

Don't Get Berned – An Important Limitation on Enforcement of Foreign Copyrights Under U.S. Law

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Since March 1, 1989, the United States has been a member of an international copyright treaty named the Berne Convention (formally called the “International Union for the Protection of Literary and Artistic Works”). This treaty was established on September 8, 1886 in, of course, Berne, Switzerland. The World Intellectual Property Organization, located in Geneva, Switzerland, is charged with administration of the treaty and, at present, there are 174 contracting nations.

The Berne Convention guarantees that works shall be protected in countries other than the author’s country of origin to the same degree the foreign country protects works of its own national authors. Moreover, “[t]he enjoyment and the exercise of these rights shall not be subject to any formality; such enjoyment and such exercise shall be independent of the existence of protection in the country of origin of the work.” Berne Convention art. 5(2) (Paris text). The United States took a long time to join the Berne Convention because of the formalities required by U.S. Copyright Law, including use of proper copyright notice and registration as a prerequisite to bringing legal action.

The no-formalities protocol of the Berne Convention does not mean, however, that contracting parties cannot impose additional requirements under their national laws, either for domestic copyright owners or to take advantage of certain additional remedies under national law. So when it joined the Berne Convention, the United States decided to maintain certain formalities for domestic works, while dispensing with formalities for foreign-based works. For example, Section 411(a) of the Copyright Act was amended to read: “no civil action for infringement of the copyright in **any United States work** shall

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be instituted until preregistration or registration of the copyright claim has been made” (emphasis added). Accordingly, owners of foreign works may bring an action for copyright infringement in U.S. courts without having obtained a registration from the U.S. Copyright Office, whereas U.S. citizens must still obtain a registration to bring a lawsuit.

Most notably, however, and the purpose of this post is to highlight the fact that a foreign copyright owner who brings suit in the United States without a corresponding United States copyright registration can likely only obtain an injunction, actual damages, and/or an infringer’s profits as a remedy. Statutory damages, which Congress included in the Copyright Act as an incentive for timely registration of works, and which a copyright plaintiff can elect instead of having to prove actual damages and profits, are not available to foreign copyright owners who have not registered their works with the U.S. Copyright Office.

Statutory damages are a powerful tool for a copyright plaintiff. To qualify for statutory damages, a work generally must either be registered within three months after first publication of the work or before the date the infringement occurs. At present, the range of statutory damages a court can award range from \$750 to \$30,000, though a court can increase the award to \$150,000 in cases of willful infringement.

Courts have affirmed that although the Copyright Act does not require registration of foreign works to bring an infringement lawsuit, the Act does not exempt registration with respect to statutory damages. See, e.g., Football Association Premier League Ltd. v. YouTube Inc., 633 F. Supp. 2d 159, 162-63 (S.D.N.Y. 2009). Further, both the House and Senate Reports on the implementation of the Berne Convention specifically note that the imposition of a registration requirement to qualify for statutory damages is not inconsistent with the no-formalities requirements of the Berne Convention.

The takeaway is that owners of foreign copyrights that qualify for protection in the United States under the Berne Convention should obtain U.S. copyright registrations for their most important works, as doing so preserves the ability to claim statutory damages in a lawsuit. Otherwise, foreign copyright owners could find themselves faced with the time-consuming and expensive effort of proving actual damages and profits in infringement actions.