>100</sup> The period was six month, if the deposit was to be made from an outlying territorial possession of the US or a foreign country. See sec. 13 of the US Copyright Act 1909; 17 USC § 14 (1947).

<sup>101</sup> Sec. 13 of the US Copyright Act 1909; 17 USC § 14 (1947). Thus, the copyright in a work would not become void as a result of a late deposit, but only because of a failure to deposit after a demand by the Register. See *Washingtonian Pub. Co. v. Pearson*, 306 US 30, 59 S.Ct. 397 (US Supreme Court, 1939); and *Lumiere v. Pathe Exchange*, 275 Fed. 428 (Second Circuit, 1921), at 430.

<sup>102</sup> Sec. 12 of the US Copyright Act 1909; 17 USC § 13 (1947). Tardy deposit constituted no ground for preventing the institution of an infringement action. See *Washingtonian Pub. Co. v. Pearson*, 306 US 30, 59 S.Ct. 397 (US Supreme Court, 1939), at 42, 403: ‘while no action can be maintained before copies are actually deposited, mere delay will not destroy the right to sue’. For an extensive discussion of, and interesting comments to, the *Washingtonian* case, see Kaplan 1958, at 346-351.

<sup>103</sup> But see Ginsburg 2010a, at 336 and Ginsburg 2010b, at 451, arguing that ‘the dichotomy between these two deposit provisions may not be quite as sharp as initially thought’.

<sup>104</sup> 17 USC § 408(b) (1976).

<sup>105</sup> 17 USC § 407(a) (1976).

<sup>106</sup> *Ibid.*, indicating explicitly that the library deposit is no condition of copyright protection.

<sup>107</sup> 17 USC § 407(d) (1976).

<sup>108</sup> However, a small technical amendment was made. To ensure that all works protected by copyright and published in the US were subjected to mandatory deposit, whether affirmatively marked with a

the US is still required to deposit copies for the use or disposition of the Library of Congress and for completing the ‘voluntary’ registration requirement.<sup>109</sup>

### 2.1.5 NOTICES

A last type of formalities that is used widely, although often not required by law, is notice requirements. The most common notices in intellectual property law, apart from the ©-sign in copyright law, are the indication ‘patented’ in patent law, the symbols ® and ™ in trademark law and the ‘d-in-a-circle’ in designs law.<sup>110</sup> These notices are often voluntarily used by right owners to indicate that a certain object is protected by intellectual property. Nevertheless, in some countries, the law attaches legal consequences to their use. Some laws state that, if a product has been marked with a prescribed notice, an innocent intent defense in mitigation of damages cannot be relied upon in an infringement proceeding.<sup>111</sup> Other laws more generally provide that, in the event of failure to mark a product with a prescribed notice, no damages or profits shall be recovered by the right owner in a suit for infringement, except on proof that the defendant had actual notice of the registration of the right.<sup>112</sup>

Since fulfilling notice requirements does not involve a registering authority but is purely self-initiated, most intellectual property laws containing notice requirements also impose fines for falsely using a notice with the intent of deceiving the public or inducing them to believe that a product is protected by a patent, design or trademark right.<sup>113</sup> Interestingly, even in countries where no statutory notice requirements are provided for, but where the use of notices has nevertheless become customary, the courts have at times condemned the false marking of a product with an intellectual property notice. The courts held this to be an unfair commercial practice.<sup>114</sup>

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copyright notice or not, the Act eliminated the qualification ‘with notice of copyright’ in 17 USC § 407(a) (1976). See sec. 8 of the Berne Convention Implementation Act 1988.

<sup>109</sup> 17 USC §§ 407 and 408(b).

<sup>110</sup> See e.g. 35 USC § 287(a): the word ‘patent’ or the abbreviation ‘pat.’, together with the number of the patent; sec. 29 US Trademark Act 1946 (15 USC § 1111): the words ‘Registered in US Patent and Trademark Office’ or ‘Reg. US Pat. & Tm. Off.’ or the letter R enclosed within a circle, thus ®; and 17 USC § 1306(a): the words ‘Protected Design’, the abbreviation ‘Prot’d Des.’, or the letter ‘D’ with a circle, or the symbol ‘\*D\*’, together with the registration number or the year in which design protection commenced plus the name of the owner of the right in the design.

<sup>111</sup> See e.g. sec. 24B(2) UK Registered Designs Act 1949 and sec. 62(1) UK Patents Act 1977.

<sup>112</sup> See e.g. 35 USC § 287(a) and sec. 29 US Trademark Act 1946 (15 USC § 1111).

<sup>113</sup> See e.g. secs 110 and 111 UK Patents Act 1977, sec. 95 UK Trade Marks Act 1994, sec. 35 UK Registered Designs Act 1949 and 35 USC § 292(a). In the US, the notice ® is a federal registration symbol and can be used with registered trademarks only. See sec. 29 US Trademark Act 1946 (15 USC § 1111). Using it with unregistered trademarks may result in claims of fraud. See *Copelands’ Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563 (US Court of Appeals, Federal Circuit, 1991).

<sup>114</sup> See e.g. German Federal Supreme Court, decision of 26 February 2009, I ZR 219/06 (*Thermoroll*): ‘Any person who uses a sign with the suffix ®, without being the owner or licensee of the trademark, regularly misleads the public in an anticompetitive manner. This may be different if the person is the owner of a similar trademark and the use of the sign with the suffix ® can be qualified as a genuine

In contrast to notice requirements in patents, designs and trademarks law, which typically are the complement of the formalities to which intellectual property rights are subject, copyright notices normally are stand-alone formalities. Publication with copyright notice, for example, was the sole condition for securing protection under the 1909 US Copyright Act.<sup>115</sup> Likewise, as we shall see in more detail below, at the international level, the Universal Copyright Convention provides that, to qualify for protection in contracting states that subject copyright to formalities, all copies of a published works must be marked with a copyright notice (see para. 4.4).

In the US, the 1909 Copyright Act carefully prescribed the form and position of placement of the copyright notice. The notice should consist of three elements, i.e., the indication ‘copyright’, ‘copr.’ or the symbol ©, the name or initials of the right owner and the year of publication.<sup>116</sup> It should be placed on the title page – or other visible part – of each copy of the work published or offered for sale in the US by authority of the copyright owner.<sup>117</sup> Publication without notice normally caused a copyright to be held invalid by the courts,<sup>118</sup> but the law provided limited relief in case of the omission by accident or mistake of the copyright notice from a particular copy or copies.<sup>119</sup> Still, this rule was rather narrowly interpreted.<sup>120</sup> Also, failure to affix the notice in the correct form and location on each copy of the work could lead to a loss of copyright.<sup>121</sup> However, in some cases, the courts held a copyright to be valid, even if the notice was not in the specified form or position.<sup>122</sup> Fraudulent use, alteration or removal of copyright notices was treated as a criminal offence.<sup>123</sup>

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use.’ In the original: ‘*Wer ein Zeichen mit dem Zusatz ® verwendet, ohne Inhaber dieser Marke oder einer Lizenz an dieser Marke zu sein, führt den Verkehr regelmäßig in wettbewerblich relevanter Weise irre. Etwas anderes kann gelten, wenn der Betreffende Inhaber einer ähnlichen Marke ist und die Verwendung des Zeichens eine rechtserhaltende Benutzung dieser Marke darstellt.*’

<sup>115</sup> See secs 9 and 18 to 20 of the US Copyright Act 1909; 17 USC §§ 10 and 19 to 21 (1947).

<sup>116</sup> Sec. 18 of the US Copyright Act 1909; 17 USC § 19 (1947). For sound recordings, the notice had to consist of the symbol ©. See Act of 15 October 1971, Public law 92-140, 85 Stat. 391. The name of the copyright owner could be substituted by that of the assignee, if the copyright was assigned and recorded in the Copyright Office. See sec. 46 of the US Copyright Act 1909; 17 USC § 32 (1947).

<sup>117</sup> Secs 9 and 19 of the US Copyright Act 1909; 17 USC §§ 10 and 20 (1947).

<sup>118</sup> See e.g. *Sieff v. Continental Auto Supply*, 39 F.Supp. 683 (District Court, D. Minnesota, 1941); and *Superfine Products v. Denny*, 54 F.Supp. 148 (District Court, N.D. Georgia, Atlanta Division, 1943).

<sup>119</sup> See sec. 20 of the US Copyright Act 1909; 17 USC § 21 (1947), providing that the omission by accident or mistake of the notice ‘from a particular copy or copies’ would not invalidate the right, but only prevent the recovery of damages against innocent infringers who are misled by the omission.

<sup>120</sup> See Weil 1917, at 350, indicating that the application of the rule hinged on the facts in each case. In practice, courts applied the provision only where the notice was omitted from one or perhaps a very limited number of copies. See *United Thrift Plan v. National Thrift Plan*, 34 F.2d 300 (District Court, E.D. New York, 1929), at 302; *Goes Lithographing Co. v. Art Lithographic Co.*, 14 F.Supp. 620 (District Court, S.D. New York, 1936); *Krafft v. Cohen*, 117 F.2d 579 (Third Circuit, 1941).

<sup>121</sup> See e.g. *Goes Lithographing Co. v. Apt Lithographic Co.*, 14 F.Supp. 620 (District Court, S.D. New York, 1936); *Wildman v. New York Times Co.*, 42 F.Supp. 412, (District Court, S.D. New York, 1941); *Group Publishers v. Winchell*, 86 F.Supp. 573 (District Court, S.D. New York 1949). For an exhaustive overview of court decisions on defective notices, see Doyle et al. 1957, at 237-249.

<sup>122</sup> See e.g. *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 161 F.2d 406 (Second Circuit, 1946), certiorari denied, 331 US 820 (US Supreme Court, 1947); *Harry Alter Co. v. Graves Refrigeration*,

In 1976, publication with copyright notice, while still required, no longer formed the decisive element for the coming into being of copyright.<sup>124</sup> Although copyright could still be lost by publication without notice, an omission of notice could always be cured by registration within a five-year grace period.<sup>125</sup> The Act protected good faith users who innocently infringed a copyright in reliance upon copies from which the notice was omitted.<sup>126</sup> Furthermore, it relaxed the conditions as to the placement and form of the copyright notice<sup>127</sup> and protected good faith users against defective notices and notices containing erroneous information.<sup>128</sup> Use, removal or alteration of copyright notices with fraudulent intent was considered a criminal offence.<sup>129</sup>

When the US adhered to the Berne Convention, the mandatory copyright notice was removed and replaced with an incentive for voluntary notice.<sup>130</sup> This incentive is still contained in current US copyright law. It accords evidentiary weight to the voluntary use of copyright notices to preclude innocent intent defenses in mitigation of damages. Therefore, if a copyright notice appears on copies of a work to which a defendant in an infringement suit had access, no weight is given to a defense based on innocent infringement in mitigation of actual or statutory damages.<sup>131</sup>

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*Inc.*, 101 F.Supp. 703 (US District Court, N.D. Georgia, 1951); *Ziegelheim v. Flohr*, 119 F.Supp. 324 (US District Court, E.D. New York, 1954).

<sup>123</sup> Secs 29 and 30 of the US Copyright Act 1909; 17 USC §§ 105 and 106 (1947).

<sup>124</sup> Although it was stated out front in 17 USC § 102(a) (1976) that US federal copyright protection automatically attached upon fixation of a creative work in tangible form, 17 USC §§ 401(a) and 402(a) (1976) provided that a notice of copyright should be placed on all publicly distributed copies of a work when these were published by authority of the copyright owner.

<sup>125</sup> See 17 USC § 405(a)(2) (1976). The copyright owner should make reasonable efforts to add notices to all copies distributed in the US after the omission was discovered. The Act further provided that copyright would not be held invalid if the notice was omitted from a small number of copies or if the omission violated an express requirement in writing that the right owner did not consent to the public distribution of copies of his work without notice. See 17 USC § 405(a)(1) and (3) (1976).

<sup>126</sup> See 17 USC § 405(b) (1976), limiting the right to claim actual or statutory damages against good faith users. See also Gorman 1978, at 869-870.

<sup>127</sup> See 17 USC §§ 401(c) and 402(c) (1976), requiring the notice to be affixed 'in such manner and location as to give reasonable notice of the claim of copyright'. The 1976 Act directed the Register of Copyrights to prescribe specific methods of affixation and positions of the notice on various types of works, but these specifications were meant as examples and were non-exhaustive.

<sup>128</sup> See 17 USC § 406 (1976), providing good faith users who would be misled by a wrong name in the copyright notice with a complete defense to any action for infringement. Use of the wrong name was no defense, however, if the name of the true copyright owner was registered before the infringing use began. Notices that postdated the year of first publication with more than one year or that contained no date or no name were dealt with as if the notice was omitted altogether.

<sup>129</sup> 17 USC §§ 506(c) and (d) (1976).

<sup>130</sup> See sec. 7 of the Berne Convention Implementation Act 1988.

<sup>131</sup> See 17 USC §§ 401(d) and 402(d), as amended by the Berne Convention Implementation Act 1988.

## 2.2 The Nature and Legal Effects of Formalities

The overview in para. 2.1 has revealed that formalities may not only take different forms, but can also vary greatly in nature, depending on the legal consequences that the lawmaker attaches to them. In general, the lawmaker can subject the existence (para. 2.2.1) and/or the continuation (para. 2.2.2) of intellectual property rights to formalities. Alternatively, he can leave the existence of these rights unaffected, but make their exercise (para. 2.2.3) or the scope of a specific exploitation right (para. 2.2.4) conditional on formalities. This section briefly describes these four variations of the nature of formalities. It is important to note that, since the legal consequences of formalities can be changed by the lawmaker, they have no fixed nature. Instead, formalities are flexible instruments that can be adapted to specific needs.

### 2.2.1 CONSTITUTIVE FORMALITIES

A first type of formalities, which is often perceived as the most rigid type, is those that constitute ownership titles. This type of formalities functions as a *sine qua non* for protection. If they are not completed in accordance with the statutory conditions and time limits, no protection is established. Nowadays, most intellectual property rights, with the exception of copyright, are subject to this type of formalities.

Formalities that are constitutive of the right include the registration requirements in patent, design and trademark law (see para. 2.1.1). In patent law, for example, registration is the source of the right. A patent cannot be acquired without a patent application having been examined, approved and registered by a patent office.<sup>132</sup> The same applies to design and trademark rights, which in most countries are obtained by registration as well.<sup>133</sup> A notable exception, however, is the US trademark right, which arises from the use of a mark. Here, registration has merely declaratory effect (see para. 2.2.3). Also, in design law, certain laws confer protection on unregistered designs, but this protection is usually weaker than for registered designs.<sup>134</sup>

In US copyright law, the copyright notice for a long time was constitutive of the right. No protection was accorded to a work, unless published with copyright notice (see para. 2.1.5). This changed in 1976 when copyright automatically attached upon fixation of a work in tangible form. Nonetheless, until the US implementation of the Berne Convention in 1989, publication without notice could still result in a loss of protection.

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<sup>132</sup> See the references in note 69 above.

<sup>133</sup> See e.g. art. 6 Community Trade Mark Regulation: 'A Community trade mark shall be obtained by registration.' For further references, see notes 70 (trademarks) and 71 (designs) above.

<sup>134</sup> See e.g. art. 1(2) under (a) in conjunction with arts 11 and 19(2) Community Designs Regulation; and Part III, UK Copyright, Designs and Patents Act 1988. See also Bently & Sherman 2009, at 616.

### 2.2.2 MAINTENANCE FORMALITIES

Other formalities are necessary prerequisites for the continuation of protection. This is the case, for example, with renewal registration (see para. 2.1.2). If an intellectual property right that is subject to renewal is not renewed in a timely manner, that is, if the renewal formalities are not fulfilled on time, the protection will lapse. For example, a patent expires by operation of law if the periodic maintenance fees are not paid within a certain time frame of the due date.<sup>135</sup> Likewise, the owners of a trademark or design right lose protection if they fail to periodically renew the registration.<sup>136</sup> Finally, in US copyright law, until 1976, copyright protection also terminated if the right was not renewed in the last year of the initial twenty-eight year term of protection.<sup>137</sup>

Maintenance formalities often follow initial registration. This is the case, e.g., in patent, design and trademark law, where initial registration is followed by a fixed or unlimited number of renewal terms. However, they can also exist independently of such registration. In relation to US copyright law, some scholars recently suggested the imposition of an initial formality-free term of protection of a limited number of years following first publication, with the option of renewing this term a number of times, upon the requirement of registering the work.<sup>138</sup> In general, these proposals aim at advancing the moment at which works for which copyright protection is no longer desired enter the public domain. Thus, renewal formalities bear directly on the term of protection. They seem to be suitable instruments for the purpose of differentiating the length of copyright according to the commercial value of the work (see para. 2.3.1).<sup>139</sup>

### 2.2.3 DECLARATORY FORMALITIES

In contrast with constitutive and maintenance formalities, declaratory formalities do not impinge on the existence of rights. Non-compliance with this type of formalities

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<sup>135</sup> See the references in note 75 above.

<sup>136</sup> See the references in notes 76 (trademarks) and 77 (designs) above.

<sup>137</sup> Sec. 23 of the US Copyright Act 1909; 17 USC § 24 (1947).

<sup>138</sup> See e.g. Landes & Posner 2003a, at 473, proposing a system of indefinitely renewable copyright but recognizing that such system can also have an 'upper bound' by laying down an initial term of twenty years plus a maximum of six renewal terms of ten years each; Kuhne 2004, at 562, suggesting the same, with the exception that he proposes an initial term of thirty years plus a maximum of seven renewal terms of ten years each; and Lessig 2004, at 248-56, advocating a regime in which the author is required to register his work fifty years after first publication and every ten years thereafter until the currently prescribed copyright term would have lapsed. This proposal found its way into the Public Domain Enhancement Act, H.R. 2601, 108th Congress, 1st Session, 25 June 2003.

<sup>139</sup> See e.g. Landes & Posner 2003a, at 503-507, articulating that, because the commercial life cycle of different kinds of works (e.g., books, musical and graphic arts) may vary greatly, renewal registration can lead to more differentiated terms of protection for different kinds of works; and Sprigman 2004, at 521-523, examining the effect of renewal registration on the real term of copyright.

will not result in a defeat of copyright. Declaratory formalities rather help to declare that existing rights are legal and protected by law. This does not imply, however, that they are without legal effect. To induce compliance, most laws prescribe that a failure to fulfil a declaratory formality incurs consequences, which may vary from a fine to the impossibility to institute action to enforce copyright before the courts. In the latter event, while the protection of copyright is certainly also in danger, the law can provide that, once the formalities are completed, copyright owners may proceed even against earlier infringements, thus mitigating the adverse effects of declaratory formalities (see para. 2.3.1). Additionally, the law can also reward compliance with declaratory formalities with some important procedural advantages.

A well-known example of a mere declaratory formality is the registration system in US federal trademark law. US federal trademark protection arises from the use in commerce of a trademark and is not created by registration. Registration is neither required by law, nor is constitutive of the trademark right.<sup>140</sup> Nevertheless, it has some important legal consequences. First of all, federal registration is designed to give nationwide protection, as opposed to state protection under common law.<sup>141</sup> In addition, it constitutes constructive use of the mark and is constructive notice of the registrant's claim of ownership.<sup>142</sup> Further, it is prima facie evidence of the mark's validity, the registrant's ownership of the mark, and the registrant's exclusive right to use the mark.<sup>143</sup> After five consecutive years of unopposed use, a registered mark can become 'incontestable'.<sup>144</sup> This means, inter alia, that instead of mere prima facie proof, the registration becomes conclusive evidence of the mark's validity and legal protectability, as well as of the registrant's ownership of the mark.<sup>145</sup>

The overview of para. 2.1 demonstrates that, except for constitutive formalities, US copyright has been subject to various declaratory formalities. Registration, for example, was – and for works of US origin still is – a prerequisite for initiating a copyright infringement action. Furthermore, the recovery of statutory damages and attorney's fees was and still is limited to instances of infringement occurring after registration. Recordation, which gives constructive notice and establishes priority in case of conflicting transfers, also has only declaratory effect. The same applies to copyright notices. Since their constitutive nature has been removed, no more than evidentiary weight is accorded to the voluntary use of such notices. Finally, right holders failing to complete the free library deposit incur only a fine.

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<sup>140</sup> See e.g. *United Phosphorus, Ltd. v. Midland Fumigant, Inc.*, 21 F. Supp. 2d 1247 (US District Court of Kansas, 1998) and *S Industries, Inc. v. Stone Age Equipment, Inc.*, 12 F. Supp. 2d 796 (US District Court of Illinois, 1998).

<sup>141</sup> *Fleming Companies, Inc. v. Thriftway, Inc.*, 809 F. Supp. 38 (US District Court of Ohio, 1992).

<sup>142</sup> See secs 7(c) and 22 US Trademark Act 1946 (15 USC §§ 1057(c) and 1072).

<sup>143</sup> See secs 7(b) and 33(a) US Trademark Act 1946 (15 USC §§ 1057(b) and 1115(a)); and *Gateway, Inc. v. Companion Products, Inc.*, 320 F. Supp. 2d 912 (US District Court of South Dakota, 2002).

<sup>144</sup> See sec. 15 US Trademark Act 1946 (15 USC § 1065).

<sup>145</sup> Sec. 33(b) US Trademark Act 1946 (15 USC § 1115(b)); and *Brookfield Communications, Inc. v. West Coast Entertainment Corporation*, 174 F.3d 1036 (US Court of Appeals, Ninth Circuit, 1999).

#### 2.2.4 SITUATION SPECIFIC FORMALITIES

A last category of formalities that has not yet been introduced in para. 2.1 above is situation specific formalities, which are peculiar to copyright law. They are related, not to copyright as a whole, but to a particular type of exploitation right, usually of a particular category of works. Examples include notices of reservation to retain a public performance right in musical compositions or a translation right in literary works, which in the history of copyright played a key role (Chapter 3). A modern example of situation specific formalities is the notice of reservation to retain a reproduction right in articles in newspapers and weekly journals.<sup>146</sup> Sometimes the rights of reproduction and communication to the public in works communicated by or on behalf of public authorities are also subject to a notice of reservation.<sup>147</sup>

The consequence of non-compliance with situation specific formalities is not as catastrophic as with constitutive or maintenance formalities. If the copies of a work are not marked with a notice of reservation of the particular exploitation right, this right cannot be invoked against third parties. Hence, non-compliance with situation specific formalities does not cause entire works to enter the public domain, as do constitutive or maintenance formalities. It only has the effect that a particular limitation applies, which otherwise would not. This means that, to the extent that the limitation applies, authors can no longer prevent third parties from making unauthorized use of their works.

### 2.3 The Functions of Formalities

Formalities may fulfil a number of important functions, depending on their type and the legal effects that the law attaches to them. This section examines these functions in the light of the challenges described in Chapter 1. This means that we endeavour to identify the functions that formalities generally perform, without highlighting the functions that are specific to one or the other formality. Examples of formalities that have specific functionalities are deposit requirements, which obviously also aim at enriching national libraries,<sup>148</sup> renewal formalities, which may be imposed to protect the interests of original right owners,<sup>149</sup> and recordation requirements, which, from

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<sup>146</sup> See e.g. art. 49 German Copyright and Neighbouring Rights Act 1965; art. 15(1) Dutch Copyright Act. This notice of reservation is expressly permitted pursuant to art. 10bis(1) Berne Convention.

<sup>147</sup> See e.g. art. 15b Dutch Copyright Act.

<sup>148</sup> See e.g. Ginsburg 2010a, at 336-337 and Ginsburg 2010b, at 451-452.

<sup>149</sup> By designating the author or, if not living, his relatives (i.e., the widow(er), child(ren), executors or next of kin) as beneficiaries of copyright renewal, the 1909 US Copyright Act clearly aimed at giving these beneficiaries an opportunity to benefit from the success of the author's work and to renegotiate disadvantageous contracts. See Ringer 1960, at 517 and 521. In practice, however, the beneficiaries did not always profit, as the author's renewal interest could be assigned during the original copyright term. See *Fred Fisher Music Co. v. M. Witmark & Sons*, 318 US 643 (US Supreme Court, 1943).

the point of view of property law, can also be a legal condition to complete the transfer of title.<sup>150</sup> Hence, instead of meticulously analyzing which formality fulfils what function, this section studies the functions of formalities in general. These are the filtering function (para. 2.3.1), the demarcation function (para. 2.3.2), the signalling and publicity function (para. 2.3.3), the evidentiary function (para. 2.3.4) and the information function (para. 2.3.5).

### 2.3.1 FILTERING FUNCTION

Formalities may, first of all, play an important role as filtering instruments between subject matter for which beneficiaries desire protection and those for which they do not.<sup>151</sup> Constitutive formalities, in particular, operate as ‘one-way switches’ between non-protection and protection.<sup>152</sup> Since constitutive formalities are initial conditions for the coming into being of the right, protection is accorded only upon their timely fulfilment. Otherwise, the subject matter will be part of the public domain.

Because, at present, the acquisition of most intellectual property rights depends on registration or other formalities, there is a clear separation between – allegedly – protected and unprotected subject matter.<sup>153</sup> Under the patent, design and trademark laws of most countries, no invention, design or trademark will be protected unless it is registered.<sup>154</sup> Hence, a prospective beneficiary must make an initial assessment of whether the relevant subject matter is sufficiently valuable to warrant protection.<sup>155</sup> That is, he must determine whether the benefits resulting from registration (e.g., the exclusivity of use of the invention, design or trademark; the expected revenues from sale and royalties; the esteem of being recognized as an inventor or designer; etc.) would exceed the costs of applying for registration.<sup>156</sup> In general, if this assessment appears favourable, the invention, design or trademark will likely be registered, so as to secure protection. In contrast, all subject matter that remains unregistered will be part of the public domain and, consequently, is free to be used by all.

For a long time, this filtering mechanism also existed in US copyright law. Since publication with copyright notice was the essence of securing copyright under the

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<sup>150</sup> In most countries, however, transfer of intellectual property is effectuated by signing a valid contract. It does not have to be recorded in the registers to take legal effect. See e.g. art. 3:95 Dutch Civil Code (*Burgerlijk Wetboek*). Often, recordation is only relevant for establishing third party effect.

<sup>151</sup> Sprigman 2004, at 502 et seq.

<sup>152</sup> Van Gompel 2010a, at 164.

<sup>153</sup> The reason for using the word ‘allegedly’ is that, even if the formalities have been fulfilled, subject matter may still fail to satisfy the substantive requirements of protection. This can be detected either in an examination or opposition procedure or in a court proceeding. See para. 2.3.2 below.

<sup>154</sup> See paras 2.1.1 and 2.2.1 above. But see para. 2.2.3, in respect of the US trademark system.

<sup>155</sup> Kawohl & Kretschmer 2003, at 221-22; Sprigman 2004, at 514.

<sup>156</sup> See e.g. Bently & Sherman 2009, at 370-372 and 616-617, describing the benefits and costs that may be relevant to the decision as to whether to apply for a patent or to register a design.

1909 Copyright Act,<sup>157</sup> publication without copyright notice was typically regarded as amounting to an ‘abandonment of the right and a dedication of one’s work to the public.’<sup>158</sup> Or, as the court stated in *Bell v. Combined Registry Co.*:

‘A publication ... which fails to include the correct notice of copyright forfeits the copyright protection and places the material into the public domain.’<sup>159</sup>

Publication without notice therefore ‘imposed an initial filter separating works with significant potential commercial value for which authors desired protection from other works for which protection was irrelevant’.<sup>160</sup> The copyright notice thus had a critical role to play in ‘placing in the public domain a substantial body of published material that no one is interested in copyrighting’.<sup>161</sup> This conclusion is supported by empirical evidence which shows that, under the pre-1976 US copyright regime, authors often abstained from marking their works with a copyright notice.<sup>162</sup>

The filtering function of formalities is not limited to constitutive formalities. The various maintenance formalities perform a similar function, although at a later stage in the lifecycle of the protected object. Since many intellectual property rights are to be periodically renewed to prolong protection, the beneficiaries of renewal ought to assess, each time the right comes up for renewal, whether the subject matter of protection is valuable enough to justify the cost of renewal.<sup>163</sup> Especially in patent law, renewal plays a key role as a ‘filter’, as is evident from the renewal fees, which escalate each year during the patent term.<sup>164</sup> Copyright renewal formalities can thus play a central role in regulating the term of protection according to the commercial value of the work,<sup>165</sup> since right holders that hold no realistic expectation of future

<sup>157</sup> *Unedea Doll Co., Inc., v. Goldfarb Novelty Co., Inc. and Walgreen Eastern Co., Inc.*, 373 F.2d 851 (US Court of Appeals, Second Circuit, 1967), certiorari dismissed, 389 US 801 (1967), describing the copyright notice as ‘the cornerstone of the formal prerequisites to obtaining a copyright’.

<sup>158</sup> *Group Publishers, Inc. v. Winchell*, 86 F.Supp. 573 (US District Court of New York, 1949), at 577. See also *Universal Film Mfg. Co. v. Copperman*, 212 Fed. 301 (US District Court of New York, 1914), affirmed, 218 Fed. 577 (Circuit Court of Appeals, Second Circuit, 1914); *Smith v. Bartlett*, 18 F.Supp. 35, 37 (US District Court of Maine, 1937); *Wildman v. New York Times Co.*, 42 F.Supp. 412, 414 (US District Court of New York, 1941); *Milton H. Carter v. Hawaii Transportation Co.*, 201 F.Supp. 301, 304 (US District Court of Hawaii, 1961).

<sup>159</sup> *Bell v. Combined Registry Co.*, 397 F.Supp. 1241 (US District Court of Illinois, 1975), at 1248; affirmed 536 F.2d 164 (US Court of Appeals, Seventh Circuit, 1976), certiorari denied 429 US 1001 (US Supreme Court, 1976). See also *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487 (US Court of Appeals, Second Circuit, 1960); and *American Fabrics Co. v. Lace Art, Inc.*, 291 F.Supp. 589 (US District Court of New York, 1968).

<sup>160</sup> Sprigman 2004, at 502.

<sup>161</sup> H.R. Report No. 94-1476, 94th Cong., 2nd Sess. (1976), at 143.

<sup>162</sup> See Sprigman 2004, at 502-519, examining the importance of the filtering function of the registration and notice requirements in the US in the period between 1790 and 1976.

<sup>163</sup> See Landes & Posner 2003a, in respect of copyright and trademark renewals, and Sprigman 2004, at 519-521, in respect of copyright renewals.

<sup>164</sup> See e.g. art. 2 of the Rules relating to fees under the European Patent Convention of 20 October 1977 as adopted on 7 December 2006 and last amended on 9 December 2008.

<sup>165</sup> See H.R. Rep. No. 2222, S. Rep. 1108, 60th Cong., 2d Sess. (1909), quoted in Ringer 1960, at 517.

benefits will presumably not renew their copyrights.<sup>166</sup> This may greatly expedite subject matter entering the public domain, as can be witnessed, for example, in pre-1976 US copyright law, where only a fraction of copyrights was ever renewed.<sup>167</sup>

Even if formalities are only declarative of the right, they can still fulfil a filtering function. Obviously, since declaratory formalities do not affect the existence of the right, a failure to comply with these formalities shall not cast subject matter into the ‘structural’ public domain, i.e., the domain that is not protected by any intellectual property right.<sup>168</sup> However, if non-compliance results in the impossibility of enforcing an intellectual property right before the courts, thereby preventing the plaintiff from maintaining an infringement action for acts occurring prior to the fulfilment of the formalities,<sup>169</sup> declaratory formalities may nonetheless enrich the ‘functional’ public domain, i.e., the domain that is protected by intellectual property but still permits an unrestricted, though clearly defined, access or use.<sup>170</sup> If no infringement action can be maintained for acts occurring prior to the fulfilment of formalities, a third party relying on incomplete formalities can use the subject matter, despite being protected by intellectual property, until the formalities have been duly completed.<sup>171</sup>

The above examples clearly demonstrate that formalities directly help to preserve the balance between protected and unprotected subject matter. Because intellectual property, in many cases, is granted upon completion of formalities only, the public domain is constantly enlarged with subject matter the formalities of which have not

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<sup>166</sup> Sprigman 2004, at 519.

<sup>167</sup> See H.R. Rep. No. 2222, S. Rep. 1108, 60th Cong., 2d Sess. (1909), quoted in Ringer 1960, at 517, Landes & Posner 2003a, at 496-513 and Sprigman 2004, at 519-521, who concludes: ‘Historically, approximately 15% of works were renewed, meaning that 85% of works moved into the public domain – by consent of rightsholders – after a relatively short term of protection’ (at 519).

<sup>168</sup> Dusollier 2011 (forthcoming). See also Benabou & Dusollier 2007, at 171.

<sup>169</sup> For some time, it was uncertain whether late deposit (and accompanying registration) under the 1909 US Copyright Act impaired the copyright previously secured by publication with notice to the extent of preventing suits for infringement antedating the late deposit. In 1939, however, the Supreme Court ruled that it is necessary only that works be deposited at any time prior to initiating the infringement suit. See *Washingtonian Pub. Co. v. Pearson*, 306 US 30, 59 S.Ct. 397 (US Supreme Court, 1939). Hence, once a work is deposited and registered, legal action can be instituted for acts of infringement occurring prior to deposit and registration. This rule still applies at present. See *Twentieth Century-Fox Film Corp. v. Dunnahoo*, 637 F.2d 1338 (US Court of Appeals, Ninth Circuit, 1981).

<sup>170</sup> Dusollier 2011 (forthcoming). See also Benabou & Dusollier 2007, at 171 et seq.

<sup>171</sup> An interesting question is whether and to what extent declaratory formalities of this kind truly enrich the functional public domain for users that want to incorporate a work for which no formalities have been fulfilled into a derivative work. Because they can be exposed to injunction proceedings after a subsequent completion of the formalities, supplementary measures should be taken to prevent legal uncertainty to arise. While this topic exceeds the scope of this book, it seems that important lessons can be learned from the recent discussions regarding orphan works, where the law is confronted with similar problems. See e.g. Van Gompel 2007 and Van Eechoud et al. 2009, at 263-296.

been duly or timely fulfilled. Accordingly, in their capacity as filtering instruments, formalities may significantly enhance the free flow of information.<sup>172</sup>

### 2.3.2 DEMARCATION FUNCTION

Other than merely filtering out the subject matter for which the formalities have not been completed, formalities may also play an important role in defining, identifying and outlining protectable subject matter, on the one hand, and excluding subject matter that does not satisfy the substantive requirements of protection, on the other hand. This is done in a threefold process. First, by way of the claim for protection in the application for registration, which defines the scope of protection and marks the boundaries of the subject matter (para. 2.3.2.1). Second, through an examination procedure, which allows registering authorities to test the validity of a claim (para. 2.3.2.2). Third, by giving third parties the opportunity to challenge the registration either in an opposition process or in a court proceeding (para. 2.3.2.3). These three procedures attempt to ensure that only subject matter which satisfies the substantive requirements of protection is registered and thus granted protection. This ultimately serves the purpose of improving the accuracy and reliability of the registers.

#### 2.3.2.1 *THE APPLICANT'S CLAIM FOR PROTECTION*

In patent, design and trademark law, the application for registration is indispensable for demarcating the subject matter and defining the scope of protection. In general, an application must contain an adequate description of the subject matter for which the applicant claims protection as well as accompanying drawings or representative specimens. This should make the abstract subject matter of the intellectual property right more concrete. The idea is that no protection can be conferred on an invention, design or trademark unless it is clearly defined in the application.<sup>173</sup>

Thus in a patent application, the subject matter which the applicant regards as his invention must be particularly pointed out and distinctly claimed and, if necessary, be accompanied by a drawing.<sup>174</sup> Together with the description of the invention, the

<sup>172</sup> See e.g. Lessig 2001, at 106-107 and 251-252, Lessig 2004, at 137-138, Landes and Posner 2003a, at 517-518, Lévêque & Ménière 2004, at 105 and Sprigman 2004, at 502-528, who emphasize that, in contrast with current copyright law, which extends copyright to each and every original work of authorship, formalities may substantially enlarge the number of works in the public domain.

<sup>173</sup> See e.g. Pakuscher 1986, at 92, in respect of the concretization of inventions, stressing that it cannot be merely an idea in the mind of the inventor that is subject to protection. Rather, the inventor must concretize his idea and put it into a specific form before the invention can be patented.

<sup>174</sup> See e.g. art. L 612-1 in conjunction with art. R 612-3 French Intellectual Property Code; art. 24 Dutch Patents Act 1995; art. 34(3) German Patents Act; sec. 14(2) UK Patents Act 1977; 35 USC §§ 111 to 113; and art. 78 European Patent Convention.

patent claim forms the core of the patent.<sup>175</sup> While the description ensures that the invention is disclosed in such a manner that it is of practical use to people skilled in the art,<sup>176</sup> the patent claim eventually demarcates and defines the scope of protection of the patented invention.<sup>177</sup> Hence, it must at least show that the invention satisfies the substantive requirements for patentability (i.e. subject matter, novelty, inventive step and susceptibility of industrial use).<sup>178</sup> If an application is not submitted in the correct form and content, the registering authority shall order the applicant to make the necessary adjustments and, if he fails to do so, reject the application.<sup>179</sup>

Likewise, an application for the registration of a trademark must at least contain a representation of the mark and a statement of the goods or services for which the mark is to be registered.<sup>180</sup> While the representation of the mark defines the subject matter of protection (i.e. the protected sign), the statement of the goods and services delineates the scope of protection (i.e. the commercial spheres in which the sign is to be protected).<sup>181</sup> Signs that cannot adequately be represented graphically, such as smells and tastes, are generally barred from trademark registration. Even if they can be fixed in a chemical formula, described in words or locked in a sample, this does not make them registrable. The European Court of Justice has ruled that the graphic representation of a mark ought to be clear, precise, self-contained, easily accessible, intelligible, durable and objective, so as to allow anyone to unambiguously identify and determine the nature of a trademark on the basis of its registration.<sup>182</sup> Chemical formulas, written descriptions and odour samples do not satisfy these requirements, since they are not sufficiently intelligible, objective and stable or durable.<sup>183</sup> Sound signs that are represented by a stave divided into bars and showing a clef, notes and

<sup>175</sup> Bently & Sherman 2009, at 360-361.

<sup>176</sup> See e.g. art. L 612-5 French Intellectual Property Code; art. 25(1) Dutch Patents Act 1995; art. 34(4) German Patents Act; sec. 14(3) UK Patents Act 1977; 35 USC § 112 and art. 83 European Patent Convention.

<sup>177</sup> See e.g. art. L 612-6 French Intellectual Property Code; art. 24(1) under e Dutch Patents Act 1995; art. 34(3) under 3 German Patents Act; sec. 14(5) UK Patents Act 1977; 35 USC § 112 and art. 84 European Patent Convention.

<sup>178</sup> Bently & Sherman 2009, at 368.

<sup>179</sup> See e.g. art. 612-12 French Intellectual Property Code; art. 30 Dutch Patents Act 1995; art. 42(1) and (3) German Patents Act; sec. 15A UK Patents Act 1977; and art. 90 European Patent Convention. On the effect of defective execution of documents in the US, see 35 USC § 26.

<sup>180</sup> See e.g. art. L 712-2 French Intellectual Property Code; art. 2:5 Benelux Convention on Intellectual Property 2005 in conjunction with rule 1.1 Implementing Regulations under the Benelux Convention on Intellectual Property; art. 32 German Trade Marks Act; sec. 32 UK Trade Marks Act 1994; sec. 1 US Trademark Act 1946 (15 USC § 1051); and art. 26 Community Trade Mark Regulation. Incomplete applications may be amended, but failure to do so will cause the application to be refused or to be treated as having not been filed. See art. L 712-7 French Intellectual Property Code; art. 2:5 Benelux Convention on Intellectual Property 2005; art. 36(1) and (2) German Trade Marks Act; sec. 37 UK Trade Marks Act 1994; 35 USC § 26; and art. 36 Community Trade Mark Regulation.

<sup>181</sup> Bently & Sherman 2009, at 781.

<sup>182</sup> See European Court of Justice, judgment of 12 December 2002, case C-273/00, *Ralf Sieckmann v. Deutsches Patent- und Markenamt*, [2002] ECR I-11737, paras 45 to 55.

<sup>183</sup> *Ibid.*, paras 69 to 73.

other musical indications may constitute a faithful representation of the sequence of sounds which form the melody in respect of which registration is sought.<sup>184</sup>

In design law, it is common that applications at least contain a representation of the design and an indication of the products to which it is intended to be applied.<sup>185</sup> Because design protection is not limited to the specific product that is indicated in the application, design applications are merely procedural and have no substantive effects.<sup>186</sup> The representation of the design, on the other hand, is an essential part of the application, as it defines the subject matter of design protection. It is 'the means to specify the features of the design for which protection is sought'.<sup>187</sup> To this end, some laws allow applications to be accompanied by a partial disclaimer, indicating that the application for registration relates to a design that forms only a part of the appearance of a product or otherwise limits the scope or extent of protection.<sup>188</sup>

Unlike patent, trademark and design law, no system of representative registration is known in copyright law. Because the subject matter of copyright is too abstract to be formulated in a representative claim, the law cannot require a copyright claimant to indicate precisely for which elements of a work he claims protection. Rather, it is left to the courts to define the subject matter and scope of protection of copyright *ex post*.<sup>189</sup> To nevertheless allow the contours and perimeters of a work to be identified *ex ante*, US copyright law requires the registration to be accompanied by a deposit of copies or, for some types of works, of photographs or other identifying material of a work.<sup>190</sup> This makes the subject matter of works, for which the applicant seeks

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<sup>184</sup> See European Court of Justice, judgment of 27 November 2003, case C-283/01, *Shield Mark*, [2003] ECR I-14313, paras 51 to 64.

<sup>185</sup> See e.g. art. L 512-2 French Intellectual Property Code; art. 3:9 Benelux Convention on Intellectual Property 2005 in conjunction with rule 2.1 Implementing Regulations under the Benelux Convention on Intellectual Property; art. 11(2) German Designs Act; sec. 3 UK Registered Designs Act 1949 in conjunction with secs 4 and 5 UK Registered Designs Rules 2006; and art. 36 Community Designs Regulation. Incomplete applications may be amended, but failure to do so will cause the application to be refused or to be treated as having been abandoned. See art. L 512-2 French Intellectual Property Code; art. 3:9 Benelux Convention on Intellectual Property 2005; art. 16 German Designs Act; sec. 3(5) UK Registered Designs Act 1949 and arts 45 and 46 Community Designs Regulation.

<sup>186</sup> Bently & Sherman 2009, at 619-620.

<sup>187</sup> See Office for Harmonization in the Internal Market, 'Guidelines for the examination of Community designs', <<http://oami.europa.eu/en/office/aspects/pdf/ExamGuidelines.pdf>>, para. 4.4.

<sup>188</sup> See e.g. sec. 6 of the UK Registered Designs Rules 2006. See also Bently & Sherman 2009, at 618, stating that: 'The representations can be conceived as the positive claims, from which the disclaimer excludes matter, so that in combination they define the property.'

<sup>189</sup> Sherman & Bently 1999, at 191-193.

<sup>190</sup> See 17 USC §§ 408(b) and 408(c)(1) in conjunction with 37 CFR § 202.21. See also secs 11 and 12 of the US Copyright Act 1909. By allowing the deposit of photographs or other identifying material in lieu of copies of a work, the Act of 29 March 1956, Public law 452, 84<sup>th</sup> Cong., 2<sup>nd</sup> Sess., c. 109 (in Copyright Enactments 1963, at 132-133) alleviated the burden of deposit in respect of works, for which it would be impracticable to deposit copies due to their size, weight, fragility, or monetary value (e.g., works of art, models, designs, drawings, plastic works, prints or pictorial illustrations).

copyright protection, available for pre-registration inspection by the US Copyright Office (see below) and post-registration examination by third parties.<sup>191</sup>

### 2.3.2.2 THE EXAMINATION PROCEDURE

While the claim in an application for registration may clearly indicate the subject matter for which right holders seek protection, this obviously does not imply that it automatically satisfies the substantive requirements for protection. Most registration systems in intellectual property law therefore give registering authorities the power to test the validity of a claim, before registering – and conferring protection on – the relevant subject matter. This may be a full examination of the substantive criteria of protection, but also a minimum ‘formal’ investigation of the application.

The grant of patents, for example, is regularly preceded by an in-depth and time-consuming examination of the substantive requirements of protection. Sometimes, a full examination of substantive requirements (i.e. subject matter, novelty, inventive step and susceptibility of industrial use) is conducted,<sup>192</sup> but it may also happen that only some substantive elements are examined.<sup>193</sup> The registering authority usually draws up a report which lists the findings and objections to the applications. The applicant is then given the opportunity to alter the application. If he does not agree with the observations of the examiner, he can appeal against the decision.<sup>194</sup> In the end, if the registering authority is satisfied that there are no substantive objections, it will grant the patent. Otherwise, it will refuse the application and decline protection.<sup>195</sup>

Similarly, in trademark law, the application for registration is typically subjected to a substantive examination. In some countries, the registering authority checks the

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<sup>191</sup> See e.g. Weil 1917, at 310: ‘The primary object of requiring the deposit of copies is that the subject matter of works in which copyright is claimed, may be made public and available, for purposes both of information and of avoiding infringement.’

<sup>192</sup> See e.g. art. 44 German Patents Act; sec. 18 UK Patents Act 1977; 35 USC § 131; and art. 94 European Patent Convention.

<sup>193</sup> See e.g. art. L 612-11 in conjunction with art. L 612-12 French Intellectual Property Code. The latter provision does not indicate lack of inventive step as a ground for refusal of a patent. See Schmidt-Szalewski 1992, at 726. Nevertheless, it is a matter that has to be included in the search report to be drawn up pursuant to art. L 612-14 French Intellectual Property Code. In the Netherlands, a search is performed of the state of the art with respect to the subject matter of the patent application prior to the grant of the patent only. See art. 32 Dutch Patents Act 1995. See also Wichers Hoeth 2007, at 42-43, indicating that, formally speaking, the search report is irrelevant for the patent grant.

<sup>194</sup> See e.g. art. 73(1) German Patents Act; sec. 97 UK Patents Act 1977; 35 USC § 134; and art. 106 European Patent Convention.

<sup>195</sup> See e.g. arts L 612-12 (grounds for refusal) and L 612-17 (patent grant) French Intellectual Property Code; arts 48 and 49 German Patents Act; sec. 18(3) and (4) UK Patents Act 1977; 35 USC §§ 131, 132 and 151; and art. 97 European Patent Convention. In the Netherlands, on the other hand, a patent is granted irrespective of the outcome of the search. See art. 36 Dutch Patents Act 1995.

trademark application against both absolute and relative grounds for refusal.<sup>196</sup> That is, it refuses registration if a trademark has no distinctive character; is merely descriptive of the kind, quality or other characteristics of the goods or services for which protection is sought; is contrary to public policy or to accepted principles of morality; etc.;<sup>197</sup> and if a trademark conflicts with a similar or identical trademark that has been registered earlier.<sup>198</sup> Other registering authorities examine applications only against absolute grounds for refusal and abstain from searching the registers to check for similar or identical trademarks.<sup>199</sup> In the latter cases, the relative grounds for refusal can be raised by third parties either in an opposition procedure or in trial (see para. 2.3.2.3). The examination process will eventually result in acceptance or refusal of the application. Appeal can be lodged against this decision.

In design law, on the other hand, it is very common that the registering authority performs a minimum examination of the application only. Often, the application for registration is accepted as it is and, without a prior examination as to subject matter, novelty or individual character of the design, recorded on the registers.<sup>200</sup> However, design registration can usually be refused on specific grounds, to be detected by the registering authority on formal examination. Depending on the law, these grounds may include the fact that the subject matter for which protection is sought does not fall within the definition of design; consists of a national emblem, flag or other item excluded from registration; is dictated by function; or is contrary to public policy or accepted principles of morality.<sup>201</sup> Since registration cannot be rejected on the basis of a lack of novelty or individual character, whether a registered design is actually protected by the law can only be established *ex post* by the courts.

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<sup>196</sup> This is the case e.g. in the UK and the United States. See sec. 37 UK Trade Marks Act 1994; sec. 12 in conjunction with sec. 2 US Trademark Act 1946 (15 USC §1062 in conjunction with §1052).

<sup>197</sup> On the absolute grounds for refusal, see arts L 711-2 and L 711-3 French Intellectual Property Code; art. 2:11(1) Benelux Convention on Intellectual Property 2005; art. 8 German Trade Marks Act; secs 3 and 4 UK Trade Marks Act 1994; sec. 2(a), (b), (c) and (e) US Trademark Act 1946 (15 USC § 1052 (a), (b), (c) and (e)); and art. 7 Community Trade Mark Regulation.

<sup>198</sup> On the relative grounds for refusal, see art. L 711-4 French Intellectual Property Code; art. 2:14 Benelux Convention on Intellectual Property 2005; art. 9 German Trade Marks Act; secs 5 and 6 UK Trade Marks Act 1994; sec. 2 (d) US Trademark Act 1946 (15 USC §1052 (d)); and art. 8 Community Trade Mark Regulation.

<sup>199</sup> This is the case e.g. in France, the Netherlands and Germany. See art. L 712-7 French Intellectual Property Code (no reference to art. L 711-4); art. 2:11 Benelux Convention on Intellectual Property 2005; and art. 37 German Trade Marks Act. See also art. 37 Community Trade Mark Regulation.

<sup>200</sup> See Bently & Sherman 2009, at 620 and 624 (with respect to UK design registration and Community design registration) and Wichers Hoeth 2007, at 159 (with respect to Benelux design registration).

<sup>201</sup> See e.g. sec. 3A UK Registered Designs Act 1949 and art. 18 German Designs Act (which does not permit the registrar to examine whether a design is dictated by function). In many countries, only a limited substantive examination as to whether the design complies with morality and public policy is carried out. See art. L 512-2 French Intellectual Property Code and art. 3:13 Benelux Convention on Intellectual Property 2005. Art. 47 Community Designs Regulation subject design applications to the test of morality and public policy and of being in compliance with the legal definition of designs.

The examination practice in design law closely resembles the one established in US copyright law. Here too, no substantive examination of the copyrightability of a work is performed before registration. That is, the US Copyright Office conducts no investigation as to the originality of a work.<sup>202</sup> Nonetheless, it is instructed by the 1976 Copyright Act to inspect the material that is deposited with the registration to see whether it constitutes copyrightable subject matter before it may register a copyright claim.<sup>203</sup> As a result, the US Copyright Office has the discretionary power to refuse registering creations that do not qualify as literary or artistic works or that, on the surface, lack sufficient originality. In particular, it entertains no applications for registration of works not subject to copyright, such as words and short phrases; ideas, plans, methods, systems or devices; and typeface as typeface.<sup>204</sup> When, after examination, the US Copyright Office believes that copyright subsists in the work, and all formalities are complied with, it registers the claim. Otherwise, registration will be refused.<sup>205</sup> While the applicant, despite the refusal of registration, is entitled to file suit for copyright infringement, the US Register of Copyrights may become a party to the action with respect to the registrability of the copyright claim.<sup>206</sup>

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<sup>202</sup> See King et al. 1986, at 35, stating that '[the] Copyright Office does not generally examine works for artistic merit or newness, nor (as misperceived by many individuals in the US) does it "examine" works to determine if the work is in fact an "original" work'.

<sup>203</sup> 17 USC § 410(a) and (b).

<sup>204</sup> See 37 CFR § 202.1, listing examples of creations that are not subject to copyright and, therefore, are not registered by the Copyright Office. This includes the following:

'(a) Words and short phrases such as names, titles, and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering or coloring; mere listing of ingredients or contents; (b) Ideas, plans, methods, systems, or devices, as distinguished from the particular manner in which they are expressed or described in a writing;

(c) Blank forms, such as time cards, graph paper, account books, diaries, bank checks, scorecards, address books, report forms, order forms and the like, which are designed for recording information and do not in themselves convey information;

(d) Works consisting entirely of information that is common property containing no original authorship, such as, for example: Standard calendars, height and weight charts, tape measures and rulers, schedules of sporting events, and lists or tables taken from public documents or other common sources; and

(e) Typeface as typeface.'

<sup>205</sup> 17 USC § 410(a) and (b).

<sup>206</sup> 17 USC § 411. This is subject to the conditions (a) that the application, deposit and registration fee have been delivered to the Copyright Office in proper form; and (b) that the Register of Copyrights is notified of the civil action instituted by the applicant. By contrast, under the 1909 Copyright Act, an applicant was required to first file suit against the Register to compel issuance of the registration certificate before a copyright infringement action could be started. See e.g. *Vacheron & Constantin-Le Coultre Watches v. Benrus Watch Company*, 260 F.2d 637 (Second Circuit, 1958).

2.3.2.3 *OPPOSITION OR INVALIDATION BY THE COURT*

Although the acceptance of an application following the examination of a claim will typically result in the grant of registration, several laws give third parties the chance to formally challenge the applicant's claim in a pre-registration or post-registration opposition procedure. During this procedure, substantive defects that the examining division of the registering authority missed or that remained unexamined can be laid bare. A successful opposition will lead to a refusal of the application or a revocation of the registration, should the claim already be registered. As registration is granted only to subject matter that passes the opposition or that is not opposed, this practice effectively contributes to fine-tuning the protection conferred by registration.

Opposition procedures are available in patent and trademark law in particular. In the case of patents, some laws give third parties the chance to submit observations on the patentability of an invention during application only.<sup>207</sup> Other laws provide third parties with the opportunity to officially oppose registration within a certain period following the publication of a patent grant.<sup>208</sup> During opposition, a number of objections can be raised, including lack of patentability.<sup>209</sup> After the objections are examined, the opposition division of the registering authority decides whether the patent should be maintained, maintained with limitations or revoked.<sup>210</sup>

In trademark law, most laws provide that, after a trademark application has been examined, accepted and published by a registering authority, third parties can make observations on, or formally oppose, the proposed registration of the mark.<sup>211</sup> In countries where trademark applications are examined against absolute and relative grounds for refusal, any person can typically make observations or oppose on both absolute and relative grounds.<sup>212</sup> In systems where trademark applications are only examined against absolute grounds for refusal, opposition can normally be filed by proprietors of earlier trademarks and on relative grounds only.<sup>213</sup> If examination of

<sup>207</sup> See e.g. art. L 612-13 French Intellectual Property Code, art. 38 Dutch Patents Act 1995; and sec. 21 UK Patents Act 1977. Sometimes, third parties are allowed to make observations, even if opposition can be made. See e.g. art. 115 European Patent Convention and 35 USC § 301.

<sup>208</sup> See e.g. art. 59 German Patents Act; 35 USC § 302 and art. 99 et seq. European Patent Convention.

<sup>209</sup> See art. 59 in conjunction with art. 21 German Patents Act and art. 100 European Patent Convention. In the US it concerns a re-examination of a patent on the basis of prior art. See 35 USC § 302.

<sup>210</sup> See e.g. art. 61 German Patents Act; 35 USC § 307; and art. 101 European Patent Convention.

<sup>211</sup> In Germany, rather than a pre-registration opposition procedure, a post-registration opposition procedure is provided for, similar to the one in patent law. See art. 42 German Trade Marks Act.

<sup>212</sup> See sec. 38 UK Trade Marks Act 1994; and sec. 13 in conjunction with sec. 2 US Trademark Act 1946 (15 USC §1063 in conjunction with §1052).

<sup>213</sup> See e.g. art. L 712-4 French Intellectual Property Code; art. 2:14 Benelux Convention on Intellectual Property 2005; art. 42 German Trade Marks Act; and art. 41 Community Trade Mark Regulation. In addition to this formal opposition procedure, art. 40 Community Trade Mark Regulation also allows anyone to submit written observations, but these may relate to absolute grounds of refusal only.

the opposition reveals that a trademark should not be registered, the application for registration shall be rejected. Otherwise, the trademark shall be registered.<sup>214</sup>

Opposition is a less common feature of design law.<sup>215</sup> Instead, the law often gives third parties the opportunity to invoke the nullity of a design registration, either on absolute grounds (i.e. if the design does not meet the substantive requirements for protection) or relative grounds (i.e. if the design conflicts with an earlier right).<sup>216</sup> Depending on the law, applications for declaration of invalidity are to be made to the registrar or to the courts. If a design is declared invalid, it shall be deemed as never having existed from the outset.<sup>217</sup> In patent and trademark law, similar actions for invalidating a patent or trademark registration can be instituted.<sup>218</sup>

In US copyright law, federal courts have the power to rule on the registrability of copyright claims and on the copyrighability of the relevant subject matter.<sup>219</sup>

### 2.3.3 SIGNALLING AND PUBLICITY FUNCTION

In addition to the filtering and demarcation functions, which essentially allow for a separation to be made between protected and unprotected subject matter, formalities may play an important signalling and publicity function. By alerting third parties to the fact that an invention, design or trademark might be protected by an intellectual

<sup>214</sup> See e.g. art. L 712-7 French Intellectual Property Code; art. 2:16 Benelux Convention on Intellectual Property 2005; sec. 40 UK Trade Marks Act 1994; and arts 42 and 45 Community Trade Mark Regulation. Because, in Germany, a post-registration opposition procedure is provided for, a successful opposition will result in a cancellation of the registration. See art. 42 German Trade Marks Act.

<sup>215</sup> Nevertheless, it is sometimes applied. See Bently & Sherman 2009, at 617, referring to an opposition procedure under the Swedish Designs Act 2002.

<sup>216</sup> See e.g. art. L 512-4 French Intellectual Property Code; art. 3:23 Benelux Convention on Intellectual Property 2005; art. 33 German Designs Act; sec. 11ZA in conjunction with sec. 11ZB UK Registered Designs Act 1949; and art. 25 Community Designs Regulation.

<sup>217</sup> See Wichers Hoeth 2007, at 180. See also art. L 512-6 French Intellectual Property Code; art. 33(3) German Designs Act; sec. 11ZE(2) UK Registered Designs Act 1949; and art. 26(1) Community Designs Regulation.

<sup>218</sup> See e.g., in patent law, art. L 613-25 et seq. French Intellectual Property Code; art. 75 Dutch Patents Act 1995; art. 21 German Patents Act; sec. 72 et seq. UK Patents Act 1977; 35 USC § 282; and art. 138 European Patent Convention; and, in trademark law, art. L 714-3 French Intellectual Property Code; art. 2:28 Benelux Convention on Intellectual Property 2005; arts 50 to 52 German Trade Marks Act; sec. 47 UK Trade Marks Act 1994; and arts 52, 53 and 55(2) Community Trade Mark Regulation. Sec. 33 US Trademark Act 1946 (15 USC § 1115) provides only limited grounds for invalidation, depending on whether registration is prima facie or conclusive evidence of validity.

<sup>219</sup> See 17 USC § 411(a), with respect to the registrability of copyright claims. Recently, it was held by the Supreme Court that, despite the pre-suit registration requirement of 17 USC § 411, a copyright holder's failure to comply with that requirement does not restrict a federal court's subject-matter jurisdiction over infringement claims involving unregistered works in a class-action infringement suit. See *Reed Elsevier, Inc. v. Muchnick*, 130 S.Ct. 1237 (US Supreme Court, 2010).

property right, they contribute significantly to establishing legal certainty.<sup>220</sup> This is elementary, given the intangible character of intellectual property rights.

The underlying principle is fairly simple. Upon public dissemination of a product that incorporates a patent or a design or is labelled with a trademark, the respective owner of the patent, design or trademark loses physical control over his intellectual property.<sup>221</sup> Even so, pursuant to the law, he has the right to prevent other persons from reusing and exploiting the patent, design or trademark. However, third parties that purchase, obtain or otherwise take possession of a product that includes subject matter protected by intellectual property may have no knowledge of the existence of such a right and of the possible intention of its right holder to enforce it. Therefore, to enable third parties to ascertain whether they might be infringing another person's intellectual property, they should somehow be made aware of this fact.<sup>222</sup>

Most intellectual property systems fulfil this signalling and publicity function by advertising applications and the acceptance of applications in an official journal and by maintaining a register that is open for public inspection.<sup>223</sup> The advertisements, which usually only include the fact that an application has been made or accepted at a certain date,<sup>224</sup> aim at notifying and alarming third parties.<sup>225</sup> The registers enable them to obtain further information about the current status of pending applications and registered patents, designs or trademarks.<sup>226</sup> This has great advantages, both for society at large, which is duly informed about the subject matter that is protected by intellectual property, and for traders and competitors, who, on timely notification of

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<sup>220</sup> See e.g. European Commission, Green Paper on the Legal Protection of Industrial Design, Working document of the services of the Commission, III/F/5131/91-EN, Brussels, June 1991 [Green Paper on Industrial Design 1991], at 47 (para. 4.3.9): 'The purpose of registration is to create legal certainty as to which designs are protected and which are not.'

<sup>221</sup> With respect to movable property, mere possession (e.g. of a bicycle) fulfils the publicity function. See e.g. art. 3:119(1) of the Dutch Civil Code, stating that the possessor of a good is presumed to be the proprietor ('*De bezitter van een goed wordt vermoed rechthebbende te zijn.*') and art. 2014 of the old Dutch Civil, stating that possession qualifies as a perfect title ('*Bezit geldt als volkomen titel.*').

<sup>222</sup> See Bently & Sherman 2009, at 375.

<sup>223</sup> *Ibid.*, at 381-382 and 383-384 (with respect to UK and European patent registration), 620-621 and 624 (with respect to UK and Community design registration) and 791-792, 794, 782 and 798-800 (with respect to UK and Community trademark registration). See also Wichers Hoeth 2007, at 44-45 (with respect to Dutch patent registration), 159 (with respect to Benelux design registration) and 252-253 (with respect to Benelux trademark registration).

<sup>224</sup> See e.g. secs 16(1) and 24(1) UK Patents Act 1977, indicating that the Official Journal advertises the fact and date of publication of a patent application and a notice of the patent grant, respectively.

<sup>225</sup> That the objective of notifying third parties is taken seriously can be seen e.g. in art. 97(3) European Patent Convention, which states that the decision to grant a European patent takes no effect until the date on which the mention of the grant is published in the European Patent Bulletin.

<sup>226</sup> See e.g. art. 19(1) Dutch Patents Act 1995: 'The Office shall be responsible for maintaining a patent register from which the current status with respect to patent applications and patents can be derived and from which information can be provided to third parties for that purpose.'

the fact that an application is filed or protection is granted, may be able to decide on whether to oppose or otherwise challenge the application or registration.<sup>227</sup>

Furthermore, the owners of intellectual property rights often voluntarily mark the products that incorporate their intellectual property rights with a notice, such as the word ‘patented’, the symbol ® or ™ or the ‘d-in-a-circle’. By so doing, they intend to alarm third parties of the fact that an intellectual property right applies.

An additional publicity function is performed by the recordation of assignments of rights. This signals to the public that, from a particular moment in time, another person than the original right holder owns the rights in the intellectual property. By inquiry of the registers, third parties can ascertain changes of title.

In US copyright law the mandatory copyright notice for a long time played a key role as a signalling mechanism informing the public as to whether or not a particular work was protected by copyright.<sup>228</sup> Since the law required a copyright notice to be attached to the copies of a work to obtain protection (see para. 2.2.1), anyone could easily ascertain whether a work was protected. The courts consistently held that the object of the copyright notice was ‘to prevent innocent persons who are unaware of the existence of the copyright from incurring the penalties of infringers by making use of the copyrighted work.’<sup>229</sup> If a copyright notice was omitted, it could instantly be recognized that a work resided in the public domain and therefore could be used without prior authorization. Even though the copyright notice at present is no longer required, it can still function as an important ‘No Trespassing’ sign, used by authors to signal to the public that they are serious about enforcing their rights.<sup>230</sup>

Likewise, depending on whether copyrights have been registered and transfers of copyrights have been recorded, the records of the US Copyright Office may provide further publicity about existing statutory copyrights and about changes of copyright ownership (see also para. 2.3.5 below).

#### 2.3.4 EVIDENTIARY FUNCTION

Just as third parties must be notified of the existence of intellectual property rights, so are owners of intellectual property in need of confirmation of existence of their

<sup>227</sup> See e.g. European Court of Justice, judgment of 12 December 2002, case C-273/00, *Ralf Sieckmann v. Deutsches Patent- und Markenamt*, [2002] ECR I-11737, para. 51: ‘economic operators must [...] be able to find out about registrations or applications for registration made by their current or potential competitors and thus to receive relevant information about the rights of third parties’.

<sup>228</sup> See H.R. Report No. 94-1476, 94th Cong., 2nd Sess. (1976), at 143.

<sup>229</sup> *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 161 F.2d 406 (Circuit Court of Appeals, Second Circuit, 1946), at 409; certiorari denied 331 US 820 (US Supreme Court, 1947). See also *Harry Alter Co. v. Graves Refrigeration, Inc.*, 101 F.Supp. 703 (US District Court of Georgia, 1951), at 705; and *Fleischer Studios, Inc. v. Ralph A. Freundlich, Inc.*, 73 F.2d 276 (Circuit Court of Appeals, Second Circuit, 1934), at 277; certiorari denied 294 US 717 (US Supreme Court, 1935).

<sup>230</sup> See Goldstein 2001, at 189 and Goldstein & Hugenholtz 2010, at 222.

rights. In essence this follows the same rationale. Once the intangible subject matter of intellectual property is publicly disseminated, it cannot easily be traced back to its rightful proprietor. Hence, to be able to prove that they actually own the rights, right owners need evidence linking them to the intellectual property and identifying them as the legal proprietors. Formalities may help to provide this evidence.

Several laws, for example, presume that the person registered as proprietor in the respective register is entitled to the rights conferred by the registration of a patent, design or trademark.<sup>231</sup> Although a legal presumption of this kind is not a guarantee that the registration is valid,<sup>232</sup> it may provide prima facie or constructive evidence of the registrant's title of ownership.<sup>233</sup> Often, the registrant can obtain a certificate of registration, which typically has similar evidentiary weight as the entrance in the registers.<sup>234</sup> This enables right owners to easily assert their rights and claim the title of property in intangible subject matter. This may be particularly useful in conflicts where the anteriority or priority of a property claim needs to be resolved.

To prevent fraudulent registration by a person who is not entitled to register, the law often makes provision for persons who believe that they have a right in an invention, design or trademark that is registered, or for which registration has been applied, to claim ownership, e.g., by bringing legal proceedings before a civil court.<sup>235</sup> In some countries, the law also penalizes the deliberate falsification of the registers.<sup>236</sup>

In US copyright law, formalities also fulfil important evidentiary functions.<sup>237</sup> If a copyright claim is registered before or within five years after first publication, the certificate of registration constitutes prima facie proof of the validity of copyright and of the facts that it contains.<sup>238</sup> Similarly, recordation gives constructive notice of

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<sup>231</sup> See e.g., in patent law, sec. 32(9) UK Patents Act 1977; in trademark law, art. 28(1) German Trade Marks Act, sec. 72 UK Trade Marks Act 1994, and secs 22 and 33 US Trademark Act 1946 (15 USC §§ 1072 and 1115); and, in design law, sec. 17(8) UK Registered Designs Act 1949 and art. 17 Community Designs Regulation.

<sup>232</sup> See Bently & Sherman 2009, at 781 and 794.

<sup>233</sup> Although entries in the registers usually provide prima facie evidence of the property title only, they sometimes may constitute constructive notice of the registrant's property claim or property title. See e.g. secs 22 and 33(b) US Trademark Act 1946 (15 USC §§ 1072 and 1115(b)).

<sup>234</sup> See e.g., in patent law, sec. 24(2) in conjunction with sec. 32(10) UK Patents Act 1977; in trademark law, sec. 7(a) US Trademark Act 1946 (15 USC § 1057(a)); and, in design law, sec. 18(1) in conjunction with 17(9) UK Registered Designs Act 1949.

<sup>235</sup> See e.g. art. L 511-10 (design law), art. L 611-8 (patent law) and art. L 712-6 (trademark law) French Intellectual Property Code. In UK patent law, anyone having or claiming a proprietary interest in an invention may refer to the register's comptroller, either before or after the grant, the question of who is properly entitled to be granted a UK patent. See secs 8(1) and 37(1) UK Patents Act 1977.

<sup>236</sup> See e.g. sec. 109 UK Patents Act 1977, sec. 94 UK Trade Marks Act 1994, sec. 34 UK Registered Designs Act 1949.

<sup>237</sup> See King et al. 1986, at viii and 105-109.

<sup>238</sup> 17 USC § 410(c). Before 1976, a certificate of registration had similar evidentiary weight. See sec. 55 of the US Copyright Act 1909, as amended by the Act of 2 March 1913, 62nd Cong., 3rd Sess. (in Copyright Enactments 1963, at 90-91); 17 USC § 209 (1947).

the facts stated in the recorded document, provided that it specifically identifies the work to which it pertains and that this work has been registered.<sup>239</sup> The law further states a penalty for any person who knowingly makes a false representation of a material fact in any written statement filed in the process of registration.<sup>240</sup>

### 2.3.5 INFORMATION FUNCTION

A last function that is inherent to formalities is that they supply an important source of information. This generally concerns information pertaining to the subject matter and scope of protection, the ownership of rights and the term of protection.<sup>241</sup>

Most formalities inform the public about the subject matter of protection and the ownership of intellectual property rights. Patent, design and trademark registers are typical examples of formalities that provide for such information. By allowing these registers to be searched, third parties are able to identify existing patent, design and trademark rights, ascertain their scope of protection and determine whether a new application conflicts with an earlier entry.<sup>242</sup> Furthermore, the registers may contain current information about the names and addresses of applicants, right owners and, if applicable, their appointed representatives.<sup>243</sup> This makes it easier for third parties to identify and locate the relevant proprietors of the intellectual property.

In US copyright law the copyright notice for a long time also informed the public of the existence of the copyright and the name of the copyright owner.<sup>244</sup> This name could be substituted by that of the assignee, in case the copyright was assigned and recorded in the US Copyright Office.<sup>245</sup> In addition, information about the work and the copyright owner was – and still is – made publicly available through the records of the US Copyright Office. Although registration was and is not required, the 1909 and 1976 US Copyright Acts contain(ed) a number of incentives to register.<sup>246</sup> Until

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<sup>239</sup> 17 USC § 205(c). Before 1976, the catalogues of copyright entries at the US Copyright Office were admitted in any court as prima facie evidence of the facts they contained as regards copyright registration and recordation. See sec. 56 of the US Copyright Act 1909; 17 USC § 210 (1947).

<sup>240</sup> 17 USC § 506(e).

<sup>241</sup> Except for providing information on the ownership of rights and the subject matter, scope and term of protection, patent registers are an important source of public scientific and technical knowledge.

<sup>242</sup> See Bently & Sherman 2009, at 785, referring to the ‘information function’ of a representation of the mark that must accompany the application for trademark registration.

<sup>243</sup> See e.g. art. 30 German Patents Act. Sometimes, inventors or designers are also given the right to be named as such in the registers. See e.g., in patent law, art. L 611-9 French Intellectual Property Code and art. 62 European Patent Convention; and, in design law, art. 18 Community Designs Regulation.

<sup>244</sup> See H.R. Report No. 94-1476, 94th Cong., 2nd Sess. (1976), at 143 and *Harry Alter Co. v. Graves Refrigeration, Inc.*, 101 F.Supp. 703 (US District Court of Georgia, 1951), at 705.

<sup>245</sup> Sec. 46 of the US Copyright Act 1909; 17 USC § 32 (1947), as amended by the Act of 15 October 1971, Public law 92-140, 85 Stat. 391, which took effect on 15 February 1972.

<sup>246</sup> See para. 2.1.1 above.

1976, registration was also a prerequisite for the renewal of copyright.<sup>247</sup> Therefore, the records of the US Copyright Office were – and still are – regularly updated with relevant information about copyrighted works and copyright ownership.

However, this is not to say that the registered information is always adequate and up-to-date. First of all, the records of the US Copyright Office provide no detailed information about the scope of protection. Unlike other intellectual property rights, the scope of copyright cannot directly be derived from the registers, but must rather be inferred from the work itself (see para. 2.3.2.1). Second, recordation of transfers was not mandatory in twentieth-century US copyright law.<sup>248</sup> Consequently, there is no guarantee that the information about copyright ownership is up-to-date.<sup>249</sup>

Nevertheless, the records of the US Copyright Office are a useful starting point for third parties to establish the ownership of copyrighted works.<sup>250</sup> Especially if the law prescribes that supplementary registration augments rather than supersedes the information contained in an earlier registration,<sup>251</sup> the records may help third parties to trace the chain of title. Even if the records are not fully up-to-date, this may ease the identification and location of the current copyright owner of a work.

Formalities may also offer important information about the term of protection.<sup>252</sup> Most intellectual property rights are protected for a fixed term, which is calculated either from the date of filing of the application,<sup>253</sup> or from the date of registration.<sup>254</sup> Since these dates are usually recorded in the registers,<sup>255</sup> it can easily be ascertained whether a patent, design or trademark is still protected. If an earlier expiry, waiver, revocation or invalidation by the court of a patent, design or trademark right is also

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<sup>247</sup> See para. 2.1.2 above.

<sup>248</sup> See para. 2.1.3 above.

<sup>249</sup> See Ginsburg 2008, at 176-177 (note 8), concluding: ‘Thus, the information identifying the author or copyright owner of a work published with notice in 1930 whose registration was renewed in 1958 (and whose copyright will endure until 2025) will today be 50 years old. The likelihood that the information in the 1958 renewal certificate remains accurate may not be very high.’

<sup>250</sup> See King et al. 1986, at ix and 109-113.

<sup>251</sup> See e.g. 17 USC § 408(d).

<sup>252</sup> See e.g. Green Paper on Industrial Design 1991, at 82-83 (para. 6.2.4.2), concluding that calculating the terms of unregistered designs from the date of first public disclosure is more difficult and causes more legal uncertainty than calculating the terms of registered designs from the date of filing.

<sup>253</sup> See e.g., in patent law, art. L 611-2 under (1) French Intellectual Property Code; art. 36(6) Dutch Patents Act 1995; art. 16(1) German Patents Act; sec. 25(1) UK Patents Act 1977; 35 USC § 154(a)(2); and art. 63(1) European Patent Convention; in trademark law, art. L 712-1 French Intellectual Property Code; art. 2:9(1) Benelux Convention on Intellectual Property 2005; art. 47(1) German Trade Marks Act; and art. 46 Community Trade Mark Regulation; and, in design law, art. L 513-1 French Intellectual Property Code; art. 3:14(1) Benelux Convention on Intellectual Property 2005; art. 27(2) German Designs Act; and art. 12 Community Designs Regulation.

<sup>254</sup> See e.g., in trademark law, sec. 42(1) UK Trade Marks Act 1994 and sec. 8 US Trademark Act 1946 (15 USC § 1058); and, in design law, sec. 8(1) UK Registered Designs Act 1949.

<sup>255</sup> See e.g. art. 19(1) Dutch Patents Act 1995.

filed in the registers,<sup>256</sup> it can moreover be determined whether an invention, design or trademark has entered the public domain before the official expiry date.

Until 1976, formalities also greatly facilitated the calculation of copyright terms in the US. The 1909 Copyright Act laid down a fixed term of protection of twenty-eight years, which began at the date of first publication.<sup>257</sup> As all copies of a work were to be marked with a copyright notice, including the date of first publication, the time of commencing of copyright was immediately displayed. Hence, the initial term of protection could easily be calculated.<sup>258</sup> Additionally, upon registration with the US Copyright Office, the copyright could be renewed for another twenty-eight years.<sup>259</sup> It could be inferred from the records of the US Copyright Office, therefore, whether a copyright was in its second term or whether it had already expired.

This changed when, pursuant to the 1976 US Copyright Act, the copyright terms were no longer measured from the date of first publication, but from the date of the author's death.<sup>260</sup> Since then, term calculation has been dependent on information about the author's death, which cannot be directly deduced from the registers or the copyright notice. To nevertheless facilitate the calculation of the copyright term, the US Register of Copyrights is instructed to maintain current records of information relating to the death of authors of copyrighted works, based on recorded statements made by interested parties and, in so far as it is practicable, on data contained in any of the records of the US Copyright Office or in other reference sources.<sup>261</sup>

## 2.4 Conclusion

The previous sections have demonstrated that, within the framework of intellectual property, formalities may perform a number of important functions. First, if subject matter for which formalities have not been completed is excluded from protection, they impose an initial filter separating protected from unprotected subject matter. In addition, formalities can help to demarcate and outline the subject matter and scope of protection, both positively, by requiring applicants to clearly specify the features of an invention or design for which they claim protection and the goods or services for which they seek trademark registration, and negatively, by refusing registration for subject matter that does not meet the substantive requirements of protection.

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<sup>256</sup> See e.g. art. 62 Dutch Patents Act 1995, indicating that the expiry of patents resulting from a failure to pay the maintenance fees before the prescribed due date shall be recorded in the patent register. See also art. 30(1) German Patents Act.

<sup>257</sup> Sec. 23 of the US Copyright Act 1909; 17 USC § 24 (1947).

<sup>258</sup> See H.R. Report No. 94-1476, 94th Cong., 2nd Sess. (1976), at 143 and *Harry Alter Co. v. Graves Refrigeration, Inc.*, 101 F.Supp. 703 (US District Court of Georgia, 1951), at 705.

<sup>259</sup> Sec. 23 of the US Copyright Act 1909; 17 USC § 24 (1947).

<sup>260</sup> 17 USC § 302(a) and (b). Nonetheless, for anonymous works, pseudonymous works and works made for hire, the law lays down fixed terms of protection. See 17 USC § 302(c).

<sup>261</sup> 17 USC § 302(d).

Moreover, by identifying and making more visible the intangible subject matter of intellectual property, formalities may fulfil an important signalling and publicity function. They can alarm third parties of the existence of intellectual property or of a change of intellectual property ownership, of which they might otherwise have had no knowledge. Similarly, for right owners, they may perform an important evidentiary function. By connecting them with the intellectual property and identifying them as the legal proprietors, formalities can help right owners to prove their title. This may significantly enhance legal certainty for both right owners and third parties.

Finally, formalities may provide a useful source of information from which third parties, by inquiry, can identify the subject matter of protection, ascertain its scope, calculate the term of protection and discover the names and contact details of right owners. This can facilitate the regular exercise of intellectual property rights and, in the end, improve the functioning of intellectual property law as a whole.

Accordingly, it seems safe to conclude that formalities may well be fit to address the challenges that copyright is facing in the current digital era. First, depending on how they are shaped, formalities may contribute greatly to enhancing the free flow of information, by enlarging the public domain and enabling the public to separate protected from unprotected works. Second, by identifying copyrighted works, they may also help to establish more legal certainty over copyright claims. If they also included a provision for excluding subject matter that does not qualify as literary or artistic works or clearly lacks originality, they moreover would help to prevent all kinds of trivial works from entering the copyright arena. Third, by supplying information about copyrighted works, their authors and current right owners plus their contact details, formalities may play a key role in facilitating the licensing of copyright.

In view of these benefits, several – in particular US – scholars have argued that formalities are ‘unquestionably beneficial and desirable’.<sup>262</sup> But this is just one side of the coin. Even if reinstating copyright formalities may have become something worthy of consideration, this does not change the reality of today, namely, that in nearly all countries around the world, copyright formalities have been abolished or reduced to a minimum. This did not happen for no reason. Therefore, to understand why copyright formalities lost their significance, the next two chapters examine the reasons behind their change or abolition at the national and the international level.

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<sup>262</sup> See Ginsburg 2010a, at 344 and Ginsburg 2010b, at 458, who, despite acknowledging the benefits of formalities, petitions strongly against reintroducing mandatory opt in formalities, as she believes that the burden should ‘not be on the author to acquire rights, but rather to *disclaim* them’. Therefore, she seems to endorse formalities only to the extent that they allow the author or right owner to opt out of the copyright system.