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International Trademark and Copyright Protection

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I. INTRODUCTION

Commercial counterfeiting of both trademarked and copyrighted goods has reached staggering levels over the last five years. One recent United States International Trade Commission study placed the 1983 product counterfeit loss to United States businesses at sixteen to eighteen billion dollars, in manufactured goods alone. This represents a dramatic increase of over 450 percent from the 1978 estimate of three billion dollars.[1] Commercial counterfeiting is peculiarly international in scope and effect.[2] Foreign products counterfeiters flourish because of the division of the world into independent nations. Often, unless the counterfeiter is "present" in either the operational or physical sense, the domestic law of the nation to which he is exporting cannot reach him. Furthermore, even if the counterfeiter has operations within the importing or exporting nation, domestic law only affects the part of the organization which is within that nation. Consequently, domestic law must be supplemented by international law to effectively curb foreign counterfeiters.

The victim of an international counterfeiter must look to international treaties or arrangements to obtain maximum protection. Otherwise, he is left with no redress or must press suit in a foreign country which extends him little or no protection. Even with treaty protection, the victim may still be compelled to bring suit under foreign law. However, the major multilateral treaties ensure that a minimum level of protection is available within all signatory nations.[3] The existing bilateral treaties may sometimes afford more specific protection to the individual than the multilateral treaties, but only if the victim is fortunate enough to have been injured by a counterfeiter operating out of a nation which maintains a strong treaty with his country.[4] Furthermore, bilateral copyright agreements have become much

1. *Putting Teeth in the Trademark Laws*, BUS. WK., Oct. 8, 1984, at 75.

2. Rakoff & Wolff, *Commercial Counterfeiting: The Inadequacy of Existing Remedies*, 73 TRADE-MARK REP. 493, 532 (1983).

3. *See, e.g.*, Paris Convention of 1883, 21 U.S.T. 1583, T.I.A.S. No. 6923, art. 5*quater* [hereinafter cited as Paris Union].

4. By their nature bilateral treaties only have force between the two nations that are parties.

less significant since the United States entered its first major multilateral copyright agreement in 1954.[5] Consequently, because multilateral treaties have a broader application this comment is limited to those multilateral trademark and copyright agreements from which American authors and businesses can receive protection.

This comment is divided into two major sections — trademarks and copyrights. Patents are also used to protect the intellectual property rights of the holder, but patents have been exhaustively covered in other works. Each section of this comment discusses the functions and protections of the applicable major multilateral treaties. In addition, this comment will discuss the shortcomings of each treaty, ideas for strengthening international protection, and suggestions for a businessman or author's course of action in the present international environment.

II. INTERNATIONAL TRADEMARK PROTECTION

Trademark laws protect an owner's pecuniary interests in his goods. Trademarks are used by particular manufacturers or merchants to distinguish their goods from all others. Through either use, registration, or both, a trademark owner gains the exclusive right to use that mark on his goods.[6] The world is generally divided between the use and registration theories. Countries such as the United States require a trademark's actual use before granting the mark to an applicant. Most other countries follow the registration rationale and grant a trademark to the first applicant regardless of that mark's prior use.[7] Any unauthorized use of this exclusive right by a third party constitutes trademark infringement.[8] A "trademark" is generally de-

5. The Berne Convention for the Protection of Literary and Artistic Works of Sept. 9, 1886, *completed at* Paris on May 4, 1896, *revised at* Berlin on Nov. 13, 1908, *completed at* Berne on Mar. 20, 1914, and *revised at* Rome on June 2, 1928, at Brussels on June 26, 1948, at Stockholm on July 14, 1967, and at Paris on July 24, 1971, *effective* Oct. 10, 1974, *reprinted in* 7 COPYRIGHT 135 (1971) [hereinafter cited as Berne Convention].

6. The United States requires the trademark applicant to use the mark before an application is granted. Conversely, many foreign nations grant an application when the trademark applicant declares an intention to use the mark in the future. J. GILSON, TRADEMARK PROTECTION AND PRACTICE § 9.01[6] (1984).

7. *Id.*

8. The exclusive right to the trademark prevents third party use on similar goods. *See, e.g.*, Paris Union, *supra* note 3, art. 6*bis*. Article 6*bis*(1) provides:

> (1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country

fined to include any word, symbol, name, or device or a combination thereof to distinguish one set of goods from all others.[9]

Trademarks are granted nationally by statute. As a result, there are enormous differences among nations as to the definition and formalities of trademarks.[10] In order to protect the rights of trademark owners against extraterritorial infringement of their marks, several multilateral treaties have been created, the most important being the Paris Union, the as yet unratified Trademark Registration Treaty, and the proposed International Anticounterfeiting Code. Each is discussed below.

A. The Paris Union

The Paris Convention for the Protection of Industrial Property[11] (Paris Union) was established in 1883, and is administered by the World Intellectual Property Organization (WIPO).[12] The basic purpose of the Paris Union is to ensure that each member country grants effective protection to the citizens of all other members against unfair competition in industrial and commercial matters,[13] particularly in trademarks and patents. At its centennial in 1984, the Union's membership numbered ninety-two nations, including the United States.[14] Although the Union was initially composed solely of developed nations, developing countries comprise approximately one-half of the membership today.[15]

The Paris Union is neither a multinational nor supranational

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as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

Id.

9. BLACK'S LAW DICTIONARY 1336 (unabridged 5th ed. 1979).

10. For instance, in the United States the trademark must be used to identify the goods with which it is used and distinguish those goods from others. United States courts look to four factors in determining the validity of a trademark. These are: genericness, distinctiveness, secondary meaning, and descriptiveness. Although trademark definitions vary widely throughout the world, nearly all nations prohibit the use of any national flag, symbol, or insignia for use as a trademark. E. KINTNER & J. LAHR, AN INTELLECTUAL PROPERTY LAW PRIMER 256-61 (2d. ed. 1982).

11. Paris Union, *supra* note 3.

12. J. GILSON, *supra* note 6, § 9.01[1].

13. Schuyler, *Paris Convention for the Protection of Industrial Property — A View of the Proposed Revisions*, 8 N.C.J. INT'L L. & COM. REG. 155, 165 (1983).

14. *Id.* at 155.

15. *Id.* at 157.

treaty.[16] Rather, the Union operates under the concept of "national treatment."[17] Each member must grant nationals of other member nations the same protection it grants to its own nationals.[18] Each member nation passes and enforces its own trademark and patent laws. The Paris Union limits the registration of a mark to the state which grants it, and does not provide an extraterritorial mechanism to enforce its provisions.[19] Therefore, trademark protection under the Paris Union is only as good as individual national laws.[20] A trademark owner can only expect the same protection given to citizens within the country where he brings an infringement action.

The Paris Union contains three articles which specifically apply to commercial counterfeiting: Article 6*bis*, Article 9, and Article 10*bis*.[21] Article 6*bis* prohibits the use and registration of confusing trademarks, and requires each member nation to refuse registration of any mark that is an imitation of a mark well known in that nation.[22] Article 9[23] prohibits the importation of goods bearing unlawful trade-

16. Under a multinational treaty a signatory's national laws control. However, these national laws are passed pursuant to the language and provisions of the treaty itself. Consequently, until the treaty provisions are made a part of the signatory's body of law the treaty really has no force or effect. Conversely, a supranational treaty replaces national laws altogether, the trademark owner need only look to the provisions of the treaty. J. GILSON, *supra* note 6, § 9.01[1].

17. Paris Union, *supra* note 3, arts. 2, 3. Article 2(1) provides:

> (1) Nationals of any country of the Union shall, as regards the protection of industrial property, enjoy in all the other countries of the Union the advantages that their respective laws now grant, or may hereafter grant, to nationals; all without prejudice to the rights specially provided for by this Convention. Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided that the conditions and formalities imposed upon nationals are complied with.

Id.

Article 3 provides:

> Nationals of countries outside the Union who are domiciled or who have real and effective industrial or commercial establishments in the territory of one of the countries of the Union shall be treated in the same manner as nationals of the countries of the Union.

Id.

18. J. GILSON, *supra* note 6, § 9.01[1]. *See also* Paris Union, *supra* note 3, art. 3.

19. Schuyler, *supra* note 13, at 160.

20. Rakoff & Wolff, *supra* note 2, at 533.

21. *Id.* at 532-33.

22. Paris Union, *supra* note 3, art. 6*bis*.

23. *Id.* art. 9(1), which requires that "[a]ll goods unlawfully bearing a trademark or trade name shall be seized on importation into those countries of the Union where such mark or trade name is entitled to legal protection."

marks entitled to protection in that member country.[24] Also, such goods may be seized when permitted by national law.[25] Seizure procedures are relatively fast and are effective to the extent that the goods are confiscated before any damage is done.[26] Finally, Article 10*bis* provides protection against unfair competition.[27] Member nations must assure all other members effective protection against unfair competition. Subsequently, Article 10*bis* prohibits acts or allegations which create confusion with, or discredit a competitor, and any allegations liable to mislead the public about the nature, characteristics, or quantity of the goods.[28]

A trademark can be registered in any member nation of the Paris Union so long as it does not violate any article of the Union or does not infringe upon a mark already granted to another.[29] Article 4 of

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24. Such trademarks are "unlawful" because another has already acquired the mark in that country either by use or registration. *Id.* art. 10*bis*. Article 10*bis* provides:

> (1) The countries of the Union are bound to assure to nationals of such countries effective protection against unfair competition.
>
> (2) Any act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition.
>
> (3) The following in particular shall be prohibited:
>
> 1. all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor;
>
> 2. false allegations in the course of trade of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities, of a competitor;
>
> 3. indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods.

Id.

25. Rakoff & Wolff, *supra* note 2, at 533. *See also* Paris Union, *supra* note 3, art. 9(3), which provides: "Seizure shall take place . . . in conformity with the domestic legislation of each country."

26. Schuyler, *supra* note 13, at 164-65.

27. Paris Union, *supra* note 3, art. 10*bis*.

28. *Id.* art. 10*bis* (3).

29. Paris Union, *supra* note 3, art. 6*quinquies*. Article 6*quinquies* B. reads:

> B. — Trademarks covered by this Article may be neither denied registration nor invalidated except in the following cases:
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> 1. when they are of such a nature as to infringe rights acquired by third parties in the country where protection is claimed;
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> 2. when they are devoid of any distinctive character, or consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production, or have become customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed;
>
> 3. when they are contrary to morality or public order and, in particular, of such a nature as to deceive the public. It is understood that a mark may not be considered contrary to public order for the sole reason that it does not con-

the Paris Union provides for retroactivity of trademark registration.[30] For example, if a trademark is filed in a member country, the holder then has six months to meet the registration requirements of other member countries where he also wishes to file.[31] If the trademark owner satisfies these requirements within six months from his first filing, then the subsequent registrations relate back to the date of first filing.[32] Retroactivity is a very important concept because a trademark holder can defeat the trademark claims of a third party by virtue of his priority of date registration.

Article 6*quinquies* provides that a trademark duly registered in the country of origin[33] shall be protected by all members of the Union.[34] Each country is required to extend domestic protection to the trademark holder. However, there still exists no extraterritorial mechanism for enforcement. Registration may be denied only if the trademark would infringe the rights of third parties, is contrary to morality or the public order, or is devoid of distinctive character.[35] Article 6*quinquies* A was implemented at the 1967 Stockholm Revision to the Paris Union and modified the Article 6*telle quelle* provision.[36] The *telle quelle* provision required each member nation to accept another member's registration of a trademark in the very same form. Today, as a result of the *telle quelle* provision modification,[37] a trademark may be denied registration under a member's law based on the broad grounds set forth in Article 6*quinquies*.[38] Those broad grounds include immoral or descriptive marks, marks incorporating a national emblem, or marks that interfere with the prior rights of do-

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form to a provision of the legislation on marks, except if such provision itself relates to public order.

This provision is subject, however, to the application of Article 10*bis*.

Id.

30. Schuyler, *supra* note 13, at 160. *See also* Paris Union, *supra* note 3, art. 4.

31. Schuyler, *supra* note 13, at 160.

32. *Id.*

33. A country of origin is one where the applicant is domiciled or maintains an industrial or commercial establishment. Paris Union, *supra* note 3, art. 6*quinquies*.

34. *Id.*

35. *Id.*

36. Zelnick, *Shaking the Lemon Tree: Use and the Paris Union Treaty*, 67 TRADE-MARK REP. 329, 337 n.18 (1977).

37. The *telle quelle* provision exceptions are enumerated in article 6*quinquies* B and include denial based on the prior rights of domestic proprietors, national emblems, immorality, descriptiveness, and the like. Paris Union, *supra* note 3, art. 6*quinquies*.

38. Derenberg, *The Myth of the Proposed International Trademark Registration Treaty (TRT)*, 68 TRADE-MARK REP. 433, 443 (1978).

mestic proprieters.[39]

Under the Paris Union, a trademark set aside in one member country does not result in that trademark's invalidation in the other member countries.[40] That is a consequence of each member country's registration being independent from every other member country's registration.[41] Therefore, the trademark owner is forced to invalidate the counterfeit mark separately in each country where the infringing third party has registered.

As a result of the increase in membership of developing nations to the Paris Union there have been increasing pressures to amend the treaty to favor developing nations. If the 1981 Nairobi Revision to the Union[42] is an indication of things to come, then trademark owners may be facing additional problems in protecting their rights.[43] At the Nairobi Revision developing countries nearly succeeded in getting two provisions enacted.[44] The first was the compulsory exclusive license whereby a member country requiring that goods manufactured under a patent be manufactured domestically can grant a patent to a domestic manufacturer when the original patent holder does not manufacture there. Once a compulsory exclusive license is issued, the original patent holder may no longer import his goods into that country.[45] The second provision was the "automatic forfeiture" provision, which empowered a government official to subjectively cancel a patent at any time within five years of the patent grant.[46] Consequently, the aim of developing countries to achieve leverage and/or lower prices for products may result in an erosion of the protections afforded by the Paris Union.

Because the Paris Union functions under national treatment, whether protection is afforded to trademarks based upon their registration or use differs country by country. However, there is a growing tendency throughout the world to grant protection to a trademark

39. Paris Union, *supra* note 3, art. 6*quinquies*.

40. Schuyler, *supra* note 13, at 161. Article 4 A(1) of the Paris Union seemingly brings trademarks under the ambit of article 4*bis*. Paris Union, *supra* note 3, art. 4.

41. Schuyler, *supra* note 13, at 160.

42. Held at Nairobi, Kenya, 1981. *Id.* at 162.

43. *Id.*

44. Although both provisions involved patents, they may be indicative of how developing countries may strive to favor their own nationals at the expense of foreign trademark owners in years to come. *Id.*

45. *Id.*

46. Under the Nairobi Revisions a government official need not base the cancellation upon objective criteria. Rather, it appears any reason could suffice. *Id.*

which has neither been used nor registered in a particular country.[47] In some instances a mark may be well-known worldwide, but neither registered nor imported into a particular country. The trademark holder can overcome misappropriation of his mark in that country through Article 6*bis* of the Union. Under Article 6*bis*, the trademark owner may prevent or cancel another's trademark application in that country because it is confusingly similar or identical to his own well-known mark.[48] There are three prerequisites to invoking Article 6*bis*. These are: the trademark must be "well-known" in that country, the challenged mark must be used on similar or identical goods, and the trademark owner bringing the challenge must be from a member country.[49]

The Paris Union is effective to the extent that it ensures minimum trademark protections among its member states. Foreign trademark holders are guaranteed those protections granted to domestic trademark holders. Additionally, the Union provides for seizure proceedings which are a valuable asset to trademark holders. Unfortunately, the Union's primary accomplishment, national treatment, is also its greatest shortcoming. The concept of national treatment prevents the implementation of an extraterritorial mechanism for enforcement and a central agency for trademark applications and filing. If the Convention contained those provisions it would be an enormously effective document and life for trademark owners would be greatly simplified.

B. The Trademark Registration Treaty

The Trademark Registration Treaty (TRT) was signed by the United States and seven other nations in Vienna, Austria on June 12, 1973.[50] Presently, the TRT numbers fourteen member nations and will become effective six months after five signatory nations ratify it.[51] The TRT is a multinational treaty. Therefore, assuming it is implemented it would effectively establish multinational trademark regis-

47. Hoffmann & Brownstone, *Protection of Trademark Rights Acquired by International Reputation Without Use or Registration*, 71 TRADE-MARK REP. 1, 1 (1981).

48. *Id.* at 2. *See also* Paris Union, *supra* note 3, art. 6*bis*.

49. *Id.* Article 6*bis* lends no criteria for what makes a mark "well-known" within a particular country. Paris Union, *supra* note 3, art. 6*bis*.

50. Pattishall, *The Use Rationale and the Trademark Registration Treaty*, 61 A.B.A.J. 83, 83 (Jan. 1975).

51. J. GILSON, *supra* note 6, § 9.02.

tration through a single application.[52] The TRT would be administered by WIPO in Geneva, Switzerland and would provide an alternative method for central filing. This treaty is not designed to replace the existing national registration procedures of the member countries.[53] Rather, each member would be free to determine, under its own national laws, whether the proposed trademark is eligible for domestic registration. Each trademark would be considered ex parte and may be refused registration even if there was no national mark with which it could be confused.[54] In his application, the trademark applicant would list the nations in which he wants to register. Each nation would then be free to either accept or reject the application. If rejected, the applicant must be given the grounds for rejection within fifteen months from his date of application.[55]

The TRT is a compromise between those countries adhering to the registration rationale and those adhering to the use rationale.[56] Most of the world adheres to the registration rationale, whereby a trademark is granted upon the applicant's "intention to use" the mark within a prescribed period of time. Conversely, the United States adheres to the use rationale, which favors actual use of a trademark over simple registration.[57] Accordingly, the United States Patent Office denies registration of foreign trademarks registered in member nations but not in use anywhere in the world. If ratified, the TRT would require the United States to relinquish all use requirements to trademark registration. All member nations would have to satisfy themselves with the applicant's intention to use the trademark.[58] Actual use would not be required for a minimum of three years and could be expanded to five years at the discretion of a member nation.[59]

Obviously, if the TRT were ratified by the United States drastic changes would have to be made in the national laws. Even if the United States did ratify the TRT and made the subsequent Lanham

52. *Id.* § 9.01[1].

53. *Id.* § 9.02.

54. Each member would consider the trademark application within the frame and scope of the Paris Union's article 6*quinquies' telle quelle* provision. Derenberg, *supra* note 38, at 443.

55. Because the applicant is given grounds for the refusal, or potential refusal, he may remedy the application to conform to the specific national law. Further, the applicant can request a proceeding between himself and the national office in which objections to registration may be aired and overcome. J. GILSON, *supra* note 6, § 9.02.

56. Pattishall, *supra* note 50, at 83.

57. *Id.*

58. Derenberg, *supra* note 38, at 439.

59. *Id.* Pursuant to TRT Article 19(3)(b).

Act changes, many more nations would have to ratify the TRT for it to provide effective international protection for the trademark owner.[60] Furthermore, the TRT remains vulnerable to several shortcomings. Specifically, the TRT would only apply to, at most, the members of the Paris Union. The commercially-important non-Union countries would be excluded.[61] Additionally, the TRT does not contain a "central attack" provision. Without that provision trademark cancellation must be done on a member-by-member basis rather than by one central agency cancellation.[62] Overall, the inherent costs to the United States in drastic domestic law changes appear to outweigh the benefits of international trade standardization. Central filing may be convenient to the trademark applicant, but it still remains an insufficient remedy for counterfeiting.

C. The Proposed Anticounterfeiting Agreement

The General Agreement on Tariffs and Trade (GATT) is scheduled to meet in Geneva, Switzerland in the Fall of 1986. One of the items on the agenda is the passage of an International Anticounterfeiting Code. The proposed Anticountefeiting Code is largely attributable to the International Anticounterfeiting Coalition, which is comprised mainly of companies, trade associations, and government agencies.[63] The proposed Code seeks to strengthen the basic seizure and forfeiture laws regarding counterfeit goods that attempt to clear customs into member nations.[64] The purpose of the Anticounterfeiting Code is to provide an effective deterrent to international products counterfeiting.[65] Such a deterrent would prevent counterfeiters from shipping their goods to signatory nations, thereby significantly lessening counterfeiting revenues and incentives.[66]

The Code provisions are designed to thwart counterfeiters through the institution of safeguards at each member nation's customs point.[67] Each signatory nation would establish its own proce-

60. J. GILSON, *supra* note 6, § 9.02.

61. Countries not members of the Paris Union include: Taiwan, Peoples Republic of China, India, Peru, Chile, Pakistan, Thailand, Colombia, and Venezuela.

62. Derenberg, *supra* note 38, at 442.

63. *Putting Teeth in the Trademark Laws*, *supra* note 1, at 75.

64. Rakoff & Wolff, *supra* note 2, at 533.

65. *Putting Teeth in the Trademark Laws*, *supra* note 1, at 75-76.

66. Walker, *A Program to Combat International Commercial Counterfeiting*, 70 TRADEMARK REP. 117, 124 (1980).

67. Telephone interview with Alice Zalik, Office of the Special Trade Representative, Department of International Affairs, Washington D.C. (Mar. 7, 1986).

dures which the trademark owner must then follow.[68] The trademark owner may have the burden of alerting the proper officials in each nation of past or possible future counterfeiting violations, depending on the specific nation's procedure. Once counterfeit goods are seized at the customs point the trademark owner is notified and a hearing is held to determine the status of the goods.[69] If they are indeed counterfeit, the Code recommends the goods be forfeited.[70] If implemented, the Code will provide the only means of internationally detecting and seizing counterfeit goods. Currently, there is no such method. Many of the Code provisions are already a part of, and in fact were based upon, United States seizure and forfeiture laws.[71] An obvious prerequisite to invoking the Code seizure and forfeiture provisions is registration of the trademark in the country of importation. Hence, the proposed Code would be an enforcement arm of existing international trademark agreements.

The proposed Anticounterfeiting Code has a dual character. It signifies a government-to-government agreement, yet has the force and effect of domestic law.[72] As governmental agreements, the Code provisions can only be invoked at the government level. However, these agreements require the signatories to adopt the Code provisions in their national laws. Upon ratification in the national law, the individual company can invoke these domestic provisions to seek relief from counterfeiting.[73]

If implemented, the Code will provide a strong enforcement tool against international counterfeiters. However, the proposed Code also has several deficiencies. First, it does not reach counterfeit goods once the goods pass through customs. After the goods clear customs, national law controls unless another international agreement applies. As a result, the Code provisions must work at a member nation's border or not at all. Second, the Code provisions do not reach domestic counterfeits. If the counterfeit goods are not exported to a signatory nation the Anticounterfeiting Code is inapplicable. In sum, the proposed Code only applies to those goods moving in international com-

68. *Id.*

69. *Id.*

70. Walker, *supra* note 66, at 124.

71. The enactment of the International Anticounterfeiting Code would also increase domestic protection in the United States. It would add another method to traditional Lanham Act and state unfair competition procedures in protecting American trademark owners. *Id.* at 125.

72. *Id.* at 122.

73. *Id.*

merce, and only when they are at the signatory's border.[74]

Overall, the proposed International Anticounterfeiting Code is a step towards enforcement against commercial counterfeiting. It also serves to involve nations in preventing the importation of counterfeit goods into their territories. Despite its shortcomings it may very well serve as a first step towards strict international anticounterfeiting laws.

III. INTERNATIONAL COPYRIGHT PROTECTION

Copyright laws protect an author's or originator's moral and monetary interests in his work.[75] Copyright is a right of literary property granted by statute to an author or originator of certain classes of literary or artistic works. Copyright gives an author or originator the sole and exclusive privilege for multiplying, publishing, and selling his work, for a limited period of time.[76] The principal purpose of copyright law is to recognize and protect the rights of authors in their works and supply an incentive for further creation of such works.[77] Generally, copyright protection extends to the following categories of work: literary, musical, dramatic, pantomime, choreographical, pictoral, sculptural, motion picture, audio-visual, and sound recording.[78] Copyright protection is granted primarily through national legislation. As with trademarks, such protection varies from nation to nation. However comprehensive and protective a nation's copyright protection may be, it is unimportant to an author whose work is being infringed outside of that nation. There is no extraterritorial enforcement of those protections. Rather, the author must look to international copyright agreements for protection or redress.

There are four ways an author can protect his work from infringement which occurs internationally. These are: multilateral treaties, bilateral treaties, reciprocity, or bringing an action directly in the pirate's nation under that nation's law.[79] In theory there is a fifth method; namely, suing in the author's own national courts. However, the copyright pirate would have to submit to the author's juris-

74. Rakoff & Wolff, *supra* note 2, at 534.

75. Tocups, *The Development of Special Provisions in International Copyright Law for the Benefit of Developing Countries*, 29 J. COPYRIGHT SOC'Y U.S.A. 402, 403 (1982).

76. *Id.*

77. E. KINTNER & J. LAHR, *supra* note 10, at 339.

78. All of these are considered "writings" under the United States 1976 Copyright Act. *Id.* at 350.

79. Tocups, *supra* note 75, at 403.

diction. For obvious reasons, that is highly unlikely. Only the major multilateral treaties which offer protection to American authors will be discussed in this comment.

A. The Berne Convention

The Berne Convention for the Protection of Literary and Artistic Works was adopted in 1886.[80] It is the oldest multilateral treaty for copyright protection and presently includes seventy-four members. The Berne Convention, like the Paris Union, was founded on the concept of national treatment[81] and abolished the formalities of notice and deposit[82] except for those required by the author's country of origin.[83] Although the United States has never joined the Berne Convention, American authors have received the Convention's protection when they first or simultaneously publish their work in a member country.[84]

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80. Berne Convention, *supra* note 5.

81. *Id.* art. 3(1), (2), which provides:

> (1) The protection of this Convention shall apply to:
>
> *(a)* authors who are nationals of one of the countries of the Union, for their works, whether published or not;
>
> *(b)* authors who are not nationals of one of the countries of the Union, for their works first published in one of those countries, or simultaneously in a country outside the Union and in a country of the Union.
>
> (2) Authors who are not nationals of one of the countries of the Union but who have their habitual residence in one of them shall, for the purposes of this Convention, be assimilated to nationals of that country.

Id.

82. Previously, protection required that the author affix a notice on the work indicating that the work was his creation, and deposit that work into a certain national library (dependent upon the country of deposit). A. LATMAN, HOWELL'S COPYRIGHT LAW 86-88 (4th ed. 1962). *See* Berne Convention, *supra* note 5, art. 5(2).

83. Comment, *International Copyright*, 13 GA. J. INT'L & COMP. L. 83, 86-87 (1983).

84. Olian, *International Copyright and the Needs of Developing Countries: The Awakening at Stockholm and Paris*, 7 CORNELL INT'L L.J. 81, 83 (1974). Article 6 of the Berne Convention is known as the "back door" to the Convention and provides:

> (1) Where any country outside the Union fails to protect in an adequate manner the works of authors who are nationals of one of the countries of the Union, the latter country may restrict the protection given to the works of authors who are, at the date of the first publication thereof, nationals of the other country and are not habitually resident in one of the countries of the Union. If the country of first publication avails itself of this right, the other countries of the Union shall not be required to grant to works thus subjected to special treatment a wider protection than that granted to them in the country of first publication.
>
> (2) No restrictions introduced by virtue of the preceding paragraph shall affect the rights which an author may have acquired in respect of a work published in a country of the Union before such restrictions were put into force.
>
> (3) The countries of the Union which restrict the grant of copyright in accordance with this Article shall give notice thereof to the Director General of the World Intellectual Property Organization (hereinafter designated as "the Director Gen-

The Berne Convention is premised on the principles that the artist should receive maximum protection, that members adopt minimum standards to protect the artist's interests,[85] and that members grant equal protections to foreign and national artists alike.[86] Specifically, an artist's work is protected for his life plus fifty years.[87] Additionally, the Berne Convention now prohibits the imposition of formalities to act as a bar to copyright protection. "Formality" is defined as any condition on which the existence of the right depends, such as registration fees and deposit of copies into national libraries.[88] Finally, the Berne Convention recognized the artist's moral right at the Rome Conference in 1928.[89] This right is deemed separate from the artist's copyright and cannot be assigned.[90] Moral right gives the artist the power to prohibit any modification of his work and to claim paternity.[91] The duration of moral right is set by the Convention, but the specific conditions of protection are left to each particular member's legislation.[92] Copyright protection under the Berne Convention is afforded to any artist who first or simultaneously publishes his work in a member country, and the definition of copyrightable works is broader than that in the United States, which only protects "writ-

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eral") by a written declaration specifying the countries in regard to which protection is restricted, and the restrictions to which rights of authors who are nationals of those countries are subjected. The Director General shall immediately communicate this declaration to all the countries of the Union.

Berne Convention, *supra* note 5, art. 6.

85. These interests include the following: reproduction, translation, public performance, recitation, broadcasting, cinematography, adaptation, and recording of musical works. Berne Convention, *supra* note 5, arts. 6*bis*, 8-14.

86. Comment, *Abandon Restrictions, All Ye Who Enter Here!: The New United States Copyright Law and the Berne Convention*, 9 N.Y.U. INT'L L. & POL. 455, 457 (1977).

87. Berne Convention, *supra* note 5, art. 7(1), which provides: "The term of protection granted by this Convention shall be the life of the author and fifty years after his death."

88. *Id.* art. 5(2). "The enjoyment and exercise of these rights shall not be subject to any formality; such enjoyment and such exercise shall be independent of the existence of protection in the country of origin of the work." *Id.*

89. *Id.* art. 6*bis*(1), which reads:

> Independently of the author's economic rights, and even after the transfer of said rights, the author shall have the right to claim authorship of the work and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation.

Id.

90. Comment, *Author's Expression: The Necessity for U.S. Protection Through Statute and Multilateral Treaty*, 9 SYRACUSE J. INT'L & COMP. L. 137, 151 (1982).

91. *Id. See also* Berne Convention, *supra* note 5, art. 6*bis*(1).

92. Berne Convention, *supra* note 5, art. 6*bis* (2).

ings."[93] American artists find the Berne Convention desirable because it extends the greatest protection given artists by any multilateral copyright treaty. Further, the artist receives Berne Convention protection plus the specific protections of the country in which he publishes.[94]

The impediment to the United States' entry into the Berne Convention stems from its disagreements over the Convention's general philosophy, as well as certain specific provisions. The Berne Convention considers copyright an extension of the artist's personality and, consequently, as a basic human right.[95] Conversely, the United States operates under a statutory system of copyright founded upon constitutional provision[96] and dependent upon compliance with legislative requirements.[97] Until the Copyright Act of 1976 the United States' and the Berne Convention's approach to copyright protections differed greatly. For instance, while the Berne Convention prohibited any formality from barring copyright protection, the United States maintained strict requirements regarding notice, entry of title, deposit, and United States manufacture.[98] In addition, the Berne Convention recognizes creation of a copyright upon a work's creation rather than on publication, a greater length of copyright protection, and the artist's moral right. As a result of the 1976 Copyright Act these differences have been largely minimized.[99] Presently, the only major area of contention is recognition of the artist's moral right. Because the United States premises its copyright law upon completely assignable property rights it will not be easily reconciled with the Berne Convention's position of copyright being a non-assignable personal right. Further modification of the 1976 Copyright Act to require only a simple notice requirement and the insertion of the moral

93. The Berne Convention expressly protects dance, mime, architecture, and other artistic works while the United States only impliedly protects them as "writings." *See* E. KINTNER & J. LAHR, *supra* note 10, at 339. *See also* Berne Convention, *supra* note 5, art. 2.

94. Berne Convention, *supra* note 5, art. 5(1).

95. Comment, *supra* note 86, at 458.

96. U.S. CONST. art. 1, § 8, cl. 8 (empowering Congress to secure to "Authors" the exclusive right to their "Writings").

97. Comment, *supra* note 86, at 458.

98. Comment, *supra* note 83, at 87. Prior to the 1976 Copyright Act, in order for English language works to receive protection in the United States the works must have been manufactured domestically. *See id.* at 87 n.35.

99. Comment, *supra* note 90, at 151. The United States now provides the Berne Convention's protection of life plus fifty years for those works created on or after January 1, 1978. Previously, the duration was for twenty-eight years from the date of first publication. Also, copyright is now granted at the work's creation, not its publication. *Id.*

rights doctrine would suffice to bring the United States into line with the Berne Convention and the majority of the world's nations.[100]

B. The Universal Copyright Convention

The second major multilateral treaty covering copyrights is the Universal Copyright Convention (U.C.C.).[101] The U.C.C. was sponsored by and is administered by the United Nations Educational Scientific and Cultural Organization (UNESCO).[102] The U.C.C. presently numbers approximately seventy-three member nations, including the United States.[103] In fact, following World War II the United States spearheaded the movement toward creation of a second multinational copyright treaty.[104] This resulted in the creation of the U.C.C., which is essentially a compromise between the copyright principles of the United States and the Berne Convention. As a consequence, the U.C.C. offers much less protection to the artist than does the Berne Convention. However, ratification of the treaty ended the United States' previous non-cooperation and non-participation in the international copyright conventions.[105]

The U.C.C. was a compromise which neither forced the United States to meet the more stringent Berne Convention standards nor forced that Convention to lower its standards.[106] Prior to U.C.C. ratification there were at least a dozen multilateral and one hundred bilateral treaties in force. Conflict between the Berne Convention and the U.C.C. was minimized by several U.C.C. provisions. Certainly the most important, Article XVII, affirmed a co-existence between the U.C.C. and the Berne Convention.[107] Any disparities between the

100. *Id.* at 160-61.

101. Universal Copyright Convention, *ratified* Sept. 6, 1952, 6 U.S.T. 2731, T.I.A.S. No. 3324, 216 U.N.T.S. 132, *revised* July 24, 1971, 25 U.S.T. 1341, T.I.A.S. No. 7868 [hereinafter cited as U.C.C.].

102. Comment, *supra* note 90, at 153.

103. U.C.C., *supra* note 101.

104. Comment, *supra* note 83, at 88. There existed great pressure for the United States to join a major multilateral copyright treaty because many Berne Convention members were angry over Americans simultaneously publishing in Convention countries and thereby enjoying Berne protections. The Berne Convention was likely to foreclose this benefit to Americans unless the United States became a signatory to the U.C.C. *Id.*

105. *Id.*

106. Olian, *supra* note 84, at 86. U.C.C. article XVII, paragraph 1, provides that "this Convention shall not in any way affect the provisions of the Berne Convention for the Protection of Literary and Artistic Works . . . or membership in the Union created by that Convention."

107. Comment, *supra* note 86, at 459.

two treaties are resolved in favor of the Berne Convention.[108] Consequently, many nations are members of both conventions.

The United States ratified the U.C.C. primarily because of the treaty's principle of national treatment and the absence of the moral right doctrine.[109] Thus, under the U.C.C. if an American author's work is infringed upon in Mexico the controlling copyright law is that of Mexico. Protection is conditioned upon either the author being a national of a U.C.C. member country or first publishing in a member country.[110] Because there are no U.C.C. provisions on moral rights, the United States was not forced to reconcile its purely economic copyright philosophy with the contrasting personal right philosophy of the Berne Convention.

Further inducements to United States ratification of the U.C.C. were the formalities requirement, the term of copyright protection, and the absence of specific provisions regarding works to be protected. As noted earlier, the Berne Convention is contrary on all of these points.[111] Although the U.C.C. limits the number of formalities required as a condition precedent to copyright protection, it retained the simple notice requirement.[112] Consequently, all that is required is the copyright symbol, the copyright proprietor, and the year of publication.[113] The minimum duration of copyright protection under the U.C.C. is life plus twenty-five years. Members are free to grant increased durations and those members that measure duration from the date of publication must grant at least twenty-five years of copyright protection.[114]

IV. CONCLUSION

A. Trademarks

International products counterfeiting and trademark infringement have been rising rapidly because the potential for profits is great while the risk is small. There is presently no major multilateral treaty

108. U.C.C., *supra* note 101, arts. XVII, XIX.

109. Comment, *supra* note 90, at 154.

110. *Id.* Additionally, a United States national must still comply with United States copyright law to receive U.C.C. protection. This compliance is required of all nationals who wish to receive U.C.C. protection. U.C.C., *supra* note 101, art. III.

111. *See supra* notes 80-100 and accompanying text.

112. U.C.C., *supra* note 101, art. III, para. 1.

113. *Id.* A member nation may still require strict formalities for nationals or those publishing a work within its territory. *Id.*

114. *Id.* art. IV.

which imposes stiff penalties on counterfeiters nor adequate monitoring devices to catch them. The trademark owner generally must do all the work in detecting the counterfeiter and putting a stop to the illicit activity. Oftentimes a trademark owner will begin to register his mark in a particular country or export his goods there, only to discover that his trademark has already been registered there by another. In such a case the foreign trademark holder is forced to purchase the prior registration, operate the sale of goods in that country through the person who holds the domestic registration, or withdraw from business in that country altogether. Although existing international multilateral treaties afford minimum protections among member nations, they do not provide a central filing system for registering trademarks nor do they provide a central attack provision for invalidating spurious marks.[115]

The Paris Union, despite its large membership, is phrased in general terms and contains no specific standards for registration or trademark protection.[116] The members are free to devise their own procedures and protection is left entirely to the individual nation when an infringement occurs within its territory. This concept of "national treatment" in trademark law is nothing different than what exists in almost all areas of the law. A nation is the sovereign within its borders and accordingly makes its own law. Finally, the Union has no detection or prosecution mechanism for enforcing its trademark provisions. Hence, there is little deterrent effect upon international counterfeiters.[117] Any deterrence must necessarily be the result of national laws. Thus, the effectiveness of the Paris Union is only as good as the individual laws of the member countries.

The TRT does not provide significantly better protection than the Paris Union. Although it seeks to implement a central filing agency for trademark registration, each member nation is free to accept or reject the trademark application. The TRT also functions under the concept of national treatment. Additionally, the TRT does not contain a central attack provision. Therefore, the trademark owner must still work to invalidate spurious marks nation-by-nation. Obviously, the high costs involved in such a task cause some trade-

115. One salient problem is that a mark invalidated in one country is not necessarily "spurious" in another country. A central attack provision would invalidate a mark in all member nations subsequent to invalidation under the treaty.

116. Rakoff & Wolff, *supra* note 2, at 533.

117. *Id.*

mark owners to either succumb to "trademark blackmail" or forego importation into a particular country altogether.

The proposed International Anticounterfeiting Agreement provides only a partial solution to the counterfeiting problem. The proposed Code provisions do not reach domestic counterfeit goods or those counterfeit goods that have cleared customs. However, despite its deficiencies, the proposed Code is at least a mechanism for the detection of, and enforcement against, counterfeit goods.

The optimal situation for the trademark owner would be harmonization of world trademark laws. However, because of the conflict between the use and registration systems, the developed-developing country dichotomy, and the concept of sovereignty, harmonization of world trademark laws in the near future is unlikely. Consequently, the trademark owner must use whatever means are currently available for international protection. Groups such as the International Anticounterfeiting Coalition are an effective means for individual companies to put pressure on their national governments for stricter trademark protection. Governments make the laws in the international arena, and one government may be able to persuade others to invoke provisions for treaty enforcement and specific remedies against counterfeiters such as jail terms or stiff fines. Without effective deterrents, the treaties have no real force or impact on counterfeiting. A more direct approach for trademark owners is to register or use their marks in as many countries as possible. The costs and mechanics of such a course of action, however, may be prohibitive. If possible, the trademark owner should identify those countries to which he plans to import his goods within the next three to five years and attempt to register his mark there immediately.[118] The trademark owner should also be pragmatic and retain the assistance of foreign counsel in the countries where he seeks to register, create a subsidiary company, or prevent counterfeiting. The vast differences among nations regarding trademark treatment require that the individual trademark owners do most of the work.

B. Copyrights

As the copyright discussion indicates, the Berne Convention extends much greater protection to the artist than does either the U.C.C. or United States domestic law. The basic resolution of con-

118. J. GILSON, *supra* note 6, § 9.01[5]. Professor Gilson sets out a possible registration priority checklist which he suggests trademark owners use. *Id.*

flict in the international copyright arena is to bring the United States law up to the standards set by the Berne Convention. The major stumbling block to United States membership in the Berne Convention is the simple notice requirement precondition to protection. If this were eliminated from the 1976 Copyright Act, the United States could then join the Convention.[119] A moral rights clause should also be added to United States law. Doing so would provide further protection to artists, and hence greater incentives to create. Finally, United States participation in the Berne Convention would help upgrade copyright protection worldwide. The effectiveness of the Berne Convention would be enhanced by superpower participation. Additionally, United States membership might eventually lead to even greater protections for artists worldwide.

At present, the best course of action for an American author is to simultaneously publish his work in the United States and a Berne Convention nation. Under Article 3(3) and (4) of the Berne Convention, "simultaneous" is defined as being within thirty days while "publication" is defined as a number sufficient to satisfy the reasonable needs of the public.[120] Since United States publication presupposes adherence to domestic copyright laws, the author is then protected domestically and internationally by both the U.C.C. and the Berne Convention. Generally, that is the maximum protection which an American author or originator can receive today.

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119. Comment, *supra* note 90, at 161.

120. Berne Convention, *supra* note 5, art. 3(3), (4). *See supra* note 85.