This practice note is a broad overview of how copyright can be enforced cross-border.

Summary

An international system of copyright enforcement exists, established by four conventions.

At the heart of the system is the principle of national treatment. This means that a copyright owner will be treated as if they are a national of the territory in which the infringement is taking place and can claim the protection of copyright laws there.

Copyright owners wanting to use this international system must be prepared to sue in a foreign jurisdiction with the added difficulties and costs that may be involved.

Background

Intellectual property rights are essentially territorial, ie they give protection in one territory only. As far back as the 1800s it was recognised that this was inadequate in relation to copyright. At that time, it was becoming easier for a copyright work to be copied in a foreign country but there was nothing what the copyright owner could do about it as their copyright was recognised only in their home country and had no validity in any foreign state. There were calls for an international system of copyright to be developed.

Today, we have something of an international system of copyright. At one time, this was a topic merely for interesting academic study. But, given the global nature of our society and the rise of the internet, which transcends national borders, it is now of real practical relevance for copyright owners.

Legal basis

The international system of copyright is established by four copyright conventions. The detailed history of these conventions is beyond the scope of this note. Negotiations originally began in the 1800s and the conventions were continually amended and refined right up until 1971 and beyond. The text of the conventions is now largely settled.
The conventions

The four principal copyright conventions are:

- The Berne Convention (Berne)
- The Universal Copyright Convention (UCC)
- The Rome Convention (Rome)
- The WIPO Copyright Treaty (WCT)

Berne and the UCC are read together and operate alongside one another. They are significant because they cover the greatest number of copyright works. Rome and the WCT extend the international system of protection to other types of copyright work which are outside the scope of Berne and the UCC.

Signatories

There are 164 signatories to the Berne Convention. A list can be found on the WIPO website.

There are 100 countries that have signed the UCC. A list of those countries can be found on the UNESCO website.

A list of the 91 signatories to Rome can be found on the WIPO website.

There are 89 signatories to the WCT and these are listed on the WIPO website.

The UK is a signatory to all four conventions.

Cross-border enforcement--bird’s eye view

Berne and the UCC create a system of reciprocity of copyright enforcement. Broadly, this means that if copyright is being infringed in a foreign territory and the conventions are available, the copyright owner is treated as a national of the foreign territory. The work is protected by the copyright laws of that territory and the copyright owner can bring proceedings for copyright infringement. This is known as the principle of ‘national treatment’.

Practical steps for copyright owners

If a copyright owner thinks that their copyright is being infringed abroad, they should assess the following:

- Are they a national of/habitually resident in/incorporated in a country which is a signatory to Berne or the UCC (regardless of whether the work in question has been published)?

If yes, go to step 3.

If no, continue to step 2.

- Was the work in question first published in a country which is a signatory to Berne or the UCC or simultaneously published in that country and a non-signatory country (within 30 days of each other)?

If yes, go to step 3.
If no, the copyright owner’s claim ends here. They cannot take advantage of national treatment.

- Is the work covered by Berne/UCC?

Berne and the UCC cover literary, artistic and scientific works. These are given a very broad definition within Article 2 of Berne to include ‘every production in the literary, scientific and artistic domain whatever may be the mode or form of its expression’. See Article 2 of Berne. This means that most categories of work conventionally protected by copyright will fall within Berne/the UCC.

Rome and the WCT extend the international system of protection to additional works. Rome covers performances, sound recordings and broadcasts. The WCT covers computer programs and databases.

If the work is covered by one of the conventions, the copyright owner can take advantage of national treatment.

**No formalities required**

Signatory countries cannot require copyright owners to follow particular formalities (such as registering their copyright in that country) before being allowed to take advantage of national treatment there. However, the UCC provides that, if formalities are required in any particular country, that country must regard them as satisfied where the copyright owner marks their work with a copyright notice comprising the copyright symbol (©) together with the author’s name and year of publication.

**Term of protection**

Copyright works accorded national treatment must be protected for specified minimum terms. These differ according to the nature of the work and the applicable convention. Broadly, the minimum terms are:

- Berne--life plus 50 years
- UCC--life plus 25 years
- Rome--20 years
- WCT--50 years

It is open to a signatory country to provide protection for a longer period if it wishes.
Where to sue

The conventions themselves do not say which courts will have jurisdiction over a copyright infringement action brought under them. There are no other treaties providing for this either. This means that a copyright owner wishing to sue must fall back on conventional jurisdictional principles.

In Europe, these are found in the Brussels Regulation, which has European-wide effect. A detailed discussion of the Regulation is outside the scope of this note. Broadly, the Regulation states that a defendant must be sued in their home country, i.e. their country of domicile. ‘Domicile’ means that the defendant is resident in that country (for a company, the place of the registered office or incorporation is relevant). If a defendant has more than one domicile, the courts of more than one EU Member State will have jurisdiction and the claimant will have a choice of where to sue. The domicile rule can, however, be overridden in the case of copyright infringement so that proceedings may be brought instead in the country in which the infringement occurred (if different).

Although bound by the Brussels Regulation, the English courts have developed a set of common law rules to assess whether they have jurisdiction over any particular set of proceedings. These rules say that a defendant should generally be sued in the country where the copyright infringement occurred; this is in line with the Regulation. However, the English courts have generally been willing to accept jurisdiction where the defendant has been physically present in the UK. This was illustrated recently in the case of Lucasfilm v Ainsworth. In this case, the Supreme Court held that a US copyright infringement action was justiciable in the English courts. Although the infringing acts were taking place in the US, the defendant was a UK national and domiciled here, which gave the English courts personal jurisdiction over him. The court was willing to accept jurisdiction in this case even though questions of US copyright law were in issue. Their Lordships were of the view that the English courts should be more willing to accept jurisdiction over foreign copyright infringement claims.

Technically, this decision means that the English courts would, in principle, be willing to accept jurisdiction over a dispute occurring in a country much further afield, such as Botswana, provided the defendant was domiciled or resident in the UK. In practice the UK courts are unlikely to be willing to handle a dispute such as this given the complex public policy and political issues that may be involved, not to mention the potential language barriers and the different system of law.

Jurisdictional issues in practice

Ideally, copyright owners will want to sue in the familiar legal surroundings of the UK. However, this will only be possible where the infringing acts are occurring abroad but the defendant is a UK national or is domiciled or resident here. Otherwise, the copyright owner will have little choice but to sue in a foreign jurisdiction.

So, a copyright owner using the international system of enforcement provided by the conventions must be prepared to bring proceedings in a foreign jurisdiction as this will be necessary in most cases unless the defendant lives in the UK. Copyright owners should be aware that this is unlikely to be straightforward. Different laws, languages and procedures will be involved. It will be necessary to instruct local lawyers and translators and additional costs will be incurred simply in litigating at long distance. However, many of the difficulties can be mitigated by instructing experienced UK lawyers to manage the process. Faced with the prospect of international proceedings, copyright owners should seek legal advice and, together with their lawyers, weigh up the potential benefits of an infringement action against the difficulties that may be involved.

References: Lucasfilm Ltd and others v Ainsworth and another [2011] IP & T 733
At Squire Sanders, we combine sound legal counsel with a deep knowledge of our clients’ businesses to resolve their legal challenges. We care about the quality of our services, the success of our clients and the relationships that are forged through those successes. Whatever is needed, we are able to deliver the seamless cross-practice, cross-border and industry-specific support that clients require for success in today’s competitive markets. The client base of our global legal practice spans every type of business, both private and public, worldwide.

In London, Squire Sanders provides a full range of services to both local and international clients, offering focused and commercial legal advice. Our London office is international in nature, comprising a combination of both UK- and US-qualified lawyers who between them speak numerous languages. Lawyers in our London office advise UK and international clients from a wide spectrum of industries on investing, litigating or doing business in the UK, in continental Europe or beyond. They counsel clients on patent, trademark, copyright and design disputes and contractual disputes relating to intellectual property. They also file and prosecute trademark and design applications, advise on the commercial exploitation of intellectual property and provide corporate due diligence support.

Squire Sanders has approximately 1,300 lawyers in 37 offices and 18 countries around the world. With one of the strongest integrated global platforms and our longstanding “one-firm firm” philosophy, Squire Sanders provides seamless legal counsel worldwide.

If you would like to contribute to Lexis® PSL IP & IT please contact:

Simon Hamlet
LexisNexis
Halsbury House
35 Chancery Lane
London, WC2A 1EL
simon.hamlet@lexisnexis.co.uk
+44 (0) 207 400 2907

For details of how to access more practice notes like this one, please visit www.lexislegalintelligence.co.uk/psl