

From Berne to Madrid and Beyond: The road to international copyright and trademark protection in the United States

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The past twenty-five years have witnessed a remarkable change in the law of the United States with respect to the international protection of copyrights and trademarks, as embodied in the Berne Convention and the Madrid Protocol. On March 1, 1989, one hundred three years after the formation of the Berne Union, the United States eliminated the formal notice requirement for copyright protection in the United States, which was the fundamental barrier to accession to the Berne Convention. A little over eight months later, on November 16, 1989, a new trademark law reversed the requirement of use of a trademark as a prerequisite to applying for federal registration, bringing U.S. law into conformity with that of the vast majority of other nations. On November 2, 2003, the United States finally became a party to the Madrid Protocol. These events fell into a discernable pattern of rapprochement with the basically Eurocentric development of international law and procedures for the protection of intellectual property. A quarter century later, U.S. copyright and trademark law is much closer to that of Europe, but important differences remain.

I. The Process of Assimilation

International protection for intellectual property began with the Convention for the Protection of Industrial Property (“Paris Convention”), signed in 1883 and dealing with patents and trademarks.¹ That same year, the Association Littéraire et Artistique Internationale, inaugurated work on an agreement for international copyright registration, which was signed three years later in Berne, Switzerland (“Berne Convention” or “Berne”).² In 1891, building on the foundation of the Paris Convention, several European nations entered into the Madrid Agreement (“Madrid”), which permitted unified filing of trademark applications among its members.³

The United States accepted the principle of national treatment of proprietors of patents and trademarks – that is, equal treatment of foreign and domestic applicants and registrants – when it adopted the Paris Convention⁴ in 1887. Four years later, Congress gave statutory

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¹ Convention of Paris for the Protection of Industrial Property of 20th March, 1883, revised Brussels, 1900; Washington, 1911, 37 Stat. 1645, T. S. 579, July 21, 1914; The Hague, 1925, 47 Stat. 1789, T. S. 834, 2 Bevans 524, June 9, 1931; London, 1934, 53 Stat. 1748, T. S. 941, 2 Bevans 223, August 3, 1948; Lisbon, 1958, 53 Stat. 1748, 13 U.S.T. 1, T. I. A. S. 9431, February 13, 1962; Stockholm, 1967, 21 U.S.T. 1583, T. I. A. S. 6923, July 16, 1968 [hereinafter “Paris Convention”].

² The Berne Convention for the Protection of Literary and Artistic Works of September 9, 1886, 331 U. N. T. S. 217 [hereinafter “Berne Convention”]. The most recent revision was completed in Paris on July 24, 1971. The Paris text became effective July 10, 1974, reprinted in 9 *M. Nimmer*, *Nimmer on Copyright*, app. 27-1 (2010).

³ Arrangement of Madrid for the International Registration of Marks, reprinted in *L. Altman*, *Callman on Unfair Competition, Trademarks and Monopolies*, app., § 55:10 (4th ed. 2003) [hereinafter “Callmann”].

⁴ Paris Convention, *supra* note 1, arts. 2 and 4.

recognition to the principle of protection of foreign copyrights,⁵ but the United States declined to adopt either the Berne Convention or the Madrid Agreement since they contained elements which were considered antithetical to U.S. law: the automatic granting of copyright without formalities⁶ and the recognition of trademark rights prior to actual use. It ultimately took another century for the United States to accept these two fundamental elements of international protection.

While resisting attempts to adopt these principles, the United States sought alternate means of cooperation with the international community, such as the Universal Copyright Convention (“UCC”)⁷ and the Trademark Registration Treaty (“TRT”)⁸ on terms that it hoped would elevate the U.S. legal principles to world standards. During the ascendancy of U.S. political and economic power in the twentieth century, this policy was reasonably successful with respect to the UCC. Although the TRT was effectively stillborn,⁹ the practice of the U.S. Patent and Trademark Office eventually permitted foreign applications without requiring use anywhere, basing its position on the provisions of the Paris Convention.

Nearly a quarter century later, however, it is apparent that the primary effect of this policy was to provide a stepping stone for the further development of U.S. law in the direction charted in Europe over a century ago.

II. Copyright

As a young nation anxious to import culture, the United States had very little interest in affording adequate protection to foreign authors. Publishers in the United States routinely pirated the works of English authors including Dickens and Trollope.¹⁰ Only after the formation of the Berne Union, under the Berne Convention, did the United States subscribe to national treatment, the central tenet of international protection of intellectual property. This step forward, accomplished in the Chace Act of 1891, was accompanied not only by formalities¹¹ rejected by Berne in the Berlin revision of 1908¹² but also by the overtly protectionist “manufacturing provision” that denied copyright protection to foreign works unless they were printed in the United States.¹³

⁵ The International Copyright Act of 1891, 26 Stat. 1106.

⁶ Berne Convention, *supra* note 2, art. 5 (2).

⁷ The Universal Copyright Convention, September 8, 1952, 6 U. S. T. 2731, T. I. A. S. No. 3324, 216 U. N. T. S. 133, revised July 24, 1971, 25 U. S. T. 1341, T. I. A. S. No. 7868, 943 U. N. T. S. 178, [hereinafter “UCC”] reprinted in *Nimmer*, *supra* note 2, at app. 25-1.

⁸ Trademark Registration Treaty, adopted at Vienna, June 12, 1973, reprinted in *Callman*, *supra* note 3, at app. § 55:20.

⁹ See discussion *infra*, at note 73.

¹⁰ *Sandison*, The Berne Convention and the Universal Copyright Convention: The American Experience, 11 Columbia-VLA J. L. & Arts 89, 92-94 (1986).

¹¹ Section 4956 of the Chace Act, requiring registration before publication and deposit of two copies of the work on or before the date of publication anywhere.

¹² One year after the Berlin revision of Berne, Congress enacted a complete revision of the copyright law which retained and codified the formalities of notice and registration in essentially the form which remained in effect until the effective date of the Berne Implementation Act on March 1, 1989, Ch. 320, 35 Stat. 1075.

¹³ Chace Act, Section 4956, liberalized but retained in the 1909 copyright law, Ch. 320, 35 Stat. 1075, Sec. 21-22.

Following World War I, in a spate of internationalism, Congress made many attempts to bring U.S. law into closer conformity to Berne, with eight bills introduced between April 1922 and October 1923.¹⁴ In 1924, Congress considered a major revision, the Dallinger bill, which would have cleared the way for memberships in Berne.¹⁵ Although the bill achieved widespread support, it was finally killed by opposition from the National Association of Book Publishers on the ground that elimination of the manufacturing provision would deprive the industry of its protected American market.¹⁶ That Congress credited this argument indicates that, whatever the accomplishments of U.S. authors by this time, their markets abroad were not substantial enough to change the nation's self-image as an importer and user of copyrighted material.

The failure of the Dallinger bill was followed by six other legislative efforts before World War II to bring the United States into Berne. Some of these were based on the Dallinger bill,¹⁷ while others were "minimalist" approaches, providing for only the changes deemed absolutely essential to qualify for Berne.¹⁸ Even though these efforts were lacking in coherence, the continuing pressure for change demonstrated the increasing importance of the film and recording industries as exporters to foreign, principally European, markets.¹⁹ The final pre-war effort to revise U.S. copyright law, in 1935-36, foundered as its proponents became uncomfortable with the changes in the political climate in Germany and Italy.²⁰

After World War II, Europe wanted better access to the American market and the United States became a leading exporter of copyrighted works, making the U.S. failure to join Berne more critical.²¹ Although larger U.S. publishers had discovered the so-called "back door" to protection under Berne by simultaneously publishing in Canada and the United States, thereby qualifying the publications for protection under Berne, there was fear of retaliation if no further steps were taken toward coordination with Berne.²²

The members of the Berne Union were unwilling to dilute the protection afforded to authors, however, in order to attract the United States into Berne.²³ At the same time, although it had relaxed the requirement of the manufacturing provision with several exceptions,²⁴ the United States was unwilling to accept the principle of automatic copyright without the formalities of notice and registration, believing that these formalities were necessary to insure "the fullest possible use of intellectual works consistent with the encouragement of authorship."²⁵ Indeed, it

¹⁴ *Brown*, The Role of the United States in relation to the International Copyright Union In Recent Years, 34 J. Pat. Off. Soc'y, 201-02 (1952).

¹⁵ H. Hearings on H.R. 6250 and H.R. 9137, 68th Cong., 1st Sess. (1924) cited in *Brown*, supra note 14, at 202, n.39.

¹⁶ *Brown*, supra note 14, at 204.

¹⁷ See, e.g., the Vestal Bill of 1926, H.R. 10434, 69th Cong., 1st Sess. (1926) reintroduced in 1929, H.R. 8912, 70th Cong., 1st Sess. See *Brown*, supra note 14, at 206-07.

¹⁸ 1933 Bills H.R. 5853, 73d Cong., 1st Sess. (1933), S. 1928, 73d Cong., 1st Sess. (1933), and Duffy Bill of 1935 S. 2465, 74th Cong., 1st Sess. (1935). See *Brown*, supra note 14 at 215.

¹⁹ See discussion of the 1932 Sirovich Bill in *Brown*, supra, note 14 at 212-14.

²⁰ *Brown*, supra, note 14, at 221.

²¹ *Note*, International Copyright Protection and the United States: The Impact of the UNESCO Universal Copyright Convention on Existing Law, 62 Yale L.J. 1065, 1083 (1953).

²² *Id.*

²³ *Ringer*, The Role of the United States in International Copyright – Past, Present and Future, 56 Geo. L.J. 1050, 1060-61 (1968).

²⁴ *Id.*

²⁵ *Henn*, The Quest for International Copyright Protection, 39 Cornell L.Q. 43, 58 (1953) (citation omitted).

was felt that the procedures were eminently sensible and should be used as a model for the rest of the world. Many still shared the opinion expressed two decades earlier by the Chairman of the Committee on Patents in hearings on the possibility of U.S. conformity to Berne: “instead of having Europe to educate us, why can’t we educate Europe and have Europe adopt the principle of copyright notice and registration?”²⁶

The solution to this impasse was the promulgation of the UCC under the auspices of UNESCO.²⁷ The UCC was designed to require only minimal changes in domestic law²⁸ and the formalities of notice and registration under U.S. law were relatively simple and inexpensive.²⁹ Congress provided an incentive to members of the Berne Union to join the UCC with the exemption of all UCC works from the weakened but still troublesome manufacturing provision.³⁰ The UCC treaty succeeded in attracting most of the existing Berne Union members and a number of other countries as signatories.³¹ The overlapping of membership and the practice of holding joint meetings encouraged peaceful coexistence and even cooperation between the treaty groups, but an underlying assumption on the part of the U.S. about the superiority and ultimate victory of its position as expressed in the UCC caused it to adopt a competitive stance. For example, in 1967, the two camps were both courting the developing nations as potential members in a “polite but fierce competition” whose outcome was described as “very much in doubt.”³²

The competition between the two treaties was inherently uneven, however. While the UCC had been designed to accommodate both Berne and non-Berne members so that UCC signatories were free to join Berne without affecting their UCC relations, the Berne members were able to include a provision to prevent any Berne member from leaving the union and relying solely on the UCC.³³ In effect, the UCC became a recruiting tool for Berne,³⁴ while the United States found itself increasingly left out of the deliberations affecting international copyright protection.³⁵

²⁶ Id., at 64, n. 106 (quoting William I. Sirovich in Hearings before Committee on Patents on General Revision of the Copyright Law, 72d Cong., 1st Sess. 37-38 [1932]).

²⁷ See *Callman*, supra note 3.

²⁸ *Note*, supra, note 21 at 1084.

²⁹ The form of notice required was minimal – (c) followed by the date and the name of the author – and the procedure for registration was simple and inexpensive enough to be carried out without legal assistance in most cases.

³⁰ Act of U.S. Congress of Aug. 31, 1954, ch. 116, sec. 9 (1), 68 Stat. 130.

³¹ All but six of the forty members of Berne at the time the UCC was promulgated acceded to the UCC. See *Nimmer*, supra note 2, app. 20 and

³² *Ringer*, supra note 23, at 1065 (describing this competition which resulted in the Stockholm Protocol of 1967 to the Berne Convention).

³³ UCC art. XVII and the related Appendix Declaration effective among Berne members who are also members of the UCC. See *Ringer*, supra, note 23, at 1062.

³⁴ All but two of the UCC’s one hundred members are also Berne signatories, while sixty-five of Berne’s one hundred sixty-six signatories have not joined the UCC. Of the countries who have joined both the UCC and Berne since the UCC came into force, over twice as many joined the UCC first. See *Nimmer*, supra note 2, at apps. 21 & 22. Treaty information, is available at http://www.wipo.int/wipolex/en/other_treaties/details.jsp?treaty_id=208 for the UCC and at <http://www.wipo.int/treaties/en/ip/berne/> for Berne.

³⁵ *Ringer*, supra note 23, at 1070, (describing the frustration felt by the U.S. delegation at the Stockholm Conference as “Berne outsiders with no real influence upon the outcome”).

By 1976, the United States was ready to begin harmonization of its copyright law to the standards of Berne. In the Copyright Revision Act of 1976,³⁶ Congress finally eliminated the “manufacturing provision” and changed the term of copyright protection to the life of the author plus fifty years,³⁷ a change which was promoted to obtain the “benefits of uniformity with foreign laws” and because “[w]ithout this change, the possibility of future United States adherence to the Berne Copyright Union would evaporate.”³⁸ Acceptance of the Berne principles of automatic copyright and elimination of the formalities of registration as a condition to copyright enforcement were not achieved until passage of the Berne Convention Implementation Act (BCIA)³⁹ over a decade later.

From the legislative history of the Berne Convention Implementation Act it is clear that there was no longer any dispute that the international standard for copyright protection is set by Berne and not by the UCC. Berne standards were described as “high, reasonable and widely accepted internationally”⁴⁰ and the foundation of “an international legal consensus on the basic rules of authors’ rights.”⁴¹

Underlying these statements was the stark reality that there were over twenty Berne members who were not members of the UCC and were therefore safe havens for unlicensed copying and sale of U.S. copyrighted material as long as the United States remained outside of Berne.⁴² The extent of such copyright piracy was enormous, amounting to “well over \$1 billion” each year.⁴³ A repeated theme in the Congressional deliberations was that the U.S. position in negotiations to stop the piracy, whether in bilateral talks⁴⁴ or within the General Agreement on Tariffs and Trade (GATT), was being greatly weakened by the perception that the United States was unwilling to bring its laws up to the prevailing world standard. In testimony before the Senate Committee on the Judiciary, C. William Verity, the Secretary of Commerce, cited the example of Thailand, a member of Berne, where other Berne members were able to enforce their copyrights by police action while the claims of the United States, based on simultaneous publication, were considered too tenuous to merit such a response.⁴⁵

The ultimate rationale for implementing Berne was that it was necessary to the competitiveness of the United States. With copyright industries accounting for five percent of

³⁶ U.S. Copyright Act of 1976, former 17 U.S.C. § 101, *et seq.* (1989).

³⁷ The term of copyright was extended to life of the author plus seventy years by the Sonny Bono Copyright Term Extension Act of 1998.

³⁸ H.R. Rep. No. 1476, 94th Cong., 2d Sess. 135 (1976) quoted in *Sandison*, *supra*, note 10 at 104.

³⁹ P.L. No. 100-568 (1989) (signed on October 31, 1988 and entered into force on March 1, 1989).

⁴⁰ Testimony of *Robert W. Kastenmeier*, Chairman, Subcommittee on Courts, Civil Liberties and the Administration of Justice, House Committee on the Judiciary, on U.S. Adherence to the Berne Convention, before the Subcommittee on Patents, Trademarks and Copyrights, Senate Committee on the Judiciary, February 18, 1988, 68 U.S. Cong. Documents, 100th Cong., at 51 (1988) [hereinafter “*Kastenmeier Testimony*”] (quoted by Senator *DeConcini* in remarks before the Senate, October 5, 1988, Cong. Rec. S 14553).

⁴¹ *Id.*

⁴² Statement of Hon. C. *William Verity*, the Secretary of Commerce, 68 U.S. Cong. Documents, 100th Cong., at 122 (1988) [hereinafter “*Verity Testimony*”].

⁴³ *Id.* at 70.

⁴⁴ *Id.* (referring to the case of Thailand, a member of Berne where the bilateral treaty with the U.S. was invalidated by a Thai court on procedural grounds and, following substantial problems in protecting U.S. copyrights under the simultaneous publication rule, the efforts to reinstate the bilateral relations were met with irritation over the failure of the U.S. to join Berne).

⁴⁵ Answers to questions from Senator *Heflin*, 68 U.S. Cong. Documents, 100th Cong., at 121 (1988).

the GNP and returning a trade surplus of over one billion dollars,⁴⁶ the United States had become the largest exporter of copyrighted materials in the world, economically dependent upon trading partners who were all members of Berne.⁴⁷ In 1988, faced with the exclusion of the United States from effective participation in the formulation and management of international copyright policy,⁴⁸ Congress finally abandoned its reliance on the UCC and passed the BCIA. As stated by Denis de Freitas, Chairman of the British Copyright Council on the occasion of the 100th anniversary of the Berne Union:

I regard the UCC as a worthy United Nations initiative designed in the middle of the 20th century to enable developing countries (notably the United States of America) to enter into multilateral copyright relations with those countries which have been developing the copyright system internationally from the middle of the last century to the sophisticated code now embodied in the Berne Convention.⁴⁹

In passing BCIA, Congress decided not to make the Berne Convention self-executing, requiring instead that U.S. copyright law be amended as necessary to comply with the obligations of the treaty. Although the BCIA included amendments to implement the principle of automatic copyright, it did nothing to bring U.S. law into compliance with Berne's recognition of the doctrine of moral rights, which holds that the creators of artistic works have certain personal rights in their creations that transcend their economic rights in the works. The doctrine encompasses four basic rights: disclosure, retraction, attribution and integrity. The rights of disclosure and retraction recognize that the artist is the sole judge of when a work is finished and worthy of public disclosure or display. The right of attribution gives the artist control over whether and how his or her name will be associated with the work. The right of integrity gives the artist control over alteration, distortion or destruction of the work, including the contexts in which it may be displayed. At the time, it was argued that explicit protection of moral rights was not necessary because other Berne signatories were not in full compliance⁵⁰ and that then existing U.S. law, including the Lanham Act and laws relating to defamation, privacy, publicity, and unfair competition, contained "the basic elements of moral rights sufficient to comply with Berne."⁵¹

In fact, subsequent efforts by artists to vindicate their moral rights under the Lanham Act and other laws have often been turned back.⁵² A number of states, including New York and California, enacted statutes which typically protected the moral rights of integrity and attribution⁵³ although they were inconsistent in their coverage as well as on the duration of

⁴⁶ *Verity Testimony*, supra note 42, at 70.

⁴⁷ Remarks of Representative Fish, H 10097, Cong. Rec. (daily ed. October 12, 1988), reprinted in 36 J. Copyright Soc'y USA 65 (1988).

⁴⁸ The second major reason that the United States should join Berne is that adherence is necessary to ensure effective U.S. participation in the formulation and management of international copyright policy. U.S. adherence to Berne would give our officials the right to participate fully in the administration and management of the Convention. New technologies for the transmission and use of copyrighted works have "internationalized" intellectual property to an unprecedented extent, and U.S. participation in the premier international copyright organization is essential.

⁴⁹ Freitas, *The Berne Convention and the Market Economy Countries* 11 Columbia-VLA J.L. & Arts 73, 77 (1986).

⁵⁰ Monica E. Antezana, *The European Union Internet Copyright Directive as Even More than It Envisions: Toward a Supra-EU Harmonization of Copyright Policy and Theory*, Note, 26 B.C. INT'L & COMP. L. REV. 415, 427 (2003).

⁵¹ 134 CONG. REC. 10323 (Statement of Sen. Katzenmeier).

⁵² Robert C. Bird and Lucille M. Ponte, *Protecting Moral Rights in the United States and the United Kingdom: Challenges and Opportunities under the U.K.'s New Performances Regulations*, 24 B.U. INT'L L.J. 213, 253-254 (2006).

⁵³ N.Y. Arts & Cult. Aff. Law § 11.01-14 and Cal. Civ. Code §§ 980-990.

protection, waivers and remedies and were nearly always restricted to visual arts.⁵⁴ Even these fledgling developments were largely pre-empted, however, when Congress adopted the Visual Artists Rights Act (VARA)⁵⁵ in 1990. VARA was another step toward the Berne standard in that it granted federal recognition of some of the moral rights of visual artists, but the act's narrow definition of visual art⁵⁶ and its limitation of the right to prevent destruction to works of "recognized stature"⁵⁷ have made it very difficult for visual artists to assert their moral rights in court, leaving them with even less protection than they were afforded under the state laws.⁵⁸ Moreover, with the exception of Puerto Rico,⁵⁹ none of the statutes protect musical artists.

It remains to be seen whether the United States will continue on a course toward compliance with the moral rights obligation of Berne. Other common law jurisdictions, such as Canada, Australia and New Zealand and the United Kingdom now protect moral rights in both visual art and music,⁶⁰ which weakens the argument that moral rights are incompatible with the common law tradition. On the other hand, it was the economic interest of U.S. publishers in encoring their copyrights abroad that drove the United States to join Berne. Since moral rights are personal rather than economic in nature, they are unlikely to attract the level of support necessary to overcome the traditional U.S. antipathy toward them in the absence of strong pressure from the international community.

III. Trademark

The most enduring barrier to U.S. participation in the development of international trademark law – the requirement of actual use before application for registration – was not instigated by Congressional action. In the Trade-Mark Act of 1870, Congress had permitted

⁵⁴ See generally Thomas P. Heide, *The Moral Right of Integrity and the Global Information Infrastructure: Time for a New Approach*, 2 U.C. DAVIS J. INT'L L. & POL'Y 211, 233-35 (1996) and Brian T. McCartney, "Creepings" and "Glimmers" of the Moral Rights of Artists in American Copyright Law, 6 UCLA ENT. L. REV. 35, 55-71 (1998).

⁵⁵ 17 U.S.C. § 106(A) (2005). Even without statutory preemption, state legislation that attempts to protect artists rights cannot reach activity occurring wholly outside the state. *Estate of Graham v. Sotheby's Inc.*, 860 F.Supp.2d 1117 (C.D. Cal. 2012) (California statute provide a resale royalty right for fine artists on sales of art by California residents occurring outside California violated the dormant Commerce Clause).

⁵⁶ VARA defines a "work of visual art" as:

(1) a painting, drawing, print, or sculpture, existing in a single copy, in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author, or, in the case of a sculpture, in multiple cast, carved, or fabricated sculptures of 200 or fewer that are consecutively numbered by the author and bear the signature or other identifying mark of the author; or

(2) a still photographic image produced for exhibition purposes only, existing in a single copy that is signed by the author, or in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author. 17 U.S.C. § 101.

The definition excludes

(A)(i) any poster, map, globe, chart, technical drawing, diagram, model, applied art, motion picture or other audiovisual work, book, magazine, newspaper, periodical, data base, electronic information service, electronic publication, or similar publication; (ii) any merchandising item or advertising, promotional, descriptive, covering, or packaging material or container; (iii) any portion or part of any item described in clause (i) or (ii); (B) any work made for hire; or (C) any work not subject to copyright protection under this title. *Id.*

⁵⁷ 17 U.S.C. § 106A(a)(3)(B).

⁵⁸ See Patricia Alexander, *Moral Rights in the VARA Era*, 36 ARIZ. ST. L.J. 1471, 1490-91 (2004); RayMing Chang, *Revisiting the Visual Artists Rights Act of 1990: A Follow-up Survey About Awareness and Waiver*, 13 TEX. INTELL. PROP. L.J. 129, 144-45 (2005).

⁵⁹ P.R. Laws Ann. Tit 31, §§ 1401-1401(a).

⁶⁰ Bird, *supra* note 52 at 276.

registration based on the intent to use a mark. This provision was eliminated by judicial enforcement of a constitutional limitation on the power of Congress. While Congress is constitutionally empowered to regulate patents and copyrights, its power over trademarks flows from its general power to regulate commerce. Because marks not yet in use were deemed not to affect commerce, the 1870 law was struck down in the Trade-Mark Cases.⁶¹ Thus, at the international conference of 1880 in preparation for the Paris Convention, the United States delegation was under strict instructions that any conclusions of the conference respecting trademarks “must be considered as absolutely subordinate to such legislative provisions as may hereafter be made” by the United States.⁶² The subsequent legislative provisions, in the Trade-Mark Act of 1905, required use in commerce and specimens of use as preconditions to application for registration.⁶³

The Paris Convention contained three elements that together set the stage for the eventual assault on the requirement of actual use. First was the principle of national treatment, contained in Article 2.⁶⁴ The second element, the right of priority contained in Article 4, granting retroactive protection in member countries based upon filing in another member country, was a new idea. It has been called “the most significant innovation and contribution of the Paris Convention. . . . There had been nothing like it in earlier bilateral treaties.”⁶⁵ The third element was the most controversial. It would eventually serve as the wedge to crack open the U.S. requirement of use. It was contained in Article 6 (now 6 quinquies) of the Convention and is generally known by the French phrase “telle quelle”, referring to the requirement that “[a]ny trademark duly deposited in the country of origin shall be admitted to deposit and protected ‘telle quelle’ [in original form] in all other countries of the Union.”⁶⁶

As in the case of copyrights, the Paris Convention was soon followed by a European vision of a more unified approach to international trademark protection: the Madrid Agreement of 1891. The Madrid Agreement “institutionalized and systematized the underlying philosophy of the ‘telle-quelle’ provision”⁶⁷ by extending the country of origin registration of a trademark to other member countries without a multiplicity of national filings and creating a presumption of validity for such extended applications unless denied within twelve months by the member country affected.⁶⁸

The United States objected to several provisions of the Madrid Agreement, but the primary objection was that it allowed the international registration of trademarks without a requirement of use. Since international filings under Madrid were based on registration in the

⁶¹ 100 U.S. 82 (1879).

⁶² *Pegram*, Trademark Law Revision: Section 44, 78 Trademark Rep. 141, 153, n. 74, (1988) (quoting Foreign Relations of the United States, 378-79 [1880]).

⁶³ Act of Feb. 20, 1905, ch. 592, 33 Stat. 724 (1905). Although the commerce clause is now given a broader reading than at the time of the Trade-Mark Cases, *supra* note 53, the possibility of a constitutional objection to the intent to use provisions of the trademark law discussed in this article cannot be totally dismissed. However, full discussion of this issue is beyond the scope of this article.

⁶⁴ *Pegram*, *supra* note 62, at 154; *S.P. Ladas*, Patents, Trademark, and Related Rights: National and International Protection (1975).

⁶⁵ *Pegram*, *supra* note 62, at 155.

⁶⁶ *Id.* at 156; Paris Convention, *supra* note 1, Article 6 quinquies.

⁶⁷ *Frayne*, History and Analysis of TRT, 63 Trademark Rep. 422, 423-24 (1973).

⁶⁸ *Id.*

country where the registrant was organized or carried on business, the Agreement would enable applicants in a country not requiring use to obtain priority over those in use based systems. It was also feared that membership in Madrid would subject the United States to a proliferation of registrations of unused marks.⁶⁹

Several of the minor objections of the United States were addressed in the 1957 Nice Revision.⁷⁰ The United States did not consider the changes sufficient, however, and suggested further revisions in 1969. Discussions were held under the auspices of the World Intellectual Property Organization (WIPO) in 1970, but they eventually foundered, in large part on the issue of whether use should be a prerequisite for registration.⁷¹

At the close of the unsuccessful WIPO conference in April 1970, the United States proposed a separate treaty for the international registration (or, more accurately, the international filing) of trademarks which, following the successful example of the UCC, would be open to all members of the Paris Convention but could coexist with the Madrid Agreement. As in the case of the UCC, an element of competition was present, with the hope that a new treaty could replace the Madrid Agreement.⁷²

The resulting Trademark Registration Treaty (“TRT”) was finished in June 1973. It allowed filings in French or English, eliminated dependency of international registrations on country of origin registrations, and extended the time for refusal of an international application from twelve to fifteen months. The treaty addressed the issue of non-use by allowing international registrations prior to use while allowing members to restrain infringement actions in the absence of use and permitting cancellation for non-use three years after registration.⁷³

The preliminary predictions of commentators on the future of the TRT were gloomy.⁷⁴ They also proved accurate. Although the treaty had been suggested by the United States and was intended as a compromise, the provision allowing registration of unused marks proved too radical a change and the treaty was never ratified by Congress, which refused to make the necessary amendments to the Lanham Act.⁷⁵ Only eight countries signed the treaty and it ended up having only five members: Soviet Union, Congo, Gabon, Burkina Faso and Togo.⁷⁶

While the United States considered and rejected the idea of protection of trademarks not yet in use, the Patent and Trademark Office (“USPTO”)⁷⁷ eventually created an exception to the requirement of use for applications based on foreign registrations or applications. Starting with

⁶⁹ Address by *J. Samuels*, Assistant Commissioner of Patents and Trademarks, U.S. Patent and Trademark Office, at the Association of the Bar of New York City (March 8, 1990) [hereinafter “*Samuels Address*”]; see also, *Pegram*, supra note 62, at 425.

⁷⁰ See *Callman*, supra note 3, at § 26:3.

⁷¹ *Frayne*, supra note 67 at 426-427.

⁷² *Ladas*, What Does the Vienna Trademark Registration Treaty Mean to the United States?, 63 Trademark Rep. 551, 568 (1973).

⁷³ *Frayne*, supra note 59, at 32-33.

⁷⁴ See, *Ladas*, supra note 72; *Frayne*, supra note 67; and *Derenberg*, The Myth of the Proposed International Trademark “Registration” Treaty (TRT), 63 Trademark Rep. 531 (1973).

⁷⁵ See *Callman*, supra note 3, at § 27:4.

⁷⁶ See *L. Altman*, *Callman on Unfair Competition, Trademarks and Monopolies*, app., § 55:10 (4th ed. 1984), at app. § 55:17.

⁷⁷ Formerly the Patent Office. The name was changed in 1975.

the MERRY COW decision in 1955, it held that a United States application based upon a country of origin registration under Section 44 of the Lanham Act is exempted from the requirement of use, basing its decision on an analysis of Articles 6 A and 6 B of the Paris Convention.⁷⁸ Over the following three decades, the USPTO was inconsistent in its application of the exception⁷⁹ but, by 1984, in the *Crocker* case,⁸⁰ it had fully embraced the policy of accepting trademark applications under the Convention without any allegation of use.

The application of the *telle quelle* exception resulted in a disparity of treatment of foreign trademark owners, who were allowed to file applications with no allegation of use, and domestic applicants, still bound by the old rule of use. Although lobbyists for the 1988 Trademark Law Revision Act emphasized the benefits of the intent to use system on its own merits, the goal of eliminating this disparity was probably the largest factor in the adoption of the intent to use provision.⁸¹

With the passage and implementation of the Trademark Law Revision Act of 1988, the irreconcilable differences between the trademark law of the United States and that of the members of the Madrid Union were substantially eliminated. While these developments were occurring in the United States, the efforts at harmonizing the trademark laws of the members of the European Community resulted in the Directive of December 21, 1988, which explicitly approved the revocation of registrations of trademarks not put to “genuine use” within five years of registration.⁸² This move toward consensus was combined with an effort to bring all members

⁷⁸ Ex parte Societe Fromageries Bel, 105 U.S.P.Q. 392, 45 Trademark Rep. 846, 64 Trademark Rep. 315 (Com’r 1955) (Asst. Com’r Leeds) (1955).

⁷⁹ Cf. In re Certain Incomplete Trademark Applications, 137 U.S.P.Q. 69 (Com’r 1963) (refusing registration of two Canadian and two UK applications for which no use was alleged) and John Lecroy & Son, Inc. v. Langis Foods Limited, 177 U.S.P.Q. 717-18, 64 Trademark Rep. 308-09 (TTAB 1973), rev’d 376 F. Supp. 962, 182 U.S. P. Q. 132, 64 Trademark Rep. 301 (D.D.C. 1974), rev’d sub nom SCM Corp. v. Langis Foods, Ltd., 539 F.2d 196, 190 U.S.P.Q. 288, 64 Trademark Rep. 308 (D.C. Civ. 1976). It has been suggested that the *Lecroy* decision by the Board was intended to “pave the way” for ratification of the Trademark Registration Treaty. See *Derenberg*, supra note 74, at 546.

⁸⁰ *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 U.S.P.Q. 909 (TTAB 1984).

⁸¹ *Comment*, Intent-to-Use Applications for Trademark Registration, 35 Wayne L. Rev. 1135, 1149 (1989). The discriminatory application of the use requirement was emphasized in the introductory remarks of the sponsors of the bill in both houses of Congress:

“Even more disturbing is the fact that foreign companies applying to register trademarks in the United States are not subject to these same use requirements that apply to U.S. applicants.” (Statement of Sen. *DeConcini*), Congressional Record, S 16,546 S 16,547, (daily ed. November 19, 1987), reprinted in the The Trademark Law Revision Act of 1988, *United States Trademark Association* (hereinafter “*USTA Report*”) at 113 (1989).

“U.S. trademark law favors foreign companies seeking to obtain and register trademark rights in the United States... The legislation puts American and foreign businesses on essentially the same footing when they apply to register trademarks in the United States.” Remarks of Representative *Moorehead*, Congressional Record, E 665 (daily ed. March 15, 1988), reprinted in the *USTA Report*, at 129.

In the report of the Senate Committee on the Judiciary, the first comment regarding the introduction of applications based on intent to use was that the bill “will improve the federal trademark registration system by eliminating the requirements that U.S. citizens and businesses, unlike their foreign counterparts, must use a mark in commerce before they can file an application to register it”. S. Rep. No. 515, 100th Congress, 2d Sess. (1988), reprinted in the *USTA Report* at 156.

⁸² Council Directive, Articles 10-12. The five year period is comparable to the period for filing the compulsory statement of use under Section 8 of the Lanham Act, 15 U.S.C. § 1058 (1989). Although the Lanham Act still contains the *prima facie* presumption of abandonment of a trademark following two years of non-use, it is not clear how this presumption will be applied to an international application which states, but is not based upon, an intent to use, an intention which the law allows to continue for up to three years.

of the European Community (“EC”), including those with common law systems of trade mark protection such as the U.K. and Ireland, into the Madrid Union.⁸³ By seeking greater consensus with the common law systems, the Madrid Union also moved closer to the position of the United States.

Beginning with the WIPO initiative convened at the request of the 1981 Assembly of the Madrid Union, a working group of Madrid and European Community members approved the Madrid Protocol of 1989 to link Madrid and the European Community.⁸⁴ The Protocol allowed a country of origin application as the basis for international applications, eliminated all dependency on the country of origin mark following application, allowed English as a working language, permitted a national trademark office to take up to eighteen months to refuse registration of an international application and permitted members to charge their own national fees.⁸⁵

The gravitational pull of the new Protocol on the United States was immediately apparent. Speaking less than four months after the effective date of the new U.S. trademark law, Jeffrey Samuels, the Assistant Commissioner of Patents and Trademarks of the USPTO, remarked that the Protocol removed most of the objections of the United States to the Madrid Agreement and suggested that it was time for the trademark bar in the United States to start planning for membership in Madrid.⁸⁶

Fourteen years later, in 2003, the United States finally became a party to the Protocol, completing a journey that had begun in 1887, finally making it possible for U.S. applicants to take advantage of Madrid’s international filing mechanism based on an application filed in the United States. The harmonization is not complete however, since U.S. applicants must submit proof of use before they can obtain a trademark registration, while foreign applicants are granted registrations under the *telle quelle* exception. The practical result is that international registrations by U.S. applicants must be limited to a narrowly drawn list of specific goods or services while foreign applicants can obtain and maintain broader registrations, subject only to the risk of cancellation proceedings by third parties if they fail to commence use within three years or cancellation, in whole or in part, by the USPTO if they have not commenced use on all of the goods after six years.

IV. Conclusion

Looking back on the past quarter century of copyright and trademark law in the United States, we can perceive a dramatic conclusion to a journey that began 125 years ago. As increasing legal divergence led to its economic isolation, the United States first sought to bend the developing regime of international intellectual property law toward a compromise standard. In the end, however, these efforts did not establish new standards but rather allowed the United

⁸³ The United Kingdom, Ireland, Denmark and Greece have not joined the Madrid Agreement.

⁸⁴ See *Samuels Address*, supra note 69.

⁸⁵ Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, signed at Madrid, June 28, 1989, Multilateral Treaties, Text 3-007, pages 001-011, Industrial Property, July/August 1989 (World Intellectual Property Organization).

⁸⁶ See *Samuels Address*, supra note 69.

States to traverse most of the distance between its laws and those of Europe at a more comfortable pace.