South Carolina Law Review

Volume 3 | Issue 1 Article 10

9-1950

International Copyright Protection

Robert W. Foster

NOTES

INTERNATIONAL COPYRIGHT PROTECTION

ROBERT W. FOSTER*

[Editor's note] This paper is the winner of the first prize from the University of South Carolina School of Law 1950, awarded each year in the Nathan Berkan Memorial Competition sponsored by the American Society of Composers, Authors and Publishers. Published by permission of the American Society of Composers, Authors and Publishers.

INTRODUCTION

The United States Constitution grants the power, "to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries".[1] Acting under this authority Congress enacted the Copyright Act of 1790 and amended it in 1831. Both of these Acts, however, limited copyright protection to citizens and residents of the United States. In view of this limitation on the copyright protection in this country during the nineteenth century, systematic piracy was committed on works published in all foreign countries, especially in England. This state of the law naturally led to a reluctance, if not a refusal, on the part of foreign countries to extend copyright protection to American authors and composers. It is apparent that our copyright laws during this period were in need of some reformation.

The first step taken by this country toward securing copyright protection to aliens came on July 1, 1891, when the so-called Chace International Copyright Act was passed. This Act, as amended on March 4, 1909, provided for copyright protection for certain aliens, and will be discussed in more detail under a subsequent heading.

Presidential proclamations granting reciprocal copyright protection, as provided for in this Act, have been extended to most of the nations of the world. However, reciprocal copyright agreements have never been made with the following countries: Bulgaria, Bolivia, Egypt, Estonia, Yugoslavia, Latevia, Lichenstein, Lithuania, Persia, Turkey, Russia, and Venezuela.[2] Therefore, citizens of these coun-

*Member of the Senior Class, School of Law.

1. U.S. CONST. ART. 1, § 8, Cl. 8.
2. 2 LADAS, THE INTERNATIONAL PROTECTION OF LITERARY AND ARTISTIC WORKS, § 390 (1st ed. 1938).

tries who are not domiciled in the United States receive no copyright protection in this country, and American authors and composers receive little or no copyright protection in these countries.

The United States Copyright Act cannot be correctly termed international in its scope as the copyright laws in one country have no extra territorial operation.[3] Separate and independent copyrights must be obtained in the several countries in accordance with their respective laws.[4] For example, if an American author wanted to secure copyright protection in England, today, he must enter his title at Stationers' Hall, London, and pay the required fee. He must also have his work published in England or in her dominions simultaneously with its publication in the United States.[5] In each country both the procedure and the length of protection varies. Likewise, an alien who is entitled to copyright protection of his work in the United States must comply with all of the procedural requirements of our copyright laws. The citizens of member nations of the International Copyright Union, which will be discussed in more detail under a subsequent heading, do not have to comply with copyright procedure of other member countries, but are granted copyright protection automatically.[6]

Common Law Protection to Aliens

Statutory copyright law deals exclusively with copyright protection after there has been an initial publication of the work. In addition to this, the author or composer has a common law property right in the exclusive use of his work which remains perpetual prior to publication.[7] The Copyright Act makes protection after publication dependent upon complying with certain regulations and even excludes certain aliens from copyright protection, in this country, of their published works under any conditions. Common law copyright is granted to citizens and aliens alike and is independent of any regulations and conditions. This principle was clearly set out in *Ferris v. Frohman*[8] where the Supreme Court of the United States said, "An English author of an unpublished drama is entitled to protection against its unauthorized use in this country as well as England". It should be noted, however, that this common law protection is not reciprocated to American authors in England. A

3. Ferris v. Frohman, 223 U.S. 424 (1911).
4. 13 C.J. 1056.
5. 7 Encyclopedia Americana, 673 (1947).
6. Ball, Law of Copyright and Literary Property, § 98 (1st ed. 1944).
7. Palmer v. DeWitt, 47 N.Y. 532 (1872).
8. See note 3, *supra*.

foreign author in that country has no common law right to copyright protection as it has been taken away by the Statute of Anne,[9] and the statutory copyright is the only protection now available to the author.[10]

The United States Copyright Act in no way tends to take away or cut down this common law copyright protection. In fact, Section 2 of the Act provides for the preservation of this right as follows:

> That nothing in this Act shall be construed to annul or limit the right of the author or proprietor of an unpublished work, at common law or in equity, to prevent the copying, publication, or use of such unpublished work without his consent and to obtain damages therefor.[11]

As has been previously stated, this common law right is limited to unpublished works and may be lost by publication. Once the common law protection has been abandoned by such publication, the work becomes *publici juris,* subject only to such rights as the author may have secured under the copyright statute.[12] In order for the author to take advantage of the statutory copyright protection, however, he must have maintained intact, under the laws of this country, his common law copyright.[13] The unrestricted sale of a single copy of a work has been held to constitute such publication as to extinguish an author's common law rights, thereby denying him the right to obtain protection under the Statute.[14]

Whether there has been a publication and thereby an abandonment of the common law right is a question to be decided by the law of the country where the case is being tried. For example, the public representation of a play constitutes a publication under the English law, while such a representation is not a publication under the United States law. It was held in *Ferris v. Frohman*[15] that a United States copyright of a play by an English author was not extinguished by a prior public representation of the play, though this would have been an abandonment of the author's common law right in England.

The Copyright Act is silent as to where publication shall take place in order to constitute an abandonment of the common law

9. 8 Anne, C. 19 (Eng. 1710).
10. Chappell v. Purday, 14 Meeson and Welsty 309; 9 Jur. 495 (1845).
11. 35 STAT. 1077, 17 U.S.C. § 8 (1909).
12. Caliga v. Inter-Ocean Newspaper Company, 215 U.S. 182 (1909).
13. Basevi v. Edward O'Toole Company, 26 F. Supp. 41 (S.D. N.Y. 1939).
14. See note 12, *supra.*
15. See note 3, *supra.*

protection, thus creating an interesting problem where the first publication takes place abroad. It has been contended that a foreign publication would not be a publication in this country and, therefore, the common law copyright would not be lost.[16] The courts have taken a contrary position from this, however, and have held that the publication of a book in a foreign country will prevent the owner of the book from subsequently securing a valid copyright in the United States.[17]

There can obviously be no abandonment of common law copyright protection by publication without the consent of the author. Therefore, no one would have the right to import a work into this country and publish it here, prior to publication in a foreign country. However, once the work has been published with the consent of the author, it is thereby dedicated to the world, and no copyright protection can be acquired in this country.[18]

Statutory Protection to Aliens

If a foreign author has maintained his common law copyright intact as outlined above, and if he falls within the classification to which the copyright Act extends, he may procure copyright protection for his published works the same as if he were a citizen of this country. Section 8 of the Copyright Act which provides for protection of aliens provides as follows:

> Authors or proprietors entitled; aliens. The author or proprietor of any work made the subject of copyright by this title, or his executors, administrators, or assigns, shall have copyright for such work under the conditions and for the terms specified in this title. The copyright secured by this title shall extend to the work of an author or proprietor who is a citizen or subject of a foreign state or nation only:
>
> (a) When an alien author or proprietor shall be domiciled within the United States at the time of the first publication of his work; or
>
> (b) When the foreign state or nation of which such author or proprietor is a citizen or subject grants, either by treaty, convention, agreement, or law, to citizens of the United States the benefit of copyright on substantially the same basis as to its own citizens, or copyright protection, substantially equal to

16. Italian Book Company v. Cardelli, 273 Fed. 619 (S.D. N.Y. 1921).
17. See note 13, *supra*.
18. Boucicault v. Wood, 3 Fed. Cas. 988 (1867).

protection secured to such foreign author under this title or by treaty, or when such foreign state or nation is a party to an international agreement which provides for reciprocity in the granting of copyright, by the terms of which agreement the United States may, at its pleasure, become a party thereto.

The existence of the reciprocal conditions aforesaid shall be determined by the President of the United States, by proclamation made from time to time, as the purposes of this title may require.[19]

Part (a) of this section extends the copyright protection to the published works of all aliens domiciled within the United States even if their sovereign does not extend reciprocal rights to this country. However, such an alien will not be protected under the Copyright Act for his unpublished works. In *Leibowitz v. Columbia Graphophone Company*,[20] an alien who was domiciled in New York but who was a citizen of a country with which the United States had no reciprocal copyright agreement, took out a copyright under Section 11 of the Copyright Act, as an unpublished work. At the time the author brought the action for infringement of his copyright his work had never been published in this country. The Court held that this alien author did not bring himself within the protection of Section 8 which protects persons "domiciled in the United States at the time of publication of his work", as this work was never published. This section cannot be taken to mean "domiciled in the United States at the time of acquiring the copyright".[21]

The question of whether a person is domiciled in the United States so as to allow him to benefit from the Copyright Act, is governed by the general law of domicile, and is determined by the intention of the party. The intention existing at the time of the filing of the title is controlling, and is unaffected by any subsequent change of intention.[22]

An author or composer has such a property right in the work he produces as may be freely assigned. This right, however, may not be used to protect an author who would otherwise be excluded from protection by the terms of the statute by allowing him to assign his rights to a person who would be entitled to protection under the statute.[23] If such an assignee could then take out a

19. 35 STAT. 1077, 17 U.S.C. § 8 (1909).
20. 298 Fed. 342 (S.D. N.Y. 1924).
21. The plaintiff's common law right of protection of his unpublished work was not raised in this case.
22. See note 18, *supra*.
23. Keene v. Wheatley, 14 Fed. Cas. 180 (1819).

copyright in this country, the author would be obtaining indirectly what the statute prohibits him from obtaining directly. The court refused to grant copyright protection to such an assignee in *Bong v. Alfred S. Campbell Art Company*,[24] setting out the rule as follows:

> An author of a painting, who not being a citizen or subject of a foreign state with which the United States has copyright relations, is excluded by the statute from benefit of copyright, and cannot convey such right to a person whose citizenship is such as to satisfy the provisions of that section.

The converse of this principle is not true, however, and a non-resident foreigner who would not be allowed to take out a copyright in this country, could protect a copyright which was assigned to him, provided his assignor came within the protection of the statute.[25]

Occasionally a copyrightable work is composed jointly by two or more persons, one of whom is entitled to copyright protection under the statute, and another who is not. For example, an American citizen may write the words to a song while the melody may be written by an alien who is not eligible to obtain a copyright. In such a case, the courts treat the work as though a United States citizen was the sole author and a copyright taken out by him will protect the entire work.[26] The extent to which this principle has been extended is well illustrated in *Black v. Henry G. Allen Co.*,[27] where alien publishers of a foreign encyclopedia, who were not entitled to copyright protection in the United States, procured copyright articles from citizens of the United States and incorporated them into the entire body. The court held in this case that the publishers could protect the copyright in the courts of the United States even though the articles were procured for the express purpose of preventing the book from being reprinted in this country.

The Copyright Act provides for protection of aliens who are citizens of a country which grants reciprocal copyright protection to citizens of this country. Although a country may actually extend reciprocal protection to citizens of this country, the statutory requirements are still not met unless this is evidenced by a Presidential proclamation to that effect.[28] This proclamation is a conclusive determination that the laws of that country grant United States citi-

24. 214 U.S. 236 (1908).
25. American Tobacco Co. v. Werchmeister, 207 U.S. 284 (1907).
26. G. Ricordi & Co., Inc. v. Columbia Graphophone Co., 258 Fed. 72 (S.D. N.Y. 1919).
27. 42 Fed. 618 (S.D. N.Y. 1890). *But Cf.* Bentley v. Tibbals, 223 Fed. 247 (C.C.A. 2nd 1915).
28. See note 24, *supra.*

zens reciprocal protection and the Courts are bound to presume that such conditions exist until a different proclamation is made.[29] The practical effect of this provision of the Copyright Act, is that an alien citizen of a country which actually grants reciprocal protection to United States citizens, but to which no Presidential proclamation has been issued, will be denied protection in this country. On the other hand, an alien citizen of a country to which a proclamation has been issued will be protected in the United States, even though that country does not actually extend reciprocal protection to America.

This Presidential proclamation must have been issued to the country of which the alien seeking protection is a citizen prior to first publication of the work. The proclamation speaks only from the date of its issuance unless made retroactive by its terms.[30]

STATUTORY PROCEDURAL REQUIREMENTS

A foreign author or composer who is entitled to protection under the Copyright Act, must follow the same procedural steps required of a citizen of this country before he will be protected. Section 9 of the Copyright Act sets out one of these requirements as follows:

> That any person entitled thereto by this Act may secure copyright for his works but publication thereof with the notice of copyright required by this Act, and such notice shall be affixed to each copy thereof, published or offered for sale in the United States by authority of the copyright proprietor.

This section is rather unique as this notice is required in no other country in the world, aside from a few Latin American republics. Nevertheless, an alien will lose his United States Copyright if he publishes his work in this country without the statutory notice of copyright.

As the power of the United States Congress is limited within the borders of this country, and it is presumed that it will not pass an Act which goes beyond its limits, the statute does not require notice of the American copyright on books published abroad and sold only for use there.[31] This situation creates one of the anomalies of the Copyright Act. A foreign edition of a book need not carry the statutory notice required by books sold within this country after a United States copyright has been acquired.[32]

29. Chappell & Co. v. Fields, 210 Fed. 864 (C.C.A. 2nd 1914).
30. 28 Op. Atty. Gen. 222; 13 C.J. 1055.
31. United Dictionary Co. v. C. and C. Merriam Co., 208 U.S. 260 (1907).
32. 13 C.J. 1068.

Section 29 of the Copyright Act provides for the punishment of any person who inserts any notice of copyright on any uncopyrighted article. This provision, however, does not extend to false statements affixed abroad as this Act can have no extraterritorial effect outside the United States.[33] In order to prevent the circulation in this country of books containing illegal copyright notices which were affixed abroad, Section 30 was added to the Copyright Act. This section prohibits the importation into this country of any article bearing a false notice of copyright. Section 32 of the Copyright Act provides for forfeiture and destruction of articles which are imported in violation of this section.

Another condition which alien authors must meet prior to protection of their work in this country was created by Section 15 of the Copyright Act. This section provides that all books, with certain exceptions, in order to be copyrightable in this country, must be printed from type set in the United States and if the book is bound it must be done in this country. Three classes of works are expressly exempted from the provisions of this section, viz; (1) books in a language other than English of foreign origin; (2) books in raised characters for the use of the blind and; (3) books in the English language published abroad and seeking *ad interim* protection.[34] In all other cases, an affidavit to the effect that the above conditions have been complied with is required. In default of this procedure being followed, the work will fall into the public domain and is not thereafter subject to copyright.[35]

The rigidity of this section is somewhat lessened by Section 16 of the Copyright Act as amended June 3, 1949. This section allows a foreign author or publisher of an English language book or periodical manufactured outside the United States to obtain copyright protection in the United States for five years. During this five year period of *ad interim* protection, the foreign author may manufacture an American edition of his work and thereby extend his protection to the full term as elsewhere provided for under the Act.

The manufacturing requirements are furthermore rendered less severe by an amendment to the Copyright Act passed by Congress on June 3, 1949. This amendment allows a publisher to import 1,500 copies of a foreign book into the United States, without losing his copyright protection in this country. This is intended to permit a publisher to test the market before investing money in manufacturing an edition in the United States.

33. See note 31, *supra.*
34. LADAS, INTERNATIONAL PROTECTION OF LITERARY AND ARTISTIC WORKS, § 351 (1st ed. 1938).
35. 13 C.J. 1067.

INTERNATIONAL COPYRIGHT UNIONS

During the 19th century the advancements made in printing and transportation facilities brought about an ever increasing flow of literrary and artistic works in international commerce. This creates a demand for an effective agreement among the nations of the world in the protection of copyright. In 1858 the seed was planted for such an agreement when representatives from 15 nations of the world met in Brussels to work out a plan for the international protection of copyright. After several similar meetings were held, the conference drew up an agreement entitled The Berne Convention of 1886 and invited all other nations to join therein. Ten of the participating nations joined in its immediate execution and shortly thereafter other nations followed their lead and acceded to the Union.[36] Since the execution of this agreement in 1886, subsequent conventions have been held in Paris, 1896; Berlin, 1908; additional protocol, 1914; Rome, 1928; and more recently in Brussels in 1948.[37] While there have been important amendments and changes made by these subsequent conventions, the basic principle of "national treatment" has remained intact. This so-called national treatment is expressed in Article 4 of the Berne Convention which provides as follows: "Authors enjoy in the other countries for their works the rights which the respective laws grant now or shall grant in the future to nationals". It is therefore the law of the country where protection is sought, *lex loci,* which is the primary legal source of protection in the Union.

This national treatment, however, was made subject to the limitation that the duration of copyright could not exceed in any country of the Union the term provided for in the country of origin. The construction of these provisions are plainly set out in an English case. England being a member of the Copyright Union at the time of the decision, in which it was said:

> . . . the remedies of the court hearing the case will be applied and the court need not consider the remedies of another country except that the copyright owner is entitled to protection for the term which the country of origin gives him.[38]

Like the general principle of national treatment, this limitation on it has also remained unchanged by the subsequent conventions.

36. LADAS, THE INTERNATIONAL PROTECTION OF LITERARY AND ARTISTIC PROPERTY, § 37 (1st ed. 1938).
37. UNESCO's COPYRIGHT BULLETIN, Vol. 3, No. 1, p. 3 (1950).
38. Baschet v. London Illustrated Standard Co., 1 Ch. 73 (Eng. 1900).

It is interesting to note that, while obviously the Union has no authority to legislate as to the term of copyright protection in any country, this limitation to the general rule of national treatment has had the practical effect of making the duration of copyright more uniform in the member countries of the Union. Today the duration of copyright is for the life of the author plus 50 years in 28 of the 40 countries which are members of the Union. The compelling reason for this uniformity is that a country which by its local laws provides for a shorter term of protection would find itself granting a longer copyright period to foreign authors than to its own citizens as it must apply the law of the country of which the alien is a citizen in determining the duration of copyright protection. Moreover, a citizen of the country which grants a shorter term of copyright protection, who seeks copyright in a nation which grants a longer term of protection, would not be allowed the benefit of the longer term as the law of the country of which he is a citizen would be applied. Therefore, in order to protect and grant full advantages of copyright to its own citizens, most of the countries of the Union have extended the term of copyright protection to the uniform period.

Article 3 of the Berne Convention of 1886 provides as follows: "The enjoyment of these rights is subject to the accomplishments of the conditions and formalities prescribed by law in the country of origin of the work . . ." The meaning of this was that a person must first prove that he was entitled to protection in the country of origin before he would be granted protection in another member country. However, after this was shown, no other formalities were necessary in the country in which protection was sought.[39] At the third meeting of the conference in Berlin in 1908, this provision was amended to provide that protection is no longer subject to any formality whatsoever and is independent of the existence of protection in the country of origin. This automatic protection is probably the most important and advantageous provision of the Union today.

The International Copyright Union is open to all of the nations of the world and 40 countries have joined to date. However, the United States has not seen fit to join this Union but instead has become connected with another union of nations for the international protection of copyright. This other Intenational organization for the protection of literary and artistic works is known as the Pan-American Convention. Its first convention was drawn up and signed in 1902, and has since been revised in 1906, 1910, 1928, and 1946.[40]

39. See note 40, *supra.*
40. UNESCO, COPYRIGHT BULLETIN, Vol. 3, No. 1, p. 3 (1950).

The Buenos Aires Convention of 1910 is the most significant of these as it is presently binding on 13 American Republics including the United States. The main principles of this convention are set out in Article 3, which provides as follows:

> The recognition of the right of ownership obtained in a State, in conformity with its laws, shall produce, in full right, its effects in all the others, without having to comply with any other formalities provided there appears in the work some indication that the copyright is reserved.

This principle plus the limitation of membership in the convention to American Republics has the effect of producing three requirements upon which protection is conditioned. These requirements are as follows: (1) publication must take place in an American Republic; (2) the formalities of the country of origin must be observed; and (3) a notice of registration of copyright must appear on the work.

Although automatic protection is not granted under this Pan-American Union as it is under the Berne International Copyright Convention, the two unions are international in their scope as they both provide that a copyright acquired in accordance with the laws of any one of the States shall be protected in all the others without the necessity of complying with any other formality. The two unions are also similar in the fundamental principle of national treatment of authors with the exception of the duration of protection as outlined in the discussion on the Berne Convention, supra.

There has been a great deal of criticism expressed concerning the inadequacies of the international protection of copyright for the authors and composers of this country.[41] Instead of joining the International Copyright Union whereby automatic copyright protection would be granted, we have continued to use the less practical and less effective system of independent agreements with each country. Under this obsolete plan, a foreign author must comply without statutory formalities prescribed for securing copyright in this country and Americans must comply with the formal requirements of a foreign country in order to obtain copyright protection there.[42] There are times when the impracticalities of complying with the requirements in a foreign country are prohibitive to copyright protection. It seems rather paradoxical that this country, with its constant striving for cooperation and understanding and a minimum degree of friction among the nations of the world, has consistently refused to

41. SHAFTER, MUSICAL COPYRIGHT, p. 445 (2nd ed. 1939).
42. Leibowitz v. Columbia Graphophone Co., 298 Fed. 342 (S.D. N.Y. 1924).