CHOICE OF LAW—AN UNRESOLVED QUESTION IN THE FIRST ADULT VIDEO COPYRIGHT CASE OF THE TAIWAN INTELLECTUAL PROPERTY COURT

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ABSTRACT

On February 20, 2014, the Taiwan Intellectual Property Court ("TIPC") issued its first adult video copyright case, Taiwan Intellectual Property Court Criminal Judgment 101 Xing-Zhi-Shang-Yi-Zi No. 74 (2012). It held that an adult video work is copyright-eligible under the Taiwan Copyright Act and found the Japanese adult video works at dispute meet the orginaility requirement. Unfortunately, the TIPC court failed to address that issue in its first adult video copyright infringement case. To enrich the discussion related to the AV decision, this paper explores the "choice of law" issues regarding the cross-border protection of copyright. The theory developed is to help resolve those issues ignored by the TIPC. Relying on the Berne Convention, this paper argues that the issues related to authorship, copyright-eligibility, originality, and ownership should be governed by the law of the country of origin. So, the appropriate governing law for the copyright cases concerning Japan adult videos is the Japan copyright law instead of the Taiwan copyright law.

Keywords: Berne Convention, copyright, copyright-eligibility, ownership, originality

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I. Introduction

On February 20, 2014, the Taiwan Intellectual Property Court ("TIPC") issued its first adult video copyright case, Taiwan Intellectual Property Court Criminal Judgment 101 Xing-Zhi-Shang-Yi-Zi No. 74 (2012) (智慧財產法院刑事判決 101 年度刑智上易字第 74 號, hereinafter, "AV decision"). The infringed works were Japan adult videos. It held that an adult video work is copyright-eligible under the Taiwan Copyright Act. The decision is contrary to a prior decision of the Taiwan Supreme Court (最高法院, *zui gao fa yuan*). The Taiwan Supreme Court in 88 Tai-Shang-Zi No. 250 (最高法院 88 年度台上字第 250 號) held that an adult video work is not copyright-eligible because of a moral reason.[1]

To establish copyright-eligibility, the TIPC provided three grounds. First, pornographic works are a work defined in the Taiwan Copyright Act. Second, a work of softcore pornography should be protected under the Taiwan Copyright Act if it meets the originality requirement. Third, a Japanese work of pornography should be protected under the Taiwan Copyright Act.

To support that an adult video is a copyright-eligible work in Taiwan, the AV decision discussed a variety of sources of laws from the Taiwan Constitution to foreign copyright laws. Particularly, the TIPC recognized that the Japan copyright law protects adult video works. Regaring the originality issue, the TIPC replied on the case law deveploped by the Taiwan Supreme Court to determine that the adult video works at dispute meet the originality requirement. But, the TIPC failed to identify the governing law on the issues of originality and copyright-eligibility. Therefore, this article is intended to add an aspect of choice-of-law issues to the discussions surrounding the AV decision.

This paper argues that the choice-of-law for the issues of copyright-eligibility and originality is the Japan copyright law. To explore the legal theories behind that argument, Part II starts with the analysis of the Berne Convention for the Protection of Literary and Artistic Works ("Berne Convention"), which is the oldest international treaty regarding copyright protection.[2] The focused topics include country of origin, authorship, ownership, and implied choice-of-law rules. This paper particularly elaborates a definition of "author" in the context of the Berne Convention.[3]

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[1] *See* Ping-Hsun Chen, *Discussing the Rights Vested in Pornography Compact Disks under the Taiwan Copyright Act* [*lun se-qing guang-die zai wo-guo zhu-zuo-quan-fa shang zhi quan-li*], 6(5) ZHONG LU HUI XUN ZA ZHI 40, 40-48 (2004).

[2] *See* WORLD INTELLECTUAL PROPERTY OFFICE, WIPO INTELLECTUAL PROPERTY HANDBOOK: POLICY, LAW AND USE 262, *available at* http://www.wipo.int/export/sites/www/about-ip/en/iprm/pdf/ch5.pdf#berne.

[3] *See* Paul Edward Geller, *Conflicts Of Laws in Copyright Cases: Infringement and*

Part II concludes that the choice of law for the issues of authorship, copyright-eligibility, and ownership should be the law of the country of origin. Part III discusses the choice-of-law issues under the TIPC's jurisprudence regarding copyright cases. This paper specifically analyzes relevant provisions of "Act Governing the Choice of Law in Civil Matters Involving Foreign Elements" (涉外民事法律適用法, *she-wai min-shi fa-lu shi-yong fa*, hereinafter, "Choice-of-Law Act"),[4] and concludes that the Japan copyright law is the right choice of law for the issues of copyright-eligibility and originality because it is the law of the country of origin.

II. Protection of a Foreigner's Copyright under the Berne Convention

A. Berne Convention and National Treatment

The Berne Convention is the first international treaty addressing copyright protection of foreigners' works and provides a principle of "national treatment."[5] Article 5(1) of the Berne Convention states, "*Authors* shall enjoy, in respect of works for which they are protected under this Convention, in *countries* of the Union *other than the country of origin*, the rights which *their respective laws* do now or may hereafter grant to *their nationals*, as well as the rights specially granted by this Convention."[6] The principle mandates each member state to treat foreign copyright owners equally to or more favorably than its nationals.[7]

Taiwan is not considered as a sovereign state, so it cannot become a member state of the Berne Convention. But, in 2002 Taiwan joined the

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Ownership Issues, 51 J. COPYRIGHT SOC'Y U.S.A. 315, 360 (2004) ("Unfortunately, neither the Berne Convention nor any other copyright treaty, including the TRIPs Agreement, expressly defines the term 'author.'").

[4] The text of the Choice-of-Law Act can be found at http://law.moj.gov.tw/LawClass/LawAll.aspx?PCode=B0000007 (Mandarin version) and http://law.moj.gov.tw/Eng/LawClass/LawAll.aspx?PCode=B0000007 (English version).

[5] *See* Susan Sell, *Intellectual Property and Public Policy in Historical Perspective: Contestation and Settlement*, 38 LOY. L.A. L. REV. 267, 293 (2004) (describing that a member of the Berne Convention was required to "extend their legislative protection to foreigners of member states"); *see also* Michael Brandon Lopez, *Creating the National Wealth: Authorship, Copyright, and Literary Contracts*, 88 N.D. L. REV. 161, 180 (2012) ("The underlying purpose of the Berne Convention is to 'demand that each member state accord to nationals of other members the same level of copyright protection as it accords its own nationals.'").

[6] *See* Berne Convention art. 5(1) (emphasis added).

[7] *See* Jason Iuliano, *Is Legal File Sharing Legal? An Analysis of the Berne Three-Step Test*, 16 VA. J.L. & TECH. 464, 489 ("Since the Berne Convention is a safeguard against the maltreatment of foreign works alone, member nations are free to treat their domestic works less favorably.").

World Trade Organization ("WTO").[8] As a member state of the WTO, Taiwan is also a member of the Agreement on Trade-Related Aspects of Intellectual Property Rights ("TRIPS Agreement").[9] The TRIPS Agreement requires its member state to follow the requirements vested in Articles 1 through 21 of the Berne Convention.[10] Thus, Taiwan's obligation to protect a foreigner's copyright is now rooted from the Berne Convention.

B. Country of Origin

The Berne Convention has specific rules for identifying the nationality of a copyrighted work. Article 5 of the Berne Convention defines "the country of origin" for published works and unpublished works. Besides, Article 5 provides a non-publication-based rule specially for cinematographic works and architectural works.

For published works, the "country of origin" is decided by where the work is published. There are four rules. First, if a work is first published in only one member state, the country of origin of the work is that member state.[11]

The second and third rules relate to works published "simultaneously" in different countries, where Article 3(4) of Berne Convention states, "A work shall be considered as having been published simultaneously in several countries if it has been published in two or more countries within thirty days of its first publication."[12] The "country of origin" of those works depends on the place and timing of those "simultaneous" publications. If a work has been published in different countries of different terms of protection "within thirty days of its first publication," the country of origin is the country of the shortest term of protection.[13] If a work is published first in a non-member

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[8] *See* Raj Bhala, *Poverty, Islamist Extremism, and the Debacle of Doha Round Counter-Terrorism: Part One of a Trilogy-Agricultural Tariffs and Subsidies*, 9 U. ST. THOMAS L.J. 5, 29 (2011).

[9] *See* V.K. Unni, *Indian Patent Law and TRIPS: Redrawing the Flexibility Framework in the Context of Public Policy and Health*, 25 PAC. MCGEORGE GLOBAL BUS. & DEV. L.J. 323, 328-29 (2012) ("One of the most important agreements within the WTO is the Trade-Related Aspects of Intellectual Property ('TRIPS') Agreement, which mandates that all WTO members adopt and enforce certain minimum standards of IPR protection."), *available at* http://www.mcgeorge.edu/Documents/Conferences/GlobeJune2012_IndianPatentLaw.pdf.

[10] *See* TRIPS Agreement art. 9.1 ("Members shall comply with Articles 1 through 21 of the Berne Convention (1971) and the Appendix thereto. However, Members shall not have rights or obligations under this Agreement in respect of the rights conferred under Article 6*bis* of that Convention or of the rights derived therefrom.").

[11] *See* Berne Convention art. 5(4)(a) ("The country of origin shall be considered to be ... in the case of works first published in a country of the Union, that country.").

[12] Berne Convention art. 3(4).

[13] *See* Berne Convention art. 5(4)(a) ("The country of origin shall be considered to be ...

state and then "simultaneously" in a member state, the country of origin is that member state.[14]

The fourth rule is that if a work is first published in a non-member state without then having been published in any member state within thirty days of its first publication, the country of origin is the member state where the author is a national.[15]

For unpublished works, the country of origin is the member state where the author is a national.[16] Thus, when a work is unpublished, the "country of origin" of that work is merged with the nationality of the author. The merger rule is also applicable to a work first published in a non-member state without being published in other member states within thirty days of its first publication. Otherwise, the nationality of a work depends on where that work is first published.

Last, as for cinematographic works and architectural works, Article 5(4)(c) provides exceptions for "unpublished works" and "works first published in non-member state without being published in other member states within thirty days of its first publication." For "cinematographic works the maker of which has his headquarters or his habitual residence in a [member state]," the country of origin is that member state.[17] For architectural works "erected in a country of the Union or other artistic works incorporated in a building or other structure located in a [member state]," the country of origin is that member state.[18]

C. Protectable Work

The definition of the "country of origin" of a work is very important because the consideration of the "country of origin" of a work is part of the determination of whether that work is protectable under the Berne Convention when the Berne Convention becomes binding. As stated in

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in the case of works published simultaneously in several countries of the Union which grant different terms of protection, the country whose legislation grants the shortest term of protection.").

[14] *See* Berne Convention art. 5(4)(b) ("The country of origin shall be considered to be ... in the case of works published simultaneously in a country outside the Union and in a country of the Union, the latter country.").

[15] *See* Berne Convention art. 5(4)(c) ("The country of origin shall be considered to be ... in the case ... of works first published in a country outside the Union, without simultaneous publication in a country of the Union, the country of the Union of which the author is a national.").

[16] *See* Berne Convention art. 5(4)(c) ("The country of origin shall be considered to be ... in the case of unpublished works … , without simultaneous publication in a country of the Union, the country of the Union of which the author is a national.").

[17] *See* Berne Convention art. 5(4)(c)(i).

[18] *See* Berne Convention art. 5(4)(c)(ii).

Article 18(1), the Berne "Convention shall apply to all works which, at the moment of its coming into force, have not yet fallen into the public domain in the *country of origin* through the expiry of the term of protection."[19] Assume that a work of Country A is in the public domain because of the expiry of the term of protection, while the same work is during the term of protection in Country B. If the country of origin of such work is determined to be Country A, then Country B does not need to protect such work.

D. Authorship

Identifying authors is very important for calculating the term of protection. Particularly in a case of works of joint authorship, without identifying all authors, it is impossible to measure the term of protection from "the death of the last surviving author."[20]

Authors also control the "country of origin" of their works. Article 3(3) of the Berne Convention defines "published works" as "works published with the *consent* of their authors."[21] For published works, an author has to consent to publish her work in a member state, so her work can acquire the country of origin as that member state. If she consents to publish her work in a non-member state, the country of origin is her nationality. For works published in different member states, an author can control the timing of "simultaneously" publications other than the first one, so her work may be tied to the country of the first publication.

But, the Berne Convention does not define "author" in three aspects.[22] First, whether an author has to be a natural person is not clear.[23] Article 7(1) of the Berne Convention provides that the term of protection is "the life of

[19] Berne Convention art. 18(1) (emphasis added).

[20] *See* Berne Convention art. 7*bis* ("The provisions of the preceding Article shall also apply in the case of a work of joint authorship, provided that the terms measured from the death of the author shall be calculated from the death of the last surviving author."); *see also* Roberto Garza Barbosa, *Revisiting International Copyright Law*, 8 BARRY L. REV. 43, 49-50 (2007).

[21] *See* Berne Convention art. 3(3) (emphasis added) ("The expression 'published works' means works published with the consent of their authors, whatever may be the means of manufacture of the copies, provided that the availability of such copies has been such as to satisfy the reasonable requirements of the public, having regard to the nature of the work. The performance of a dramatic, dramatico-musical, cinematographic or musical work, the public recitation of a literary work, the communication by wire or the broadcasting of literary or artistic works, the exhibition of a work of art and the construction of a work of architecture shall not constitute publication.").

[22] *See* Jane C. Ginsburg, *The Concept of Authorship in Comparative Copyright Law*, 52 DEPAUL L. REV. 1063, 1069 (2003).

[23] *See id.*

the author and fifty years after his death."[24] Only a natural person can die, so Article 7(1) indicates that an author has to be a natural person to be eligible for the protection under the Berne Convention.[25]

Second, how much a person has to contribute herself to a work so as to become an author of that work is not clear. In other words, no definition of the level of "contribution" is made in the Berne Convention. However, while the Berne Convention speaks nothing about the definition of an author's "contribution," it does imply that an author has to contribute something to a work in Article 14*bis*. Article 14*bis* defines a rule of "choice of law" for ownership of copyright in a cinematographic work (film).[26] Specifically, Article 14*bis*(2)(b) recognizes a film maker's right to use the film in a member state where "authors who have brought contributions to the making of the [film]" are considered as owners of the film.[27] By using "contributions" in Article 14*bis*(2)(b), the Berne Convention indicates that an author must have some "contribution" to her work in order to assert authorship.

Third, the question following the requirement of "contribution" is "originality." The Berne Convention does not define the level of originality which renders an author's work copyright-eligible. Some commentators have agreed that the Berne Convention left the issue of "originality" to each member state to decide.[28] Thus, the country of origin of a work controls

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[24] *See* Berne Convention art. 7(1).

[25] *See* Arthur R. Miller, *Copyright Protection for Computer Programs, Databases, and Computer-Generated Works: Is Anything New Since Contu?*, 106 HARV. L. REV. 977, 1052 (1993) ("The draft's authors took the view, however, that to qualify for Berne Convention protection, these works must trace their origin to a human author.").

[26] *See* F. Jay Dougherty, *Not a Spike Lee Joint? Issues in the Authorship of Motion Pictures under U.S. Copyright Law*, 49 UCLA L. REV. 225, 315 (2001); see also William Patry, Choice of Law and International Copyright, 48 AM. J. COMP. L. 383, 428-29 (2000) (describing the rules of authorship and ownership of a film in different countires).

[27] *See* Berne Convention art. 14*bis*(2)(b) ("However, in the countries of the Union which, by legislation, include among the owners of copyright in a cinematographic work authors who have brought contributions to the making of the work, such authors, if they have undertaken to bring such contributions, may not, in the absence of any contrary or special stipulation, object to the reproduction, distribution, public performance, communication to the public by wire, broadcasting or any other communication to the public, or to the subtitling or dubbing of texts, of the work.").

[28] *See* Laurence R. Helfer, *Adjudicating Copyright Claims under the TRIPs Agreement: The Case for a European Human Rights Analogy*, 39 HARV. INT'L L.J. 357, 369 (1998) ("Commentators agree, however, that the Berne Convention does not specify the quantum of individual creativity or originality necessary for any literary and artistic work to be eligible for copyright protection, leaving the issue to member states' discretion."), *available at* http://scholarship.law.duke.edu/cgi/viewcontent.cgi?article=2648&context=faculty_scholarship; *see also* Christine Haight Farley, *Protecting Folklore of Indigenous Peoples: Is*

whether that work meets the originality requirement.

At most, the Berne Convention provides rules for identifying the author of a work. Article 15(1) mandates each member state to allow an author to file a law suit as long as her name appears on her work in a usual manner.[29] Even in a case where an author uses her pseudonym, as long as her pseudonym "leaves no doubt as to [her] identity," she should be allowed to suit infringers.[30] While Article 15(1) provides a simple formality for the author of an infringed work to bring a suit, it does not help find the real author of such infringed work.

E. Ownership and "Choice of Law"

While the Berne Convention does not define "authorship," it does express that the author of a work enjoys the rights granted by copyright laws of member states and by the Berne Convention.[31] So, the author of a work may acquire initial ownership of copyright of that work, either published or unpublished. In addition, ownership of copyright may be vested in entities other than authors. Article 2(6) of the Berne Convention provides that "[t]his protection shall operate for the benefit of the author and his successors in title."[32] So, the rights given to authors can be transferred to their successors in title.

To resolve the issue of ownership, it is necessary to find a real author first. If the author of a work and the "country of origin" of that work have the name nationality, the governing law may be simply only one law, either "the

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Intellectual Property the Answer?, 30 CONN. L. REV. 1, 19 n.71 (1997) ("The Berne Convention does not define the requisite level of originality."); Jane C. Ginsburg, *Surveying the Borders of Copyright*, 41 J. COPYRIGHT SOC'Y U.S.A. 322, 327 (1994) ("[T]he Berne Convention does not define the requisite level of originality.").

[29] *See* Berne Convention art. 15(1) ("In order that the author of a literary or artistic work protected by this Convention shall, in the absence of proof to the contrary, be regarded as such, and consequently be entitled to institute infringement proceedings in the countries of the Union, it shall be sufficient for his name to appear on the work in the usual manner."); *see also* Paul Edward Geller, *Conflicts of Laws in Copyright Cases: Infringement and Ownership Issues*, 51 J. COPYRIGHT SOC'Y U.S.A. 315, 358-59 (2004) ("The Berne Convention provides that, when a person's name appears as the author's on a 'work in the usual manner,' that person is presumed to be that author with standing to sue.").

[30] *See* Berne Convention art. 15(1) ("This paragraph shall be applicable even if this name is a pseudonym, where the pseudonym adopted by the author leaves no doubt as to his identity.").

[31] *See* Berne Convention art. 5(1) ("Authors shall enjoy, in respect of works for which they are protected under this Convention, in countries of the Union other than the country of origin, the rights which their respective laws do now or may hereafter grant to their nationals, as well as the rights specially granted by this Convention.").

[32] Berne Convention art. 2(6).

law of the country of origin" or "the law of the country where the copyright law suit is filed." But, if the author and the "country of origin" have different nationalities, the governing law is not clear because the Berne Convention does not mention any "choice of law" rule for authorship.

The Berne Convention does not express a general rule of "choice of law" for copyright ownership, neither.[33] However, Article 14*bis*(2)(a) of the Berne Convention provides that "[o]wnership of copyright in a cinematographic work shall be a matter for legislation in the country where protection is claimed."[34] This provision indicates that the Berne Convention has an implied "choice of law" rule for copyright ownership issues. That is, the choice of law regarding copyright ownership is the law of the country of origin.

In addition to Article 14*bis*(2)(a), the Berne Convention has several provisions mentioning "choice of law" rules. Several terms are used in those provisions: "a matter for legislation in the countries of the Union,"[35] "governed exclusively by the laws of the country where protection is claimed,"[36] "governed by domestic law,"[37] "authorized by the legislation of the country where protection is claimed,"[38] "governed by the legislation of the country where protection is claimed,"[39] "a matter for legislation in the country where protection is claimed,"[40] "a matter for the legislation of the country where the maker of the cinematographic work has his headquarters or habitual residence,"[41] "a matter for the legislation of the country of the Union where protection is claimed,"[42] "only if legislation in the country to

[33] *See* Jane C. Ginsburg, *Global Use/Territorial Rights: Private International Law Questions of the Global Information Infrastructure*, 42 J. COPYRIGHT SOC'Y U.S.A. 318, 331 (1995) ("Apart from the article specifically addressing the law applicable to determine ownership of copyright in cinematographic works, the Berne Convention proffers no general choice of law rule for copyright ownership.").

[34] Berne Convention art. 14*bis*(2)(a); *see also* Dougherty, *supra* note 26, at 315 ("These variations in treatment of films led to difficulty in exploitation, and studies were conducted to amend the Berne Convention to address and harmonize the issue of film ownership. The amendment was passed as part of the 1967 Stockholm Revision of the Convention, adding a new Article 14 bis, which attempted to deal with those difficulties. That article states that ownership of copyright in films is to be determined under the law of the country where protection is sought.").

[35] *See* Berne Convention arts. 2(2), 2(4), 2(7), 2*bis*(1), 2*bis*(2), 7(4), 9(2), 10(2), 10*bis*(1), 10*bis*(2), 11*bis*(2), 11*bis*(3).

[36] *See* Berne Convention art. 5(2).

[37] *See* Berne Convention art. 5(3).

[38] *See* Berne Convention art. 6*bis*(2).

[39] *See* Berne Convention arts. 6*bis*(3), 7(8).

[40] *See* Berne Convention art. 14*bis*(2)(a).

[41] *See* Berne Convention art. 14*bis*(2)(c).

[42] *See* Berne Convention art. 14*bis*(2)(c).

which the author belongs so permits, and to the extent permitted by the country where this protection is claimed,"[43] "a matter for legislation in that country," [44] "in any country of the Union where the work enjoys legal protection," [45] "in accordance with the legislation of each country," [46] and "granted by legislation in a country of the Union."[47]

To specify the implied "choice of law" rule for copyright ownership, Article 5 of the Berne Convention can provide a start. First, Article 5(1) provides, "*Authors* shall enjoy, in respect of works for which they are protected under this Convention, in *countries* of the Union *other than the country of origin*, the rights which their respective laws do now or may hereafter grant to their nationals, as well as the rights specially granted by this Convention." [48] It implies that before having a right to enjoy the protection outside the country of origin, the author of a work should have a right to enjoy the protection within the country of origin. Thus, it is fair to say that a work must be a copyright-eligible work in the country of origin so as to enjoy the protection in countries other than the country of origin.

Second, Articles 5(2) and 5(3) together demonstrate that there are two choices of law for adjudicating copyright disputes. On one hand, Article 5(2) provides that "apart from the provisions of this Convention, the *extent of protection*, as well as the *means of redress* afforded to the author to protect his rights, shall be governed *exclusively* by the *laws of the country where protection is claimed*."[49] It indicates that the economic rights, moral rights, and remedial measures are governed by the law of the country where protection is claimed. On the other hand, Article 5(3) provides, "*Protection* in the *country of origin* is governed by *domestic law*."[50] It indicates that the protection within the country of origin is governed by the law of the country of origin. Otherwise, "domestic law" should have been replaced by "the laws of the country where protection is claimed" as used in Article 5(2).[51]

Third, Article 5(3) and Article 3(1)(b) together confirm that the law of the "country of origin" of a work governs the creation of that work. The author of a work enjoys the protection of copyright of her work because her work is initially protectable in the country of origin. Article 5(3) provides that "when the *author* is not a national of the country of origin of the work

[43] *See* Berne Convention art. 14*ter*(2).
[44] *See* Berne Convention art. 15(4)(a).
[45] *See* Berne Convention art. 16(1).
[46] *See* Berne Convention art. 16(3).
[47] *See* Berne Convention art. 19.
[48] Berne Convention art. 5(1) (emphasis added).
[49] Berne Convention art. 5(2) (emphasis added).
[50] Berne Convention art. 5(3) (emphasis added).
[51] *See* Berne Convention art. 5(2).

for which he is protected under this Convention, he shall *enjoy* in that country *the same rights as national authors*." [52] Because Article 5(3) emphasizes "protection within the country of origin," the same protection extends to authors who are not nationals of a member state where their works are published. Consequently, the country of origin of their works is that member state. This view is consist with Article 3(1)(b) which provides, "The protection of this Convention *shall* apply to: … (b) authors who are *not nationals* of one of the countries of the Union, for *their works first published* in one of those countries, or *simultaneously* in a country outside the Union and in a country of the Union."[53] In addition, Article 3(2) provides that the protection of the Berne Convention shall apply to "[a]uthors who are *not nationals* of one of the countries of the Union but who have their *habitual residence* in one of them."[54]

In conclusion, authors acquire copyright protection because of their works. There are three categories of persons who can become authors within the country of origin of their works: nationals of the country of origin, nationals of a country other than the country of origin, and residents of a member state with the nationality of a non-member state. The country of origin of a work creates authorship and makes that work become protectable within the country of origin. This indicates that the copyright protection of a work is defined by the country of origin of that work. Therefore, the law of the country of origin of a work should govern the ownership issue of that work as well as authorship or originality.

F. Transitional Period

"Author" is very important because an author controls the publication of her work. Under Article 3(3) of the Berne Convention, if the means of publication is "manufacture of the copies," "the availability of such copies has been such as to satisfy the *reasonable requirements of the public*, having regard to the *nature of the work*."[55] Two elements, "reasonable requirements of the public" and "nature of the work," must be considered before the determination of whether a work has been published.

The question becomes more complicated when the nationality of the author and the "country of origin" of such published work are different. Assume that the author of a work is a national of Country X and that the place where the work is first published is Country Y. Under Article 5(4), when the work is not published, the country of origin is Country X; however,

[52] Berne Convention art. 5(3) (emphasis added).
[53] Berne Convention art. 3(1)(b) (emphasis added).
[54] Berne Convention art. 3(2) (emphasis added).
[55] *See* Berne Convention art. 3(3) (emphasis added).

after the work is published, the country of origin is Country Y. So, the "choice of law" question arises again because the Berne Convention does not clarify whether the law of Country X or the law of Country Y governs the issues related to publication. Perhaps, the law of Country Y should be the governing law regarding the issues surrounding publication. First, Country Y as the country of origin has standing to assist a published work to be protected in other countries. That published work enjoys the protection outside the country of origin because its country of origin is recognized as Country Y. Thus, it is fair to say that the laws of Country Y should govern the issues of publication so as to control the scope of works protected internationally under its name.

III. "Choice of Law" Issues of Copyright Cases in Taiwan

A. Issues

Since the TIPC was established in 2008,[56] it has never addressed choice-of-law issues in copyright cases regarding foreign works in the light of the Berne Convention. The TIPC often refers to the Choice-of-Law Act to conclude that the Taiwan Copyright Act governs every issue.[57]

Article 42.1 of the Choice-of-Law Act states, "For a right on a subject matter based on intellectual property, the laws of the place where that right shall be protected are governing."[58] Replying on this provision, the TIPC chooses the Taiwan Copyright Act as the governing law in copyright disputes.

While Article 42.1 is very similar to Article 5(2) of the Berne Convention in terms of choice-of-law issues, it fails to distinguish the pure property rights on a work (*e.g.*, ownership, authorship, or originality) from the economic or moral rights associated with that work.

"Protection" is another undefined term in the Berne Convention. If authorship and ownership are taken into consideration, the rights granted by the Berne Convention as "protection" can be divided into two categories. A person has to become the author of her work before she can enjoy the copyright protection of her work. So, one category covers the rights to claim authorship or ownership, and the other category is the rights to enjoy the economic or moral rights.

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[56] *See* Huei-Ju Tsai, *The Practice of Preventive Proceeding and Preservation of Evidence in Intellectual Property Civil Actions*, 1 NTUT J. OF INTELL. PROP. L. & MGMT. 105, 106 (2012).

[57] *See*, *e.g.*, Taiwan Intellectual Property Court Civil Judgment 102 Min-Zhe-Su-Zi No. 4 (2013) (智慧財產法院民事判決 102 年度民著訴字第 4 號).

[58] Article 42.1 of the Choice-of-Law Act is officially translated as "A right in an intellectual property is governed by the law of the place where the protection of that right is sought ('lex loci protectionis') [以智慧財產為標的之權利, 依該權利應受保護地之法律]."

Each category should be subject to its own choice of law. For the rights to claim authorship or ownership, the choice of law should be the law of the country of origin. For the rights to enjoy the economic or moral rights, the choice of law should be the law of the country where protection is claimed.

B. Law of the Country of Origin

The TIPC's application of Article 42.1 of the Choice-of-Law Act is so limited that only Taiwan intellectual property laws govern all issues in intellectual property litigation. If all issues are governed by Taiwan laws only because a copyright owner files a law suit to assert copyright protection in Taiwan, Article 42.1 will be non-sense.

If the Legislative Yuan (Taiwan congress) chose to adopt the laws of Taiwan for all rights of intellectual property, it would have used "the law of Taiwan" instead of "the laws of a place where that right shall be protected." Thus, a court must have some choices of law other than Taiwan laws for adjudicating IP issues.

When an author creates a work, she can actually own that work as a property. Under the Berne Convention or domestic copyright law, she also owns copyright associated with that work. While copyright is considered as something detached from a physical work, copyright actually can be felt by human beings because it is based on expression of that work. Thus, a copyrighted work is not an invisible object but a sensible property as a real property protected by property law.

If the issues related to the creation of a work are considered as the issues of property law, then Article 38.2 of the Choice-of-Law Act can be taken into consideration in resolving the issues of choice of law in the context of authorship, originality, or ownership. Article 38.2 states, "For a property right on a subject matter based on any right, the laws of the place where that right was established are governing."[59] If authorship and ownership are considered as a right-based property right (not like a real estate or movable object), then Article 38.2 is applicable for a court to resolve the issues of authorship, originality, or ownership. So, the court should adopt the law of the country of origin to resolve those issues.

Therefore, whether a work is copyright-eligible for protection outside the country of origin under the Berne Convention should be governed by the law of the country of origin not the laws of another country where protection is claimed. If a work deserves copyright protection within the country of origin, it should be protected by copyright law in another country.

[59] Article 38.2 of the Choice-of-Law Act is officially translated as "A property right in a right is governed by the law of the place where the right is formed [關於以權利為標的之物權, 依權利之成立地法]."

Last, particularly for a work for hire, Article 42.2 states, "The ownership of a right of intellectual property created by an employee on duty is governed by the law applicable to the employment contract."[60] Thus, if an author has an obligation to transfer title to copyright to her employer, the ownership issue becomes more complex because the law governing the employment contract or relationship may be another choice of law which may be different from either the law of the country of origin or the law of the country where protection is claimed.

C. Law of the Country Where Protection is Claimed

When a legitimate copyright owner of a foreign work files a complaint of copyright infringement in Taiwan, this means that she claims copyright protection outside the country of origin of her work. Because Article 5(2) of the Berne Convention states that "the extent of protection, as well as the means of redress afforded to the author to protect his rights, shall be governed *exclusively* by the laws of the country where protection is claimed," [61] the application of domestic copyright law to adjudicating whether any right granted to copyright owners is violated complies with the Berne Convention.

The application of domestic copyright law to copyright infringement issues is also supported by another sentence of Article 5(2) which indicates the independency of protection in different countries. As stated in Article 5(2), "such enjoyment and such exercise shall be independent of the existence of protection in the country of origin of the work."[62] Therefore, even if the country of origin grants better protection, the copyright owner cannot assert such better protection in another country.[63] As long as a country complies with the minimal protection requested by the Berne Convention, it is that country where protection is claimed to decide how far the copyright owner can claim protection for her work in that country.

Last, while Article 14*bis* of the Berne Convention chooses the law of the

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[60] Article 42.2 of the Choice-of-Law Act is officially translated as "Any right in an intellectual property created by an employee in the performance of his/her duties is governed by the law applicable to the contract of employment [受僱人於職務上完成之智慧財產, 其權利之歸屬, 依其僱傭契約應適用之法律]."

[61] Berne Convention art. 5(2) (emphasis added).

[62] *Id.*

[63] *See* Miaoran Li, Comments, *The Pirate Party and the Pirate Bay: How the Pirate Bay Influences Sweden and International Copyright Relations*, 21 PACE INT'L L. REV. 281, 292 (2009) ("[C]opyright protection is independent of the existence of protection in the originating country, although if a Berne Union state has a stronger protection period than the country of origin and the protection has elapsed in the country of origin, protection may be denied.").

country where protection is claimed as the governing law for the ownership issue of a cinematographic work, Article 42.2 of the Choice-of-Law Act provides the law which governs the employment contract is the choice of law for the ownership issues of an employee's work. Thus, the choice of law in that case may be different from the law of the country where protection is claimed. But, it is the law of the country where protection is claimed which chooses the law of another jurisdiction to resolve the issues. So, Article 42.2 is not contrary to the Berne Convention.

D. Rethinking the Legal Reasoning of the AV Decision

In a Japan adult video film with a Chinese subtitle, when the actors say "*kimochi*" (気持ち), the relevant subtitle shows "*song*" (爽). While it is true that Taiwanese people who cannot speak Japanese learns the idea of the scene through relevant Chinese subtitles, those subtitles are only the translation of the original transcript.

The copyright-eligibility or originality of a work is judged by the original content not its translated counterpart. So, the ultimate question is whether "*kimochi*" or "*song*" is the center of the copyright-eligibility or originality analysis. Alternatively, whether the law of Japan or the law of Taiwan governs the copyright-eligibility or originality of a Japan adult video is a question which must be considered before looking into the issues of originality.

In the AV decision, the TIPC held that an adult video is copyright-eligible and further found that the adult video works at dispute meet the originality requirement. In either conclusion, the TIPC failed to explain any legal reasoning for the "choice of law" issue and went on to apply the Taiwan copyright law. This application of the "choice of law" is inappropriate because the right choice of law should have been the law of the country of origin of those adult video works. That is the Japan copyright law.

According to the Berne Convention, the issues of copyright-eligibility and originality should be governed by the law of the country of origin. In other words, the law of the country of origin can be a more appropriate choice of law for those issues. The analysis of Articles 38.2 and 42.1 of the Choice-of-Law Act supports the same "choice of law" rule. Thus, it is suggested that for future cases regarding Japanese adult video works, the TIPC should apply the Japan copyright law, including case law, to the issues of copyright-eligibility and originality.

IV. Conclusion

While the AV decision recognizes that the adult video works at dispute are copyright-eligible and of originality, this conclusion is not based on a correct choice of law. To fix that error, the Berne Convention as an

international copyright treaty for protecting authors provides a basis for analysis. While the Berne Convention does not express any general rule of "choice of law," it does provide that the ownership of copyright in a film is governed by the law of the country where protection is claimed. This indicates that the issues of copyright ownership are presumed to be governed by the law of the country of origin. Because of that, under the Berne Convention, an appropriate choice of law for the issues of originality and copyright-eligibility is the law of the country of origin. Thus, the correct choice of law for a Japan adult video film is the Japan copyright law instead of the Taiwan copyright law.

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