

JET-SETTING ORPHAN WORKS: THE TRANSNATIONAL MAKING AVAILABLE OF WORKS OF UNKNOWN AUTHORSHIP, ANONYMOUS WORKS, OR LOST AUTHORS

INTRODUCTION

One of the problems plaguing international copyright law today is the lack of clarity and consistency among the laws of different countries.¹ Because copyright law around the world continues to change with noted frequency, there is very little notice to copyright owners and authors as to the scope of protection afforded their works, as well as future notice to potential copyright users.² Nowhere is this problem more pervasive than in the laws concerning the transnational “making available” of orphan works.³

The term “orphan works” denotes those works in which “rightholders cannot be identified or, if they can be identified, they cannot be located”⁴ An orphan work has also been defined as:

a work protected by copyright but the current owner is unknown or untraceable by diligent search. The current owner of the copyright might be the author or other creator, some other first owner if the rights (such as the author’s employer—when applicable) or a publisher) or any right holder who is presumed to be the right holder according to the legislation or contractual agreement or any successor of the first owner.⁵

¹ See STEPHEN M. STEWART, *INTERNATIONAL COPYRIGHT AND NEIGHBOURING RIGHTS*, at v (1983).

² See Frédéric Pollaud-Dulian, *Foreword to 5 PERSPECTIVES ON INTELLECTUAL PROPERTY: THE INTERNET AND AUTHOR’S RIGHTS* (Frédéric Pollaud-Dulian ed., 1999).

³ Jane C. Ginsburg, *Recent Developments in US Copyright Law: Part I—“Orphan” Works* 18–19. (Columbia Law Sch. Pub. Law & Legal Theory Working Paper Group, Paper No. 08152, 2008) (published as Jane C. Ginsburg, *Recent Developments in US Copyright Law: Part I—“Orphan” Works*, 217 *REVUE INTERNATIONALE DU DROIT D’AUTEUR*, (2008)), available at http://lsr.nellco.org/columbia_pllt/08152.

⁴ EU High Level Expert Group, Copyright Subgroup, i2010: Digital Libraries, *Final Report on Digital Preservation, Orphan Works, and Out-of-Print Works*, § 5.1 (June 4, 2008), available at http://ec.europa.eu/information_society/activities/digital_libraries/doc/hleg/reports/copyright/copyright_subgroup_final_report_26_508-clean171.pdf [hereinafter E.U. Copyright Subgroup—Final Report].

⁵ Eur. Digital Libraries Initiative, *Joint Report: Sector-Specific Guidelines on Due Diligence Criteria for Orphan Works*, § 1.2 (2008), available at http://ec.europa.eu/information_society/activities/digital_libraries/doc/hleg/orphan/guidelines.pdf.

In the United States and elsewhere, this occurs as a result of missing or inaccurate information at the registration-seeking phase of copyright protection.⁶ Especially since the Berne Convention has abolished the requirement of any formalities before receiving copyright protection,⁷ there is no provision mandating that copyright owners register specific details of their work in order to receive protection.⁸ Berne Article 5(2) states that “enjoyment and the exercise of these rights shall not be subject to any formality.”⁹ Orphan work status can also result from older copyrights, which may not have been registered or were not submitted to an archival database, such as the Library of Congress for copyrighted works in the United States.¹⁰ To stress the enormous extent of this problem, the British Library estimates that 40% of its copyrighted collection is comprised of orphan works.¹¹ This means that many authors are not collecting licensing fees for the use of their works. It may also mean that some works are not being used or accessed at all because the author cannot be located. In the United States, some use of orphan works would still be permitted under a fair use analysis,¹² but the instances where fair use applies

⁶ EU Copyright Subgroup—Final Report, *supra* note 4, § 5.1.

⁷ Berne Convention for the Protection of Literary and Artistic Works art. 5(2), Sept. 9, 1886, 102 Stat. 2853, 828 U.N.T.S. 221 [hereinafter Berne Convention]. The Berne Convention states that “[t]he enjoyment and the exercise of these rights shall not be subject to any formality.” *Id.* For more information on the Berne Convention, *see infra* note 23.

⁸ *See* Berne Convention, *supra* note 7. This is not exactly the case in the United States, however. Section 407(a) of the Copyright Act states “the owner of copyright or of the exclusive right of publication in a work published in the United States shall deposit, within three months after the date of such publication—(1) two complete copies of the best edition” 17 U.S.C. § 407(a) (2006). Although failure to do so does not result in lack of protection, it does result in a monetary fine. *Id.* §§ 407(a), 407(d)(1).

⁹ Berne Convention, *supra* note 7, art. 5(2). A formality is a condition that must be satisfied prior to copyright protection. WILLIAM BRIGGS, *THE LAW OF INTERNATIONAL COPYRIGHT* 149–50 (Fred B. Rothman & Co. 1986) (1906). “The principal of these relate to deposit of copies of the work, registration of title, and other formalities, which have almost as many variations in mode as there are contracting States. The confusion created by these restrictions is such that the total abolition of them has been strongly advocated” *Id.* This total abolition of formalities has been achieved due to Berne. Berne Convention, *supra* note 7, art. 5(2).

¹⁰ *See* 17 U.S.C. § 407.

¹¹ Press Release, Digital Libraries Initiative, Agreement Between Cultural Institutions and Right Holders on Orphan Works (June 4, 2008), available at http://ec.europa.eu/information_society/newsroom/cf/itemlongdetail.cfm?item_id=4145.

¹² 17 U.S.C. § 107 (2006). The statute states:

Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.

are rare and do not solve the issue.¹³ For example, a newspaper could still report newsworthy expression from an orphan work, but a filmmaker could not adapt a screenplay by a lost author.¹⁴ Now, “would-be users . . . must decide whether to renounce their projects or to incur the risk that the copyright owner will reappear once the exploitation is underway, and will demand both injunctive and substantial monetary relief in an ensuing infringement action.”¹⁵

The issue of what law to apply to transnational disputes over copyright infringement is complicated, especially when it involves the transnational use of an already complicated group of works, such as orphan works, which may or may not have been used according to an appropriate scheme, such as a clearance search and/or payment of a licensing fee.¹⁶ And then, what country’s law should determine the correct “taking”¹⁷ of that orphan work? The central

Id. A fair use analysis consists of a four factor statutory test, which must be analyzed to determine whether a particular use qualifies for this exception. *See, e.g.,* Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 578 (1993). The first factor looks to the purpose and character of the use, meaning that transformative uses of a work are more likely to qualify as fair use, whereas superceding or commercial uses are less likely to qualify for the exception. *Id.* at 578–79. The second factor analyzes the nature of the copyrighted work. *Id.* at 586. Here, the court looks to see if the work is something traditionally covered by copyright (such as a fictional novel) or is something not traditionally covered by copyright law (such as a work more factual in nature). *Id.* The third factor is the amount and substantiality used in relation to the copyrighted work as a whole. *Id.* This means that if a user takes the majority of a work, or the heart of a work, he or she is less likely to qualify for the fair use defense to infringement. *Id.* at 587–88. The final factor in the test is the effect of the use on the market for the original work or the value of the original work as a whole. *Id.* at 590. This means that if the original author will be harmed in any way from the use, the new use is less likely to qualify for the fair use defense. *Id.* Although courts tend to discuss each of these factors in deciding whether a particular use qualifies, none of the factors are dispositive, and courts can weigh each factor’s value as it wishes. *Id.* at 577–78.

¹³ *See* 17 U.S.C. § 107 (noting the limited uses of a work that might qualify as fair use). Thus, the strict protection of orphan works would not hinder access for the public as long as such use fell within one of the uses allowed under the fair use statute.

¹⁴ *See id.* The use of original works “for purposes such as criticism, comment, news reporting, teaching . . . scholarship, or research, is not an infringement of copyright.” *Id.*

¹⁵ Ginsburg, *supra* note 3, at 2.

Potentially frustrated users range widely, from commercial entities who seek to reissue out-of-print works or to create new works based on ‘orphan’ works, to cultural institutions, notably museums and libraries, who seek to digitize works for preservation and educational purposes, to individuals who seek to incorporate an ‘orphan’ work in their webpage or blog.

Id.

¹⁶ A clearance search is an initial search that must be conducted by a potential user to locate the rightholder prior to using an orphan work. *See* E.U. Copyright Subgroup—Final Report, *supra* note 4, § 9.2. Works should not be declared orphaned merely because their author is difficult to locate. *Id.* A license fee entails paying the found rightholder for the exploitation of their work. *Id.*

¹⁷ A “taking” is merely the initial appropriation and use of a copyrighted work. A “taking” does not necessarily imply an infringing use. *See, e.g.,* Coree Thompson, *Orphan Works, U.S. Copyright Law, and*

problem here is that the choice of law could significantly affect the outcome of the case because countries differ as to the level of protection they give orphan works and, more generally, any copyrighted work.¹⁸ For example, Dutch law dictates that an employer owns all rights in works created by its employees in the course of their employment, whereas German law dictates that the company cannot exploit the work without the employee's consent.¹⁹ One can see how this might create confusion for a Dutch company wishing to exploit a work-for-hire in Germany.²⁰ In general, most countries' laws provide that before using an orphan work, some kind of reasonable search efforts must be made to locate the orphan work's author, and a potential user must either secure permission or pay for the use.²¹ A problem arises when users cannot find the author, continue with their infringing use regardless, and the author suddenly emerges and sues for infringement.²²

Currently, the international copyright regime does not cover the specific case of orphan works, leaving potential users baffled as to how to make use of an orphan work transnationally.²³ As it stands, the international copyright regime is composed of both the individual national copyright laws of each country, as well as the international and multilateral treaties that establish the

International Treaties: Reconciling Differences to Create a Brighter Future for Orphans Everywhere, 23 ARIZ. J. INT'L & COMP. L. 787, 816 (2006).

¹⁸ See generally *Société des auteurs des arts visuels et de l'image fixe v. SARL Google France*, Tribunal de grande instance [T.G.I.] [ordinary court of original jurisdiction] Paris, May 20, 2008, 05/12117, 1, 7–8, available at <http://www.foruminternet.org/specialistes/veille-juridique/jurisprudence/IMG/pdf/tgi-par20080520.pdf>. Compare U.S. Copyright Act of 1976, 17 U.S.C.A. §§ 101–1332 (2009) with Agreement on Trade-related Aspects of Intellectual Property Rights art. 45, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, Legal Instruments—Results of the Uruguay Round vol. 31, 33 I.L.M. 1125, 1215 (1994) [hereinafter TRIPS].

¹⁹ MIREILLE VAN EECLOUD, CHOICE OF LAW IN COPYRIGHT AND RELATED RIGHTS: ALTERNATIVES TO THE LEX PROTECTIONIS 19 (2003).

²⁰ According to U.S. law, one type of work made for hire is “a work prepared by an employee within the scope of his or her employment.” 17 U.S.C. § 101(C)(1) (2006).

²¹ See EU Copyright Subgroup—Final Report, *supra* note 4, § 5.1.

²² See Ginsburg, *supra* note 3, at 2.

²³ See, e.g., Berne Convention, *supra* note 7; TRIPS, *supra* note 18. However, the Berne Convention does provide that “countries of the Union shall not be required to protect anonymous or pseudonymous works in respect of which it is reasonable to presume that their author has been dead for fifty years.” Berne Convention, *supra* note 7, art. 7(3). This may be helpful for works that fall into that narrow category, but it does not provide for all orphan works, nor does it provide for the choice of law to be used in orphan work cases. Like many articles in the Berne Convention, Article 7(3) merely dictates the minimum amount of protection that is required of an individual nation's laws regarding intellectual property protection. See generally, Berne Convention, *supra* note 7.

minimum standards of protection for those national copyright laws.²⁴ One of the most important international copyright treaties is the Berne Convention for the Protection of Literary and Artistic Works (“Berne Convention”), which was originally signed in 1886 and most recently revised in Paris in 1971.²⁵ The Berne Convention is a non-self-executing treaty, which means that it must be implemented by national legislation in order to have effect.²⁶ The World Intellectual Property Organization (“WIPO”), a specialized agency of the United Nations in Geneva, Switzerland, administers the treaty.²⁷

The other treaty that significantly affects international copyright law is the Agreement on Trade-Related Aspects of Intellectual Property (“TRIPS”), which was established in 1994.²⁸ Unlike the Berne Convention, TRIPS is “expressly linked” to the World Trade Organization (“WTO”) and international trade issues.²⁹ Because of this, any country that wishes to be a member of the WTO must also adhere to the minimum standards of copyright protection set forth by TRIPS.³⁰ The other primary advantage of TRIPS is its enforcement mechanism, a Dispute Settlement Body, established under the auspices of the WTO.³¹ This judicial body enables member states to bring claims for violations of TRIPS directly to a WTO institution and provides the “threat of trade sanctions under the WTO.”³²

Although the Berne Convention and TRIPS seem to provide a well-established base for international copyright law, they have not provided for many of the situations that may arise in the field of international copyright, particularly orphan works.³³ Given the world’s advancing globalization, namely that the Internet and other technology provide a means for widespread infringement, amendments and additions to these treaties are necessary. Nowhere is this more apparent than in the case of orphan works, which neither Berne nor TRIPS mention explicitly.³⁴ Thus, as the international copyright

²⁴ DANIEL C.K. CHOW & EDWARD LEE, INTERNATIONAL INTELLECTUAL PROPERTY: PROBLEMS, CASES, AND MATERIALS 16 (2006).

²⁵ BRIGGS, *supra* note 9, at v; Berne Convention, *supra* note 7.

²⁶ CHOW & LEE, *supra* note 24, at 25.

²⁷ *Id.*

²⁸ *Id.*

²⁹ *Id.*

³⁰ CHRISTOPHER MAY, THE WORLD INTELLECTUAL PROPERTY ORGANIZATION: RESURGENCE AND THE DEVELOPMENT AGENDA 2 (2007).

³¹ CHOW & LEE, *supra* note 24, at 26.

³² *Id.*

³³ *See* Berne Convention, *supra* note 7.

³⁴ *See Id.*; TRIPS, *supra* note 18.

regime currently stands, it is not clear how and where orphan works claims should be adjudicated.³⁵

Although the United States has proposed legislation to deal with the use of orphan works, this Comment will not examine whether this legislation is useful or in compliance with international treaty obligations.³⁶ Nor will this Comment suggest changes or additions to the United States's proposed legislation in order to make the United States consistent with the approaches of other countries. Rather, this Comment will focus on which country's law should apply to both the initial "taking,"³⁷ of the orphan work, as well as what law should apply as to a subsequent copyright infringement claim. International treaties, such as TRIPS and the Berne Convention, and caselaw will be analyzed in order to suggest a solution to this current choice-of-law quandary. Because countries differ as to the stringency of the searches required prior to using an orphan work, as well as the amount of damages available to a recently surfaced rightholder, the choice of law could seriously affect the decision reached by a court.³⁸ In discussing and analyzing which country's law should apply to both the initial use of the orphan work as well as disputes that may arise concerning that use, this Comment will also discuss some of the policy concerns and theoretical approaches to copyright law and the goal of achieving a balance between protecting copyright owners and allowing the public access to information.³⁹

Part I of this Comment will discuss the lack of a universal system for determining the necessary steps required for securing permission for use of an orphan work transnationally, and it will give examples of different countries' current systems. Part II will address the inconsistencies that arise when courts

³⁵ See Berne Convention, *supra* note 7; TRIPS, *supra* note 18.

³⁶ See Orphan Works Act of 2006, H.R. 5439, 109th Cong. (2006) (proposed 17 U.S.C. § 514 of the Copyright Act of 1976). For a detailed discussion of whether this new legislation conforms with international treaty obligations, see Thompson, *supra* note 17.

³⁷ For an explanation of a "taking," see *supra* note 17.

³⁸ EU Copyright Subgroup—Final Report, *supra* note 4, § 5.1. The Copyright Subgroup, through its proposals, seeks "to ensure interoperability, enhance coordination and facilitate a multilingual access point." *Id.* § 5.5. The Copyright Subgroup would not have had these goals if the international copyright community were already acting in a cohesive manner. See *id.* § 5.1; Société des auteurs des arts visuels et de l'image fixe v. SARL Google France, Tribunal de grande instance [T.G.I.] [ordinary court of original jurisdiction] Paris, May 20, 2008, 05/12117, 1, available at <http://www.foruminternet.org/specialistes/veille-juridique/jurisprudence/IMG/pdf/tgi-par20080520.pdf>.

³⁹ The preamble to Berne, for example, stresses the importance of protecting authors, rather than public domain access, by stating that "[t]he countries of the Union, being equally animated by the desire to protect, in as effective and uniform a manner as possible, the rights of authors in their literary and artistic works." See Berne Convention, *supra* note 7, pmb1.

do not universally apply the same law as to the issue of infringement in an international copyright infringement dispute and that the conflict of law rules of different countries are not compatible. Part III will analyze the case of *Société des auteurs des arts visuels et de l'image fixe v. SARL Google France*⁴⁰ (“SAIF”) as an example of how choice of law can greatly affect the issue of transnational use of copyright and will offer an analysis of current international copyright treaties to shed light on which law should apply to both the prior search of orphan works, as well as the copyright infringement dispute which may arise following an ineffectual search. Part IV will apply conflict-of-law principles to the pre-use requirement search guidelines for orphan works, as well as the disputes that may arise from their use across borders. Part IV.A will analyze the case of *Itar-Tass Russian News Agency v. Russian Kurier, Inc.*⁴¹ (“Itar-Tass”) as an example of how to subdivide a copyright claim into the separate issues of ownership and infringement and apply a different country’s law as to each issue. Part IV.B will offer other creative solutions to make the use of orphan works transnationally more effective. Part IV.C will provide insight into reasons for and against different choice-of-law systems to be applied to the issue of infringement in international copyright disputes over orphan works. And finally, Part V will offer a temporary solution as to the most efficient and equitable means of resolving conflict-of-law issues which will arise in international copyright infringement disputes over orphan works.

I. BACKGROUND

A. *Securing Permission to Use an Orphan Work Transnationally*

Most countries require that a potential orphan work user conduct a “diligent search” to locate the copyright owner prior to “taking,” adapting, digitizing, or using an orphan work in any way.⁴² For example, the proposed United States legislation requires “a qualifying search,” which is defined as a “diligent effort to locate the owner of the infringed copyright.”⁴³ Yet, as the Copyright Subgroup (organized by the European Commission in order to construct a plan

⁴⁰ See *Société des auteurs des arts visuels et de l'image fixe v. SARL Google France*, Tribunal de grande instance [T.G.I.] [ordinary court of original jurisdiction] Paris, May 20, 2008, 05/12117, 7–8.

⁴¹ See *Itar-Tass Russian News Agency v. Russian Kurier*, 153 F.3d 82 (2d Cir. 1998).

⁴² See EU Copyright Subgroup—Final Report, *supra* note 4, §§ 5.1–5.4.

⁴³ See Orphan Works Act of 2006, H.R. 5439, 109th Cong. (2006) (proposed 17 U.S.C. § 504(b)(2)(A)(i)).

for European Digital Libraries Initiative⁴⁴) makes clear, these search requirements differ by country, creating confusion for potential users, such as a European author who may want to make a derivative work⁴⁵ from an existing American orphan work.⁴⁶ The purpose of the Copyright Subgroup was to suggest possible solutions in order to create a more effective global system.⁴⁷ The Copyright Subgroup's Final Report states: "Under all voluntary or regulatory measures, there needs to be guidance on what constitutes diligent search required before the use of a work."⁴⁸

The Copyright Subgroup claims that there are four general prerequisites which need to be fulfilled when considering the use of orphan works:

- A user wishes to make good faith use of a work with an unclear copyright status;
- Due diligence has been performed in trying to identify the rightholders and/or locate them;
- The user wishes to use the work in a clearly defined manner; and
- The user has a duty to seek authority before exploiting the orphan work, unless a specific copyright exception applies, such as fair use.⁴⁹

Many systems have been created in order to attempt to fulfill these requirements, but as of yet, there is no universal system.

Some countries have adopted regimes where a public body may issue the license in the case of non-locatable copyright owners.⁵⁰ These countries include the United Kingdom and Fiji, where the Copyright Tribunal may

⁴⁴ The European Digital Libraries Initiative is an initiative "for digitisation, online accessibility and digital preservation of Europe's collective memory." EU Copyright Subgroup—Final Report, *supra* note 4, § 2.

⁴⁵ According to 17 U.S.C. § 101, a "derivative work" is

a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a "derivative work."

17 U.S.C. § 101 (2006).

⁴⁶ EU Copyright Subgroup—Final Report, *supra* note 4, §§ 5.2–5.4.

⁴⁷ *Id.* § 5.2.

⁴⁸ *Id.* § 5.1.

⁴⁹ *Id.* § 5.2.

⁵⁰ *Id.*

authorize use of a recording in order to make a new recording if the identity and whereabouts of the author cannot be ascertained by reasonable inquiry.⁵¹ Yet, this type of system provides no relief for resurfaced orphan work owners due to sovereign immunity.⁵² For example, if the United States developed a national licensing system for orphan works, authors who had resurfaced upon exploitation of their works would have no remedy for relief since the Eleventh Amendment of the U.S. Constitution provides sovereign immunity to the government to defeat any claim for monetary relief under the Copyright Act.⁵³

Japan authorizes its Commissioner of the Agency for Cultural Affairs to issue a compulsory license for the use of a work if, “after due diligence has been exercised, the copyright owner is unknown or cannot be found.”⁵⁴ Again, in this situation, it is the government that is “giving permission” for the use of the work, rather than the author who owns the rights to the work in question.⁵⁵ The dual goals of copyright law seem to argue against such governmental interference.⁵⁶ In South Korea, the Minister of Culture can issue a license for the use of an orphan work if, “despite considerable efforts, the owner of the copyright cannot be located.”⁵⁷ Part of the problem is that countries have adopted different standards for searches.⁵⁸ It is almost impossible to differentiate the level of search required between the United Kingdom and Fiji, which require “reasonable inquiry”; versus Japan, which requires “due diligence”; versus South Korea, which requires “considerable efforts”; versus the United States, which requires a “reasonably diligent search.”⁵⁹ Not even scholars of copyright law could differentiate between these standards and provide an author or entity with an idea as to what each of these standards

⁵¹ *Id.*

⁵² Ginsburg, *supra* note 3, at 15.

⁵³ *Id.* (citing *Chavez v. Arte Publico Press*, 204 F.3d 601 (5th Cir. 2000)). Ginsburg concludes:

When the State or its officials are the infringer, the bill conditions the limitation on injunctive relief against infringers who have commenced or prepared derivative works on the State’s waiver of sovereign immunity by agreeing to be sued for damages, or by making an “enforceable promise to pay reasonable compensation.”

Id.; see also Orphan Works Act of 2006, H.R. 5439, 109th Cong. (2006) (proposed 17 U.S.C. § 514(c)(2)(C)).

⁵⁴ EU Copyright Subgroup—Final Report, *supra* note 4, § 5.2.

⁵⁵ *Id.*

⁵⁶ See *Twentieth Century Music Co. v. Aiken*, 422 U.S. 151, 156 (1975) (“The immediate effect of our copyright law is to secure a fair return for an ‘author’s’ creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good.”).

⁵⁷ EU Copyright Subgroup—Final Report, *supra* note 4, § 5.2.

⁵⁸ *Id.*

⁵⁹ *Id.*

might entail.⁶⁰ Furthermore, these different standards create consistency problems among verdicts.⁶¹ As one copyright scholar admonishes, “variable levels of diligence would render the same work (or same rights in the work) ‘orphaned’ as to some users but not as to others.”⁶²

Other countries have come up with a scheme where “extended collective license[s]” are issued.⁶³ Some Nordic countries have expanded the notion of extended collective licenses to cover certain activities in libraries, museums, and archives.⁶⁴ The problem with these types of schemes is that they focus entirely on the importance of free access to information through the public domain rather than a balance with author’s or copyright owner’s rights, which the Berne Convention and TRIPS seem to advocate.⁶⁵ Based on the differences between the ways individual countries deal with orphan work usage, these domestic mechanisms simply are not compatible with one another.⁶⁶

⁶⁰ See EU Copyright Subgroup—Final Report, *supra* note 4, §§ 5.1–5.2.

⁶¹ Ginsburg, *supra* note 3, at 17–18.

⁶² *Id.* at 12.

⁶³ Jukka Liedes & Hannu Wager, *Extended Collective License: The Nordic Solution to Complex Copyright Questions* (Kopinor, Oslo, Norway), June 1991, available at <http://www.kopinor.org/layout/set/print/content/view/full/1605>. A license generally is:

defined as a contractual permission to perform certain acts with respect to the protected intellectual creation. These acts would constitute infringement of intellectual property rights if they were performed without the authorisation of the right owner. The counterpart of the licensee’s right of use is the licensor/right owner’s contractual obligation not to enforce the intellectual property with respect to the acts permitted under the agreement.

VAN EECHOU, *supra* note 19, at 12. Thus, an extended collective license is “a support mechanism for freely negotiated licensing agreements.” EU Copyright Subgroup—Final Report, *supra* note 4, § 5.2.

⁶⁴ EU Copyright Subgroup—Final Report, *supra* note 4, § 5.2. On extended collective licenses, see generally Gunnar Karnell, *Extended Collective License Clauses and Agreements in Nordic Copyright Law*, 10 COLUM. J.L. & ARTS 73 (1985).

⁶⁵ See generally Berne Convention, *supra* note 7, pmb.; TRIPS, *supra* note 18, art. 7. TRIPS article 7 states:

The protection and enforcement of intellectual property rights should contribute to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations.

Id.

⁶⁶ See EU Copyright Subgroup—Final Report, *supra* note 4, § 5.2.

Due largely to globalization and the Internet's freer access to information, the problem of which law to apply to the issue of orphan work use is becoming more and more prevalent.⁶⁷ The Copyright Subgroup writes:

Taking into account that various alternative mechanisms exist to deal with the issue of orphan works, the Commission has recommended that Member States, in collaboration with stakeholders, establish mechanisms to facilitate the use of orphan works. Under this approach, interoperability and mutual recognition of existing solutions become an important issue, especially if the cross-border nature of the use is considered.⁶⁸

Through this globalization and cross-border use of orphan works, technology, such as the Internet, also enlarges the potential infringing use of works.⁶⁹ As Dr. Christophe Geiger, the new General Director of the Centre d'Etudes Internationales de la Propriété Industrielle, writes: "The problem is that technical devices are not capable of respecting the balance provided by law. A technical blockage is 'blind' and cannot discern whether a user is about to make a lawful or unlawful use of the work."⁷⁰

In order to determine which law should apply to the transnational use of an orphan work, it makes sense to analyze the current international treaties which deal with copyright law transnationally, such as the Berne Convention and TRIPS. Before offering a suggestion for a solution to that matter, this Comment will first discuss the connected problem of what law should be applied once an infringement dispute arises over use of an orphan work.

B. What Country's Law Should Apply to Transnational Infringement Suits?

The problem of what country's law to apply in an international dispute is not unique to copyright law; yet, due to the potentially high damages involved in a large number of copyright infringement disputes, it is an important one.⁷¹ The i2010 Digital Libraries Initiative would not have been necessary if there already existed a clearly defined system to regulate which country's law

⁶⁷ See Pollaud-Dulian, *supra* note 2, at vii–viii.

⁶⁸ EU Copyright Subgroup—Final Report, *supra* note 4, § 5.3.

⁶⁹ Christophe Geiger, *Copyright and Free Access to Information: For a Fair Balance of Interests in a Globalised World*, 28 EUR. INTELL. PROP. J. 366, 366–73 (2006).

⁷⁰ *Id.* at 369. Geiger continues, "[c]ertainly, the internet implies dangers for existing copyright; but it also offers a great opportunity for broader and simpler access to information and can therefore play an important role in education, research and culture more generally." *Id.*

⁷¹ See VAN EECHOUD, *supra* note 19, at 1.

controlled in an infringement action.⁷² Somewhat naïvely, this report urges “Member States . . . to recognise solutions in other Member States that fulfil the prescribed criteria in order to achieve the cross-border effect needed in the Digital Library Initiative. As a result, material that can be lawfully used in one Member State would also be lawfully used in another.”⁷³ This kind of approach would mean that the most lenient, or public domain-friendly, country’s law would always prevail in a dispute. That kind of result cannot be meshed with the prevailing view of copyright law: a utilitarian approach that seeks to achieve a balance between access to information on the one hand and incentive to authors to create on the other hand.⁷⁴ Additionally, because the stakes are so high in many copyright infringement suits, most countries will want to protect their own national laws and will not allow another country’s laws to simply override their own. The idealistic solution advocated in the committee’s report is not workable in today’s world. Mutual recognition and cooperation are overly naïve solutions that will not achieve any results. Furthermore, this type of solution lacks enforcement mechanisms that create necessary incentive for states to conform and comply with requirements.

Many countries have their own choice-of-law rules,⁷⁵ but unless every country’s rules are the same, the problem of which law to apply is not remedied. As Columbia professor and noted intellectual property scholar Jane C. Ginsburg writes:

Were the applicable law that of the country from which (rather to which) the works are made available, the orphan works solution would be considerably simplified, but it would be necessary for all the countries concerned to adhere to the same choice of law rule. For example, even if US courts were to adopt a point-of-origin choice of law, that will not help a US exploiter who makes orphan works available from the US to EU member States if the choice of law rule in the EU States designates the laws of the countries of receipt.⁷⁶

Because it is highly unlikely that countries will agree on one choice-of-law rule, the courts must determine the solution.⁷⁷ Unfortunately, the international treaties that cover copyright provide little guidance as to a choice-of-law rule. For example, the WIPO Copyright Treaty does not indicate a choice-of-law

⁷² EU Copyright Subgroup—Final Report, *supra* note 4, § 2.

⁷³ *Id.*

⁷⁴ See *Twentieth Century Music Co. v. Aiken*, 422 U.S. 151, 156 (1975).

⁷⁵ See VAN EECHOUD, *supra* note 19, at 3.

⁷⁶ Ginsburg, *supra* note 3, at 19.

⁷⁷ See VAN EECHOUD, *supra* note 19, at 3.

rule.⁷⁸ At best, it provides: “Contracting Parties shall ensure that enforcement procedures are available under their law so as to permit effective action against any act of infringement of rights covered by this Treaty, including expeditious remedies to prevent infringements and remedies which constitute a deterrent to further infringements.”⁷⁹ Although this treaty language provides some information regarding the enforcement of rights, it leaves the enforcement procedures to the respective domestic laws of the contracting parties.⁸⁰

TRIPS is no more informative and, at worst, confuses courts as to the meaning of national treatment.⁸¹ Under Article 3 of TRIPS, “[e]ach Member shall accord to the nationals of other Members treatment no less favourable than that it accords to its own nationals with regard to the protection of intellectual property.”⁸² This means that if the United States provides a fair use exception for educational purposes to national works, foreign authors’ works are also subjected to this same exception, even if their own country of origin does not recognize such an exception. Yet, some courts have confused the principle of national treatment to mean the same thing as the Berne Convention Article 5(2),⁸³ which provides for choice of law for infringement suits and does not apply to national treatment.⁸⁴ This is what the court did in the case of *Murray v. British Broadcasting Corporation*.⁸⁵ In that case, the court should have analyzed the Berne Convention Article 5(1),⁸⁶ the national treatment provision, but instead attempted to interpret the choice-of-law provision as dictating the scope of protection and deference to forum selection

⁷⁸ See World Intellectual Property Organization, Copyright Treaty, Dec. 20, 1996, S. TREATY DOC. NO. 105–117, 36 I.L.M. 65 [hereinafter WIPO Copyright Treaty].

⁷⁹ *Id.* art. 14(2).

⁸⁰ *Id.*

⁸¹ See TRIPS, *supra* note 18, art. 3; see also *Hasbro Bradley, Inc. v. Sparkle Toys, Inc.* 780 F.2d 189, 192–93 (2d Cir. 1985) (finding that toys created by a Japanese national and first sold in Japan enjoyed copyright protection under U.S law as soon as they were created).

⁸² TRIPS, *supra* note 18, art. 3 (footnotes omitted).

⁸³ Berne Convention art. 5(2) provides: “[T]he extent of protection . . . shall be governed exclusively by the laws of the country where protection is claimed.” Berne Convention, *supra* note 7, art. 5(2).

⁸⁴ See, e.g., *Murray v. British Broadcasting Corp.*, 81 F.3d 287, 290 (2d Cir. 1996).

⁸⁵ *Id.*

⁸⁶ Berne Convention art. 5(1) states:

Authors shall enjoy, in respect of works for which they are protected under this Convention, in countries of the Union other than the country of origin, the rights which their respective laws do now or may hereafter grant to their nationals, as well as the rights specifically granted by this Convention.

Berne Convention, *supra* note 7, art. 5(1).

by a foreign plaintiff.⁸⁷ Because the Berne Convention Article 5(1) and TRIPS Article 3 are equivalent in meaning,⁸⁸ this proves that TRIPS Article 3 provides no guidance as to choice of law and even further confuses an already complicated international copyright legal analysis.

The Berne Convention may provide some guidance as to what law controls in the case of copyright infringement suits, but it does not specify how that choice of law affects the multi-stage analysis, which orphan works require.⁸⁹ The Berne Convention Article 5(2) seems to be the most instructive as a means of determining what law applies to determine the amount of protection afforded a work in an infringement suit and what damages are available to the injured rightholder.⁹⁰ It states that “the extent of protection, as well as the means of redress afforded to the author to protect his rights, shall be governed exclusively by the laws of the country where protection is claimed.”⁹¹ However clear this may appear, it becomes difficult to determine where protection is claimed in the case of transnational Internet disputes where infringement might occur in multiple countries at the same time. Referring to the Berne Convention, one commentator noted: “What is exceptional is that the treaty that is still the core instrument in international copyright today . . . was conceived at a time when modern copyright was not the well-defined, integral part of private law that it is today.”⁹² It is unreasonable to expect that a treaty drafted in the late nineteenth century could provide for the global world of the twenty-first century. Through the wide dissemination of information over the Internet, it is simply too easy to infringe.⁹³ The Internet and intellectual property, namely copyright law, are in a constant “dialectical relationship”⁹⁴ and simply cannot function without the international copyright regime adapting. The current choice-of-law provision in the Berne Convention

⁸⁷ *Murray*, 81 F.3d at 290. The court interprets Berne’s choice-of-law provision to entail a national treatment analysis, but national treatment does not concern choice of law. Here, the British plaintiff tried to argue that national treatment dictated that he receive identical procedural opportunities as accorded American plaintiffs, but the court disagreed. *Id.*

⁸⁸ See Berne Convention, *supra* note 7, art. 5(1); TRIPS, *supra* note 18, art. 3. TRIPS Article 3 states, “Each member shall accord to the nationals of other Members treatment no less favourable than that it accords to its own nationals with regard to the protection of intellectual property” TRIPS, *supra* note 18, art. 3(1).

⁸⁹ See Berne Convention, *supra* note 7.

⁹⁰ *Id.* art. 5(2).

⁹¹ *Id.*

⁹² See VAN EECHOUD, *supra* note 19, at 2.

⁹³ Pollaud-Dulian, *supra* note 2, at vii–viii. “As a work travels instantaneously all over the globe, its ubiquity is reinforced, but will its author and his business partners receive a fee proportionate to this hyperinflated dissemination over which they have lost all initiative?” *Id.* at viii.

⁹⁴ *Id.* at vii.

is not suited to take on the case of Internet infringement; one can imagine that adjudication of Internet infringement of orphan works, particularly under the Berne Convention, would prove to be a grueling, if not impossible, task.⁹⁵

There is also the related problem of infringement in non-Berne signatory countries. Although a resurfaced rightholder could still bring an infringement action in any country with proper jurisdiction,⁹⁶ the forum court might have difficulty applying the laws of a country which either has no established copyright regime, or whose copyright laws fail to provide even the minimum requirements set forth in both the Berne Convention and TRIPS. This type of application results in a different standard for infringement depending on where the work is exploited. A choice-of-law rule that submits the same work to a multitude of different tests and subsequently permits infringement in some jurisdictions rather than others is not a practical choice-of-law rule. Although Berne Convention Article 5(2) may be useful as a guide or preliminary choice-of-law rule, it needs to be supplemented with another provision which can provide for more universal application. For example, Berne Convention Article 5(2) provides no help in determining which country's law to apply in an Internet case where infringement has occurred in multiple countries at the same time—an inevitability with today's widespread Internet use.⁹⁷

II. ANALYSIS

A. *Société des auteurs des arts visuels et de l'image fixe v. SARL Google France*

As the previous section indicated, the choice of law in international copyright infringement suits can significantly affect the outcome of the case and often dictates the winner purely by the choice of law.⁹⁸ The following case demonstrates the difficulty that courts currently have with interpreting the Berne Convention's choice-of-law provision and how the place of infringement is not always as clear as one would imagine. Due to the lack of case law on orphan works, other areas of copyright case law must be analyzed

⁹⁵ See Berne Convention, *supra* note 7, art. 5(2).

⁹⁶ Gary Lea, *Moral Rights and the Internet: Some Thoughts from a Common Law Perspective*, in 5 PERSPECTIVES ON INTELLECTUAL PROPERTY: THE INTERNET AND AUTHOR'S RIGHTS, *supra* note 2, at 87, 100; see Berne Convention, *supra* note 7, art. 5(2).

⁹⁷ Berne Convention, *supra* note 7, art. 5(2); Lea, *supra* note 96, at 100.

⁹⁸ See *infra* Part II.B.

in order to prove the current failure of the international copyright regime and its treaties in the Internet age. As will become clear, the following case demonstrates the inequitable reality the Berne Convention allows courts to create by adopting different interpretations of the same statutory language.

In *SAIF*, the French Copyright Collecting Society of Authors of Visual Arts and Still Images (“SAIF”) sued Google for infringing thousands of works belonging to its authors by displaying and reproducing thumbnail images on the Google Images search engine and offering these images to Google users.⁹⁹ The search service is advertised on Google’s homepage. Users can type in keywords and the search engine produces one or more pages of results from the entire Web based on the user’s keywords.¹⁰⁰ The search engine does not store images, but it does store the addresses of the websites referenced in the search results.¹⁰¹ For Google Image, however, the results page not only mentions the website, but it also reproduces the images in a “thumbnail” format within the search results.¹⁰² SAIF is not contesting the search engine itself, but rather the display without compensation of thousands of works belonging to its repertory.¹⁰³ SAIF represents more than 9,000 authors, and the term “author” includes photographers, architects, designers, drafters, graphic artists, illustrators, painters, plastic artists, and sculptors of French and other nationalities.¹⁰⁴ SAIF brought this case in French court, but Google urges the court to apply United States law as the law of the country where protection is claimed, according to the Berne Convention Article 5(2).¹⁰⁵

The Paris District Court, per Google’s solicitation, applied the Berne Convention Article 5(2) and determined that the applicable law was the law of the place where the event causing the possible infringement occurred.¹⁰⁶ This is a perfect example of how the current international copyright treaties do not provide for cases of Internet infringement; instead of the treaty clearly providing for a choice of law, the lawyers for both sides must argue the

⁹⁹ *Société des auteurs des arts visuels et de l’image fixe v. SARL Google France*, Tribunal de grande instance [T.G.I.] [ordinary court of original jurisdiction] Paris, May 20, 2008, 05/12117, 1, 7–8, available at <http://www.foruminternet.org/specialistes/veille-juridique/jurisprudence/IMG/pdf/tgi-par20080520.pdf>.

¹⁰⁰ *Id.* at 5.

¹⁰¹ *Id.*

¹⁰² *Id.*

¹⁰³ *Id.*

¹⁰⁴ *Id.*

¹⁰⁵ *Id.* at 7; see Berne Convention, *supra* note 7, art. 5(2).

¹⁰⁶ *Société des auteurs des arts visuels et de l’image fixe v. SARL Google France*, Tribunal de grande instance [T.G.I.] [ordinary court of original jurisdiction] Paris, May 20, 2008, 05/12117, 1, 8, available at <http://www.foruminternet.org/specialistes/veille-juridique/jurisprudence/IMG/pdf/tgipar20080520.pdf>.

meaning of limited treaty language that was never meant to apply to such a complicated case.¹⁰⁷ It was crucial for Google in this case that the court applied United States law because French law does not provide for the same fair use exception.¹⁰⁸ Thus, this analysis will focus on the court's discussion of the applicable law.

The Berne Convention Article 5(2) provides that “the extent of protection . . . shall be governed exclusively by the laws of the country where protection is claimed.”¹⁰⁹ However, the court interpreted this to mean the law of the country where the proximate cause arose and not where the damage was felt, citing two recent rulings from the Cour de cassation, the highest French civil court, to support its interpretation.¹¹⁰ The court dispensed with its analysis of Article 5(2) after only one sentence and based its entire ruling on the *Sté informatique service réalisation organisation (Sisro) v. Sté de droit néerlandais en liquidation Ampersand Software BV* (“*SISRO*”) and *Lamore* cases,¹¹¹ which are given somewhat light treatment in the opinion.¹¹² Although the court's decision may seem to indicate that it was comfortable with this type of analysis, that is not the case. The court reasoned that because the servers enabling access to the site <http://www.google.fr> are located in California and the basic technology belongs to Google, Inc., which is located in the United States, United States law should apply as to the issue of infringement.¹¹³

By taking a closer look at the reasoning in *SISRO*, it appears that the court in *SAIF* ignored an entire part of that case's holding.¹¹⁴ In *SISRO*, the plaintiffs appealed the ruling of the appeals court as to the issue of what law to apply as to the infringement.¹¹⁵ The appeals court held the laws of the United Kingdom, the Netherlands, and Sweden were applicable, and that French law did not apply because France was the “place of effect,” not the place of

¹⁰⁷ See VAN ECHOUD, *supra* note 19, at 2–3.

¹⁰⁸ *Société des auteurs des arts visuels et de l'image fixe v. SARL Google France*, Tribunal de grande instance [T.G.I.] [ordinary court of original jurisdiction] Paris, May 20, 2008, 05/12117–8.

¹⁰⁹ Berne Convention, *supra* note 7, art. 5(2).

¹¹⁰ *Société des auteurs des arts visuels et de l'image fixe v. SARL Google France*, Tribunal de grande instance [T.G.I.] [ordinary court of original jurisdiction] Paris, May 20, 2008, 05/12117, 7–8.

¹¹¹ See *Sté informatique service réalisation organisation (Sisro) v. Sté de droit néerlandais en liquidation Ampersand Software BV*, Première chambre civile [Cass. 1e civ.] [first civil chamber] Mar. 5, 2002, J.C.P. 2002, II, 10082, 994, note Watt.

¹¹² See *Société des auteurs des arts visuels et de l'image fixe v. SARL Google France*, Tribunal de grande instance [T.G.I.] [ordinary court of original jurisdiction] Paris, May 20, 2008, 05/12117, 7–8.

¹¹³ *Id.* at 7.

¹¹⁴ See *Sté informatique service réalisation organisation (Sisro)*, J.C.P. 2002, II, 10082, 994, note Watt.

¹¹⁵ *Id.*

causation.¹¹⁶ The plaintiffs based their appeal on Article 5(2) of the Berne Convention and sought to invoke “the law of the place of perpetration, which in the case of a multitude of places of perpetration was the law that was most appropriate, and specifically the law of the place of the effect, in the present case French law.”¹¹⁷ Although the court in *SAIF* makes no reference to the specific facts of *SISRO*,¹¹⁸ it also makes no mention of the fact that French law could have applied to Google’s use of the images if the court had found enough of a connection between the alleged infringement and France. Specifically, the court in *SISRO* stated, “where a number of places of perpetration are involved, French law as the law of the ‘place of effect’ is not exclusively applicable to the entire litigation in the absence of proof of a closer connection to France.”¹¹⁹ Although this may not have affected the result in *SAIF*, it provides a much needed clarification of precedent for future cases that may arise in similar circumstances.

The place of infringement could have been interpreted differently in *SAIF* because the site was accessed in France as well.¹²⁰ Therefore, the potentially infringing behavior would have occurred in France, and French law would have applied to the issue of infringement.¹²¹ *SAIF* argued that in “complex offenses such as copyright infringements committed on the Internet, no conflict-of-law rule provides a clear answer to the issue of the applicable law, and that pursuant to case law the applicable law is that of the place where the loss is sustained.”¹²² This argument further highlights the need for clarification in the international copyright regime because the current system evades equity in many complex situations, such as infringement through the Internet. *SAIF* contested the application of the law of the server location jurisdiction stating, “it would suffice to place the servers in countries where there is no legal protection of copyright for there to be no preservation of any copyright whatsoever.”¹²³

¹¹⁶ *Id.*

¹¹⁷ *Id.*

¹¹⁸ *Société des auteurs des arts visuels et de l’image fixe v. SARL Google France*, Tribunal de grande instance [T.G.I.] [ordinary court of original jurisdiction] Paris, May 20, 2008, 05/12117, 7, available at <http://www.foruminternet.org/specialistes/veille-juridique/jurisprudence/IMG/pdf/tgipar20080520.pdf>.

¹¹⁹ *Sté informatique service réalisation organisation (Sisro)*, J.C.P. 2002, II, 10082, 994, note Watt.

¹²⁰ *Société des auteurs des arts visuels et de l’image fixe v. SARL Google France*, Tribunal de grande instance [T.G.I.] [ordinary court of original jurisdiction] Paris, May 20, 2008, 05/12117, 5.

¹²¹ *See id.* at 7–8.

¹²² *Id.*

¹²³ *Id.*

This argument is persuasive for a number of reasons. First, SAIF acknowledged the failures of the current international copyright regime.¹²⁴ Second, the lawyers for SAIF warned the court of setting precedent that allows for widespread navigation around infringing behavior.¹²⁵ Yet, the court practically ignored SAIF's argument. The court stated, "reference should be made to the law of the country where the incriminated acts occurred . . . the place where the proximate cause of the infringement occurred"¹²⁶ Although this quite clearly would indicate the United States, since that is the location of the servers that allow access to the images, it does not dictate an equitable result in every case. Although many search engines are useful and help promote authors' works, the legality of the exploitation of the work should still be subjected to the laws of the appropriate country. By this court's analysis, Google could establish servers in a country that does not recognize copyright protection for authors, provide access to every copyrighted work in creation, and escape liability. It is shocking that this court did not spend any time even considering this disastrous result. Because the French court chose to apply the 1976 Copyright Act of the United States, Google enjoyed the luxury of the statute's fair use provision,¹²⁷ which the court ultimately applied in this case.¹²⁸ Due to the European custom of "loser pays," Google walked away with attorney's fees paid for by SAIF.¹²⁹

B. Applying Choice of Law to Search Guidelines for Orphan Works and the Disputes That Arise from Their Use

In any copyright infringement suit involving orphan works, a court should first consider whether the accused infringer complied with the requisite search requirements prior to exploiting a work.¹³⁰ Although it is more difficult for the forum court, the same law may not and, arguably should not, be applied to both the initial taking and the alleged infringement.¹³¹ Again, a "taking" is merely the initial appropriation of a work and does not necessarily imply an infringing exploitation.¹³² The conflict-of-law technique called "dépeçage" (from the

¹²⁴ *See id.*

¹²⁵ *See id.*

¹²⁶ *Id.* at 7–8.

¹²⁷ 17 U.S.C.A. § 107 (2009).

¹²⁸ Société des auteurs des arts visuels et de l'image fixe-Saif v. SARL Google France, Tribunal de grande instance [T.G.I.] [ordinary court of original jurisdiction] Paris, May 20, 2008, 05/12117, 9.

¹²⁹ *Id.* at 12.

¹³⁰ EU Copyright Subgroup—Final Report, *supra* note 4.

¹³¹ Itar-Tass Russian News Agency v. Russian Kurier, 153 F.3d 82, 90 (2d Cir. 1998).

¹³² *See supra* note 17.

French, meaning “dismemberment”) is the best way to resolve this problem.¹³³ Although this technique is not new to copyright law cases, it does not appear that courts have decided cases on orphan works using this method.¹³⁴ Under this technique, the choice of law for different issues related to a cause of action may be decided differently with laws from different jurisdictions applying to separate issues related to the same claim.¹³⁵ This provides for more flexibility in the court’s decision-making process by allowing the court to choose and apply the laws that provide the most equity to the parties;¹³⁶ thus, *depêçage* provides a workable framework for the adjudication of orphan work disputes in the future. And although the following case does not concern orphan works, the court’s application of *depêçage* highlights the feasibility of this process for orphan work infringement disputes that will always entail two separate copyright issues. *Itar-Tass* provides a good example of how *depêçage* can be used to yield an equitable result in these types of cases.¹³⁷

1. *Itar-Tass as a Guide to Conflict of Laws*

Itar-Tass concerns a Russian language newspaper published in New York City by the defendant *Kurier*.¹³⁸ *Kurier* copied about 500 articles that either first appeared in the plaintiffs’ publications or were distributed by the plaintiff.¹³⁹ The plaintiffs include a major Russian language newspaper in Russia and the Union of Journalists of Russia, the “professional writers union of accredited print and broadcast journalists of the Russian Federation.”¹⁴⁰ There are a few substantive issues in this case. First is “whether a newspaper publishing company has an interest sufficient to give it standing to sue for copying the text of individual articles appearing in its newspapers.”¹⁴¹ Second is which country’s law should apply to the issue of ownership of the articles and which country’s law should apply to the issue of whether the defendant infringed those articles.¹⁴² The choice of which law to apply to each issue is

¹³³ See VAN EECHOU, *supra* note 19, at 212.

¹³⁴ *Id.*

¹³⁵ See generally *Itar-Tass*, 153 F.3d at 90.

¹³⁶ VAN EECHOU, *supra* note 19, at 17. Eechoud argues “[t]hat the choice-of-law process should also yield a result that is just, from the perspective of the individual parties involved, is a relatively novel idea.” *Id.* This is exactly the type of consideration that arguably *must* be considered in a choice-of-law analysis.

¹³⁷ See *Itar-Tass* 153 F.3d at 90.

¹³⁸ *Id.* at 84.

¹³⁹ *Id.*

¹⁴⁰ *Id.*

¹⁴¹ *Id.*

¹⁴² *Id.* at 90–91.

significant in this case because Russian law explicitly excludes newspapers from a work-for-hire doctrine.¹⁴³ This means the articles are actually owned by their individual authors rather than the news agency or publishing company.¹⁴⁴

In this case, the Second Circuit, home to a large number of copyright cases, decided to apply Russian law to the issue of ownership and United States law to the issue of infringement.¹⁴⁵ In deciding to apply Russian law to the issue of ownership, the court first analyzed the connecting factors between the work and Russia.¹⁴⁶ These connecting factors included the fact that the works were created in Russia by Russian nationals were first published in Russia (which according to the Berne Convention Article 5(4)¹⁴⁷ classified Russia as the country of origin); thus, the works had the closest relationship to Russia.¹⁴⁸ Applying this reasoning to the case of orphan works suggests that the country of origin of the work should apply to the initial search requirements prior to the use of the work. This is also in line with the guidelines of the Commission for the European Digital Libraries Initiative, which “foresee that diligent search would generally use the resources of the country of origin of the work (if known) and be carried out on a title by title basis, based on available data.”¹⁴⁹ Additionally, narrowing the prerequisites of use to the country of origin of the work clarifies the requirements for the potential exploiter who would have to perform multiple searches if the standard for choice of law was the country where the work would be exploited, which could include multiple countries. Such a standard would not only be burdensome for a potential exploiter, but it would also prove taxing for courts that would have to analyze multiple standards for search if an infringement action arose from the orphan work’s use.

The Second Circuit in *Itar-Tass* showed its facility applying foreign law to the issue of ownership and applying United States law to the issue of

¹⁴³ *Id.* at 92.

¹⁴⁴ *Id.* at 84.

¹⁴⁵ *See id.*

¹⁴⁶ *Id.* at 90.

¹⁴⁷ Berne Convention, *supra* note 7, art. 5(4). Providing guidance as to how to define the country of origin, article 5(4)(a) states, “in the case of works first published in a country of the Union, that country; in the case of works published simultaneously in several countries of the Union which grant different terms of protection, the country whose legislation grants the shortest term of protection.” *Id.*

¹⁴⁸ *Itar-Tass*, 153 F.3d at 90. The court reasoned “[t]o whatever extent we look to the Berne Convention itself as guidance in the development of federal common law on the conflicts issue, we find nothing to alter our conclusion. The convention does not purport to settle issues of ownership” *Id.* at 91.

¹⁴⁹ Eur. Digital Libraries Initiative, *supra* note 5, at 2.

infringement.¹⁵⁰ This supports the theory that *depêçage* in orphan works cases would be effective because courts, particularly federal courts, are capable of interpreting foreign law, and arguably, multiple foreign laws in the same case. Since federal courts decide all copyright cases in the United States, dividing the initial search requirement and ownership issues from infringement and applying different laws to each is feasible. In *Itar-Tass*, the court turned to expert witnesses in Russian law to assist in interpreting Russian copyright law and legislative history.¹⁵¹ This indicates that it is possible for courts deciding orphan work infringement suits to consult expert witnesses from other countries for assistance with the requirements for pre-use clearance searches.

Itar-Tass was one of the first cases to address the conflict-of-law issue and devote time to its analysis and ultimate decision.¹⁵² In choosing to apply Russian law to the ownership issue and United States law to the infringement issue, the court not only analyzed the Berne Convention, but also examined principles of property and tort law.¹⁵³ Because of the Berne Convention's many gaping holes, it was necessary for the court to look outside of the Berne Convention and augment its rudimentary guide to choice of law with other theoretical approaches to copyright law.¹⁵⁴ In deciding to apply Russian law to the ownership of the copyright issue, the court reasoned that copyright is a form of property and thus applied the property principle that "the interests of the parties in property are determined by the law of the state with 'the most significant relationship' to the property and the parties."¹⁵⁵ For orphan works, this would mean that the applicable law would usually be the law of the work's country of origin. However, this may not always be the case, especially in situations where the rightholder owns the rights to the work through an assignment and has predominantly made use of the work in a country other than the work's country of origin. Because such a situation is fathomable, courts cannot always rely on the application of property theories to dictate a workable result, unless the choice-of-law decision is made on an individual, ad

¹⁵⁰ See *Itar-Tass*, 153 F.3d at 90.

¹⁵¹ *Id.* at 86.

¹⁵² See *id.* at 86; see also, *Greenwich Film Prod. S.A. v. D.R.G. Drugs, Inc.*, 25 U.S.P.Q.2d 1435, 1437–38 (S.D.N.Y. 1992) (identifying the conflict of law issue, but ruling that it was not necessary to be resolved in that case).

¹⁵³ *Itar-Tass*, 153 F.3d at 90–92.

¹⁵⁴ See *id.* See generally Berne Convention, *supra* note 7.

¹⁵⁵ *Itar-Tass*, 153 F.3d at 90.

hoc basis for each case depending on the country with the closest relationship to the work.¹⁵⁶

As to the conflicts rule for infringement issues, the court in *Itar-Tass* applied the torts principle of *lex loci delicti*.¹⁵⁷ This traditional tort rule states that the law of the place of the wrong automatically governs as to substantive issues in a tort case.¹⁵⁸ A well-known treatise on tort law suggests this rule “is relatively easy to apply, [and] furnishes certainty and predictability of outcome.”¹⁵⁹ Although the *SAIF* court reached the same result by applying the law of the country of infringement, this result seems to provide savvy exploiters with a means of circumventing infringement by exploiting works in places where the law favors them, such as establishing Internet servers in remote countries with lenient copyright protection laws.¹⁶⁰

Additionally, the strengths espoused by this rule are not applicable in copyright infringement suits. First, as the Second Circuit Court proved in *Itar-Tass*, courts are capable of applying complex arrangements of law and do not need to be provided with the easiest solution, although this should not be viewed as a total defense to complexity because a simple solution would be preferable if also effective.¹⁶¹ In fact, the court in *Frink America, Inc. v. Champion Road Machinery, Ltd.* argued that very fact, stating “while the difficulties attendant in resolving questions of foreign law are a proper consideration . . . it is well-established that the need to apply foreign law is not alone sufficient to dismiss under the doctrine of *forum non conveniens*.”¹⁶²

Second, in the case of orphan works, neither certainty nor predictability are achieved by applying the law of the place of the wrong because such an

¹⁵⁶ *Id.* at 90–91. In fact, the court warns:

[t]he division of issues, for conflicts purposes, between ownership and infringement issues will not always be as easily made as the above discussion implies. If the issue is the relatively straightforward one . . . the law of the country with the closest relationship to the work will apply to settle the ownership dispute. But in some cases . . . the issue is not simply who owns the copyright but also what is the nature of the ownership . . .

Id. at 91.

¹⁵⁷ *Id.*

¹⁵⁸ STUART M. SPEISER, CHARLES F. KRAUSE & ALFRED W. GANS, 1 THE AMERICAN LAW OF TORTS § 2:9, 212 (Thomson West 2003) (1983).

¹⁵⁹ *Id.* at 213.

¹⁶⁰ See *supra* Part III.A.

¹⁶¹ See generally *Itar-Tass*, 153 F.3d at 88–94.

¹⁶² *Frink Am., Inc. v. Champion Road Mach., Ltd.*, 961 F. Supp. 398, 404 (N.D.N.Y. 1997) (quoting *Peregrine Myanmar v. Segal*, 89 F.3d 41, 47 (2d Cir. 1997)).

application produces inconsistent results (whereby a work would be treated differently depending on the place of exploitation).¹⁶³ Thus, despite the frequency of applying the law of the country of infringement to the issue of infringement, this method has only worked up to this point due to the relatively simple cases to which it has been applied.¹⁶⁴ Therefore, although complex legal applications are usually seen as negative, they are justifiable when applied to the specific niche of orphan work disputes.

Surprisingly, only three cases have cited to *Itar-Tass* regarding its application of foreign law to the issue of ownership in a copyright infringement suit.¹⁶⁵ Perhaps courts would be better served in the future by utilizing the *Itar-Tass* analysis. Although the court in *Itar-Tass* divided the issues of ownership and infringement and applied different countries' laws to each, it appears that other courts have not followed its lead.¹⁶⁶ In *In re Bridgestone/Firestone Tires Products Liability Litigation*,¹⁶⁷ the court cited *Itar-Tass* as an example of how a court can use expert witnesses to aid in foreign law interpretation, but that case did not involve a copyright claim, and therefore, the more detailed issue of *depêçage* was not necessary.¹⁶⁸ The other notable case citing *Itar-Tass* is *Films by Jove v. Berov*.¹⁶⁹ In *Films by Jove*, the defendants attempted to argue the conflict-of-law principles in *Itar-Tass*, which dictated that Russian law should apply to the issue of ownership.¹⁷⁰ However, because the defendants in *Films by Jove* confused the conflict-of-law rules with the policy considerations behind the act of state doctrine, the court did not need to analyze *Itar-Tass* further.¹⁷¹

Both the French court in *SAIF* and the court in *Itar-Tass* stated that the alleged infringer was a United States corporation.¹⁷² Although neither court

¹⁶³ See *Société des auteurs des arts visuels et de l'image fixe v. SARL Google France*, Tribunal de grande instance [T.G.I.] [ordinary court of original jurisdiction] Paris, May 20, 2008, 05/12117, 1, 7–8, available at <http://www.foruminternet.org/specialistes/veillejuridique/jurisprudence/IMG/pdf/tgipar20080520.pdf>.

¹⁶⁴ See *Itar-Tass*, 153 F.3d at 91–92.

¹⁶⁵ *In re Bridgestone/Firestone Tires Prods. Liab. Litig.*, 212 F. Supp. 2d 903, 913 (S.D. Ind. 2002); *Films by Jove v. Berov*, 341 F. Supp. 2d 199, 210 (E.D.N.Y. 2004); *Viacom Int'l v. Fanzine Int'l*, No. 98 CIV. 7448(KMW), 2000 WL 1854903, at *4 (S.D.N.Y. July 12, 2000).

¹⁶⁶ See *Itar-Tass*, 153 F.3d at 88–95.

¹⁶⁷ *In re Bridgestone Firestone Tires Prods. Liab. Litig.*, 212 F. Supp. 2d at 913.

¹⁶⁸ *Id.*

¹⁶⁹ *Films by Jove*, 341 F. Supp. 2d at 210.

¹⁷⁰ *Id.*

¹⁷¹ See *id.*

¹⁷² See *Itar-Tass Russian News Agency v. Russian Kurier*, 153 F.3d 82, 84 (2d Cir. 1998); *Société des auteurs des arts visuels et de l'image fixe v. SARL Google France*, Tribunal de grande instance [T.G.I.]

indicated this factor as a strong impetus for its choice of United States law as to the infringement issue, it clearly informed their respective decisions.¹⁷³ This presents another choice-of-law option for infringement of orphan works: the law of the country where the exploiter is a national. However, such a system, at least for Berne Convention signatory countries, would be facially counter to the Berne Convention Article 5(2), which provides: “[T]he extent of protection . . . shall be governed exclusively by the laws of the country where protection is claimed.”¹⁷⁴ For non-Berne signatory countries, this solution might be applicable, as it would prevent would-be infringers from choosing an amenable jurisdiction within which to exploit an orphan work.¹⁷⁵ However, courts would still have to consult TRIPS to determine where an exploiter was considered a national.¹⁷⁶ The reality is that all solutions are malleable, and the law cannot possibly account for all deceitful behavior that may be used to circumvent the law. Ultimately, what *Itar-Tass* indicates is the court’s ability to apply a choice-of-law analysis to copyright infringement cases.¹⁷⁷ Thus, until countries agree on compatible legislation concerning choice of law in copyright disputes, it appears that courts must independently reason their way to an equitable result.

2. Other Solutions for Making Orphan Works Available

One solution for the question of which law to apply to the initial use requirements for using an orphan work would be to use a connecting factor analysis to decide which country has the closest relationship to the work, like in *Itar-Tass*.¹⁷⁸ In most cases, this would be the country of origin of the work, as in *Itar-Tass*; however, this is not always the case, since a transferred work

[ordinary court of original jurisdiction] Paris, May 20, 2008, 05/12117, 1, 7–8, available at <http://www.foruminternet.org/specialistes/veille-juridique/jurisprudence/IMG/pdf/tgipar20080520.pdf>.

¹⁷³ *Itar-Tass*, 153 F.3d at 84. The court in *Itar-Tass* explains that “[t]o whatever extent *lex loci delicti* is to be considered only one part of a broader ‘interest’ approach, United States law would still apply to infringement issues, since not only is this country the place of the tort, but also the defendant is a United States corporation.” *Id.* at 91; see *Carbotrade S.p.A v. Bureau Veritas*, 99 F.3d 86, 89–90 (2d Cir. 1996).

¹⁷⁴ Berne Convention, *supra* note 7, art. 5(2).

¹⁷⁵ VAN EECHOU, *supra* note 19, at 17. “Plaintiffs may shop around for a court that they expect will apply a law favourable to their case. But if all fora were to apply the same choice-of-law rules, they would apply the same rules of substantive law and there would be decisional harmony.” *Id.*

¹⁷⁶ TRIPS, *supra* note 18, art. 1, ¶ 3 n.1. “[W]hen ‘nationals’ are referred to in this agreement, they shall be deemed, in the case of a separate customs territory Member of the WTO, to mean persons, natural or legal, who are domiciled or who have a real and effective industrial or commercial establishment in that customs territory.” *Id.*

¹⁷⁷ See *Itar-Tass*, 153 F.3d at 88–95.

¹⁷⁸ See *id.*

may have greater connections with the country where the transferee is a national or where the transferee exploited the work. Based purely on policy, this standard makes sense because a work should be afforded the same level of search scrutiny regardless of where the potential user is a national or where the user plans to exploit the work.

This logical argument makes sense to courts as well. In *Greenwich Film Production v. DRG Records*,¹⁷⁹ the court agreed with the plaintiff's reasoning that, because "it is a French entity asserting copyright ownership in [a] work commissioned in France for a French film[,] . . . French law should govern the determination of ownership."¹⁸⁰ Although the court saw the logic and legal support behind this argument, the court ultimately decided that, although there was a potential conflict-of-law issue present in the case, it was unnecessary to resolve the conflict-of-law issue due to the specific facts of the case.¹⁸¹ It is probable that, had the court needed to apply some sort of choice-of-law analysis, a connecting factor test would have been the logical progression from its previous reasoning.¹⁸²

The Copyright Subgroup of the European Digital Libraries Commission advocated another solution to the problem posed by orphan works. This High Level Expert Group suggests the development of a rights clearance procedure and a Rights Clearance Center to grant licenses to use orphan works.¹⁸³ This is a practical solution because it places the burden on a seemingly more knowledgeable group than potential users. Nonetheless, the High Level Group's suggestion still raises questions of sovereign immunity and may not be the best means of achieving protection for orphan work rightholders.¹⁸⁴ Additionally, this type of system ameliorates the problem of orphan work use on a national level only and, at best, a European level in the specific case of the European Union Member States.¹⁸⁵

Although the WIPO Copyright Treaty authorizes a contracting party to construct a system whereby works would be made available,¹⁸⁶ this type of

¹⁷⁹ *Greenwich Film Prods. v. DRG Records, Inc.*, No. 91 CIV. 0546(JSM), 1992 WL 279357, at *1-2 (S.D.N.Y. Sept. 25, 1992).

¹⁸⁰ *Id.* at *2.

¹⁸¹ *Id.* at *2-3.

¹⁸² *See id.*

¹⁸³ EU Copyright Subgroup—Final Report, *supra* note 4, § 5.1.

¹⁸⁴ *See* Ginsburg, *supra* note 3, at 15.

¹⁸⁵ WIPO Copyright Treaty, *supra* note 78, art. 14.

¹⁸⁶ *Id.* art. 7(3).

exception must conform to the three-part test dictated by the treaty.¹⁸⁷ Thus, a rights clearance search would also have to conform to this test. Article 6(2) of the WIPO Copyright Treaty authorizes a contracting party to exhaust the rights enjoyed by authors under certain conditions.¹⁸⁸ Yet, Article 10 makes clear that any limitations or exceptions, such as not protecting orphan works at all, must comply with a three-part test—the same three-part test included in both the Berne Convention and TRIPS.¹⁸⁹

The first part of the test requires that the exception be limited to “certain special cases,” which orphan works could arguably be considered, especially since they are not explicitly dealt with in the treaties.¹⁹⁰ The second part of the test requires that the exception “[does] not conflict with a normal exploitation of the work.”¹⁹¹ This would depend on the specific use of an orphan work, but would probably be satisfied in most instances. Yet, the third part of the test poses a problem: It requires that the exception “not unreasonably prejudice the legitimate interests of the author.”¹⁹² It is hard to satisfy this requirement for any orphan work exception through legislation because the rightholders are not given an opportunity to express dissatisfaction with the exploitation of their works, often because they are unaware of any exploitation.¹⁹³ An author’s interests would be “unreasonably prejudiced” the moment that his or her work is used without his or her permission. An author should be afforded every possible opportunity to exploit his or her work and to reap the commercial benefits of such use. It runs contrary to the utilitarian purpose of copyright law

¹⁸⁷ *Id.* art. 10.

¹⁸⁸ *Id.* art. 6(2).

¹⁸⁹ WIPO Copyright Treaty article 10 states:

Contracting Parties may, in their national legislation, provide for limitations of or exceptions to the rights granted to authors of literary and artistic works under this Treaty in certain special cases that do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the author.

Id. art. 10. TRIPS Agreement Article 13 likewise provides: “Members shall confine limitations or exceptions to exclusive rights to certain special cases which do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the right holder.” TRIPS, *supra* note 18, art. 19. Additionally, the Berne Convention Article 9(2) provides: “It shall be a matter for legislation in the countries of the Union to permit the reproduction of such works in certain special cases, provided that such reproduction does not conflict with a normal exploitation of the work and does not unreasonably prejudice the legitimate interests of the author.” Berne Convention, *supra* note 7, art. 9(2).

¹⁹⁰ WIPO Copyright Treaty, *supra* note 78, art. 10; TRIPS, *supra* note 18, art. 13; Berne Convention, *supra* note 7, art. 9(2).

¹⁹¹ WIPO Copyright Treaty, *supra* note 78, art. 10.

¹⁹² *Id.*

¹⁹³ *See generally* EU Copyright Subgroup—Final Report, *supra* note 4, at 10–11.

for an unauthorized user to receive unjust enrichment from another's creative expression.¹⁹⁴ Thus, the establishment of a Rights Clearance Center without the consent of the author would violate the three major international copyright treaties, not to mention copyright law's underlying policy concerns.¹⁹⁵

C. *Reasons for Choice of Law as to the Issue of Infringement*

The question remains as to whether the law of the country of origin of the work should also apply to an infringement dispute that arises between an alleged exploiter and a resurfaced orphan work rightholder. As *SAIF* and *Itar-Tass* demonstrated, courts in the past have not applied the law of the work's country of origin to the infringement claim.¹⁹⁶ Had that been the case in *SAIF*, French law would have applied to the question of infringement because the infringed works were of French origin.¹⁹⁷ Applying the *SAIF* court's reasoning to disputes over infringement of orphan works means that the law of the country of origin of the work would only apply if the infringing act occurred exclusively in the work's country of origin.¹⁹⁸ This is unrealistic because today so much infringement occurs over the Internet, and thus, works are accessed in numerous countries simultaneously.¹⁹⁹ Another problem with applying the law of the work's country of origin to the issue of infringement, at least for the over 150 Berne Convention signatory countries, is that it directly conflicts with the Berne Convention Article 5(2) which expressly indicates that "the extent of protection . . . shall be governed by the laws of the country where protection is claimed."²⁰⁰ Moreover, Paul Edward Geller, a copyright attorney and general editor of the treatise *International Copyright Law and Practice*, maintains: "[I]f a field, such as copyright, has a treaty-governed 'international system,' an *ordre public international*, such as the Berne/TRIPs regime, then the principles of that system, to the extent relevant to choice of

¹⁹⁴ See *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 154–56 (1975).

¹⁹⁵ See WIPO Copyright Treaty, *supra* note 78, pmb.; TRIPs, *supra* note 18, pmb.; Berne Convention, *supra* note 7, pmb.

¹⁹⁶ See *Société des auteurs des arts visuels et de l'image fixe v. SARL Google France*, Tribunal de grande instance [T.G.I.] [ordinary court of original jurisdiction] Paris, May 20, 2008, 05/12117, 1, 7–8, available at <http://www.foruminternet.org/specialistes/veillejuridique/jurisprudence/IMG/pdf/tgipar20080520.pdf>; *Itar-Tass Russian News Agency v. Russian Kurier*, 153 F.3d 82, 90 (2d Cir. 1998).

¹⁹⁷ See *Société des auteurs des arts visuels et de l'image fixe v. SARL Google France*, Tribunal de grande instance [T.G.I.] [ordinary court of original jurisdiction] Paris, May 20, 2008, 05/12117, 1–3.

¹⁹⁸ See *id.*

¹⁹⁹ Paul Edward Geller, *Conflicts of Law and International Copyright*, 51 J. COPYRIGHT SOC'Y 315, 333 (2004).

²⁰⁰ Berne Convention, *supra* note 7, art. 5(2).

law, must serve as binding constraints on conflicts analysis in the field.”²⁰¹ Thus, there does not seem to be a persuasive argument for applying the law of the work’s country of origin to the issue of infringement in a copyright dispute.

One option for choice of law for the question of infringement would be to apply the law of the country where infringement occurred. In the case of *SAIF*, that was the United States because that is where the servers were accessed.²⁰² In *Itar-Tass*, the country where the infringement occurred was also the United States because that is where the infringing newspapers were published.²⁰³ Many scholars have argued that this option is what national treatment requires.²⁰⁴ TRIPS Article 3(1) states: “Each member shall accord to the nationals of other Members treatment no less favourable than that it accords to its own nationals with regard to the protection of intellectual property”²⁰⁵ “Protection” used in this context includes “matters affecting the availability, acquisition, scope, maintenance and enforcement of intellectual property rights.”²⁰⁶

The requirement of national treatment is included in TRIPS to ensure that countries do not give more protection to their own nationals than the nationals of other member states.²⁰⁷ Thus, if a German copyright owner’s work was infringed in the United States, he should receive the same amount of protection as if an American copyright owner’s work was infringed in the United States.²⁰⁸ Although some scholars (such as Geller) and some courts have interpreted national treatment to indicate a choice of law, this does not coincide with the function of national treatment.²⁰⁹ As William Patry, a noted copyright lawyer and blogger, makes clear:

Up to this point, there is nothing to suggest that national treatment operates as a choice of law principle; instead, it functions as a non-discrimination device, restricting countries’ ability to enact laws that treat domestic authors more favorably than foreign authors. Indeed, a case may be made that national treatment alone never operates as a

²⁰¹ Geller, *supra* note 199, at 326.

²⁰² See *Société des auteurs des arts visuels et de l’image fixe v. SARL Google France*, Tribunal de grande instance [T.G.I.] [ordinary court of original jurisdiction] Paris, May 20, 2008, 05/12117, 7.

²⁰³ *Itar-Tass Russian News Agency v. Russian Kurier*, 153 F.3d 82, 84 (2d Cir. 1998).

²⁰⁴ See Geller, *supra* note 199, at 338–39.

²⁰⁵ TRIPS, *supra* note 18, art. 3.

²⁰⁶ *Id.* art. 3 n.3.

²⁰⁷ *Id.* art. 3.

²⁰⁸ See *id.*

²⁰⁹ See Geller, *supra* note 199, at 329; see also *Murray v. BBC*, 81 F.3d 287, 290–92 (2d Cir. 1996).

choice of law principle, in the sense of directing a court to apply the laws of one country in a case where the court might also apply the laws of another country.²¹⁰

Applying a categorical choice-of-law rule, such as the law of the country where infringement occurred, submits an orphan work to a multiplicity of different laws. It is not difficult to foresee a case where infringement occurred in a multitude of jurisdictions, all with different standards for infringement. Under this reasoning, the Berne Convention Article 5(2) is also problematic because protection can be “claimed” in a number of different countries simultaneously when infringement is widespread, like in Internet cases.²¹¹ This suggests that a more policy-based conflict-of-law approach would be appropriate. In fact, “the principle of territoriality becomes problematic if it means that posting a work on the GII [Global Information Infrastructure] calls into play the laws of every country in which the work may be received, when . . . these laws may differ substantively.”²¹² Additionally, “without physical territoriality, can legal territoriality persist?”²¹³

The answer to the previous question is beyond the scope of this Comment, but it does offer a rather simple choice-of-law solution for orphan work infringement disputes. The WIPO Guide to the Berne Convention indicates that parties can stipulate what law will apply in a potential infringement action through a forum selection clause.²¹⁴ Although this might not be helpful in disputes between exploiters and resurfaced rightholders, it may decrease the number of disputes between orphan work authors and subsequent assignees. By including a forum selection clause in all international copyright contracts, courts could avoid complex conflict of law discussions, since the parties would have already stipulated a particular forum’s laws to control in their dispute. Although this solution will not work for orphan work infringement suits due to the nature of orphan works—namely that the works’ authors are usually unknown—others have suggested it as a solution.²¹⁵

Another option would be to always apply the law of the forum that adjudicates the claim. This seems like a very simple approach and would ease

²¹⁰ William Patry, *Choice of Law and International Copyright*, 48 AM. J. COMP. L. 383, 405 (2000).

²¹¹ See Berne Convention, *supra* note 7, art. 5(2).

²¹² Jane C. Ginsburg, *Global Use/Territorial Rights: Private International Law Questions of the Global Information Infrastructure*, 42 J. COPYRIGHT SOC’Y 318, 319 (1995).

²¹³ *Id.* at 320.

²¹⁴ WIPO GUIDE TO THE BERNE CONVENTION 33 (1978); Berne Convention, *supra* note 7, art. 33.

²¹⁵ See WIPO GUIDE TO THE BERNE CONVENTION, *supra* note 214.

the burden on the court, as it would only need to interpret one law: its own. Conversely, this might provide an incentive for orphan work rightholders to forum shop so that they can choose the jurisdiction with the most advantageous law.²¹⁶ Additionally, this option violates Article 5(2) of the Berne Convention²¹⁷ and is not a workable solution for international orphan work disputes for policy reasons, such as forum shopping.²¹⁸ As Geller contends: “In cross-border cases, claimants often shop for forums [because] forum law normally includes the court’s jurisdictional, procedural, and conflicts laws.”²¹⁹ Although the law cannot prevent forum shoppers from seeking out beneficial procedural laws to their advantage, it can limit the extent to which the forum law applies to substantive issues.²²⁰ Additionally, if countries wish to universally apply the law of the forum, it must be agreed upon in a convention or agreement because adopting the principle *ad hoc* would violate the sovereignty of other nations.²²¹ Therefore, applying the law of the forum provides too great an incentive for forum shopping, and thus, it is not a workable solution for the choice-of-law dilemma.

The idea that a law, other than the country of origin’s law, could apply in an infringement action contradicts a strictly territorial approach to copyright. A territorial approach contends that a work has only one copyright in its country of origin and only that copyright can be violated, as opposed to an independent copyright approach, which views a work as having a copyright in every country where it is protected.²²² This territorial approach could be viewed as rather straightforward since the Berne Convention includes a definition of “country of origin,”²²³ which would relieve some of the difficulty in determining which country’s law to apply to the infringement action. Berne Convention Article 5(4) states:

²¹⁶ Patry, *supra* note 210, at 396.

[T]he forum court can easily apply its own law and rely on the actions of its own administrative agency. The principal disadvantage is substantial, though: the same work will be subject to a multiplicity of laws as well as actions of administrative agencies of other countries, laws and actions that may vest different parties with ownership or exploitation rights.

Id.

²¹⁷ Berne Convention, *supra* note 7, art. 5(2).

²¹⁸ See, e.g., VAN EECHOUD, *supra* note 19, at 17; Geller, *supra* note 199, at 317.

²¹⁹ Geller, *supra* note 199, at 317.

²²⁰ Patry, *supra* note 210, at 391.

²²¹ *Id.* at 402–03.

²²² Geller, *supra* note 199, at 319–20.

²²³ Berne Convention, *supra* note 7, art. 5(4).

The country of origin shall be considered to be: (a) in the case of works first published in a country of the Union, that country; in the case of works published simultaneously in several countries of the Union . . . the country whose legislation grants the shortest term of protection; (b) in the case of works published simultaneously in a country outside the Union and in a country of the Union, the latter country; (c) in the case of unpublished works or of works first published in a country outside the Union . . . the country of the Union of which the author is a national.²²⁴

This particular provision is one of the clearest and most easily applied in all of the Berne Convention. For that reason, this format should guide the choice-of-law rule for international copyright infringement actions. Unlike some of the other provisions of the Berne Convention, Article 5(4) takes into account many different scenarios.²²⁵ The problem with this provision is that it seems to be most applicable, in its current form, to the issue of term of protection rather than choice of law.²²⁶ But the clarity of Article 5(4) should dictate a solution as to how to improve the actual choice-of-law provision, Article 5(2).²²⁷

Berne Convention Article 5(2) merely indicates that one should apply “the laws of the country where protection is claimed” in an infringement action.²²⁸ Yet, as discussed previously, it is often difficult to determine with any certainty where the author is actually claiming protection.²²⁹ If, for example, Berne Convention Article 5(2) were changed to read “the laws of the work’s *country of origin*,” then this choice-of-law provision would reap the benefits of the clarity found in Article 5(4). Because Article 5(4) is more explicit in its consideration of country of origin, courts would reach more consistent results than they do under the current system (which requires legal argument and analysis that must be heard regarding where the author is really claiming protection of his work).²³⁰

It is much simpler to identify a work’s country of origin than the country where the author is seeking to claim protection; this small change in the text of Article 5(4) simplifies the whole analysis. Although this solution still lacks universal applicability because not every country in the world is a Berne

²²⁴ *Id.*

²²⁵ *See id.*

²²⁶ *See id.*

²²⁷ *See id.* arts. 5(2), 5(4).

²²⁸ *Id.* art. 5(2).

²²⁹ *See supra* Part II.B.

²³⁰ *See* Berne Convention, *supra* note 7, arts. 5(2), 5(4).

Convention signatory, it provides for the majority of countries that would be facing copyright infringement actions.²³¹ Additionally, Article 5(2) could be expanded to cover more than just the “extent of protection,”²³² but also to cover the scope of necessary search requirements prior to use of an orphan work. In that way, the Berne Convention could become the foremost treaty on international use of orphan works.

By applying the law of the country of origin both to the initial search requirements as well as the subsequent infringement action, courts would only have to apply and analyze one law. However, even this option for choice of law presents a loophole for the savvy author. It is not unfathomable that a clever lawyer might inform his client that if he first publishes his work in a jurisdiction with protectionist copyright laws, he will forever enjoy that same protection, regardless of where infringement occurs. Yet, this is inevitable with any law. Lawyers currently strategize their way around the law. Any solution to the problem of choice of law will be malleable; this malleability should not be looked at as an obstacle, but rather as a necessary evil.

CONCLUSION

As one can see, the current international copyright treaties lack a solution as to what law should apply to the transnational prerequisites for use of an orphan work, as well as to potential copyright infringement actions that may result from transnational use of an orphan work.²³³ “An orphan works regime must therefore aim to make works more widely available by reducing the exploiter’s risk with respect to truly ‘orphaned’ works while avoiding the other extreme of thrusting ‘orphanage’ upon works whose right holders can in fact be found.”²³⁴ I suggest that a *depêçage* of the law is necessary in order to achieve a balance, not only between the laws of the two disputing countries or nationals of those countries, but also between the ever-present policy concerns surrounding copyright law—namely, the tug-of-war between public domain access for the public versus protection of author’s rights in order “To promote the Progress of Science and useful Arts.”²³⁵

²³¹ As one would imagine, most of the countries that deal with copyright issues are Berne Convention signatories; most third-world countries do not have much use for copyright law. *See id.*

²³² Berne Convention, *supra* note 7, art. 5(2).

²³³ *See supra* Part II.

²³⁴ Ginsburg, *supra* note 3, at 4.

²³⁵ U.S. CONST. art. I, § 8, cl. 8.

Thus, I will provide two suggested reforms for this problem. First, I will offer some temporary guidelines to be used in conjunction with the current international copyright treaties. Second, I will offer a statutory amendment that can be made to the Berne Convention to aid with future orphan work disputes. I suggest that until every country enacts legislation dictating which country's law controls for search requirements prior to orphan work use as well as for infringement cases over orphan works, the only equitable solution is to decide these cases on an ad hoc basis and assess policy concerns, along with the current treaty provisions, as the main impetus for the choice of law in each case.

This ad hoc basis test can be structured in such a way as to promote consistency of result between different jurisdictions' courts. Although every court will inevitably have its own policy concerns and its own legal analysis, by following at least the same plan, courts will more often than not reach the same result. As mentioned previously, inconsistency of verdicts is a fear, especially in copyright law.²³⁶ If injured copyright owners can simply search out the most advantageous jurisdiction, there is really no equity in the decision.²³⁷ This is particularly the case when the orphan work exploiter did everything in his or her power to conduct extensive searches, wanted to pay the owner a license fee, and was simply unable to locate the proper rightholder for whatever reason.²³⁸ In order to avoid this inequitable result, every court, regardless of which country, should decide choice-of-law issues for international orphan work cases based on the same test or statutory language.

Because Berne Convention Article 5(2) already indicates a preliminary guide as to which law to apply to the issue of infringement, I do not wish to advise courts to ignore the only statutory guide that the international system currently provides.²³⁹ However, the Berne Convention does not provide for the particular case of orphan works, and because of that, additional guidelines are necessary in order to provide courts with a consistent manner with which to decide these complicated cases of transnational use and possible infringement of orphan works. First, I will offer a suggestion for temporary guidelines for courts to apply before the international community makes any legislative amendments to either the Berne Convention or TRIPS. Second, I will offer an amendment to the statutory language of the Berne Convention that will not

²³⁶ See discussion *supra* Part II.A.

²³⁷ See VAN EECHOUD, *supra* note 19, at 17.

²³⁸ See *id.*

²³⁹ See Berne Convention, *supra* note 7, art. 5(2).

only provide for the case of international copyright infringement, but will also provide for the more specific case of transnational orphan work use and the subsequent infringement actions that may arise from such exploitation.

A. *Temporary Guidelines*

The temporary guidelines must begin with the idea of *dépêçage* discussed previously in Part III.²⁴⁰ Because the legal analysis of any orphan work case must necessarily include both an analysis of the defendant's efforts in the initial search to locate the rightholder of the work, as well as the legal analysis of the alleged infringement, the concept of dismembering the claim into two parts and applying a different country's law to each is practical.²⁴¹ The goal of dividing the claim up into its two separable parts is not simply to apply two different countries' laws and thereby achieve some sort of theoretical equity, but to choose the country's law that has the most practical application to the issue at hand. By applying the law with the most applicability to each issue, both the plaintiff and the defendant should feel that he or she is receiving the consequences or benefits of the most obvious law. Courts should not be blindsiding the parties by applying an arbitrary country's law without adequate notice.

Because the current international treaties do not provide for a choice of law in the case of orphan work disputes, the guidelines for choice of law as to the issue of initial search requirements is a new one.²⁴² By applying a connecting factor test to the work, courts can achieve the most predictable and practical result as to which country's law to apply to the issue of the defendant's obligations as to initial search requirements.²⁴³ By choosing the country's law with the strongest relationship to the work, the plaintiff receives the benefit of the law that he would assume to be *protected by*, and a defendant has adequate notice of the law that he would assume to be *held accountable for*.

This choice-of-law rule has fewer consequences than a rule that applies the laws of the work's country of origin to the issue of diligent search requirements prior to an orphan work's exploitation. First, rights in a work are often transferred and the rights can change hands numerous times throughout a work's protectable years. It seems arbitrary to apply the law of the work's

²⁴⁰ See discussion *supra* Part III.B.

²⁴¹ See VAN EÉCHOUD, *supra* note 19, at 212–13. See generally Ginsburg, *supra* note 3.

²⁴² Cf. Berne Convention, *supra* note 7; TRIPS, *supra* note 18; WIPO Copyright Treaty, *supra* note 78.

²⁴³ See *Itar-Tass Russian News Agency v. Russian Kurier*, 153 F.3d 82, 88–92 (2d Cir. 1998).

country of origin merely because that was the first place of publication or the place where the original author is a national.²⁴⁴ If an author creates and publishes a work in Germany in year one and then transfers that same work in year two to an Italian who exploits the work for the next forty years, does it not make sense that the laws of Italy should have more weight on a future infringement action than the laws of Germany? If courts apply a connecting factor test, this is exactly the result that will be reached.

Additionally, a connecting factor test will prevent authors from “country shopping” for the best country in which to publish their work.²⁴⁵ If the choice-of-law rule for the issue of search requirements were the country of origin, clever authors would search out the country with the most rigid and impossible-to-achieve search standards and publish their work in that country in order to forever prohibit exploiters from making a legal use of their work. But, by allowing the law of the country with the most connecting factors to the work, the author has almost no control over which law will be applied to the issue of search requirements. Because an author will exploit his or her creative expression wherever it is convenient and most sought after, he or she will not choose to exploit a work in a country with protectionist copyright law. It is not economically practical or efficient. Thus, by choosing to apply the law of the country with the strongest relationship to the work, neither current rightholder nor future orphan work exploiter is given any procedural advantages. Therefore, courts are more likely to reach an equitable result as to the scope of diligent search required prior to using an orphan work.

There also needs to be temporary guidelines for courts as to the choice of law to apply to the issue of infringement. An international statutory standard already exists;²⁴⁶ however, this standard does not provide consistent or equitable results in most cases.²⁴⁷ Berne Convention Article 5(2) provides that the law to be applied should be the law “where protection is claimed.”²⁴⁸ But as we have seen from some of the previous cases, it is not always easy for courts to interpret where exactly protection is being claimed.²⁴⁹ This has been interpreted to mean a number of places including the actual place of

²⁴⁴ See Berne Convention, *supra* note 7, art. 5(4).

²⁴⁵ See VAN ECHOU, *supra* note 19, at 17.

²⁴⁶ Berne Convention, *supra* note 7, art. 5(2).

²⁴⁷ See discussion *supra* Part III.

²⁴⁸ Berne Convention, *supra* note 7, art. 5(2).

²⁴⁹ See *Société des auteurs des arts visuels et de l'image fixe v. SARL Google France*, Tribunal de grande instance [T.G.I.] [ordinary court of original jurisdiction] Paris, May 20, 2008, 05/12117, 1, 7–8, available at <http://www.foruminternet.org/specialistes/veillejuridique/jurisprudence/IMG/pdf/tgipar20080520.pdf>.

infringement,²⁵⁰ the place where the effects of infringement are felt,²⁵¹ or the place where the work is being accessed.²⁵² It is clear that, as it currently stands, Berne Convention Article 5(2) is not very useful to courts.²⁵³ I suggest that courts continue to consult the Berne Convention as a guide to choice of law for the issue of infringement, but perhaps combine the statutory test with a more policy-based connecting factor test, similar to that used to determine choice of law for the issue of diligent search requirements.²⁵⁴ By combining these two types of tests, courts would have more of a framework with which to sort out the parties' arguments as to the place of infringement or, in other words, the place "where protection is claimed."²⁵⁵

The purpose of adding this connecting factor test to the issue of infringement is not to discreetly force both issues under the same country's law, but rather to provide a means of choosing the law that is obvious and that provides both parties the greatest notice. Of course, courts may in some cases interpret the connecting factors analysis differently, but at least this provides both the parties and the courts a realistic hope of consistent verdicts. Again, by incorporating a connecting factor test to the choice-of-law analysis for the infringement issue, courts can avoid both inconsistent results and forum shopping. Because courts employ balancing tests such as this for many other legal issues, this solution is not stretching a court's capacity beyond its normal everyday functions. These guidelines are both achievable and practical.

B. Statutory Amendment to the Berne Convention

Although I have advocated a temporary solution for the choice-of-law issue in international orphan work disputes, eventually, a statutory amendment would make the issue clearer and more reliable. Because of the large number of countries that are Berne Convention signatories, I would suggest an

²⁵⁰ *Itar-Tass Russian News Agency v. Russian Kurier*, 153 F.3d 82, 84 (2d Cir. 1998); *Société des auteurs des arts visuels et de l'image fixe v. SARL Google France*, Tribunal de grande instance [T.G.I.] [ordinary court of original jurisdiction] Paris, May 20, 2008, 05/12117, 8.

²⁵¹ *Sté informatique service réalisation organisation (Sisro) v. Sté de droit néerlandais en liquidation Ampersand Software BV*, Première chambre civile [Cass. 1e civ.] [first civil chamber] Mar. 5, 2002, J.C.P. 2002, II, 10082, 994, note Watt.

²⁵² See discussion *supra* Part III.A.

²⁵³ See generally *Itar-Tass*, 153 F.3d at 91; *Sté informatique service réalisation organisation*, J.C.P. 2002, II, 10082, 994, note Watt; *Société des auteurs des arts visuels et de l'image fixe v. SARL Google France*, Tribunal de grande instance [T.G.I.] [ordinary court of original jurisdiction] Paris, May 20, 2008, 05/12117, 7–8.

²⁵⁴ See discussion *supra* Part III.B.1–2; *Itar-Tass*, 153 F.3d at 88–92.

²⁵⁵ Berne Convention, *supra* note 7, art. 5(2).

amendment to the Berne Convention, particularly Article 5(2)—the “alleged” choice-of-law provision.²⁵⁶ Currently, Berne Convention Article 5(2) provides: “[T]he extent of protection . . . shall be governed exclusively by the laws of the country where protection is claimed.”²⁵⁷ The word “exclusively” suppresses a court’s ability to weigh factors and make any type of ad hoc decision based on policy or practicality. Thus, I would delete that adverb from the provision. Ultimately, Berne Convention Article 5(2) should read: “[T]he extent of protection . . . shall be governed by the laws of the country where protection is claimed.” The “country where protection is claimed” shall be determined by a connecting factor test. Moreover, in the case of orphan works, the search requirements prior to use shall be governed exclusively by the law of the country deemed to have the most connecting factors to the work. Until every country legislates to provide for the same choice-of-law rule, this amended legislation can aid courts in determining the most equitable result for internationally exploited orphan works.

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²⁵⁶ *Id.*

²⁵⁷ *Id.*

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