

THE BERNE CONVENTION AS A CANON OF CONSTRUCTION: MORAL RIGHTS AFTER *DASTAR*

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I. INTRODUCTION

Usually cited for the rule that Congressional legislation must be presumed to be constitutional, Justice Marshall's opinion in *Murray v. Schooner Charming Betsy*¹ also teaches that acts of Congress should never be construed to violate international laws if another interpretation is available.² The "Charming Betsy" Rule requires Congress to be "crystal clear" if it seeks to abrogate a principle of international law,³ and requires courts to interpret statutes consistently with both customary international law and treaties.⁴

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1. 6 U.S. (2 Cranch) 64 (1804).

2. 6 U.S. at 118. Professor Steinhardt has suggested that *Schooner Charming Betsy* does not actually reach the "avoidance of constitutional issues" question for which it is now most often cited (e.g., *NLRB v. Catholic Bishop of Chicago*, 440 U.S. 490, 500 (1979)). See Ralph G. Steinhardt, *The Role of International Law as a Canon of Domestic Statutory Construction*, 43 VAND. L. REV. 1103, 1130-31 (1990) (noting that "[t]his use of the *Charming Betsy* principle is seriously flawed"). Another important aspect of the "Charming Betsy" Rule was articulated by Justice Sutherland, who reasoned in his dissent in *Cunard S.S. Co. v. Mellon*, 262 U.S. 100, 132 (1923) that U.S. statutes should not be construed to apply to conduct occurring on board foreign vessels. Justice Sutherland's "territoriality" rule was subsequently adopted by the Court in *Lauritzen v. Larsen*, 345 U.S. 571, 593 (1952), and again in *McCulloch v. Sociedad Nacional de Marineros de Honduras*, 372 U.S. 10, 21-22 (1963). The general importance of the presumption of territoriality was reiterated by the Court in the 2003 Term in *F. Hoffman-La Roche Ltd. v. Empagran*, 124 S. Ct. 2359 (2004).

3. See WILLIAM BURNHAM, INTRODUCTION TO THE LAW AND LEGAL SYSTEM OF THE UNITED STATES 664 (3d ed. 2002).

4. Steinhardt, *supra* note 2 at 1152-63 (tracing the development of the "Charming Betsy" Rule from a principle imposing territorial jurisdictional limits to a principle "under which United States courts are directed to interpret statutes con-

In its 2003 decision in *Dastar Corp. v. Twentieth Century Fox Film Corp.*,⁵ the Court's narrow interpretation of a key provision in the Lanham Act was at odds with the obligation of the United States under article 6*bis* of the Berne Convention for the Protection of Literary and Artistic Works (Berne Convention).⁶ Article 6*bis* requires members of the Convention, which the United States joined in 1988, to protect the right to be identified as the author of copyright works one has created.⁷ Under the Berne Convention, this right endures even after an author has alienated the economic aspects of the copyright.

On accession to the Berne Convention, Congress did not enact a broadly applicable "author attribution" statute. It stated instead that U.S. and state laws already provided sufficient protection of the right. Included among these protections was section 43(a) of the Lanham Act, which prohibits use in commerce of a "false designation of origin" that is likely to cause confusion or mistake, or to deceive.⁸ *Dastar* held that section 43(a) cannot be invoked to pro-

sistently with international law. . . includ[ing] both customary law and treaties."). *Id.* at 1161.

5. 539 U.S. 23 (2003).

6. Berne Convention for the Protection of Literary and Artistic Works, art. 6*bis* (Sept. 9, 1886; revised July 24, 1971 and amended 1979; entered into force for U.S. Mar. 1, 1989 (Sen. Treaty Doc. 99-27)) 1986 U.S.T. Lexis 160 or 1 B.D.I.E.L. 715 [hereinafter Berne Convention].

7. *Id.* art. 6*bis*. The relevance of the Berne Convention to the issues in *Dastar* was brought to the Court's attention in a number of briefs. Petitioner's Brief at 31, n.27, *Dastar*, 539 U.S. 23 (No. 02-428); Respondent's Brief at 22, n.7 (No. 02-428); Petitioner's Reply, at 13-14 (No. 02-428); Brief of Amici Curiae Director's Guild of America, et al. at 4, 9-11 (No. 02-428); Brief of Amici Curiae Malla Pollack, et al. at 7, n.9 (No. 02-428); Brief of Amici Curiae United States, at 1, 9-11 (No. 02-428).

8. The full text of section 43(a)(1) of the Lanham Act, 15 U.S.C. § 1125, provides as follows:

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

tect authors against misleading statements or representations as to authorship of copyright works.⁹

So holding, the *Dastar* Court seemed particularly solicitous of the public domain, reasoning that those who market public domain materials should not be liable under the Lanham Act for providing misleading information about the “origin” of the works’ “intellectual” content. Subsequent cases have not, however, confined the ruling to public domain materials.¹⁰ Whatever protections to the right to claim authorship of one’s works that the Lanham Act formerly provided,¹¹ *Dastar* appears to have diminished them significantly, leaving authors with very limited protection of their Berne Convention right to be named as the authors of their own works.

In this article, I argue that the premises upon which the Court appeared to base its solicitude for the public domain are unsound. To be sure, there are important public benefits in a public domain, but this does not mean that the public always benefits from entirely unimpeded marketing of public domain material. If the public interest in the public domain does not require completely unfettered marketing of products that were once subject to copyright protection, the extension of *Dastar* to works still within their copyright term seems especially problematic. Secondly, I suggest that in *Dastar* the Court missed an opportunity to endorse the relevance of international obligations to the development of U.S. domestic intellectual property law. While the context of the *Dastar* decision made article 6*bis* of the Berne Convention¹² particularly relevant, the sug-

9. The Court recognized, however, that a claim under the Lanham Act would be sustained “if *Dastar* had bought some of New Line’s *Crusade* videotapes and merely repackaged them as its own.” 539 U.S. at 31.

10. *Carroll v. Kahn*, 68 U.S.P.Q. 2d 1357, 1361–62 (N.D.N.Y. 2003); *Williams v. UMG Recordings, Inc.*, 281 F. Supp. 2d 1177, 1185 (C.D. Cal. 2003).

11. The Lanham Act protections were generally limited to *misattribution* of authorship, rather than failure to attribute. A right to be protected against the latter is also included in article 6*bis* of the Berne Convention. See Roberta Rosenthal Kwall, *Copyright and the Moral Right: Is an American Marriage Possible?*, 38 *VAN. L. REV.* 1, 1–3 (1985) (critically assessing the (former) level of protection provided under the Lanham Act).

12. The Court was, as Professor Okediji points out, “very clearly aware” of the Berne Convention. Ruth L. Okediji, *Through the Years: The Supreme Court and the Copyright Clause*, 30 *WM. MITCHELL L. REV.* 1633, 1651 (2004). This is indicated by the citations to the Berne Convention or the BCIA in the briefs: Petitioner’s Brief, 2003 WL 367729, p. 31, n. 27, *Dastar* (No. 02-428); Respondent’s Brief, 2003 WL 1101321, p.22, n.7, *Dastar* (No. 02-428); Petitioner’s Reply, 2003 WL 1610796, p. 13–14; Amicus Briefs: Director’s Guild of America, et al., 2003 WL 1101049, p. 4, 9–11, *Dastar* (No. 02-428); Malla Pollack, et al., 2003 WL 21058263, p. 7, n. 9; United States, 2003 WL 544536, p. 1, 9–11, *Dastar* (No. 02-428). Also, Justice Scalia based part of his analysis on the negative implications of Congress’ enactment of

gestion that public international law obligations provide canons of statutory construction may be of more general significance.

The two arguments are linked. However important the public domain is to intellectual property law and societal welfare generally, if solicitude for the public domain does not demand unimpeded marketing, it also imposes no insurmountable barrier to the idea that section 43(a) of the Lanham Act should, where possible, be interpreted consistently with the international obligation of the United States to protect authors' attribution rights under article 6*bis*. While the Supreme Court is unlikely to revisit the interpretive issue raised in the *Dastar* decision any time soon,¹³ we might hope nevertheless that lower courts could be encouraged to view the *Dastar* decision narrowly in future cases, and to approach future author attribution cases more in line with the public international law obligations this country owes to much of the rest of the world in the copyright field.¹⁴ As a general matter, statutes should be inter-

the Visual Artists Rights Act, Pub. L. No 101-650, tit. VI, 104 Stat. 5089, 5128-33 (1990) (VARA), which enacts moral right protections for works of fine art broadly coextensive with article 6*bis* of the Berne Convention, albeit for a much narrower range of works. *Dastar*, 539 U.S. at 34-35.

13. See *Francis v. S. Pac. Co.*, 333 U.S. 445, 450 (1948) (observing that Supreme Court construction of a statute is "part of the warp and the woof" of legislation); *Flood v. Kuhn*, 407 U.S. 258, 271-285 (1972) (finding a strong presumption of correctness for Supreme Court precedents interpreting statutes). See also Ruth Bader Ginsburg, *An Open Discussion with Justice Ruth Bader Ginsburg*, 36 CONN. L. REV. 1033, 1043 (2004) (discussing *stare decisis* in the context of the Supreme Court revisiting earlier decisions, and observing that "[w]hen it's a matter of statutory interpretation, and the Court has made its best guess at what some dense statute means, we are likely to adhere to that reading. . . . We've said what we thought the statute meant. After that, the ball is in Congress' Court; Congress can change the law, thereby overturning our decision, anytime.")

14. As of November 3, 2004, WIPO Treaties and Contracting Parties lists 157 signatories to the Berne Convention. See <http://www.wipo.int/treaties/en/documents/pdf/e-berne.pdf> (Jan. 19, 2005). Other bodies of public international law may also affect interpretive questions. For example, a number of scholars and agencies have explored the role of international human rights law in the development of both international and domestic intellectual property law. See, e.g., David Weissbrodt & Kell Schoff, *A Human Rights Approach to Intellectual Property Protection: The Genesis and Application of Sub-Commission Resolution 2000/7*, 5 MINN. INTELL. PROP. REV. 1 (2003); Laurence R. Helfer, *Human Rights and Intellectual Property: Conflict or Coexistence*, 5 MINN. INTELL. PROP. REV. 47 (2003). Particularly important for the present context is the statement by the United Nations Committee on Economic, Social, and Cultural Rights that nations should recognize the importance of the integration of international human rights norms into the "enactment and interpretation of intellectual property law" in a way that balances public and private interests in knowledge without infringing on human rights. ESCOR, Comm. on Econ., Soc., and Cult. Rights, 27th Sess., Agenda Item 3, U.N. Doc. E/C.12/2001/

preted consistently with international obligations. In the specific context of *Dastar*, greater cognizance of the Berne Convention obligation under article 6*bis* might have prompted the Court to articulate a narrower rule that did not sweep away the protections to author attribution afforded by section 43(a) for copyright protected works. It could have done this by withholding protection from works that, like the works at issue in *Dastar*, were already in the public domain for the purpose of copyright law.

II.

DASTAR AND THE BERNE CONVENTION RIGHT TO CLAIM AUTHORSHIP

When the United States finally¹⁵ joined the Berne Convention, the first “true” multilateral convention on copyright,¹⁶ in 1988,¹⁷ its obligations included compliance with article 6*bis* which, among other things, announces authors’ right “to claim authorship” to their works.¹⁸ This right is to be protected, “independently of the author’s economic rights, and even after the transfer of the said rights.”¹⁹ At the international law level, article 6*bis* remains one of Berne’s “toothless” obligations. The TRIPs Agreement,²⁰ which added “bite” to Berne by incorporating its substantive articles into the World Trade Organization (WTO) system,²¹ requires compliance

15 (2001) (commemorating a meeting concerning “Human Rights and Intellectual Property”). This work suggests that an increased role for international human rights principles in the development of international intellectual property law might have potential to *constrain* the scope of intellectual property rights. These issues are beyond the scope of this article, however.

15. On the U.S. tardiness in joining the Berne Convention and the reasons for it, see Jane C. Ginsburg & John M. Kernochan, *One Hundred And Two Years Later: The U.S. Joins the Berne Convention*, 13 COLUM.-VLA J. L. & ARTS 1, 1–8 (1988).

16. See Sam Ricketson, *The Birth of the Berne Union*, 11 COLUM.-VLA J. L. & ARTS 9, 9 (1986) (noting that prior to Berne, there had been other multilateral copyright conventions, but that these had been of limited territorial effect).

17. Effective March 1989. See Berne Convention Implementation Act of 1988, Pub. L. No.100-568, 102 Sta. 2853 (1988) [hereinafter BCIA].

18. The 1928 Rome Act of the Berne Convention was the first to recognize the moral rights of authors. See SAM RICKETSON, *THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS: 1888–1986*, 102 (1987).

19. Berne Convention art. 6*bis*.

20. Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, Results of the Uruguay Round vol. 3, 33 I.L.M. 1125, 1201 (1994) (requiring member states to comply with articles 1 through 21 of the Berne Convention (1971)) [hereinafter TRIPs Agreement].

21. Susan Tiefenbrun, *A Hermeneutic Methodology and How Pirates Read And Misread the Berne Convention*, 17 WIS. INT’L L.J. 1, 7 (1999); Laurence R. Helfer, *Adjudi-*

with article 6*bis*, but it excludes 6*bis* from the “rights and obligations” that parties to TRIPs have against each other under the latter instrument.²² Accordingly, trade sanctions or other penalties cannot be imposed under the WTO dispute system for non-compliance with the Berne obligation to protect authors’ attribution right, or the other rights delineated in article 6*bis*.²³

As is well known, the Congress did not enthusiastically embrace the Berne Convention when the United States joined. It adopted some of the Convention’s requirements, such as the removal of formalities, more-or-less fully.²⁴ Other requirements, particularly the moral rights provisions in article 6*bis*, caused greater difficulties.²⁵ The United States declined to enact a new moral rights statute. Instead, adopting a “minimalist” approach²⁶ to the need for implementing legislation,²⁷ the House Committee on the Judiciary, whose report accompanied the Berne Convention Implementation Act of 1988 (BCIA), emphasized that existing state and

cating Copyright Claims under the TRIPs Agreement: the Case for a European Human Rights Analogy, 39 HARV. INT’L L. J. 357, 381 (1998).

22. TRIPs Agreement art. 9.

23. Members of the Berne Convention have the right to adjudicate disputes in the International Court of Justice. No case, however, has been brought using this mechanism. *See* Monique L. Cordray, *GATT v. WIPO*, 76 J. PAT. & TRADEMARK OFF. SOC’Y 121, 131 (1994). Arguably, because the TRIPs Agreement specifically excludes the moral rights provisions in the Berne Convention, the former does not override the latter, with the result that the non-TRIPs-incorporated provisions in the Berne Convention remain outside of the WTO mechanisms for enforcement of rights. The WTO panel in its report in the dispute over compliance with § 110 (5) of the Copyright Act, noted: “In the area of copyright, the Berne Convention and the TRIPs Agreement form the overall framework for multilateral protection. . . . We recall that it is a general principle of interpretation to adopt the meaning that reconciles the texts of different treaties and avoids a conflict between them. Accordingly, one should avoid interpreting the TRIPs Agreement to mean something different than the Berne Convention except where this is explicitly provided for.” WTO Dispute Panel Report, United States, Section 110.5 of the US Copyright Act, at 24, http://www.wto.org/english/tratop_e/dispu_e/1234da.doc; 17 U.S.C. § 110(5). For a different view, *see* Okediji, *supra* note 12, at 1651, n. 113.

24. Ginsburg & Kernochan, *supra* note 15, at 15–16 (questioning whether the strong encouragements for registration for foreign origin works are consistent with the spirit of the Berne Convention). The requirement to take reasonable steps to cure defective notice for publications prior to the effective date of the BCIA remained in effect. *See* Charles Carnier, *Paris v. Andin Int’l, Inc.*, 844 F.Supp 89, 93–94 (D. R.I. 1994).

25. Ginsburg & Kernochan, *supra* note 15 at 27–31.

26. H.R. REP. NO. 100-609, at 7 (1988), *reprinted in* 1988 USCCAN 1037.

27. The Congress concluded that the Berne Convention was not self-executing in the United States. H.R. REP. NO. 100-609 at 28, *See* BCIA, *supra* note 17, § 3(1).

federal laws already afforded authors equivalent protections.²⁸ Specifically mentioned were: state law protections provided by rights of publicity and prohibitions against breach of contract, fraud and misrepresentation, unfair competition, defamation, and federal protections against unfair competition afforded by section 43(a) of the federal Lanham Act.²⁹ Given the existing state of the law, the Committee “[found] that current United States law meets the requirement of article 6*bis*.”³⁰ Under the terms of article 6*bis*, the means of redress for the rights provided “shall be governed by the legislation of the country where protection is claimed.” However desirable a specific moral rights statute might have been,³¹ the United States was not obliged to enact one.³² So emphatic was the Committee that authors could not rely on the government’s joining the Berne Convention for the assertion of moral rights that Congress included precautionary wording in the implementing legislation, stressing that no rights or interests of authors could be

28. It was bolstered in this view by the evidence of the “great majority” of the witnesses testifying before the Subcommittee on Courts, Civil Liberties and the Administration of Justice. H.R. REP. NO. 100-609, at 33. The Committee reported that this view was also shared by the Director General of the World Intellectual Property Organization. *Id.* at 37 & n. 84.

29. *Id.* at 34 (USCCAN 1043); The Committee relied on *Gilliam v. American Broad. Cos.*, 538 F.2d 14 (2d Cir. 1976) in support of this proposition. The Second Circuit recognized that the Lanham Act could provide a legal remedy for authors of the scripts for television programs when the programs were broadcast in such a distorted format that they were arguably no longer the works that the scriptwriters had authored. *Cf. Choe v. Fordham Univ. School of Law*, 920 F.Supp. 44 (S.D.N.Y. 1995), *aff’d* 81 F.3d 319 (2d Cir. 1996) (dismissing Lanham Act claim on the basis that errors in edited version of law review comment did not depart so dramatically from the original work that the plaintiff could no longer be called its “author”).

30. H.R. REP. NO. 100-609, at 38; *see also* Justin Hughes, *American Moral Rights and the Dastar Decision*, (paper delivered at the Fordham University Law School 13th International Intellectual Property Conference, April 1, 2005) (suggesting that the varying approaches of parties to the issue of moral rights both sheds interpretive light on the scope of the Berne Convention obligations and indicates that a “patchwork” approach to moral rights, as was adopted by the United States, might be consistent with those obligations) (paper on file with author) [hereinafter Hughes, *American Moral Rights*].

31. *See* Jane C. Ginsburg, *The Right to Claim Authorship in U.S. Copyright and Trademarks Law*, 41 Hous. L. Rev. 263, 264–67 (2004) (noting the benefits to authors and audiences of broad attribution rights and lamenting the narrow protection for these rights under general U.S. copyright and trademark laws) [hereinafter Ginsburg, *Right to Claim*].

32. H.R. REP. NO. 100-609, at 37 (citing REPORT OF THE WORK OF MAIN COMMITTEE I, Para. 15 in RECORDS OF THE INTELLECTUAL PROPERTY CONFERENCE OF STOCKHOLM (1967) 1134 (W.I.P.O. 1971) for the proposition that “legislation,” as used in the Convention, includes the common law).

claimed outside of domestic law, and that adherence of the United States to the Berne Convention did not in itself expand or reduce any right of an author to claim authorship of the work or to object to a work's derogatory treatment.³³

The *Dastar* litigation was an opportunity to test Congress' faith in the Lanham Act as a source for legal protection of authors' rights. But as others have pointed out, the "unappealing"³⁴ nature of the facts did not present a case in which any claims to moral rights could be examined in their best light. Broadly, the facts were as follows: In 1949, Twentieth Century Fox had Time Inc. produce a documentary series based on then-General Dwight D. Eisenhower's World War II memoir, *Crusade in Europe*. Fox had acquired the television rights from Eisenhower's publisher and had also secured the copyright in the television series. However, Fox failed to renew the copyright registration in the series and the films entered the public domain in 1977. In 1995, defendant Dastar released a set of videos entitled "Campaign in Europe," which substantially copied the original series.³⁵ In its marketing and packaging, Dastar mentioned neither Fox nor the original "Crusade" series. The district court granted summary judgment to Fox on its claim under section 43(a) of the Lanham Act that Dastar's release of the videos under its own name constituted "a false designation of origin" and granted Fox double Dastar's profits, a decision that the U.S. Court of Appeals for the Ninth Circuit affirmed in an unpublished opinion.

33. See H.R. REP. NO. 100-609, at 2-3 (referencing the BCIA, as reported by the Committee on the Judiciary). The relevant provision is codified at 17 U.S.C. § 104(c) (2000): "No right or interest in a work eligible for protection under this title may be claimed by virtue of, or in reliance upon, the provisions of the Berne Convention, or the adherence of the United States thereto. Any rights in a work eligible for protection under this title that derive from this title, other Federal or State statutes, or the common law, shall not be expanded or reduced by virtue of, or in reliance upon, the provisions of the Berne Convention, or the adherence of the United States thereto." See *infra* Part IV.A. Other relevant provisions in the BCIA are as follows: section 2(2), which provides: "The obligations of the United States under the Berne Convention may be performed only pursuant to appropriate domestic law"; section 3(a)(2), which provides: "The provisions of the Berne Convention . . . shall not be enforceable in any action brought pursuant to the provisions of the Berne Convention itself"; and section 3(b)(1), which provides: "The provisions of the Berne Convention . . . do not expand or reduce the right of any author of a work, whether claimed under Federal, State, or the common law . . . to claim authorship of the work."

34. See Ginsburg, *Right to Claim*, *supra* note 31, at 267.

35. The *Dastar* Court characterized this as "nearly wholesale reliance" on the earlier work. 539 U.S. 23, 31 (2003).

The Supreme Court reversed, 8-0 (Justice Breyer recused). In effect, the Court rejected the argument that section 43(a) could be relied on to protect against misattribution of the original creator of a work of authorship in connection with newly made copies of the work that are sold in commerce.³⁶ While the lower courts' decisions had protected Fox rather than the actual maker of the documentary (Time, Inc.), the Court's holding, interpreted broadly, swept away most of the protections against misattribution of the creative content of works of authorship that the Lanham Act was once assumed to provide.³⁷ Subsequent cases have interpreted *Dastar* as holding that section 43(a) can no longer be invoked in attribution claims concerning communicative products.³⁸ Recourse for such claims is now only "available through copyright," if at all.³⁹ Additionally, lower courts appear disinclined to regard as material the fact that the copyright in Fox's television series had expired.⁴⁰ Thus, in the wake of *Dastar*, lower courts have denied Lanham Act claims, regardless of whether copyright still subsists in the relevant communicative products.

Dastar exposes the precarious state of authors' moral rights in United States law that resulted from Congress' decision not to provide express protections for moral rights on joining the Berne Convention. The judicial branch has effectively told the legislative branch that it was wrong to have assumed that the Lanham Act provides federal protection broadly in line with the requirements of article 6*bis* of the Berne Convention. The extent of the Court's departure from Congress' understanding of the scope of section 43(a)

36. The Court recognized that repackaging physical goods would, if likely to give rise to confusion, remain actionable under the Lanham Act. *See id.* The Court also emphasized, however, that "[f]or merely saying it is the producer of the video, however, no Lanham Act liability attaches to *Dastar*." *Id.* at 38.

37. *See, e.g.,* Smith v. Montoro, 648 F.2d 602, 606-07 (9th Cir. 1981) (holding that a film company would be liable for substituting one actor's name for another); Johnson v. Jones, 149 F.3d 494, 503 (6th Cir. 1998) (holding architect liable for substituting his name for the true author of the plans). *See generally*, Roberta Rosenthal Kwall, *The Attribution Right in the United States: Caught in the Cross-fire Between Copyright and Section 43(A)*, 77 WASH. L. REV. 985 (2002).

38. Carroll v. Kahn, 68 U.S.P.Q.2d 1357, 1361-62 (N.D.N.Y. 2003).

39. Williams v. UMG Recordings, Inc., 281 F. Supp. 2d 1177, 1185 (C.D. Cal. 2003).

40. *See Carroll v. Kahn*, 68 U.S.P.Q.2d at 1361-62 (holding, with respect to a copyrighted work, that "[a] Lanham Act claim based on Defendants' alleged failure to give Plaintiff proper credit as author and/or producer . . . is foreclosed by *Dastar*"); Williams v. UMG Recordings, Inc., 281 F. Supp. 2d 1177, 1185 (C.D. Cal. 2003) (reasoning that "the Supreme Court's holding did not depend on whether the works were copyrighted or not").

may be tested by asking whether, had *Dastar* pre-dated the Berne Convention Implementation Act, Congress could have claimed that section 43(a) was among those parts of American law establishing that the article 6*bis* rights were already sufficiently protected. Had *Dastar* come first, such an assertion would have seemed disingenuous at best.

III. IMPEDIMENTS TO A MORE "BERNE-CONSISTENT" INTERPRETATION?

Before considering whether there might be a greater role for the Berne Convention in the construction of section 43(a) of the Lanham Act, it is necessary to address whether an interpretation that is more consistent with the Berne Convention is a "possible" construction.⁴¹ Canons of statutory construction provide only a basis for choosing among available interpretations of a statute under consideration. Clear words mandating a contrary interpretation can remove the choice.⁴² Accordingly, it becomes necessary to evaluate the reasons underlying the *Dastar* Court's interpretation of the section to assess whether they impose insurmountable barriers to a more "Berne-consistent" interpretation.

Even if Justice Scalia, who authored the *Dastar* opinion, had wanted to adopt an interpretation of section 43(a) of the Lanham Act that was consistent with the Berne Convention, it seems unlikely that he would have regarded this approach as an "available" construction. First, he identified practical impediments to such an interpretation: with many creative works there may be a number of people or entities who could claim to be the "origin" of the intellectual aspects of the products. Secondly, he identified legislative policy impediments: author attribution claims would impede the policy favoring unfettered marketing of public domain materials. They would also conflict with the narrow attribution right Congress pro-

41. See, e.g., *Edison Bros. Stores, Inc. v. Broadcast Music, Inc.*, 954 F.2d 1419 (8th Cir. 1992), where the Court of Appeals for the Eighth Circuit rejected an argument that it should look beyond the clear statutory text (17 U.S.C. § 110(5)) and interpret sections of the Copyright Act 1976 in the light of the Berne Convention.

42. NORMAN J. SINGER, 2A STATUTES AND STATUTORY CONSTRUCTION § 46:04 (6th ed. 2004) ("[C]ourts are bound to give effect to the literal meaning without consulting other indicia of intent or meaning when the meaning of the statutory text itself is 'plain' or 'clear and unambiguous.'").

vided authors of works of fine art under the Visual Artists Rights Act of 1990 (VARA).⁴³

A. *Practical Limitations—Too Many Authors*

Section 43(a) of the Lanham Act provides a civil cause of action for a party who believes she is likely to be damaged by the use in commerce of “any false designation of origin.”⁴⁴ According to Justice Scalia, one reason the word “origin” in the Act means only the physical source of a product, rather than the source of the product’s intellectual content, is that there are no discernible limits to help distinguish between the potentially large number of parties who might claim to be an “originator” of the product’s intellectual content. To illustrate the point, he referred to the MGM film “Carmen Jones,” an example that was also discussed during oral argument.⁴⁵

Reading “origin” in § 43(a) to require attribution of uncopyrighted materials would pose serious practical problems. Without a copyrighted work as the basepoint, the word “origin” has no discernible limits. A video of the MGM film *Carmen Jones*, after its copyright has expired, would presumably require attribution not just to MGM, but to Oscar Hammerstein II (who wrote the musical on which the film was based), to Georges Bizet (who wrote the opera on which the musical was based), and to Prosper Mérimée (who wrote the novel on which the opera was based).⁴⁶

If we assume, as the Court appeared to,⁴⁷ that some consumers really are concerned about the “origins” of a work’s intellectual content, is it necessary to preclude all legal protection against possible confusion because there may be a number of potential candidates for the “originator” of that content? Even with “non-intellectual” goods and services, few (if any) trademarks provide full

43. Visual Artists Rights Act of 1990 § 603, 17 U.S.C. § 106A (2000).

44. 15 U.S.C.A. § 1125. The statute is quoted *supra* note 8.

45. Supreme Court Oral Argument, 2003 WL 1876459 at 38, *Dastar*, (No. 02-428).

46. 539 U.S. at 35.

47. Distinguishing between tangible goods and “communicative products,” the Court recognized that for consumers a communicative product might be valued “not primarily for its physical qualities, such as a hammer, but for the intellectual content that it conveys, such as a book or, as here, a video.” 539 U.S. at 33. The Court did not explore the implications of these suppositions about consumer responses. Instead, Justice Scalia’s opinion turned immediately to issues of legal policy.

information about the source of the product.⁴⁸ “Klondike” works as a trademark for ice-cream products, even if it discloses little about those responsible for the product.⁴⁹ For consumers, trademark law’s single anonymous source principle means that “Klondike” signals “those nice people (whoever they might be) whose ice-cream I’ve enjoyed before (or whose advertising messages I’ve absorbed).” Exactly what the consumer responds to most readily—“Quaker Oats” or “Trix”? “White Strips” or “Crest” (or both)?—often depends on branding and marketing strategies that determine which brand is emphasized in advertising campaigns. Consumers can derive a lot of useful “trademark information” even if the information they receive doesn’t say everything there is to say about the source of the physical product. The Lanham Act protects against misleading conduct in trade, even though trademark proprietors’ appellations of origin do not provide entirely accurate or comprehensive information.

Some of the information that consumers glean about the “origins” of “intellectual” products is of the same character. Even in reverse passing off cases, where the defendant markets the plaintiff’s product as her own, there needs to be a likelihood of confusion,⁵⁰ which seems also to require that the author’s name at least be recognizable in the marketplace. Suppose I wanted to purchase Senator Hillary Rodham Clinton’s autobiography, *Living History*.⁵¹ I might assume that Senator Clinton had help: a small army—a “village,”⁵² perhaps?—of assistants may have worked on the text, contributing ideas, additional text, editorial work and so on. Her publisher doubtless also had considerable input into the final product that hit bookstands with such éclat in the summer of 2003. There were also photographers, designers, type-setters, and so on.⁵³ Nevertheless, I am likely to be far more interested in the name “Hillary Rodham Clinton” than in the names of research assistants, copy editors, and photographers. The name, “Hillary Rodham Clinton,”

48. Indeed, it is axiomatic that the *less* descriptive a mark is, the stronger it will be. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976).

49. The Klondike brand is marketed by Good-Humor-Breyers. See www.icecreamusa.com (last visited Feb. 13, 2005).

50. See, e.g., *Harlem Wizards Entm’t. Basketball, Inc. v. NBA Properties, Inc.*, 952 F. Supp. 1084, 1091 (D.N.J. 1997).

51. HILLARY RODHAM CLINTON, *LIVING HISTORY* (2003).

52. HILLARY RODHAM CLINTON, *IT TAKES A VILLAGE, AND OTHER LESSONS CHILDREN TEACH US* (1996).

53. Senator Clinton graciously acknowledges the assistance of many individuals. CLINTON, *LIVING HISTORY*, *supra* note 51 at 533–38.

used on the book cover and in the publicity for the book, seems to be signifying for consumers something really quite important about the intellectual “origin” of the book (and, of course, in this instance, it also tells us something about the book’s contents). In book markets, it operates like a trademark.⁵⁴ If, despite the contribution of others to the final book “product,” the name “Hillary Rodham Clinton” provides consumers with some useful information, this would seem to contest the inference drawn from Justice Scalia’s analysis that the usefulness of an appellation of origin is completely negated when it doesn’t convey to consumers all that can be said about intellectual contributions to the final product.

Consider again the *Carmen Jones* example: there is likely no absolute measure of which pieces of information about the intellectual origins of the work might be relevant in a trademark sense. The name “Oscar Hammerstein II” doubtless does operate in this way for many consumers, due to the extraordinary fame he achieved. To update the example a little, had Jonathan Larsen, author of the Broadway musical *Rent*, lived long enough to produce new works, his name might have become, like Oscar Hammerstein II, particularly relevant to consumers’ future theatre-going decisions, even though many others have contributed to the final shape of the musical. Sadly, after Larson’s death, we are quite likely to see future works marketed under the banner, “From the producers who brought you *Rent*.” *Rent* itself was heavily influenced by Giacomo Puccini’s Opera, *La Boheme*. But this does not mean that Larsen, Puccini, or Henry Murger, author of *Scenes de la vie de Boheme*, on which Puccini’s opera was based, should all necessarily be candidates for protection under the Lanham Act. Whether any of these “authors” will be protected should depend on the associations that have been built up in the minds of consumers between the names and the product, associations that result from decisions made by those responsible for marketing *Rent*. Unless and until those who assisted Mrs. Clinton with her “product” become famous in their own right, the name “Hillary Rodham Clinton” will be quite sufficient for my book-buying decisions.

This analysis perhaps goes some way to answer Justice Scalia’s more general concerns arising from perceived difficulties with identifying the intellectual “origins” of the *Crusade in Europe* television series:

54. See generally Mary LaFrance, *Authorship, Dominance, and the Captive Collaborator: Preserving the Rights of Joint Authors*, 50 EMORY L.J. 193 (2001) (discussing the difference between “authorship” and “proper attribution” claims).

While Fox might have a claim to being in the line of origin, its involvement with the creation of the television series was limited at best. Time, Inc., was the principal if not the exclusive creator, albeit under arrangement with Fox. And of course it was neither Fox nor Time, Inc., that shot the film used in the Crusade television series. Rather, that footage came from the United States Army, Navy, and Coast Guard, the British Ministry of Information and War Office, the National Film Board of Canada, and unidentified “Newsreel Pool Cameramen.” If anyone has a claim to being the *original* creator of the material used in both the Crusade television series and the Campaigns videotapes, it would be those groups, rather than Fox. We do not think the Lanham Act requires this search for the source of the Nile and all its tributaries.⁵⁵

Protection under the Lanham Act need not be all or nothing. For consumers, it might be the river, or it might be one or more of the tributaries that are important. This does not follow from any abstract or fundamental truth about the “real” author. What is relevant depends on past marketing practices and other ways that goodwill attaches to intellectual products.

On the facts of *Dastar*, it may well have been correct to assume that the various appellations of origin at issue did not provide very much trademark information. But surely whether various signs actually do signify the “origins” of an intellectual product is largely a question of fact. The Court went further than was necessary to suggest that none could.

B. Policy Constraints—Too Many Rights

The Court also reasoned that imposing impediments sourced in the Lanham Act on the marketing of a video that had fallen into the public domain would conflict with policies articulated in a number of leading Supreme Court cases emphasizing the right to copy public domain materials.⁵⁶ This concern is most often invoked in the patents context: it is based on the idea that functional products (or aspects of products) that do not achieve the standard for inven-

55. *Dastar*, 539 US at 35–36.

56. *Id.* at 33–34. The Court cites: *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 230 (1964); *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111 (1938); *TraFFix Devices, Inc. v. Marketing Displays, Inc.* 532 U.S. 23 (2001); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989).

tiveness in patent law are not removed from the public domain through other kinds of legal protections.⁵⁷

Granted, once a patent has expired, the right to make the product, “including the right to make it in precisely the shape it carried when patented,” passes to the public.⁵⁸ But this does not necessarily mean that no legal constraints may be imposed on copiers’ marketing activities. This is illustrated by *Kellogg Co. v. National Biscuit Co.*⁵⁹ Although the *Dastar* Court cited *Kellogg* for the free copying point, this is not the complete holding of the case.⁶⁰ The Court did not give Kellogg *carte blanche* to market shredded wheat biscuits after National Biscuit’s patent had expired. Kellogg was required to market its product “fairly.” The Court continued: “Fairness requires that it be done in a manner which reasonably distinguishes its product from that of plaintiff,”⁶¹ a restriction that apparently did not conflict with the general principle that products whose patents had expired should be consigned to the public domain.

Unfair competition doctrines, including section 43(a) of the Lanham Act, do not in themselves negate the efficacy of other branches of intellectual property, such as patent law. They serve different purposes. A key purpose of trademark law relates to the public’s interest in avoiding marketplace confusion.⁶² Occasionally, Congress carves out areas where unfair competition laws and other intellectual property systems cannot coexist, such as the prohibition against trademark rights subsisting in functional aspects of products.⁶³ Much of the time, however, the two branches of law live rela-

57. Cf. F. Scott Kieff, *Contrived Conflicts: The Supreme Court Versus the Basics of Intellectual Property Law*, 30 WM. MITCHELL L. REV. 1717, 1722–26 (2004) (questioning the validity of such policy concerns).

58. *Stiffel*, 376 U.S. at 230.

59. 305 U.S. at 111.

60. See also Graeme B. Dinwoodie, *The Seventh Annual Honorable Helen Wilson Nies Memorial Lecture in Intellectual Property Law: The Trademark Jurisprudence of the Rehnquist Court*, 8 MARQ. INTELL. PROP. L. REV. 187, 204 (2004) (noting that the right to copy a work that has fallen out of the public domain is expressly conditioned on the defendant not mislabeling it) [hereinafter Dinwoodie, *Trademark Jurisprudence*].

61. *Kellogg*, 305 U.S. at 120. See also *Blinded Veterans Ass’n v. Blinded Am. Veterans Found.*, 872 F.2d 1035, 1043 (D.C. Cir. 1989) (picking up on the *Kellogg* analysis in the trademark context and emphasizing that a subsequent competitor may not “pass[] itself or its product off as the first organization or its product”).

62. See Ginsburg, *Right to Claim*, *supra* note 31, at 269–70.

63. For instance, section 43(a)(3) of the Lanham Act provides that “[i]n a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection

tively comfortably together.⁶⁴ Indeed, the Court has recognized that some of the requirements that states may impose on the marketing of goods under such circumstances in order to avoid confusion are not preempted.⁶⁵

More generally, in many contexts there are clusters of extra-patent restrictions on marketing of products, such as safety standards for pharmaceuticals, with which patent owners and those who market generic products alike must comply.⁶⁶ Restrictions on the marketing of goods—whether protected by patents or not—do not in themselves undermine the integrity of the patent system. Although there may be a public interest in the public domain status of things that were once protected by intellectual property rights, in reality that public interest is seldom equated with the removal of all marketing restrictions. Returning to the specific *Dastar* context, the premise that the public domain is good for the public does not lead inexorably to the conclusion that the public is also well served by misleading information about authorship being affixed to public domain material.⁶⁷

Moreover, the specific issue in *Dastar* did not arise in a context where there is much evidence of a congressional concern that legal protections should not trespass on the public domain. Compare this to the congressional deliberations on copyright protection for artistic works under the 1976 Copyright Act, which expanded the 1909 Act's more limited protection to works of fine art.⁶⁸ There was a deliberate attempt in the design context to craft legislation that protects three dimensional and other artistic works under the Copyright Act, but which avoids according protection under copyright

has the burden of proving that the matter sought to be protected is not functional." 15 U.S.C. § 1125(a)(3) (2004).

64. See, e.g., *Frederick Warne & Co. v. Book Sales, Inc.*, 481 F.Supp. 1191, 1196 (S.D.N.Y. 1979) (declining to hold that as a matter of law Lanham Act protection is precluded for copyright material that has fallen into the public domain and recognizing that trademark and copyright protection can "co-exist, and possibly . . . overlap").

65. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989).

66. A number of different regimes impact on the "freedom" to market public domain goods. See, e.g., Fair Packaging and Labeling Act, 15 U.S.C. §§ 1451–1461 (2004); The Federal Food, Drug, and Cosmetic Act 21 U.S.C. §§ 301–99 (2004); the Federal Hazardous Substances Labeling Act 15 U.S.C. §§ 1261–78 (2004).

67. See Ginsburg, *Right to Claim*, *supra* note 31, at 270.

68. S. REP. NO. 94–473 (1975); H.R. CONF. REP. NO. 94–1733 (1976); P.L. 94–553 (1976) (codified as amended at various sections of 17 U.S.C. (2000)); see PAUL GOLDSTEIN, COPYRIGHT § 2.15.1–2 (Supp. 2005) (noting the concerns about preventing the 1976 Copyright Act from protecting "functional" work and discussing the close-grained distinctions the Act makes).

law that clashes with the patent system. Rightly or wrongly,⁶⁹ these expressions of legislative policy continue to influence judicial exegesis of statutory standards.⁷⁰ There is no equivalent analysis in the congressional record suggesting that it is inappropriate to afford protections under the Lanham Act against deceptive or misleading uses of appellations of origin where those appellations are affixed to (or are)⁷¹ material that might be protected under other intellectual property statutes.

The *Dastar* Court also reasoned that requiring attribution of the originator of products' intellectual content would conflict with the "carefully limited and focused" right of attribution contained in the Visual Artists Rights Act of 1990.⁷² The attribution right under VARA attaches only to specified "work[s] of visual art,"⁷³ and is personal to the artist.⁷⁴ The Court reasoned: "Recognizing in § 43(a) a cause of action for misrepresentation of authorship of noncopyrighted works (visual or otherwise) would render these limitations superfluous. A statutory interpretation that renders another statute superfluous is of course to be avoided."⁷⁵ But this reads too much into VARA's limitations, particularly when consid-

69. "Why a court should repair to the legislative history is unclear; the second circuit did not identify any ambiguity in §101 that needed to be resolved The Supreme Court does not permit the use of legislative history to alter, as opposed to elucidate, a statutory text." *Pivot Point Int'l, Inc. v. Charlene Prods., Inc.*, 170 F. Supp. 2d 828, 833 (N.D. Ill. 2001).

70. *Pivot Point Int'l, Inc. v. Charlene Products, Inc.*, 372 F.3d 913, 919 (7th Cir. 2001).

71. See *Comedy III Prods., Inc. v. New Line Cinema*, 200 F.3d 593, 596 (9th Cir., 2000).

72. The Court explained:

The Visual Artists Rights Act of 1990, § 603(a), 104 Stat. 5128, provides that the author of an artistic work "shall have the right . . . to claim authorship of that work." 17 U.S.C. § 106A(a)(1)(A). That express right of attribution is carefully limited and focused: it attaches only to specified "work[s] of visual art," § 101, is personal to the artist, §§ 106A(b) and (c), and endures only for "the life of the author," § 106A(d)(1).

Dastar 539 U.S. at 34–35, (citing Visual Artists Rights Act of 1990, s. 603, 17 U.S.C. s. 106A (2000)).

73. *Dastar*, 539 U.S. at 34.

74. See Hughes, *American Moral Rights*, *supra* note 30 (noting divergences between VARA and the Berne Convention, art. 6*bis*).

75. *Id.* at 35 (citations omitted). Petitioner's Brief took these points further, arguing that protections under the Lanham Act should be limited by negative inference from the prohibitions against removal or alteration of "the name of, and other identifying information about, a writer, performer, or director who is credited in the audiovisual work" that were added to the Copyright Act 1976 by the Digital Millennium Copyright Act, 17 U.S.C., § 1202(b) and (c)(5) (2000). Petitioner's Brief at 31, *Dastar* (No. 02–428).

ered in the light of congressional deliberations on the implementation of Berne Convention obligations. As we have seen, Congress believed that protection for moral rights was already sufficiently secured under American law when the United States joined the Berne Convention and enacted the BCIA. It seems peculiar, then, to infer a basis for denying all authors the benefits of a different statutory basis for requiring acknowledgement of authorial input (where actual authorial input coincides with consumer recognition) from a subsequent statute that actually enhances rights of attribution.⁷⁶

To be sure, some courts have interpreted VARA's legislative history, particularly its "narrow definition of works of visual art,"⁷⁷ as evidence of an intention to "avoid conflict with other aspects of the Copyright Act, specifically sections applicable to movies and videos."⁷⁸ However, it is more difficult to credit the Lanham Act with generating much "conflict," given Congress' claims of consistency between the Lanham Act and the Berne Convention at the time of the latter's implementation. Congress specifically provided that neither "adherence to the Convention nor the implementing legislation expands *or reduces* any rights under federal, state, or common law to claim authorship of a work or to object to any distortion, mutilation, or other modification of a work."⁷⁹ Given that explicit—and elaborate—admonition, perhaps we should not so readily assume that Congress *impliedly* reduced the authors' protections under the Lanham Act with the passage of VARA. After all, VARA is itself a statute meant to *enhance* some authors' rights of attribution under copyright law. And the relatively narrow range of works to which VARA applies (it does not apply to musical or literary works, for example) suggests that it was not meant to obliterate many of the Lanham Act protections Congress explicitly recognized at the time of the BCIA.

Where there is a specific exception or defense that accompanies the expansion of rights, the analysis might be different. Prior

76. The Amici Brief filed by the Directors Guild of America, Writers Guild of America (East), Writers Guild of America, West, Inc. and Screen Actors Guild, Inc. made the point that "Congress expressly endorsed the interplay between the Lanham Act and federal copyright protections with respect to creative works when implementing the Berne Convention." Brief Amici Curiae of the Directors Guild of America et al. at 5, *Dastar* (No. 02-048).

77. *Carter v. Helmsley-Spear, Inc.*, 71 F.3d 77, 84 (2d Cir. 1995).

78. *Phillips v. Pembroke Real Estate, Inc.*, 288 F. Supp. 2d 89, 98 (D. Mass. 2003) (citing H.R. REP. NO. 101-514, at 9 (1990)).

79. Berne Convention Implementation Act of 1988, Pub.L. No. 100-568, 102 Stat. 2853, § 22, 3 (1988). See also *Carter* 71 F.3d at 83.

to the passage of the Architectural Works Copyright Protection Act of 1990, architectural works received limited copyright protection due to their characterization as “useful articles.”⁸⁰ Congress excluded from the new category of copyright protection for architectural works that are ordinarily visible from a public place “the right to prevent the making, distributing, or public display of pictures, paintings, photographs, or other pictorial representations of the work.”⁸¹ Given this legislative history, the Ninth Circuit was probably correct in a recent case to adopt a fairly robust approach to what constituted an architectural work, in the light of a deliberate “carve out” for publicly visible two dimensional depictions of architectural works.⁸² But the Ninth Circuit was dealing with a different kind of legislative history from the history that was relevant to the issue before the *Dastar* Court. The *Dastar* Court, nevertheless, divined from VARA⁸³ an *implicit* limitation on protections afforded by the Lanham Act.

IV. THE BERNE CONVENTION AS A CANON OF CONSTRUCTION

If the interpretive and policy concerns that underscored the Court’s approach in *Dastar* did not dictate the analysis that the Court adopted, then an interpretation of the Lanham Act that is more consistent with article 6*bis* of the Berne Convention may not be precluded. The interpretive question arose in *Dastar* because of

80. See PAUL GOLDSTEIN, COPYRIGHT § 2.15.1, at 2:183 (2d ed. 2005). Architectural plans were protected prior to the passage of the 1990 statute, as graphical works. 1 Nimmer on Copyright, § 2.08[D][2][a], at 2–117. Following the passage of the 1990 Act, architectural plans have two bases of protection: as architectural works, and as “pictorial, graphical and sculptural” works. See Pub.L. No 100-568, § 4 (a)(1)(A), 102 Stat. 2853 (1988) (codified at 17 U.S.C. § 101 (2000)).

81. 17 U.S.C. § 120 (2000).

82. *Leicester v. Warner Bros.*, 232 F.3d 1212 (2001) (characterizing a faux streetscape that was incorporated into the overall framework of the building as an architectural work for the purposes of the statutory exception for two-dimensional depictions).

83. Some limitations on copyright owners’ rights are sufficiently obvious that they do not always need to be expressed. In *Quality King Distribs., Inc. v. L’Anza Research Int’l Inc.*, 523 U.S. 135 (1998), the Supreme Court supported its conclusion that the importation right in 17 U.S.C. § 602(a) was subject to the first sale doctrine on the basis that if the importation right operated independently of other exclusive rights of the copyright owner, only the latter would be subject to other established defenses, such as the fair use defense in 17 U.S.C. § 107. *Quality King Distribs., Inc.*, 523 U.S. at 146–49. Such a result would be anomalous, as the Court recognized. See *id.* at 151.

perceived ambiguities in section 43(a) as to its application to misleading information about the intellectual origins of works of authorship. In cognate jurisdictions, courts quite often refer to relevant international obligations to assist with the resolution of statutory ambiguities.⁸⁴ This is not so typical of the American system.⁸⁵

A. *The Berne Convention in U.S. Case Law*

The Supreme Court last Term in *F. Hoffman-La Roche Ltd. v. Empagran*⁸⁶ approached the interpretation of the Foreign Trade Antitrust Improvements Act of 1992⁸⁷ on the basis that Congress should be assumed to have acted consistently with customary rules of international law concerning the comity of nations and not to have intended to legislate extraterritorially.⁸⁸ In *Dastar*, the Court acknowledged no similar assumptions arising from *express* public international law obligations. The Berne Convention is not mentioned in the *Dastar* opinion, and received only scant attention in oral argument. Counsel for the United States, which had *amicus* status in the litigation, was dismissive of the Convention's relevance, emphasizing provisions in the Berne Convention Implementation Act that appeared to promise no change in the law as a result of the implementing legislation.⁸⁹

84. See generally Gibran van Ert, *Using Treaties in Canadian Courts*, 38 CAN. YEAR-BOOK INT'L L. 3, 29–30 (2000).

85. See generally Steinhardt, *supra* note 2. However, as Professor Edward Lee discusses in an exhaustive and path-breaking analysis, there is a growing tendency among some U.S. judges to look to foreign law to assist in the development of American jurisprudence. Professor Lee describes this development as creating a new interpretive canon. Edward Lee, *The New Canon: Using or Misusing Foreign Law to Decide Domestic Intellectual Property Claims*, 46 HARV. INT'L L.J. (2005). See, e.g., *Roper v. Simmons*, 125 S. Ct. 1183 (2005), in which the Court cited a number of public international law instruments, including the UN Convention on the Rights of the Child (not ratified by the U.S.) in support of its holding that imposing the death penalty on people who were under the age of 18 years when their crimes were committed, was unconstitutional.

86. 124 S. Ct. 2359 (2004).

87. *Empagran* also concerned the extraterritorial scope of the Sherman Act. *Id.*

88. *Id.* at 2366–67.

89. Despite the express obligations to provide authors with the right of attribution in article 6*bis* of the Berne Convention, the United States persisted with the argument that it was meant to have no impact on domestic law, as is indicated by the following exchange between the Court and Counsel for the United States:

QUESTION: Mr. Garre, before you finish, there was a reference in your brief that I didn't follow. It cropped up in another brief too, and it had – it was a reference to the Berne Convention. Could you – what is the relevance of that

The *Dastar* Court's silence on the potential relevance of the Berne Convention is fairly typical of U.S. case law in the intellectual property area. The Berne Convention has not generally been viewed by U.S. courts as a source of legal principles or ideas that might be invoked to shape or influence domestic copyright jurisprudence. Rather, its role in this jurisprudence is generally much more confined. For example, a large group of cases simply confirm that the BCIA relaxed the formalities and notice requirements under U.S. copyright law.⁹⁰ Occasionally, courts have needed to remind litigants that these changes were meant to be taken seriously. A district court in Louisiana had to endure the argument that defective copyright notice had the effect of resurrecting pre-BCIA forfeiture provisions.⁹¹ And a district court in Pennsylvania needed to confirm that "copyright notice is no longer a prerequisite to copyright protection for works published after March 1, 1989."⁹² For the most part, however, these cases only mention the BCIA in passing, identifying it as the source for these changes to U.S. domestic copyright law.⁹³ Similar recitations of the legislative history feature in architectural copyright cases, which note that the clarification of

international treaty to this – to this case? MR. GARRE: May I answer that question? QUESTION: Briefly. MR. GARRE: It is relevant in that it's an international convention that – that covers copyrights, but we explain in our brief it – we don't think that it affects the analysis in this case because it – as – as the Berne Convention Implementation Act states, it doesn't expand or reduce existing rights under – under domestic law. QUESTION: Thank you Mr. Garre.

Dastar, Supreme Court Oral Argument, 2003 WL 1876459 at 24 (April 2, 2003). Both of the principal parties' Supreme Court briefs presented conflicting arguments as to whether Berne should influence the Court's reasoning. Respondants noted legislative history pointing toward Congress' specific intent that 43(a) function to meet the United States' "minimum requirements of the moral rights provision at least insofar as . . ." 43(a) would give rise to a claim by the actual author where the work is attributed to another author. Respondents' Brief at 22, n.7 *Dastar* (No. 02-428). In its Reply, *Dastar* also invoked legislative history to argue that Berne should not be used to aid the Court's interpretation of the Lanham Act. Petitioner's Reply Brief at 13–14, n.8 (No. 02-048).

90. See, e.g., *Qualey v. Caring Center of Slidell*, Civ.A.No.95-1360, 1996 WL 3915 (E.D. La Jan. 3, 1996); *Master Sound Int'l, Inc. v. PolyGram Latino U.S.*, 52 U.S.P.Q.2d 1060, 1062 (S.D.N.Y. 1999); *Bridge Publ'ns, Inc. v. F.A.C.T.Net, Inc.*, 183 F.R.D. 254, 262 (D. Co. 1998); *Piaggio & C.S.P.A. v. Scooterworks USA, Inc.*, 1999 WL 674749, *5 (N.D. Ill.).

91. *Qualey v. Caring Center of Slidell*, No. 95–1360, Slip. Op. at 2 (E.D. La Jan. 3, 1996).

92. *Mike Rosen & Assocs., P.C. v. Omega Builders, Ltd.*, 940 F. Supp. 115, 119 (E.D. Pa. 1996).

93. See, e.g., *Cordon Holding B.V. v. Northwest Publ'g Corp.*, 2002 WL 530991, at *8 (S.D.N.Y. Apr. 8, 2002) (narrating the changes made to U.S. domestic law following enactment of implementing legislation).

copyright for architectural copyrights was itself a response to requirements under the Berne Convention,⁹⁴ and discussions of the international provenance of the ideas informing domestic legislation often feature in cases arising under VARA.⁹⁵

Another group of cases concerns the somewhat obvious point that the Berne Convention was not meant to provide an independent cause of action outside the Copyright Act. This was confirmed by the BCIA, which expressly provides that the Convention is not self-executing. One example, notorious among publishers of law reviews, is *Choe v. Fordham Univ. School of Law*, a case brought by a law student who was disgruntled about a journal's alleged "mutilation" of his Comment.⁹⁶ The plaintiff claimed that article 6*bis* conferred a right of action in federal court for breach of moral rights. The District Court for the Southern District of New York dismissed the claim, pointing out that the Berne Convention provides no domestically-enforceable causes of action.⁹⁷ The teaching of *Choe* is not always heeded, however. As late as 2003, a U.S. district court again needed to instruct litigants that the Berne Convention is not self-executing, and "cannot be used to support a separate copyright claim" outside of the rights accorded by domestic U.S. copyright law.⁹⁸

Some intriguing variations on the argument that the Berne Convention itself might give rise to an independent cause of action occasionally come before U.S. courts. For example, a foreign plaintiff invoked the Convention as providing a basis for a district court's subject matter jurisdiction over infringements occurring in foreign

94. See, e.g., *John G. Danielson, Inc. v. Winchester-Conant Properties, Inc.*, 186 F.Supp.2d 1, 9–10 (D. Mass. 2002) (tracing the recent history of architectural copyrights); *Zitz v. Pereira*, 119 F. Supp. 2d 133, 147 (E.D.N.Y. 1999) (same); *Leicester v. Warner Bros.*, 47 U.S.P.Q.2d 1501 (C.D. Cal.), aff'd, 232 F.3d 1212 (9th Cir. 2000) (same).

95. See *Generally Cort v. St. Paul Fire and Marine Ins. Cos., Inc.*, 311 F.3d 979, 985 (9th Cir. 2002). See *Martin v. City of Indianapolis*, 192 F.3d 608, 611 (7th Cir. 1999); *Phillips v. Pembroke Real Estate, Inc.*, 288 F. Supp. 2d 89, 97 (D. Mass. 2003); *Shaw v. Rizzoli Int'l. Publ'ns. Inc.*, 51 U.S.P.Q.2d 1097, 1104 (S.D.N.Y. 1999).

96. *Choe v. Fordham Univ. School of Law*, 920 F. Supp 44 (1995).

97. *Id.* at 49.

98. *Rodriguez v. Casa Salsa Rest.*, 260 F. Supp. 2d 413, 422 (D. P.R. 2003); See also *Leutwyler v. Royal Hashemite Court of Jordan*, 184 F. Supp. 2d 303, 306 n.2 (S.D.N.Y. 2001) (dismissing withdrawn claim for "copyright infringement under international law, in violation of the Berne convention"); *Carell v. Shubert Org., Inc.*, 104 F.Supp.2d 236, 258–59 (S.D.N.Y. 2000); *Quantitative Fin. Software Ltd. v. Infinity Fin. Tech.*, 47 U.S.P.Q.2d 1764, 1766 (S.D.N.Y. 1998).

territories.⁹⁹ The District Court for the Southern District of New York dismissed the claim, holding that “[n]either the Berne Convention Implementation Act nor the Berne Convention confers subject matter jurisdiction to entertain an action asserting copyright infringement outside of the United States.”¹⁰⁰ In 1996, in *Hoopla Sports & Entertainment, Inc. v. Nike, Inc.*¹⁰¹ the District Court for the Northern District of Illinois also dismissed as “nonexistent” a claim based on the Berne Convention,¹⁰² where a plaintiff had pleaded the Berne Convention as a “fallback” in case the court invalidated its copyright registrations.¹⁰³ The plaintiff’s theory was that, if its registrations were invalidated, it could challenge the distinction between the pre-suit registration requirements for U.S. and foreign authors, on the basis that requiring only U.S. authors to register their works violated the equal protection clause of the Fourteenth Amendment.¹⁰⁴ The court dismissed the parts of the complaint based on the Berne Convention and side-stepped this (decidedly convoluted) theory by invoking the rule that when considering a motion to dismiss, allegations of fact, including assertions of the validity of copyright registrations, are assumed to be true.

Very occasionally, though, U.S. case law provides instances of a court’s deliberate attempt to shape domestic jurisprudence in ways that are sensitive to the specific provisions and structure of the Berne Convention. A relatively early example is *Birnbaum v. United States*,¹⁰⁵ where the Second Circuit relied on the Berne Convention’s definition of publication¹⁰⁶ to reject an argument that reading of private mail effected a divestive publication. This decision predated accession to the Berne Convention by some ten years.

Private international law is another context in which the Berne Convention is accorded more substantive significance. Unlike in some other cognate jurisdictions,¹⁰⁷ the U.S. Copyright Act is silent

99. Some courts have recognized that subject matter jurisdiction may exist under such circumstances according to *domestic* law conflicts principles. *See, e.g.,* *London Film Prods. Ltd. v. Intercontinental Communications, Inc.*, 580 F. Supp. 47, 49–50 (S.D.N.Y. 1984).

100. *Quantitative Financial Software Ltd. v. Infinity Financial Tech.* 47 U.S.P.Q. 2d 1764, 1766 (S.D.N.Y. 1998).

101. 947 F. Supp. 347 (N.D. Ill 1996).

102. *Id.* at 355.

103. *Id.*

104. *Id.*

105. 588 F.2d 319 (2d Cir. 1978).

106. *Id.* at 327.

107. *E.g.,* the U.K. Copyright Act, in section 16, specifies that the enumerated infringements must be committed “in the United Kingdom.” Copyright, Designs and Patents Act 1988, Ch. 48 § 16 (1) (U.K.).

on the territorial reach of most of its provisions.¹⁰⁸ Private international law questions are largely matters of federal common law.¹⁰⁹ The Berne Convention's national treatment principle has been invoked for the proposition that U.S. copyright law is indeed territorially confined, notwithstanding the legislative silence.¹¹⁰ And lest it be thought that respect for international intellectual property instruments inevitably leads to amplification of domestic copyright protections, in the Ninth Circuit's recent decision in *Los Angeles News Service v. Reuters Television International Ltd.*,¹¹¹ part of the seemingly endless saga involving infringement of the copyright in film footage depicting episodes occurring during the 1992 Los Angeles riots, the court relied on the Berne Convention to limit the scope of the plaintiff's remedies. At issue was whether an earlier ruling basing defendants' liability on the "predicate act" theory (which allows recovery under U.S. copyright law for infringements that occurred abroad if the foreign infringements were facilitated by making an infringing copy in the United States)¹¹² allowed the plaintiff to recover damages or only the defendants' profits. Limiting the plaintiff's relief to profits, the Ninth Circuit based its decision in part on a concern that extraterritorial application of U.S. copyright law would disrupt American foreign policy interests and

108. An exception is 17 U.S.C. § 203(b)(5), providing that termination of grants of rights "in no way affects rights arising under any . . . foreign laws." 17 U.S.C. § 203(b)(5) (2004).

109. See *Itar-Tass Russian News Agency v. Russian Kurier, Inc.*, 153 F.3d 82, 90 (2d Cir. 1998) ("We . . . fill the interstices of the Act by developing federal common law on the conflicts issue."); *The Bridgeman Art Library, Ltd. v. Corel Corp.*, 25 F.Supp.2d 421, 425 (S.D.N.Y. 1999) (identifying a similar role for federal common law).

110. See, e.g., *Itar-Tass Russian News Agency*, 153 F.3d at 91 ("The Berne Convention provides that the law of the country where protection is claimed defines what rights are protected.") (internal quotation omitted); *Murray v. British Broad. Corp.*, 81 F.3d 287, 290 (2d Cir. 1996) (noting that national treatment "mandat[es] that the applicable law be the copyright law of the country in which the infringement occurred"); *Subafilms, Ltd. v. MGM-Pathe Communication Co.*, 24 F.3d 1088, 1097 (9th Cir. 1994) ("[T]he national treatment principle implicates a rule of territoriality."); *Twentieth Century Fox Film Corp. v. ICRAVETV*, 2000 WL 255989 (W.D. Pa. Feb. 8, 2000); see also *Creative Tech. Ltd. v. Aztech Syst. Pte, Ltd.*, 61 F.3d 696, 700-01 (9th Cir. 1995) (reasoning that the Berne Convention implicates a rule of territoriality, but that a territorial approach includes domestic conflict of laws principles, including *forum non conveniens*); *Skelton Fibres Ltd. v. Canas*, 1997 WL 97835 (S.D.N.Y. Mar. 6, 1997).

111. 340 F.3d 926 (9th Cir. 2003), *cert. denied*, 124 S.Ct. 2158 (2004).

112. See *Sheldon v. Metro-Goldwyn Pictures Corp.*, 106 F.2d 45 (2d Cir. 1939).

“the policy of domestic enforcement expressed in the Berne Convention.”¹¹³

In the main, however, U.S. courts have not accorded much substantive or interpretive weight to the Berne Convention in domestic copyright issues. In some respects, this seems curious, given the character of the Copyright Act: though some of its drafting is quite detailed, large parts of it are drafted with broad strokes, leaving it to courts to fill in interpretive “gaps.”¹¹⁴ It is surprising, then, that U.S. courts have not been more receptive to the international obligations of the United States as a source for extrinsic aids to interpretation. That said, in U.S. domestic jurisprudence, there is no strong tradition of invoking public international law obligations in statutory interpretation contexts.¹¹⁵ Indeed, in some circles there appears to be a deep suspicion of the influence of foreign or international law sources in American jurisprudence.¹¹⁶ It is also possible that no case has arisen where a statutory ambiguity can be identified whose resolution would be assisted by recourse to the interpretive guidance of the Berne Convention. The United States has only been a member of the Berne Convention for some fifteen years, perhaps not giving it sufficient time to establish a tradition of relying on its terms for interpretive guidance.

Moreover, as was seen above, the BCIA expressly provides that rights in copyright works accorded by the Copyright Act or other enactment or the common law “shall not be expanded or reduced by virtue of, or in reliance upon, the provisions of the Berne Con-

113. *Reuters*, 340 F.3d at 931 (citing *Subafilms*, 24 F.3d at 1097–98). It is questionable whether limiting plaintiff’s recovery to *profits* in itself evinces sufficient solicitude for international copyright relations. See generally Graeme W. Austin, *Domestic Laws and Foreign Rights: Choice of Law in Transnational Copyright Infringement Litigation*, 23 COLUM.-VLA J.L. & ARTS 1 (1999).

114. See generally, Pierre Leval, *Trademark: Champion of Free Speech*, 27 COLUM.-VLA J.L. & ARTS 187, 196–201 (2004). David Nimmer, *Codifying Copyright Comprehensively*, 51 UCLA L. REV. 1233 (2004).

115. See Steinhardt, *supra* note 2, at 1111, n. 34 (pointing out that international law is not often discussed in standard U.S. texts on statutory interpretation). The truth of Professor Steinhardt’s observation is also illustrated by the very few citations to his article, the leading work in this area, that appear in federal cases. A Westlaw search of the “allfeds” database produced three citing references.

116. As was manifest recently by the introduction to the 108th Congress of the “American Justice for American Citizens” bill, a response to its sponsors’ concerns about “a new technique of interpretation called ‘transjudicialism’: the reliance by American judges upon foreign judicial and other legal sources outside of American Constitutional law.” H.R. 4118, 108th Cong. (2004).

vention, or the adherence of the United States thereto.”¹¹⁷ But while the legislative attempt to limit the effect of the BCIA and the accession to the treaty may have discouraged domestic courts from referring to the Berne Convention as an interpretive guide,¹¹⁸ it is questionable whether the section really prohibits adoption of this approach to statutory interpretation issues. The legislative history indicates that parts of the implementing legislation that emphasized the limited effect of the Berne Convention on domestic law were based on the premise that, according to the Committee for the Judiciary: “adherence to Berne will have no effect under those amendments or those existing laws that may be claimed. In other words, adherence to Berne will have no effect whatsoever on the state of moral rights protections in this country.”¹¹⁹ Given that the Committee Report had already concluded that moral rights were sufficiently protected under U.S. domestic laws, *including* under section 43(a),¹²⁰ adopting an interpretation that was consistent with the Berne Convention would give best effect to the Congressional intention that there should be *no change* in existing protections. Additionally, it is not clear that recourse to the Berne Convention would result in an expansion or reduction of rights “by virtue of, or in reliance on” the Convention itself or the fact of adherence by the United States. Because the Convention is not self-executing, neither the Convention itself nor the fact of adherence can effect a change in the scope of substantive rights. The scope of substantive rights continues to be accorded by domestic law: recourse to the Convention as an interpretive guide would merely assist in determining what the domestic law means.

117. Somewhat ironically, even if the BCIA was meant to preclude recourse to the Berne Convention as an interpretive guide, this wording might not have achieved this on the facts of the *Dastar* case. In *Dastar* the works at issue, Fox’s original documentary programs, were already in the public domain. Accordingly, the documentaries were not copyright “works” to which the section facially applies.

118. The possibility that domestic courts might look to the Berne Convention for interpretive guidance was raised in a statement by Mr. David Ladd, for the Coalition To Preserve the American Copyright Tradition, in hearings on the BCIA, on Sept. 16, 1987. Mr. Ladd observed:

even if Congressional declarations can forestall self-execution, courts faced with moral rights claims will in close cases likely look for guidance to Berne and the laws of those nations that are far more familiar with the rights mandated by the Convention. Thus, there will be substantial pressure for the courts to expand the moral right once recognized.

H.R. REP. NO. 100-609, at 35 (1988).

119. *Id.* at 38.

120. *Id.* at 34.

B. The Berne Convention in Cognate Jurisdictions

The moral rights articulated in article 6*bis* have found their fullest expression in the civil law tradition.¹²¹ But despite the toothless character of the public international law obligation to protect moral rights, legal systems in the common law tradition have also adopted moral rights protections in various forms. Canadian copyright law has protected moral rights in a manner generally consistent with the Berne Convention since 1931.¹²² The United Kingdom took the opportunity of its major reform of its intellectual property laws in 1988 to adopt moral rights protection,¹²³ and New Zealand followed suit in 1994, borrowing its moral rights statute from the United Kingdom.¹²⁴ Most recently, Australia in 2000 adopted comprehensive moral rights legislation.¹²⁵

There are significant variations between these regimes,¹²⁶ and it is arguable that some aspects of moral rights regimes in cognate jurisdictions do not comply with all the requirements of article 6*bis*.¹²⁷ Nevertheless, the approaches of these jurisdictions present a marked contrast to that of the United States. In part because of the recent adherence of the United States to the Berne Convention, and the “minimal compliance” approach taken by Congress with the enactment of the implementation legislation, U.S. copyright law has seldom been “drawn to give effect”¹²⁸ to the Berne

121. See RICKETSON, *supra* note 18, at 102 (noting how the two principal moral rights, the right to claim authorship of a work, (*droit a la paternité*) and the right to the integrity of a work (*droit au respect de l'oeuvre*) were as of 1928 steadily being incorporated into national legal systems of Berne Convention members).

122. Copyright Amendment Act, R.S.C. ch. 8, § 12(7) (1931). Canadian moral rights provisions were updated in 1988. Copyright Act, R.S.C., ch. 1C-42 (1985) (Can.).

123. Copyright, Designs and Patents Act, 1988, ch. 48, § 77 (U.K.).

124. Copyright Act, 1994, §§ 94–97 (N.Z.). See SUSY FRANKEL & GEOFF MCLAY, INTELLECTUAL PROPERTY IN NEW ZEALAND 241–247 (2002).

125. Copyright Amendment (Moral Rights) Act 2000 (Austl.).

126. Ginsburg, *Right to Claim*, *supra* note 31 at 286–300.

127. See, *id.* at 298 (arguing that the United Kingdom, New Zealand, and Canadian schemes allowing for “waiver” of moral rights do not sufficiently respect the independence of moral and economic rights under article 6*bis* of the Berne Convention).

128. Cf. *Australasian Performing Right Ass’n v. Commonwealth Bank of Australia* (1992) 40 F.C.R. 59, 66 (“The United Kingdom legislation predating the 1911 Act, like [the U.S. Copyright Act of 1909] was not drawn to give effect to the Berne Convention.”). The Canadian Federal Court of Appeal has, however, opined that U.S. precedents in the copyright field may be of assistance to Canadian courts when considering parts of Canadian legislation that were amended or added to give effect to the North American Free Trade Agreement. North American Free Trade Agreement between the Government of the United States, the Gov-

Convention. In the past, the “copyright isolationism” of the United States has prompted Commonwealth courts to express reservations about the weight that should be accorded to U.S. decisions. The Supreme Court of Canada in 1980, for example, counseled wariness about applying U.S. copyright decisions in Canadian cases, even where the factual situations are similar, emphasizing that “[t]he United States statutes have not been based upon the international copyright treaties of the 19th and 20th centuries, [including] the Berne Convention of 1886.”¹²⁹

Differences between the United States and Commonwealth jurisdictions are not confined to different styles of implementation. Commonwealth jurisdictions also appear to accord more weight to the Berne Convention in the resolution of domestic law issues.¹³⁰ Now that the United States is a member of the Convention, it may be instructive to compare the general approach in foreign jurisdictions to the role of the Berne Convention in the adjudication of copyright issues.

Some Commonwealth courts, such as the Supreme Court of Malaysia, have emphasized that it is not appropriate to refer to the Convention, or other “extraneous” material, if the statutory provision is clear.¹³¹ This has its corollary in the U.S. in the “Charming Betsy” Rule: a construction that is consistent with the international

ernment of Canada, and the Government of the United Mexican States, Dec. 17, 1992, 32 I.L.M. 296 [hereinafter NAFTA]. *Tele-Direct (Publications) Inc. v. American Business Info., Inc.* (1997) 154 D.L.R. (4th) 328, 336. For present purposes, it is also useful to note that the Canadian court relied on NAFTA to determine whether Canadian copyright law protected compilations of data based on a “sweat of the brow” standard. *Id.* at 335.

129. *Compo Co. v. Blue Crest Music Inc.*, [1980] S.C.R. 357, 367.

130. In the United Kingdom, courts generally adopt the principle that public international law obligations are relevant to construction of statutes. *See Ahmad v. Inner London Educ. Auth.*, 1978 Q.B. 36, 48 (Eng. C.A.) (Scarman LJ, dissenting). However, in the intellectual property context, English courts might now be expected to refer more often to the European Union directives on intellectual property, which have been framed for the context of the specific circumstances of the EU, rather than the more venerable, but more general, Berne Convention. But see *Hyde Park Residences Ltd. v. Yelland* [2001] Ch. 143, 164 (Eng. C.A.) where Aldous L.J. reasoned that recognition of a public interest defense to copyright infringement would be incompatible with, *inter alia*, the Berne Convention.

131. *Foo Loke Ying v. Television Broads. Ltd.*, [1985] 2 M.L.J. 35, 39. This point was also made by Justice Plowman in the English Chancery Court in *Warwick Film Prods. v. Eisinger* [1969] 1 Ch. 508, 521; relying on *Ellerman Lines v. Murray*, 1931 A.C. 126 (appeal taken from Eng. C.A.) (holding that where a section is unambiguous it is not permissible to refer to a draft convention to which the Act was intended to give effect in order to give the section a meaning other than its natural meaning).

law obligation of the United States needs to be an available construction. Where recourse to the Berne Convention is not precluded by clear statutory wording, other Commonwealth courts have indicated that the Convention, along with other intellectual property treaties, are part of a change in legal culture in the intellectual property field. The Federal Court of Australia recently observed:

An important consideration . . . is that the law relating to copyright and designs is an international affair. The Berne Convention for the protection of literary and artistic works has brought about that position. It is important that persons dealing in articles which may be the subject of protection by copyright or designs law should be able to do so with a degree of certainty. They should be able to act upon the basis that the law of one country will confer in respect of the same subject matter rights which, though not identical, will be of similar extent.¹³²

Australian courts have also endorsed the use of the Berne Convention as an interpretive guide. The Full Federal Court of Australia, for instance, has articulated the “well-established” principle that “any ambiguity” in the provisions of the Australian Copyright Act would be “resolved . . . [with] regard to the Berne Convention.”¹³³ Australia’s highest court, the High Court of Australia, recently adopted exactly this approach when it invoked article 11*bis*(1) to assist with interpreting sections of the Australian Copyright Act of 1968 that deal fairly opaquely with the broadcasting right.¹³⁴ Likewise, the Federal Court of Australia drew on the Berne Convention to determine the scope of the right to “perform the work in public,” an issue on which the Australian Act provided little guidance.¹³⁵

132. *Interlego A.G. v. Croner Trading Pty, Ltd.*, (1991) 102 A.L.R. 379, 397 (Austl.).

133. *Enzed Holdings Ltd. v. Wynthea Pty. Ltd.* (1984) 57 A.L.R. 167, 181 (Austl.); *accord*, *Ozi-Soft Pty. Ltd. v. Wong* (1988) 10 I.P.R. 520 (Austl.); *Australian Olympic Comm. Inc. v. The Big Fights, Inc.*, (1999) F.C.A. 1042, 1999 AUST FEDCT LEXIS 518, at #39 (Fed. Ct. Aust.).

134. *Telstra Corp. Ltd. v. Australasian Performing Right Assoc.*, 1997 AUST HIGH CT LEXIS 49 at #44 (Austl.). The case concerned whether “on-hold” music breached the “broadcasting right” under § 31(1)(a)(iv) of the Australian Copyright Act.

135. *Australasian Performing Rights Ass’n. v. Commonwealth Bank of Australia*, (1992) 40 FCR 59, 66–67 (referring to *inter alia* art. 11 of the Berne Convention, as interpreted by Prof. Ricketson in RICKETSON, *supra* note 18, at 432 in support of its holding that performance of music to employees of a bank is a performance “in public” for the purposes of section 31(1)(a)(iii) of the Australian Copyright Act 1968).

Australian courts have also referred to the Convention when interpreting the phrase “equitable remuneration” in the Australian Copyright Act,¹³⁶ and when considering what constitutes a “dramatic” work.¹³⁷

The New Zealand High Court has adopted a similar approach in a case involving the New Zealand parallel importation statute.¹³⁸ At issue was whether the owner of the copyright in a lighting design had, for the purposes of the New Zealand Copyright Act 1994, “failed to take some step available to them to secure the copyright (or other equivalent intellectual property right) in the work in the country from which it had been imported”¹³⁹ when it did not secure the maximum rights in the work by way of a design registration in China. An affirmative answer to that question would have enabled the defendant to import copies of the work without liability. Referring to article 5 of the Berne Convention, which provides that rights secured under the Convention “shall not be subject to any formality,” and article 9, which establishes authors’ reproduction rights, the High Court declined the defendant’s invitation to regard design registration as an “available” step with which the plaintiff needed to comply to protect its New Zealand copyright against a gray market.¹⁴⁰ The Court reasoned that requiring the plaintiff to comply with the formalities of the foreign design registration system would have been contrary to the requirement of national treatment and to the spirit of the Berne Convention’s requirement that copyrights do not depend on compliance with formalities.

It is likely that the greater relevance accorded to the Berne Convention in the domestic law of some Commonwealth jurisdictions results from the broader tendency in these jurisdictions to take seriously the international obligations of the executive branch for the purposes of the development of domestic law. In the Anglo tradition, as in the United States, the presumption of consistency

136. See also, *Univ. of Newcastle v. Audio-Visual Copyright Soc’y Ltd.* (1999) 151 F.L.R. 115, 130 (Austl.) (1999) (referring to *inter alia* art. 9 of the Berne Convention to assist with the interpretation of the term “equitable remuneration” in section 153A of the Australian Copyright Act 1968).

137. *Australian Olympic Comm. v. The Big Fights, Inc.* (1999) FCA 1042, 1999 AUST FEDCT LEXIS 518, AT #31 (referring to *inter alia* the Berne Convention and the seminal text on the Berne Convention by Professor Sam Ricketson (see RICKETSON, *supra* note 18) to assist with the interpretation of “dramatic work” in the Copyright Act 1968).

138. *Massive N.V. v. Lighting Plus Ltd.* [2003] N.Z.L.R. 222.

139. *Id.* at 232; Copyright Act, 1994, § 12(5A) (N.Z.).

140. *Massive N.V. v. Lighting Plus Limited* [2003] N.Z.L.R. 222, 226–27, 232–35.

with international obligations dates back to at least the nineteenth century.¹⁴¹ In recent decades increased attention has been given to the role of international law in the construction of domestic statutes. As Professor Claudia Geiringer suggests, the increasing importance of international human rights norms following World War II has provided some of the impetus for this development.¹⁴² In a number of jurisdictions, this has led to the application of the presumption of consistency even when no statutory ambiguity can be identified.¹⁴³

Under systems of parliamentary sovereignty, separation of powers concerns generally preclude courts from giving direct effect to public international obligations,¹⁴⁴ a rule that was also established

141. See *Rv Keyn*, 2 Ex. D. 63, 85 (1876).

142. Claudia Geiringer, *Tavita and All That: Confronting Confusion Surrounding Unincorporated Treaties and Administrative Law*, 21 N.Z. U. L. REV. 67, 70–71 (2004). See also Catherine Powell, *Dialogic Federalism: Constitutional Possibilities for Incorporation of Human Rights Law in the United States*, 150 U. PA. L. REV. 245 (2001).

143. See, e.g., *Nat'l Corn Growers v. Canadian Import Tribunal*, [1990] S.C.R. 1324, 1372–73, where Gonthier J. expressly rejected the proposition that “consultation of the treaty is proper only where it appears that the text to be interpreted is ambiguous on its face.” See also Sir Kenneth Keith, *The Harkness Henry Lecture: The Impact of International Law on New Zealand Law*, WAIKATO L. REV. 1, 23 (1998) (discussing the demise of the ambiguity prerequisite in New Zealand Law). Cf. *Brind v. Sec'y of State for the Home Dept.* [1991] All E.R. 729, 722–23, 734 (statutory ambiguity a prerequisite for application of presumption of consistency under English law).

144. A fundamental premise of parliamentary sovereignty means that there is no concept of self-executing treaties that can be given direct effect in courts without incorporation into domestic law by parliamentary action. The incorporation requirement reflects the broader principle that the executive cannot bind citizens or subjects. The point was confirmed in 1611 by Lord Coke, in *Proclamations Case* 12 Co. Rep. 74, 76; 77 Eng. Rep. 1352, 1354 (1611) (holding that the “King’s proclamations” do not make domestic law). The classic twentieth-century statement of the rule was given in *Attorney Gen. for Can. v. Attorney Gen. for Ontario* [1937] D.L.R. 673, 678, a Privy Council appeal from the Supreme Court of Canada, where Lord Atkin explained: “[t]here is a well-established rule that the making of a treaty is an executive act, while the performance of its obligations, if they entail alteration of the existing domestic law, requires legislative action.” The leading domestic Canadian decision on the existence of the consistency presumption is in the Supreme Court of Canada’s decision in *Daniels v. White and the Queen*, [1968] S.C.R. 517, 539. As the direct incorporation of (self-executing) treaties through the Supremacy Clause in the U.S. Constitution, art. VI, illustrates, different constitutional structures can provide for more direct ways of incorporating international laws into the domestic legal system. Likewise, the Constitutions of France and Germany do not require legislation to give international treaty obligations the force of law. See FR. CONST. (Oct. 4, 1958) article 55; F.R.G. GG (German Basic Law of May 23, 1949) article 25.

in the United States for non self-executing treaties.¹⁴⁵ On the other hand, as a leading English law lord said in 1978, the requirement of domestic incorporation does not mean that domestic courts “pay no regard to . . . international obligations.”¹⁴⁶ The presumption of consistency reflects the view that courts ought to “pay very serious regard to them.”¹⁴⁷ The presumption provides courts a method, within the confines of separation of powers concerns, to hold the executive to account, by signaling that accession to international treaties will not be regarded as mere window dressing.¹⁴⁸ As one Canadian commentator has said, “[w]hile unimplemented treaties are not formal sources of law, it is nonsense to treat them as having no legal consequence.”¹⁴⁹ Particularly in the human rights context, one result of the presumption is that if legislatures wish to derogate from international obligations, the legislation must be specific, and, as a result, derogation from the treaty is more likely to be susceptible to political scrutiny.¹⁵⁰

The Supreme Court in *Dastar* has effectively done the opposite. The *entry* to the Berne Convention in 1989 was subject to intense political scrutiny, and was accompanied by intense lobbying by many interested parties. The votes by the U.S. Senate and House

145. See *Foster v. Neilson*, 27 U.S. (2 Pet.) 253, 314 (1829) (Marshall J.) (“Our constitution declares a treaty to be the law of the land. It is, consequently, to be regarded in the courts of justice as equivalent to an act of the legislature, whenever it operates of itself without the aid of any legislative provision. But when the terms of the stipulation import a contract, when either of the parties engages to perform a particular act, the treaty addresses itself to the political, not the judicial department; and the legislature must execute the contract before it can become a rule for the Court.”)

146. *Ahmad v. Inner London Educ. Auth.*, 1978 Q.B. 36, 48 (Eng. C.A.) (Scarman LJ, dissenting).

147. *Id.*

148. See *Tavita v. Minister of Immigration* [1994] 2 N.Z.L.R. 257, 266 (C.A.), where (then) Cooke P. characterized the New Zealand government’s argument that accession to the U.N. Convention on the Rights of the Child (UNCROC) was of no significance in domestic law as an “unattractive” argument, “apparently implying that New Zealand’s adherence to the international instruments has been at least partly window-dressing.” See also *Minister of State for Immigration and Ethnic Affairs v. Teoh* (1995) 183 C.L.R. 273 (Austl.) (holding that Australia’s accession to UNCROC imposes procedural obligations on administrative actors).

149. See *van Ert*, *supra* note 84, at 29–30.

150. A decision of the Ontario High Court illustrates this point. In *Re Mitchell and the Queen*, [1983] O.R. 481, 493, Linden J. held that the International Covenant on Civil and Political Rights may be used “to assist a court interpret ambiguous provisions of a domestic statute, notwithstanding the fact that the Covenant has not been formally incorporated into the law of Canada, provided that the domestic statute does not contain express provisions contrary to or inconsistent with the Covenant.”

of Representatives in 1988 to bring U.S. law into line with the Berne Convention were described as “historic” and “momentous” by leading American copyright scholars.¹⁵¹ It was an important, and hard-fought, foreign and domestic policy initiative. Its long-enduring non-membership had proved embarrassing for the United States in its trade negotiations aimed at encouraging foreign jurisdictions to better protect U.S. origin copyright works.¹⁵² Though the Congress did not as fully embrace its obligations to protect authors’ rights as other nations had, including our northern neighbor,¹⁵³ it probably did the best that it could at the time, given the political pressures against enactment of a specific moral rights statute.¹⁵⁴ As Professors Ginsburg and Kernochan observed, Congress was not disingenuous when it determined that there existed real protections under existing U.S. law for moral rights.¹⁵⁵ In the light of this legislative history, the *Dastar* Court’s determination “to say what the law is”¹⁵⁶ seems quite “emphatic” indeed, given the conflict between its holding and the Congress’s careful deliberations about the scope of the protections afforded by section 43(a).¹⁵⁷ The U.S. political branches are already quite adept at avoiding, when convenient, public international obligations in the copyright field, as is shown by the failure to amend U.S. copyright legislation following an adverse WTO dispute settlement panel decision on the “small business exception” in the U.S. Copyright Act.¹⁵⁸ When it comes to avoiding international obligations, the United States does not need any more help from the judicial branch.

151. Ginsburg & Kernochan, *supra* note 15, at 1.

152. Ginsburg & Kernochan, *supra* note 15, at 3–4.

153. See *supra* note 122, referring to Canada’s specific moral rights statute.

154. See Ginsburg & Kernochan, *supra* note 15, at 27–31 (discussing the political opposition to moral rights protections).

155. Ginsburg & Kernochan, *supra* note 15, at 37.

156. *Marbury v. Madison*, 5 U.S. (1 Cranch) 137, 177 (1803) (“It is emphatically the province and duty of the judicial department to say what the law is.”).

157. The *Dastar* Court’s approach seems particularly bold when it is recalled that the source of authors’ attribution right derives from treaty relationships of the United States. On the role of the judicial branch in relation to foreign affairs issues, see generally *U.S. v. Curtiss-Wright Exp. Corp.*, 299 U.S. 304 (1936). Justice Scalia is not one to accord much weight to legislative history in his opinions. See ANTONIN SCALIA, *A MATTER OF INTERPRETATION* 16 (1997). And, moreover, the report of the House Committee on the Judiciary that accompanied the BCIA was not even part of the legislative history of the Lanham Act itself: it was a *subsequent* (re)interpretation of the Lanham Act by the Congress in the light of Berne Convention obligations. See H.R. REP. NO. 100-609 (1988).

158. WTO Dispute Panel Report, United States, Section 110.5 of the US Copyright Act, at 24, http://www.wto.org/english/tratop_e/dispu_e/1234da.doc.

III.
TOWARD A MORE “BERNE-CONSISTENT”
INTERPRETATION OF SECTION 43(A) OF
THE LANHAM ACT

The suggestion that the Berne Convention might be invoked as a canon of statutory construction is premised on the idea that it is good to keep one's bargains, and that the Court should interpret legislation in a way that assumes that this is what the Congress intends to do. Professor Ralph G. Steinhardt has provided an exhaustive analysis of the scope and bases for the “Charming Betsy” Rule, pointing out that in some contexts at least, the rule serves the important public policy of ensuring that the United States speaks with one voice in foreign affairs matters.¹⁵⁹ So understood, the presumption of consistency with international obligations also serves separation of powers values.

Some commentators have been critical of the increasing scope and role of public international law in the intellectual property field, arguing that the international law in this field inappropriately burdens other nations with compliance costs to the detriment of societal welfare. One scholar has recently suggested that the Berne Convention should be jettisoned altogether.¹⁶⁰ For present purposes, it is not necessary to engage with those arguments, to the extent that they concern the wisdom of entering into international intellectual property treaties in the first place. My argument concerns the domestic law implications of the fact that the United States has already decided to take on these public international law obligations.

Separation of powers issues might prompt further pause, however.¹⁶¹ Some see the rise of international obligations as undemocratic, removing the development of intellectual property laws from democratic scrutiny.¹⁶² To be sure, a nation's intellectual property laws touch on many of the important policy questions a society must confront—agriculture policy, education and literacy, health, freedom of expression, and, more generally, the availability and price

159. Steinhardt, *supra* note 2, at 1133–34.

160. Alan Story, *Burn Berne: Why the Leading International Copyright Convention Must Be Repealed*, 40 HOUS. L. REV. 763 (2003).

161. *See generally*, Lee, *supra* note 85, at 35 (discussing separation of powers concerns in the context of courts' recourse to foreign, rather than international, law in the interpretation of ambiguous statutes).

162. *See, e.g.*, Marci A. Hamilton, *Database Protection and the Circuitous Route Around the United States Constitution*, in INTELLECTUAL PROPERTY AND THE COMMON LAW WORLD 9 (Charles E. F. Rickett & Graeme W. Austin, eds., 2000).

of materials of culture. These are areas where domestic self-determination can be particularly important, and can be closely tied to issues of domestic sovereignty and democratic accountability.¹⁶³ Advocating an increased role for international obligations in the shaping of domestic laws might encourage the judicial branch to become complicit in the overriding of “representational” values in the intellectual property field.

As a general matter, however, as Professor Graeme Dinwoodie has pointed out, the idea that domestic international intellectual property law is always dictated by public international law norms is itself a fallacy.¹⁶⁴ Each influences the other. This was the case even under the Universal Copyright Convention, a precursor to the Berne Convention for the United States. Judge Gurfein recognized this point in the 1973 decision in *Rosette v. Rainbo Record Manufacturing Corp.*,¹⁶⁵ which decided that distribution of phonorecords without copyright registration is not a divestive publication of common law rights in the unpublished composition under the terms of the 1909 Act.¹⁶⁶ Bolstering his conclusion with the reference to the Universal Copyright Convention’s definition of “publication” as requiring visibly perceptible copies,¹⁶⁷ Judge Gurfein noted that this definition was reached “not so much on a theoretical basis;”¹⁶⁸ rather, adoption of any other wording in the

163. I develop this argument in more detail in Graeme W. Austin, *Valuing “Domestic Self-Determination” in International Intellectual Property Jurisprudence*, 77 CHL-KENT L. REV. 1155 (2002) [hereinafter Austin, *Valuing “Domestic Self-Determination”*].

164. Graeme B. Dinwoodie, *The Integration of International and Domestic Intellectual Property Lawmaking*, 23 COLUM.-VLA J.L. & ARTS 307 (2000).

165. 354 F. Supp. 1183 (1973). The Supreme Court in *White-Smith Publ’g Co. v. Apollo Co.*, 209 U.S. 1 (1908) had held that a piano roll did not constitute an infringing copy of the recorded music. The Ninth Circuit, in *Corcoran v. Montgomery Ward & Co.*, 121 F.2d 572 (9th Cir. 1941) extended the rule to phonograph records.

166. *Cf. Mills Music Inc. v. Cromwell Music Inc.*, 126 F. Supp 54, 69–70 (S.D.N.Y. 1954) (dictum suggesting that widespread authorized sale of phonorecords constituted publication under the 1909 Act); *McIntyre v. Double A-Music Corp.*, 166 F. Supp 681, 682 (S.D. Cal. 1958) (same). In *Rosette*, Judge Gurfein also held, however, that though publication of the phonorecords was not a divestive publication, failure to affix a notice on the phonorecords precluded enforcement of the copyrights in the underlying compositions. 354 F. Supp. at 1192.

167. Article 6 of the Convention defines “publication” as “the reproduction in tangible form and the general distribution to the public of copies of a work from which it can be read or otherwise visually perceived.” Universal Copyright Convention, Sep. 16, 1955, art. 6, 6.3 U.S.T. 2731.

168. *Rosette*, 354 F. Supp. 1188–89.

Convention would have required an amendment of United States copyright law, “unlikely to be accepted by Congress.”¹⁶⁹

Moreover, there is surely a difference between overriding domestic legislative choices by judicial fiat,¹⁷⁰ and respecting—and, to the extent permitted by statutory wording, *requiring* legislatures to take seriously—the international obligations that the political branches have deemed beneficial to shoulder.¹⁷¹ While domestic self-determination in copyright law is a key aspect of domestic sovereignty over social and economic policy,¹⁷² much of the policy domain of domestic intellectual property law is also increasingly part of a larger international system. For nations willingly signing on, there is a deliberate bargaining of a possible reduction of control over domestic policy choices in exchange for better protections abroad.¹⁷³ Courts should assume that, when the United States enters into international agreements, its actions should be taken seriously. Separation of powers ideals are preserved by the reality that Congress remains able, using express words, to negative any unwanted solicitude the judiciary might have for the nation’s international obligations. Then the dispute can shift to the international context, as the United States attempts to justify its non-compliance to its treaty partners at the public international law level.

How might a presumption of compliance be applied in the context of authors’ attribution rights in the wake of *Dastar*? Congress’ decision to rely on existing legislation and common law to comply with its obligations under article 6*bis* itself gives rise to is-

169. *Id.*

170. See Graeme W. Austin, *Social Policy Choices and Choice of Law for Copyright Infringement in Cyberspace*, 79 OR. L. REV. 575 (2000) (arguing that some American choice of law strategies, which are tantamount to extraterritorial application of U.S. copyright law, inappropriately override domestic policy choices made by other nations) [hereinafter Austin, *Social Policy Choices*].

171. See generally, Shira Perlmutter, *Participation in the International Copyright System as a Means to Promote the Progress of Science and Useful Arts*, 36 LOY. L.A. L. REV. 323 (2002). Domestic nations should remain able to identify “flexibilities” in their public international law obligations in order to pursue important domestic policy agenda. See Graeme B. Dinwoodie & Rochelle Cooper Dreyfuss, *International Intellectual Property Law and the Public Domain of Science*, 7 J. INT’L ECON. L. 431 (2004) (exploring the scope provided by the TRIPs Agreement for domestic self-determination in the development of scientific research policies).

172. See Austin, *Valuing “Domestic Self-Determination”*, *supra* note 163.

173. For different nations, different outcomes will be sought through this process. As Professor Dinwoodie puts the point, as a result of linking intellectual property to international trade regime, “let in my bananas, we’ll cut you some slack on CDs” becomes a more ready and explicit form of discussion.” Graeme B. Dinwoodie, *The Architecture of the International Intellectual Property System*, 77 CHI.-KENT L. REV. 993, 1004 (2002).

sues concerning the application of the presumption. Section 43(a) of the Lanham Act was not enacted to give expression to treaty obligations; and its initial enactment¹⁷⁴ predates accession to the Berne Convention. Construing the section more consistently with the Berne Convention would thus not exactly be giving effect to legislative intent *as expressed* in a domestic statute. Instead, it would be to give effect to Congress' interpretation of an existing statute. Logically, however, it should not matter whether Congress added new ink to the statute books or confirmed what it thought the existing ink meant. Incidentally, this appears to be the emerging consensus in Commonwealth jurisdictions: the presumption of consistency with international obligations appears to apply even if the statute was first in time, and even if its enactment was not itself motivated to give effect to a new international law obligation.¹⁷⁵

Perhaps more significantly, the Lanham Act provides an inexact fit with the obligations of the United States under the Berne Convention. First, article 6*bis* requires only that moral rights be "maintained, at least until the expiry of the economic rights."¹⁷⁶ Secondly, the Berne Convention does not require protection of all authors: while it imposes the obligation of "national treatment" on all member states, it does not mandate that the minimum standards of protection apply to members' own authors.¹⁷⁷ One of the ironies resulting from the legislative history of the BCIA is that, despite the Committee's careful avoidance of the amplification of authors' rights beyond those afforded by domestic law, by relying on extant legal provisions, U.S. law may have gone further than the Berne Convention requires. It chose not to distinguish between domestic and local authors; and, by linking authors' rights to the Lanham Act (and state law unfair competition principles), the U.S. approach gives rise to the possibility of perpetual protection for authors against misattribution of their works.

There is no reason—subject, of course, to *Dastar*—why authors should not benefit from these Congressional decisions about the

174. The Trademark Law Revision Act of 1988 rewrote and expanded section 43(a) to cover product disparagement claims. Pub. L. No. 100-667, § 132, 102 Stat. 3935 (1988); codified at 15 U.S.C. § 1125(a) (2000).

175. See van Ert, *supra* note 85, at 35–42 (discussing the emerging approach in Commonwealth jurisdictions toward viewing the presumption as a stand alone rule of construction).

176. Berne Convention, art. 6*bis*(2).

177. Berne Convention, art. 5(1). In accordance with this rule, U.S. domestic copyright law distinguishes between "United States" and foreign origin works for the purposes of the pre-infringement action registration requirement. See 17 U.S.C. § 411 (2000).

appropriate scope of moral rights protections if their attribution claims otherwise fit within the Lanham Act framework: it appears to have been Congress' intention that they should. But, as we have seen, lower courts have applied *Dastar* to claims in relation to works that have not yet entered the public domain.¹⁷⁸ It would be more consistent with the international obligations of the United States to view the *Dastar* holding as applying only to misattribution claims for works whose copyrights have expired. For non-public domain works, where the assertion of authors'¹⁷⁹ moral rights claims is broadly in line with article 6*bis*, courts should continue developing the earlier line of decisions under the Lanham Act that supported those claims.¹⁸⁰ They might be steeled in this limiting of *Dastar* by the conviction that courts should not, through decisional law, place the political branches in the position of being in breach of public international law obligations under article 6*bis* of Berne if another approach is available. That is, the Berne Convention and the "Charming Betsy" Rule provide a doctrinal basis for limiting the effect of the *Dastar* decision.

Indeed, and perhaps ironically, the *Dastar* decision might, if the present approach were adopted, give the attribution right an important boost. The principle of *stare decisis* requires the *Dastar* holding to control for *something*. Limiting its holding to public domain works would enable lower courts to continue developing an "attribution rights jurisprudence" under the Lanham Act, broadly in line with Berne Convention moral rights principles. However, if *Dastar* is read as impeding recognition of a right against misattribution for public domain works, *Dastar* has the potential to allow an attribution right to continue to develop in its shadow for *copyright protected* works, while ameliorating the fear that section 43(a) is of unbounded scope.¹⁸¹

A more "Berne-consistent" approach to section 43(a) of the Lanham Act will only take domestic protections of moral rights so far. The Lanham Act will not protect all authors' attribution

178. See, e.g., *Zyla v. Wadsworth, Div. of Thomson Corp.*, 360 F.3d 243 (1st Cir. 2004); *Williams v. UMG Recordings, Inc.*, 281 F. Supp. 2d 1177, 1185 (C.D.Cal. 2003); *Carroll v. Kahn*, 68 U.S.P.Q.2d 1357, 1361-62 (N.D.N.Y. 2003).

179. As compared with claims by authors' employers. The latter claims might be supported under general Lanham Act principles (see discussion *supra* Part II.A), but they do not carry the same moral weight as claims by those responsible for the creation of the works. See Jane C. Ginsburg, *The Concept of Authorship in Comparative Copyright Law*, 52 DEPAUL L. REV. 1063, 1091 (2003).

180. See *supra* note 37.

181. On concerns as to the scope of section 43(a), see Dinwoodie, *Trademark Jurisprudence*, *supra* note 60, at 202-05.

claims. Consistent with basic trademark law principles, it should protect only those authors who have achieved a sufficient reputation such that their names operate in a trademark-like way.¹⁸² While the Berne Convention can help encourage courts to continue developing an author-attribution jurisprudence in the wake of *Dastar*, it should not lead to distortion of trademark principles. Justice Scalia expressed the fear that protecting authors' attribution rights under the Lanham Act would produce a "mutant copyright law."¹⁸³ The Court's analysis might have been more productively directed at instructing lower courts to avoid creating a mutant *trademark* law, while continuing to allow the Lanham Act to provide at least some parts of the patchwork of protections for authors' rights, consistent with Congress' intentions when it enacted the BCIA.

IV. CONCLUSION

Courts and litigants draw on a range of different sources and principles when interpreting statutes. This article has concerned the relevance of the Berne Convention to the interpretation of section 43(a) of the Lanham Act, which was meant to give expression to one of the fundamental rights under the international copyright system: the right to be identified as an author. The Berne Convention has its more natural home in the interpretation of the Copyright Act, as the Commonwealth cases suggest. In future cases, it might be relevant to different interpretive quandaries.

It is impossible to anticipate the interpretive issues on which the Convention might provide guidance. One example might be in delineating the relationship between the derivative work right and the first sale doctrine: is a derivative "work" created that implicates an author's exclusive right under section 106(2) when the party making the work used authorized copies, without also making new (unauthorized) reproductions? So far, courts have tended to resolve this difficulty in favor of the author,¹⁸⁴ a result that seems consistent with moral rights protections under article 6bis of the Berne Convention to object to derogatory treatment, and the right under article 12 to authorize "alterations" of their works. The virtue of

182. See *supra* Part III.A for discussion of the some of the types of trademark information protected by the Lanham Act that are relevant to the present discussion.

183. *Dastar*, 539 U.S. at 34.

184. *Mattel, Inc. v. Walking Mountain Prod.*, 353 F.3d 792, 801 (9th Cir. 2003) (finding the right under section 106(2) implicated but concluding on the facts that the *prima facie* infringement came within the fair use defense).

achieving consistency with the Berne Convention might give added weight to that conclusion. Other examples of this kind are likely to arise from time to time.¹⁸⁵

It is also possible that the importance of the role of treaties in the copyright field may increase in the near future. Recently, litigants have been mounting constitutional challenges against amendments to U.S. copyright legislation that were enacted to bring U.S. law more into line with its public international law obligations in the intellectual property context.¹⁸⁶ Once the dust settles on these claims, and, assuming courts hold that these amendments are generally consistent with the treaty obligations of the United States,¹⁸⁷ if not the Copyright and Commerce Clauses themselves,¹⁸⁸ it would seem particularly appropriate to consider the texts of the relevant treaties if interpretive questions arise.

This approach to statutory construction is not only consistent with the approach often adopted in cognate jurisdictions. The “Charming Betsy” Rule, which assumes that the political branches mean what they say when they enter into international agreements, has a long legal pedigree and a compelling moral resonance.

185. Limitations on the scope of permitted reproductions under art. 9(2) might bolster concerns for protecting author’s future markets in the fair use analysis. *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004, 1017 (9th Cir. 2001).

186. *Golan v. Gonzales*, 2005 WL 914754 (D. Colo. 2005); *Kahle v. Ashcroft*, 2004 WL 2663157 (N.D.Cal.), 2005 Copr.L.Dec. P 28,927, 72 U.S.P.Q.2d 1888; *Luck’s Music Library v. Ashcroft*, 321 F.Supp.2d 107 (D.D.C. 2004).

187. *Golan*, 2005 WL 914754 at *15.

188. But see *Kiss Catalog v. Passport Int’l Prods.*, 350 F.Supp.2d 823 (C.D. Cal. 2004) (dismissing as unconstitutional a claim brought under 17 U.S.C. § 1101 (the federal “anti-bootlegging statute” prohibiting inter alia unauthorized fixations of live performances, which the enacted in compliance with the TRIPs Agreement, art. 14); and *United States v. Martignon*, 346 F. Supp. 2d 413 (S.D.N.Y.2004) (same). Cf. *United States v. Moghadam*, 175 F.3d 1269 (11th Cir. 1999) (upholding the constitutionality of 18 U.S.C. § 2319A, a criminal statute prohibiting bootlegging).