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

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Chapter 5

Contextualizing the International Prohibition on Copyright Formalities

The prohibition on formalities is one of the central features of current international copyright law. As we have observed in the previous chapter, it is incorporated in the Berne Convention and, by reference, in the TRIPS Agreement and the WCT. Since the majority of countries are members to at least one of these treaties,⁹¹⁷ virtually all countries in the world are bound by it. Hence, at first glance, there seems to be little room for reintroducing formalities in the existing framework of copyright law.

However, the degree to which countries adhering to the Berne Convention, the TRIPS Agreement and the WCT can impose copyright formalities depends on the scope of the prohibition on formalities. Under the terms of the first sentence of Article 5(2) of the Berne Convention (1971), '[the] enjoyment and the exercise of these rights shall not be subject to any formality'. To determine whether and to what extent the challenges identified in Chapter 1 – i.e., to establish legal certainty over copyright claims, improve rights clearance and enhance the free flow of information – can be addressed by reintroducing copyright formalities, we must systematically and critically analyze this provision. This is done in the following sections.

The chapter first studies the scope of application of the prohibition on formalities by exploring which 'rights' pursuant to Article 5(2) of the Berne Convention cannot be subject to formalities. It also investigates the different application of the Berne prohibition on formalities in the TRIPS Agreement and the WCT (para. 5.1). Then, it scrutinizes which types of 'formalities' are covered by the Berne prohibition on formalities (para. 5.2) and what the reference to the 'enjoyment' and the 'exercise' of rights signifies (para. 5.3). The chapter aims to identify to what extent the present international copyright framework leaves room for reintroducing formalities. This is further elaborated on in the concluding section of this chapter (para. 5.4).

On the surface, Article 5(2) of the Berne Convention seems fairly straightforward but, in practice, its scope is not entirely clear.⁹¹⁸ Some scholars go as far as arguing

⁹¹⁷ In October 2010, there were 164 contracting parties to the Berne Convention, 153 contracting parties to the WTO Agreement (including the TRIPS Agreement) and 88 contracting parties to the WCT.

⁹¹⁸ This critique was already voiced by Potu 1914, at 54. See also Hishinuma 2010, at 463.

that the formalities prohibited by the Berne Convention include all ‘the formal and substantive prerequisites for the *genesis* of the right of the author’.⁹¹⁹ However, this definition appears too broad. Formalities are unlikely to include all the ‘substantive’ conditions for copyright. They at least do not include the substantive conditions that are inherent in the work and that equally determine the genesis of copyright, such as the standard of originality and the idea/expression dichotomy. Other scholars define formalities less broadly,⁹²⁰ but no one appears to have a clear answer as to where the prohibition begins or ends. Unfortunately, this question remained unanswered in the 2009 US-China dispute before the WTO Dispute Settlement Body.⁹²¹ The panel was asked to judge on the compatibility of the Chinese Copyright Act, which subjected copyright protection to pre-publication censorship, with Article 5(2) of the Berne Convention. However, since it already held the Chinese Copyright Act to be at odds with Article 5(1) of the Berne Convention, it did not expressly rule on this question, as it ‘would not contribute further to a positive solution to this dispute’.⁹²²

This chapter attempts to clarify the scope of the Berne prohibition on formalities, by interpreting the provision in the context and in the light of the object and purpose of the Berne Convention. This is in conformity with the 1969 Vienna Convention on the Law of Treaties.⁹²³ When the meaning remains ambiguous or obscure, recourse is made to supplementary means of interpretation, including the preparatory work of the Berne Convention.⁹²⁴ Moreover, where appropriate, it will be examined how the terms of Article 5(2) of the Berne Convention have been explained in literature and court decisions. To the degree that this chapter analyzes the application of the Berne prohibition on formalities under the TRIPS Agreement and the WCT it also looks at the context, object and purpose and other relevant materials of these treaties.

5.1 The Scope of Application of the Prohibition on Formalities

The material scope of application of the prohibition on formalities is defined by the words ‘these rights’ in Article 5(2) of the Berne Convention. These two words refer back to Article 5(1) of the Berne Convention and demarcate the application of the prohibition on formalities in three directions. They establish the territorial reach of

⁹¹⁹ Nordemann, Vinck, Hertin & Meyer 1990, at 77.

⁹²⁰ See Gervais 2010a, at 201, concluding that ‘the two characteristics of prohibited formalities under Article 5(2) are thus that they should be (a) imposed by law and (b) copyright-specific’. See also Gervais 2005, at 351, Gervais 2006, at 34 and Gervais 2010b, at 26.

⁹²¹ See WTO Panel Report, ‘China – Measures Affecting the Protection and Enforcement of Intellectual Property Rights’, WT/DS362/R, 26 January 2009 (adopted on 20 March 2009), paras 7.145 to 7.153 and para. 7.192: ‘The Panel exercises judicial economy with respect to the claim under Article 5(2) of the Berne Convention (1971), as incorporated by Article 9.1 of the TRIPS Agreement’.

⁹²² *Ibid.*, para. 7.153.

⁹²³ Art. 31 of the Vienna Convention on the Law of Treaties, done at Vienna on 23 May 1969, entered into force on 27 January 1980 [Vienna Convention on the Law of Treaties].

⁹²⁴ *Ibid.*, art. 32.

the prohibition on formalities (para. 5.1.1), the substantive elements of copyright to which it applies (para. 5.1.2) and, finally, its addressees (para. 5.1.3).

This section investigates the three areas in which the scope of application of the prohibition on formalities is delineated. The object of this investigation is to identify the room that the international copyright framework leaves for a reintroduction of formalities. It will be seen that the international copyright treaties do not completely ban formalities, but that they offer too little room for reintroducing formalities with the purpose of addressing the various challenges in current copyright law.

5.1.1 THE TERRITORIAL SCOPE OF THE PROHIBITION ON FORMALITIES

Article 5(2) of the Berne Convention prohibits Berne Union states from imposing formalities on non-domestic works for which protection is claimed under the Berne Convention.⁹²⁵ This follows from the words ‘these rights’, which refer to rights that contracting states must grant to copyright owners from countries of the Berne Union other than the country of origin of the work.⁹²⁶ Except for purely national situations, it is prohibited to subject authors and copyright owners to formalities.

Because of the incorporation by reference of the Berne prohibition on formalities in the TRIPS Agreement and the WCT, the territorial application of this prohibition is similar under these treaties. WTO members and contracting states to the WCT are prohibited from subjecting non-domestic works that qualify for protection under the TRIPS Agreement or the WCT to formalities.⁹²⁷ The prohibition on formalities does not extend to the protection of domestic works in their country of origin.⁹²⁸

Hence, the prohibition on formalities applies only to international situations. This leaves considerable room for reintroducing formalities. All countries adhering to the Berne Convention, the TRIPS Agreement and/or the WCT remain absolutely free to impose formalities on works of which they are the country of origin.⁹²⁹ As observed, the US has exercised this liberty by making the institution of infringement suits for

⁹²⁵ Masouyé 1978, at 33.

⁹²⁶ Pursuant to art. 5(3) of the Berne Convention, protection in the country of origin, which is established according to the criteria of art. 5(4) of the Berne Convention, is governed by domestic law.

⁹²⁷ See the Agreed Statement concerning art. 3 WCT and Reinbothe & Von Lewinski 2002, at 59-60.

⁹²⁸ See e.g. the ruling of the Dutch Supreme Court of 30 October 2009, *Montis (Charly & Chaplin)*, *AMI* 2010, no. 6, at 68-69, note M.M.M. van Eechoud.

⁹²⁹ *Actes 1908*, at 237; Berne Centenary 1986, at 148. See also Wauwermans 1910, at 70-71, stating: ‘la législation du pays où l’œuvre est publiée conserve le droit de subordonner à telles conditions qu’elle estime convenir, l’existence ou l’exercice du droit à la protection dans ce pays en ce qui concerne ses nationaux. C’est affaire de droit interne’. See also the rulings of the Dutch Supreme Court of 26 May 2000, *Cassina v. Jacobs*, *NJ* 2000, 671, note D.W.F. Verkade and *AMI* 2000, at 210-214, note N. van Lingen and of the Dutch Supreme Court of 11 May 2001, *Vredestein v. Ring 65*, *NJ* 2002, 55, note J.H. Spoor and *AMI* 2001, no. 14, at 97-99, note N. van Lingen, where it was held that a particular Dutch formality, i.e. a declaration (‘*instandhoudingsverklaring*’) with the Benelux Bureau for Design Registration necessary for maintaining copyright in industrial designs after the expiration of designs protection (see para. 5.3.1.2), could not be imposed on Italian works but only on Dutch works.

works of US origin dependent on registration. However, the possibility of imposing formalities on domestic works is not limited to declaratory formalities. Works in the country of origin may be subject to all types of formalities, including constitutive and maintenance formalities. Thus, countries have sufficient opportunity to impose those formalities that most effectively address the challenges to be overcome.

At first sight, this suggests that there is enough room for reintroducing copyright formalities with a view to addressing the challenges that we identified in Chapter 1. It is feasible, for example, that countries subject the protection of domestic works to registration and that the different national registers so established are combined and integrated into an international register. This would have the advantage of creating a universal repository of information on copyright protected works that would not run counter to the international prohibition on formalities. It would also be possible that countries make the protection of domestic works conditional on a copyright notice. This would have the advantage of making valuable information about copyright readily available, even if the works are distributed beyond their national borders.

From an international viewpoint, however, a reintroduction of formalities along this line would have the effect of facilitating rights clearance, but the effects on establishing legal certainty over copyright claims and on enhancing the free flow of information would be minimal. Even if countries subject the protection of domestic works to constitutive formalities, a failure to fulfil them would not cause the works to enter the public domain in other contracting parties to the Berne Convention, the TRIPS Agreement and the WCT, as they are obliged to protect works independently from the protection in the country of origin.⁹³⁰ This would result in the odd situation of works enjoying protection around the world, but not in their home country.⁹³¹

Consequently, subjecting works to formalities in the country of origin may have the effects of creating legal certainty over copyright claims and enhancing the free flow of information, but these effects are limited to the country of origin. In other countries, the work will be protected even if it resides in the public domain in the home country due to a failure to fulfil the domestic formalities. Conversely, in the country that subjects domestic works to formalities, the same effects will apply only to domestic works, because foreign works cannot be subject to formalities.

Moreover, it is uncertain whether countries are willing to subject domestic works to formalities. There is a clear and understandable antipathy to the idea of giving foreign authors better protection than national authors. This was also the reason why most countries, when joining the Berne Convention, the TRIPS Agreement or the WCT decided not just to abolish formalities in relation to foreign works, but to grant unconditional protection to all works, irrespective of their origin.⁹³² Furthermore, national authors can fairly easily circumvent the domestic formalities

⁹³⁰ See De Beaufort 1909, at 353, with respect to the Berne Convention.

⁹³¹ See *Le Droit d'Auteur* 1910, 2-7, at 7 and Allfeld 1928, at 418.

⁹³² See Briggs 1906, at 293-294, Ricketson 1987, at 206, Reinbothe & Von Lewinski 2002, at 60 and Ricketson & Ginsburg 2006, I, at 311.

by manipulating the country of origin. They can publish their works in contracting states to the Berne Convention, the TRIPS Agreement or the WCT that impose no formalities. By so doing, national authors evade domestic formalities, while retaining protection in their own country by virtue of the Berne Convention, the TRIPS Agreement or the WCT.⁹³³

Therefore, a system that relies on a reintroduction of formalities in the country of origin would seem to require a coordinated approach and broad support, preferably from states adhering to the Berne Convention, the TRIPS Agreement and the WCT collectively. In the absence of mutual agreement between countries about subjecting domestic works to copyright formalities, it is unlikely that countries on their own accord will make the protection of domestic works conditional on formalities. This is especially so, given that the system is only as strong as its weakest link. Because it can be commercially interesting for countries to abstain from partaking in a collective approach, as this can make them attractive publishing havens for authors seeking to circumvent domestic formalities, a collective approach seems unrealistic.

5.1.2 THE SUBSTANTIVE SCOPE OF THE PROHIBITION ON FORMALITIES

The scope of application of the prohibition on formalities is also demarcated by the substantive elements of copyright to which it applies. To identify these elements, it must first be examined how the prohibition on formalities is to be applied under the different treaties and whether, and to what extent, it applies to rights that are subject to the rule of national treatment (para. 5.1.2.1). After this general examination, this section specifically studies how the prohibition on formalities applies to the subject matter of protection (para. 5.1.2.2), the rights to be protected (para. 5.1.2.3) and the duration of protection (para. 5.1.2.4). This investigation demonstrates that, while the substantive coverage of the prohibition on formalities is very broad, there are a few situations in which a specific type of work or a specific type of right can be subject to formalities. Accordingly, the framework of substantive law leaves some room for reintroducing formalities, but it does not permit a generic introduction of copyright formalities with a view to addressing the challenges in current copyright law.

5.1.2.1 PRELIMINARY OBSERVATIONS

The substantive scope of application of the prohibition on formalities is determined entirely by the way in which the prohibition on formalities is to be applied under the Berne Convention, the TRIPS Agreement and the WCT. This includes not only its application to the rights specially granted by these treaties, but also to the protection

⁹³³ See Ladas 1938, I, at 275, note 38. Especially in the online environment, manipulating the country of origin is fairly easy. See e.g. Austin 2005, at 416-417.

to be granted pursuant to the rule of national treatment. Before the application of the prohibition on formalities to the subject matter of protection, the rights and duration of protection is analyzed, this section first examines its application in general.

The Application of the Prohibition on Formalities under the Different Treaties

Article 5(2) of the Berne Convention prohibits Berne Union states from subjecting the minimum corpus of rights laid down in the Berne Convention and the rights that must be granted pursuant to the rule of national treatment to formalities. Again, this follows from the words ‘these rights’, which refer to ‘the rights specially granted by this Convention’ (i.e., the Berne minima) and ‘the rights which their respective laws do now or may hereafter grant to their nationals’ (i.e., the rule of national treatment) ‘in respect of works ... protected under this Convention’, as provided for by Article 5(1) of the Berne Convention. Consequently, the prohibition on formalities applies to the whole range of rights that can be claimed under the Berne Convention.

Under the TRIPS Agreement, the prohibition on formalities seems to apply only to the rights that can be claimed pursuant to the provisions of the Berne Convention that are incorporated by reference. This includes the Berne minima and the rights to be granted under the principle of national treatment enshrined in Article 5(1) of the Berne Convention.⁹³⁴ Because the TRIPS Agreement contains no ‘*mutatis mutandis* application’ rule, the prohibition on formalities appears not to extend to the ‘Berne-plus’ provisions in Section 1 of Part II (‘Copyright and related rights’) of the TRIPS Agreement. If it did, it would also be applicable in relation to related (neighbouring) rights of performers, phonograms producers and broadcasting organizations.⁹³⁵ This would conflict with the protection of related rights under the Rome Convention, which is not subject to a prohibition on formalities, but to a uniform notice formality (a ‘p-in-a-circle’).⁹³⁶ Therefore, it would be at odds with the intention of the TRIPS Agreement not to derogate from existing obligations of WTO members under the key intellectual property treaties, including the Rome Convention, if the prohibition on formalities would also be applicable to the ‘Berne-plus’ provisions.⁹³⁷

Nonetheless, some of the ‘Berne-plus’ provisions in TRIPS seem to be so closely linked to the Berne Convention that they may perhaps be subject to the prohibition

⁹³⁴ Art. 3(1) of the TRIPS Agreement also contains a rule of national treatment. For the purpose of the application of the prohibition on formalities, however, the applicable rule seems to be art. 5(1) of the Berne Convention, because in the TRIPS context, the prohibition on formalities is not applied *mutatis mutandis*. Therefore, it is governed solely by the relevant provisions of the Berne Convention.

⁹³⁵ Art. 14 of the TRIPS Agreement.

⁹³⁶ Art. 11 of the International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations, adopted at Rome on 26 October 1961 [Rome Convention] provides, in relation to the international protection of published phonograms, that all domestic formalities are regarded as fulfilled if the copies of a phonogram bear a notice consisting of a ‘p-in-a-circle’ plus the year of first publication and the names of the owners of the related right in the phonogram.

⁹³⁷ Art. 2(2) of the TRIPS Agreement.

on formalities in a roundabout way. This may arguably be the case where the TRIPS Agreement brings a provision directly within the scope of the Berne Convention or where a provision lies within the object of protection of the Berne Convention and therefore should be granted national treatment pursuant to Article 5(1) of the Berne Convention. In the next sections, the provisions in the TRIPS Agreement relating to computer programs, databases and rental rights are examined in more detail.

Under the WCT, the application of the prohibition on formalities is broader than under the Berne Convention and the TRIPS Agreement. The prohibition applies not only to the provisions of the Berne Convention that are incorporated by reference with Article 1(4) of the WCT, but also to the ‘Berne-plus’ provisions in the WCT. This follows from the ‘*mutatis mutandis* application’ rule of Article 3 of the WCT, which suggests that, ‘in respect of works ... protected under the Berne Convention and the WCT’, the contracting parties to the WCT are prohibited from subjecting ‘the rights specially granted by the Berne Convention and the WCT’ (i.e., the Berne and WCT minima) and ‘the rights which their respective laws do now or may hereafter grant to their nationals’ (i.e., the rule of national treatment) to formalities.⁹³⁸ Hence, the prohibition on formalities applies to all rights that can be claimed under the WCT, either by virtue of the Berne provisions that are incorporated by reference or on the basis of the WCT provisions directly. However, as will be seen later, the prohibition on formalities appears to be limited to copyright protection, which implies that it is not applicable to certain provisions in the WCT that aim at protecting technological protection measures (TPMs) and rights management information (RMI).

The Prohibition on Formalities and the Rule of National Treatment

The previous section has shown that the prohibition on formalities is also applicable to the rights to be granted by virtue of the rule of national treatment, as enshrined in Article 5(1) of the Berne Convention. This provision is incorporated by reference in the TRIPS Agreement and the WCT and it applies *mutatis mutandis* in the context of the WCT. The rule of national treatment obliges contracting states to confer ‘the rights which their respective laws do now or may hereafter grant to their nationals’ on foreign works for which protection is claimed under the relevant treaty.

As a rule, national treatment extends to those matters that lie within the object of protection of the relevant treaty.⁹³⁹ That is the Berne Convention, when protection is claimed under this Convention or the TRIPS Agreement, and the Berne Convention plus the WCT, when protection is claimed under the WCT. The object of protection of the Berne Convention and the WCT is ‘the protection of the rights of authors in

⁹³⁸ See the instruction of the Agreed Statement concerning art. 3 of the WCT.

⁹³⁹ See e.g. Vaver 1986, I, at 582-584, Ricketson 1987, at 208 et seq. and Ricketson & Ginsburg 2006, I, at 312 et seq.

their literary and artistic works'.⁹⁴⁰ The national treatment obligation thus extends to the subject matter, the rights and the duration of copyright protection. Anything that lies entirely outside these matters is not subject to national treatment.⁹⁴¹

The question remains how the prohibition on formalities applies in relation to the rights that are subject to national treatment. If it is regarded purely as a rule of non-discrimination, 'promising foreign creators who come within the treaty's protection that they will enjoy in the protecting country no less favorable treatment for their creations as the protecting country gives to its own nationals',⁹⁴² then it can perhaps be argued that, as long as formalities are applied in a non-discriminatory manner, it would not conflict with the prohibition on formalities if a right granted beyond the minimum treaty rights is subject to formalities. Yet, if the prohibition on formalities pertains to 'the rights which their respective laws do now or may hereafter grant to their nationals', then it would apply to all rights that contracting states grant beyond the minimum treaty standards and that lie within the treaty's objectives.

Given the rules of customary international law, as codified in Section 3 of Part III of the Vienna Convention on the Law of Treaties, the latter interpretation seems to prevail. Article 31(1) of the Vienna Convention states that the terms of a treaty must be interpreted (i) in accordance with their ordinary meaning, (ii) in their context and (iii) in the light of the object and purpose of the treaty.⁹⁴³ All three elements seem to support the interpretation that the prohibition on formalities also applies to the rights that contracting states must grant pursuant to the rule of national treatment.

First, when read in conjunction, the first and second paragraph of Article 5 of the Berne Convention clearly prohibit contracting states from making 'the rights which their respective laws do now or may hereafter grant to their nationals' dependent on formalities. The Berne Convention contains no exceptions to this rule. An objective, textual analysis of the prohibition on formalities therefore negates the interpretation that rights that fall under the rule of national treatment can be subject to formalities, provided that they are imposed in a non-discriminatory way on national and foreign works. Second, if the prohibition on formalities is seen in the light and context of its legislative history (Chapter 4), then it becomes abundantly clear that, by introducing this prohibition, contracting states aimed to create a situation in which authors would be free from complying with copyright formalities in each and every contracting state to secure international protection. Therefore, it was prohibited for contracting states to subject the protection of the Berne Convention, including the rights to be granted pursuant to the rule of national treatment, to formalities. This also corresponds with the object and purpose of the Berne Convention, which is to

⁹⁴⁰ See the preamble and art. 1 of the Berne Convention and the preamble of the WCT.

⁹⁴¹ See Ricketson 1987, at 209 and Ricketson & Ginsburg 2006, I, at 315.

⁹⁴² Goldstein & Hugenholtz 2010, at 99. See also Ladas 1938, I, at 365, arguing that national treatment implies a 'complete assimilation of foreigners to nationals, without condition of reciprocity'.

⁹⁴³ See Senftleben 2004, at 99-101, who reads this rule of treaty interpretation as giving preference to the objective approach (focusing on the meaning of the text) over the subjective approach (focusing on the intention of the parties) and the teleological approach (focusing on the object and purpose).

guarantee an adequate and effective protection of literary and artistic works at the international level.

Thus it seems safe to conclude that the prohibition on formalities does not merely apply to the minimum treaty standards, but also to the protection to be granted under the rule of national treatment. All rights that are granted beyond the minimum treaty standards and that lie within the object of protection of the Berne Convention (and the WCT when protection is claimed under this treaty) are subject to the prohibition on formalities. For all other rights the prohibition does not apply, even if contracting states voluntarily extend the protection of those rights to foreign authors.⁹⁴⁴

5.1.2.2 SUBJECT MATTER OF PROTECTION

Under the Berne Convention, the prohibition on formalities applies to all rights that must be granted to authors ‘in respect of works for which they are protected under this Convention’.⁹⁴⁵ These are ‘literary and artistic works’, which generally include ‘every production in the literary, scientific and artistic domain, whatever may be the mode or form of its expression’.⁹⁴⁶ In the Berne Convention, a number of examples of ‘literary and artistic works’ is given, but this list is non-exhaustive.⁹⁴⁷

If a Berne Union state protects subject matter that is not included in the examples listed in the Berne Convention, it should be determined through legal interpretation whether it qualifies as a Berne protected literary or artistic work.⁹⁴⁸ If so, it must be granted national treatment and its protection may not be subjected to formalities. If not, contracting states are under no obligation to extend national protection of this subject matter to foreign authors⁹⁴⁹ and, even if they do, the Berne Convention does not prohibit them from making this protection conditional on formalities.

⁹⁴⁴ See Vaver 1986, I, at 596. Examples of rights that lie entirely outside the copyright framework are rights of authors to social security or social welfare payments, tax reductions, promotional measures, subsidies or *domaine public payant* (i.e. special royalties from public domain works that are paid into cultural and/or social funds in order to support living authors). See Vaver 1986, II, at 718.

⁹⁴⁵ See art. 5(1) in conjunction with art. 5(2) of the Berne Convention.

⁹⁴⁶ Article 2(1) of the Berne Convention.

⁹⁴⁷ The Berne Convention names ‘books, pamphlets and other writings; lectures, addresses, sermons and other works of the same nature; dramatic or dramatic-musical works; choreographic works and entertainments in dumb show; musical compositions with or without words; cinematographic works ...; works of drawing, painting, architecture, sculpture, engraving and lithography; photographic works ...; works of applied art; illustrations, maps, plans, sketches and three-dimensional works relative to geography, topography, architecture or science’ in art. 2(1), ‘translations, adaptations, arrangements of music and other alterations of a literary or artistic work’ in art. 2(3) and ‘collections of literary or artistic works such as encyclopedias and anthologies which, by reason of the selection and arrangement of their contents, constitute intellectual creations’ in art. 2(5).

⁹⁴⁸ See Vaver 1986, I, at 597, Goldstein 2001, at 78 and Goldstein & Hugenholtz 2010, at 105.

⁹⁴⁹ Vaver 1986, I, at 590 et seq.

An example of subject matter that falls outside the Berne definition of ‘literary and artistic works’ is subject matter protected by related rights, such as phonograms (sound recordings).⁹⁵⁰ Although, in some jurisdictions, phonograms are protected by copyright law in a narrow sense,⁹⁵¹ under the Berne Convention, there is no requirement to extend national treatment to the protection of phonograms and, consequently, there is no prohibition on subjecting this protection to formalities.⁹⁵² Another example of subject matter to which the rule of national treatment does not apply is topographies of semiconductor products (chips design). Although their protection resembles the protection of copyright in the sense that originality is required before protection is afforded,⁹⁵³ topographies of semiconductor products are not literary or artistic works in the meaning of the Berne Convention. Therefore, their protection can be subject to formalities and many countries have indeed decided to do so.⁹⁵⁴

Moreover, Article 2(7) of the Berne Convention contains one specific exception to the rule of national treatment. Contracting states are not obliged to grant national copyright protection to works of applied art and industrial designs and models that in their country of origin are solely protected by design law. The protection of such works is subject to material reciprocity, which means that contracting states are only obliged to protect them under design law. If a contracting state has no design law, however, then it must protect them as artistic works under copyright law.⁹⁵⁵ Works of applied art and industrial designs and models that in their country of origin are protected by copyright law, or by design law and copyright law cumulatively, must also be protected under copyright law in other contracting states, unless these states protect such works solely with design law, in which case they must be protected under design law.⁹⁵⁶ The Berne Convention prohibits contracting states from subjecting works of applied art and industrial designs and models to formalities only

⁹⁵⁰ Vaver 1986, I, at 598 et seq. In the past, some scholars considered sound recordings as adaptations of musical works and thus as Berne protected works. See Ladas 1938, I, at 424-426, repudiating this.

⁹⁵¹ This is the case for example in the US. See 17 USC § 102(a)(7).

⁹⁵² Other treaties, however, may include specific rules about subjecting the protection of phonograms to formalities. Examples are art. 11 of the 1961 Rome Convention, allowing contracting states to subject the protection of phonograms to a specific notice formality (a ‘p-in-a-circle’), and art. 20 of the 1996 WIPO Performances and Phonograms Treaty (WPPT), prohibiting contracting states from subjecting the enjoyment and the exercise of the rights provided for in the WPPT to formalities.

⁹⁵³ See art. 2(2) of the EU Council Directive 87/54/EEC of 16 December 1986 on the legal protection of topographies of semiconductor products, *OJL* 24/36, 27 January 1987 [EU Semiconductor Directive] and 17 USC § 902(b)(1), as introduced by the 1984 Semiconductor Chip Protection Act, Pub. L. No. 98-620, 98 Stat. 3347. In the US, the protection of chips design is embodied in copyright law.

⁹⁵⁴ Art. 4(1) of the EU Semiconductor Directive permits EU Member States to subject the protection to a registration or deposit requirement. See also 17 USC § 902(a)(1)(A) in conjunction with 17 USC § 908, which lays down a registration requirement for mask works.

⁹⁵⁵ See the last sentence of art. 2(7) of the Berne Convention.

⁹⁵⁶ See the first sentence of art. 2(7) of the Berne Convention.

in so far as it requires such works to be protected under copyright law.⁹⁵⁷ Design protection, on the other hand, can be made conditional on registration or deposit.⁹⁵⁸

For two other types of subject matter, computer programs (software) and original databases, it is uncertain whether they qualify as literary or artistic works under the Berne Convention. In so far as computer language can be made visually perceptible and readily comprehensible, software may perhaps qualify as a literary work under the Berne Convention, provided of course that it results from creative authorship.⁹⁵⁹ However, it is questionable whether all elements of a computer program, the source code and object code, in particular, satisfy these criteria.⁹⁶⁰ To the degree that they do not, they are not protected under the Berne Convention and therefore they may be subject to formalities. The same applies to databases, which seem to be excluded from the protection of the Berne Convention as well. The protection of collections of literary and artistic works, such as encyclopaedias and anthologies (Article 2(5) of the Berne Convention), appears not to extend to databases or other compilations of data.⁹⁶¹ Consequently, the Berne Convention does not seem to prohibit contracting states from making the protection of databases conditional on formalities.

Even so, software and original databases are protected by the TRIPS Agreement and the WCT.⁹⁶² Given the '*mutatis mutandis* application' of the Berne prohibition on formalities under the WCT, their protection under the WCT cannot be subject to formalities. It is uncertain however whether under the TRIPS Agreement this is also the case. This requires legal interpretation. On the one hand, the TRIPS Agreement does not provide that the prohibition on formalities applies *mutatis mutandis* to the 'Berne-plus' rights in the TRIPS Agreement. This suggests that only the provisions of the Berne Convention that are incorporated by reference are subject to the Berne

⁹⁵⁷ See the ruling of the Dutch Supreme Court of 26 May 2000, *Cassina v. Jacobs*, NJ 2000, 671, note D.W.F. Verkade and *AMI* 2000, at 210-214, note N. van Lingen, in which it was held that the former art. 21(3) of the Benelux Designs Act was at odds with the Berne prohibition on formalities, because it made the continuation of copyright after the expiry of the term of design protection (max. 15 years) conditional on the deposit of a 'maintenance notice' ('*instandhoudingsverklaring*') with the Benelux Bureau for Design Registration. In this specific case, however, the Berne Convention seems to have been applied wrongly. It involved the expiry of copyright in Italian furniture designs due to a failure to deposit the required 'maintenance notice'. Since Italy did not protect designs under copyright, the Berne Convention neither required contracting states to extend national copyright protection to Italian designs, nor prohibited them from subjecting Italian designs to formalities. See the conclusion of the Advocate-General Mr Langemeijer, at 2.11, and Nordemann, Vinck, Hertin & Meyer 1990, at 53.

⁹⁵⁸ See Dreier in Dreier & Hugenholtz 2006, at 17.

⁹⁵⁹ See Vaver 1986, I, at 602 et seq.

⁹⁶⁰ For an exhaustive overview of the protection of software as a literary work, see Van Rooijen 2010, at 53-61. See also Vaver 1986, I, at 602 et seq. and Ricketson 1987, at 897-898.

⁹⁶¹ See Gervais 2003, at 136.

⁹⁶² See art. 10(1) and (2) of the TRIPS Agreement and arts 4 and 5 of the WCT. The database protection of the TRIPS Agreement and the WCT does not extend to non-original databases (as protected, *inter alia*, by the *sui generis* right granted under the EU Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases, *OJ L 77/20*, 27 March 1996).

prohibition on formalities and that this prohibition does not extend to the protection of software and databases under the TRIPS Agreement. As observed, it is uncertain whether software and databases are Berne-protected works and their inclusion in the TRIPS Agreement (or the WCT) has not changed this.⁹⁶³ On the other hand, it may perhaps be argued that, under the TRIPS Agreement, the prohibition on formalities should at least also apply to the protection of software, since the TRIPS Agreement literally provides that '[computer] programs, whether in source or object code, shall be protected as literary works under the Berne Convention'.⁹⁶⁴ Similarly the TRIPS Agreement states that certain databases can be protected as intellectual creations,⁹⁶⁵ which may also suggest that they are to be protected as a Berne-protected work, for the term 'intellectual creations' is directly borrowed from Article 2(5) of the Berne Convention.⁹⁶⁶ However, whether it can be concluded from this that the prohibition on formalities also applies to software and databases under the TRIPS Agreement is doubtful. Nothing in the legislative history of the TRIPS Agreement supports this conclusion. Therefore, and in the absence of a clear '*mutatis mutandis* application' rule, it seems that a more restrictive legal interpretation should prevail.

5.1.2.3 EXCLUSIVE RIGHTS

Under the Berne Convention, the prohibition on formalities applies to the minimum set of rights laid down in the Berne Convention and the rights that must be granted pursuant to the rule of national treatment. The rights specially granted by the Berne Convention include moral rights; the rights of translation and reproduction; certain rights in dramatic and musical works; broadcasting and associated rights; certain rights in literary works; the rights of adaptation, arrangement and other alteration; and cinematographic and associated rights.⁹⁶⁷ Article 5(2) of the Berne Convention prohibits contracting states from subjecting these rights to formalities.

In addition, Berne Union states are prohibited from making the rights for which they must grant national treatment conditional on formalities. As observed, these are all rights granted to nationals that are '*in pari materia*' with the rights laid down in the Berne Convention.⁹⁶⁸ However, one right is explicitly exempted from the rule of

⁹⁶³ It is a general rule of public international law that in case of successive treaties on the same topic, the later treaty does not alter the meaning of the provisions of substantive law of the earlier treaty, unless this is explicitly stated and approved by all the parties to the earlier treaty. See arts 30(4) and (5) in conjunction with arts 39 to 41 of the Vienna Convention on the Law of Treaties. This is neither the case under the TRIPS Agreement, which was concluded in a different context (WTO) than the Berne Convention (WIPO), nor under the WCT, which is a special agreement between a number of Union states granting to authors more extensive rights than those granted by the Berne Convention.

⁹⁶⁴ Art. 10(1) of the TRIPS Agreement.

⁹⁶⁵ Art. 10(2) of the TRIPS Agreement.

⁹⁶⁶ See Gervais 2003, at 137.

⁹⁶⁷ See arts 6*bis*, 8, 9, 11, 11*bis*, 11*ter*, 12 and 14 of the Berne Convention.

⁹⁶⁸ Vaver 1986, II, at 718.

national treatment. This is the resale royalty right (or *droit de suite*), i.e., the author's right to a share of the profits of the sale of his work after the first transfer of that work by the author. Berne Union states are not compelled to protect this right and, even if they do, they are not obliged to grant national treatment. The protection of the resale royalty right is subject to material reciprocity.⁹⁶⁹ Accordingly, it seems not to be prohibited to subject the protection of this right to formalities.⁹⁷⁰

For other types of rights, such as public lending and commercial rental rights, it is more difficult to establish whether the Berne Convention creates an obligation for contracting states to grant national treatment. It seems that a lending or rental rights scheme may fall under the Convention's national treatment obligation if it 'takes the form of giving the author a right to receive remuneration ... each time it authorizes a person to borrow [or to rent] his/her book [or work]'.⁹⁷¹ However, if it takes the form of a social welfare scheme, it would probably not be covered by Article 5(1) of the Berne Convention.⁹⁷² Hence, whether national treatment must be granted seems to depend chiefly on how the lending or rental rights scheme is set up and regulated by national law.⁹⁷³ Contracting states are prohibited from subjecting these rights to formalities only to the extent that they are to be granted national treatment.

The TRIPS Agreement, on the other hand, contains a commercial rental right in respect of computer programs and cinematographic works.⁹⁷⁴ Since the prohibition on formalities does not apply *mutatis mutandis* to the 'Berne-plus' rights provided for in the TRIPS Agreement, however, WTO members do not seem to be prohibited from subjecting the protection of this right to formalities. The Berne prohibition on formalities applies only to the Berne provisions that are incorporated by reference in the TRIPS Agreement. Thus, WTO members seem to be prohibited from subjecting the protection of the commercial rental right to formalities, only if it comes within the national treatment obligation of Article 5(1) of the Berne Convention.

This is different under the WCT. Here, the prohibition on formalities applies both to the Berne provisions that are incorporated by reference in the WCT and *mutatis mutandis* to the protection provided for in the WCT.⁹⁷⁵ This includes the exclusive rights of distribution, commercial rental and communication and making available

⁹⁶⁹ See art. 14ter(2) Berne Convention. See also Vaver 1986, II, at 719.

⁹⁷⁰ Pursuant to art. 121(5) of the German Copyright and Neighbouring Rights Act 1965, foreign authors can benefit from the *droit de suite* only if the government of the country to which they belong has officially proclaimed that it grants a corresponding right to German authors. Irrespective of whether it constitutes a 'formality' in the meaning of the Berne Convention, this requirement is compatible with the prohibition on formalities. See Nordemann, Vinck, Hertin & Meyer 1990, at 78.

⁹⁷¹ Vaver 1986, II, at 720.

⁹⁷² *Ibid.*, at 720. See also Goldstein 2001, at 83 and Goldstein & Hugenholtz 2010, at 108.

⁹⁷³ See Ricketson 1987, at 210 and Ricketson & Ginsburg 2006, I, at 316-317. But see Desbois, Françon & Kerever 1976, at 152-153, Nordemann, Vinck, Hertin & Meyer 1990, at 73 and Kerever 1993, at 92, who assert that national treatment extends to every right that flows from the act of authorship.

⁹⁷⁴ Art. 11 of the TRIPS Agreement.

⁹⁷⁵ Art. 3 of the WCT.

to the public.⁹⁷⁶ Whether the prohibition on formalities also extends to Articles 11 and 12 of the WCT, which create the obligations to protect technological protection measures (TPMs) and rights management information (RMI), is uncertain.

On the surface, Articles 11 and 12 of the WCT appear to be included among the provisions that are subject to the prohibition on formalities. Article 3 of the WCT provides that Article 5(2) of the Berne Convention applies *mutatis mutandis* to ‘the protection provided for’ in the WCT. Moreover, the legislative history of the WCT suggests that Articles 3 to 6 of the Berne Convention be applicable ‘to all new rights and aspects of protection in the present draft’.⁹⁷⁷ This seems to imply that the basic provisions of Berne, including the prohibition on formalities, would also apply to the protection of TPMs and RMI under Articles 11 and 12 of the WCT.⁹⁷⁸

On the other hand, there are strong indications that the prohibition on formalities does not apply to all elements of protection in the WCT, but only to ‘the protection of the rights of authors in their literary and artistic works’.⁹⁷⁹ Despite the wording of Article 3 of the WCT suggesting that the prohibition applies *mutatis mutandis* to ‘the protection provided for’ in the WCT, Article 5(2) of the Berne Convention only prohibits contracting states from subjecting ‘these rights’ to formalities. Pursuant to the Agreed Statement concerning Article 3 of the WCT, in the context of the WCT, this includes the rights that are to be granted under the rule of national treatment and ‘the rights specially granted by the Berne Convention and the WCT’ with respect to ‘works ... protected under the Berne Convention and the WCT’.⁹⁸⁰

Articles 11 and 12 of the WCT, however, constitute no ‘rights’ in the meaning of Article 5(2) of the Berne Convention read in conjunction with the Agreed Statement concerning Article 3 of the WCT. For one thing, they grant no copyright protection in literary and artistic works. TPMs and RMI are not ‘works ... protected under the Berne Convention and the WCT’.⁹⁸¹ In addition, they do not create new substantive or exclusive rights or widen the scope of existing rights.⁹⁸² They merely create new

⁹⁷⁶ Arts 6 to 8 of the WCT.

⁹⁷⁷ *Records of the diplomatic conference in Geneva 1996*, para. 2.02, at 172.

⁹⁷⁸ Reinbothe & Von Lewinski 2002, at 61. See also Wand 2001, at 46, arriving at the same conclusion with respect to the protection of RMI under art. 12 of the WCT. However, he bases this conclusion not on art. 3 of the WCT, but on the Agreed Statement concerning art. 12 of the WCT (*infra* text).

⁹⁷⁹ See *Records of the diplomatic conference in Geneva 1996*, para. 2.01, at 172, stating that, as a matter of reason, ‘it seems feasible and well-founded to build *new protection for literary and artistic works* upon the same principles’ as enshrined in Articles 3 to 6 of the Berne Convention (emphasis added).

⁹⁸⁰ This Agreed Statement is an important source of interpretation of the text of art. 3 of the WCT. It must be regarded as an ‘agreement relating to the treaty which was made between all the parties in connection with the conclusion of the treaty’ under art. 31(2) sub (a) of the Vienna Convention on the Law of Treaties. Therefore, it is part of the context for the purpose of the interpretation of the WCT. See Reinbothe & Von Lewinski 2002, at 19, Ficsor 2002, at 61-64 and Senftleben 2004, at 106.

⁹⁸¹ See Wand 2001, at 36 and 45, arguing that arts 11 and 12 of the WCT do not aim to protect creations of the mind (*‘bestimmter kultureller Geistesschöpfungen’*) and therefore are no substantive copyright rules but ancillary forms of protection (*‘flankierende Bestimmung[en] zur Rechtsdurchsetzung’*).

⁹⁸² See e.g. *Records of the diplomatic conference in Geneva 1996*, para. 13.03, at 216: ‘The obligations established in the proposed Article 13 [i.e. Article 11 WCT] are more akin to public law obligations

obligations for contracting states to provide for adequate legal safeguards in relation to the enforcement or management of copyright.⁹⁸³ Systematically, therefore, these provisions constitute rules of enforcement rather than exclusive rights.⁹⁸⁴

Thus, the Berne prohibition on formalities appears not to apply *mutatis mutandis* to the protection of TPMs against circumvention and the protection of RMI against removal or tampering.⁹⁸⁵ This gives contracting parties to the WCT the opportunity to subject this protection to particular formalities. It is feasible, for example, that the protection of TPMs is made conditional on a mandatory disclosure of the keys and specifications of TPMs that are applied to a work.⁹⁸⁶ This may prevent content being unnecessarily locked up by technology.⁹⁸⁷ Similarly, it would permit contracting states to subject the protection of RMI to a mandatory registration or deposit of RMI in a publicly accessible database.⁹⁸⁸ This can significantly facilitate the clearance of rights and, consequently, address part of the current copyright challenges.

Nonetheless, not all challenges in current copyright law can be addressed by such measures. Contracting parties to the WCT may not rely on Articles 11 and 12 of the WCT to adopt measures that would have the effect of imposing formalities that are not permitted under the Berne Convention or the WCT.⁹⁸⁹ Accordingly, they cannot subject the protection of copyright to a mandatory disclosure of the keys of TPMs or a mandatory registration or deposit of RMI or oblige right owners to apply TPMs or to attach RMI to copies of a work as a prerequisite for the enjoyment or the exercise of copyright.⁹⁹⁰ Since formalities that relate to the protection of TPMs or RMI may

directed at Contracting Parties than to provisions granting “intellectual property rights”. See also Ricketson & Ginsburg 2006, II, at 965 and Senftleben in Dreier & Hugenholtz 2006, at 111.

⁹⁸³ In implementing these provisions, several contracting states have adopted the view that they create no exclusive ‘rights’. See e.g. sec. 375 of the Irish Copyright and Related Rights Act 2000 (on RMI), which is clearly drafted as a remedy for copyright infringement. Other contracting states, however, protect RMI and TPMs as exclusive rights. See e.g. arts 166 and 166a of the Slovenian Copyright and Related Rights Act 2004. See in more detail Guibault et al. 2007, at 79.

⁹⁸⁴ See Reinbothe & Von Lewinski 2002, at 142 and 152-153 and Senftleben in Dreier & Hugenholtz 2006, at 111.

⁹⁸⁵ See Burk & Cohen 2001, at 72-73 and Dusollier 2011 (forthcoming), with respect to the protection of TPMs, and Hugenholtz et al. 2006, at 179-180, Van Gompel 2007, at 682-683 and Van Eechoud et al. 2009, at 274-276, with respect to the protection of RMI. But see Denicola 2004, at 20, arguing that subjecting the protection of TPMs to formalities might well be prohibited under the WCT.

⁹⁸⁶ See Burk & Cohen 2001, at 65-70 and Denicola 2004. Pursuant to art. 95d of the German Copyright and Neighbouring Rights Act 1965, works to which a TPM is applied must be clearly marked with an indication of the characteristics of the TPM and the name and address of the copyright owner, so as to ensure that beneficiaries of a copyright exception can demand the right owner to provide them with the means necessary to benefit from the exception. Failure of doing so is sanctioned by administrative fines (see art. 111a(1) under 3), but does not result in the loss of protection of the TPM.

⁹⁸⁷ Dusollier 2011 (forthcoming), arguing that formalities can help preventing TPMs to lock up creative content, first, by enabling competitors to create interoperable products and, second, by enabling users to legally circumvent TPMs for the purpose of making use of a particular copyright exception.

⁹⁸⁸ See e.g. Hugenholtz et al. 2006, at 179-180, Van Gompel 2007, at 682-683 and Van Eechoud et al. 2009, at 274-276.

⁹⁸⁹ This is explicitly stated in the Agreed Statement concerning Article 12 of the WCT.

⁹⁹⁰ See Ricketson & Ginsburg 2006, II, at 991 and Guibault 2010, at 57 (para. 12).

not affect copyright as such, the effects on enhancing the free flow of information and on creating legal certainty over copyright claims will be negligible.

5.1.2.4 DURATION OF PROTECTION

Another element of copyright to which the prohibition on formalities extends is the duration of protection. Article 7 of the Berne Convention, which is incorporated by reference in the TRIPS Agreement and the WCT, lays down the minimum terms of protection of international copyright.⁹⁹¹ These terms are among ‘the rights specially granted by this Convention’ and thus cannot be subjected to formalities by countries adhering to the Berne Convention, the TRIPS Agreement or the WCT.

In general, if a contracting state grants terms of protection that exceed the Berne minimum terms,⁹⁹² it must also confer such terms on non-domestic works for which protection is sought under the Berne Convention, the TRIPS Agreement or the WCT. This follows from the rule of national treatment, which also applies in relation to the duration of copyright.⁹⁹³ Since contracting states are prohibited from subjecting the rights that must be granted pursuant to the rule of national treatment to formalities, they cannot make these longer terms of protection conditional on formalities.

The Berne Convention contains one exception to the rule of national treatment. It permits contracting states to grant to non-domestic works a copyright term that does not exceed the term of protection granted by the country of origin.⁹⁹⁴ This so-called ‘comparison of terms’ implies that, in relation to terms, material reciprocity applies. If a country is not obliged to grant national treatment, but nevertheless extends its national copyright terms to foreign works, the Berne Convention does not prohibit it from subjecting such voluntarily extended terms of protection to formalities.

5.1.3 THE ADDRESSEES OF THE PROHIBITION ON FORMALITIES

The scope of application of the prohibition on formalities is also demarcated by the subjects to which it is addressed. If Articles 5(1) and 5(2) of the Berne Convention are read in conjunction, it follows that the prohibition on formalities applies only to rights that contracting states must grant to works of which they are not the country of origin. This implies that the prohibition on formalities is addressed to contracting parties (i.e., Berne Union states, WTO members or contracting parties to the WCT) and not, for example, to private individuals or corporate entities.⁹⁹⁵

⁹⁹¹ Art. 9 of the WCT orders contracting states not to apply art. 7(4) of the Berne Convention, stating a minimum term of protection of twenty-five years after creation, in respect of photographic works.

⁹⁹² Art. 7(6) of the Berne Convention.

⁹⁹³ See Goldstein 2001, at 238-239 and Goldstein & Hugenholtz 2010, at 287.

⁹⁹⁴ Art. 7(8) of the Berne Convention.

⁹⁹⁵ See Gervais 2005, at 351 and Gervais 2006, at 34 and Gervais 2010b, at 26.

Because the prohibition on formalities has no horizontal application, it applies to state-imposed formalities only and does not govern the relationship between private legal subjects. Thus, it does not prohibit collective rights management organizations (CMOs) from requiring that copyright owners sign contracts for the acquisition and exploitation of their rights, provide information on their names, places of residence and the repertoire of works or perhaps deposit a copy of their works. These matters, which are contractually negotiated, may be necessary for a good administration and exploitation of rights. They might be governed by national contract and competition law,⁹⁹⁶ but certainly not by the international prohibition on formalities.⁹⁹⁷

For the same reason, the Books Rights Registry, which is supposed to be created as part of the Google Books Search Settlement in the US,⁹⁹⁸ cannot be regarded as a prohibited formality. This Registry is effectively a new CMO for the administration of the rights of authors whose works are covered by the settlement.⁹⁹⁹ It collects the royalties, which Google under the proposed settlement must pay for the digitization and making available to the public of books, and distributes them among relevant copyright owners. The Registry is compatible with the prohibition on formalities for the sole reason that it results from a settlement between private parties.

However, things may become somewhat different if a government grants to these private arrangements a legislative stamp of approval that has the effect of extending their application to parties that were not actually involved in their conclusion. This is the case, for instance, in an extended collective licensing system.¹⁰⁰⁰ Likewise, the Google Books Search Settlement, which is a class action settlement, may also get an extended effect. Upon judicial approval, it will be binding for all copyright owners in the relevant class.¹⁰⁰¹ Moreover, a government can create a system of mandatory collective licensing. In these cases, it can no longer be maintained that it concerns a relationship between private legal entities pure and simple.¹⁰⁰² Therefore, a conflict with the prohibition on formalities can arise if such non-voluntary licensing systems qualify as Berne prohibited formalities that affect the enjoyment or the exercise of copyright. As we shall see in para. 5.3.2.3 below, this is not the case.

⁹⁹⁶ See e.g. Guibault & Van Gompel 2006, at 125 et seq. on the regulation of CMOs in Europe.

⁹⁹⁷ See Gervais 2005, at 351: 'One cannot simply assume that the prohibition on legislatively-imposed formalities such as registration or deposit extends to dealings with private entities, which most CMOs are.' See also Gervais 2006, at 34.

⁹⁹⁸ See the Proposed Settlement in the case of *The Authors Guild, Inc., et al. v. Google Inc.*, Case No. 05 CV 8136 (S.D.N.Y.), filed on 28 October 2008, <<http://www.googlebooksettlement.com/>>.

⁹⁹⁹ Grimmelmann 2009, at 13.

¹⁰⁰⁰ On the extended collective licensing system, see para. 5.3.2.3 below.

¹⁰⁰¹ See Grimmelmann 2009, at 13.

¹⁰⁰² See Kretschmer 2002, at 126-136, arguing that instead of instruments of private property law, CMOs have increasingly become regulatory instruments that are part of a broader public law policy.

5.2 The Formalities to Which the Prohibition Applies

Another element of Article 5(2) of the Berne Convention defining the application of the prohibition on formalities is the word ‘formalities’. Although, at first sight, this term seems to be fairly straightforward, its interpretation has created problems from the start.¹⁰⁰³ This is mainly caused by the confusion arising from the report drawn up for the 1908 Berlin conference by Mr Renault. This report attempts to shed light on how the term ‘formalities’ must be interpreted following the change of terminology in 1908. Although the 1908 and current texts of the Berne Convention merely refer to the term ‘formalities’, Mr Renault’s report contains a short statement in brackets declaring that: ‘(the Article in the draft only refers to *formalities*, but this is meant to cover the *conditions and formalities* to which the 1886 Convention refers)’.¹⁰⁰⁴

Most legal commentators conclude from this statement that the term ‘formalities’ in Article 5(2) of the Berne Convention must be interpreted in the broader meaning of ‘conditions and formalities’ under the 1886 Berne Convention.¹⁰⁰⁵ This raises the questions of what these ‘conditions and formalities’ in the 1886 Convention exactly encompassed and whether it is correct to assume that the term ‘formalities’ in the 1908 and current text of the Berne Convention bears the same meaning as the words ‘conditions and formalities’ in Article 2(2) of the Berne Convention (1886). These questions are examined in the next sections. The object is to discover which types of conditions and formalities are covered by the prohibition on formalities.

To answer these questions, we must again revisit the drafting history of the Berne Convention. In addition, we shall examine legal commentaries of the late nineteenth and early twentieth century to establish how in those days the terms ‘conditions and formalities’ (1886) and ‘formalities’ (1908) were interpreted by legal scholars.

This section first analyzes the meaning of the words ‘conditions and formalities’ in the 1886 Berne Convention (para. 5.2.1). It reveals that the word ‘formalities’ is straightforward, but that the scope of the word ‘conditions’ varied according to the viewpoint taken. In general, it could be broadly interpreted (to exclude protection to foreign works that are not protected in the country of origin) or narrowly interpreted (to subject the protection of foreign works to certain domestic conditions). Next, the section explores the meaning of the word ‘formalities’ in the 1908 and current texts of the Berne Convention (para. 5.2.2). It will be seen that this word includes more than the word ‘formalities’ in Article 2(2) of the Berne Convention (1886), but not all ‘conditions and formalities’ under the broad interpretation of this provision. The section concludes with a short observation on how the word ‘formalities’ in Article 5(2) of the Berne Convention must be interpreted legally (para. 5.2.3).

¹⁰⁰³ See Potu 1914, at 54, referring to a letter of 7 December 1909, which the *Syndicat pour la protection de la propriété intellectuelle* in Paris addressed to the *Commission de l’enseignement et des beaux-arts* to petition for an official and authentic explanation of the word ‘formalities’.

¹⁰⁰⁴ *Actes 1908*, at 237; Berne Centenary 1986, at 148.

¹⁰⁰⁵ See, inter alia, Hilty 1986, at 212, Ricketson 1987, at 222, Peukert 2005, at 62, Gervais 2005, at 350, Gervais 2006, at 33, Ricketson & Ginsburg 2006, I, at 325 and Gervais 2010b, at 25.

5.2.1 THE ‘CONDITIONS AND FORMALITIES’ IN THE 1886 TEXT

Article 2(2) of the Berne Convention (1886) reads: ‘The enjoyment of these rights shall be subject to the accomplishment of the conditions and formalities prescribed by law in the country of origin of the work.’ During the drafting procedure, different wordings were proposed as regards the ‘conditions and formalities’ to be fulfilled in the home country. The 1883 draft convention of the ALAI referred to ‘formalities’, but the German delegation proposed the words ‘*conditions formelles et matérielles*’ and the Swiss Federal Council the phrase ‘formalities and conditions’.¹⁰⁰⁶

The assembly ultimately adopted the words ‘conditions and formalities’, because they seemed to include ‘all the conditions and procedures specified in the country of origin for authors’ rights to be secured’.¹⁰⁰⁷ However the German delegation was not entirely satisfied with this explanation and asked for a clarification. Dr Meyer, the superior counsellor at the German Department of Justice, stated the following:

‘It is merely a question of noting that the wording proposed by the German Delegation, “*conditions formelles et matérielles*”, has been replaced by the words “formalities and conditions”, and that the word “formalities”, being taken as a synonym of the term “*conditions formelles*”, included, for instance, registration, deposit, etc.; whereas the expression “conditions”, being in our view synonymous with “*conditions matérielles*”, includes, for instance, the completion of a translation within the prescribed period. Thus the words “formalities and conditions” cover all that has to be observed for the author’s rights in relation to his work to come into being (“*Voraussetzungen*” in German), whereas the effects and consequences of protection (“*Wirkungen*” in German), notably with respect to the extent of protection, have to remain subject to the principle of treatment on the same footing as nationals.’¹⁰⁰⁸

Mr Droz, the president of the 1884 conference, confirmed this explanation by noting that the assembly agreed with Dr Meyer on the scope of the words ‘formalities and conditions’.¹⁰⁰⁹ Because none of the delegations opposed this reading, at that time, there seemed to be broad consensus that the ‘conditions and formalities’ in Article 2(2) of the Berne Convention covered ‘all that has to be observed for the author’s rights in relation to his work to come into being’ as defined by Dr Meyer.

Apart from the Meyer’s definition, however, the minutes of the 1884-1886 Berne conferences do not further explicate what the ‘conditions and formalities’ under the 1886 Convention exactly encompassed. To identify the prerequisites of protection that had to be fulfilled in the country of origin to be able to claim protection in other contracting states (i.e. the ‘*Voraussetzungen*’ in the Meyer’s definition), this section

¹⁰⁰⁶ See *Actes 1884*, at 7-8, 11 and 41; Berne Centenary 1986, at 83-84, 85 and 94.

¹⁰⁰⁷ See *Actes 1884*, at 42; Berne Centenary 1986, at 94.

¹⁰⁰⁸ *Actes 1884*, at 43; Berne Centenary 1986, at 95.

¹⁰⁰⁹ See *Actes 1884*, at 43; Berne Centenary 1986, at 95.

looks at how the words ‘formalities’ (para. 5.2.1.1) and ‘conditions’ (para. 5.2.1.2) are defined by some of the leading commentaries on the Berne Convention between 1886 and 1908. In addition, it examines which requirements are explicitly exempted from the ‘conditions and formalities’ in the 1886 Berne Convention. The minutes of the 1884-1886 Berne conferences clearly points this out (para. 5.2.1.3).

5.2.1.1 FORMALITIES (‘CONDITIONS FORMELLES’)

Under the 1886 Berne Convention, the term ‘formalities’ (or ‘*conditions formelles*’) was interpreted fairly straightforwardly as being requirements that authors or their successors in title must fulfil with a state authority to obtain copyright protection or to be able to prove the existence of their rights, e.g., in legal proceedings.¹⁰¹⁰ Hence, formalities were said to be requirements that were externally imposed on copyright owners,¹⁰¹¹ thus excluding all intrinsic conditions of copyright protection. Because the completion of formalities required the intervention by and assistance of a state authority, they had the character of public law instruments. Examples of formalities are the deposit of copies of works and the registration or declaration of works before state officials.¹⁰¹² This corresponds with the definition given by Dr Meyer.

5.2.1.2 CONDITIONS (‘CONDITIONS MATÉRIELLES’)

The term ‘conditions’ (‘*conditions matérielles*’) were defined in legal commentaries as characteristics with which authors must equip their works in order to make them eligible for copyright protection.¹⁰¹³ No state authority was involved in the process of completing the statutory conditions of protection.¹⁰¹⁴ Thus, depending on whether they wished to invoke or revoke protection, authors could on their own discretion decide whether or not to fulfil them.¹⁰¹⁵ Examples of conditions are the requirements to mark copies of a work with a notice of reservation to retain a certain right (e.g., a

¹⁰¹⁰ See Allfeld 1902, at 309, Röhliberger 1904, introduction, at III-IV, Röhliberger 1906, at 107 and Allfeld 1908, at 245.

¹⁰¹¹ See e.g. Röhliberger 1906, at 107: ‘*die Förmlichkeiten [sind] äusserliche, dem Autor oder seinen Rechtsnachfolgern auferlegte Mittel zu Erlangung des Schutzes*’.

¹⁰¹² See Allfeld 1902, at 309, Röhliberger 1904, introduction, at III-IV, Röhliberger 1906, at 107 and Allfeld 1908, at 245.

¹⁰¹³ See Röhliberger 1906, at 107: ‘*Die Bedingungen stellen also die Eigenschaften dar, mit welchen ein Werk vom Autor auszurüsten ist, um schutzfähig zu werden*’.

¹⁰¹⁴ Accordingly, because no state authority was involved, in international disputes, it was impossible for national courts to require the production of certificates to the effect that the conditions in the country of origin had been fulfilled. Art. 11(3) of the Berne Convention (1886) acknowledged this, as can be concluded from the fact that it allowed courts to require the production of certificates with respect to ‘formalities’ but not with respect to ‘conditions’ that were completed in the country of origin.

¹⁰¹⁵ See Allfeld 1902, at 309, Röhliberger 1904, introduction, at III-IV, Röhliberger 1906, at 107 and Allfeld 1908, at 245.

reproduction right in newspaper articles or a translation right in literary works);¹⁰¹⁶ to publish or to not publish a work to enjoy a particular right (e.g., a right of public recitation in unpublished works);¹⁰¹⁷ to complete a translation within a given period to enjoy an exclusive right of translation;¹⁰¹⁸ to mark the copies of a work with the author's name to benefit from a longer term of protection; and so forth.¹⁰¹⁹

As a result, the term 'conditions' in Article 2(2) of the Berne Convention (1886) was interpreted fairly broadly. Even so, it is doubtful whether it covered 'all that has to be observed for the author's rights in relation to his work to come into being', as in the definition of Dr Meyer. At least it seems to exclude the substantive conditions that are inherent in the work and that equally determine the coming into existence of copyright, such as the requirement of originality and the idea/expression dichotomy. For one thing, Berne Union states were obliged to grant national treatment to works of authors of other contracting states.¹⁰²⁰ Therefore, it seems that the conditions that establish the intrinsic protectability of works were also subject to national treatment and not to the country of origin rule of Article 2(2) of the Berne Convention, which, as observed, is an exception to the rule of national treatment (see para. 4.3.1).

Hence, the 'conditions' in Article 2(2) of the Berne Convention (1886) appear to have signified only the characteristics with which a work must be equipped after its actual creation. This suggests that the substantive conditions that are inherent to the creation of works would not be covered by this provision. One indication in support of this reading can be found in the fact that foreign works, for which protection was sought under the Berne Convention, were sometimes denied copyright protection in Berne Union states because they did not satisfy the standard of originality in those countries.¹⁰²¹ If the originality requirement was a 'condition' in the sense of Article 2(2) of the Berne Convention (1886), then declining copyright to foreign works that

¹⁰¹⁶ See e.g. the British case *Sarpy v. Holland and Savage*, [1908] 2 Ch. 198 (Court of Appeal, 5-7 May 1908), in which the court acknowledged that the notice of reservation to retain a public performance right in musical works was a 'condition' in the meaning of art. 2(2) of the Berne Convention (1886).

¹⁰¹⁷ See Allfeld 1902, at 309. But see Röhrlisberger 1906, at 108-110, arguing that the fact that the right of public recitation applied only to unpublished works did not make 'non-publication' a condition for protection. Allfeld, however, opposed this and asserted that it was a condition for enjoying the right. See Allfeld 1908, at 245: '*Es handelt sich hierbei nicht nur um Bedingungen der Entstehung des Schutzes überhaupt, sondern auch um solche des Schutzes in einer gewissen Richtung*'.

¹⁰¹⁸ See e.g. the Belgian decision of the *Tribunal correctionnel de Bruxelles* of 3 February 1896, *Maes v. Ramakers, Le Droit d'Auteur* 1896, at 30, in which a Belgian translation of a German work was held to be no infringement, since the formalities required by German law for acquiring the translation right not been completed. But see Kohler 1907, at 404, arguing that the specific requirements with respect to the right of translation were not covered by art. 2(2) of the Berne Convention (1886).

¹⁰¹⁹ See Allfeld 1902, at 309, Röhrlisberger 1904, introduction, at III-IV, Röhrlisberger 1906, at 107 and Allfeld 1908, at 245.

¹⁰²⁰ See art. 2(1) of the Berne Convention (1886).

¹⁰²¹ See e.g. the rulings of the French Court of Cassation of 15 June 1899, *May v. Landsberg, Le Droit d'Auteur* 1899, at 134 et seq. and the Berlin *Tribunal supérieur I* (Germany) of 5 June 1905, *Magnien v. Lachmann, Le Droit d'Auteur* 1905, at 157-159, in which the courts tested foreign works against the domestic standard of originality. See also Röhrlisberger 1906, at 147.

were deemed sufficiently original and thus qualified for protection in their country of origin would not have been permitted under the Berne Convention.

Another difficulty that existed with interpreting the word ‘conditions’ in Article 2(2) of the Berne Convention (1886) was that its scope completely depended on the viewpoint taken. Berne Union states could look in two directions when interpreting Article 2(2). On the one hand, when taking an inward-looking perspective, Article 2(2) seemed to leave Berne Union states room for imposing certain ‘conditions’ on foreign works as long as these conditions did not affect the coming into existence of copyright. It seems likely that, from such inward-looking perspective, Berne Union states may well have interpreted the term ‘conditions’ in Article 2(2) of the Berne Convention narrowly, so as to retain more scope for imposing domestic ‘conditions’ as to the extent of protection (i.e. the ‘*Wirkungen*’ in the Meyer’s definition).¹⁰²²

On the other hand, when taking an outward-looking perspective, it seems rational that Berne Union states interpreted the term ‘conditions’ in Article 2(2) of the Berne Convention (1886) more broadly. Article 2(2) intended to provide that Berne Union states were not obliged to protect foreign works if they were not protected in their home country, i.e., if the domestic ‘conditions and formalities’ were not fulfilled.¹⁰²³ No protection in the country of origin meant no protection in other Union states.¹⁰²⁴ If the term ‘conditions’ would be interpreted narrowly, then Union states could still be forced to protect foreign works that received no copyright in their home country, e.g., if this country applied stricter ‘conditions’ than the protecting state.¹⁰²⁵

Thus, the scope of the word ‘conditions’ in Article 2(2) of the Berne Convention (1886) was not entirely clear.¹⁰²⁶ As we shall see later, this was an important reason for deleting this word when the prohibition on formalities was introduced.

5.2.1.3 SOME EXPLICIT EXCEPTIONS

Although Article 2(2) of the Berne Convention (1886) could be interpreted broadly, it did not cover all conditions and formalities. National procedural requirements, for example, were explicitly excluded from its scope. This was emphasized at the 1884 Berne conference, where it was proposed to state in Point 1 of the Final Protocol:

‘It is understood that the final provision of Article 2 of the Convention is without any prejudice to the legislation of each of the Contracting States

¹⁰²² See e.g. Kohler 1907, at 404, arguing that art. 2(2) of the Berne Convention (1886) merely covered those conditions ‘*welche Voraussetzungen des Rechts oder der Klagbarkeit überhaupt sind*’ but not conditions ‘*die nötig sind, um diesem Rechte im Ursprungslande den vollen Umfang zu geben*’.

¹⁰²³ See Kohler 1896, at 350, Röhrlisberger 1906, at 153-154 and De Beaufort 1909, at 350.

¹⁰²⁴ See Kohler 1896, at 340 and De Beaufort 1909, at 351.

¹⁰²⁵ Given that art. 2(2) of the Berne Convention (1886) already raised controversy in the years between the adoption of the Berne Convention in 1886 and the introduction of the prohibition on formalities in 1908 (see paras 4.3.2 and 4.3.3.1), this seemed to have been unacceptable for many countries.

¹⁰²⁶ See e.g. the discussions as to the scope of ‘conditions’ in notes 1017 and 1018 above.

concerning the procedure to be followed before the courts and the competence of those courts'.¹⁰²⁷

Because the Drafting Committee found this rule unnecessary and superfluous,¹⁰²⁸ it was not adopted. Even so, it was made perfectly clear that Article 2(2) of the Berne Convention (1886) did not encompass national procedural requirements.

Other 'conditions' explicitly excluded from Article 2(2) of the Berne Convention were the presumptions of authorship in Article 11 of the Berne Convention (1886). At the 1885 conference, the Italian delegation questioned how these presumptions relate to the 'conditions' referred to in Article 2(2) of the Berne Convention.¹⁰²⁹ The German delegation asserted that there was no relationship between the two. It stated that the 'conditions' in Article 2(2) signified conditions to be observed for copyright to come into being, while presumptions of authorship had procedural significance only. They indicated that, until proven otherwise, the person whose name appeared on the work was regarded as the author of the work.¹⁰³⁰ Consequently, they were no 'conditions' in the meaning of Article 2(2) of the Berne Convention.¹⁰³¹

5.2.2 THE 'FORMALITIES' IN THE 1908 AND CURRENT TEXTS

In 1908, the country of origin rule with respect to formalities was transformed into a prohibition on formalities. On this occurrence, the 1886 terminology of 'conditions and formalities' was changed to 'formalities'. This section explains the need for this change of terminology (para. 5.2.2.1) and how this was translated into the German proposition on the eve of the Berlin revision conference (para. 5.2.2.2). We shall see that the language was changed to prevent the prohibition of formalities from having an overly broad effect. The prohibition on formalities was considered to extend only to external conditions ('formalities and *conditions extrinseques*') and not to internal conditions of protection ('*conditions internes*'). As is demonstrated next, this is also how the word 'formalities' was interpreted in practice by legal scholars and national legislators in the years following the 1908 revision of the Berne Convention (para. 5.2.2.3). Lastly, this section examines which internal conditions of protection can be considered to be excluded from the prohibition on formalities (para. 5.2.2.4).

¹⁰²⁷ *Actes 1884*, at 13; Berne Centenary 1986, at 86.

¹⁰²⁸ *Actes 1884*, at 62-63; Berne Centenary 1986, at 103.

¹⁰²⁹ See the Italian delegate Mr Rosmini in *Actes 1885*, at 34; Berne Centenary 1986, at 116.

¹⁰³⁰ See the German delegate Mr Reichardt in *Actes 1885*, at 34-35; Berne Centenary 1986, at 116.

¹⁰³¹ See *Actes 1885*, at 50; Berne Centenary 1986, at 122. See also the decision of the Court of Cassation of Turin of 25 August 1897, *May frères v. Istituto Italiana d'Arti grafiche*, *Le Droit d'Auteur* 1899, at 20-21 and the decision of the Court of Cassation of Milan of 23 November 1899, *Albrecht et Meister v. Gualassini*, etc., *Le Droit d'Auteur* 1900, at 121-123. See also '*Des moyens de prouver l'existence du droit d'auteur d'après la Convention de Berne*', in *Le Droit d'Auteur* 1899, at 50-52.

5.2.2.1 THE NEED FOR ADJUSTMENT OF TERMINOLOGY

The new regime that the 1908 Berlin revision conference established with respect to formalities brought no significant material changes for authors.¹⁰³² In 1886, they had already been liberated from complying with the ‘conditions and formalities’ in other Berne Union states. This was no different under the prohibition on formalities. The only difference was that, to be able to claim protection under the Berne Convention, authors no longer had to prove that they had duly complied with the conditions and formalities in their home country, as under the 1886 country of origin rule.

For Berne Union states, on the other hand, the new regime brought an important change. Because of the introduction of the rule of independence of protection, they were no longer permitted to deny protection to foreign works on the ground that the author had failed to complete the domestic conditions and formalities. Following the 1908 Berlin revision they were only prohibited from imposing formalities on non-domestic works that were eligible for protection under the Berne Convention. Thus, instead of pursuing an inward and outward-looking perspective with respect to the question of ‘conditions and formalities’, Berne Union states could now only take an inward-looking perspective. The only relevant question was: Which formalities and conditions were they prohibited from imposing on non-domestic works?

As observed, under the 1886 Berne Convention this question arguably gave rise to a narrower interpretation of the word ‘conditions’ than under the outward-looking perspective (see para. 5.2.1.2). From an inward-looking perspective, the distinction made by Dr Meyer between conditions and formalities relating to the coming into being of copyright (*‘Voraussetzungen’*), which Berne Union states could not impose on foreign works, and conditions and formalities relating to the extent of protection (*‘Wirkungen’*), which they could impose on foreign works, was mostly relevant.

Although it has not been documented in the proceedings of the Berlin conference why the word ‘conditions’ was deleted, the adjustment has seemingly been inspired by the expanded international obligations resulting from the introduction of the rule of independence of protection. Because, under this rule, the extent of protection is governed exclusively by the law of the country where protection is claimed,¹⁰³³ this country should retain discretion to regulate the extent of protection and subject it to ‘conditions’, if necessary. An overly broad interpretation of the word ‘conditions’ should therefore be avoided.¹⁰³⁴ As the language ‘conditions and formalities’ in the 1886 text was sometimes interpreted broadly, so as to give effect to the rule that no protection in the home country implied no protection in the Berne Union (i.e., the

¹⁰³² See De Beaufort 1909, at 353.

¹⁰³³ See art. 4(2) of the Berne Convention (1908), currently, art. 5(2) of the Berne Convention (1971).

¹⁰³⁴ See e.g. Dungs 1910, at 34: *‘Was die Förmlichkeiten anlangt, so sprach die frühere Fassung von Bedingungen und Förmlichkeiten ...; jetzt ist der Bedingungen nicht mehr Erwähnung getan. Dies ist geschehen, um einer zu weiten Auslegung der Vorschrift vorzubeugen’*.

outward-looking perspective), it was presumably thought that the word ‘conditions’ could better be deleted.¹⁰³⁵ This should avoid problems of interpretation.

Accordingly, to the extent that Mr Renault alludes to the narrow interpretation of the word ‘conditions’ in the 1886 text, his assertion that the ‘the Article in the draft only refers to *formalities*, but this is meant to cover the *conditions and formalities* to which the 1886 Convention refers’ can be endorsed. However, to read his statement as including ‘conditions’ in the broad interpretation following the outward-looking perspective would be incorrect.¹⁰³⁶ Still, this does not explain what the term ‘formalities’ in the 1908 Convention covers exactly. This is examined in the next sections.

5.2.2.2 THE GERMAN PROPOSITION

The German authorities that were responsible for drafting the preparatory text for the 1908 Berlin conference sensed the need for a change of language. To articulate that not all ‘conditions’ should be subject to the proposed prohibition on formalities, they suggested distinguishing between ‘formalities and *conditions extrinsèques*’ and ‘*conditions internes*’. They argued that the prohibition on formalities should apply to ‘formalities and *conditions extrinsèques*’ to the full extent, but that Berne Union states should be able to subject non-domestic works that were eligible for protection under the Berne Convention to ‘*conditions internes*’ without restraint.¹⁰³⁷

At the Berlin conference, the German proposal received quite some opposition. The Italian delegation, in particular, raised the objection that the term ‘*extrinsèque*’ was too unclear and could lead to serious misinterpretation.¹⁰³⁸ It argued that if this term was meant to signify that the prohibition also applied to ‘conditions of a formal nature’ or ‘conditions of form’, it would be redundant because the term ‘formalities’ obviously included such conditions.¹⁰³⁹ However, it proved difficult to find language that better fitted the prohibition. Several delegations proposed alternative wordings, varying from ‘formalities and *conditions extrinsèques*’ (the German proposition) to the simple ‘*conditions de forme*’ (Monaco), the existing ‘formalities and conditions’ (France) and the finally adopted and straightforward term ‘formalities’ (Italy).¹⁰⁴⁰

¹⁰³⁵ See De Beaufort 1909, at 352. See also the message of the Swiss Federal Council of 8 October 1909, in: *Le Droit d’Auteur* 1910, 2-7, at 5: ‘*Nous constatons avec satisfaction que le terme peu clair de “conditions” a été supprimé, de sorte qu’il n’est plus question que de formalités*’.

¹⁰³⁶ See *Le Droit d’Auteur* 1910, 2-7, at 5, suggesting that Mr Renault meant to say that ‘formalities’ also include ‘conditions of a formal nature’ or ‘conditions of form’. The latter is a much narrower reading of the word ‘conditions’ in the 1886 Convention than was given to it in legal commentaries. Perhaps this explains why in the proceedings Mr Renault’s statement was put between brackets.

¹⁰³⁷ Propositions of the German authorities, in: *Actes 1908*, 35-52, at 39.

¹⁰³⁸ See Potu 1914, at 53 and the references therein.

¹⁰³⁹ See *Le Droit d’Auteur* 1910, 2-7, at 5.

¹⁰⁴⁰ *Actes 1908*, at 283-284.

Apart from terminological objections, however, the German proposition was not criticized on substance. Consequently, there appeared to be consensus that the term ‘formalities’ also covered the ‘*conditions extrinsèques*’ as referred to in the German proposition.¹⁰⁴¹ On the other hand, the ‘*conditions internes*’ seemed to be excluded from the scope of the prohibition on formalities.¹⁰⁴² For this reason, the distinction initially made in the German proposition should be more carefully examined.

Formalities and ‘Conditions Extrinsèques’

The German authorities clarified that by ‘formalities’ they understood a deposit of copies, an inscription in a register and the conveyance of a formal declaration to the authorities. This is in harmony with the 1886 definition of ‘formalities’. In addition, they explained that ‘*conditions extrinsèques*’ signify external conditions that authors had to comply with to secure protection for their works. This includes acts such as the making of an express reservation of rights, the indication of the author’s name and the affixation of any other mark or sign on the copies of a work.¹⁰⁴³ They argued that, similar to the 1886 Berne Convention, Union authors should be liberated from these formalities and ‘external conditions’ under the revised Convention.¹⁰⁴⁴

‘Conditions Internes’

On the other hand, the German authorities defined ‘*conditions internes*’ as intrinsic conditions that establish the modalities of copyright and that are an essential part of it.¹⁰⁴⁵ These conditions first of all include ‘the constitutive elements for a work to be protected’.¹⁰⁴⁶ Examples are the requirement of originality and the idea/expression dichotomy. As observed, these conditions seem to have already been excluded from the ‘conditions and formalities’ in the 1886 text. Other ‘*conditions internes*’ affect the inner characteristics and perimeters of copyright without impinging on copyright protection as such. This is the case, for instance, when conditions must be fulfilled to invoke a specific right or to avoid a possible limitation of copyright. Accordingly, these ‘*conditions internes*’ merely involve the extent or quality of protection. Given

¹⁰⁴¹ See De Beaufort 1909, at 352-353: ‘*Over de zaak zelve is men het blijkbaar steeds – en ook op de Conferentie van Berlijn – eens geweest; de moeilijkheid lag slechts in het vinden van de juiste uitdrukking. Nu de Conventie alleen spreekt van “formaliteiten” zijn daaronder zonder twijfel ook de “uiterlijke voorwaarden”, welke de Deutsche Regeering bedoelde, begrepen.*’

¹⁰⁴² See *Le Droit d’Auteur* 1910, 2-7, at 5-6.

¹⁰⁴³ Propositions of the German authorities, in: *Actes 1908*, 35-52, at 39.

¹⁰⁴⁴ *Ibid.*, at 39. See also *Le Droit d’Auteur* 1910, 2-7, at 6.

¹⁰⁴⁵ Propositions of the German authorities, in: *Actes 1908*, 35-52, at 39.

¹⁰⁴⁶ See Osterrieth in: *Actes 1908*, at 169: ‘*les conditions intrinsèques de la protection, c’est-à-dire les éléments constitutifs de l’œuvre à protéger.*’

that, under the rule of independence of protection, the extent of protection was to be governed exclusively by the law of the country where protection is claimed, it was alleged that Berne Union states were at liberty to impose ‘*conditions internes*’. Only this could ensure that their laws would become applicable in full scale.¹⁰⁴⁷

5.2.2.3 THE INTERPRETATION OF THE WORD ‘FORMALITIES’ IN PRACTICE

Although, since 1908, the Berne Convention only refers to ‘formalities’, in practice, this term was often interpreted in the broader meaning of ‘formalities and *conditions extrinsèques*’ as defined in the German proposition. Most legal commentators of the period following the 1908 revision of the Berne Convention appear to have accepted the distinction that the German authorities proposed between prohibited ‘formalities and *conditions extrinsèques*’ and permitted ‘*conditions internes*’.¹⁰⁴⁸

A number of national legislators followed the same distinction for determining to which conditions they could subject the protection of non-domestic works under the revised Berne Convention. In the report addressed by the German government to the *Reichstag* for the ratification of the revised Berne Convention of 1908, for example, it was asserted that the Berne prohibition merely included formalities and conditions of an external nature (‘*nur Bedingungen äusserer Natur*’), thus excluding conditions that affect the effects or consequences of protection in substance (‘*Bedingungen ... welche die Wirkung des Urheberschutzes sachlich beeinflussen*’).¹⁰⁴⁹

Finally, in response to calls for an official and authentic explanation of the word ‘formalities’ in Article 4(2) of the Berne Convention (1908), the Berne International Bureau made an effort to define the word ‘formalities’ in an article published in *Le Droit d’Auteur*, the official journal of the Berne Union, in 1910.¹⁰⁵⁰ Even though the terms ‘*conditions extrinsèques*’ and ‘*conditions internes*’ do not appear prominently in it, this article used the exact same distinction as in the German proposal to define which conditions were prohibited and which were allowed under the revised Berne Convention. The Berne International Bureau confirmed that contracting states were permitted to impose ‘*conditions intrinsèques*’ on non-domestic works.¹⁰⁵¹

¹⁰⁴⁷ See *Le Droit d’Auteur* 1910, 2-7, at 6.

¹⁰⁴⁸ See De Beaufort 1909, at 352-353, Dungs 1910, at 34-35, Wauwermans 1910, at 71-72, Potu 1914, at 53-58, Baum 1932, at 927 et seq., Hoffmann 1933, at 374-375, Hoffmann 1935, at 92 and Ladas 1938, I, at 273-274. But see Allfeld 1928, at 418, criticizing the distinction because of the weakness of its distinguishing features. Allfeld maintained that it was difficult to determine whether a condition constituted the right or merely concerned the effects and consequences of protection (*Wirkungen*).

¹⁰⁴⁹ *Denkschrift zur revidierten Berner Konvention vom 2. April 1909*, in: *Drucksachen des Reichstags 1907/09*, no. 1324, at 30, as reported in: Potu 1914, at 54.

¹⁰⁵⁰ See *Le Droit d’Auteur* 1910, at 2-7.

¹⁰⁵¹ *Ibid.*, at 6. See also Wauwermans 1910, at 72.

5.2.2.4 EXAMPLES OF 'CONDITIONS' EXCLUDED FROM THE PROHIBITION

The preceding sections have demonstrated that the Berne prohibition on formalities does not relate to all conditions of protection. Only external conditions of protection ('*äußere Voraussetzungen des Schutzes*') are covered by it.¹⁰⁵² According to Kohler, such conditions impinge on copyright or its enforcement in all respects.¹⁰⁵³ Internal conditions of protection, i.e., those relating to the substantive contents of copyright protection,¹⁰⁵⁴ are not covered by the prohibition on formalities. Such conditions are necessary to give full effect to copyright in Berne Union states where protection is sought.¹⁰⁵⁵ Because, in practice, it might be difficult to distinguish between external and internal conditions,¹⁰⁵⁶ this section gives examples of '*conditions internes*' that, according to legal literature, are excluded from the prohibition on formalities.

One example of a '*condition interne*' is mandatory publication, non-publication or separate publication. Some countries grant particular rights only to published or unpublished works. In Germany for example the right of public recitation of literary works under the 1901 Copyright Act was recognized only in respect of unpublished works.¹⁰⁵⁷ This is not a Berne prohibited formality.¹⁰⁵⁸ Likewise, it is not prohibited to subject the protection of posthumous works to the requirement that these works must be published separately from works previously published. Presently, such rule is still included in French copyright law.¹⁰⁵⁹ Finally, the *droit de divulgation* (i.e. the author's moral right to decide whether or not to make his work publicly available) is undeniably restricted to unpublished works. Although non-publication is a condition for enjoying this right, it is not a Berne prohibited formality. This condition merely establishes the inner characteristics and perimeters of the *droit de divulgation*.

Another '*condition interne*' that is excluded from the scope of the prohibition on formalities is the condition that works are to be fixed in material form to be eligible for copyright protection.¹⁰⁶⁰ This condition basically governs the extent of copyright protection in substance. Moreover, since 1967 the Berne Convention openly permits contracting states to make fixation a general condition for protection.¹⁰⁶¹

¹⁰⁵² Dungs 1910, at 35.

¹⁰⁵³ See Kohler 1907, at 404, speaking of conditions and formalities '*welche Voraussetzungen des Rechts oder der Klagbarkeit überhaupt sind*'.

¹⁰⁵⁴ See Dungs 1910, at 35, referring to 'internal conditions' as '*Vorschriften ... bei ihnen ... es sich um den sachlichen Inhalt des Urheberrechtes [handelt]*'.

¹⁰⁵⁵ See Kohler 1907, at 404.

¹⁰⁵⁶ See Allfeld 1928, at 418.

¹⁰⁵⁷ Art. 11(3) of the German Copyright Act of 19 June 1901, *RGBl.* 1901, 227.

¹⁰⁵⁸ See *Le Droit d'Auteur* 1910, 2-7, at 6.

¹⁰⁵⁹ Art. L 123-4(4) French Intellectual Property Code.

¹⁰⁶⁰ At present, a fixation requirement is imposed by law in a number of countries. See e.g. sec. 3(2) UK Copyright, Designs and Patents Act 1988 and 17 USC § 102(a).

¹⁰⁶¹ See art. 2(2) of the Berne Convention (1967), currently art. 2(2) of the Berne Convention (1971). For this reason, Ricketson 1987, at 224 and Ricketson & Ginsburg 2006, I, at 327, argue that the fixation

Another example of a ‘*condition interne*’ is the public disclosure of the names of authors of anonymous/pseudonymous works as a condition for receiving the longer term of protection granted to works of known authorship. Most countries require the names to be disclosed by a simple public announcement,¹⁰⁶² but in some countries it is required to record the authors’ names in a public register to be able to claim the longer copyright term. This is the case, for example, in modern German copyright law.¹⁰⁶³ It is commonly understood that these requirements are not Berne prohibited formalities,¹⁰⁶⁴ but only constitute basic elements for the calculation of the copyright term: it is impossible to calculate the copyright term *post mortem auctoris* without knowing who the unknown author is. Thus, these conditions are necessary to give to copyright law full effect. They ensure that authors receive ample protection.¹⁰⁶⁵

A fourth example of ‘*conditions internes*’ is situation specific formalities that are linked to copyright exceptions or limitations. An example is the reservation requirement to retain a reproduction right in newspapers articles.¹⁰⁶⁶ While notices of reservation of this kind outwardly appear to be ‘*conditions extrinsèques*’ as defined in the German proposal,¹⁰⁶⁷ at the 1908 Berlin conference, it was unambiguously stated:

‘Under Article 9, paragraph 2, of the draft, the copyright in newspaper articles is occasionally subject to a prohibition to reproduce which the author has to give. This is not a *formality* within the meaning of Article 4 and the accomplishment of the *condition* is necessary to guarantee the right.’¹⁰⁶⁸

This quotation illustrates that the notice of reservation to retain a reproduction right in newspapers articles is not a Berne prohibited formality, but a permitted condition, presumably a ‘*condition interne*’ in the meaning of the German proposal. Scholars have indeed qualified this notice of reservation as a ‘*condition interne*’, maintaining that it is ‘a basic element of protection’ that authors must fulfil to prevent the reproduction right in newspapers articles from being limited by application of the law.¹⁰⁶⁹

requirement is not a Berne prohibited formality. They assert that this is due to the application of the general principle ‘*lex specialis legi generali derogat*’ (the specific law overrides the general law).

¹⁰⁶² See e.g. in contemporary copyright law, arts 37 and 38(3) Dutch Copyright Act, art. L 123-3(3) French Intellectual Property Code and sec. 12(4) UK Copyright, Designs and Patents Act 1988.

¹⁰⁶³ Art. 66(2) German Copyright and Neighbouring Rights Act 1965. A similar registration requirement is imposed in the US (17 USC § 302(c) (1976)) and Japan (art. 75 Japanese Copyright Act).

¹⁰⁶⁴ See e.g. Kohler 1907, at 225, Allfeld 1928, at 418 and Raestad 1931, at 171.

¹⁰⁶⁵ See the ruling of the *Tribunal de l’Empire* (Germany) of 10 February 1915, *Le Droit d’Auteur* 1917, at 90 et seq. and the series of articles in *Le Droit d’Auteur* 1917, at 88-90, 100-103 and 111-114.

¹⁰⁶⁶ See art. 9(2) of the Berne Convention (1908), currently, art. 10*bis* of the Berne Convention (1971).

¹⁰⁶⁷ See Snijder van Wissenkerke 1933, at 7-8 and Hoffmann 1933, at 375-376, calling such conditions a ‘formality *pur et simple*’ which nevertheless is exempted from the Berne prohibition on formalities.

¹⁰⁶⁸ *Actes 1908*, at 240; Berne Centenary 1986, at 149.

¹⁰⁶⁹ See Potu 1914, at 58 and Ladas 1938, I, at 274, who qualify the notice of reservation as an ‘*élément de fond*’ (a basic element of protection) and a ‘*condition interne*’, respectively. But see Ricketson 1987, at 224 and Ricketson & Ginsburg 2006, I, at 327-328, concluding that the notice of reservation

Interestingly this seems to suggest that the Berne Convention permits contracting states to subject a copyright exception or limitation to formalities, the exception or limitation then being the default rule from which authors can ‘escape’ by explicitly reserving their rights through a notice of reservation. Of course, this is subject to the condition that the copyright exception or limitation complies with the three-step test as laid down, *inter alia*, in Article 9(2) of the Berne Convention (1971). Pursuant to this test, an exception or limitation can only be imposed (i) in certain specific cases, as long as (ii) it does not conflict with a normal exploitation of the work and (iii) it does not unreasonably prejudice the author’s legitimate interests. Because the notice of reservation provides the author with the possibility to escape from the exception or limitation, it may actually ease compliance with the three-step test, for it ensures that authors can retain exclusivity by fulfilling the condition. Nevertheless, Berne Union states may not go as far as introducing overly broad exceptions or limitations that would have the effect of subjecting the enjoyment or the exercise of the right as such to situation specific formalities. This would oppose the first of the three steps, according to which an exception or limitation can only be imposed in certain specific cases.

For this reason, Berne Union states are not allowed to limit the enjoyment or the exercise of the translation right to works, the translation of which is begun with or completed within a given period,¹⁰⁷⁰ or to subject the enjoyment or the exercise of the translation right as such to the requirement to mark all copies of a literary work with a notice of reservation. Between 1886 and 1908, Berne Union states were only obliged to grant a translation right to foreign works, the translation of which was started or completed within ten years from the date of first publication of the original work.¹⁰⁷¹ However, this was a transitional provision only.¹⁰⁷² In 1908, the translation right was completely assimilated to the reproduction right.¹⁰⁷³ Since then, contracting states have been precluded from setting a time frame for the beginning and completion of a translation.¹⁰⁷⁴ Moreover, since all exceptions to and limitations of the translation right are subject to the three-step test, Berne Union states are not allowed to introduce an exception or limitation that subjects the enjoyment or the exercise of the translation right as such to a notice of reservation.¹⁰⁷⁵ Such exception or limitation is not specific enough to satisfy the first of the three steps.

is a permitted ‘condition’, not on the basis of its qualification as a ‘*condition interne*’, but because it is permitted by a specific rule (art. 10*bis* of the Berne Convention (1971)) that overrides the general rule of art. 5(2) of the Berne Convention (1971): ‘*lex specialis legi generali derogat*’.

¹⁰⁷⁰ In the nineteenth century, the translation right was often limited this way. For instance, Art. 6 of the German Copyright Act of 1870 granted a translation right in literary works only if the translation was started within one year and completed within three years after the first publication of the work. For dramatic works, the translation should be finished within six months after the work was first issued.

¹⁰⁷¹ Art. 5(1) of the Berne Convention (1886), as later amended by the 1896 Paris Additional Act.

¹⁰⁷² *Actes 1908*, at 245; Berne Centenary 1986, at 151.

¹⁰⁷³ See *Actes 1908*, at 245 et seq.; Berne Centenary 1986, at 150 et seq.

¹⁰⁷⁴ See art. 8 of the Berne Convention (1908), currently, art. 8 of the Berne Convention (1971).

¹⁰⁷⁵ See *Le Droit d’Auteur* 1910, 2-7, at 6.

A last example of a requirement that may perhaps qualify as a '*condition interne*' is the requirement of public assertion of the author's moral right of attribution in the UK Copyright, Designs and Patents Act 1988. The Act states that this right cannot be invoked unless it is publicly 'asserted' in one of the manners specified by law.¹⁰⁷⁶ Whether this requirement is in harmony with the prohibition on formalities depends on the interpretation of Article 6*bis* of the Berne Convention, which states that 'the author shall have the right to claim authorship of the work'. The British legislator understood this provision to oblige Union states to grant authors the right 'to claim' authorship,¹⁰⁷⁷ thereby justifying the requirement of public assertion as an accepted internal condition of protection. However, various scholars assert that the provision must not be read as granting a right to claim authorship, but a right to be recognized as the author of the work. Therefore, they argue that the UK provision conflicts with the Berne prohibition on formalities, because it precludes authors from enjoying and exercising the right of attribution until they have publicly asserted this right.¹⁰⁷⁸

5.2.3 CONCLUSION

This section has shown that, from the outset, there was broad understanding that the dividing line between prohibited 'formalities' and permitted conditions runs parallel to the distinction between 'formalities and *conditions extrinsèques*' and '*conditions internes*'. The former, which include requirements such as the registration of works, the deposit of copies of works and the mandatory affixation of a copyright notice to copies of works, are covered by the prohibition on formalities. The latter conditions are excluded from the prohibition. These '*conditions internes*' establish the specific modalities of copyright, such as the substantive contents and extent of protection. It is permitted under the Berne Convention to subject the protection of foreign works to certain basic conditions or contingencies establishing the effects or consequences of protection, in particular the extent and quality of copyright, in substance.¹⁰⁷⁹

If Article 5(2) of the Berne Convention is read until the end, there seems to be a strong indication that '*conditions internes*' are indeed excluded from the prohibition on formalities. While the first sentence lays down the prohibition on formalities, the second sentence provides that certain acts are governed exclusively by the laws of protecting states. Article 5(2) of the Berne Convention reads as follows:

¹⁰⁷⁶ Sec. 78 UK Copyright, Designs and Patents Act 1988.

¹⁰⁷⁷ See Bently & Sherman 2009, at 245-246.

¹⁰⁷⁸ See e.g. Ginsburg 1990, at 128, Cornish & Llewelyn 2007, at 489-490 (para. 12-70) and Ricketson & Ginsburg 2006, I, at 326.

¹⁰⁷⁹ Ladas 1938, I, at 274. These '*conditions internes*' are similar to the excepted category of conditions establishing 'the effects and consequences of protection ... notably with respect to the extent of protection', as defined by Dr Meyer at the 1884 Berne conference (*supra* text).

‘The enjoyment and the exercise of these rights shall not be subject to any formality; such enjoyment and such exercise shall be independent of the existence of protection in the country of origin of the work. Consequently, apart from the provisions of this Convention, the extent of protection, as well as the means of redress afforded to the author to protect his rights, shall be governed exclusively by the laws of the country where protection is claimed.’

Accordingly, Article 5(2) of the Berne Convention distinguishes clearly between the ‘enjoyment’ and the ‘exercise’ of copyright, to which the prohibition on formalities applies, and the ‘extent of protection’ and ‘means of redress afforded to the author to protect his rights’, which are governed exclusively by the laws of the protecting state.¹⁰⁸⁰ This seems to imply that, where the Berne Convention affords contracting states full leeway to regulate the extent of protection (i.e. to establish the manner in which authors can exercise their authority),¹⁰⁸¹ it also grants them freedom to subject the extent of protection to certain internal conditions.¹⁰⁸² Only to the extent that they affect the enjoyment or the exercise of copyright or conflict with other conventional provisions (such as the three-step test) are such conditions prohibited by the Berne Convention. The next section studies what the reference to the ‘enjoyment’ and the ‘exercise’ of copyright in Article 5(2) of the Berne Convention exactly entails.

5.3 Formalities as to the Enjoyment and the Exercise of Copyright

The last elements defining the scope of the prohibition on formalities of Article 5(2) of the Berne Convention are purpose related. Subjecting copyright to formalities is prohibited only if it affects the ‘enjoyment’ or the ‘exercise’ of this right.¹⁰⁸³ Hence, formalities that leave the enjoyment or the exercise of copyright unaffected are not covered by the Berne prohibition on formalities. An example of accepted formalities is formalities that establish evidentiary effects. This includes formalities according evidentiary weight to preclude innocent intent defences in mitigation of damages,¹⁰⁸⁴ providing rebuttable evidence about the validity of a copyright claim¹⁰⁸⁵ or giving

¹⁰⁸⁰ See Baum 1932, at 930.

¹⁰⁸¹ De Beaufort 1909, at 351.

¹⁰⁸² See Baum 1932, at 931: ‘*Allgemein wird gesagt werden können, daß Förmlichkeiten durch die Landesgesetze mit Wirkung für die Verbandsangehörigen immer dann eingeführt werden können, wenn diese Förmlichkeiten lediglich den Schutzzumfang betreffen.*’

¹⁰⁸³ See Ficsor 2003, at 41.

¹⁰⁸⁴ See 17 USC §§ 401(d) and 402(d), according evidentiary weight to the use of a copyright notice. But see Ginsburg & Kernochan 1988, at 12, stating: ‘Were the actual damages awarded to notice omitting copyright proprietors significantly reduced, it would be difficult to maintain that compliance with the notice formality is no longer a condition to enjoyment and exercise of copyright.’

¹⁰⁸⁵ See 17 USC § 410(c), conferring prima facie evidence of the validity of copyright and of the facts stated in the certificate, if registration is made before or within five years after the first publication of

constructive notice of a transfer of rights.¹⁰⁸⁶ Another example is formalities, which, although applying to copyright protected works, have nothing to do with copyright protection as such. The legal deposit of books, which is imposed by law in several countries,¹⁰⁸⁷ is not a prohibited formality as long as it is detached from copyright law, i.e., as long as failure to deposit does not cause the loss of protection.¹⁰⁸⁸

Except for these clearcut examples of formalities that do not affect the enjoyment or the exercise of copyright, there are quite a few cases in which it cannot easily be established whether the ‘enjoyment’ or the ‘exercise’ of copyright is at risk of being exposed to formalities. This section examines a number of cases that have been the subject of academic scrutiny since the introduction of the prohibition on formalities. It is divided in two parts. The first part defines what the term ‘enjoyment’ of rights precisely means and examines what its limits are by analyzing a number of assumed formalities related to the ‘enjoyment’ of rights (para. 5.3.1). The second part does exactly the same, but in relation to the ‘exercise’ of copyright (para. 5.3.2).

5.3.1 FORMALITIES AS TO THE ‘ENJOYMENT’ OF COPYRIGHT

The meaning of the word ‘enjoyment’, which was already referred to in Article 2(2) of the Berne Convention (1886), is rather straightforward. According to Dr Meyer’s statement at the 1884 Berne conference, it signified that the 1886 country of origin rule with respect to formalities applied only to conditions and formalities that were necessary ‘for the author’s rights in relation to his work to come into being’.¹⁰⁸⁹ This suggests that the word ‘enjoyment’ in effect means ‘coming into being’. This is also how the word was explained by legal commentators of the same period. As Planiol, the author of a leading treatise on French civil law, wrote: ‘Having the enjoyment of a property right is to have the aptitude necessary to become the proprietor’.¹⁰⁹⁰

In addition to the coming into being of copyright, the reference to ‘enjoyment’ in Article 5(2) of the Berne Convention seems to signify that authors should be able to enjoy a formality-free protection during the existence of copyright. Therefore, it can

a work. But see Ficsor 2003, at 41, arguing that if courts dismiss copyright infringement cases for the sole reason that a certificate of registration is missing, registration is a *de facto* formality.

¹⁰⁸⁶ See 17 USC § 205(c), stating that the certificate of recordation gives constructive notice of the facts it contains. Other countries require an instrument in writing to be able to prove a transfer of copyright against the author. See e.g. art. 3(1) Belgian Copyright Act, art. L 131-2 French Intellectual Property Code and art. 12 Luxembourg Copyright Act.

¹⁰⁸⁷ See e.g. 17 USC § 407, Book I, Title III of the French Code of Heritage (*Code du Patrimoine*) and the UK Legal Deposit Libraries Act (2003), c. 28.

¹⁰⁸⁸ See Gervais 2005, at 350, Gervais 2006, at 33, Gervais 2010a, at 200 and Gervais 2010b, at 24-25.

¹⁰⁸⁹ *Actes 1884*, at 43; Berne Centenary 1986, at 95.

¹⁰⁹⁰ See Planiol 1908-1910, I (1908), at 161 (no. 431): ‘*Avoir la jouissance du droit de propriété, c’est avoir l’aptitude nécessaire pour devenir propriétaire.*’

be generally assumed that ‘enjoyment’ means ‘existence’, covering both the coming into being (para. 5.3.1.1) and the continuation (para. 5.3.1.2) of copyright.¹⁰⁹¹

5.3.1.1 THE COMING INTO EXISTENCE OF COPYRIGHT

In general, formalities affecting the coming into being of copyright include all those formalities that are constitutive of the right (see para. 2.2.1).¹⁰⁹² We have seen many examples of such formalities in this book. Examples are the mandatory registration, deposit and notice requirements which throughout the history of copyright law were imposed by law in many countries (see Chapter 3). To the extent that the acquisition of copyright was conditional on such formalities, the Berne Convention has released authors claiming protection under this Convention from their fulfilment.¹⁰⁹³

For other types of requirements, it is more difficult to determine whether they are to be considered as formalities in relation to the ‘enjoyment’ of copyright. Examples are the requirements of domestic manufacturing and pre-publication censorship. Outwardly these requirements affect the coming into being of copyright. Yet if they are looked at more closely, they are not necessarily inconsistent with the prohibition on formalities, although they contradict other rules of the Berne Convention.

Domestic Manufacturing Requirements

If a country lays down a requirement of domestic manufacturing, this implies that it grants no copyright protection to works that have not been manufactured in its own territory. The history of copyright shows that, in the past, various countries imposed domestic manufacturing requirements.¹⁰⁹⁴ Often, these were stand-alone provisions, but sometimes the law also required authors to prove domestic manufacturing by an affidavit.¹⁰⁹⁵ Especially in the latter case domestic manufacturing requirements were

¹⁰⁹¹ See the ruling of the Dutch Supreme Court of 26 May 2000, *Cassina v. Jacobs*, NJ 2000, 671, note D.W.F. Verkade and *AMI* 2000, at 210-214, note N. van Lingen. But see the decision of the Court of Appeal in Arnhem of 16 March 1999, *Vredestein vs. Ring 65*, *IER* 1999, no. 4, at 182-185, ruling that Article 5(2) of the Berne Convention did not apply to the continuation of copyright.

¹⁰⁹² See *Le Droit d'Auteur* 1925, at 11 and *Le Droit d'Auteur* 1932, at 102.

¹⁰⁹³ See e.g. De Beaufort 1909, at 262 and 352-353, Dungs 1910, at 34, Wauwermans 1910, at 71, Potu 1914, at 55, Seiller 1927, at 211-212, Baum 1932, at 927, Hoffmann 1935, at 89-91, Ladas 1938, I, at 273, Masouyé 1978, at 33, Ricketson 1987, at 222, Goldstein 2001, at 188, Gervais 2005, at 350-351, Gervais 2006, at 32-33, Ricketson & Ginsburg 2006, I, at 325, Gervais 2010b, at 24-25 and Goldstein & Hugenholtz 2010, at 220.

¹⁰⁹⁴ See e.g. art. 61 of the German Copyright Act of 11 June 1870, art. 20 of the German Copyright Act of 9 January 1876, art. 27 of the Dutch Copyright Act of 1881, sec. 3 of the US Act of 3 March 1891, sec. 15 of the US Copyright Act 1909 and 17 USC § 16 (1947).

¹⁰⁹⁵ See e.g. sec. 16 of the US Copyright Act 1909 and 17 USC § 17 (1947). See also art. 10 of the Dutch Copyright Act of 1881.

suspicious of being Berne prohibited formalities. The reason was that the enjoyment of copyright fully depended on compliance with ‘formal’ requirements.¹⁰⁹⁶

Although, on the surface, domestic manufacturing requirements may appear to be Berne prohibited formalities, it is questionable whether they actually are. A stronger argument is that, in essence, they are criteria of eligibility for protection under the laws of protecting states. This suggests that they are at odds with the Berne points of attachment rather than the prohibition on formalities. The Berne Convention obliges contracting states to protect (un)published works created by nationals of one of the Union states and works of non-Union authors that have been first or simultaneously published in a Union state.¹⁰⁹⁷ The Berne Convention does not permit contracting states to apply additional points of attachment, such as first fixation in a Union state or domestic manufacturing. Once a work becomes eligible for protection under the criteria of the Berne Convention, contracting states are obliged to protect it.

Accordingly, domestic manufacturing requirements are primarily in conflict with the Berne points of attachment. Perhaps, secondarily, they are also inconsistent with the Berne prohibition on formalities, but this seems to be the case only if and to the extent that they require an affidavit for proving domestic manufacturing.

Pre-Publication Censorship Requirements

Another example of requirements for which it is unclear whether they fall within the ambit of the prohibition on formalities are pre-publication censorship requirements. These requirements were central to the copyright dispute between the US and China before the Dispute Settlement Body of the WTO in 2009.¹⁰⁹⁸ The main object of this dispute was Article 4 of China’s Copyright Act, which reads as follows: ‘Works the publication and/or dissemination of which are prohibited by law shall not be protected by this Law’.¹⁰⁹⁹ The US asserted that, in combination with China’s strict censorship laws and regulations, this provision conflicted with the Berne prohibition on formalities,¹¹⁰⁰ since it allowed China to deny copyright protection to works that did not successfully pass the pre-publication content review process.¹¹⁰¹

¹⁰⁹⁶ See e.g. Goldstein 2001, at 188 Goldstein & Hugenholtz 2010, at 220. In the US, the domestic manufacturing requirement and accompanying affidavit were generally perceived as a ‘formality’ in the meaning of the main international copyright treaties. When the US joined the UCC, foreign works protected under the UCC were exempted from this requirement so as to comply with the uniform notice requirement under the UCC. See McCannon 1963, at 1145-1147.

¹⁰⁹⁷ Art. 3(1) of the Berne Convention.

¹⁰⁹⁸ See WTO Panel Report, ‘China – Measures Affecting the Protection and Enforcement of Intellectual Property Rights’, WT/DS362/R, 26 January 2009 (adopted on 20 March 2009).

¹⁰⁹⁹ Art. 4 of the Copyright Law of the People’s Republic of China, as amended on October 27, 2001.

¹¹⁰⁰ First submission of the US, WT/DS362, 30 January 2008, at para. 220 et seq.

¹¹⁰¹ China’s censorship laws and regulations include, *inter alia*, the Regulation on the Administration of Audio and Video Products (State Council Order No. 341), the Regulation on the Administration of Films (State Council Order No. 342), the Regulation on the Administration of Publications (State

Outwardly, China's pre-publication censorship requirements indeed appear to be formalities prohibited by Article 5(2) of the Berne Convention. They have the effect of subjecting the enjoyment (or the enforceability)¹¹⁰² of copyright to obtaining prior permission from the censor to publish and disseminate a work. This resembles the early book formalities in the *Ancien Régime*, which also made the acquisition of protection conditional on a 'licence to print' from the censor (see para. 3.1).

However, it can also be argued that the pre-publication censorship requirements of China merely introduce a morality norm as a substantive condition for protection. This is not uncommon. There are other countries in which obscene, blasphemous or immoral works (e.g., pornographic works) have been withhold copyright protection *ex post* for public policy reasons.¹¹⁰³ If it is accepted that morality is a substantive condition for protection,¹¹⁰⁴ then arguably it cannot be maintained that China's pre-publication censorship approval is a Berne prohibited formality. Subject matter that does not meet the morality norm is simply not eligible for protection.¹¹⁰⁵

If it be not accepted that morality is a substantive condition for protection, as was apparently the opinion of the WTO Dispute Settlement Body,¹¹⁰⁶ the pre-publication censorship requirements of China would undoubtedly be at variance with the Berne Convention. However it seems that they conflict more directly with Article 17 of the Berne Convention than with the prohibition on formalities. Union states are allowed 'to permit, to control, or to prohibit ... the circulation, presentation, or exhibition of any work' for reasons of state security, protection of public morals or other matters of public order.¹¹⁰⁷ Accordingly, while Union states are free to regulate the details of

Council Order No. 343) and the Regulations on the Administration of Electronic Publications (Order No. 11 of the General Administration of Press and Publication, 30 December 1997).

¹¹⁰² China argued that Article 4 of its Copyright Act did not affect the 'enjoyment' of copyright, because it did not cause a denial of 'copyright', but only resulted in a denial of 'copyright protection', which it equated with the 'enforceability' of copyright. See WTO Panel Report, WT/DS362/R (2009), para. 7.61 et seq. As we shall see below, this argument would not stand in court, as Berne Union states are also prohibited from subjecting the 'enforceability' of copyright to formalities (see para. 5.3.2.1).

¹¹⁰³ See Howell 1994, Goudreau 2008, Sims 2008 and Bently & Sherman 2009, at 117-118. Examples of countries where public policy grounds are invoked to deny copyright protection are the UK, Canada, Australia and New Zealand. The fact that it concerns mostly common law countries can perhaps be explained by the utilitarian copyright approach in these countries, which may well have motivated courts to remove all incentives to create immoral, obscene, blasphemous or libelous works.

¹¹⁰⁴ See e.g. Bently & Sherman 2009, at 91, including this requirement in the list of substantive criteria for protection. See also Kohler 1907, at 160, who denies copyright to immoral works by arguing that: '*Unsittliche Erzeugnisse der Literatur genießen keinen Schutz und können keinen Schutz genießen*'. But see Mom 1995, at 93-95, asserting that, presently, the viewpoint that immorality can be no reason to completely deny copyright protection to works appears to be more universally accepted.

¹¹⁰⁵ See Bently & Sherman 2009, at 117, indicating that it is uncertain whether the denial of copyright protection to obscene, blasphemous or immoral works implies 'that there is no copyright in the work at all, or that equity will not enforce the copyright'. See also Sims 2008.

¹¹⁰⁶ See WTO Panel Report, WT/DS362/R (2009), paras 7.104 to 7.119.

¹¹⁰⁷ Art. 17 of the Berne Convention dates back to 1886, when it was incorporated in art. 13 of the Berne Convention (1886). See also *Actes 1884*, at 58; Berne Centenary 1986, at 101.

how copyright protected works are publicly disseminated, they cannot, by virtue of national censorship regulations, deny copyright protection altogether.¹¹⁰⁸

Consequently, while China may subject Berne protected works to pre-publication censorship and prohibit the distribution of works that have not been authorized for publication or dissemination in China, it cannot refuse protecting these works under national copyright law. That would be contrary to China's international obligations under the Berne Convention.¹¹⁰⁹ However this does not immediately qualify the pre-publication censorship requirements as Berne prohibited formalities. In fact, Article 17 of the Berne Convention explicitly permits Union states to scrutinize the contents of works.¹¹¹⁰ Therefore the requirements appear acceptable as long as the censorship authority does not judge on the existence (or the enforceability) of copyright.¹¹¹¹

5.3.1.2 THE MAINTENANCE OF COPYRIGHT

In addition to formalities affecting the coming into being of copyright, the reference to the 'enjoyment' of rights in Article 5(2) of the Berne Convention also suggests that contracting states are prohibited from imposing formalities entailing the loss of protection during the existence of copyright. This is the case when the maintenance of copyright is subject to a formal act, e.g., a registration or making of a declaration with a governmental body. One example is copyright renewal, which for long time was a key constituent of US copyright law (see para. 2.1.2). Another example is the declaration ('*instandhoudingsverklaring*'), which the former Benelux Designs Act required for the continuation of copyright in industrial designs of which the design protection (at that time: max. 15 years) had expired.¹¹¹² The Dutch Supreme Court found this declaration to be in conflict with the Berne prohibition on formalities,¹¹¹³ after which it was removed from the Benelux Designs Act on 1 December 2003.

More difficult is the situation where the maintenance of copyright is not subject to a formal act with a state authority but to a requirement of use, as in the case of so-called 'use it or lose it' provisions. These generally exist in two variants. If a work is no longer made commercially available to the public after a statutory period, the

¹¹⁰⁸ See Ricketson 1987, at 545-546 and Ricketson & Ginsburg 2006, I, at 844. See also Dreier in Dreier & Hugenholtz 2006, at 69.

¹¹⁰⁹ See WTO Panel Report, WT/DS362/R (2009), paras 7.120 to 7.139.

¹¹¹⁰ See Bappert & Wagner 1956, at 75, arguing, with respect to some early film censorship regulations in Germany: '*Der Verbandsangehörige Urheber kann sich deshalb in solchen Fällen genau so wenig auf Art. 4 Abs. 2 [i.e., the Berne prohibition on formalities] berufen, wie wenn etwa sein Werk wegen staatsgefährdenden oder sittenwidrigen Inhalts beschlagnahmt und eingezogen wird*'.

¹¹¹¹ See Dreier in Dreier & Hugenholtz 2006, at 69, asserting that the permission that Berne Union states pursuant to art. 17 of the Berne Convention may require for the public dissemination of works 'must not be a "formality" within the meaning of art. 5(2)' of the Berne Convention.

¹¹¹² Art. 21(3) of the Benelux Designs Act of 1975.

¹¹¹³ See the ruling of the Dutch Supreme Court of 26 May 2000, *Cassina v. Jacobs*, NJ 2000, 671, note D.W.F. Verkade and AMI 2000, at 210-214, note N. van Lingen.

law can either permit others to use the work under a copyright exception or compulsory licence,¹¹¹⁴ or provide that the copyright is deemed to be lost altogether.¹¹¹⁵

The first variant seems to cause no complications in relation to the prohibition on formalities, as it does not affect the ‘enjoyment’ of rights. Copyright protection does not cease upon non-usage. Moreover, the fact that failure to fulfil the requirement of use leads to the application of a copyright exception or compulsory licence does not make this requirement a prohibited formality concerning the ‘exercise’ of rights. As will be demonstrated in para. 5.3.2, this would only be the case if non-compliance would prevent the author from enforcing or exercising his rights altogether.

The second variant, on the other hand, bears resemblance with copyright renewal at least in its effects. In both cases, non-compliance causes a loss of protection. This shows that the ‘enjoyment’ of copyright is at risk here. However, the requirement of use may perhaps be compatible with the Berne prohibition on formalities if it can be qualified as a requirement of substantive law rather than a prohibited formality. One argument that may support such interpretation is that the requirement of use differs from copyright renewal in that it does not require application in multiple countries, but only a continuation of the commercial exploitation of the work. A ‘use it or lose it’ provision can therefore also be perceived as a way with which contracting states can regulate the extent of protection (see para. 5.2.3). However, they can only apply it to works of which the minimum terms of protection of the Berne Convention have expired. Otherwise it would conflict with the Berne minimum requirements.

5.3.2 FORMALITIES AS TO THE ‘EXERCISE’ OF COPYRIGHT

While Article 2(2) of the Berne Convention (1886) only referred to the ‘enjoyment’ of rights, the 1908 prohibition on formalities added the reference to the ‘exercise’ of rights. The reasons for this change have not been documented in the proceedings of the Berlin revision conference, but it seems that the word ‘exercise’ was added so as to elucidate that the prohibition did not only cover constitutive formalities, but also formalities that are prerequisites to sue. Although it had been confirmed in both case law and legal doctrine that the latter formalities were also deemed formalities as to the ‘enjoyment’ of rights,¹¹¹⁶ the drafters of the revised Berne Convention probably

¹¹¹⁴ See e.g. Lessig 2001, at 258-259, proposing the introduction of such a ‘use it or lose it’ provision.

¹¹¹⁵ See art. 10a(6) of the Proposal for a European Parliament and Council Directive amending Directive 2006/116/EC of the European Parliament and of the Council on the term of protection of copyright and certain related rights, COM (2008) 464 final, Brussels 16 July 2008, proposing such a ‘use it or lose it’ provision with respect to related rights of phonogram producers and performing artists.

¹¹¹⁶ See German Supreme Court, 26 September 1902, *Juven v. Schönau*, [1902] 35 *Entscheidungen des Reichsgericht in Strafsachen* 360, *Le Droit d’Auteur* 1903, at 5, treating the French legal deposit that was a prerequisite to sue as a formality covered by art. 2(2) of the Berne Convention (1886). See also the ruling of the Civil Court of Justice of Geneva, 20 May 1905, *Bonnard v. Lithographie parisienne*, *Le Droit d’Auteur* 1905, at 144-145. See Röthlisberger 1906, at 107-108 and Kohler 1907, at 404.

wished to avoid any misunderstanding of authors who claimed protection under the Berne Convention being fully released from compliance with formalities, regardless of whether they affected the existence or the enforcement of their rights.¹¹¹⁷

Despite the reasonable explanation for the reference to the ‘exercise’ of rights, in practice, it gives rise to many problems of interpretation. One reason is that the legal connotation of the ‘exercise’ of rights extends beyond the intended ‘enforcement’ of rights. According to French legal terminology around the period of adoption of the prohibition on formalities, the ‘exercise of a property right’ denotes ‘being able to use that right’,¹¹¹⁸ i.e., ‘to legally enforce it, assign it, license it, etc.’.¹¹¹⁹ This raises the question of whether the reference to the ‘exercise’ of rights in Article 5(2) of the Berne Convention suggests that the prohibition on formalities applies to more than just formalities that relate to the ‘enforcement’ of rights. This question is important because, as we shall see next, legal scholars have sometimes overstretched the scope of the prohibition on formalities by interpreting the word ‘exercise’ too broadly.

This section examines whether and to what extent requirements pertaining to the enforcement of copyright (para. 5.3.2.1), the transfer of copyright (para. 5.3.2.2) and the management of copyright (para. 5.3.2.3) can be seen as prohibited formalities that relate to the ‘exercise’ of rights under Article 5(2) of the Berne Convention.

5.3.2.1 THE ENFORCEMENT OF COPYRIGHT

One type of formalities to which the prohibition on formalities applies is formalities affecting the enforcement of rights.¹¹²⁰ In this book, we have seen various examples of such formalities, such as the legal deposit under the 1793 French decree and the registration requirement under the 1842 UK Literary Copyright Act, both of which functioned as a prerequisite to sue for copyright infringement. To optimally secure international copyright protection, it was thought that all formalities that authors had to complete to be able to enforce their copyrights before the courts or in administrative hearings in Berne Union states other than the country of origin should be removed. This was confirmed by the *Tribunal de Commerce de la Seine* in a 1913 decision, in which it ruled that the French legal deposit, which was continued as a precondition to sue until 1925, did not have to be fulfilled with

But see the earlier decision of the German Supreme Court, 8 April 1897, [1898] 30 *Entscheidungen des Reichsgericht in Strafsachen* 81, *Le Droit d’Auteur* 1901, at 30-31, stating that the ‘enjoyment’ of copyright in art. 2(2) of the Berne Convention (1886) signified ‘*die rechtliche Verfolgbarkeit des Urheberrechtes*’ (‘the legal prosecutability of copyright’), while leaving it open whether this related to the French legal deposit because it did not affect the existence of copyright as such.

¹¹¹⁷ See *Le Droit d’Auteur* 1910, 2-7, at 5, Petit 1911, at 35 and Potu 1914, at 52.

¹¹¹⁸ See Planiol 1908-1910, I (1908), at 161 (no. 431): ‘[En] avoir l’exercice [du droit de propriété], c’est pouvoir user de son droit de propriété.’

¹¹¹⁹ See Potu 1914, at 52: ‘c’est-à-dire l’exercer en justice, le céder, le transmettre, etc.’ See also Baum 1932, at 930, arguing that the assignment of copyright undoubtedly is also a means of exploiting the copyright, perhaps even the mode of exploitation ‘*par excellence*’.

¹¹²⁰ See e.g. Wauwermans 1910, at 73 and Potu 1914, at 52.

respect to foreign works for which protection was claimed under the Berne Convention, as this was inconsistent with the prohibition on formalities in relation to the ‘exercise’ of rights.¹¹²¹

For the same reason, when joining the Berne Convention, the US legislator lifted registration as a prerequisite to instituting a copyright infringement action for works of non-US origin. This formality was thought to conflict with the Berne Convention because it subjects the ‘exercise’ of rights to compliance with formalities.¹¹²²

On the other hand, national procedural requirements are explicitly excluded from the scope of Article 5(2) of the Berne Convention.¹¹²³ This was already so under the 1886 Berne Convention (see para. 5.2.1.3). Examples include the deposit of security for costs (i.e. the ‘*cautio judicatum solvi*’)¹¹²⁴ and the registration requirement with regard to the recovery of statutory damages and attorney’s fees in the US.¹¹²⁵ Article 5(2) of the Berne Convention leaves procedural requirements (‘the means of redress afforded to the author to protect his rights’) to be regulated by national law. Because procedural requirements apply only in connection with a particular national lawsuit, they do not impede the enjoyment or the exercise of international copyright as such. Therefore, they can be excluded from the prohibition on formalities.

5.3.2.2 THE TRANSFER OF COPYRIGHT

The transfer of copyright, whether by assignment of the right or by the granting of a licence,¹¹²⁶ can be subject to various requirements of form, such as the requirement

¹¹²¹ Commercial Tribunal of the Seine, 13 November 1913, *Magalhaès et Moniz c. Muroz Escamoz, Le Droit d’Auteur* 1914, at 38-40.

¹¹²² See ‘Final Report of the Ad Hoc Working Group on US Adherence to the Berne Convention,’ [1986] 10 *Columbia-VLA Journal of Law & the Arts* 513, at 565-574. See also Ginsburg & Kernochan 1988, at 12. Initially, the House of Representatives and the Senate disagreed about whether this requirement was congruent with the Berne standards. Whereas the House believed that it was Berne compliant, as it held the requirement to be procedural by nature (H.R. Rep. No. 609, 100th Cong., 2nd Sess. (1988), at 40-44), the Senate argued that it should be abolished altogether (S. Rep. No. 352, 100th Cong., 2nd Sess. (1988), at 13-25). Eventually, Congress reached a compromise and eliminated the requirement of registration as a prerequisite to sue for copyright infringement for non-US works only.

¹¹²³ See e.g. Röthlisberger 1906, at 108, Nordemann, Vinck, Hertin & Meyer 1990, at 78 and Ricketson & Ginsburg 2006, I, at 326, arguing however that, while Berne Union states are permitted to impose domestic rules of evidence or procedure applicable to judicial proceedings in general, they may not impose procedural requirements (e.g., court fees) that are specific to copyright infringement suits.

¹¹²⁴ See e.g. Rechtbank ‘s-Hertogenbosch, 11 June 2008, *Adobe & Microsoft v. Patch Marketing* (LJN: BD3658). But see Ricketson 1987, at 223 and Ricketson & Ginsburg 2006, I, at 326, maintaining that the *cautio judicatum solvi* falls foul of the Berne prohibition on formalities.

¹¹²⁵ The relevant provision (17 USC § 412) was considered to satisfy the Berne standards because it only affects remedies and not the loss of copyright. See H.R. Rep. No. 609, 100th Cong., 2nd Sess. (1988), at 40-41 and S. Rep. No. 352, 100th Cong., 2nd Sess. (1988), at 14-15.

¹¹²⁶ See e.g. Guibault & Hugenholtz 2002, at 29, defining the ‘assignment’ of copyright as the complete transfer of the right from the one party to the other and the granting of a ‘licence’ as the contractual permission to exploit the copyright or to perform certain acts in respect of the work protected.

for the transfer to be recorded in a register, be in writing or drawn up in an authentic legal document or bear the transferor's signature.¹¹²⁷ Over the years, there have been intense discussions, both in jurisprudence and in legal doctrine, about whether these requirements are in harmony with Article 5(2) of the Berne Convention.

In 1926, for example, the Berne International Bureau asserted that Union authors are not obliged to comply with an Italian law subjecting the assignment of copyright to a mandatory registration, because it held this requirement to be a formality as to the 'exercise' of rights.¹¹²⁸ A few years later, however, it expressed doubt about this assertion in a case involving a Canadian statute, which also required assignments of copyright to be registered.¹¹²⁹ Because it appeared that requirements of form relating to transfer of copyright were not considered when the prohibition on formalities was drafted, their inconsistency with the Berne Convention was uncertain.¹¹³⁰ It hoped that the matter would be clarified at the 1928 Conference in Rome, but because this did not happen,¹¹³¹ the question remained unresolved.¹¹³²

However, if the various requirements of form relating to the transfer of copyright are examined more carefully, it will be seen that they do not affect the enjoyment or the exercise of rights. They are either evidence for establishing the existence and the scope of the transfer ('formalities *ad probationem*') or conditions of validity of the contract of transfer vis-à-vis third parties ('formalities *ad substantiam*').¹¹³³ In the former capacity, they create evidentiary effects only. As observed, this is permitted under the Berne Convention. The fulfilment of requirements of form for the validity of a contract, on the other hand, is necessary to give legal effect ('*Rechtswirkung*')

¹¹²⁷ See e.g. the Portuguese Copyright Act, which requires an instrument in writing for the licensing of copyright (art. 41(2)), a written document bearing signatures for the partial assignment of copyright (art. 43(2)) and a public deed (*escritura pública*) for the complete assignment of copyright (art. 44).

¹¹²⁸ See *Le Droit d'Auteur* 1926, 109-114, at 112, with respect to the Italian Act of 7 November 1925.

¹¹²⁹ Art. 39 of the Canadian Copyright Act (1921), 11 and 12 George V., c. 24. See also the rulings of the Tribunal of Toronto, 7 March 1927, *The Canadian Performing Right Society Ltd. v. Famous Players' Canadian Corporation Ltd.*, *Le Droit d'Auteur* 1927, at 133-135 and the Judicial Committee of the Private Council, 1 February 1929, *The Canadian Performing Right Society Ltd v. Famous Players' Canadian Corporation Ltd*, *Le Droit d'Auteur* 1929, at 57, rejecting a claim against a film producer who had used works administered by the Performing Right Society, on the ground that the rights in question had not been registered and thus were not assigned to the Performing Right Society.

¹¹³⁰ See *Le Droit d'Auteur* 1927, at 135: '*Les rédacteurs de la Convention de Berne révisée n'ont jamais songé aux formalités de la cession, cela nous semble hors de doute. Mais peut-on soutenir que les formalités de cette catégorie se concilient avec l'esprit de l'article 4 de la Convention révisée? Nous n'oserions pas l'affirmer*'.

¹¹³¹ See *Le Droit d'Auteur* 1929, at 57.

¹¹³² See e.g. *Le Droit d'Auteur* 1929, at 83, in which the Berne International Bureau recognized that '*le problème était complexe*'. See also *Le Droit d'Auteur* 1934, at 101.

¹¹³³ Guibault & Hugenholtz 2002, at 148. Examples of formalities *ad probationem* are 17 USC § 205(c) (certificate of recordation), art. 3(1) Belgian Copyright Act, art. L 131-2 French Intellectual Property Code and art. 12 Luxembourg Copyright Act (document in writing) and of formalities *ad substantiam* are 17 USC § 204(a) and art. 77 Japanese Copyright Act (recordation), art. 2(2) Dutch Copyright Act (deed) and arts. 43(2) and 44 Portuguese Copyright Act (document in writing; public deed).

to a legal transaction.¹¹³⁴ These requirements essentially determine the way in which the author can legally transfer his copyright. Rather than affecting the enjoyment or the exercise of copyright, therefore, they establish the extent to which the author can exploit his rights.¹¹³⁵ As much as the Berne Convention permits contracting states to preclude the assignment of copyright or create certain presumptions of assignment, it allows them to establish the conditions under which copyright can be assigned,¹¹³⁶ including the requirements of form relating to the validity of a contract.¹¹³⁷

Consequently, it seems safe to assume that Article 5(2) of the Berne Convention does not prohibit requirements of form, which determine the way in which a transfer of copyright must be effectuated or which corroborate the existence or scope of the relevant transaction.¹¹³⁸ This is an important observation. It suggests that contracting states are permitted to subject the transferability of copyright to formalities of some kind. An example would be the introduction of a mandatory recordation of transfer, giving legal effect to a copyright transfer only if it is recorded in a public register or database. This would have the advantage that, by consulting the register or database, anyone can easily ascertain who owns the copyright in a work. If it is not recorded, it may be assumed that the copyright belongs to the author. A recordation system of this kind would facilitate copyright clearance, thus addressing part of the challenges identified in Chapter 1. As we observed there, one of the causes for the current rights clearance difficulties is the transferability and divisibility of copyright.

This does not imply, however, that all formalities as to the transfer of copyright are permitted. Only to the extent that they relate directly to the transaction by which the right is transferred are they justified.¹¹³⁹ An example of a formality that conflicts with Article 5(2) of the Berne Convention is the recordation of transfer that, until the US joined the Berne Convention, was included in US copyright law. In its pre-1989 incarnation, recordation was a condition for initiating a copyright infringement suit for persons claiming to be the copyright owner by virtue of a transfer of rights. This recordation of transfer was deemed to be at odds with Article 5(2) of the Berne Convention, because copyright enforcement depended on its fulfilment.¹¹⁴⁰

¹¹³⁴ Hoffmann 1935, at 93. See also Hoffmann 1933, at 376-377.

¹¹³⁵ See Baum 1932, at 930. See also *Le Droit d'Auteur* 1927, at 135: '*L'enregistrement n'est pas une condition de l'existence même du droit d'auteur, mais une condition de la validité, à l'égard des tiers, du transfert de ce droit au profit de titulaire actuel*'.

¹¹³⁶ See Baum 1932, at 931. See also the last part of art. 5(2) of the Berne Convention.

¹¹³⁷ Wauwermans 1910, at 70.

¹¹³⁸ See e.g. Wauwermans 1910, at 70, Baum 1932, at 929-931, Hoffmann 1933, at 376, Hoffmann 1935, at 92-93, Bappert & Wagner 1956, at 75-76, Masouyé 1978, at 33, Ricketson & Ginsburg 2006, I, at 326-327, Ginsburg 2010a, at 316-317 and 345-346 and Ginsburg 2010b, at 429-430. But see Marwitz & Möhring 1929, at 341, Raestad 1931, at 79, Ladas 1938, I, at 273 and Ricketson 1987, at 223-224.

¹¹³⁹ See Ricketson & Ginsburg 2006, I, at 326-327.

¹¹⁴⁰ S. Rep. No. 352, 100th Cong., 2nd Sess. (1988), at 25-26: 'a transferee claiming under an unrecorded document is effectively precluded from enforcing his or her claim, and thus from enjoying and exercising his or her rights, within the meaning of Article 5(2) of Berne'.

This explanation finds support in the rationales behind the Berne prohibition on formalities. The idea was to free authors from the multitude of formalities that they otherwise had to complete in the different Berne Union states to secure international copyright protection. To the degree that formalities are connected with a specific act or transaction, however, they have no international implications. Although the rights may be transferred across borders, the transaction habitually takes place in a single country.¹¹⁴¹ Therefore, the transfer of copyright can easily be governed by the law in that country. That this law imposes particular requirements of form does not create legal obstacles for authors seeking copyright protection at the international level, for these requirements must not be fulfilled in each and every country where protection is sought, but only in the country where the relevant transaction takes place. This is different when right holders are required to record the transfer of rights in national registers to be able to enforce their rights, which would certainly create international difficulties that the Berne prohibition on formalities has tried to avoid.

5.3.2.3 *THE MANAGEMENT OF COPYRIGHT*

Similar to the requirements of form that determine the way in which the author can legally transfer his rights, the various modes of exploitation that the law puts at the author's disposal also seem to relate to the extent of protection. Therefore, it seems that these modes of exploitation can be regulated by national law without interfering with the Berne prohibition on formalities.¹¹⁴² Even so, ever since the introduction of this rule, it has been questioned whether the collective licensing system, in general, and specific forms of non-voluntary collective licensing, in particular, are consistent with the prohibition on formalities. This section examines these questions, focusing, in particular, on the establishment and functioning of collective rights management organizations (CMOs), non-voluntary and extended collective licensing systems and models allowing right owners to 'opt out' of established licensing systems.

The Establishment or Functioning of CMOs

In the 1930s, it was openly questioned whether the conditions imposed by national law for the establishment or functioning of CMOs were compliant with the Berne prohibition on formalities.¹¹⁴³ The Canadian Copyright Amendment Act of 1931, for example, required each CMO for performance rights to deposit with the Copyright Board, at regular intervals, a list of all the works it administered plus an overview of

¹¹⁴¹ See e.g. Van Eechoud 2003, at 193 et seq., arguing that this can be the country where the relevant act takes place, the country of habitual residence of the transferor, the country where protection is sought or any other country, depending on the applicable choice of law criteria.

¹¹⁴² See e.g. Baum 1932, at 930, Masouyé 1978, at 33 and Schönherr 1981, at 297.

¹¹⁴³ See Snijder van Wissenkerke 1933, at 5 et seq.

all the revenues it generated from the exploitation of these rights. The CMO was not permitted to administer and legally enforce the rights until it had duly fulfilled these requirements.¹¹⁴⁴ The Berne International Bureau considered this requirement to be inconsistent with the prohibition on formalities because it subjected the ‘exercise’ of performance rights to deposit.¹¹⁴⁵ That it concerned the administration of rights by a CMO instead of the author was deemed irrelevant, since the provisions of the Berne Convention applied to authors as well as to their successors in title.¹¹⁴⁶

For the same reasons, the Berne International Bureau queried whether the Dutch and the German Copyright Acts, which required CMOs to obtain ministerial consent or a ministerial licence to be able to act as a commercial agent in matters of musical performance rights,¹¹⁴⁷ were compatible with the prohibition on formalities.¹¹⁴⁸

At present, it seems to be accepted that these conditions are not prohibited by the Berne Convention.¹¹⁴⁹ They are not requirements of form on which the enjoyment or the exercise of copyright depends. Copyright exists irrespective of whether a CMO fulfils these requirements. Moreover, even if a CMO fails to complete them, authors are free to exercise their rights individually. Intrinsically, therefore, requirements of this kind have little to do with copyright law, but are rather of a public order. They are aimed at facilitating the control of the functioning of CMOs in the interest of authors and users of the repertoire administered by CMOs.¹¹⁵⁰ Provided that they do not preclude the exercise of rights altogether, they appear to be Berne compliant.

Non-Voluntary Licensing Systems

More recently, questions have been raised about the compatibility of non-voluntary licensing schemes with Article 5(2) of the Berne Convention.¹¹⁵¹ Two examples are compulsory licensing and mandatory collective licensing. In cases where the public

¹¹⁴⁴ Sec. 10 of the Canadian Copyright Amendment Act of 11 June 1931.

¹¹⁴⁵ See *Le Droit d’Auteur* 1932, at 5. See also the resolution adopted by the International Confederation of Authors and Composers Societies (CISAC) in London in 1931, in *Le Droit d’Auteur* 1931, at 69.

¹¹⁴⁶ See *Actes 1908*, at 236; Berne Centenary 1986, at 147.

¹¹⁴⁷ Art. 30a Dutch Copyright Act, which was introduced on 11 February 1932 and has remained in force until today, and the German Act (*Reichsgesetz*) of 4 July 1933, which has been repealed and replaced by art. 1 of the German Copyright Administration Act (*Urheberrechtswahrnehmungsgesetz*).

¹¹⁴⁸ See *Le Droit d’Auteur* 1933, at 110, concluding, however, that: ‘*Il semble que l’opinion générale tende plutôt à ne pas voir dans des mesures de ce genre une formalité interdite par l’article 4, alinéa 2, de la Convention*’.

¹¹⁴⁹ See e.g. Hoffmann 1933, at 373-377, Roeber 1933, at 368 et seq., Möhring 1934, at 333, Hoffmann 1935, at 94-96, Mentha 1955, at 157 and Mentha 1965, at 64. See also Snijder van Wissenkerke 1933, at 6-8, asserting however that the provisions of the Canadian Act of 1931 were incompatible with the Berne prohibition on formalities. But see Hubmann 1966, at 33-34.

¹¹⁵⁰ See Snijder van Wissenkerke 1933, at 6-7 and Hoffmann 1935, at 94-95.

¹¹⁵¹ See e.g. Doutrelepoint 1998, at 542-543, Lucas 1998, at 1168-1169, Lucas & Lucas 2001, no. 694, at 536-537, Von Lewinski 2004, at 11 and Bernault & Lebois 2006, no. 130-131, at 55-56.

interest in obtaining copyright licences outweighs the copyright owner's interest in retaining exclusivity, legislators can adopt a statutory compulsory licencing scheme, requiring right owners to license particular rights to third parties in return for which they receive reasonable compensation.¹¹⁵² For the same reason, a statutory regime of mandatory collective licensing can be introduced,¹¹⁵³ by operation of which all right owners in a given field are collectively represented by one or more CMOs.

Evidently, these non-voluntary licensing schemes put a restriction on the way in which copyright owners can exercise their rights.¹¹⁵⁴ Many legal commentators have therefore argued that these systems are inconsistent with the Berne prohibition on formalities.¹¹⁵⁵ They state that Article 5(2) of the Berne Convention does not permit Union states to oblige authors to revert to a public agency to collect the reasonable compensation under a compulsory licensing scheme or to conclude agreements with a CMO to take advantage of their rights. They maintain that the exclusive nature of copyright entails that there should always be room for individual licensing.¹¹⁵⁶

However, that copyright owners are unable to individually exercise their rights is by itself not enough to qualify these licensing systems as prohibited formalities. All copyright limitations somehow restrict the author in the exercise of his rights. Non-voluntary licensing systems are no exception. Rather than precluding the exercise of copyright altogether, they prescribe the manner of exercise of copyright by limiting it to a specific form of licensing. Accordingly, they regulate the extent of protection rather than the enjoyment or the exercise of copyright.¹¹⁵⁷ In view of that, it seems

¹¹⁵² US copyright law knows various compulsory licences. Examples are compulsory licences for cable retransmission (17 USC § 111), for the making and distribution of phonorecords (17 USC § 115) and for retransmission by satellite carriers (17 USC § 119). Under the Berne Convention, Union states are allowed to establish compulsory licences in respect of broadcasting and related rights (art. 11*bis*(2) of the Berne Convention) and rights of recording of musical works (art. 13(1) of the Berne Convention).

¹¹⁵³ A system of mandatory collective rights management exists, inter alia, in the EU in the area of cable retransmission rights. See art. 9(1) of the EU Council Directive 93/83/EEC of 27 September 1993 on the coordination of certain rules concerning copyright and rights related to copyright applicable to satellite broadcasting and cable retransmission, *OJ L* 248/15, 6 October 1993. See also Von Lewinski 2004, at 2-3, for examples of mandatory collective licensing systems at the national level.

¹¹⁵⁴ See e.g. Von Lewinski 2004, at 5, Ficsor 2006, at 42 and Ficsor 2010, at 44.

¹¹⁵⁵ See e.g. Peter 1954, at 299, Mentha 1955, at 157, Bappert & Wagner 1956, at 75, Mentha 1965, at 64-65 and Hubmann 1966, at 30 et seq. See also Nordemann, Vinck, Hertin & Meyer 1990, at 78.

¹¹⁵⁶ See Nordemann, Vinck, Hertin & Meyer 1990, at 78, arguing that mandatory collective licensing is acceptable under art. 5(2) of the Berne Convention to the extent that it concerns the administration of mere remuneration rights, but not in so far as the author's exclusive rights are involved.

¹¹⁵⁷ See Baum 1932, at 932: '*Die aus dem Urheberrecht fließenden Verwertungsmöglichkeiten betreffen den Schutzzumfang, nicht aber den Genuß und Ausübung des Urheberrechts*'. See also Drexl 1990, at 82-83, Lucas & Lucas 2001, no. 694, at 536 and Von Lewinski 2004, at 11. But see Doutrelepon 1998, at 543, doubting whether collective rights management could easily match the concept of the 'extent of protection' in the meaning of the last part of art. 5(2) of the Berne Convention. However, she admits that it may well fall within the category 'means of redress' in the same provision.

consistent with Article 5(2) of the Berne Convention to subject the exercise of rights to a system of compulsory licensing or mandatory collective licensing.¹¹⁵⁸

Extended Collective Licensing Systems

Another licensing system in respect of which the compatibility with the prohibition on formalities has been called into question is extended collective licensing (ECL), which is applied in the ‘Nordic countries’ (Denmark, Finland, Norway, Sweden and Iceland) in various sectors.¹¹⁵⁹ ECL is characterized by statutory provisions that give extended effect to clauses in a collective licensing contract concluded between (a certain group of) users and a CMO representing a ‘substantial’ number of copyright owners in a given field. The law extends this agreement to cover an entire class of works or rights, thus binding all copyright owners in the relevant field. To protect the interests of right owners who are not members of the CMO and who do not wish to participate in the collective licensing scheme, ECL systems often give copyright owners the choice to ‘opt out’ and individually manage their rights.¹¹⁶⁰

It has been maintained that the ECL ‘opt out’ procedure should be as simple and straightforward as possible to prevent it from being a ‘*de facto* formality’ prohibited by Article 5(2) of the Berne Convention.¹¹⁶¹ It is questionable however whether this assertion is correct. ECL systems govern the extent to which rights can be exercised no more than mandatory collective licensing systems do. Collective licensing is the statutory default under both systems. As observed, this is not prohibited by Article 5(2) of the Berne Convention. The question remains whether the ‘opt out’ procedure complies with the prohibition on formalities. It seems that it does. The possibility to ‘opt out’ from the ECL scheme does not affect the ‘enjoyment’ or the ‘exercise’ of copyright. The right is exercised in any event, either collectively as statutory default rule or individually if the author ‘opts out’. Accordingly, it only reflects the specific modes of exploitation that the law puts at the author’s disposal. In the system of the Berne Convention, this is a matter left to be regulated by contracting states.¹¹⁶²

¹¹⁵⁸ See Von Ungern-Sternberg 1973, at 62, note 2, Hilty 1986, at 212, Drexl 1990, at 82-83, Lucas & Lucas 2001, no. 694, at 536-537, Von Lewinski 2004, at 11, Gervais 2005, at 351, Bernault & Lebois 2006, no. 130-131, at 55-56, Gervais 2006, at 34 and Gervais 2010b, at 26. Obviously if the coming into being of copyright depends on the requirement to become a member of a CMO, there is a breach of art. 5(2) of the Berne Convention. See e.g. Hilty 1986, at 212 and Doutrelepon 1998, at 543.

¹¹⁵⁹ See Olsson 2005, Koskinen-Olsson 2006 and Koskinen-Olsson 2010.

¹¹⁶⁰ See Olsson 2005, para. 6.4, on these ‘opt out’ mechanisms in the laws of the Nordic countries.

¹¹⁶¹ See Ficsor 2006, at 48 and Ficsor 2010, at 62.

¹¹⁶² See e.g. Baum 1932, at 930: ‘*Die Frage ... welche Verwertungsmöglichkeiten ein Urheber hat, ist eine Frage der “étendue” des Schutzes, des Schutzzumfanges. Ob und in welchem Umfange solche Verwertungsmöglichkeiten bestehen, hängt daher lediglich von der nationalen Gesetzgebung ab.*’

Other 'Opt Out' Models

The question of compatibility with the prohibition on formalities has been raised in relation to other 'opt out' models as well. One example is the government-operated levy or tax system that one scholar proposed a few years ago to legalize peer-to-peer file sharing.¹¹⁶³ It was suggested to have the rights of reproduction, communication to the public and making available to the public replaced with a compensation scheme. For this purpose, a levy or tax would be imposed on the sale of devices or services that consumers use when sharing files over peer-to-peer networks.¹¹⁶⁴ Right owners could 'opt out' of the compensation scheme by making their works available in a given 'digital file format' capable of conveying RMI and perhaps incorporating DRM technology. Works already released in other formats could also be withdrawn from the compensation scheme, but only if right owners would reclaim all copies of these works by giving consumers owning authorized, commercial copies the chance to exchange them for copies in the 'digital file format' free of charge.¹¹⁶⁵

It has been questioned whether the 'opt out' model discussed here complies with the Berne prohibition on formalities.¹¹⁶⁶ Some scholars assert that it does not. They argue that it is 'a state-required formality for the enjoyment of minimum exclusive rights'.¹¹⁶⁷ By emphasizing that 'international copyright law persists in the notion of exclusive rights', they contend that the proposed compensation scheme is consistent with international copyright law only if exclusivity is the statutory default.¹¹⁶⁸ Hence they assert: 'If exclusivity has to be the default ..., the opt-out mechanism can well be said to be a formality requirement'.¹¹⁶⁹ This understanding closely resembles that of legal scholars who deem mandatory collective licensing to be a Berne prohibited formality for the reason that it precludes the enjoyment of exclusive rights.

However, for the same reasons applied to the non-voluntary licensing system and the ECL system, the argument that the 'opt out' model is a Berne prohibited formality because it affects the exclusivity of copyright is not convincing. The 'opt

¹¹⁶³ Litman 2004, at 39-50. See also Fisher 2004, at 9-10 and 199-258, proposing a similar compensation system, but based on a voluntary 'opt in' model. Copyright owners would be given the opportunity to be compensated for the online use of their works, if they voluntarily attach a unique file name to their digital works which they could obtain by registering their works with the US Copyright Office.

¹¹⁶⁴ Litman 2004, at 44. Alternatively she proposes a model requiring people who wish to engage in non-commercial file sharing to pay, together with their monthly or annual subscription for internet access, a blanket licence fee that would release them from liability for copyright infringement.

¹¹⁶⁵ *Ibid.*, at 46-48.

¹¹⁶⁶ See Peukert 2005, at 60-69 and, indirectly, Gervais 2005, at 351 and Gervais 2006, at 34.

¹¹⁶⁷ Peukert 2005, at 67. See also Gervais 2005, at 351 and Gervais 2006, at 34, stating: 'A government-operated levy or tax system that would replace exclusive rights guaranteed by the Berne Convention by a compensation regime (e.g. a levy) would not only have to comply with the three-step test (to validate the exception) but may also constitute a prohibited formality'.

¹¹⁶⁸ See Peukert 2005, 60-69, at 67.

¹¹⁶⁹ *Ibid.*, at 61 and 67, confirming: 'These exclusive rights have to come into existence without further formalities as the statutory default'.

out' model is part of a levy or tax system, which is an exception to copyright. To be consistent with international copyright law, the system must first of all comply with the three-step test laid down in the international copyright treaties.¹¹⁷⁰ If it does not, it is not permitted to adopt the levy or tax system and the question of whether 'opting out' is consistent with the Berne prohibition on formalities would be totally redundant.

If the proposed compensation system satisfies the three-step test, on the other hand, it is permitted to limit the exclusive enjoyment of copyright. This means that the 'opt out' procedure could only be qualified as a Berne prohibited formality if it affects the enjoyment or the exercise of copyright, not because it affects copyright exclusivity. In fact, it may well be that the possibility to 'opt out' eases compliance with the three-step test because it mitigates some of the adverse effects of the proposed copyright exception. That is, it enables authors to retain exclusivity by opting out of the compensation scheme (see para. 5.2.2.4).¹¹⁷¹ However, the 'opt out' model does not seem to be a prohibited formality. Akin to the non-voluntary licensing and ECL system, it regulates the extent of protection rather than the enjoyment or the exercise of copyright. The possibility to 'opt out' merely reflects the choice that right owners can make between two different exploitation models that the law offers them. They may choose to enjoy the benefits of the compensation system or to enjoy exclusivity of copyright by withdrawing their works from the compensation system.¹¹⁷² That the system requires works to be registered with an agency responsible for collecting and distributing the levy or tax does not seem to make a difference.¹¹⁷³ It is comparable with the need to become a member of, and to register works with, a particular CMO to receive the compensation collected in a collective licensing scheme.

5.4 Conclusion

The international prohibition on formalities is not absolute. As one commentator has recently stated: 'It would be patently incongruous to read Article 5(2) as preventing the mandatory doing of anything.'¹¹⁷⁴ This chapter has shown that the prohibition on formalities is defined and delimited in three different manners at least.

¹¹⁷⁰ See art. 9(2) of the Berne Convention with respect to the reproduction right and art. 13 of the TRIPS Agreement and art. 10 of the WCT for copyright in general. See also para. 5.2.2.4 above.

¹¹⁷¹ See also Litman 2004, at 45-46, asserting that 'if such a system allows copyright owners to decline to participate, it seems more likely that it will be deemed at least arguably compliant with our treaty obligations under the Berne Convention and the WIPO Copyright Treaty'.

¹¹⁷² See Peukert 2005, at 43, arguing that a levy or tax system with in-built 'opt out' possibility 'does not limit exclusivity as such; it just offers the right holder an additional business model to generate income from the uses of her work in cyberspace'. See also, *ibid.*, at 60.

¹¹⁷³ But see Peukert 2005, at 67.

¹¹⁷⁴ See Gervais 2005, at 351 and Gervais 2006, at 33.

First, its scope of application is limited to ‘these rights’. This means that it only applies to rights that contracting states must secure under the applicable treaty (i.e., the minimum set of rights and the rights subject to national treatment) in respect of works of which they are not the country of origin. The applicable treaty is the Berne Convention, in the context of the Berne Convention and the TRIPS Agreement, and the Berne Convention and the WCT jointly, in the context of the WCT.

Second, the prohibition applies to ‘formalities’ only. This must be understood to mean formalities (e.g., registration and deposit) and external conditions (e.g., notice requirements). Conditions establishing the inner characteristics or the consequences and effects of copyright protection in substance are excluded from its scope.

Third, formalities are banned only to the degree that they affect the ‘enjoyment’ or the ‘exercise’ of copyright. This includes formalities relating to the coming into existence, the maintenance and the enforcement of copyright. The Berne prohibition on formalities does not extend to formalities that regulate the extent of protection or the means of redress afforded to authors to protect their rights.¹¹⁷⁵ This suggests that formalities are allowed if they establish the manner of exercising copyright, but not if their non-compliance renders the exercise of rights completely impossible.

Consequently, the international copyright framework seems to leave considerable room for reintroducing formalities. In general, all contracting states are permitted to make the protection of domestic works conditional on formalities. This implies that, in principle, an international system of formalities can be established if all countries would subject the protection of domestic works to the same formalities. However, a system of this kind may be difficult to introduce, given the likely antipathy between states to grant to foreign authors a better protection than to national authors and the risk of circumvention of domestic formalities by manipulating the work’s country of origin. This would necessitate a collaborative and coordinated approach.

Other than instituting a general regime of formalities relating to domestic works, the international copyright treaties also permit contracting states to adopt piecemeal approaches, by subjecting specific types of rights, works or modes of exploitation to formalities. We have seen many examples of this. One example is the protection of RMI. Although the Berne prohibition on formalities applies *mutatis mutandis* to the protection provided for in the WCT, the protection of RMI is arguably not touched by it. This would allow contracting states to make the protection of RMI conditional on the registration or deposit of such information in a publicly accessible database. Another example is the transfer of copyright. The prohibition on formalities appears not to extend to requirements of form that establish the manner in which a transfer of copyright must be effectuated or that prove the existence or scope of the relevant transaction. This allows for the adoption of a recordation system, giving legal effect to copyright transfers only upon recordation in a publicly accessible register.

However, whatever regime of formalities contracting states might be permitted to adopt, it cannot address the various challenges in current copyright law identified in

¹¹⁷⁵ See Baum 1932, at 931.

Chapter 1. What the above examples illustrate is that with the current possibilities of introducing formalities, contracting states may perhaps be able to address part of the rights clearance problems, but they cannot tackle the challenges of establishing legal certainty over copyright claims and advancing the free flow of information.

Even if contracting states subject domestic works to constitutive formalities, the effects on creating legal certainty over copyright claims and enhancing the free flow of information would be minimal. Because of the independence of protection, works for which domestic formalities have not been fulfilled will nevertheless be protected in other contracting states. Thus, these works would only enter the public domain in the country of origin, which would therefore become an unprotected island in a sea of copyright protection. Moreover, only in the country of origin could the validity of copyright claims be legally determined by means of formalities. In other countries, the copyrightability of works must still be tested against the standard of originality applied in the protecting state. Accordingly, while the effect of domestic formalities on facilitating rights clearance may be significant, even in an international context (i.e., if the information that the formalities supply is made available universally), the effects on creating legal certainty over copyright claims and enhancing the free flow of information would be limited to domestic works in the country of origin.

Likewise, the registration of RMI and the recordation of transfer can significantly improve rights clearance by making adequate information available about copyright and transfers of copyright, but these formalities do not enlarge the public domain or shed light on the validity of copyright claims. Therefore, such formalities cannot be introduced with the intention of addressing the challenges of creating legal certainty over copyright claims and enhancing the free flow of information either.

In conclusion, the international copyright framework leaves insufficient room for reintroducing formalities with a view to addressing the various challenges in current copyright law. If the object is to establish legal certainty over copyright claims or to advance the free flow of information, then the prohibition on formalities would need to be altered or perhaps even be abolished altogether. The question is whether this is feasible, given the motives behind the abolition of formalities at the national and the international levels. The next chapter scrutinizes one of the most critical arguments against copyright formalities, namely, that copyright is a 'natural right' that comes into existence automatically and, for this reason, cannot be subject to formalities. As we have concluded in Chapter 3 and Chapter 4, together with the complications and costs that completing formalities at the international level would entail, this was perhaps the most salient reason for the adoption of the prohibition on formalities in 1908 and the abolition of copyright formalities in the various countries around the same time.