



Owners of Copyrights in Foreign Works Must Register Their Works in the U.S. to Seek Statutory Damages and Attorneys' Fees in a Lawsuit – Berne Convention Does Not Supersede Section 412 of the Copyright Act

February 11, 2010

by [Thad Chaloehtiarana](#), [Trademark Attorney](#)

Article Five of the Berne Convention for the Protection of Literary and Artistic Works ("Berne Convention") provides that "the enjoyment and the exercise of [rights under the Convention] shall not be subject to any formality". In the Berne Convention Implementation Act of 1988 (the "Implementation Act"), Congress brought United States copyright law into conformity with the standards of the Berne Convention. Among other things, the Implementation Act released foreign (but not U.S.) claimants from the obligation to register their foreign copyrights as a prerequisite to enforcing them in United States courts. The Implementation Act, however, did not amend Section 412 of the Copyright Act of 1976 which conditions an award of statutory damages or attorneys' fees on registration of the copyright in the United States.

Does Section 412 of the Copyright Act conflict with Article Five of the Berne Convention, such that it should be pre-empted by the Supremacy Clause of Article VI of the United States Constitution? In [Elsevier B.V. v. UnitedHealth Group Inc.](#), 93 U.S.P.Q.2D 1408 (S.D.N.Y. 2010), the U.S. District Court for the Southern District of New York, following the well-established precedent that the Berne Convention was not self-executing, answered, "No".

In [Elsevier](#), Plaintiffs Elsevier B.V., Elsevier, Inc. and Mosby, Inc. (collectively, "Elsevier"), owned or exclusively licensed copyrights in scientific publications that were offered to subscribers via an on-line database. Many of the publications were created outside of the United States and the foreign copyrights were not registered in the United States. In the context of a copyright infringement action, Elsevier sought a declaration that the statutory damages and attorneys' fees provisions of Section 412 of the Copyright Act violated the Supremacy Clause of Article VI of the United States Constitution because the provisions conflicted with Article Five of the Berne Convention. Elsevier



PATTISHALL
McAULIFFE
NEWBURY
HILLIARD &

GERALDSON LLP • 311 South Wacker Drive, Suite 5000 • Chicago IL 60606 • T (312) 554-8000 • F (312) 554-8015 • www.pattishall.com

These materials have been prepared by Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP for general informational purposes only. They are not legal advice. They are not intended to create, and their receipt by you does not create, an attorney-client relationship.

argued that the Berne Convention superseded Section 412 of the Copyright Act because statutory damages and attorneys' fees are integral to the enjoyment and exercise of foreign copyrights. The court determined that Elsevier's argument required a finding that the Berne Convention was self-executing and became law upon ratification by Congress.

The court pointed to evidence that, when adopting the Implementation Act, Congress declared that the Berne Convention "was not self-executing under the Constitution and laws of the United States" and that "[t]he obligations of the United States under the Berne Convention may be performed only pursuant to appropriate domestic law". Elsevier, 93 U.S.P.Q.2D at 1409-1410 (citations omitted). Moreover, the court recognized that the Implementation Act's legislative history indicated that Congress specifically considered the impact of the Berne Convention on Section 412 and chose not to amend that provision. Id. at 1410. Because the court found that Berne Convention is not self-executing, the court determined that the Berne Convention cannot serve as a basis for a claim of preemption under Article VI of the U.S. Constitution.

The Elsevier decision supports the increasingly well-settled view that the Berne Convention creates neither an independent cause of action in U.S. courts nor a basis to preempt provisions of the U.S. Copyright Act.

* * *

Thad Chaloehtiarana is a partner with [Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP](#), a [leading intellectual property law firm](#) based in Chicago, Illinois. Pattishall, McAuliffe represents both plaintiffs and defendants in [trademark](#), [copyright](#) and [unfair competition trials and appeals](#), and advises its clients on a broad range of domestic and international intellectual property matters, including brand protection, Internet and eCommerce issues. Thad's practice focuses on litigation, transactions and counseling in domestic and international [trademark](#), [trade dress](#), [Internet](#) and [copyright](#) law.