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Anti-Counterfeiting Trade Agreement

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Thomas Dreier
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The New Swiss Patent Litigation System

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Abstract: Switzerland is about to implement a completely new patent litigation system, following the establishment of a new specialized federal patent trial court and the replacement of twenty-six cantonal codes of civil procedure with a single uniform federal code of civil procedure. This article pro-

vides an overview of the general structure and the most important features of the new patent litigation system that may be of interest to international patent litigants and litigators.

Keywords: Patents; Litigation; Switzerland; Patent Court; Specialized Courts; Preliminary Injunctions; Provisional Measures; Civil Procedure; Expert Opinions; Jurisdiction; Remedies; Descriptive Seizure; Saisie Helvétique; Zurich Route

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A. Introduction

- 1 As of 2012, for the first time in history, patent litigation in Switzerland will be governed by a single set of procedural rules applied by a single first instance patent court with nationwide jurisdiction over virtually all civil patent matters.
- 2 While substantive patent law has been uniform federal law since the enactment of the first Swiss Patent Act in 1888, the new federal patent litigation system constitutes a fundamental shift in procedure compared to the previous system that was based on the federalist idea of having twenty-six different non-specialist cantonal courts adjudicate an estimated combined average of thirty patent cases a year¹ on the basis of twenty-six remarkably different cantonal codes of civil procedure.² Most courts, with the exception perhaps of the four cantonal commercial courts,³ simply did not have a sufficient caseload to develop any patent expertise.
- 3 This state of affairs opened the system up to the strategic use and abuse of forum shopping by potential defendants, who could file preemptive declaratory judgment actions in notoriously inexperienced courts in order to delay the judicial resolution of conflicts or in order to avoid litigation in more experienced and faster courts, either elsewhere in Switzerland or abroad, most notably in Germany.⁴ Moreover, many judges who were actually assigned patent cases had a hard time grappling with the issues and were all too often tempted to defer their judgment to the opinion of court-appointed experts in technical and sometimes, as troublesome as it is, even in legal matters.⁵ In addition, any factual errors on the trial level could not (and cannot) be remedied on appeal to the Swiss Supreme Court, which is the second and final instance in patent and other intellectual property cases, because Supreme Court review is, in principle, limited to legal issues only.⁶ This further increases the importance of improving trial-level judicial expertise in patents.⁷

- 4 Although only now being implemented, neither the idea of a federal code of civil procedure nor the idea of specialized courts in the field of intellectual property law is new for Switzerland. In fact, proposals for specialized nationwide intellectual property courts go back as far as 1906.⁸ The specific idea of establishing a federal patent trial court was further discussed in the context of patent reform beginning in the 1940s,⁹ but was subsequently dropped over concerns about its constitutionality in view of cantonal sovereignty in matters of civil procedure and court organization.¹⁰ The adoption of a new Swiss Constitution in 2000 and the following constitutional reform of the federal judiciary¹¹ paved the way for both the creation of new first instance federal trial courts and the enactment of a uniform federal code of civil procedure, leaving only the organization of cantonal court systems to the limited discretion of the cantons.¹² On the basis of this revised constitutional framework, the new federal Code of Civil Procedure (*Zivilprozessordnung*)¹³ was adopted in 2008 and entered into force on January 1, 2011, along with the revised Lugano Convention on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters.¹⁴
- 5 Parallel to the work on unifying the law of civil procedure, the Swiss government, supported by parliamentary initiatives and by Swiss business and intellectual property lawyers' associations, prepared a draft statute on a specialized federal first instance patent court whose slightly amended final version was adopted by parliament in 2009. The court, established by the new Act on the Federal Patent Court (*Patentgerichtsgesetz*),¹⁵ was originally planned to become operative along with the entry into force of the new Code of Civil Procedure on January 1, 2011. However, while the provisions necessary for the election of the federal patent judges entered into force as planned on March 1, 2010, and although the patent judges have since been elected as planned, the starting date of the Federal Patent Court had to be postponed for organizational reasons. It is currently expected that the Court will begin its work on January 1, 2012.
- 6 Along with the Patent Court comes a new statute governing patent agents who are customarily referred to as patent attorneys (*Patentanwälte*) in Europe, even though they typically do not have law degrees. In Switzerland, patent attorneys may advise clients in patent matters and represent them before administrative bodies such as the Swiss Federal Institute of Intellectual Property (the Swiss Patent and Trademark Office), but they are generally not allowed to professionally represent clients before courts, unless they are also fully qualified lawyers and members of a Swiss bar. In Europe, law degrees are first university degrees rather than professional degrees (as is the case in the United States), and it is quite rare for someone to possess both a university degree in law and in the hard sciences, because the investment of time necessary to acquire both degrees is often excessive, given that the European educational system is not designed to support dual majors. Prior to the enactment of the new Act on Patent Attorneys (*Patentanwaltsgesetz*),¹⁶ which is currently planned to enter into force on July 1, 2011, there were no specific rules governing the profession of patent agents or the use of the title "patent attorney" in Switzerland. This will be changed by implementing a system that limits the use of the professional title "patent attorney" to those who (i) have a recognized degree in the natural sciences or engineering, (ii) have passed a Swiss or recognized foreign patent attorney exam, (iii) have a minimum of three to four years of practical experience, and (iv) are registered with the Swiss Federal Institute of Intellectual Property.¹⁷ This change is relevant to future patent litigation in Switzerland, because registered patent attorneys will be allowed to represent clients before the Federal Patent Court in cases regarding patent validity and will also be given the opportunity to be heard with regard to the technical aspects of the facts of a case in all hearings before the Federal Patent Court.¹⁸ As a result, professional representation before the Federal Patent Court will not be exclusively reserved to legally trained attorneys, although it is clear that the current practice of using teams consisting of both legally trained attorneys and patent attorneys will be continued.
- 7 The following is an overview of the new Swiss patent litigation system, consisting of a review of the structure and organization of the Patent Court, an analysis of selected procedural aspects, and a short conclusion.¹⁹

B. The New Swiss Federal Patent Court

I. Background

- 8 Despite the obvious shortcomings associated with a highly fragmented patent litigation system of the kind described above, it was not necessarily clear at the outset that the urgency of creating a nationwide patent court on the trial level could easily be conveyed to decision-makers in the political process, especially in view of the general availability of Supreme Court review of issues of law in patent matters and given the relatively low number of patent cases tried in Switzerland.
- 9 First, the Swiss patent litigation system differs significantly from systems practiced in other countries in that it consists of two levels only, namely one trial level and one appellate level. Prior to the creation of the Federal Patent Court, patent cases were tried

before one of the twenty-six cantonal trial courts²⁰ whose decisions are subject to appellate review by the Supreme Court as a matter of right without exception.²¹ In other words, unlike in Germany or in the United States, the Swiss Supreme Court had to hear any and all appeals of patent cases from the cantonal trial courts. While Supreme Court review is generally limited to issues of law, this system still guaranteed the uniformity of patent jurisprudence no matter how differently the Patent Act was applied on the trial level. As a result, the purpose of replacing twenty-six cantonal trial courts with a single federal patent court is not so much to create uniformity in the adjudication of patent cases,²² but rather to professionalize the handling of patent matters on the trial level in order to make Switzerland more attractive as a venue for international patent litigation.²³ This was a harder sell politically, because there are other areas of law with higher caseloads that might benefit from a professionalized judiciary as well.

- 10 Second, limiting the new court's jurisdiction to patent law, to the exclusion of other fields of intellectual property, inevitably reduces the number of relevant proceedings to be tried before the court, leaving it with a fairly generous current estimate of thirty patent cases annually.²⁴ The need for establishing a separate court for a comparatively low number of cases was also not necessarily self-evident, especially because most of the problems that plagued the previous patent trial system, such as the legal and technical complexity of cases, the dependence on court-appointed experts, the lack of judicial expertise in view of a low volume of relevant cases, the sometimes excessive duration of court proceedings, and the lack of *de novo* appellate review of findings of fact²⁵ are not limited to patent cases.²⁶ The same concern exists in other areas, for example, in software copyright or antitrust cases.²⁷ However, within the Ministry of Justice, which was in charge of drafting the Act on the Federal Patent Court, it appears that the Justice Department's typically Swiss federalist concerns ultimately prevailed over the Federal Institute of Intellectual Property's originally more encompassing views on the scope of jurisdiction of the Court.²⁸ Interestingly, it turned out that restricting the jurisdiction of the new court to patent matters enhanced its chances of political success, given that it was easier to finance and that most cantonal courts were quite happy to give up their jurisdiction over patent cases, while they were less inclined to do so in other fields of intellectual property law.
- 11 Against this background, the factor that likely tipped the balance in favor of the establishment of the Federal Patent Court was the concomitant movement towards a unified patent litigation system on the European level,²⁹ whose implementation would also be relevant to Switzerland as a signatory of the European Patent Convention. At the time the Federal Patent Court was conceived, the project of a common

European patent judiciary was once again gaining strong political support and a breakthrough seemed imminent. Both the now defunct draft European Patent Litigation Agreement (EPLA),³⁰ under the umbrella of the European Patent Organization, and the most recent proposals with regard to the creation of a European and European Union Patents Court (EE-UPC) on the basis of an international agreement³¹ would enable the establishment of decentralized regional chambers as part of a unified European patent judiciary. It was clear to the Swiss government that if Switzerland wanted to play any role in the future of patent litigation in Europe, be it as a preferred forum of choice or as a seat for a regional chamber within the framework of a future European system (for example in conjunction with Austria and Liechtenstein), it could not credibly do so without the track record and the expertise that only a specialized national patent trial court can provide.³²

II. Court Structure and Organization

- 12 With a view towards keeping costs low, the Court will share infrastructure and administrative personnel with the Federal Administrative Court.³³ It will be financed by court fees and part of the yearly patent fees collected by Swiss Federal Institute of Intellectual Property.³⁴ The Court will generally hold its hearings at the location of the Federal Administrative Court,³⁵ which will move from Bern to St. Gallen in 2012. This is unfortunate given Bern's central location within Switzerland, but the Patent Court is also entitled to hold hearings at a different location if the case so requires and may use the infrastructure of cantonal courts for this purpose free of charge.³⁶
1. Selection of Judges
- 13 In order to address the shortcomings of the previous system, the Federal Patent Court will consist of both legally and technically trained judges, all of whom must have a demonstrated knowledge of patent law.³⁷ Aside from the legal expertise of the judges, however, a significant factor in measuring the future success of the Federal Patent Court will be the average duration of the proceedings, which in part depends on the degree to which it will be necessary to rely on court-appointed experts. Since maximizing the substitution of outside experts with technical judges requires a sufficiently large pool of technical judges in all relevant technical fields and ideally in all official Swiss languages (in particular German, French, and Italian),³⁸ the parliament has elected 21 technical judges³⁹ to supplement the 12 elected legally trained judges. This may seem like overkill at first sight given the estimated annual load of thirty patent cases, but only two judges are full members of the Federal Patent Court, while all other judges hold

outside jobs and will only act as judges on a case-by-case basis. Moreover, only one of the two full members of the Court, namely the legally trained President of the Court (the Chief Judge),⁴⁰ will work full time, while the second full member, a technically trained judge,⁴¹ will dedicate half of his time to extra-judicial activities. All patent judges are elected for a term of six years and may be re-elected.⁴²

- 14 Because the court will rely on a relatively large pool of judges and on a high number of part-time judges and because patent expertise is needed, special measures were taken in organizing the election of the judges to the Court.⁴³ The Committee on Courts, a parliamentary body that formally proposes all judicial candidates for what is generally a rubber stamp election by the Swiss Parliament, normally considers political party affiliation when nominating candidates. This political litmus test rules out the majority of highly qualified potential candidates for the positions to be filled. However, in the case of the Federal Patent Court, an exception was made and party affiliation was not taken into account, because the Committee simply could not afford to deter any qualified candidates with patent expertise if it did not want to run the risk of not having enough viable candidates. As an additional quality assurance mechanism, the Committee on Courts was statutorily authorized to consult with the Swiss Federal Institute of Intellectual Property, professional associations active in the patent field, and other interested parties during the selection process.⁴⁴ Not surprisingly, the Committee made ample use of this rather exceptional statutory authorization,⁴⁵ and the Swiss Parliament elected all of the judges proposed by the Committee on Courts on June 16, 2010.
- 15 Regarding ethical concerns, while the two full members of the Federal Patent Court will not be allowed to professionally represent third parties in court proceedings at all,⁴⁶ the same prohibition does not apply to the rest of the judges, many of whom will continue to pursue their jobs as attorneys and patent attorneys and who are also likely to continue to represent clients before the Federal Patent Court in the future. This comparatively generous rule was deemed necessary in order to attract qualified judges, but it raises legitimate concerns about conflicts of interest and impartiality. In order to alleviate these concerns, in addition to the general grounds for recusal established by the new Code of Civil Procedure,⁴⁷ patent judges must recuse themselves not only if they have a personal interest or stake in a particular proceeding,⁴⁸ but also if another person working for the same firm or the same employer represents a client before the Federal Patent Court.⁴⁹ Moreover, following Supreme Court precedent, a patent judge will have to recuse himself or herself in cases that give rise to the same legal issues as the ones at stake in a pending case in which the judge acts as a party representative, at least if the decision in which the

patent judge participates as a judge has a precedential effect on the pending case the judge handles as a party representative.⁵⁰ The problem of potential conflicts of interest inevitably associated with a court system relying on part-time judges is an additional reason why it was necessary to have a large pool of judges on the Federal Patent Court.

2. Composition of Panels

- 16 Cases before the Federal Patent Court will typically be heard by panels of three judges.⁵¹ If the development of the law or the uniformity of the case law so requires, the President of the Court may order that a case be decided by a panel of five judges instead,⁵² which will likely be the standard during the beginning phase in order to establish a solid body of case law and to train some of the patent judges without previous judicial experience. In cases that involve multiple technical fields, the President of the Court may even order that a case be tried before a panel consisting of up to seven judges.⁵³
- 17 All panels must consist of a mix of legally and technically trained judges, whereas technical judges are selected on the basis of the technical field relevant to the case at hand.⁵⁴ It is further required that each panel include a full member of the Court.⁵⁵ The details of case distribution and the composition of the panels are subject to internal regulations to be determined by the court management consisting of the two full members and an additional member of the Court.⁵⁶ The underlying idea of this system is that each panel will be tailored to the individual case to be decided, while still maintaining institutional knowledge and continuity due to the mandatory participation of one of the two full members of the Court in each case.
- 18 Not all decisions relevant to a pending case must be taken by panels. Most importantly, requests for provisional measures such as preliminary injunctions are generally decided by the President of the Court alone.⁵⁷ However, if required by legal or technical circumstances, the President of the Court *may* order that the decision be made by a panel of three judges, and if the understanding of the technical background of the case is of particular importance to the decision on provisional measures, the decision *must* be made by a panel of three judges.⁵⁸ In addition to requests for provisional measures, the President of the Court decides (i) about the dismissal of actions that are obviously inadmissible, (ii) about requests for the waiver of court fees, (iii) about the formal disposition of pending actions in case of mootness, withdrawal, acknowledgement, or settlement, and (iv) about actions regarding the granting of compulsory licenses for the purposes of production of a pharmaceutical product and its export to eligible importing countries.⁵⁹ Note, however, that the applica-

ble rules provide that some or all of these decisions may be delegated by the President of the Court to another legally trained member of the Federal Patent Court.⁶⁰

3. Law Clerks and Publication of Opinions

- 19 Law clerks generally play a comparatively important role in Swiss courts, because they not only prepare draft materials such as bench memoranda for the judges assigned to a particular case, but they also participate in internal judicial deliberations (without casting a vote) and actually draft the opinions of the court. The Federal Patent Court will be no exception to this rule,⁶¹ which is why the selection of adequately trained law clerks by the court management⁶² is important in ensuring the quality of the case law available to those who are not parties to the proceedings and who are left to read the written opinions generated by the Federal Patent Court.
- 20 The Court is required to inform the public about its opinions,⁶³ and it is likely that it will do so by publishing them on the Internet, which is important if the Court wants to avoid the impression of generating insider knowledge in favor of attorneys and patent attorneys who happen to be part-time judges at the expense of those who are not. Judging from the Swiss government's administrative statement,⁶⁴ the public can be hopeful that the Federal Patent Court will not engage in the often unjustified practice of anonymizing its published written opinions, which is still the norm today, even in intellectual property and other commercial law cases. This would greatly enhance transparency for all involved in patent litigation and patent law research, as opposed to the current practice in which courts typically (i) try to hide the ball by deleting patent numbers, party names, and product names from the opinions they release to the public and (ii) make those requesting copies of unpublished opinions pay a fee for having them anonymized.

III. Subject Matter Jurisdiction

- 21 The subject matter jurisdiction of the Federal Patent Court is limited to *civil* patent matters, that is, disputes between private litigants with regard to Swiss patents, European patents granted under the European Patent Convention and effective in Switzerland, and national supplementary protection certificates.⁶⁵ Moreover, the Federal Patent Court may also adjudicate disputes with regard to foreign patents, foreign parts of European patents, or foreign supplementary protection certificates, always provided that the Federal Patent Court has international jurisdiction under the applicable rules of international civil procedure.⁶⁶

- 22 By contrast, the jurisdiction of the Federal Patent Court does not extend to the adjudication of *criminal* patent infringement nor does it include *administrative* patent matters. Therefore, contrary to patent courts in other countries, the Swiss Federal Patent Court will not have any jurisdiction over appeals from the Federal Institute of Intellectual Property in patent prosecution matters or in proceedings regarding the granting of supplementary protection certificates, because these appeals will continue to be heard by the Federal Administrative Court,⁶⁷ subject to further review for legal error by the Swiss Supreme Court.⁶⁸

1. Non-Patent Intellectual Property Cases

- 23 Due to the complex jurisdictional interrelationship between the Federal Patent Court and the cantonal court systems to be discussed further below, the subject matter jurisdiction of the Federal Patent Court in civil patent matters must be viewed against the backdrop of the general system of jurisdiction for intellectual property matters in Switzerland.
- 24 Under the new Code of Civil Procedure, the basic principle remains that each of the twenty-six cantons must designate a "sole cantonal instance court" for the adjudication of all civil intellectual property matters.⁶⁹ This sole cantonal instance court may be a commercial court, where such courts exist.⁷⁰ Compared to the old system, the exclusive subject matter jurisdiction of these twenty-six cantonal courts has been significantly expanded to include all disputes in connection with intellectual property law, including issues of infringement, validity, ownership, assignment, and licensing,⁷¹ subject only to the exclusive jurisdiction of the Federal Patent Court (see Section 2 below).⁷² Moreover, the sole cantonal instance courts now also have exclusive jurisdiction over disputes relating to antitrust law, the law of company names, and – if the amount in controversy exceeds CHF 30'000 or if the plaintiff is the federal government – the law of unfair competition.⁷³ In addition, these sole cantonal instance courts also have exclusive jurisdiction with regard to provisional measures prior to the pendency of a lawsuit in these matters,⁷⁴ which is a major improvement compared to the previous system under which the cantons were free to have different courts for proceedings on the merits and proceedings regarding provisional measures.
- 25 The question of which of the twenty-six sole cantonal instance courts can be chosen by the plaintiff to hear a particular intellectual property case is a matter of territorial jurisdiction under the applicable rules of the Code of Civil Procedure,⁷⁵ the Code of International Private Law,⁷⁶ and/or the Lugano Convention on Jurisdiction and the Recognition and Enforcement of Judgments in Civil and Commercial Matters.⁷⁷

2. Exclusive and Concurrent Jurisdiction

- 26 A key feature of the new Federal Patent Court is that its subject matter jurisdiction in civil patent matters is in part exclusive and in part concurrent with the jurisdiction of the twenty-six sole cantonal instance courts.⁷⁸
- 27 The Federal Patent Court has *exclusive* nationwide jurisdiction⁷⁹ with regard to (i) infringement actions, including actions for declaratory judgment of non-infringement, (ii) invalidity or nullity actions, including actions for declaratory judgment of patent validity, (iii) actions requesting the granting of compulsory patent licenses, and (iv) requests for provisional measures relating to any of these three types of actions if requested prior to their pendency.⁸⁰ Contrary to the German system, there is and will be no bifurcation between validity and infringement proceedings in Switzerland.
- 28 By contrast, the Federal Patent Court and the sole cantonal instance courts have *concurrent* jurisdiction regarding civil actions that are closely related to patents or supplementary protection certificates, in particular disputes about ownership, assignment, and licensing,⁸¹ and also regarding controversies involving contractual issues relating to patents or inventions that may arise in the context of research and development agreements or consulting agreements if the services rendered under such agreements include inventive activities. In all of these cases of concurrent jurisdiction, the plaintiff may chose to file his or her actions *either* with the Federal Patent Court *or* with one of the sole cantonal instance courts (provided that the cantonal court of choice has territorial jurisdiction).⁸²
- 29 The rationale underlying this system of subject matter jurisdiction is that the Federal Patent Court's technical expertise may not be needed in patent disputes that are not about validity, infringement, or the scope of compulsory licenses. While it is generally left to the plaintiff to make that call, the Swiss legislature recognized that technical expertise may well be necessary depending upon the arguments put forward by the defendant, for example, if an action for payment of outstanding patent licensing fees brought before a cantonal court is countered with the argument that the licensed patent is invalid or that the product sold by the defendant is not covered by the licensed patent.⁸³ In order not to leave the adjudication of these defenses to the cantonal courts in a system of concurrent jurisdiction, the Swiss legislature devised a fairly complex procedural mechanism for transferring all or part of a case properly filed with a cantonal court to the Federal Patent Court depending upon the defendant's reaction to the lawsuit in question.
- 30 There are two possible courses of action once a lawsuit that falls within the scope of concurrent jurisdiction is filed with one of the twenty-six cantonal courts rather than the Federal Patent Court. If the defendant reacts by filing a *counterclaim* for invalidity or infringement with the cantonal court, the cantonal court will have to transfer both the original action and the counterclaim to the Federal Patent Court for exclusive adjudication.⁸⁴ By contrast, if invalidity or non-infringement is merely pleaded as a *defense* or if questions of validity or infringement arise as *preliminary questions* relevant to the resolution of the plaintiff's action, the cantonal court will not permanently transfer the case to the Federal Patent Court but will instead set a deadline for the defendant to file an invalidity or infringement action with the Federal Patent Court and will continue its proceedings only after a final judgment⁸⁵ has been handed down by the Federal Patent Court on the issue of invalidity or infringement.⁸⁶ If the defendant fails to file such action with the Federal Patent Court by the deadline set by the cantonal court, the cantonal court will continue its proceedings on the plaintiff's action and disregard any defense or preliminary question regarding validity or infringement.⁸⁷
- 31 This rather complicated mechanism⁸⁸ could have been avoided if the Federal Patent Court had been given exclusive jurisdiction over all actions relating to patents and supplementary protection certificates⁸⁹ or if the permanent transfer rule regarding counterclaims had also been applied to defenses or preliminary questions.⁹⁰ Instead, the system chosen was undoubtedly inspired by the "Zurich Route", developed by the Zurich Commercial Court in response to the European Court of Justice's unfortunate judgment in *GAT v. LuK*.⁹¹ In essence, the Zurich Commercial Court, faced with a request for cross-border injunctive relief on the basis of two Community trademarks and a defense of invalidity, concluded that it did not have international jurisdiction to rule on the issue of validity under *GAT v. LuK*⁹² and decided to suspend its proceedings and set a deadline for the defendant to initiate nullity proceedings with a competent European court, indicating that it would disregard the invalidity defense if no action was filed and that it would keep the proceedings suspended until the final resolution of the question of invalidity by a competent European court if such action was filed within the deadline.⁹³
- 32 The obvious problem with the Zurich Route now codified by the Act on the Federal Patent Court is that, if taken at face value, the defendant will be forced to file an action before the Federal Patent Court even though the defendant chose not to take the counterclaim route, but instead to invoke the issues of validity or infringement as a mere defense *inter partes*. Whether the Federal Patent Court will follow thoughtful suggestions in legal scholarship⁹⁴ on how

to exert its jurisdiction while avoiding the potentially significant procedural and substantive ramifications of requiring the filing of a counterclaim⁹⁵ remains to be seen.

3. The Patent/Other IP Intersection

33 A potential drawback⁹⁶ of the establishment of a specialized patent court as opposed to a court with subject matter jurisdiction over all intellectual property cases is that patent validity or infringement actions cannot be joined with actions based on other intellectual property rights or based on a claim of unfair competition or antitrust law, because under the general rules of civil procedure the joining of actions requires the same court to have jurisdiction over all actions.⁹⁷ Therefore, an action relating to patent law may only be combined with other intellectual property, unfair competition, or antitrust claims against the same defendant if the Federal Patent Court does not have jurisdiction, namely if the patent side of the dispute does not involve issues of infringement or validity, in which case one of the twenty-six sole cantonal instance courts may hear all the actions in one proceeding.

34 It has been pointed out in the legal literature⁹⁸ that the strict jurisdictional separation between patent matters and other intellectual property matters does not apply to counterclaims under the general rules of civil procedure because, if read literally, they do not require a court to have subject matter jurisdiction over a counterclaim in order to adjudicate it, provided that both the main action and the counterclaim are subject to the same type of proceedings.⁹⁹ In other words, if a patent infringement action were filed with the Federal Patent Court, the Court would also have jurisdiction to decide non-patent counterclaims, such as a counterclaim for copyright or trademark infringement. Whatever the merits of a specialized patent court are and however much one may have preferred to have an intellectual property court instead, it makes little sense to have technically trained judges without adequate legal training outside patent law participate in deciding copyright, trademark, design, unfair competition, or antitrust counterclaims. There is also no meaningful analogy to the Swiss commercial courts, even though these courts also consist of mixes of legally trained judges and lay judges, because the latter typically represent different fields of trade and business and are generally assigned to individual cases on the basis of their relevant industry expertise.¹⁰⁰ While a banker participating in a lawsuit involving banks may well add value to the decision-making process, it is somewhat difficult to imagine that to be the case if a chemist participates in the adjudication of a software copyright claim. After all, the Federal Patent Court is purposely designed to address specific problems that arise in patent litigation, and the composition

of the panels is tailored to the particular technical needs of the individual case at hand. If the idea underlying the limited jurisdiction of the Federal Patent Court is that its jurisdiction ought to be limited to patents, because this is where the participation of technical judges is beneficial, then there is no reason to deviate from this principle in the context of non-patent counterclaims before the Federal Patent Court. These points should be taken into consideration when interpreting the general rules of civil procedure on counterclaims, which means that the Federal Patent Court should find that non-patent counterclaims fall outside the scope of its subject matter jurisdiction.

35 Conversely, if a plaintiff files a trademark infringement claim before a sole cantonal instance court, for example, and the defendant subsequently files a counterclaim for patent infringement, the sole cantonal instance court should *not*, as suggested by other authors,¹⁰¹ transfer *both* actions to the Federal Patent Court, but instead deny jurisdiction for the patent counterclaim and proceed with the main trademark claim, as inefficient as this may seem. As is clear from the context of the relevant provision, the transfer rules contained in the Act on the Federal Patent Court¹⁰² only apply to cases of concurrent jurisdiction under the same Act,¹⁰³ that is, to cases in which the main action is an action relating to *patents* rather than to intellectual property rights in general.¹⁰⁴ By contrast, if a patent counterclaim before a sole cantonal instance court does not involve issues of infringement or validity, the cantonal court may hear *both* actions on the basis of its concurrent jurisdiction over patent matters.¹⁰⁵

4. Transitional Rules

36 The transitional rules of the Act on the Federal Patent Court are an additional source of uncertainty. As a general matter, the rule is that cases pending before cantonal courts will be transferred to the Federal Patent Court upon its coming into existence, provided that the “main hearing” has not yet taken place.¹⁰⁶ Aside from the fact that a number of cantonal codes of civil procedure did not provide for a main hearing in the sense of the new federal rules on civil procedure,¹⁰⁷ the statute is unclear about (i) who will decide about the transfer of a pending case, (ii) whether the Federal Patent Court, if the case is transferred, will have to continue to apply the various pre-existing cantonal procedural laws,¹⁰⁸ and (iii) whether a transfer is only possible if the case falls within the exclusive rather than the concurrent jurisdiction of the Federal Patent Court. Moreover, it is uncertain whether the parties will be able to conclude binding and enforceable agreements with regard to the issues of transfer and the applicable procedural law. Perhaps the most troublesome development for litigants is that this transfer provi-

sion seems to have led a number of cantonal courts to stall the patent cases currently pending before them in order not to advance the case beyond the point of transfer to the Federal Patent Court. It remains to be seen how the transitional provisions will be handled by the courts.

C. Selected Procedural Aspects

37 As a general matter, the proceedings before the Federal Patent Court are governed by the new federal Code of Civil Procedure, except where the Act on the Federal Patent Court or the Patent Act contain specific rules deviating from those prescribed by the Code of Civil Procedure.¹⁰⁹ In the following, I will highlight a few special procedural points regarding the proceedings on the merits and provisional measures.

I. Proceedings on the Merits

1. General Rules

38 Proceedings on the merits in patent cases are initiated like in any other civil case, namely by the plaintiff's filing of a court action¹¹⁰ by submitting a brief containing the names of the parties and their representatives, the requests for relief, the amount in controversy, the statement of facts, the identification of the pieces of evidence supporting the statement of facts, and the date and signatures.¹¹¹ Statements as to the law are not required,¹¹² but are virtually always included in the brief in a section following the statement of facts. Upon receipt, the court will forward the plaintiff's brief to the defendant and set a deadline for the filing of a response brief, which will again be forwarded to the plaintiff upon receipt.¹¹³

39 If necessary under the circumstances, which is often the case in patent matters,¹¹⁴ the court may order the exchange of further briefs,¹¹⁵ that is, a reply by the plaintiff followed by a rejoinder by the defendant. In terms of case management, the court may, at any time, hold hearings to discuss the case, learn more about the facts, attempt to settle, take evidence, or prepare the main hearing.¹¹⁶ It was standard court practice, at least at the Zurich Commercial Court, that a hearing was held after the first round of briefs in which a member of the court gave a preliminary assessment of the case and tried to get the parties to settle early on. It is likely that the Federal Patent Court will adopt a similar case management strategy, given its considerable success rate in practice and given that the new President of the Court previously sat on the Zurich Commercial Court. Note that there are no jury trials in civil matters in Switzerland and that courts are generally bound by the

facts and requests for relief submitted by the parties without having the power to investigate the facts on their own or to go beyond any party requests in adjudicating a civil case, which is particularly important in validity proceedings.¹¹⁷

40 Following the briefing phase and, if necessary, the phase of taking evidence, the parties will be invited for a main hearing in order to plead their case orally¹¹⁸ or to take evidence if it was not done so at a prior hearing.¹¹⁹ The parties are free to waive the main hearing if they both agree.¹²⁰ After the main hearing, if any, the court will render its decision, which can then be appealed to the Swiss Supreme Court as a matter of right without regard to the amount in controversy.¹²¹ The Supreme Court reviews lower court decisions *de novo* with regard to legal issues.¹²²

2. Special Rules for the Federal Patent Court

41 In view of the flexibility of the general procedural rules outlined above, there are only three notable deviations that were deemed necessary in the context of proceedings on the merits before the Federal Patent Court.

42 First, cases will always be managed by the President of the Federal Patent Court or a legally trained judge assigned by the President¹²³ rather than by a panel of judges as provided by the default rule under the general rules on civil procedure.¹²⁴ The underlying idea is to enable flexible case management despite the large number of part-time judges who will be more difficult to coordinate efficiently than full-time judges who have no professional obligations outside their judicial duties.¹²⁵ Note that the judge in charge of case management may, at his or her discretion, consult with technically trained judges who will act as advisors without the right to vote or decide on matters of case management.¹²⁶

43 Second, being a nationwide court in a country with multiple official languages (specifically German, French, and Italian), the Federal Patent Court will have to determine the language of the proceedings in each case,¹²⁷ and it will do so by considering the language of the parties provided that it is one of the official languages.¹²⁸ Most likely, the language selection process will be regulated in more detail in the court rules that are currently being drafted. What is unusual about the language regime before the Federal Patent Court is that each party may still use a different official language in its briefs and oral presentations than the one selected by the court for the proceedings.¹²⁹ If the court and the parties agree, it is even possible to use the English language, but with a view towards potential appellate proceedings before the Supreme Court,¹³⁰ the Federal Patent

Court's opinions and orders will always have to be rendered in an official language.¹³¹ In order to reduce costs and improve efficiency, the court will only order translations when necessary. With regard to foreign language documents, the Federal Patent Court, with the consent of the opposing party,¹³² may waive the translation requirement, even if documents presented are not in one of the official languages (or in English, if English was chosen as the language of the proceedings).¹³³ The ability to present documents in English without translation is especially useful in cases involving European patents protected in Switzerland that were issued in English, but not translated into any official Swiss language.¹³⁴

- 44 Third, there is a special provision with regard to comments on the evidence in cases before the Federal Patent Court. Under the general rules of civil procedure, it is possible for evidence to be taken during the main hearing and for the parties to be required to comment on the evidence orally at the very same hearing unless both parties request that written submissions be made instead.¹³⁵ Given that the subject matter of evidence in patent matters is often complicated and highly technical, forcing the parties to comment on such evidence immediately after its presentation will hardly ever be feasible, which is why the Act on the Federal Patent Court provides that parties be given the opportunity to comment on the evidence in writing upon a reasoned request.¹³⁶

3. Technical Judges and Expert Witnesses

- 45 As explained above, one of the foundational characteristics of the new Swiss patent litigation system is the idea that the technical expertise required to resolve patent disputes should be provided by technically trained judges rather than by outside court-appointed experts, who were a major source of delay in patent proceedings under the old system.
- 46 Of course, this general shift towards internalizing technical expertise does not mean that the Federal Patent Court is not allowed to rely on court-appointed experts, but it is expected that the need for doing so will be significantly reduced by virtue of the existence of technically trained judges, who are assigned to each case on the basis of their expertise. Should outside experts nevertheless be necessary, their expert opinions must be provided in writing and the parties must also be given the opportunity to comment in writing on the expert opinions,¹³⁷ which is a deviation from the general rule that courts may order expert opinions to be rendered orally (as opposed to being submitted in writing and then being explained orally at a hearing).¹³⁸
- 47 When there is no need for outside court-appointed experts due to the expertise of technical judges, a remaining concern is to keep the infusion of expert

knowledge into the judicial process transparent. In order to guarantee adequate transparency with regard to internal technical knowledge that might influence the outcome of the proceedings, the general rules of civil procedure require the court to disclose internal expert knowledge in order for the parties to comment on it.¹³⁹ In addition, a special provision requires the Federal Patent Court to take minutes of expert statements by technically trained judges and to allow the parties to comment on them.¹⁴⁰

- 48 With regard to party expert opinions (as opposed to court-appointed expert opinions), the state of affairs is rather unfortunate under Swiss law, because party expert opinions will likely not be admissible into evidence,¹⁴¹ as difficult as it may be in practice to rebut an opinion by a court-appointed expert without being allowed to submit a party expert opinion. It remains to be seen whether cutting and pasting a party expert opinion into a party brief and then offering the party expert as an expert witness to corroborate the technical allegations in the brief¹⁴² will be a viable workaround.

II. Provisional Measures

- 49 In most patent cases, the proceedings on the merits described above will be preceded or at least accompanied by motions for provisional measures, in particular for preliminary injunctions. In this regard, the new Swiss patent litigation system creates a beneficial set of uniform general rules and introduces new devices for the pretrial taking of evidence.¹⁴³

1. General Rules

- 50 As a general matter, courts will order the provisional measures they deem necessary if the moving party shows the likely existence (i) of an actual or impending act of infringement of its legal rights and (ii) of irreparable harm resulting from such infringement if a provisional measure is not granted.¹⁴⁴ Under the general rules of civil procedure, courts may order any provisional measure suitable to avoid the irreparable harm in question,¹⁴⁵ and the intellectual property statutes specify that these provisional measures may, *inter alia*, consist of orders securing evidence, orders aimed at determining the origin of goods violating intellectual property rights, orders conserving the status quo, and – most importantly – preliminary injunctions or seizure orders.¹⁴⁶ In proceedings before the Federal Patent Court, the default rule is that motions for provisional measures before and during the pendency of a patent action will not be decided by the panel of judges to whom a particular case has been or will be assigned, but rather by the President of the Court or a legally trained judge selected by the President.¹⁴⁷ However, if prompted by particular le-

gal or technical circumstances, the judge in charge may ask for two additional judges to join him or her in deciding the motion for provisional measures in question as a three-judge panel.¹⁴⁸ Moreover, if the understanding of the technical facts is particularly important for the decision on provisional measures, the motion in question *must* be decided by a three-judge panel.¹⁴⁹

51 Generally, the adverse party will be given the opportunity to be heard prior to any ruling on motions for provisional measures, always provided that the motion in question is not obviously inadmissible or obviously unfounded, in which case it would be dismissed or denied without first hearing the adverse party.¹⁵⁰ However, in cases of particular urgency, provisional measures may be ordered without prior notice to the adverse party (*ex parte* orders).¹⁵¹ This will typically be done only if immediate and irreparable harm will result to the moving party before the adverse party can be heard in opposition. If so, a hearing must be held without delay, or the adverse party must be given the opportunity to comment in writing on the motion, before a decision is made on whether to grant the motion and uphold any *ex parte* provisional measures pending the outcome of the proceedings on the merits.¹⁵² If no patent action is pending at the time the motion for provisional measures is granted, the moving party must file such patent action before the deadline set by the judge; failure to do so will result in the automatic lifting of the provisional measure.¹⁵³ The granting of motions for provisional measures may be conditioned on the moving party's giving of security if the adverse party may suffer any damage as a result of a provisional measure, and the moving party is liable for any damages caused by wrongfully ordered provisional measures, although the compensation of damages may be reduced or waived if the moving party proves that its motion was made in good faith.¹⁵⁴ Provisional measures issued by the Federal Patent Court may be appealed to the Swiss Supreme Court, but review is limited to the violation of constitutional rights.¹⁵⁵ Note, however, that provisional measures may be modified or lifted at any time if the circumstances change or if they turn out to be unjustified.¹⁵⁶

52 Given the significant ramifications of *ex parte* orders of provisional measures for the party affected by them, the general rules of civil procedure have codified a defense mechanism developed in practice in order to reduce the information deficit judges may have when ruling on motions for *ex parte* orders. Any party which has reason to believe that a motion for an *ex parte* order of provisional measures may be filed against it is entitled to the preemptive filing of a protective brief containing its views on the matter in dispute.¹⁵⁷ In order not to provide the other party with a checklist for the filing of its motion for provisional measures, protective briefs will only be dis-

closed to the other party if that party actually files a request for an *ex parte* order.¹⁵⁸ Protective briefs older than six months will be disregarded.¹⁵⁹ While it was possible to file protective briefs with some cantonal courts prior to the establishment of the new patent litigation system,¹⁶⁰ that mechanism was not as frequently used in patent practice as one might imagine, in part because the fragmentation of jurisdiction and the availability of forum shopping made it difficult to predict which court would ultimately have jurisdiction. This may well change in the future given the Federal Patent Court's nationwide jurisdiction,¹⁶¹ provided that the Court's approach to granting *ex parte* orders for provisional measures is not as restrictive as it traditionally has been in Switzerland.

2. Pretrial Taking of Evidence

53 The establishment of new procedural avenues to obtain evidence prior to the filing of a court action brings about significant changes both in Swiss civil procedure in general and in patent matters in particular.¹⁶²

54 While there is no common law style pretrial discovery in Switzerland, it has always been possible to file pretrial motions for provisional measures regarding the securing of evidence, including the precise description of allegedly infringing processes or products, but such motions have only been granted when the moving party could show both the likely existence of an actual or impending violation of a legal right and the likely unavailability of a particular piece of evidence unless it be provisionally secured. However, this procedural device could not be used to obtain evidence for the purpose of assessing the merits of a case prior to filing a court action, which made patent litigation a risky business in a loser-pays system where patent holders were unable to obtain evidence to verify the existence of potentially infringing acts. This was particularly true in cases involving process patents.¹⁶³ Both the new Code of Civil Procedure and a provision in the Patent Act newly amended by the Act on the Federal Patent Court mitigate the problem of imperfect information and lack of evidence during the pretrial phase.

55 More specifically, under the new general rules of civil procedure, it is possible to have a court take evidence as a provisional measure at any time prior to the commencement of a court action not only for purposes of securing evidence upon a showing of the likely unavailability of the evidence at trial, but also upon the moving party's showing of a mere legitimate interest in the pretrial taking of evidence.¹⁶⁴ The purpose of assessing the merits of a case qualifies as a legitimate interest, if the moving party shows the likely existence of a legal claim for which the evidence to be taken may serve as proof.¹⁶⁵

56 Moreover, under the Patent Act as amended by the Act on the Federal Patent Court, the requirements for obtaining a precise description of allegedly infringing processes, products, and means of production have been further relaxed. Under the new rule that was in part modeled on the French “saisie-description” (descriptive seizure order)¹⁶⁶ and for which the term “saisie helvétique” has been adopted in the Swiss legal literature,¹⁶⁷ a moving party may request a court to order the making of a precise description solely by showing some likelihood of infringement.¹⁶⁸ In other words, while mere suspicions of patent infringement are not sufficient, all that is needed is a substantiated allegation of infringement with a certain level of evidentiary support.¹⁶⁹ By contrast, a showing of unavailability of the evidence or of specific legitimate interests justifying the pretrial taking of evidence is not required, which is a significant exception from the general rules of civil procedure. Note, however, that orders for the actual seizure (as opposed to the description) of allegedly infringing goods or of the means for producing such goods are still subject to the general requirement of a showing of irreparable harm, namely that the products or means for production are about to be sold or destroyed or modified unless they are seized prior to the commencement of any patent action.¹⁷⁰

57 Once ordered, the “saisie helvétique” is carried out by a member of the Federal Patent Court who may consult with an expert and cooperate with the cantonal authorities, in particular the police.¹⁷¹ The party requesting the description is allowed to participate in the process,¹⁷² unless the opposing party shows that business or manufacturing secrets may be disclosed as part of the description, in which case the party requesting the description may be excluded from the process. As an additional safeguard for the protection of business and manufacturing secrets,¹⁷³ the opposing party will be given the opportunity to comment on the results of the description process prior to the moving party’s gaining access to these results,¹⁷⁴ which may prompt the court to restrict access to or redact part of the results.¹⁷⁵ Aside from these statutory rules, the procedural details of the “saisie helvétique” are not yet entirely clear, and it is one of the many tasks of the Federal Patent Court to devise a workable system in this regard.

D. Conclusion

58 While the establishment of a specialized nationwide trial court for patent matters holds the promise of professionalizing the adjudication of patent cases in Switzerland, it is unclear as of yet whether international patent litigants will see the Swiss Federal Patent Court as an attractive venue for patent disputes. Much will depend on the reliability of its case dispositions and the duration of its proceed-

ings, which should not exceed twelve to eighteen months for proceedings on the merits, including two to six months for proceedings regarding provisional measures.¹⁷⁶ However, the strategy of replacing outside experts with technically trained judges alone is hardly enough to guarantee speedy trials, given that part-time judges with demanding attorney work schedules may not always be able to prioritize their judicial duties. Tight case management will be indispensable. Moreover, the flipside of having a sole nationwide patent trial court instead of several cantonal courts is that litigants will no longer be able to forum shop and will have to rely on the Federal Patent Court no matter how well it performs. It remains to be seen whether a professional patent court with a few procedural assets such as the combination of validity and infringement proceedings, the use of technical judges instead of outside experts, the availability of the remedy of precise description, and the possibility to use English as the language of the proceedings, will turn Switzerland into a prime venue for European patent litigation.

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1 Botschaft zum Patentgerichtsgesetz, BBl 2008, 455, 461.

2 Note that, much like Germany or the United States, Switzerland is a federalist country consisting of twenty-six Cantons (states) that were – with a few exceptions – relatively autonomous in matters of civil procedure and court organization until the entry into force of the new federal Code of Civil Procedure on January 1, 2011. By contrast, virtually all of Swiss private law, including all Swiss intellectual property law, has been a matter of uniform federal legislation for at least the past 100 years.

3 Commercial courts currently exist in the four Cantons of Aargau, Bern, St. Gallen, and Zurich. They typically have jurisdiction over commercial disputes between companies registered in the commercial register, and they also had exclusive cantonal jurisdiction over intellectual property matters and will continue to have such jurisdiction except in cases that will fall within the jurisdiction of the newly created Federal Patent Court.

4 See, e.g., BGE 129 III 295; see also generally Botschaft zum Patentgerichtsgesetz, BBl 2008, 455, 464.

5 See also *Weibel*, Bundespatentgericht unerwünscht, NZZ No. 106 of 9 May 2005, p. 9; *Bircher/Thouvenin*, Ein eidgenössisches Patentgericht erster Instanz, sic! 2002, 650 (reporting a statement by Martin Lutz); *Stieger*, Bundespatentgericht ante portas!, in *Festschrift für Alfred Bühler*, Zurich 2008, 179, 183.

6 The Supreme Court is generally bound by the findings of fact by the lower instance court; see Art. 105 para. 1 BGG. Therefore, a claim of erroneous fact-finding will only be heard by the Supreme Court (i) if the facts found by the lower court were either obviously wrong or based on legal error and (ii) if correcting the erroneous fact-finding may be outcome-determinative; see Art. 97 para. 1 BGG (Bundesgesetz vom 17. Juni 2005 über das Bundesgericht, SR 173.110). Note that prior to January 1, 2007, the Supreme Court had the power to review the cantonal court’s findings of fact in technical matters on the basis of Art. 67 OG (Bundesgesetz vom 16. Dezember 1943 über die Organisation der Bundesrechtspflege in der Fassung vom 1. Januar 1956), but the Supreme Court hardly ever exercised this power; see *Stieger*, Bundespatentgericht ante portas!, in *Festschrift für Alfred Bühler*, Zurich 2008, 179, 181.

- 7 Botschaft zum Patentgerichtsgesetz, BBl 2008, 455, 461; see also *Stieger*, Bundespatentgericht ante portas!, in Festschrift für Alfred Bühler, Zurich 2008, 179, 184.
- 8 See *Guyer*, Ein schweizerisches Fachgericht zur Beurteilung von Patent-, Muster-, Modell- und Marken-Prozessen, SJZ 1906/1907, 33, 46, 58; *Weiss*, Ein schweizerisches Fachgericht für Patent- u. Streitigkeiten und die Stellung des Bundesgerichts, SJZ 1906/1907, 109; *Guyer*, Ein schweizer. Fachgericht für Patent-, Muster- und Marken-Prozesse, SJZ 1906/1907, 146.
- 9 See Botschaft über die Revision des Bundesgesetzes betreffend die Erfindungspatente vom 25. April 1950, BBl 1950 I 977, 992-993; Ergänzungsbotschaft zur Vorlage über die Revision des Bundesgesetzes betreffend die Erfindungspatente vom 28. Dezember 1951, BBl 1952 I 1, 20-21.
- 10 For contemporary discussions of the various proposals, see *Troller*, Setzt die Einführung eines Schweizerischen Patentgerichtes eine Revision der Bundesverfassung voraus?, (Schw.) Mitt. 1944, 93; *Winter*, Über ein eidgenössisches Gericht für Patent-Nichtigkeitsklagen, (Schw.) Mitt. 1945, 217; *Müller*, Patentgerichtshof, (Schw.) Mitt. 1946, 27; *Giacometti*, Die Verfassungsmässigkeit des eidgenössischen Patentgerichtshofes, (Schw.) Mitt. 1946, 256; *Giacometti*, Die Verfassungsmässigkeit des eidgenössischen Patentgerichtshofes, Ergänzungsgutachten, (Schw.) Mitt. 1947, 134; *Justizabteilung*, Bemerkungen zum Ergänzungsgutachten Giacometti über die Schaffung eines schweizerischen Patentgerichtshofes, (Schw.) Mitt. 1947, 169; *Perrin*, Considération concernant une nouvelle organisation de la juridiction en matière de brevets, (Schw.) Mitt. 1948, 8; *Fritzsche*, Über die Schaffung eines eidgenössischen Patentgerichtes als separate Kammer beim Bundesgericht, (Schw.) Mitt. 1948, 15; *Brack*, Das Patentgericht, Diss. Bern 1950; *Weidlich*, Buchbesprechung Brack, GRUR 1951, 336.
- 11 For a brief English language overview of these developments, see *Rigamonti*, The New Swiss Constitution and Reform of the Federal Judiciary (May 4, 2000), <http://jurist.law.pitt.edu/world/swisscor1.htm>.
- 12 Art. 191a para. 3 BV and Art. 122 BV (Bundesverfassung der Schweizerischen Eidgenossenschaft vom 18. April 1999, SR 101 [the Swiss Constitution]); see also *Bosshard*, Le nouveau Tribunal fédéral des brevets et les juridictions cantonales, SZP 2010, 191, 192-193.
- 13 Schweizerische Zivilprozessordnung (Zivilprozessordnung, ZPO) vom 19. Dezember 2008 (SR 272), AS 2010, 1739.
- 14 Übereinkommen vom 30. Oktober 2007 über die gerichtliche Zuständigkeit und die Anerkennung und Vollstreckung von Entscheidungen in Zivil- und Handelssachen (Lugano-Übereinkommen, LugÜ) (SR 0.275.12). Note that Art. 22, no. 4 of the Lugano Convention basically codifies the widely criticized cross-border judgment of the European Court of Justice in *GAT v. LuK*, Case No. C-4/03, OJ C 224 of 16 September 2006, 1. For an analysis of this topic from a Swiss perspective, see *Hess-Blumer*, Crossborder Litigation – und sie lebt doch!, sic! 2006, 882.
- 15 Bundesgesetz über das Bundespatentgericht (Patentgerichtsgesetz, PatGG) vom 20. März 2009 (SR 173.41), AS 2010, 513. For a brief overview of the developments leading up to the enactment of this statute, see *Bosshard*, Le nouveau Tribunal fédéral des brevets et les juridictions cantonales, SZP 2010, 191, 193-194.
- 16 Bundesgesetz über die Patentanwältinnen und Patentanwälte (Patentanwaltsgesetz, PAG) vom 20. März 2009 (SR 935.81), BBl 2009, 2013.
- 17 Art. 2 PAG.
- 18 Art. 29 PatGG.
- 19 Readers should also note the availability of overviews of the new Federal Patent Court and the proceedings before it in the German and French language legal literature; see *Holzer*, Das neue Bundespatentgericht, sic! 2009, 744; *Stieger*, die Zuständigkeit der Schweizer Gerichte für Prozesse über und im Zusammenhang mit Patenten ab 2011, sic! 2010, 3; *Stieger*, Prozessieren über Immaterialgüterrechte in der Schweiz – ein Quantensprung steht bevor, GRUR Int. 2010, 574; *Bosshard*, Le nouveau Tribunal fédéral des brevets et les juridictions cantonales, SZP 2010, 191; *Legler*, Sind in Zukunft Patentstreitigkeiten in der Schweiz *de lege lata* nicht mehr schiedsfähig?, ASA Bulletin 2010, 253; *Gick-Komondy*, Schweizerische Patentgerichtsbarkeit im Vergleich mit der europäischen Entwicklung, Diss. Bern, Zurich 2010, 189-213. For views and background information on the topic prior to the adoption of the final statutory text, see also *Hilti*, Ein eidgenössisches Patentgericht (EPG) 1. Instanz in greifbarer Nähe?, sic! 2002, 283; *Bircher/Thouvenin*, Ein eidgenössisches Patentgericht erster Instanz, sic! 2002, 650; *Brändle*, Eidgenössisches Patentgericht erster Instanz – Fluch oder Segen?, in Festschrift für Gert Kolle und Dieter Stauder, Cologne 2005, 301; *Weibel*, Bundespatentgericht unerwünscht, NZZ No. 106 of 9 May 2005, p. 9; *Stieger*, Bundespatentgericht ante portas!, in Festschrift für Alfred Bühler, Zurich 2008, 179; *Weissenberger/Aschmann*, Bundespatentgericht auf der Zielgeraden? Fragen zum Gesetzesentwurf, sic! 2008, 846.
- 20 Each Canton had to designate a sole cantonal instance court to handle civil patent cases as a matter of federal law. The legal basis for this requirement used to be Art. 76 para. 1 PatG (Bundesgesetz über die Erfindungspatente vom 25. Juni 1954 [Patentgesetz, PatG], SR 232.14), which was deleted from the Patent Act once the more general, but substantively equivalent, Art. 5 para. 1 lit. a ZPO entered into force on January 1, 2011.
- 21 Art. 72 para. 1, Art. 74 para. 2 lit. b, and Art. 75 para. 2 lit. a/b BGG.
- 22 But see Botschaft zum Patentgerichtsgesetz, BBl 2008, 455, 463.
- 23 See also *Holzer*, Das neue Bundespatentgericht, sic! 2009, 744.
- 24 On this issue, see also *Weissenberger/Aschmann*, Bundespatentgericht auf der Zielgeraden? Fragen zum Gesetzesentwurf, sic! 2008, 846, 848.
- 25 See *Stieger*, Bundespatentgericht ante portas!, in Festschrift für Alfred Bühler, Zurich 2008, 179, 182-184; *Stieger*, Prozessieren über Immaterialgüterrechte in der Schweiz – ein Quantensprung steht bevor, GRUR Int. 2010, 574, 576.
- 26 See also *Weissenberger/Aschmann*, Bundespatentgericht auf der Zielgeraden? Fragen zum Gesetzesentwurf, sic! 2008, 846, 851.
- 27 It is no surprise that, following the successful creation of the Federal Patent Court, the Swiss government has recently proposed the creation of a Federal Competition Court in explicit analogy to the Federal Patent Court; see Erläuternder Bericht zur Änderung des Bundesgesetzes über Kartelle und andere Wettbewerbsbeschränkungen (Kartellgesetz, KG), 12. For a recent discussion of this topic, see, e.g., *Rizvi/Babey*, Braucht die Schweiz ein Bundeswettbewerbsgericht?, AJP 2010, 1585. It is interesting to note that only three years ago, the Swiss government responded to opponents of the Federal Patent Court (who claimed that the creation of one specialized court would encourage the creation of other specialized courts, thereby jeopardizing the unity of the law in the long run) by arguing that patent law was an exceptional case; see Botschaft zum Patentgerichtsgesetz, BBl 2008, 455, 467.
- 28 Note that during the constitutional reform of the federal judiciary, the Swiss government, when considering the potential for the creation of additional federal courts with nationwide jurisdiction to supplement the existing Federal Criminal Court and Federal Administrative Court, specifically cited the need for a federal intellectual property court, not a patent court; see Botschaft über eine neue Bundesverfassung vom 20. November 1996, BBl 1997 I 1, 540.

- 29 See also *Hilti*, Ein eidgenössisches Patentgericht (EPG) 1. Instanz in greifbarer Nähe?, sic! 2002, 283; *Stieger*, Bundespatentgericht ante portas!, in Festschrift für Alfred Bühler, Zurich 2008, 179, 181.
- 30 The drafts are available at <http://www.epo.org/patents/law/legislative-initiatives/epla/latestdrafts.html>.
- 31 The prospects for such plans are not particularly rosy, due to the recent CJEU Opinion 1/09, issued on March 8, 2011, which found the EEUPC project incompatible with primary EU law.
- 32 See Botschaft zum Patentgerichtsgesetz, BBl 2008, 455, 469; see also *Stieger*, Bundespatentgericht ante portas!, in Festschrift für Alfred Bühler, Zurich 2008, 179, 181.
- 33 Art. 5 PatGG.
- 34 Art. 4 PatGG.
- 35 Art. 6 PatGG.
- 36 Art. 7 PatGG.
- 37 Art. 8 para. 1 PatGG.
- 38 See Art. 9 para. 3 PatGG.
- 39 The Swiss Parliament's Committee on Courts is currently advertising four to five more positions for part-time technical judges with a chemistry background; see NZZ Executive of December 11/12, 2010, p. 8.
- 40 The first President of the Court is Dr. Dieter Brändle, a former judge on the Zurich Commercial Court with significant patent experience. He has also been a regular participant in meetings of European Patent Judges.
- 41 The second full member of the Court is Dr. Tobias Bremi, a technically trained judge and registered European Patent Attorney.
- 42 Art. 13 para. 1 PatGG.
- 43 For a detailed description of the standard process for the selection of federal judges for election by the Swiss Parliament, see *Marti*, Die Gerichtskommission der Vereinigten Bundesversammlung, in «Justice-Justiz-Giustizia» 2010/1.
- 44 Art. 9 para. 4 PatGG.
- 45 See, e.g., INGRES News 9/2010, 5.
- 46 Art. 10 para. 4 PatGG.
- 47 See Art. 47 ZPO.
- 48 Art. 22 para. 4 PatGG.
- 49 Art. 28 PatGG.
- 50 See, e.g., BGE 133 I 1, BGE 128 V 82, BGE 124 I 121.
- 51 Art. 21 para. 1 PatGG.
- 52 Art. 21 para. 2 PatGG.
- 53 Art. 21 para. 3 PatGG.
- 54 Art. 21 para. 4 PatGG.
- 55 Art. 21 para. 5 PatGG.
- 56 Art. 20 para. 3 lit. a PatGG.
- 57 Art. 23 para. 1 lit. b PatGG.
- 58 Art. 23 para. 3 PatGG.
- 59 Art. 23 para. 1 lit. a, c-e PatGG.
- 60 Art. 23 para. 2 PatGG.
- 61 Art. 24 paras. 1 and 2 PatGG.
- 62 See Art. 20 para. 3 lit. b PatGG.
- 63 Art. 25 PatGG.
- 64 See Botschaft zum Patentgerichtsgesetz, BBl 2008, 455, 482.
- 65 Supplementary protection certificates are not explicitly mentioned in the Act on the Federal Patent Court, but given their close interrelationship with patents, there is no doubt that they must be treated just like patents in terms of jurisdiction of the Federal Patent Court; see also *Stieger*, Prozessieren über Immaterialgüterrechte in der Schweiz – ein Quantensprung steht bevor, GRUR Int. 2010, 574, 580-581.
- 66 See also Botschaft zum Patentgerichtsgesetz, BBl 2008, 455, 461, 482; *Stieger*, die Zuständigkeit der Schweizer Gerichte für Prozesse über und im Zusammenhang mit Patenten ab 2011, sic! 2010, 3, 4-6.
- 67 See Art. 31 VGG (Bundesgesetz über das Bundesverwaltungsgericht [Verwaltungsgerichtsgesetz, VGG] vom 17. Juni 2005, SR 173.32) in conjunction with Art. 5 VwVG (Bundesgesetz vom 20. Dezember 1968 über das Verwaltungsverfahren, SR 172.021). Note, however, that this limitation is not particularly significant in practice, given that the Federal Administrative Court appears to have had only five cases on appeal from the Federal Institute of Intellectual Property since the court's inception on January 1, 2007; see Federal Administrative Court Cases Nos. B-7477/2006, B-7478/2006, B-3064/2008, B-1729/2009, and B-1019/2010. One of the reasons for the low volume of appeals to the Federal Administrative Court is that far more than 90% of the patents valid in Switzerland are European patents examined and issued by the European Patent Office in Munich and that national Swiss patent applications are not examined for novelty or nonobviousness by the Federal Institute of Intellectual Property; see Art. 59 para. 4 PatG.
- 68 Art. 72 para. 2 lit. b no. 2 BGG in conjunction with Art. 75 para. 1 BGG.
- 69 Art. 5 para. 1 ZPO.
- 70 Art. 6 para. 4 lit. a ZPO in conjunction with Art. 5 para. 1 ZPO.
- 71 Art. 5 para. 1 lit. a ZPO.
- 72 Note that the general rules on jurisdiction in intellectual property cases also apply to patent cases until the Federal Patent Court becomes operative in 2012.
- 73 Art. 5 para. 2 lit. b-d ZPO.
- 74 Art. 5 para. 2 and Art. 6 para. 5 ZPO.
- 75 In particular Art. 10 and Art. 36 ZPO.
- 76 Art. 109 IPRG (Bundesgesetz vom 18. Dezember 1987 über das internationale Privatrecht [IPRG], SR 291).
- 77 In particular Art. 2, Art. 5 no. 3, and Art. 22 no. 4 of the Lugano Convention.
- 78 For a detailed discussion of the Federal Patent Court's subject matter jurisdiction, see *Stieger*, Die Zuständigkeit der Schweizer Gerichte für Prozesse über und im Zusammenhang mit Patenten ab 2011, sic! 2010, 3. See also *Bosshard*, Le nouveau Tribunal fédéral des brevets et les juridictions cantonales, SZPP 2010, 191.
- 79 It goes without saying that the term "exclusive" relates to state courts only and does not have any bearing on the jurisdiction of arbitral tribunals. There is no question that arbitration continues to be available in patent matters under Art. 354 ZPO or, regarding international arbitration, under Art. 177 IPRG. See also *Legler*, Sind in Zukunft Patentstreitigkeiten in der Schweiz *de lege lata* nicht mehr schiedsfähig?, ASA Bulletin 2010, 253; *Stieger*, Die Zuständigkeit der Schweizer Gerichte für Prozesse über und im Zusammenhang mit Patenten ab 2011, sic! 2010, 3, 6.
- 80 Art. 26 para. 1 lit. a-b PatGG. Moreover, the Court has exclusive jurisdiction with regard to the execution of its own judgments rendered in adjudicating any of these actions; Art. 26 para. 1 lit. c PatGG.
- 81 Art. 26 para. 2 PatGG.
- 82 Note that given the all-encompassing subject matter jurisdiction of the sole cantonal instance courts in intellectual property cases, it is impossible that any court other than the sole cantonal instance courts will have concurrent jurisdiction in patent matters, even though the Act on the Federal Patent Court does not actually use the expression "sole cantonal in-

- stance courts”, but instead uses the seemingly more general term “cantonal courts”; see Art. 26 para. 2 PatGG.
- 83 See *Stieger*, Die Zuständigkeit der Schweizer Gerichte für Prozesse über und im Zusammenhang mit Patenten ab 2011, sic! 2010, 3, 12, 14.
- 84 Art. 26 para. 4 PatGG. In this case, the cantonal court ceases to have jurisdiction contrary to the general rule of civil procedure, according to which counterclaims can be filed before the same court if the counterclaim is subject to the same type of proceedings as the main claim; see Art. 224 para. 1 ZPO.
- 85 Final judgment means *res judicata*, that is, adjudication of the issue by the Federal Patent Court possibly followed by Supreme Court review.
- 86 Art. 26 para. 3 PatGG.
- 87 Art. 26 para. 3 PatGG.
- 88 For a critique, see *Weissenberger/Aschmann*, Bundespatentgericht auf der Zielgeraden? Fragen zum Gesetzesentwurf, sic! 2008, 846, 851.
- 89 See also *Stieger*, Bundespatentgericht ante portas!, in *Festschrift für Alfred Bühler*, Zurich 2008, 179, 195.
- 90 See also *Stieger*, Die Zuständigkeit der Schweizer Gerichte für Prozesse über und im Zusammenhang mit Patenten ab 2011, sic! 2010, 3, 17.
- 91 ECJ, Case No. C-4/03, OJ C 224 of 16 September 2006, 1.
- 92 While Switzerland is not a member of the European Union and therefore generally not bound by judgments of the European Court of Justice, its case law on international jurisdiction is nevertheless relevant for Switzerland because Swiss courts have to consider ECJ case law in applying the Lugano Convention on Jurisdiction and the Recognition and Enforcement of Judgments in Civil and Commercial Matters; see Art. 1 para. 1 of Protocol No. 2 on the uniform interpretation of the Lugano Convention.
- 93 Zurich Commercial Court, Case No. HG050410, Order dated 13 October 2006, sic! 2006, 854; for a detailed review of this case, see *Hess-Blumer*, Crossborder Litigation – und sie lebt doch!, sic! 2006, 882.
- 94 See *Stieger*, Die Zuständigkeit der Schweizer Gerichte für Prozesse über und im Zusammenhang mit Patenten ab 2011, sic! 2010, 3, 16; *Stieger*, Prozessieren über Immaterialgüterrechte in der Schweiz – ein Quantensprung steht bevor, GRUR Int. 2010, 574, 584.
- 95 On these ramifications, see *Stieger*, Die Zuständigkeit der Schweizer Gerichte für Prozesse über und im Zusammenhang mit Patenten ab 2011, sic! 2010, 3, 14-15.
- 96 See also *Stieger*, Bundespatentgericht ante portas!, in *Festschrift für Alfred Bühler*, Zurich 2008, 179, 195.
- 97 See Art. 90 lit. a ZPO.
- 98 *Stieger*, Die Zuständigkeit der Schweizer Gerichte für Prozesse über und im Zusammenhang mit Patenten ab 2011, sic! 2010, 3, 18-19.
- 99 Art. 224 para. 1 ZPO.
- 100 See, e.g., *Brunner*, Zur Auswahl der Handelsrichter nach ihrem Fachwissen, SJZ 105 (2009), 321.
- 101 See, e.g., *Stieger*, Die Zuständigkeit der Schweizer Gerichte für Prozesse über und im Zusammenhang mit Patenten ab 2011, sic! 2010, 3, 19.
- 102 Art. 26 paras. 3 and 4 PatGG.
- 103 Art. 26 para. 2 PatGG.
- 104 The transfer rule for counterclaims contained in Art. 26 para. 4 PatGG uses the term “the cantonal court” rather than the expression “a cantonal court”. It is difficult to make sense of the use of this particular language other than by reading it as a reference to the definition of concurrent jurisdiction in *patent* matters under Art. 26 para. 2 PatGG. In principle, the same is true for the rule codifying the “Zurich Route” for defenses and preliminary questions (Art. 26 para. 3 PatGG), but it may make sense for cantonal courts faced with patent issues as a defense to a non-patent action or as a preliminary question in the context of a non-patent action to go down the “Zurich Route” by applying Art. 26 para. 3 PatGG by analogy.
- 105 Art. 26 para. 2 PatGG.
- 106 Art. 41 PatGG.
- 107 See also *Bosshard*, Le nouveau Tribunal fédéral des brevets et les juridictions cantonales, SZP 2010, 191, 197.
- 108 It is unclear whether Art. 404 para. 1 ZPO, which provides that cantonal procedural law will continue to be applicable until the conclusion of the proceedings before the “instance concerned”, is applicable in case of a transfer to the Federal Patent Court, that is, whether the Federal Patent Court is such an “instance concerned”. But see *Stieger*, Die Zuständigkeit der Schweizer Gerichte für Prozesse über und im Zusammenhang mit Patenten ab 2011, sic! 2010, 3, 21.
- 109 Art. 27 PatGG.
- 110 Art. 220 ZPO.
- 111 Art. 221 para. 1 ZPO. For the required exhibits (powers of attorney, documentary evidence, list of evidence), see Art. 221 para. 2 ZPO.
- 112 Art. 221 para. 3 ZPO.
- 113 Art. 222 paras. 1 and 4 ZPO.
- 114 See, e.g., *Stieger*, Bundespatentgericht ante portas!, in *Festschrift für Alfred Bühler*, Zurich 2008, 179, 197.
- 115 Art. 225 ZPO.
- 116 Art. 226 ZPO.
- 117 See also *Stieger*, Bundespatentgericht ante portas!, in *Festschrift für Alfred Bühler*, Zurich 2008, 179, 200-203.
- 118 Art. 228 ZPO.
- 119 Art. 231 ZPO.
- 120 Art. 233 ZPO.
- 121 Art. 74 para. 2 lit. e and Art. 75 para. 1 BGG; Art. 1 para. 2 PatGG.
- 122 Art. 97 BGG.
- 123 Art. 35 para. 1 PatGG.
- 124 Art. 124 para. 1 ZPO.
- 125 See *Botschaft zum Patentgerichtsgesetz*, BBl 2008, 455, 488.
- 126 Art. 35 para. 2 PatGG.
- 127 Under the general rules of civil procedure, proceedings are held in the official language of the canton in question, whereas the cantons determine which official language is to be used if multiple languages are spoken in that particular canton; see Art. 129 ZPO.
- 128 Art. 36 para. 1 PatGG.
- 129 Art. 36 para. 2 PatGG.
- 130 English is not allowed as a procedural language before the Swiss Supreme Court; Art. 54 para. 1 BGG.
- 131 Art. 36 para. 3 PatGG. Note that proceedings before the Swiss Supreme Court will typically be in the language of the decision that is appealed; Art. 54 para. 1 BGG.
- 132 For a critique of this regime as too restrictive given the consent requirement with regard to both parties, see *Weissenberger/Aschmann*, Bundespatentgericht auf der Zielgeraden? Fragen zum Gesetzesentwurf, sic! 2008, 846, 852.
- 133 Art. 36 para. 4 PatGG. The same rule applies to proceedings before the Swiss Supreme Court; Art. 54 para. 4 BGG.
- 134 Following the entry into force of the London Agreement on the application of Article 65 EPC (OJ EPO 2001, 549), Switzerland no longer requires the translation of European patents issued in English into an official Swiss language; see Art. 1 para. 1 London Agreement (Übereinkommen über die Anwendung

des Artikels 65 des Übereinkommens über die Erteilung europäischer Patente [Sprachenübereinkommen], abgeschlossen in London am 17. Oktober 2000 [SR 0.232.142.202]).

- 135 Art. 232 ZPO.
- 136 Art. 38 PatGG.
- 137 Art. 37 paras. 1 and 2 PatGG. In addition, the parties must be given the opportunity to request the court to order an oral or written explanation of the expert opinion by the expert or the submission of additional questions to the expert; see Art. 187 para. 4 ZPO.
- 138 Art. 187 para. 1 ZPO.
- 139 Art. 183 para. 3 ZPO.
- 140 Art. 37 para. 3 PatGG.
- 141 Art. 168 para. 1 in conjunction with Art. 183 et seq. ZPO. See also BGE 132 III 83.
- 142 See Art. 175 ZPO.
- 143 For a general overview, see *Willi*, Vorsorgliche Massnahmen nach der Schweizerischen Zivilprozessordnung (ZPO), sic! 2010, 591.
- 144 Art. 261 para. 1 ZPO. Note that the courts may refrain from ordering provisional measures if the adverse party provides adequate security (Art. 261 para. 2 ZPO), but given the importance of preliminary injunctions in patent matters, this option should be confined to rare exceptions; see also *Stieger*, Bundespatentgericht ante portas!, in *Festschrift für Alfred Bühler*, Zurich 2008, 179, 214.
- 145 Art. 262 ZPO.
- 146 See Art. 59 MSchG, Art. 38 DesG, Art. 65 URG, and – as of 2012 – Art. 77 para. 1 lit. a PatG i.V.m. Art. 66 lit. b PatG; see also *Willi*, Vorsorgliche Massnahmen nach der Schweizerischen Zivilprozessordnung (ZPO), sic! 2010, 591, 596.
- 147 Art. 23 para. 1 lit. b PatGG in conjunction with Art. 23 para. 2 PatGG.
- 148 Art. 23 para. 3 PatGG.
- 149 Art. 23 para. 3 PatGG.
- 150 Art. 253 ZPO.
- 151 Art. 265 para. 1 ZPO.
- 152 Art. 265 para. 2 ZPO.
- 153 Art. 263 ZPO.
- 154 Art. 264 ZPO.
- 155 Art. 98 BGG.
- 156 Art. 268 para. 1 ZPO.
- 157 Art. 270 para. 1 ZPO.
- 158 Art. 270 para. 2 ZPO. Note that this provision is the exact opposite of the previous practice of the Zurich Commercial Court, which, invoking the constitutional law principle of equal treatment, used to forward protective briefs to the other party prior to the actual filing of a motion for an *ex parte* order of provisional measures; see Zurich Commercial Court, Order of April 6, 2009, ZR 108 (2009), No. 46.
- 159 Art. 270 para. 3 ZPO.
- 160 See, e.g., Zurich Commercial Court, Presidential Order of May 2, 1997, ZR 96 (1997), No. 46.
- 161 See also *Stieger*, Bundespatentgericht ante portas!, in *Festschrift für Alfred Bühler*, Zurich 2008, 179, 217-218.
- 162 For general reviews of these developments, see *Calame*, Beweissicherung im Zusammenhang mit Patentverletzungsklagen in der Schweiz ab 2011, in *Liber Amicorum für Rudolf Tschäni*, Zurich 2010, 485; *Schweizer*, Vorsorgliche Beweisabnahme nach schweizerischer Zivilprozessordnung und Patentgesetz, ZZZ 2010 No. 21/22, 3.
- 163 See also *Calame*, Beweissicherung im Zusammenhang mit Patentverletzungsklagen in der Schweiz ab 2011, in *Liber Amicorum Rudolf Tschäni*, Zurich 2010, 485, 487-488; *Stieger*, Bundespatentgericht ante portas!, in *Festschrift für Alfred Bühler*, Zurich 2008, 179, 216-217.
- 164 Art. 158 para. 1 lit. b ZPO.
- 165 See also *Schweizer*, Vorsorgliche Beweisabnahme nach schweizerischer Zivilprozessordnung und Patentgesetz, ZZZ 2010 No. 21/22, 3, 8-9.
- 166 See Art. L. 615-5 of the French Code de la propriété intellectuelle; see also Art. 7 of the Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights, OJ L 157 of April 30, 2004, 45.
- 167 *Stieger*, Bundespatentgericht ante portas!, in *Festschrift für Alfred Bühler*, Zurich 2008, 179, 216; *Calame*, Beweissicherung im Zusammenhang mit Patentverletzungsklagen in der Schweiz ab 2011, in *Liber Amicorum Rudolf Tschäni*, Zurich 2010, 485; *Schweizer*, Der Anspruch auf genaue Beschreibung gemäss Art. 77 PatG, sic! 2010, 930, 931.
- 168 Art. 77 para. 1 lit. b PatG in conjunction with Art. 77 para. 2 PatG (as amended by the Act on the Federal Patent Court).
- 169 See *Calame*, Beweissicherung im Zusammenhang mit Patentverletzungsklagen in der Schweiz ab 2011, in *Liber Amicorum Rudolf Tschäni*, Zurich 2010, 485, 497.
- 170 See also *Schweizer*, Der Anspruch auf genaue Beschreibung gemäss Art. 77 PatG, sic! 2010, 930, 932.
- 171 Art. 77 para. 4 PatG (as amended by the Act on the Federal Patent Court).
- 172 See also Art. 155 para. 3 ZPO.
- 173 See also Art. 68 PatG and Art. 156 ZPO.
- 174 Art. 77 para. 5 PatG (as amended by the Act on the Federal Patent Court).
- 175 See also Botschaft zum Patentgerichtsgesetz, BBl 2008, 455, 495.
- 176 See also *Hilti*, Ein eidgenössisches Patentgericht (EPG) 1. Instanz in greifbarer Nähe?, sic! 2002, 283.

Richtungsweisend oder eine nur begrenzt wahrgenommene Chance?

Der Copyright-Code des Wittem-Projekts

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Kurzzusammenfassung: Der „European copyright code“ des Wittem-Projekts von 4/2010 ist pragmatisch, konstruktiv-konservativ ausgefallen. Traditionell das Werk- und Autorenverständnis. Schrankenregelungen werden über einen hybriden Ansatz offen gehalten. Bildung und Wissenschaft werden nicht gerade verwöhnt. Die Wittem-Gruppe hat sich nicht in

den „Treibsand visionärer Modelle“ begeben wollen. Ein guter Text, aber dann doch nicht wirklich wegweisend für den Umgang mit Wissen und Information in elektronischen Räumen, am ehesten noch durch den Vorschlag einer Schrankenbestimmung zur Begünstigung des wirtschaftlichen Wettbewerbs.

Keywords: Autor; Bildung; Dreistufentest; European copyright code; hybrid; moral rights; Schranken; Vergütung; Urheberrecht; Verwertungsrechte; Wittem-Projekt; Werk; Wettbewerb; Wissenschaft

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Zusammenfassung:

- 1 Mit dem *Code* liegt ein mit hoher Kompetenz erstellter Rahmen für ein europäisches Copyright vor. Die Stimme der Rechtswissenschaft versucht sich in der EU-Politik Geltung zu verschaffen. Dabei wurde wohl weniger ein grundsätzlicher Neuansatz angestrebt, sondern, mit Respekt vor dem *acquis communautaire* der sieben EU-Richtlinien seit 1991, ein Fortschreiben des *status quo*, aber in der Intention, diesen transparenter und schlanker zu machen, und mit der Erwartung, Verbesserungen im derzeit geltenden Urheberrechtsparadigma zu erreichen. Dieses Ziel hat den *Code* doch recht konservativ ausfallen lassen, zunächst sowohl was den Werk- als auch den Autorenbegriff angeht. Anders als bei der EU-Richtlinie von 2001 wird stärker Wert auch auf die „moral rights“, die Persönlichkeitsrechte, gelegt. Sowohl bezüglich der kommerziellen Verwertungsrechte (an sich geschlossen, aber über das Rechte der öffentlichen Zugänglichmachung offen) als auch bezüglich

der Schrankenregelungen wird ein hybrider Ansatz gewählt. Neue Schranken können entwickelt werden, wenn sie den Ausprägungen der bisherigen ähnlich sind und wenn sie, natürlich, nicht gegen den Dreistufentest verstoßen. Die Schrankenvorschläge für Wissenschaft und Bildung werden, wie aus dem konservativen Ansatz zu erwarten, kaum den Bedürfnissen und Erwartungen in diesen Bereichen gerecht. Positiv, dass die genehmigungsfreie Nutzung nicht kleinteilig näher spezifiziert wird. Enttäuschend aber, dass nicht versucht wurde, eine Vergütungsfreiheit konditioniert zu ermöglichen. Wirkliches Neuland wird mit dem Vorschlag einer Schrankenbestimmung betreten, wodurch zur Begünstigung des wirtschaftlichen Wettbewerbs eine genehmigungsfreie Nutzung bei frei aushandelbarer Vergütung vorgeschlagen wird. Zweifellos hat sich die Wittem-Gruppe nicht in den „Treibsand visionärer Modelle“ begeben wollen. Sie hat die bei den letzten Urheberrechtsregulierungen verfolgte Politik der kleinen Schritte fortgesetzt. Ein wenig mehr

Mut, Neuland zu betreten, hätte man angesichts der hohen Kompetenz und Unabhängigkeit der Autoren erwarten dürfen. Vielleicht wäre dazu eine interdisziplinäre Ausrichtung der Gruppe erforderlich gewesen. Ein guter Text, aber dann doch nur bedingt wegweisend für den Umgang mit Wissen und Information in elektronischen Räumen.

A. Ziel und Ansatz des Wittem-Projekts

- 2 Renommiertere europäische Urheberrechtsexperten haben sich seit vielen Jahren in dem sogenannten „Wittem project“ zusammengetan und sich schließlich auf einen „European copyright code“ verständigt und ihn im April 2010 öffentlich gemacht. Schwierig dieser geballten Kompetenz etwas entgegenzusetzen, aber bloße Affirmation führt ja nicht weiter. Also hier eine durchaus kritische Reaktion bei allem Respekt vor der demonstrierten Fähigkeit, sich auch unter Professoren konsensual auf einen *Code* zu einigen.
- 3 Die Gruppe versucht mit dem *Code*, die akademische Expertise stärker als bisher in die politischen europäischen Urheberrechtsdebatten einzubringen. In der Vergangenheit sind erarbeitete Vorschläge, z.B. aus dem Amsterdamer Instituut voor Informatierecht (Universiteit van Amsterdam), nicht immer konstruktiv von der EU-Politik aufgenommen worden¹. Auch ist mehr als fraglich, ob die früher vorgelegten Vorschläge zur liberaleren, flexibleren Reinterpretation des Dreistufentests, die aus einer teilweise identischen Personengruppe entwickelt worden sind², von der Politik aufgegriffen werden. Heilige Kühe werden, wenn überhaupt, dann wohl nur in wirklichen Notsituationen geschlachtet. Es ist nicht anzunehmen, dass die Wittem-Gruppe das Urheberrecht in einer weitgehenden, dramatischen Divergenz zwischen politischer Regulierung und öffentlicher Erwartung sieht.
- 4 Es mag überinterpretiert sein, aber der überwiegend konservative, man kann auch sagen realistische Ansatz, der in dem *Code* ersichtlich wird, ist vielleicht dem Ziel geschuldet, der Politik auf der Grundlage bestehende Verträge, Richtlinien oder Vereinbarungen Vorschläge zu machen, die Aussicht auf Umsetzung im derzeit geltenden Urheberrechtssparadigma haben. Die Vorschläge jüngerer Urheberrechtswissenschaftler, wie z.B. die von Till Kreutzer oder Gerd Hansen (um nur diese aus Deutschland zu nennen), gehen allerdings über den *Code* weit hinaus³. Auch das Aktionsbündnis „Urheberrecht für Bildung und Wissenschaft“ ist in Deutschland zu der Einschätzung gekommen, dass die Fortschreibung der Urheberrechtsregulierungen auf der Grundlage der geltenden Systematik und Dogmatik die grundsätzlichen Widersprüche des geltenden Urheberrechts nicht lösen können. Das Aktionsbündnis setzt sich z.B. für eine umfassende Wissenschaftsklausel ein – ein Gedanke, der dem *Code* vermutlich zu weit gegangen wäre.
- 5 Die Experten des *Code* denken hier pragmatischer. Das wird in der folgenden Formulierung sehr deutlich:
- 6 “This Code is not a recodification of EU copyright law tabula rasa. Since European copyright law must operate within the confines of the international commitments of the European Union and its Member States, the Code takes account of the substantive norms of the Berne Convention and the TRIPs Agreement. Also, the members of the Group have found it hard to ignore the *acquis communautaire* in the form of seven Directives that the European legislature has produced in this field since 1991. However, the Code does on occasion deviate from the *acquis*, and therefore cannot be considered a mere restatement or consolidation of the norms of the directives.” (7)
- 7 Sie verfolgen dabei das praktische Ziel, „to promote transparency and consistency in European copyright law“ (5). Der *Code* soll ein Referenzmittel sein, um die zukünftige Harmonisierung bzw. Vereinheitlichung des Urheberrechts [hier als synonym mit *Copyright*] voranzutreiben. Aus dieser Absicht soll aber nicht abgeleitet werden können, ob die Experten eine solche Harmonisierung überhaupt für sinnvoll halten oder nicht. Das ist allerdings schwer nachzuvollziehen – einen *Code* zur Harmonisierung vorzuschlagen, ohne eindeutig Stellung bezüglich des Ziels der Harmonisierung in der EU zu beziehen. Die Gruppe geht davon aus, dass es das Ziel der EU-Politik sei, diese Harmonisierung zu erreichen – so ist es ja auch in den Erläuterungen zur EU-Copyright-Richtlinie von 2001 formuliert⁴. Und wenn es das politische Ziel ist, sollte Wissenschaft, so wohl das Kalkül, versuchen, Verfahren zum Erreichen des Ziels vorzuschlagen (!!). Die Gruppe ist sich jedenfalls darüber einig – dies lässt nicht zuletzt die Mitwirkung von Bernt Hugenholtz schließen⁵ –, dass das Ziel der Harmonisierung durch die jeweiligen nationalen Umsetzungen der erwähnten, bis heute verbindlichen Richtlinie von 2001 nicht erreicht worden ist.
- 8 Der *Code* macht keineswegs Vorschläge für alle Aspekte des Urheberrechts, sondern geht „nur“ auf die systematisch zentralen Themen ein: „*subject matter of copyright (Chapter 1), authorship and ownership (Chapter 2), moral rights (Chapter 3), economic rights (Chapter 4), and limitations (Chapter 5)*“ (p. 6). Hierzu, ohne abschließenden Vollständigkeitsanspruch, einige Anmerkungen – mit Schwerpunkt auf die Interessen von Bildung und Wissenschaft.
- 9 Mir als Nicht-Jurist ist bewusst, dass die folgenden Anmerkungen keinesfalls auf dem Niveau formuliert sind, wie sie die hochkompetenten Autoren des *Code*

erwarten können und gewohnt sind. Die folgenden Anmerkungen sind vielmehr geschuldet dem zunehmend öffentlichen Unbehagen oder sogar Unverständnis, dass die offizielle Politik und die offizielle Jurisprudenz abnehmend in der Lage sind, den Realitäten in elektronischen Umgebungen über das Urheberrecht gerecht zu werden. Vielleicht müssen Anstöße von außen kommen, wobei hier mehr Fragen gestellt als verbindliche Antworten gegeben werden, schon gar nicht juristisch kodifizierte.

- 10 Mit einer bloßen Fortschreibung des ökonomischen, politischen und rechtlichen *status quo* kann aber wohl nicht mehr angemessen dem fundamentalen Wandel beim Umgang mit Wissen und Information in elektronischen Umgebungen begegnet werden. Warum waren im *Drafting Committee* nur Juristen? Können die Urheberrechtsprobleme wirklich alleine aus juristischer Kompetenz und unter Anerkennung des *acquis communautaire der sieben EU-Richtlinien seit 1991* gelöst werden? Es sieht fast so aus, dass die juristische Wissenschaft sich weniger als andere Disziplinen mit dem interdisziplinären Diskurs anfreunden kann. Warum eigentlich?

B. Ein statischer (?) Werkbegriff

- 11 Art 1.1 bestimmt den für das Urheberrecht zentralen Begriff des Werks. Das ist extensional und intensional ganz im Rahmen des Bestehenden gehalten. Wäre es aber nicht an der Zeit, von mystischen Formulierungen wie „creation“ Abstand zu nehmen? Autoren wie Hilty plädieren doch sonst immer dafür, endlich von dem naturrechtlich begründeten, romantisierenden Bild des kreativen, alleine für sich arbeitenden Schöpfers mit all seinen moralischen Ansprüchen auf exklusive Anerkennung seiner Schöpfungen Schluss zu machen und anzuerkennen, dass die vom Urheberrecht zu regulierenden Objekte zwar auch Kulturgegenstände sind, aber in erster Linie vom Recht deshalb geschützt werden, weil sie, dann auch unter dem Anspruch der Vergütung für erbrachte Leistungen, für moderne Volkswirtschaften und für die Innovationschancen der Wirtschaft zentral sind⁶. Später wird dem durch den Art. 5.4 bei den Schrankenregelungen durchaus ja auch Rechnung getragen, wenn als eine der Begründungen für Schrankenregelungen auch der „purpose of enhancing competition“ angeführt wird. Das ist ein wirklich im wahrsten Sinne des Wortes innovativer und konstruktiver Beitrag, der dazu führen kann, das Urheberrecht von seiner bisherigen Kopflastigkeit und mystischen Idealisierung auf den Boden der Realität zu bringen (vgl. dazu unten 5-3). Warum ist dieser Gedanke nicht in die Konzepte vom Autor und vom Werk eingeflossen?
- 12 Schon gar nicht wird dem Rechnung getragen, dass heute unter dem Einfluss gegenwärtiger Technik

und Wissenstechnologie ein ganz neues Werkverständnis entstanden ist. Werke werden nicht mehr ausschließlich als „its author's own intellectual creation“ angesehen, sondern entstehen sowohl in der Wissenschaft als auch in der Kunst immer mehr kollaborativ. Zudem sind Werke unter dem umfassenden Hypertext-Paradigma (Web-Paradigma) immer mehr als offene, nicht abgeschlossene Werke anzusehen, zum einen durch den nicht-linearen Charakter hypertextueller Objekte, aus denen in der Navigation keine statischen, sondern dynamische Werke abgeleitet werden⁷, zum andern dadurch, dass „Werke“ bewusst von den Erstellern als offen angesehen und in die Webwelt hineingegeben werden, mit der Aufforderung, sich an deren Weiterentwicklung zu beteiligen.

- 13 Wie reagiert das Urheberrecht auf diese offenen, nicht-linearen, dynamischen, kollaborativen Werke? Ansätze dazu könnten im Code durchaus vorhanden sein, z.B. durch den Vorschlag, die bisherigen Verwertungsrechte durch ein „right of adaptation“ zu ergänzen. Aber das ist an dieser Stelle als Recht des Autors anzusehen bzw. dann auch als Nutzungsrecht des Verwerter, wenn der Autor dieses Recht, wie die anderen auch, an diesen übertragen hat. Sollte aber nicht ein „right of adaptation“ auch Eingang in die Schrankenregelungen finden?

C. Autorenbegriff

- 14 Nicht ganz so „romantisch“ wie beim Werkbegriff bleiben die Ausführungen zum Autorenbegriff (obgleich auch hier wieder das „created“-Konzept verwendet wird), da unter Art. 2.1 für den „author of a work“ neben „natural person“ auch „group of natural persons“ angesprochen sind. Institutionen bleiben weiterhin von den Urheberrechtsansprüchen direkt ausgeschlossen, obgleich natürlich ein Großteil der heutigen Werke weder individuell noch Gruppen zugerechnet wird, sondern eben der Institution.
- 15 Ansonsten wird nicht zwischen verschiedenen Typen an Autoren unterschieden und damit auch nicht zwischen verschiedenen Gegenstandsbereichen des schützenden und ermöglichenden Urheberrechts. Alle Autoren, auf welchem Gebiet sie auch tätig sind, haben die gleichen moralischen und kommerziellen Rechte. Wie auch sonst, wird nicht versucht, hier differenzierend einzugreifen. Macht es keinen Unterschied auch für das Urheberrecht, wenn Werke in der Wissenschaft oder in der Unterhaltungsindustrie, von Wissenschaftler/innen oder von Industriekonsortien produziert werden? Die Einheitlichkeit des Urheberrechts wird im Wittem-Vorschlag weiter als anzustrebendes Ziel verfolgt. Modifikationen werden nicht bei den Rechten vorgenommen, sondern allenfalls bei den Schrankenregelungen.

- 16 Die Zeit scheint noch nicht reif zu sein, um sich an die Umsetzung der von Kreuzer vorgeschlagenen „Zweiteilung von funktionalem Werkschutz und persönlichkeitsbezogenem Urheberschutz“ zu machen. Erst recht scheint es derzeit nicht realistisch zu sein, als Kriterium für das Recht auf Urheberrechtsschutz das Ausmaß der Nützlichkeit für die Allgemeinheit anzunehmen (so jüngst ebenfalls Kreuzer⁸) oder für die kommerzielle Verwertung das Ausmaß der Erarbeitung informationeller Mehrwerte gegenüber dem Ausgangswerk des/der Autors/in.

D. Zu den Rechten im einzelnen

- 17 Bei den ökonomischen Rechten ist es interessant, dass die Übertragung der Rechte an Dritte (assignment) nur gültig sein soll, wenn der Vertrag schriftlich abgeschlossen ist. Die einfache Überlassung, wie häufig in Bildung und Wissenschaft üblich, soll nicht zu einer einklagbaren Rechtsverbindlichkeit führen. Ansonsten bleiben Urhebervertragsrechte im *Code* ausgeblendet, obgleich gerade hier in den letzten Jahren eine heftige Diskussion darüber entstanden ist, z.B. über ein unabdingbares Zweitverwertungsrecht der Autoren oder, grundlegender, in welchem Ausmaß z.B. Wissenschaftlern in öffentlichen Beschäftigungsverhältnissen die Übertragung ihrer Verwertungsrechte als Nutzungsrechte zugestanden werden soll. Auch die Frage, ob Nutzungsrechte der kommerziellen Verwerter daran festzumachen wären, in welchem Ausmaß informationelle Mehrwerte gegenüber dem Ausgangsprodukt des Autors erbracht worden sind, kann dann im *Code* nicht angesprochen werden. Wie gesagt, das Ziel des *Code* ist begrenzter, bescheidener, realistischer (?).
- 18 Anders als in der EU-Richtlinie, aber auch durchaus anders als bei den angelsächsischen Copyright-Regelungen, ist ein ganzes Kapitel (Art 3.1-3.6) den „moral rights“, den Persönlichkeitsrechten, gewidmet. Ist das als Gegengewicht zu der immer stärker werdenden ökonomischen Sicht auf das Urheberrecht zu werten? Bemerkenswert aber auch, dass durch Art. 3.6 den „interests of third parties“ (seien es private Parteien wie Verleger oder auch legitime Interessen der Öffentlichkeit, verbesserten Zugang zu dem veröffentlichten Werk zu erhalten) Rechnung getragen wird. Das hätte bei den Schrankenregelungen weiter ausgebaut werden können. Die Idee eines „commons-based copyright“ war den Autoren des Wittem-Projekts ohnehin wohl noch entweder unbekannt oder zu weit entfernt von der juristischen Realität.
- 19 Bezüglich der kommerziellen Verwertungsrechte wird ein interessanter hybrider Ansatz gewählt. Einerseits wird von einer abgeschlossenen Liste dieser Rechte gesprochen, andererseits wird speziell das Recht der öffentlichen Zugänglichmachung (right
- of communication to the public) zu Recht als offenes Konzept aufgefasst: „comprises a nonexhaustive (open) list of acts falling under that concept“.

E. Schrankenregelungen – genehmigungsfrei, aber nur in Ausnahmen vergütungsfrei, nicht für Bildung und Wissenschaft

- 20 Aus der Nutzersicht sind natürlich vor allem die Schrankenregelungen interessant. Für diese wurde die englische Bezeichnung „limitations“ verwendet (die systematisch irreführende, aber oft auch verwendete Bezeichnung „exceptions“ wurde vermieden). Schranken sollten in der Tat als rechtlich verbindliche und systematisch zum Urheberrecht gehörige Begrenzungen der exklusiven Autoren-/Verwerterrechte verstanden werden, nicht bloß als aus „Gnade“ gewährte Ausnahmen.
- 21 Die EU-Richtlinie von 2001 wurde in der Literatur vor allem wegen der Abgeschlossenheit der vorgeschlagenen Liste der Schranken kritisiert⁹, die die Anpassung an sich ändernde, nicht zuletzt mediale Rahmenbedingungen schwierig bis unmöglich mache. Zudem wurde häufig kritisiert, dass die Harmonisierung dadurch erschwert werde, dass kein obligatorischer Kern für Schranken festgelegt wurde.
- 22 Um dem ersten Kritikpunkt Rechnung zu tragen, wurde auch hier ein hybrider Ansatz gewählt: „reflects a combination of a common law style open-ended system of limitations and a civil law style exhaustive enumeration“ (FN 48). Die Flexibilität soll dadurch möglich werden, dass in den Schrankenregelungen exemplarisch jeweils Beispiele angeführt werden. Weitere Nutzungen könnten von Gerichten im Streitfall als ebenfalls erlaubt angesehen werden, wenn sie als ähnlich zu den bislang angeführten Nutzungsausnahmen angesehen werden und, natürlich, wenn diese neuen, legitime Interessen Dritter berücksichtigende Nutzungen als kompatibel mit dem Dreistufentest angesehen werden können (ebda). In Art. 5.5 wird entsprechend noch einmal explizit darauf hingewiesen, dass die Einführung anderer Schrankenbestimmungen möglich sein muss, wenn dadurch die normale Verwertung und die legitimen Interessen der Rechteinhaber (Autoren und Verwerter) nicht gefährdet sind. Dieser Weg wird aber wohl nur dann beschritten werden können, wenn sich eine ausgewogenere Interpretation des Dreistufentests, unter Berücksichtigung der öffentlichen Interessen, durchsetzen wird, wie es ja von Geiger et al. (vgl. FN 2 in diesem Text) vorgeschlagen wurde.
- 23 Sehr gut auch, dass mit Art. 5.8 versucht wird, der seit geraumer Zeit in den Gesetzestexten festgeschriebe-

nen Priorität von technischen Schutzmaßnahmen gegenüber Schrankenbestimmungen entgegen zu wirken. Hier lassen ja auch die 95er-Paragraphen im deutschen Urheberrecht einiges zu wünschen übrig. Der Wittem-Vorschlag sieht die Rechteinhaber in der Pflicht, den Nutzern zu ermöglichen, die ihnen durch Schranken gegebenen Rechte auch wahrzunehmen. Vielleicht hätte man hier an eine institutionelle Sicherung der Nutzungsrechte denken können, z.B. durch eine Hinterlegung und dann, bei nachgewiesener Nutzungsberechtigung, die Bereitstellung der Entschlüsselungscodes.

- 24 Mit Blick auf Bildung und Wissenschaft ist vor allem wichtig:

Art. 5.2 – Uses for the purpose of freedom of expression and information
aber auch:

Art. 5.3 – Uses permitted to promote social, political and cultural objectives
Art. 5.4 – Uses for the purpose of enhancing competition

I. Schranke für Zwecke wissenschaftlicher Forschung – kaum elektronischen Umgebungen angemessen

- 25 Bei Art. 5.2 wird unterschieden nach Nutzungen, für die Genehmigungs- und Vergütungsfreiheit bestehen (Abs.1, a-e), und Nutzungen, die zwar auch genehmigungsfrei sein sollen, für die aber vergütet werden muss, und die nur insoweit in Anspruch genommen werden dürfen, als es dem Zweck der Nutzung entspricht (Abs. 2, 1-b). Unter (b) ist „use for purposes of scientific research“ angeführt. Wissenschaftliche Forschung fällt also für die Wittem-Gruppe nicht unter die ganz besonders privilegierte Nutzungen wie in (Abs. 1, a-e) aufgeführt. Vergütungspflichtigkeit ist gefordert, und die Einlösung dieser Verpflichtung wird hier ausschließlich Verwertungsgesellschaften überlassen.
- 26 Man hat offenbar nicht versucht, zumindest durch eine Konditionierung an der Vergütungspflichtigkeit für wissenschaftliche Nutzung zu rütteln. Dass die freie Nutzung im öffentlichen Interesse liegt, dafür sollten es eigentlich ausreichende Gründe geben. Wäre eine Konditionierung nicht in dem Sinne möglich gewesen, dass Gebührenfreiheit gegeben ist a) nur unter der Voraussetzung, dass die Einrichtung, die die Nutzung möglich macht (z.B. Bibliotheken), für die Nutzung durch Kauf oder Lizenz entsprechendes Entgelt geleistet hat, b) dass die freie Nutzung nur für den persönlichen wissenschaftlichen Gebrauch gestattet ist oder c) für einen genau bestimmten abgegrenzten Kreis der Nutzer, z.B. in einer

Forschungsgruppe oder für Angehörige eines Lehrstuhls? Warum muss immer wieder für jede Nutzung abgerechnet werden?

- 27 Die Wittem-Gruppe sieht hier offenbar den entscheidenden Unterschied zwischen Vergütung (remuneration) im analogen Medium und im elektronischen Medium. Bei analogen Objekten wird ja keine weitere Vergütung für Kopien von rechtmäßig erworbenen Originalen verpflichtend gemacht, und die anbietenden Verlage haben das auch akzeptiert bzw. sich zusätzliche Einnahmen über die (pauschalen) Geräteabgaben gesichert¹⁰.
- 28 Diese Unterscheidung ist letztlich alleine der Annahme verpflichtet, dass im elektronischen Medium beliebig viele Kopien ohne Qualitätsverlust (also weitere Originale) und mit minimalem Kostenaufwand erstellt werden können und dass es im Extremfall nur nötig wäre, nur ein Exemplar irgendwo in einer Bibliothek zu erwerben, auf das dann alle freien Zugang hätten. Diese aus der Unterhaltungsindustrie wohl übertragene Argumentation ist im Bereich von Bildung und Wissenschaft keinesfalls zutreffend.
- 29 Zum einen ist nicht zu erwarten, dass ein wissenschaftlicher Artikel häufiger als für die direkte Nutzung erforderlich abgerufen wird¹¹. Das ist bei einem Musikstück ganz anders, wo gleich Millionen Nutzer interessiert sein können. Und zum andern könnte die freie Nutzung, wie unter (a)-(c) angeführt, ja durchaus konditioniert werden. Die Wittem-Gruppe muss man hier fragen, ob sie nicht nach Regelungen für die Vergütung gesucht hat bzw. warum sie entsprechende Lösungen verworfen hat, die die kommerzielle Informationswirtschaft veranlassen würde, elektronischen Umgebungen angemessene Geschäftsmodelle mit entsprechend flexiblen Vergütungsverfahren zu entwickeln. So, so scheint mir, schreibt der Code nur bestehende Modelle fort und sichert den bisherigen Besitzanspruch der kommerziellen Verwerter. Oder waren solche Überlegungen wie konditionierte Vergütungsfreiheit der Gruppe zu kleinteilig?
- 30 Wie auch immer - nicht einzusehen ist, weshalb die öffentliche Hand quasi dreifach für die Nutzung bezahlen sollte: a) für Primärerwerbung bzw. -lizenz, b) für die aktuelle Nutzung und c) für Geräteabgaben. Wäre hier eventuell eine neue Form von pauschaler Abgabe in Form einer wissenschaftlichen Flat rate sinnvoll, die an Stelle der immer schwieriger zu rechtfertigenden Geräteabgabe treten könnte? Es kann doch nicht sein, dass Urheberrechtsregelungen für die Nutzung von wissenschaftlicher Information tatsächlich zu einer Lizenz für einen stetig fließenden Einnahmestrom bzw. für eine Verpflichtung zu einem stetig fließenden Ausgabestrom für die öffentliche Hand werden.

31 Die noch weitergehende Frage haben sich die Wittem-Experten offenbar gar nicht gestellt bzw. die positive Antwort darauf verworfen: Ist es nicht eine legitime Forderung, dass das mit öffentlich Mitteln gefördert und finanziert erstellte Wissen wenn nicht sogar jedermann, dann zumindest denen frei zur Verfügung stehen soll, die im Interesse der gesamten Gesellschaft weiteres Wissen schaffen wollen¹²?

II. Schranke für Zwecke der Ausbildung (education) – ebenso kaum elektronischen Umgebungen angemessen

- 32 Diese Frage könnte natürlich auch Anwendung finden auf Art. 5.3 – Uses permitted to promote social, political and cultural objectives. Auch hier wird die Unterscheidung getroffen zwischen Anwendungen, die sowohl genehmigungsfrei als auch nutzungsfrei sein sollen (Abs. 1, a-c), und solchen, die zwar genehmigungsfrei, aber vergütungspflichtig sein sollen (Abs. 2, a und b). Die sich auf Bibliotheken und ähnliche Einrichtungen abzielende Nutzungserlaubnis Abs. 1,c ist für die direkte Nutzung irrelevant (wenn auch kulturpolitisch natürlich sinnvoll), da sie nur auf die Erlaubnis zum Archivieren abzielt.
- 33 Der gesamte Abs. 2 ist, wie auch schon die Entsprechung in Art. 5.2, wenig liberal oder flexibel gehalten, sondern verstärkt mit Blick auf Abs. 2, a sogar schon bestehende nationale Regelungen wie die zur Privatkopie in § 53 des deutschen UrhG. Aufgenommen wurde die Formulierung aus dieser Norm, dass die Nutzung nur insoweit erlaubt ist, als es sich bei der Quelle der Kopie nicht schon um eine „obviously infringing copy“ handelt. Warum aber ist im Wittem-Code auch für die Privatkopie eine offenbar nutzungsbezogene Vergütung vorgesehen? Wie soll das abgerechnet werden? Ein Hinweis über eine ausreichende Vergütung durch Geräteabgabe oder Flat rate wird nicht gegeben.
- 34 Auch hier zeigt sich, dass die Autoren des Wittem-Vorschlag gut daran getan hätten, ihrem kodifizierten Vorschlag Erläuterungen hinzuzufügen. Vielleicht kann das noch nachgeholt werden.
- 35 Bei der geforderten Vergütungspflichtigkeit für „use for educational purposes“ (Abs. 2,b) gelten die gleichen kritischen Argumente, wie sie hier schon bezüglich Art. 5.2, Abs.2,b vorgetragen worden sind. Verblüffend zumal, dass bei „educational purposes“ überhaupt nicht weiter differenziert wird, weder horizontal noch vertikal, also z.B. nicht zwischen öffentlichen Bildungseinrichtungen und kommerziellen, oder zwischen Kindergärten, Schulen oder Hochschulen.
- 36 Schließlich hätte man bei der Überschrift von Art. 5.3 erwarten können, dass auch für den weiteren öffentlichen Kulturbereich Nutzungsregelungen getroffen worden wären. Hat man nicht eine Chance verpasst, Regelungen vorzusehen, die z.B. der Kunst zeitgemäße Formen der Nutzung urheberrechtlich geschützter Materialien erlaubten? Hatte das Wittem-Projekt keinerlei Intentionen einer Kultur des Tauschens, Adaptierens, Mixens, Weiterentwickeln etc. Rechnung zu tragen? Muss ja nicht gleich HipHop im Urheberrecht vorkommen¹³. Hat man nicht erwogen, dass die meisten der unter Art. 5.2 und 5.3 angesprochenen Nutzungen der Beförderung der immateriellen Gemeingüter Rechnung tragen, die nicht in erster Linie unter den kommerziellen Primat gestellt werden sollten?
- 37 (5-3) Etwas versteckt findet man in Art. 5.4 dann doch einen wirklich innovativen Vorschlag. Hier werden Schrankenbestimmungen vorgeschlagen, durch die der wirtschaftliche Wettbewerb gefördert werden soll. Einigen Nutzungen sollten dabei sowohl genehmigungs- als auch vergütungsfrei sein, z.B. für Werbungszwecke oder für das *Reverse Engineering*.
- 38 Folgenreicher dürfte eine zweite Gruppe sein, bei der „news articles, scientific works, industrial designs, computer programs and databases“ tatsächlich genehmigungsfrei genutzt werden dürfen – allerdings auch nur dann, wenn dies aus Wettbewerbsgründen erforderlich ist, wenn der Rechteinhaber die Nutzung über Lizenz verweigert hat und wenn – wie gehabt – der Dreistufentest dabei nicht verletzt wird. In dieser Hinsicht wird die wirtschaftliche Nutzung dann doch nicht ganz derjenigen in Bildung und Wissenschaft gleichgestellt. In der Tat ist es stark innovationshemmend, wenn in jedem einzelnen Fall der Nutzung um Erlaubnis nachgefragt werden muss. Sinnvoll wäre es sicher auch gewesen, wenn die Nutzung durch *Information Broker*, die ja der Wirtschaft durch ihre Recherchen zuarbeiten, ebenfalls explizit aufgeführt worden wäre¹⁴.
- 39 Kühn auch der Vorschlag, bei der für diese Gruppe vorgesehenen Vergütung die Verwertungsgesellschaften mit Pauschalvergütungen außen vor zu lassen. So muss die Idee der „negotiated remuneration“ wohl gedeutet werden: „means that the compulsory license fee is to be negotiated in individual cases, and therefore does not imply a role for collective rights management.“ (FN 54 im Wittem-Text). Ob dies wirklich wegweisend sein kann, könnten nur Feldversuche klären. Die Gefahr besteht zweifellos, dass hier Großunternehmen zu besseren Konditionen kommen können als die eher innovationsfördernde mittelständische Wirtschaft. Aber immerhin – die Vorschläge in Art. 5.4 zeigen doch, dass Neuland betreten werden kann und dass experimenteller Spielraum auch von den Gesetzgebern gegeben werden sollte.

F. Schluss – gut, aber dann doch nicht wirklich wegweisend

- 40 Der *Code* ist keineswegs als der Versuch anzunehmen, eine Konzeption für ein umfassendes, zeitgemäßes Urheberrecht zu entwickeln, die der Politik gleichsam als eine regulative Idee vorzugeben wäre. Niemand wird erwarten, dass eine solche Konzeption von der Politik dann gänzlich in der Praxis umgesetzt wird – aber ohne Leitvorstellungen wird Politik nicht angemessen „handeln“, sondern eher nur – im Kantischen Sinne – „hantieren“, also nicht zielorientiert vorgehen, sondern nur handwerkliche Modifikationen am Bestehenden vornehmen. Warten wir also weiter auf einen richtungsweisenden Entwurf (vielleicht auch aus dem Wittem-Projekt) – wenn denn die Urheberrechtswissenschaftler es wagen, die Grenzen des Vorgegebenen zu überschreiten.
- 41 Natürlich folgt die heutige Rechtswissenschaft keineswegs mehr radikal der reinen Rechtslehre im Sinne von Hans Kelsen, nach dem es Ziel der Jurisprudenz sei, „ausschließlich und allein, das positive Recht zu beschreiben, die Frage zu beantworten, was und wie das Recht ist, nicht aber, wie es sein oder gemacht werden soll“¹⁵. Aber juristische Texte haben immer noch überwiegend selbst-referenziellen Charakter. D.h. Vorschläge über neue Normen oder Modifikationen bestehender Normen werden in erster Linie daraufhin abgeklöpft, ob sie mit bestehenden Gesetzen, völkerrechtlich verbindlichen Vereinbarungen oder ebenso verbindlichen Richtlinien-Vorgaben, z.BV. der EU, kompatibel sind. Dann entstehen juristisch gute Texte wie eben dieser *Code*, aber keine wegweisenden.
- 42 Eine Forderung, wie von mir in (Kuhlen 2008, 532) erhoben¹⁶, dass Juristen nicht bloß „dogmatisch kongruent und damit defensiv, sondern auch kreativ modifizierend“ vorgehen mögen, wird in der Regel zurückgewiesen. So merkt auch Eric W. Steinhauer in seiner durchaus freundlich unterstützenden Besprechung dieses Buches an: „Ein Jurist freilich, der den sicheren Boden der Dogmatik verlässt und sich auf den Treibsand visionärer Modelle begibt, hört auf, Jurist zu sein. Er agiert dann vielleicht politisch oder philosophisch, aber nicht mehr juristisch.“¹⁷ Na gut – sicher sollen nach Platon die Philosophen nicht die Politiker sein; aber ein wenig mehr über die Regulierung des Umgangs mit Wissen und Information sollten sie schon mitbestimmen dürfen. Es steht dabei zu viel auf dem Spiel, als dass dies den professionellen Juristen überlassen bleiben darf. Gebraucht sind Zwischenformen zwischen dem Treibsand visionärer Modelle und der selbst-referentiellen Dogmatik.
- 43 **The Wittem Project. European copyright code** April 2010 - www.copyrightcode.eu

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Prof. Lionel Bently, Emmanuel College and CIPIIL, Cambridge

Prof. Thomas Dreier, Institut für Informations- und Wirtschaftsrecht, Zentrum für angewandte Rechtswissenschaft, Karlsruhe Institute of Technology (KIT)

Prof. Reto Hilty, Max Planck Institute for Intellectual Property, Competition and Tax Law, Munich

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Prof. Antoon Quaadvlieg, Radboud Universiteit Nijmegen

Prof. Alain Strowel, Facultes universitaires Saint-Louis, Bruxelles

Prof. Dirk Visser, Universiteit Leiden

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- 1 Vgl. Open Letter concerning European Commission's 'Intellectual Property Package' von Bernt Hugenholtz an Dr. Jose Manuel Barroso, President of the European Commission, vom 18.8.2008. Hugenholtz' Kritik, dass die beiden Studien:
 - The Recasting of Copyright & Related Rights for the Knowledge Economy, available at: [http://Nv.vw.ivir.nl/publications/other/IViR Recast Final Report 2006.pdf](http://Nv.vw.ivir.nl/publications/other/IViR%20Recast%20Final%20Report%202006.pdf)
 - Study on the Implementation and Effect in Member States' Laws of Directive 2001/29/EC on the Harmonisation of Certain Aspects of Copyright and Related Rights in the Information Society, available at: http://www.ivir.nl/publicatioiis/guibault/Infosoc_report_2007.pdf
 "have been almost entirely ignored in the so-called 'forward looking package' on Intellectual Property that the Commission has released on July 16, 2008"; obgleich: "both studies have attracted considerable attention in scholarly circles and among stakeholders and continue to play an important role in informing the current debate on the future of copyright law and policy in the EU".
 - 2 Geiger, Christophe; Hilty, Reto; Griffiths, Jonathan; Suthersanen, Uma: Declaration. A Balanced Interpretation of the "Three Step Test" in Copyright Law 6/2008 http://www.ip.mpg.de/shared/data/pdf/declaration_three_steps.pdf
 - 3 Kreutzer, Till: Das Modell des deutschen Urheberrechts und Regelungsalternativen. Konzeptionelle Überlegungen zu Werkbegriff, Zuordnung, Umfang und Dauer des Urheberrechts als Reaktion auf den urheberrechtlichen Funktionswandel, Nomos Verlagsgesellschaft, Baden-Baden 2008; vgl. auch (Kreutzer 2010) – Referenz in Anm. 7; Hansen, Gerd: Warum Urheberrecht? Die Rechtfertigung des Urheberrechts unter besonderer Berücksichtigung des Nutzerschutzes. Schriftenreihe zu Bildung und Kultur Band 4. Nomos Verlagsgesellschaft, Baden-Baden 2009
 - 4 Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society. *Official Journal L 167*, 22/06/2001 P. 0010 – 0019 "(1) The Treaty provides for the establishment of an internal

market and the institution of a system ensuring that competition in the internal market is not distorted. Harmonisation of the laws of the Member States on copyright and related rights contributes to the achievement of these objectives.”
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=CELEX:32001L0029:EN:HTML>

- 5 Study on the Implementation and Effect in Member States’ Laws of Directive 2001/29/EC on the Harmonisation of Certain Aspects of Copyright and Related Rights in the Information Society, available at: http://www.ivir.nl/publicatiois/guibault/Infosoc_report_2007.pdf

Vgl. Mireille van Eechoud, P. Bernt Hugenholtz, Stef van Gompel, Lucie Guibault and Natali Helberger: HARMONIZING EUROPEAN COPYRIGHT LAW The Challenges of Better Lawmaking. Kluwer Law International 2009
<http://www.kluwerlaw.com/Catalogue/titleinfo.htm?ProdID=9041131302>

Vgl. Manuel Medina Ortega; Entwurf eines Berichts über den Bericht der Kommission über die Anwendung der Richtlinie 2001/29/EG zur Harmonisierung bestimmter Aspekte des Urheberrechts und der verwandten Schutzrechte der Informationsgesellschaft (2008/2121(INI))
http://www.europarl.europa.eu/meetdocs/2004_2009/documents/pr/744/744876/744876de.pdf

- 6 Vgl. Reto Hilty: Sündenbock Urheberrecht? In: Ohly, A. / D. Klippel (Hrsg.): Geistiges Eigentum und Gemeinfreiheit, Bd. 11 der Schriftenreihe: Geistiges Eigentum und Wettbewerbsrecht. Tübingen, Mohr Siebeck, 2007, S. 107 - 144 „Es gibt keine Naturgesetzlichkeit, gestützt auf welche das Urheberrecht als etwas ganz anderes zu behandeln wäre als alles andere. Realität ist vielmehr, dass das Urheberrecht – wie die gewöhnlichen Schutzrechte auch – längst zu einem ganz gewöhnlichen, ja sogar ausgesprochen wichtigen, aber auch entsprechend hart umkämpften Faktor unserer Volkswirtschaft geworden ist“ (111).
- 7 Vgl. Kuhlen, Rainer: Hypertext. Ein nicht-lineares Medium zwischen Buch und Wissensbank, Springer Verlag: Heidelberg 1991
- 8 Kreuzer, Till: Den gordischen Knoten durchschlagen – Ideen für ein neues Urheberrechtskonzept. In: Copy.Right.Now! Plädoyers für ein zukunftstaugliches Urheberrecht. Schriftenreihe zu Bildung und Kultur Band 4. Hrsg. von der Heinrich-Böll-Stiftung In Zusammenarbeit mit iRights.info. Berlin April 2010, 45-55
http://www.boell.de/downloads/2010-04-copy_right_now_zukunft_urheberrecht.pdf
- 9 Vgl. z.B. Hugenholtz, P. Bernt; Okediji, Ruth L.: CONCEIVING AN INTERNATIONAL INSTRUMENT ON LIMITATIONS AND EXCEPTIONS TO COPYRIGHT. FINAL REPORT March 06, 2008
<http://www.ivir.nl/publicaties/hugenholtz/finalreport2008.pdf>
- 10 Die Generalsekretärin der ARD, Verena Wiedemann, hatte schon auf ihrer Rede auf dem Leipziger Bibliothekartags von 2007 die Unterscheidung von analogem und digitalem Online-Angebot kritisiert, die es bislang den öffentlich-rechtlichen Rundfunkanstalten untersagt, ihre mit öffentlichen Mitteln erstellten Angebote frei ins Internet zu stellen: „Die Online-Welt“, so kritisiert Wiedemann, „gehöre nicht zu unserem öffentlich-rechtlichen Programmauftrag, so das Postulat. Unsere Wissensgesellschaft, so die Essenz dieser Forderungen, gehört nicht der Allgemeinheit, sondern dem Markt“. Wiedemann befürchtet, dass sich der bei den öffentlichen Bibliotheken deutlich in den negativen Konsequenzen sichtbare Trend auch bei den öffentlich-rechtlichen Rundfunkanstalten fortsetzen wird. Das sei nicht hinzunehmen: „Was uns, die ARD und die BID verbindet, ist die unbedingte Verpflichtung auf die Interessen unserer Nutzer, das heißt also nicht die Verpflichtung auf den „shareholder value“, son-

dern auf den „public value“. „Als Gesellschaft dürfen wir es aber nicht hinnehmen, dass vergleichsweise wenige Marktteilnehmer für sich beanspruchen, ausgerechnet in dem historischen Augenblick, in dem die Menschheit in die Lage versetzt wird, durch die technische Entwicklung alle physischen Barrieren für den Zugang zum kulturellen Erbe und zum Wissen zu überwinden, diesen öffentlichen Raum zu privatisieren und allein den Interessen von Aktionären zu unterwerfen.“ Zitate aus: „Freier Zugang zur Information als Grundrecht für eine moderne Gesellschaft“ Festvortrag anlässlich der Eröffnungsveranstaltung von Dr. Verena Wiedemann, ARD-Generalsekretärin, vor dem BID am 19. März 2007 in Leipzig (3. Leipziger Kongress für Information und Bibliothek)
http://www.opus-bayern.de/bib-info/volltexte/2007/417/pdf/Rede%20Leipzig_VWiedemann_%20M%E4rz%202007.pdf

- 11 Ähnliche Bedenken des Missbrauchs wurden in den 70er Jahren des vergangenen Jahrhunderts geäußert, als man die Forderung nach freiem Zugang zu den Online-Datenbanken der öffentlich geförderten Fachinformationszentren für die Endnutzer in Bildung und Wissenschaft zurückweisen wollte. Befürchtet wurde, dass jede/r beliebige Recherchen durchführen und sich so massenhaft eigene Datenbestände aufbauen würde. Dies Furcht war und ist unbegründet. Unter der Gewissheit, dass erneute Zugriffe immer wieder möglich sind, wird tatsächlich nur recherchiert und genutzt, was im Zusammenhang aktueller Arbeit gebraucht wird. Ähnlich verhält man sich ja auch bei den Suchmaschinen im Internet.
- 12 Lars Fischer (Hauptpetent) Petition: Wissenschaft und Forschung - Kostenloser Erwerb wissenschaftlicher Publikationen vom 20.10.2009
<https://epetitionen.bundestag.de/index.php?action=p petition%3bsa=details%3bp petition=7922>
 Aktionsbündnis Urheberrecht für Bildung und Wissenschaft: „Urheberrechte von wissenschaftlichen Autorinnen und Autoren stärken und Open Access befördern – Ergebnisse von mit öffentlichen Mitteln geförderter Forschung kostenfrei zugänglich machen“ Zusatzpetition zur Petition von Lars Fischer
<http://www.urheberrechtsbuendnis.de/docs/Aktionsbuendnis-petition-open-access-ergz-zu-LarsFischer250110.pdf>
 Beide Petitionen werden vom Bundestag zusammen behandelt – allerdings wann, ist zur Zeit (0710) durchaus noch offen.
- 13 Vgl. Jan Simon: HipHop Urheberrecht. Die Rechtsprechung beeinflusst die Kunst. HipHop würde anders aussehen, wenn Sampling frei wäre. Vier prominente Fälle - <http://de-bug.de/mag/3650.html>
- 14 Dies hatte ja schon einmal Hilty vorgeschlagen. Hilty, R M (2009). Ungereimtheiten auf der urheberrechtlichen Wertschöpfungskette: der Wissenschaftsmarkt als Prüfstein für die urheberrechtliche Zwangslizenz. In: Hilty, R M [et al.]. Schutz von Kreativität und Wettbewerb: Festschrift für Ulrich Loewenheim zum 75. Geburtstag. München (Germany), 119-135
- 15 Zitiert nach: <http://www.wienerzeitung.at/linkmap/personen/kelsen.htm>
- 16 Kuhlen, Rainer: Erfolgreiches Scheitern – eine Götterdämmerung des Urheberrechts? Schriften zur Informationswissenschaft; Bd. 48. vwh - Verlag Werner Hülsbusch: Boizenburg 2008
- 17 In: Forum Buch und Bibliothek BuB 10/2009, 741-745

The Law Applicable to Online Copyright Infringements in the ALI and CLIP Proposals:

A Rebalance of Interests Needed?*

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Abstract: The article discusses the problems of applicable law to copyright infringements online. It firstly identifies the main problems related to the well established territoriality principle and the *lex loci protectionis* rule. Then; the discussion focuses on the “ubiquitous infringement” rule recently proposed by the American Law Institute (ALI) and the European Max Planck Group for Conflicts of Law and Intellectual Property (CLIP). The author strongly welcomes

a compromise between the territoriality and universality approaches suggested in respect of ubiquitous infringement cases. At the same time; the paper draws the attention that the interests of “good faith” online service providers (such as legal certainty and foreseeability) have been until now underestimated and invites to take these interests into account when merging the projects into a common international proposal.

Keywords: applicable law; copyright; Internet; ALI; CLIP; ubiquitous infringement; territoriality

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1 Since the turn of the century, the law applicable to copyright infringements committed in electronic networks has become one of the most discussed topics in both the doctrine and the practice of copyright law. As online infringements are *per se* cross-border, private international law issues have also gained increasing attention, at least in the doctrine. However, in court practice their importance is still underestimated – few decisions thoroughly discuss jurisdictional questions, and even fewer mention issues related to applicable law. Yet when the courts have found answers to the still very problematic substantive law questions (e.g., indirect liability, copyright exceptions online), the attention toward international private law issues will most likely increase. Meanwhile, the rules of international private law need to be updated to the new demands of the online environment.

2 This paper will first give a short overview of the main problems of applicable law to copyright infringe-

ments. Apart from the general problems, attention will be focused on whose interests – those of right holders or users (potential infringers) – are favored by existing practice. Second, the paper will focus on how the identified problems are solved, in particular, whether the interests of parties are balanced in the two most recent proposals on jurisdiction, applicable law, and recognition and enforcement of judgments in intellectual property from the American Law Institute (ALI) and the Max Planck Group on Conflict of Laws in Intellectual Property (CLIP). The analysis will be limited to the issues related to copyright (not other intellectual property rights), applicable law (not jurisdiction), and infringements (not licensing); the sensitive initial ownership issue will be excluded from the scope of this paper.

A. Problem Identification

- 3 It is accepted in most countries that copyright (its existence, scope, duration, etc.) is limited to the territory of a particular country (the “territoriality principle”) and that copyright infringements are adjudicated under the law of the protecting country (the “*lex loci protectionis*” rule).¹ Both the territoriality principle and the *lex loci protectionis* rule, however, have numerous problems. To mention only a few: the territoriality principle, as a principle of substantive law, is agreed to be an ambiguous concept without any clear meaning,² its scope is more flexible than might be expected,³ and it seems to lose its ground in the context of ever more harmonized copyright laws and ever more globalized copyright commerce, especially on the Internet.⁴ *Lex loci protectionis*, as a rule of applicable law, is no less problematic. It has no clear source at the international level⁵ and is rarely found in national statutes.⁶ The Rome II Regulation⁷ codified *lex loci protectionis* for intellectual property disputes in the EU,⁸ but its scope remains unclear.⁹ It is further doubted whether the territoriality principle, as a substantive law principle, indispensably leads to the *lex loci protectionis* as an applicable law rule.¹⁰ Also, delimitation of *lex loci protectionis* from other applicable law rules – especially from the *lex loci delicti* rule – is not clear in either doctrine or court practice.¹¹
- 4 Most importantly, it is argued here that the application of the *lex loci protectionis* rule in online infringement cases has led to the imbalance of interests between right holders and users. When the content is made available over the Internet, *lex loci protectionis* allows the right holder to pursue the infringement under the law of each country where the work has either been uploaded or could be potentially accessed (in most cases, worldwide).¹² This enables right holders who have sufficient resources¹³ to identify and claim the most protective law in the case (“race-to-the-top” effect).¹⁴ Although formally the relief acquired under one country’s law should be limited to its territory, in practice it often has extraterritorial effects.¹⁵ Meanwhile the user (both an intermediary service provider (ISP) and a private consumer) who makes the works available online faces a threat to be sued under any law where the work can be accessed and thus should accommodate its conduct to (almost) each law worldwide. This causes great legal uncertainty and hampers the development of legitimate online businesses.
- 5 Recently, the courts have started applying the “market effect” doctrine, which was initially proposed by World Intellectual Property Organization (WIPO) for online trademark cases.¹⁶ It defines the infringement as occurring only in the countries where the conduct had a commercial effect.¹⁷ Its application to copyright cases, however, has been of little effect

until now. Although mere access to content in the country is no longer sufficient to claim an infringement under its laws, the courts are often satisfied with minimum connecting factors to establish sufficient connection to the forum country.¹⁸ Thus, online copyright infringement can still be found under multiple national laws, and the legal uncertainty problem is barely limited.

- 6 Moreover, despite the territorial nature of copyright, the remedies granted on the basis of a single applicable national law often have extraterritorial effects: a domestic injunction often leads to the overall shut-down of the website; damages are often calculated on the basis of overall access numbers regardless of where the access originates from. This may lead to problems of conflicting or overlapping remedies. For instance, an injunction granted under the law of one country may prevent conduct that is legitimate in another country (the conflicting injunctions problem).¹⁹ Alternatively, when the conduct is illegal in several countries and the courts grant damages independently from each other, the overall damage granted may eventually exceed the actual harm (the cumulative damage problem).²⁰ Certainly, the courts could try to limit the remedies to a specific country (e.g., by ordering the application of measures limiting geographical access to the website or calculating damages on the basis of local access figures). Even if this becomes ever more technologically possible and economically reasonable (which may take some time), it is questionable if such “reterritorialization” of remedies would be suitable in all cases. For instance, this would require right holders even in obvious mass-scale infringement (“piracy”) cases to prosecute the infringer separately under the law of each protecting country.
- 7 In sum, the territorial approach and the adherence to a strict *lex loci protectionis* approach, as currently applied in court practice, have led to an imbalance of interests between the parties – they allow the right holder to claim for infringement under the most protective law and, in many cases and despite the formal limitation by the territoriality principle, to obtain a remedy with extraterritorial effects. Meanwhile, Internet users (both ISPs and consumers) are subject to numerous applicable laws and face the problem of conflicting or overlapping remedies. It remains to be seen whether the recent proposals by the ALI and the draft CLIP proposals may help to reestablish the necessary balance of interests.

B. ALI and CLIP Proposals

- 8 After the Hague convention on rules of jurisdiction and recognition of judgments²¹ failed and only a much more limited Convention on Choice of Court Agreements²² could be agreed on, the American Law

Institute started working on the Principles on Jurisdiction, Applicable Law, and Recognition and Enforcement of Judgments in Intellectual Property (ALI Principles),²³ which were issued in 2008. In 2009 a preliminary draft of the European counterpart was made available by the Max Planck Group on Conflict of Laws and Intellectual Property (CLIP Proposal).²⁴ Neither of these has binding legal value;²⁵ instead, they both intend to provide guidelines for courts, legislative bodies, or international organizations on international private law issues in cross-border intellectual property disputes.²⁶ Taking into account that both projects involved numerous internationally recognized scholars from various countries, and they are the first international initiatives of such extent,²⁷ they may have a far-reaching international impact. Already today the academic debate in other major IP jurisdictions such as Japan is taking notice of both projects to gain inspiration for a possible amendment of domestic rules.²⁸

- 9 Although the ALI and CLIP proposals represent different traditions – common and continental law – they have resulted in rather similar sets of rules. As far as law applicable to copyright infringements is concerned, both proposals, first, retain *lex loci protectionis* as a main applicable law rule.²⁹ Both groups thereby reaffirm the remaining relevance of the territorial approach despite the ever-increasing globalization and international harmonization of copyright laws. The proposals also constitute the first attempts at the international level to explicitly formulate the *lex loci protectionis* rule and define its scope. Second, both proposals suggest similar “ubiquitous infringement” rules devoted to online infringements.³⁰ Third, they introduce a limited party autonomy principle in infringement cases.³¹ Such party autonomy has so far been rejected³² and thus should be welcomed as a step toward higher efficiency of proceedings in cross-border cases. However, the proposals differ on the very sensitive issue of initial ownership.³³ As another difference, the CLIP Proposal incorporates a modified market effect rule – the “*de minimis* rule”. It allows finding the infringement under the law of a specific state only when the defendant has “substantially acted” or his/her conduct has led to “substantial effects” or was directed to that state.³⁴ The ALI Principles, on the other hand, do not contain any similar explicit provision.³⁵
- 10 The following paragraphs will focus on whether the ubiquitous infringement rule proposed by the ALI and CLIP Groups reestablishes the balance of the interests between right holders and users. After an overview of the main features of the ubiquitous rule, more attention will be given to its applicability, the closest connection rule, and an exception to it.

I. Ubiquitous Infringement Rule: Main Features

- 11 In both the ALI and CLIP proposals, the ubiquitous infringement rule contains three main parts.³⁶ First, both proposals subject ubiquitous infringements to the “closest connection rule.” More specifically, the ALI Principles subject the ubiquitous infringement to the law or laws having a “close connection” to the dispute,³⁷ whereas the CLIP Proposal refers to the law having the “closest connection.”³⁸ Second, each proposal provides for an exemplary list of factors on which the “close/closest connection” basis is to be determined. The ALI Principles include broad criteria that appear to be neutral of the parties’ role as right holder or infringer, such as both parties’ residence, the pre-existing relationship between parties, the extent of both parties’ activities, and the investment of the parties as well as the place of the affected markets.³⁹ In a slightly different manner, the CLIP Proposal contains factors that are more infringer-oriented and slightly more narrowly defined.⁴⁰ Third, both rules provide for an exception to the closest connection test. Leaving aside slight differences in wording,⁴¹ both proposals essentially allow any party to prove that the law of another country connected to the dispute would lead to another solution that should be taken into account when determining the remedies. This exception allows parties to retreat back to the territorial approach and apply separate national laws when they contain provisions favorable to any of the parties (hereafter – “retreat to territoriality” exception).
- 12 The expected effect of the rule could be demonstrated by the following example. A defendant residing in Germany made available on a German-language website short extracts of a musical work belonging to the plaintiff residing in the US. The court applied German law as the law having the closest connection with the dispute (because the defendant resides in Germany, the defendant’s physical conduct took place in Germany, and the website targeted primarily the German market) and granted international relief based on German law. The defendant, however, proved that the use of short extracts of a work constitutes fair use in the US, and the court thus limited the remedies accordingly – the injunction and damages excluded activity in US territory.

II. Applicability

- 13 The first issue that deserves a closer look is the scope of application of the rule. Under the ALI Principles, the ubiquitous infringement rule “may” be applied when two conditions are met – when there is a “ubiquitous activity” and “when the laws of multiple States are pleaded.”⁴² Similarly, the CLIP Proposal stipulates that the rule “may” be applied in respect

of infringement occurring over “ubiquitous media” when the infringement “arguably takes place in every State where the signals can be received.”⁴³ This non-compulsory application of the rule and two cumulative requirements (ubiquitous conduct/media and worldwide/multiple-state infringement) may be of more significance than it may seem from the first glance.

1. Cumulative conditions: Ubiquitous conduct and worldwide infringement

14 First of all, it is questionable whether all online infringements would meet both conditions set in the ALI and CLIP proposals. The requirement of ubiquitous, or “instantaneous and worldwide,”⁴⁴ conduct/media was meant to exclude offline multi-state infringements from its scope.⁴⁵ However, one could wonder whether it could lead to the exclusion of some online cases. For instance, there are websites that limit access geographically, and thus they are not accessible worldwide.⁴⁶ Will they qualify as “ubiquitous conduct”? Also, the worldwide/multi-state infringement requirement suggests that the only cases that are covered are those where the violation of copyright is arguably occurring in each country worldwide (ALI – in multiple states). There will be numerous cases where such worldwide/multi-state infringement is not obvious – *e.g.*, because of a different scope of protection in different countries.⁴⁷ Also, when the case concerns Internet-specific uses (*e.g.*, thumbnails, search of snippets from books) whose (il)legality has not yet been clarified in many jurisdictions, the court is unlikely to assume “worldwide infringement.” Thus, the ubiquitous infringement rule is likely to apply only to obvious online infringement (“piracy”) cases.

2. “May,” not “shall”

15 Second, the use of “may” and not “shall” in the wording of the rule suggests that the ubiquitous infringement rule, even if all requirements are met, will not necessarily apply to online cases. This raises a question as to who may decide on the applicability of the rule – the court or (also) the plaintiff (normally the right holder). Neither of the proposals gives an explicit answer. However, it is likely that the rule will be applied only at the request of the plaintiff – if the right holder prefers to prosecute an online infringement in a single state, he/she shall not be prevented from doing so. Obviously, the right holder will request to apply the ubiquitous infringement rule only if it would lead to a more favorable solution than other rules.

3. Lex loci protectionis and de minimis rules: For online cases?

16 When the ubiquitous infringement rule is not applied (because any of two requirements is not met or because the right holder does not express a wish to apply it), the next question is what rule applies to online infringements in these cases. It seems that the *lex loci protectionis* and the *de minimis* provisions, as generally applicable rules, come into play.⁴⁸ As argued earlier, their application is generally more advantageous for the right holders – they can choose to claim the most favorable law and acquire the remedies which, despite a formally valid territoriality principle, may have extraterritorial effects in online disputes. For the users, this means that they could be sued under (almost) any law worldwide, and decisions adopted by several courts simultaneously may lead to conflicting or cumulative remedies.

17 As far as cumulative and conflicting remedies are concerned, neither proposal seems to suggest specific solutions to this problem.⁴⁹ Interestingly, the 2001 WIPO Recommendation on the use of signs online already devoted much attention to the extraterritorial effects of remedies.⁵⁰ In regard to the problem of multiple laws being applicable, as mentioned above, the courts have already tried to come to a certain limitation by applying only those laws where a significant (market) effect could be found. Could this problem be solved with the help of a similar *de minimis* rule as found in the CLIP Proposal?⁵¹ As discussed above, the market effect rule has not significantly limited the number of applicable laws – national courts easily establish at least a certain connection to the forum and apply domestic law. The *de minimis* rule, as formulated in the CLIP Proposal, seems to set an even lower threshold. First, it allows finding for infringement not only in the country where a significant *effect* is established but also where a significant *conduct* takes place. Thus, if the person uploaded content from country A to the website accessible only in country B (thus causing no direct effects in country A), the infringement could still be found in country A because the significant conduct – the uploading act – took place there. This is advantageous for the right holders as it helps to effectively prevent the action under the law of the country of conduct, in case the country of effects has weaker protection. For the user, however, it has consequences similar to those of the Bogsch theory: the conduct is subjected both to the law of the place of emission and to (numerous) laws of the place of reception. Second, even if both the conduct and effect in a specific country are *de minimis*, the court may derogate from the *de minimis* rule and still apply the law of that country “when reasonable under the circumstances of the case.”⁵² Initially this could have been justified, *e.g.*, in specific copyright cases where the violation of moral rights does not lead to any

identifiable economic effects on the market. However, after eliminating “economic” from the definition of the *de minimis* rule and introducing “place of conduct” as an additional connecting factor, it is questionable whether the exception is still needed for such or similar cases. As a result, the *de minimis* rule, when applied to exceptional online cases, is not intended to significantly decrease the number of multiple potentially applicable laws and is likely to cover only clear “overspill” cases.⁵³

- 18 Thus, because of a narrow application of the ubiquitous infringement rule, it is likely that a problematic *lex loci protectionis* will still apply to many online copyright cases; the *de minimis* rule, if compared to a traditional (market) effect rule, is even less likely to diminish its problems.

4. Secondary infringement: Unsolved issue

- 19 In addition, it is not clear how the ubiquitous infringement rule would be applied to secondary (or indirect) infringement, which is especially relevant in cases of ISP liability. Traditionally, the courts tend to subject secondary infringements to the law regulating the main (primary) infringement.⁵⁴ This practice becomes especially problematic in case of ISP liability. Normally, there are multiple primary infringements by Internet end users, which might be subject to different laws. It is thus not clear which “law of primary infringement” will be applied to the secondary infringement. Still, neither proposal clarifies whether secondary infringements “follow” primary infringements,⁵⁵ or whether they could be autonomously subject to the ubiquitous infringement rule.⁵⁶
- 20 Overall, the scope of application of the ubiquitous infringement rule seems to be rather narrow and not entirely clear. It is likely to be applied only when the plaintiff claims it – this choice is normally reserved for the right holder, unless the alleged infringer brings the case to court first (e.g., with an action for a declaration of non-infringement). Also, it is not clear whether all online cases will meet the two requirements of ubiquitous media/conduct and worldwide/multi-state infringement. If these requirements are not met, online infringement will be subject to the traditional *lex loci protectionis* rule, which tends to favor the right holder and may be a significant obstacle for worldwide Internet services, as it leads to the application of multiple laws and may result in cumulative or conflicting remedies and thus a regulatory “race to the top.” The market effect rule was supposed to limit the former problem; however, the *de minimis* rule, as suggested in the CLIP Proposal, is likely to have even fewer positive effects in regard to the multiple applicable law problem than could

be expected from the market effect rule. In addition, the law applicable to secondary infringements remains unanswered in both proposals. Thus, it is unclear if and how the ubiquitous infringement rule will be applied in respect of ISPs, which have to deal mainly with secondary liability claims.

III. Close/Closest Connection Rule

- 21 The second issue worthy of consideration is the closest connection rule, a core of both provisions on ubiquitous infringement. It subjects the overall ubiquitous infringement to a single law with the closest connection. Closest connection is to be determined by taking into account all relevant factors – the ALI and CLIP proposals provide only an exemplary list of them.⁵⁷ With this rule, the ALI and CLIP Groups first sought to enable the application of a single law (universality approach) to all online infringement and to acquire worldwide remedies. Second, they intended to avoid the situation where the user moves to the country with the least protection (“forum shopping”), which would lead to the overall decrease of copyright protection (“race to the bottom”). These problems are normally associated with other doctrines that follow the universality approach.⁵⁸

1. Single applicable law: Not really?

- 22 With regard to the first goal, the application of a single law to the entire online infringement is generally advantageous both for the right holders and the users. For the former, it means the acquisition of worldwide remedies on the basis of a single law. For the latter, it eliminates the problem of multiple applicable laws and, simultaneously, the danger of cumulative or conflicting remedies granted under different laws.
- 23 However, it should be noted that the ALI Principles refer to “the law or laws of the State or States” instead of “a (single) law.”⁵⁹ The effect of this formulation is not entirely clear. First, such wording may merely mean that the court can also apply the law as invoked by a party under the “retreat to territoriality” exception.⁶⁰ However, this possibility is already implied by the exception itself. A specific reference to the exception in the closest connection rule seems both redundant and may even be contradictory.⁶¹ Second, it could mean that different issues (existence, scope, duration, remedies, etc.) may be subject to different laws (“*dépeçage*”). However, such *dépeçage* is possible when applying a similar rule found in the US Restatement of the Laws (Second), although it refers only to “a law.”⁶² Therefore, a third interpretation seems to reflect what the authors meant – if a dispute has a close connection

with more than one country, several laws are to be applied. The open wording of the provision is not surprising, taking into account the innovative nature of the rule. However, this weakens at the same time the potential effectiveness of a single law approach – it remains possible that several laws will apply, though it cannot be foreseen in what cases and which laws.

- 24 Furthermore, the ALI Principles refer to a “close” instead of the “closest” connection.⁶³ Many laws may have a “close” connection. It is likely that most courts that find sufficient grounds to establish jurisdiction over the dispute would also find that the law of the forum has a sufficiently “close” connection to the dispute.⁶⁴ This allows right holders, when choosing a court, to simultaneously choose the applicable law. Meanwhile, the users have to simultaneously adhere to all laws potentially connected to the dispute.

2. Exemplary list of connecting factors

- 25 As far as potential dangers of “forum shopping” or the “race to the bottom” are concerned, the close/closest connection rule doubtlessly eliminated them. The law with the close/closest connection is determined by taking into account all relevant factors; the exemplary factors are defined broadly, especially in the ALI Principles.⁶⁵ Thus, the potential infringers cannot manipulate the applicable law by changing their place of establishment or their online conduct, as those factors are not the only factors that determine the law applicable to the dispute.
- 26 On the other hand, an exemplary and non-mandatory list of factors contains a problem of legal uncertainty and lack of foreseeability for both parties. Right holders cannot exactly foresee which law the court will apply. However, as mentioned above, if only a “close” connection is required, the courts will most often apply forum law, and it is the right holder who normally chooses the forum.⁶⁶ The situation of users is more problematic. From the exemplary list of factors, they cannot foresee the law applicable to the dispute. Such legal uncertainty and lack of foreseeability hampers the development of legitimate online services, as well as a reduction of online piracy.⁶⁷ It is worth noting that in its early drafts, the CLIP Proposal contained a “defendant’s residence” rule.⁶⁸ However, it was suggested only as a “last resort” when the law with the “closest connection” cannot be determined, not as a default rule. It is thus doubtful whether it could have brought more legal certainty. In comparison, under continental tradition, torts are normally subject to specific and well-defined conflict rules, whereas the “closest connection” rule serves as an exception.⁶⁹
- 27 Thus, the closest connection rule is likely to facilitate the enforcement of ubiquitous infringements by formally enabling right holders to acquire worldwide relief under a single (most likely, forum) law. At the same time, the rule reduces the potential for “forum shopping” by users and the risk of a “race to the bottom” of copyright protection. Although such a single-law (or universality) approach could be generally advantageous for users (no multiple applicable laws leading to cumulative or conflicting remedies), the loose formulation of the closest connection rule (“law and laws” and “close connection”) and a merely exemplary list of broad connecting factors do not ensure the necessary degree of legal certainty and foreseeability in online cases.

IV. “Retreat to Territoriality” Exception

- 28 Finally, both proposals contain an exception to the closest connection rule. In short, any party may prove that the law of another state (than the one to which the law has the closest connection) provides a solution that differs from that obtained under the law(s) chosen to apply to the case as a whole; this differing law should be taken into consideration when determining the remedy.⁷⁰ With this rule, both the ALI and the CLIP Groups presumably intended to preserve the territorial interests of the states. Importantly, diverging national copyright laws may be raised only on the initiative of any of the parties and may influence only the remedies, not the liability issues. It is true that this exception “might lead to as much litigation over the content of foreign law as would serial application of the laws of each State for which protection is sought.”⁷¹ However, the legitimate interest of states to enforce differing territorial laws remains relevant in online disputes as well.
- 29 With regard to the interests of parties, it seems that the exception primarily serves the interests of the users. When a plaintiff (normally the right holder) requests worldwide relief under a single applicable law, the exception allows a defendant (normally the user) to invoke a law that leads to a different solution, obviously favoring the defendant. Defendants are currently able to dispute the applicability of the forum law in respect of uses originating in foreign countries, and courts are formally under the obligation to grant remedies limited to the territory of the country whose law is being applied (the territorial approach). However, defendants’ attempts to challenge jurisdiction over conduct originating abroad often fail,⁷² and courts sometimes apply the territorial approach loosely, leading to an extraterritorial effect of judgments based on a single law. The exception thus will not only allow challenge the application of domestic laws in respect of foreign conduct but will also provide defendants with an additional

possibility to claim foreign laws to make use of provisions favorable for them (e.g., on limited liability, scope of remedies). Also, this “retreat to territoriality” exception decreases the danger of conflicting or overlapping remedies. When the law different from the one applied by the court leads to different remedies, the court is obliged to take measures to avoid conflicting remedies (e.g., not to extend the injunction to a particular country).

30 The rule should thus be welcomed. Only two minor points deserve further consideration.

1. “Any party”

31 It may seem that the exception makes the situation of the right holder worse – he/she may not be sure which laws the defendant will invoke for its defense, a defense which is likely to prolong the court proceedings. On the other hand, as the rule refers to “any party,” a right holder could equally make use of the exception. For instance, if the court decides to apply German law as the law with the close/closest connection, the right holder may still claim statutory damages under the US law in respect of the US part of the infringement.

32 Equal treatment of parties to the dispute is generally understandable. The right holder, as an injured party, cannot be put in a less favorable position than the user who caused the injury.⁷³ On the other hand, the above analysis has shown that the ubiquitous infringement rule is more advantageous to the right holder in numerous aspects. For instance, the loose formulation of the close/closest connection rule and an exemplary list of flexible connecting factors are likely to lead to the application of forum law as “closely connected” to the dispute (and it is the right holder who chooses the forum). Furthermore, if a right holder is concerned that the court will find the closest connection to a law not favorable to him/her, he/she may choose to apply the *lex loci protectionis* instead, which would still lead to extraterritorial effects of the remedies in many cases. Thus, it could be disputed whether the right holder needs any additional guarantees proposed by the “retreat to territoriality” exception.

2. “Prove”

33 The last point concerns the term “prove.” Both proposals allow an interested party to “prove” that another law leads to a differing solution. Such formulation may be seen as shifting the burden of proof from the right holder to the user. Under the *lex loci protectionis* rule, it has been the right holder who has to prove that the infringement takes place in each relevant country. Under the ubiquitous infringement rule, the worldwide/multi-state infringement is as-

sumed, whereas the “retreat to territoriality” exception seems to set a duty for the defendant to prove that there is no infringement in certain countries (or that the liability is limited, less stringent remedies are available, etc.). Such shifting of burden might be reasonable in obvious “piracy” cases. However, it may be questionable in cases where the user is acting in good faith. Thus, it may be considered whether the wording “prove” should be changed to a more neutral term (such as “claim”). Then, the allocation of the burden of proof would be left to the discretion of courts in each particular case. Even if this were to weaken the position of the right holder, it may potentially strengthen the position of the user, whose interests have not been sufficiently taken into account in the current wording of the ubiquitous infringement rule.

C. Conclusion

34 The application of the territoriality principle and the *lex loci protectionis* rule to online copyright infringement cases has led to a distortion of the balance of interests between right holders and users. The current practice allows right holders to choose the most favorable law to claim for infringement and, despite the formally recognized territoriality principle, to obtain relief that often has extraterritorial effects. Meanwhile, users have to simultaneously adhere to multiple potentially applicable laws and face the danger of conflicting or overlapping remedies. Although the market effect rule, which is getting more popular in courts, may mitigate the negative effects, it does not seem to be a sufficient solution.

35 Both the ALI and the CLIP proposals, by developing a “ubiquitous infringement” rule, seek for a compromise between territoriality and universality. It is questionable, however, whether the balance of interests between right holders and users is properly defined. The ubiquitous infringement rule enables right holders to acquire, under a single applicable law, international relief in online cases. Also, the dangers of a single-law approach (such as “forum shopping” by users leading to a “race to the bottom” of copyright protection) have been eliminated by implementing a flexible closest connection rule with an open-ended list of connecting factors. In addition, if the right holders are unsure about applying the ubiquitous infringement rule (e.g., because it is uncertain which law will be found as having the “close/closest” connection), they are left with the possibility to opt for the application of the traditional *lex loci protectionis* rule – this rule has often allowed right holders to obtain national remedies with extraterritorial relief before, and this has not been effectively limited by any of the proposals. Finally, it is true that the efficiency of the court procedures may decrease if the users invoke another differing

law under the “retreat to territoriality” exception. However, this exception may be equally used by the right holder, *e.g.*, in order to obtain more extensive damages available in some jurisdictions.

- 36 The interests of the users – both ISPs and consumers – seem to cause more problems. Generally, the single applicable law is of interest for the users since it eliminates the problem of multiple potentially applicable laws as well as the danger of cumulative or conflicting remedies. However, the two cumulative conditions (ubiquitous conduct/media and worldwide/multi-state infringement) make it unclear to which online cases the rule may be applied. The uncertainty is increased further by subjecting the application of the rule to the choice of the plaintiff (right holder). It also remains undecided whether and how the ubiquitous infringement rule applies to secondary liability. Furthermore, the flexible close/closest connection rule does not allow users to foresee which law will be applied to the dispute. Thus, several laws that might have a connection to the dispute will still have to be taken into consideration when online business models are developed. Certainly, the “retreat to territoriality” exception may help users to partly defend their interests and diminish the danger of conflicting or cumulative remedies. However, it seems to transfer a duty of proof from the right holder on the user.
- 37 These issues could be further discussed when considering the possibility to merge ALI and CLIP projects into a single international proposal.

Annex

I. American Law Institute

Intellectual Property: Principles Governing Jurisdiction, Choice of Law and Judgments in Transnational Disputes (American Law Institute Publishers, St Paul, MN 2008)

(ALI Principles)

[Extract]

§321. *Law of Laws to Be Applied in Cases of Ubiquitous Infringement*

When the alleged infringing activity is ubiquitous and the laws of multiple States are pleaded, the court may choose to apply to the issues of existence, validity, duration, attributes, and infringement of intellectual property rights and remedies for their infringement, the law or laws of the State or States with close connections to the dispute, as evidenced, for example, by:

- (a) Where the parties reside;
- (b) Where the parties’ relationship, if any, is centered;
- (c) The extent of the activities and the investment of the parties; and
- (d) The principal markets toward which the parties directed their activities.

Notwithstanding the State or States designated pursuant to subsection (1), a party may prove that, with respect to particular States covered by the action, the solution provided by any of those States’ laws differs from that obtained under the law(s) chosen to apply to the case as a whole. The court shall take into account such differences in determining the scope of liability and remedies.

II. European Max Planck Group on Conflicts of Laws in Intellectual Property

Principles for Conflict of Laws in Intellectual Property, Third Preliminary Draft of 1 September 2010, available at <www.cl-ip.eu> [Accessed on 10 September 2010]

(CLIP Proposal, Third Draft)

[Extract]

Article 3:603: Ubiquitous infringement

In disputes concerned with infringement carried out through ubiquitous media such as the Internet, the court may apply the law of the State having the closest connection with the infringement, if the infringement arguably takes place in every State in which the signals can be received. This rule also applies to existence, duration, limitations and scope to the extent that these questions arise as incidental question in infringement proceedings.

In determining which State has the closest connection with the infringement, the court shall take all the relevant factors into account, in particular the following:

- the infringer’s habitual residence;
- the infringer’s principal place of business;
- the place where substantial activities in furthering of the infringement in its entirety have been carried out;

the place where the harm caused by the infringement is substantial in relation to the infringement in its entirety.

Notwithstanding the law applicable pursuant to paragraphs 1 and 2, any party may prove that the rules applying in a State or States covered by the dispute differ from the law applicable to the dispute in aspects which are essential for the decision. The court shall apply the different national laws unless this leads to inconsistent results, in which case the differences shall be taken into account in fashioning the remedy.

* The article is based on the PhD dissertation “Law Applicable to Copyright Infringements: An Analytical Comparison of the ALI and CLIP Proposals,” which was successfully defended at the Law Faculty of the Albert Ludwig University of Freiburg in July 2010 (work supervisor: Prof. Th. Dreier) and will be published by Edward Elgar Publishing in 2011. I remain sincerely grateful for Prof. Th. Dreier and CLIP Group members for their kind help and support in my research work.

- 1 The opposite “universality” principle and the corresponding *lex originis* rule is applied for copyright infringements in few countries (e.g., Greece, Romania, Portugal).
- 2 See, e.g., Wadlow, Christopher, Enforcement of Intellectual Property in European and International Law para. 1-22 (London Sweet & Maxwell 1998); Kegel, Gerhard & Seidl-Hohenveldern, Ignaz, *Zum Territorialitätsprinzip im internationalen öffentlichen Recht*, in Heldrich, Andreas & Henrich, Dieter & Sonnenberger, Hans-Jürgen, *Konflikt und Ordnung* 233-277, 234 (C.H. Beck'sche Verlagsbuchhandlung 1978).
- 3 E.g., US courts apply an exception to the territoriality principle on the basis of a so-called root copy approach: when an initial copy is made in the US, damages in respect of all copies subsequently reproduced abroad could be granted under the US law, see Geller, Paul Edward, *International Intellectual Property, Conflicts of Laws, and Internet Remedies*, E.I.P.R. 125, 129 (2000).
- 4 Cf. Schack, Haimo, *Urheber- und Urhebervertragsrecht* para. 98 (Mohr Siebeck 2007).
- 5 There is no agreement if it can be derived from Art. 5(2) of the 1886 Berne Convention for the Protection of Literary and Artistic Works, cf. Schack, supra note 3, p. 400 ff.; Drexl, Josef, *Europarecht und Urheberkollisionsrecht*, in Ganea, Peter et al. (eds.), *Urheberrecht. Gestern-Heute-Morgen* 461-479, 463 (Verlag C.H. Beck 2001).
- 6 E.g., it cannot be found in German, French, UK, or US statutes.
- 7 Regulation (EC) 864/2007 of the European Parliament and of the Council of 11 July 2007 on the law applicable to non-contractual obligations (Rome II), OJ L 199, 31.7.2007, p. 40-49.
- 8 Rome II Regulation, Art. 8.
- 9 It is not clear whether it covers only infringement-related issues (illegal acts, remedies) or also propriety-related ones (existence, scope, duration, initial ownership, transferability), see Leistner, Matthias, *The Law Applicable to Non-Contractual Obligations Arising from an Infringement of National or Community IP Rights*, in Leible, Stefan & Ohly, Ansgar (eds.), *Intellectual Property and International Private Law* (Mohr Siebeck 2009); Basedow, Jürgen & Metzger, Axel, *Lex loci protectionis europea*, in: Trunk, A. et al. (eds.) *Russia in the International Context: Private International Law, Cultural Heritage, Intellectual Property, Harmonization of Laws*. Festschrift für Mark Moiseevic Boguslavskij 153, 162 (Berliner Wissenschafts-Verlag 2004).
- 10 Drexl, Josef, *Münchener Kommentar zum Bürgerlichen Gesetzbuch*. Band 11: Internationales Wirtschaftsrecht Art. 50-245 EGBGB, para. 13 (Verlag C.H. Beck 2005).
- 11 Some seek to draw a clear distinction between the two rules, see Drexl, supra note 9, para. 12; others use the expressions “law of protecting country” and “law of the place where the infringement occurred” interchangeably, see Fawcett, James J. & Torremans, Paul, *Intellectual Property and Private International Law* 499, 501, 507 ff. (Clarendon Press 1998).
- 12 The so-called Bogsch theory.
- 13 E.g., major record companies, producers, publishers.
- 14 Certainly, the choice of right holder is limited by jurisdictional rules. However, they normally allow plaintiffs to sue under the law of the country of the “harmful event,” which would normally coincide with the “place of infringement,” see, e.g., Art. 5(3) of Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (Brussels I), *OJ L 12, 16.1.2001, p. 1-23*.
- 15 See text below; for more about the problematic of *lex loci protectionis* and remedies in multistate infringements, see Drexl, Josef, *Münchener Kommentar zum Bürgerlichen Gesetzbuch*. Band 11, *Intrnationales Immaterialgüterrecht (IntImmGR)* para. 277 et seq. (5. Aufl. Verlag C.H. Beck München 2010).
- 16 Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet, adopted on September 24 to October 3, 2001 (hereinafter – 2001 WIPO Recommendation).
- 17 See 2001 WIPO Recommendation, Art. 2 (“the use of a sign on the Internet shall constitute use in a Member State for the purposes of these provisions, only if the use has a commercial effect in that Member State (...).”)
- 18 German courts set a rather high market effect threshold in trademark cases, see, e.g., German Supreme Court decision of 13 October 2004 – I ZR 163/02 *Hotel Maritime*, 5 GRUR Int. 433 (2005) (in a trademark infringement case, court found no sufficient connection to Germany, even though the website was in German and targeted *inter alia* German audience); the threshold in copyright cases, however, seems to be lower, see, e.g., Appeals Court of Jena decision of 27 February 2008 – 2 U 319/07 *Thumbnails*, MMR 408 (2008) (German law was applied on the basis that the defendant displaced the reconfiguration of the pictures into the thumbnails in the hit list of its search engine in Germany); confirmed by German Supreme Court decision of 29 April 2010 – I ZR 69/08 – *Vorschaubilder*, GRUR 628, para. 14 (2010) (international jurisdiction of German courts has been confirmed on the basis that “the thumbnails in a search engine of the defendant can be seen (also) in Germany”); Appeals Court of Munich decision of 28 July 2005 – 29 U 2887/05 *Heise Zeitschriften*, MMR 768 (para. 22) (2005) (the fact that the website was “available in German and was directed also to German users” was sufficient to establish the jurisdiction of German courts and apply German law); Appeals Court of Dresden decision of 5 December 2006 – 14 U 1735/06 *Internet-Videorekorder*, 5 GRUR-RR, 138, 139 (2007) (“The ‘virtual videorecorder’ was directed for the use of German Internet users”); Supreme Court decision of 21 September 2006 – 29 U 2119/06 *Haftung von eBay als Mitstörer für Urheberrechtsverletzungen*, JurPC Web-Dok. 124/2006, Abs. 1-76, 46 (the connection to the country is established when the service “is in German language and directed to domestic commerce”); Supreme Court decision of 2 March 2010 – VI ZR 23/09 (a mere Internet access is not sufficient for the establishment of jurisdiction in a personality case; rather, the objective connection to the country is needed); Appeals Court of Hamburg decision of 10 March 2010 – 7 W 5/10 (the website www.google.com has a sufficient connection to Germany if the link to it is provided on the website www.google.de).

- 19 *E.g.*, in the *National Football League* case the injunction of broadcasting in the US prevented the legitimate reception of signals in Canada, see *National Football League v. PrimeTime 24 Joint Venture*, 211 F.3d 10 (2nd Cir. 2000) (USA); on the Internet, a private user condemned for sharing files under one law will have to abandon the activity overall, even if the conduct could be legal in some of the countries where the shared files had been accessed.
- 20 *E.g.*, in the *Sender Felsberg* case, collecting societies in Germany and France independently requested royalties for the same broadcasting conduct (even though there were no receptions by the public in Germany), see Supreme Court decision of 7 November 2002 - I ZR 175/00 *Sender Felsberg*, *GRUR Int.* 470 (2003) (Germany); on the Internet, a similar problem would arise if a website is made available in several countries and the website operator has to pay separate royalties to different national collecting societies.
- 21 For a preliminary draft of the Hague Convention on Jurisdiction and Enforcement of Judgments, see <http://www.state.gov/www/global/legal_affairs/991030_forjudg.html> [accessed on 2 July 2009].
- 22 Hague Convention on Choice of Court Agreements, concluded on 30 June 2005, available on <www.hcch.net> [accessed on 10 December 2010].
- 23 American Law Institute, *Intellectual Property: Principles Governing Jurisdiction, Choice of Law and Judgments in Transnational Disputes* (American Law Institute Publishers, St Paul, MN 2008).
- 24 European Max Planck Group on Conflict of Laws in Intellectual Property (CLIP), *Principles for Conflicts of Laws in Intellectual Property, Third Preliminary Draft of 1 September 2010*, available at <www.cl-ip.eu> [Accessed on 10 September 2010] (CLIP Proposal, Third Draft). In the meeting on 19-20 November 2010, the CLIP Group adopted the final CLIP Proposal; however, at the time of submission of this article for publication, it had not yet been made available to the public.
- 25 However, the ALI Restatements of Law are an important secondary source of law in US court practice; the ALI Principles have already been mentioned in, *e.g.*, *Fairchild Semiconductor Corp. v Third Dimension (3D) Semiconductor*, Decision of 10 December 2008 by District Court of Maine, Civil No. 08-158-P-H (USA); *City of New York v A-1 Jewelry and Pawn Inc.*, 247 F.R.D. 296, 337-338 (E.D.N.Y. 2007).
- 26 See CLIP Proposal, Third Draft, Preamble to Part 1; ALI Principles, § 102.
- 27 Similar projects have been developed in Japan and Korea; for a Japanese version, see Transparency Proposal on Jurisdiction, Choice of Law, Recognition and Enforcement of Foreign Judgments in Intellectual Property, available at <<http://www.tomeika.jur.kyushu-u.ac.jp/ip/proposal.htm>> [accessed 21 December 2009]; for a comparison of all three proposals, see Basedow, Jürgen, Toshiyuki Kono & Metzger, Axel, *Intellectual Property in the Global Arena: Jurisdiction, Applicable Law and the Recognition of Judgments in Europe, Japan and the US* (Mohr Siebeck 2010).
- 28 See, *e.g.*, Japanese Transparency Proposal on Jurisdiction, Choice of Law, Recognition and Enforcement of Foreign Judgments in Intellectual Property, a draft of October 2009 can be found in Jürgen Basedow et al. (eds.), *Intellectual Property in the Global Arena* 394-402 (Mohr Siebeck 2010); see also Shigeki Chaen, Toshiyuki Kono, Dai Yokomizo, *Jurisdiction in Intellectual Property Cases: The Transparency Proposal*, in: *id.*, p. 77 et seq.; Bariatti (ed.), *Litigating Intellectual Property Rights Disputes Cross-border: EU Regulations, ALI Principles, CLIP Project* (Padova 2010).
- 29 ALI Principles, § 301; CLIP Proposal, Third Draft, Art. 3:102.
- 30 ALI Principles, § 321; CLIP Proposal, Third Draft, Art. 3:603.
- 31 ALI Principles, § 302; CLIP Proposal, Third Draft, Art. 3:605.
- 32 It was explicitly prohibited in Germany and Austria and under the Rome II Regulation, Art. 8(3); for criticism, see Dickinson, Andrew, *The Rome II Regulation. The Law Applicable to Non-Contractual Obligations* para 8.54 (Oxford University Press 2008); Boschiero, Nerina, *A Commentary on Article 8 of the Rome II Regulation*, 9 Yearbook of Private International Law, 87, 107 et seq. (2007); Boer, Th. M., *Party Autonomy and Its Limitations in the Rome II Regulation*, 9 Yearbook of Private International Law 19, 26 (2007); in favor, see Basedow, Jürgen & Metzger, Axel, *Lex loci protectionis europea*, in: Trunk, A. et al. (eds.) *Russia in the International Context: Private International Law, Cultural Heritage, Intellectual Property, Harmonization of Laws*. Festschrift für Mark Moiseevic Boguslavskij 153, 160 et seq. (Berliner Wissenschafts-Verlag 2004); Buchner, Benedikt, *Rom II und das Internationale Immaterialgüter- und Wettbewerbsrecht*, 12 GRUR Int. 1004, 1008 (2005).
- 33 The ALI Principles adopt the universality approach, whereas the CLIP Proposal starts with the territoriality approach and allows territoriality exceptions only in certain cases, see ALI Principles, § 313; CLIP Proposal, Third Draft, Art. 3:201.
- 34 CLIP Proposal, Third Draft, Art. 3:602.
- 35 Interestingly, in the ALI Principles, a similar market effect rule was suggested in the Preliminary Draft as a main applicable law rule for intellectual property infringements (*i.e.*, instead of *lex loci protectionis*), see ALI Principles, Preliminary Draft, § 301(2), in Jürgen Basedow et al. (eds.), *Intellectual Property in the Conflicts of Laws* 229-250 (Mohr Siebeck 2005).
- 36 See annex to this paper for the exact citation of articles.
- 37 ALI Principles, § 313 (1).
- 38 CLIP Proposal, Third Draft, Art. 3:603(1).
- 39 ALI Principles, 313 (1) (a-d).
- 40 See, *e.g.*, Art. 3:603(2)(a) (“infringer’s habitual residence”) or (b) (“infringer’s principal place of business”).
- 41 The second sentence of the CLIP Proposal provides a more complicated formula, which, however, seems to eventually lead to the same legal consequences as the formulation in the ALI Principles.
- 42 ALI Principles, §321(1).
- 43 CLIP Proposal, Third Draft, Art. 3:603(1).
- 44 Cf. ALI Principles, Discussion Draft, 2006, §321, available (for sale) at <www.ali.org> [accessed on 12 October 2009] (“instantaneous and worldwide”).
- 45 Interestingly, at the initial stage of the ALI Project, departures from the territoriality principle were proposed for all multi-state (not only online) infringements, see Ginsburg, Jane C., *Private International Law Aspects of the Protection of Works and Objects of Related Rights Transmitted Through Digital Networks*, WIPO/PIL/01/2 of 18 December 2000, p. 11-12 available at <www.wipo.int> [accessed on 13 October 2009].
- 46 *E.g.*, some websites or content are not accessible in all countries because they are blocked by states (*e.g.*, Google, YouTube, and Wikipedia are not accessible in China) or by operators themselves (*e.g.*, eBay blocks the sale of Nazi memorabilia items in Germany in order to comply with German law).
- 47 *E.g.*, copyright protection lasts 50 years in some countries and 70 years in others; not all countries recognize the protection of performers’ rights, etc.
- 48 Alternatively, the parties are allowed to choose the applicable law; however, the choice is limited only to remedies, see ALI Principles, §302; CLIP Proposal, Third Draft, Art. 3:605.
- 49 The CLIP Proposal reiterates territoriality in respect of injunctions in Art. 2:601(1). It is doubtful, however, whether this will be sufficient – the article neither covers damages nor gives guidelines how the effect of the injunction should be limited territorially when the restriction of geographical access of the website is not feasible. Also, up to now courts have been

- bound by the territoriality principle but have often ignored it in online infringement cases.
- 50 2001 WIPO Recommendation, Arts. 13-15.
- 51 See CLIP Proposal, Third Draft, Art. 3:602: “De minimis rule: (1) A court applying the law or the laws determined by Article 3:601 shall only find for infringement if (a) the defendant has substantially acted or has taken substantial preparatory action to initiate or further the infringement in the State or the States for which protection is sought, or (b) the activity by which the right is claimed to be infringed has substantial effect within, or is directed to the State or the States for which protection is sought. (2) The court may exceptionally derogate from that general rule when reasonable under the circumstances of the case.”
- 52 CLIP Proposal, Third Draft, Art. 3:602(2).
- 53 *E.g.*, a website clearly targets only Lithuanian consumers (a website is provided in Lithuanian, the currency used is Lithuanian Litas); however, it has been accessed by two Lithuanians living in Germany. A German court could find that the infringement in Germany is *de minimis* and deny remedies under German law.
- 54 See Germany: German Supreme Court decision of 16 June 1994 – I ZR 24/92 *Folgerecht bei Auslandsbezug*, 11 GRUR, 798 (1994) (organization of the resale in Germany is not sufficient to establish the infringement under German copyright law; *i.e.*, the organization of resale is subject to the same law that regulates the resale itself); US: *Metzke v. May Dep’t Stores*, 878 F. Supp. 756 (1995) (USA) (offshore copying will infringe US law if the defendant knew or should have known that copies would be sold in the US); Denaro, James, *Choice of Law Problems Posed by the Internet and by Satellite Broadcasting*, 1(3) Tulane Journal of Technology and Intellectual Property 1, para. 51 (2000).
- 55 But see ALI Principles, §301, comment h (“facilitation of the infringement” is subject to the law of the primary infringement – the comment, however, concerns only *lex loci protectionis*).
- 56 In the present text of the CLIP Principles, there is a certain hint in Art. 3:601(2)(a). For further discussion, see Dinwoodie, Graeme B. & Dreyfuss, Rochelle & Kur, Annette, *The Law Applicable to Secondary Liability in Intellectual Property Cases*, 42 New York University Journal of International Law and Politics 201 (2010), available at SSRN: <<http://ssrn.com/abstract=1502244>> [accessed on 2 December 2009]. Just before the submission of this paper for publication, in its final draft adopted on 19-20 November 2010 (*supra* note 24), the CLIP Group for the first time formulated the rule for secondary infringements. However, it remains to be seen if it is maintained (and in which wording) in the final CLIP Principles.
- 57 The closest connection rule was inspired by the “most significant relationship” rule as found in §145 and §188(1) of Restatement of the Law (Second), Conflict of Laws 2nd (American Law Institute 1971); and §145 of Restatement of the Law (Third) of Foreign Relations Law of the United States (American Law Institute 1987).
- 58 One of them is a so-called emission theory, which subjects satellite broadcasting to a single law of the country where the signal is emitted; it was initially implemented in Art. 2(b) of Council Directive 93/83/EEC of 27 September 1993 on the coordination of certain rules concerning copyright and rights related to copyright applicable to satellite broadcasting and cable retransmission, OJ L 248, 06.10.1993, p. 15-21. The other is a “country of origin” (or “country of establishment”) doctrine (*Herkunftslandsprinzip*), which subjects online conduct to a single law of the country where the service provider is situated; it was implemented in Art. 3 of the Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market, OJ L 178, 17.7.2000, p. 1-17 (however, copyright and related rights are excluded from its scope, see Annex to the Directive).
- 59 The CLIP Proposal, Second Draft, Art. 3:201(1) also referred to “law or laws.”
- 60 See discussion below.
- 61 The “retreat to territoriality” exception allows taking into account a differing law only in respect of remedies; such a limitation cannot be found in the wording of the closest connection rule.
- 62 See Restatement of the Law (Second), *supra* note 52, §145, comment on Subsection (1)(d).
- 63 Cf. CLIP Proposal, Third Draft, Art. 3:603(1) (refers to the “closest connection”).
- 64 Such a practice currently prevails.
- 65 *E.g.*, ALI Principles, §321(1)(c) (“The extent of the activities and the investment of the parties”).
- 66 Interestingly, ALI Principles used to contain *lex fori* as a “last resort” rule, see ALI Principles, Discussion Draft, 2006, *supra* note 39, §321(2).
- 67 The connection between the development of legitimate online services and reduction of online piracy has also been highlighted by the Council of European Union, see Council Conclusions on the development of legal offers of online cultural and creative content and the prevention and combating of piracy in the digital environment of 20 November 2008, available at <http://www.consilium.europa.eu/uedocs/cms_Data/docs/pressdata/en/educ/104198.pdf> [accessed on 17 May 2009].
- 68 See Art. V.3.(3) of CLIP, Possible Structure of the Principles, Draft of 2008 (unpublished).
- 69 Cf. Rome II Regulation, Art. 4.
- 70 See ALI Principles, §321(2); CLIP Proposal, Third Draft, Art. 3:603(3).
- 71 See ALI Principles, Reporters’ Notes, p. 156.
- 72 See, *e.g.*, District Court decision *Sonofon A/S (formerly DMT2 A/S) v IFPI Danmark*, ECDR 10, 16 (2009) (Denmark) (an Internet access provider was ordered by a Danish court to terminate access to the Pirate Bay website despite the fact that the persons behind the website were domiciled in Sweden).
- 73 Cf. Kegel, Gerhard & Schurig, Klaus, *Internationales Privatrecht* 725 (9. Auflage, C.H. Bech’sche Verlagsbuchhandlung 2004).

Liability for Copyright Infringements on the Internet:

Host Providers (Content Providers) – The German Approach¹

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Abstract: Copyright infringements on the Internet affect all types of media which can be used online: films, computer games, audio books, music, software, etc. For example, according to German studies, 90% of all copyright violations affecting film works take place on the Internet.² This storage space is made available to such infringers, as well as to others whose intentions are legal, by hosting providers. To what extent do hosting providers have a duty of

care for their contribution to the copyright infringements of third parties, i.e. their users? What duties of care can be reasonably expected of hosting providers to prevent such infringements? These questions have been heavily debated in Germany, and German courts have developed extensive case law. This article seeks to examine these questions by assessing German jurisprudence against its EU law background.

Keywords: E-Commerce Directive; Liability; Host Provider; Copyright; User Generated Content; Duty of Care; Störerhaftung; Telemediengesetz

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A. Introduction

¹ Internet piracy is not a phenomenon confined to Germany. The reasons are comparable in many countries worldwide and are of a complex nature. A key reason, however, is the nature of the Internet itself. Generally speaking, the infringers are able to commit their infringing acts anonymously. Investigating the identity of the person or persons responsible is a costly, time-consuming process and is often impossible. In addition, the disadvantage of bringing an action against individual infringers is that each infringement has to be prosecuted individually – a process which is also laborious and expensive considering the sheer numbers of infringe-

ments concerned.³ Therefore, it is logical to consider taking action against suppliers of Internet services who provide infringers with the relevant infrastructure and thus make the copyright violations possible in the first place. Legal action against such providers has a much greater effect than that against individual perpetrators as the German Federal Court of Justice has already recognised.⁴ The prosecution of hosting providers and access providers is primarily conceivable;⁵ this paper is restricted to addressing the liability of hosting providers. It is limited to German case law and tries to explain it against the relevant EU law background. But, as will be shown in part III below, due to the wide applicability of German law, not only providers located in Germany are affected.

B. Types of Hosting Providers

- 2 Hosting providers (or content providers or web hosts) make Internet storage space available to others. Hosting providers' users can then save their own content there. Some business models include the hosting provider appropriating this – actually external – content so that one can no longer really call it third-party content. However, these cases are not the subject of this paper.⁶ In particular, copyright-protected content within the results list of search engines – such as the thumbnails in Google's image search engine – constitute the content of the search engine operator.⁷ Hence this paper will treat search engines as hosting providers only to the extent that results shown in these lists enable copyright-infringing content to be found. Also, sites such as YouTube have been found by German courts to make their own content publicly available when the videos posted by users are made available to the public; in such scenarios, they are directly liable for copyright infringement, which is not the subject of this article.
- 3 Up to now, numerous business models for host providers have been developed, some of which overlap. Several business models will be outlined below:
- 4 "User-generated content" sites (also known as "UGC" sites): These enable users to store their own content on a platform. In order for such content to be found by the public, the hosting provider usually provides a particular structure for the storage, or at least the possibility of searching. Examples of such "user-generated content" sites are Internet auction platforms (e.g. eBay) and platforms for storage and making available of video files (e.g. YouTube), photographs (e.g. Flickr), links (e.g. alluc.org, g-stream.in) and discussion boards or content of social networks (e.g. Facebook). The susceptibility to infringements can be seen from the offer of particular categories such as "current feature films" or "series" (e.g. www.g-stream.in) or "audio books".
- 5 File hosts: Some hosting providers limit themselves to the mere provision of storage space. This is partly realised in return for payment for the storage of any content (e.g. the large German host provider 1&1); others allow the storage of any content free of charge due to advertising revenue (e.g. cyberlockers such as Rapidshare). The key feature of these types of business is that the hosting provider does not offer the customer any structure for the content they store – in particular no categorisation thereof – to make it directly available to the public. Hence further input is required from the user. If someone rents storage space from 1&1 for their own public video portal, they have to decide themselves how to structure it for the public. Advertising-financed file hosts usually at least allow the content stored on their servers to be accessed by way of links; the user can thus make the stored content available to the public through publishing a link.
- 6 Link-sharing sites: Numerous websites have emerged which make links available to files stored with file hosts. Such sites are known as link-sharers (also "linking sites" or "leeching sites"⁸). Such sites offer a categorisation and searching possibility (e.g. alluc.org, kino.to). These are often UGC sites, i.e. the links are posted by the users. Link-sharing sites are usually especially susceptible to infringement. For example, link sharers such as kino.to usually contain links to copies of many current cinema films, which are in turn stored with file hosts.
- 7 Link referrers: Other hosting providers have business models between the previous two mentioned. So-called link referrers encrypt the collections of links (to files stored with file hosts) made available by link sharers, sometimes preparing access to such files in a download-friendly manner. It is thus made more difficult for the rights holder searching for rights infringements to determine the storage location at the file host and in turn to identify the source at the file host. Hence, there is a real danger that an increased encryption of such rights-infringing links could be undertaken.
- 8 Index hosts: There are also host providers who make their servers available for an index to be made available via the Internet. This is designed to make it easier for the user to find particular content. Such indexes are often compiled automatically by a software program. The most well-known index is produced by Google with the hits generated by its search engine; in this case, the index refers to the entire Internet.⁹ However, indexes can also refer to smaller networks within the Internet. In particular, so-called eDonkey servers have become known through court proceedings. They make an index available to users of eDonkey file-sharing networks so they can find music and film content – including copyright-infringing music and film content within the network.¹⁰ Providers also regularly make indexes available in the so-called Usenet (more on this below) of files, which includes many copyright-infringing music, film and software files.¹¹ Piratebay.org is a search engine for locating film and music files within the BitTorrent network, the vast majority of which are illegal.¹²
- 9 Usenet providers: The Usenet is a worldwide network of discussion boards ("newsgroups") which are partly used to exchange copyright-infringing files. Depending on the specific offer, the services of Usenet providers cover access, storage space and software ("Useclient"), including indexing functions. The user of the Usenet provider makes files available to other users via "the user's" Usenet provider (so-called "initial" or "original" Usenet provider). According to the jurisprudence of the Court of Appeals (OLG) of Hamburg, the "original" Usenet provider has

the same liability as a hosting provider.¹³ The “non-original” Usenet provider, in contrast, is liable only as an Internet access provider; the latter is only obligated to a low level of due diligence;¹⁴ however, it is technically open, according to the court, what a “non-original” Usenet provider could do.¹⁵ This applies unless the non-original Usenet provider advertises the illegal use of those services. Such a provider is liable as the “original” Usenet provider, i.e. to the (more strict) extent of a hosting provider.¹⁶ In contrast, the *Court of Appeals (OLG) Dusseldorf*¹⁷ classified Usenet providers as so-called cache providers, without differentiating between “original” and “non-original”. Cache providers are those who store files by way of caching in order to speed up data transfer.

C. Application of German Law (Conflict of Laws)

- 10 The aforementioned German legal approach to duties of care for host providers is likely to be relevant for all hosting sites which are (also) intended for Germany. Pursuant to Article 8, Para. 2 Regulation Rome II, German copyright law is applied to everything that is made available on the Internet which is at least also intended to reach German users.¹⁸ All German-language infringements will meet this requirement, but also other language offers if other elements speak in favour of an intention to reach German users – for example, an English-language movie that is on a German language site or is not yet out in German and hence is also interesting for German speakers. Therefore, it can be expected that the German case law will develop a considerable pull for the behaviour of host providers even if they are located outside Germany.

D. General Remarks on the Liability of Host Providers

- 11 The liability for damages and criminal liability of hosting providers is limited by Article 14 eCommerce Directive,¹⁹ implemented by Sec. 10 German Telemedia Act (*Telemediengesetz, TMG*).²⁰ However, this has as yet been of little or no interest in copyright law practice. According to case law, liability for damages of hosting providers is redundant even in principle, hence before the exceptions under the TMG apply. Any liability concepts created by the *German Federal Supreme Court* which – for third-party content – could cause liability for damages, may not be applied to hosting providers.
- 12 In addition to the breach of duty of care and delinquent liability of contributors due to a violation of duties of care, a further “general basis for imputability” can be considered. The *German Federal Supreme*

Court adopted such a “general basis for imputability” in the *Halzband* case in order to assume a delinquent liability of the holder of an eBay account for copyright infringements which his wife had committed using his account.²¹ However, the specific “general basis for imputability” from the *Halzband* decision will usually not be applicable to the liability of hosting providers. This is because the imputability is based on the idea that indirectly responsible persons give the legal appearance of acting themselves.²² Such a legal appearance is, however, rarely assumed in the case of hosting providers. Another “general basis for imputability” can be considered, though, if a hosting provider “consistently” violates duties of care. The German Federal Court of Justice considers that sufficient to give rise to intentional abetting.²³ It would be better, however, to work with a general basis for imputability which leads to a delinquent liability. This would also not be a problem due to the equality of the participatory and delinquent liability (Sec. 830, Par. 2 German Civil Code, BGB).

- 13 The above-mentioned copyright decision practice of the German Federal Court and its Civil Senate I (competent for copyright law) is to a degree in conflict²⁴ with the stricter jurisprudence of its Civil Senate Xa (for Patents),²⁵ which tends to more aggressively assume delinquent liability. One must, however, deal with this reality in copyright law: usually, the grounds for delinquent liability for hosting providers do not apply according to the jurisprudence of the (Copyright) Civil Senate I.
- 14 Thus, only the principle of breach of duty of care remains. It is called the *Stoererhaftung*, which literally translated means “responsibility of the disquieter”. The *Stoererhaftung* is derived from Sec. 1004 BGB.²⁶ This principle is aimed only at claims for injunctive relief and removal but not claims for damages.²⁷ Sec. 10 TMG (Art. 14 eCommerce Directive) does not apply for injunctive relief claims against hosting providers based on it.²⁸

E. Requirements for a Breach of Duty of Care (Stoererhaftung)

- 15 A breach of duty of care in respect of third-party content has three requirements:
 1. The *Stoerer* (secondary infringer) has to have contributed to the infringement of the protected right in an adequately causal manner.²⁹ This is no requirement of culpability.³⁰
 2. The *Stoerer* must also have a legal possibility of preventing the principal offense.³¹

3. In order to prevent unlimited extension of the breach of duty of care, case law requires that the *Stoerer* must also have violated a duty of care.³² The assumption of a violation of such a duty of care requires a comprehensive balancing of interests and an assessment whether the fulfilment of the duty of care was reasonable in the allocation of risks.³³ This normally requires that the copyright violation be recognisable to the indirect *Stoerer*. Therefore, the case must concern either a clearly recognisable act of infringement, or the indirect *Stoerer* has to be made aware of the infringement by the infringing party.³⁴

In respect of the question as to the reasonableness of a duty of care, the *German Federal Supreme Court* has considerably eased rights holders' burden of proof and stating the case against the Internet service provider against whom the right holder has brought an action.³⁵ In principle, the burden of proof and stating the case for what can reasonably be expected of the *Stoerer* lies with the Claimant (and thus with the rights holder).³⁶ According to the *German Federal Supreme Court*, however, there is a secondary burden of proof and stating the case for the party claimed against. This is based on the fact that only the Internet service provider is in possession of the relevant knowledge of its technical infrastructure. Thus, the party subject to the claim is obligated to state which protection measures that party is able to take and which it is unreasonable to expect.³⁷

4. For a liability of the *Stoerer*, however, it is not necessary for the infringer or intentional contributor to the infringement not to be able to be prosecuted.³⁸ The breach of duty of care is thus not a subsidiary liability.

F. EU Directive Conformity of the Principle of Breach of Duty of Care

16 According to the German principle of breach of duty of care, the possibility of bringing an action against anyone indirectly responsible or co-responsible who is not liable as a perpetrator or contributor, is imperative in the scope of a directive-conforming interpretation. Article 11, sentence 3 of the Directive 2004/48/EC (so-called "Enforcement Directive") stipulates bindingly that it must be made possible for injunctions to be applied for against "intermediaries". The national legislator is also obligated under Article 8, Para. 3 of the Directive on the harmonisation of certain aspects of copyright and related rights in the information society³⁹ (Copyright Directive) to provide for blocking claims against "intermediaries" whose services are used for copyright infringements. There is no problem with classifying providers as "intermediaries",⁴⁰ so a liability provision must also be made available under German law. Whether the German principle of breach of duty of

care (*Stoererhaftung*) fulfils Article 8, Para. 3 Copyright Directive in particular seems somewhat doubtful. On the almost identical Article 11, sentence 3 of the Enforcement Directive, the *German Federal Supreme Court* stated in the *Internet-Versteigerung II (Internet Auction II)* case that the requirements above which accompany the breach of duty of care principle were compliant with European law on the basis of Recital 23 of the Enforcement Directive, because the regulation of the "conditions and procedures" are to be left to the Member States.⁴¹ Recital 23 (practically identical to Recital 59 of the Copyright Directive on Article 8, Para. 3), however, does not grant *carte blanche* to Member States to set any requirements they wish. Rather, the liability requirements clearly have to be subordinate to delinquent and contributory liability as otherwise the separate provisions of Article 11, sentence 3 Enforcement Directive and Article 8, Para. 3 Copyright Directive would be superfluous. Recital 59 also states expressly that the liability of the "intermediary" must also exist even if the "acts carried out by the intermediary are exempted under Article 5 [Copyright Directive]". In the recent report of the *European Commission* analysing the application of the Enforcement Directive, the European Commission highlighted that neither Article 11, sentence 3 Enforcement Directive nor Article 8, Para. 3 Copyright Directive had any requirement of liability.⁴² Hence, it does not seem to be clear that the violation of duties of care, as is made a requirement of breach of duty of care by the *German Federal Supreme Court*, is sufficiently inferior to the requirements of delinquent liability. In particular, the requirement of awareness runs parallel to the requirements for exception under Article 5 Copyright Directive. The *German Federal Supreme Court* would at least have had to submit the *Internetversteigerung II* case to the ECJ in accordance with Article 267 TFEU (formerly Art. 234 EC Treaty).

G. Concrete Application of Breach of Duty of Care (*Stoererhaftung*) to Hosting Providers in the Case of Copyright Infringements

17 Of all the requirements of breaches of duty of care mentioned above,⁴³ the infringement of duties of care has been focussed on in both the case law of the courts⁴⁴ and in literature.⁴⁵ This paper shall therefore examine the concept of German case law in greater detail.

I. How Duties of Care Arise

18 The existence of duties of care usually requires that the hosting provider be aware of the copyright-infringing third-party content on the host's server.⁴⁶

This knowledge is usually gained by the hosting provider through a so-called “notice-and-takedown letter” (also in German law) sent by the rights holder. In this letter, the rights owner informs the hosting provider of the infringement of the protected right through third-party content on the platform of the hosting provider and requests that the hosting provider prevent such infringement.

- 19 Upon becoming aware of a rights infringement, the hosting provider has a duty of care to prevent rights infringements for which there are specific grounds through checking content. This must be the same as the question as to whether there is a risk of repeated or first offences.⁴⁷ Duties of care can then exist in two respects:
- 20 There is a duty of care to prevent the repetition of the specific infringement as described in the notice-and-takedown letter, whereby a distinction can be made as to whether the infringement is “clear” (point a below). German courts justify this duty through the risk of repetition.
- 21 Furthermore, based on the risk of first offence and in cases of clear infringements, a duty of care has been recognised to prevent the same type but just as clearly recognisable rights infringements (point 2 below).⁴⁸

1. Duty of care to prevent the known specific infringement in future

- 22 All hosting providers – regardless of their business model – are subject to the obligation of preventing a “clear” (point 3 below) rights infringement in the future once they have become aware of it. In this context, the host providers must delete the infringements which they have been made aware of and prevent such content from being stored in their data storage space again. This seems so self-explanatory that the courts in part no longer even examine this in detail, such that the misunderstanding can occur that a hosting provider is not liable at all.⁴⁹
- 23 No cases are known in which the hosting provider was unable to permanently block the rights-infringing content. In order to filter rights-infringing files, so-called hash filters can be used to help identify a file as identical. In the case of file hosts such as *Rapidshare*, such hash filters are known as “MD5 filters”.⁵⁰ Other infringements, such as illegal links on link referrer sites or in search engine results, can also be reliably blocked through respective keyword filters. A particular feature applies to the “original” Usenet provider: following a “cancel request” by the rights holder, the Usenet provider is then responsible for deleting the rights-infringing file throughout the entire Usenet (via the so-called “kill command” according to Usenet rules which apply between the

providers).⁵¹ If the hosting provider does not remove the clear infringement that the provider has been made aware of, the provider is liable not only as a *Stoerer* but also as a contributing infringer and thus in German law like the direct infringer itself (Sec. 830 BGB).⁵² Against this background, it does not seem convincing that the *District Court (LG) Berlin* was of the opinion that *Google* as the hosting provider for links was only liable for removing a link to an obvious rights infringement if there was no possibility for the infringed party to achieve anything against the operator or host of the actual content.⁵³ That does not reflect the jurisprudence of the *German Federal Supreme Court*, which obligated *Google*, in the case of “clear” rights infringements, to prevent future infringements.⁵⁴

- 24 However, it seems as yet unclear whether the duty of care for the hosting provider also exists if the provider is made aware of an “unclear” (point 3) rights infringement. It is in part required that the unlawfulness be at least recognisable “from the perspective of an impartial Internet user”.⁵⁵ Fundamentally, any requirements of the unlawfulness which limit the duty of care should not be important. Since the *German Federal Supreme Court’s* decision in the *ambiente.de* case, a fundamental limitation of the duty of care to known, clear cases (described as “obvious, easy to recognise by the responsible employee of the Defendant”)⁵⁶ only takes place if the provider performs a quasi-state activity, i.e. one which would otherwise have to be performed by a state authority. This reasoning can be ruled out in respect of hosting providers on the principle that mere unlawfulness should be enough to trigger a duty of care. It is up to the risk of the hosting provider whether the provider decides to enter into the dispute between the customer and the rights holder. A (legitimate) business model is generally not seriously threatened by a hosting provider removing individual content which has been objected to.
- 25 The risk is also up to the hosting provider because the provider chose those (file-storing) customers. There is also no subsidiarity (see above E, no. 4). Therefore, it seems to be correct that the *German Federal Supreme Court* obligated the operator of a forum on the Internet to remove a (general) moral right infringement, although the case was not entirely clear; the court also did not check whether the unlawfulness was recognisable to an unbiased Internet user.⁵⁷
- 26 Any privileged treatment for host providers can only be considered in exceptional cases. In particular, this could be the case where there is a lack of specification of the accusation of rights infringement so that a precise check is not possible for the hosting provider.⁵⁸ In addition, exceptions are conceivable for neutral search engines not susceptible to infringements such as *Google*. The *German Federal*

Supreme Court considered, in terms of thumbnail images, that *Google*, as an image search engine in the general public interest, is at least liable for “clear” rights infringements.⁵⁹ Whether the liability is indeed restricted to that is, however, questionable and requires an examination of each individual case; this seems better attributed to the examination of the violation of a duty of care (more under point 2 below) than to the examination of the development of a duty of care. A justified public interest in copyright-infringing content being transported via *Google* is not always recognisable for infrastructure service providers who also act in the “public interest”. A violation of the duty of care can, however, cease to apply if it is possible, without great difficulty, to take action against the actual infringer and thus safely eradicate the source of the infringement.⁶⁰

2. Duty of care to prevent the same type of and just as clearly recognisable infringements when aware of clear rights infringements

- 27 In any case, for “clear” (point c) rights infringements the duty of care of the hosting provider goes beyond the mere blocking of the specific infringement. In this respect, the breach of duty of care exceeds the direct infringers and the contributing infringer liability, which only apply to the specific infringement due to the requirement of intent.⁶¹ According to the case law of the *German Federal Supreme Court*, there is also a duty of care to prevent the same type of as well as clearly recognisable infringements once there is an awareness of clear rights infringements.⁶² This was justified by the court through the existing risk of first offence, which in German law is sufficient to establish an injunction claim.
- 28 Several commentators have criticised this case law as going too far and not being in line with Article 15 eCommerce Directive.⁶³ Article 15 denies a general obligation to monitor for ISPs, including host providers. Although the case law of the *German Federal Supreme Court* “is entitled to the greatest of respect”, the *High Court of Justice Chancery Division* (England and Wales) in the *L’Oréal/Ebay* case referred the issue to the ECJ as question No. 10.⁶⁴ In his opinion, the Advocate General particularly refers to Article 3, Para. 2 Enforcement Directive and its principle (“Those measures, procedures and remedies shall also be effective, proportionate and dissuasive and shall be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse”). He comes to the conclusion that EU law does not prohibit further duties for host providers other than to filter the specific infringement, but it would also not oblige Member States to provide such claims. Hence, “the conditions and procedures relating to such injunctions are defined in national law.” If the ECJ follows this opinion, the case law of the *German Federal Supreme Court* could live on.
- 29 Anyway, the German case law seems convincing. A general duty of care in the sense of Article 15 eCommerce Directive is not established. Rather, such a duty of care to look for clear infringements of the same type, which are just as clearly recognizable, is limited to illegal scenarios that are likely to occur. Also, the host provider seems to be in principle best placed to stop such future infringements from happening, as it is the provider’s customers on the provider’s infrastructure that will commit the infringements.
- 30 It is, however, a different question as to which copyright scenarios include clear infringements of the same type and which are just as clearly recognisable. Under German law as well, this is an issue which has only been discussed for copyright law to a certain extent by the *German Federal Supreme Court*. The article proposes the following assessment under copyright law:
- 31 a) Infringements are of the same type if the same work is affected and the same copy (in another file) or another just as clearly rights-infringing copy has been used.⁶⁵ For example, the same type exists in copyright law if a video portal once more stores and makes available the same cinema film in another file as that in the notice-and-takedown letter. The same type would also be considered applicable if a link referrer made another link to the same film available to the public. A file host would be committing an offence of the same type if the host saved the same work in another file (also available to the public via link referrers).
- 32 b) The duty of care must not be restricted to the same work mentioned in the notice-and-takedown letter. An infringement of other works of the same category can be seen as similar and can be regarded as equivalent, provided they originate from the same perpetrator and do not require a new legal assessment. In such cases, the argument of “repeat offenders” becomes relevant. The *German Federal Supreme Court Jugendgefährdende Medien bei eBay* decision (concerning breaches of German unfair competition law) contains this relevant statement:⁶⁶ “It seems likely from life experience that an auctioneer of media which endangers youths should be considered a provider of further media, at least in the same category.” In its *Rapidshare* decisions on copyright law, the *Court of Appeals (OLG) Hamburg* also sees other obvious rights infringements by “repeat offenders” as likely.⁶⁷ In the case of such obvious rights infringements by the same persons, no proactive monitoring or investigation is required to which the Internet service provider would not be allowed to be obligated under Article 15 eCommerce Directive. Rather,

the obligation to remove obvious other rights infringements of the infringer conforms with Article 14, Para. 3 and Recital 48 of the Directive 2000/31/EC on electronic commerce.

- 33 c) Furthermore, the question remains open whether the duty of care of the hosting provider also refers to other works of other categories which were not contained in the notice-and-takedown letter and do not originate with the initial infringer. There is fundamentally no proactive duty of care, as mentioned above, as per Article 15 eCommerce Directive. However, something else could be the case if the hosting service is especially susceptible to infringements and the hosting provider is aware of that.⁶⁸ The *Court of Appeals (OLG) Hamburg* considered a breach of duty of care in the decision on *Long Island Ice Tea* under the condition that Internet discussion boards are related to particular topics and/or uploading of rights-infringing images has already occurred several times in the past.⁶⁹ Citing the *German Federal Supreme Court* decision, the *Court of Appeals (OLG) Zweibrücken* requires *Internet-Versteigerung II* as a restriction that a specific danger of infringement must be threatening in order for duties of care to arise.⁷⁰ A duty of care can also arise, even without a notice-and-takedown letter, in particular from a hosting provider who is increasing the susceptibility of the provider's hosting services through certain activities; an example would be that the hosting provider advertises the rights-infringing use of the provider's service.⁷¹ Furthermore, a link-sharing site is able to set up categories such as "current cinema films" or "series" (e.g. *g-stream.in*) and thus all but provoke the copyright infringement.⁷² Duties of care must, however, also apply if particular categories which are actually "neutral" turn out to have an increased susceptibility to infringements, e.g. predominantly (50%+) infringements; as soon as the host is aware of it, the host is liable for all infringements posted if the category is not immediately blocked. Duties of care can also occur without a categorisation susceptible to infringements. If a non-categorising file host such as *Rapidshare* stores all new theatre releases of a rights holder from the last years and then makes these available via third-party sites (link referrers), then there is a duty of care for the file host to block a film work that is just prior to its premiere. The file host must, however, be informed of the film title and the circumstances of the above-mentioned premiere. The duty of due diligence is violated if the film is hosted by the file host after the premiere and made available to the public from there (via link referrers).⁷³ For link referrers whose business model is to a great extent suitable for hiding illegal links, the same applies.
- 34 d) In summary, one can ascertain that duties of care to block the same type of infringements which are also clearly recognisable do not only refer to the same work. Rather, an obligation to block can also

exist for other works. The repeat offender argument is particularly relevant here; but even if the service otherwise demonstrates an increased susceptibility to infringement, a duty of care could exist for other works.

3. "Clear" infringement

- 35 As we have seen, the scope of the duties of care can depend on whether there is a "clear" rights infringement. What is a "clear" infringement in copyright law? The definition requires the creation of objective criteria. The perspective of an average unbiased Internet user⁷⁴ can be ruled out because if this were used, copyright claims would be dependent on the extent to which the German Copyright Act was known in the population. One can also expect a hosting provider to employ staff trained in copyright law. What cannot be expected, however, is for the host provider to employ well-trained lawyers.⁷⁵ The making available to the public of identical copies of copyright protected works – be it film works, music works, audio books or photography – would accordingly be a "clear" infringement; they form the vast majority of works illegally made available on the Internet. However, unchanged works are also still "clear" infringements, provided a free use (Sec. 23 German Copyright Act - UrhG) may not be seriously considered. Examples of not "clear" infringements would be borderline cases between adaptation (Sec. 23 UrhG) and free use (Sec. 24 UrhG), where one would need to consult a well-trained lawyer in copyright law to recognise the infringement.⁷⁶ Other copyright exemptions (Sec. 44a et seq. UrhG) also do not change anything in terms of a "clear" rights infringement insofar as their application cannot seriously be considered. Particularly in the case of making available to the public on the Internet under Sec. 19a UrhG, no exemptions can be seriously considered⁷⁷ – even in the case of privately acting persons – so one can usually assume making available to the public on the Internet constitutes a "clear" rights infringement. As the obviousness of the infringement plays a decisive role, so too should the "clarity" of the right to take action. For a clear infringement of photo rights, the *German Federal Supreme Court* requires that the *Stoerer* have "sufficient clarity on the authorisation of the claimant".⁷⁸
- 36 However, this cannot mean that works with a complicated chain of title can no longer be "clearly" infringed; that would discriminate against older works, e.g. older films which have changed rights owners several times and therefore have a long chain of title. It cannot be the case that works with a complicated chain of title do not trigger a duty of care and their rights holders are therefore unable to take action effectively against copyright infringements on the Internet.

37 The right to sue is “clear” if there are *no justified doubts of the hosting provider* as to such a right. The rights holder can disclose the chain of title by way of substantiation. That is not necessary, however. Justified doubts of the hosting provider are already considered not to exist if the hosting provider can trust the information in the notice-and-takedown letter stating rights ownership. Any declarations which expose the rights holder to the risk of criminal prosecution in the event of provision of false information should suffice. The rights holder can also work with a binding release of the hosting provider. In addition, the rights holder can cite the legal assumptions derived from Article 5 Enforcement Directive (implemented by Sec. 10 UrhG) or actual assumptions, e.g. a mentioning as rights holders in legal copies or even in the illegally hosted copy itself.⁷⁹

II. Violation of Duties of Care, in Particular Reasonableness

38 However, the question arises in relation to all business models as to whether the above-mentioned duties of care are reasonable to expect of hosting providers when they become aware of rights infringements. One can assume a violation of such duties of care if the hosting provider fails to utilise reasonable controlling measures and thus encourages further infringements. Whether a duty of care of the hosting provider is reasonable has to be decided, after a comprehensive weighing of interests, on a case-by-case basis, namely which of the different rights and causal contributions of the infringer, hosting provider and rights owner should be observed.⁸⁰

39 The following factors are of particular significance:⁸¹ intensity of the risk, commercial advantage of the hosting provider from the infringements, weight of interests of the copyright holder, expense of limiting such risk, and lack of or existing possibilities to neutralise the source of the infringement just as effectively in a different way.⁸² This means that the unreasonableness threshold rises more the more hosting providers, through their behaviour, provoke rights infringements by third parties, for example by advertising using illegally hosted content⁸³ or setting up categories susceptible to infringements.⁸⁴ One must also take into account whether the hosting provider receives a commission for the infringing acts⁸⁵ or at least indirectly profits through increased advertising revenue due to the illegal acts.⁸⁶ An example would be if the income of advertising financed hosting providers such as link referrers, file hosts and link encrypters rises with the number of times the hosted content is illegally accessed. Often the perpetrators are anonymous, meaning efficiently combating them is only possible via the host and not possible if each perpetrator has to be prosecuted individually.⁸⁷ When assessing the reasonable-

ness of specific measures, one must not forget that a combination of the individual retaliatory measures could make sense.⁸⁸

1. Notice to users to refrain from infringements

40 It seems self-explanatory that hosting providers would make their users aware of the possibility of copyright infringements and forbid them.⁸⁹ The precautionary claim for injunctive relief based on the principle of breach of duty of care can also be aimed at the education of individual infringing users prior to their specific copyright infringements. Such general education is included by most hosting providers in the terms and conditions. However, this is not sufficient on its own.⁹⁰ Many hosting providers – e.g. *YouTube* – also threaten copyright infringers beyond this with deleting their account. This also makes sense but is insufficient on its own.

2. Hash value filters

41 Hash value filters (e.g. MD5 filters) must be used as they at least ensure that the files named in the notice-and-takedown letter are actually blocked.⁹¹ However, hash value filters are not sufficient to block the same type of infringement which is just as clearly apparent, because the hash value changes with every change to the file and infringing files can thus no longer be found.⁹²

3. Deletion interface

42 However, it is reasonable to expect the hosting provider to make a deletion interface available upon the request of the rights holder, as it can stop the infringements, at least to a certain extent, and thus falls within the duty of care of the host.⁹³

43 According to one of the more recent decisions of the *German Federal Supreme Court Kinderhochstuehle im Internet* (Children’s High Chairs on the Internet), it fulfils the duty of care to provide a search function to the rights holder which enables the rights holder to search with the same effort and success as the host provider. In a trademark case regarding *eBay*, offering the rights holder the opportunity to participate in *eBay’s VeRI-Programm* was sufficient for *eBay*.⁹⁴ This, however, cannot be applied to host providers who – in contrast to *eBay* – allow users to store illegal content anonymously. In such cases, the rights holder cannot search with the same success as the host provider. Anyway, granting rights holders the possibility to use a deletion interface is also insufficient as it cannot hinder the infringement but sim-

ply provides the rights holder with the means to stop the infringement itself swiftly.⁹⁵

4. Keyword filters and other text-based due diligence measures

- 44 A suitable filter tool for fulfilling the duty of due diligence could be keyword filters for text-based filters. These are, however, only efficient if the specific infringement and further infringements of the same type can be identified via text. This is not the case for files whose names do not say anything about the content, as with film files which do not contain the film title. Hence, keyword filters can be more susceptible to failing when it comes to file hosts; this is because the respective users often – although not always – save the files without using the title of the work.⁹⁶ However, as such filters are associated with a low cost of implementation, it is reasonable for file hosts to employ them even if the level of success is low.⁹⁷
- 45 In contrast, for host providers who make text-based search tools available to their users, the keyword filter appears highly efficient. That applies, for example, for link referrers, user-generated content sites, search engines and Usenet providers in relation to the filtering of the index. The search term to be selected should at least be the title of the work; in the case of music, the performing artist's name is also given. Analogous to the principles of protectability of trade marks, search terms are fundamentally unsuitable if they have no distinctive character. For example, when filtering for the music title "Ey DJ" by the band *Culcha Candela*, the word "Culcha" was suitable for filtering illegal downloads.⁹⁸ A possibly unsuitable term would have been merely the word "DJ".⁹⁹ This matches with the case law of the *German Federal Supreme Court* that *eBay* did not have to employ a filter in case only 0.5% of the filtering results turned out to be illegal.¹⁰⁰
- 46 For file hosts and other hosts for whom keyword filters have only limited effectiveness, the combination with other measures is a good option. In the case of file hosts (e.g. *Rapidshare*), a making available to the public of the film, music, audio book and software files stored there occurs on third-party sites. The link with which the file stored at the file host can be accessed is made available to the public there.¹⁰¹ Thereafter, there exists a duty of care of the file host to check such third-party sites with collections of links.¹⁰² The same applies for link encrypters. The duty of care covers all links published there which constitute the same type of and just as clearly recognisable infringements. As link referrers make text-based searches available to their users, an automated - keyword-based - check is conceivable. In itself that is not sufficient as this measure only helps uncover

infringements which have already happened and does not prevent infringements from happening in the first place.¹⁰³

- 47 Furthermore, independent of work title, other search terms can also produce fruitful results. Very often, for example, films are stored at file-hosting sites not under the title of the film but under another "suspicious" name such as "Part1", "Part2", etc. In combination with other suspicious indications for a pirated copy – e.g. the type of file, size of file, particular file meta data or file saved by anonymous user – a duty of care can exist to subject such files to a further check using other methods (manual checks, contact with customer who has stored file, etc.).

5. Audio and audio-visual filter

- 48 Filter systems which recognise the content of audio files or audiovisual files (content filters) are also conceivable. These are offered by a number of manufacturers and constantly improved. If the hosting provider wants to claim that these are not sufficiently effective to justify the cost of implementation, the burden of proof and stating the case lies with the hosting provider, according to the jurisprudence of the *German Federal Supreme Court*.¹⁰⁴

6. Manual controls

- 49 Insofar as automatic filter procedures have gaps and cannot rule out rights infringements, these must be dealt with by hand.¹⁰⁵ An extension of the controlling personnel is not necessarily unreasonable.¹⁰⁶ However, it would be disproportionate to expect the host provider to check manually every offer that carries a certain element, in case such a manual control would endanger the (legal) business model of the host provider due to the staff expenditure. For example, in a trade mark case *eBay* did not have to check every offer that used a certain trade mark, as this – taking claims of other trade mark owners into account – would have jeopardized *eBay's* business model.¹⁰⁷
- 50 The *Court of Appeals (OLG) Dusseldorf* took a far more provider-friendly approach recently in its *Rapidshare* decision on breach of duty of care of the hosting provider.¹⁰⁸ According to this, the manual checking of data on the basis of keywords is, "on the basis of the huge number of files and the multiple meanings of the individual terms, as well as the ease of circumvention, disproportionate to the success achieved". Manual checking would therefore not be a suitable method for preventing third-party infringements. It is not clear from this decision that the *Court of Appeals (OLG) Dusseldorf* observed the secondary burden of proof and stating the case because the more general considerations were sufficient to reject a reasonableness of manual checking obligations for *Rapidshare*.

In particular, it is not mentioned anywhere why specifically a manual checking obligation should be unreasonable and jeopardize the whole business model of *Rapidshare*. *Rapidshare* – and other file hosts – is commercially an extremely successful company that could in theory afford additional checking personnel. For example, *Rapidshare* also employs manual checking staff in an “abuse department”. In that case it would have been up to *Rapidshare* to prove credibly why the whole business model would fail if manual checking obligations were imposed.

7. De-anonymising infringing users

51 To anticipate repeat offenders, case law demands, in part, the de-anonymisation of rights-infringing users, such that these can also be filtered, where necessary also manually. It has not yet been clarified, however, whether this requires a mandatory registration under a clear name or if other measures could suffice, e.g. protocol of the IP address.¹⁰⁹ Especially on *Rapidshare*, the *Court of Appeals (OLG) Hamburg* decided on the basis of the *German Federal Supreme Court Jugendgefährdende Medien bei eBay* decision that a business model which leads to mass copyright infringements and which provides for a fully anonymous upload procedure is not approved by the law and as a consequence cannot cite unreasonableness of duties of care.¹¹⁰

8. Altering the business model

52 Even a legitimate business model of the hosting provider does not enjoy protection from any changes.¹¹¹ The *German Federal Supreme Court* has always merely stressed that the hosting provider is protected from having “requirements placed upon him which would jeopardise his business model which is approved under the legal system or make his activity disproportionately more difficult”.¹¹² In cases of increased susceptibility to infringements, however, the *German Federal Supreme Court* has repeatedly demanded alterations to business models, e.g. the court advised *eBay* to remove whole categories which have a higher risk of infringements.¹¹³ Hence it seems unfounded for the *Court of Appeals (OLG) Dusseldorf* to want to protect the essentially “neutral” business model from any alterations by way of duties of care to prevent rights infringements.¹¹⁴ Rather, the *Court of Appeals (OLG) Hamburg*¹¹⁵ is correct when it says that reasonable changes to the business model may be demanded. If the business model of the hosting provider demonstrates an increased risk of infringements, then increased counter-measures as duties of care are reasonable. Hence, it does not seem convincing, according to the current business models of hosting providers, to create a matrix of who has what duties of care.¹¹⁶ The business models, as “flexible sys-

tems”,¹¹⁷ are subject to changes, in particular if they have a higher susceptibility to infringements. The limit of reasonableness is only reached if the hosts credibly prove and provide evidence for their having to abandon their business entirely if particular obligations were applied. However, only hosting providers whose business model is not based to a considerable degree on rights infringements can cite this principle.

H. Summary

53 In German law, the principle of breach of duty of care remains in the focus of approaches of rights holders against hosting providers for copyright infringements committed by the hosting provider’s customers. Other delinquent liability models have not as yet been applied to copyright infringements of hosting providers. There are different types of hosting providers¹¹⁸ with differing degrees of susceptibility that make them subject to different duties of care.

54 Whether the German breach of duty of care conforms with European law is questionable in light of Article 11, sentence 3 Enforcement Directive and Article 8, Para. 3 Copyright Directive, and this question should be clarified through reference to the ECJ. Under German case law, duties of care not only exist in relation to preventing further clear infringements of a particular infringed work, but also in relation to preventing just as clearly recognisable infringements, after having been informed of specific rights infringements. This extension of the duty of care to future similar infringements is currently before the ECJ, but should not be held contrary to EU law. Rather, it should be in line with Article 15 eCommerce Directive. The duties of care under German law not only create duties of care for the hosting provider to combat repeat offenders. Rather, particularly susceptible categories have to be constantly checked. The extent to which further duties of care can be expected of a hosting provider must be determined with a weighing up of the interests of rights holders, providers and users. Often, hosting providers will only avoid a breach of duty of care if they can undertake several due diligence measures simultaneously. Due to the rules on conflict of laws, the German concept of duties of care will also be applied extensively to hosting providers outside Germany.

1 The article was written relying on a talk the author gave to several district groups of the German Association for the Protection of Intellectual Property (GRUR). Parts of this article were published in German in 2010 *Computer & Recht* 653.

2 See *Gesellschaft zur Verfolgung von Urheberrechtsverletzungen (GVU)*, the German anti-piracy organization for films and games, Annual Report 2007, p. 5, available on <http://www.gvu.de/media/pdf/408.pdf>.

- 3 There are similar difficulties regarding trademark piracy on the Internet: Rösler (2006) IIC 771, 785.
- 4 German Federal Supreme Court (2007) GRUR, 890, 894 note 40 – *Jugendgefährdende Medien bei eBay*.
- 5 District Court (LG) Hamburg, decision of 3 September 2010, published in (2010) MMR 833; an example of another opinion is the Spanish Mercantile Court No. 7, Madrid, decision 289/2010, 22 September 2010.
- 6 See German Federal Supreme Court (2010) GRUR, 616 notes 22 et seq. – *marions-kochbuch.de*; Court of Appeals (OLG) Hamburg, (2009) ZUM, 642, 644 – *Gitarrist im Nebel*.
- 7 German Federal Supreme Court (2010) GRUR, 628 note 20 – *Vorschaubilder*.
- 8 Wilmer, (2008) NJW, 1845, 1846.
- 9 Google regarded as a host provider by EuGH, decision of 23 March 2010, C.236/08, C-238/08, notes 109 et seq.; referring to that decision, German Federal Supreme Court (2010) GRUR, 628 note 39 – *Vorschaubilder*.
- 10 Court of Appeals (OLG) Dusseldorf (2008) MMR, 675; District Court (LG) Frankfurt (2009) MMR, 70.
- 11 Court of Appeals (OLG) Hamburg (2009) ZUM-RD, 246, 263 et seq. – *Usenet I*.
- 12 See http://en.wikipedia.org/wiki/The_Pirate_Bay.
- 13 Court of Appeals (OLG) Hamburg (2009) ZUM-RD, 246, 264 et seq. – *Usenet I*.
- 14 Court of Appeals (OLG) Hamburg (2009) ZUM-RD, 246, 261 – *Usenet I*.
- 15 Court of Appeals (OLG) Hamburg (2009) ZUM-RD, 246, 263 et seq. – *Usenet I*; Court of Appeals (OLG) Hamburg, (2009) ZUM-RD, 439 – *Usenet II*.
- 16 Court of Appeals (OLG) Hamburg (2009) ZUM-RD, 246 – *Usenet I*; Court of Appeals (OLG) Hamburg (2009) ZUM-RD, 439 – *Usenet II*.
- 17 Court of Appeals (OLG) Dusseldorf (2008) ZUM, 332, 334.
- 18 See German Federal Supreme Court (2007) GRUR, 871, 872 *Wagenfeld-Leuchte*; Jan Bernd Nordemann, in: Fromm/Nordemann, Urheberrecht [German Copyright Law], 10th ed. 2008, Sec. 105 UrhG note 10 and Nordemann-Schiffel, in: Fromm/Nordemann, Urheberrecht [German Copyright Law], 10th ed. 2008, before Sec. 120 notes 96 et seq.
- 19 Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market ('Directive on electronic commerce').
- 20 See Dreier, in: Dreier/Schulze, Urheberrechtsgesetz [German Copyright Law], 3rd ed. 2008, Sec. 97 note 36; Jan Bernd Nordemann, in: Fromm/Nordemann, Urheberrecht [German Copyright Law], 10th ed. 2008, Sec. 97 note 185 with further references.
- 21 German Federal Supreme Court (2009) GRUR 597 – *Halzband*.
- 22 German Federal Supreme Court (2010) GRUR, 633 note 14 – *Sommer unseres Lebens*; also see German Federal Supreme Court (2009) GRUR, 597 note 19 – *Halzband*.
- 23 German Federal Supreme Court (2007) GRUR, 708 note 32 – *Internet-Versteigerung II*; German Federal Supreme Court (2004) GRUR, 860 – *Internet-Versteigerung I*.
- 24 Same opinion Schaefer (2010) ZUM, 699, 700; Stang/Hühner (2010) GRUR, 636, 637, commenting the decision German Federal Supreme Court (2010) GRUR, 633 – *Sommer unseres Lebens*.
- 25 See German Federal Supreme Court (2009) GRUR, 1142, 1144 et seq. notes 30 et seq. – *MP3-Player-Import*.
- 26 Jan Bernd Nordemann, in: Fromm/Nordemann, Urheberrecht [German Copyright Law], 10th ed. 2008, Sec. 97 note 154; critical on the deduction from Sec. 1004 German Civil Code (BGB): Ahrens, (2007) WRP, 1281, 1284.
- 27 German Federal Supreme Court (2004) GRUR, 860, 864 – *Internetversteigerung I*; German Federal Supreme Court (2002) GRUR, 618, 619 – *Meißner Dekor*; Dreier, in: Dreier/Schulze, Urheberrechtsgesetz [German Copyright Law], 3rd ed. 2008, Sec. 97 note 33; Jan Bernd Nordemann, in: Fromm/Nordemann, Urheberrecht [German Copyright Law], 10th ed. 2008, Sec. 97 note 154.
- 28 German Federal Supreme Court (2007) GRUR, 708, 710 note 19 – *Internet-Versteigerung II*; German Federal Supreme Court (2007) GRUR, 724, 725 note 7 – *Meinungsforum*.
- 29 German Federal Supreme Court (2008) GRUR, 702, 706 note 50 – *Internetversteigerung III*; German Federal Supreme Court (2007) GRUR, 708, 711 note 40 – *Internetversteigerung II*; German Federal Supreme Court (2004) GRUR, 860, 864 – *Internetversteigerung I*; Dreier, in: Dreier/Schulze, Urheberrechtsgesetz [German Copyright Law], 3rd ed. 2008, Sec. 97 note 33; Jan Bernd Nordemann, in: Fromm/Nordemann, Urheberrecht [German Copyright Law], 10th ed. 2008, Sec. 97 notes 156 et seq.
- 30 Jan Bernd Nordemann, in: Fromm/Nordemann, Urheberrecht [German Copyright Law], 10th ed. 2008, Sec. 97 note 156; Spindler/Volkman, (2003) WRP, 1, 2; v. Wolff, in: Wandtke/Bullinger, Urheberrechtsgesetz [German Copyright Law], 3rd ed. 2008, Sec. 97 note 15.
- 31 German Federal Supreme Court (1999) GRUR, 518, 519 – *Möbelklassiker*.
- 32 German Federal Supreme Court (2007) GRUR, 708, 711 note 40 – *Internetversteigerung II*; German Federal Supreme Court (2004) GRUR, 860, 864 – *Internetversteigerung I*, in-depth Haedicke, GRUR 1999, 397.
- 33 Jan Bernd Nordemann, in: Fromm/Nordemann, Urheberrecht [German Copyright Law], 10th ed. 2008, Sec. 97 note 158.
- 34 German Federal Supreme Court (1999) GRUR, 418, 420 – *Möbelklassiker*; German Federal Supreme Court (1984) GRUR, 54, 55 – *Kopierläden*.
- 35 German Federal Supreme Court (2008) GRUR, 1097 notes 19 et seq. – *Namensklau im Internet*.
- 36 German Federal Supreme Court (2008) GRUR, 1097 notes 19 – *Namensklau im Internet*; regarding Sec. 5 TDG earlier version German Federal Supreme Court (2004) GRUR, 74, 75 – *rassistische Hetze*.
- 37 German Federal Supreme Court (2008) GRUR, 1097 notes 19 et seq. – *Namensklau im Internet*; Jan Bernd Nordemann, in: Fromm/Nordemann, Urheberrecht [German Copyright Law], 10th ed. 2008, Sec. 97 note 162.
- 38 German Federal Supreme Court (2007) GRUR, 724, 726 note 13 – *Meinungsforum*; German Federal Supreme Court (2007) GRUR, 890, 894 note 40 – *Jugendgefährdende Medien bei eBay*; Jan Bernd Nordemann, in: Fromm/Nordemann, Urheberrecht [German Copyright Law], 10th ed. 2008, Sec. 97 note 158.
- 39 Directive 2001/29/EC of May 22, 2001.
- 40 See Reinbothe, (2001) GRUR Int., 733, 743; Spindler, (2002) GRUR, 105, 119.
- 41 German Federal Supreme Court (2007) GRUR, 708, 711 note 36 – *Internetversteigerung II*.
- 42 European Commission, Analysis of the application of the Directive 2004/48/EC, of the European Parliament and the Council of 29 April 2004 on the enforcement of intellectual property rights in the Member States, SEC(2010) 1589 final, p. 16 and 17 (December 22, 2010).
- 43 See IV.
- 44 German Federal Supreme Court (2009) GRUR, 841, 843 notes 19 et seq. – *Cybersky*; concerning trademark law German Federal Supreme Court (2008) GRUR, 702, 706 notes 50 et seq. – *Internetversteigerung III* and recently German Federal Supreme Court of 22 July 2010, File No. I ZR 139/08 notes 38 et seq..
- 45 E.g. Gabriel/Albrecht, (2010) ZUM, 392; Breyer, (2009) MMR, 14; Wilmer, (2008) NJW, 1845; Lehment, (2005) GRUR, 210, 213;

- Sobola/Kohl, (2005) CR, 443, 449; Berger/Janal (2004) CR, 917, 922; Leible/Sosnitza, (2004) NJW, 3225, 3226; Wild in Schricker/Loewenheim, Urheberrecht [German Copyright Law], 4th ed. 2010, Sec. 97 Rn. 93. In English language: Rösler (2006) IIC 771.
- 46 German Federal Supreme Court (2008) GRUR, 702, 703 et seq. note 19 – *Internetversteigerung III*; Court of Appeals (OLG) Köln (2008) GRUR-RR, 35, 37 – *Rapidshare*.
- 47 Loschelder/Dörre (2010) WRP, 822, 824; Köhler, in: Köhler/Bornkamm, Gesetz gegen den unlauteren Wettbewerb [German Unfair Competition Law], 28th ed. 2010, Sec. 8 UWG note 2.5b; also see German Federal Supreme Court (2007) GRUR, 708 note 44 – *Internet-Versteigerung II*, where the risk of first offence is deduced from the duties of care (and not the other way around).
- 48 Concerning trademark law German Federal Supreme Court (2008) GRUR, 702, 706 note 51 – *Internetversteigerung III*; German Federal Supreme Court (2007) GRUR, 708, 712 note 45 – *Internetversteigerung II*; see for further – also criticising references – below fn. 62.
- 49 See e.g. Court of Appeals (OLG) Dusseldorf (2010) ZUM, 600 – *Rapidshare* with comment by Jan Bernd Nordemann (2010) ZUM, 604.
- 50 Court of Appeals (OLG) Hamburg (2008) ZUM-RD, 527, 537. – *Rapidshare I*; Court of Appeals (OLG) Hamburg (2010) MMR, 51, 54 – *Rapidshare II*.
- 51 Court of Appeals (OLG) Hamburg (2009) ZUM-RD, 246, 248 – *Usenet I*; Court of Appeals (OLG) Hamburg (2009) ZUM-RD, 439, 441 – *Usenet II*.
- 52 See German Federal Supreme Court (2004) GRUR, 860, 864 – *Internet-Versteigerung I*.
- 53 District Court (LG) Berlin decision of 1 September 2009, file No. 16 O 293/08, p. 6 et seq., unpublished.
- 54 German Federal Supreme Court (2010) GRUR, 628 note 39 – *Vorschaubilder*.
- 55 District Court (LG) Köln (2010) ZUM-RD, 90, 93 on unlawfulness in General Personality Law.
- 56 German Federal Supreme Court (2001) GRUR, 1038, 1040 – *ambiente.de*.
- 57 German Federal Supreme Court (2007) GRUR, 724 note 3 – *Meinungsforum*; see the discussion on the justification of a statement – this should rule out a “clear” case.
- 58 District Court (LG) Köln (2010) ZUM-RD, 90, 93 on General Personality Law.
- 59 German Federal Supreme Court (2010) GRUR, 628 note 39 – *Vorschaubilder*.
- 60 Also see Leistner (2010) GRUR addendum, 1, 32 fn. 341.
- 61 Jan Bernd Nordemann, in: Fromm/Nordemann, Urheberrecht [German Copyright Law], 10th ed. 2008, Sec. 97 note 159; also see Court of Appeals (OLG) Hamburg (2009) ZUM, 642, 647 – *Gitarist im Nebel*.
- 62 On trademark law German Federal Supreme Court (2008) GRUR, 702, 706 note 51 – *Internetversteigerung III*; German Federal Supreme Court (2007) GRUR, 708, 712 note 45 – *Internetversteigerung II*; other opinion Breyer, (2009) MMR, 14, 15, who states that all preventive duties of care of providers are not compatible with Sec. 7, Par. 2, sentence 1 German Telemedia Act (TMG).
- 63 Breyer, (2009) MMR, 14, 15, who states that all preventive duties of care of providers are not compatible with Art. 15 eCommerce Directive; further Sobola/Kohl, (2005) CR, 443, 449; Berger/Janal (2004) CR, 917, 922; Wild, in: Schricker/Loewenheim, Urheberrecht [German Copyright Law], 4th ed. 2010, Sec. 97 note 93. In favour of the case law of German Federal Supreme Court: Leible/Sosnitza, (2004) NJW, 3225, 3226 (but requesting reference to ECJ due to Art. 267 TFEU); Lehment (2005) GRUR, 210, 213; Jan Bernd Nordemann, in: Fromm/Nordemann, Urheberrecht [German Copyright Law], 10th ed. 2008, Sec. 97 note 159.
- 64 See Decision of 22 May 2009, Case No. HC07C01978, note 326.
- 65 On trademark law German Federal Supreme Court (2007) GRUR, 708, 712 note 47 – *Internetversteigerung II*.
- 66 German Federal Supreme Court (2007) GRUR, 890, 895 note 44 – *Jugendgefährdende Medien bei eBay*.
- 67 Court of Appeals (OLG) Hamburg (2008) ZUM-RD, 527, 543 – *Rapidshare I*; Court of Appeals (OLG) Hamburg (2010) MMR, 51, 54 – *Rapidshare II*.
- 68 On increased duties of care, when the hosting service is especially susceptible to infringements: Leistner (2010) GRUR addendum, 1, 32.
- 69 Court of Appeals (OLG) Hamburg (2009) NJOZ, 2835, 2840 – *Long Island Ice Tea*.
- 70 Court of Appeals (OLG) Zweibrücken (2009) MMR, 541, 542.
- 71 See German Federal Supreme Court (2009) GRUR, 841, 843 notes 21 et seq. – *Cybersky*; Wilmer, (2008) NJW 1845, 1849.
- 72 See Wilmer, (2008) NJW, 1845, 1849.
- 73 District Court (LG) München I, decision of 24 August 2009, File No. 21 O 1592509, unpublished.
- 74 District Court (LG) Köln (2010) ZUM-RD, 90, 93, though this case concerned General Personality Law, which is not entirely comparable with Copyright Law.
- 75 See German Federal Supreme Court, Decision of 22 July 2010, file No. I ZR 139/08, note 48 – *Kinderhochstuehle im Internet*.
- 76 See German Federal Supreme Court, Decision of 22 July 2010, file No. I ZR 139/08, note 48 – *Kinderhochstuehle im Internet*.
- 77 Jan Bernd Nordemann/Dustmann (2004) CR, 380, 381; further Dustmann, in: Fromm/Nordemann, Urheberrecht [German Copyright Law], 10th ed. 2008, Sec. 19a note 30; Dreier in: Dreier/Schulze, Urheberrechtsgesetz [German Copyright Law], 3rd ed. 2008, Sec. 19a note 4.
- 78 German Federal Supreme Court (2010) GRUR, 628 note 39 – *Vorschaubilder*.
- 79 Schulze in: Dreier/Schulze, Urheberrechtsgesetz [German Copyright Law], 3rd ed. 2008, Sec. 10 UrhG notes 36 et seq.; A. Nordemann, in: Fromm/Nordemann, Urheberrecht [German Copyright Law], 10th ed. 2008, Sec. 10 UrhG notes 55 et seq.; Thum, in: Wandtke/Bullinger, Urheberrechtsgesetz [German Copyright Law], 3rd ed. 2008, Sec. 10 UrhG notes 50 et seq..
- 80 Court of Appeals (OLG) Hamburg (2008) ZUM-RD, 527, 537 et seq. – *Rapidshare I*; Court of Appeals (OLG) Hamburg (2010) MMR, 51, 53 – *Rapidshare II*; Jan Bernd Nordemann, in: Fromm/Nordemann, Urheberrecht [German Copyright Law], 10th ed. 2008, Sec. 97 note 162.
- 81 Leistner, (2010) GRUR addendum, 1, 32; Loschelder/Dörre, (2010) WRP, 822, 824 et seq.
- 82 But no general subsidiarity, see above V. 4.
- 83 Gabriel/Albrecht, (2010) ZUM, 392, 394; Wilmer, (2008) NJW, 1845, 1849; also see German Federal Supreme Court, (2009) MMR, 625, 626 et seq. – *Cybersky*; Court of Appeals (OLG) Hamburg (2009) ZUM-RD, 246 – *Usenet I*; Court of Appeals (OLG) Hamburg (2009) ZUM-RD, 439 – *Usenet II*.
- 84 Wilmer, (2008) NJW, 1845, 1849.
- 85 German Federal Supreme Court (2004) MMR, 668, 671 – *Internetversteigerung I*; Gabriel/Albrecht, 2010 (ZUM), 392, 394.
- 86 Wilmer, (2008) NJW, 1845, 1849.
- 87 German Federal Supreme Court (2007) GRUR, 890 note 40 – *Jugendgefährdende Medien bei eBay*.
- 88 Jan Bernd Nordemann (2010) ZUM, 604, 605, contrary to Court of Appeals (OLG) Dusseldorf (2010) ZUM, 600 – *Rapidshare*.
- 89 See German Federal Supreme Court (1960) GRUR, 340, 343 – *Magnettonbandgeräte*; German Federal Supreme Court (1984) GRUR, 54,

- 55 – *Kopierläden*; The Federal Constitutional Court (BVerfG) concludes that there is a duty of care to give notice to users, to refrain from infringements, (1997) GRUR, 124, 125 – *Kopierläden II*; Jan Bernd Nordemann, in: Fromm/Nordemann, Urheberrecht [German Copyright Law], 10th ed. 2008, Sec. 97 note 173; Spindler, (2006) MMR, 403, 404; Leistner, (2006) GRUR, 801, 810.
- 90 *Court of Appeals (OLG) Hamburg* (2010) MMR, 51, 54 – *Rapidshare II*, *Court of Appeals (OLG) Hamburg* (2008) MMR, 823, 825 et seq. – *Rapidshare I*.
- 91 See above VII. 1.a).
- 92 *District Court (LG) Dusseldorf* (2008) ZUM, 338, 341; also see Breyer, (2009) MMR, 14, 17, who concludes that the lack of efficiency of hash filters excludes them from measures applicable due to duties of care.
- 93 Jan Bernd Nordemann, (2010) ZUM, 604, 605; other opinion Breyer, (2009) MMR, 14, 18.
- 94 See *German Federal Supreme Court*, Decision of 22 July 2010, file No. I ZR 139/08, note 43 – *Kinderhochstuehle im Internet*.
- 95 *Court of Appeals (OLG) Hamburg* (2010) MMR, 51, note 82 in juris edition – *Rapidshare II*; *Court of Appeals (OLG) Hamburg* (2008) MMR, 823, 826 – *Rapidshare I*; also see Gabriel/Albrecht, (2010) ZUM, 392, 396; Wilmer, (2008) NJW, 1845, 1847.
- 96 *Court of Appeals (OLG) Dusseldorf* (2010) ZUM, 600, 603 – *Rapidshare*.
- 97 Other opinion *Court of Appeals (OLG) Dusseldorf* (2010) ZUM, 600, 603; also other opinion Breyer, (2009) MMR, 14, 17, who declines such duties of care due to the great effort and threat to freedom of speech.
- 98 *District Court (LG) Berlin* Decision of 10 June 2008, File No. 15 O 144/08, p. 11; Jan Bernd Nordemann, in: Fromm/Nordemann, Urheberrecht [German Copyright Law], 10th ed. 2008, Sec. 97 note 163.
- 99 Jan Bernd Nordemann, in: Fromm/Nordemann, Urheberrecht [German Copyright Law], 10th ed. 2008, Sec. 97 note 163.
- 100 *German Federal Supreme Court*, Decision of 22 July 2010, file No. I ZR 139/08, note 41 – *Kinderhochstuehle im Internet*.
- 101 See above II. 3.
- 102 *Court of Appeals (OLG) Hamburg* (2010) ZUM-RD, 527, 541 et seq. – *Rapidshare I*; *Court of Appeals (OLG) Hamburg* (2010) MMR, 51, 54 – *Rapidshare II*; Jan Bernd Nordemann, (2010) ZUM, 604, 605; Wilmer, (2008) NJW, 1845, 1851, who presumably sees this duty of care under the condition of earlier infringements, see (2008) NJW, 1845, 1848; other opinion *Court of Appeals (OLG) Dusseldorf* (2010) ZUM, 600 – *Rapidshare*; Breyer, (2009) MMR, 14, 17.
- 103 *Court of Appeals (OLG) Hamburg* (2008) ZUM-RD, 527, 542. – *Rapidshare I*; *Court of Appeals (OLG) Hamburg* (2010) MMR, 51, 54 – *Rapidshare II*.
- 104 *Court of Appeals (OLG) Hamburg* (2009) MMR, 631, 635 – *Usenet I*; also see *German Federal Supreme Court* (2008) GRUR, 1097 – *Namensklaue im Internet*.
- 105 *German Federal Supreme Court* (2007) GRUR, 708 note 47 – *Internet-Versteigerung II*; also see *Court of Appeals Berlin (KG)* (2010) GRUR-RR, 7, 8; Jan Bernd Nordemann, in: Fromm/Nordemann, Urheberrecht [German Copyright Law], 10th ed. 2008, Sec. 97 note 162.
- 106 *Court of Appeals (OLG) Köln* (2008) GRUR-RR, 35, 37 – *Rapidshare*; expecting less of the host provider *Court of Appeals (OLG) Dusseldorf* (2008) ZUM, 866, 868 – *eDonkey-Server*, according to which it is unreasonable for a host provider to control 300 hits of 17 filtered titles manually.
- 107 See *German Federal Supreme Court*, Decision of 22 July 2010, file No. I ZR 139/08, note 41 – *Kinderhochstuehle im Internet*.
- 108 *Court of Appeals (OLG) Dusseldorf*, (2010) ZUM, 600, 603 – *Rapidshare*.
- 109 *Court of Appeals (OLG) Hamburg* (2010) MMR, 51, notes 91 et seq. in juris edition – *Rapidshare II*; also see *Court of Appeals (OLG) Hamburg* (2008) ZUM-RD, 527, 543 – *Rapidshare I*; against the possibility of identification via IP addresses *Court of Appeals (OLG) Dusseldorf* (2010) ZUM, 600, 603 – *Rapidshare*.
- 110 *Court of Appeals (OLG) Hamburg* (2010) MMR, 51 note 109 in juris edition – *Rapidshare II*; explicitly against that *Court of Appeals (OLG) Dusseldorf* (2010) ZUM, 600, 603 – *Rapidshare*.
- 111 Jan Bernd Nordemann, (2010) ZUM, 604, 605.
- 112 *German Federal Supreme Court* (2007) GRUR, 890, 894 note 39 – *Jugendgefährdende Medien bei eBay*.
- 113 *German Federal Supreme Court* (2007) GRUR, 890, 895 note 49 – *Jugendgefährdende Medien bei eBay*.
- 114 *Court of Appeals (OLG) Dusseldorf* (2010) ZUM, 600, 601 – *Rapidshare*. It is doubtful whether *Rapidshare* can really be regarded as “neutral” and not infringement-provoking, see *District Court (LG) München I* Decision of 24 August 2009, File No. 21 O 15925/09, quoted by Jan Bernd Nordemann (2010) ZUM, 604, 605.
- 115 *Court of Appeals (OLG) Hamburg* (2008) ZUM-RD, 527, 549 – *Rapidshare I*.
- 116 Other opinion Wilmer, (2009) NJW, 1845, 1850.
- 117 Leistner, (2010) GRUR addendum, 1, 32.
- 118 See above II.

Creative Commons Olympics

How Big Media is Learning to License From Amateur Authors.

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Abstract: NBC Universal's decision to use Creative Commons-licensed photographs in an Olympic broadcast is an example of how media conglomerates are experimenting with collaboration with amateurs, but it also reveals potential problems of letting non-lawyers negotiate copyright licensing agreements. In the process, NBC's producers nearly opened the door for a multimillion-dollar infringement law suit. To avoid such pitfalls, media companies need to adopt

policies and best practices for using amateur licensed works. These guidelines should instruct how a production can attribute collaborating authors and how the Open Content licensing terms affect the licensing of the productions. The guidelines should also instruct how producers can seek alternative licensing arrangements with amateurs and contribute back to the Open Content community.

Keywords: Creative Commons; Licensing; Open Content; Free Culture; Media Law; Online Images; Flickr; User Generated Content; User Created Content; NBC Olympics

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A. From Flickr to Olympics

- 1 In February 2009, on an especially cold day, author and Harvard scholar Doc Searls shot some pictures of ice crystals that had formed inside the old storm windows of his apartment, and put them on the online photo-sharing site Flickr. Searls is no newcomer when it comes to sharing his photos online. He generously shares many of his 34,000 photos with the Creative Commons¹ (CC) licenses that give the public royalty-free permission to use the licensed work under certain terms. After Searls released the photos, he waited for nature to take its course.
- 2 In November 2009, a producer from the NBC television network sent an email to Searls. NBC wanted to use his photos in the upcoming Vancouver Olympic Games. However, NBC had some problems with the attribution part of the Creative Commons license that Searls was using. By email, Searls agreed
- 3 NBC used Searls' ice crystal images in transition graphics, as background for digital studio sets, in event-information graphics and scoreboards, and in many other graphic elements of NBC's Olympic broadcasts.³ Searls' photos, which had received just over 1000 views on Flickr, suddenly had a daily audience of 25 million Americans. In his popular blog, Searls expressed excitement that NBC had used his photos in the Olympics and concluded, "It's a big win for Creative Commons, too."⁴
- 4 The case study raises several questions. Was it really a win for Creative Commons? Did Searls waive the whole Creative Commons' license or just the attribution requirements? What if the only license NBC had was the modified CC license? Is there something we can learn from this experience on how media com-

to waive that and let NBC credit him in the end credits, along with the rest of the NBC creative team.²

panies should deal with using amateur works and Creative Commons licenses?

B. Lawyer-free licensing

- 5 The goal of the non-profit organization, Creative Commons, is to reduce copyright licensing costs by removing the need for lawyers and other intermediaries.⁵ Creative Commons provides a set of free legal “do-it-yourself” tools that help authors and rights owners to share their work on terms with which they feel comfortable. Creative Commons has a free website, offering a variety of licenses for rights owners to use. Many web services offer their users an option to use the Creative Commons licenses. For example, Flickr users can easily attach CC licenses to their photos. The site has over 150 million Creative Commons-licensed photos.
- 6 There are six different basic Creative Commons licenses. Searls chose the Attribution-Share license as his default license for the photos he uploaded to Flickr. Searls’ license was valid only if the licensee would give attribution in the manner specified by the license. The license has a rather long clause that defines the proper way to attribute. In this case, NBC would have had to display the name of the author, the name of the work, the link to the license, the license name, the author’s name, and the information that NBC had modified the original work. It is easy to understand that displaying the attribution data each time NBC showed the photo did not fit NBC’s plans. However, proper attribution was not the only requirement for Searls’ license.
- 7 Many of the Creative Commons licenses grant permission to modify the licensed work and to reproduce and distribute adaptations of it. Searls chose a license that permits modifications. However, the license had a so-called ShareAlike condition for distribution of modified works. If the licensee chooses to distribute the adaptations, the licensee has to license the adaptations with the same or similar Attribution-ShareAlike license. NBC used the photos as part of video collages that mixed the live broadcast, scoreboards, graphics, and text in a mixture of rich wallpapers of moving images. Because NBC produced the adaptations and distributed them, the adaptations could have fallen under the ShareAlike terms. Was NBC obliged to share the adaptations with the ShareAlike license or not? The answer depends on whether NBC’s email exchange with Searls created a separate agreement or whether the modified Creative Commons agreement was the only license NBC had. Searls could grant non-Creative Commons licenses or modify the original license terms as he wanted.⁶ The question centers on what happened in those two emails.
- 8 The fact that two people who had never met before formed a legal agreement through email raises the question whether the communication can even result in a binding agreement. However, copyright licenses have no common form requirements. It is all right to make nonexclusive license agreements online or through an email.⁷ The parties do not have to sign the license or even have it in writing.⁸ Eventually, it is up to the licensees to show they have received permission to use the otherwise exclusive rights. A screen shot of a web page that has a public license could be enough to show that the person who posted a photo was offering it to the public under the license terms. Similarly, an email could prove what the parties have agreed.

I. Interpretation of incomplete contracts

- 9 Was NBC really embracing the open creativity that Creative Commons cultivates? What led to Searls having the impression that Creative Commons’ terms still applied? The relevant communication was in the two emails between the parties.

10 NBC’s email said:

- 11 Doc,
Our designers were building some graphic backgrounds for our coverage of the upcoming Vancouver Games and in their search for winter images they came across your crystal photography on Flickr. We saw that there wasn’t [sic] any restrictions in using this material as long as there was credit given for fair use. Since these backgrounds would already have text on them from our broadcast we would like your permission to *waive that* and instead offer you a credit within our design team when the credits run at the conclusion of our final Olympic Broadcast.

Thank you.
X X
NBC Olympics⁹

12 Searls replied four days later in an email:

- 13 What you propose is fine. Those photos are meant to be used any way people like. I’m glad to accept payment when offered. :-) But when not, running my name in the credits is fine.

Cheers,
Doc

- 14 It is clear that NBC could have shown there was an agreement. The agreement should also serve as a guidepost for the parties to resolve their disputes.¹⁰ The licensing agreement was incomplete in many ways. The language in the emails left room for inter-

pretation and the parties interpreted the language differently. There are two ways to understand the email exchange between Searls and NBC. One interpretation of the license is that NBC wanted to waive only the attribution part of the license — and the “waive *that*” is a reference to the attribution condition of the license. This would have meant that NBC was using the work under a modified CC license. While the parties had indisputably waived the attribution clause, the other conditions, such as the ShareAlike terms, were still valid. If NBC was not acting within the license, it was infringing on Searls’ copyrights.

- 15 The second interpretation is that NBC wanted to waive the whole license and replace it with another agreement and that “waive *that*” was a reference to the entire Creative Commons public license. This would have meant that NBC did not have to fulfill any of the conditions of the CC license. The only condition for permission was that NBC give credit to Searls in the end credits.
- 16 Parties can have very different opinions of what they had agreed to. In this case, the subjective understandings of the parties were in conflict. Searls did not really know whether he had granted a new license or just agreed to attribution in the end credits. In fact, Searls’ blog posts and email exchanges suggest that he did not think he had waived the CC license. Searls’ communications in his blog led to blog commentators congratulating CC and wondering how NBC would pay for using the images.¹¹ At the same time, the person at NBC may have thought the network had a short and simple new license agreement. Which party’s interpretation is the right one? The case is a textbook example of an incomplete contract interpretation situation. Fortunately, contract law has a set of interpretation rules that define how the parties and courts should interpret incomplete contracts.¹²
- 17 Searls was aware he had used CC’s license, and that the license had conditions for its use. Then again, his email has a conflicting message as he wrote that the photos “are meant to be used *any way* people like.” Was he granting another public license or dedicating the work to the public domain?¹³
- 18 The normality rule provides unclear terms with the meanings they would have in normal use. The rule assumes that the parties give the meaning that a reasonable person of the same kind would give to it in the same circumstances.¹⁴ The rule would also help to protect licensees who are basing their actions on the reasonable expectations that the license and licensor’s action/passivity creates.¹⁵ Ultimately it will be up to the licensee to show why the objective reasonability and subjective expectations should be protected against the licensor’s own expectations. A reasonable person could conclude that Searls’ reply, “Those photos are meant to be used any way people like,” meant that he did not want to restrict in any way the use of his work and that Searls did accept a new individual licensing deal with NBC. Even if the language left room for interpretation, NBC had an implied license from Searls.¹⁶
- 19 However, examining only the email exchange between NBC and Searls gives a somewhat incomplete image of the legal nature of their relationship. If a contract is incomplete or silent regarding the terms of the agreement, a court can use previous communication and the existing terms as a reference.¹⁷ For example, the history of how the licensor has acted before can raise the licensee’s expectation that the licensor will act the same way in the future. Searls’ Flickr pages contained the CC license information, and the email suggests that the people at NBC had noticed it.¹⁸ Searls’ default copyright was neither “all rights reserved” nor dedicated to the public domain. He was using the “some rights reserved” licensing scheme that Creative Commons licensing offered. A reasonable person who knew Searls’ preference to share his works with Creative Commons could interpret his reply as a reference to the permission he had granted with the CC license.
- 20 Creative Commons markets the licenses with the catchphrase, “some rights reserved.” The CC terms grant freedom to use the photos liberally in almost any way people like. However, it appears that the people at NBC also had not carefully read the license terms, or that they had problems fully understanding them. The notion, “We saw that there weren’t any restrictions in using this material as long as there was credit given for fair use,” was not accurate. The license has several other conditions and restrictions for using the work. The license also explicitly states that the license does not affect fair use rights.
- 21 Another question is whether Searls was responsible for correcting NBC’s obviously wrong impression of the licensing terms. If Searls knew of the error NBC made and tried to benefit from it, at the worst a court could have considered it a fraudulent act.¹⁹ However, Searls admitted in an interview later that he had forgotten that the licenses he used had the ShareAlike element. The parties’ uneven legal resources also suggest it was NBC’s responsibility to know the terms of the license. An organization such as NBC must have the ability to clear copyrighted materials accurately. One goal of the CC licensing is to remove the need for attorneys. Amateur authors are rarely legal experts and should not carry the burden of educating licensees.
- 22 The CC license does discuss the matter of waiving terms of the license: “No term or provision of this License shall be deemed waived and no breach consented to unless such waiver or consent shall be in writing and signed by the party to be charged with

such waiver or consent.”²⁰ It is questionable whether parties can agree to waive a term of the license with a non-signed agreement. This fact may favor NBC’s interpretation that the parties had agreed on a new licensing agreement. However, the CC license does state that the licensee may implement the credit in any reasonable manner.²¹ The license’s minimum requirement is that the credit must appear where the licensee credits other comparable authorship. NBC probably did not even need Searls’ permission to list the credit separately.

- 23 NBC initiated the licensing agreement with its email. Courts have repeatedly interpreted contracts against the party who was responsible for drafting the agreement, which, in this case, was NBC. According to the *contra proferentem* rule, when a term is unclear and there is doubt, the ambiguity rule favors the party that did not unilaterally draft or supply the terms.²² This is because the drafter is in the best position to express the parties’ shared intentions and because, in the typical contract negotiation, the drafter who is the more experienced party should bear the consequences of any drafting failure.²³ The ambiguity rule is important, especially in business-to-consumer transactions.
- 24 With copyright licenses, courts have favored licensors by applying a presumption that interests not expressly conveyed are impliedly reserved to the author,²⁴ giving even more weight to the author’s opinion of the interpretation.²⁵ Especially in a copyright licensing, the interpretation is typically narrow and protects the rights owner.²⁶
- 25 Given that most of the interpretation rules favor the underdog amateur, there is a chance that courts could have taken Searls’ side. However, such analysis is academic when the parties can peacefully agree to disagree and can work things out. All the same, the fact remains that, at one point, the parties did not have a common understanding of the details of the agreement, which led to a legal uncertainty.

II. Resolution

- 26 After hearing Searls’ side of the incident, this author was curious to know whether NBC thought it had a separate license or if it had just missed the ShareAlike license element and was going to attribute Searls in the end credits according to the CC license terms. An email was sent to the NBC producer explaining the situation and asking how the network planned to credit Searls. The producer did not reply to that email. However, the email did get attention. The producer contacted Searls, saying the network thought the agreement they had was sufficient. Searls was willing to work things out and he replied that it would be sufficient. The new agreement clarified that NBC credited Searls as part of NBC’s cre-

ative team, and NBC’s legal department did not have to worry about the Creative Commons terms.

- 27 Searls later commented that he did not want to play a “gotcha game” with NBC. Rather, he wanted to start a discussion with media companies on how they could become part of the Free Culture movement. In an article he wrote for *Linux Journal*, Searls said he is happy with what NBC did: “It was not only fun to watch, but also to feel a sense of participation in a good cause that transcended the commercial interests involved. In other words, I felt honored, not exploited.”²⁷ The CC license he used opened the door to that satisfaction, even if he waived it. In his opinion, one thing CC does is to provide a nicely bounded context for zones of interaction between parties with good will toward each other, who do not require lawyers to help them reach agreements, whether or not those agreements are within the letter of the relevant laws.
- 28 We will never know what would have been the outcome if Searls had not been the reasonable man he is. Nevertheless, the incident deserves hypothetical speculation. The web is full of people who are not shy about going after an opportunity to cash in on the copyrights they own. Suing a major media company for a Creative Commons license infringement might seem a lucrative proposition for many. Therefore, for the next couple of pages, let us imagine that the parties never reached an agreement and the only permission NBC had was the original CC license. What were NBC’s options and what are the possible outcomes?

C. ShareAlike Olympics

- 29 The BY-SA Creative Commons license Doc Searls used requires that the adaptations made from Searls’ photos share the same license terms. ShareAlike licenses are useful in online collaboration projects such as Wikipedia. They permit people to collaborate by building on top of and improving the existing works. They also try to make certain the collaboration can continue. This is why the license requires the licensee to place the improvements, alterations, and adaptations, if distributed, under the same license as the original work. If NBC were to honor the license terms, a big chunk of NBC’s Olympic broadcast would have fallen under the royalty-free Creative Commons ShareAlike license. How much of the content does the ShareAlike term affect? The ShareAlike term kicks in when the licensee distributes, performs, or displays the derivative works. The license defines “Derivative Work” as a
- 30 . . . work based upon the Work or upon the Work and other pre-existing works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, con-

densation, or any other form in which the Work may be recast, transformed, or adapted, except that a work that constitutes a Collective Work will not be considered a Derivative Work for the purpose of this License.

- 31 Searls' photos were an integral part of the Olympic broadcast. It is clear that NBC used the photos to create a derivative work. However, the exact amount of NBC's material affected by the ShareAlike term is unclear. Did it include just the background graphics, or did it include every copyrightable element displayed while the ice crystals were on screen — or even the whole segments where the crystals appeared? To make the matter even more complicated, NBC does not own and cannot license out many of the copyrightable elements that it displayed on the screen next to the background graphics.
- 32 NBC was in a situation where it had to make a decision. NBC had two options. First, it could distribute the segments that had snow crystals with a ShareAlike license, infringe on the Olympic Committee's copyrights, and possibly breach the broadcasting contract. One irony of the story is that NBC has been eager to target users and websites that rebroadcast and share its Olympic coverage without permission. The second option would have been to use the crystal photos without distributing the derivative works with the CC license.
- 33 There is little doubt that NBC never wanted its crown jewels, the Olympics, to fall into any royalty-free licensing scheme. Even if NBC had allowed this to happen, the Olympic Committee, the owner of the sports broadcast that NBC only licensed, would not agree to it under any circumstances. As NBC was most likely not willing to use the photos under the CC license and the email license agreement was wobbly, there is a chance that NBC was infringing in one of its biggest productions of the year.
- 36 In the United States, statutory damages are set out in Title 17, Section 504 of the US Code. The court can grant damages of between \$750 and \$30,000 per work. Plaintiffs who can show willful infringement may be entitled to damages up to \$150,000 per work. In this case, the infringement happened because of misunderstanding, which could reduce the liability. Defendants who can show they were "not aware and had no reason to believe" they were infringing on a copyright may have the damages reduced to \$200 per work. However, a court could expect a media company such as NBC to be diligent in making sure such misunderstandings do not happen. Nevertheless, under 17 USC 412, statutory damages are available only in the United States for works that were registered with the Copyright Office prior to infringement.²⁹ Just like most other amateur creators, Searls had not registered his works. However, because his photos were US works, he would have had to register the works prior to suing NBC.³⁰
- 37 Rights owners do not have to settle for statutory damages. If they can show the infringer has made a profit with their work, they can be entitled to their part of it. NBC paid more than \$2 billion for the domestic rights to broadcast the summer and winter Olympics in 2010 and 2012.³¹ Searls' copyrighted works were overlaid maybe 5% of the time. Searls could have claimed they were worth tens of millions of dollars. The court would have probably considered the relevance of the ice crystals and reduced that amount considerably. Showing the profits may have been a difficult task as NBC has said publicly that the Olympics resulted in a multimillion-dollar loss³² for the company. Nevertheless, having copyrighted works in a program that has hundreds of millions of viewers and a multi-billion-dollar budget means that the damages could have been in the range of millions of dollars.
- 38 What about the fact that Searls made the works available for anybody to use royalty-free? If the author is happy sharing his works and does not care to collect royalties, why should NBC have to pay any damages? The rights owner is free to set any price to the licenses or restrict the license to certain uses. The fact that the CC license has limitations of use makes a difference. The royalty-free element is part of the CC license package. The license grants the royalty-free permit only if the licensee meets all the license terms. If the licensee breaches any term of the license, the license terminates automatically.³³ The court should consider the non-licensed use as an infringing use, which is not royalty-free.

I. Potential damages for the infringement

- 34 If NBC could not comply with the license terms, it was infringing on Searls' copyrights. Such infringement opens interesting problems. What kind of damages did Searls suffer? How do you measure infringement damages when the author is willing to share his works for free? Does it matter that NBC tried to negotiate a license but ultimately failed to do so?
- 35 One way to assess the monetary damages is to look at the comparable licensing prices on commercial stock photo sites. An extensive license for an ice crystal photo from iStockPhoto costs less than 100 dollars.²⁸ However, that is the price for licensing prior to the infringement and authors can set their own prices.

D. Combining the corporate and Free Culture values

- 39 Typically, a media company's strategy is to reserve all rights and charge users for the licenses. The Free Culture movement has a different approach. The underlying idea of the Creative Commons licenses is to tailor licenses that retain just the necessary rights and share the rest with the world. At first, it might seem that the ideas of profit maximization and free sharing are not compatible.³⁴ It is true that many rights owners who use CC licenses have no commercial expectations for their works.³⁵ However, many rights owners are using the CC-licensed versions to boost the market for non-licensed uses. Their goal is to increase the exposure of their works with sharing and create demand that would not exist without that attention. There is no reason why media companies could not take advantage of the same strategies in marketing and community-building around their products and services.
- 40 While media companies have been slow to experiment with open content, the free software community has lived in well-functioning symbiosis with the corporate world for two decades. Some of the biggest commercial software vendors have learned to foster and benefit from free software and open licensing. For example, companies such as IBM, Google, and Oracle are actively developing free software that helps them compete in the market, collaborate with developers, and support their business.
- 41 Is there a reason why the content industry has not also taken advantage of the open licensing? How could the companies work together with the Free Culture community? How should the companies collaborate to benefit the community and the company? In other words, how do you build the system so that it rests on a sustainable base?

I. Lessons from the experience

- 42 The authors of the Free Culture community have varying motivations for creating and sharing works.³⁶ In a recent email interview, Searls wrote that he sees his photographs as a tree might see its leaves, i.e.,
- 43 *... as things I create and scatter to the world freely, so other contributors to the world can use them any way they please. While I prefer that users credit me, and I would be glad to accept payment if they choose to provide it, I would rather not require either, or to encumber use and re-use in any way.*
- 44 Searls' current view to his copyrighted works is very liberal and permissive. However, Searls has changed the way he licenses his works several times in the

past couple of years. The motivations and their changes reflect in the licenses that the authors choose to use.

- 45 When Searls first chose to use the CC licenses, he picked the license that permits only non-commercial use. He wanted to make sure that automatic spam blogs would not use his photos and monetize them with ads. Searls chose to change his non-commercial license to the ShareAlike license in 2009. He made the change after realizing that Wikipedia would not use his photos if they were under the NonCommercial license. Finally, the experience with NBC made him ready to change all his photos to the CC0 license, which is close to public domain dedication.³⁷ Searls said he would have changed the licenses, but changing the licenses in tens of thousands of photos in Flickr is cumbersome and Flickr does not enable easy labeling of photos with the CC0 licenses.
- 46 Many authors prefer to keep more control than Searls. They are happy to share their works, but do not want commercial users to take advantage of their creations for free. For these licensors, Creative Commons has created licenses that permit only non-commercial use. Licensors can also choose to grant licenses that do not permit the alteration of the works. The nuances of the different licenses reflect the diverse motivations of the authors.
- 47 The fact that the Free Culture authors have chosen royalty-free licenses for their works often means they are willing to negotiate deals. Sometimes the parties may want to negotiate separate agreements because the licensee cannot use the work according to the public license. Non-lawyers may be able to replace or waive some of the terms, but creating a copyright license from scratch is a demanding job even for a copyright lawyer.
- 48 There is a dilemma: Should the media company approach with a multipage license that responds to every potential legal need or with a short document a non-lawyer can understand? If a media company is looking to use a work without paying compensation, and sends a copyright license that is an inch thick, the licensor may become suspicious. It is easy to understand why the people at NBC decided not to get lawyers involved in the licensing transaction. Lawyers' involvement with a long, complicated copyright license could scare amateur photographers and unnecessarily slow down the copyright clearing process. Creative professionals are sometimes better at settling legal issues than lawyers who can obfuscate matters. Having a short, plain-language licensing deal does not require the licensor to have a PhD in copyright law, but it certainly helps in the process. It can be a hard task to find a competent copyright attorney to make sure the license covers all the bases but is also "human-readable."

- 49 One solution is to use the industry's standard agreements and pay a fair licensing fee. Amateur authors are often flattered that their work qualifies as a commercial production. Paying the going industry rate is an acknowledgement that the amateur is producing valuable work, and could mean the courts will interpret potential licensing disputes like any other commercial licensing transactions.
- 50 The other option is to try to play on the terms of the Free Culture community. A company should examine whether there is something non-monetary that the company could do for the author in exchange for a free license. Authors and artists such as Searls do not mind sharing their works for free online to large, non-paying audiences. However, they often do mind if for-profit companies try to take advantage of them without giving anything back. Asking permission politely and attributing the authors, their work, and any other way of providing more traffic to the authors' websites can often be more rewarding to the authors than monetary compensation.
- 51 While eventually NBC did credit Searls in the end credits, the credits did not inform the viewers what Searls' contribution was, where the viewers could access Searls' photos, and that they were free to use his photos under the CC license. Had NBC created a story of how they used Searls' photos and presented it during the Olympic Games, they would have scored points with the web-savvy audience and rewarded Searls handsomely with attention. There could have been a simple way to please the whole CC community and create a human-interest story by covering the amateur-professional collaboration during the games. The story could have presented Flickr and Searls as a part of a wider Free Culture movement that contributes valuable works to a show that millions of Americans enjoy watching.
- 52 Giving something back to the Free Culture community makes it easier to deal with its members in the future. Nothing makes the amateur crowd happier than seeing their works make it into a professional production. Big Hollywood productions like *Iron Man*³⁸ and *Children of Men*³⁹ have managed to use the CC-licensed material successfully and the Free Culture community has rejoiced.⁴⁰
- 53 CC licenses cover only copyright issues. Producers need to take into account several other legal issues as well. In 2007, a teenage girl sued Virgin Mobile for using her photo in an ad campaign.⁴¹ While the photographer released the work and Virgin Mobile used it under a Creative Commons license, the person in the photo had not released the photo for advertising use. Amateur photographers often have not cleared privacy and publicity rights with their models and, even if they have, the CC license does not include permission from the models. While privacy and publicity rights were not relevant with the

abstract snow crystals in this case, it is something media companies have to keep in mind when using CC-licensed amateur photos and videos.

II. Setting policies for Open Content use

- 54 The old media is just learning to use the new social media. Tapping into the pool of amateur creativity offers rewards both in reduced production costs and increased audience participation. The growing catalogue of CC-licensed works provides amazing material that may not be available in commercial stock photo services. However, there are some caveats in dealing with amateur licensors. Many authors are unaware of the details of the terms of the licenses they use. Chances are they have not read the license text and might not even know which license they are using. In the end, it is the licensee's responsibility to understand and respect the terms of the license and to acquire all the necessary permissions from all the rights owners.
- 55 The license details can be demanding for a non-professional licensee to grasp. For example, it really takes an effort to understand how the licensee can properly attribute the original author if the licensee makes adapted works.⁴² Researchers from the Decentralized Information Group at MIT sampled over a thousand CC-licensed photos on several websites and found the licensees had managed to properly attribute the author in less than 20% of the photos.⁴³ Creative Commons built its licenses so that ignoring the strict rules of giving credit may void the license and open the gate for an infringement suit. This is why authors who work for media companies and want to use CC-licensed works should get proper training for using those works. Creative Commons' website provides relevant information and is a good place to start, but it does not replace lawyers' advice. Having an in-house policy and instructions for using Free Culture works would reduce the research the creative people have to do.
- 56 What should a policy document include? Probably the easiest policy is to prohibit the use of open content altogether. However, a policy that prohibits the use of open-content work means the company will give a competition edge to its rivals, who can take advantage of the huge repositories of open content. If a company wants to take advantage of the open-content repositories and avoid legal risks, it should train its employees to spot the potential legal pitfalls in advance.
- 57 The policy should at least 1) list the licenses that are safe for the company to use and list sites that have reliable and usable content; 2) include a checklist of non-copyright issues that the produc-

tion has to clear; 3) outline a process for storing license information so the company can show that it acted in good faith and relied on a license the author had granted; 4) instruct how the use of the licensed works affects the sharing of the productions; 5) include templates for proper attribution (while the licenses do not require the licensees to report their use, many licensors value having knowledge of where and how licensees are using their works); and 6) have a plan for how the company contributes back to the community.

- 58 The policy is a first step, but organizations could easily implement technologies that make sure that authors respect copyrights and licensing terms. A simple software program can check the images on web pages for RDF rights description metadata, which some software includes with the digital images. If the metadata includes CC tags and the publisher has not attributed the author of the photo, it should be flagged or automatically attributed correctly.⁴⁴
- 59 The guidelines should also include contact information to an in-house attorney who is familiar with the open-content issues. You do not need a lawyer to deal with every licensing issue, particularly when you use standard licenses drafted by skilled lawyers. Creative Commons has used an army of them to make sure that their licenses cover all bases and deal with the most common questions that arise in licensing. They have done it so the amateur artists and re-users do not have to negotiate repeatedly for the most common uses. If the production team needs to deviate from the company's licensing policy, there should be an easy way to contact the legal department and check whether there is a need for a lawyer to get involved.
- 60 Television producers and creative teams are not the only ones tempted to use Creative Commons' licensed works. Today many journalists use Wikipedia as a source for their research. Journalists who are used to copying and pasting text from news agency press releases might carry on the habit with Wikipedia. However, while the license Wikipedia uses allows copying, there are rules and limitations involved in the practice. The practice is very different from the ones journalists are used to dealing with. In 2009, the Wikimedia Foundation shifted all its sites to CC BY-SA license use.⁴⁵ Newspapers and other media outlets caught plagiarizing Wikipedia content do not just encounter copyright claims; they also risk losing face. People who do not trust Wikipedia also lose their trust in the publications that directly copy those works. And, finally, the people who trust and contribute to Wikipedia may think their contributions are taken advantage of without the reciprocity on which that community is based.

E. Conclusions

- 61 The story did not receive a lot of publicity during the Olympics. Doc Searls published a short post on his blog and there was an email discussion among his university colleagues. I also posted a description of the events and a call for policy-setting.⁴⁶ When I published my blog post, I received feedback that the story was spreading unnecessary fear, uncertainty, and doubt (FUD) and that speculation regarding potential outcomes can scare people from using the CC-licensed works and harm the PR image of the Free Culture cover model. However, the image stain to Creative Commons would have been much greater had Searls sued NBC for multimillion-dollar damages.
- 62 The people in the Free Culture world with whom I have discussed the case see the use of CC-licensed works as a victory for the Free Culture movement. "NBC's extensive use of Searls' photos, and Searls' happiness for that use, demonstrates the power of Creative Commons licenses as a means to signal openness to collaboration, even if the resulting collaboration does not occur under the terms of the license originally offered," said Mike Linksvayer, Vice-President of Creative Commons in an email interview. The attention and the huge audience is a reward itself for many amateurs. However, NBC used the photos without really giving much back to the community. The ShareAlike licenses Searls used create copyleft reciprocity – the idea is that if I give you a permission to share and build upon, please do the same thing for me. NBC did not share any of its assets. The end credits did list Searls as a member of the creative team, but the credits did not show what his contribution was. Again, if NBC had done the attribution according to the CC license, the audience would have known the graphics were using Searls' photos and the audience was free to do the same thing. Therefore, the ice crystals were a victory for amateur creativity, but not as much for the Free Culture movement. The positive side is that Doc Searls was thrilled to see his photos in the Olympics. One can also hope the incident will act as the first step for NBC to prepare the organization for dealing with amateur licensors and to start a fruitful collaboration with the Free Culture movement that is open for corporations and amateurs alike.
- 63 The incident did not spell the end of the world for NBC, and Searls was honored to see his photos in the Olympics. However, unfortunately, it seems evident that NBC as a company may have failed to learn from the experience. It is likely the creative department did not talk to the legal department about the negotiations. The case offered plenty of lessons for an organization such as NBC. The most important lesson is to prepare a policy and best practices to deal with amateur licensors.

- 64 Litigation does not benefit the Free Culture movement or media companies. Yet media companies – and their deep pockets – are prime targets for copyright litigation. While the same rules of law do apply to these companies, the fact that they have bigger budgets does not mean they are more liable if they act diligently. Having an Open Content policy that is enforced will limit the legal troubles, but may also show that the production has done everything to comply with the community rules. If a rights owner then surfaces with a claim for infringement even though the producers have played their cards publicly, the judge in the case would most likely reduce the financial liability for the infringement.
- 65 After reading a draft of this article, Doc Searls responded,
- 66 *CC does provide a nicely bounded context for zones of interaction between parties with good will towards each other, who don't require lawyers to help them reach agreements, whether or not those agreements are within the letter of the relevant laws. If both parties agree, and no harm is done to either party or anybody else, what harm is done?*
- 67 In a way, he is right. In a perfect world where people do not sue each other, non-lawyers can negotiate permissions. However, we live in a world where courts expect parties to write down accurately the terms of the agreements. Failure to do so might lead to unexpected consequences. The Creative Commons public licenses are detailed and well-prepared legal documents that leave little room for interpretation. A set of lawyer-drafted private licenses will help to reduce the need for post-licensing arguments. However, it is clear the private licenses have to take into account that the licensors are not lawyers and may not have the resources or willingness to employ one to explain the licenses to them.
- * I would like to thank Oshani Seneviratne and Doc Searls for their valuable comments.
- 1 Lawrence Lessig, *The Creative Commons*, 65 MONT. L. REV. 1 (2004).
- 2 Jacobsen v. Katzer, 535 F. 3d 1373 (2008) (free licensing does not mean that no economic consideration has been received by the licensor).
- 3 2010_02_14 Olympic Ice Shots, <http://www.flickr.com/photos/docsearls/sets/72157623323934755/>.
- 4 Doc Searls: Not a medal, but still an Olympic win, Feb. 16, 2010, <http://blogs.law.harvard.edu/doc/2010/02/16/not-a-medal-but-still-an-olympic-win/>.
- 5 Herkko Hietanen, *The Pursuit of Efficient Copyright Licensing – How Some Rights Reserved Attempts to Solve the Problems of All Rights Reserved* (2008).
- 6 Lawrence Lessig, *Re-Crafting a Public Domain* 18 YALE J.L. & HUMAN. 56, 82 (Special Issue 2006).
- 7 Microstar v. Formgen, Inc., 154 F.3d 1107, 1113 (9th Cir. 1998) (the transfer of the exclusive rights granted to copyright owners including the right to prepare derivative works must be in writing, but nonexclusive licenses may be granted orally or implied by conduct).
- 8 Maxwell, Inc. v. Veeck, 110 F.3d 749, 751-752 (11th Cir. 1999) (the court found a nonexclusive license from course of conduct and the parties' oral representations).
- 9 Sender's name omitted (emphasis added).
- 10 Konigsberg Int'l. Inc. v. Rice, 16 F.3d 355, 357 (9th Cir. 1994).
- 11 Doc Searls: Not a medal, but still an Olympic win, Feb. 16, 2010, <http://blogs.law.harvard.edu/doc/2010/02/16/not-a-medal-but-still-an-olympic-win/>.
- 12 See also Niva Elkin-Koren, *What Contracts Cannot Do: The Limits of Private Ordering in Facilitating a Creative Commons*, 74 FORDHAM L. REV. 415 (2005) (discussing the interpretation issues).
- 13 Robert P. Merges, *A New Dynamism in the Public Domain*, 71 U. CHI. L. REV. 183, 199 (2004) (discussing how open public licenses resemble public domain dedications).
- 14 See, e.g., International Institute for the Unification of Private Law (UNIDROIT), Art. 4.2.
- 15 Catharine Mitchell, *Leading a Life of its Own? The Roles of Reasonable Expectation in Contract Law*, 23 OXFORD JOURNAL OF LEGAL STUDIES 639, 648 (2003).
- 16 Wilchcombe v. TeeVee Toons, Inc., 555 F.3d 949, 956 (11th Cir. 2009) (“In determining whether an implied license exists, a court should look at objective factors evincing the party’s intent, including deposition testimony and whether the copyrighted material was delivered without warning that its further use would constitute copyright infringement”), quoting I.A.E., Inc. v. Shaver, 74 F.3d 768, 776 (7th Cir. 1996).
- 17 Asset Marketing Systems, Inc. v. Gagnon, 542 F.3d 748, 756 (9th Cir. 2008) (“Courts have looked to contracts, even if unexecuted, as evidence of the intent of the party submitting the contract”).
- 18 “We saw that there weren’t any restrictions in using this material as long as there was credit given for fair use.”
- 19 “It must be obvious to everyone familiar with equitable principles that it is inequitable for the owner of a copyright, with full notice of an intended infringement, to stand inactive while the proposed infringer spends large sums of money in its exploitation, and to intervene only when his speculation has proved a success.” Peter Letterese and Assoc., Inc. v. World Institute of Scientology Ent., 533 F.3d 1287, 1320 (11th Cir. 2008), quoting Haas v. Leo Feist, Inc., 234 F. 105, 108 (S.D.N.Y. 1916).
- 20 Creative Commons Attribution-ShareAlike 2.0, term 8d, <http://creativecommons.org/licenses/by-sa/2.0/legalcode>.
- 21 Creative Commons Attribution-ShareAlike 2.0, term 4c, (“Such credit may be implemented in any reasonable manner; provided, however, that in the case of a Derivative Work or Collective Work, at a minimum such credit will appear where any other comparable authorship credit appears and in a manner at least as prominent as such other comparable authorship credit.”).
- 22 S.O.S., Inc. v. Payday, Inc., 886 F.2d 1081 (9th Cir. 1989) and Ole Lando & Hugh Beale, *The Principles Of European Contract Law*, The Hague 2000 article 5:103, available at http://frontpage.cbs.dk/law/commission_on_european_contract_law/PECL%20engelsk/engelsk_partI_og_II.htm; International Institute for the Unification of Private Law (UNIDROIT), art. 4.6.
- 23 See, e.g., Rey v. Lafferty, 990 F.2d 1379, 1391 (1st Cir. 1993); Apple Computer, Inc. v. Microsoft Corp., 710 F.Supp. 925, 929 (N.D. Cal. 1989).
- 24 See, e.g., Warner Bros. Pictures v. Columbia Broadcasting Sys., 216 F.2d 945 (9th Cir. 1954); New York Times Co. v. Tasini, 533 U.S. 483 (2001).
- 25 Frisby v. BBC, Ch 932 (1967); Playmedia Sys., Inc. v. America Online, Inc., 171 F. Supp. 2d 1094, 1099 (C.D. Cal. 2001) (“A

- Copyright license must be interpreted narrowly”), *See also* Lionel Bently & Brad Sherman, *Intellectual Property Law* 249 (2d ed. 2004).
- 26 *See also* Saxon v. Blann, 968 F.2d 676, 680 (8th Cir. 1992) (where copyright owner did not state intention to transfer a copyright, owner “therefore did not transfer the copyright”); Weinstein Co. v. Smokewood Entertainment Group, LLC, 664 F. Supp. 2d 332, 340 (S.D.N.Y. 2009) (agreement to transfer copyright “must evidence the transfer with reasonable clarity” and “the intention of a copyright owner seeking to transfer an ownership interest must be clear and unequivocal”); Radio Television Espanola S.A. v. New World Entm’t, Ltd., 183 F.3d 922, 927 (9th Cir. 1999).
 - 27 Doc Searls, *EOF - Commons Interests: Were the Winter Olympics a win for Creative Commons?*, Linux Journal, <http://www.linuxjournal.com/article/10755>.
 - 28 Winter night behind frozen window glass, Vetta stock photo | File #: 11497720 iStockphoto Exclusive, <http://www.istockphoto.com/stock-photo-11497720-winter-night-behind-frozen-window-glass.php>.
 - 29 Thomas Cotter, *Toward a Functional Definition of Publication in Copyright Law*, 92 MINN. L. REV. 1724, 1749 (2008), (the interrelation between the Copyright Act, the Berne Convention, and the Internet, and what constitutes “publication”); *see also* Moberg v. 33T LLC, 666 F. Supp. 2d 415, 420 (D. Del. 2009) (the Swedish plaintiff’s photographs were not published simultaneously in the US regardless of whether the German website was considered to have published them).
 - 30 The statutory precondition of 17 U.S.C.A. § 411 provides that “no civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title.”
 - 31 Edward Wyatt, *NBC Expects Winter Olympics to Lose Money for the Network*, N.Y. TIMES, Jan. 11, 2010, at B11, <http://www.nytimes.com/2010/01/11/sports/olympics/11olympics.html>.
 - 32 *Id.*
 - 33 <http://creativecommons.org/licenses/by-sa/2.0/legalcode>.
 - 34 Robert Merges, *A New Dynamism in the Public Domain*, 71 U. CHI. L. REV. 183, 199 (2004) (argues that stronger rights may increase the benefit of giving creative works away for some people).
 - 35 Herkko Hietanen, *License or a Contract, Analyzing the Nature of Creative Commons Licenses*, 6 NORDIC INTELLECTUAL PROPERTY LAW REVIEW 517 (2007).
 - 36 *See, e.g.*, Oded Nov, *What Motivates Wikipedians*, 11 COMMUNICATIONS OF THE ACM 60 (2007); Hietanen, *supra* note 5.
 - 37 Creative Commons CC0 FAQ, wiki.creativecommons.org/CC0_FAQ.
 - 38 Fred Benenson, *Iron Man and the Right Not to Be Attributed*, Dec. 2, 2008, <http://creativecommons.org/weblog/entry/11118>.
 - 39 Eric Steuer, *Freesound sample in “Children of Men,”* Jan. 17, 2007, <http://creativecommons.org/weblog/entry/7196>.
 - 40 *Iron Man, before and after*, <http://www.flickr.com/photos/adactio/3073579891/>. (There are over 100 comments congratulating the author Jeremy Keith for the photo that made it to *Iron Man*.)
 - 41 Chang and Wong v. Virgin Mobile and Creative Commons Corp., *Plaintiffs’ Original Petition*, available at <http://lessig.org/blog/complaint.pdf>. *See also* Reto Mantz, *Creative Commons-Lizenzen*, 1 GRUR INT. 20, 23 (2008) (commenting on the case); Hietanen, *supra* note 36, at 60-62.
 - 42 Oshani Seneviratne, Lalana Kagal and Tim Berners-Lee, *Policy Aware Content Reuse on the Web*, <http://dig.csail.mit.edu/2009/Papers/ISWC/policy-aware-reuse/paper.pdf>. *Proceedings of the International Semantic Web Conference 2009*. (“Users may be ignorant as to what each of the licenses mean, or forget or be too lazy to check the license terms, or give an incorrect license which violates the original content creator’s intention, or intentionally ignore the CC license given to an original work in their own interests.”).
 - 43 *Id.*
 - 44 *Id.*
 - 45 Herkko Hietanen, *Wikimedia Licensing Policy Change – A Conundrum*, 6 WIPO MAGAZINE (2009).
 - 46 Herkko Hietanen, *NBC Nearly Goes Creative Commons*, THE PI BLOGS, Mar. 1, 2010, <http://cfp.mit.edu/cfp-pi/?p=27>.

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Book review

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- 1 In Höffners Werk erzeugt Ehrfurcht, handelt es sich doch um einen enormen Themenkomplex, dem man sich aus der Richtung unterschiedlicher wissenschaftlicher Disziplinen nähern könnte. Was den Leser wirklich erwartet, verrät Höffner auf S. 4: Die Arbeit folge einem „wirtschaftsgeschichtlichen Ansatz“.
- 2 In der Tat, Höffners derzeit gut 850 Seiten starke Schrift (Erweiterung zum Jahresende angekündigt) setzt den Schwerpunkt auf die *ökonomischen Hintergründe und Zusammenhänge* der Entstehung des Urheberrechts (Band 1) und eine *ökonomische Folgenabschätzung* (Band 2), allerdings mit dem Anspruch, auch die philosophischen und gesellschaftspolitischen Entstehungsbedingungen einzubeziehen. Das zeitliche und räumliche Spektrum der Betrachtung ist ebenso ambitioniert: Die Entwicklungen in England, Frankreich und Deutschland vom 16. bis zum 19. Jahrhundert bilden den Schwerpunkt der Betrachtung, doch auch die Rechts- und Wirtschaftsverhältnisse der Antike, des Mittelalters und der Gegenwart werden an vielen Stellen eingebracht. Insgesamt leidet die Arbeit ein wenig unter ihrem
- universellen Anspruch und hat in der empirischen ökonomischen Rechtsanalyse, vor allem in Band 2, ihre stärksten Momente.
- 3 Höffner liefert eine wirtschaftshistorisch begründete, kritische Auseinandersetzung mit den verbreiteten Theorien zur ökonomischen Rechtfertigung des Urheberrechts. Dabei beschäftigt er sich fast ausschließlich mit dem historischen Verlagswesen und dem Bücherdruck – notwendigerweise, denn die Entstehungsgeschichte des neuzeitlichen Urheberrechts ist zugleich die Geschichte der Entwicklung der Druckwerke zu Wirtschaftsgütern.
- 4 In **Band 1**, der die Grundlagen für die in Band 2 folgende ökonomische Analyse legt, breitet Höffner in minutiöser Kleinarbeit die Entstehungsbedingungen aus, unter denen sich seit der Einführung des Buchdrucks die Ausschließlichkeitsrechte zunächst der Verleger, dann der Autoren entwickelt haben. Dabei beginnt Höffner an den Wurzeln, nämlich bei den alten Griechen und Römern. Schon in diesen Exkursen merkt man, dass Höffner bisweilen dazu neigt, seine bedeutungsschweren Thesen apodiktisch vor-

zutragen. Dies ist schlicht dem enormen geschichtlichen Umfang geschuldet, den er sich in seiner Betrachtung auferlegt.

- 5 Tiefgründig und weit ausholend erzählt Höffner die Geschichte des Verlagswesens und des Buchhandels. Im Grundsatz kann man Höffner recht geben: „Der Wunsch nach einem Schutz vor Kopien setzte erst nach der Verbreitung des Buchdrucks ein“ (S. 20). Höffner erläutert bis in kleinste Details, wer vom Buchdruck Gebrauch machte,¹ welche Arten von Büchern gedruckt wurden (etwa Luthers Thesen),² und wie allmählich die Nachdrucke zum Ärgernis für die Verleger wurden. Für sämtliche geschichtliche Fakten und Anekdoten wartet Höffner mit Fundstellen auf, überhaupt ist seine Arbeit hervorragend dokumentiert. Allerdings bietet Band 1, anders als Band 2, kaum neue Erkenntnisse und Thesen, denn die geschichtlichen Ursprünge des Urheberrechts sind in zahlreichen Schriften bereits ausführlich dokumentiert; auf sie wird ausgiebig verwiesen.
- 6 Mit dem Privilegienwesen, das in urheberrechtshistorischen Werken traditionell ausgiebig erörtert wird, beschäftigt sich Höffner bewusst nur am Rande, und legt den Fokus vielmehr auf die Druckerordnungen im Deutschland des 16. und 17. Jahrhunderts (S. 7). Eine von Höffners Hauptthesen im ersten Band ist, dass sich schon mitten im 17. Jahrhundert in Deutschland ein „vollständiges Immaterialgüterrecht“ entwickelt habe (S. 194). Insbesondere die Frankfurter Druckordnung von 1598 beweise, dass „das geistige Eigentum als Regelungsgegenstand in Deutschland bereits im 16. Jahrhundert vollständig bekannt war“ (S. 203). Höffner setzt damit früher an als etwa der einflussreiche Autor Pütter³ oder (aus neuerer Zeit) Gieseke und Hilty, die das Konzept des geistigen Eigentums erst im 18. Jahrhundert lokalisieren (S. 194 f., 210 m.w.N.). Zum Ursprung des Urheberrechts schreibt er, es handle sich um „ein überkommenes Relikt, ein Rest aus der aus dem späten Mittelalter stammenden Wirtschaftspolitik“ (S. 379). Höffner scheut auch nicht den Vergleich mit Schutzzöllen und der Planwirtschaft absolutistischer Fürsten, die eine ähnliche protektionistische Wirkung gehabt hätten (Bd. 2, S. 261).
- 7 In getrennten Abschnitten seziert Höffner in Band 1 die Entwicklung des Buchdrucks und der entsprechenden Regeln und Gesetze in England, Deutschland und Frankreich. Die Abschnitte haben sprechende Bezeichnungen: „England – das Handelsgut“, „Deutschland – Staatenwettbewerb“, „Die Aufklärung und das Originalgenie“. Mit vielen rechtlichen Wertungen rennt Höffner offene Türen ein, etwa mit der Feststellung, dass das Copyright in England ursprünglich ein Recht des Verlegers war und den Autoren wenig nützte (S. 64 f.). Wertvoll sind jedoch die unzähligen Fakten, Fallbeispiele und Literaturnachweise, etwa zu den englischen Büchergilden. Daneben will Höffner en passant rechtsphilosophische Grundprinzipien und Geschichtsabschnitte erläutern, wie etwa „die Besonderheit des Naturrechts“ (S. 72 f.), das „Eigentum an körperlichen Gegenständen als Rechtsinstitut“ (S. 174), die Geschichte der britischen Jurisprudenz seit William the Conqueror (S. 103 ff.) oder die Entstehung des Urheberpersönlichkeitsrechts, die er innerhalb einer Buchseite (!) mit Verweisen auf Platon, Hegel, Schopenhauer, Nietzsche, Wagner, Mann und Mundt durchexerziert (S. 122 f.).
- 8 Wo die Erörterung sich auf die ökonomische Wirklichkeit zurückbesinnt, findet sie den roten Faden wieder: etwa bei den Plädoyers der englischen Buchdruckergilde (1643) für ein geistiges Eigentumsrecht (S. 84), die verblüffend nah an heutigen Argumentationsmustern liegen. Mit Interesse liest man auch über die wirtschaftlichen Bedingungen, unter denen die deutschen Autoren ihrer Profession nachgingen. Im Abschnitt zu Frankreich geht Höffner vor allem auf das Konzept des Künstlergenies und dessen Zusammenhang mit der Entstehung des geistigen Eigentums ein. Darauf folgt ein Kapitel „Das Buch, sein Geistiges“, in dem die ersten Versuche der künstlerischen Autoren im 18. Jahrhundert geschildert werden, von ihren Honoraren zu leben (S. 323).
- 9 Im **zweiten Buch** kündigt Höffner „eine empirische Untersuchung über die Wirkung des Urheberrechts in der Zeit beginnend nach dem Siebenjährigen Krieg [1763] bis ungefähr 1850“ an (S. 2). Eine hochinteressante, vielversprechende Zielsetzung. Die utilitaristischen Begründungen für das Urheberrecht (Anreizfunktion, Sicherstellung der kulturellen Vielfalt usw.) müssten sich an einer solchen Empirie messen lassen. Im Kern untersucht Höffner die Auswirkung der Einführung des Nachdruckschutzes und macht sich dabei die zeitliche Differenz zwischen England (1710 mit dem Statute of Anne) und Deutschland (ab etwa 1837) zunutze.
- 10 Höffner nimmt vorweg, dass sich im Laufe seiner Untersuchung sein Bild über das Urheberrecht vollständig gewandelt habe – und zwar zum Negativen. Bis 1880 müsse „man die Vorteile des Urheberrechts mit der Lupe suchen“ und werde „selbst dann kaum fündig“ (S. 3). Seine Bilanz ist vernichtend: „Die vermuteten Nachteile einer freien Kopierbarkeit von Werken sind in Deutschland nicht eingetreten. Vielmehr hatte der Nachdruck auf breiter Ebene eine wohlfahrtsfördernde Wirkung. Nach den Theorien hätte sich ein vollkommen gegensätzliches Ergebnis zeigen müssen“ (S. 4). Damit sägt Höffner an den Grundfesten der anerkannten Urheberrechtstheorien.
- 11 Höffner geht davon aus, dass die Autoren im 18. Jahrhundert ganz überwiegend das Ziel des Honorarerwerbs verfolgt haben; die These, viele Autoren hätten damals noch überwiegend für die Ehre geschrieben, geißelt er als „lebensfremde Behauptung“, mit der man versucht habe, die utilitaristi-

- schen Theorien dort zu retten, wo sie eigentlich scheitern müssten (S. 58 f., 109 f.).
- 12 Nach gewohnt weitschweifigen Vorüberlegungen dringt Höffner zum Kern seiner Untersuchung vor: „Zum Sachverhalt“, also der empirischen Zustandsbeschreibung der Buchmärkte in Deutschland und Großbritannien. Diese Analyse strotzt vor Statistiken und Einzelbeispielen. Höffner klärt ebenso über den Wohlstand, die Einkommenssituation und die allgemeine technische Entwicklung auf wie über die Lesefähigkeit, das Bibliothekswesen und – selbstverständlich – über die technischen und wirtschaftlichen Bedingungen der Buchproduktion, und zwar bis auf das Gramm Papier und jeden Taler genau.
 - 13 Besonders widmet sich Höffner den Autorenhonoraren. Diese hätten sich gegen Ende des 18. Jahrhunderts in Deutschland zwar deutlich erhöht, aber auch stark divergiert (S. 201 f.). Die damaligen Honorar-Modelle (Pauschalhonorar, Absatzabhängigkeit etc.) entsprächen in etwa den heute üblichen (S. 209). Entschieden wendet sich Höffner gegen den „Mythos über die schlechten Honorare im Nachdruckzeitalter“ (S. 391). Die breite Masse der deutschen Autoren hätte besser verdient als ihre Kollegen in England, obwohl es drüben seit 1710 einen Nachdruckschutz gab, in Deutschland aber nicht (S. 241 ff., 258). Nur eine Handvoll englischer Bestsellerautoren habe exorbitante Honorare erzielt und so das Bild verzerrt.
 - 14 Profitiert von den Nachdruckverboten hätten, in England und in Deutschland, unterm Strich allein die Verleger – ein interessanter Aspekt, wenn man sich vor Augen führt, wie heute die mächtigen Instrumente des Urheberrechts immer stärker von Werkvermittlern (heute: den „Leistungsschutzberechtigten“) okkupiert werden.
 - 15 Die Wirkungen des in Deutschland bis 1837 blühenden Nachdrucks sieht Höffner vollauf positiv, denn er habe einen Wettbewerbsdruck erzeugt, der die Originalverleger zu häufigen Neuerscheinungen und erschwinglichen Ausgaben gezwungen habe (S. 213). Während im 17. Jahrhundert in Großbritannien deutlich mehr neue Werke erschienen seien als in Deutschland, habe sich das Bild ab 1700 gewandelt (S. 249 f.)⁴ – trotz dessen, oder gerade weil auf der Insel 1710 das Copyright eingeführt wurde. Durch das Statute of Anne hätten weder der Wettbewerb unter den Verlegern, noch der Buchhandel an Dynamik gewonnen (Bd. 1, S. 92). Die Behauptung, der Nachdruck habe zu höheren Preisen geführt, lasse sich an der deutschen Entwicklung nicht bestätigen. Erst der drohende Nachdruck habe die Originalverleger gezwungen, sich an den Produktionskosten zu orientieren (S. 193). Die Deutschen hätten somit ihren Ruf als Volk der Dichter und Denker (zumindest in erheblichem Maße) dem Nachdruck zu verdanken (S. 214).
 - 16 Der vom Nachdruck beflügelte deutsche Büchermarkt habe breite Schichten der Bevölkerung versorgt, sogar mit wissenschaftlichen Veröffentlichungen (S. 254 f.). In Großbritannien seien Bücher exklusive Luxusgegenstände gewesen (S. 226, 230). Ausgerechnet der Bereich, der „nicht durch das Copyright beeinträchtigt wurde“, habe sich dort besser weiterentwickelt als in Deutschland: der Zeitungsmarkt (S. 252 f.).
 - 17 Und nun lässt Höffner seine bemerkenswerte Hauptthese folgen: Bei sämtlichen Indikatoren, die für die Folgen des „Urheberrechts“ (gemeint ist der Nachdruckschutz, 1710 eingeführt durch das Statute of Anne) von Bedeutung seien, nämlich nach dem Preis und der Verbreitung der Bücher, der Anzahl der Neuerscheinungen und dem Autorenhonorar, sei das „britische System offensichtlich und eindeutig dem deutschen unterlegen“ gewesen (S. 253) – und dieses Bestand bis 1837 darin, gar kein Urheberrecht zu haben. Die Annahmen der utilitaristischen Urheberrechtstheorie seien „in überhaupt keinem Umfang tatsächlich eingetreten“. „Der Schutz durch das Verwertungsrecht“ habe „zu niedrigeren Honoraren, weniger Werken, einer geringeren Vielfalt und teureren Büchern geführt“, kurz: zu einem „schädlichen Kreislauf“ (S. 253, 308). In der Tat kann Höffner mit einer frappierenden Grafik zur Zahl der Neuerscheinungen von 1770 bis 1870 aufwarten, in welcher der britische Büchermarkt auf niedrigem Niveau stagniert, der deutsche Markt ab etwa 1815 aber regelrecht explodiert, bis er 1840 das zehnfache des britischen Marktes betrug (S. 254). Die exzellente Entwicklung in Deutschland sei erst durch Einführung des Urheberrechts 1837-1845 jäh gestoppt worden. Das neue Rechtsinstrument habe in Deutschland im Ergebnis zur einer „langfristigen regressiven Phase“ ab 1844 geführt (in der Tat knickt die Kurve in diesem Jahr plötzlich ein, die Zahl der Neuerscheinungen stürzt ab), und die Preise hätten sich vervielfacht (S. 270 f.). Der durchschnittliche deutsche Autor habe 1800 ohne Urheberrecht vergleichsweise mehr verdient als heute (S. 255). Vielleicht hätte Goethe seinen Faust unter einem Urheberrechtsregime gar nicht geschrieben, orakelt Höffner. Und in aller Deutlichkeit schreibt er: ohne Ausschließlichkeitsrechte stünden Autoren, in der Gesamtheit betrachtet, besser dar als mit ihnen (S. 371 f.).
 - 18 Höffners Fazit: „Der Schutz des geistigen Eigentums führte nicht zu dem gewünschten Ergebnis, sondern hat dem Markt praktisch jede Entwicklungsmöglichkeit geraubt“ (S. 255). Mit steigendem Schutz seien – mit Ausnahme der Bestsellerautoren und den dazugehörigen Rechteverwertern – alle Beteiligten schlechter gestellt gewesen (S. 264).
 - 19 Diesen recht pauschalen Thesen möchte man unmittelbar entgegenhalten: Die Konzepte zum Schutz des geistigen Eigentums in England und in Deutschland weisen, wie Höffner an anderer Stelle selbst heraus-

arbeitet, erhebliche Unterschiede auf. Ebenso gut könnte man den Schluss ziehen: das kontinentaleuropäische, an der Person des Urhebers ausgerichtete Urheberrechtskonzept sei dem britischen Copyright-Konzept überlegen gewesen. Aber: dass der deutsche Büchermarkt im 18. Jahrhundert *ohne* ein gesetzliches Urheberrecht jedenfalls ganz hervorragend florierende, wird man angesichts der überdeutlichen Statistiken in Höffners Arbeit anerkennen müssen, und auch, dass er kurz nach Einführung der Nachdruckverbote sofort einbrach und dann etwa 40 Jahre stagnierte.

- 20 Ohne in einen tiefgründigen Disput einzusteigen, wird man aber fragen dürfen, ob nicht das Copyright in Großbritannien vor allem deshalb die erdrosselnde Wirkung für den Büchermarkt gehabt haben könnte, weil hier in einer viel früheren Phase der Marktentwicklung massiv in diesen eingegriffen wurde, während in Deutschland erst über hundert Jahre später ein ähnliches Monopolrecht eingeführt wurde, als der Markt sich schon deutlich gefestigt und vergrößert hatte. Insofern könnte man die Befunde Höffners auch für eine Kritik am frühen Zeitpunkt heranziehen, zu dem Großbritannien den sich entwickelnden Büchermarkt – auf Druck der Verleger – durch mächtige Instrumentarien gestört hat, obwohl man die Folgen für die allgemeine Wohlfahrt nicht sicher abschätzen konnte. Auch der schlichte Umstand, dass es sehr viel weniger Bücher gab, und die einzelnen Bücher daher – anders als später – kaum austauschbar waren, mag dazu geführt haben, dass die Verlage mithilfe des Urheberrechts eine willkürliche Preispolitik betrieben haben. Wurde nicht irgendwann eine „kritische Marktgröße“ erreicht, bei der die Verleger die Kundenbedürfnisse nicht mehr ignorieren konnten, weil mit wachsender Verlegerkonkurrenz und steigender Gesamtbücherzahl mehr und mehr preiswertere Substitute verfügbar waren? Höffner meint, im Betrachtungszeitraum habe es keinen wirksamen Substitutionswettbewerb gegeben; er betrachtet den urheberrechtlich regulierten Buchmarkt grundsätzlich als Monopolmarkt. Das könnte etwas zu kurz gegriffen sein.
- 21 Höffner sieht durch seine Befunde die ökonomischen Theorien über das geistige Eigentum, die sich übrigens seit 1774 nicht wesentlich geändert hätten, praktisch entkräftet; es handle sich um „wertlose Konstruktionen“ (S. 261 f.). Auch hier möchte man protestieren: Höffners gute empirische Argumente lassen sich letztlich nur gegen den Nachdruckschutz richten, und auch nur für den untersuchten Zeitraum, nicht gegen das Konzept des Urheberrechts oder gar des geistigen Eigentums an sich. Der Nachdruckschutz, oder allgemein: das Vervielfältigungsrecht ist zwar ein zentrales urheberrechtliches Verbot, es ist aber keinesfalls mit dem Urheberrecht gleichzusetzen.
- 22 Auch fragt man sich, ob es primär dem Copyright angelastet werden kann, dass in Großbritannien niemand in die Marktlücke für billige Nachdrucke eingetreten ist, obwohl augenscheinlich eine gewaltige Nachfrage danach bestanden haben muss (siehe Deutschland). Offenbar hat der Markt kolossal versagt. Besteht wirklich ein Kausalzusammenhang zwischen Copyright und dieser Unterentwicklung? Der Frage geht Höffner selbst nach, und antwortet: es habe Kartelle unter den britischen Verlegern gegeben, die die Preise künstlich hoch gehalten haben (S. 269). Da möchte man antworten: heute würden Wirtschaftsunternehmen sich solche Marktlücken niemals entgehen lassen. Den damaligen britischen Verlegern muss man offenbar eine völlig verfehlte Markteinschätzung attestieren. Lediglich am Rande stellt Höffner ähnliche Überlegungen an: Man habe in Großbritannien in weiten Kreisen die Unterentwicklung des Marktes nicht realisiert, und das Angebot habe sich vom tatsächlichen Bedarf abgekoppelt (S. 373). Interessant sein Gedankenexperiment zum Internet: wären die frühen Internetdienste von vornherein kostenpflichtig gewesen, wäre das Internet womöglich auch verkümmert, ohne dass man sein Potenzial erkannt hätte.
- 23 Dann schlägt Höffner noch den Bogen zur Gegenwart und macht einen konkreten Vorschlag zur ökonomisch sinnvollen Ausgestaltung des Urheberrechts unter heutigen Bedingungen. Der Vorschlag orientiert sich an Kant, und lautet: ... Aber nein, etwas Spannung muss erhalten bleiben. Nur so viel sei vertragen: Höffners Vorschläge sind radikal, aber eine Überlegung wert.
- 24 Fazit: Höffners Arbeit bietet einen wertvollen Fundus an Fakten und literarischen Quellen zur Entstehung des geistigen Eigentums. Offenbar als wissenschaftlicher Rundumschlag konzipiert, liefert sie in erster Linie neue Erkenntnisse über die Entstehung und die Wirkungen der ersten Nachdruckverbote. Lesenswert ist vor allem die ökonomische Folgenabschätzung in Band 2, mit all ihren provokanten Thesen. Höffners Theorie, die Einführung des Nachdruckverbots habe in Deutschland und England zu Wohlfahrtsverlusten geführt, kann man angesichts der gebotenen Faktenmasse nicht leicht widerlegen können. Höffner leistet eine bislang wohl einzigartige empirische Untersuchung der Auswirkungen der ersten urheberrechtlichen Statuten. Dies ist ein großes Verdienst. Streitbar sind aber seine Schlussfolgerungen, gipfelnd in einer Fundamentalkritik an geistigen Eigentumsrechten und der Verwerfung aller gängigen utilitaristischen Begründungsmuster.
- 25 Jedenfalls zeigt Höffner eindrucksvoll, dass man mit rein utilitaristischen Theoremen leicht in argumentative Sackgassen geraten kann, wenn man die empirische Probe aufs Exempel vorgerechnet bekommt. Der erste Zweifler an der ökonomischen Sinnhaftigkeit der geistigen Eigentumsrechte mit ihren mo-

nopolistischen Auswirkungen ist Höffner beileibe nicht. Schon 1961 schrieb Fritz Machlup: „Gäbe es bei uns keinen Patentschutz, so wäre es nach der gegenwärtigen Kenntnis seiner wirtschaftlichen Folgen unverantwortlich, die Annahme eines Patentgesetzes zu empfehlen.“⁵ Da ist man als Urheberrechtler froh, als letzte Zuflucht die moralischen und naturrechtlichen Begründungsmuster in der Hinterhand zu haben.

26 Wer über die ökonomische Rechtfertigung geistiger Eigentumsrechte diskutiert, wird zukünftig an einer Auseinandersetzung mit Höffner nicht vorbeikommen.

- 1 Bis zum Jahr 1500 sollen es rund 250-270 Druckorte in Europa gegeben haben, S. 20, m.w.N.
- 2 1570 waren beinahe die Hälfte der Messe-Neuerscheinungen theologische Werke, 1800 machten diese Werke nur noch 6 % aus, S. 46.
- 3 Pütter, Johann Stephan: Der Büchernachdruck nach ächten Grundsätzen des Rechts geprüft, 1774.
- 4 Beachte insb. die Grafik auf S. 250.
- 5 GRUR Ausl 1961, 524, 537.

OPINION OF EUROPEAN ACADEMICS ON ANTI-COUNTERFEITING TRADE AGREEMENT

The Signatories of the Opinion

following the adoption of the Anti-Counterfeiting Trade Agreement (ACTA) on 3rd December 2010 recognizing that

- (a) the extensive international trade in goods infringing intellectual property rights prejudices the legitimate interests of right holders and thus appropriate enforcement standards as well as international cooperation are needed;*
- (b) ACTA does not intend to extend the scope of protection of intellectual property rights granted under national laws and contains general provisions committed to balanced enforcement procedures;*
- (c) the most controversial enforcement measures proposed in the initial stages of the negotiations of ACTA have been narrowed down or abandoned in its final version;*
- (d) the appropriate balance needs to be effectively ensured between the enforcement of intellectual property rights and the fundamental rights of users such as the right to information and education, the freedom of expression, the right to accessible health care, the right to privacy and protection of personal data, the right to due process as well as other human rights and good governance in general;*
- (e) the protection and enforcement of intellectual property is one of the means to promote technological and creative innovation and its dissemination to the public; it thus must be seen together and not in conflict with other EU internal and external policies such as the promotion of the information society, the fostering of education, health care and development in third countries, and the promotion of biological and cultural diversity on an international scale;*
- (f) the Commission repeatedly reassured and the European Parliament welcomed in its Resolution of 24 November 2010 that ACTA is entirely compatible with existing EU law, but in fact this is not clear;*
- (g) certain controversial provisions were not fully removed from ACTA but are in some cases formulated as non-binding (“may”) clauses, which signifies international political incitement to implement these clauses into contracting Party’s law;*
- (h) ACTA, being plurilateral in its nature, contains numerous provisions requiring higher enforcement standards than those set under existing international agreements; no state shall be put under pressure to adopt standards negotiated in a forum in which it did not participate;*

draw the attention to the following points:

I. EU LAW

Contrary to the European Commission's repeated statements and the European Parliament's resolution of 24 November 2010, certain ACTA provisions are not entirely compatible with EU law and will directly or indirectly require additional action on the EU level.

The following is a non-exhaustive list of illustrations that indicate the general tendency of ACTA:

Civil enforcement

1. Injunctions: art. 8.1 ACTA requires Contracting Parties to grant an order against a party to desist from an infringement, and *inter alia*, an order to that party or, where appropriate, to a third party to prevent infringing goods from entering into the channels of commerce. While the wording of art. 8.1 ACTA itself appears to be similar to the corresponding provision of art. 11 Directive 2004/48, it is worth mentioning that art. 12 of Directive 2004/48 gives the Member States an option to order pecuniary compensation to be paid to the injured party instead of applying the measures provided for in art. 11 Directive 2004/48, if the conditions specified in art. 12 are met. It seems that this option would be lost or at least called into question if art. 8.1 ACTA were enacted in its present form. It should not be forgotten that the US Supreme Court has recently upheld the traditional equitable four-factor test for injunctions in patent law and rejected an approach which favours automatic injunctive relief¹.
2. Damages: art. 9.1 ACTA refers to a set of criteria which specifies the amount of compensatory damages. Some of the factors mentioned at the end of the provision are not provided for in art. 13.1 Directive 2004/48. These factors should not be adopted in European law since they are not appropriate to measure the damage. "The value of the infringed good or service, measured by the market price, [or] the suggested retail price", as indicated in art. 9.1 ACTA, does not reflect the economic loss suffered by the right holder. Furthermore, according to art. 9.4 ACTA pre-established damages or presumption based damages (especially reasonable royalties) may only be ordered as an alternative to the damages referred to in art. 9.1 (compensatory damages) and art. 9.2 (infringer's profits). In the absence of a clear rule on the alternative application of art. 9.1 or art. 9.2, it may be argued that compensatory damages and infringer's profits may be ordered cumulatively which is not explicitly stated in art. 13 Directive 2004/48. This would raise the amount of damages for the infringement of intellectual property.
3. Other Remedies: for corrective measures, art. 10 ACTA shifts the focus from "disposal outside the channels of commerce" to outright destruction ("except in exceptional circumstances"), while art. 10 Directive 2004/48 provide several options, destruction only being one of them. Also, it may be asked why the caveat of proportionality which exists in art. 10.3 Directive 2004/48 is omitted. In particular, the interests of non-infringing third parties may need to be protected (e.g. property rights in the infringing goods which may have been acquired by a bona fide consumer; property of third parties in the materials/implements used to create the infringing goods). It is true that art. 6.3 ACTA provides for a general requirement of proportionality, but the same holds true for art. 3 Directive 2004/48, and still there is a specific reference to proportionality in the specific provision on corrective measures.
4. Provisional Measures: art. 12 ACTA does not make specific reference to the procedural guarantees for the defendant laid down in Directive 2004/48 (arts. 9.4, 9.5 Directive 2004/48). This is unfortunate, as the European Court of Justice has stressed the importance of these provisions "to ensure that a balance is maintained between the competing rights and obligations of the right holder and of the defendant"². Both the Luxembourg and the

Strasbourg³ courts have repeatedly held that the right to be heard occupies an eminent position in the organisation and conduct of a fair legal process. While the specific rules concerning the right to be heard may vary according to the urgency of the matter (and thus allow the adoption of provisional measures *inaudita altera parte* as provided for in art. 12.2 ACTA), “any restriction on the exercise of that right must be duly justified and surrounded by procedural guarantees ensuring that persons concerned by such proceedings actually have the opportunity to challenge the measures adopted in urgency”⁴. It is not easy to understand why ACTA provides for provisional measures *inaudita altera parte*, but does not at the same time take up the procedural guarantees which have been introduced in Directive 2004/48 and which are necessary to ensure that persons concerned by such proceedings have a later opportunity to challenge these measures.

Border measures

5. Definition: ACTA’s provision on the scope of the border measures section contains an ambiguity giving rise to potential misuse. Whereas art. 2.1(a) Border Measures Regulation 1383/2003/EC (BMR) specifically narrows the scope of application of border measures for trademark infringements to “counterfeit goods” only, art. 13 ACTA instead allows border measures in the case of “intellectual property rights” in general and thus applies to all kinds of trademark infringements. IP rights are defined in art. 5 (h) ACTA as all categories of IP covered by TRIPS. This suggests an interpretation of art. 13 ACTA that includes not only cases of counterfeiting, but also all other forms of trademark infringements based on mere similarity of signs, risk of confusion and even the protection for well-known trademarks against dilution. This is not only a clear extension of the EU *acquis*, but presents a particular problem for international trade in generic medicines which could be seized based on allegations of ‘ordinary’ trademark infringements. For all these reasons, art. 13 ACTA requires re-wording or, at least, a narrow interpretation and implementation. As art. 13 ACTA allows Contracting Parties to exclude certain forms of IP infringements as long as this does not amount to ‘unjustifiable discrimination’, public health grounds can justify the exclusion of ordinary trademark infringements from the scope of border measures. This would also ensure that ACTA parties live up to their general obligation in art. 6.1 ACTA not to create barriers to legitimate trade.

Criminal enforcement

6. No EU *acquis* on criminal measures: within the EU legal framework there are currently no provisions on criminal enforcement of intellectual property rights. ACTA, therefore, is by nature outside the EU law and would require additional legislation on the EU level.
7. Scope: art. 23.1 ACTA provides for a broad definition of ‘commercial scale’ covering all acts carried out on a commercial scale including at least those carried out as commercial activities for direct or indirect economic or commercial advantage. By contrast, in its Position of 25 April 2007, the European Parliament (EP) expressly excluded acts “carried out by private users for personal and not-for-profit purposes”⁵. The EP also declared that “the fair use of a protected work, including such use by reproduction in copies or audio or by any other means, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship or research, does not constitute a criminal offence”. ACTA does not reaffirm these safeguards for private users and for limitations and exceptions.

8. Parallel imports: art. 23.2 ACTA prescribes criminal procedures and penalties on the wilful importation and domestic use on a commercial scale of goods infringing trademark rights. The vague language of the article could seem to cover importation and domestic use of products which, although lawfully marketed in the exporting country, have not been authorized in the importing country. Such interpretation would hinder parallel imports in the EU. The EP in art. 1 of its Position suggested that parallel imports should be specifically excluded from the scope of criminal offences. Such exclusion is not reflected in ACTA.
9. Cinematographic works: while according to art. 23.3 ACTA criminal measures for the unauthorized copying of cinematographic works are merely optional, ACTA prompts Contracting Parties to criminalize such an action without the commercial scale assessment and without any assessment of the intention of the defendant. Again, this disregards the exception in relation to fair use and copying for private and not-for-profit purposes repeatedly stressed by the EP.
10. Safeguards: while strengthening criminal enforcement measures, ACTA at the same time does not provide any of the safeguards needed to ensure the balance of interests between parties and guarantee a due process. In comparison, art. 7 of the EP Position of 25 April 2007 required the prohibition of the misuse of criminal procedures and sanctions, especially when they are employed for the enforcement of the requirements of civil law. Such guarantees, for instance, would be of particular importance in ex officio proceedings allowed under art. 26 ACTA. Also, art. 8 of the EP Position required that the rights of infringers are duly protected and guaranteed. Meanwhile, art. 25 ACTA authorizes judicial national authorities to issue seizure, forfeiture and destruction orders. However, it does not guarantee the infringer's right to be heard in these procedures.

II. INTERNATIONAL LAW

As recognized and welcomed by both the European Commission and the European Parliament, ACTA introduces enforcement standards higher than those existing under current international law. However, certain ACTA provisions do not ensure a balance between the interests of different parties, since they either eliminate safeguards existing under international law or, after strengthening enforcement measures, fail to introduce corresponding safeguarding measures.

Most issues discussed above in relation to EU law are also of concern at the level of international law and go beyond TRIPS. The following points are pertinent only for the international law level. The list contains the most important provisions where the balance of interest is lacking and is meant to be illustrative and non-exhaustive:

Civil enforcement

11. Right of information: art. 11 ACTA strengthens the right of information as already found in art. 47 TRIPS. First, under ACTA it becomes compulsory (voluntary under art. 47 TRIPS). Second, the list of information that might be requested is expanded and the right may be directed both against infringers or alleged infringers (only against infringers under art. 47 TRIPS). Meanwhile, the proportionality requirement, as available under art. 47 TRIPS (and art. 8.1 EU Directive 2004/48), has been eliminated. Also, ACTA contains no effective provision against misuse of acquired information (e.g. comparable to art. 8.3(c) EU Directive 2004/48).

Border Measures

12. Scope: while TRIPS requires border measures only against the importation of counterfeit trademark goods or pirated copyright goods, ACTA parties have to provide border enforcement against imports and exports of goods infringing any IP right covered in TRIPS – except patent rights and test data which are excluded by virtue of fn. 6 ACTA. However, these exemptions as such do not offer sufficient safeguards for the international trade in generic drugs. Extending border measures to goods suspected of ‘ordinary’ trademark infringement can create barriers to global trade – in particular if applied to generics in transit. ACTA parties hence must take their general obligation, under Article 6.1, “to avoid the creation of barriers to legitimate trade” seriously and establish systems which safeguard international trade and public health.
13. Safeguards: ACTA eliminates the following safeguards available under TRIPS. First, art. 56 TRIPS contains a mandatory requirement that customs must have “authority to order the applicant to pay the importer, the consignee and the owner of the goods appropriate compensation for any injury caused to them through the wrongful detention of goods”. ACTA, however, has no directly equivalent provision for compensation in cases of wrongful detentions. Further, art. 18 ACTA widens the options for right holders to provide securities, while it does not include the (mandatory) option for the goods owner/importer to provide a security under art. 53.2 TRIPS. Instead, it contains a limited allowance for the latter to provide securities to obtain possession of the goods “in exceptional circumstances” (art. 18, 4th sentence ACTA). Finally, art. 55 TRIPS contains mandatory limits to the duration of the initial detention of goods suspected of infringement within which proceedings leading to a decision on the merits of the case have to be initiated or the goods released. Again, ACTA does not contain an equivalent rule – art. 19 ACTA merely demands the initiation of infringement proceedings “within a reasonable period”.

Criminal enforcement

14. Definition of “commercial scale”: art. 23 ACTA defines acts carried out on a “commercial scale” as “commercial activities for direct or indirect economic or commercial advantage”. It is doubtful if this is compatible with a more flexible market/product-based interpretation of commercial scale adopted by the WTO Panel, which refers to “counterfeiting or piracy carried on at the magnitude or extent of typical or usual commercial activity with respect to a given product in a given market”⁶.

Digital chapter

15. Technological measures: arts. 27.5-6 ACTA require stronger protection of technological measures than set under art. 11 WIPO Copyright Treaty and art. 18 WIPO Performances and Phonograms Treaty (no similar provisions exist in TRIPS). In particular, ACTA provides a broad definition of technological measures (no definition under WIPO Treaties), it prohibits both acts of circumvention as well as preparatory acts, and covers technological measures having dual (both legal and illegal) functions. Although art. 27.8 ACTA allows preservation of exceptions and limitations, it does not provide any mechanisms to ensure their exercise and enforcement.
16. Disclosure of subscribers’ data: art. 27.4 ACTA regulates disclosure of subscriber’s data and is broader than the (non-mandatory) right of information under art. 47 TRIPS. Most importantly, whereas ACTA poses a duty to disclose subscribers’ data both on infringing and non-infringing intermediaries, art. 47 TRIPS refers only to an infringer. Also, ACTA

mentions that fundamental principles “such as freedom of expression, fair process, and privacy” shall be preserved. However, it does not provide more specific provisions on how these rights should be effectively ensured (compare with detail provisions on privacy in EU Directives 95/46/EC, 2002/58/EC, and 2006/24/EC).

Taking above into account,

the Signatories of the Opinion invite the European institutions, in particular the European Parliament, and the national legislators and governments,

to carefully consider the above mentioned points and, as long as significant deviations from the EU *acquis* or serious concerns on fundamental rights, data protection, and a fair balance of interests are not properly addressed, to withhold consent.

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For further information and to sign the Opinion see <http://www.iri.uni-hannover.de/acta-1668.html>.

- 1 eBay Inc v. MercExchange, L.L.C., 547 U.S. 388 (2006).
- 2 ECJ Case C-89/99, [2001] ECR I-5851 para. 38 seq. – Schieving-Nijstad.
- 3 ECHR App.-No. 17056/06 para. 78 seq. – Micallef v. Malta.
- 4 ECJ Case C-341/04, [2006] ECR I-3813 para. 66 – Eurofood.
- 5 Position of the European Parliament adopted at first reading on 25 April 2007 with a view to the adoption of Directive 2007/.../EC of the European Parliament and of the Council on criminal measures aimed at ensuring the enforcement of intellectual property rights (EP-PE_TC1-COD(2005)0127).
- 6 China – Measures Affecting the Protection and Enforcement of Intellectual Property Rights (China – IPRs), WT/DS362/R, 09/0240, 26/01/2009.



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20 Jahre Computerprogrammrichtlinie: Eine Bilanz

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