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DOES THE FIRST AMENDMENT RESTRICT RECOGNITION AND ENFORCEMENT OF FOREIGN COPYRIGHT JUDGMENTS AND ARBITRATION AWARDS?

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I. INTRODUCTION

In their haste to stem the hemorrhaging of economic losses attributable to the problem of international copyright infringement, United States policy-makers have overlooked the problem of recognition and enforcement of foreign copyright judgments and arbitration awards imposed by the United States Constitution. In particular, the first amendment's guarantees of freedom of speech and press, undeniably have a direct impact on copyright law in the United States. Although there are no reported cases where a United States court has refused to recognize and enforce a foreign copyright judgment or arbitration award because of first amendment implications, recent United States court decisions have refused to enforce English libel judgments on the grounds that English libel laws were repugnant to the first amendment. Certainly, many foreign copyright

laws would not pass a similar first amendment analysis. If the same rationale were to be used in an action involving the enforcement of a foreign copyright judgment or arbitration award in the United States it is possible that enforcement would be denied. Yet these constitutional implications seem to have gone unnoticed.

It is not altogether surprising that these constitutional problems have been given little attention. International copyright infringement costs United States businesses billions of dollars each year. With the inclusion of copyright protection for computer programs and the advent of the Internet, the international business implications are immense. It would be difficult to argue that the same economic incentives are involved with libel laws. Yet, these economic and international incentives do not justify this lack of attention given to constitutional problems. Indeed, with so much attention focused on international conventions, treaties and accords dealing with intellectual property issues, it is imperative that we address potential constitutional problems especially in the area of enforcement.

Two of the most important international agreements in the field of international copyright law are the Berne Convention for the Protection of Literary and Artistic Works ("Berne")[1] and the General Agreement on Tariffs and Trade ("GATT")[2]—Trade Related Aspects of Intellectual Property Rights ("TRIPS").[3] These two international agreements were implemented to provide a uniform mechanism for the international protection of copyrighted works, but they do little to assist in the recognition and enforcement of a foreign copyright judgment or arbitration award. Protection may be meaningless without a mechanism of enforcement. Inevitably, it is only a matter of time before this omission is addressed. Thus, the question this article is directed to is what happens if the holder of a foreign copyright

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[1] *See* Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, 828 U.N.T.S. 221 (as last revised at Paris, July 24, 1971) [hereinafter Berne] .

[2] *See* General Agreement on Tariffs and Trade, Oct. 30, 1947, 55 U.N.T.S. 188 [hereinafter GATT].

[3] *See* Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marakesh Agreement Establishing the World Trade Organization, Annex 1C, LEGAL INSTRUMENTS—RESULTS OF THE URUGUAY ROUND vol. 31, § 33 I.L.M. 1197 (1994) [hereinafter TRIPs].

judgment or arbitration award seeks recognition and enforcement in the United States? Will they be denied recourse due to the first amendment?

Although this problem is real, it is not insurmountable.[4] This article addresses the problem by posing a hypothetical copyright problem applying the copyright laws of the United Kingdom. It will be necessary to compare copyright laws of the United States and the United Kingdom and to examine the rights of free speech and press in the United States and the United Kingdom. Next, we shall examine the decisions by courts in the United States in cases refusing to enforce English libel judgments on first amendment grounds. It will be shown that the decisions by these courts are erroneous. This misapplication of the first amendment can be corrected by higher courts in the United States than those that rendered the opinions refusing to recognize and enforce English libel judgments. Given the international and economic implications, it is likely that courts in the United States will, either correct this misapplication, reinterpret the first amendment or simply ignore the problem in order to allow recognition and enforcement of foreign copyright judgments and arbitration awards. Finally, we shall examine Berne and GATT/TRIPS to illustrate why these agreements do not alleviate the problem of recognition and enforcement.

II. THE PROBLEM

Defendant copied information from plaintiff's directory of solicitors and barristers to compile his own directory. The information taken included names, addresses and telephone numbers. As with plaintiff's directory, defendant's directory compiled the information in alphabetical order. There is no question that information was copied, although the information could have been obtained by other sources.

Plaintiff is a Canadian living in the United Kingdom and the defendant is an American living in the United Kingdom.

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[4] *See* ALEXIS DE TOCQUEVILLE, DEMOCRACY IN AMERICA 150 (Henry Reeve trans. & Francis Bowen ed., Harper Row 1966)(1835). The author observed: "I have never been more struck by the good sense and the practical judgement of the Americans than in the manner in which they elude the numberless difficulties resulting from their Federal Constitution." *Id.*

The subject work's place of origin is Canada. The alleged infringement occurs in the United Kingdom and an action is filed in the United Kingdom. Plaintiff obtains judgment. But, alas, defendant has no money in the United Kingdom so plaintiff attempts to enforce her judgment in the United States where defendant has most of his assets.

The copyright law of the United Kingdom would apply in the underlying action. The plaintiff is a foreign (Canadian) author so Berne would require national treatment and the application of lex loci protectionis. The problem for our copyright plaintiff is a problem of recognition and enforcement in the United States of a United Kingdom copyright judgment. The copyright laws of the United Kingdom are fundamentally different from those of the United States in the application of the idea/expression–fact/expression dichotomy and the fair use doctrine and these differences have first amendment implications.

Should a court in the United States in an action to recognize and enforce a foreign copyright judgment or arbitration award apply the first amendment to a situation where all the relevant acts took place outside of the United States?

III. Domestic Framework Regarding Copyright Law, Free Speech and Free Press

Before we can determine if there is a real first amendment problem in recognizing and enforcing United Kingdom copyright judgments and arbitration awards, we need to compare the copyright laws of the United States and the United Kingdom and analyze how they coalesce with free speech and press concerns. While laws in the United States and the United Kingdom share a common heritage, they are historically and politically different in many fundamental respects. Nowhere is this more apparent than in the fact that certain laws in the United States, such as copyright law, are based upon and limited by a written constitution whereas laws in the United Kingdom are free from the limitations set down by a written constitution. This section addresses some of the historical and legal differences between United States and United Kingdom copyright laws and examines free speech and press rights in the United States and United Kingdom.

A. *United States Copyright Law*

Copyright law in the United States is based upon the United States Constitution. Article 1, section 8, clause 8 of the United States Constitution provides, in pertinent part:

> "The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries. . . ."

Without a doubt, the drafters of the United States Constitution were familiar with copyright law in Great Britain.[5] Further, the inclusion of this provision in the United States Constitution does not appear to have caused a great deal of controversy at the time that the Constitution was drafted, debated and ratified. THE FEDERALIST PAPERS, an apologia and analysis of the United States Constitution written in an attempt to garner support for the Constitution,[6] dedicates little attention to the copyright provision of the Constitution. The pertinent part may be found in THE FEDERALIST, No. 43, which addresses the powers granted to Congress and states:

> 1. A power "to promote the progress of science and useful arts by securing, for a limited time, to authors and inventors the exclusive right to their respective writings and discoveries."[7]
>
> The utility of this power will scarcely be questioned. The copyright of authors has been solemnly adjudged in Great Britain to be a right of common law.
>
> The right to useful inventions seems with equal reason to belong to the inventors. The public good fully coincides in both cases with the claims of individuals.
>
> The States cannot separately make effectual provision for either of the cases, and most of them have anticipated the decision of this point by laws passed at the instance of Congress.[8]

There is no further discussion about the copyright provision of the United States Constitution in this great apologia. A ra-

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[5] *See* JOSEPH STORY, COMMENTARIES ON THE CONSTITUTION OF THE UNITED STATES, 48 (1970).

[6] *See* Clinton Rossiter, INTRODUCTION TO THE FEDERALIST PAPERS, vii-ix (1961)(1788).

[7] JAMES MADISON, THE FEDERALIST, Number 43 (1788).

[8] *Id.* at 271-72.

tional conclusion to be drawn from their near silence on this issue is that they did not deem it necessary to defend the copyright clause.

On May 31, 1790, under the authority of the copyright provision in the United States Constitution, Congress enacted the first copyright law in the United States.[9] To keep up with the ever-changing developments of technology, Congress has amended the copyright law on several occasions.[10] Yet, despite these amendments to the United States copyright law, Congress' design to protect authors by creating a property right in their works remains intact.[11] It is believed that by creating this property right and granting to authors limited legal monopolies in their works[12] the primary goal of United States copyright law, namely the promotion of creativity and the dissemination of creative works, will be achieved.[13] These legal monopolies granted to authors are limited not only in duration,[14] but also in scope in that the original expressions of authors are protected but ideas and facts are not.[15]

1. *The Idea/Expression–Fact/Expression Dichotomy*

Under the idea/expression–fact/expression dichotomy, United States copyright protection extends only to an author's

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[9] *See* Melville B. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?*, 17 UCLA L. REV. 1180, 1182, n. 7 (1970).

[10] *See* 17 U.S.C. §§ 101, *et. seq.* For example, the 1976 and 1980 amendments relating to protection of computer programs; the 1988 amendment relating to the United States becoming a member of the Berne Convention; the 1990 amendment relating to the visual arts; and the 1992 amendment relating to registration.

[11] *See* William W. Fisher III, *Reconstructing the Fair Use Doctrine,* 101 HARV. L. REV. 1659, 1662 (1987); W. Warren Hamel, *Harper & Row v. The Nation: A First Amendment Privilege for News Reporting of Copyright Material?* 19 COLUM. J. L. & SOC. PROBS., 253, 255 (1985).

[12] *See* 17 U.S.C. § 106. *See also* J.H. Reichman, *Legal Hybrids Between the Patent and Copyright Paradigms,* 94 COLUM. L. REV. 2431, 2434 (1994).

[13] *See* Leslie A. Kurtz, *Speaking to the Ghost: Idea and Expression in Copyright,* 47 U. MIAMI L. REV. 1221, 1223 (1993); 3 STORY, *supra* note 5, at 49. *See also* Deborah A. Hartnett, *A New Era for Copyright Law: Reconstructing the Fair Use Doctrine*, 39 COPYRIGHT LAW SYMPOSIUM 167 (1992).

[14] *See* 17 U.S.C. §§ 301-305.

[15] *See* 17 U.S.C. § 102(b). *See also* MELVILLE B. NIMMER AND DAVID NIMMER, NIMMER ON COPYRIGHT, vol. 4, §§ 16.01-16.08 (1996).

expression, not to facts or ideas.[16] Consequently, the "market place of ideas" protected by the first amendment is not compromised by copyright law[17] as facts and ideas may be freely disseminated without fear of copyright infringement. One problem with the dichotomy is that courts have difficulties in discerning where an expression ends and an idea or fact begins.[18] A further problem arises when the idea or fact can only be expressed in a limited fashion or when the fact(s) or idea(s) become so entwined with the expression as to become inseparable. In such cases, courts may invoke the merger doctrine and no copyright protection is available.[19]

Courts have had to contort the dichotomy at times in order to protect first amendment concerns. For example, in the case of *Time, Inc. v. Bernard Geis Assoc.*,[20] which involved the question of copyright protection for Mr. Zapruder's home movie that captured President Kennedy's assassination, the court ignored the problem of the idea and expression being so interwoven as to be inseparable.[21] Rather than address this problem and the possible application of the merger doctrine, the court presumed expression and applied the fair use doctrine.[22] While this course of action may have avoided a head on collision between the first amendment and copyright law, it contorts the idea/expression–fact/expression dichotomy.

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[16] *See* 17 U.S.C. § 102(b). *See also* Tiffany D. Trunko, *Remedies for Copyright Infringement: Respecting the First Amendment*, 89 COLUM. L. REV. 1940, 1948 (1989).

[17] *See* Robert C. Denicola, *Copyright and Free Speech: Constitutional Limitations on the Protection of Expression*, 67 CAL. L. REV. 283, 292 (1979). *See, e.g.*, Sid & Marty Kroft v. McDonalds, 562 F.2d 1157 (9th Cir. 1977).

[18] *See* Trunko, *supra* note 16, at 1952. *See, e.g.*, Salinger v. Random House, Inc., 811 F.2d 90 (2d Cir. 1987), *cert. denied*, 484 U.S. 890 (1987)(where the court appears to have difficulty in discerning the difference between an idea and an expression).

[19] *See* Denicola, *supra* note 17, at 292-93. *See, e.g.*, Hebert Rosenthal Jewelry Co. v. Kalpakian, 446 F.2d 738 (9th Cir. 1971); Morrisey v. Procter & Gamble Co., 379 F.2d 675 (1st Cir. 1967).

[20] 293 F. Supp. 130 (S.D.N.Y. 1968).

[21] *See* NIMMER, *supra* note 9, at 1197-99.

[22] *See id.*

2. *The Fair Use Doctrine*

Courts in the United States have relied on English cases in developing the fair use doctrine.[23] It has been defined as:

> "[a] privilege in others than the owner of a copyright to use the copyrighted material in a reasonable manner without his consent, notwithstanding the monopoly granted to the owner by the copyright."[24]

The fair use doctrine is applied only after there has been a determination that there is some expression warranting protection.[25] If the work contains no expression and is only ideas and/or facts, there is no protection and no need to do a fair use analysis.[26] Under the fair use doctrine, a defendant otherwise liable for infringement has a statutory defense excusing liability if four factors weigh in his or her favor:

> 1. The purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
>
> 2. The nature of the copyrighted work;
>
> 3. The amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
>
> 4. The effect of the use upon the potential market for or value of the copyrighted work.[27]

As with the idea/expression–fact/expression dichotomy, courts, at times, contort the fair use doctrine when a copyright injunction presents prior restraint, first amendment concerns.[28] For example, although the first factor in the fair use doctrine requires the court to consider whether or not the nature of the

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[23] *See* Hartnett, *supra* note 13, at 168, n. 3.

[24] HORACE BALL, THE LAW OF COPYRIGHT AND LITERARY PROPERTY 260 (1944).

[25] *See* Fisher, *supra* note 11, at 1686. *See also* Hamel, *supra* note 11, at 259; 17 U.S.C. § 107.

[26] *See* 17 U.S.C. § 107. *See also* NIMMER, *supra* note 9, at 1200-01.

[27] *See* 17 U.S.C. § 107. The legislative history for this statutory provision indicates that these four factors are merely illustrative. *See* H.R. Rep. No. 1476, 94th Cong., 2d Sess. 160, reprinted in 1976 U.S. Code Cong. & Admin. News 5659, 5776.

[28] *See* Trunko, *supra* note 16, at 1951. *See also* Denicola, *supra* note 17, at 294-95; Rosemont Enterprises, Inc. v. Random House, Inc., 366 F.2d 303 (2nd Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967); Keep Thomas Governor Comm. v. Citizens for Gallen Comm., 457 F. Supp. 957 (D.N.H. 1978).

use is commercial,[29] some courts have disregarded or given little weight to this factor arguably to protect first amendment interests.[30] This creates a problem as the United States Supreme Court has held that commercial speech is protected by the first amendment, albeit with less vigor than political speech.[31]

In applying the fourth factor of the fair use doctrine, courts have balanced plaintiff's economic interests against the free flow of information to the public encouraged by the fair use doctrine and the first amendment.[32] The problem with such a balancing test is that it risks reducing first amendment guarantees by subordinating them to economic interests.[33]

3. *There is no Separate and Distinct First Amendment Defense to Copyright Infringement*

Some commentators have argued that the idea/expression–fact/expression dichotomy and fair use doctrine are insufficient to cover all first amendment concerns[34] because they leave open the possibility that certain expressions of tremendous public importance may not be disseminated.[35] By way of example, Nimmer cites the case of *Time, Inc. v. Bernard Geis Assoc.*,[36] as well as the pictures from the My Lai massacre.[37] In each of these examples, the ideas and/or facts were so entwined with the expression that it was impossible to separate one from

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[29] Indeed, the U.S. Supreme Court has held that commercial use is presumptively unfair. *See, e.g.,* Sony Corp v. Universal Studios, Inc., 464 U.S. 417, 449 (1984).

[30] *See* Janice E. Oakes, *Copyright and the First Amendment: Where Lies the Public Interest*, 59 TUL. L. REV. 135, 145 (1984-85). *See also* Consumer Union of United States, Inc. v. General Signal Corp., 724 F.2d 1044 (2d Cir. 1983); *Rosemont,* 366 F.2d at 306.

[31] *See* Bates v. State Bar of Arizona, 433 U.S. 350 (1977).

[32] *See* New York Times Co. v. Roxbury Data Interface, Inc., 434 F. Supp. 217 (D.C.N.J. 1977); Time, Inc. v. Bernard Geis Assoc., 293 F. Supp. 130 (S.D.N.Y. 1968).

[33] *See* Denicola, *supra* note 17, at 303, 309.

[34] *See id.* at 309. For an argument that fair use and the idea-expression dichotomy are sufficient see Oakes, *supra* note 30, at 136-41; Pamela Samuelson, *Reviving Zacchini*: Analyzing First Amendment Defenses in Right of Publicity and Copyright Cases, 57 TUL. L. REV. 836, 879 (1982).

[35] *See* Denicola, *supra* note 17, at 309.

[36] 293 F. Supp. 130 (S.D.N.Y. 1968).

[37] *See* Nimmer, *supra* note 9, at 1197-99.

the other. The doctrine of merger could have been but was not applied.

However, it is not within the scope of this paper to examine whether a separate first amendment defense is needed. Rather, we shall accept the general consensus that there are first amendment implications in United States copyright law and explore the issue of whether this creates a problem in the context of recognition and enforcement of foreign copyright judgments and arbitration awards.

B. *United Kingdom Copyright Law*

Copyright law in the United Kingdom has a rather checkered history. It began as laws enacted to encourage the printing of books.[38] Then it developed into laws enacted to restrict and censure printing and to protect the interests of publishers.[39] Finally, it evolved into laws designed to encourage the dissemination of information and protect authors.[40]

Copyright law in the United Kingdom has been traced back to the fifteenth century with the advent of printing.[41] In England, under King Richard III, a statute was passed encouraging the printing of books and allowing them to be imported.[42] However, this law was repealed fifty years later on protectionist grounds.[43]

In 1556, the original Charter of Stationers' Company was passed.[44] This was supported by publishers, not authors, as a means of trying to protect their financial interest.[45] It was also supported by the Crown whose object was to prevent the propagation of the new Protestant religion by restricting the press.[46] The institution given the authority to regulate the manner of

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[38] *See* Michael L. Crowley, *A First Amendment Exception to Copyright for Exigent Circumstances*, 21 CAL. W. L. REV. 437, 439-42 (1985); Paul Goldstein, *Copyright and the First Amendment,* 70 COLUM. L. REV. 983, 989 (1970); E.P. SKONE JAMES, ET AL., COPINGER AND SKONE JAMES ON COPYRIGHT, 7-11 (1980).

[39] *See id.*

[40] *See* W.R. Cornish, *The International Relations of Intellectual Property*, CAMBRIDGE L. J., 46, 46-50 (1993).

[41] *See* JAMES, *supra* note 38, at 7.

[42] *See* 1 Ric. 3, c. 9 (1483).

[43] *See* 25 Hen. 8, c.15.

[44] *See* JAMES, *supra* note 38, at 7-8.

[45] *See id.*

[46] *See id.*

printing, the number of presses and enforcing the prohibition of printing materials that opposed statutes or the law of the realm was the infamous Star Chamber.[47] The Star Chamber was abolished in 1640.[48]

From 1640 to 1695, in order to print a book one had to obtain a license.[49] This not only prevented the printing of materials believed by the Crown and Parliament to be undesirable it also created a proprietary right for the publisher of the book giving the publisher the sole printing rights.[50]

In 1709, the first copyright act was passed.[51] This act gave authors of books the sole right and liberty of printing their books.[52] Up to this point in time copyright law, arguably, was more of a tool of the Crown to suppress free speech and press rather than encourage it. The 1709 Act was not amended until 1814.[53] The act has been subsequently amended on numerous occasions. The current copyright act is the 1988 Act.[54]

1. *Idea/Expression–Fact/Expression Dichotomy*

Unlike United States copyright law, statutory copyright law in the United Kingdom does not state that ideas are not protected.[55] Although copyright law in the United Kingdom acknowledges that, at some level, there is no copyright protection in ideas, the legal premise behind this proposition, and hence the legal analysis, is fundamentally different from United States copyright law. For example, it has been said:

> There is no copyright in an idea as such, for it is neither a literary, dramatic or musical work. Unfortunately, this simple proposition has frequently been stated in a more extreme form, that there is no copyright in ideas or information but only in the form in which they are expressed. Like all pithy catch phrase, this is liable to lead to confusion. It is sometimes used to mean

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47 *See id.* at 7.

48 *See id.* at 8.

49 *See* JAMES, *supra* note 38, at 10.

50 *See id.*

51 *See* 8 Anne, c.19. *See also* JAMES, *supra* note 38 at 11.

52 *See* JAMES, *supra* note 38, at 11.

53 *See id.* at 12.

54 United Kingdom Copyright Act of 1988.

55 *See* HUGH LADDIE, ET AL., THE MODERN LAW OF COPYRIGHT AND DESIGN 61 (2d ed. 1995).

> that copyright law protects form—language, for instance—but never substantive content. We propose to show that this assertion cannot withstand serious critical analysis.[56]

It is perhaps more accurate to say that in the United Kingdom, copyright law does not protect general ideas, only detailed ideas.[57] The more detailed the expression of facts or ideas, the more likely protection will be afforded.[58]

Because the 1988 Act does not specify that ideas are not protected, arguably courts should not apply an idea/expression dichotomy test.[59] What is to be afforded protection under the 1988 Act is an original work.[60] Accordingly, courts in the United Kingdom should examine whether general facts and ideas were copied and if the infringing work so closely resembles the plaintiff's work in structure and pattern as to lead one to the conclusion that it infringes.[61]

With regard to the protection of facts, copyright law in the United Kingdom is more liberal in allowing protection for the compilation of facts than United States copyright law. Indeed, it has been said that the law in the United Kingdom regarding the protection of facts is different from United States copyright law.[62]

2. *Fair Dealing*

In the United Kingdom, there is an exception to copyright protection under the doctrine of fair dealing,[63] which is similar

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[56] *See id.* at 61.

[57] *See id.* at 64. *See also* Ibcos Computers Ltd v. Barclays Mercantile Highland Finance, Ltd. [1994] F.S.R. 275.

[58] *See id.* at 64-65. References have been made in some cases from the United Kingdom (for example, John Richardson Computers Ltd v. Flanders [1993] F.S.R. 497, Ferris J.) to the American case of Nichols v. Universal Pictures Corp., 45 F.2d 119 (2nd Cir. 1930) for the proposition that, in cases where one is not talking about literal copying, it is difficult to separate the ideas from the expression; but the more general the statement the more likely it is an idea. However, the *Nichols* case does not stand for the proposition that specific ideas are protected under copyright law in the United States. *See id.* What it does stand for is the proposition that non-literal structures in literary works may be afforded copyright protection. *See id.*

[59] *See* LADDIE, *supra* note 55, at 64.

[60] *See* Copyright Act, *supra* note 54, § 1.

[61] *See* LADDIE, *supra* note 55, at 65.

[62] *See id.* at 56-57.

[63] *See* United Kingdom Copyright Act of 1988, at §§ 29, 30.

to the United States doctrine of fair use.[64] Like fair use, fair dealing allows the use of copyrighted works for research[65] or private study. Similarly, fair dealing considers such factors as the purpose and character of the copyrighted work, the amount and substantiality of the portion used[66] and market effects such as whether the work in question is commercially competing.[67] However, the fair dealing exception only applies to literary, dramatic, musical and artistic works and not to film, sound recordings, broadcasts or cable programs.[68] This is fundamentally different from United States copyright law.[69]

C. *Free Speech and Press in the United States*

As with copyright law, the fundamental rights of free speech and press in the United States are based upon the United States Constitution.[70] Free speech and press protection can be found in the first amendment, which provides in pertinent part:

> "Congress shall make no law . . . abridging the freedom of speech, or of the press . . . ."[71]

The first amendment is not merely an assertion of idealized values of the American society to be ignored when it is politically, economically, or otherwise expedient to do so. As with other provisions of the United States Constitution, it sets limits upon the government. Any acts beyond those limits are void.[72]

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[64] *See* LADDIE, *supra* note 55, at 132. *See also* United Kingdom Copyright Act of 1988, at § 2.155.

[65] Some do not take kindly to this aspect of the copyright exception of fair dealing. Wilson Mizner (1876-1933) is reputed to have said: "When you steal from one author, it's plagiarism; if you steal from many, it's research." JOHN BARTLETT, FAMILIAR QUOTATIONS 757 (15th ed. 1980).

[66] *See* LADDIE, *supra* note 55, at 134.

[67] *See* Associated Newspapers Group v. New Group Newspapers, Ltd. [1986] R.P.C. 515.

[68] *See* LADDIE, *supra* note 55, at 132. *See also* United Kingdom Copyright Act of 1988, at §§ 29, 30; GILLIAN DAVIES, IIC STUDIES, STUDIES IN INDUSTRIAL PROPERTY AND COPYRIGHT LAW 39 (Max Plank Institute for Foreign and International Patent, Copyright and Competition Law, Munich) (1994).

[69] *See* 17 U.S.C.A. § 107.

[70] *See* U.S. CONST. amend. I.

[71] *Id.*

[72] *See* ZECHARIAH CHAFFEE, JR., FREE SPEECH IN THE UNITED STATES, 6-7 (1967). *See also* Nimmer, *supra* note 9, at 1182 and Reid v. Covert, 354 U.S. 1, 5-6 (1957).

To insure that the government does not act beyond its constitutionally limited powers, the United States judiciary is invested with the power and the duty to strike down, as void, acts of the government that are unconstitutional.[73]

The first amendment not only protects ones right to speak, it also protects the right to hear.[74] The dissemination of truths, ideas, facts and information encouraged by first amendment principles has been allegorized as creating a "marketplace of ideas." Thus, it has been said that it is the corollary to the right to disseminate truths, ideas, facts and information that there is an audience to receive those words.[75] The notion of the "marketplace of ideas," which has been inextricably tied to the first amendment, presumes that there is not only a seller in the "marketplace of ideas," but also a buyer.[76]

Finally, the first amendment also protects one's right to refrain from speaking, i.e. privacy rights.[77] This right to remain silent is not as apparent in the historical background to the first amendment, but it is a logical extrapolation as it seems rather incredible that the first amendment would allow the government to force people to speak.

The language of the first amendment is phrased in absolute terms. However, it has been held that the first amendment cannot be read as an absolute prohibition against any governmental acts that inhibit speech or the press.[78] Most commentators agree with this interpretation on the basis that to hold otherwise would be to venture into the absurd.[79] As one commentator eloquently stated:

> "That this amendment was intended to secure every citizen an absolute right to speak, or write, or print, whatever he might

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[73] *See* ALEXANDER HAMILTON, THE FEDERALIST, No. 78 (1788).

[74] *See* Crowley, *supra* note 38, at 439-42; Hartnett, *supra* note 13, at 199; Board of Educ. v. Pico, 457 U.S. 853, 867 (1982); Goldstein, *supra* note 38, at 989.

[75] *See* ALEXANDER MEIKEJOHN, POLITICAL FREEDOM, 26-28 (1965).

[76] *See* Board of Educ., 457 U.S. at 867 (Brennan, J.).

[77] *See* Trunko, *supra* note 16, at 1957-58. For an example of an attempt to use copyright to protect privacy interests see Estate of Hemmingway v. Random House, Inc., 244 N.E.2d 250 (1968).

[78] *See* Schenck v. United States, 249 U.S. 47 (1919); Konigsberg v. State Bar, 366 U.S. 36 (1961).

[79] *See* STORY, *supra* note 5, at 731-38; CHAFEE, *supra* note 72, at 8; Nimmer, *supra* note 9, at 1183

please, without any responsibility, public or private, therefor, is a supposition too wild to be indulged by any rational man."[80]

Even those who were contemporaries of the authors of the United States Constitution did not view free speech and press in absolute terms. For example, the Alien and Sedition Acts of 1798[81] unquestionably limited speech, perhaps unconstitutionally, yet were implemented by a Congress composed of contemporaries of the original authors of the Constitution.[82]

Inevitably, if we are to accept the proposition that the first amendment is not absolute, we must ask the question: What governmental limitations on the freedom of speech and press are constitutional? As with many legal questions there is no bright line test to apply. The facts of each case must be examined individually by the courts and the governmental interests of order, safety and protection are weighed against the interests of free speech and press,[83] "but freedom of speech [and press] ought to weigh very heavily in the scale. The First Amendment gives binding force to this principle of political wisdom."[84]

1. *The Requirement of State Action*

The first amendment limits *Congress* from making laws that infringe upon freedom of speech and press.[85] The first amendment was made applicable to the various American states by the incorporation provision of the fourteenth amendment of the United States Constitution.[86] Thus, the protection of speech and press under the first amendment is predicated upon state action. If there is no state action, there is no first

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[80] *See* STORY, *supra* note 5, at 731-32.

[81] The Alien and Sedition Acts of 1798 made it a crime to publish any writing that "defamed or traduced" the Congress, President, or member of the federal judiciary. *See* Hugh Stevens, Essay, *Responsibility in the Media*, 9 U. OF FLA. J. OF L. & PUB. POL. 177, 182 (1998).

[82] The constitutionality of the Alien and Sedition Acts was never challenged in the United States Supreme Court. The Acts, by their own terms, expired in 1801.

[83] *See* Gerald Gunther, *In Search of Judicial Quality on a Changing Court: The Case of Justice Powel*, 24 STAN. L. REV. 1001 (1972).

[84] *See* CHAFFEE, *supra* note 72, at 31.

[85] "*Congress* shall make no law . . . abridging the freedom of speech, or of the press . . . ." U.S. CONST., amend. I (emphasis added).

[86] *See* Gitlow v. New York, 268 U.S. 652 (1925).

amendment protection.[87] So what is meant by state action? It is when the government, state or federal attempts to take away or restrict a constitutional right, such as first amendment rights, through legislation.[88] Furthermore, "[c]onduct that is formally 'private' may become so entwined with governmental policies or so impregnated with a governmental character as to become subject to the constitutional limitations placed upon state action."[89] Thus, if the government delegates some of its duties to private parties, the actions of those parties may constitute state action.

There is no authority for the proposition that acts by foreign governments constitute state action for purposes of the first amendment. But the fact that actions by foreign governments may not constitute state action under a first amendment analysis does not end the inquiry. What about the situation where one tries to enforce a foreign judgment or arbitration award in the United States? Would judicial enforcement of a foreign judgment or arbitration award by a court in the United States constitute state action, bring the first amendment into force? Judicial enforcement of private matters may rise to the level of state action as in the case of *Shelly v. Kramer,*[90] where it was held that the lower court's enforcement of a racially restrictive covenant contained in the title of real property was state action for constitutional purposes. However, deeming judicial enforcement "state action" has not been expanded beyond the scope of the facts and circumstances set forth in *Shelly v. Kramer*. Indeed, in the case of *United Egg Producers v. Standard Brands, Inc.*[91] the enforcement of a stipulated settlement whereby one party agreed to refrain from making certain statements was not sufficient state action to bring the first amendment into play. The court held:

> "[W]here a court acts to enforce the right of a private party which is permitted but not compelled by law, there is no state ac-

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[87] *See* Cohen v. Cowles Media Co., 501 U.S. 663 (1991); Hudgens v. N.L.R.B., 424 U.S. 507 (1976); Columbia Broadcasting System v. Democratic National Committee, 412 U.S. 94 (1973).

[88] *See Hudgens,* 424 U.S. at 513.

[89] Evans v. Newton, 382 U.S. 296, 299 (1966).

[90] 334 U.S. 1 (1948).

[91] 44 F.3d 940 (11th Cir. 1995).

> tion for constitutional purposes in the absence of a finding that constitutionally impermissible discrimination is involved."[92]

Thus, the recognition and enforcement of a foreign copyright judgment or arbitration award may not amount to state action if the underlying action involves the right of a private party which is permitted but not compelled by law and the issue of discrimination is not involved.

2. *The First Amendment and Copyright Law*

As stated above, United States copyright law creates a property right.[93] Although the fundamental goal of United States copyright law, to promote the dissemination of creative works, is rooted in the first amendment,[94] it has been recognized that there is some tension between copyright law and the first amendment.[95] To the extent that copyright law encourages the dissemination of creative works, it is in harmony with first amendment objectives.[96] However, there are certain limited situations where copyright law and the first amendment come into conflict. These situations may arise when the owner of a copyrighted work attempts to prevent dissemination through an infringement action. A successful infringement action not only prevents the defendant in such action from speaking, but it also may infringe upon the equally important first amendment guarantee of the community's right to hear.[97]

When this tension arises, a balance needs to be struck between the property rights created by copyright law and the constitutional interests of free speech and press.[98] To the extent

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[92] United Egg Producers, 44 F.3d at 943.

[93] *See* Fisher, *supra* note 11, at 1662.

[94] *See Clarifying the Copyright Misuse Defense: The Role of Antitrust Standards and First Amendment Values*, 104 HARV. L. REV. 1289 (1990-91); Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 558 (1985); Twentieth Century Music Corp. v. Aikin, 422 U.S. 151, 156 (1975).

[95] *See* Denicola, *supra* note 17, at 285; Crowley, *supra* note 38, at 437-38; Stephen S. Zimmermann, *A Regulatory Theory of Copyright: Avoiding a First Amendment Conflict*, 35 EMORY L. J. 163 (1986); Hamel, *supra* note 11, at 253-55; Nimmer, *supra* note 9, at 1180-82; Hartnett, *supra* note 13, at 167.

[96] *See* Denicola, *supra* note 17, at 285-86; Kleindienst v. Mandel, 408 U.S. 753 (1972); Stanley v. Georgia, 394 U.S. 557 (1969); Martin v. City of Struthers, 319 U.S. 141 (1943).

[97] *See* Crowley, *supra* note 38, at 439-42.

[98] *See* Denicola, *supra* note 17, at 287 and Goldstein, *supra* note 38, at 991.

that the property rights of copyright law and the constitutional interests of free speech and press may not be reconciled, the property rights of copyright law must yield to the constitutional interests of free speech and press.[99] This is so because the United States Congress may act only within the limits of the enumerated powers specified within the United States Constitution.[100] While the Constitution does grant Congress the power to make laws regarding copyright,[101] this power is tempered by the first amendment.[102] So to the extent that the copyright law imposed by Congress violates first amendment interests, the first amendment, which imposes limits upon Congress, will nullify those actions.

Although courts in the United States have recognized that there are first amendment concerns regarding copyright, to date, they have asserted that these concerns are adequately addressed by exceptions to copyright protection, such as the idea/expression–fact/expression dichotomy and the fair use doctrine.[103]

D. *Free Speech and Press in The United Kingdom*

In the United Kingdom, the constitutional rights of freedom of speech and press are not premised upon a "written" constitution. The British Constitution is an "unwritten" constitution with its provisions being derived from many sources.[104] Unlike

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[99] *See* Denicola, *supra* note 17, at 288, 303; Hartnett, *supra* note 13, at 174; Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562 (1977); Paulson v. Personality Posters, Inc., 59 Misc.2d 444 (1969); Factors Etc., Inc. v. Pro Arts, Inc., 579 F.2d 215 (2nd Cir. 1978). In this regard, it is important to note that the fair use exception to copyright is imposed *by* Congress while first amendment guarantees are imposed *on* Congress. *See* Samuelson, *supra* note 34, at 912.

[100] *See Reid*, 354 US 1 (1957); Nimmer, *supra* note 9, at 1182; JAMES MADISON, THE FEDERALIST No. 41 (1788).

[101] U.S. CONST., art. I, sec. 8, cl. 8.

[102] U.S. CONST., amend. I.

[103] *See Zacchini*, 433 U.S. 562, 577 n. 13; United States v. Bodin, 375 F. Supp. 1265, 1267 (W.D. Okla. 1974); New Era Publications Int'l v. Henry Holt & Co., 873 F.2d 576, 584 (2d Cir. 1989); Triangle Publications, Inc. v. Knight-Ridder Newspapers, Inc., 626 F.2d 1171, 1174 (5th Cir. 1980); Wainwright Sec. v. Wall St. Transcript Corp., 558 F.2d 91, 95 (2d Cir. 1977); Consumers Union of the United States, Inc. v. General Signal Corp., 724 F.2d 1044, 1049 (2nd Cir. 1983). Additional protection is provided by the refusal to provide copyright protection for facts. *See* Oaks, *supra* note 30, at 138.

[104] *See* O. HOOD PHILLIPS, CONSTITUTIONAL AND ADMINISTRATIVE LAW 22-26 (1978).

the United States Constitution, the various provisions of the British Constitution can be altered legislatively by the Queen in Parliament as the legislature is supreme over the constitution.[105] Furthermore, courts in the United Kingdom have no power to review Parliamentary legislation and declare it unconstitutional.[106]

With regard to free press, it has been said:

> "The liberty of the press is essential to the nature of a free state; but this consists in laying no previous restraint upon publications, and not in freedom from censure for the criminal matter when published."[107]

Thus, one is free to print whatever he or she desires, but must suffer the consequences if the subject matter violates the law as set down by Parliament.

1. *Free Speech and Press and Copyright Law in The United Kingdom*

There is a dearth of authority from the United Kingdom regarding the application of free speech and press rights to copyright cases. While there does not appear to be any commentary on the application of the idea/expression–fact/expression dichotomy and little on the doctrine of fair dealing to protect free speech and press rights,[108] copyright law in the United Kingdom allows the denial of copyright protection on the grounds of public policy.[109] Unfortunately, this can be double-edged sword, while one may argue that public policy requires the denial of copyright protection in order to allow, the dissemination of information, it may also be argued that public policy requires the denial of copyright protection in order to suppress information. This is what the court did in the Spycatcher cases on the

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[105] *See id.* at 26.

[106] *See id.*

[107] BLACKSTONE'S COMMENTARIES ON THE LAW, 814 (1941). *See also* JOSEPH R. FISHER AND JAMES A. STRAHAN, THE LAW OF THE PRESS (1990).

[108] By analogy to defamation cases, some United Kingdom cases do apply the fair dealing doctrine in refusing to grant interlocutory injunctions in copyright cases. *See* MODERN LAW OF COPYRIGHT, *supra*, note 55, at 135 (citing Fraser v. Evans, [1969] 1 Q.B. 349); Hubbard v. Vosper, [1972] 2 Q.B. 84.

[109] *See* Copyright Act, *supra* note 54, at § 171(3). *See also* LADDIE, *supra* note 55, at 130; DAVIES, *supra* note 68, at 40-41; Hubbard v. Vosper, [1972] 2 W.L.R. 394.

grounds that the author owed a duty of confidence to the Crown.[110]

IV. Case Comparison Between United States and United Kingdom Copyright Law

Perhaps the best way to illustrate the differences between United States copyright law and United Kingdom copyright law is to examine their applications under case law. For this exercise, we shall use the example of the computer copyright cases of *Computer Assoc. v. Altai*[111] compared with *Ibcos Computers Ltd v. Barclays Mercantile Highland Finance Ltd.*[112] to exemplify the differences in the application of the idea/expression dichotomy and the compilation copyright cases of *Feist Publications, Inc. v. Rural Tel. Serv.*[113] compared with *Waterlow Directories Limited v. Reed Information Services Limited*[114] to exemplify the differences in the application of the fact/expression dichotomy.

A. Computer Assoc. v. Altai

The *Computer Assoc.* case illustrates the trend for courts in the United States to broadly interpret non-protected ideas. In that case, defendant hired a former employee of plaintiff to create a program that directly competed with plaintiff's program.[115] Defendant realized that its program infringed on plaintiff's program after it was created.[116] Therefore, defendant created a second program through the use of a "clean room." Specifically, defendant assigned its programmers to a room in which they would work without having access to plaintiff's program codes.[117] Plaintiff asserted that this second program still

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[110] See comments of Lord Jauncey in Attorney General v. Guardian Newspapers; Attorney General v. Observer (No. 2), [1990] A.C. 109, 293. *See also* Denis de Freitas, *Letter From the United Kingdom*, 26 Copyright 31, 48 (1990).

[111] 982 F.2d 693 (2nd cir. 1992).

[112] [1994] F.S.R. 275.

[113] 499 U.S. 340 (1991).

[114] [1992] F.S.R. 409.

[115] *Computer Assoc.*, 982 F.2d at 699.

[116] *See id.* at 700.

[117] *See id.*

infringed by copying the non-literal aspects, that is the structure, sequence and operation of its program.[118]

To determine if defendant impermissibly copied expression as opposed to ideas, the court applied an abstraction test whereby the computer program was broken down to its various constituent layers such as code, sub-modular, modular, subcomponent and component designs.[119] At the various levels, the court filtered out the "ideas" and other non-protected parts. What was left after the court filtered out the non-protected parts was the "core of protectable material."[120]

In describing this abstraction test, the court referred to *Nichols v. Universal Pictures Corp.*[121] where Judge Learned Hand decried the difficulties in discerning what was an idea and what was expression.[122] The abstraction test is one method utilized by courts in the United States to deal with this difficult task. After applying the abstraction test, the court in *Computer Assoc.* found very little protectable expression.[123]

B. Ibcos Computer Ltd v. Barclays

Ibcos also involved a competing program created by a former employee of plaintiff's.[124] However, in this case the former employee was the creator of both programs and no clean room was involved. As such, more literal elements of copying, such as spelling mistakes in the code, were evident. This case is interesting in that it compares copyright law of the United Kingdom with copyright law of the United States.[125]

First, the court set forth the pertinent language of the 1988 Act to emphasize the point that any test to be applied in an infringement action in the United Kingdom must look to the

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[118] *See id.*

[119] *See Computer Assoc.*, 982 F.2d at 706. *See also* Gary M. Rinck, *The Maturing U.S. Law on Copyright Protection for Computer Programs: Computer Associates v. Altai and Other Recent Case Developments*, 14 EUROPEAN INTELLECTUAL PROP. REV. 351, 353 (1992).

[120] *See Computer Assoc.*, 982 F.2d at 707.

[121] 45 F.2d 119 (2d Cir. 1930).

[122] *See Computer Assoc.* 982 F.2d at 704.

[123] *See id.* at 721.

[124] *See Ibcos*, [1994] F.S.R. at 282-283.

[125] See Laurence Jacobs, *Demystifying Copyright Infringement of Computer Software*, 16 EUROPEAN INTELLECTUAL PROP. REV. 206 (1994) for a detailed comparison of *Ibcos* and *Computer Assoc.*

statute and avoid such statements like "there is no copyright in an idea." This is so given that the 1988 Act does not prohibit copyright protection of ideas.[126] The statutory test, according to the court, involves asking the following questions:

> 1. What is the work or works in which the plaintiff claims copyright?
> 2. Is such work "original?"
> 3. Was there copying from that work?
> 4. If there was copying, has a substantial part of that work been reproduced?[127]

It was under the second prong of this test, in trying to determine originality, that the court discussed the idea/expression dichotomy. There, the court stated:

> The true position is that where an 'idea' is sufficiently general, then even if an original work embodies it, the mere taking of that idea will not infringe. But if the 'idea' is detailed, then there may be infringement. It is a question of degree.[128]

With respect to the application of United States copyright cases, the court noted:

> The fact is that United States copyright law is not the same as ours, particularly in the area of copyright works concerned with functionality and compilations. The Americans (many would say sensibly) never developed copyright so that functional things like exhaust pipes could not be copied. This is partly due to their statute, which is different from our Act.[129]

Although the court did emphasize the differences between United Kingdom copyright law and United States copyright law, it is doubtful that a court in the United States faced with similar facts would have ruled differently.

C. Feist Publications v. Rural Telephone Service[130]

In *Feist*, plaintiff sued defendant for copyright infringement stemming from defendant's incorporating information

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[126] *See Ibcos*, [1992] F.S.R. at 289.
[127] *See id.* at 290.
[128] *Id* at 291.
[129] *Id.* at 292.
[130] 499 U.S. 340 (1991)

from plaintiff's telephone directory into its own telephone directory.[131] There was no dispute that defendant did copy some of the information contained in plaintiff's telephone directory.[132] Nor was there any dispute that defendant's telephone directory directly competed for advertisement fees with plaintiff's telephone directory.[133] The United States Supreme Court identified the issue in *Feist* as the interaction between the well-established principle that facts are not copyrightable but that compilations of facts may be copyrightable.[134] The Court ultimately held that there was no protection.[135]

The Court focused its attention on the originality requirement of United States copyright law[136] stating that this is a constitutional requirement.[137] The term "originality" is not to be found in article I, section 8, clause 8 of the United States Constitution. This pronouncement by the Court is derived from case law defining the term "author" as an originator.[138] Because facts are not "original," one cannot claim protection of facts. However, factual compilations may possess a "modicum" of originality allowing some protection. This originality may be in the selection, coordination or arrangement in which the facts are organized for presentation to the reader.[139] Not every selection, coordination or arrangement will necessarily be original. For example, there may be only a limited number of ways that facts may be organized to be of any use. Because of this necessity in arrangement, there may not be the minimal level of creativity required for originality.

The Court noted that copyright protection for factual compilations was necessarily thin.[140] This was due to constitutional constraints as the pertinent parts of United States Constitution have as their main goal the dissemination of information, not the protection of the labor of authors. Thus, the

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131 *See Feist*, 499 U.S. at 343.
132 *See id.* at 344.
133 *See id.*
134 *See id.*
135 *See id.* at 362.
136 *See* 17 U.S.C. §§ 101, 103.
137 *See Feist*, 499 U.S. at 351.
138 *See id.*
139 *See* 17 U.S.C. § 101.
140 *See Feist*, 499 U.S. at 358.

Court specifically rejected the "sweat of the brow" theory,[141] which some lower courts in the United States had applied.[142]

There was no dispute that the material copied was factual. The main question was whether the facts were compiled in such a fashion as to meet the originality requirement. The Court unanimously agreed that the originality requirement was not met.[143] The end product produced by plaintiff was a "garden-variety" telephone directory with the names listed in alphabetical order.[144]

D. Waterlow Directories v. Reed Information[145]

In *Waterlow*, the court was considering a restraining order sought by plaintiff and, thus, had to decide if plaintiff was likely to prevail at trial.[146] *Waterlow* involved facts similar to *Feist* in that the defendant copied information from plaintiff's directory to compile its own directory. The directory was one of solicitors and barristers as opposed to a general telephone book.[147] Still, the information taken—names, addresses and telephone numbers—was similar.

The court focused upon whether a substantial portion was taken (a fact conceded in *Feist*), and whether the fact that defendant could have obtained the information from other sources obviated the alleged infringement.[148] The court held that a substantial portion was taken and the fact that defendant could have obtained the information from other sources did not change the fact that defendant had copied plaintiff's directory.[149] Finding that plaintiff was likely to prevail in its infringement action, the restraining order was granted.[150]

The court did not discuss whether facts were part of the information copied nor did it state that facts were not copyright-

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[141] "Sweat of the Brow" theory is the underlying notion that copyright was a reward for the hard work that went into compiling facts. *Id.* at 352.

[142] *See id.* 359.

[143] *See id.* at 361.

[144] *See id.* at 367.

[145] *See* [1992] F.S.R. 409.

[146] *See Waterlow*, [1992] F.S.R. at 411.

[147] *See id.*

[148] *See id.* at 411-12.

[149] *See id.* at 413.

[150] *See id.* at 417.

able. Further, the court did not require any creativity or originality in a compilation. The court did state that a "sweat of the brow" theory was the law in the United Kingdom and cited the case of *Morris v. Ashbee,*[151] to wit:

> [N]o one has a right to take the results of the labour and expense incurred by another for the purpose of a rival publication, and thereby save himself the expense and labour of working out and arriving at these results by some independent road.[152]

E. *Summary*

It is apparent that there are some fundamental differences between United States and United Kingdom copyright law. This point is made clear by the court in *Ibcos* and can be deduced from the comparison of *Computer Assoc.* with *Ibcos*, which establishes that:

> 1. United States copyright law does not distinguish between "general ideas" and "specific ideas" whereas United Kingdom copyright law does; and
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> 2. The United States idea/expression dichotomy is based upon constitutional constraints and statutory language but it is not afforded such authority in the United Kingdom and, thus, may be given less weight by courts in the United Kingdom.[153]

The comparison between *Feist* and *Waterlow* is even more interesting as it shows inconsistent results due to the fundamental differences in the laws. For example:

> 1. *Feist* points out the fact/expression dichotomy, which is not apparent in *Waterlow*;
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> 2. *Feist* expressly rejects the "sweat of the brow" theory, which was expressly accepted by the court in *Waterlow*; and
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> 3. The Court in *Feist* severely limited the protection to compilations by focusing on the constitutional and statutory requirement of originality, while the court in *Waterlow* focused on whether a substantial portion was taken. The court did not pro-

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[151] [1868] L.R. 7 Eq. 34.

[152] *Morris,* [1868] L.R. 7 Eq. 34, Sir George Giffard V.C., at 40.

[153] For a more detailed discussion on the differences between the United States and the United Kingdom in the application of the idea/expression dichotomy, see Steven Ang, *The Idea-Expression Dichotomy and Merger Doctrine in the Copyright Laws of the U.S. and the U.K.*, 2 INT'L J. L. AND INFORMATION & TECHNOLOGY 111.

vide an analysis of the "original" language set forth in section 1 of the 1988 Act, nor did it discuss the definition of "author" as a creator in section 9 of the 1988 Act.

Because both *Computer Assoc.* and *Ibcos* reached a similar result, albeit by a different road, the differences in the law are not as glaring. However, as the court in *Ibcos* points out, there are differences and they are of a fundamental nature.[154] These differences are more evident in comparing compilation cases, such as *Feist* and *Waterlow*, as these cases reached entirely different conclusions.[155]

V. THE LIBEL LAW ANALOGY

Thus far, we have examined copyright law and freedom of speech and press in the United States and the United Kingdom illustrating that there are fundamental differences in these laws. In the United States, the Constitution limits Congress' power to provide copyright protection when protection would mean an unacceptable compromise of first amendment free speech and press rights. In the United Kingdom, Parliament is supreme and there are fewer limits on copyright protection. But, as a practical matter, do these differences have any foreseeable consequences? To date, there are no cases or commentary raising any practical concerns stemming from these differences. However, in other areas of law, such as libel law, differences between United States law and United Kingdom law has had alarming consequences.[156] This is significant because United States libel law, like United States copyright law, has first amendment implications.

A. *The First Amendment in Libel and Copyright Cases*

The analogy between libel defendants asserting claims of constitutional privileges based upon the first amendment and defendants in copyright infringement suits asserting claims of constitutional privileges based upon the first amendment has

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154 *See Ibcos*, [1992] F.S.R. at 292.

155 Clive D. Thorne, *Infringement of Database Compilations: A Case for Reform*, 13 EUROPEAN INTELLECTUAL PROP. REV. 331 (1991).

156 *See, e.g.*, Matusevitch v. Telnikoff, 877 F. Supp. 1 (D.D.C. 1995); Bachchan v. Abroad Publications, Inc. 585 N.Y.S.2d 661 (1992); Abdullah v. Sheridan Press, Inc., 154 F.R.D. 591 (S.D.N.Y. 1994).

not gone unnoticed by legal commentators.[157] Public policy interests have been considered by courts in both libel[158] and copyright cases.[159] While a separate and distinct first amendment defense in copyright cases has not been successfully upheld by courts in the United States, it is clear that first amendment concerns permeate the reasoning behind the idea/expression–fact/expression dichotomy and the fair use doctrine.

As we have already observed, free speech and press are not absolute in democratic societies.[160] A classic example of restricting unfettered free speech and press is evident in the various libel laws which restrict free speech and press to some extent in favor of other social policies, such as ones right to his or her reputation and privacy interests.[161] In the United States, libel laws are enforceable provided they meet the constitutional requirements set down by the United States Supreme Court decision of *New York Times Co. v. Sullivan*[162] and its progeny. In the United Kingdom, libel laws are routinely invoked to restrict speech that damages one's reputation.[163]

Although there are some similarities between United States libel laws and United Kingdom libel laws, courts in the United States have held that the differences between these laws raise first amendment concerns when one tries to enforce an English libel judgment in the United States.[164] An examination of this case law illustrates these differences, including: the failure of the courts in the United States to apply a proper state action analysis and the possibility of applying the reasoning of these cases to foreign copyright judgments and arbitration

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[157] *See* Trunko, *supra* note 16, at 1940; Denicola, *supra* note 17, at 283; Goldstein, *supra* note 38, at 983; Oakes, *supra* note 30, at 135; Hartnett, *supra* note 13, at 183, n. 75.

[158] *See* Chapadeau v. Utica Observer-Dispatch, Inc., 341 N.E.2d 569 (1975).

[159] *See* Rosemont Enterprises, Inc. v. Random House, Inc., 366 F.2d 303 (2d Cir. 1966); Trunko, *supra* note 16, at 1964.

[160] *See* Schenck v. United States, 249 U.S. 47 (1919).

[161] *See* CAL. CIV. CODE § 45.

[162] 376 U.S. 254 (1964).

[163] *See* KENNETH MCK NORRIE, DEFAMATION AND RELATED ACTIONS IN SCOTS LAW 1 (1995); P.F. CARTER-RUCK AND R. WALKER, CARTER-RUCK ON LIBEL AND SLANDER, 30-53 (3rd ed. 1985).

[164] *See, e.g.,* Matusevitch v. Telnikoff, 877 F. Supp. 1 (D.D.C. 1995); Bachchan v. Abroad Publications, Inc., 585 N.Y.S.2d 661 (1992); Abdullah v. Sheridan Press, Inc., 154 F.R.D. 591 (S.D.N.Y. 1994).

awards in subsequent recognition and enforcement actions in the United States.

B. *The English Libel Judgment Cases*

In *Matusevitch v. Telnikoff*,[165] Telnikoff, a Russian emigre employed by the B.B.C. Russian service, wrote an article that was published in a British newspaper.[166] Matusevitch, also a Russian emigre, was employed by Radio Liberty in London, a United States owned radio station. Matusevitch wrote a letter in response to Telnikoff's article, which was published in a British newspaper.[167] Telnikoff sued Matusevitch in England alleging that Matusevitch's letter was defamatory and prevailed.[168] Thereafter, Telnikoff sought to have his English libel judgment recognized and enforced in the United States.

The court in the United States ruled that Telnikoff's judgment could not be recognized and enforced in the United States on the grounds that English law on libel differs from United States law and is repugnant to first and fourteenth amendment rights.[169] The court held that public policy considerations, i.e. preservation of first and fourteenth amendment rights, were sufficient to decline recognition.[170] Because the defamation laws of England do not afford a defamation defendant the same free speech and press protection afforded under United States law, the Court ruled that the first amendment prevented the judgment from being recognized and enforced in the United States.[171]

The main problem with the court's analysis in *Matusevitch* is that there is no discussion regarding state action nor any contact with the United States which might justify the application of the first amendment.[172] There is no indication that any of

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165 877 F. Supp. 1 (D.D.C. 1995).

166 These preliminary facts are not discussed in the American case. They are set forth in the British case of *Telnikoff v. Matusevitch*, [1992] 2 A.C. 343.

167 *See Telnikoff*, [1992] 2 A.C. at 343.

168 *See id.*

169 *See Matusevitch*, 877 F. Supp. at 4.

170 *See id.*

171 *See id.* at 6.

172 The court referred to the case of Abdullah v. Sheridan Press, Inc., 154 F.R.D. 591 (S.D.N.Y. 1994) as illustrative of a court's decision to deny recognition of a foreign libel judgement on public policy grounds based upon the first amend-

the parties were United States citizens, that the defamatory statement was made in the United States or published in the United States. One wonders why the court applied the first amendment in such an extraterritorial fashion.[173]

In *Bachchan v. India Abroad Publications Inc.*,[174] plaintiff, an Indian national, sued defendant, a New York based operator of a news service, in England for libel stemming from a story written by a reporter in London and published in the United Kingdom.[175] The English court entered judgment in favor of the plaintiff.[176] Plaintiff sought to have the judgment recognized in the United States. The court in New York ruled that the judgment could not be recognized because the alleged defamatory statements were matters of public concern and, hence, the first amendment was applicable.[177] The court found that English libel law, unlike United States libel law, placed the burden of proof on the defendant and did not require a finding of fault.[178] Thus, it was repugnant to the first amendment.[179]

Once again, the court did not discuss state action or any contacts with the United States, which would justify the application of the first amendment. In *Bachchan*, the defendant was a New York based news service, so the court may have believed that this contact was sufficient to apply the first amendment. However, the lex loci delicti was in England as it was only the publication in England that was at issue. It is difficult to see how recognition of the English judgment would affect free speech in the United States, which should be the focus of the court's concern.[180]

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ment. Unfortunately, the *Abdullah* case does nothing to assist our analysis as it does not discuss state action, U.S. contacts nor lex loci delicti issues.

[173] For an analysis on the extent of any extraterritorial application of the United States Constitution, see United States v. Verdugo-Urquidez, 494 U.S. 259 (1990).

[174] 585 N.Y.S.2d 661 (1992).

[175] *See Bachchan,* 585 N.Y.S.2d at 661. The article also was published in New York but plaintiff's action was limited to the damages arising from the publication in England. *See* Derek Devgun, *United States Enforcement of English Defamation Judgements: Exporting the First Amendment?*, 23 ANGLO-AM. L. REV. 195, 202 (1994).

[176] *See Bachchan,* 585 N.Y.S.2d at 661.

[177] *See id.* at 664.

[178] *See id.* at 663.

[179] *See id.* at 665.

[180] Devgun, *supra* note 175, at 203.

C. *Applying the Libel Law Analogy to Copyright Cases*

The libel law analogy gives rise to a very interesting problem in resolving international copyright disputes. Given these decisions by courts in the United States, refusing to recognize and enforce English defamation judgments, could the same reasoning be used by courts in the United States to refuse to recognize and enforce a foreign copyright judgment or arbitration award?[181]

If we are to accept as United States law what the courts have stated in *Matusevitch* and *Bachchan*, then one could argue that the law requires that courts in the United States considering recognition and enforcement of foreign copyright judgments and arbitration awards examine free speech and press protection afforded under the substantive law applied as they have in libel cases.

Obtaining an arbitration award, as opposed to a judgment, does not solve this problem. While copyright issues are arbitrable in the United States[182] and in the United Kingdom,[183] a court in the United States ruling on the recognition and enforcement of an arbitration award from the United Kingdom, applying United Kingdom copyright law, would refer to the New York Convention on the Recognition and Enforcement of Foreign Arbitral Awards (the "New York Convention")[184] as both the United States and the United Kingdom are signatories. While the New York Convention does provide an effective international framework for recognizing and enforcing international arbitration awards, arbitration does not provide the panacea for recognition and enforcement problems. Article V (2)(b) of the New York Convention allows a court to refuse to recognize and enforce the arbitration award if it would be contrary to the pub-

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[181] The possibility of extending the rule of no enforcement in these defamation cases to other causes of action was suggested by Devgun, *supra* note 175, at 211-13.

[182] *See* Saturday Evening Post Co. v. Rumbleseat Press, Inc., 816 F.2d 1191 (7th Cir. 1987); Laurie Seigel Kaplan, *Arbitration and Intellectual Property: A Survey in Patent, Trademark and Copyright Cases*, 18 INTELLECTUAL PROP. L. REV. 439 (1986).

[183] *See* ETRI Fans Limited v. NMB UK Limited, [1987] F.S.R. 389; London & Leeds Estates Ltd. v. Paribas Ltd. No.2, [1995] 02 E.G. 134, [1995] 1 E.G.L.R. 102.

[184] United Nations Convention on the Recognition and Enforcement of Foreign Arbitral Awards, June 10, 1958, 21 U.S.T. 2517, T.I.A.S. No. 6.997, 330 U.N.T.S. 3.

lic policy of that country.[185] While this provision is not often invoked by courts in the United States, it must be remembered that the *Matusevitch* and *Bachchan* cases were decided upon public policy considerations. Indeed, to recognize and enforce such awards would violate the first amendment and hence the public policy of the United States.

Another related problem comes to mind, and that is the arbitrability of United States constitutional issues. Even though the courts in the United States seem to be ready to accept the arbitrability of almost any legal issue between private parties,[186] they have not, to date, recognized the arbitrability of constitutional issues. Congress does have the power to regulate foreign commerce by implementing the Federal Arbitration Act[187] and federal policy in the United States does favor arbitration,[188] especially in international business transactions.[189] However, once again the Constitution of the United States is the supreme law of the land and it is up to the courts, not Congress, to rule upon the arbitrability of constitutional issues.

A first amendment examination by courts in the United States considering recognition and enforcement of foreign copyright judgments and arbitration awards may have an effect unanticipated by United States policy-makers in their eagerness to provide international protection for United States copyright owners. The refusal to recognize and enforce a foreign copyright judgment or arbitration award would undermine the purpose behind most international agreements in this field of law and may have significant political repercussions. To illustrate these unanticipated effects, it is necessary for us to examine United States incentives for supporting international copyright conventions, treaties and accords and to examine some of the

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185 *See id.* art. V (2)(b).

186 Joseph D. Becker and Joosje M. Kleyn, *Public Policy and Arbitration—The 'Unruly Horse' and the Arbitrability of Claims in America*, 17 INT'L BUS. LAWYER 422 (1989).

187 9 U.S.C. 1, *et seq.*; Seymour v. Gloria Jean's Coffee Bean Franchising Corp., 732 F. Supp. 988 (D.Minn. 1990).

188 *See* Shearson/American Exp., Inc. v. McMahon, 482 U.S. 220 (1987).

189 *See* National Titanium Dioxide Co., Ltd. v. Velco Enterprises, Ltd., 879 F. Supp. 372 (S.D.N.Y. 1995).

more prominent international agreements regarding copyright protection such as Berne[190] and GATT[191]/TRIPS.[192]

VI. THE UNITED STATES INCENTIVES FOR SUPPORTING INTERNATIONAL COPYRIGHT CONVENTIONS, TREATIES AND ACCORDS

It is not difficult to discern the United States' incentives for supporting international copyright conventions, treaties and accords. In 1988 alone it was estimated that there was between $14 billion[193] and $23.8 billion[194] in international infringement losses and billions of dollars in trade surplusage attributed to the copyright industries.[195] Thus, many would argue that it would have been irresponsible not to support international copyright protection. What is surprising is the apparent lack of attention paid by United States policy-makers to the possible constitutional problems that could undermine the purpose behind these international copyright conventions, treaties and accords.[196] Given the supremacy of the United States Constitution over enactments of Congress, including international treaties, conventions and accords,[197] one would think that it would be imperative for United States policy-makers to

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190 *See* Berne, *supra* note 1.

191 *See* GATT, *supra* note 2.

192 *See* TRIPS, *supra* note 3.

193 *See* Al J. Daniel, Jr., *Intellectual Property in the Uruguay Round: The Dunkel Draft and a Comparison of United States Intellectual Property Rights, Remedies, and Border Measures*, 25 N.Y.U. J. INT'L L. & POL. 751, 752-64 (1992).

194 *See* Gabriel E Larrea Richerand, *GATT, Intellectual Property Rights and the Developing Countries*, 25(3) COPYRIGHT BULLETIN 4.

195 *See* Carol Motyka, *U.S. Participation in the Berne Convention and High Technology*, 39 COPYRIGHT L. SYMP. (ASCAP) 107, 118 (1992)($13 billion in 1988).

196 *See* NIMMER, supra note 15, at § 18.06 (c)(3)(a)(b), 18-81 to 18-84. *See also* Olivia Regnier, *Who Framed Article 18? The Protection of Pre-1989 Works in the U.S.A. Under the Berne Convention*, 15 EUROPEAN INTELLECTUAL PROP. REV. 400, 402 (1993); Katherine S. Deters, *Retroactivity and Reliance Rights Under Article 18 of the Berne Copyright Convention*, 24 VAND. J. TRANSNAT'L L. 971 (1991). The *Final Report of the Ad Hoc Working Group on U.S. Adherence to the Berne Convention*, 10 COLUM.-VLA J.L. & ARTS 513 (1985-86), states that there may be a first amendment problem with the retroactivity provision in article 18 of Berne (*Id.* at 587-591), but devotes little attention to a viable solution to the problem and ignores other constitutional implications.

197 *See* 2 RENE DAVID, INTERNATIONAL ENCYCLOPEDIA OF COMPARATIVE LAW, ch. 3 at 40-41 (The Hague 1984); U.S. CONST. art. VI, § 2; U.S. v. Curtiss-Wright Export Corp., 299 U.S. 304 (1936); LOUIS HENKIN, FOREIGN AFFAIRS AND THE CONSTITUTION 253-54 (1972).

consider constitutional implications. Yet, it seems that in pushing forward in the international field of copyright law, United States policy-makers have pushed back the Constitution.

As a practical matter, the fact that United States policy-makers have paid little heed to the constitutional constraints upon copyright law matters little if the international treaties, conventions, and accords do not in fact create a problem where the United States cannot provide redress for foreign copyright owners due to constitutional impediments. In this regard, we must keep in mind the fact that United States copyright law has been held to have no extraterritorial effect.[198] So our analysis is not concerned with the application of United States copyright law abroad; rather it is concerned with the application of international and foreign copyright law in recognition and enforcement actions in the United States.

A. *A Review of the Berne Convention*

The Berne Convention was first signed in 1886.[199] The impetus behind Berne was the authors' and publishers' associations of France and Germany who desired to implement formal international protection for copyrights.[200] This avowed purpose is stated in the preamble of Berne, to wit "to protect, in as effective and uniform a manner as possible, the rights of authors in their literary and artistic works."[201] Immediately, our problem is apparent: How effectively can the rights of authors be protected if they cannot enforce their foreign copyright judgments or arbitration awards?

Berne has been revised several times: Paris in 1886, Berlin in 1908, Rome in 1928, Brussels in 1948, Stockholm in 1967 and

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[198] *See* Graeme B. Dinwoodie, *Affirmation of Territorial Limits of U.S. Copyright Protection: Two Recent Decisions*, 14 EUROPEAN INTELLECTUAL PROP. REV. 136, 138 (1992); EEOC v. Arabian Am. Oil Co., 499 U.S. 244 (1991); Subafilms, Ltd. v. MGM-Pathe Communications Co., 24 F.3d 1088 (9th Cir. 1994); NIMMER, *supra* note 15, at § 17.02.

[199] *See* VINCENT PORTER, BEYOND THE BERNE CONVENTION—COPYRIGHT, BROADCASTING AND THE SINGLE EUROPEAN MARKET 2 (1991). The original signatories to Berne included Belgium, France, Germany, Great Britain, Italy, Spain, Tunis and Haiti. *See id.* at 2.

[200] *See id.* at 2.

[201] Berne, *supra* note 1 (the Berne Preamble, Paris 1971 is the same as the original version, circa 1886).

Paris in 1971.[202] The main purpose behind each of these revisions was the desire to update Berne to provide additional protection to authors in response to new technology. For example, the Berlin revision of 1908 was to address the new technologies of photography, sound recording and cinematography;[203] the Rome revision of 1928 was to address radio broadcasting rights;[204] the Brussels revision of 1948 was to address difficulties arising with regard to the recording and film industries, as well as the new television industry;[205] and the Stockholm revision of 1967 together with the Paris revision of 1971 modified Berne to further accommodate new technologies.[206] Because there are five effective revisions, it is important to determine which version a country has executed. For example, a country which has executed the 1948 Brussels Act but not the 1971 Paris Act, will only be bound by Berne pursuant to the Brussels Act (1948). The United Kingdom and the United States are bound by the Paris Act (1971).[207]

Article 36 of Berne requires a country wishing to become a member to reform its copyright laws to be compatible with Berne.[208] For example, when the United States became a member of Berne it had to revise its copyright law to remove formal notice and registration requirements, remove its requirement that works be published in the United States to receive protection in the United States, add protection of moral rights and

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202 *See* PORTER, *supra* note 199, at 2.

203 *See id.* at 4.

204 *See id.* at 5.

205 *See id.* at 7-9.

206 *See id.* at 10. The Stockholm revision of 1967 never came into effect due to insufficient ratification. However, some of its revisions were adopted by the Paris revision of 1971, which is currently in effect. *See* Porter, *supra* note 199, at 10.

207 *See* WORLD INTELLECTUAL PROPERTY ORGANIZATION ("WIPO") General Information, 51 (Geneva 1996). The United States implemented the Paris Act (1971) on March 1, 1989 when the United States first became a member of Berne. *See id.*

208 *See* Berne, *supra* note 1, at art. 36.

architecture, revise the term of protection[209] and allow for the retroactive application of protection.[210]

If a work is specifically protected by Berne, it is protected by a member country even if it is not protected under the member country's domestic laws.[211] The list of works specifically protected by Berne can be found in article 2(1).[212] For example, if a member country's domestic law does not protect lithography, protection will be afforded to lithography under the terms of Berne as it is a work specifically protected under article 2(1). There is no formal enforcement mechanism for a violation of Berne.[213] However, a member country may bring an action against another member country at the International Court of Justice.[214]

Article 18 of Berne requires retroactive application of protection to all works that have not fallen into the public domain through the expiry of the term of protection.[215] Thus, if a work in the United States has fallen into the public domain due to failure to comply with the notice requirements under the pre-1989 United States copyright law, it would receive protection under Berne.

The protection afforded under Berne is national treatment of foreign authors.[216] This means that a foreign author from member state *A* will be afforded protection in member state *B* to the same extent that national authors in member state *B* are afforded protection.

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[209] *See* Motyka, *supra* note 195, at 114-15; Ralph Oman, *Letter From the United States of America*, 27 COPYRIGHT 117 (1991). In general, the term of protection under Berne is the author's life plus 50 years. *See also* Sam Ricketson, *Duration of Term of Protection Under the Berne Convention*, 27 COPYRIGHT 84 (1991); Berne, *supra* note 1, at art. 7.

[210] Initially, the United States did not revise its law regarding retroactive application of protection as required by article 18 of Berne. *See* Regnier, *supra* note 196, at 402. This was corrected in 1994 by the TRIPS Amendment. *See* NIMMER, *supra* note 15, at §§ 9A.01 and 18.06 (c)(1).

[211] *See* Motyka, *supra* note 195, at 129-30.

[212] *See* Berne, *supra* note 1, at art. (2)(1).

[213] *See* Motyko, *supra* note 195.

[214] *See* Berne, *supra* note 1, art. 33.

[215] *See* Berne, *supra* note 1, at art. 18.

[216] *See* Gyorgy Boytha, *Some Private International Law Aspects of the Protection of Authors' Rights*, 24 COPYRIGHT 399, 400 (1988) and WIPO, *supra* note 207, at 52.

There is some debate amongst commentators over the applicable substantive law in an action for infringement under Berne. Some argue that the law of the place of protection, i.e. the lex loci protectionis, applies.[217] Others argue that the law of the place of the origin of the work, i.e. the lex loci originis, applies.[218] To some extent, Berne applies both lex loci protectionis and lex loci originis within its framework of protection. Under Berne, an author must have a link to a member country.[219] These "links," or eligibility factors, are specified in Berne at article 3, to wit:

> 1. An author who is a national of a member country;
>
> 2. An author who is not a national of a member country, but whose work is first published in a member country or simultaneously published in a country that is not a member and in a member country; or
>
> 3. An author who is not a national of a member country but who is a habitual resident of a member country.[220]

As we can see, the second eligibility factor does apply the doctrine of lex loci originis. However, it would be a mistake to view this as the proper law to be applied in an infringement action. Article 5(1) of Berne clearly provides that the proper law to be applied is the lex loci protectionis.[221] The eligibility factors merely determine if Berne is applicable, not what substantive law is applicable.

Another area under Berne where the lex loci originis may apply is the term of protection.[222] Under Berne, the term of protection is governed by the law of the place where protection is claimed but it shall not exceed the term of the country of origin (lex loci originis) unless the law of the place where protection is claimed (lex loci protectionis) provides otherwise.[223]

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[217] *See* Berne, *supra* note 1, art. 5(1).

[218] *See, e.g.*, Boytha, *supra* note 216, arguing that the law of the place of protection applies as compared to Georges Koumantos, *Private International Law and the Berne Convention*, 24 COPYRIGHT 415 (1988) arguing that the law of the place of origin applies.

[219] *See* Berne, *supra* note 1, art. 3, secs. 1 & 2.

[220] *Id.*

[221] *See* Boytha, *supra* note 216, at 407-09.

[222] *See id.* at 411.

[223] *See* Berne, *supra* note 1, at art. 7(8).

Although article 5(1) of Berne provides for protection under the doctrine of lex loci protectionis,[224] it is not entirely clear if this means that a foreign author is to be protected by the law of the place where the work was improperly used or the law of the place of the proceedings (lex fori). The majority view is that it is the law of the place where the work was improperly used as opposed to the lex fori.[225]

In general, Berne does not apply to protection of works in the country of origin. Protection in the country of origin is governed by domestic law.[226] However, to the extent that the domestic law of the country of origin does not apply to foreign authors, Berne requires that the foreign author be given national treatment.[227]

To recapitulate, the purpose of Berne is to provide international protection, "in as effective and uniform a manner as possible," of "the rights of authors in their literary and artistic works."[228] When a country becomes a member of Berne, certain minimum protection requirements must be met. Under Berne, the mechanism to achieve its goal is to provide national treatment to foreign authors. This means that the lex loci protectionis will be applied regarding acts of infringement and remedies but lex loci originis will be applied for some eligibility issues and possibly for the term of protection.

B. *A Review of GATT/TRIPS*

GATT/TRIPS was the first successful attempt to bring intellectual property within the terms of GATT.[229] TRIPS does not replace Berne. Rather, it supplements Berne by incorporating Berne's provisions, such as the application of article 18 of Berne through article 14(6) of TRIPS[230], and adding the enforcement incentive of trade sanctions on countries that do not provide adequate protection.[231]

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224 *See id.* at art. 5(1).

225 *See* Boytha, *supra* note 216, at 409.

226 *See* Berne, *supra* note 1, at art. 5(3).

227 *See* Boytha, *supra* note 216, at 409; Koumantos, *supra* note 218, at 424.

228 Berne, *supra* note 1, at Preamble.

229 *See* Daniel, *supra* note 193, at 752; Regnier, *supra* note 196, at 405.

230 *See* Regnier, *supra* note 196, at 405.

231 *See* Clive Bradley, *The Role of GATT in Intellectual Property*, 25(3) COPYRIGHT BULLETIN 11, 12 (1991).

Certainly, from a political perspective, it was advantageous for the United States to become a member of Berne prior to entering into negotiations for TRIPS. It was rather difficult for the United States to argue in favor of including intellectual property in a GATT agreement to protect its interests while it was not even a signatory to the most influential international agreement on copyright.[232] And, from an economic perspective, it is possibly advantageous to have some enforcement mechanism, although it is limited in its usefulness. But the lack of careful constitutional analysis could pose an embarrassing problem for the United States if United States courts refuse to recognize and enforce foreign copyright judgements and arbitration awards due to first amendment concerns. Such court decisions would undermine the purpose of Berne and GATT/TRIPS by not providing effective and adequate protection.

VII. CONCLUSION

United States copyright law is expressly based upon the United States Constitution.[233] While the United States Constitution grants the United States Congress power to enact copyright laws, this power is tempered by freedom of speech and press guaranteed by the first amendment of the United States Constitution. Unfortunately, United States policy-makers seem to have neglected to take first amendment mandates into consideration when they pushed forward with their desire to provide international protection to holders of United States copyrights.

The problem with this lack of foresight is made apparent when one recognizes the fact that United States copyright law is different in some fundamental respects from the copyright laws of other nations. This article has examined some of these differences by a comparison with the copyright law of the United Kingdom, a country with a common legal heritage and hence many legal similarities. The problems may be even more egregious if one compares United States copyright law with the laws of other nations.[234]

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[232] *See* Motyka, *supra*, note 195, at 138.

[233] U.S. CONST., art. I, § 8, cl. 2.

[234] French copyright law, for example, has as its main objective the moral rights of the author, as opposed to the Anglo-American copyright law, which is

As a practical matter, one should consider the political and economic influences at play. Copyright law has become one of the "darlings" of the international legal community. This is easily explained by the significant amount of money involved. Perhaps one of the most telling signals of this political and economic influence in the United States can be gleaned from the name-change of the Senate subcommittee with jurisdiction over copyright from "Courts, Civil Liberties and the Administration of Justice" to "Courts, Intellectual Property and the Administration of Justice."[235] This name-change occurred at approximately the same time that the United States became a member of Berne. Although it has been suggested that this name-change did not reflect a change of focus from the Bill of Rights, including the first amendment, to intellectual property,[236] one cannot help but wonder why the subcommittee felt the need to change its name if there was not a change of focus.

Under United States law it is the courts and not the United States policy-makers or Congress who have the last say. And just how courts in the United States will deal with this issue is a mystery. Some insight may be obtained, by analogy, from the libel law field. The libel law analogy establishes that there are real and practical problems faced by those who possess a foreign copyright judgment or arbitration award and try to have it recognized and enforced in the United States. If there are United States constitutional implications a court may find that the foreign law runs afoul of the United States Constitution and refuse recognition and enforcement on public policy grounds. Such a ruling would undermine the purposes of Berne and GATT/TRIPS and may result in other countries' refusals to recognize and enforce United States copyright judgments and arbitration awards.

This article has argued that the first amendment analysis by the courts in the libel cases of *Matusevitch v. Telnikoff*[237] and

based upon economics. *See* EDWARD W. PLOMAN AND L. CLARK HAMILTON, COPYRIGHT: INTELLECTUAL PROPERTY IN THE INFORMATION AGE, 108 & 196 (1980).

235 Robert W. Kastenmeier, *The 1989 Horace S. Manges Lecture—'Copyright in an Era of Technological Change: A Political Perspective'*, 14 COLUM.-VLA J.L. & ARTS 1 (1989).

236 *See id.*

237 877 F. Supp. 1 (D.C.D.C. 1995).

Bachchan v. India Abroad Publications, Inc.[238] is flawed and that recognition and enforcement should have been allowed. However, to date, these cases are still good law. Therefore, one attempting to enforce a foreign copyright judgment or arbitration award in the United States must consider this problem: if the substantive foreign law of the underlying action raises United States constitutional concerns the judgment or arbitration award may not be recognized and enforced in the United States.

[238] 585 N.Y.S.2d 661 (1992).