

## **DETERMINATION OF COUNTRY OF ORIGIN WHEN A WORK IS FIRST PUBLICLY DISCLOSED OVER THE INTERNET**

Report by the Country of Origin Study Group of the  
International Literary and Artistic Association (ALAI)\*

### The problem

At the June 2011 ALAI Executive Committee meeting, the members designated the creation of a study group to examine the Berne Convention determination of the country of origin of a work first disclosed over the Internet. The study was prompted in part by the decision of a U.S. district court holding that the initial making a work available over a non-U.S. website for downloading by users located anywhere in the world, including the U.S., qualified the work as simultaneously “first published” in the US, and therefore subject to U.S. formalities. *See, Kernal Records OY v Mosley*, 794 F.Supp. 2d 1355 (S.D. Fla. 2011). Under Berne art. 5(3), protection in the country of origin is governed by local law, which under art 5(1) need not, as to domestic authors, conform to Berne minima (such as the prohibition of formalities conditioning the exercise or existence of copyright). But if a work first disclosed over the Internet is considered “simultaneously first published” in every country where it may be downloaded, then the work could have over 160 countries of origin, and in effect might receive Berne minimum protections in none of them.

At the same time, if mere disclosure over the Internet “first publishes” a work everywhere in the Berne Union, a non-Union national or resident author would be eligible for Berne protection by virtue of art. 3(1)(b) and art. 5(3) phr. 2, and therefore would be entitled to national treatment (albeit not Berne minima) in every country of the Union notwithstanding that author’s home country’s non participation in the Union. While article 3 offers several ways in which non-Union creators can become eligible for protection, it nonetheless retains some exclusions, thus allowing Member States to deny national treatment to Berne outsiders. An interpretation of first publication to cover mere disclosure over the internet would effectively override those limitations.

Such absurd and undesirable results would defeat the general purpose of the Berne Convention, but it is necessary to examine whether these results are consistent with the Convention’s text, in art. 3(3). For the reasons set out below, the Study Group concludes that it is not.

If first disclosure over the Internet does not “publish” the work, so that it remains unpublished (unless or until publication within the meaning of art. 3(3) occurs), the country of origin is that of the author’s nationality (art. 5(4)(c)). But in the case of many

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\* This report was adopted by the ALAI Executive Committee at its meeting in Paris on January 14, 2012. The members of the Study Group were Jørgen Blomqvist, Mihály Ficsor, Ysolde Gendreau, Jane Ginsburg, Silke von Lewinski, Delia Lipszyc, Antoon Quaedvlieg, Sam Ricketson, Paolo Spada and Michel Walter.

internet-disclosed works, the work may have multiple authors. The Berne Convention, however, does not specifically address multiple authorship, apart from the art. 7bis calculation of term based on the death of the last surviving co-author, and, implicitly, regarding cinematographic works, for which art 5(4)(c)(i) simplifies the determination of the unpublished work's country of origin by designating the habitual residence of the "maker" headquartered in a Union country. For other works, the general art. 5(4)(c) reference to the authors' nationalities would seem to apply. Yet if the countries of the authors' nationalities supply the reference for determining the work's country of origin, the risk of multiplication of countries which need not extend Berne minimum protection expands with the number of participants in the work's creation. The Study Group therefore addressed the analysis of country of origin for multiple-authored works. We believe that Berne allows for solutions/interpretations that are consistent with its system whilst avoiding Berne-adverse consequences. Accordingly, we propose several approaches that fill the gaps in the Convention while remaining true to its overall goals of promoting the international dissemination and protection of works of authorship.

Determination of the country of origin is also relevant to other Berne provisions, including the application of the art. 7(8) rule of the shorter term and to the application in time of the Berne Convention under art. 18. While the reciprocity provision of art. 2(7), concerning applied art, also turns on identification of the country of origin, the works at issue exist exclusively in material copies, and therefore, unless images of the works are first disseminated over the internet, are not likely to be affected by the internet disclosure problem.

## I "First publication"

The Study Group determined that under the 1971 Paris Act articles 5(4) and 3(3), a work made available over the Internet for downloading is not "simultaneously published" all over the world because the copies referred to in art 3(3) are physical copies, not digital copies.<sup>1</sup> We infer this from the words "manufacture of copies" or, in the authoritative French version, "fabrication d'exemplaires," and the term "availability of *such* copies" (emphasis supplied), which would seem to refer back to the material copies that are made available by the author or authorized intermediary distributor. Under a more permissive interpretation of art 3(3), the hallmark of publication would be the public availability of copies, regardless of how the copies are materialized.<sup>2</sup> But the conclusion that the copies envisioned in article 3(3) are pre-existing physical copies also follows from the comparison of the first and second phrases of art 3(3): the exclusion

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<sup>1</sup> Berne article 3(3) states:

The expression "published works" means works published with the consent of their authors, whatever may be the means of manufacture of the copies, provided that the availability of such copies has been such as to satisfy the reasonable requirements of the public, having regard to the nature of the work. The performance of a dramatic, dramatico-musical, cinematographic or musical work, the public recitation of a literary work, the communication by wire or the broadcasting of literary or artistic works, the exhibition of a work of art and the construction of a work of architecture shall not constitute publication.

<sup>2</sup> S Ricketson and JC Ginsburg, *International Copyright and Neighbouring Rights: The Berne Convention and Beyond* para. 6.52 (2006) (characterizing this interpretation as "more progressive").

from the definition of “published works” of literary or artistic works communicated by wire or broadcasting casts doubt on the characterization of works “made available” to the public over digital networks as “published.” Moreover, in light of the purpose of the Berne Convention to promote the international protection of authors, it would be counterproductive (not to say perverse) to adopt a concept of “publication” that, by multiplying the work’s countries of origin, would have the effect of disqualifying internet-disclosed works from the treaty’s minimum standard of protection.<sup>3</sup> The abandonment during the 1996 Diplomatic Conference of the draft art. 3 of the WCT, which would have equated the making available of copies for public access with published works under Berne art. 3(3),<sup>4</sup> presents a further impediment to extending the Berne text to encompass copies materialized only on receipt. Thus, works made available only on the Internet, even when globally accessible, are not “published” according to the definition in art. 3(3), because the required distribution of pre-existing physical copies to serve the needs of the general public has not taken place.<sup>5</sup>

Furthermore, the Study Group considered that art. 3(3) of the Berne Convention indeed presupposes a substantial and traceable attachment to a particular country, which seems to be established by a work’s publication in the traditional sense, because, for example, the place of first publication will coincide with the author’s residence, or if the publisher is situated elsewhere, the author will have selected that publisher knowing of its foreign location. Whether the chosen publisher is local or foreign, the selection of a publisher evidences an element of active *distribution*, a sustained effort to reach the public and sell or offer the work in a particular place over a more or less extended period. Only under such circumstances is there a sufficiently significant relationship with the legal and economic order of the country from which the work is deemed to “originate,” to grant domestic copyright law (and its elements of economic regulation) priority over the Berne minima and prohibition of formalities. By contrast, these points of attachment do not necessarily pertain with regard to a mere dissemination over the internet.<sup>6</sup>

The Study Group considered whether nonetheless, given the evolution in the means of reproduction, which allows users to make copies upon receipt, art. 3(3) should be interpreted to embrace the creation of copies by recipients of a digital communication. We concluded that such an interpretation, in tension with the text, would not be desirable from a practical point of view either. Because denominating every country of potential

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<sup>3</sup> The latter is the main argument in S von Lewinski, *International Copyright Law and Policy*, paras. 7.31-33 (2008). For detailed discussion of the relationship of the two phrases and of the conclusion that article 3(3) “copies” do not include on-demand digital copies, see *ibid*, and J. Reinbothe and S. Von Lewinski, *The WIPO Treaties 1996*, paras. 18-21 (2002).

<sup>4</sup> See, e.g., Mihaly Ficsor, *The Law of Copyright and the Internet: The 1996 WIPO Treaties, Their Interpretation and Implementation*, paras. 2.53-55 (2002).

<sup>5</sup> That article’s reference to “satisfy the reasonable requirements of the public, having regard to the nature of the work” anticipates that “publication” can occur when copies are distributed to intermediaries who will perform or communicate the work, for example in musical scores publicly performed by orchestras or film prints publicly exhibited in cinemas, because the “reasonable requirements of the public” in such instances are to hear or see the performance of the work, not to obtain individual copies of it. See, e.g., S Ricketson and JC Ginsburg, *supra*, at paras. 6.33-35 (reviewing drafting history of “availability of such copies has been such as to satisfy the reasonable requirements of the public” language in art 3(3)).

<sup>6</sup> See *Walter*, *Österreichisches Urheberrecht – Handbuch I* n° 100.

receipt as a country of simultaneous first publication could effectively eviscerate the application of the Berne Convention, we addressed two alternative points of attachment for first publication: the country from which the work was uploaded, and the country in which the host website is situated. The first point of attachment is problematic for at least two reasons. First, the place from which the upload takes place may lack any significant connection with the author or her work; because an upload may occur from anywhere, the author may just be passing through a given territory when she sends her work to a website. Second, if the work has multiple authors, there may be multiple countries from which uploads occur, so the identification of the country of origin may not be simplified.

The second potential point of attachment, the situs of the website from which the work is first disclosed, at first seems both predictable and reasonable. The website in effect would be deemed to play the role of a traditional publisher, whose territory (assuming the work is first distributed from there) becomes the country of origin.<sup>7</sup> This concept appears to underlie the – subsequently abandoned – WCT draft article 3(2) proposal that “When applying Article 5(4) of the Berne Convention, Contracting Parties shall consider works [made available over digital networks] to be published in the Contracting Party where the necessary arrangements have been made for the availability of these works to members of the public.” But, in addition to the negative inferences that follow from the 1996 Diplomatic Conference’s rejection of this text, it may be misleading to equate traditional publishers and website operators. While the former have been rooted in particular territories, the latter’s connection to a particular country may be both fortuitous and transitory, given the transnational mobility of online operations. Moreover, in choosing to make her work available over a given website, the author may not even know where the website is physically located. The potential lack of a significant relationship between the author and the location of the servers hosting a particular website makes that location a dubious candidate for country of origin.<sup>8</sup> It is also important to take account of digital means other than websites through which works are made available to the public, including by means of online storage “boxes” whose contents the storage service’s customers make available to other users of the service. The location of the “cloud” service’s computers or its business seat may lack a significant relationship to the author or her creation.

The Study Group recognizes that interpreting art 3(3) to require that the material copies must pre-exist the end-user's acquisition of them could mean that a work made available for end-user conversion into a hard copy (e.g., print-on-demand) would not thereby be "published" even though there seems little functional difference between acquiring a pre-materialized copy, and acquiring a copy that is materialized at the

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<sup>7</sup> The EU 1993 Cable and Satellite Directive, art. 1(2)(b) and (d), takes an analogous approach, in rooting the act of communication to the public in the country of uplink (or in the country of the uplinker’s effective establishment). But the Commission has declined to extend this approach to the Internet, inter alia because the source country of the communication will often be likely to be outside the EU.

<sup>8</sup> See, e.g., Reinbothe & von Lewinski, *supra*, at para. 20 (“the location of the server is a matter of chance and in the main cannot be influenced, nor easily ascertained, by the rightholder. Any other possible determination of the place of publication in an online environment would seem a fiction rather than an interpretation of the existing provisions.”).

moment of purchase (or other lawful mode of acquisition). On the other hand, it may be difficult to draw the line between immediate print-on-demand (arguably “published”), and making available for downloading for potential subsequent printing-out, or burning to CD, or other mode of generating hard copies (arguably not “published”). The Study Group also acknowledges that under its interpretation, a work which exists only in digital format stored in computer memories, which may soon be the case for recorded music, and perhaps increasingly the case for literary and photographic works and at least some audiovisual works, will never be “published” within the meaning of art. 3(3). But the possibility that works may be disseminated without being “published” appears already to be accepted in the international arena. For example, the 2011 EU Directive on the duration of neighboring rights in sound recordings recognizes in art. 1(2) that a sound recording may be made available yet never “published” because it calculates duration from either the date of publication or from when the recording was “lawfully communicated to the public.”

Given the absurdities that can arise from tying the country of origin to public disclosure in the digital environment, with the resulting multiplications of countries of origin, the Study Group concludes that the seemingly counter-intuitive result that a work disseminated only in dematerialized digital format is never “published” is the less problematic outcome. It is important in this respect to underscore that a work which, while technically “unpublished,” has been publicly disclosed and made available to the public with its author’s consent would, by virtue of its divulgation, be subject to the Union member copyright exceptions permitted under art. 10(1). In other words, “publication” (specifically in the context of *first* publication) is a term of art entailing particular consequences under the Berne Convention. In the sense of the Convention, the term should be employed with precision, and not conflated with the more colloquial meaning of “publicly disclosed.”<sup>9</sup>

## II Country of origin of multiple-authored works

If an Internet-disclosed work is not (and might never be) “published” within the meaning of art 3(3), the point of attachment under art. 5(4)(c) becomes the author’s nationality (at the time of the work’s creation). Because this is a relatively stable criterion, it supplies a workable point of reference – for single-authored works. The more co-authors a work has, however, the more it may have potential countries of origin, particularly in the digital environment, which may foster collaborations across many countries. The question therefore arises whether it is possible, under the Berne Convention, to simplify the determination of the country of origin of unpublished multiple-authored works. The Study Group notes that the interpretive issues underlying this determination are not confined to internet-disclosed works, and that the Convention’s lacuna in this regard affects unpublished works generally. Nonetheless, the problem is most acute in the context of “unpublished” works made available over the internet, and

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<sup>9</sup> That “publication” or “published” might have a technical meaning entailing certain legal consequences as well as a more imprecise and colloquial meaning is not unknown in national laws, particularly in the U.S. copyright law. See Robert A. Gorman and Jane C. Ginsburg COPYRIGHT: CONCEPTS AND INSIGHTS 109-12 (2012).

therefore seemed appropriate for the Study Group's attention and recommendations. We observe that, because we are filling a gap in the Convention, and taking into consideration the different functions of the country of origin notion within its framework, the approaches we outline, while consistent with the text and purpose of the Berne Convention, may not be the only ways to resolve the problem of identifying the country of origin for multiple-authored unpublished works.

One approach could be to analogize from art. 5(4)(a), which addresses simultaneous first publication in multiple Union countries, and designates the country with the shortest Berne-compatible term. But even if many countries have now adopted a life+70 copyright term, there remain many countries whose term of protection is still life+50; as a result, the solution of designating the country of the shorter term may not simplify sufficiently.

On further reflection, however, it may not be necessary to reduce the identification of the country of origin to a single country when the point of attachment is authorship rather than publication. While, in the case of multiple authors, the country of origin may be all the countries of the authors' nationalities, this does not in fact mean that the WORK will be subject to sub-Berne protection in each of those countries. Rather, under art. 5(1) only the local AUTHOR might be covered by her national law (which might be less protective than Berne minima); non local authors would still be entitled to Berne minimum protection. As a practical matter, then, Berne member States may not impose formalities on (or otherwise accord less than Berne-minimum protection to) multiple-authored works whose authors are nationals of other countries because one author's country of origin is not the country of origin for the other authors.

A disadvantage of this approach is that, in the event of sub-Berne protections in a particular Member State, the plaintiffs in any copyright action will have to be the non local authors. This may increase the cost of litigation, and, conceivably, deny monetary recovery to the local author.

There exist within the interstices of the Berne Convention alternative approaches to designating the country of origin. Because the Convention's definition of country of origin does not address joint works, it may be possible to fill the gap by interpreting the country of origin of a multiple-authored work as the country of nationality (or residence) of a majority of the co-authors. In the case of dynamic collaborations, however, the majority country could change as new co-authors participate in the work's creation. Failing a majority country, or in lieu of such a point of attachment, the joint authors might agree to designate one co-author's country as the origin. In the case of multiple-authored works created over the Internet, such a designation could easily be implemented, for example in the terms of access to the co-authored work.

The co-authors' designation of a country of origin may resolve an additional problem which may arise in the collaborative creation of works over the Internet: the country of origin of anonymous works. If the unpublished work is truly anonymous, it has no country of origin, and will not qualify for protection under the Convention.

However, if some of the co-authors (and their nationalities) are known, the work will not be considered anonymous. If none of the co-authors are known, but the work is a cinematographic work, the maker's nationality supplies the point of attachment (assuming the maker is known), see Berne art. 5(4)(c)(i). For other kinds of works, if none of the authors is known, there may still be a way to identify a country of origin within the Berne Convention's coverage. Under art. 15(3) the "publisher" whose name appears on the work is "deemed to represent the author." The word "publisher" in art. 15(3) need not always be understood as the person or entity who "publishes" the work in the sense of art. 3(3). Instead, the art 15(3) "publisher" of "unpublished" works could also be understood as the person or entity who assembles, edits and makes the work available, such as, for example, a wiki. This would seem a permissible interpretation in view of the changing technology. As the author's proxy, the "publisher"'s nationality or seat could therefore supply the relevant point of attachment under art 5(4)(c).

Article 15(3) inspires a more general approach: In the case of a work created by multiple authors, particularly one to which multiple authors contribute successively, and in the absence of a collective designation of a country of origin, then even if some or all of the contributors are known, the person or entity who has assembled and made the work available could be deemed the author or publisher of the work as a whole - without prejudice to the authorship of individual contributions, if separately identifiable - and the country of that person's nationality or seat would be deemed the country of origin. This designation adopts the solution found in many national laws, including the U.S., with respect to "collective works" (a category, like joint works, that the Berne Convention generally leaves unaddressed) such as newspapers and encyclopedias. This solution fills a gap in the Convention in a manner we believe consistent with the overall goals of the convention to facilitate the effective international protection of works of authorship, but we acknowledge that the Convention does not mandate our approach. We therefore include this solution in the list of "recommended" interpretations, rather than "conclusions" derived from the text of the Convention.

In general, in the online environment, the location of the website or server from which a work is first disclosed to the public may lack the importance once taken for granted in the case of the place selected for the first publication of hard copies. Because in the online context it may no longer be appropriate to assume a significant relationship between the work and the terrestrial place corresponding to the virtual place of its initial disclosure, the relevant point of attachment should remain the nationality of the author. In the case of multiple authors from multiple countries, the authors may themselves determine the place of most significance to their creative endeavor by designating a country of origin. Alternatively, where a person or entity performs the coordinating role of a traditional publisher of a collective work, it is consistent with the goal of identifying the country with the most significant relationship to the creation and dissemination of the work to designate as the country of origin the country of which the coordinator of the collective work is a national or has its seat.

The Study Group acknowledges that its recommendations respecting multiple authorship propound a new and progressive interpretation of the Berne Convention.

Where, as in this instance, there are gaps in the treaty language, and issues arise that were never seriously contemplated when the Convention and its subsequent revisions were originally formulated (most recently, over 40 years ago), forward-looking interpretations are especially warranted. The Convention's general lack of fixed rules regarding the country of origin of multiple-authored works may thus offer an opportunity rather than an impediment, for it allows interpretations of the Convention in light of technological change. The proposed recommendations promote the overall objectives of the Convention - the protection of authors - with the flexibility needed to respond to evolving conditions of creation and dissemination of works of authorship.

### Summary Conclusions

1. A work disclosed only in immaterial form over a digital network is not "published" within the meaning of Berne art. 3(3)
2. Such a work's country of origin will be the country of nationality of its author at the time of the work's creation, under Berne art. 5(4)(c)

### Recommendations

3. If the work has multiple co-authors, the country of origin will be one co-author's country of nationality, as designated by the co-authors
4. In the absence of such a designation, the country of origin will be that of the nationality of a majority of the known authors at the time of the work's creation
5. If none of the authors is known, but a person or entity has assembled and made the work available, that person shall be deemed to represent the authors under Berne art. 15(3), and the country of that person's nationality or seat shall be the country of origin
6. In the case of a work created by multiple authors, particularly one to which multiple authors contribute successively, and in the absence of a collective designation of a country of origin, then even if some or all of the contributors are known, the person or entity who has assembled and made the work available may, for purposes of interpretation of Berne art. 5(4), be deemed the author of the work as a whole - without prejudice to the authorship of individual contributions, if separately identifiable - and the country of that person's nationality or seat shall be deemed the country of origin.