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## Articles

TV Signal Delivery to Cable Operators and DTH Platform Operators: Primary Copyright Use, Retransmission, or Another Form of Communication to Public?  
by Elżbieta Traple

Interoperabilität von Software: Art. 6 der Computerprogramm-Richtlinie aus heutiger Sicht  
by Andreas Wiebe

Software als Schutzgegenstand des Europäischen Urheberrechts  
by Christian Heinze

Sui Generis Rights for the Protection of Traditional Cultural Expressions: Policy Implications  
by K. Bizer, M. Lankau, G. Spindler, P. Zimbehl

The Right to Be Forgotten: More Than a Pandora's Box?  
by Rolf H. Weber

Creative Commons licences and design: Are the two compatible?  
by Catherine Jasserand

## Court decisions

Google face à la justice française et belge: Nouvelles décisions en matière de droit d'auteur  
by Agnès Lucas-Schloetter

GERMANY: Creating New Property Rights on the Basis of General Legal Concepts - Without Limits?  
by Thomas Dreier

## Book reviews

Stig Strömholm, Copyright and the Conflict of Laws: A Comparative Survey  
by Rita Matulionyte

Simon Chesterman, One Nation Under Surveillance – A New Social Contract to Defend Freedom Without Sacrificing Liberty  
by Thomas Dreier

Till Kreutzer, Das Modell des deutschen Urheberrechts und Regelungsalternativen. Konzeptionelle Überlegungen zu Werkbegriff, Zuordnung, Umfang und Dauer des Urheberrechts als Reaktion auf den urheberrechtlichen Funktionswandel  
by Matthias Leistner

## Documents

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## Table Of Contents

### Articles

- TV Signal Delivery to Cable Operators and DTH Platform Operators: Primary Copyright Use, Retransmission, or Another Form of Communication to Public?  
by Elżbieta Traple 75
- Interoperabilität von Software: Art. 6 der Computerprogramm-Richtlinie aus heutiger Sicht  
by Andreas Wiebe 89
- Software als Schutzgegenstand des Europäischen Urheberrechts  
by Christian Heinze 97
- Sui Generis Rights for the Protection of Traditional Cultural Expressions: Policy Implications  
by K. Bizer, M. Lankau, G. Spindler, P. Zimbehl 114
- The Right to Be Forgotten: More Than a Pandora's Box?  
by Rolf H. Weber 120
- Creative Commons licences and design: Are the two compatible?  
by Catherine Jasserand 131

### Court decisions

- Google face à la justice française et belge: Nouvelles décisions en matière de droit d'auteur  
by Agnès Lucas-Schloetter 144
- GERMANY: Creating New Property Rights on the Basis of General Legal Concepts - Without Limits?  
by Thomas Dreier 152

### Book reviews

- Stig Strömholm, Copyright and the Conflict of Laws: A Comparative Survey  
by Rita Matulionyte 158
- Simon Chesterman, One Nation Under Surveillance – A New Social Contract to Defend Freedom Without Sacrificing Liberty  
by Thomas Dreier 162
- Till Kreutzer, Das Modell des deutschen Urheberrechts und Regelungsalternativen. Konzeptionelle Überlegungen zu Werkbegriff, Zuordnung, Umfang und Dauer des Urheberrechts als Reaktion auf den urheberrechtlichen Funktionswandel  
by Matthias Leistner 165

### Documents

- EU Commission: Comments on the "Opinion of European Academics on Anti-Counterfeiting Trade Agreement" 171

# Articles

# TV Signal Delivery to Cable Operators and DTH Platform Operators

## Primary Copyright Use, Retransmission, or Another Form of Communication to Public?

by Elżbieta Traple\*

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**Abstract:** The paper discusses new business models of transmission of television programs in the context of definitions of broadcasting and retransmission. Typically the whole process of supplying content to the end user has two stages: a media service provider supplies a signal assigned to a given TV channel to the cable operators and satellite DTH platform operators (dedicated transmission), and cable operators and satellite DTH platform operators transmit this signal to end users. In each stage the signals are encoded and are not available for the general public without the intervention of cable/platform operators. The services relating to the sup-

ply and transmission of the content are operated by different business entities: each earns money separately and each uses the content protected by copyright. We should determine how to define the actions of the entity supplying the signal with the TV program directly to the cable/digital platform operator and the actions of the entity providing the end user with the signal. The author criticizes the approach presented in the Chellomedia and Norma rulings, arguing that they lead to a significant level of legal uncertainty, and poses the basic questions concerning the notion of "public" in copyright.

**Keywords:** Satellite DTH platform, cable operators, retransmission, communication to public, collecting society, broadcasting, media service provider, mandatory management by collecting society, audiovisual media service, equitable remuneration

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## A. Introduction

1 New models of cooperation between broadcasters, cable operators, and operators of digital platforms all require that digital TV must be transmitted to the end user. This creates serious problems in the domain of the collective management of copyrights. Various entities take part in the transmission process, usually acting on their own behalf, and what they do should be somehow placed within the known modes of use of copyright works. It is necessary to establish which entity is responsible for which part of the transmission process and whether it has obtained all relevant authorizations from the right holders. The adopted classification of such acts will

also determine whether there will be compulsory licensing by a collecting society. A good illustration of this problem can be found in two recent court rulings: BUMA and STEMRA v. Chellomedia Programming and Norma – Irda v. NL Kabel Vecai.<sup>1</sup> Both cases shared a common problem: on the one hand, how to define the actions of the entity supplying the signal with the TV program directly to the cable operator or an operator of a digital TV platform; and on the other hand, how to define the actions of the entity providing the end user with the signal. It has been discussed inter alia whether providing the operator with the signal with the TV program could be understood as broadcasting, retransmission, or maybe another form of communication to the pub-

lic. Should the last view be correct, compulsory licensing by collecting societies would not be applicable. The spotlight has also been cast on the concept of the “public,” deemed to be a necessary component of broadcasting.

- 2 Based on these two rulings, one may furthermore notice that the same use of work may be looked at differently by copyright law and by public law governing broadcasting activities. It seems indispensable to bring the copyright regulations into compliance with the technological neutrality rule of audiovisual services, which is uniformly accepted as the basis for development of the information society. The incompatibility of the definition of a broadcaster in public law regulations with the definition of broadcasting in copyright regulations could impede the process of transferring the technological neutrality rule to copyright law.
- 3 The present paper tries to situate the process of transferring digital signals from the supplier to the cable operator/operator of a digital platform and transmitting the signal to the end user in the context of the definitions of “broadcasting” and “retransmission.” It will also try to discuss the legal and economic consequences of leaving the above-described model of transmitting TV signals outside the scope of compulsory licensing by collecting societies.
- 4 Before we turn to the copyright context of new models of transmission of broadcasts, it would be useful to start with drawing a picture of the various forms of distribution of television channel signals that we come across in practice.

## B. New models of transmission of television programs

### I. Initial comments

- 5 In the new business models for transmitting television programs, we typically deal with specific activities carried out by different business entities. Each conducts business on its own account, while the services relating to supply of the content (the content component) and the transmission of the content (distribution component) to the user are separate. Transmission takes place via an electronic communications network, which is the access facility (for instance, satellite networks and fixed telephone networks, both circuit- and packet-switched, as defined in Art. 2a) of the Directive EC 2002/21).<sup>2</sup>
- 6 The whole process of supplying content to the end user has many stages and includes services relating to creation of the content and putting together of television programs; transmission of a signal car-

rying the programs, i.e., transmission of audiovisual content using electromagnetic energy; operation of an access facility; and finally sale of access to the programs to end users. Consequently, technical and organizational operations, performed to supply television programs to the end user, are performed consecutively by:

- a) the media service provider as defined in Art. 1d) of Directive 89/552/EEC (the “AVMS Directive”)<sup>3</sup> as worded according to Directive EC/2007/65;<sup>4</sup>
- b) cable network operators or satellite DTH platform operators (so-called access facility operators) who are the first users of channel distribution services;
- c) and the entities acting as subcontractors of those listed above, i.e., transmission network operators and others (for example, entities retransmitting the signal and/or supplying telecommunications equipment and telecommunications networks).

## II. Media service provider

- 7 The process described above involves the entity that has actual control over the choice of individual programs as defined in Art. 1b) of the AVMS Directive, and the manner in which they are placed in the chronological layout of the distributed television channel. This entity bears editorial responsibility for the content and is thus the broadcaster from the point of view of public law, i.e., the provider of a media service in the form of television broadcasting (linear audiovisual media service) as defined in Art. 1f) of the AVMS Directive.
- 8 The supply by the media service provider of the television program constitutes the provision of a media audiovisual service as defined in Art. 1a) of the AVMS Directive. The fact that there is no payment to the media service provider directly from the end user cannot change this classification. The term “payment” does not have to be understood in such a way that the consumer always pays for the service directly. For example, in its ruling of 30 April 1974 in the case 155/73 Sacchi,<sup>5</sup> the ECJ found that broadcasting of a television channel maintained solely from the revenue from advertisements shown on that channel constituted a “service.” One should also consider that a large number of television channels are maintained using a portion of the revenue from a subscription fee that the user pays to the access facility operator.
- 9 The media service provider can be a producer (in-house production), co-producer, or entity entitled to make use of the programs under license or sub-license agreements concluded with copyright hold-

ers, with regard to programs making up the content of the channel as defined in Art. 1b) of the AVMS Directive (for example, feature films, documentaries, or transmission of sporting events).<sup>6</sup>

### III. Supply of television signals to users for further transmission

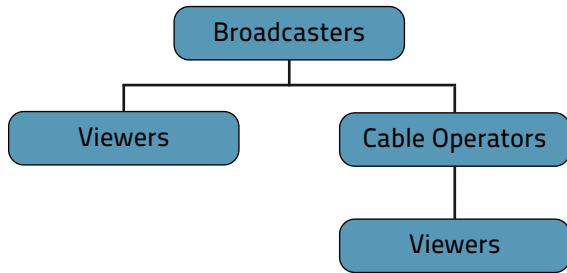
- 10 In the above-described process of transmission of television channels (process of distribution of audiovisual content), a distinction should be made between:
- a) supplying of a signal assigned to a given television channel to the first users, i.e., cable operators and satellite DTH platform operators;
  - b) transmission of a television signal by cable operators and satellite DTH platform operators to end users.
- 11 A media service provider (broadcaster) makes the signal available for a given television channel directly to commercial users (satellite DTH platform operators and cable network operators), who provide the service of distribution of the received signal within the access facility they operate. In each stage the signals are encoded and are not available for general reception by the end user without the intervention of cable operators. The term “cable television network” as defined in Art. 1. 8) of Directive EC 2002/77<sup>7</sup> refers to any mainly wire-based infrastructure established primarily for the delivery or distribution of radio or television broadcasts to the public. Television signals carrying the programs are therefore transmitted via the above-described wire-based cable television infrastructure or satellite-earth DTH platforms, which are a configuration of two or more earth stations interworking by means of a satellite. A media service provider can supply a television program to a cable operator and/or satellite DTH platform operator by way of
- a) wireless transmission made into an encoded signal via an earth telecommunications infrastructure and satellite,
  - b) a wire-based and direct transmission of a signal over a live feed between the entities referred to above,
  - c) supply of carriers (for example, CD, DVD) with recorded audiovisual content for communication.
- 12 This paper discusses only the first two models as the third should not give rise to any controversies in copyright law. In the first of these models, the actions taken during the process of making available the television programs to end users are taken consecutively by the media service provider and cable operator or satellite DTH platform operator. By itself or by making use of the services of transmission infrastructure operators, the media service provider sends the signal via an uplink. The signal is enhanced and encoded to the appropriate standard. As a result, it is not possible to access the data (of a given television channel) without the appropriate devices and technical solutions needed to decode it. The described process of transmission (making available) of the signal is performed by the media service provider solely for a cable operator or satellite DTH platform operator (dedicated transmission). This is because the signal is directed individually, using a satellite downlink, solely to that cable operator or satellite DTH platform operator’s head-end, which has the relevant contractual arrangements with the audiovisual media service provider.
- 13 In the second model, the media service provider transmits the audiovisual content to the cable operator directly via a wire-based connection (over the Internet). This can be done at the same time for a number of cable operators and satellite DTH platform operators. It should be emphasized that the supplied television program does not have to be made available to the public via any other distribution platform, for example via wireless broadcasting of a signal.
- 14 In both cases, the cable and satellite DTH platform operators receive a signal from the media service provider that carries a linear television program for the purpose solely of distributing it to a specified group of users. The operators are required to comply with the following rules:
- a) Provide access to television signals carrying the programs solely to those users who fulfill the payment conditions specified between the media service provider and an access facility operator.
  - b) Secure access to the television signal from third parties who have not been granted access in the manner agreed upon (CAS: conditional access system).
  - c) Refrain from tampering with the integrity of the television programs and any other content of a different nature (any modifications and shortening are not allowed).
  - d) Prevent the television program from being copied and further distributed by unauthorized parties.
  - e) Refrain from using the supplied television program as a carrier for framing.
- 15 To summarize, in the business of cable and satellite DTH platform operators, we are dealing with a mul-

tiptex of received channels and additional services (for example, an Electronic Programme Guide: EPG) in one byte stream and its retransmission in a multi-cast system sent simultaneously to a precisely specified group of end users. This transmission system – in contrast to a point-to-point unicast system and a typical broadcast system – is characterized by a selective supply of television signals solely to those users who fulfill the specified conditions laid down in the broadcaster's agreement with the access facility operator. Cable and satellite DTH platform operators have the option of varying the number and type of television channels that are to be supplied to a given subscriber.

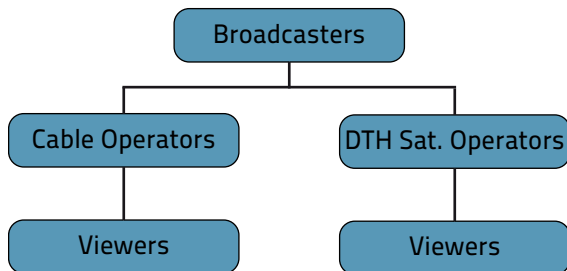
#### IV. Model for cooperation between media service providers and access facility operators

- 16 Different payment models are used in the agreements between cable or satellite DTH platform operators with media service providers:
- a) payment by the media service provider to the access facility operator for transmission of the signal (then however the media service provider collects subscription fees from end users);
  - b) payment by that operator to the media service provider for the right to use the program.
- 17 In both of these cases, the model used for settlement of payments is *per subscriber, per period*.<sup>8</sup>
- 18 These methods of settlement of payments can each exist separately or both at the same time. Usually, media service providers do not enter into exclusive agreements for distribution of a given television channel.<sup>9</sup> It should also be underlined that in the case in question, neither of the categories of the entities described above – as a rule – can be given the right to provide users with authorization for individual access to television channels (*pay-per-view or on demand*).
- 19 A television program is distributed using a conditional access system so that the television channels and other additional services can only be received by persons entitled to do so for the relevant fee. In a given case, the term “conditional access system,” defined in Art. 2b) of Directive 98/84/EC<sup>10</sup> and Art. 2f) of Directive 2002/21/EC, should be understood to mean specific instruments and technical devices – i.e., a combination of technical elements implemented by the access facility operator and located with the user (smartcard, digital decoder) – which form a uniformly functioning system enabling control over access to the audiovisual media service. An audiovisual media service provided in this way constitutes a protected service as defined in Art. 2a) of Directive 98/84/EC, i.e., a service provided against remuneration (paid directly to the access facility operator) and on the basis of conditional access. The signal is therefore encoded to ensure that the user pays the relevant fee. The access facility operator allows users to purchase/rent devices (conditional access device adapted as required) such as terminals or smartcards and authorizes them through transmission of the so-called decoding keys (intelligent access card technology). This system is no different from the typical system of access to the traditional cable television network.
- 20 From an economic point of view, the models described above are characterized by the fact that each entity participating in the transmission process earns money separately and that its business involves the use of content protected by copyright. A media service provider (supplier of content) makes money on advertisements and fees from the operator; the operator – the supplier of the service directly to the subscriber – makes money on the subscription fees. The supplier of the content also makes money on advertising since those submitting the advertisements decide to buy specific advertising slots because of the qualities of the TV channel that it puts together.
- 21 Are the models described above entirely different from the existing ones? The broadcasting market has changed recently because of new digital technologies and through development of new distribution services. Broadcasters seek viewers interested in specific programs; they do not broadcast them via Hertzian waves directly to the public but use intermediaries. As a result, the television signals carrying the programs are not available for general reception by the viewers without the intervention of cable operators. Traditionally, cable operators caught the broadcasted programs from the terrestrial network or from satellite; now broadcasting organizations transmit their programs directly to cable operators (direct feed), who then sell them to their own subscribers. This mechanism justifies the following question: Are there are two separate economic activities involved (as there used to be), which would give the right holders the right to remuneration both from broadcasting companies and from the telecom operator, or only one activity (primary copyright use) and thus only one source of remuneration?
- 22 The difference may be illustrated by the following diagram:

1. Traditional model



2. New model



**C. The model for transmission of programs in the Buma and Stemra v. Chellomedia Programming and Norma v. NLKabel cases**

23 Chellomedia produced various television programs, a large portion of which was copyrighted material, and then uplinked the signals carrying the program in coded form to a distribution satellite from which the signals were then down-linked to cable head-end facilities and DTH (Direct to Home) platforms. These signals could only be received using specialized decoding devices by operators who entered into the appropriate agreement with the broadcaster. The signals could not be directly received by the viewers. The viewers received the signals from the operator and decoded it using the device supplied by the operator. The business model used in the Norma v. NLKabel case (which concerned the neighboring rights, but this does not change much here) was similar. The signals carrying programs were sent directly to cable head-end facilities and DTH platforms and were not accessible to the public. Under copyright law, the question is how the described model for distribution of programs should be classified, i.e., what form of exploitation should be attributed to it. Theoretically, the options are the following:

1. The process of uplinking an encoded signal to a distribution satellite and down-linking it to the operator of head-end facilities or a DTH plat-

form operator is broadcasting, while the process of sending the signal to the end user is retransmission.

2. The process of uplinking an encoded signal to a distribution satellite and down-linking it to the operator of head-end facilities or DTH platform operator is a neutral process from the point of view of copyright law, while the process of sending a signal to an end user is communication to the public other than broadcasting and retransmission, though nevertheless subject to copyright.<sup>11</sup>

3. The process of uplinking an encoded signal to a satellite and then down-linking it to the operator of head-end facilities or DTH platform operator and the process of sending the signal to the end user is a single process in which various entities take part, qualified in its entirety as broadcasting.<sup>12</sup>

24 In the rulings cited above in the Chellomedia and Norma cases, the conclusion of the courts was that the process of uplinking a signal in coded form to a distribution satellite for reception only by cable or DTH platform operators could not be regarded as the initial broadcasting because the signal was intended for a closed group of users, i.e., operators, and not for general reception by the public. As a result, the second part of the process of distribution of the signal could not be considered retransmission and was described as communication of a work to the public. The courts thus adopted the classification described in point 2 above.

25 What are the implications of this reasoning? They are quite serious as far as guaranteeing copyright holders due remuneration and operators a proper level of legal confidence with respect to acquiring the rights needed to conduct business. The operators have no agreements with right holders on the basis of which they would receive the right to communicate the works to the public. A radio or television organization as a media service provider (referred to further for the sake of convenience as a broadcaster) that sends a so-called dedicated signal acquires on the basis of an agreement with the right holders the rights to broadcast and not a vast right to communicate works to the public in any imaginable way. Thus, a broadcaster is not entitled to sublicense the right that it has not received. As explained below, the right to broadcast is a right that falls within the scope of communication to the public but constitutes only a part of that right (i.e., the general right of communication to the public encompasses different separate rights, and broadcasting is only one of them). The broadcaster usually pays a single fee for the broadcast, calculated with regard to such factors as time and the envisaged viewing figures, the geographical scope, and the number of likely repeats.



The broadcaster gains its main revenue from advertising agencies buying advertising spots based on the channel put together beforehand. In this business model, the broadcaster obtains remuneration from the cable operators or the DTH platform operators, too. As hinted above, the cable and DTH platform operators are not subcontractors of the broadcaster with regard to the transmission to the end user; instead, they enter into agreements with the end users independently and in their own name. If we accept the legal classification adopted by the courts in the Chellomedia and Norma cases, the right holder who grants permission to broadcast does not receive any remuneration from the broadcaster from the fees collected by the operators. It is difficult to assume that the copyright holder's agreement with the broadcaster provides for remuneration in this respect because the broadcaster does not know in advance how many subscribers there will be for a given service and what the value of the subscription will be. As far as the business of the operators is concerned, the fact that it is regarded as communication to the public "other than re-transmission" means that the permission and remuneration for exploitation of this kind do not have to be obtained and paid via a collecting society, as would be mandatory in the case of retransmission. Moreover, the cable or DTH platform operators will want to pay the right holder only on the basis of their own revenue from the subscription charged to the end user. Although we are dealing with two separate types of business activity, in which each of the participants independently makes commercial use of a copyright work, the copyright holder would receive only "one" remuneration, i.e., remuneration reflecting the use of the work on only one field of exploitation. It is therefore clear that the classification referred to above considerably limits the copyright holder's right to obtain equitable remuneration. The principle of equitable remuneration is stressed in numerous EU documents, including 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.<sup>13</sup>

- 26 It has long been emphasized in the copyright law doctrine that equitable remuneration to the right holder should be ensured when a third party gains revenues from economic exploitation of his work, i.e., where a business activity depends, at least in part, on the exploitation of the work.<sup>14</sup>
- 27 There is no doubt that the classification applied by the courts in the Cellomedia and Norma cases also has certain negative consequences for the cable and DTH platform operators, as in practice they are forced to obtain permission individually from all relevant right holders. This applies not only to the part of the program with regard to which the broadcasting organization is not the producer, but also often

to the rest of the program. The broadcaster as a producer usually acquires the rights to broadcast and rights of re-transmission and not the right to communicate the work to the public in every possible form. It should be noted at this point that in most national regulations, extended collective management is permitted in the field of radio and television broadcasting, thus ensuring a high level of certainty for users.<sup>15</sup> Cable operators are not able to negotiate licenses with all concerned right holders prior to supplying the signal to the public.

- 28 Adoption of the classification listed in point 3 above would mean that the entire transmission process from the broadcaster to the end user should be treated as one field of exploitation, following the concept adopted in the satellite and cable Directive with respect to satellite transmission. According to its Art. 1 (2), communication to the public by satellite means the act of introducing, under the control and responsibility of the broadcasting organization, the program-carrying signals intended for reception by the public into an uninterrupted chain of communication leading to the satellite and down towards the earth. However, the difference between the process regulated in Art. 1(2) of the cable Directive and the process that is the subject of this article is essential. In the first case, the process of uploading and downloading signals carrying programs remains under the broadcaster's control and responsibility, and the chain of communication may not be interrupted. Retransmission of satellite signals by an independent entity should count as an interruption. In the model of transmission considered in this article, two separate, independent subjects are responsible for the process of communication to the public.
- 29 Treating this process as a whole means the exclusion of mandatory management of a collecting society, which could be detrimental to the legal certainty for operators and could lead to an increase in the management costs. The classification named in point 3 above is neither in line with the concept of the specification of rights built on the criterion of participation of a different entity in the process of exploitation of a work nor on the criterion of separate economic significance of the use, which has been universally accepted in doctrine and, importantly, also introduced into EU directives. Of course, the criteria for specification of a separate right (separate field of exploitation) are not laid down by law; nevertheless, certain principles are universally accepted. We only have to mention the right to retransmission, where the criterion for acknowledging this separate right has been the participation in the entire process of an entity other than the broadcaster.<sup>16</sup> The retransmission does not comprise initial broadcasting in cable networks. Another criterion is the separate economic significance of a specific type of use of a work. In the Directive 2001/29/EC on the Information Society,<sup>17</sup> it is precisely this criterion

that determined the exclusion from the exclusive author's right of temporary reproductions that are transient or incidental, an integral and essential part of a technological process, and whose sole purpose is to enable:

- a) transmission in a network between third parties by an intermediary, or
- b) lawful use of a work or other subject matter to be made, and which have no independent economic significance (Art. 5. 1).

30 In the transmission model discussed here, we are undoubtedly dealing with two procedures carried out by two independent business entities, and each of these procedures has separate economic significance. It seems that this prerequisite should preclude the possibility of the described transmission model being perceived as one broadcasting process or as one process of communication to the public. Moreover, the broadcasting organization does not have any influence on factors such as the scope in which the channel is distributed to subscribers, combining of the channel with other channels in one package, or the subscription price. If only for these reasons, it is difficult to conclude that this is one field of exploitation of works and one right. Since we concur with the viewpoint that the process of retransmission of a signal to the operator and from the operator to the end user are two procedures that are separate, not only technically but above all economically, an attempt should be made to establish how they should be fitted into the existing bundle of separate rights vested with the owner of copyright.

## D. The broadcasting right

- 31 Can we classify the process of supplying the signals carrying the program by a media service provider to a cable or platform operator as broadcasting?
- 32 The Berne Convention does not give a definition of broadcasting. Art. 11bis of the Convention refers to broadcasting of works via radio or television or their communication to the public by means of wireless diffusion of signs, sounds, or images.<sup>18</sup> In line with the universal understanding of this term, in the Convention "broadcasting" is limited to wireless transmission and therefore applies to ground and satellite broadcasting. The requirement that there should be an unrestricted group of viewers to receive the signal has not been mentioned as relevant with respect to the notion of broadcasting.
- 33 No provision in the Convention or in the EU directives assumes that each act of exploitation of a work should give access to the work to the general public. Quite the opposite is true: there is a basic assumption at the core of the philosophy of copyright law

according to which each instance of economic use of a work within the scope of the author's exclusive right is subject to the author's permission, provided there is no private or permissible public use.<sup>19</sup> For this reason, reproduction of a work for the internal purposes of an employer without the permission of the author is an infringement of the author's exclusive rights, and broadcasting of a work within an intranet radio hub or a so-called closed circuit television – i.e., in a way that limits the number of users and precludes the general public from access – is an act of exploitation of the work that can be classified as broadcasting. The term "broadcasting" in copyright law is therefore not inherently linked to reception by an unlimited number of users, and broadcasting will take place even if the group of users is determined in advance. Therefore, the fact that in the business model under consideration in this paper the signal is received by a limited number of entities (operators) is not in itself a fundamental obstacle to arguing that the process of transmission of the signal from a broadcasting station to operators constitutes broadcasting. Moreover, only classification in this way is coherent with provisions concerning broadcasting activity in public law (media and communication law).<sup>20</sup>

- 34 If the broadcasting organization makes a channel available for transmitting by another entity but is responsible for its content, this element is sufficient for that entity to be considered a broadcaster from the point of view of public law. Moreover, in many countries this organization has to obtain a concession for this type of activity if it is not a public radio or public television facility. Only the conclusion that transmission of a signal to an operator is broadcasting makes it possible to reconcile the notion of a broadcaster used in public broadcasting activity regulations and in copyright law with the notion of a media service provider (supplier of content) under the AVMS Directive. It seems that by all accounts it is desirable that a broadcaster as defined in copyright law should be the same entity as a broadcaster defined in regulatory legislation. After all, no one can deny that broadcasters use protected works in their business activities regardless of whether they are sending the signal to an unlimited number of viewers or to a specified number of operators. This assertion determines that in the first stage of transmission of a signal, the broadcasting organization does not conduct activity that is neutral from the point of view of copyright law.
- 35 Another question arises: Is the fact that the operators receiving the signal are not end users, in the sense that they are not viewers, relevant with respect to classification of a given activity as broadcasting? It seems that this should not be decisive because the operator somehow uses the purchased content from scratch, combining the obtained programs into specific packages and performing so-

called multiplexing. In the study drawn up for the European Commission (“Study on the application of measures concerning the promotion of the distribution and production of European Works in audiovisual media services i.e. including television programmes and non-linear services”),<sup>21</sup> it is emphasized that in EU countries there are two types of transmission characterized by separate added value. The first is a straightforward supply of a signal to the viewer, while the second applies when the entity supplying the signal is the seller of a combination of channels or packages at the same time. The added value is created by the putting together of the channels, the channel’s trademark (brand) and image, and by the pricing of packages and services for a client in the form of invoicing and information helpdesks.

- 36 A frequent argument used to deny that the transmission of the signal to a cable or DTH platform operator by a content provider constitutes broadcasting is the definition of “the public” used by the ECJ in the *Lagardère*<sup>22</sup> and *Mediakabel*<sup>23</sup> cases. Are the rulings in the *Lagardère* and *Mediakabel* cases materially relevant for evaluation of the notion of broadcasting in copyright law?
- 37 In the *Lagardère* case, the ECJ interpreted the Directive 93/83 on satellite and cable retransmission for the purpose of determining the obligation to pay equitable remuneration for broadcasting of phonograms for public reception via a satellite and ground stations in France and Germany. According to Directive 93/83, satellite broadcasting takes place only in the member state in which the channel signal is sent, under the control of the broadcasting station and at its risk, to a closed communication chain to a satellite and back to earth (the country of origin rule) The Directive assumes that the distinction in copyright regulations between transmission by direct and communication satellites is no longer viable when the signal from the communication satellite can be received directly by the public. Therefore, satellite transmission in which the signal can be received directly is subject only to the law of the country in which it is linked up. The Directive equates the legal status of satellite transmission via a communication satellite to the status of satellite transmission via a direct satellite, provided that the signal can be received directly by the public.
- 38 For this purpose, the definition of a satellite has been provided in Art. 1.1 of the Directive. This definition affects the definition of satellite transmission covered by the Directive. It assumes that if signals are sent in frequency bands reserved under telecommunications law for private individual communication, the signal must be received individually on conditions comparable to the conditions existing when the signal is transmitted for public reception.
- 39 For this reason, it is only when the signal can be received directly by the public that the Directive is applicable, with the result that only the law of the country from which the signal is sent directly to the satellite can be applied to that transmission. If direct reception from a communication satellite is not possible, there are no grounds for excluding the law of other countries that may come into play, because in that case intervention of a ground station becomes highly relevant.<sup>24</sup>
- 40 The ECJ concluded at the same time that a limited group of people who can receive the signal from the satellite using professional equipment cannot constitute the public, taking into account that the public has to be made up of an unspecified number of potential viewers.<sup>25</sup> The assertion that the lack of direct reception by the general public means the requirement set forth in Art. 1.1 of the Directive is not fulfilled (individual reception in line with the guidelines laid down in the Directive must be comparable to those that apply in the case of broadcasting on frequencies for reception by the public) is entirely correct. It seems, however, that there are no grounds for building the generally applicable concept of “the public” on the basis of this decision. It should be emphasized that the mere term “satellite” is used in the directive in a very technical meaning (a satellite operating on frequency bands which are reserved under telecommunications law for the broadcast of signals for reception by the public or which are reserved for closed, point-to-point communication – Art. 1.1 of the directive). If a communication satellite is used for retransmission of encoded signals, which can only be decoded using equipment available to professionals and are not directed towards the general public, the satellite in question is not a “satellite” as defined in Art. 1.1, and therefore the Directive is not applicable to retransmission of that kind. It is emphasized in the doctrine that in the definition of satellite retransmission to which the Directive applies, stress is placed on the intended use of the signal and not the program.<sup>26</sup> For this reason, the encoded signals sent by the satellite and exclusively intended for reception by a ground station for retransmission, from which they are then transmitted to the end user (i.e., to the general public), cannot be regarded as communication to the public. However, the term “the public” is not defined in the Directive, and its interpretation has been left to the national courts.<sup>27</sup>
- 41 In the *Lagardère* case, ECJ concluded that there was, based on the facts of the case, no “public retransmission by satellite” as provided for in Art. 1.2a of Directive 93/83, since this provision requires the signals bearing the program to be intended for public reception. The court compared versions of that provision in different languages and stated that it was the signals that had to be intended for reception by the public and not the programs carried by those

signals. In light of the objective of the Directive – i.e., securing the legal certainty both for broadcasters and copyright holders when signals bearing the channel are retransmitted to a satellite and back to earth – this view is not unfounded.<sup>28</sup>

- 42 The ruling in the Legardère case correctly concluded that there were no grounds for the applicability of the Directive because the facts under consideration clearly showed separate territorial use and two separate procedures, instead of one procedure of transmission to one ground station. It is also reasonable to doubt whether that ruling can be treated as creating a general notion of the public in copyright law within the EU countries, and therefore in divergence from the objectives of the Directive.
- 43 In the Mediakabel case, the ECJ reviewed the issue of classification of a given media service from the point of view of public law. Mediakabel BV filed a complaint against the decision issued by the Commissariaat voor de Media (the media regulatory authority, the “Authority”), in which the Authority stated that the “Filmtime” service offered by Mediakabel was a television service subject to the permit procedure in Holland. In Mediakabel’s view this was an incorrect assessment because the service provided should have been treated as an interactive service. As such it belonged to the category of information society services and did not require permission. Mediakabel offered its subscribers a service called “MrZap,” provided by broadcaster networks managed by third parties. In exchange for the monthly subscription, this service made possible (using a decoder and chipcard) the reception of the television channels as extra channels to the channels broadcast by the network provider. In addition to this service, Mediakabel offered subscribers to the MrZap service per-view access to additional films within the “Filmtime” service. Subscribers to the MrZap service were entitled to order a film from a list of 60 films offered by Mediakabel. Upon payment of the relevant fee, they received an individual access code allowing them to watch the film on their television sets at specified times. The issue considered was therefore whether this service should be classified as a service on demand or a television broadcast service under Art. 1a of Directive 89/552/EEC of 3 October 1989 on coordination of certain provisions laid down by law, regulation or administrative action in Member States concerning the pursuit of television broadcasting activities.<sup>29</sup> The ECJ’s conclusion was that the scope of application of the term “television service” was laid down in an autonomous and exhaustive way in Art. 1a of Directive 89/552. This term comprises any service that is the original broadcast by wire or wireless means of television channels intended for general reception, including satellite transmission, in coded or uncoded form.
- 44 The ECJ also stressed at the same time that services of this type, such as subscription television received by a limited number of users, are not excluded from the scope of the term “television service.” The important factor was that it was at the same time reception of the same images by an undefined number of potential viewers. Therefore, a television service provided for a fee, even if available to a limited number of users but relating solely to channels selected by the broadcaster and transmitted at the time determined by the broadcaster, is not a service provided upon individual request.
- 45 It is worth stressing that the ECJ did not pronounce the view that Directive 89/552 created an autonomous definition of a television service. This definition was drafted for the purposes of public law and does not necessarily have to be transferred directly to other directives or to the field of copyright law.
- 46 C. Caron also believes that in the Chellomedia and Norma cases the courts might have been influenced too much by the ECJ’s ruling in the Lagardère case. He points out that the rulings are not consistent with Art. 1. 2b of the satellite and cable Directive adopting the country of origin rule, and indicating the law of the country in which the signal is sent to the satellite as the governing law. The country of origin theory was thought up to protect the author because the author is entitled to protection “at the foot of the antenna.” The Chellomedia and Norma rulings take away that entitlement, concluding that the process of transmission to a satellite and to earth is neutral from the point of view of copyright law and referring it to the law of the country in which the public communication takes place. This author also notices the improper distinction between the signal and the program, which leads to a divergence between telecommunications law and copyright law. The author’s view is that an “equal sign” should be put between the signal and the program channel.<sup>30</sup>

## E. Retransmission in Directive 93/83 on cable and satellite retransmission

- 47 Under Art. 1. 3 of the Directive 93/83, the term “simultaneous cable retransmission” means the simultaneous, unaltered, and unabridged retransmission by a cable or microwave system for reception by the public of an initial transmission from another member state, by wire or over the air or by satellite, of television or radio programs intended for reception by the public.
- 48 In the Chellomedia and Norma cases, the courts concluded from the definition given above that they were not dealing with retransmission because the transmission of a signal to an operator did not con-

stitute initial broadcasting. Signals sent to a satellite cannot be received by the general public. As emphasized above, the courts cited at the same time the ECJ ruling in the Lagardère case. On the basis of the ruling in the Lagardère case, it was argued that professionals receiving the signal using specialized equipment could not be “the public” because this term meant an unlimited group of potential viewers. This classification is transferred to satellite transmission of encoded signals intended solely for operators.

- 49 The notion “retransmission,” however, needs to be interpreted in terms of the objective to be achieved by implementing the Directive. The main objective of the Directive laid down in the preamble is to secure free retransmission of channels within the EU by ensuring legal certainty with regard to how transmission will be treated in different EU countries. The Directive is not applicable to transmissions of a national range. The objective of the Directive – to secure the legal conditions for creating a European audiovisual area – is implemented among other things by making negotiations easier, ensuring that the negotiations are held in good faith, imposing collective exercising of rights, and therefore securing to the greatest degree possible the interests of cable operators by strengthening the level of legal certainty with regard to the acquired rights. However, as emphasized in the preamble to the Directive (comment 21), it is necessary to ensure protection for authors, performers, producers of phonograms, and broadcasting organizations. As stated in comment 2), the harmonization of legislation entails the harmonization of the provisions to ensure a high level of protection. The interpretation of the term “retransmission” to cover only transmission of a signal that was initially intended for reception by the general public leads to significant limitation of the level of protection of right holders. As observed in comment 19 of the preamble to the Directive, in the past international coproduction agreements have often not expressly and specifically addressed communication to the public by satellite within the meaning of the Directive, especially as a particular form of exploitation being the subject of a separate right. The same should be said of the form of exploitation existing in the new business model described for transmission of signals to users. This model was without doubt not taken into account in coproduction agreements, in agreements between authors and producers of audiovisual works, or often in agreements between a producer and the broadcaster. The interpretation adopted by the courts leads therefore to a significant increase in the level of legal uncertainty on the part of users and the need for examination, with respect to individual works, of the extent to which rights were in fact acquired. The question therefore arises whether the exclusion from regulation of retransmission of transmission of a signal as described above (i.e., as a new business model explained in the

first part of this article) is in line with the objectives of the Directive.

## F. The right of communication to the public under the Berne Convention in Directive 2001/29/EC and in the WIPO Copyright Treaty of 20 December 1996

- 50 Because in the Chellomedia and Norma cases the courts concluded that the cable or satellite DTH platform operators make the use of the right of communication to the public, it is necessary to define that right.<sup>31</sup>
- 51 S. Ricketson and J.C. Ginsburg have observed that the Berne Convention does not create uniform regulation regarding communication to the public, and that the regulation it provides is broken down into various provisions, leaving certain loopholes.<sup>32</sup> The Convention regulates rights that are separate with respect to the various forms of communication, particularly with respect to performance in the presence of the public and over a distance. Art. 11bis is the broadest regulation, but it does not cover all forms of broadcasting: it does not apply to the initial wire-based communication. The right of initial wire-based communication applies in the Convention only to cinematographic, literary, and artistic works if adapted to a cinematographic work, and literary, musical, and dramatic/musical works but only if they are performed.
- 52 S. Ricketson and J.C. Ginsburg also emphasize that one of the major questions which arise in connection with Art. 11bis (1) (i) concerns the criterion that the broadcast has to be received by the public directly (without intermediary services). During the 1948 Brussels Revision Conference, direct reception was obvious in light of universal practice at that time, as could be seen by the definition of broadcasting in the Radio Regulations of the International Telecommunications Union (ITU) adopted at the 1947 Atlanta conference. Delegates at the Brussels Revision Conference did not therefore see the need to introduce a different definition of broadcasting.<sup>33</sup>
- 53 Art. 3 of the Directive on the information society requires that member states provide authors with the exclusive right to authorize or prohibit any communication of their works to the public, by wire or wireless means, including the making available to the public of their works in such a way that members of the public may access them from a place and at a time individually chosen by them. The right of communication to the public in Art. 8 of the WIPO Copyright Treaty<sup>34</sup> is worded in a similar way, clearly stating that this right does not prejudice the provisions

of Art. 11(1)(ii), 11bis (1)(i) and (ii), 11ter (1)(ii), 14(1)(ii) and 14bis (1) of the Berne Convention.

- 54 Both definitions show unequivocally that the right of communication to the public has a broader scope than just the right of communication in such a way that anyone can gain access to the work at a time and place of their choice. There is therefore a broad understanding of this right, applying it to all kinds of communication of works by wire or wireless means. According to comment 23 of the preamble to the Directive, this right should be understood in a broad sense to cover all communication to the public not present at the place where the communication originates. This right should cover any such transmission or retransmission of a work to the public by wire or wireless means, including broadcasting. However, there is no definition in the Directive of the term “the public,” which means that the question of how many people make up “the public” remains open. Up until now this aspect of copyright law has not been harmonized, and therefore the task of defining the term “public” has been left to national laws.<sup>35</sup>
- 55 T. Dreier underlines that because the WIPO Copyright Treaty is a special agreement as defined in Art. 20 of the Berne Convention, the notion of communication of a work to the public has to be interpreted in the context of that Convention. Like the Directive on the information society, Art. 8 of the Treaty does not define the term “the public” – this has to be done at the national level. The phrase “communication to the public” in Art. 8 of the Treaty is assumed to be technologically neutral and to correspond to the requirements of the digital community. In the context of the first section of Art. 8 of the Treaty, the expression “communication to the public” refers to the situation in which a work is made available in such a way that the public can receive it at a different time and in various places. It is assumed that Art. 8 is supplementary to the Berne Convention to the extent to which the Convention does not regulate all areas of communication to the public.<sup>36</sup>
- 56 Following the rulings in the Chellomedia and Norma cases, if we assume that cable and satellite DTH platform operators do not use the works by broadcasting or by retransmitting, they have to obtain a license from the right holders to use the work for communication to the public in a manner other than broadcasting or retransmitting. In practice this can give rise to huge problems due to the terminology used in agreements entered into in the past between a producer and the broadcaster. In those agreements, the parties usually used the terms “broadcasting” or “retransmission” and not the term “communication to the public.” The same certainly applies to agreements entered into by a producer of an audiovisual work with co-authors. The producer of an audiovisual work created before the WIPO Treaty and Directive 2001/29/EC came into effect did not acquire

the right to communication of the work to the public from the co-authors, but the right to broadcast and in certain cases to retransmit. Particular difficulties arise when agreements should be taken into account that have been concluded under different legal regimes. As the right to broadcast and to retransmit are only a fragment of the right to communicate to the public in the broad sense, the acquisition of the right to broadcast or retransmit cannot include communication to the public in other forms.<sup>37</sup>

## G. Conclusion

- 57 The approach presented in the Chellomedia and Norma rulings leads to a significant level of legal uncertainty, and it seems to cause serious problems with determining the right holder who has the right to communicate the work to the public in the way described in the model presented in this paper. It should be remembered that the burden of proof as to whether the user has acquired the right to a specific form of exploitation lies with the user. This is why it was in the interests of the cable operators to introduce the compulsory management of a collecting society in the exercising of the right to retransmission.
- 58 On the basis of those rulings, the question needs to be asked whether the term “broadcasting” and the term “the public” have in fact been harmonized by the EU legislation. A procedure classified as broadcasting from the technical point of view will not necessarily be classified as broadcasting from the point of view of copyright law.<sup>38</sup> The same applies to the correlation between public law and copyright law – if we accept the reasoning as presented in the Chellomedia and Norma rulings, an entity that is treated as the broadcaster from the point of view of public law (the entity responsible for content) is not a broadcaster as defined in copyright law. There are, furthermore, serious concerns as to whether the ECJ rulings described above in the Lagerdère and Mediakabel cases can lead the foundation for creating a harmonized notion of “the public” in copyright law. It should be remembered that until now it has been a basic principle of copyright law that there is a major contrast between public and private use, and that each exploitation which does not meet the criteria for private use should be treated as public use regardless of whether the work is communicated to a limited or an unlimited group of users. It also seems that the notion of communication to the public introduced into the Directive on the information society does not diverge from this distinction. It should be underlined that there is no criterion of an unlimited group of viewers in Art. 3 (1).<sup>39</sup>
- 59 P. Weber is therefore right to suggest that the satellite and cable Directive be amended, in particular with regard to the maintaining of the criterion for

initial transmission in the definition of cable retransmission.<sup>40</sup> P. Weber observes that in order to distinguish between initial transmission and retransmission, the important factors are the provisions of an agreement between the satellite DTH platform operator and the broadcaster on the one hand, and the business model of the relations of the operator with the end user on the other. In cases in which a satellite DTH platform operator makes available a channel to viewers at the operator's own economic risk, and there is a legal relationship between the operator and the viewers, it should be assumed that another transmission takes place; therefore, from the point of view of copyright law, this constitutes retransmission<sup>41</sup> because the determining factor has to be the separate economic significance of use. After all, this was also the criterion at the core of Art. 11bis (1) (ii) of the Berne Convention, in which retransmission of a broadcast is based upon the intervention of a third party. It should also be noted that the satellite and cable Directive applies solely to cross-border retransmission and does not deal with broadcasting and retransmission of a domestic nature. Moreover, the Directive does not regulate initial cable broadcasting because in many countries this system was not being used. The conclusion is therefore that there is no reason why the national legislature shouldn't treat as retransmission the activity of a cable or satellite DTH platform operator that consists of combining the channels of a number of broadcasters into one encoded stream (package) and sending a signal to users for a fee. This is supported by the identical economic nature of exploitation of works in the form of direct cable retransmission as in the case of retransmission as defined in the Directive.

60 Another argument supporting the view presented above is the principle of technological neutrality, which is deemed to be a starting point for the regulation of information society services. The principal objective of the Directive was to facilitate the clearing of rights with respect to cable and satellite retransmission and to overcome barriers in national legislation in relation to those forms of retransmission. The objective of the Directive was not fully achieved due to the contractual systems for obtaining rights and the applied encoding systems, which still allow division of the European markets. As B. Hugenholtz emphasizes, the objective of the Directive was not achieved, not due to national differences in the national copyright law systems but because of a combination of encoding technology and territorial licensing.<sup>42</sup> The Directive does not prohibit territorial licensing, and film producers rarely license exploitation for the entire territory of Europe. To ensure territorial division, they also require encoding from broadcasters. Broadcasters are also not interested in obtaining licenses covering all of Europe because broadcasting in Europe is territorial. The parties can therefore agree that the signals will

be encoded in order to avoid reception by the general public in countries for which broadcasting is not designated. As B. Hugenholtz argues, territorial division can be achieved in principle through restriction of access to decoders.<sup>43</sup> There is therefore no doubt that cable and satellite DTH platform operators are not able to negotiate licenses with all of the right holders before transmitting the signal to users, especially as they receive channel data from the content providers not much in advance. Therefore, the assumption that acquisition of rights to communicate to the public (as discussed here) should be negotiated without societies, as concluded by the courts in the *Chellomedia* and *Norma* cases, is pure fiction from the outset. The real danger of this approach is that individual right holders could, in these cases, block retransmission of certain works and cause blackout. Therefore, a core provision in the cable and satellite Directive states that the right of cable retransmission may not be exercised by right holders individually but only by a collecting society. Legal certainty was the main reason for this regulation. It should be made clear that the Directive leaves the national legislatures the freedom to make decisions with regard not to cross-border but national retransmission.<sup>44</sup> The right of retransmission is certainly a fragmentary right that constitutes an element of the right of communication to the public, a right harmonized for the first time in the Directive on the information society.<sup>45</sup> However, harmonization does not go so far as to specify definitions of separate rights included in the broad scope of the right of communication to the public. The right of communication to the public has been defined meanwhile in specifics at the national level.<sup>46</sup> A system of terrestrial television is beginning to be replaced by direct transmission of a signal to a network, above all in those countries in which cable networks are well developed. This requires a fresh look at this process, first and foremost from the point of view of the separate economic significance of the activities of both the broadcaster and the operator. It is the economic significance and entry into the whole process of transmission by another entity acting on its own account that should determine how this entire process should be split (also from the point of view of legal classification) into two separate rights, even if they fall within the scope of the general right of communication to the public.

\* The author would like to thank her younger colleague Paweł Gruszecki for his help in describing the characteristics of the new models of transmission of TV programs.

1 *BUMA and STEMRA v. Chellomedia Programming*, Supreme Court of the Netherlands (*Hoge Raad*), 19 June 2009, available at: [www.rechtspraak.nl](http://www.rechtspraak.nl); *Norma v. NL Kabel*, District Court of The Hague, 28 January 2009, case HA ZA 06-2844, available at: [www.boek9.nl](http://www.boek9.nl), B9 7522.

- 2 Directive 2002/21/EC of the European Parliament and of the Council of 7 March 2002 on a common regulatory framework for electronic communications networks and services (Framework Directive) (OJ L 108, 24.4.2002, p. 33).
- 3 Council directive of 3 October 1989 on the coordination of certain provisions laid down by law, regulation or administrative action in Member States concerning the pursuit of television broadcasting activities (89/552/EEC) (OJ L 298, 17.10.1989, p. 23) amended by Directive 97/36/EC of the European Parliament and of the Council of 30 June 1997 amending Council Directive 89/552/EEC on the coordination of certain provisions laid down by law, regulation or administrative action in Member States concerning the pursuit of television broadcasting activities (OJ L 202, 30.07.1997, p. 60).
- 4 Directive 2007/65/EC of the European Parliament and of the Council of 11 December 2007 amending Council Directive 89/552/EEC on the coordination of certain provisions laid down by law, regulation or administrative action in Member States concerning the pursuit of television broadcasting activities (Text with EEA relevance). (OJ L 332, 18.12.2007, p. 27).
- 5 Case 155/73 *Sacchi* [1974] ECR 409.
- 6 We use the term licensing and sublicensing agreements due to the inconsistent distinction in copyright law between agreements that transfer copyright and licensing agreements, especially exclusive licensing agreements; see P. B. Hugenholtz et al., *The Recasting of Copyright & Related Rights for the Knowledge Economy*. Report to the European Commission, DG Internal Market, November 2006.
- 7 Commission Directive 2002/77/EC of 16 September 2002 on competition in the markets for electronic communications networks and services (Text with EEA relevance) (OJ L 249, 17.09.2002, p. 21).
- 8 Case Comp/M.4338 *Cinven-Warburg Pincus/Casema-Multikabel* EUR-Lex No. 32006M4338.
- 9 *Ibid.*
- 10 Directive 98/84/EC of the European Parliament and of the Council of 20 November 1998 on the legal protection of services based on, or consisting of, conditional access (OJ L 320, 28.11.1998, p. 54).
- 11 See Tribunal de Bruxelles, 27.01.2005, *Auteurs & Media*, 2005, p. 138 et seq.
- 12 With respect to this arrangement, of course, the question arises as to who is responsible for this broadcasting process. It could be said that the broadcaster is responsible for content, as it is the broadcaster who decides the form of retransmission and enters into licensing agreements with operators. See F. de Visscher, B. Michaux, *Précis du droit d'auteur et des droits voisins*, Bruxelles 2000, p. 127. It is also possible to argue that in this case both entities are jointly and severally liable.
- 13 OJ L 248, 6.10.1993, p. 15.
- 14 BGH GRUR 1955, 492, 496 *Tonband/Grundig/Reporter*, BGH GRUR 2002, 248, 252 *Spiegel-CD-ROM*, W. Nordemann, *Das neue Urhebervertragsrecht*, C.H.Beck, 2002, p. 59. See also the special report by M. R. Dittrich, A. Kerever, W. Weinecke, *Intellectual Property Rights and Cable Distribution of Television Programmes*, Strasbourg 1983.
- 15 This solution has also been adopted in Art. 21 of the Polish Act on Copyright and Related Rights of 4 February 1994 (cons. text.: Journal of Laws of the Republic of Poland of 2006, No. 90, item 631, as am., referred to further as the "Polish Copyright Act"). However it can be applied only to broadcasting and to the making available of a work to the public in such a way that anyone can access the work at a time and place of their choice. Hence, it cannot be applied to the described signal retransmission model.
- 16 This criterion is adopted in the Berne Convention (Art. 11<sup>bis</sup> (2) (ii)).
- 17 Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonization of certain aspects of copyright and related rights in the information society (OJ L 167, 22.6.2001, p. 10), referred to further as the Directive on the information society.
- 18 "Authors of literary and artistic Works shall enjoy the exclusive right of authorizing: (i) the broadcasting of their works or (ii) the communication thereof to the public by any other means of wireless diffusion of signs, sounds or images."
- 19 For example, Art. 6 (4) of the Polish Copyright Act gives the following definition of broadcasting: distribution by way of wire-based or wireless radio or television broadcasting (earth or satellite). Meanwhile, this definition does not contain any reference to the reception by the public consisting of an unlimited number of persons.
- 20 For example, under Art. 4 (1) of the Polish Act on Radio and Television Broadcasting (cons. text.: Journal of Laws of the Republic of Poland of 2004, No. 253, item 2531, as am., referred to further as the "Polish Broadcasting Act"), a broadcaster is a person who creates or puts together a channel and distributes it or transmits it to other persons for retransmission in its entirety and unchanged, while under Art. 4 (2) Polish Broadcasting Act, retransmission is: a) wireless broadcasting of a channel for simultaneous, general reception, b) placing of a channel into a cable network (collective reception system). In modern regulations in which the AVMS Directive has been implemented, the broadcaster of a media service is deemed to be an entity which is responsible for the content. See Belgian Decret du 27 fevrier 2003 sur les services de medias audiovisuels; in its Art. 1 (12), the definition of "editeur de services" is given as: "la personne physique ou morale qui assume la responsabilité éditoriale du choix du contenu du service de medias audiovisuels et qui determine la manière don't il est organisé."
- 21 Available at [http://ec.europa.eu/avpolicy/info\\_centre/library/studies/index\\_en.htm](http://ec.europa.eu/avpolicy/info_centre/library/studies/index_en.htm).
- 22 Case C-192/04 *Lagardère Active Broadcast* [2005] ECR I-7199.
- 23 Case C-89/04 *Mediakabel* [2005] ECR I-4891.
- 24 In the *Lagardère*, the ECJ notes that as a result of technological progress it has become possible to broadcast directly to the public on frequencies not designated in telecommunications law for public reception. For this reason, the authors of the Directive took into account this technological development and concluded that point-to-point satellite transmission is subject to regulation under the Directive if the public is capable of receiving signals individually and directly from the satellite.
- 25 With regard to this last statement, the ECJ cites an earlier ruling in case C -89/04 *Mediakabel*.
- 26 See B. Hugenholtz [in:] *Concise European Copyright Law*, ed. T. Dreier, B. Hugenholtz, Kluwer Law International 2006, p. 271. The placing of emphasis on the designation of the signal for public reception is justified as the authors of the Directive intended that the reception of the signal from an indirect reception satellite should have the same status as reception from a direct satellite.
- 27 B. Hugenholtz, op.cit., p. 271.
- 28 In the facts of the *Lagardère* case, the signals were returned to earth where they were received by ground stations in France, which broadcast the signal to users on modified wave frequencies. Because this frequency did not cover the whole of France, the satellite sent signals to two ground stations in Germany as well, from where they were sent to users on long wave. CERT, a firm representing *Lagardère*, made those broadcasts. The channels could be received to a limited extent in Germany but were not used commercially in Germany. *Lagardère* paid for the phonograms in France to an author's organization, SPRE. For its part, CERT paid the German organization GVL fees for



the same phonograms. The fees paid by CERT to GVL were then deducted from the fees paid to the French organization SPRE. This raised the issue whether there were grounds to make that deduction and whether it could be concluded that only the law of the country in which the signals sent to the satellite originated applied.

- 29 Cited in Fn. 3.
- 30 C. Caron, *La transmission d'oeuvres et d'interprétations, le cas échéant par l'intermédiaire d'un satellite, vers le cablodistributeur ? Deux récentes décisions hollandaises, imprégnées de droit communautaire, apportent une réponse contestable à cette question importante d'un point de vue tant théorique que pratique*, Communication – Commerce Électronique- Revue Mensuelle Lexisnexis Jurisclasseur, Octobre 2009, p.12.
- 31 The principal difference between the Chellomedia and Norma cases is that in the Chellomedia case, the issue was the classification of the stage of transmission to the satellite and from the satellite to the end operator's station, while in the Norma case, in which there was direct transmission (the signals were received directly from the broadcaster), the issue was classification of the stage of transmission from the operator to the user- subscriber.
- 32 S. Ricketson, J. C. Ginsburg, *International Copyright and Neighbouring Rights*, Oxford University Press 2006, p. 717.
- 33 S. Ricketson, J. C. Ginsburg, op. cit., p. 724.
- 34 WIPO Copyright Treaty (WCT) (OJ L 89, 11.4.2000, p. 8).
- 35 S. Bechtold [in:] *Concise European Copyright Law*, p. 360-361.
- 36 M. Senftleben [in:] *Concise European Copyright Law*, p. 105. It should also be noted that the term "communication to the public" in Art. 2 (g) of the WIPO Performances and Phonograms Treaty (OJ L 89, 11.4.2000, p. 15) is not as broad as in Art. 8 of the Copyright Treaty. Under this article, "communication to the public" of a performance or a phonogram means the making available to the public by any medium, otherwise than by broadcasting, of sounds of a performance or the sounds or the representations of sounds fixed in a phonogram. This solution is a result of the special provision for the right to remuneration in the case of broadcasting in Art. 15 of the WIPO Performances and Phonograms Treaty.
- 37 The problem of divisibility of the general broad right into narrower separate rights (fields of exploitation) arose clearly with respect to the right to broadcasts as well. See M. Fischer, *Der Begriff des Sendens aus urheberrechtlicher und aus rundfunkrechtlicher Sicht*, ZUM 2009, No. 6, p. 465-470, summary from the conference held in Institut für Urheber- und Medienrecht, "Der Begriff des Sendens aus urheberrechtlicher und aus rundfunkrechtlicher Sicht."
- 38 See G. Gounalakis, *Der Begriff des Sendens aus urheberrechtlicher Sicht*, ZUM 2009, No. 6, p. 447.
- 39 It is worth pointing out that in Case C-306/05 SGAE [2006] ECR I-11519, the ECJ adopted a broad definition of "the public" based on Art. 3 of the Directive on the information society.
- 40 P. Weber, *Die Reichweite des urheberrechtlichen Sendebegriffs aus Sicht der Europäischen Rundfunkunion EBU*, ZUM 2009, No. 6, p. 461.
- 41 Also according to P. Weber, op. cit., p. 464.
- 42 B. Hugenholtz, *SatCab Revisited: The Past, Present and Future of the Satellite and Cable Directive*, IRIS plus, "Convergence, Copyrights and Transfrontier Television," 2009-8, p. 7-19.
- 43 B. Hugenholtz, op. cit. p. 10. In practice in agreements now entered into between radio and television organizations (content providers) and cable and satellite DTH platform operators, there are major territorial restrictions, including within the EU.
- 44 B. Hugenholtz underlines that the Directive does not harmonize retransmission, which does not have a range beyond the territory op. cit. p.12.
- 45 See comment 23 in the preamble to the Directive, which says that this right should be understood in a broad sense covering all communication to the public not present at the place where the communication originates. This right should cover any such transmission or retransmission of a work to the public by wire or wireless means, including broadcasting.
- 46 B. Hugenholtz, op. cit. p. 17.

# Interoperabilität von Software

## Art. 6 der Computerprogramm-Richtlinie aus heutiger Sicht

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**Abstract:** This article reviews Article 6 of the Software Directive and discusses the need for a revision. Beyond clarification of the scope of the very limited provision on reverse engineering, it seems that the introduction of the clause into copyright was unfortunate. The indirect protection of ideas by prohibiting reverse engineering is foreign to the copyright concept. Permitting reverse engineering altogether

would promote research and development and further other goals like ICT security. Innovation would not be retarded, which is the reason why US trade secret law permits reverse engineering based also on economic arguments. The notions of compatibility Article 6 tries to address are better dealt with by Competition Law, which was demonstrated by the Microsoft Decision of the European Court in 2007.

**Keywords:** Reverse engineering, decompilation, interoperability, copyright limitation, research, protection of ideas, know-how, interfaces, competition law

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### A. Einführung

- 1 Es gab keine Vorschrift der RL, die im Gesetzgebungsverfahren so umstritten war wie Art. 6. Im Prozess des Erlasses der RL hat es einen erbitterten Kampf der Lobbygruppen um Reichweite und Formulierung der Regelung gegeben. Herausgekommen ist die längste, detaillierteste und unübersichtlichste Vorschrift der RL. In seltsamem Kontrast dazu steht die Tatsache, dass man heute in den einschlägigen Kommentierungen keine einzige Entscheidung zu dieser Vorschrift findet, die im deutschen Recht in § 69e UrhG umgesetzt wurde.
- 2 Das könnte man nun darauf zurückführen, dass die Vorschrift so detaillierte Regelungen enthält, dass ihre Klarheit jeglichen Rechtsstreit verhindert hat.<sup>1</sup> Man darf allerdings nicht die Detailliertheit einer Regelung mit Klarheit verwechseln, was sich gerade an dem Beispiel von § 69e UrhG zeigt. Eine weitere Erklärung könnte darin liegen, dass die Rechtsdurchsetzung weitgehend im Kartellrecht stattfindet. IBM wurde bereits in den achtziger Jahren in kartellrechtlichen Verfahren gezwungen, Schnittstelleninformationen offen zu legen und dies hatte natürlich auch Auswirkungen auf das Verhalten anderer Her-

steller. Schließlich bleibt, wenn ein Hersteller wirklich ein Verletzungsverfahren anstrengen sollte, auch ein gravierendes Nachweisproblem, da der Nachweis einer Übernahme von geschützten Informationen wiederum ein – nicht erlaubtes – Dekompilieren des angeblich übernehmenden Programms erforderlich machen würde.<sup>2</sup>

- 3 Ich möchte im Folgenden das zugrundeliegende Problem näher eingrenzen, die Lösung der Richtlinie darstellen und die Reichweite der Erlaubnis in § 69e näher untersuchen. Sodann möchte ich der Frage nachgehen, inwieweit hier das Kartellrecht hinreichende Lösungsmöglichkeiten bietet, um auf dieser Basis dann zu diskutieren, inwieweit ein Reformbedarf bezüglich Art. 6 der RL erkennbar wird.

## B. § 69e UrhG

### I. Die Regelungen der Richtlinie und deren Umsetzung

#### 1. Das Problem

- 4 Tatsächlich ist das Problem, das Art. 6 der RL behandelt, eher ein kartellrechtliches. Hintergrund ist die Bedeutung von Schnittstelleninformationen für die Kompatibilität von Software und Hardware und damit die Möglichkeit, durch Geheimhaltung solcher Informationen den Wettbewerb einzuschränken. IBM war bereits in den achtziger Jahren einem Kartellverfahren ausgesetzt, bei dem es um die Offenlegung solcher Schnittstelleninformationen ging.<sup>3</sup> Vorwurf war u.a., dass IBM seine marktbeherrschende Stellung dadurch missbrauche, dass es andere Hersteller nicht rechtzeitig mit solchen Informationen versorge, die zur Herstellung wettbewerbsfähiger Produkte zu dem System von IBM notwendig waren. IBM gab dann vor dem formellen Abschluss des Verfahrens eine Verpflichtungszusage ab, die Schnittstelleninformation für das System IBM/370 und die IBM Systems Network Architecture gegenüber Wettbewerbern auf Anfrage offenzulegen, von denen diese auch rege Gebrauch machten.<sup>4</sup>
- 5 Betrachten wir die Problematik aus der Sichtweise des Urheberrechts, so geht es um die Problematik des sog. Reverse Engineering. „Proprietäre“ Softwarehersteller versuchen ihr Programm-Know-how dadurch zu schützen, dass sie das Programm nur in maschinenlesbarer Fassung vertreiben (Object Code). Eine Erschließung des Know-hows durch Wettbewerber ist dann nur durch eine Rückwärtsentwicklung („Reverse Engineering“) oder auch Dekompilierung möglich. Zur Terminologie: Dekompilieren bezeichnet die Rückübersetzung des Objektformats in einen Source Code; Reverse Engineering ist weiter und bezeichnet daneben auch andere Techniken der Rückwärtsanalyse.<sup>5</sup> Trotz Verfügbarkeit entsprechender Tools ist bei komplexeren Programmen immer noch ein erheblicher Aufwand nötig, um die Dekompilierung durchzuführen, wobei dieser oft größer ist als die zur Entwicklung des Originalprogramms.<sup>6</sup> Ein weiteres kommt hinzu: es ist nie möglich, den Quellcode vollständig wieder herzustellen. Vielmehr gehen jedenfalls Kommentare und ursprüngliche Formatierung verloren.
- 6 Weit verbreitet sind heute JAVA-Anwendungen. Wegen der Besonderheiten der Programmierumgebung war es relativ einfach, einen Großteil des Source Code mittels Dekompilierung zu rekonstruieren. Daraufhin haben die Programmierer sog. „ob-

fuscators“ (Verdunkler, Verschleierer) eingebaut, um das Dekompilieren zu erschweren.<sup>7</sup>

- 7 Darüber hinaus sind die Einsatzmöglichkeiten des Dekompilierens keineswegs beschränkt auf die Zwecke der Erlangung von Schnittstelleninformationen. Im Rahmen der Softwarepflege etwa kann zu Zwecken der Migration oder bei Verlust des Source Code zur Fehlerberichtigung eine Dekompilierung erforderlich sein. Auch zu Sicherheitszwecken wird die Dekompilierung eingesetzt.
- 8 Allen von uns ist noch das berühmte „Jahr-2000-Problem“ in Erinnerung, zu dem einige dicke Bücher geschrieben worden sind, allerdings nur im Vorfeld. Zur Bewältigung des Problems war es notwendig, die Stellen im Programm zu finden, wo ein Datum zu verarbeiten war, und festzustellen, ob zwei oder vier Stellen für die Jahreszahl vorgesehen waren.<sup>8</sup> Manche Programme waren nur noch im Objektformat verfügbar, bei manchen war die Dokumentation schlecht oder die Programmiersprache veraltet. Hier war dann das Dekompilieren ein Mittel der Abhilfe.
- 9 Urheberrechtlich betrachtet handelt es sich beim Dekompilieren um eine Vervielfältigung oder Bearbeitung, die eine Zustimmung des Rechteinhabers notwendig macht.<sup>9</sup>

#### 2. Die Lösung

- 10 im Gesetzgebungsverfahren wollte man das Problem zunächst dem Kartellrecht überlassen. Auf Intervention des Europäischen Parlaments hat dann vorgeschlagen, auch eine entsprechende Vorschrift ins Urheberrecht einzufügen,<sup>10</sup> und dies hat sich im Ergebnis auch durchsetzen können. Es gibt im Immaterialgüterrecht übrigens eine Reihe eher kartellrechtlich motivierter Ausnahmeregelungen, die flankierend zum Kartellrecht wirken sollen.
- 11 Zunächst hatte man an eine weite Dekompilierungs-erlaubnis gedacht, die das Dekompilieren auch zu Wartungszwecken sowie zur Erlangung kompatibler Hardware zustimmungsfrei machen sollte. Die endgültige Regelung wurde dann aber eng gefasst und auf den Zweck der Herstellung von Interoperabilität mit anderen Programmen begrenzt. Interessanterweise wurde übrigens während der Beratungen auch eine Fair-Use-Klausel als Alternative diskutiert aber wegen der abweichenden kontinentaleuropäischen Tradition zugunsten einer detaillierten Regelung wieder verworfen.<sup>11</sup>
- 12 Auf Seiten der Softwarehersteller zeigten sich durchaus unterschiedliche Interessenlagen.<sup>12</sup> Teilweise (von Seiten einiger großer Unternehmen der Branche) wurde auf die Gefahr der Verbreitung geheimen Know-hows und eine sich daraus ergebende Beeinträchtigung der Anreizfunktion des Urheberrechts

hingewiesen. Andere Teile der Softwareindustrie (KMU) sahen die Gefahr eher in einer Beeinträchtigung des Wettbewerbs durch fehlenden Zugang zu den notwendigen Schnittstelleninformationen. Die Anwenderseite hat teilweise noch weitergehende Zugangsinteressen zum Source Code, etwa hinsichtlich des Bedürfnisses nach Änderungen und war deshalb auch gegen die Regelung.

### 3. Die Regelung im Einzelnen

- 13** Die dann erlassene Regelung ist recht komplex und immer noch mit einigen Streitfragen zur Auslegung behaftet. Sie ist unterteilt in die Voraussetzungen der Dekompilierungsfreiheit nach Abs. 1 und die beschränkten Verwendungsmöglichkeiten der gewonnenen Informationen nach Abs. 2. Voraussetzungen für das zustimmungsfreie Dekompilieren sind nach Abs. 1:
- ▶ Unerlässlichkeit zur Herstellung von Interoperabilität, beschränkt auf die dafür notwendigen Teile
  - ▶ das zu schaffende interoperable Programm muss eine unabhängige Schöpfung darstellen
  - ▶ zulässig nur durch Lizenznehmer oder andere zur Verwendung eines Vervielfältigungsstücks berechnigte Person
  - ▶ Informationen dürfen dem Berechtigten nicht anderweitig zugänglich gemacht sein.
- 14** Der zentrale Zweck ist die Herstellung von Interoperabilität. Daher ist es wichtig, dies ein wenig zu konkretisieren. Interoperabilität bezeichnet die „funktionale Verbindung und Interaktion in logischer, funktionaler und zum Teil in physischer Hinsicht über sog. Schnittstellen“.<sup>13</sup> Dabei geht es um die „Interaktion“ zwischen Computerprogrammen ebenso wie zwischen Software und Hardware. Anerkannt ist auch, dass es nicht etwa nur um die Interoperabilität von Betriebssystemen und Anwendungsprogrammen geht, sondern das zweite Programm kann auch in Konkurrenz zum dekompierten Programm treten.<sup>14</sup> Das bedeutet andererseits nicht, dass die Wettbewerber identische Programme entwickeln dürfen; das wäre auch mit dem Zugang nur zu den Schnittstelleninformationen gar nicht möglich. Vielmehr wird es Unterschiede hinsichtlich Geschwindigkeit, Verlässlichkeit, Sicherheit und sonstiger Funktion geben. Allerdings muss etwa ein konkurrierendes Arbeitsgruppen-Betriebssystem, wie im Microsoft-Fall, in der Lage sein, bestimmte Informationen mit einem Windows Client-PC auszutauschen, also zu senden und zu empfangen.<sup>15</sup> Dazu ist es aber nicht notwendig, dass das konkurrierende Betriebssystem intern genau identisch zu dem Microsoft-Betriebssystem funktioniert.
- 15** Nach der Gesetz gewordenen Fassung sind andere Zwecke nicht zugelassen. Das betrifft auch die angrenzende Vorschrift des § 69d Abs. 1 UrhG, wonach die Fehlerberichtigung zulässig ist.<sup>16</sup> Insoweit wird § 69e als vorrangig angesehen. Anerkannt ist aber auch, dass das Merkmal der Erforderlichkeit nicht bedeutet, dass sich die Dekompilierung auf die eigentlichen Schnittstelleninformationen beschränken muss, denn deren Anordnung ist nicht immer von vornherein bekannt. Daher können auch andere Programmteile dekompiert werden, wenn und solange nicht erkennbar ist, wo sich die Schnittstelleninformationen befinden.<sup>17</sup> Zur Verhinderung von Missbrauch wird man hier aber zurückhaltend operieren müssen.
- 16** Die Verwendung der so gewonnenen Informationen ist durch Abs. 2 in dreierlei Hinsicht beschränkt:
- ▶ keine Verwendung zu anderen Zwecken
  - ▶ keine Weitergabe an Dritte
  - ▶ keine Verletzung der Rechte am Ursprungsprogramm.
- 17** Das zweite Merkmal bedeutet, dass eine Veröffentlichung der Informationen unzulässig ist. Gleiches gilt für die Weitergabe der Informationen an andere Programmhersteller, die dann selbst wieder eine Dekompilierung vornehmen müssen. Dabei geht es um den Schutz vor einer unkontrollierten Verbreitung der Informationen. Andererseits erschwert diese enge Fassung aber den Aufwand gerade für KMU.<sup>18</sup>
- 18** Probleme wirft aber vor allem der letzte Punkt auf. Zu beachten ist auch im Rahmen des § 69e die Unterscheidung von schutzfähigem Ausdruck und ungeschützter Idee. Standardisierte Spezifikationen können in verschiedenen Formen geschützten Ausdrucks also Programmcode umgesetzt werden. Insofern wird vor allem von Blocher vertreten, dass die Verwendungsbeschränkungen von vornherein nur Einschränkungen des Urheberrechts beabsichtigen, und daher auf geschützten Ausdruck beschränkt sind, während allgemeine Ideen und Prinzipien nicht erfasst werden.<sup>19</sup> Hier muss man auch Art. 1 Abs. 2 RL berücksichtigen, der ja ausdrücklich noch einmal betont, dass Ideen und Prinzipien, die den Schnittstellen zugrunde liegen, nicht geschützt sind (§ 69a Abs. 2 S. 2 UrhG). Ein solches Ergebnis erscheint aber mit der h.M. im Wege der Auslegung schwer zu erreichen.
- 19** Streitig diskutiert wird auch die Frage, ob Schnittstelleninformationen auch in einem solchen Umfang übernommen werden dürfen, dass es sich um eigentlich geschützten Ausdruck handelt, soweit dies zur Herstellung der Interoperabilität notwendig ist. Dies wird überwiegend befürwortet und dabei verwiesen auf fehlende Gestaltungsmöglichkeiten und auch die

U.S.-amerikanische „Merger“-Doktrin, die in solchen Fällen die Übernahme von Code zulässt.<sup>20</sup> Inzwischen hat sich die Programmieretechnik so weiterentwickelt, dass es bei manchen Programmen nicht mehr ohne weiteres möglich ist, gezielt die Schnittstelleninformationen isoliert zu gewinnen.<sup>21</sup> Hier ist dann verstärkt die Frage aufgeworfen, ob auch ein größerer Teil des geschützten Codes frei übernommen werden kann, um Interoperabilität herzustellen. Dies hängt natürlich vom Umfang im Einzelfall ab. Jedenfalls erscheint dies nicht mehr unbedingt von der Intention des Gesetzgebers gedeckt. Die Grenze ist jedenfalls durch § 69e Abs. 2 Nr. 3 UrhG gezogen, wenn die Übernahme zu einem Programm mit „im wesentlichen“ ähnlicher Ausdrucksform führt.

## II. Hauptkritikpunkt: Schutz von Ideen

### 1. Urheberrechtlicher Know-how-Schutz

20 Gerade der erste Punkt hat bereits während der Richtlinienentstehung zu Kritik herausgefordert.<sup>22</sup> Folgt man der weit aus h.M., so wird wegen der notwendigen Urheberrechtsverletzung zu deren Erlangung auch der Zugang zu ungeschützten Ideen beschränkt. Man hat die Vorschrift daher auch als „urheberrechtlichen Know-how-Schutz“<sup>23</sup> bezeichnet.

21 Dies scheint mir einer der kritischsten Punkte der Regelung zu sein. Das Urheberrecht versperrt den Weg zur Erlangung des Programm-Know-how. Natürlich kann man an eine sog. Black-Box-Analyse denken, die aber auch nur innerhalb der engen Grenzen von § 69d Abs. 3 UrhG zugelassen ist und meist nicht weiterführt.<sup>24</sup> Nun geht es bei dem Schutz von Know-how eigentlich um den Schutz eines Wettbewerbsvorsprungs im Interesse der Innovation. Das ist aber nicht die Stoßrichtung des Urheberrechts, dem es um die Kreativität geht, während das Partizipationsinteresse durch die reine Analysetätigkeit nicht berührt ist.<sup>25</sup> Dies hat etwa die Bundesregierung im Umsetzungsverfahren bemängelt und die Vorschrift insoweit als systemwidrig bezeichnet.<sup>26</sup>

22 Darüber hinaus ist ein so weitgehender Schutz des Know-how auch inhaltlich unangemessen. Schaut man in die technischen Schutzrechte, die ja primär für den Schutz technischen Know-how „zuständig“ sind, so bestehen etwa im Patentrecht Ausnahmen für private Nutzung sowie vor allem für Versuchszwecke, die auch für gewerbliche Zweck zugelassen sind (§ 11 Nr. 1, 2 PatG). Darüber hinaus ist es für den patentrechtlichen Schutzzweck der Innovationsförderung von essentieller Bedeutung, dass die Erfindung offenbart wird, also das technische Wissen der Allgemeinheit zur Verfügung gestellt wird, damit an-

dere Entwickler darauf aufbauen können. Instruktiv ist auch ein Blick in das Halbleiterschutzgesetz.<sup>27</sup> Nach § 6 Abs. 2 sind folgende Handlungen nicht vom Schutz umfasst:

1. die Nachbildung der Topographie zum Zwecke der Analyse, der Bewertung oder der Ausbildung;
2. die geschäftliche Verwertung einer Topographie, die das Ergebnis einer Analyse oder Bewertung nach Nummer 2 ist und Eigenart im Sinne von § 1 Abs. 2 aufweist.

23 In den technischen Schutzrechten wird das Interesse am Informationsaustausch in Wissenschaft und Forschung damit besonders berücksichtigt. Anders als der Patentschutz ist das Urheberrecht auf diesen Interessenkonflikt nicht zugeschnitten. Die Sondervorschriften zum Softwareschutz schießen noch stärker über das Ziel hinaus und sind enthalten insofern weit keinen angemessenen Interessenausgleich. Das zeigt sich auch an den Wertungen des wettbewerbsrechtlichen Know-how-Schutzes.

### 2. Wettbewerbsrechtlicher Know-how-Schutz von Schnittstellen

24 Nur im Objektformat vertriebene Programme können sich den Schutz nach §§ 17, 18 UWG zunutze machen, der sich auch gegen ein nicht genehmigtes Reverse Engineering richten kann.<sup>28</sup> Fraglich ist, ob die Wertung des Art. 6 der RL auch auf den Know-how-Schutz übergreift. Teilweise wird dies wegen der Parallelität beider Schutzmöglichkeiten und der ausdrücklichen Entscheidung des Rates gegen einen Vorrang urheberrechtlicher Bestimmungen abgelehnt wird,<sup>29</sup> Überwiegend wird aber ein Verbot der nach Art. 6 erlaubten Handlungen auf der Grundlage des Geheimnisschutzes abgelehnt mit Hinweis darauf, dass es sich bei der RL um die speziellere Vorschrift handelt.<sup>30</sup> Letzterem wird man wohl heute folgen müssen, so dass im Umfang der urheberrechtlichen Freistellung auch ein Know-how-Schutz nicht zum Tragen kommt.

25 Interessant ist insofern aber ein rechtsvergleichender Blick in die U.S.A. Dort hat das Trade Secret Law einen ungleich höheren Stellenwert als Schutzsystem erlangt als in Deutschland.<sup>31</sup> Anders als bei uns ist dort aber das reverse engineering von Computerprogrammen vom Schutz freigestellt. Tragendes Argument dafür ist, dass dieser Vorgang so zeitaufwändig und teuer ist, dass sich ein Wettbewerber dadurch keinen Wettbewerbsvorsprung verschaffen kann.<sup>32</sup> Darin liegt auch eine andere und wohl realistischere Bewertung des Interessenkonflikts zwischen Rechteinhaber und Zugangsinteressen der Wettbewerber. Die Gefährdung der ersten Gruppe, die der engen Fassung der RL zugrunde liegt, wird hier als viel geringer eingeschätzt. Dafür werden die

Interessen am Zugang zum Programm-Know-how höher bewertet. Der freie Zugang fördert Innovation und letztlich auch die Interessen der Verbraucher.<sup>33</sup>

### 3. Freigabe des Reverse Engineering

- 26 Folgt man dieser Bewertung, und angesichts der technischen und wirtschaftlichen Ausgestaltung des Reverse Engineerings muss man das wohl, so erscheint als angemessener Interessenausgleich nur eine völlige Freigabe des Reverse Engineering. Das wettbewerblich motivierte Interesse der Rechteinhaber würde dadurch nicht beeinträchtigt. Zugleich würde dem urheberrechtlichen Prinzip des freien Zugangs zu Ideen Rechnung getragen. Damit kämen die Interessen von Wissenschaft und Forschung am freien Austausch von Ideen zum Tragen.
- 27 Eine solche Freigabe öffnete den Weg auch für weitere legitime Zwecke.<sup>34</sup> Das gilt etwa für die IT-Sicherheit. Beispielsweise kann das Dekompilieren dazu dienen, zu überprüfen, ob sicherheitsrelevante Anwendungen wie Verschlüsselungssysteme frei von Trojanern oder Umgehungsmöglichkeiten sind.<sup>35</sup> Weitere sinnvolle Anwendungen ergeben sich im Bereich der Wartung und Pflege von Software. Weiterhin könnte die Dekompilierung eingesetzt werden, um den Nachweis einer Rechtsverletzung durch einen Nachprogrammierung durch einen Dritten zu ermöglichen. Dadurch könnte die Einschaltung eines unabhängigen Gutachters vermieden werden.<sup>36</sup>
- 28 Rückwirkungen ergäben sich durch eine Freigabe des Reverse Engineering auf § 69d UrhG. Dieses wäre auch zu Zwecken der Fehlerbeseitigung zulässig und könnte dieser Regelung zusätzliche Wirksamkeit verschaffen.
- 29 Zum Schutz der Interessen der Rechteinhaber sollte es aber hinsichtlich der Verwendungsbeschränkungen nach § 69e Abs. 2 UrhG dabei bleiben, dass die Schaffung von Konkurrenzprogrammen mit gleicher oder ähnlicher Ausdrucksform untersagt ist. Die ergibt sich aber bereits aus §§ 16, 23 UrhG. Andererseits besteht angesichts des Gesagten keine Notwendigkeit, den Schutz gegen die Verwendung der erlangten Information auf die Phasen der Entwicklung und Herstellung vorzuverlagern, wie es § 69e Abs. 2 Nr. 3 UrhG vorsieht.

### C. Kartellrecht als zweite Säule

- 30 Es herrscht Einigkeit, dass es sich bei § 69e um eine zumindest kartellrechtlich motivierte Vorschrift handelt. Daher ist es zur Bewertung der Regelung auch notwendig, einen Blick auf Eingreifen und Reichweite des eigentlichen Kartell- und Wettbe-

werbsrechts zu werfen. Das kann zur Klärung beitragen, inwieweit überhaupt ein Bedürfnis für eine spezielle Ausnahmevorschrift zur Herstellung von Interoperabilität im Urheberrecht besteht. Hier geht es vor allem um das Missbrauchsverbot des Art. 102 EG (vormals 82). Dabei können wir das Missbrauchsverfahren gegen Microsoft heranziehen, das mit der Entscheidung des EuG vom 17.9.2007 endete<sup>37</sup> und in dem zuvor die Kommission ein Bußgeld in bis dato unerreichter Höhe von 497 Mio € festgesetzt hatte.

### I. Das Verfahren Kommission gg. Microsoft 2004/2007

- 31 Die Kommission hatte sich auf Art. 82 lit b EG a.F. gestützt, wonach ein Missbrauch insbesondere in der Einschränkung der Erzeugung, des Absatzes oder der technischen Entwicklung zum Schaden der Verbraucher bestehen kann. Im Kern ging es in dem für uns relevanten Teil des Verfahrens um den Vorwurf, dass Microsoft konkurrierenden Herstellern von Arbeitsgruppen-Serverbetriebssystemen nicht alle Schnittstelleninformationen zur Verfügung stellte, die diese zur Herstellung „voller Interoperabilität“ mit Windows-basierten Client-PC's benötigten.<sup>38</sup> Ziel sei es, die überragende Stellung auf dem Markt für PC-Betriebssysteme auszunutzen, um Wettbewerber von den Märkten für Serverprogramme zu verdrängen. Microsoft hatte zwar immer in gewissem Umfang Schnittstelleninformationen den Wettbewerbern zur Verfügung gestellt, nicht aber für bestimmte neue Windows-Funktionen, z.B. Active Directory. Insoweit geschlossene Vergleiche in den U.S.A. reichten der Kommission nicht aus.
- 32 Kernfrage war insoweit, wann das Kartellrecht der Ausübung immaterialgüterrechtlicher Befugnisse Grenzen setzen kann. Der EuGH hatte bereits in einigen vorhergehenden Entscheidungen Pflöcke für die ausnahmsweise Annahme eines Missbrauchs von Immaterialgüterrechten eingeschlagen, vor allem in den Entscheidungen Magill<sup>39</sup> und IMS Health<sup>40</sup>. Voraussetzung ist danach, dass
1. die Lizenzierung unerlässlich ist für den Zugang zu einem benachbarten Markt
  2. ihre Verweigerung jeden wirksamen Wettbewerb ausschließen würde
  3. das Erscheinen eines neuen Produkts auf diesem Markt verhindern würde
  4. keine objektive Rechtfertigung vorliegt.
- 33 Die zu diesen Voraussetzungen in diesem Verfahren ausgetauschten Argumente erinnern an die Punkte, die auch in der Diskussion zu § 69e UrhG von besonderer Bedeutung sind. Microsoft trug vor, es fehle

an der Unerlässlichkeit der Preisgabe der Informationen, da diese bereits auf fünf anderen Wegen von Wettbewerbern beschafft werden könnten. Das EuG hob jedoch hervor, dass Interoperabilität für die Endkunden eine große Bedeutung habe und daher eine den MS-Produkten vergleichbare Interoperabilität hergestellt werden müsse, um wettbewerbsfähig zu sein.

- 34 Diese strengen Anforderungen sind kritisiert worden. Hier wird darauf verwiesen, der EuGH habe bisher keine völlige Gleichstellung verlangt, sondern bereits das Bestehen weniger günstiger Alternativen ausreichen lassen.<sup>41</sup> Andererseits muss man hier wohl auch die Besonderheiten bei der Software berücksichtigen, die für die Notwendigkeit einer „vollen“ Interoperabilität sprechen.
- 35 Hinsichtlich der zweiten Voraussetzung trug Microsoft vor, es würde keinesfalls jeglicher Wettbewerb durch die Verweigerung ausgeschlossen. Das Gericht betonte hierzu, das die Märkte besonders durch Netzwerkeffekte geprägt seien und ein Ausschluss vom Wettbewerb nicht rückgängig zu machen sei. Auch sei der Marktanteil von Microsoft stetig gewachsen.
- 36 Zum Erfordernis des „neuen Produkts“ hatte Microsoft geltend gemacht, die Wettbewerber würden die Produkte einfach klonen, so dass keine neuen Produkte entstünden. Das EuG hielt es jedoch für ausreichend, wenn die Wettbewerbsprodukte „substantielle“ eigene Elemente enthielten. Darüber hinaus wurde das Erfordernis selbst vom EuG unter Hinweis auf die allgemeinere gesetzliche Formulierung der Einschränkung der technischen Entwicklung zum Nachteil der Verbraucher angezweifelt. Letzteres sei hier gegeben, da die Wettbewerber durch die Bindung der Kunden an Microsoft-Produkte ihre innovativen Produkte nicht absetzen könnten.
- 37 Im Rahmen einer Rechtfertigung prüfte das Gericht dann das Argument, die Zwangslizenzierung führe zur Herabsetzung der Innovationsbereitschaft bei Microsoft und anderen Wettbewerbern. Dies sah das Gericht aber nicht als hinreichend dargelegt an.
- 38 Während in der Entscheidung des EuG Art. 6 der SoftwareRL nur mittelbar von Bedeutung war, hatte der Kommissionsbeschluss die Richtlinie ausdrücklich angesprochen.<sup>42</sup> Microsoft hatte dazu vorgetragen, dass die Entscheidung den ausgewogenen Ausgleich in Frage stelle, den die RL zwischen Urheberrecht und Wettbewerbspolitik hergestellt habe. Die Kommission stellte dazu fest, dass die RL als sekundäres Gemeinschaftsrecht hinter Art. 82 EG zurücktreten müsse. Darüber hinaus sei Art. 6 ein guter Ausgangspunkt auch für die kartellrechtliche Bewertung und stimme inhaltlich mit den von der Kommission gestellten Anforderungen überein. Allerdings gehe Art. 82 insofern über die SoftwareRL hinaus, als

hier nicht nur eine passive Duldungspflicht hinsichtlich der Dekompilierung begründet werde, sondern eine aktive Pflicht zur Bereitstellung der entsprechenden Informationen. Erwägungsgrund 27 der RL lasse aber ausdrücklich die Anwendung der Wettbewerbsregeln des EGV unberührt.

- 39 Eingehend diskutiert wurden auch Microsofts Argumente, die gestellten Anforderungen gingen über das hinaus, was Art. 6 RL im Hinblick auf Interoperabilität fordere. Demgegenüber bekräftigten die Kommission und danach auch das EuG, dass die in dem Verfahren gestellten Anforderungen mit dem Erfordernis der Interoperabilität in der RL kongruent seien. Vor allem beinhalte dieses das Vorhandensein der Möglichkeit zum wechselseitigen Austausch und Nutzung der Informationen. Microsofts engere Definition würde demgegenüber bedeuten, dass bereits jeder noch so beschränkte Zugang eines Clients zum Server-Betriebssystem ausreichen würde, um hinreichend Interoperabilität herzustellen.

## II. Bewertung

- 40 Will man insoweit die komplementär gegebenen kartellrechtlichen Möglichkeiten bewerten, so zeigt sich, dass diese inhaltlich weitgehend mit den Anforderungen des Art. 6 konsistent sind, auch wenn zusätzlich wettbewerbsrechtliche Kriterien zu prüfen sind. Beschränkt wird der Anwendungsbereich des Art. 82 EG durch das Erfordernis der marktbeherrschenden Stellung, während das Urheberrecht auf alle Hersteller Anwendung findet. Hier lässt sich allerdings fragen, ob der auch Art. 6 zugrundeliegende Zweck es nicht auch rechtfertigt, die Vorschrift nur auf marktbeherrschende Unternehmen anzuwenden, da nur von diesen eine Gefahr für den Wettbewerb ausgeht und kleinere Hersteller eher geschützt werden müssten.
- 41 Weiterhin ist es zwar grundsätzlich richtig, dass Art. 6 nur eine passive Duldungspflicht begründet, er zielt aber auch darauf ab, die Unternehmen zu einer frühzeitigen Veröffentlichung zu veranlassen, um die bei der Dekompilierung immer gegebene Missbrauchsmöglichkeit von vornherein auszuschließen. Insofern bestehen in der Zielrichtung keine wesentlichen Unterschiede.
- 42 Zu beachten bleibt aber, dass das Reverse Engineering einen zeit- und kostenaufwändigen Prozess beinhaltet. Schließlich stehen dem Hersteller auch andere Möglichkeiten zur Verfügung, um die Herstellung von Kompatibilität zu erschweren. Dazu gehört ein Upgrade des Betriebssystems, wie etwa beim Übergang von Windows NT auf Windows 2000. Das war auch der Grund, warum die Fa. Sun sich im Verfahren vor der Kommission nicht auf das reverse engineering verlassen hat sondern aktive Offenlegung der Schnittstellen gefordert hat. Dies scheint also das

wesentlich effektivere Mittel zu sein, um den Wettbewerb zu schützen. Es vermeidet auch unnötigen Parallelaufwand.

- 43 Hier scheint mir einer der wesentlichen Gründe zu liegen, warum Art. 6 RL scheinbar in der Praxis bisher kaum eine Rolle spielt. Andererseits wäre eine aktive Offenlegungspflicht für das Urheberrecht ein Fremdkörper, im Kartellrecht dagegen am richtigen Platz.<sup>43</sup>

## D. IV. Schlussfolgerungen

- 44 Der letztere Aspekt ist von großer Bedeutung auch für ein Gesamtfazit unter dem Gesichtspunkt eines Reformbedarfs. Natürlich ist – wie nicht selten – die sprachliche Fassung der Richtlinie nicht immer glücklich und an manchen Stellen verbesserungs- und klärungsbedürftig. Auch habe ich einige Streitfragen zur Reichweite der Erlaubnis angesprochen, die man von Seiten des Gesetzgebers klarstellen könnte. Dazu gehören die Zulässigkeit der Dekompilierung zur Herstellung der Interoperabilität von Hardware sowie die Erlaubnis zur Übernahme eigentlich urheberrechtlich geschützter Code-Elemente, soweit dies zur Herstellung der Interoperabilität unvermeidlich ist.

- 45 Ich möchte aber den Schwerpunkt auf eine weiter gefasste Perspektive legen. Die Ausgangsfrage lautet: „Reichen die Vorschriften der Richtlinie“. Die Frage ist natürlich: reichen wozu? Wenn es um den Zweck eines angemessenen Ausgleichs zwischen Urheberrechtsschutz und Wettbewerb geht, so komme ich zu dem Ergebnis, dass die Ansiedlung dieser Vorschrift im Urheberrecht ein Fehlgriff war. Dafür sprechen nicht nur die bisher nicht erkennbare praktische Relevanz, sondern auch der Vergleich zum komplementären Kartellrecht. Daraus möchte ich folgende Thesen/Forderungen ableiten:

1. *Reverse Engineering urheberrechtlich ganz freigeben!*

- 46 Hierfür sind mehrere Erwägungen ausschlaggebend:

- 47 Die von *Blocher* zu Recht in den Mittelpunkt gestellte Kritik am systemfremden Schutz der Ideen durch das Urheberrecht, die sich allerdings im Wege der Auslegung nicht beseitigen lässt. Hier könnte eine Befreiung der Dekompilierungserlaubnis von den engen Grenzen der Interoperabilität helfen, dem Prinzip der Schutzfreiheit der Ideen wieder zur Geltung zu verhelfen;

- 48 Die Freigabe der Zwecke ermöglicht die Dekompilierung auch zu Zwecken von Forschung und Entwicklung sowie weitere Zwecke, etwa der IT-Sicherheit. Damit würde man den Gleichklang zu den Wertungen der technischen Schutzrechte herstellen, von denen man keineswegs sagen kann, dass sie die Her-

steller schädigen; vielmehr wird der Informationsaustausch durch das Einzwängen des Softwareschutzes in das Urheberrecht noch stärker behindert, als wenn man Software in den technischen Schutzrechten belassen hätte; zugleich bekäme Art. 6 damit stärker den Charakter einer echten Schrankenregelung;

- 49 eine unangemessene Gefährdung der Interessen der Rechteinhaber wäre damit nicht verbunden: bei den Programmen, um die es hier geht, ist der Prozess des reverse engineering so zeitaufwändig, dass ein Verlust der für die Innovation notwendigen lead time für die Hersteller nicht zu befürchten ist; im übrigen ist ein Schutz dieser Lead time nicht Aufgabe des Urheberrechts, sondern gehört in das Wettbewerbsrecht; nicht ohne Grund ist aber auch im amerikanischen relativ strengen Trade Secret Law das reverse engineering auch bei Software erlaubt, da sich der Dekompilierer dadurch keinen Wettbewerbsvorsprung verschafft; das leitet über zum nächsten Punkt

2. *Wettbewerbsaspekte sind besser im Wettbewerbsrecht aufgehoben!*

- 50 Das Kartellrecht ist von Eingriffsschwelle und inhaltlicher Ausgestaltung sehr viel besser geeignet, die Gefährdung des Wettbewerbs zu erfassen und angemessen zu bekämpfen. Die Kommission hat mittlerweile auch eindrucksvoll ihren Willen gezeigt, dies auch in die Praxis umzusetzen. Auch die Rechtsfolge einer aktiven Informationspflicht wird dem Wettbewerbsgedanken sehr viel effektiver gerecht als die bloß passive Duldungspflicht hinsichtlich des Kompilierens.

- 51 Diese Überlegungen sind nicht neu und haben zT schon in der Diskussion im Vorfeld der Richtlinie eine große Rolle gespielt. Die Tatsache, dass die Vorschrift weitgehend totes Recht ist, während andererseits das Kartellrecht immer größere Bedeutung erlangt, sollte uns aus heutiger Sicht ein neuer Anstoß sein, die Regelung zu überdenken. Nicht zuletzt auch die zunehmende Strömung in Richtung auf mehr Access im Urheberrecht im Interesse von Wissenschaft, Forschung und Informationsfreiheit gibt uns heute zusätzliche Argumente, die Vorschrift jedenfalls zu lockern.

1 Vgl. Dreier/Schulze-Dreier § 69e Rn. 7.

2 Vgl. a.a.O.

3 EuGH, Rs. 60/81, 190/81 – IBM/Kommission, Slg. 1981, 2639.

4 Vgl. Loewenheim/Meessen/Riesenkampff, Kartellrecht, 2. Aufl. München 2009, GRUR Rn. 126; Sucker, CR 1988, 271, 274 ff.

5 Vgl. Harte-Bavendamm, GRUR 1990, 657 ff. Zur Zulässigkeit Schrickler/Loewenheim, § 69d Rn. 22 f.

6 Eingehend dazu Blocher/Walter, in: Walter/v. Lewinsky (eds.), European Copyright Law, 2nd ed., Oxford/New York 2010, Computer Program Directive Zi. 5.6.13.



- 7 Vgl. a.a.O., Zi. 5.6.20.
- 8 Vgl. Blocher/Walter (Fn. 6), Rn. 5.6.16.
- 9 Haberstumpf, CR 1991, 129, 132 ff.
- 10 ABL. EG 1990 Nr. C 231, S. 81.
- 11 Vgl. Blocher/Walter (Fn. 6) Rn. 5.6.6.
- 12 Vgl. Blocher/Walter (Fn. 6) Rn. 5.6.3; Marly, Praxishandbuch Softwarerecht, 5. Aufl. München 2009, Rn. 230 ff., jew. m.w.Nachw.; Haberstumpf, CR 1991, 129 f.
- 13 Dreier (Fn. 1) § 69e Rn. 11. Vgl. auch Erwägungsgrund 12 der RL. Zur Verwendung des Begriffs im europäischen Recht vgl. Blocher/Walter (Fn. 6) Rn. 5.6.29.
- 14 OLG Düsseldorf, CR 2001, 371, 372; Dreier (Fn. 1) Rz 11 m.w.Nachw.
- 15 Vgl. EuG 17.9.2007, Rs. T-201/04, Rn. 231 ff. – Microsoft.
- 16 Schricker/Loewenheim, 4. Aufl. München 2010, § 69e Rn. 10; Dreier (Fn. 1) § 69e Rn. 12. Konrad/Timm-Goltzsch/Ullrich, in: Ullrich/Lejeune, der Internationale Softwarevertrag, 2. Aufl., Frankfurt 2006, Rn. 823, verweisen auf die Möglichkeit der Hinterlegung von Source Code und Entwicklerdokumentation.
- 17 Vgl. auch Czarnota/Hart, Legal Protection of Computer Programs in Europe, 1991, S. 80.
- 18 Schricker/Loewenheim (Fn. 16), § 69e Rn. 20.
- 19 Blocher/Walter (Fn. 6), Rn. 5.6.41; Marly (Fn. 12) Rn. 249; a.A. wohl die h.M. vgl. Wandtke/Bullinger/Grützmaker, § 69e Rn. 20 m.w.Nachw.
- 20 Eher zustimmend Dreier (Fn. 1 Rn. 20); Vinje, GRUR Int. 2991, 250, 259 f.; Marly (Fn. 1) Rn. 250, auch unter Berufung auf die „Merger“-Doktrin; ablehnend. Wandtke/Bullinger/Grützmaker, Praxiskommentar zum Urheberrecht, 4. Aufl. München 2011, § 69e Rn. 11.
- 21 Diesen Hinweis verdanke ich Malte Grützmaker auf der Tagung „20 Jahre Computerprogramm-Richtlinie“ am 12.5. in Hannover.
- 22 Vgl. die Nachweise bei Pres, Gestaltungsformen urheberrechtlicher Softwarelizenzverträge, Köln 1994, S. 137 f.; Haberstumpf, CR 1991, 129, 140; Lehmann, CR 1989, 1057, 1060.
- 23 Marly (Fn. 12), Rn. 236; vgl. ferner Schulte, CR 1992, 648, 653; Wandtke/Bullinger/Grützmaker (Fn. 20), Rn. 3.
- 24 Danach ist nur die Anzeige des Codes auf dem Bildschirm erlaubt, nicht jedoch die Dekompilierung, vgl. Dreier (Fn. 1), § 69e Rn. 12.
- 25 Klar in dieser Hinsicht auch Haberstumpf, CR 1991, 129, 140 f.; Kindermann, CR 1990, 640.
- 26 BT-Drs. 12/4022 v. 18.12.1992, S. 13.
- 27 Vgl. auch Blocher/Walter (Fn. 6), Rn. 5.6.22.
- 28 Vgl. Wiebe, Know-How-Schutz von Computersoftware, München 1993, S. 182 ff, 267 ff.
- 29 Wiebe (Fn. 28), S. 269; Moritz, CR 1993, 257, 267.
- 30 LG Mannheim, NJW 1995, 3322, 3323; Dreier (Fn. 1), Rn. 5; Wandtke/Bullinger/Grützmaker (Fn. 1), Rn. 31; Pres (Fn. 22), S. 142.
- 31 Vgl. Wiebe (Fn. 20), S. 330 ff.
- 32 *Bonito Boats, Inc. v. Thundercraft Boats, Inc.*, 489 U.S. 141 (1989); *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470 (1974); *E.I. duPont de Nemours & Co., Inc. v. Christopher*, 431 F.2d 1012 (5<sup>th</sup>. Cir. 1970). Vgl. auch Wiebe (Fn. 20), S. 384 f.
- 33 Eingehend Samuelson/Scotchmer, *The Law and Economics of Reverse Engineering*, 111 Yale L. J. 1575 (2002).
- 34 Dazu auch Haberstumpf, CR 1991, 129, 130.
- 35 Vgl. Blocher/Walter (Fn. 6), Rn. 5.6.15.
- 36 Vgl. Dreier (Fn. 1), § 69e Rn. 12, der für anhängige Gerichtsverfahren auch eine Analogie zu § 45 UrhG befürwortet.
- 37 EuG 17.9.2007, RS T-201/04 – Microsoft; dazu Körber WuW 2007, 1209 ff.
- 38 Kommission, 24.3.2004, COMP/C-3/37.792 – Microsoft.
- 39 EuGH 6.4.1995, Rs. 241, 242/91, Slg. 1995, I-743 – Magill.
- 40 EuGH 29.4.2004, Rs. C-418/01, Slg. 2004, I-5039 – IMS Health.
- 41 Körber, WuW 2007, 1209, 1213, unter Verweis auf EuGH, Rs. C-7/97, Slg. 1998, I-7791 – Bronner.
- 42 S. Fn. 38 unter 5.3.1.4.1.4.
- 43 Für eine kodifizierte Zwangslizenzregelung im Kontext des Datenbankschutzes Grützmaker, *Urheber-, Leistungs- und Sui-generis-Schutz von Datenbanken*, Baden-Baden 1999, S. 380 ff.

# Software als Schutzgegenstand des Europäischen Urheberrechts

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**Abstract:** After 20 years of silence, two recent references from the Czech Republic (*Bezpečnostní softwarová asociace*, Case C-393/09) and from the English High Court (*SAS Institute*, Case C-406/10) touch upon several questions that are fundamental for the extent of copyright protection for software under the Computer Program Directive 91/250 (now 2009/24) and the Information Society Directive 2001/29. In Case C-393/09, the European Court of Justice held that “the object of the protection conferred by that directive is the expression in any form of a computer program which permits reproduction in different computer languages, such as the source code and the object code.” As “any form of expression of a computer program must be protected from the moment when its reproduction would engender the reproduction of the computer program itself, thus enabling the computer to perform its task,” a graphical user interface (GUI) is not protected under the Computer Program Directive, as it does “not enable the reproduction of that computer program, but merely constitutes one element of that program by means of which users make use of the features of that program.” While the definition of computer program and the exclusion of GUIs mirror earlier jurisprudence in the Member States and therefore do not come as a surprise, the main significance of Case C-393/09 lies in its interpretation of the Information Society Directive. In confirming that a GUI “can, as a work, be protected by copyright if it is its author’s own intellectual

creation,” the ECJ continues the Europeanization of the definition of “work” which began in *Infopaq* (Case C-5/08). Moreover, the Court elaborated this concept further by excluding expressions from copyright protection which are dictated by their technical function. Even more importantly, the ECJ held that a television broadcasting of a GUI does not constitute a communication to the public, as the individuals cannot have access to the “essential element characterising the interface,” i.e., the interaction with the user. The exclusion of elements dictated by technical functions from copyright protection and the interpretation of the right of communication to the public with reference to the “essential element characterising” the work may be seen as welcome limitations of copyright protection in the interest of a free public domain which were not yet apparent in *Infopaq*. While Case C-393/09 has given a first definition of the computer program, the pending reference in Case C-406/10 is likely to clarify the scope of protection against non-literal copying, namely in how far the protection extends beyond the text of the source code to the design of a computer program and where the limits of protection lie as regards the functionality of a program and mere “principles and ideas.” In light of the *travaux préparatoires*, it is submitted that the ECJ is also likely to grant protection for the design of a computer program, while excluding both the functionality and underlying principles and ideas from protection under the European copyright directives.

**Keywords:** Computerprogramm, Software, Richtlinie 2009/24, Richtlinie 91/250, Richtlinie 2001/29, Programmcode, Steuerungsfunktion, Benutzeroberfläche, Idee(n) und Grundsätze, Algorithmen, Programmiersprachen, Individualität, Werkbegriff, öffentliche Wiedergabe, Programmstruktur, Schnittstelle, Individualität, Originalität

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Nach einem fast zwanzig Jahre andauernden Dornröschenschlaf sind es nun gleich drei<sup>1</sup> Vorlageverfahren, die die Richtlinie 91/250/EWG über den Rechtsschutz von Computerprogrammen<sup>2</sup> (nunmehr 2009/24/EG<sup>3</sup>, im Folgenden Richtlinie bzw. RL 2009/24) aus ihrem sanften Schlummer erwecken. Während die bereits entschiedene tschechische Vorlage *Bezpečnostní softwarová asociace* (im Folgenden: BSA) die Schutzfähigkeit einer graphischen Benutzeroberfläche betraf<sup>4</sup>, fragt der englische High Court in einem umfangreichen Vorlagebeschluss in der anhängigen Rechtssache C-406/10 (*SAS Institute*) u.a. nach dem Schutz von Programmiersprachen, Schnittstellen und Funktionalitäten eines Computerprogramms<sup>5</sup>. Beide Verfahren betreffen grundsätzliche Fragen des Softwareschutzes<sup>6</sup> und geben Anlass, den Gegenstand und die Voraussetzungen des Urheberrechtes für Computerprogramme im Unionsrecht näher zu beleuchten. Nach einer kurzen Einführung (dazu A.) steht dabei zunächst der Schutz nach der Richtlinie 2009/24 im Vordergrund (B.), bevor im zweiten Teil auf die Möglichkeit ergänzenden Schutzes über die allgemeinen Bestimmungen der Richtlinie 2001/29/EG zur Harmonisierung bestimmter Aspekte des Urheberrechtes und der verwandten Schutzrechte in der Informationsgesellschaft<sup>7</sup> (im Folgenden Richtlinie bzw. RL 2001/29) eingegangen werden soll (C.). Außer Betracht bleibt der durch die Richtlinie 2009/24 unberührte (vgl. Art. 8 RL 2009/24) Schutz durch das Patentrecht, das Wettbewerbsrecht und das Vertragsrecht ebenso wie der Schutz von Datenbanken nach der Richtlinie 96/9/EG<sup>8</sup>.

## A. Computerprogramme zwischen Urheberrecht und Sonderrechtsschutz

- 1 Spätestens mit der Entkopplung der Computerprogramme von der Hardware und dem Entstehen eines eigenen Marktes für Software<sup>9</sup> warf die leichte Vervielfältigung und Nachahmung<sup>10</sup> solcher Werke die Frage nach ihrem angemessenen Rechtsschutz auf<sup>11</sup>. Von Anfang an standen sich dabei zwei Konzeptionen gegenüber: Während sich zunächst etwa die WIPO für einen urheberrechtsangelehnten Sonderrechtsschutz aussprach<sup>12</sup>, setzte sich in den USA und etwas später in Deutschland der Schutz von Computerprogrammen als literarisches Werk im Sinne der Urheberrechtsgesetzgebung durch<sup>13</sup>. Dieser Konzeption folgt auch die europäische Richtlinie aus dem Jahr 1991, deren Erwägungsgrund 6 sich ebenso wie Art. 1 Abs. 1 ausdrücklich zum urheberrechtlichen Schutz als literarisches Werk bekennt<sup>14</sup>. Auch auf internationaler Ebene findet sich dieses Konzept inzwischen in Art. 10 Abs. 1 TRIPS<sup>15</sup> und Art. 4 WCT<sup>16</sup>.
- 2 Gleichwohl ist auch im heutigen System des Urheberrechtes für Computerprogramme unverkennbar,

dass derartige Werke eine Sonderstellung einnehmen. Zum einen ist der Schutz von Computerprogrammen in speziellen Regeln verankert (vgl. Art. 1 Abs. 2 RL 2001/29; §§ 69a ff. UrhG), zum anderen unterscheidet sich auch die Ausgestaltung des Urheberrechtes für Computerprogramme vom klassischen Urheberrecht. Zudem fällt nicht jedes Element einer Software unter den Schutz der Computerprogrammrichtlinie, so dass sich ein vollständiges Bild des Softwareschutzes erst erschließt, wenn neben den Regeln für Computerprogramme (dazu sogleich B.) auch der ergänzende Schutz nach allgemeinem Urheberrecht berücksichtigt wird (dazu unter C.).

## B. Schutzgegenstand und Schutzvoraussetzungen nach der Computerprogrammrichtlinie

- 3 Wendet man sich zunächst den speziellen Regeln für Computerprogramme zu, so ist Ausgangspunkt der Untersuchung die Regelung des Art. 1 RL 2009/24, wobei zwischen dem Gegenstand des Programmschutzes (Art. 1 Abs. 1, 2 RL 2009/24) und seinen Schutzvoraussetzungen (Art. 1 Abs. 3 RL 2009/24) zu unterscheiden ist.

### I. Schutzgegenstand

- 4 Dem Schutzgegenstand der Computerprogrammrichtlinie widmen sich die ersten beiden Absätze in Art. 1 RL 2009/24. Art. 1 Abs. 1 Satz 1 RL 2009/24 verpflichtet die Mitgliedstaaten, „gemäß den Bestimmungen dieser Richtlinie ... Computerprogramme urheberrechtlich als literarische Werke im Sinne der Berner Übereinkunft<sup>17</sup> zum Schutze von Werken der Literatur und der Kunst“ zu schützen. Satz 2 präzisiert, dass der Begriff „Computerprogramm“ auch das Entwurfsmaterial zu ihrer Vorbereitung umfasst. Art. 1 Abs. 2 Satz 1 ergänzt sodann, dass der Schutz nach der Richtlinie „für alle Ausdrucksformen von Computerprogrammen“ gilt, während „Ideen und Grundsätze, die irgendeinem Element eines Computerprogramms zugrunde liegen“, nicht im Sinne der Richtlinie Urheberrechtsschutz genießen (Art. 1 Abs. 2 Satz 2 RL 2009/24). Der Schutzgegenstand der Richtlinie wird also bestimmt durch den Begriff des Computerprogramms und seine Abgrenzung von urheberrechtsfreien Ideen und Grundsätzen.

### 1. Die Definition des Computerprogramms durch Programmcode und Steuerungsfunktion

- 5 Leider hat es der europäische Gesetzgeber unterlassen, den Begriff des Computerprogramms in der Richtlinie selbst zu definieren, um zu vermeiden,

dass eine derartige Begriffsbestimmung veraltet<sup>18</sup>. In der Rechtssache *BSA* greift der EuGH deshalb auf den Regelungszusammenhang und die Ziele sowohl der Richtlinie wie des die Union bindenden Völkerrechts (TRIPS) zurück, um den Begriff zu konkretisieren<sup>19</sup>. Dabei stellt der Gerichtshof zunächst heraus, dass sich der urheberrechtliche Schutz auf alle Ausdrucksformen von Computerprogrammen erstrecken soll (Art. 1 Abs. 2 RL 2009/24), gleich ob sie in dem für Menschen lesbaren Quellcode oder in Maschinenprogrammcode (Objektcode) ausgedrückt sind (Art. 10 Abs. 1 TRIPS)<sup>20</sup> und ob sie in Software oder Hardware integriert sind (Erwägungsgrund 7 RL 2009/24)<sup>21</sup>. Daher, so das Luxemburger Gericht, seien „der Quellcode und der Objektcode eines Computerprogramms dessen Ausdrucksformen“, die „nach Art. 1 Abs. 2 der Richtlinie 91/250 den urheberrechtlichen Schutz für Computerprogramme verdienen“<sup>22</sup>. Der durch die Richtlinie geschaffene Schutzgegenstand beziehe sich somit „auf das Computerprogramm in allen seinen Ausdrucksformen, die es erlauben, es in den verschiedenen Datenverarbeitungssprachen, wie Quellcode und Objektcode, zu vervielfältigen“<sup>23</sup>, einschließlich des „Entwurfsmaterial[s] zur Entwicklung eines Computerprogramms, sofern die Art der vorbereitenden Arbeit die spätere Entstehung eines Computerprogramms zulässt“ (Erwägungsgrund 7 Satz 2, Art. 1 Abs. 1 Satz 2 RL 2009/24)<sup>24</sup>. Neben der Bezugnahme auf den Programmcode und das Entwurfsmaterial als Ausdrucksform des Computerprogramms entwickelt der Gerichtshof sodann in Rn. 38 der Entscheidung unter Bezugnahme auf die Schlussanträge des Generalanwalts<sup>25</sup> als zweites Definitionsmerkmal des Computerprogramms, dass

„jede Ausdrucksform eines Computerprogramms ab dem Moment geschützt sein [muss], ab dem ihre Vervielfältigung die Vervielfältigung des Computerprogramms zur Folge hätte und auf diese Weise der Computer zur Ausführung seiner Funktion veranlasst werden könnte“<sup>26</sup>.

- 6 Die Definition des Computerprogramms anhand des Programmcodes und der Steuerungsfunktion (Veranlassung des Computers zur Ausführung einer Funktion) deckt sich mit den Ausführungen im ursprünglichen Vorschlag der Kommission für die Computerprogrammrichtlinie, an die sich der Generalanwalt angelehnt hat<sup>27</sup>, und stellt daher keine Überraschung dar<sup>28</sup>. Der Schutz durch Art. 1 RL 2009/24 kommt also<sup>29</sup> in Betracht, wenn durch die Vervielfältigung urheberrechtlich relevanter<sup>30</sup> Teile<sup>31</sup> der Befehlsfolge<sup>32</sup> des Programmcodes<sup>33</sup> gleich in welcher Ausdrucksform (Quellcode, Objekt-/Maschinencode, Assemblercode oder mögliche Zwischenformen) das Funktionsausführungselement des Computerprogramms übernommen wird, also der Computer zur Ausführung einer Funktion oder

Aufgabe veranlasst werden könnte, für die das Programm entwickelt worden ist<sup>34</sup>.

- a. Konsequenzen für den Schutz von Benutzeroberflächen und audiovisuellen Darstellungen
- 7 Als Folge der Definition des Computerprogramms anhand des Programmcodes und der Steuerungsfunktion werden Programmelemente ohne Steuerungsfunktion aus dem Schutzbereich der Richtlinie ausgenommen, durch deren Vervielfältigung der Computer nicht zur Ausführung einer bestimmten Aufgabe oder Funktion veranlasst wird. Dementsprechend ist auch reinen Daten ohne Steuerungsfunktion<sup>35</sup> oder nicht an den konkreten Programmcode gebundenen Elementen (z.B. den Funktionen<sup>36</sup> oder dem Erscheinungsbild eines Computerprogramms) der Schutz der Richtlinie zu versagen, denn auch in diesen Fällen fehlt es an der Steuerungsfunktion bzw. kann die Funktionalität oder das Erscheinungsbild durch verschiedene Quell- und Objektcodes erreicht werden, so dass nicht die im Programmcode verkörperte Ausdrucksform des Programms wiedergegeben wird. Zu dieser Kategorie nicht steuerungsbezogener Programmelemente zählt der Gerichtshof auch – was der überwiegenden Auffassung in Deutschland und England entspricht<sup>37</sup> – graphische Benutzeroberflächen, da diese als Interaktionsschnittstelle lediglich die Kommunikation zwischen Computerprogramm und Nutzer zur Nutzung der Programmfunktionen ermöglichen<sup>38</sup>. Zudem, darauf weist der Generalanwalt ergänzend hin, können Computerprogramme mit verschiedenen Quell- und Objektcodes durchaus dieselbe Benutzeroberfläche haben, so dass diese nicht das Programm selbst wiedergebe<sup>39</sup>. Gegen den Ausschluss graphischer Benutzeroberflächen mag man einwenden, dass man über eine breitere Definition der Funktion eines Computerprogramms durchaus auch die Interaktion mit dem Nutzer in die Programmdefinition einbeziehen könnte<sup>40</sup>, zumal eine Differenzierung zwischen der graphisch-räumlichen Anordnung der Oberflächenelemente (nur allgemeiner Urheberschutz) und dem Verhalten der Oberfläche i.S.d. logischen Abfolge der Masken und der Reaktionen auf Benutzereingaben denkbar wäre<sup>41</sup>. Die Entscheidung *BSA* spricht sich allerdings gegen eine solche Differenzierung und für eine generelle Anwendung des allgemeinen Urheberrechts auf den Schutz graphischer Benutzeroberflächen aus, denn der Gerichtshof stellt bei der Auslegung des Begriffs der öffentlichen Wiedergabe für die Zwecke des allgemeinen Urheberrecht Art. 3 Abs. 1 RL 2001/29) gerade auch auf die Funktion der Benutzerschnittstelle ab, eine Interaktion zwischen dem Computerprogramm und dem Benutzer zu ermöglichen<sup>42</sup>, so dass offenbar auch das Verhalten der Oberfläche unter die allgemeine Richtlinie 2001/29 und nicht unter die Richtlinie 2009/24 fallen soll (dazu C.). Für den Schutz von Computer-

spielen dürfte die Entscheidung *BSA* somit die Differenzierung zwischen dem Schutz der spielsteuernden Software (als Computerprogramm) und der audiovisuell wahrnehmbaren Spielgestaltung (als sonstiges Werk)<sup>43</sup> bestätigen, auch wenn diese angesichts einer immer engeren Verknüpfung von Programmcode und audiovisuellem Inhalt in jüngerer Zeit skeptisch beurteilt wird<sup>44</sup>.

#### b. Konsequenzen für den Schutz von Schnittstellen

- 8 Auch wenn die Entscheidung *BSA* der graphischen Benutzeroberfläche als Interaktionsschnittstelle den Schutz als Computerprogramm abspricht, so lässt sich daraus nicht folgern, dass Schnittstellen, die eine Verbindung und Interaktion zwischen den Elementen von Software und Hardware mit anderer Software und Hardware ermöglichen sollen (Erwägungsgrund 10 Satz 2 und 3), generell der Urheberschutz zu versagen ist. Wie ein Gegenschluss aus Art. 1 Abs. 2 Satz 2 („einschließlich der den Schnittstellen zugrunde liegenden Ideen“) und die Existenz einer speziellen Schrankenregelung in Art. 6 RL 2009/24 nahelegen, kann nämlich der einer Verbindungsschnittstelle zugrundeliegende Programmcode durchaus Urheberschutz genießen<sup>45</sup>, denn sonst wäre die explizite Gestattung der „Vervielfältigung des Codes oder die Übersetzung der Codeform“<sup>46</sup> in Art. 6 Abs. 1 RL 2009/24 nicht verständlich<sup>47</sup>. Daran ändert auch die Rechtssache *BSA* nichts, da der Generalanwalt explizit zwischen Verbindungsschnittstellen zum „Dialog mit anderen Komponenten des Computersystems“ und Interaktionsschnittstellen wie der graphischen Benutzeroberfläche unterscheidet und sich seine Ausführungen zur fehlenden Schutzfähigkeit nur auf letztere beziehen<sup>48</sup>. Gleiches gilt für die Entscheidung des Gerichtshofs selbst, der ebenfalls nur zu Interaktionsschnittstellen Stellung nimmt<sup>49</sup>. Nicht mehr vom Programmschutz erfasst sind allerdings Schnittstellenspezifikationen, also die Regeln und Methoden des Datenaustausches und der Zusammenarbeit der Programme und Module, sei es weil man diese als die der Schnittstelle zugrundeliegenden Ideen und Grundsätze ansieht<sup>50</sup> oder weil ein entsprechender Schutz der auf Interoperabilität (Erwägungsgrund 10 Satz 4) angelegten Zielrichtung der Richtlinie zuwider liefe, denn Interoperabilität setzt gerade die exakte Verwirklichung der Schnittstelle voraus<sup>51</sup>.

#### c. Konsequenzen für die Feststellung einer Rechtsverletzung

- 9 Die am Programmcode und der Steuerungsfunktion orientierte Interpretation des Schutzbereichs der Richtlinie bestätigt außerdem, dass zur Feststellung einer Rechtsverletzung grundsätzlich von den Übereinstimmungen im Text des Programmcodes auszugehen ist (zur Programmstruktur unten A. I. 2.)<sup>52</sup>.

Trotz des Schutzes sämtlicher Ausdrucksformen des Programmcodes dürften Übereinstimmungen dabei regelmäßig anhand des Quellcodes nachzuweisen sein<sup>53</sup>, da Übereinstimmungen im Maschinencode auch auf die Benutzung derselben Programmbasis<sup>54</sup>, identischer Hilfsprogramme oder desselben Compilers zurückzuführen sein können<sup>55</sup>. Bei der Übereinstimmungsanalyse sind allerdings solche Modifizierungen des Programmcodes außer Acht zu lassen, die für die Maschine und damit die Steuerungsfunktion unmaßgeblich sind, wie etwa unterschiedliche Formatierungen (Leerzeichen, Einrückungen), abweichende Variablennamen oder eine für die Programmausführung unerhebliche Veränderung der Reihung von Codezeilen (z.B. Definitionen von Programmfunktionen oder Variablen)<sup>56</sup>. Relevant und sogar besonders aussagekräftig bleiben demgegenüber neben den eigentlichen Programmzeilen auch die (an den menschlichen Leser gerichteten) Kommentarzeilen im Quellcode<sup>57</sup>, da sich gerade dort für das Verständnis des Programms wichtige programmtechnische Erläuterungen finden<sup>58</sup>.

- 10 Lassen sich Übereinstimmungen im Programmcode nachweisen, so kann eine konkrete Prozentzahl übernommener Codezeilen nur als erster Ausgangspunkt zur Identifikation klarer Fälle dienen<sup>59</sup>. Aufgrund des Schutzes auch von Programmteilen und der Vorverlagerung des Programmschutzes („ab dem Moment“<sup>60</sup>) ist sie durch eine qualitative Bewertung der übernommenen Programmzeilen zu flankieren, die auch bei quantitativ geringen Prozentzahlen eine Rechtsverletzung begründen kann, wenn es sich bei den übereinstimmenden Teilen um urheberrechtlich relevante Programmsequenzen handelt<sup>61</sup>.
- 11 Schließlich ist nicht zu übersehen, dass offenbar in der Praxis die Feststellung einer Urheberrechtsverletzung nicht nur objektiv vom Umfang der Übereinstimmungen, sondern auch subjektiv durch die Frage beeinflusst wird, ob der Nachahmer Zugang zum Quellcode hatte<sup>62</sup>. Daran wird sich auch durch die Entscheidung des Gerichtshofs in *BSA* nichts ändern, da diese Praxis eine Stütze im ursprünglichen Kommissionsvorschlag findet<sup>63</sup> und der Gerichtshof die Feststellung der Rechtsverletzung im Einzelfall den nationalen Gerichten überlässt<sup>64</sup>.

## 2. Erstreckung des Programmschutzes auf Entwurfsmaterial und Programmstruktur

- 12 Während der EuGH den Schutzgegenstand der Richtlinie anhand von Programmcode und Steuerungsfunktion konkretisiert, musste der Gerichtshof in *BSA* nicht zu der Frage Stellung nehmen, ob und inwieweit der Schutz der Richtlinie über die im Programmcode niedergelegte konkrete Befehlsfolge

hinaus auch die Programmstruktur<sup>65</sup> („Architektur“)<sup>66</sup> oder Programmkonzeption („Design“)<sup>67</sup> als „Drehbuch des Computerprogramms“<sup>68</sup> erfasst, also etwa die Identifizierung und Gliederung von Teilaufgaben und Objekten, die Umsetzung dieser Objekte in Datenstrukturen oder die Programmroutinen zur Modellierung des Verhaltens der Objekte<sup>69</sup>. Für die Einbeziehung auch solcher Elemente in den Programmschutz der Richtlinie spricht zunächst<sup>70</sup>, dass auch das Entwurfsmaterial eines Computerprogramms geschützt ist, „sofern die Art der vorbereitenden Arbeit die spätere Entstehung eines Computerprogramms zulässt“ (ErwG 7 Satz 2, Art. 1 Abs. 1 Satz 2 RL 2009/24). Da solches Entwurfsmaterial häufig Ablaufdiagramme oder Beschreibungen von Schrittfolgen oder andere Elemente umfasst<sup>71</sup>, in denen über den Programmcode hinaus strukturelle und konzeptionelle Überlegungen niedergelegt werden, erstreckt sich der Schutz der Richtlinie auch auf die Programmkonzeption und Programmstruktur, soweit diese so konkret ist, dass sie die spätere Entstehung eines bestimmten Computerprogramms ermöglicht<sup>72</sup>.

- 13 Für eine Ausdehnung des Programmschutzes auf die Programmstruktur lässt sich zudem auf die Begründung zum ursprünglichen Kommissionsvorschlag verweisen. Dort wird ausdrücklich festgehalten, dass die Elemente des geistigen Schöpfungsaktes – Kreativität, Können und Erfindungsgeist – in einem Computerprogramm in der „Art und Weise“ zum Ausdruck kommen, in der das Programm ausgearbeitet ist. Diese „Art und Weise“, in der die Schritte zur Verwirklichung des vom Programm gewünschten Endergebnisses ausgedrückt werden, also seine „Struktur, mit Abschnitten und Unterabschnitten, für den Informationsfluss“, gebe dem Programm seine besonderen Merkmale der Schnelligkeit, Leistungsfähigkeit und sogar des Stils<sup>73</sup>. Auch an anderer Stelle führt die Kommissionsbegründung aus, dass auch bei Gemeinfreiheit der Unterprogramme die schöpferische Leistung des Gesamtprogramms „in der Auswahl und Zusammenstellung dieser ansonsten allgemein bekannten Elemente liegen“ kann<sup>74</sup>. Der Erfolg des Programms im Sinne der Fähigkeit, seine Aufgaben auszuführen, werde, so die Kommission weiter, „weitgehend von dieser Auswahl abhängen, die der Urheber bei jedem Schritt des Programmaufbaus trifft“<sup>75</sup>. Schließlich spricht für eine Einbeziehung der Programmstruktur in den Schutzbereich der Richtlinie auch die Entwicklung moderner (visueller) Programmierwerkzeuge, die aus dem Entwurfsmaterial in Diagrammform automatisch ein Quellcodegerüst erzeugen können, so dass sich nicht mehr eindeutig zwischen Entwurfsmaterial und Computerprogramm unterscheiden lässt<sup>76</sup>. Und nicht zuletzt lässt sich auf eine aktuelle Entscheidung des EuG verweisen, das unlängst in einer Urheberrechtsverletzungsklage gegen die Kommission zur Feststellung der Schutzfähigkeit explizit auf

die Architektur und Struktur des betreffenden Computerprogramms zurückgegriffen hat<sup>77</sup>.

### 3. Abgrenzung zu urheberrechtlich freien Ideen und Grundsätzen

- 14 Erstreckt sich damit der Schutz der Computerprogrammrichtlinie neben der konkreten Kodierung auch auf die im Entwurfsmaterial niedergelegten Ablaufdiagramme und Schrittfolgen sowie die konkrete Struktur des Programms, so schließt sich die Folgefrage an, wo die Grenze zu den nach Art. 1 Abs. 2 Satz 2 RL 2009/24 urheberrechtlich freien „Ideen und Grundsätze[n], die irgendeinem Element des Computerprogramms zugrunde liegen“ zu ziehen ist<sup>78</sup>. Zu dieser Schutzbeschränkung auf die konkrete Ausdrucksform (vgl. Art. 9 Abs. 2 TRIPS; Art. 2 WIPO Copyright Treaty), die vor allem dem Zweck dient, die Entstehung von Monopolen zu verhindern und anderen Urhebern genügend Spielraum zu belassen, um ähnliche oder sogar identische Programme zu entwickeln<sup>79</sup>, musste sich der Gerichtshof in *BSA* nicht äußern<sup>80</sup>.

#### a. Eine europäische „Merger“-Doktrin?

- 15 Interessant ist in diesem Kontext allerdings eine Bemerkung des Gerichtshofs zum ergänzenden Schutz graphischer Benutzeroberflächen nach allgemeinem Urheberrecht (also der RL 2001/29). Im Anschluss an den Generalanwalt stellte der EuGH fest, dass „das Kriterium der Originalität nicht erfüllt [sei], wenn der Ausdruck (...) durch [die] technische Funktion vorgegeben ist“, denn dann seien „die verschiedenen Möglichkeiten der Umsetzung einer Idee (...) so beschränkt, dass Idee und Ausdruck zusammenfallen“, so dass es dem Urheber nicht mehr möglich sei, „seinen schöpferischen Geist in origineller Weise zum Ausdruck zu bringen und zu einem Ergebnis zu gelangen, das eine eigene geistige Schöpfung dieses Urhebers darstellt“<sup>81</sup>. Diese Beschränkung für technisch vorgegebene Ausdrucksformen scheint sich („Idee und Ausdruck zusammenfallen“) an die „Merger-Doktrin“ des US-amerikanischen Copyright Law<sup>82</sup> anzulehnen. Nicht klar wird in *BSA* allerdings, ob die technisch vorgegebene Ausdrucksform den Urheberschutz wegen der Schutzfreiheit von Ideen („Idee und Ausdruck zusammenfallen“) oder wegen fehlender Individualität („Kriterium der Originalität nicht erfüllt“) ausschließen soll. Letztendlich dürfte die überzeugendste Begründung für diese Schutzbeschränkung darin zu sehen sein, dass eine Monopolisierung technisch bedingter Schöpfungen nicht über das Urheberrecht ermöglicht werden soll, um die Gemeinfreiheit auf diesem Gebiet im Interesse der Kreativität und der Innovation zu erhalten<sup>83</sup>.

## b. Programmcode als Ausdrucksform der Idee

16 Abgesehen von dem Sonderfall der technisch bedingten Ausdrucksform liegt es nahe, den Programmcode als Ausgangspunkt für die Abgrenzung von Idee und Ausdrucksform zu wählen. Begreift man den Programmcode nämlich mit dem Generalanwalt als die geschützte Ausdrucksform der Ideen des Programmierers<sup>84</sup>, so handelt es sich umso eher um eine urheberrechtsfreie Idee, je weiter sich das in Rede stehende Element vom Programmcode entfernt. Je größer und vielgestaltiger die Umsetzungsmöglichkeiten der Idee in Gestalt unterschiedlicher Programmcodes und Programmstrukturen wird, desto eher handelt es sich um eine urheberrechtsfreie Idee und nicht mehr um ihre konkrete Ausdrucksform<sup>85</sup>. Als Ideen vom Urheberschutz ausgenommen sind daher Ideen zum Einsatz eines Computerprogramms zur Lösung einer bestimmten Aufgabe<sup>86</sup> (z.B. für ein Buchhaltungsprogramm oder die Betriebsratsarbeit<sup>87</sup>), aber auch (Ideen für) bestimmte Funktionalitäten eines Programms<sup>88</sup>, da diese durch eine Vielzahl unterschiedlicher Möglichkeiten auf Ebene des Programmcodes umgesetzt werden können<sup>89</sup>. Ebenfalls nicht schutzfähig sind Programmierstile und Methoden der Softwaretechnik<sup>90</sup>, da auch solche Stile und Methoden in unterschiedlichsten Programmcodes und Programmstrukturen zum Ausdruck kommen können. Auf der Ebene der Programmstruktur ist der Abgrenzung von Idee und Ausdrucksform dadurch Rechnung zu tragen, dass einzelnen Gestaltungsideen oder Strukturmerkmalen der Schutz zu versagen ist und der Schutz einer Programmstruktur an einer Mehrzahl von Design- und Strukturentscheidungen festzumachen ist, die ein Programm oder einen wesentlichen Teil des Programms ausmachen<sup>91</sup>.

## c. Insbesondere Algorithmen, Programmiersprachen und Logik

17 Besondere Schwierigkeiten wirft die Abgrenzung von Ausdrucksform und Idee bei Algorithmen, Programmiersprachen und Logik auf, die bereits bei der Definition des Algorithmus beginnen<sup>92</sup>. Während der ursprüngliche Kommissionsvorschlag neben den Ideen und Grundsätzen auch die Logik, die Algorithmen und Programmiersprache, die dem Programm zugrunde liegen, vom Schutz ausnehmen wollte (Art. 1 Abs. 3 des ursprünglichen Kommissionsvorschlags)<sup>93</sup>, beschränkt Art. 1 Abs. 2 Satz 2 des endgültigen Richtlinienartikels die Ausnahme auf die „Ideen und Grundsätze, die irgendeinem Element eines Computerprogramms zugrunde liegen, einschließlich der den Schnittstellen zugrunde liegenden Ideen und Grundsätze“. Explizite Erwähnung finden die Logik, Algorithmen und Programmiersprachen nur noch in Erwägungsgrund 11, dessen zweiter Satz den „Ideen und Grundsätze[n], die der Logik, den Algorithmen und den Programmiersprachen zu-

grunde liegen“, im Rahmen der Richtlinie urheberrechtlichen Schutz versagt. Diese Änderung ist auf das Parlament zurückzuführen<sup>94</sup> und dient lediglich der Kürzung und Vereinfachung, um die urheberrechtliche Grundidee klarer herauszuarbeiten, dass „Urheberrechtsschutz nur für die Ausdrucksform einer Idee oder eines Grundsatzes, nicht aber für die Idee oder den Grundsatz selbst gewährt wird“<sup>95</sup>.

18 Aus Erwägungsgrund 11 lässt unter Berücksichtigung seiner Entstehungsgeschichte ableiten, dass Logik, Algorithmen und Programmiersprachen durch schutzfähige Elemente eines Computerprogramms sein, solange sich dieser Schutz nicht auf die zugrundeliegenden Ideen und Grundsätze erstreckt. Schutz kommt daher auch diesen Elementen zu, soweit ihre konkrete „Art und Weise der Implementierung und Zuordnung zueinander“ in einem Computerprogramm, also ihre „Ausdrucksform“ betroffen ist<sup>96</sup>.

19 Ein darüber hinausgehender Schutz von Algorithmen, Programmiersprachen oder Programmlogik als solcher, also unabhängig von ihrer Einbettung in ein konkretes Programm, dürfte demgegenüber zumindest unter der Richtlinie 2009/24 eher skeptisch zu beurteilen sein<sup>97</sup>. Dies ergibt sich nicht nur aus der Schutzfreiheit von zugrundeliegenden Ideen und Grundsätzen (Erwägungsgrund 11), sondern auch aus der Definition des Computerprogramms, die an den Programmcode und die Steuerungsfunktion anknüpft. Am ehesten erwägen mag man einen Schutz für die Bezeichnung und Auswahl der Schlüsselwörter und Befehle einer Programmiersprache<sup>98</sup>, weil es sich letztendlich um eine Sammlung von Regeln handelt<sup>99</sup>, deren Schutz unter bestimmten Voraussetzungen auch im allgemeinen Urheberrecht möglich ist<sup>100</sup>. Gegen den Schutz als Computerprogramm spricht allerdings, dass diese Regeln nicht zur Lösung einer konkreten Aufgabe geschrieben wurden, sondern als Steuerungsbefehle abhängig von der Gestalt des konkreten Programms zur Lösung einer Vielzahl unterschiedlicher Aufgaben eingesetzt werden können<sup>101</sup>. Zudem stellt sich, wenn man Urheberschutz bejahen will, unmittelbar die Folgefrage, ob nur die Vervielfältigung wesentlicher Teile des Regelwerkes oder bereits die Anwendung der Programmiersprache in einem Programm, das in der betreffenden Sprache geschrieben wurde, eine Rechtsverletzung begründen soll<sup>102</sup>. Es bleibt zu hoffen, dass die Entscheidung der Rechtssache *SAS Institute* in diesen Punkten Klarheit bringt.

## II. Schutzvoraussetzungen

20 Neben der Einbeziehung in den Schutzgegenstand setzt der Schutz der Computerprogrammrichtlinie gemäß Art. 1 Abs. 3 Satz 1 RL 2009/24 weiter voraus, dass die Computerprogramme „individuelle Werke

in dem Sinne darstellen, dass sie das Ergebnis der eigenen geistigen Schöpfung ihres Urhebers sind“. Andere Kriterien, wie etwa qualitative oder ästhetische Vorzüge eines Computerprogramms, sollen demgegenüber nicht als Kriterium für die Beurteilung der Schutzfähigkeit als individuelles Werk herangezogen werden (Art. 1 Abs. 3 Satz 2, Erwägungsgrund 8 RL 2009/24).

- 21 Auch diese Vorschrift der Richtlinie wurde gegenüber dem ursprünglichen Kommissionsvorschlag im Gesetzgebungsverfahren überarbeitet. Insbesondere der Wirtschafts- und Sozialausschuss kritisierte das Fehlen einer europäischen Definition für Individualität, was den Harmonisierungserfolg der Richtlinie in Frage stellen könne<sup>103</sup>. Der Ausschuss schlug eine Klarstellung vor, dass an das Programm weder ästhetische, qualitative oder quantitative Kriterien angelegt noch eine bestimmte Höhe der Programmierkunst verlangt werden dürfen und sich die Prüfung darauf beschränken solle, Programmteile zu schützen, die nicht von anderen Programmen kopiert worden sind<sup>104</sup>. Ein ähnlich niedriges Individualitätserfordernis wurde auch bereits im vorbereitenden Grünbuch<sup>105</sup> und in der Begründung zum ursprünglichen Kommissionsvorschlag<sup>106</sup> in bewusster Abkehr von der restriktiveren früheren deutschen Rechtsprechung<sup>107</sup> befürwortet, so dass Art. 1 Abs. 3 Satz 2 und Erwägungsgrund 8 RL 2009/24 vor allem klarstellende Funktion haben. Das abgesenkte Individualitätserfordernis der Richtlinie orientiert sich somit eher am britischen als am deutschen Vorbild<sup>108</sup>, ist aber als europäischer Begriff autonom von nationalen Begrifflichkeiten auszulegen, was sich nicht zuletzt an bemerkenswerten Parallelen zu den Schutzvoraussetzungen nach der Halbleiterrichtlinie 87/54/EWG zeigt („Ergebnis der eigenen geistigen Arbeit ihres Schöpfers“ in RL 87/54/EWG gegenüber „Ergebnis der eigenen geistigen Schöpfung ihres Urhebers“ in RL 2009/24)<sup>109</sup>. Inzwischen findet sich dieser Begriff auch in Art. 3 Abs. 1 der Richtlinie 96/9 zum Datenbankschutz und Art. 6 Abs. 1 der Richtlinie 2006/116<sup>110</sup> zum Schutz von Fotografien und wurde jüngst vom Gerichtshof sogar in die allgemeinen Urheberrechtsrichtlinie 2001/29 (Art. 2 lit. a RL 2001/29) übertragen<sup>111</sup>.
- 22 Als Folge des niedrigen Individualitätserfordernisses setzt die Richtlinie für die Schutzfähigkeit eines Computerprogramms keine besondere schöpferische Gestaltungshöhe voraus, sondern unterstellt auch die kleine Münze des Programmschaffens dem urheberrechtlichen Schutz<sup>112</sup>. Demgegenüber erscheint es zu weitgehend, jedes nicht kopierte Computerprogramm dem Schutz der Richtlinie unterstellen zu wollen<sup>113</sup>. So ist das Kriterium der Originalität zumindest dann nicht erfüllt, wenn die konkrete Ausdrucksform eines Computerprogramms durch seine technische Funktion vorgegeben ist, weil die verschiedenen Möglichkeiten der Umsetzung einer Idee dann so beschränkt sind, dass Idee und Ausdruck

zusammenfallen und der Urheber seinen schöpferischen Geist nicht in origineller Weise zum Ausdruck bringen kann<sup>114</sup>. Beispiele für einen derart engen Ausdrucksspielraum, bei dem sich Ähnlichkeiten nicht vermeiden lassen, finden sich auch bereits in den Kommissionsmaterialien (z.B. die Implementierung von Schnittstellen oder die Erstellung von Programmen mit sehr ähnlichen Aufgaben, beschränkten Lösungswegen und geringer Komplexität<sup>115</sup>).

- 23 Als weitere Einschränkung auf der Ebene der Individualität lässt sich aus der Rechtsprechung des Gerichtshofs das Erfordernis gewinnen, dass der Programmierer seinen „schöpferischen Geist in origineller Weise zum Ausdruck bringen“ muss, um eine eigene geistige Schöpfung zu kreieren<sup>116</sup>. Diese Einschränkung rechtfertigt es, „einfache[n] und routinemäßige[n] Programmierleistungen, die jeder Programmierer auf dieselbe oder ähnliche Weise erbringen würde“<sup>117</sup>, den Schutz der Richtlinie zu versagen. Demgegenüber schließt der Rückgriff auf Programmbibliotheken die Individualität nicht von vorneherein aus, weil sich die schöpferische Leistung insofern aus der Konzeption der „Beziehungen zwischen objektorientierten Klassen“ und den verwendeten Begrifflichkeiten ergeben kann<sup>118</sup>. Auch bei computergenerierter Software<sup>119</sup> oder „lernenden Algorithmen“, die ihre Erscheinungsform im Zeitablauf ändern, fehlt es nicht an einem „Ausdruck des [menschlichen] schöpferischen Geistes“, solange diesen Prozessen durch menschliche Programmierung angelegte Fähigkeiten zugrunde liegen und das (niedrige) Originalitätskriterium gewahrt bleibt<sup>120</sup>.

## C. Ergänzender Schutz nach allgemeinem Urheberrecht

- 24 Während die Entscheidung in der Rechtssache *BSA* aus Sicht der Computerprogrammrichtlinie keine grundlegenden Neuerungen bringt<sup>121</sup>, finden sich die interessantesten Ausführungen im zweiten Teil der Entscheidung zu der Frage, ob eine graphische Benutzeroberfläche in den Genuss des allgemeinen Urheberrechtsschutzes nach der Richtlinie 2001/29 gelangen kann.

### I. Zulässigkeit des Rückgriffs auf die Richtlinie 2001/29

- 25 Ein derartiger Rückgriff auf die allgemeinen Regeln der Richtlinie 2001/29 ist grundsätzlich gestattet, weil der Vorrang der Computerprogrammrichtlinie (Art. 1 Abs. 2 lit. a RL 2001/29) außerhalb ihres Anwendungsbereichs (Computerprogramme und vorbereitendes Entwurfsmaterial) nicht zum Tragen kommt. Allerdings darf der Rückgriff auf die allgemeinen Bestimmungen nicht dazu führen, dass



die in Art. 1 Abs. 2 Satz 2 RL 2009/24 angeordnete Schutzfreiheit der zugrundeliegenden Ideen und Grundsätze umgangen wird, weil es sich dabei um einen allgemeinen „Urheberrechtsgrundsatz“ handelt (Erwägungsgrund 11 RL 2009/24), der richtlinienübergreifend für das gesamte Europäische Urheberrecht Geltung beansprucht. Ein ergänzender Schutz kommt damit nur in Betracht, soweit der Schutz nach der Richtlinie 2009/24 am Merkmal „Computerprogramm“ (Art. 1 Abs. 1, 2 Satz 1 RL 2009/24) scheitert, nicht jedoch soweit es sich um eine nicht schutzfähige Idee (Art. 1 Abs. 2 Satz 2 RL 2009/24) handelt.

## II. Schutzgegenstand und Schutzvoraussetzungen

### 1. Offener Werkbegriff und Originalitätskriterium

26 Ausgangspunkt für das Verständnis des zweiten Teils der Entscheidung BSA ist die Rechtssache *Infopaq*, in der der Gerichtshof die Harmonisierung des Vervielfältigungsrechts „für die Urheber in Bezug auf ihre Werke“ (Art. 2 lit. a RL 2001/29) zum Anlass nahm, erste Konturen eines europäischen Werkbegriffs zu zeichnen<sup>122</sup>. In *Infopaq* hatte der Gerichtshof aus dem Gesamtzusammenhang der Berner Übereinkunft und den Art. 1 Abs. 3 RL 2009/24, Art. 3 Abs. 1 RL 96/9 und Art. 6 RL 2006/116<sup>123</sup> den allgemeinen Grundsatz abgeleitet, dass „das Urheberrecht im Sinne des Art. 2 Buchst. a der Richtlinie 2001/29 nur in Bezug auf ein Schutzobjekt angewandt werden [kann], bei dem es sich um ein Original in dem Sinne handelt, dass es eine eigene geistige Schöpfung seines Urhebers darstellt“<sup>124</sup>. Diesen Grundsatz übertragen Gerichtshof und Generalanwalt in BSA auf den Schutz graphischer Benutzeroberflächen, so dass graphische Benutzeroberflächen grundsätzlich als eigene geistige Schöpfung des Urhebers geschützt sein können. Damit entwickelt der Gerichtshof einen offenen Werkbegriff für das Europäische Urheberrecht<sup>125</sup> – eine dem deutschen Urheberrecht vertraute (vgl. § 2 Abs. 1 UrhG: „insbesondere“), für das britische Recht indes neue Erkenntnis<sup>126</sup>.

27 Neben dem offenen Werkbegriff bestätigen Gerichtshof und Generalanwalt das „Kriterium der Originalität“<sup>127</sup> als Voraussetzung des Urheberschutzes. Der Schutz graphischer Benutzeroberflächen hänge daher von der Einschätzung des nationalen Gerichts ab, ob „die Anordnung oder spezifische Konfiguration aller Komponenten (...), aus denen sich die grafische Benutzeroberfläche zusammensetzt“, „das Kriterium der Originalität erfüllen“<sup>128</sup>, so dass sie eine „eigene geistige Schöpfung“<sup>129</sup> ihres Urhebers darstellen. Diese Prüfung überlässt der EuGH dem nationalen Gericht<sup>130</sup>. Er gibt allerdings noch den Hin-

weis, dass das Kriterium nicht erfüllt sei, wenn „der Ausdruck [der] Komponenten der Benutzeroberfläche durch ihre technische Funktion vorgegeben ist, denn [dann] sind die verschiedenen Möglichkeiten der Umsetzung einer Idee so beschränkt, dass Idee und Ausdruck zusammenfallen“, so dass es dem Urheber nicht mehr möglich sei, „seinen schöpferischen Geist in origineller Weise zum Ausdruck zu bringen und zu einem Ergebnis zu gelangen, das eine eigene geistige Schöpfung dieses Urhebers darstellt“<sup>131</sup> (zu dieser europäischen „Merger“-Doktrin bereits oben B. I. 3. a.).

### 2. Konsequenzen

28 Auch wenn der EuGH in BSA den Trend zur Europäisierung des Werkbegriffs aus *Infopaq* fortschreibt<sup>132</sup>, ist durch diese Entscheidung nach wie vor nicht endgültig geklärt, welche Anforderungen das europäische Recht an das Kriterium der Originalität stellt. Die Herleitung aus den niedrigen Schutzvoraussetzungen für Computerprogramme, Datenbanken und Fotografien<sup>133</sup> und der in *Infopaq* postulierte „weitreichende“ Schutz nach Art. 2 RL 2001/29<sup>134</sup> deuten auf eine eher niedrige Hürde für die „eigene geistige Schöpfung“ hin. Andererseits sprechen die in BSA entwickelte Ausnahme von technisch bedingten Gestaltungen und das Erfordernis, den „schöpferischen Geist in origineller Weise zum Ausdruck zu bringen“<sup>135</sup> gegen eine allzu kleine Münze, zumal für Benutzeroberflächen der Urheberschutz in BSA durch das Erfordernis der Übernahme der Interaktionsfunktion als wesentliches, die Schöpfungshöhe begründendes Werkelement eine zusätzliche Einschränkung erfährt (dazu sogleich C. III.). Solange sich deutsche Gerichte vor einer Rückkehr zum Erfordernis eines hohen Maßes eigenschöpferischer Formgestaltung hüten, was beim Schutz für Darstellungen wissenschaftlicher und technischer Art (§ 2 Abs. 1 Nr. 7 UrhG) ohnehin nicht der Rechtsprechung entspricht<sup>136</sup>, sollte es daher gestattet bleiben, zumindest eine „individuelle, sich vom alltäglichen Schaffen abhebende Geistestätigkeit in dem darstellerischen Gedanken“ auch für den Schutz graphischer Benutzeroberflächen zu verlangen<sup>137</sup>, zumal der Gerichtshof die Konkretisierung des Originalitätserfordernisses im Einzelfall den nationalen Gerichten überlässt<sup>138</sup>. Bereits diese Hürde hat sich in der Vergangenheit als so hoch erwiesen, dass in den letzten 15 Jahren kein deutsches Gericht einer Benutzeroberfläche Urheberschutz zugebilligt hat<sup>139</sup>, während in England und Österreich<sup>140</sup> durchaus Urheberschutz gewährt wurde<sup>141</sup>. Dies zeigt sehr anschaulich die begrenzte Harmonisierungswirkung durch Richtlinien, die nationalen Gerichten einen erheblichen Einschätzungsspielraum auf tatsächlicher Ebene belassen<sup>142</sup>.

29 Ebenso wie graphische Benutzeroberflächen fallen auch Bedienungsanleitungen oder Wartungshand-

bücher für Computerprogramme, solange dort nicht wesentliche Teile des Programms selbst wiedergegeben werden, nicht unter den Schutz der Richtlinie 2009/24<sup>143</sup>. Auch für solche Werke ist ein Urheberrechtsschutz aufgrund der Richtlinie 2001/29 als Sprachwerk (§ 2 Abs. 1 Nr. 1 UrhG) oder als wissenschaftlich-technische Darstellung (§ 2 Abs. 1 Nr. 7 UrhG) möglich<sup>144</sup>, zudem kommt für begleitende Lichtbilder ein Schutz nach Art. 6 RL 2006/116 (§ 2 Abs. 1 Nr. 5 UrhG) in Betracht. Die moderaten Anforderungen der deutschen Rechtsprechung für den Schutz wissenschaftlich-technischer Darstellungen<sup>145</sup> und für den Schutz von Lichtbildern<sup>146</sup> erscheinen mit dem durch Art. 6 RL 2006/116 und die Rechtssache *Infopaq* abgesenkten Originalitätskriterium vereinbar. Unzulässig dürfte es allerdings sein, bei den sprachlichen Teilen der Bedienungsanleitung als einem zu Gebrauchszwecken dienendem Schriftwerk ein „deutliches Übertreten des Alltäglichen, des Handwerksmäßigen, der mechanisch-technischen Aneinanderreihung des Materials“ zu verlangen<sup>147</sup>. Denn gerade diesem Kriterium, das sich auch in der früheren deutschen Rechtsprechung zum Schutz von Computerprogrammen antreffen ließ<sup>148</sup>, wollte der Richtlinienggeber mit der Absenkung der Schutzvoraussetzungen in der Richtlinie 2009/24 entgegenwirken<sup>149</sup>. Da dieser Maßstab vom Gerichtshof in der Rechtssache *Infopaq* auf die Richtlinie 2001/29 erstreckt wurde, erscheint es nicht mehr zulässig, ihn für den Schutz von Sprachwerken beizubehalten<sup>150</sup>. Als mögliches Gegengewicht im Interesse der Gemeinfreiheit ist allerdings der Ausschluss technisch bedingter Gestaltungen zu berücksichtigen, der bei Sprachwerken in eine Schutzfreiheit der durch die Funktion bedingten Gestaltungselemente zu übersetzen ist.

- 30 Ein weiteres Beispiel für die ergänzende Anwendung von allgemeinem Urheberrecht ist der Schutz von Computerspielen, bei denen neben dem Programmschutz für die spielsteuernde Software ein begleitender Schutz für die audiovisuellen Programmelemente als Filmwerk (§ 2 Abs. 1 Nr. 6 UrhG) in Betracht kommt<sup>151</sup>. Die Absenkung des Schutzstandards durch *Infopaq* dürfte auch hier keine Umwälzungen erfordern, da sich bereits heute die deutsche Rechtsprechung bei Filmwerken mit der „kleinen Münze“ begnügt<sup>152</sup>. Gewisse Schwierigkeiten könnte die durch BSA bestätigte Trennung von Steuerungsprogramm (Schutz nach der Computerprogrammrichtlinie) und audiovisueller Darstellung (Schutz nach Richtlinie 2001/29) allerdings für den Vorschlag bereiten, angesichts der engen Verknüpfung beider Elemente bei modernen Computerspielen eine Schwerpunktbeurteilung zugunsten des Computerprogrammschutzes vorzunehmen<sup>153</sup>. Auf der anderen Seite ist nicht zu verkennen, dass der EuGH trotz formaler Trennung beider Schutzsysteme bei der Auslegung des Vervielfältigungsrechts in BSA auf die „Interaktionsfunktion“ der Benutzeroberfläche zurückgegriffen hat (dazu sogleich C. III.), was eine Annäherung zu

mindest in den Ergebnissen andeuten könnte. Weitere in der Rechtsprechung erwogene Beispiele für einen begleitenden Urheberschutz sind eine optimierte sprachliche Gestaltung zur leichteren Auffindbarkeit einer Internetseite<sup>154</sup> oder der Schutz von Computergraphiken<sup>155</sup>. Soweit für letztere der Schutz nach § 2 Abs. 1 Nr. 4 UrhG unter Hinweis auf die erhöhten Anforderungen im Bereich der „Gebrauchskunst“ versagt wurde<sup>156</sup>, dürfte auch diese Rechtsprechung nach *Infopaq* auf das Erfordernis einer eigenen geistigen Schöpfung zurückzuführen sein<sup>157</sup>, wobei es zulässig und geboten bleibt, technisch bedingten Gestaltungen den Urheberschutz zu versagen.

### III. Schutzgegenstand und öffentliche Wiedergabe

- 31 Nachdem der EuGH also die Schutzfähigkeit grafischer Benutzeroberflächen nach Art. 2 lit. a RL 2001/29 grundsätzlich bejaht hat, schließt sich der wohl interessanteste Teil der Entscheidung an. Das nationale Gericht hatte den Gerichtshof nämlich außerdem gefragt, ob die Fernsehausstrahlung einer graphischen Benutzeroberfläche eine öffentliche Wiedergabe eines urheberrechtlich geschützten Werkes i.S.d. Art. 3 Abs. 1 RL 2001/29 darstellt. In seiner Antwort bekräftigt der EuGH zunächst, dass der Begriff der öffentlichen Wiedergabe weit zu verstehen sei und insbesondere auch die Fernsehausstrahlung eines Werkes erfasse. Dennoch verneinte er im konkreten Fall die öffentliche Wiedergabe:

„Wenn jedoch im Rahmen einer Fernsehsendung eine grafische Benutzeroberfläche angezeigt wird, wird diese Oberfläche den Fernsehzuschauern nur passiv wiedergegeben, ohne dass sie die Möglichkeit zum Tätigwerden haben. Sie können die Funktion dieser Benutzeroberfläche nicht nutzen, die darin besteht, eine Interaktion zwischen dem Computerprogramm und dem Benutzer zu ermöglichen. Da die grafische Benutzeroberfläche durch die Fernsehausstrahlung nicht der Öffentlichkeit in dem Sinne zur Verfügung gestellt wird, dass die Personen, aus denen sich diese zusammensetzt, Zugang zu dem wesentlichen Merkmal der Schnittstelle haben, nämlich der Interaktion mit dem Benutzer, erfolgt keine öffentliche Wiedergabe der grafischen Benutzeroberfläche im Sinne von Art. 3 Abs. 1 der Richtlinie 2001/29“<sup>158</sup>.

- 32 Es bietet sich erneut an, diese Ausführungen mit den Grundsätzen aus *Infopaq* in Verbindung zu setzen, wo der Gerichtshof die Frage einer Rechtsverletzung an die Voraussetzung geknüpft hat, dass die übernommenen Werkteile „die eigene geistige Schöpfung ihres Urhebers zum Ausdruck bringen“<sup>159</sup>. Die Entscheidung BSA lässt sich nun in zwei Richtungen deuten<sup>160</sup>. Zum einen könnte man sie als konsequente

Fortschreibung von *Infopaq* verstehen: Wenn sich bei einer graphischen Benutzeroberfläche die Schöpfungshöhe und damit die eigene geistige Schöpfung *allein* aus der Art und Weise der Kommunikation mit dem Benutzer ergibt<sup>161</sup>, dann ist es durchaus konsequent, eine Rechtsverletzung zu verneinen, wenn gerade auf die Wiedergabe dieses wesentlichen (den Urheberschutz begründenden) Elements verzichtet wird. Wenn man allerdings über die Art und Weise der Kommunikation hinaus auch anderen Elementen einer Benutzeroberfläche nicht grundsätzlich den Schutz versagen will (z.B. dem Design), dann könnte man die Entscheidung *BSA* auch so verstehen, dass die Rechtsverletzung neben der Übernahme der „eigenen geistigen Schöpfung“ zudem die Übernahme „wesentlicher Merkmal(e)“<sup>162</sup> des Ausgangswerkes voraussetzt<sup>163</sup>. Konsequenzen hätte dies vor allem für solche Fälle, in denen eine Vervielfältigung allein als technischer Zwischenschritt notwendig ist oder in denen ein Werk nur als Resultat einer Internetsuche oder im Hintergrund eines Films wiedergegeben wird<sup>164</sup>.

- 33 Auch wenn ein solches Wesentlichkeitserfordernis durchaus manche Schwächen des geltenden Schrankenkatalogs abfedern könnte, so wäre seine Handhabung nicht nur der Rechtssicherheit im europäischen Rechtsraum abträglich, sondern dürfte auch einen Konflikt mit der grundsätzlich weiten Auslegung des Begriffs der Vervielfältigung und öffentlichen Wiedergabe heraufbeschwören (vgl. Art. 2 RL 2001/29: „unmittelbare oder mittelbare, vorübergehende oder dauerhafte“, Erwägungsgründe 21, 23 RL 2001/29). *BSA* dürfte daher eher als Fortschreibung von *Infopaq* aufzufassen sein, allerdings mit der wichtigen Präzisierung, dass die Übernahme der „eigenen geistigen Schöpfung“ des Ausgangswerkes dann besonders kritisch zu prüfen und häufig zu verneinen sein wird, wenn die „Funktion“<sup>165</sup>, die „besondere Natur“<sup>166</sup>, der „ursprüngliche Charakter“<sup>167</sup> oder andere „wesentliche Merkmale“<sup>168</sup> des Ausgangswerkes (hier die Interaktion mit dem Computer) im Rahmen der Verwertungshandlung nicht übernommen werden. In der Erweiterung des Blickwinkels auf die Funktion, den Charakter und andere das Ausgangswerk wesentlich prägende Elemente könnte der größte Beitrag von *BSA* zur Fortentwicklung des Europäischen Urheberrechts liegen. Ein derart auch funktionales Verständnis ist dem Urheberrecht bisher zwar weitgehend fremd<sup>169</sup>, es könnte aber durchaus das Potential besitzen, auf der Ebene der Verwertungshandlungen manch überbordenden Urheberschutz zurückzunehmen, dem die Rechtsprechung bisher mit Hilfskonstruktionen wie der Einwilligung oder Gestattung des Rechteinhabers zu begegnen sucht<sup>170</sup>. Auch droht durch diese Elemente keine Erweiterung des Urheberschutzes, weil sie nur begrenzend wirken, nicht aber den Urheberschutz über die konkrete Ausdrucksform des Werkes hinaus auch auf Funktionalitäten oder gar zugrundeliegende Ideen zu erweitern suchen.

- 34 Speziell für den Schutz von graphischen Benutzeroberflächen bedeutet die Einschränkung des Begriffs der öffentlichen Wiedergabe, dass letztendlich auch im allgemeinen Urheberrecht ähnlich wie beim Computerprogrammenschutz das Recht nur bei Betroffenheit der „Steuerungsfunktion“ zum Tragen kommt, nur dass sich diese Steuerungsfunktion nicht auf die Steuerung einer Maschine, sondern auf die Interaktion mit dem Nutzer bezieht. In der Sache hat der Gerichtshof damit den Computerprogrammenschutz samt seinen Schutzvoraussetzungen<sup>171</sup> und Begrenzungen<sup>172</sup> in gewisser Weise in das allgemeine Urheberrecht verlängert. Die Konsequenzen dieses Schlusses vom Besonderen (Computerprogramme, Datenbanken, Photographien) auf das Allgemeine sind nach wie vor nicht ausgelotet und dürften die Europäische Urheberrechtswissenschaft auch in den kommenden Jahren weiter in Atem halten.

## D. Zusammenfassung

Die Entscheidung *BSA* bestätigt in ihrem ersten Teil im Wesentlichen die in den Gesetzgebungsmaterialien angelegte und in Rechtsprechung und Literatur weit verbreitete Definition des Computerprogramms anhand von Programmcode und Steuerungsfunktion. Gleiches gilt für die Versagung des Schutzes der Computerprogrammrichtlinie für graphische Benutzeroberflächen und der Trennung zwischen Programmenschutz (Steuerungssoftware) und audiovisueller Darstellung (allgemeines Urheberrecht). Deshalb konnte sich der Gerichtshof – angesichts der anhängigen Rechtssache *SAS Institute* wohl nur vorläufig – eine Stellungnahme zum Schutz von Programmstrukturen und zur Abgrenzung der Ausdrucksform von der schutzrechtsfreien Idee ersparen. Die eigentliche Bedeutung der Entscheidung *BSA* liegt deshalb nicht in den Ausführungen zur Computerprogrammrichtlinie, sondern im zweiten Teil der Entscheidung, der sich mit dem allgemeinen Urheberrechtsschutz graphischer Benutzeroberflächen nach der Richtlinie 2001/29 befasst. Dort schreibt der EuGH nicht nur den Trend zur Europäisierung des Werkbegriffs („eigene geistige Schöpfung des Urhebers“) aus *Infopaq* fort, sondern entwickelt mit der Schutz Ausnahme für technisch bedingte Gestaltungen und dem offenen Katalog der Werkarten weitere Kriterien für eine europäisch-autonome Überformung dieses Begriffs. Besonders überraschend sind dabei die Einschränkungen des Begriffs der öffentlichen Wiedergabe, die der Gerichtshof unter Hinweis auf die fehlende Übernahme der wesentlichen Funktion der Benutzeroberfläche, eine Interaktion mit dem Benutzer zu ermöglichen, im konkreten Fall verneint. *BSA* schreibt damit nicht nur den Trend aus *Infopaq* zur Annäherung der Schutzstandards im allgemeinen (RL 2001/29) und besonderen Urheberrecht (RL 2009/24) fort, sondern zeigt mit der Einschränkung für technisch bedingte Gestaltungen

gen und dem „funktionalen“ Verständnis der öffentlichen Wiedergabe eine größere Sensibilität für die Gemeinfreiheit als noch in *Infopaq* erkennbar war. Speziell für den Schutz computerbasierter audiovisueller Werke dürften die Annäherung der Schutzvoraussetzungen und das „funktionale“ Verständnis der Verwertungshandlungen trotz formaler Trennung von Computerprogrammenschutz und allgemeiner Urheberrechtsschutz zu einer Annäherung zumindest in den Ergebnissen führen, die angesichts der engen Verknüpfung von Steuerungsprogramm und audiovisueller Darstellung in moderner Unterhaltungssoftware auch sinnvoll erscheint.



- 1 Eine dritte laufende Vorlage betrifft nicht den Schutzgegenstand, BGH GRUR 2011, 418 – UsedSoft.
- 2 Richtlinie 91/250/EWG des Rates vom 14. Mai 1991 über den Rechtsschutz von Computerprogrammen, ABL.L 122 vom 17.5.1991, S. 42.
- 3 Richtlinie 2009/24/EG des Europäischen Parlaments und des Rates vom 23. April 2009 über den Rechtsschutz von Computerprogrammen (kodifizierte Fassung), ABL.L 111 vom 5.5.2009, S. 16.
- 4 EuGH 22.12.2010, Rs. C-393/09, *Bepečnostní softwarová asociace (BSA)*, GRUR 2011, 220.
- 5 ABL.C 346 vom 18.12.2010, S. 27; *SAS Institute v. World Programming* [2010] EWHC 1829 (Ch).
- 6 Die Begriffe Software und Computerprogramm werden im Urheberrecht nicht als Synonyme verstanden, weil zur Software auch Begleitmaterial und Programmbeschreibungen zählen, die nicht unter den Begriff des Computerprogramms fallen, *Marly*, Praxishandbuch Softwarerecht, 5. Auflage 2009, Rn. 78. Im Unterschied zu Software kann ein Computerprogramm auch fest in der Hardware verankert sein.
- 7 Richtlinie 2001/29/EG des Europäischen Parlaments und des Rates vom 22. Mai 2001 zur Harmonisierung bestimmter Aspekte des Urheberrechts und der verwandten Schutzrechte in der Informationsgesellschaft, ABL.L 167 vom 22.6.2001, S. 10.
- 8 Richtlinie 96/9/EG des Europäischen Parlaments und des Rates vom 11. März 1996 über den rechtlichen Schutz von Datenbanken, ABL.L 77 vom 27.3.1996, S. 20.
- 9 Zu dieser Entwicklung *Arckens* 38 (1986) Fed. Comm. L.J. 283, 283 m.w.N.
- 10 Dies war auch Beweggrund des Vorschlags der Kommission für eine Richtlinie des Rates über den Rechtsschutz von Computerprogrammen, KOM(88) 816 endg., ABL.C 91 vom 12.4.1989, S. 4, S. 5 Tz. 1.3.
- 11 Siehe Green Paper on Copyright and the Challenge of Technology – Copyright Issues Requiring Immediate Action, COM(88) 172 final, S. 175, Tz. 5.3.1, S. 179, Tz. 5.3.11.
- 12 Siehe *Industrial Property* 1977, 259 (Copyright 1978, 6), deutsche Übersetzung in GRUR Int. 1978, 286. Die Mehrheit der Delegationen in der WIPO sprach sich später für die Aufgabe dieses Standpunkts aus, siehe Report of the Committee of Experts on the Legal Protection of Computer Software, Geneva, June 1983, LPCS/11/6; Executive Committee of the International Union for the Protection of Literary and Artistic Works (Berne Union), Copyright Aspects of the Protection of Computer Software, Paris, April 15, 1985, [http://www.wipo.int/mdocsarchives/B\\_EC\\_XXIV\\_85/B\\_EC\\_XXIV\\_8%20\\_IGC%20\\_1971\\_VI\\_9\\_E.pdf](http://www.wipo.int/mdocsarchives/B_EC_XXIV_85/B_EC_XXIV_8%20_IGC%20_1971_VI_9_E.pdf), S. 3, Tz. 17.
- 13 Für einen Überblick über den Urheberschutz von Computerprogrammen Mitte der 1980er Jahre *Arckens* 38 (1986) Fed. Comm. L.J. 283, 287 ff., mit Résumé auf S. 299: „Many countries already consider computer software to be a work of authorship protected by copyright law, and a growing number of countries have enacted legislation providing explicitly for the protection of software under their copyright laws“. Zur Rechtsprechung zum Urheberschutz von Computerprogrammen aus den frühen 1980er Jahren siehe auch Green Paper (Fn. 11), COM(88) 172 final, S. 178, Tz. 5.3.9, S. 202 Fn. 9; siehe auch *Le Stanc*, in: *Droit et Technique – Etudes à la mémoire du Professeur Xavier Linant de Bellefonds*, 2007, S. 271, 273 ff.
- 14 Zuvor bereits Mitteilung der Kommission: Initiativen zum Grünbuch – Arbeitsprogramm der Kommission auf dem Gebiet des Urheberrechts und der verwandten Schutzrechte, KOM(90) 584 endg., Tz. 5.2.2, S. 16. Zur Rezeption US-amerikanischer Entwicklungen durch das europäische Recht *Derclaye* [2000] EIPR 7, 56.
- 15 Übereinkommen über handelsbezogene Aspekte der Rechte des geistigen Eigentums, für die Union genehmigt durch Beschluss 94/800/EG des Rates vom 22. Dezember 1994 über den Abschluß der Übereinkünfte im Rahmen der multilateralen Verhandlungen der Uruguay-Runde (1986 - 1994) im Namen der Europäischen Gemeinschaft in bezug auf die in ihre Zuständigkeiten fallenden Bereiche, ABL.L 336 vom 23.12.1994, S. 1.
- 16 Urheberrechtsvertrag der Weltorganisation für geistiges Eigentum (WIPO), für die Union genehmigt durch Beschluss 2000/278/EG des Rates vom 16. März 2000 über die Zustimmung - im Namen der Europäischen Gemeinschaft - zum WIPO-Urheberrechtsvertrag und zum WIPO-Vertrag über Darbietungen und Tonträger, ABL.L 89 vom 11.4.2000, S. 6.
- 17 Schutz im Sinne der Berner Übereinkunft bedeutet, dass die Schutzstandards in Art. 5 ff. dieser Übereinkunft für den Urheberschutz zu wahren sind, siehe auch Art. 10 Abs. 1 TRIPS und Art. 4 WCT, *Bently*, in: Dreier/Hugenholz, *Concise European Copyright Law*, 2006, Computer Programs Dir., Art. 1, S. 216. Der Kommission kam es offenbar vor allem auf den Grundsatz der Inländerbehandlung an, KOM(88) 816 endg. (Fn. 10), S. 8, Tz. 4. Ferner dient der Hinweis der Klarstellung, dass Computerprogramme „eindeutig in den Anwendungsbereich dieser internationalen Konvention fallen“, Mitteilung der Kommission an das Europäische Parlament – Betr. Gemeinsamer Standpunkt des Rates zum Vorschlag für eine Richtlinie über den Rechtsschutz von Computerprogrammen, GRUR Int. 1991, 545, 550 Tz. 4.3.
- 18 KOM(88) 816 endg. (Fn. 10), S. 9. Dieser Standpunkt wurde im Commission Staff Working Paper on the review of the EC legal framework in the field of copyright and related rights, SEC(2004) 995, S. 8 bestätigt: „Taking into account the abovementioned risk that a definition might not keep up with the technology and the fact that no difficulties seem to exist in practice, there would not be any added value to inserting a definition of computer program in the Directive“. Siehe auch *Moon* [2009] EIPR 396 zum Einordnung der Computerprogramme in das Vermögensrecht des common law.
- 19 EuGH (Fn. 4), Rs. C-393/09, *BSA*, Rn. 30.
- 20 KOM(88) 816 endg. (Fn. 10), S. 9.
- 21 EuGH (Fn. 4), Rs. C-393/09, *BSA*, Rn. 31-33; KOM(88) 816 endg. (Fn. 10), S. 9.
- 22 EuGH (Fn. 4), Rs. C-393/09, *BSA*, Rn. 34.
- 23 EuGH (Fn. 4), Rs. C-393/09, *BSA*, Rn. 35.
- 24 EuGH (Fn. 4), Rs. C-393/09, *BSA*, Rn. 36 f. Die ausdrückliche Einbeziehung des Entwurfsmaterials in Art. 1 Abs. 1 Satz 2 RL 2009/24 geht auf eine Änderungsanregung des Europäischen Parlaments zurück, siehe Art. 1 Abs. 2a Satz 2 des vom Parlament geänderten Richtlinien vorschlags, ABL.C 231 vom 17.9.90, S. 78. Allerdings wollte das Parlament auch die technische Dokumentation und die Bedienungsanleitungen in den Programmschutz einbeziehen, was die Kommission und der

- Rat unter Hinweis auf deren „eigenständigen Schutz nach der Berner Übereinkunft zum Schutz von Werken der Literatur und Kunst“ zurückwiesen, siehe Gemeinsamer Standpunkt des Rates vom 13. Dezember 1990 im Hinblick auf die Genehmigung einer Richtlinie für den Rechtsschutz von Computerprogrammen, GRUR Int. 1991, 545, 548. Als Beispiele für vorbereitendes Material und Entwurfsmaterial nennt der ursprüngliche Richtlinienentwurf KOM(88) 816 endg. (Fn. 10), S. 9 „Ablaufdiagramme oder Beschreibungen von Schrittfolgen in Klarschrift“; die Schlussanträge des Generalanwalts Bot vom 14.10.2010, Rs. C-393/09, *Bezpečnostní softwarová asociace (BSA)*, Rn. 63 ergänzen „eine Struktur oder ein Flussdiagramm“.
- 25 Schlussanträge (Fn. 24), Rs. C-393/09, BSA, Rn. 61.
- 26 EuGH (Fn. 4), Rs. C-393/09, BSA, Rn. 38.
- 27 Schlussanträge (Fn. 24), Rs. C-393/09, BSA, Rn. 47 f, 60 f. Nach dem Kommissionsvorschlag umfasst der Begriff „Computerprogramm“ „das in jeder Form, Sprache und Notation oder in jedem Code gewählte Ausdrucksmittel für eine Folge von Befehlen, die dazu dient, einen Computer zur Ausführung einer bestimmten Aufgabe oder Funktion zu veranlassen“, KOM(88) 816 endg. (Fn. 10), S. 9. Siehe auch bereits die Definition im Green Paper (Fn. 11), COM(88) 172 final, S. 170, Tz. 5.1.1: „A computer program is a set of instructions the purpose of which is to cause an information processing device, a computer, to perform its functions“. Eine ausdrückliche Definition hatte auch das Europäische Parlament in Art. 1 Abs. 2a seiner geänderten Fassung des Richtlinienentwurfs vorgeschlagen, ABl. C 231 vom 17.9.90, S. 78: „Im Sinne dieser Richtlinie versteht man unter Computerprogramm jede Abfolge von Befehlen, die direkt oder indirekt in einem Computersystem verwendet werden, um eine Funktion zu realisieren oder um ein bestimmtes Ergebnis zu erzielen, unabhängig von seiner Ausdrucksform“. Verwiesen wird häufig auch auf die Definition in § 1(i) der WIPO Mustervorschriften, in deutscher Übersetzung abgedruckt in GRUR Int. 1978, 286, 290: „'Computerprogramm' eine Folge von Befehlen, die nach Aufnahme in einen maschinenlesbaren Träger fähig sind zu bewirken, daß eine Maschine mit informationsverarbeitenden Fähigkeiten eine bestimmte Funktion oder Aufgabe oder ein bestimmtes Ergebnis anzeigt, ausführt oder erzielt“.
- 28 *Marly*, GRUR 2011, 204, 207. Zum entsprechenden Verständnis des § 69a UrhG bereits *Hoeren*, in: Möhring/Nicolini, Urheberrechtsgesetz, 2. Auflage 2000, § 69a Rn. 2; *Haberstumpf*, in: Mestmäcker/Schulze, Kommentar zum deutschen Urheberrecht, Band 1.2, Stand 2003, § 69a Rn. 2 f.; *Czychowski*, in: Fromm/Nordemann, Urheberrecht, 10. Auflage 2008, § 69a Rn. 5; *Dreier*, in: Dreier/Schulze, Urheberrechtsgesetz, 3. Aufl. 2008, § 69a Rn. 12; *Grützmacher*, in: Wandtke/Bullinger, Praxiskommentar zum Urheberrecht, 3. Aufl. 2009, § 69a Rn. 3; *Marly* (Fn. 6), Rn. 77; *Loewenheim*, in: Schrickler/Loewenheim, Urheberrecht, 4. Auflage 2010, § 69a Rn. 2; *Wiebe*, in: Spindler/Schuster, Recht der elektronischen Medien, 2. Auflage 2011, § 69a UrhG Rn. 3; zu Art. 1 RL 2009/24 *Blocher/Walter*, in: Walter, Europäisches Urheberrecht, 2001, Art. 1 Software-RL Rn. 20; *de Miguel Asensio*, Derecho Privado de Internet, 4. Auflage 2010, Rn. 570. Zur Debatte in den USA auch bereits *Apple Computer Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1253 (3d Cir. 1983). Für einen Schutz des „Computer Program Behavior“ („user interface, user interaction, ensemble of functions“) aber noch *Carleton 10* (1995) *Berkeley Technology Law Journal* 405.
- 29 Zur Erstreckung des Schutzes auf die individuelle Programmstruktur und Programmkonzeption sogleich B. I. 2.
- 30 OLG Düsseldorf ZUM-RD 2009, 182, 186; *Dreier/Schulze* (Fn. 28), § 69a UrhG Rn. 21; zum alten Recht BGH GRUR 1991, 449, 453 – Betriebssystem.
- 31 Zum Schutz von Programmteilen Art. 4 lit. a RL 2009/24: „Vielfältigung, ganz oder teilweise“; siehe auch KOM(88) 816 endg. (Fn. 10), S. 9: „Der Computerprogrammen gewährte Schutz erstreckt sich infolgedessen auf das Programm als Ganzes und auf seine Bestandteile, soweit diese ein genügendes Maß an schöpferischer Tätigkeit aufweisen, um selber als ‚Werke‘ bezeichnet werden zu können“.
- 32 Schlussanträge (Fn. 24), Rs. C-393/09, BSA, Rn. 60; BGH GRUR 1991, 449, 452 – Betriebssystem: „Sammlung, Auswahl und Gliederung der Befehle“; OLG Rostock GRUR-RR 2008, 1, 1: „Folge von Befehlen ...“, die zur Kontrolle bzw. Steuerung des Programmablaufs benutzt werden“; *Marly* (Fn. 6), Rn. 86: „prägende Programmstrukturen“; *Wandtke/Bullinger/Grützmacher* (Fn. 28), § 69a Rn. 24: „konkrete Befehlsfolge und -auswahl“. Zum allgemeinen Urheberrecht auch EuGH 16.7.2009, Rs. C-5/08, *Infopaq*, Slg. 2009, I-6569, Rn. 45: Ausdruck des schöpferischen Geists durch „Auswahl, Anordnung und Kombination“ von Wörtern.
- 33 Zur Maßgeblichkeit der Textelemente des Computerprogramms Schlussanträge (Fn. 24), Rs. C-393/09, BSA, Rn. 49: „Die Kommission stellt hier letztlich auf die Textelemente ab, die die Grundlage des Computerprogramms bilden, d.h. den Quell- und den Objektcode“; Rn. 50: „Diese Codes stellen die Schrift des Computerprogramms ... dar. Sie sind Ausdruck der Ideen des Programmierers und kommen insoweit ohne Zweifel in den Genuss des durch die Richtlinie 91/250 gewährten urheberrechtlichen Schutzes“; deutlich auch *Marly*, GRUR 2011, 204, 207: „letztlich allein der Programmcode“.
- 34 Zum letzten Definitionselement Schlussanträge (Fn. 24), Rs. C-393/09, BSA, Rn. 64.
- 35 OLG Düsseldorf MMR 1999, 602, 602 (Computerspielstände); OLG Hamburg NJW-RR 1999, 483, 484 (Spielstände ohne Programmbeefehle). Zu weiteren Beispielen für eine Trennung zwischen Steuerungsprogramm und audiovisueller Darstellung bzw. bloßen Ergebnissen der Datenverarbeitung *Wandtke/Bullinger/Grützmacher* (Fn. 28), § 69a Rn. 18, 21 (Internetseiten ohne Steuerbefehle, Multimediaerzeugnisse).
- 36 *Nova Productions Ltd v Mazooma Games Ltd* [2007] EWCA Civ 219, Rn. 51; *Cass. civ. 13.12.2005, 2005 1 N° 499-420 – Madame Cuadros et a. c. Société Microsoft France et a., pourvoi n°03-21.154*; *SAS Institute v. World Programming* [2010] EWHC 1829 (Ch), Rn. 228 ff., insbesondere Rn. 236; *de Miguel Asensio* (Fn. 28), Rn. 570. Zu dieser Frage wird sich der EuGH in der Rs. C-406/10 in Vorlagefragen 1 und 2 äußern müssen. Zum fehlenden Schutz der Funktionalität auch KG CR 2010, 424, 425 unter Hinweis auf *Dreier/Schulze* (Fn. 28), § 69a Rn. 2.
- 37 Schutz als Computerprogramm verneinend OLG Karlsruhe GRUR-RR 2010, 234, 235 – Reisebürosoftware; *Navitaire Inc v Easyjet Airline Company* [2004] EWHC 1725 (Ch), Rn. 97 f.; *Schack*, MMR 2001, 9, 12; *Schricker/Loewenheim* (Fn. 28), § 69a Rn. 7; *Wandtke/Bullinger/Grützmacher* (Fn. 28), § 69a Rn. 14; *Spindler/Schuster/Wiebe* (Fn. 28), § 69a UrhG Rn. 10; a.A. noch OLG Karlsruhe GRUR 1994, 726, 729 – Bildschirmmasken; *Möhring/Nicolini/Hoeren* (Fn. 28), § 69a Rn. 6; wohl nur obiter KG CR 2010, 424, 425.
- 38 EuGH (Fn. 4), Rs. C-393/09, BSA, Rn. 40-42; Schlussanträge (Fn. 24), Rs. C-393/09, BSA, Rn. 64 f.
- 39 Schlussanträge (Fn. 24), Rs. C-393/09, BSA, Rn. 65.
- 40 *Griffiths*, ECJ decision in Czech GUI case could pose questions for UK copyright law, <http://ipandit.practicallaw.com/6-504-8145>, Analysis a (letzter Abruf 2.5.2011).
- 41 Vorgeschlagen etwa von *Karl*, Der urheberrechtliche Schutzbereich von Computerprogrammen, 2009, S. 196, 199; siehe jüngst auch *Hoeren*, GRUR-RR 2010, 238, 239.
- 42 EuGH (Fn. 4), Rs. C-393/09, BSA, Rn. 57.
- 43 *Poll/Brauneck*, GRUR 2001, 389, 390; *Katko/Maier*, MMR 2009, 306, 307; *Spindler*, K&R 2009, 521, 522; zum britischen Recht *Nova Productions Ltd v Mazooma Games Ltd* [2007] EWCA Civ 219, Rn. 51 f. (Schutz im Ergebnis verneint, da bloße Funktionalität betroffen); dazu *Silver/Lee* [2007] EIPR 251; zum japa-

- nischen Recht japanischer Oberster Gerichtshof 25.4. 2002, [2002] EIPR N-147 – KK Kapukon v KK Akuto.
- 44 Zur Kritik *Kreutzer*, CR 2007, 1, 4 ff.; siehe auch *Bullinger/Czychowski*, GRUR 2011, 19, 26.
- 45 *Marly* (Fn. 6), Rn. 87; *ders.*, GRUR 2011, 204, 208. *Wandtke/Bullinger/Grützmaker* (Fn. 28), § 69a Rn. 31; *Schricker/Loewenheim* (Fn. 28), § 69a Rn. 13; a.A. etwa *SAS Institute v. World Programming* [2010] EWHC 1829 (Ch), Rn. 226. Auch im ursprünglichen Richtlinienvorschlag KOM(88) 816 endg. (Fn. 10), S. 8, Tz. 3.12 finden sich Hinweise, dass die Ausdrucksweise einer Schnittstelle (also der Programmcode) geschützt sein kann, vgl. „darf sich ihre Ausdrucksweise keineswegs mit der anderer geschützter Programme gleichen“. Siehe allerdings auch den Hinweis in Tz. 3.12, dass trotz Ähnlichkeiten im Code eine Urheberrechtsverletzung normalerweise nicht vorliegen wird, da sich gewisse Ausdrucksformen nicht vermeiden lassen, wenn eine Schnittstelle derart eingeschränkt ist, dass eine andere Implementierung nicht möglich ist.
- 46 Dazu Gemeinsamer Standpunkt des Rates (Fn. 24), GRUR Int. 1991, 545, 548 Tz. 3.
- 47 Der Urheberschutz für den Programmcode einer Schnittstelle kann das Ziel der Interoperabilität gefährden, weil das Ersetzen der Schnittstelle allein durch Dekompilierung und Programmieren eines anderen Codes mit gleicher Funktionalität zuweilen so aufwendig ist, dass es wirtschaftlich nicht lohnt. Dennoch dürfte sich aufgrund des Richtlinientextes der Urheberschutz nicht generell versagen lassen, sofern nicht nur eine mögliche Ausdrucksform der Schnittstellenprogrammierung möglich ist (in diesem Fall mag man einen Rückgriff auf die „Merger“-Doktrin erwägen, dazu II 1 c aa und oben Fn. 45).
- 48 Schlussanträge (Fn. 24), Rs. C-393/09, BSA, Rn. 54-56 sowie Rn. 57 ff. Neben diesen logischen oder Softwareschnittstellen nennt der Generalanwalt noch physische Schnittstellen wie den Bildschirm, die Tastatur oder die Maus.
- 49 EuGH (Fn. 4), Rs. C-393/09, BSA, Rn. 40-42.
- 50 So der ursprüngliche Richtlinienvorschlag KOM(88) 816 endg. (Fn. 10), S. 8, Tz. 3.11; *Schricker/Loewenheim* (Fn. 28), § 69a Rn. 13.
- 51 Siehe auch *Karl* (Fn. 41), S. 238.
- 52 Zur Maßgeblichkeit des Programmcodes deutlich Schlussanträge (Fn. 24), Rs. C-393/09, BSA, Rn. 49 f.: Abstellen „letztlich auf die Textelemente“ als „Schrift des Computerprogramms“; Rn. 65: „Im Übrigen können Computerprogramme mit verschiedenen Quell- und Objektcodes durchaus dieselbe Benutzeroberfläche haben. Die grafische Benutzeroberfläche gibt also nicht das Computerprogramm wieder“.
- 53 KG CR 2010, 424, 425; dazu auch *Redeker*, CR 2010, 426, 427; kritisch zum Versuch einer vom Quellcode losgelösten Verletzungsklage auch *SAS Institute v. World Programming* [2010] EWHC 1829 (Ch), Rn. 250: „remarkable that a claim for infringement of copyright can be advanced in which ... the claimant does not consider it necessary for either its own expert witness or the court to see the copyright work“.
- 54 OLG Frankfurt GRUR 1989, 678, 679 – PAM-Crash (zur alten Rechtslage).
- 55 *Karl* (Fn. 41), S. 227 f.
- 56 Zum Ganzen *Karl* (Fn. 41), S. 228 f.
- 57 *Karl* (Fn. 41), S. 227 (zu Inline-Kommentierungen und Variablennamen).
- 58 OLG Düsseldorf ZUM-RD 2009, 182, 186.
- 59 Siehe etwa EuG 16.12.2010, Rs. T-19/07, *Systran*, Rn. 144: Übernahme von 72% der Programmstrukturen und 80-95% des Quellcodes des Programmcodes ausreichend für eine Verletzung; ferner *Karl* (Fn. 41), S. 231, der grundsätzlich eine Übernahme von „50% des individuell gestaltbaren, nicht vorgegebenen Quellcodes“ verlangt, im Einzelfall sich aber auch mit niedrigeren Prozentwerten zufrieden geben will.
- 60 EuGH (Fn. 4), Rs. C-393/09, BSA, Rn. 38: „jede Ausdrucksform eines Computerprogramms ab dem Moment geschützt (...), ab dem ihre Vervielfältigung die Vervielfältigung des Computerprogramms zur Folge hätte und auf diese Weise der Computer zur Ausführung seiner Funktion veranlasst werden könnte“.
- 61 OLG Düsseldorf ZUM-RD 2009, 182, 186: Übernahme von Kommentarzeilen im Objektcode, nichttriviale Zeilenübereinstimmungen, Übereinstimmungen in den Verweisstrukturen zwischen den Modulen. Siehe auch EuGH (Fn. 32), Rs. C-5/08, *Infopaq*, Rn. 48: teilweise Vervielfältigung zu bejahen, wenn der übernommene Teil „einen Bestandteil des Werkes enthält, der als solcher die eigene geistige Schöpfung des Urhebers zum Ausdruck bringt“. Für eine Übertragbarkeit auf die Übernahme von Programmteilen auch *SAS Institute v. World Programming* [2010] EWHC 1829 (Ch), Rn. 243 f.
- 62 Siehe OLG Düsseldorf ZUM-RD 2009, 182, 186, das wesentlich auf die zahlreichen Spuren von Namensabkürzungen des Ausgangsprogramms im Nachahmerprogramm abstellt.
- 63 Für ein subjektives Element lässt sich auch auf den Richtlinienvorschlag KOM(88) 816 endg. (Fn. 10), S. 7, Tz. 3.6 verweisen, wonach das Urheberrecht Personen, „die ein Computerprogramm unabhängig entwickelt haben“, nicht hindern soll, „den Nutzen aus ihrer Arbeit und Investition zu ziehen“. Eine „unabhängige Entwicklung“ scheidet aber aus, wenn Anhaltspunkte für eine Anlehnung an ein vorbestehendes Programm bestehen. An anderer Stelle (S. 6, Tz. 2.6) heißt es, dass ein Programmhersteller, „auch soweit kein Kopieren erfolgt, theoretisch sogar ein ganzes Programm herstellen [könnte], das eine sehr große Ähnlichkeit mit bereits bestehenden Programmen aufweist, bei denen die zu erfüllenden Aufgaben identisch und die Betriebsabläufe durch eine sehr geringe Komplexität gekennzeichnet sind“.
- 64 Vgl. EuGH (Fn. 32), Rs. C-5/08, *Infopaq*, Rn. 48.
- 65 BGH GRUR 1991, 449, 452 – Betriebssystem: „individuelle (formale) Programmstrukturen (...)“; BGH GRUR 1994, 39, 41 – Buchhaltungsprogramm: „Programmstruktur mit der Aufteilung in Unterprogramme“; OLG Düsseldorf MMR 1999, 729 – Framing; OLG Frankfurt GRUR-RR 2005, 299 Rn. 31 (juris): „innere Struktur und Organisation des Programms“; KG CR 2010, 424, 425: „Programmstruktur“; *Wandtke/Bullinger/Grützmaker* (Fn. 28), § 69a Rn. 27: „innere Gestaltung“; *Spindler/Schuster/Wiebe* (Fn. 28), § 69a UrhG Rn. 14; *Marly*, GRUR 2011, 204, 207: „prägende[n] Programmstrukturen und sonstige wesentliche inhaltliche Strukturelemente, Sammlung, Auswahl und Gliederung der Befehle“. Der BGH sprach in Anlehnung an *Ulmer* zuweilen auch vom „Gewebe“ des Programms, BGH GRUR 1991, 449, 453 – Betriebssystem.
- 66 KG CR 2010, 424, 425; *Broy/Lehmann*, GRUR 1992, 419, 422: „Architektur und modulare[r] Aufbau“; *Lehmann*, in: *Loewenheim*, Handbuch des Urheberrechts, 2. Auflage 2009, § 76 Rn. 3: „Sammlung (Problemanalyse), Einteilung (Strukturierung) und Anordnung (Systementwurf) des Materials (der Anweisungen und Informationen)“.
- 67 *SAS Institute v. World Programming* [2010] EWHC 1829 (Ch), Rn. 232: „I accept that copyright protection is not limited to the text of the source code of the program, but extends to protecting the design of the program, that is, what has been referred to in some cases as its ‚structure, sequence and organisation‘, letzterer Begriff wurde geprägt durch *Whelan Assocs. v. Jaslow Dental Laboratory*, 797 F.2d 1222 (3d Cir. 1986), ist aber in den USA wegen fehlender Klarheit kritisiert worden, *Schechter/Thomas*, *Intellectual Property: The Law of Copyright, Patents and Trade Mark*, 2003, § 4.1. Vorherrschend ist dort inzwischen wohl der „abstraction-filtration-test“ aus *Computer Associates Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693 (2d Cir. 1992): „In ascertaining substantial similarity under this approach, a court would first break down the allegedly infringed program into its constituent structural parts [‘abstraction’]. Then, by examining each of these parts for such things as incorpora-

- ted ideas, expression that is necessarily incidental to those ideas, and elements that are taken from the public domain, a court would then be able to sift out all non-protectable material [‘filtration’]. Left with a kernel, or possible kernels, of creative expression after following this process of elimination, the court’s last step would be to compare this material with the structure of an allegedly infringing program [‘comparison’] “. Zu den einzelnen Elementen der „filtration“: „At the lowest level of abstraction, a computer program may be thought of in its entirety as a set of individual instructions organized into a hierarchy of modules. At a higher level of abstraction, the instructions in the lowest-level modules may be replaced conceptually by the functions of those modules. At progressively higher levels of abstraction, the functions of higher-level modules conceptually replace the implementations of those modules in terms of lower-level modules and instructions, until finally, one is left with nothing but the ultimate function of the program“.
- 68 Schlussanträge (Fn. 24), Rs. C-393/09, BSA, Rn. 63.
- 69 Zu diesen Beispielen *Karl* (Fn. 41), S. 214 ff.
- 70 Andeutungsweise auch Schlussanträge (Fn. 24), Rs. C-393/09, BSA, Rn. 63.
- 71 KOM(88) 816 endg. (Fn. 10), S. 9.
- 72 So wohl auch die Schlussanträge (Fn. 24), Rs. C-393/09, BSA, Rn. 63, die ausdrücklich „eine Struktur oder ein Flussdiagramm“ als Beispiele für geschütztes Entwurfsmaterial nennen.
- 73 KOM(88) 816 endg. (Fn. 10), S. 5, Tz. 2.3. Siehe auch KOM(88) 816 endg. (Fn. 10), S. 6, Tz. 2.8, wonach die Fähigkeit des Programms zur Ausführung der ihm zugeordneten Aufgaben von der „Auswahl“ und „Zusammenstellung“ des Urhebers bei jedem Schritt des Programmaufbaus abhängt.
- 74 KOM(88) 816 endg. (Fn. 10), S. 6, Tz. 2.7.
- 75 KOM(88) 816 endg. (Fn. 10), S. 6, Tz. 2.8.
- 76 Darauf weist *Karl* (Fn. 41), S. 60 f., 84 ff., 213 hin; eingehend zum urheberrechtlichen Schutz objektorientierter Software *Koch*, GRUR 2000, 191.
- 77 EuG 16.12.2010, Rs. T-19/07, *Systran*, Rn. 139 („structure de la logiciel Systran“), Rn. 141 („l’architecture“), Rn. 142 („cette structure“), Rn. 144 („structures de données“).
- 78 Zu diesem Problem bereits Green Paper (Fn. 11), COM(88) 172 final, S. 185, Tz. 5.5.12: „While copyright protection reaches beyond the form of the program, in object or source code, to include preparatory material such as the program description, there comes a point at which a claim for protection is a claim to an idea rather than the expression of that idea“. Eine allgemeine Schutz Ausnahme für Ideen, Verfahren, Arbeitsweisen oder mathematische Konzepte als solche findet sich auch in Art. 9 Abs. 2 TRIPS.
- 79 KOM(88) 816 endg. (Fn. 10), S. 7, Tz. 3.6, 3.7.
- 80 Siehe allerdings Vorlagefragen 3, 6 und 7 im Verfahren C-406/10, auch zur Auslegung von Art. 5 Abs. 3 RL 2009/24.
- 81 EuGH (Fn. 4), Rs. C-393/09, BSA, Rn. 49 f.
- 82 *Baker v. Selden*, 101 U.S. 99, 103 (1879); *Hart v. Dan Chase Taxidermy Supply Corp*, 86 F.3d 320, 322 (1996) (2d Cir. 1996): „The fundamental copyright principle that only the expression of an idea and not the idea itself is protectable has produced a corollary maxim that even expression is not protected in those instances where there is only one or so few ways of expressing an idea that protection of the expression would effectively accord protection to the idea itself“.
- 83 Siehe die Schlussanträge (Fn. 24), Rs. C-393/09, BSA, Rn. 75 f., der den Grund für diese Einschränkung des Urheberschutzes darin sieht, Monopole auf dem Markt der Computerprogramme zu vermeiden, die Kreativität und Innovation entgegen der Zielrichtung der Richtlinie 2001/29 „beachtlich einschränken würden“.
- 84 Schlussanträge (Fn. 24), Rs. C-393/09, BSA, Rn. 50.
- 85 Siehe auch *Marly*, Urheberschutz für Computersoftware in der Europäischen Union, 1995, S. 131: „Erfordernis der Abstraktion zur Unterscheidung der ungeschützten Idee von der geschützten Form“. Vgl. auch *Karl* (Fn. 41), S. 100 f., der auf die „Abstrahierbarkeit“ abstellt und umso eher eine Idee bejahen will, je leichter sich die „Idee“ von einem Werk auf andere Werke übertragen lässt. Könne eine Idee, die z.B. für ein Programm zur Verwaltung von Patientendaten entwickelt wurde, auch in einem Programm zur Aktenverwaltung eines Rechtsanwalts verwendet werden, dann liege der Schluss nahe, dass diese Idee nicht zum Schutzgegenstand des Programms zähle.
- 86 OLG Köln GRUR-RR 2005, 303, 304 – Entwurfsmaterial.
- 87 OLG Karlsruhe GRUR 1994, 726, 729 – Bildschirmmasken.
- 88 Oben Fn. 36.
- 89 *Karl* (Fn. 41), S. 95, 179-181, der auch zutreffend bemerkt (S. 181), dass bei Beschränkung der Funktionalität auf eine Realisierungsmöglichkeit in der konkreten Programmstruktur der Urheberschutz aus Gründen fehlender Individualität (Art. 1 Abs. 3 RL 2009/24) versagt werden muss. Zur „Merger“-Doktrin B. I. 3. a.
- 90 *Karl* (Fn. 41), S. 94.
- 91 *Karl* (Fn. 41), S. 221.
- 92 Siehe *Pomberger/Dobler*, Algorithmen und Datenstrukturen – Eine systematische Einführung in die Programmierung, 2008, S. 32: „keine allgemein anerkannte Definition für den Begriff Algorithmus“. Im Folgenden sollen unter einem Algorithmus solche Rechen- oder Verarbeitungsvorschriften verstanden werden, „die auf eine ganze Klasse von Problemen anwendbar sind und die so präzise festgelegt sind, dass sie ein gegebenes Problem – trotz Schleifen und Verweisungen – mit endlich vielen Rechenschritten (Finitheit) und regelmäßig bei gleichen Ausgangsbedingungen nur in einer Weise abarbeiten und nur mit einem bestimmten Ergebnis lösen (Determiniertheit)“, *Wandtke/Bullinger/Grützmacher* (Fn. 28), § 69a Rn. 28. Siehe auch *Cormen/Leiserson/Rivest/Stein*, Algorithmen – Eine Einführung, 2. Auflage 2007, S. 5: Folge von Rechenschritten, die eine Eingabe von Größen in eine Ausgabe umwandelt.
- 93 „Der gemäß dieser Richtlinie gewährte Schutz gilt für alle Ausdrucksformen von Computerprogrammen, erstreckt sich jedoch nicht auf die Ideen, die Grundsätze, die Logik, die Algorithmen und Programmiersprache, die dem Programm zugrunde liegen“. Zur Begründung siehe der Richtlinienvorschlag KOM(88) 816 endg. (Fn. 10), S. 5, Tz. 2.4, wo die Kommission die einzelnen Algorithmen, auf denen das Programm aufgebaut ist, mit den Wörtern des Dichters, den Pinselstrichen des Malers oder den Tonfolgen des Komponisten vergleicht. Siehe auch bereits das Green Paper (Fn. 11), COM(88) 172 final, S. 182 f., Tz. 5.5.6, 5.5.7, das sich im Interesse der Entwicklungsfreiheit gegen einen Schutz von Algorithmen ausspricht.
- 94 Siehe Art. 1 Abs. 3 Satz 2 des geänderten Parlamentsvorschlages, ABl. C 231 vom 17.9.90, S. 79: „Ideen und Grundsätze, die irgendeinem Element des Programms einschließlich seiner Schnittstellen zugrunde liegen, sind nicht im Sinne dieser Richtlinie urheberrechtlich geschützt.“ Siehe auch die Stellungnahme des Wirtschafts- und Sozialausschusses zu dem Vorschlag für eine Richtlinie des Rates über den Rechtsschutz von Computerprogrammen, ABl. C 329 vom 30.12.89, S. 5, der die fehlende Schutzzähigkeit von Logik, Algorithmen und Programmiersprachen als Selbstverständlichkeit ansah und daher eine kürzere Formulierung vorschlug: „Der gemäß dieser Richtlinie gewährte Schutz gilt für alle Ausdrucksformen von Computerprogrammen, erstreckt sich jedoch nicht auf die Ideen oder Grundsätze, die dem Programm zugrunde liegen“.
- 95 Mitteilung der Kommission an das Parlament (Fn. 17), GRUR Int. 1991, 545, 550 Tz. 4.2 lit. a, Tz. 4.3; siehe auch die wörtliche Wiedergabe in SAS Institute v. World Programming [2010] EWHC 1829 (Ch), Rn. 215 f.

- 96 BGH GRUR 1991, 449, 453 – Betriebssystem; siehe auch bereits Green Paper (Fn. 11), COM(88) 172 final, S. 185, Tz. 5.5.12: „Copyright should protect the manner of implementation, and hence the particular advantages in terms of performance, and leave the [mathematical] formula to be implemented by anyone“; ferner *Dreier*, GRUR 1993, 781, 786; *Ensthaler/Möllenkamp*, GRUR 1994, 151, 158; *Wandtke/Bullinger/Grützmacher* (Fn. 28), § 69a Rn. 28; *Blocher/Walter*, in: *Walter/von Lewinski*, European Copyright Law, 2010, Computer Program Directive Rn. 5.1.37: „may enjoy protection, as far as the specific logical structure and organization of a certain program is concerned“. Siehe auch bereits den Richtlinienvorschlag KOM(88) 816 endg. (Fn. 10), S. 9: „Wird ein Programm insgesamt oder teilweise aus solchen gewöhnlichen oder nichtgeschützten Algorithmen und Programmen gebildet, so sollte es trotzdem als eine Zusammenstellung geschützt werden, sofern es im vorgenannten Sinne Individualität aufweist und der Schöpfer bei der Schaffung der Zusammenstellung Können und Mühe bewiesen hat“.
- 97 OLG Celle CR 1994, 748, 749 f. (kein Schutz für Algorithmen); *Navitaire Inc v Easyjet Airline Company* [2004] EWHC 1725 (Ch), Rn. 88 (kein Schutz für Programmiersprachen); *SAS Institute v. World Programming* [2010] EWHC 1829 (Ch), Rn. 217 (kein Schutz für Programmiersprachen); LG Hamburg ZUM-RD 2008, 563, 566 (kein Schutz für mathematisches Formelwerk); *Blocher/Walter* (Fn. 28), Art. 1 Software-RL Rn. 29; *Schricker/Loewenheim* (Fn. 28), § 69a Rn. 10, 12 (kein Schutz als allgemeines Kommunikationsmittel, sondern nur in konkreter Anwendung und Verknüpfung im Programm); *Möhring/Nicolini/Hoeren* (Fn. 28), § 69a Rn. 12; für einen Schutz von Programmiersprachen als solchen aber *Dreier/Schulze* (Fn. 28), § 69a Rn. 24; *Wandtke/Bullinger/Grützmacher* (Fn. 28), § 69a Rn. 30 (der indes bestimmte Entwicklungs- und Programmiermethoden aus dem Schutz ausnehmen will); für einen Schutz bestimmter Algorithmen aber *Mestmäcker/Schulze/Haberstumpf* (Fn. 28), § 69a Rn. 18 f.; differenzierend *Fromm/Nordemann/Czychowski* (Fn. 28), § 69a Rn. 30 (Schutz beziehe sich nicht auf „die Rechenregel als solche, sondern allenfalls auf ihre Kombination im Rahmen einer Folge von Anweisungen“). Zum Schutz von Programmiersprachen nunmehr Vorlagefrage 3 im Verfahren *SAS Institute*, Rs. C-406/10.
- 98 *Dreier/Schulze* (Fn. 28), § 69a Rn. 24; *Wandtke/Bullinger/Grützmacher* (Fn. 28), § 69a Rn. 30; a.A. *Fromm/Nordemann/Czychowski* (Fn. 28), § 69a Rn. 31; *Marly* (Fn. 6), Rn. 86; *ders.*, GRUR 2011, 204, 207. Zum Schutz von Schlüsselwörtern und Syntax einer Programmiersprache Vorlagefrage 3 im Verfahren *SAS Institute*, Rs. C-406/10.
- 99 *Karl* (Fn. 41), S. 237, der den Schutzbereich jedenfalls eng definieren will.
- 100 Vgl. *Schricker*, GRUR Int. 2008, 200, 203 f.; LG Köln NJOZ 2010, 97, 98: „Spielregeln in ihrer konkreten Ausgestaltung“.
- 101 Vgl. *Marly*, GRUR 2011, 204, 207: „Programmiersprachen im Sinne der jeweiligen für die Erstellung eines Programms verwendbaren Befehle sind mangels konkreter Steuerung nicht geschützt“.
- 102 *Karl* (Fn. 41), S. 237.
- 103 Stellungnahme des Wirtschafts- und Sozialausschusses (Fn. 94), S. 6, Tz. 3.3.3.1.
- 104 Stellungnahme des Wirtschafts- und Sozialausschusses (Fn. 94), S. 6, Tz. 3.3.3.3.1-3.3.3.3. Das Parlament schlug vor, Computerprogramme zu schützen, „wenn sie insofern Originale darstellen, als sie das Ergebnis der kreativen geistigen Leistung ihres Urhebers sind. Zur Bestimmung ihrer Schutzfähigkeit sind keine anderen Kriterien anzuwenden“, siehe Art. 1 Abs. 4 des vom Parlament geänderten Richtlinienvorschlags (Fn. 94).
- 105 Green Paper (Fn. 11), COM(88) 172 final, S. 187, Tz. 5.6.4.
- 106 KOM(88) 816 endg. (Fn. 10), S. 9: „Das einzige Kriterium, das zu Feststellung der Schutzwürdigkeit angewendet werden sollte, ist das der Individualität, d.h. daß das Werk nicht kopiert worden ist. Es sollte kein anderer ästhetischer oder qualitativer Test angewendet werden“.
- 107 BGH GRUR 1985, 1041, 1048 – Inkasso-Programm.
- 108 *Blocher/Walter* (Fn. 28), Art 1 Software-RL Rn. 13; zweifelnd an der Anlehnung an anglo-amerikanische Vorbilder *Mestmäcker/Schulze/Haberstumpf* (Fn. 28), § 69a Rn. 23.
- 109 Richtlinie 87/54/EWG des Rates vom 16. Dezember 1986 über den Rechtsschutz der Topographien von Halbleitererzeugnissen, ABL.L 24 vom 27.1.1987, S. 36. Zur Anlehnung an die Halbleiterrichtlinie Green Paper (Fn. 11), COM(88) 172 final, S. 188, Tz. 5.6.7.
- 110 Richtlinie 2006/116/EG des Europäischen Parlaments und des Rates vom 12. Dezember 2006 über die Schutzdauer des Urheberrechts und bestimmter verwandter Schutzrechte (kodifizierte Fassung), ABL.L 372 vom 27.12.2006, S. 12.
- 111 EuGH (Fn. 32), Rs. C-5/08, *Infopaq*, Rn. 35-37 (in Rn. 37 dieser Entscheidung wird die RL 2006/116 als RL 2001/116 bezeichnet).
- 112 BGH GRUR 2005, 860, 861 – *Fash 2000*; noch großzügiger OLG Düsseldorf ZUM-RD 2009, 182, 186: „Schutzhöhe ... nicht auf dem Niveau der „kleinen Münze“, sondern noch darunter“; großzügig auch *de Miguel Asensio* (Fn. 28), Rn. 570: „la presencia di pequeñas variaciones en el código fuente ... puede ser suficiente para satisfacer el requisito de originalidad“.
- 113 So aber KOM(88) 816 endg. (Fn. 10), S. 9 (oben Fn. 106).
- 114 EuGH (Fn. 4), Rs. C-393/09, *BSA*, Rn. 49 f. (zu Art. 2 RL 2001/29, der ein ähnliches Individualitätserfordernis zugrunde liegt, siehe oben Fn. 111). Alternativ mag man diese Einschränkung bereits als nicht schutzfähige „Idee“ oder „Grundsatz“ ansehen, siehe die Ausführungen oben unter B. I. 3. a.
- 115 So aber KOM(88) 816 endg. (Fn. 10), S. 8, Tz. 3.13; S. 6, Tz. 2.6.
- 116 EuGH (Fn. 4), Rs. C-393/09, *BSA*, Rn. 50.
- 117 BGH GRUR 2005, 860, 861 – *Fash 2000*; siehe auch *Marly* (Fn. 6), Rn. 93: kein Schutz für „Banalprogramme“.
- 118 *Koch*, GRUR 2000, 191, 198.
- 119 Während der ursprüngliche Entwurf der Kommission insofern noch klarstellen wollte, dass auch computergenerierte Programme geschützt werden, wenn sie das Erfordernis der Individualität erfüllen (Art. 1 Abs. 4 lit. b des Richtlinienvorschlags, KOM(88) 816 endg. (Fn. 10), S. 13), ist diese Klarstellung im endgültigen Richtlinienentwurf entfallen.
- 120 Zum Computer Aided Software Engineering *Wandtke/Bullinger/Grützmacher* (Fn. 28), § 69a Rn. 32; aus englischer Sicht einerseits *de Wachter*, CRI 2010, 12, 17 (Urheberschutz verneinend); andererseits *Paton/Morton*, CRI 2011, 8, 12 (Urheberschutz bejahend).
- 121 *Marly*, GRUR 2011, 204, 207.
- 122 Der Gesetzgeber dürfte dies nicht beabsichtigt haben, vgl. Commission Staff Working Paper (Fn. 18), SEC(2004) 995, S. 14: „These special cases aside, Member States remain free to determine what level of originality a work must possess for granting it copyright protection“.
- 123 Hier findet sich in der Rs. *Infopaq* (Rn. 35) eine falsche Richtlinienbezeichnung, oben Fn. 111.
- 124 EuGH (Fn. 32), Rs. C-5/08, *Infopaq*, Rn. 34-37.
- 125 Deutlich sind die Schlussanträge (Fn. 24), Rs. C-393/09, *BSA*, Rn. 72 f.: „überhaupt kein Zweifel“.
- 126 *Griffiths* (Fn. 40), Analysis b: „consequences ... would be traumatic for UK copyright law“; siehe auch die Diskussion von *Bently* u.a. im IPKAT Weblog, 11th January 2011, <http://ipkit.ten.blogspot.com/2011/01/lionel-bezpecnostni-sofwarovav-associace.html> (letzter Abruf 2.5.2011).



- 127 EuGH (Fn. 4), Rs. C-393/09, BSA, Rn. 48; siehe bereits EuGH (Fn. 32), Rs. C-5/08, Infopaq, Rn. 37; Schlussanträge (Fn. 24), Rs. C-393/09, BSA, Rn. 74, dort auch: „Schöpfungshöhe“ (Rn. 75, 84).
- 128 EuGH (Fn. 4), Rs. C-393/09, BSA, Rn. 48.
- 129 EuGH (Fn. 4), Rs. C-393/09, BSA, Rn. 45 f., 50.
- 130 EuGH (Fn. 32), Rs. C-5/08, Infopaq, Rn. 48; EuGH (Fn. 4), Rs. C-393/09, BSA, Rn. 47.
- 131 EuGH (Fn. 4), Rs. C-393/09, BSA, Rn. 49.
- 132 Offen ist, ob der Trend zur Europäisierung alle Werkarten erfasst. Insbesondere für den Originalitätsmaßstab beim (ergänzenden) Urheberschutz von Mustern und Modellen ist auf Art. 17 Satz 2 der Richtlinie 98/71/EG des Europäischen Parlaments und des Rates vom 13. Oktober 1998 über den rechtlichen Schutz von Mustern und Modellen, ABl. L 289 vom 28.10.1998, S. 28 zu verweisen, der den Mitgliedstaaten ausdrücklich die Regelung vorbehält, „in welchem Umfang und unter welchen Bedingungen ein solcher Schutz gewährt wird, (...) einschließlich der erforderlichen Gestaltungshöhe“. Zu dieser Vorschrift jüngst EuGH 27.1.2011, Rs. C-168/09, Flos, GRUR 2011, 216 Rn. 41: „Daraus folgt, dass nach Art. 17 der Richtlinie 98/71 den durch ein in einem oder mit Wirkung für einen Mitgliedstaat eingetragenes Recht an einem Muster geschützten Mustern, die die von den Mitgliedstaaten vorgeesehenen Bedingungen für die Erlangung des Urheberrechtsschutzes, insbesondere die Bedingung der Gestaltungshöhe, erfüllen (...), der Schutz nach dem Urheberrecht dieses Mitgliedstaats zugutekommen musste“ (Unterstreichung nicht im Original).
- 133 EuGH (Fn. 32), Rs. C-5/08, Infopaq, Rn. 35.
- 134 EuGH (Fn. 32), Rs. C-5/08, Infopaq, Rn. 43.
- 135 EuGH (Fn. 4), Rs. C-393/09, BSA, Rn. 50; siehe auch bereits EuGH (Fn. 32), Rs. C-5/08, Infopaq, Rn. 45.
- 136 BGH GRUR 1991, 529, 530 – Explosionszeichnungen; BGH GRUR 1993, 34, 35 – Bedienungsanweisung; BGH GRUR 2005, 854, 855 – Karten-Grundsubstanz. Anderes gilt für § 2 Abs. 1 Nr. 4 UrhG, dazu unten bei Fn. 155.
- 137 So OLG Karlsruhe GRUR-RR 2010, 234, 235 – Reisebürosoftware.
- 138 Oben Fn. 130. Einen Unterschied zwischen der „eigenen geistigen Schöpfung“ und der „persönlich-geistigen Schöpfung“ i.S.d. § 2 Abs. 2 UrhG (offenbar auch soweit sich letztere nur auf die „kleine“ Münze bezieht) sehen Marly (Fn. 6), Rn. 90; Wandtke/Bullinger/Grützmaker (Fn. 28), § 69a Rn. 33. Gegen einen prinzipiellen Unterschied aber Dreier/Schulze (Fn. 28), § 69a UrhG Rn. 26; Schricker/Loewenheim (Fn. 28), § 69a Rn. 14.
- 139 Otto, K&R 2010, 419. Siehe etwa OLG Düsseldorf MMR 1999, 729, 732 f.; OLG Frankfurt MMR 2005, 705, 705; OLG Rostock GRUR-RR 2008, 1, 2 – Urheberrechtsschutz von Webseiten (Schutz nur als Sprachwerk, nicht als Werk der angewandten Kunst); OLG Karlsruhe GRUR-RR 2010, 234, 235 – Reisebürosoftware (unter Aufgabe von OLG Karlsruhe GRUR 1994, 726, 729 – Bildschirmmasken); a.A. aber östOGH MMR 2002, 42, 43. Der Hinweis auf Bildschirmmasken in KG CR 2010, 424, 425 stellt nur ein obiter dictum dar.
- 140 östOGH MMR 2002, 42, 43.
- 141 Navitaire Inc v Easyjet Airline Company [2004] EWHC 1725 (Ch), Rn. 98.
- 142 Oben Fn. 130. In England ist man traditionell großzügiger mit den Anforderungen an die Schöpfungshöhe, vgl. Nova Productions Ltd v Mazooma Games Ltd [2007] EWCA Civ 219, Rn. 51: „The fact that a work can get copyright even if mundane, is old and familiar to an English lawyer“.
- 143 KOM(88) 816 endg. (Fn. 10), S. 9; siehe auch BGH NJW 2000, 3571, 3572 – OEM-Version; Fromm/Nordemann/Czychowski (Fn. 28), § 69a Rn. 29. Gleiches gilt für solche vorbereitenden Materialien, die nicht bereits die Entstehung eines konkreten Programms ermöglichen, sondern lediglich seine Funktionalität oder die Vorgaben des Auftraggebers beschreiben (Lasten- und Pflichtenheft), OLG Köln GRUR-RR 2005, 303, 304 – Entwurfsmaterial; Walter/von Lewinski/Blocher/Walter (Fn. 96), Computer Program Directive Rn. 5.1.28. Anderes gilt für die eng mit dem Programmcode verknüpfte Dokumentation in Gestalt sogenannter Inline-Kommentare, die zum Programmcode zu zählen sind, Karl (Fn. 41), S. 85, 227.
- 144 KOM(88) 816 endg. (Fn. 10), S. 5, Tz. 1.1; SAS Institute v. World Programming [2010] EWHC 1829 (Ch), Rn. 254 und Vorlagefragen 8 und 9 in der anhängigen Rechtssache SAS Institute, Rs. C-406/10.
- 145 Oben Fn. 136.
- 146 BGH GRUR 1993, 34, 35 – Bedienungsanweisung: „Mindestmaß an persönlicher geistiger Leistung, das in der Regel bei allen einfachen Fotografien gegeben ist“.
- 147 BGH GRUR 1993, 34, 36 – Bedienungsanweisung; zu Bedienungsanleitungen von Computerprogrammen Wandtke/Bullinger/Grützmaker (Fn. 28), § 69a Rn. 13; Spindler/Schuster/Wiebe (Fn. 28), § 69a UrhG Rn. 9.
- 148 BGH GRUR 1985, 1041, 1047 f. – Inkasso-Programm
- 149 KOM(88) 816 endg. (Fn. 10), S. 9; explizit ablehnend zu den Maßstäben der Inkasso-Programm-Entscheidung auch Green Paper (Fn. 11), COM(88) 172 final, S. 187 f., Tz. 5.6.3 ff.
- 150 Diese Konsequenz zieht in Großbritannien bereits Newspaper Agency Ltd v Meltwater Holding BV [2010] EWHC 3099 (Ch), Rn. 83.
- 151 Oben Fn. 43.
- 152 BGH GRUR 1984, 730, 733 – Filmregisseur; OLG Frankfurt ZUM 2005, 477, 479 – TV Total. Gleiches gilt für Musikwerke, BGH GRUR 1988, 812, 814 – Ein bisschen Frieden.
- 153 Kreuzer, CR 2007, 1, 4 ff.; siehe auch Bullinger/Czychowski, GRUR 2011, 19, 21, 26.
- 154 OLG Rostock GRUR-RR 2008, 1, 2 – Urheberrechtsschutz von Webseiten; zum Schutz der Steuerungsprogramme von Webseiten auch Schack, MMR 2001, 9, 12.
- 155 OLG Köln GRUR-RR 2010, 141, 142 – 3D-Messestände.
- 156 OLG Köln GRUR-RR 2010, 141, 142 – 3D-Messestände unter Hinweis auf BGH GRUR 1995, 581, 582 – Silberdistel; BGH GRUR 2004, 941, 942 – Metallbett.
- 157 Sofern man nicht den Vorbehalt der Definition der Gestaltungshöhe durch den nationalen Gesetzgeber speziell beim Schutz von Mustern und Modellen durch Art. 17 Satz 2 RL 98/71/EG rechtfertigen will, dazu oben Fn. 132.
- 158 EuGH (Fn. 4), Rs. C-393/09, BSA, Rn. 57.
- 159 EuGH (Fn. 32), Rs. C-5/08, Infopaq, Rn. 39: „die verschiedenen Teile eines Werkes [sind] somit unter der Voraussetzung, dass sie bestimmte Elemente enthalten, die die eigene geistige Schöpfung ihres Urhebers zum Ausdruck bringen, nach Art. 2 Buchst. a der Richtlinie 2001/29 geschützt“.
- 160 Griffiths (Fn. 40), Analysis d.
- 161 In diese Richtung wohl die Schlussanträge (Fn. 24), Rs. C-393/09, BSA, Rn. 83 ff.
- 162 EuGH (Fn. 4), Rs. C-393/09, BSA, Rn. 57.
- 163 Für ein derartiges Verständnis von BSA Griffiths (Fn. 40), Analysis d.
- 164 Zu diesen Beispielen Griffiths (Fn. 40), Analysis d.
- 165 EuGH (Fn. 4), Rs. C-393/09, BSA, Rn. 57.
- 166 Schlussanträge (Fn. 24), Rs. C-393/09, BSA, Rn. 84.
- 167 Schlussanträge (Fn. 24), Rs. C-393/09, BSA, Rn. 85.
- 168 EuGH (Fn. 4), Rs. C-393/09, BSA, Rn. 57.
- 169 Allerdings kann man in der Anknüpfung an die Steuerungsfunktion von Computerprogrammen durchaus ein funktionales Element im Urheberrecht sehen, vgl. Schechter/Thomas (Fn. 67), § 4.1: Computer programs „don't just instruct users

in how to perform tasks, they actually perform those tasks by themselves“.

**170** Siehe etwa BGH GRUR 2010, 628, 631, Rn. 33 ff. – Vorschaubilder.

**171** EuGH (Fn. 32), Rs. C-5/08, Infopaq, Rn. 35, 37.

**172** Zur Abgrenzung von Idee und Ausdrucksform auch EuGH (Fn. 4), Rs. C-393/09, BSA, Rn. 49.

# Sui Generis Rights for the Protection of Traditional Cultural Expressions

## Policy Implications

by Kilian Bizer, Matthias Lankau, Gerald Spindler, Philipp Zimbehl, Göttingen\*

**Abstract:** Within the international community there have been many calls for better protection of traditional cultural expressions (TCEs), for which classic instruments of intellectual property rights do not seem to fit. In response, at least five model laws have been advanced within the last 40 years. These are referred to as *sui generis* because, though they generally belong to the realm of intellectual property they structurally depart from classic copyright law to accommodate the needs of the holders of TCEs. The

purpose of this paper is to provide a well-founded basis for national policy makers who wish to implement protection for TCEs within their country. This is achieved by systematically comparing and evaluating economic effects that can be expected to result from these regulatory alternatives and a related system or private ordering. Specifically, we compare if and how protection preferences of local communities are met as well as the social costs that are likely to arise from the different model laws.

**Keywords:** Sui generis, traditional cultural expressions, policy, private ordering, law and economics

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## A. What is the Regulatory Choice Problem?

1 Most of what is referred to as traditional cultural expressions or folklore (TCE) is unprotected and part of the public domain. Anybody may therefore make use of or market TCE even without the consent of its traditional owners. The relatively recent movie picture “Twilight Eclipse” is a case in point. Here, the founding legend of the Quileute, a tribe in the Western United States who believes that their ancestors were shape shifters between men and wolves, is employed for the plot of the movie. Rather frequently, traditional owners strongly disapprove of such uses by third parties, yet lack the legal instruments to control the terms of use or even prohibit access altogether. This could be the case when there is a perceived sense of injustice, for instance when local communities have no legal claim to a fair share of the revenues generated by third parties. Another reason can be perceived indignation when elements

of TCE with a high cultural meaning are misappropriated. As a result, for many years representatives of traditional communities have argued for a better protection of their TCE within the realm of intellectual property. These claims were carried to higher political levels and can now be considered a fixed agenda item within international negotiations on extensions of intellectual property such as the ones in the Intergovernmental Committee of World Intellectual Property Organization (Lankau, Bizer et al. 2010).

2 From a normative economic perspective, protection of TCE can be justified. It may prevent negative effects on the traditional owners holding TCE via acts of misappropriation. Bicskei et al. (2010) for instance show that such access can negatively affect the identity of cultural carriers and go as far as seriously impairing their fundamental dignity. Should this be the case, the authors argue for protection of these elements of TCE. This in turn gives rise to a regulatory choice problem: How should TCE

be protected? From a law and economics perspective one possibility is to allot property rights for traditional owners of TCE, which can exclude outsiders. It has been shown that approaches within the regular IPR-system, such as copyright, do not meet the requirements postulated by traditional owners (see for instance Lewinski (2007)). In response, the international community has developed model laws for the protection of TCE in the last decades, which may be used as a basis for the development of national legislation. These are referred to as “sui generis”, which signifies a status of its own kind. While they count as intellectual property, they systematically depart from classic copyright. This paper evaluates the regulatory alternatives in the sui generis model laws and the system of private ordering and develops policy guidelines for their implementation.

## B. Introducing the Regulatory Alternatives

- 3 Sui generis rights must be classified as group rights for traditional communities aiming to protect their TCE<sup>1</sup> by extending the conventional forms of intellectual property rights. The alternative model laws are the (1) *Model Provisions of the UNESCO/WIPO* which were created in 1982 (2) the *South Pacific Model Law for National Laws* of 2002 (3) the *Tunis Model Law on Copyright for Developing Countries* of 1972, (4) the *WIPO Draft Provisions*<sup>2</sup> of 2004 and (5) the *ARIPO Provisions* of 2010.

**Table 1: Sui Generis Model Laws**

Model Law	Year	Abbreviation
Tunis Model Law on Copyright for Developing Countries	1972	TML
Model Provisions of the UNESCO / WIPO	1982	MPUW
South Pacific Model Law for National Laws	2002	SPML
WIPO Draft Provisions	2004	WDP
ARIPO Provisions	2010	ARIPO

- 4 These model laws share many features. For instance, all sui generis rights contain rules of exclusion of the public and mechanisms of benefit sharing. Also, their protection solely targets uses of TCE that occur beyond rather than within its traditional context by granting economic as well as moral rights to the traditional owners. In addition, they recognize group ownership, seek protection in perpetuity and do not require any kind of formality for protection to come into effect. Yet, the sui generis rights differ with regard to the holders of rights. For the sake of this article right holders can be split into (1) legal owners (title holders) of TCE, (2) beneficiaries of

protection, i.e. the actors entitled to receive compensation, and (3) actors responsible for negotiating access with non-traditional users.

- 5 Basically, there are three systems of allocating the rights. Within the first system all of the mentioned rights in TCE are allocated to a central state agency (see the TML). Within the second system all rights are allocated to the local communities that hold the TCE (WDP, SPML). The third system establishes a mix of right holders (ARIPO). While the community is entitled to their elements of TCE, a state agency is responsible for negotiating access with non-traditional users. It is, however, not completely free in its decisions, as the respective community has to approve of any decision taken. Collected proceeds are directly transferred to the community from which the folklore originates.

## C. Which Political Level Ought to Address the Protection Issue?

- 6 Any allocation of exclusive rights would have to live up to the ubiquitous character of TCE as an immaterial good. International protection in the sense of trans-border protection is still very weak in the field of immaterial property. The principle of country protection, which is part of the Revised Berne Convention, the TRIPS (Agreement on Trade-Related Aspects of Intellectual Property Rights), and the WIPO Performances and Phonograms Treaty ensures that the criteria for what kind of work and how protection is granted are only to be found in the respective country's legislation (*lex loci protectionis*). Thus, even if a sui generis right is granted in a particular country, the protection would only apply within this country. In order to broaden the scope of protection, any of the mentioned systems of exclusive or partly exclusive rights would have to be implemented in as many states as possible. The foundation of such an implementation should be an international treaty setting out minimal standards of protection, like the Revised Berne Convention or the World Copyright Treaty do for patents and copyright. Consequently, an individual state should address protection of TCE not only on the national level but also within the international community in order to create effective protection.

## D. Evaluation of the Alternative Sui Generis Rights

- 7 Sui generis rights can be compared according to how protection preferences of traditional owners are met within the different systems as well as according to the social costs that they are likely to cause. Social costs are incurred by restricting society's non-tradi-

tional access to folklore and thus the pool of knowledge enabling socially desirable innovation. These costs may well be substantial,<sup>3</sup> as for instance the boundaries of the rights (which elements of TCE are protected and which not) are unclearly defined (Bessen and Meurer 2008) and rights are granted automatically without any formalities and limitations in time.

- 8 Complete local right holder assignments, such as in the WDP and SPML, are likely to result in protection that is oriented at the preferences of the indigenous communities holding the TCE. This is because the decision making process lies with the actor incurring costs and benefits, that is with the indigenous groups themselves, which ascertains that TCE is only used externally if the group obtains a net benefit. It will thus be unlikely that groups grant access to elements of TCE if this affects their fundamental dignity in a disparaging way. As a result, protection is very likely to be differentiated according to the value of TCE as perceived by the communities of origin. Yet, such a system is also likely to result in substantial social costs. First of all, local TCE ownership may raise transaction costs merely through the intricacies of clearly determining exactly whom the rights should be allocated to. For instance, even if an element of TCE is currently practiced by Group A, it may very well be rooted in traditions of Group B. There are also transaction cost issues in the process of negotiating access with traditional owners. If, for instance, representation is contested, or if many group actors hold exclusive rights on the TCE elements demanded, negotiation could turn out to be very costly, as every single right holder would need to be compensated. This is likely to result in an underuse of folklore, which could cause a tragedy of the anti-commons (Heller 1998). These cost and thus usage effects can even multiply, should there be more than one group holding rights over an element of TCE. Negotiation would then have to be carried out with each owner.
- 9 Within a system that allocates all rights to a state agency, the situation is likely to be reversed. There are almost no costs of identifying the state agency as the owner and negotiations of access with a single actor are by far not as cost intensive as what could be expected to result from a local allocation of rights. But due to principal-agent problems it is very likely that local preferences for protection are not taken into consideration to the same extent as they are in the case of a local right allocation. The degree of departure from local preferences hinges on the assumptions of how the state agency acts. If regular arguments of the economic theory of bureaucracy hold, the leading bureaucrat can be expected to show budget maximizing behavior in order to increase personal utility (Niskanen 1971). This being the case, there would be clear incentives to lower restrictions and to increase the number of non-traditional access

to TCE, as this justifies raising the number of agency employees needed and the prestige associated. Consequently, we would expect higher numbers of non-traditional access than when rights are locally allocated. Conversely, bureaucrats could be assumed to behave altruistically towards local communities. Communities' preferences will then be strongly regarded in access negotiations with non-traditional users, resulting in very few principal-agent problems. Yet, it is debatable whether such behavior can be assumed to be in equilibrium. Lastly, we can assume bureaucrats to be susceptible to fraudulent behavior by third parties that wish to gain access to TCE, for instance by bribery. In that case preferences of local communities may not be regarded at all given that outsiders seeking access to TCE have a higher willingness to pay than local communities to secure bureaucratic support. This can lead to numerous access decisions that are completely disconnected from local communities' preferences. In general, assessing the likely behavior of state agency bureaucrats will be a key decision factor in determining which system of sui generis rights is appropriate.

- 10 Within the ARIPO system of mixed ownership, effects in terms of protection as well as social costs are likely to be in the middle of the spectrum that is created by the local and central allocation of rights. While the state agency is responsible for negotiating access with third parties, its decisions may always be vetoed by the respective communities. It therefore enjoys much less slack as is the case when rights are allocated centrally. Yet, the representation of traditional preferences may still not be perfect, because there will be information asymmetries between agency and communities. The costs of determining traditional owners will be similar to other local right allocation systems, yet costs of negotiating access will be reduced as outsiders only have to deal with the state agency.

## E. Administration through Private Ordering

- 11 If a form of sui generis right is established, the rights still require administration. In cases where the rights are allocated to the owners on the local level, two specific tasks must be addressed. The first consists in ensuring a balance between non-traditional access and privatization of the cultural foundations (Brown 2005) – aligning the private domain where every use is exclusive with the public domain of collectiveness is essential for every system of IP rights (Dusollier 2007). The second entails assisting the local groups in managing their rights with the first task in mind. These tasks can be supported by systems of private ordering of rights which are already established in the world of Open Access Publishing (Dusollier 2007).

They aim to keep the balance between the authors and the general public's interest.

- 12 If a sui generis right is in place, a system of private ordering could strengthen the position of the owners of the TCE. For instance, they could demand from the licensees to comply with certain standards in use and licensing of folklore. Such restrictions may concern the prohibition of misappropriate actions or the obligation to enforce the owners' conditions vis-à-vis third parties. A system working through private ordering can be very flexible in view of the right holders, uses and benefit sharing mechanisms. A potential form of control executed through private ordering could require that every deriving work be under a license that complies with the original license.<sup>4</sup> Nevertheless, control could go beyond that. Under another possible scheme, the rights on every deriving work could be reassigned to the owners of TCE, while the creator of the derivative only gains the right to receive a license, which entitles him for uses in compliance with the rules of the indigenous groups.
  - 13 A group could determine the restriction for every use on a case by case basis. An innovative use, which is not seen as disparaging, could be allowed while a use that is more likely to conflict with the interests of the owners of TCE can be prohibited. In addition, the boundaries could be negotiated for every single use or object. A licensing system like the one described above, where the creator of a derivative has to assign all his rights to his original licensor, the owner of TCE, would create strong incentives for owners of TCE to implement a flexible system. A more open licensing means more chances of benefits, while a very wide licensing system, on the other hand, could threaten their own identity.<sup>5</sup> The licensee who seeks to create a derivative work has the strong incentive to comply with the requirements of the license and to be aware of the wishes of the owner, since he is constantly facing the risk of losing his license not only for the original folklore but for the derivative, as well. A system of private ordering, which relies on numerous license agreements is likely to cause high transaction costs since every license would have to be negotiated. This could be overcome by standard licenses, a trend observable for open source software (OSS) and open access (Spindler and Zimbeh 2011). Such a system could serve as a supplement to the sui generic rights described above. A sui generis protection that targets all elements of TCE of a certain traditional community can serve as the basis of a system of private ordering.
- have to decide which of the sui generis rights best fits their national circumstances. We have shown that different right allocation systems come with diverse cost and benefit effects. A central right allocation saves transaction costs, yet can lead to strong principal-agent problems, potentially disregarding local protection preferences, while more local systems regard local preferences yet increase transaction costs. Consequently, each country will have to strike a balance between regarding the preferences of local communities and the needs of the general public.
- 15 National policy decision makers could for instance attach a higher value to preferences of local communities than to minimizing social costs. In that case, they should choose a sui generis right that allocates all rights locally, shifting the burden of protection to the general public. This would be the case when applying the WIPO Draft Provisions (WDP) and the South Pacific Model Law (SPML). Conversely, the minimization of the social burden could be the main concern over and above regarding local preferences, in which case decision makers ought to choose the central right allocation system that is proposed in the Tunis Model Law (TML).
  - 16 It is conceivable, however, that both benefit as well as cost effects of sui generis rights are simultaneously taken into consideration. Whether the social cost saving alternatives really lead to a disregard of local preferences, crucially depends on the behavioral assumptions of the bureaucrats.
  - 17 If bureaucrats behave altruistically towards the preferences of local communities, the solution to the regulatory choice problem is the central right allocation in the TML. When fraudulent behavior is prevalent and local preferences are regarded as important, a local right allocation is the superior solution. Then, WDP or SPML should be chosen. If bureaucrats are driven by selfish motives such as prestige, principal-agent problems are very likely to arise. Assigning rights locally (WDP and SPML) will circumvent these, yet higher social costs will have to be accepted. The ARIPO system of mixed right ownership is an alternative, since principal agent problems can be reduced due to the vetoing power of local communities.
  - 18 If local communities are given the ownership of the rights, they face a globalized market for IP rights and the possible forms of infringement that come with it (Riley 2005). This is addressed in the SPML and the UNESCO/WIPO Draft Provisions (MPUW) which both aim to establish an authority to monitor the use of the rights. A private ordering approach as described above in connection with standardized licenses can support the local groups in the administration of their rights.

## F. Recommended Procedures

- 14 As mentioned in section 3, each country that wishes to protect its folklore from misappropriation will

- 19 While domestic legislation is limited to state borders, the immaterial character of folklore brings the risk of trans-border infringements. Every system which allocates exclusive or partly exclusive rights would have to be implemented in as many states as possible. A standardized implementation of rights on the international level seems to be a very difficult task. Even in the field of copyright law, we are far away from a harmonized system. An approach to deal with this would be a set of bilateral contracts with cross approval under the shield of an international agreement which regulates minimal protection standards. The foundation of such an implementation should be an international treaty which sets out minimal standards of protection, like the Revised Berne Convention or the World Copyright Treaty.

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- 1 TCE are considered as such when having been handed over from generation to generation. Examples of this common definition are for instance be performances such as ceremonies, rituals or dances; musical expressions such as songs or verbal expression such as stories or legends (see for instance WIPO (2006)).
- 2 The version that is used here is WIPO/GRTKF/IC/9/4. By now there have been many discussions on how to improve these provisions. Yet, the ideas included in this document shall nevertheless serve as a first baseline of comparison.
- 3 Many authors have pointed to the high social costs in stifling innovations that are generated by the system of intellectual property rights. For more details see Boldrin and Levine (2008), Heller (2008), Jaffe and Lerner (2004).
- 4 This is the case with many Open Access and Open Source licenses which contain a, so-called, viral clause.

- 5 This is unlikely to happen. Concerning the minimal standard of protection an indigenous group will seek, see: Bicskei, Gubaydullina et al. (2010).



# The Right to Be Forgotten

## More Than a Pandora's Box?

by Rolf H. Weber,\*

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**Abstract:** Recently, political voices have stressed the need to introduce a right to be forgotten as new human right. Individuals should have the right to make potentially damaging information disappear after a certain time has elapsed. Such new right, however, can come in conflict with the princi-

ple of free speech. Therefore, its scope needs to be evaluated in the light of appropriate data protection rules. Insofar, a more user-centered approach is to be realized. "Delete" can not be a value as such, but must be balanced within a new legal framework.

**Keywords:** Data protection; delete; free speech; privacy; privacy enhancing technologies; user-centered approach

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## A. Introduction

- 1 In 2010 a first legislative project was developed in France that envisaged the creation of a "right to be forgotten" online.<sup>1</sup> Subsequently, not much concrete information was made available about the proposed law, which was intended to force online and mobile firms to dispose of e-mails and text messages after an agreed-upon length of time or at the request of the individual concerned. In November 2010, the EU Commission took up the idea of introducing a right to be forgotten in the context of the ongoing revision of the Data Protection Directive 95/46;<sup>2</sup> the outcome of the vague proposal is still uncertain.
- 2 The right to be forgotten in the context of digital memory and/or data retention was only recently proposed as a fundamental right; however, its inherent background concept has been a discussion topic in Continental Europe and in the United States for many years. The main example in court practice and legal doctrine concerned persons who were convicted in court and who wanted to make this information disappear after a certain time period had elapsed.<sup>3</sup> In the United States, the lists of sexual offenders living in the neighborhood that are partly published on the Internet are topics of debate. A

specific "case" is described in Mayer-Schönberger's book *Delete: The Virtue of Forgetting in the Digital Age*.<sup>4</sup> Stacy Snyder, a 25-year-old former education student at Millersville University School of Education in Pennsylvania, was confronted with a professor who became aware of a picture of her from a party posted on her MySpace web page, showing her drinking from a plastic cup and wearing a pirate's hat (captioned "drunken pirate"). The professor informed the school authorities dealing with Stacy's file, who thereupon refused to grant the young woman the diploma she had earned, stating that her conduct was "unprofessional" and that she had, albeit indirectly, encouraged young people to drink. Stacy's attempt to reverse the decision in court on the basis of her right of free speech failed.<sup>5</sup>

- 3 As mentioned, the term "right to be forgotten" has only recently been created. A decade ago, however, a similar term, namely the "right to forget," was already a topic of debate.<sup>6</sup> But viewed precisely, the active and the passive side of the "forget" medal are not identical, and the right to *be forgotten* should not be confused with the right to *forget* as happens frequently in blog discussions.<sup>7</sup> The "right to forget" refers to the already intensively reflected situation that a historical event should no longer be revital-

ized due to the length of time elapsed since its occurrence; the “right to be forgotten” reflects the claim of an individual to have certain data deleted so that third persons can no longer trace them.<sup>8</sup> Therefore, the right to be forgotten is based on the autonomy of an individual becoming a rightholder in respect of personal information on a time scale; the longer the origin of the information goes back, the more likely personal interests prevail over public interests.

- 4 This contribution looks at the direct and indirect traces that lead from the general personality right to a specific right to be forgotten, it analyzes some key data protection concepts in light of the actual implementation of such a new and fundamental right, and finally it takes possible legal and technological limits of this proposed right into account.

## B. Substance of the Right to Be Forgotten

### I. Basis in the Right of the Personality

#### 1. Continental Europe

- 5 In Continental Europe, the right to be forgotten can be considered as being contained in the right of the personality, encompassing several elements such as dignity, honor, and the right to private life. Manifold terminologies are used in the context of the right of personality – mainly the right for the (moral and legal) integrity of a person not to be infringed and for a sphere of privacy to be maintained and distinguished. The (privacy) right to indeed keep certain things secret has already been arguably extended to the right of Internet users not to make their activity trails available to third persons.<sup>9</sup> Essentially, rightholders are relying on their own autonomy to individually decide on the possible use of their own data.<sup>10</sup>
- 6 In most Continental European countries, there is wide court practice available delineating the extent to which (Internet) media have a right of their own to reveal information about a specific person, who in turn may claim the right to enjoy the protection of private life (privacy).<sup>11</sup>
- 7 Switzerland is a good example for the development of the right to be forgotten. After a first groundbreaking decision forbidding an artist to present a painting of the famous late Swiss painter Hodler in an art gallery,<sup>12</sup> courts have mainly dealt with situations in which a convicted person wanted to avoid information about earlier criminal records (of an official or unofficial nature) being drawn to public attention:<sup>13</sup> Since criminals do not remain of interest to the public indefinitely, the public should not have access to the respective records after a certain time period.<sup>14</sup> Insofar, court practice acknowledges an individual’s right to be forgotten as a criminal.<sup>15</sup> For the courts, the discretion in interpreting the term “substantial amount of time” that has passed since the occurrence of criminal activity, therefore removing the interest of the public in being reminded of these events, is rather broad; obviously the evaluation depends upon the circumstances, such as which information is no longer of public interest and possibly counterproductive to the goal of rehabilitating the person in question.<sup>16</sup> Consequently, privacy concerns might preclude the media from revealing certain truths and previously publicized facts if the information is no longer newsworthy, but when the information about the past is still needed to protect the public in present times, a right to be forgotten cannot be invoked.<sup>17</sup>
- 8 Similar discussions are also being held in other Continental European countries. In Germany, for example, following the famous *Lebach* decision of the Constitutional Court,<sup>18</sup> several court proceedings have taken place in view of a possible interpretation of the right to be forgotten;<sup>19</sup> court practice has thereby applied a differentiated approach, evaluating the circumstances of the case (push or pull service, importance of criminal activity, etc.). Apart from the question how relevant criminal records should be after the expiration of a certain time period, aspects of involvement in political movements (for example, during World War II or as a member of the ruling party in the former German Democratic Republic) are also debated issues. Furthermore, the Spanish Data Protection Authority (EAPD) recently accused Google of invading the personal privacy of users, arguing that the company was in breach of the right to be forgotten as acknowledged in the laws of Spain.<sup>20</sup>
- 9 During the last decades, national court practice has been condensed and further developed in the judgments of the Human Rights Court in Strasbourg based on the European Convention on Human Rights (hereinafter ECHR).<sup>21</sup> The Human Rights Court in Strasbourg has rendered many decisions by applying a balance-of-interests test between the fundamental right to privacy (Art. 8 ECHR) and the freedom of speech (Art. 10 ECHR); however, the right to be forgotten has not yet been specifically addressed. In the case of Caroline von Hannover, who (unsuccessfully in Germany) initiated legal actions against photographers who took pictures from her daily life involving activities of a purely private nature, the Human Rights Court at least expressed the opinion in the field of traditional media that the information distribution should be limited by the interest of the concerned person not to make public very personal or even intimate information, and that the state

would be obliged to protect this interest.<sup>22</sup> Closer to the “forgetting” topic, the Human Rights Court recently clarified the relation of the freedom of media vis à vis the rights of privacy in a specific case (relating to Norway) in which a person with a criminal record invoked the presumption of innocence and the “right to be forgotten.” The Court concluded that the publication had gravely damaged the person’s reputation and honor and had been especially harmful to the person’s moral and psychological integrity; the reasoning was based on privacy considerations in general, not on the right to be forgotten.<sup>23</sup>

## 2. United States

- 10 In Anglo-American court practice, particularly in the United States, the right of free speech according to the First Amendment has been applied in favor of the dissemination of truthful information relevant to the public interest about convicted persons.<sup>24</sup> Since the First Amendment to the US Constitution plays a particularly important role in court practice and seems to have reached a prevailing level as an entrenched right in comparison with other fundamental rights,<sup>25</sup> US courts rather tend to the statement that restrictions to the right of free speech would “invite timidity and self-censorship and very likely lead to the suppression of many items that would otherwise be published and that should be available to the public.”<sup>26</sup> For decades, court practice defined the potential scope of a right to be forgotten in quite a narrow way since the justification for limiting the freedom of speech was tied to the constitutional scrutiny of “highest order” of public confidentiality interest, making it very difficult to satisfy this standard.<sup>27</sup>
  - 11 Theoretically, disclosure could also constitute a tort according to the Second Restatement of Torts;<sup>28</sup> however, the Supreme Court did overturn a decision of a Florida court granting compensatory and punitive damages to a victim of disclosure.<sup>29</sup> Legal doctrine has shed light on the “public significance test” as developed by the Supreme Court and applied under the Restatement’s public disclosure tort; however, the interests-balancing test between the right of a democratic society to be informed and the claim of an individual to have a right to be forgotten is usually interpreted in the favor of society and civic values.<sup>30</sup> The privacy right seems to prevail only if sensitive information is disclosed after interventions into the private sphere have been done in frivolous and socially irredeemable forays.<sup>31</sup>
  - 12 This restrictive approach also seems to be the reason why the case of Andrew Feldmar, who had a criminal record because of violating anti-drug laws by taking LSD in his younger years, is discussed at length by Mayer-Schönberger from a US perspective under a data retention angle;<sup>32</sup> if this case had happened in Continental Europe, the appreciation would “naturally” have been done under the aspects of personality rights as described above (and would probably not have caused any specific problems related to the digital memory of the Internet).
- ## II. Limits of the Right to Be Forgotten
- 13 The EU approach mentioned above (similarly to the earlier French approach) would introduce a right to be forgotten that would allow an individual to have his or her data deleted. However, the proposal so far does not clearly explain how this right could actually be enforced or how the deletion could be done in practice. Various problems in this context must be taken into account:
  - 14 Privacy or a right to keep personal information confidential can be in conflict with other rights, such as free speech, and other privileges related to the free use of the web. Obviously, as already outlined, there is a court practice that balances the interests of privacy advocates against the freedom-of-speech defenders, and trade-offs are also needed in the real world.<sup>33</sup> Nevertheless, in the context of Internet communications, legal doctrine clearly refers to the fact that protection of the right to privacy is so difficult since it would mean “a right to have the government stop you from speaking about me.”<sup>34</sup> Furthermore, this traditional concept is increasingly confronted with the fact that social networks such as Facebook are assuming an information-transporting function that might extend the implied consent of the person concerned (like Stacy Snyder) to upload a photo. In addition, the question remains whether the right to be forgotten is actually a “privacy” right since privacy concerns information that is not publicly known. In contrast, the right to be forgotten would turn public information into private information at a certain time by no longer allowing third persons to access such information.<sup>35</sup>
  - 15 A further (practical) obstacle consists in the fact that Internet users consider censorship damaging and go to lengths to circumvent it. As recent experiences with the attempt of many governments to block access to the Internet have shown,<sup>36</sup> interested persons generally find a way to communicate electronically. With improved technology, it is becoming increasingly difficult for governments and private persons to contain certain information.
  - 16 Finally, a cultural aspect must be taken into account: The question needs to be raised to what extent society has changed, as assumed for example by Mark Zuckerberg of Facebook.<sup>37</sup> Many people seem happy to make the trade-off in favor of sharing more about themselves in exchange for services and convenience (or they are at least not aware of the consequences of their behavior).<sup>38</sup> The enforcement problem is also confronted with the (legal) question whether the

government should “punish” those who use information that someone has voluntarily published on the Internet; legally, the time-oriented range of a given consent to publish is at stake.

- 17 Privacy protection must equally be reflected against the background of disclosure related to data that are, in fact, collected. This approach would require better monitoring by websites; when used correctly, these systems benignly aggregate information about behavior online. Indeed, first attempts have been undertaken to establish a search engine industry that would offer services to “bury” information which an Internet user may want to have forgotten so that it only turns up deep in any search results.<sup>39</sup> Insofar, sophisticated technology could play an important role in the information-gathering spectrum in the future.<sup>40</sup>
- 18 As shown, the environment for a new fundamental right to be forgotten is complex. Therefore, it is worth evaluating whether or to what extent general data protection principles can contribute to the concretization of such a new right.

### C. Right to Be Forgotten as Data Protection Promoter?

#### I. Origins of Data Protection as Privacy Condensation

- 19 Some one hundred years ago, Supreme Court Justice Louis Brandeis stated the famous sentence:<sup>41</sup> “Publicity is justly commended as a remedy for social and industrial deceases. Sunlight is said to be the best of disinfectants; electric light the most efficient policeman.” Some twenty years earlier, Brandeis, together with Samuel Warren, advocated for the right to privacy.<sup>42</sup> This concept, pioneered in 1890, was created to protect an individual’s sphere of confidentiality;<sup>43</sup> in particular, the right to privacy was understood as the “right to be let alone.”<sup>44</sup> This right focuses on commercial matters, business methods in general, and also on governmental actions.<sup>45</sup> Some years later, Brandeis referred in a dissenting opinion to “subtler and more far-reaching means of invading privacy [that] have become available.”<sup>46</sup>
- 20 The general legal and even philosophical approach of Warren/Brandeis did not immediately lead to legislative actions and was mainly directed against data collections undertaken by governmental agencies and large corporations; the “right to be let alone” did not encompass the right to be forgotten. Moreover, only after World War II and the first economic recovery in Europe did national governments realize that data protection issues must be tackled.

Historically, the movement is also linked to the development of the first big computer machines. Furthermore, an obvious tension exists between data protection and information access: The design of the scope of one’s area of rights influences the other’s area of rights, i.e., an extension of data protection diminishes information access rights and vice versa. The following overview of the release of data protection laws as well as information access laws (as the other side of the information flow coin) shows that this interrelation has often not been properly taken into account.<sup>47</sup>

Country	Data Protection Law	Information Access Law
Sweden	1973	1766
USA <sup>48</sup>	1974	1966
Germany (Brandenburg)	1977	1999
France	1978	1978
Norway	1978	1970
Denmark	1978	1985
Austria	1978	1987
Iceland	1981	1998
Australia (on national level)	1982	1982
Quebec (Canada on national level 1983) level)	1982	1983
United Kingdom	1984	2000
Finland	1987	1951
Netherlands	1988	1991
Ireland	1988	1997
Portugal	1991	1993
Hungary	1992	1992
Switzerland	1992	1993
Belgium	1992	1994
Spain	1992	1992
New Zealand	1993	1982
Italy	1996	1990
Greece	1997	1986

- 21 As shown, data protection laws have developed over the last 50 years, and the building of coherence with Internet access rights is remote; moreover, seen from a general angle, the release of data protection provisions has gone along with particular technological developments; insofar, four generations of norms can be distinguished:<sup>49</sup>
  - ▶ *First-generation laws:* The legal provisions were a reaction to the attempt of governmental and private organizations to collect data in central databases, thereby realizing a “big technical risk.”
  - ▶ *Second-generation laws:* Over time, data collections moved from big machines to small, decentralized IT equipment in governments and businesses. This has changed the scope of the

risk potential and caused the legislator to include a broader number of entities in the regulatory framework.

- ▶ *Third-generation laws:* Due to increasing data collection activities, the need for the constitution of an individual right to self-determination and participative concepts became apparent.
- ▶ *Fourth-generation laws:* In view of the fact that self-determination rights have not worked out as envisaged in reality, the need for sectorial data protection provisions – and in particular of data security rules – gained importance.

22 As a lesson from the historical developments described above, the conclusion can be drawn that reliance on an individual (human) right has proven not to be satisfactory in all respects. In particular, the autonomy of the individual in respect of the use of his/her data cannot be considered as an uncontested principle. Consequently, this experience should be kept in mind with regard to the proposed implementation of a new “right to be forgotten.”

## II. Data Protection as a Cluster Concept

23 Already 40 years ago, Arthur R. Miller described the risk of an assault on privacy;<sup>50</sup> ten years ago, legal scholars invoked the notion of the “death of privacy.”<sup>51</sup> Indeed, privacy is at risk; however, awareness has been rising over the last few years and legislative activities are taking manifold directives. Nevertheless, as Anne Cheung convincingly points out, the Internet “requires us to re-examine privacy as a concept.”<sup>52</sup> In order to come to a stable framework for legal provisions and to identify the possible scope of a new fundamental “right to be forgotten,” the sociological and philosophical basis of privacy must be evaluated in more detail.

### 1. Foundation of Privacy Elements

24 According to Lisa Austin, “technology creates privacy issues that appear to fall outside the bounds of our traditional analysis ... we need to sharpen and deepen our understanding of traditional concerns regarding privacy in order to respond to these new situations.”<sup>53</sup> Consequently, a multi-dimensional approach is required, and privacy must encompass “the ability to control and limit physical, interactional, psychological and informational access to the self or one’s group.”<sup>54</sup> (i) The physical dimension refers to how physically accessible an individual is to others; (ii) the psychological dimension looks at an individual’s right to decide with whom he or she shares personal information as well as the control of affec-

tive/cognitive inputs or outputs (e.g., non-verbal communication); (iii) the social dimension encompasses the ability to control social interactions; and (iv) the informational privacy dimension addresses an individual’s right to reveal personal information to another.<sup>55</sup>

25 Recently, Hayden Ramsay identified five forms of privacy and analyzed them from a philosophical angle:<sup>56</sup> (i) The first privacy element refers to the control over the flow of information, in which freedom and individuality are not considered the only values of social life, but also truthfulness and practical wisdom; furthermore, privacy should not be limited to controlling information but extended to the risk of invasion of privacy. (ii) The second privacy element concerns the freedom from interference and observation; insofar, according to Ramsay, the threat of loss of autonomy does not adequately explain the meaning of violation and danger people experience with the most serious attacks on their privacy. (iii) The third privacy element looks at the maintenance of a sphere of inviolability around each person, which can be seen as a substantial moral good contrasting to the lack of respect for the value of persons. (iv) The fourth privacy element constitutes the need for solitude as already discussed by Warren/Brandeis. (v) The fifth privacy element can be identified in the term of “domesticity,” asking for safety from observation and intrusion.

26 In light of the many privacy elements described above, data protection constitutes a “complex concept” requiring a consideration of these elements in view of their structural interrelations; consequently, the realization of a “cluster concept” seems to be unavoidable.<sup>57</sup> Such a “clustering” of data protection should concern a concept that ranges over information, access, and expressions. Thereby, autonomy must play an important role, also in view of the possibility to adequately react to new developments. The multi-dimensional nature of such an approach looks at informational privacy, accessibility privacy, and expressive privacy; these three aspects need to be combined and condensed to theories of privacy that include control over information, limited access, and personhood.<sup>58</sup> Informational privacy refers to control over information, accessibility privacy focuses on central observations of physical proximity, and expressive privacy protects a realm for expressing one’s self-identity.<sup>59</sup> In view of a new “right to be forgotten,” the relevant aspects of this cluster need to be identified, analyzed, and condensed into a rights structure.

## 2. Need for a More User-Centered Approach

- 27 The elements described above as a “cluster concept” must be realigned in view of the rights-oriented appreciation that data protection as a condensation of privacy is a “value” that needs to be understood as an aspect of autonomy of individuals containing both freedom from undue demands to conform and freedom to control one’s own information.<sup>60</sup> Among the different constituents of privacy, autonomy is a key element.<sup>61</sup> This element advocates for a more user-centered approach encompassing a broad transparency range. When users are online, it must be clear what is happening, who/where personal information is sent to, who is collecting this personal information, as well as if and how such personal information is being transferred to third parties. In particular, users need to be provided with understandable and (in light of the good faith principle) acceptable terms of services, including options to influence the collection of personal information.
- 28 The more user-centric approach leads to theories looking at default licensing rules of personal information, thus ensuring that individuals retain their control (and power) over their information. This could preserve flexibility based on accepted mechanisms rather than relying on complex (and somewhat rigid) legal tools.<sup>62</sup> Another voice proposed focusing on the context in which information gathering and dissemination takes place; insofar, rights protecting individuals’ information power could ensure that this context aspect remains connected to the personal data (a corollary to the purpose limitation principle).<sup>63</sup> Consequently, it is argued that the concept of property is sufficiently flexible and adjustable to work for information privacy.<sup>64</sup> Seen from this angle, privacy is understood as a bundle of interests related to information property that can be shaped through the legal system.<sup>65</sup>
- 29 Another approach applies a taxonomy based on the transactional scenarios and distinguishes between information collection (surveillance, interrogation), information processing (aggregation, identification, insecurity, secondary use, exclusion), information dissemination (breach of confidentiality, disclosure, exposure, increased accessibility, blackmail, appropriation, distortion), and invasion (intrusion, decisional interference).<sup>66</sup> This concept begins with the data subject (the individual) from which various entities (other people, governments, businesses) collect information. The qualification of the processing of information depends on the harmfulness of the respective activities. The next step consists in the information dissemination, which brings the potential control of the information even further away from the concerned individual. Finally, privacy could be (illegally) invaded by third persons.<sup>67</sup>
- 30 More attention should also be paid to the perspective of understanding information privacy in a functional sense as a type of public value since it benefits and shapes society. From this vantage point, information privacy shows characteristics of a commons that requires some degree of social and legal control to construct and then maintain;<sup>68</sup> consequently, data protection approaches are becoming a part of social policy.<sup>69</sup> In this sense, the privacy commons is a multidimensional “territory” that should be ordered through legislation structuring anonymous and semi-anonymous information spaces; therefore, the propertization of personal information should be limited to the extent it undermines the privacy commons.<sup>70</sup>
- 31 In a nutshell, the different models described rely to a great extent on individual autonomy. Autonomy as such could mean that the individual is entitled to control the information. However, such an approach does not take into account the public interests (such as ordre public, security interests, etc.). Therefore, the application of a balancing test seems to be unavoidable. Before going into the respective details, the theoretical approaches already discussed in this field will be evaluated.

## III. Privacy Risks’ Mitigation by Data Protection Rules

### 1. Potential Legal Responses

#### a. Overview

- 32 The most extensive attempt to apply data protection principles in the context of the right to be forgotten has been undertaken by Mayer-Schönberger. In his seminal book *Delete*, which is inspiring intensive debate in the United States but is not yet fully appreciated in Europe, Mayer-Schönberger discusses in depth seven potential (legal) responses that could mitigate the ills of digital memory.<sup>71</sup> Six of these responses are described in relatively short comments, while the seventh is explained in far-reaching detail:
- ▶ *Digital abstinence*:<sup>72</sup> At first sight, the solution of digital abstinence seems to be simple and straightforward since it is based on choice and autonomy (at least in transparent circumstances): If persons are staying away as much as possible from interactions that require revealing information to others, less “critical” information will be available. However, several problems cannot be overlooked: Digital abstinence is definitely based on individuals’ knowledge and preferences not being identical throughout the whole civil society. Consequently, people’s be-

havior would have to be influenced. Furthermore, the sharing of personal information offers users values that contradict the limitation of digital memory; indeed, the participation of millions of Internet users around the world in creating content has unleashed innovative and beneficial forms of information production that would not have been possible in a world of digital abstinence.<sup>73</sup> Businesses as well would have to adapt their practices and accept substantial limitations to digital remembering.

- ▶ *Information privacy rights:*<sup>74</sup> This approach is based on the notion and concept of informational self-determination: Individuals should have control over every phase and stage of the use of their personal information. As experience has shown in practice, however, the principle of consent to data collection as an expression of self-determination is very difficult to enact; furthermore, a look at court practice also demonstrates that liability claims against data collectors not complying with data protection laws are very rare. Certain procedural measures could obviously be introduced, such as shifting the burden of proof to the data collector that the individual concerned has agreed to the digital remembering. Another approach tries to underlay the right to self-determination with a property rights concept; the elements of this concept have already been outlined.<sup>75</sup>
- ▶ *Digital privacy rights infrastructure:*<sup>76</sup> More than 10 years ago, Lawrence Lessig suggested using Digital Rights Management (DRM) infrastructure as a means to protect technical code.<sup>77</sup> DRM was developed for intellectual property rights, mainly by the (Hollywood) entertainment industry in its attempt to prevent the copying of protected works. In the meantime, even DRM's promoters are no longer so convinced that this infrastructure provides an adequate protection measure. Even more questions are justified if DRM is to control personal information. Any system capable of making judgments would have to watch how users handle protected information.<sup>78</sup> Therefore, the risk exists that a technical infrastructure of pervasive surveillance would be created (a panopticon to protect from the Internet society). Further problems concern the related costs and practicability of a new technological infrastructure.<sup>79</sup>
- ▶ *Cognitive adjustment:*<sup>80</sup> This approach would not require changing society through the adoption of law or the development and implementation of a novel technical infrastructure, but the necessary changes would take place in the minds of civil society. Whether such a change could be re-

alized is another question; acknowledging cognitive adaptation related to a comprehensive digital memory might be an expectation that is too ambitious.

- ▶ *Information ecology:*<sup>81</sup> Advocates for a more stringent and comprehensive information ecology have been raising their voice for many years and asking information processors to slow down the speed of information collection and storage.<sup>82</sup> However, several conceptual weaknesses cannot be overlooked – for example, the problem that mandated information ecology might be a binary tool and that practical experience with norms trying to realize information ecology shows the difficulty of getting them politically enacted. Finally, such norms are confronted with a certain lack of built-in flexibility.
- ▶ *Perfect contextualization:*<sup>83</sup> This approach tries to apply the “knowledge” of technical systems in remembering information and in limiting data collection of information not related to the given context. Obviously, a technically perfect contextualization will never be possible. In addition, such systems need sustained attention, which is not always available.

33 Mayer-Schönberger summarizes the above six responses to the demise of forgetting under the headings of “Information Power” and “Cognition” as follows.<sup>84</sup>

	<b>Information Power (incl. information privacy)</b>	<b>Cognition, Decision-Making and Time</b>
Individuals	Digital abstinence	Cognitive adjustment
Laws	Privacy rights	Information ecology
Technology	Privacy DRM	Full contextualization

- b. Expiration Dates on Digital Data in Particular
- 34 The seventh response to the demise of forgetting is the already briefly mentioned introduction of expiration dates on digital information.<sup>85</sup> Mayer-Schönberger argues that, technically (design challenges for the most appropriate user interface aside), expiration dates would be relatively easy to implement (just as another type of meta-information associated with a piece of information). Thereby, the role of information processors would become more important, and the development of algorithms that would better approximate what kind of information should still be available for use would become crucial. If expiration dates on information files are not sufficient,

a more fine-grained approach is necessary, described by Mayer-Schönberger as the expiration of information bits.<sup>86</sup> Technologically, this concept looks at cookies as well as the expiration date for web page links and web search queries. The advantages of such measures are that individual users would not be required to become familiar with complex new technologies; they would only need to be aware of how to set expiration dates at any given moment.

- 35 Furthermore, Mayer-Schönberger also discusses the possibility of negotiating expiration dates.<sup>87</sup> Indeed, particularly in contractual transactions, two parties often have different opinions about the expiration date. In such a case, each individual should independently determine the duration of the digital memory; if the dates do not correspond, a joint understanding must be negotiated just like other contractual issues.
- 36 The new concept of introducing expiration dates for digital information is a challenging approach. Nevertheless, certain weaknesses cannot be overlooked: The ubiquity of social networking nowadays is so extensive that the introduction of “expiration dates”<sup>88</sup> requiring somebody (who?) to delete the information is difficult to apply in practice. Furthermore, the proposal of “expiration dates” also seems to be inadequate and deficient in and of itself since the approach focuses on self-censorship or a lack thereof, contradicting the human desire to chronicle life (to the smallest and most trivial detail) and to immortalize previously fleeting memories.<sup>89</sup>

## 2. Potential Technological Responses

- 37 As already mentioned, technology also plays a role in the triangle between identity, memory, and privacy; as of now, governments and civil societies are still struggling with new technological realities. Indeed, technology can provide solutions which - if embedded adequately - can contribute to overcoming data protection concerns.<sup>90</sup> In practical life, various factors are responsible for the prevailing public uncertainty with technology: Apart from a general reluctance to learn new techniques, the technology is often highly complex, making it difficult or at least cumbersome and time-consuming to apply (for example, in the context of electronic signatures). In addition, the positive aspects of technology can easily morph into negative results (from self-control to being controlled by others).
- 38 The development and proliferation of devices that provide “Continuous Archival and Retrieval of Personal Experiences” (CARPE) is a good example: In realizing the concept of autonomy, such technologies could improve the control over, the access to, and the record of collective knowledge, but they can also be used by third persons to exert control in their

own interest.<sup>91</sup> Such technologies are based on the desire for individual control over the devices, and such individual control might prove determinative in the quest for individual and collective empowerment through these technologies; however, social forces undermine the ability of all netizens to enjoy control equally.<sup>92</sup> In other words, technological parameters that rest on an atomistic concept of relatively autonomous individuals do not reflect the practical reality.<sup>93</sup> Therefore, CARPE devices often do not live up to their perceived potential because they do not operate in a social vacuum.<sup>94</sup> In the end, this question arises: How much privacy are individuals prepared to surrender in order to achieve other purposes (such as social recognition or an increase in security)?<sup>95</sup>

- 39 The aforementioned evaluation demonstrating some reluctance as far as technologies are concerned does not mean that any single approach should not be implemented. To the contrary, a number of technologies are available to achieve information privacy goals. In particular, Privacy Enhancing Technologies (PETs) can be oriented on the subject, the object, the transaction, or the system. Subject-oriented PETs aim at limiting the ability of other users to discern the identity of a particular organizational entity; object-oriented PETs endeavor to protect identities through the use of a particular technology; transaction-oriented PETs have the goal of protecting transactional data, e.g., through automated systems for destroying such data; and system-oriented PETs are designed to create zones of interaction where users are hidden and objects bear no traces of data streams handling them nor records of interactions.<sup>96</sup> Furthermore, technical developments require assessment capacity and capability, which need to be pooled on a global level; some institutionalized format for pooling available resources of data protection agencies on an international level will have to be found, thus dipping into the resources of technology assessment institutions worldwide.<sup>97</sup>
- 40 Notwithstanding the fact that technology is able to substantially back up the idea of giving each individual the possibility to autonomously control the life of his/her data, it cannot be overlooked that, in principle, technology should have a serving function; it cannot replace the legislator in designing the scope and limits of a new fundamental “right to be forgotten.”

## D. Outlook

- 41 With the increased tendency to make information of all kinds public, privacy is at risk. Notwithstanding existing and planned data protection laws, new fundamental right concepts are being developed as a consequence. Some two years ago, the German



Constitutional Court “invented” a so-called “computer confidentiality and integrity right” designed to avoid third-party interference with the personal electronic communication network.<sup>98</sup> About a year ago, as mentioned, a right to be forgotten was proposed by France and then by the European Union in the context of the revision of the Data Protection Directive 95/46.<sup>99</sup> Nevertheless, as of now there is still no concrete description of the right’s scope and contents.

- 42 In the form proposed by the European Union, the right to be forgotten cannot easily render a substantial contribution to an improvement of data protection. The concept is probably too vague to be successful. History has shown that human rights need to be embedded in strategies, and such strategies have to be actually used.<sup>100</sup> Consequently, a clearer picture of the actual objective of a new fundamental right is necessary. The proclamation of a right to be forgotten as such does not suffice. It recalls the myth of Pandora’s box: Impelled by her natural curiosity, Pandora opened the box and all the evils contained in it escaped. Moreover, a concretization of the right to be forgotten might be achieved by more specific codes of conduct, such as the French “Code of Good Practice on the Right to Be Forgotten on Social Networks and Search Engines,” encompassing practical commitments that could become the starting point for a future international memorandum or agreement.<sup>101</sup>
- 43 The right to be forgotten must be complemented with legal instruments to guide individuals and entities on how to apply data protection principles on the basis of the acknowledgement of rightholders’ autonomy. Together with such guidelines, accountability mechanisms need to be introduced and audit procedures should be established.<sup>102</sup> Possible means could be privacy marks or seals from a self-regulatory regime, which would then be monitored by established data controllers according to accountability procedures applied by the program or scheme organization. Such an “evaluation” also corresponds to the democratic theory that holds governing bodies accountable in responding to the public’s interest.<sup>103</sup> This would enable technical measures to be introduced much faster than legal instruments, and the technical measures would have a global scope of application that is not limited by geography.<sup>104</sup> Returning to Pandora’s situation: By the time she managed to close the lid, nearly the entire contents had escaped. Only one last thing lay at the bottom, and that was hope.

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# Creative Commons licences and design

## Are the two compatible?

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**Abstract:** This article analyses whether Creative Commons licences are applicable to and compatible with design. The first part focuses on the peculiar and complex nature of a design, which can benefit from a copyright and a design protection. This shows how it can affect the use of Creative Commons licences. The second and third parts deal with a specific case study. Some Internet platforms have recently emerged that offer users the possibility to download blueprints of design products in or-

der to build them. Designers and creative users are invited to share their blueprints and creations under Creative Commons licences. The second part of the article assesses whether digital blueprints can be copyrightable and serve as the subject matter of Creative Commons licences, while the last part assesses whether the right to reproduce the digital blueprint, as provided by Creative Commons licences, extends to the right to build the product.

**Keywords:** Creative Commons licences, open content, design, design law, copyright, right of reproduction, digital blueprints, third-dimensional representation, right of adaptation, derivative works approach

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## Introduction

1 New technologies have changed the way designers create and distribute their works. They use computer programs to conceive everyday objects – such as lamps, furniture, toys and electronic devices – as well as to draw their digital plans. They also use the Internet to share and distribute their digital files. During the last few years, several online platforms have emerged to host designers' digital files. These sites offer Internet users the possibility to construct product designs based on digital blueprints and encourage them to build upon the designs.<sup>1</sup> This new trend is known among the community of designers as the Do-It-Yourself (DIY) culture, referring to the fanzine movement of the 1940s where producers (fans of magazines) of small, non-commercial and non-professional publications privileged the “do-it-yourself” under the motto “make your own culture and stop consuming that which is made for you”.<sup>2</sup>

2 By disseminating their digital blueprints on specific platforms, designers are not only sharing their creations but are also encouraging co-creation. One of the features of these platforms is to invite designers to distribute their digital files or creations under an open content licence such as Creative Commons (CC) licences.<sup>3</sup>

3 These examples will constitute a good case study to analyse whether designs can be shared under a Creative Commons licence. To answer this issue, we will define in a first section (Part A) what a design is and explain the type of protection it can benefit from. The notion is rather complex and mainly subject to copyright law and design law. Rules at international, European and national levels can diverge greatly in that respect. We will see how the interaction between these two types of protection is crucial to determine how and whether Creative Commons licences can be used to share design works. This first section will identify some incompatibilities between the licences and design and propose some possible solutions.

- 4 The second and third sections of the article will assess the consequences of the use of Creative Commons licences on the digital blueprints and their 3-D representation. Part B will determine whether the nature of digital blueprints makes them compatible with Creative Commons licences as subject matter, and Part C will consider whether the 3-D creation of the product design based on the digital blueprint constitutes a reproduction of this blueprint and is authorised under a Creative Commons licence.
- 5 This article will describe in detail the international and European frameworks applicable to design. To illustrate the principles established at higher levels, the case of French law and case law will specifically be considered. The French jurisdiction constitutes a good illustration in terms of design because of the level of protection (under copyright law and design law) that a design can enjoy. References to other national laws might also be made, but only to make a specific point. Finally, the features of the Creative Commons licences will not be outlined, but references to existing articles and research on this topic will be added.<sup>4</sup>

## A. Complex nature of design

- 6 The term “design” does not have a single meaning. Depending on its context, it can refer to a discipline, a topic or a style but also to the appearance of an object.<sup>5</sup> Although some typologies are used to describe design of goods or services, they are not universal.<sup>6</sup> In the UK, for example, the Chartered Society of Designers<sup>7</sup> distinguishes product designs covering three-dimensional industrial products (such as tools, hardware, furniture, fashion and textile design) from environmental designs (including works of architecture, building, units and elements, exhibit and display) and graphic designs, generally covering two-dimensional elements that can be painted, drawn or printed (such as patterns, cards and wrapping papers).<sup>8</sup> The platforms we are referring to mainly propose to download digital blueprints of product designs. We will therefore focus our analysis on the protection of this type of design.
- 7 The peculiar nature of designs is linked to the industrial revolution, which met consumer demands at the time with mass production and product innovation. Product designs were considered industrial products. It was only later, at the beginning of the twentieth century, that industrial designers started to be seen as artists. During this same period, the boundaries between art and design started to blur, creating confusion and uncertainty concerning the protection granted to designs.<sup>9</sup>
- 8 Their complex nature is reflected in the different legal instruments protecting designs. At the international level, the two major treaties of reference, the Berne Convention and the Paris Convention, protect the copyright and industrial nature of designs, but they do not define the concept. At the Community level, the applicable European framework goes a step further by providing a definition and imposing protection under both copyright and design laws.

## I. International protection of a design

- 9 The hybrid nature of a design, considered either as a functional product combining artistic features or as an artistic product containing technical elements, shows the complexity of a design from an intellectual property perspective.
- 10 **Copyright approach of the Berne Convention:** Article 2 (1) of the Berne Convention sets up an extensive but non-exhaustive list of protectable subject matter under copyright law. The list includes (a) two-dimensional works, whether purely artistic (such as drawings and paintings) or not (such as maps, illustrations, plans and sketches) and (b) three-dimensional works, whether purely artistic (such as sculptures and engravings) or not (such as works relative to geography, topography, architecture and science). The list also mentions works of applied art. Copyright law can therefore protect works of pure art as well as works of art applied to utilitarian objects. It should be mentioned that the inclusion of works of applied art in the list of copyrightable works has provoked intensive debates and discussions among members of the Berne Union and, as a consensus, a category was added providing that national legislations would be free to define the notion.<sup>10</sup>
- 11 Article 2 (7) of the Convention refers to this option left to individual countries that may decide under their national law how works of applied art and designs (referred to as *industrial designs and models*) should be protected,<sup>11</sup> provided they apply a condition of reciprocity.<sup>12</sup> The Convention does not contain any further guidance and does not state whether works of applied art and industrial designs should constitute a single category of work or two separable types of work. In applying this article, members of the Berne Union can be split among (a) countries granting a cumulative protection for works of applied art under copyright and designs laws, without the need to distinguish them from industrial designs;<sup>13</sup> (b) countries granting a partial cumulative protection and setting up the conditions under which a design can be considered a work of art;<sup>14</sup> and (c) countries clearly distinguishing artistic works from industrial designs.<sup>15</sup> In the latter case, industrial designs are only protected under a specific design law and cannot benefit from copyright protection. If the shape can be separated from the product, then the shape alone can benefit from copyright pro-

tection.<sup>16</sup> The theory of “separability” dissociates the design from the product in which it is embodied.

- 12 **Patent-type approach of the Paris Convention:** According to Article 1(2) of the Paris Convention, industrial designs are a category of industrial property and shall be protected in all the countries of the Paris Union.<sup>17</sup> However, the Convention does not define the notion and leaves it to national legislations. No further guidance on the criteria of industrial design is provided, except in the non-binding *Guide to the application of the Paris Convention*, in which its author, Bodenhausen, defines industrial designs as “the ornamental aspects or elements of a useful article, including its two-dimensional or three-dimensional features of shape and surface, which makes up the appearance of a product”.<sup>18</sup>
- 13 Further, members of the Convention apply a national treatment principle, i.e. they must grant the same protection to their own nationals and nationals of other members, and comply with a minimum standard of rules (in terms of right of priority, grant of compulsory licences or prohibition of forfeiture designs).<sup>19</sup> However the Convention does not contain any provision specifying whether designs should benefit from a *sui generis* protection or from a copyright protection,<sup>20</sup> and whether they should be registered to receive protection.<sup>21</sup>
- 14 **Complementary protection of the TRIPS Agreement:** The TRIPS Agreement follows and supplements the Berne and Paris Conventions. Article 25 (1) of the Agreement does not define industrial designs but states that members must provide for the protection of independently created industrial designs, which are new and original and can exclude from their scope designs that are purely technical or functional.<sup>22</sup> However, the Agreement does not provide any guidance on the relationship between works of applied art and industrial designs. It is not clear whether the type of protection granted under Article 25 (1) is a copyright protection (reference to independent creation and originality) or a *sui generis* design protection (reference to the novelty criterion) or both.<sup>23</sup> Only concerning textile design does the Agreement specify that members are free to provide protection under copyright law or under a specific design law.<sup>24</sup>
- 15 The international framework applicable to design is completed by other Conventions and Agreements, such as the Hague Agreement setting up procedural matters for the international deposit or publication of designs and the Locarno Agreement establishing an international classification for the registration of industrial designs.<sup>25</sup> The rules set up at the international level are subject to national laws and only determine minimum standards. As a consequence, designs can be protected under a specific law, as well as under copyright and patent laws. In addition, the

Berne Convention permits, but does not impose, a cumulative protection.

## II. Sui generis approach of the European protection

- 16 The absence of harmonisation of national laws on the protection of designs has had an impact on the Community market. In 1991, the European Commission published a Green Paper on the legal protection of industrial design in which it proposed the adoption of a *sui generis* protection for industrial designs.<sup>26</sup> Both a copyright approach and a patent approach to protect designs at the EU level were rejected. Instead, a specific protection was set up to harmonise national laws as well as to create a Community Design System for registered and unregistered Community designs. The Green Paper resulted in the adoption of two instruments: Directive 98/71/EC (hereinafter referred as Design Directive)<sup>27</sup> and Council Regulation No. 6/2002 on Community designs (hereinafter referred as Community Design Regulation).<sup>28</sup>
- 17 In the Directive and Regulation, the term “design” refers to the appearance or composition of a product. The appearance is defined according to a number of features (such as the lines, contours, colours, shape, texture, materials of the product or its ornamentation) that do not constitute an exhaustive list.<sup>29</sup> The design is not required to be aesthetic or functional,<sup>30</sup> and purely technical designs cannot be protected.<sup>31</sup> A design must be new and have an individual character to be eligible for protection. Two designs are considered identical if differences consist of immaterial details. In addition, the overall impression that a design produces on an informed user should differ from the overall impression produced on such a user by any design that has been made available to the public.<sup>32</sup> The protection of a registered design is conferred for a maximum of 25 years from its date of registration and gives exclusive rights against unauthorised use of the design, such as making, offering, putting on the market, importing, exporting or using the product in which the design is incorporated.<sup>33</sup> An unregistered design can only be protected for a maximum of 3 years from the date it is made available to the public (through publication, exhibition, use in trade) and only offers an anti-copying right.<sup>34</sup> The Regulation provides for a registered and unregistered Community design regime, whereas the Directive only harmonises the national regime applicable to registered designs. Although neither the Regulation nor the Directive mentions it, the three-dimensional aspect of a design (shape) or its two-dimensional aspects (ornamentation, pattern) can be protected at the Community level.<sup>35</sup>

- 18 Concerning the link between copyright law and design law, Article 17 of the Design Directive and Article 96 (2) of the Community Design Regulation establish the principle of cumulation of protection with copyright protection. A design enjoys copyright protection from the date of its creation or fixation. However, the conditions under which such a protection is granted as well as the level of originality required are defined at the national level. As a consequence, member states can either apply a total or a partial cumulation of protection. An interesting issue concerns, of course, the application of the cumulative principle to designs that entered into the public domain at the time of the entry in force of the Directive (2001) or Regulation (2002).
- 19 Recently the European Court of Justice (ECJ) rendered a decision concerning the Italian law applicable to industrial designs.<sup>36</sup> Italy, which was one of the few countries to apply the theory of separability, was obliged to amend its law to introduce the principle of cumulation of protection. However, the new law created some doubts concerning its conformity with the Directive as it provided a moratorium (or transitional period) of 10 years for the application to third parties. The issue was whether Italy could exclude from copyright protection – for a period of 10 years or indefinitely – designs which, although they met the requirements for protection, had fallen in the public domain before the date of entry in force of the Directive. The ECJ considered that a balance had to be found between – on the one hand – the acquired rights and legitimate expectations of third parties (manufacturing similar designs that had fallen in the public domain) and – on the other hand – the interests of rights holders.<sup>37</sup> The exclusion of copyright protection for designs in the public domain was only considered appropriate if it was directed at a category of third parties that were entitled to legitimate expectations, i.e. persons who had already performed acts of exploitation concerning the designs in the public domain when the Directive entered into force in Italian law.<sup>38</sup> In addition, the right of these third parties to use designs fallen into the public domain needed to be limited in time.<sup>39</sup> A period of 10 years was considered excessive.<sup>40</sup> In August 2010, the Italian legislature adopted a new article of the Italian Industrial Property Code, which should now comply with the ruling of the ECJ.<sup>41</sup>
- 20 The Design Directive harmonises the definition of design to grant national protection to registered designs. The visible and specific appearance of a design embodied in a product (and not the product itself) is protected.<sup>42</sup> The design is supposed to make it more attractive and more appealing to the customer.
- 21 The definition and characteristics of a design under French law follow the rules set up at the European level. However, the term ‘design’ still refers to the expression ‘designs and models’ (or *dessins et modèles* in French).<sup>43</sup> The most interesting feature of the French regime is the constant position of the national legislature and of national courts concerning a total cumulation of protection under copyright and design law for designs. A long evolution of the law on copyright and designs in France as well as jurisprudence has resulted in the refusal to make any distinction between “pure art” and “industrial art”.<sup>44</sup> Thanks to the “theory of unity of art”, developed by Eugène Pouillet in his “*Traité Théorique et pratique de propriété littéraire et artistique et du droit de représentation*” (1908) and enshrined in the law of 14 of July 1909 on designs and models<sup>45</sup> and later in the law of 11 March 1957 on literary and artistic property for all works of art,<sup>46</sup> copyright protection is extended to all creations of forms. The law of 1957 introduced works of applied art to the list of copyrightable works. French courts relied on different criteria of differentiation (from the mechanical character of the process of reproduction, to the destination or use, and the accessory character of industrial design or model) until they implemented the unitary solution.<sup>47</sup> The principle of “unity of art” does not mean that copyright and design protections should be automatically granted to designs, but only that no distinction should be made between works of art (whether works of applied art or not) and design.
- 22 To be protected under copyright law and design law, a design needs to meet the threshold of originality as well as the criteria of novelty and individual character. Some courts have confused originality with novelty but have been censured by the Court of Cassation, which, for example, in a case concerning the copyright protection of a model of button made clear that only the criterion of originality was required to grant protection under copyright law.<sup>48</sup> The Court of Cassation recently reaffirmed that the “unity of art” does not grant automatic protection under the two regimes and that a design still needs to meet the criterion of originality to be protected under copyright law.<sup>49</sup>

#### IV. Implications of the hybrid nature for the use of Creative Commons licences

- 20 The Design Directive harmonises the definition of design to grant national protection to registered designs. The visible and specific appearance of a design embodied in a product (and not the product itself) is protected.<sup>42</sup> The design is supposed to make it more attractive and more appealing to the customer.
- 23 Following the rules set up at the European level, a design can enjoy copyright protection as well as specific design protection. We have excluded from the scope of this article the case where a design is incorporated into a patentable invention and could also be protected under patent law. Our focus is on the link existing between design and copyright laws to assess the impact on the use of Creative Commons licences.

- 24 The main issue is linked to the fact that Creative Commons licences are only applicable to copyrightable subject matters,<sup>50</sup> whereas designs have a dual nature and can benefit from a dual protection. In countries applying a total cumulation of protection, no distinction is made between the aesthetic elements and the functional elements of a design. They are indivisible. However, designs must comply with the criteria of both rights to enjoy protection. This does not mean that a licence granting rights attached to copyright (such as a Creative Commons licence), which only covers original works, can also be used for new and distinctive (in the sense of individual character) designs. Expressed otherwise, the fundamental rights that are licensed under a CC licence are not the same as the ones that can be licensed for the use of a design under design law.
- 25 Before analysing the compatibilities and incompatibilities that exist between Creative Commons licences and specific design licences, it should be remembered that designers are always free to not license their rights under a design licence. No provision of the Regulation or the Directive requires compulsory licensing. Having said that, the hypothesis at stake concerns a designer who wants to license the rights attached to his design and might want to use a Creative Commons licence to do so.
- 26 **Scope of licensed rights:** A registered design, whether at the Community level or the national level, grants to its holder an exclusive monopoly to exploit the design through the making, offering, putting on the market, importing, exporting or use of a product in which the design is incorporated or is applied to.<sup>51</sup> An unregistered design only confers a right of anti-copying to its right holder.<sup>52</sup> The rights attached to a Community design can be licensed for the whole or part of the Community on an exclusive or non-exclusive basis.<sup>53</sup> The grant of a licence for a registered design must be recorded and published.<sup>54</sup> No similar obligation exists for unregistered designs. The other rules are governed by the national law where the right holder has his seat or domicile.<sup>55</sup> Concerning national registered designs, the grant of licence is also subject to national law. In France, in the absence of specific rules in the *Code de la propriété intellectuelle*, general rules on contracts contained in the French *Code civil* are applicable, i.e. no written contract is required for the validity of the licence, but it constitutes a useful proof of existence of the licence.<sup>56</sup>
- 27 We can already spot incompatibilities with Creative Commons licences, which only license rights attached to copyright. These rights are identified in the licences as the right to reproduce, distribute the work, and depending on the options chosen by the right holder, the right to adapt it or not (the making of derivative work) as well as the right to commercially exploit it or not. Independently of the fact that a Creative Commons licence applies only to copyrightable subject matters, we also notice that the licence does not offer the broad range of rights permitted under the Community Design Regulation for a registered design and seems to be too permissive for an unregistered design, which only confers a right of copy.
- 28 **Length of protection:** Creative Commons licences apply for the duration of the copyright law (70 years p.m.a.),<sup>57</sup> whereas a registered design confers exclusivity for a maximum period of 25 years from the date of its registration<sup>58</sup> and a protection of 3 years for an unregistered design from the date it was made available to the public.<sup>59</sup> The temporal clause of the CC licences cannot match the requirements of the Community regime.
- 29 **Territorial protection:** The rights attached to a Community design can be licensed on an exclusive or non-exclusive basis for the whole or part of the Community, but not further than the Community territory. Creative Commons licences apply worldwide on a non-exclusive basis.<sup>60</sup> The territorial clause as such is not compatible.
- 30 **Commercial exploitation:** The main purpose for registering a design is for its right holder to benefit from an exclusive commercial exploitation of the design. Any licensee will then be granted the right to exploit the design against, usually, the payment of fees.<sup>61</sup> This situation is in contradiction with the royalty-free clause of Creative Commons licences and with the “non-commercial” clause, which prohibits third parties from commercially exploiting the licensed work.
- 31 **Possible solutions:** It is obvious that Creative Commons licences are not the appropriate tools to license rights attached to a design protected by design law. But could a Creative Commons licence co-exist with a specific licence under design law? We need to distinguish the case of registered designs from the case of unregistered designs.
- 32 As explained, the rights granted by a registered design are different from the rights licensed by a Creative Commons licence. Therefore, under the condition that the design licence is delivered on a non-exclusive basis, the two types of licences could co-exist. However, the same analysis is not valid for unregistered designs. The use of a Creative Commons licence in parallel with the use of a specific design licence would lead in that case to an absurd situation. The only right granted by an unregistered design is the exclusive right to copy the design, which can be licensed on a non-exclusive basis to the whole (or part of) the Community for a maximum of three years,<sup>62</sup> whereas the same right for the same design, which could also be considered a copyrightable work, would be licensed on a worldwide basis under



a Creative Commons licence and for an indefinite period of time.<sup>63</sup> The two seem to be in contradiction.

- 33 What would be the solution? For an unregistered design, a solution could be to wait until the design protection has elapsed, i.e. 3 years. However, we doubt that this solution would satisfy designers and creative users who would only share “old” designs under a Creative Commons licence. In addition, the starting point of the protection of an unregistered design is problematic and uncertain as it occurs when the design is made available to the public, and not from the date of creation of the design.<sup>64</sup> In consequence, the only solution would be for a designer to license only his unregistered design, under a Creative Commons, and renounce licensing the right of copy under a specific design licence.
- 34 Concerning a registered design, it seems that a specific non-exclusive licence could co-exist with a Creative Commons licence. It would in any case hardly be conceivable to wait until the design protection elapsed since after 25 years, the wish to share a design under a Creative Commons licence could vanish.
- 35 In conclusion of this first section, it appears that a design is not only a difficult concept to apprehend but also a difficult notion to protect. The same work can enjoy two types of protection in countries that do not apply a strict separation between works of art and designs. The use of Creative Commons licences to share these particular works does not seem to be the most appropriate tool, although some solutions can be found.
- 36 However, if we consider the case of the platforms mentioned in the introduction, the hypothesis is different from the one described in this section. The platforms do not propose designs under Creative Commons licences but the digital blueprints of the designs. The issue is then whether a blueprint can be licensable under a Creative Commons licence and what would be the consequences for the creation of the product design.

## B. Copyrightability of a blueprint

- 37 The platforms we are referring to propose that designers and creative users upload the blueprints of their works and share their creations with Internet users. Based on these blueprints, users are able to build but also, if permitted, to redesign products. From a legal perspective, our interest is to determine whether the use of Creative Commons licences to share the blueprints is appropriate.

## I. Definition

- 38 The notion of “blueprint” is not a legal concept. The term is generally used in architecture and engineering design to define the paper reproduction of a technical drawing. Its name originally derived from the blue ink that was used to fix the colour on a paper.<sup>65</sup> With the development of new technologies, the traditional technique of producing paper blueprints has been replaced by digital techniques. Blueprints are now available in the format of digital files. Designers furthermore use computer programmes, known as Computer Aided Design (CAD), to create the digital plans of their future products. The term also refers to a plan to build a product (and can contain instructions as well).<sup>66</sup>

## II. Legal protection

- 39 In the list of protectable works, Article 2(1) of the Berne Convention does not mention plans in general but refers in particular to maps and plans relative to architecture, whatever their mode and form of expression.<sup>67</sup> As the list is not exhaustive and the national rules apply where the protection is sought, original plans other than the ones referred to in the Berne Convention can enjoy copyright protection.
- 40 In France, the *Code de la propriété intellectuelle* does not mention blueprints either. Article L. 122-1 (12°) lists maps and sketches relative to geography, topography, architecture or sciences among the copyrightable works. However, courts have supplemented the list and ruled that drawings, sketches and images of industrial pieces could constitute original works (and be granted copyright protection) under the condition that the placement of the pieces, dimension of the images and lines of shadow thickness were not only dictated by the technical necessity of exact reproduction.<sup>68</sup> But they have also refused copyright protection to urban development plans or topographic maps because of their banality.<sup>69</sup> Although neither the Berne Convention nor the French law mention the criterion of originality as a prerequisite for copyright protection, legal doctrine and courts have added it and delimited its contours for years. Broadly defined as a work or creation bearing the imprint of the personality of its author (*empreinte de la personnalité de son auteur*),<sup>70</sup> the notion does not seem to be suitable for works composed of artistic and technical elements. In the field of architecture, which can be compared to design since a work of architecture combines a graphic aspect (plans, sketches) with a volumetric aspect (the erected building),<sup>71</sup> courts have lowered the threshold of originality applicable to this type of work to define it as the expression of the author’s personal creative effort.<sup>72</sup> They have extended the reasoning to other types of technical or factual works.<sup>73</sup>

- 41 The test that French courts apply to determine the originality of a technical product containing an aesthetic or artistic element is therefore the lack of banality or the personal creative effort. Provided that a digital blueprint complies with these requirements, it can benefit from copyright protection under French law.

### III. Scope of protectable works under CC licences

- 42 According to Article 1 of the unported version of Creative Commons licences, a work that is the subject matter of the licence can be a literary or artistic work as well as a neighbouring work (such as performance, broadcast or phonogram) or a compilation of data. Article 1 of the licences reproduces the list of works contained in Article 2(1) of the Berne Convention, completed by neighbouring and database rights.<sup>74</sup> Logically, general plans or blueprints are not mentioned. However, the list provided by the licences is a list of examples. Therefore, as long as blueprints constitute original works, they can be the subject matter of a CC licence. It should be noted that the licences do not refer to the criterion of originality as a pre-requisite of copyright protection. This reflects the diversity existing among national legislations (some impose the criterion; others do not).<sup>75</sup> A work is protected as long as it complies with either the international standards laid down in the Berne Convention for the unported version of CC licences or the national rules for the ported licences.
- 43 After having established that a digital blueprint can be shared under a CC licence, the most interesting issue concerns the impact of the licence on the making of the three-dimensional product based on the plan. Posed differently, are CC licences enabling users to build the product? Most of the platforms do not clearly distinguish whether the blueprint or the product design is shared under a Creative Commons licence, or implicitly assume that the right to reproduce the digital blueprint under a CC licence grants the right to build the product.<sup>76</sup>

### C. Right of reproduction

- 44 In this last section, we explore the link between the digital blueprint of a product design and its three-dimensional representation to determine whether the final product constitutes a reproduction of the blueprint, which can be authorised and shared under a CC licence.<sup>77</sup> The reproduction will be distinguished from a derivative work that a user could make by adding original elements to the design while constructing the product.

### I. Definition of the right of reproduction

- 45 Copyright holders benefit from economic rights. The first and most fundamental one is the exclusive right to reproduce their works and authorise others to copy it.
- 46 *At the international level*, the Berne Convention sets up the right of reproduction in Article 9 (1) as the right for the author of a literary and artistic work, as listed in Article 2(1), to authorise the reproduction of the work in any manner or form. In addition, Article 9 (3) adds that sound and visual recording constitutes a reproduction. No other provision of the Convention defines the scope of the right of reproduction. Some uncertainties subsist concerning, in particular, the physical nature of the reproduction and whether some form of fixation is required.<sup>78</sup> It is also not clear whether the right to make an adaptation (or derivative work) is a form of reproduction. The way national laws are considering it diverges.<sup>79</sup> However the Berne Convention provides for the right to make adaptation and translation in two different articles.<sup>80</sup>
- 47 The other international treaties do not bring any further clarification on the definition of the right of reproduction except for neighbouring rights. In particular, Article 3 (e) of the Rome Convention on neighbouring rights defines reproduction as the making of a copy or copies of a fixation, which should be interpreted narrowly.<sup>81</sup>
- 48 *At the Community level*, the right of reproduction has been identified by the European Commission in the Green Paper on Copyright and Related Rights as “the core of copyright and related right”.<sup>82</sup> Article 2 (a) of the Information Society Directive (Directive 2001/29/EC) does not define the notion of reproduction but states that the right is “the exclusive right to authorise or prohibit direct or indirect, temporary or permanent reproduction by any means and any form, in whole or in part”.<sup>83</sup> No distinction is made between copyright and related (or neighbouring) rights. Reproduction is understood as being an analogue reproduction (verbatim copy) but also as being a reproduction in a different medium. It also means that a reproduction occurs when the form of the work changes (such as the photography of an architectural work).<sup>84</sup> The Directive does not define the scope of the right nor does it refer to the law of Member States to determine its meaning. The European Court of Justice (ECJ) considers that in the absence of express reference to national laws in the European legal texts, concepts and conditions should be given an autonomous and uniform interpretation throughout the Community.<sup>85</sup> In a recent case law, *Infopaq International A/S (2009)*, the ECJ ruled that the protection granted under Article 2 of the Informa-

tion Society Directive must be given a broad interpretation, without defining the meaning of reproduction.<sup>86</sup> However, the Advocate General of the case proposed defining reproduction of a work “as fixation of the work in a given information medium”.<sup>87</sup>

49 **At the French level**, the right to reproduce is defined as the material fixation of any work,<sup>88</sup> which can be carried out by printing, drawing, engraving, photographing, moulding, and using all processes of graphic and plastic arts or by any other means.<sup>89</sup> The law does not define the exact scope of the right but gives examples of techniques used to reproduce the work. The method of reproduction and the medium in which the reproduction is fixed are irrelevant. Reproduction at the national level does not mean verbatim copies of the work, and Article L. 122-4 of the *Code de la propriété intellectuelle* requires obtaining the express consent from the copyright owner to reproduce a work by any process or technique. Contrary to other legislations,<sup>90</sup> French law does not specify whether making a three-dimensional form of a work infringes the copyright of the two-dimensional work or even constitutes a reproduction of the two-dimensional work.

50 Only in the field of architecture does the law specify that erecting a building from architectural plans constitutes a reproduction of those plans.<sup>91</sup> Courts have confirmed that the reuse of architectural plans to construct a second building without the architect’s authorisation constitutes an infringement of the right of reproduction.<sup>92</sup> In other fields, courts have interpreted the notion of material fixation and ruled, for example, that the use of a drawing to make a children’s puzzle was a reproduction,<sup>93</sup> as well as the transformation of a two-dimensional work into a three-dimensional object<sup>94</sup> or the fixation of a three-dimensional work on a flat surface.<sup>95</sup> As a consequence, a verbatim copy of a work as well as a fixation of the work carried out by any other technique or process constitutes a reproduction. In application of the rulings of French courts, the construction of a three-dimensional object based on its blueprint (two-dimensional form) is a reproduction of this plan. Denis Cohen confirmed this interpretation in his manual “*le droit des dessins et des modèles*”, in which he considers that making a model, drawing it, printing it, copying it, photographing it or filming it all constitute techniques and processes that permit the material fixation of a design and are manifestations of the right of reproduction. Article L. 122-3 of the CPI protects the work itself (intellectual creation) and not the process employed to produce it.<sup>96</sup> As a consequence, using a technique or process to reproduce a design without the authorisation of the author constitutes a copyright infringement.

## II. Distinction with derivative works

- 51 The reproduction of the blueprint in three dimensions is different from the situation where the user freely interprets the plan and adds features to the design by building the product. By doing so, the user is creating a different work based upon the original one. Several of the platforms offer users the possibility to build upon the designs proposed. The right to adapt an original work or to make a derivative work is neither defined at the international level<sup>97</sup> nor harmonised at the European level (the Information Society Directive does not deal with the issue of adaptation);<sup>98</sup> instead, it needs to be authorised by the author of the original work.<sup>99</sup> The definition of a derivative work as well as the application of the criterion of originality is left to national legislations.<sup>100</sup>
- 52 Under French law, a derivative work is defined as a new work in which a pre-existing work is incorporated without the collaboration of the author of the original work.<sup>101</sup> The definition of the right of reproduction is broad enough to cover the right of adaptation, although it does not mention it.<sup>102</sup>

## III. Application to Creative Commons licences

- 53 The right of reproduction is defined in the unported versions of the Creative Commons licences as “the right to make copies of the work by any means (...) and the right of fixation and reproduction of fixation”.<sup>103</sup> This definition refers neither to the wording of the Berne Convention nor to the Information Society Directive. As explained above, no consensus on the exact meaning of the right of reproduction has been found at the international and European levels. It can therefore be surprising to find a definition of the right in the licences. The question is whether the right to make copies includes the right to reproduce the work in a different form or using a different technique, i.e. whether the definition permits the construction of a 3-D object based on a plan. A subsidiary issue relates to the right to adapt the work and whether the definition of the Creative Commons licences extends to the right to make a derivative work. Before answering these questions, we can mention that some countries, by implementing (i.e. porting in the language of Creative Commons licences) the licences into their national law, have deleted any reference to the definition, and refer therefore to the notion as existing in their national law.<sup>104</sup>
- 54 The making of the 3-D object constitutes a reproduction of the digital plan in a different form or using a different process. The right of reproduction as defined in the unported version of the CC licences (“the right to make copies by any means”) should be interpreted as meaning by any technique or pro-

cess, in any form or medium. We can only regret that the wording is not clear enough in that respect or does not refer to a formulation used at the international level.<sup>105</sup> Not only is the 3-D object a reproduction of the digital blueprint, it is also a different form of expression of the digital blueprint and could enjoy copyright protection under the condition that it complies with the criterion of originality. The issue is not so much whether a Creative Commons licence permits the reproduction of the digital blueprint in three dimensions, but whether the result is covered by the same Creative Commons licence – in other words, whether the definition of works includes complex work or the different forms of expression of the same work. The wording of the licence lacks clarity in that respect and does not specifically refer to this situation.<sup>106</sup> As a consequence, the licences currently authorise a user to build a 3-D product based on the digital blueprint, but it is less certain that the permissions of uses, which are granted to the user for the digital blueprint, can be extended to the 3-D product.

- 55 Another situation is the case where the user alters the blueprint or adapts it, making a 3-D object different from the object described in the plan. Under the condition that the work reaches the originality threshold, it could be considered a derivative work and would need to be authorised under a Creative Commons licence permitting the adaptation of the original work, such as the Attribution Licence, the Attribution NonCommercial Licence or the Attribution ShareAlike Licence. Whether the definition of the right of reproduction under Article 1 of the CC licences extends to the right of adaptation is not so important since the right of adaptation can be expressly excluded from the scope of the permitted uses under Article 3 of the CC licences. However, we should mention here that the definition of adaptation contained in Article 1, paragraph a, of the CC licences can create some confusion: “*any form in which the work may be recast, transformed or adapted including any form recognizably derived from the original*” is an adaptation. As previously explained, the reproduction in three dimensions of a plan does not constitute a derivative work of the plan unless the construction deviates from the original plan. However, the wording of Article 1, paragraph a, is clumsy and gives the impression that any form of a work could be considered an adaptation of the original work. But in fact, only separate original works based on pre-existing original works could be considered a derivative work.
- 56 In our demonstration, we have not focused our attention on a specific Creative Commons licence, though we have mentioned that a user should be able to modify the 3-D object under a Creative Commons licence authorising derivative works. But if a designer decides to share a digital blueprint under a ShareAlike licence, what would be the conse-

quences for a user who builds the 3-D product? If the user strictly complies with the digital blueprint, the user will make the work in a different form and the ShareAlike clause will not have any impact on the way the user redistributes the work. However, if the user builds a derivative work of the digital plan, the user will be forced to distribute the 3-D product under the same CC licence as the digital blueprint or under a compatible licence.<sup>107</sup>

- 57 Of course, in this section, we could also mention the fact that the 3-D representation of the blueprint could also be considered a design and be protected as such. Consequently, and following the assessment we have made in the first section of this article, the use of a Creative Commons licence to share not the blueprint but the final product would face obstacles linked to the specific nature of a design.

## Conclusions

- 58 From the analysis made in this article, several drawbacks have been identified to the use of Creative Commons licences for design.
- 59 First of all, the complex nature of a design has shown that Creative Commons licences might not be the appropriate tool to share this type of work, especially in light of the scope of protection, the length of protection, the temporal clause and the possibility to prohibit any commercial exploitation of the design. However, solutions diverge depending on whether the design is a registered design or an unregistered design. Concerning a registered design, a Creative Commons licence could co-exist with a specific non-exclusive design licence. Concerning an unregistered design, it does not seem adequate to wait until the design protection has elapsed (i.e. three years from the date it was made available to the public) to share it under a Creative Commons licence. Designers and creative users might be eager to share their creations as soon as they can. Since it is also difficult to find out when a design was made available to the public and to determine the starting point (and therefore term) of its protection, a solution could be for a designer or creative user to renounce licensing a right of copy under a specific design licence and to only share the design under a Creative Commons licence.
- 60 Second, we have determined that licensing a digital blueprint under a Creative Commons licence should grant the right to build the design product under the right of reproduction. However, the wording of the licences could be improved to make sure that the right to copy the work encompasses the right to reproduce the work in different forms.
- 61 Third, the making of the 3-D product based upon the digital blueprint does not constitute a derivative work, unless the user adds creative features to

the product and modifies the original blueprint and therefore the design.

- 62 Finally, the 3-D representation of the digital blueprint can also constitute a copyrightable subject matter. The question is then whether a Creative Commons licence can cover the different forms of expression of a work or whether several Creative Commons licences would be necessary: one for the blueprint and another for the 3-D object. In that respect, the definition of work – the subject matter of the licence – is not crystal clear. More research on the topic is necessary to determine how to improve Creative Commons licences and increase their compatibilities with design works.<sup>108</sup>

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- 1 Among others, see the Ponoko Platform, on which “everyone clicks to make real things”, available at [www.ponoko.com/about/the-big-idea](http://www.ponoko.com/about/the-big-idea); the SomeRightsReserved Platform, defined as a “download-only design firm that produces blueprints to a range of different products and objects, connecting designer straight to consumer”, available at [www.kith-kin.co.uk/shop/](http://www.kith-kin.co.uk/shop/); and other platforms that are also present in the Netherlands and encourage not only designers but also creative users to share their creations, such as <http://unlimiteddesigncontest.org/fr>.
- 2 For more information on the fanzine movement, see Teal Triggs, *Scissors and Glue: Punk Fanzines and the Creation of a DIY Aesthetic*, in *Journal of Design History* (2006), vol. 19, issue 1.
- 3 The terms of conditions of the platforms do not always clearly identify the subject matter of the licences, which can be either the digital blueprint or the product design itself.
- 4 See Catharina Maracke, *Creative Commons International: The International License Porting Project*, JIPITEC (2010), vol. 1; for a complete and comprehensive overview of the Creative Commons model, see Mireille van Eechoud and Brenda van der Wal, *Creative commons licensing for public sector information: Opportunities and pitfalls* (2008), chap. 3, available at [www.ivir.nl](http://www.ivir.nl).
- 5 <http://en.wikipedia.org/wiki/Design>.
- 6 With the exception of the Locarno International Classification used for registered industrial designs and which contains a list of goods in which designs are incorporated; see <http://www.wipo.int/classifications/nivilo/locarno/index.htm>.
- 7 The professional body representing the interests of designers in the UK, [www.csd.org.uk/inedx.aspx?id=109](http://www.csd.org.uk/inedx.aspx?id=109).
- 8 See Uma Suthersanen, *Design Law: European Union and United States of America*, 2<sup>nd</sup> ed., (New York: Thomson Reuters, 2010) chap. 2.
- 9 For more information on the history of designs, see footnote 8, chap. 1.
- 10 See S. Ricketson and J. Ginsburg, *International Copyright and Neighbouring Rights: The Berne Convention and Beyond*, 2<sup>nd</sup> ed. (Oxford: Oxford University Press, 2005) chap. 8.
- 11 Article 2 (7) of the Berne Convention: “Subject to the provisions of Article 7 (4) of this Convention, it shall be a matter for legislation in the countries of the Union to determine the extent of the application of their laws to works of applied art and industrial designs and

models, as well as the conditions under which such works, designs and models shall be protected. [...]”

- 12 Article 2 (7) of the Berne Convention: “[...] Works protected in the country of origin solely as designs and models shall be entitled in another country of the Union only to such special protection as it is granted in that country to designs and models; however, if no such special protection is granted in that country, such works shall be protected as artistic works.”
- 13 France.
- 14 Germany.
- 15 The best illustration of the separability theory was the Italian legislation until the adoption of the Design Directive, which has forced the country to provide some copyright protection to designs.
- 16 See US Copyright law, 17. U.S.C § 101.
- 17 Article 5, Quinquies of the Paris Convention.
- 18 Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property* (Geneva: World Intellectual Property Organization, 1968).
- 19 Articles 4 A (1), 5 A (4) and 5 B of the Paris Convention respectively.
- 20 Uma Suthersanen, *Design Law: European Union and United States of America*, 2<sup>nd</sup> ed., chap. 3.
- 21 Catherine Seville, *EU Intellectual Property Law and Policy* (Cheltenham: Edward Elgar, 2009) chap. 4.
- 22 Article 25 (1) of the TRIPS : “Members shall provide for the protection of independently created industrial designs that are new or original. (...) Members may provide that such protection shall not extend to designs dictated essentially by technical or functional considerations.”
- 23 Uma Suthersanen, *Design Law: European Union and United States of America*, 2<sup>nd</sup> ed., chap. 3.
- 24 Article 25 (2) of the TRIPS : “Each Member shall ensure that requirements for securing protection for textile designs [...], Members shall be free to meet this obligation through industrial design law or through copyright law.”
- 25 <http://www.wipo.int/treaties/en/classification/locarno>.
- 26 Green Paper on the Legal Protection of Industrial Design, June 1991, III/F/5131/91/EN, available at [http://ec.europa.eu/internal\\_market/indprop/docs/design/green-paper-design\\_en.pdf](http://ec.europa.eu/internal_market/indprop/docs/design/green-paper-design_en.pdf).
- 27 Design Directive 98/71/EC of the European Parliament and Council of 13 October 1998 on the legal protection of design, [1998] OJ L289.
- 28 Regulation 6/2002 of 12 December 2001 on Community designs, [2002] OJ L3/1, amended by Regulation 1891/2006 of 18 December 2006, [2006] OJ L 386/14.
- 29 Article 1 of the Directive 98/71/EC and Article 3 of the Council Regulation (EC) No. 6/2002: “[D]esign means the appearance of the whole or a part of a product resulting from the features of in particular the lines, contours, shape, texture and/or materials of the product itself and/or its ornamentation.”
- 30 Recital 14 of the Directive 98/71/EC and Recital 10 of the Council Regulation (EC) No. 6/2002.
- 31 Article 8 of the Council Regulation (EC) No. 6/2002 and Article 7 of the Directive 98/71/EC.
- 32 Article 5 of the Directive 98/71/EC and 6 of the Council Regulation (EC) No. 6/2002.
- 33 Article 19 of the Council Regulation (EC) No. 6/2002.
- 34 Article 11 and Article 19 (2) of the Council Regulation (EC) No. 6/2002.
- 35 In the Green Paper on industrial designs, the term ‘design’ means both drawings (two-dimensional) and models (three dimensional); see para. 5.4.11 of the Green Paper, footnote 26.

- 36 *Flos Spa v. Semeraro Casa e Famiglia SpA* (ECJ), Case C-168-09, 27 January 2011.
- 37 C-168-09, para. 57.
- 38 C-168-09, para. 58.
- 39 C-168-09, para. 59.
- 40 C-168-09, para. 62 and 63.
- 41 See the new Article 239 of the Italian Industrial Property Code: “Third parties which manufactured or marketed, in the 12 months before April 19, 2001, products realised in compliance with the industrial design creations already in the public domain, are not liable for the infringement of copyright in such an activity, even after that date, in respect of products that they manufactured or purchased before April 19, 2001, and those that they manufactured in the following five years, provided that such an activity has been kept within the prior (quantitative) limits”, as translated in *ECJ ends controversy over copyright protection for industrial designs* available at [www.internationallawoffice.com](http://www.internationallawoffice.com).
- 42 Article 1 of the Directive 98/71/EC.
- 43 See Article L. 511-1 and seq. of the *Code de la propriété intellectuelle*.
- 44 For a historical overview, see G. Finniss, *The Theory of “Unity of Art” and the Protection of Designs and Models in French Laws*, 46 J. Pat. Off. Soc’y 615, 1964.
- 45 Article 1 of the law of 14 July 1909 on designs and models (abrogated): “[A]ny creator of a design or a model and his assignees have the exclusive right to exploit, sell or have sold such design or model, under the conditions provided for by the present Law, without prejudice to the rights they might hold under legal provisions, and in particular under the Law of 19 and 24 July 1793, as amended by the Law of 11 March 1902 [copyright law]”; the law of 11 March 1902 only recognised the cumulation of protection for sculptors and designers of ornaments.
- 46 Article 2 of the Law of 11 March 1957: “[T]he provisions of this Law shall protect the rights of authors of all intellectual property rights, whatever may be the genre, form of expression, merit or purpose of such works.”
- 47 See G. Finniss, *The Theory of “Unity of Art” and the Protection of Designs and Models in French laws*, 46 J. Pat. Off. Soc’y 615, 1964.
- 48 Court of Cassation, 11 February 1997, Bulletin 1997, I, N° 56, p. 36.
- 49 Court of Cassation, 5 October 2010: “If the principle of unity of art means that designs and models are protected by the provisions of Books I and III (copyright law) of the code of intellectual property and by provisions of Book V (design law), this cumulation does not mean a confusion of the two regimes of protection by automatically assimilating the criteria of application; to the contrary it has resulted from the Ordinance of 25 July 2001 an ineluctable differentiation of these two regimes since the Ordinance has profoundly reformed the law applicable to designs and models and created a specific new regime, which is necessarily autonomous to the copyright regime” (free translation).
- 50 As well as neighbouring rights.
- 51 Article 19 (1) of the Council Regulation (EC) No. 6/2002 and Article 12 of the Directive 98/71/EC.
- 52 Article 19 (2) of the Council Regulation (EC) No. 6/2002.
- 53 Article 32 of the Council Regulation (EC) No. 6/2002.
- 54 Article 32 (5) of the Council Regulation (EC) No. 6/2002.
- 55 Article 27 of the Council Regulation (EC) No. 6/2002.
- 56 See Denis Cohen, *le droit des dessins et modèles*, 3rd ed., 2009, *Pratique du droit*, Economica.
- 57 See Article 3 of Creative Commons licences, unported version.
- 58 Article 12 of the Council Regulation (EC) No. 6/2002.
- 59 Article 11 of the Council Regulation (EC) No. 6/2002.
- 60 Article 32 of the Council Regulation (EC) No. 6/2002 and Article 3 of Creative Commons licences respectively.
- 61 See Denis Cohen, *le droit des dessins et modèles*, 3rd ed., 2009, *Pratique du droit*, Economica.
- 62 Article 32 of the Council Regulation (EC) No. 6/2002
- 63 Article 3 of Creative Commons licences
- 64 Art. 11 of the Council Regulation (EC) No. 6/2002.
- 65 See <http://en.wikipedia.org/wiki/Blueprint>.
- 66 For an example of blueprint downloadable from a design platform, see <http://unlimiteddesigncontest.org/en/product/stapelbaar> (click on download blueprint); see <http://unlimiteddesigncontest.org/en/product/ribble-chair> (idem).
- 67 The Berne Convention leaves to the members of its Union to decide whether a work should be fixed in a material form to enjoy copyright protection (Article 2(2) of the Convention).
- 68 See, for example, TGI Paris 15 April 1972, TGI Paris 1st March 1993 and TGI Paris 21 November 1993.
- 69 Court of Cassation (Criminal Chamber), 13 February 1969, Bulletin Criminel Cour de Cassation Chambre Criminelle N.77, also available at [www.legifrance.com](http://www.legifrance.com).
- 70 Paris Court of Appeals, 1st Civil Chamber, 1 April 1957.
- 71 Michel Huet, *Architecture et droit d’auteur*, RIDA n°88, April 1976.
- 72 See, for example, Court of Cassation (1st Civil Chamber), 27 June 2000, 97-22537, available at [www.legifrance.com](http://www.legifrance.com).
- 73 Amiens Court of Appeals, 24 November 2005, 03-04564, available at [www.legifrance.com](http://www.legifrance.com).
- 74 For more details on the definition, see Mélanie Dulong de Rosnay, *Creative Commons Licenses Legal Pitfalls: Incompatibilities and Solutions*, available at [http://www.ivir.nl/creativecommons/CC\\_Licenses\\_Legal\\_Pitfalls\\_2010.pdf](http://www.ivir.nl/creativecommons/CC_Licenses_Legal_Pitfalls_2010.pdf).
- 75 See Ramón Casa Vallès, *The requirement of originality*, in Estelle Derclaye (ed.), *Research handbook on the future of EU Copyright* (Cheltenham: Edward Elgar, 2009).
- 76 See, for example, the Ponoko Platform referring to the licence of the “copyright design”, although creators upload their plans (or design files), <http://www.ponoko.com/make-and-sell/sell-eps>; see also the Platform *SomeRightsReserved*, which offers the possibility for designers to share the “SomeRightsReserved Downloads” under a Creative Commons licence and implicitly gives the right to build the product design from the licence, <http://www.kith-kin.co.uk/shop/terms.asp>.
- 77 The issue of the reproduction of the blueprint in three dimensions will be assessed here under copyright law, which is relevant for the application of Creative Commons licences; the specific issue of reproduction in two dimensions (such as photography) of a 3-D design under design law will not be considered in this article as the hypothesis is not related to the application of CC licences and there are doubts concerning the possibility of reproducing a 3-D design in two dimensions under the Community design framework.
- 78 See S. Ricketson and J. Ginsburg, *International Copyright and Neighbouring Rights: The Berne Convention and Beyond*, 2<sup>nd</sup> ed. (Oxford: Oxford University Press, 2005) chap. 11; Michel Walter in S. von Lewinski and M. Walter, *European Copyright Law: A Commentary* (Oxford: Oxford University Press, 2010): Information Society Directive, 11, chap. 2. The author considers that the Berne Convention does not distinguish between the fixation of a work and its reproduction nor between the original work and its copies.
- 79 According to S. Ricketson and J. Ginsburg, the right of reproduction in France is broad enough to include the right of adaptation, whereas in the United States they constitute two separate rights; see also Hugenholtz, Van Eechoud, Gompel, *The Recasting of Copyright and Related Rights for the Knowledge Economy, Final Report*, p. 53-55, available at [http://www.ivir.nl/publications/other/IViR\\_Recast\\_Final\\_Report\\_2006.pdf](http://www.ivir.nl/publications/other/IViR_Recast_Final_Report_2006.pdf)

- 80 Articles 12 and 8 of the Berne Convention respectively.
- 81 See Brison in Thomas Dreier and P. Bernt Hugenholtz (eds.) 2006, *Concise European Copyright Law*, Alphen aan den Rijn, Kluwer, Rome Convention, Article 3, p. 124-125.
- 82 Commission Green Paper, "Copyright and Related Rights in the Information Society" (1995), COM (95) 382 final, Brussels, 19 July 1995.
- 83 Directive 2001/29/EC of the European Parliament and the European Council on the harmonisation of certain aspects of copyright and related rights in the information society, OJ L 167, 22 June 2001, p.10-19.
- 84 See Bechtold in Thomas Dreier and P. Bernt Hugenholtz (eds.) 2006, *Concise European Copyright Law*, Alphen aan den Rijn, Kluwer, Information Society Directive, Article 2, p. 358.
- 85 See, for example, Case C-245/00 SENA [2003] ECR I-1251, paragraph 23 or Case C-357/98 Yiadom [2000] ECR-9265, paragraph 26.
- 86 Case C-5/08, Infopaq International [2009], paragraph 43.
- 87 Opinion, C-5/08, Infopaq International [2009], paragraph 56 and 57.
- 88 Under French law, fixation is not a requirement for copyright protection but constitutes an element of reproduction.
- 89 Article L. 122-3 of the *Code de la propriété intellectuelle*.
- 90 See Article 39 (1) (b) of the Irish Copyright and Related Rights Act, 2000: "In relation to an artistic work, the making of a copy in three dimensions of a two-dimensional work and the making of a copy in two dimensions of a three-dimensional work" constitutes a reproduction; see UK Copyright, Design and Patents Act 1988, Article 17 (3): "In relation to an artistic work copying includes the making of a copy in three dimensions of a two-dimensional work or the making of a copy in two dimensions of a three-dimensional work."
- 91 Article L. 122-3, last indent, *Code de la propriété intellectuelle*: "In the case of architecture, reproduction consists in the repeated execution of a plan or of a standard project."
- 92 Court of Cassation (Civil Chamber), 12 November 1980, Bulletin Civil I, n° 287.
- 93 Penal Court Seine, 28 February 1867.
- 94 TGI Paris, 29 December 2004; CA Paris 26 April 1994.
- 95 TGI Paris, 16 February 1867.
- 96 See Denis Cohen, *le droit des dessins et modèles*, 3rd ed., 2009, *Pratique du droit*, Economica, p. 124 and seq.
- 97 Article 2(3) of the Berne Convention only lists types of derivative works, i.e. adaptations, translations, arrangements of music and other alterations of literary and artistic works; Article 12 of the Berne Convention grants an exclusive right for the author of a work to authorise adaptations, arrangements and other alterations of their works.
- 98 Contrary to the Computer Program Directive, see Article 4 (b) of Council Directive 91/250/EEC, OJ L 122, 17.5.1991.
- 99 Article 12 of the Berne Convention.
- 100 The term "derivative work" is expressly mentioned (and defined) in the US Copyright Act (17. U.S.C. § 101), whereas the right of adaptation is mentioned in the Berne Convention but also in many national legislations. However, the two expressions should be understood as being equivalent; see footnote 80.
- 101 Article L. 113-2, para 2, of the *Code de la propriété intellectuelle*.
- 102 See footnote 56.
- 103 Article 1, paragraph i of the Attribution Licence, of the Attribution NoDerivs Licence, of the Attribution NonCommercial Licence, of the Attribution NonCommercial NoDerivs Licence and Article 1, paragraph j of the Attribution NonCommercial ShareAlike Licence and Article 1, paragraph k of the Attribution ShareAlike Licence.
- 104 See, for example, the Dutch version of Creative Commons licences, available at <http://www.ivir.nl/creativecommons/english-retranslation.pdf> for the Attribution-NonCommercial-ShareAlike, version 3.0 licence
- 105 Article 9 (1) of the Berne Convention refers to "reproduction in any manner or form"; Article 2 of the Information Society Directive refers to "reproduction by any means and in any form".
- 106 See, however, the opinion of Mélanie Dulong de Rosnay, who considers that a complex work (namely a musical composition, a performance and a phonogram) is covered by the definition of work provided by the licences, in *Creative Commons Licenses Legal Pitfalls: Incompatibilities and Solutions*, available at [http://www.ivir.nl/creativecommons/CC\\_Licenses\\_Legal\\_Pitfalls\\_2010.pdf](http://www.ivir.nl/creativecommons/CC_Licenses_Legal_Pitfalls_2010.pdf).
- 107 Creative Commons, "License Your Work", available at <http://creativecommons.org/about/licenses>.
- 108 This would imply researching the different issues identified in this article under other national jurisdictions.

# Court Decisions



# Google face à la justice française et belge

## Nouvelles décisions en matière de droit d'auteur

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**Abstract:** Internet Service Providers' liability for copyright infringement is a debated issue in France and Belgium, particularly with respect to intermediaries such as providers of hyperlinks and location tool services for which the e-commerce directive does not set explicitly any exemption from liability. Thus, the question arises among other things whether the safe harbour provisions provided for in

respect of caching and hosting also could apply to search engines. French and Belgian Courts had recently to decide on this issue in several cases concerning Google's complementary tools such as Google Videos, Google Images, Google Suggest and Google News. This article seeks to give a summary of and to assess this recent case law.

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### Introduction

Après Google Book<sup>1</sup> et Google Adwords,<sup>2</sup> c'est au tour des services Google Vidéos, Google Images et Google News d'être sur la sellette devant les juridictions françaises et belges. Les récentes décisions (janvier-mai 2011) rendues par les Cours d'appel de Paris et de Bruxelles à propos de ces nouvelles fonctionnalités du célèbre moteur de recherche font apparaître une différence d'approche et, dans l'ensemble, une plus grande sévérité, par rapport à la jurisprudence d'autres Etats européens.

l'origine comme une plate-forme communautaire permettant aux internautes de mettre à disposition (*upload*) et de télécharger (*download*) des images animées, associée à un service de référencement des vidéos disponibles sur le web. La possibilité pour les utilisateurs de mettre des contenus à disposition sur le site Google Vidéos fut supprimée en 2009 et Google a annoncé en mai 2011 la suppression de la fonction permettant aux internautes de télécharger les contenus stockés. Google Vidéos est ainsi amené à n'être à l'avenir qu'un service d'indexation et de référencement, sans activité de stockage.

### A. Google Vidéos

1 CA Paris 14.01.2011, RG n° 09/11729, 09/11737, 09/11739, 09/11779 [www.legalis.net](http://www.legalis.net)

2 Par quatre arrêts rendus le même jour, la Cour d'appel de Paris retient la responsabilité de Google pour la mise à la disposition du public, sur Google Vidéos, de films et documentaires protégés par le droit d'auteur. Les différentes procédures ont été engagées à l'époque où le service Google Vidéos était à la fois un moteur de recherche et un site de partage de vidéos. Lancé en 2005, Google Vidéos était en effet conçu à

### I. La qualification juridique du service Google Vidéos

3 Dans les quatre litiges ayant donné lieu aux arrêts commentés, les deux fonctions de Google Vidéo (moteur de recherche et hébergement) étaient cependant concernées. Les décisions, rendues en des termes quasiment identiques, sont toutes fondées sur la loi du 21 juin 2004 pour la Confiance dans l'Economie Numérique, dite LCNE, transposant la directive e-commerce<sup>3</sup> en droit français. La Cour y vérifie si Google Vidéos peut être qualifié d'hébergeur (*hosting provider*) et bénéficier ainsi du régime de respon-

sabilité allégée prévu à l'article 6.I.2 LCEN (transposant l'article 14 de la directive E-commerce). Pour ce faire, elle entreprend de rechercher si le rôle de Google Vidéos « est neutre par rapport aux informations » stockées.<sup>4</sup>

- 4 S'agissant de l'activité de stockage de vidéos, la Cour note l'absence d'une « capacité d'action du service Google Vidéos sur les contenus mis en ligne ». <sup>5</sup> Quant à l'activité de moteur de recherche, elle relève qu'il s'agit d'un « processus entièrement automatisé, sans aucune intervention ou révision par des personnes humaines » et qu'en raison de « l'automatisme de cette fonction », le service Google Vidéos n'exerce aucun « contrôle actif » sur les contenus mis en ligne, la rémunération de ce service de référencement étant sans incidence. La Cour en conclut que le rôle exercé par Google, aussi bien dans son activité de prestataire de service de stockage de vidéos reçues de tiers que dans son service de référencement, répond aux exigences de neutralité consacrées par la directive e-commerce et que Google peut donc se prévaloir du régime spécifique de responsabilité consacrée par cette dernière.

## II. La responsabilité de Google quant à son activité de stockage de vidéos

- 5 Alors pourtant que, dès réception de la notification de la part des ayants-droit, Google a procédé au retrait du contenu signalé, la Cour de Paris retient, dans deux des quatre espèces qui lui étaient soumises, la responsabilité de Google en sa qualité d'hébergeur au motif que les vidéos litigieuses ont été, par la suite, remises en ligne par des internautes. Il lui appartenait en effet, selon les juges parisiens, « de mettre en œuvre tous les moyens techniques en vue de rendre l'accès à ce contenu impossible, et ce, sans pouvoir exiger des ayants droit une intervention active ». La Cour estime que cette obligation mise à la charge de Google n'implique pas pour autant l'exercice d'un contrôle préalable des vidéos librement mises en ligne par les utilisateurs du site Google Vidéos, lequel serait incompatible avec l'article 6.I.7 LCEN (art. 15 directive e-commerce). « Faute pour elles d'avoir accompli les diligences nécessaires en vue de rendre impossible une nouvelle mise en ligne desdits documentaires déjà signalés comme illicites, les sociétés Google ne peuvent (donc pas) se prévaloir du régime instauré par l'article 6.I.2 LCEN et voient en conséquence leur responsabilité civile engagée de ce chef dans les termes du droit commun de la contrefaçon, sur le fondement des articles L. 335-3 et L. 335-4 du code de la propriété intellectuelle ».

## III. La responsabilité de Google quant à son activité de moteur de recherche

- 6 Dans les quatre décisions commentées, la Cour de Paris sanctionne également l'activité de référencement de Google Vidéos au titre de la contrefaçon. Alors pourtant que la fonction moteur de recherche du service Google Vidéos avait, en raison de son caractère automatisé, été considérée comme relevant en principe du régime de responsabilité de la directive e-commerce et de la LCEN, la Cour de Paris estime néanmoins que Google excède, dans son service de référencement, les limites de l'activité d'hébergement. Le moteur de recherche ne procède pas en effet à une simple indexation des liens hypertextes renvoyant l'internaute aux sites sur lesquels les vidéos peuvent être visionnées. Google offre bien plus à ses utilisateurs « la possibilité, par un simple clic à partir de ces liens, de visionner le film litigieux sur son propre site Google Vidéos grâce à l'ouverture d'une fenêtre ». Il s'agit là, selon la Cour, d'une « fonction active » qui, s'ajoutant aux liens hypertextes, permet à Google de « s'accaparer le contenu stocké sur des sites tiers afin d'en effectuer la représentation directe sur ses pages à l'intention de ses propres clients, distincts de ceux des sites tiers ». Google est donc condamné pour contrefaçon sur le fondement du Code de la propriété intellectuelle, la limitation de responsabilité consacrée par la directive e-commerce (transposée par la LCEN) n'étant finalement pas applicable en l'espèce.

### B. Google Images

*CA Paris 26.01.2011, SAIF c. Google, RG n° 08/13423, <http://www.juriscom.net/documents/caparis20110126.pdf> et CA Paris 04.02.2011, Google c. Au-feminin.com et al., RG n° 09/21941*

- 7 Les deux arrêts commentés concernent l'activité de référencement d'images du moteur de recherche, c'est-à-dire le service Google Images qui permet aux internautes, par la saisie de mots clés, d'afficher sous forme de vignettes (*thumbnails*) des séries d'images en rapport avec leur recherche, visibles en format réduit, et dont chacune peut être isolée pour en faciliter la lisibilité et l'agrandir. Dans la première affaire, Google était poursuivi par une société d'auteurs, la SAIF, pour avoir ainsi reproduit et communiqué au public sans droit des œuvres de son répertoire. Dans la seconde, l'action était intentée par un photographe dont l'œuvre avait été mise en ligne sans son consentement sur le site d'un magazine puis référencée par le moteur de recherche.
- 8 Les deux décisions déclarent la loi française applicable au litige, infirmant pour l'une d'elles le juge-

ment de première instance qui avait admis l'application de la loi américaine et conclu à la légitimité de Google Images au titre du *fair use*.<sup>6</sup> Ni l'une ni l'autre ne font à cet égard de distinction selon que l'atteinte alléguée porte sur le droit de reproduction ou de mise à disposition, contrairement à l'arrêt du *Bundesgerichtshof* du 29 avril 2010 dans l'affaire *Vorschaubilder*.<sup>7</sup> Pour le reste, le mode de raisonnement des juges parisiens n'est pas identique dans les deux arrêts, rendus par deux chambres différentes de la Cour d'appel de Paris, ce qui justifie de les examiner séparément.

## I. L'affaire Aufeminin.com

- 9 Contrairement à l'espèce soumise à la Cour Fédérale allemande dans l'affaire *Vorschaubilder*, l'auteur n'avait pas procédé lui-même ni consenti à la mise en ligne de l'œuvre indexée sous forme de *thumbnails*. La précision est importante car la solution ne pouvait pas être fondée sur un quelconque consentement tacite tel qu'il a été admis par la jurisprudence allemande.
- 10 Comme dans les quatre arrêts concernant Google Vidéos évoqués précédemment, la Cour recherche tout d'abord si Google peut se prévaloir de la qualité d'hébergeur, et donc de la limitation de responsabilité prévue par la LCEN, en ce qui concerne son activité de référencement d'images. Elle relève ici aussi le caractère entièrement automatisé du processus, l'absence de toute intervention humaine et en conclut que Google n'exerce aucun contrôle actif sur les contenus indexés.
- 11 Contrairement aux arrêts Google Vidéo, elle refuse en revanche de prendre en compte le fait que les utilisateurs du service ont la possibilité de visionner et télécharger la photographie litigieuse directement sur le site de Google Images. La Cour estime au contraire que « l'affichage des résultats ainsi réalisé ne saurait être considéré comme excédant la prestation technique adaptée à la fonctionnalité attendue d'un moteur de recherche d'images, tant il est vrai qu'une présentation des résultats sous la seule forme de références textuelles ne répondrait pas à la fonction d'un tel service dont la nécessité ne fait pas débat ». C'est peu dire que le raisonnement est pragmatique et qu'ont à l'évidence prévalu des considérations d'opportunité ! Reste qu'on ne voit pas très bien ce qui, sur le plan juridique, justifie cette différence de traitement entre Google Images et Google Vidéos et ce, d'autant moins que les décisions du 14 janvier et du 4 février ont été rendues par la même formation de la Cour d'appel de Paris...
- 12 L'activité de référencement de Google Images n'est pas pour autant déclarée licite. En effet, l'arrêt se contente de reconnaître à Google le bénéfice du régime spécifique de responsabilité consacré par la di-

rective e-commerce et la LCEN dont on sait qu'il subordonne l'exonération de l'hébergeur à la condition que ce dernier n'ait pas eu connaissance du caractère illicite des contenus stockés ou ait agi promptement pour les retirer une fois l'illicéité notifiée. La Cour considère en effet que Google n'est pas autorisé à maintenir l'indexation d'images dont le caractère contrefaisant lui aurait été notifié et qu'il lui incombait de prendre les mesures nécessaires pour en assurer le retrait et pour empêcher qu'elles soient à nouveau mises en ligne. Comme dans les affaires Google Vidéos, la Cour repousse expressément l'argument avancé par Google selon lequel « chaque remise en ligne, imputable au même utilisateur ou à des utilisateurs différents, commanderait une notification nouvelle sans laquelle la responsabilité du prestataire ne pourrait être engagée » et consacre une nouvelle fois le système du *notice and stay down* en droit français.<sup>8</sup>

- 13 Google est donc condamné pour contrefaçon sur le fondement du Code de la propriété intellectuelle, sans que soient précisées les prérogatives patrimoniales auxquelles il a été porté atteinte, ni évoquées d'éventuelles exceptions au droit d'auteur susceptibles de légitimer l'activité de référencement d'images de Google.

## II. L'affaire SAIF

- 14 L'arrêt rendu le 26 janvier 2011 par une autre formation de la Cour d'appel de Paris à propos du même service d'indexation d'images va quant à lui beaucoup plus loin. Il déboute en effet la société d'auteurs SAIF de l'ensemble de ses prétentions, sans se prononcer néanmoins expressément en faveur de la licéité du service Google Images au regard du droit d'auteur. Plusieurs arguments sont invoqués pêle-mêle par la Cour pour rejeter l'action de SAIF contre Google, sans que l'on sache cependant très bien s'il s'agit de justifier une limitation de responsabilité sur le fondement de la LCEN comme dans les affaires précédentes, ou d'exclure purement et simplement la contrefaçon.
- 15 La Cour reproche ainsi à la société d'auteurs de ne pas communiquer les adresses URL des images à retirer (ni d'ailleurs des sites qui seraient contrefacteurs) et de ne pas « fournir de données suffisamment déterminées pour que puisse être suffisamment (sic !) caractérisée une faute » à l'encontre de Google. Le rejet de l'action intentée par la SAIF semble donc reposer seulement sur l'absence de notification dans les formes prescrites par la LCEN,<sup>9</sup> ce qui n'impliquerait aucunement que le service Google Images soit en tant que tel licite.
- 16 Il semble néanmoins que la Cour ait plutôt entendu valider le *business model* de Google Images du point de vue du droit d'auteur et par conséquent exclu

qu'un tel service soit contrefaisant. Elle conclut en effet ses développements par la formule selon laquelle « *l'analyse du fonctionnement des services en cause ne permet pas de retenir que la responsabilité (de Google) est engagée* ». Plusieurs arguments sont avancés à l'appui de cette solution, dont aucun ne convainc totalement.

- 17 Le premier consiste à rappeler que l'éditeur d'un site a « la possibilité de poser des règles spécifiques pour chacune de ses pages et d'exclure de l'indexation les images représentées par l'utilisation de consignes (telles que) les fichiers d'exclusion robot.txt ». Contrairement à la Cour Fédérale allemande,<sup>10</sup> la Cour de Paris n'en déduit cependant pas expressément un consentement implicite des ayants-droit au référencement de leurs œuvres par Google. L'argument est seulement avancé dans le cadre de la démonstration du caractère automatique de l'indexation par Google Images.
- 18 La Cour fait ensuite observer que l'affichage des images sous la forme de vignettes sur la page de résultats du site Google Images « ne fait que répondre à la fonctionnalité nécessaire » d'un moteur de recherche dans la mesure où « une référence purement textuelle ou toute autre représentation conceptuelle serait difficile à utiliser et peu appropriée à l'objectif d'un tel service ». Ce faisant, elle fait certes preuve de pragmatisme mais ne répond pas, en droit, à la question de savoir sur quel fondement une telle utilisation non autorisée d'œuvres protégées par le droit d'auteur pourrait être légitimée. Cet argument, comme le précédent, est d'ailleurs avancé pour dénier, non pas l'existence d'une contrefaçon, mais « la réalité d'un rôle actif au sens de la directive » e-commerce.
- 19 Les juges parisiens admettent ensuite que les images référencées par Google sont stockées dans une mémoire cache, ce qui permet aux internautes, pendant quelques jours voire quelques semaines, d'y avoir accès au-delà de leur présence sur le site cible. La cour estime cependant que « cette fonction n'a qu'un caractère *transitoire* » et que « cette reproduction *provisoire* permettant la circulation rapide de l'information à destination de l'internaute et partant le bon fonctionnement technique du procédé constitue par son utilité une partie intégrante et essentielle d'un moteur de recherche d'images sur internet et doit être tolérée en tant que telle ». Par ailleurs, il n'est pas contestable, selon la Cour, « que c'est à fin de fluidifier le réseau que les images (...) se trouvent ainsi stockées automatiquement pour une durée variable, mais *temporaire* ».
- 20 La référence au caractère transitoire des reproductions opérées par le moteur de recherche et l'affirmation que ces reproductions constituent « une partie intégrante et essentielle » du procédé témoignent de la volonté de la Cour de se placer sur le terrain des

exceptions au droit d'auteur. Ces termes sont en effet ceux de l'article 5 (1) de la directive InfoSoc de 2001 qui consacre l'exception dite de reproduction transitoire ou accessoire. Mais la Cour, qui ne vise pas expressément la disposition correspondante en droit français,<sup>11</sup> n'examine pas les deux autres conditions d'application de cette exception (l'absence de signification économique indépendante et la finalité de la reproduction), lesquelles n'étaient vraisemblablement pas remplies en l'espèce. Elle n'évoque pas non plus l'exception de citation dont la jurisprudence française donne traditionnellement une interprétation très restrictive.

- 21 La décision témoigne finalement de l'embarras des juges français, visiblement désireux de légitimer le service Google Images, mais incapables de trouver un fondement juridique adéquat. D'où l'accumulation d'observations pragmatiques qui, même mises bout à bout, ne suffisent pas à justifier la solution en droit.

## C. Google Suggest

*CA Paris 03.05.2011, Snep c. Google, RG n°10/19845  
www.legalis.net*

- 22 La décision concerne la fonctionnalité Google Suggest permettant d'afficher en temps réel et au fur à et mesure que l'internaute tape sa requête, des termes de recherche supplémentaires. L'action est intentée par le Syndicat National de l'Édition Phonographique, SNEP, qui reproche à Google d'orienter les internautes recherchant de la musique en ligne vers des sites de téléchargement éventuellement illégal en leur suggérant des mots-clés tels que « torrent », « megaupload » et « rapidshare » qui correspondent à trois modes de partage illégal de fichiers. La demande de suppression des termes incriminés est fondée sur l'article L. 336-2 CPI consacré par la loi du 12 juin 2009 dite loi Hadopi.<sup>12</sup> Cette disposition a créé une action en cessation spécifique en matière de droit d'auteur qui n'existait pas en tant que telle auparavant en droit français.<sup>13</sup> L'article L. 336-2 CPI dispose en effet :
  - 23 *En présence d'une atteinte à un droit d'auteur ou à un droit voisin occasionnée par le contenu d'un service de communication au public en ligne, le tribunal de grande instance (...) peut ordonner à la demande des titulaires de droits (...) toutes mesures propres à prévenir ou à faire cesser une telle atteinte (...) à l'encontre de toute personne susceptible de contribuer à y remédier.*
  - 24 L'intérêt pour le plaideur d'invoquer cette disposition est qu'il n'a pas en principe à prouver le caractère contrefaisant de l'activité de l'intermédiaire technique contre lequel il agit. L'action est en effet ouverte contre « toute personne susceptible de remédier » à la contrefaçon alléguée et peut donc être mise en œuvre par exemple à l'encontre de fournis-

seurs d'accès (FAI) pour leur demander de bloquer l'accès aux sites illégaux de P2P ou de streaming. L'article L. 336-2 CPI, très critiqué au moment de son adoption, a été validé par le Conseil constitutionnel français, à condition que les mesures ordonnées dans ce cadre le soient au terme d'une procédure contradictoire et que leur caractère soit proportionné.<sup>14</sup>

- 25 Reste néanmoins à vérifier que les conditions de mise en œuvre de cette action en cessation sont en l'espèce remplies. Or la Cour de Paris considère ici que, « pour être applicable, le texte précité suppose la présence d'une atteinte à un droit d'auteur ou à un droit voisin occasionnée par le contenu du service de communication au public en ligne ». Tel n'est cependant pas le cas selon elle puisque la suggestion des sites incriminés « ne constitue pas, en elle-même, une atteinte au droit d'auteur ». En effet, les sites ne sont pas illicites en tant que tels, mais seulement l'utilisation que peuvent en faire certains internautes lorsqu'ils procèdent, sans autorisation, à l'échange de fichiers contenant des œuvres protégées. Google ne saurait par conséquent, selon la Cour, être tenu pour responsable « du contenu éventuellement illicite des fichiers échangés figurant sur les sites incriminés ni des actes des internautes recourant au moteur de recherche ».
- 26 Le raisonnement a priori séduisant de la Cour de Paris n'est pas à l'abri de la critique. L'interprétation restrictive de l'article L. 336-2 CPI qu'elle consacre en refusant d'appliquer la disposition aux atteintes seulement potentielles peut certes se recommander du premier membre de la phrase (« en présence d'une atteinte à un droit d'auteur... ») qui semble effectivement exiger que la contrefaçon soit constatée. Une telle interprétation est cependant plus difficile à concilier avec la suite du texte de l'article L. 336-2 CPI visant les mesures propres « à prévenir » l'atteinte alléguée au droit d'auteur, laquelle inciterait au contraire à accueillir l'action en cessation dans toutes les hypothèses où la contrefaçon est vraisemblable. La précision figurant dans la version initiale du projet de loi selon laquelle l'action en cessation peut être engagée contre toute personne susceptible de contribuer à « éviter le renouvellement » de l'atteinte a en effet été supprimée au cours des débats parlementaires. Or il est permis d'en déduire que le législateur français a entendu étendre l'action en cessation aux hypothèses d'atteintes seulement potentielles.<sup>15</sup>
- 27 La Cour justifie par ailleurs le rejet de l'action par le constat que les suggestions incriminées ne sont pas en elles-mêmes contrefaisantes. Or, même si l'on tient pour acquis que l'article L. 336-2 CPI n'est applicable qu'aux hypothèses de contrefaçons avérées et dûment constatées, il n'exige néanmoins aucunement que la personne à l'encontre de laquelle la mesure de suppression est sollicitée soit elle-même l'auteur de l'atteinte alléguée. Par conséquent, peu

importe également que tous les fichiers figurant sur les sites suggérés par Google ne soient pas « nécessairement destinés à procéder à des téléchargements illégaux », donc que les sites incriminés ne soient pas en eux-mêmes illicites, dès lors que sont constatés des actes de contrefaçon réalisés par leurs utilisateurs, ce qui était le cas en l'espèce.

- 28 L'action consacrée à l'article L. 336-2 CPI est en réalité uniquement subordonnée à la condition que la personne attraitée devant le juge soit « susceptible de contribuer à remédier » à l'atteinte. Or l'interdiction faite à Google de suggérer des sites grâce auxquels les internautes commettent des contrefaçons serait tout à fait de nature à « remédier » (apporter un remède) aux contrefaçons réalisées par les utilisateurs de ces sites. Certes, comme le fait observer la Cour, une telle interdiction n'empêcherait pas que le contenu litigieux reste accessible sur les sites concernés en dépit de la suppression de la suggestion. Il nous semble néanmoins contestable d'en déduire, comme le fait la Cour, que la mesure de filtrage sollicitée serait par conséquent inefficace puisqu'elle ne permettrait pas d'empêcher le téléchargement illégal. Une telle mesure aurait en effet incontestablement pour effet, non pas certes d'empêcher, mais à tout le moins de limiter la fréquentation des sites litigieux et par là-même le volume des échanges illicites de fichiers.

## D. Google News

*CA Bruxelles 05.05.2011, Google c. Copiepresse et al., RG n° 2007/AR/1730 [www.copiepresse.be/Copiepresse5mai2011.pdf](http://www.copiepresse.be/Copiepresse5mai2011.pdf)*

- 29 L'arrêt commenté confirme le jugement rendu par le Tribunal de première instance de Bruxelles le 13 février 2007<sup>16</sup> dans une affaire opposant Google à la société de gestion collective des éditeurs belges de la presse francophone et germanophone Copiepresse. Cette dernière invoquait deux atteintes distinctes au droit d'auteur de ses membres, du fait de la fonction « cache » de Google Web d'une part, du service Google News d'autre part. La Cour de Bruxelles lui donne gain de cause sur les deux fondements au terme d'un raisonnement minutieux et argumenté qui emporte la conviction.
- 30 Sur le premier point, la Cour considère que la pratique de Google qui consiste à enregistrer sur ses propres serveurs, dans sa mémoire « cache », des articles de presse protégés par le droit d'auteur et de permettre aux internautes d'accéder à cette copie, et non à la page originale, c'est-à-dire sans être renvoyés sur le site d'origine, constitue un acte de reproduction et de communication au public. Il convient en effet selon la Cour de ne pas confondre « la recherche instantanée d'une page toujours publiée sur Internet au moyen du service normal *Google Web* où Google ne joue qu'un rôle de moteur de re-

cherche et celle d'une ancienne page, telle qu'elle existait au moment où elle a été visitée par les robots informatiques de Google qui offre ainsi un service supplémentaire ». Ayant refusé l'application de l'exception de copie transitoire, la Cour conclut au caractère contrefaisant de la fonction « cache » de Google.

- 31 Quant au service Google News reproduisant le titre et les premières lignes d'un très grand nombre d'articles de presse et renvoyant l'utilisateur à la page d'origine du site du média concerné, la Cour estime qu'il s'agit de « la reproduction servile de la partie significative des articles référencés ». Visant l'arrêt Infopaq de la CJCE,<sup>17</sup> la Cour considère que les titres et extraits des articles publiés par les éditeurs belges sont protégés par le droit d'auteur et que Google ne pouvait donc pas les reproduire ni les communiquer au public sans autorisation. Elle rejette ensuite l'exception de citation au motif que les extraits ne sont pas reproduits « pour illustrer un propos, défendre une opinion ou réaliser une synthèse sur un point particulier ». Enfin, le service Google News porte également atteinte au droit de paternité des journalistes dont le nom n'est pas mentionné, et à leur droit au respect de l'intégrité de l'œuvre puisqu'ils n'ont pas consenti à ce que leurs articles soient publiés en extraits.
- 32 Ces considérations, au demeurant fort classiques, ne constituent pas néanmoins le cœur de l'arrêt. L'intérêt de la décision réside en effet dans les développements subséquents relatifs au triple test, à l'existence d'une autorisation implicite de reproduction et à l'application de la loi belge transposant la directive e-commerce. Tout en énonçant que le test des trois étapes de l'article 5.5 de la directive Info-Soc constitue « davantage un outil à destination du législateur qu'un mécanisme permettant au juge de restreindre l'exercice d'une exception », la Cour estime tout d'abord que la solution qu'elle retient est conforme aux exigences de ce test puisque tant la reproduction « en cache » que le service Google News portent atteinte à l'exploitation normale de l'œuvre et sont de nature à causer aux éditeurs un préjudice injustifié.<sup>18</sup> Les internautes peuvent en effet avoir accès, grâce à la fonction « cache », à une page qui soit a été supprimée du site des éditeurs, soit n'est accessible que moyennant paiement. Les auteurs sont en droit quant à eux de réclamer une rémunération pour une nouvelle publication de leur œuvre sous la forme d'un extrait substantiel telle qu'elle est réalisée par Google News.
- 33 La Cour se penche ensuite sur l'argument décisif invoqué par Google pour sa défense et tenant à l'existence d'un consentement implicite des éditeurs à la reproduction des articles publiés sur leur site dès lors qu'ils n'ont pas activé les moyens techniques permettant d'interdire aux robots de Google de les référencer. On se souvient que cet argument avait

été considéré comme déterminant par la Cour Fédérale allemande à propos du service Google Images.<sup>19</sup> Tel n'est pas en revanche l'opinion de la Cour d'appel de Bruxelles pour qui « cette thèse est incompatible avec l'exigence d'autorisation explicite qui caractérise le droit d'auteur ». Le droit de reproduction étant selon elle « exclusif et absolu », on ne saurait admettre « qu'un titulaire soit privé de ses droits par le simple fait qu'il a omis de mettre en œuvre un procédé technique ». La Cour condamne ainsi fermement le principe de l'opt-out et conclut qu'une « autorisation expresse, certaine et préalable des auteurs est indispensable pour l'exploitation des articles par Google ».

- 34 Google revendiquait par ailleurs le bénéfice de l'exonération de responsabilité relative aux prestataires de l'internet consacrée par la directive e-commerce, transposée en droit belge par la loi du 11 mars 2003 sur certains aspects juridiques des services de la société de l'information. Contrairement à la Cour de Paris qui, dans les décisions évoquées précédemment, avait assimilé Google à un hébergeur au motif que son rôle, quant aux services Google Vidéos et Google Image, était purement passif et le processus entièrement automatisé, la Cour de Bruxelles refuse quant à elle le principe d'une telle analogie. Elle fait observer que le législateur européen a expressément choisi « de ne pas inclure les moteurs de recherche dans les prestataires de services intermédiaires bénéficiant d'une exonération de responsabilité » et que c'est donc le droit commun qui s'applique. L'impossibilité d'assimiler Google aux prestataires de services visés par la directive e-commerce tient selon elle à ce que les agissements incriminés ne relèvent pas du contenu des sites auxquels Google permet l'accès.
- 35 Ayant ainsi repoussé le principe même d'une exonération de responsabilité de Google sur le fondement de la directive e-commerce, la Cour de Bruxelles entreprend malgré tout de démontrer que les conditions d'application ne sont en tout état de cause pas remplies en l'espèce. Elle fait tout d'abord observer que le stockage « en cache » effectué systématiquement par Google ne constitue pas réellement une activité liée à la transmission des contenus sur les réseaux comparable au *proxy-caching* visé par l'article 13 de la directive, mais s'apparente davantage à une copie d'archivage des sites consultés par le moteur de recherche. Or ce type de copies n'est, selon elle, pas couvert par le régime d'exonération. Quant à Google News, il ne se limite pas à transmettre un hyperlien à l'internaute et ne peut être assimilé à un simple référencement. Google ne saurait être assimilé à un simple hébergeur puisqu'il ne se contente pas de stocker des informations, mais « les sélectionne, les classe dans un ordre et selon une méthode qui lui sont propres, en reproduit une partie et même parfois, en modifie le contenu », de sorte qu'il ne peut être qualifié d'intermédiaire passif.

## Conclusion

Les décisions commentées témoignent de l'embaras de la jurisprudence européenne pour appréhender, du point de vue du droit d'auteur, les nouvelles fonctionnalités offertes par Google. Si les juridictions allemandes et espagnoles<sup>20</sup> ont accepté de légitimer la fonction « cache » du célèbre moteur de recherche ou son service Google Images, leurs homologues francophones<sup>21</sup> apparaissent dans l'ensemble plus réticents pour admettre le principe d'un consentement implicite à l'indexation des œuvres mises en ligne ou une justification tirée du triple test. Le recours à l'exception de citation n'est pas plus prometteur, eu égard aux conditions restrictives des droits français et belge quant à sa mise en œuvre.<sup>22</sup>

L'articulation des dispositions de la directive e-commerce (et des lois nationales l'ayant transposée) avec les règles du droit d'auteur soulève également de nombreuses difficultés. L'assimilation de Google, dans son activité de moteur de recherche, à un hébergeur de contenus s'avère notamment problématique et les solutions consacrées par la jurisprudence des différents Etats européens radicalement opposées. En attendant une opportune révision des directives e-commerce et InfoSoc fixant les règles applicables aux moteurs de recherche, c'est au juge national qu'il appartient de rechercher, dans chaque cas, une solution équilibrée mais respectueuse des droits d'auteur.



- 1 TGI Paris 18.12.2009, La Martinière c. Google, [www.juriscom.net](http://www.juriscom.net). V. A. Lucas-Schloetter, Digital Libraries and Copyright Issues, in I. Iglezakis, T. Synodinou, S. Kapidakis (eds.), E-Publishing and Digital Libraries, 2011, pp.165-168.
- 2 Cass. com. 13.7.2010, n°08-13944, [www.legifrance.gouv.fr](http://www.legifrance.gouv.fr) et CA Paris 19.11.2010, n°08-00620, [http://legalis.net/spip.php?page=jurisprudence-decision&id\\_article=3024](http://legalis.net/spip.php?page=jurisprudence-decision&id_article=3024).
- 3 Directive 2001/31/CE du 8 juin 2000 **relative à certains aspects juridiques des services de la société de l'information, et notamment du commerce électronique, dans le marché intérieur**.
- 4 V. le considérant 42 de la directive e-commerce et CJCE 23.03.2010, Google c. Louis Vuitton, aff. C-236/08, C-237/08 et C-238/08 à propos de Google Adwords.
- 5 Comp. Cass. 1re civ. 17.2.2011, n°09-667896, [www.legifrance.gouv.fr](http://www.legifrance.gouv.fr), sur la qualification d'hébergeur du site *Dailymotion* auquel s'applique le régime de responsabilité des intermédiaires techniques de la LCEN.
- 6 V. TGI Paris 20.05.2008, SAIF c. Google, [www.juriscom.net/jpt/visu.php?ID=1067](http://www.juriscom.net/jpt/visu.php?ID=1067).
- 7 BGH 29.04.2010, I ZR 69/98, 1 (2010) JIPITEC 190, with an English Introduction by P. Zimbehl.
- 8 Comp. les conclusions de l'avocat général dans l'affaire L'Oréal et al. c. eBay, C-324-09, 9.12.2010, <http://curia.europa.eu> estimant, en matière de marques, que l'injonction faite à l'intermédiaire technique ne doit imposer « aucune obligation impossible, disproportionnée ou illicite telle qu'une obligation générale de contrôle », mais qu'elle peut avoir pour objet « d'empêcher la répétition d'une atteinte à une marque donnée par un utilisateur donné ».
- 9 L'art. 6.I.5 LCEN énonce les éléments qui doivent être notifiés pour que la connaissance des faits litigieux soit présumée acquise.
- 10 BGH 29.04.2010, I ZR 69/98, 1 (2010) JIPITEC 190, with an English Introduction by P. Zimbehl.
- 11 Art.L. 122-5 6° Code de la Propriété Intellectuelle (CPI).
- 12 Loi n°2009-669 du 12 juin 2009 favorisant la diffusion et la protection de la création sur internet.
- 13 Le Code français de la propriété intellectuelle ne comportait en effet, jusqu'à la LCEN de 2004, aucune disposition spécifique consacrée à l'action en cessation (*Unterlassungsanspruch*), ce qui n'empêchait pas les tribunaux saisis d'une action en contrefaçon d'ordonner les mesures propres à faire cesser l'atteinte aux droits d'auteur, une fois celle-ci constatée, en application des principes généraux de la responsabilité civile selon lesquels la cessation de l'atteinte est assimilée en droit français à un mode de réparation du préjudice. La LCEN du 21 juin 2004 avait inséré un 4° à l'art. L. 332-1 CPI relatif à la procédure de saisie-contrefaçon qui prévoyait la possibilité pour le Président du TGI d'ordonner « la suspension, par tout moyen, du contenu d'un service de communication au public en ligne portant atteinte à l'un des droits de l'auteur ». Le nouvel art. L. 336-2 CPI créé par la loi Hadopi procède à une réécriture de cette disposition qu'il remplace.
- 14 Conseil constitutionnel, Décision n°2009-580 du 12 juin 2009, [www.conseil-constitutionnel.fr](http://www.conseil-constitutionnel.fr).
- 15 Une telle interprétation se justifie d'autant plus que l'action ouverte par l'art. L. 336-2 CPI est une application particulière, en matière de droit d'auteur, de l'action en cessation consacrée de façon générale par l'art. 14.3 de la directive e-commerce (transposé à l'art. 6 I 8 LCEN en droit français) selon lequel l'exonération de responsabilité des hébergeurs prévue à l'art. 14.1 n'affecte pas la possibilité pour une juridiction « d'exiger du prestataire qu'il mette un terme à une violation ou qu'il prévienne une violation » (et non pas seulement son renouvellement).
- 16 TPI de Bruxelles 13.02.2007, Copiepresse c. Google, RG n°06/10.928/C, <http://www.copiepresse.be/13-02-07-jugement-en.pdf>.
- 17 CJCE 16.7.2009, C-5/08, Infopaq.
- 18 V. *contra* Audiencia Provincial de Barcelona 17.09.2008, Aleix Pedragosa Llauradó c. Google (Megakini.com case), estimant que la fonction cache de Google Web est socialement tolérée et qu'elle ne porte pas atteinte aux intérêts du titulaire des droits dans la mesure où elle facilite la diffusion de la page web. Sur cette décision, v. M. Peguera, Internet Service Provider's Liability in Spain : Recent Case Law and Future Perspectives, 1 (2010) JIPITEC, pp. 155-156.
- 19 BGH 29.04.2010, I ZR 69/98, 1 (2010) JIPITEC 190, with an English Introduction by P. Zimbehl; Audiencia Provincial de Barcelona 17.09.2008, Aleix Pedragosa Llauradó c. Google (Megakini.com case) préc.
- 20 BGH 29.04.2010, I ZR 69/98, *Vorschaubilder* 1 (2010) JIPITEC 190, with an English Introduction by P. Zimbehl; Audiencia Provincial de Barcelona 17.09.2008, Aleix Pedragosa Llauradó c. Google (Megakini.com case), commenté in M. Peguera, Internet Service Providers' Liability in Spain: Recent Case Law and Future Perspectives, 1 (2010) JIPITEC, pp. 155-156.
- 21 V. aussi England and Wales High Court, Chancery Division, 26.11.2010 [2010] EWHC 3099: The Newspaper Licensing Agency (NLA) and others v/ Meltwater Holding BV and others, jugeant dans le même sens à propos d'un service comparable à Google News, mais qui ne s'adresse qu'à des clients professionnels et moyennant paiement.

- 22 V. cependant TGI Nancy 6.12.2010, Le Bien Public et al. C. Dijonscope, n°10/04160, [http://legalis.net/spip.php?page=jurisprudence-decision&id\\_article=3099](http://legalis.net/spip.php?page=jurisprudence-decision&id_article=3099).



# GERMANY: Creating New Property Rights on the Basis of General Legal Concepts - Without Limits?

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**Abstract:** In two cases recently decided by two different senates of the German Federal Supreme Court (Bundesgerichtshof, BGH), the following issue was raised: To what extent can the filming of sports events organized by someone else, on the one hand, and the photographing of someone else's physical property, on the other hand, be legally controlled by the organizer of the sports event and the owner of the property respectively? In its "Hartplatzhelden.de" decision, the first senate of the Federal Supreme Court concluded that the act of filming sports events does not constitute an act of unfair competition as

such, and hence is allowed even without the consent of the organizer of the sports event in question. However, the fifth senate, in its "Prussian gardens and parks" decision, held that photographing someone else's property is subject to the consent of the owner of the grounds, provided the photographs are taken from a spot situated on the owner's property. In spite of their different outcomes, the two cases do not necessarily contradict each other. Rather, read together, they may well lead to an unwanted – and unjustified – extension of exclusive protection, thus creating a new "organizer's" IP right.

**Keywords:** Filming of amateur soccer games, unfair competition law, slavish imitation, taking unfair advantage of the reputation of services; photographing private property from private grounds, property right to the visual image of movable and immovable property, scope of the domiciliary right

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## A.

1 Intellectual property protection has a history of increasing propertization, i.e., of subjecting a growing number of immaterial objects and use acts to the exclusive authorization of the right holder. Although propertization can be justified on the basis of personal rights (protecting the personality interests of creators and innovators) as well as by economic reasons (avoiding underprotection, the so-called tragedy of the commons), it is also commonly understood that legitimate access and use interests of the general public may not be disregarded, and that economic considerations also limit the granting of exclusive IP rights (avoiding overprotection, the so-called tragedy of the anti-commons). The crucial

and hotly debated issue is therefore where to draw the line between what should be the subject of exclusive protection and what should not.

2 If a particular use act of an immaterial object falls outside the limited number of existing IP rights and their defined boundaries, plaintiffs who want to prevent third parties from benefitting from, or building upon, their commercial activity, often feel tempted to invoke, and test the limits of, general notions of law in order to secure for themselves some sort of exclusivity. In this respect, two recent decisions by the German Federal Supreme Court (BGH) illustrate how plaintiffs invoked the rules against unfair competition in one case (unsuccessfully) and the right to physical property in another (successfully). True, both decisions concern areas of national law that

have not been subject to EU harmonization. However, since the conflict they undertook to solve undoubtedly exists in other EU member states as well, and because these two cases are perfect examples of both the mechanism and the driving forces behind the trend toward ever-increasing propertization, these two national cases merit discussion here.

## B.

### I. BGH of 28 October 2010, case I 60/09 - Hartplatzhelden.de<sup>1</sup>

- 3 At issue in the first case was whether the soccer association of the Region of Wuerttemberg, whose task is to organize amateur soccer matches, could prevent the defendant from operating an Internet platform ([www.hartplatzhelden.de](http://www.hartplatzhelden.de)) to which registered users could upload short filmed sequences of the amateur matches in question. The platform was financed by advertising revenue and viewing the material uploaded by the general public was free. The claim was based on a theory of unfair competition, but the real motive of the association was undoubtedly the desire to exclusively market the filming of amateur soccer matches (in much the same way as the Federal Soccer Association markets have for some time marketed the filming of professional soccer matches<sup>2</sup>), which it had failed to do thus far.
- 4 The court of first instance admitted the plaintiff's claim, and the defendant's appeal remained without success.<sup>3</sup> The first senate of the Federal Supreme Court (for copyright, trademark, and unfair competition matters) reversed, refuting all claims based on unfair competition law. In particular, the court held that the defendant did not engage in an activity of taking unfair advantage of or causing damage to the reputation of the imitated goods or services within the meaning of § 4 No. 9 b of the German Act against Unfair Competition (which, in its language, is similar to Art. 5 (2) of the EU Trademark Directive), since the defendant was not offering services (making films available via an Internet platform) that imitated the plaintiff's services (organizing soccer matches). Rather, the defendant's services built upon the plaintiff's services (in this respect, it may be noted that the BGH left open the question whether the activity of organizing soccer matches can qualify as a service within the meaning of § 4 No. 9 of the German Act against Unfair Competition at all). In addition, the BGH did not find any taking unfair advantage of, or causing damage to, the reputation of the plaintiff's services, since no transfer of the reputation of the plaintiff's services to the services of the defendant could be found. Moreover, according to the BGH, the defendant's activity did not violate the general clause of unfair competition (§ 3
- (1) of the German Act against Unfair Competition). Although not totally ruling out the possibility of protection for the entrepreneurial results of organizational efforts, the BGH requires for such protection an overriding interest of the plaintiff vis-à-vis the equally protected interest of the defendant, since the latter can avail itself of the protection by the constitutional right of freedom of information and exercise of a commercial activity (Arts. 5 (1) and 12 (1) of the German Constitution). Moreover, in view of the fact that the great majority of amateur games are currently not televised, the interest of the general public also weighs against the interests of the plaintiff. In sum, in view of the fact that the plaintiff's economic activity did not depend on the marketing of the games it organizes, and also in view of the fact that the plaintiff had so far not undertaken efforts of marketing audiovisual recordings of the games, the BGH could not find an overriding interest of the plaintiff that eventually might have given rise to protection by way of the law of unfair competition. According to the court, there is no need to have someone who has offered a service participate in the proceeds of all subsequent exploitations of that service. Similarly, the BGH did not consider the defendant's service as a targeted interference with the plaintiff's service (§ 4 No. 10 of the German Act against Unfair Competition), nor did the BGH conclude to legal protection on the basis of the plaintiff's tort claim regarding interference with its established commercial enterprise ("Eingriff in den eingerichteten und ausgeübten Gewerbebetrieb").<sup>4</sup>
- 5 This makes sense, particularly in view of the fact that German copyright contains a special exclusive right for organizers of performances by performing artists (§ 81 of the German Copyright Act). Moreover, in an earlier decision, the BGH had refused to apply this provision – either directly (soccer players are not performing artists since what they perform is not copyrighted work) or by way of analogy – to organizers of sports events.<sup>5</sup> Construing such protection on the basis of unfair competition law would therefore have disregarded the legislative decision to limit the exclusive protection to organizers of performances of performing artists, and it would have undermined the rule that absent a special intellectual property right and unless additional unfair elements of a defendant's conduct are found, competition remains free.<sup>6</sup>
- 6 However, it should be noted that the first senate of the BGH also confirmed that a soccer association may well, via its member clubs, reserve for itself the right to exploit the games by way of filming on the basis of the club's domiciliary rights (*Hausrecht*), which have their basis in the right of ownership of the stadium and the respective premises. As a matter of fact, it was on the basis of this right that the BGH, in earlier decisions regarding the audiovisual exploitation of professional soccer games, had construed the le-

gal exclusivity in favor of the German soccer association.<sup>7</sup> But in the present case, the plaintiffs had not pleaded a violation of any domiciliary rights. This may have been due to the fact that some of the film clips were taken from outside of the premises of the (usually rather small) regional and local clubs, that the clubs were not the owners of the soccer fields they were playing on, or that they – or the real owner – had not objected to the films being taken by spectators. Of course, with regard to the future, it will be important to know whether soccer clubs will make use of their domiciliary rights, and if so, what the scope of the domiciliary right is. In this respect, the second of the two decisions discussed here may shed some light, though it does not deal with the filming of sports events but rather with the photographing of physical objects.

## II. BGH of 17 December 2010, V ZR 45/10 - Prussian Gardens and Parks<sup>8</sup>

7 In the second of the two cases discussed here, the issue was whether the state foundation responsible for maintaining Prussian gardens and parks could stop a photo agency from offering, via an Internet platform, photographs of the castles and gardens which the agency had made on its own account or upon commission by third parties. In this case, the plaintiff based its claim on the property right in the land surrounding the castles and of the gardens.

8 Here, the court of first instance admitted the plaintiff's claim, but the defendant's appeal was successful.<sup>9</sup> However, the fifth senate (for, inter alia, matters concerning land property) also reversed, and thus – contrary to the “Hartplatzhelden.de” decision – decided in favor of the plaintiff. In particular, the court held that although photographing someone else's property does not interfere with the property's physical substance or with the owner's right to use the physical object of that property, it nevertheless interfered with the owner's right to exploit the outer appearance of the object of legal ownership, as long as the building or garden in question was photographed from a spot on the surrounding grounds. This right does not, however, extend to photographs taken from places outside of the owner's grounds (deciding otherwise would indeed undermine the legislative decision according to which even copyrighted works may be photographed without permission if the picture is taken from a public place; see § 59 of the German Copyright Act). But according to the court, the right is not limited to the act of photographing itself, but purportedly also extends to subsequent exploitation acts made by the photographer and even by third parties. Although not openly admitting it, the court thus did in fact conclude from the property right in the grounds and the

domiciliary right that comes with it to an exclusive right to photograph physical objects on the ground in question. In the case at the bar, this result was not even altered by the fact that the foundation had made the grounds accessible to the public. If the case was nevertheless remanded, the reason was merely that the lower courts had not sufficiently ascertained whether the foundation was in fact the owner of the castle and garden grounds.

9 In legal literature, the reasoning of this decision was unanimously rejected. As a matter of fact, hardly ever has a judgment of the German Federal Supreme Court been so heavily criticized.<sup>10</sup> True, in a similar situation, an earlier decision of the BGH from the 1970s had accepted the plaintiff's claim.<sup>11</sup> In a later decision, however, the first senate of the BGH had clarified that the physical property of an object did not include an exclusive right of the owner to authorize the making and subsequent exploitation of photographs taken from this particular object.<sup>12</sup> Moreover, although it is true that copyright in the expression of an object has to be distinguished from physical ownership of the copyrighted object itself,<sup>13</sup> in the decision just mentioned the first senate of the BGH had concluded that the copyright limitation to freely photograph copyrighted works which are permanently located at public places and streets (§ 59 of the German Copyright Act) cannot be undermined by any property right in the object photographed.<sup>14</sup> It is indeed difficult to see how the present holding of the fifth senate can be brought in line with these earlier holdings of the first senate of the BGH. This is all the more true since the foundation had admitted the public to the castle and garden grounds, which – in copyright literature – is considered sufficient to trigger the copyright exception and hence give rise to the corresponding freedom to photograph someone else's physical property. Most important, however, in its “Prussian gardens and parks” decision the BGH gives the domiciliary right of the owner of physical premises an unprecedented and unduly broad scope. The domiciliary right is the right of the owner to control physical access to his or her premises. This includes the conditions under which access is granted. Therefore, the owner may undoubtedly link the authorization to access his or her premises to a prohibition to take photographs (it is, of course, another matter whether a public entity is obliged to grant unconditional access to the general public). But the domiciliary right does not extend beyond the physical confines of the premises to which it attaches. In other words, contrary to the opinion of the BGH, once photographs taken in violation of a domiciliary right are brought outside of the protected premises, their further use is not illegal. The owner may be able to prevent the photographer from exploiting the photographs taken in violation of the domiciliary rights on the grounds of breach of contract. But there is no doctrine comparable to the “fruits of the poisoned tree” that would

prevent third parties from marketing photographs that have been made by a photographer in violation of someone else's domiciliary right. This appears to also be the opinion of the BGH in its decisions regarding the rights of the organizers of sports events, which up until now have not been considered as true exclusive rights. Ultimately, when movable objects are photographed, the decision of the BGH seems to lead to the absurd result that the owner of the movable object cannot object to photographs being taken, but the owner of the premises on which the movable object is located could.

## C.

- 10 The "Prussian gardens and parks" decision of the fifth senate of the German Federal Supreme Court may be very badly reasoned, if not blatantly wrong altogether. However, it cannot simply be disregarded. This gives rise to the question of whether it is in conflict with the decision handed down by the first senate of the BGH in the "Hartplatzhelden.de" case. After all, whereas the Wuerttemberg soccer association did not succeed with its claim for exclusivity in marketing films of the matches organized under its auspices, the foundation's claim for controlling the exploitation of photographs and films being taken from its castles and gardens (provided the foundation is its true owner) was accepted.
- 11 Here, it may first be noted that although "Hartplatzhelden.de" was already decided on 28 October 2010, the full reasoning was only published by the court in spring 2011. Hence, it may well be – or even is highly probable – that in deciding "Prussian gardens and parks" on 17 December 2010, the fifth senate wasn't fully aware of the first senate's reasoning. However, even if the outcome of the two cases is different, the two decisions do not necessarily contradict each other. In "Hartplatzhelden.de," the first senate of the BGH refuted the plaintiff's claims based on unfair competition but, in doing so, expressly referred to the protection available to the organizers of sports events on the basis of the domiciliary rights of the owners of the sports stadiums. Although the first senate may well have worked on the implicit assumption that the scope of the domiciliary right is limited and that, therefore, it does not grant to the owner of the premises an exclusive right with regard to the filming of sports events, the decision of the fifth senate now defines the scope of the domiciliary right, transforming it into a true exclusive right with regard to the exploitation of photographs and films of the sports events organized. In other words, in spite of the fact that the organizers of sports events lost their case before the first senate of the BGH, their rights seem to have been greatly reinforced by the decision of the fifth senate. Contrary to the first senate, the fifth senate, however, reached its much broader conclusion by – only sketchily – referring to existing norms. It did not embark upon an analysis of the economic need for such a far-reaching exclusive protection, nor did it analyze the effect of such protection on competition in the relevant market.
- 12 But perhaps the decision handed down by the fifth senate can be read in a more narrow way, after all. Perhaps it refers only to objects that form part of the property of the premises (under German law, buildings as well as fixtures thereto form part of the grounds on which they are erected or from which they cannot be separated without being destroyed, and hence are covered by the legal property title to the grounds). Understood in this way, the decision would not be relevant to the making of photographs of movable objects (according to the fifth senate the general rule that ownership of movable objects does not include the exclusive right to control the making of photographs shall remain untouched). However, in practice, even such a limited scope of the decision leads to the rather absurd result that the exclusivity granted with regard to the filming of the grounds and buildings (which as such merely serve as a backdrop to the images taken) would then serve as the basis of monopolizing the filming of the sports events organized on the premises protected. Finally, it should be added that personality rights of the sports players also play a role.
- 13 All this demonstrates that an increase in propertization such as the one effectuated by the German "Prussian gardens and parks" decision is much better placed in the hands of the legislature (ideally the EU legislature), which could give such an exclusive right more precise contours. That is, if one is of the opinion that propertization should indeed be extended with regard to the marketing of sports events at all.

- 1 GRUR 2011, 436. – All decisions by the German Federal Supreme Court (BGH) are available online at the court's website at <http://juris.bundesgerichtshof.de/cgi-bin/rechtsprechung/list.py?Gericht=bgh&Art=en&Datum=Aktuell&Sort=12288>.
- 2 For confirmation of the legal exclusivity with regard to professional matches, see the references in note 7.
- 3 See Landgericht (LG) Stuttgart of 8 May 2008, case 41 O 3/08 KfH, MMR 2008, 551 and Oberlandesgericht (OLG) Stuttgart of 19 March 2009, case 2 U 47/08, MMR 2009, 395.
- 4 See already the earlier decision of the BGH of 29 April 1970, case I ZR 30/68, GRUR 1971, 46 – *Bubi Scholz*.
- 5 BGH of 14 March 1990, case KVR 4/88, GRUR 1990, 702 – *Sportübertragungen*; see also OLG Hamburg of 11 October 2006, case 5 U 112/06, GRUR-RR 2007, 181 – *Slowakischer Fußball*.
- 6 For a generally approving comment, see *Armah*, GRUR-Prax 2011, 175; *Feiler*, K&R 2011, 342; *Körber/Ess*, WRP 2011, 697.
- 7 See BGH of 14 March 1990, case KVR 4/88, BGHZ 110, 371 – *Sportübertragungen*; of 11 December 1997, case KVR 7/96, BGHZ

- 137, 297 – *Europapokalheimspiele*; and of 8 November 2005, case KZR 37/03, BGHZ 165, 62 – *Hörfunkrechte*.
- 8 GRUR 2011, 323 with note by *Lehmert*; ZUM 2011, 327 with note by *Stieper*, JZ 2011, 371 with note by *Schack*. – The same day, the Federal Supreme Court also decided two parallel decisions by the same plaintiff, one against a film publisher who distributed a DVD on the city of Potsdam (case V ZR 46/10, ZUM 2011, 333; for the decision of the court of appeals, see OLG Brandenburg CR 2010, 393) and the other against the operator of an Internet platform from which photographs of the castles and gardens could be downloaded against payment of a fee (case V ZR 44/10, ZUM 2011, 325; for the decision of the court of appeals, see OLG Brandenburg ZUM 2010, 356, and for the first instance, LG Potsdam ZUM-RD 2009, 223).
  - 9 See LG Potsdam of 21 November 2008, case 1 O 161/08, ZUM 2009, 430 with note by *Ernst*, and OLG Brandenburg of 18 February 2010, case 5 U 13/09, GRUR 2010, 927.
  - 10 *Schack*, JZ 2011, 375; *Stieper*, ZUM 2011, 331; *Lehmert*, GRUR 2011, 327; *Schabenberger*, GRUR-Prax 2011, 139, and already earlier *Bullinger/Bretzel/Schmalfuß* (eds.), *Urheberrechte in Museen und Archiven*, 2010, pp.85 et seq.; *Maaßen*, GRUR 2010, 880; *Ernst*, ZUM 2009, 434; *Seiler*, K&R 2010, 234. – See, however, *Prenzel*, *Bildzitate*, pp.205 et seq., referred to by the BGH.
  - 11 BGH of 20 September 1974, case I ZR 99/73, GRUR 1975, 500 – *Schloß Tegel*. – In an even earlier decision, the BGH had held that reproducing an object not from the original but from a reproduction did not infringe the property right of the owner of the object reproduced; see BGH of 13 October 1965, case Ib ZR 111/63, BGHZ 44, 288 = GRUR 1966, 503 – *Apfel-Madonna*.
  - 12 BGH of 9 March 1989, case I ZR 54/87, GRUR 1990, 390 – *Friesehaus* (for immovable property); see also later LG Hamburg of 30 April 1993, case 324 O 77/93, AfP 1994, 161 (movable property).
  - 13 See, e.g., BGH of 23 February 1995, case I ZR 68/93, BGHZ 129, 66, 70 = GRUR 1995, 673 – *Mauer-Bilder*.
  - 14 BGH of 9 March 1989, case I ZR 54/87, GRUR 1990, 390 – *Friesehaus*; of 5 June 2003, case I ZR 192/00, GRUR 2003, 1035 – *Hundertwasserhaus*.

# Book Reviews

# Stig Strömholm, Copyright and the Conflict of Laws: A Comparative Survey

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- 1 Two decades ago there was barely any discussion on private international law (PIL) and intellectual property (IP). In recent years, however, the debate has been increasing, and numerous more or less extensive studies, publications, and academic proposals have been published worldwide. One could argue that IP lawyers, seeing the problems of enforcement of IP rights in an international context and at the same time facing little hope of further international harmonization of substantial IP law, have moved to the until recently neglected area of international private law with the expectation that some useful work can be done in this field.
- 2 The author of the book reviewed here, Prof. (em.) Dr. Dr. Dr. h.c. mult. Stig Strömholm, a former rector of the University of Uppsala, has perfectly realized the increasing importance of this field of law. Prof. Strömholm's book focuses on one of the most complicated sets of issues – conflict of laws (or applicable law) to copyright. The book's stated goal is to provide a survey of law in the field concerned, leaving the critical analysis of the existing legal framework and the development of alternatives for the discussion *ex post*. The study is divided into four chapters: (1) an introduction, (2) an introduction to the international and European legal framework, (3) an overview of the selected national laws, and (4) a summary of historical and more recent doctrinal discussion in the field.
- 3 After a short introduction in chapter 1, chapter 2 starts with an overview of substantial law provisions of the 1886 Berne Convention on the protection of literary and artistic works. It briefly explains and provides some historical comments on provi-

sions dealing with the no-formality rule, the national treatment principle, the minimum protection requirement, protected types of works, the fixation requirement, the notion of publication, provisions on cinematographic works, moral rights, and *droit de suite*. The national treatment rule as found in Article 5(2) of the Berne Convention, which is recognized to be the most important and nonetheless controversial provision related to conflict of laws in international law on copyright, is construed by the author as clearly directing to a single applicable law:

*There can be no doubt that the principle of the country of protection must be considered the expression of a choice (...) of one possibility among a number of potentially applicable laws: the solution adopted by the Convention implies that in respect of the issues set out in the text (...) the Convention indicates a single legal system and gives it exclusive applicability (para. 22).*

- 4 On the other hand, it is not necessarily seen as a conflict-of-laws rule *sensu strictu* (para. 25). Also, following the majority opinion, the author suggests that the choice-of-law rule is implemented in Article 14bis(2)(a) of the Convention, which addresses the protection of cinematographic works.<sup>1</sup> Further on, the notion of the country of origin (Art. 2(7) of the Berne Convention) is explained. Interestingly, the author points to the term of protection as the only exception from the national treatment principle and as the only case where country of origin plays a role (para. 58). One could point out that a similar “reciprocity rule” exists in respect of *droit de suite* right (Art. 14ter(2)) and industrial design (Art. 2(7)<sup>2nd</sup> sentence).

- 5 As a next step, a short account is given of the substantial provisions of other international conventions – the 1952 Universal Copyright Convention, TRIPS, WIPO Copyright Treaty, 1961 Rome Convention on Neighboring Rights, and 1974 Satellite Convention. As far as PIL issues are concerned, the author only mentions that “the problems of private (and procedural) international law (...) are essentially of the same character as those raised by the Berne Convention” (p. 31). Regarding European law, early European multilateral treaties (1960 European Television agreement, 1958 Paris Agreement on the exchange of television programs) and numerous EU directives harmonizing certain issues of copyright law are mentioned. Regarding private international law, the author rightly argues that Article 2(b) of the Satellite Broadcasting and Cable Retransmission Directive<sup>2</sup> contains a provision that “amounts in terms of its practical result to a choice of law rule” (para. 49). Regretably, the most important recent developments in the field, namely, the Rome I Regulation<sup>3</sup> and Rome II Regulation,<sup>4</sup> are only mentioned without any substantial comments.
- 6 Chapter 3 contains a comparative overview of selected national laws (i.e., Swedish, German, French, and UK) on copyright and conflict of laws. It starts with an overview of Swedish law in the field, which is a worthy contribution since the legal situation in this jurisdiction is little known for an international audience. As one issue, the chapter comments on the question surrounding which law is applied to international copyright contracts: Under Article 60 of the Swedish Copyright Act, there seems to be no agreement as to whether it is sufficient to apply to such contracts general Swedish PIL or whether, as a precondition, the work in the dispute should be protected under Swedish law (para. 52). For an international reader it may also be interesting to read about the Swedish International Copyright Regulation of 1994, which sets rules concerning the application of the Copyright Act “in respect of other countries.” While outlining the provisions of this Act, the author discusses the provisions on alien law (i.e., to which foreign works the Act applies), a reciprocity rule in respect of duration of rights, and a complicated non-mandatory choice-of-law rule for cinematographic works. From the overview, however, it seems that the regulation does not contain choice-of-law rules *sensu strictu*.
- 7 The overview of German law starts by rightly pointing to the country-of-protection rule as a well-established rule of conflict of laws to all issues related to copyright disputes. The author then makes a comment that, in regard to this country-of-protection rule, “there is agreement in principle between German law and the position which we have found to be adopted by Swedish law” and then moves to the overview of provisions on alien rights in German law. The former conclusion, however, might sound surprising for some readers since the earlier chapter on Swedish law makes no mention at all of a country-of-protection rule and seems to focus on alien law instead. The outline of the French legal situation focuses also on the rules of alien law (e.g., protection of foreign works first communicated in France but not protected in the country of origin or, *vice versa*, French works communicated abroad for the first time). Regarding rules on the conflict of laws, the author vividly and pointedly suggests that a great number of complicated cases related to conflict of laws issues and the extensive application of public policy and mandatory rules have made French lawyers “prisoners of an almost impenetrable maze.” Finally, a short look is given at the British law. Here, the provisions of the UK Copyright, Designs and Patents Act of 1988 on such issues as the qualification for protection, geographical application of the Act, and the fixation requirement as overtaken from the Berne Convention are discussed. It is rightly concluded that “British copyright legislation does not contain any explicit choice-of-law rules for international situations.” However, one could have expected at least a mention of the UK Private International Law (Miscellaneous Provisions) Act of 1995, which supposedly applies to copyright cases as well.<sup>5</sup> In regard to the chapter in general, it is interesting to note that primary attention here is paid not to the rules of conflict of laws *sensu strictu*, but rather to alien law. It might be true, as the author claims, that the rules on conflict of laws to copyright in France are still not clearly distinguished from alien law (*droit des étrangers*); however, at least in Germany, the distinction between them seems to be rather clear. The author thus seems to adapt a broader notion of conflict of laws, which includes alien law.
- 8 The last chapter takes a look at several of the most important works on copyright and conflict of laws in early and contemporary European and foreign legal doctrine. First, the proposal on IP and PIL of 1975 by Eugen Ulmer, an internationally acknowledged German scholar, is analyzed in detail. The author of the reviewed book claims that the legal situation as described by *Ulmer* “can still be characterized without much hesitation as an essentially correct description of the basic principles of European law, or at least continental European law, as it stands today.” Also, the author follows *Ulmer’s* proposal that “the body of private international law rules [for copyright disputes] are not necessary.” Rather, “solving a number of problems concerning details [of the international conventions] should be based upon the foundations laid, directly or indirectly, by the great conventions” (para. 85). Further, an account of the critics of *Ulmer’s* proposal, mainly *Neuhaus*, is given. The universal approach suggested by the latter is strongly criticized by the author. In particular, *Neuhaus’* claim on “protectionist” policies of the state and a pledge for “liberty” in intellectual property law, as well as his dis-



inction between the existence of right and its legal protection (i.e., enforcement), are all rejected.

- 9 The author then moves to a more recent French treatise, *Authors' Rights and Conflict of Laws* (Droit d'auteur et conflits de lois), by Jacques Raynard (1990). After providing a short summary of an extensive monograph, the author rightly questions whether Raynard's method, based on the classification of copyright as "a right *in rem* of the same kind as a right to property," is of real importance when proposing a practical solution for the conflict of laws (para. 94). The author greets the eventual adherence of Raynard to the principle of territoriality and the principle of the country of protection. As a third doctrinal source, a relatively more recent British monograph by James J. Fawcett and Paul Torremans, *Intellectual Property and Private International Law* (Oxford 1998), is briefly described (paras. 97-99).
- 10 At last, in the final pages of the book, the discussion on conflict of laws in regard to new digital technologies is given some attention. The reports of Jane C. Ginsburg from the United States and André Lucas from France, as prepared at the request of WIPO in 1998/2001, are briefly presented. The author summarizes the main points of the reports well. Regarding the discussion that followed these reports over the previous ten years, it is only mentioned that "an intense discussion concerning jurisdiction in international intellectual property litigation, the choice of law in different kinds of controversies (...) is going on among individual legal scholars both in international organizations and research institutes." Also, the author mentions and briefly describes the first draft of the ALI Principles (for which Ginsburg was one of three reporters and Lucas was an adviser). One should add, however, that the final version of the ALI Principles was already issued in 2008, and their content on some issues differs quite substantially from the first draft.<sup>6</sup> In this context one could also add that a European counterpart has been under preparation by the European Max Planck Group for Conflict of Laws and Intellectual Property (CLIP). The first drafts of the CLIP Proposal were made available in 2009, with an expectation to finalize the project in 2012.<sup>7</sup>
- 11 In the concluding part, the author concludes with astonishment – but correctly – that "in spite of different points of departure and equally different approaches and methods, the spokesmen [i.e., scholars] (...) have arrived at the relatively unanimous practical conclusions," i.e., the "law of the protecting country" (para. 108). The author supports this outcome of the discussion and suggests that new technologies shall be "considered as sufficiently specific but also sufficiently well defined and well delimited, to be given a special treatment without overflowing the whole field of international intellectual property law" (para. 108). He recognizes that in order to

achieve a complete effectiveness in the system, an international agreement covering virtually all states is needed, though this is improbable, if not impossible, in the foreseeable future.<sup>8</sup> Therefore, the author argues, "it seems almost certain that further development of technical protection devices and measures is necessary to complete protection by the ordinary methods."

- 12 In summary, the book provides a short general overview of the *de lege lata* situation in the field of conflict of laws and copyright without overloading it with details, specific problems, and numerous legal sources in the field. The book is an introduction to both the basics of copyright law and the rules on conflicts of law; it covers both international and several well-selected national jurisdictions in less than 100 pages. By introducing the works of the most prominent scholars from different jurisdictions during the last 50 years, the book makes the reader familiar with the historical development of the debate and lends understanding to the status of the current discussion. The book is obviously far from being comprehensive or exhaustive (this was not its goal), and a reader familiar with the field may miss specific references to existing legal practice, detailed analyses of the problems, or updates of current developments. At the same time, however, it contains a good selection of the most important legal and doctrinal sources that can be used by a beginner in the field and may serve as a first reference for further research.

- 1 In addition, the author notices the choice-of-law rule in Art. 11<sup>bis</sup> of the Berne Convention, which regulates a copyright exception on the reporting of current events; this provision has been overlooked in most studies in the field.
- 2 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, 6.10.1993, p. 15-21.
- 3 Regulation (EC) No 593/2008 of the European Parliament and the Council of 17 June 2008 on the law applicable to contractual obligations (Rome I), *OJ L*, 4.7.2008, p. 6-16.
- 4 Regulation (EC) No 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.
- 5 See Fawcett, James J. & Torremans, Paul, *Intellectual Property and Private International Law* 619 (Clarendon Press 1998).
- 6 E.g., instead of the "market effect" rule suggested as a main rule for IP disputes in the first draft, the final text suggests a traditional territoriality principle and the *lex loci protectionis* rule instead; see sec. 301 of American Law Institute, *Intellectual Property: Principles Governing Jurisdiction, Choice of Law, and Judgments in Transnational Disputes* (American Law Institute Publishers, St. Paul, MN 2008).
- 7 For available drafts and recent updates, see <[www.cl-ip.eu](http://www.cl-ip.eu)>, last accessed on 20 May 2011.
- 8 Here one can point to the new initiative of the International Law Association on private international law and intellectual property started in 2010, which may lead to further progress

at the international level; for updates, see <<http://www.ila-hq.org/en/committees/index.cfm/cid/1037>>, last accessed on 20 May 2011.

# Simon Chesterman, *One Nation Under Surveillance – A New Social Contract to Defend Freedom Without Sacrificing Liberty*

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by **Thomas Dreier**,

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- 1 What do Saddam Hussein, information law, and privacy have in common? Not much, at first sight. However, a second glance reveals that they constitute key elements of what might be termed *public information law*, i.e., the body of legal rules that govern the relationship between public authorities – both governing and administrative – toward the citizens. This characteristic distinguishes it from private information law, which structures the informational relationships amongst private firms and individuals. It hardly comes as a surprise that the issue of regulating the obtaining and use of intelligence information has received particular attention in the US in the wake of the 2001 attacks and the subsequent “war on terror” launched immediately following by the Bush administration. Of course, these issues are discussed in Europe as well with regard to anti-terror legislation, today mostly regarding the question of its prolongation. In Europe in general, however, public information law is mostly discussed under the headings of informational self-determination, freedom of information acts, and public sector information (PSI). This places the focus on the administrative aspect and the public/private interface rather than on the legal regime governing the collection and use of intelligence information by state authorities, most notably their secret services, and, for some time, also by private contractors to which the collecting of intelligence information has been outsourced.
- 2 Compared with other types of information, intelligence information possesses some particular fea-

tures, even if the boundary between intelligence and non-intelligence information may be difficult, if not impossible, to draw. Ultimately, any sort of information that is not generally available can be considered intelligence information. The important qualifier seems to be that the information in question is collected and used by an intelligence-collecting body as part of intelligence. The most prominent feature of intelligent information is that once it has been collected it is purposely kept secret. Even more, in order to keep the information secret once it has been collected, the process of collecting must itself be kept secret. From there, it is only a small – and for governments a rather tempting – step to keep even the existence of the intelligence-gathering body secret. Although the need for, and legitimacy of, both intelligence-gathering organizations and the secrecy they deploy is generally accepted as such, for democratic societies, which are based on the principles of control and, to a large extent, on transparency, it is particularly troublesome to draw proper lines regarding when secrecy is justified and when it should be lifted. The problem, of course, is how to learn about secret information in the first place. Moreover, even if a process for reviewing the real or perceived legitimacy of the secrecy is provided for, the question is which institution – internal or external, political or judicial – appears to be best suited to make the appropriate decisions. Finally, contrary to private information law, where conflicts between keepers and seekers of information as regards intelligence information can be decided by an independent third party – in general, the legislature, and in particular, the ju-

diciary – the executive and more often than not the legislature are themselves immediately involved as interested parties, making the role of the judiciary even more troublesome.

- 3 With his book, Simon Chesterman – Vice Dean and Professor of Law at the National University of Singapore, and Global Professor and Director of the New York University School of Law Singapore Program – who has extensively published on issues of international law, in particular on intelligence and security as well as on legitimacy and the limits of legality of state actions in this respect, obviously pursues two objectives. First, he gives a concise and comprehensive overview of the current legislation on gathering and using intelligence information as illustrated by the cases of the US and Britain in response to the real or perceived threats of globalized terror, but also by the different activities of the United Nations. Second, he discusses the different governance options to come up with a recommendation for how an appropriate framework for preventing abuses should be construed.
- 4 Consequently, the book is divided in three parts. Part one lays the theoretical foundations, beginning with an overview of the legal regulation of spies in times of peace and war, of consular activities under the guise of which – often tacitly accepted by the host country – intelligence gathering takes place, and of intelligence as such. This is followed by an account and discussion of the problem of emergency powers, both as regards their exercise in practice and their legal justification, which in spite of attempts to argue in a legal way, tends to limit, or at least demonstrates the limits of, the rule of law. At the end of the first part the author focuses on the need for state secrets, barriers to effective accountability, and extra-legal measures of intelligence gathering. Part two of the book then begins with the US up to the Bush administration change toward outsourcing state intelligence-gathering tasks to private contractors. With the United Kingdom, which the author has chosen as his second example, it becomes clear that in spite of the similarities of taking on the perceived threat of global terror, there was at least an attempt to maintain the rule of law, which is probably due to a different historical legal culture. This, however, accounts for the British indifference toward comprehensive CCTV surveillance as well as for the sensitivity of the British vis-à-vis the introduction of an identity card. As a third example, Chesterman has chosen not another individual state, but rather the United Nations. Here, the description of the numerous activities of the UN, its sub-organizations, and the special tribunals – none of which have intelligence information of their own but must rely on the making available of intelligence information by national secret services – reveals a much richer and more nuanced picture. This enables the author in part three of the book to examine the most appropriate structures available
- to ensure the accountability of intelligence services, and to consider whether the focus of accountability should be on the collection of intelligence or on its use. He then returns to the theme of whether and how intelligence activities can be regulated effectively in view of the diminishing sphere of truly private activity and the growing coercive powers of the state in the final chapter.
- 5 It is not the purpose of this review to focus on the issues of the regulation of intelligence activities in times of war and in peace in general, since this does not lie within the scope of a journal on IP- and IT-law. In addition, other commentators are much more qualified in this respect; it should only be noted here that although the book contains a general reference to whistleblowers, the reader will search in vain for a more detailed discussion of the usefulness and legitimacy of organizations such as Wikileaks. Depending upon which side you are on, you will either see in the book an account of “the privacy implications of the war on terror” (Frederick P. Hitz, former Inspector General, CIA) or you will conclude – more in line with Chesterman – that “often foreign and domestic intelligence gathering in the major democracies has been insensitive to public accountability, legality, and its consequences for individuals, to the detriment of both liberty and security” and “how ... this can and must change” (Gareth Evans, President Emeritus of the International Crisis Group and former Foreign Minister of Australia).
- 6 However, what is of importance for both the future of privacy and data protection is Chesterman’s core thesis and, as a matter of fact, the fundamental assumption on which all other conclusions are based: In view of the ever-increasing data available to governments as well as the ever-increasing computing power that enables governments to combine, analyze, and profile the vast amount of data collected and stored, according to Chesterman it would be illusionary to try to re-establish privacy to a pre-computer age and to implement the principle of collecting as little data as possible. Rather, in his view, attention should more realistically be focused on the legitimacy of the uses made of such data. Refuting “false” or at least “misleading” choices, in particular the classical tradeoff between liberty and security (“how much freedom shall be sacrificed for how much security?”), and after having reviewed the different options available, Chesterman finally asks for a “new social contract” that should be characterized by three principles: (1) the intelligence powers exercised must be public, (2) the entities carrying out these functions must be legal, and (3) accountability for activities of intelligence services must be consequence-sensitive (as opposed to having the aim of deterring or responding to abuse). As Chesterman concludes himself: “These principles ... may sound obvious, if not trite. Nevertheless, as this book has shown, established democracies founded on the rule

of law and the most important international organizations ... have not lived up to them.”

- 7 True, as such the book’s primary focus is not on information law per se. Rather, its main impetus is to take an active part in shaping appropriate governance structures as regards the handling of intelligence information, and, ultimately, to preserve the rule of law which – between 9/11 and the election of President Obama – has probably come more under attack in the US than in any other Western democracy. Obviously traumatized by the US experience of having suffered under the Bush administration which in many instances placed itself above the law, Chesterman analyzes the dangers that come with an unfettered collection and use of intelligence information. Although this is set against a US background, it should be noted that the title of the book (“*One Nation under Surveillance*”) does not refer to the US alone; instead, it suggests not only that the issue is global, but likewise that only one solution is appropriate. But even if it is true that information gathering by intelligence services is no longer confined to national borders, making the classical distinction between internal and external information gathering blurred if not almost meaningless (though even this may be questioned in view of the fact that the US *demand*ed European flight and credit transaction data from the EU), and if in this sense all the peoples of the world do indeed form “one” nation under surveillance, it is also true that the different cultures of the world should be taken together to form an appropriate response to the issues raised. Contrary to Chesterman, I would therefore argue that the attempt to exercise at least some fundamental sort of control over the collection of intelligence information should not be given up too easily. As a matter of fact, to cite just one national example, in 2010 the German Constitutional Court declared unconstitutional a law that obliged telecommunication companies to store all communications data, thus triggering a debate as to whether – and if so, under what circumstances – such a general storage should be permitted, and under which conditions state authorities may have access to, and make use of, the data thus collected. Also, different EU Member States have different opinions on this point. In sum, it appears that the key to the solution lies in a combination of *both* the control of *gathering and use* of intelligence information.

# Till Kreutzer, Das Modell des deutschen Urheberrechts und Regelungsalternativen. Konzeptionelle Überlegungen zu Werkbegriff, Zuordnung, Umfang und Dauer des Urheberrechts als Reaktion auf den urheberrechtlichen Funktionswandel

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- 1 I. *Till Kreutzer's* study on the existing German copyright system and its fundamental underpinnings, regulatory concepts and possible alternatives is a bold and far-reaching academic enterprise. Essentially, it summarizes and systematizes widespread concerns about the status of the existing copyright system in the academic scene and draws conclusions for a possible future alternative copyright system. This, according to *Kreutzer*, would have to take the changed factual environment of the copyright industries and the increasing importance of the users (also as authors, particularly in the context of user-generated content in the Internet) into due account.
- 2 To this end, *Kreutzer* first analyses the normative underpinnings of the existing system (also briefly comparing the fundamentals of the *droit d'auteur* systems to the different concept of Anglo-American copyright law). Second, he describes the recent development of copyright law with regard to the protection of new subject matter in the digital environment (such as computer programs and databases) as well as the factual expansion of copyright in the digital environment – namely due to the European rules on the relationship between exceptions to copyright and technical protection measures. Third, he draws conclusions from this with regard to the current status of the copyright system, concentrating on four so-called neuralgic zones: conditions of protection, the (initial) assignment of copyright, and the scope and term of copyright protection. On the basis of this analysis that highlights the shortcomings of the current system in dealing with the increasingly industrialised system of the “production” of more or less creative works and with the new (partly creative) forms of use in the Internet, he proposes his fundamental regulatory alternatives in the fourth part of his study.
- 3 Out of necessity, *Kreutzer* concentrates on copyright law, specifically on the neuralgic spots identified above, in order to focus his already very broad and voluminous study. Nonetheless, given the fact that he substantially proposes a future two-tier system of copyright law that combines author's protection for genuine personal intellectual creations with investment protection for works below this threshold, it might have been recommendable to throw a substantive side glance at German unfair competition law, where a doctrine of protection against unfair copying has been in place throughout the last century (and has been used effectively by the courts as

an investment protection tool). Recently, some authors have proposed that this doctrine be acknowledged and developed into a genuine and transparent tool for investment protection in unfair competition law. These proposals, which have sparked a vivid discussion among unfair competition lawyers, evidently relate to *Kreutzer's* proposals as they represent a fundamental alternative. Therefore, although it was hardly possible for *Kreutzer* to include even this discussion in his already outstandingly comprehensive study, the discussion certainly should be taken into account as a necessary background for discussing and evaluating his proposals.

- 4 **II.** As for the normative underpinnings of the *droit d'auteur* system, *Kreutzer* quite impressively and correctly points out the shortcomings of a deontological concept centred exclusively on the person of the individual author in the tradition of *John Locke's* property theory. (Indeed, *Locke* himself never wanted to apply his theory to immaterial property; moreover, his own property theory can be re-constructed today in an essentially utilitarian way; cf. *Leistner & Hansen*, GRUR 2008, 479, 480 et seq.) Instead, utilitarian approaches undoubtedly have to be taken into account. In the most recent literature, these utilitarian approaches no longer follow a "property logic" (trying to internalise all possible positive externalities of intellectual property), but instead emphasize the necessity of limitations to copyright law – safeguarding certain pockets for socially useful services and uses – and essentially reducing the scope of copyright law protection to what is *necessary* to prevent market failure with regard to the production of intellectual property. *Kreutzer* points out that such modern approaches, though they are discussed extensively in literature, are not yet essentially reflected in the existing German copyright law system with its author-centred approach. Furthermore, he analyses the constitutional law framework of German copyright law and comes to the conclusion that constitutional law sets only certain outer limits to a system of copyright law that is orientated more towards investment protection and characterized by a limitation of exclusive protection and an extension of mere liability rights. Indeed, though more recent decisions of the German Federal Constitutional Court suggest that it seems to be willing to take a more active role in copyright law matters, this analysis is certainly convincing.
- 5 Against this background, regarding the fundamental underpinnings of a future copyright system, *Kreutzer* pleads for an essentially dualistic system that combines strong personality protection for the authors of genuine personal, intellectual creations with a broad system of investment protection for works beyond this threshold. Indeed, the reviewer has already entered here in an indirect academic dialogue with *Kreutzer*. Concerning the diagnosed shortcomings of an exclusively authors-based ap-

proach, a slightly similar analysis can be found in *Leistner & Hansen* (GRUR 2008, 479; for comprehensive and further, partly different, consequences, cf. also *Hansen*, *Warum Urheberrecht?*, Nomos 2009). However, from this author's viewpoint, instead of re-introducing a dualistic concept to German copyright law, an integrative system *combining* individual rights-based and utilitarian fundamentals of copyright law in an integrative synthesis as the unitary objective of copyright law is the preferable way to adapt German copyright law to the changed digital environment and the accompanying policy discourse pleading for a more balanced copyright law system. Specifically, it is doubtful whether a system of investment protection that effectively unties a broad field of more practical, mundane and industrialised works (such as films and videogames) from the (arguably weaker but still existing) inner link with the personality of the authors and their right to self-determination can really provide for a regulatory development which safeguards the existence of a genuinely creative, multi-faceted cultural and academic development. This will be elaborated further when discussing some of *Kreutzer's* concrete conclusions and policy proposals.

- 6 **III.** In his study of the recent developments of "digital" copyright law, *Kreutzer's* analysis is remarkably clear-sighted and is shared in the meantime by an increasing number of authors in the German copyright community. The legislative development in the last twenty years represents a phase of legislative activity characterised by a series of more or less pointillist measures which, due to heavy lobbying and the lack of a new fundamental concept of copyright in the digital environment (which could have been used as a benchmark and warning post to prevent industry capture of legislation in parts of the field), have effectively and substantially expanded copyright law protection. *Kreutzer* emphasizes the inclusion of new protectable subject matter, such as computer programs and databases, into copyright law, as well as the area of exceptions to copyright and their relationship to the protection of technological protection measures. Indeed, the system has become unbalanced in this latter field particularly, primarily due to the fact that the Information Society Directive lets contractual agreements for online uses (accompanied by technological protection measures and their legal protection) prevail over the effective enforcement of the exceptions to copyright law. This unfortunate development, which potentially allows for a privatization of copyright (if the markets accept such solutions, which might well be doubted), goes far beyond what would have been necessary to implement the WIPO Internet Treaties, and it has been criticised in the meantime by an overwhelming majority of European copyright lawyers.
- 7 **IV.** What's really new and fundamental about *Kreutzer's* work is the attempt to genuinely propose

a fundamentally alternative copyright system that takes all these developments (which are extensively described in the study and could only be given cursory mention here) into account and to draw the necessary conclusions, including regulatory proposals for the neuralgic spots identified.

- 8 Essentially, *Kreutzer* proposes a two-tier copyright system. For genuine personal intellectual creations with a certain level of individuality, an author's protection with strong moral rights would remain applicable. For the majority of more commonplace works, traditional *droit d'auteur* copyright would be changed into an investment protection right with a rather low protection threshold and a correspondingly limited scope of protection, namely reducing the exclusive rights to mere liability rights (possibly administered by collecting societies) in many areas. Against this basic background, works would have to be systematized in different groups (allowing for a higher degree of differentiation, in particular with regard to what is an overlong protection term for certain categories of works). Such systematization, according to *Kreutzer*, could possibly follow a regulatory technique of an *a priori* catalogue for certain different categories of works; the *a priori* systematization of a given work in one of the categories could then be disproven by the right holder in court if the conditions for a "stronger" category were present in the case. As a matter of course, this concept is also slightly related to the idea of a copyright register where right holders would have to decide which category and which term of protection should be applicable to their works; however, the existing proposals in that direction are not extensively discussed or supported by *Kreutzer*.
- 9 The plea for more differentiation in copyright law is certainly justified. In particular, the term of protection is certainly too long with regard to many categories of works, namely (but not only) with regard to computer programs and other more "technical" works. *Kreutzer* convincingly refutes the possible counter-argument that the overlong term of protection is of no substantial harm anyway because most works lose their economic value long before the end of the protection term: First, the example of the problematic issue of orphan works (in particular in the framework of digitisation projects) clearly shows the potential problems of an overlong term of protection. Second, the very design of copyright undoubtedly structures the markets for the use of copyright-protected works; therefore, a longer term of protection might have a structuring influence for investment decisions (under conditions of uncertainty) in that area even if it is statistically of no substantial economical value.
- 10 As for the condition of protection, *Kreutzer* proposes a different wording which takes into account that the protection very often is no longer granted be-

cause of the individual character of the work and the resulting link of the work to the personality of its author; instead, protection is based on certain particular qualities of the work itself. Therefore, according to *Kreutzer*, the condition of protection should be an "own intellectual creation" instead of a "personal intellectual creation". Protection should be excluded if a certain "leeway for creativity" does not exist. Indeed, the European Court of Justice has already followed that terminology and harmonised the criterion of "own intellectual creation" as the European condition of protection in its *Infopaq* judgment (ECJ, Case C-5/08 *Infopaq International A/S v Danske Dagblades Forening* [2009] ECR I-6569; meanwhile followed by ECJ, Case C-393/09 *Bezpečnostní softwarová asociace – Svaz softwarové ochrany v Ministerstvo kultury*, Official Journal EU 2011, Nr C 63, 8). Although the criterion was deliberately only harmonised with regard to very specific categories of works in the Computer Program Directive, the Database Directive and in the Term Directive (with regard to photographs), the ECJ effectively horizontalised these pointillist regulatory approaches for all categories of works. In theory, this is an example to support *Kreutzer's* thesis that copyright law is in danger of being derogated because of the inclusion of more and more technical and organizational efforts into the protectable subject matter without differentiation between genuine individual creations and weaker investment protection. In practice, however, the new terminology should certainly allow the Member States to continue their more differentiated approaches with regard to the condition of protection in substance. This is because the ECJ has merely coined a new terminology for the condition of protection that should now be used cohesively throughout the Internal Market; however, Member State courts remain at liberty to specify that condition and to apply it to the facts of the cases before them. Thus, the "danger" that was seen in the *Infopaq* judgment is probably overrated.

- 11 As for the initial assignment of copyright, the consequences of *Kreutzer's* fundamental approach are clear: For activities that are characterized by an organisational or investment effort, the initial assignment of the right shall be with the investor/organizer. This would approximate European copyright law to the Anglo-American work-made-for-hire doctrine and would undoubtedly simplify matters for all kinds of producers, such as film and video game producers and aggregators of all kinds on the Internet. Actually, *Kreutzer* indeed tries to show in his study that the European system causes practical problems for the large producers in these fields. However, the consequence of initially assigning copyright to the investors for such categories of works seems problematic. First, solutions to the problem of the rights clearance already exist and can also be further developed in the future by way of more differentiated, area-specific provisions of copyright contract law



(which already exist in the area of film producers) as well as by making the system of contractual agreements more flexible with regard to moral rights (see Metzger, *Rechtsgeschäfte über das Droit moral im deutschen und französischen Urheberrecht*, C. H. Beck 2002, Oberfell, *Zeitschrift für Geistiges Eigentum/Intellectual Property Journal* 2/2011, 202). Second, one has to bear in mind that the design of copyright law undoubtedly has an impact on the situation of the individual authors (which are needed even with regard to films and video games and the like) and consequently on the *quality* and *diversity* of the works that are produced in a given system (cf. Benkler, 22 *Intern. Rev. L. & Econ.* 81 (2002); Leistner, *Zeitschrift für Geistiges Eigentum/Intellectual Property Journal* 4/2009, 403, 410). Taking this into account, the proposal to assign the rights for investment-orientated categories of works to the investors seems highly problematic (cf. similarly Dreier, *Computer und Recht* 2010, R031-R033). Indeed, first, if this would free investors from the need to acquire the necessary use rights from the individual authors, this would certainly have to be complemented by a corresponding system of obligatory copyright contract law, safeguarding the position of the individual authors contributing to such large collective works. However, such obligatory copyright contract law would then substantially reduce the advantage of having an easier rights clearance system. Moreover, it is far from clear whether such obligatory provisions in copyright contract law would indeed efficiently protect individual authors; the first experiences with the recently revised German copyright contract law have caused a certain scepticism in that regard. Second (and even more importantly), from this author's viewpoint it cannot be excluded that a streamlining of the rights clearance issue along the lines of *Kreutzer's* proposal would indeed lead to a substantially less diverse cultural sector characterised even more by large producers and mass productions. This is because the assignment of rights to the investor would mostly benefit the large producers and could possibly lead to intensified rent-seeking effects in the copyright industries. Against this background, the present German situation might be less "efficient"; however, these inefficiencies might have positive effects by contributing to cultural diversity through the consistent protection of the individual authors' self-determination.

- 12 To complete the overview of neuralgic spots, we can certainly agree with *Kreutzer's* proposals for a more transparent acknowledgement of the interests of the users and the general public instead of the present system where the exceptions to copyright do not grant genuine enforceable rights to the users. However, even within the present system, a certain more or less "cautious" development in that direction can already be noticed (see comprehensively Stieper, *Rechtfertigung, Rechtsnatur und Disponibilität der Schranken des Urheberrechts*, Mohr Siebeck

2009). It is doubtful whether it is really necessary to derogate wide areas of copyright law into an investment protection system in order to encourage these already existing approaches.

- 13 V. *Kreutzer* has presented a seminal academic study that does not stop at summarizing the widespread misgivings with the present copyright system, but instead goes on to attempt a fundamental proposal for a new, modern two-tier copyright system. This deserves the highest respect.
- 14 Many of his diagnoses – concerning *inter alia* the condition of protection (and the extension of protectable subject matter), the term of protection, the provisions on exceptions and their relationship to technical protection measures – are certainly correct. However, his proposed "remedies" can only partly be followed from this author's viewpoint. Undoubtedly, a more differentiated system is needed with regard to different categories of works. Certainly, such a system would have to substantially shorten the term of protection in some areas. Finally, the exceptions to protection should be made more flexible in order to cope with new digital uses on the Internet (cf. Leistner, *IIC* 2011, 417 et seq. with further references). However, *Kreutzer's* fundamental proposal – i.e. the derogation of wide parts of copyright law into an investment protection right characterised by a low protection threshold, the initial assignment of the right with the investor in many areas and an extended system of liability rules instead of exclusive rights – cannot be followed by this author (similarly Dietz, *Zeitschrift für Geistiges Eigentum/Intellectual Property Journal* 4/2010, 484). Indeed, here it seems that *Kreutzer* concludes his *normative* proposals from the aptly analysed *factual* situation. However, such a conclusion from the factual level to the normative level is by no means self-evident. Many factual developments, such as the increasing importance of large, industrial film and video game productions, the emergence of sometimes qualitatively doubtful user-generated content on the Internet and the like, have to be questioned with regard to their social usefulness, i.e. their contribution to a diverse cultural and academic landscape. Here, copyright law does not necessarily have to reflect and strengthen any of these new developments by making them easier. The example in point is the initial assignment of copyright. Here, *Kreutzer's* proposal would arguably weaken the position of individual authors and contribute to a decrease in cultural and academic diversity if it were not complemented by an obligatory copyright contract law (moreover, with regard to the latter, it must be doubted whether such a copyright contract law can really do the job). In a nutshell, the self-determination of the individual authors of such larger productions and works should not be qualified in order to make the production of such works more efficient; from this author's viewpoint, the existing protection of self-determination of individual

authors in the *droit d'auteur* system is the very guarantee for a vivid and diverse cultural and academic sector. Moreover, this is exactly the point where it would have been useful to think further about possible fundamental alternatives to such a concept. Instead of developing copyright into a genuine investment protection right, the existing possibilities in unfair competition law would certainly also have to be taken into account.

- 15 This difference between *Kreutzer* and this author shall by no means diminish the outstanding quality of *Kreutzer's* seminal study. Indeed, *Kreutzer's* study will have significant impact for a future copyright law in the digital environment. *Google's* Collaboratory think tank has already developed more specified scenarios and proposals for a future copyright law on the basis of *Kreutzer's* work (Annual report on 3rd initiative "Urheberrecht für die Informationsgesellschaft", <https://sites.google.com/site/colabdev3000/presse/downloads/IGCollaboratory-Abschlussbericht-Urheberrecht-fuer-die-Informationsgesellschaft.pdf>). This initiative should at least be considered by the German legislator in the framework of the "Third Basket" of German copyright law revision. Moreover, some of *Kreutzer's* clear-sighted visions have already become true, such as the European harmonisation of the terminology regarding the condition of protection or the remarkable pressure for new investment protection rights, namely for the benefit of newspaper publishers and the organizers of sports events. However, again, the fact that these developments exist and cannot be denied has to be distinguished from the question of whether they should be actively supported by the legislator.
- 16 Finally, of course, in the framework of this review it was a particularly intellectually challenging pleasure to discuss *Kreutzer's* own conclusions and policy proposals. However, *Kreutzer's* work is also a very valuable source of information for anyone who wants to be comprehensively informed about the neuralgic spots where present copyright law reaches its limits. On several occasions this author has used the study as a tool for first orientation on problematic issues in one of these fields. This was always a great pleasure as *Kreutzer* writes very clearly and has exploited a vast amount of literature. Therefore, the study will hopefully not only be considered by the German legislator but also referred to by many readers and academics.

# Docu- ments

# EU Commission: Comments on the “Opinion of European Academics on Anti-Counterfeiting Trade Agreement”

## Editors’ Note:

The “Opinion of European Academics on Anti-Counterfeiting Trade Agreement” (ACTA) of February 11, 2011, was published in 2 JIPITEC 65 (2011). Signed by more than 25 law professors and academics from across Europe who specialize in the field, this opinion addressed the following concern: Although it is uncontested that the infringement of intellectual property rights, especially in the Internet, prejudices the legitimate interests of right holders, it is still very controversial in Europe and abroad whether the enforcement standards of ACTA are balanced.

The European Commission, DG Trade, has now published a document with detailed comments on the Opinion. The comments, which are also available on the website of the European Commission [<http://trade.ec.europa.eu/doclib/html/147853.htm>], are republished here with the kind permission of the European Commission.

## Commission Services Working Paper

- 1 In January 2011, a number of academics issued an “Opinion of European Academics on Anti-Counterfeiting Trade Agreement” (“ACTA”), the “Opinion”.
  - 2 We recognise the expertise of those producing and putting their name to the Opinion, and welcome their engagement into a serious, text-based, legal analysis of ACTA. The authors recognise a number of essential features of ACTA. However, at the end of the Opinion, they invite the European institutions, in particular the European Parliament, and the national legislators and governments to withhold consent of ACTA, “...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”.
  - 3 After close examination of the Opinion, we believe that the opinion fails to demonstrate, in a convincing manner, that ACTA is not in line with the relevant Community *acquis* or that it raises legitimate concerns as regards certain fundamental rights.
  - 4 While the Opinion shows that the rules of ACTA are not entirely similar to the corresponding EU law, this does not imply that ACTA is incompatible with EU law.
  - 5 Many of the Opinion’s conclusions appear to be based on the fact that ACTA is written in more general terms than EU legislation, or that the exceptions, procedural guarantees and safeguards in ACTA are less precise, and less specific than those of the relevant EU legislation.
  - 6 However, it is understandable that an international agreement negotiated by parties with different legal traditions will be drafted in more general terms than is the case for EU legislation. Nevertheless, ACTA does, in fact, contain the necessary safeguards to allow its Parties, including the EU, to strike an appropriate balance between all the rights and interests involved. Obviously, not all ACTA parties share exactly the same view on how to put this balance into practice, which is why, rather than setting out every detail, ACTA provides the Parties with the necessary flexibility to establish a balance which takes account of their economic, political and social objectives, as well as their legal traditions.
  - 7 As a result, ACTA is fully compatible with the relevant EU law, even if it is not drafted in exactly the same terms, contains exceptions that are more precise and more specific than ACTA and strikes a more refined balance than the one within ACTA. This means that, when ACTA is adopted by the EU, the relevant EU *acquis* will not have to be modified, and can not be challenged by other parties for failing to meet the standards ACTA sets.
  - 8 Below, you will find out a more detailed analysis illustrating these points.
  - 9 It is for these reasons that the Commission has stated on a number of occasions that ACTA is indeed fully in line with the relevant EU *acquis*. It will neither require changes to that *acquis*, nor lead to different interpretations or implementation of existing EU legislation.
  - 10 Finally, as indicated in the analysis that follows, the assessment made by in Opinion sometimes goes beyond the legal questions of the compatibility of ACTA with EU law to touch on legitimate political questions. These do not, of course, reflect concrete facts nor draw on the legal provisions of the text itself and should be viewed in that light.
- \* \* \*

Opinion Of European Academics On Anti-Counterfeiting Trade Agreement	Commission Services' Comments
<i>[I. "Preamble"]</i>	
<p>The Signatories of the Opinion following the adoption of the Anti-Counterfeiting Trade Agreement (ACTA) on 3<sup>rd</sup> December 2010</p> <p>recognizing that</p> <p>(a) <i>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;</i></p> <p>(b) <i>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;</i></p> <p>(c) <i>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;</i></p> <p>(d) <i>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;</i></p> <p>(e) <i>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;</i></p> <p>(f) <i>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;</i></p>	<p>Reference is made to the statements made by the Commission in replies to written questions from MEPs, and by Trade Commissioner De Gucht in oral statements at the plenary meetings of 9 March 2010, 8 September 2010 and 20 October 2010.</p> <p>Detailed answers are provided in this document, set out in table format for ease of reading.</p> <p>The full text of Commissioner De Gucht's statements in plenary can be found on :</p> <p>9 March 2010:  <a href="http://www.europarl.europa.eu/sides/getDoc.do?type=PV&amp;reference=20100309&amp;secondRef=ITEM-015&amp;language=EN&amp;ring=P7-RC-2010-0154">http://www.europarl.europa.eu/sides/getDoc.do?type=PV&amp;reference=20100309&amp;secondRef=ITEM-015&amp;language=EN&amp;ring=P7-RC-2010-0154</a></p> <p>September 2010:  <a href="http://trade.ec.europa.eu/doclib/docs/2010/september/tradoc_146465.pdf">http://trade.ec.europa.eu/doclib/docs/2010/september/tradoc_146465.pdf</a></p> <p>20 October 2010:  <a href="http://trade.ec.europa.eu/doclib/docs/2010/october/tradoc_146791.pdf">http://trade.ec.europa.eu/doclib/docs/2010/october/tradoc_146791.pdf</a></p> <p>The full set of written parliamentary questions and Commission's replies on ACTA since 2010 can be found on: <a href="http://trade.ec.europa.eu/doclib/html/147852.htm">http://trade.ec.europa.eu/doclib/html/147852.htm</a></p>

Opinion Of European Academics On Anti-Counterfeiting Trade Agreement	Commission Services' Comments
<p>(g) <i>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;</i></p>	<p>It is a common practice in international negotiations to have recourse to provisions that are merely voluntary or optional (“parties may”), and not mandatory (“parties shall”). Parties are not obliged to implement such provisions in their domestic law.</p> <p>We would observe that the comment regarding “an international political incitement to implement such clauses” is not a legal comment.</p> <p>ACTA is a catalogue of best practices, which means that these provisions may be considered effective and justified by some parties but will not be applicable in other legal frameworks. This flexibility allows, <i>inter alia</i> to take into account different legal traditions, or even different levels of development of the Parties.</p>
<p>(h) <i>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;</i></p>	<p>ACTA is an international agreement that is binding only on its Parties. It will be open to accession by other countries sharing the same concerns about the enforcement of intellectual property, who may wish to join it in future.</p> <p>We would observe that the comment regarding “pressure” that would be exerted on other States to adopt negotiated standards is not a legal comment. This being said, the Commission has no intention to impose ACTA on third parties who would not wish to join it. In this respect, we refer to the Commission’s reply to EP question E-1654/2011 of March/April 2011.</p>
<p>draw the attention to the following points:</p> <p><b>I. EU LAW</b></p> <p><b>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.</b></p>	<p>We reiterate the Commission’s statements that ACTA provisions are compatible with existing EU law. ACTA will not require any revision or adaptation of EU law and will not require any Members States to review the measures or instruments by which they implement relevant EU law. The points raised in the Opinion will be addressed one-by-one below.</p>

Opinion Of European Academics On Anti-Counterfeiting Trade Agreement	Commission Services' Comments
<p>The following is a non-exhaustive list of illustrations that indicate the general tendency of ACTA:</p> <p>Civil enforcement</p> <p>1. Injunctions: art.8.1 ACTA requires Contracting Parties to grant an order against a party to desist from an infringement, and <i>inter alia</i>, 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 <i>instead</i> 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 relief<sup>1</sup>.</p>	<p>Article 8.1. of ACTA requires Parties to provide their judicial authorities with the possibility to issue injunctions so as to prevent infringing goods from entering the channels of commerce. Article 12 of Directive 2004/48/EC actually foresees the option of paying pecuniary compensation to the injured party <i>instead</i> of applying the measures provided for in art.11 Directive 2004/48/EC). The possibility to use this “pecuniary compensation” option <u>will</u> remain and will be fully compatible with ACTA (be it with its article 8.1 or with any other provision of ACTA).</p> <p>Article 12 of Directive 2004/48/EC gives the possibility to Member States to give their courts, under narrowly defined conditions, the authority to order alternative measures to the injunctions provided for by article 11 of the Directive. If Member States avail themselves of that option, such alternative measures must, however, be an additional option for national courts and may not replace the power to grant the injunctions provided for by article 11 of the Directive.</p>
<p>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.</p>	<p>There is no conflict between article 9 of ACTA and article 13 of Directive 2004/48/EC. Both provisions refer to ways in which courts can come to the determination of fair damages for the injured party.</p> <p>Article 9 of ACTA provides a detailed list of options for the judicial authorities to establish the damages. During the negotiations of ACTA, the Commission services made sure that article 9 ACTA does not impose on the EU any methods not foreseen in article 13 of Directive 2004/48/EC. Article 9.1 of ACTA requires Parties to give their judicial authorities the power to consider “<i>inter alia, any legitimate measure of value the right holder submits</i>”. This is not in conflict with the approach adopted in article 13 of the Directive (which instructs judicial authorities to take into account all appropriate aspects to set the damages) and does not exclude any of the options available under that article. The examples given in article 9.1 of ACTA and highlighted by the authors of the Opinion are not mandatory for the ACTA Parties (cf. the provision says “<i>may include</i>”).</p> <p>Articles 9.1 and 9.2 of ACTA, indeed enumerate an extensive list of different methods to establish the damages. However, this does not mean that the amounts stipulated in each of these provisions are cumulative and would thus raise the level of applicable damages. This is confirmed by the reference at the end of article 9.2 to the principle that the infringers’ profits may be presumed to be the amount of damages referred to in 9.1.</p> <p>Therefore, no provision in article 9 of ACTA will require the amendment of existing EU legislation or the introduction of new rules or practices.</p>

Opinion Of European Academics On Anti-Counterfeiting Trade Agreement	Commission Services' Comments
<p>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.</p>	<p>The emphasis on the destruction of the pirated and counterfeit materials reflects the consensus among ACTA Parties that it is the most effective solution to deal with this type of illegal products. However, Article 10 of ACTA contains sufficient flexibility to ensure that article 10 of Directive 2004/48/EC is compatible with it.</p> <p>As acknowledged in the Opinion, ACTA contains a “general requirement of proportionality” (Art. 6.3). Proportionality has to be found between the seriousness of the infringements, the interest of third parties and the applicable measures, remedies and penalties. This requirement gives the Parties the necessary flexibility to set an appropriate balance between all interests involved and to calibrate remedies in a proportionate way. This <u>general requirement</u> applies to all parts of ACTA, a fortiori to all sections under Chapter II of ACTA on the “legal framework for enforcement of IPRs”. During the negotiations, it was agreed among the Parties that making additional references to the proportionality principle in other provisions of ACTA was not only unnecessary but could also raise questions as to the applicability of the general requirement whenever a specific reference was lacking.</p> <p>Therefore, no provision in Article 10 of ACTA contradicts or modifies the rules set in Article 10 of Directive 2004/48/EC, which will remain fully applicable in the EU and is compatible with ACTA.</p>
<p>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”<sup>72</sup>. Both the Luxembourg and the Strasbourg<sup>3</sup> 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 <i>inaudita altera parte</i> 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”<sup>74</sup>. It is not easy to understand why ACTA provides for provisional measures <i>inaudita altera parte</i>, 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.</p>	<p>For the sake of clarity: “<i>Inaudita altera parte</i> provisional measures” means provisional measures decided by a Judge in the absence of the defending party. Such measures may, in particular, be warranted in case of urgency in order to prevent irreparable harm created by damaging or illegal activities and to secure evidence from being destroyed.</p> <p>These specific <i>inaudita altera parte</i> provisional measures foreseen in Article 12 of ACTA are in line with the corresponding article 9.4 of Directive 2004/48/EC, for the following reasons:</p> <ul style="list-style-type: none"> <li>▶ Article 6.2 of ACTA foresees general procedural guarantees which apply to the entire Chapter II, including Article 12, and which reads: <p style="margin-left: 20px;"><i>“Procedures adopted, maintained, or applied to implement the provisions of this Chapter shall be fair and equitable, and shall provide for the rights of all participants subject to such procedures to be appropriately protected”</i>. [Article 6.2]</p> </li> <li>▶ Nothing in ACTA calls into question the specific safeguards foreseen by EU legislation, <i>inter alia</i> in article 9.4 and 9.5 of Directive 2004/48/EC. These safeguards, or procedural guarantees, therefore remain applicable in the EU.</li> <li>▶ Finally, Article 1 of ACTA states that nothing in ACTA shall derogate from any obligation of a Party with respect to any other Party under existing agreements, including the TRIPS Agreement. As the guarantees contained in the TRIPS Agreement, namely article 50.4 and 50.6, are echoed, almost verbatim, in articles 9.4 and 9.5 of Directive 2004/48/EC, this is another confirmation that these guarantees remain applicable.</li> </ul> <p>Therefore, key safeguards such as the right to be heard and the right to appeal set out in Articles 9.4 and 9.4 of Directive 2004/48/EC will remain applicable in the EU.</p>



Opinion Of European Academics On Anti-Counterfeiting Trade Agreement	Commission Services' Comments
<p>Border measures</p> <p>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 <i>acquis</i>, 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 rewording 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.</p>	<p>During the ACTA negotiations, the Commission services insisted on a broad definition of trademark infringements in Section 3 on Border Measures, in order to keep the necessary flexibility in view of the ongoing review of the applicable EU legislation* (Regulation 1383/2003).</p> <p>However, as correctly pointed out in the Opinion, article 13 ACTA was drafted in a way that allows the Parties to exclude certain forms of IP infringements from border measures. In the EU, this is the case for forms of trademark infringements other than counterfeiting (as well as for topographies of semiconductor products, utility models or products containing or manufactured using a third parties' undisclosed information, without consent). There is, <u>therefore</u>, no extension of the EU <i>acquis</i> and ACTA does not trigger any obligation to modify Regulation 1383/2003.</p> <p>During the negotiations, the Commission services were particularly cautious to ensure that neither the border enforcement provisions nor any other ACTA provision will target legitimate trade in medicines either directly or indirectly. In particular, as stated in the Commission's written answers to EP Written Declaration 12/2010, to EP Resolution of 10/03/2010, to questions by Members of the European Parliament (<i>inter alia</i> P-9346/2010, P-9026/10EN, P-5214/10EN, P-0683/10EN and E- 4292/10EN) and in Commissioner De Gucht's presentations to the European Parliament plenary of 9 March, of 8 September 2010 and of 20 October 2010, it is not the Commission's intention to use enforcement measures (be it at the border or in civil or penal litigation) to hinder the legitimate trade in generic medicines.</p> <p>The Opinion authors consider that, in one particular instance, ACTA could represent a danger for the international trade of generics, (i.e. the risk that generic medicines could be seized based on allegations of 'ordinary' trademark infringements).</p> <p>We consider that there is no such risk for the following reasons:</p> <ul style="list-style-type: none"> <li>▶ as pointed out in the Opinion, article 13 ACTA contains a level of flexibility that allows the parties to exclude certain forms of IP infringements, namely on the basis of public health grounds;</li> <li>▶ ACTA contains specific safeguards to ensure that its implementation would not hinder access to medicines (see next paragraph);</li> <li>▶ the example mentioned in the Opinion appears to imply that the practice of using infringing trademarks (with mere "ordinary" infringements) is generalised among the industries producing generics. As far as we are aware, this is not the case: legitimate generic producers use their own trademarks, and have no reason or interest whatsoever to engage in trademark infringement.</li> <li>▶ In any event, defining and determining whether a trademark infringement exists on the basis of similarity to protected trademarks or other reasons, is a matter of the substantive protection of a trademark in each ACTA party and of assessing this in accordance with the respective legal orders of the Parties. These matters are neither addressed nor modified by ACTA.</li> </ul> <p>In this respect, we recall that the Commission has carefully considered and addressed, in the context of ACTA, concerns regarding access to medicines in developing countries in the following manner:</p>

Opinion Of European Academics On Anti-Counterfeiting Trade Agreement	Commission Services' Comments
	<ul style="list-style-type: none"> <li>▶ ACTA contains an express reference to Doha Declaration on TRIPS and Public Health and incorporates the objectives and principles of articles 7 and 8 TRIPS, which refer, <i>inter alia</i>, to the safeguard of public health;</li> <li>▶ Patent infringements are expressly <u>not</u> covered by <u>penal</u> enforcement provisions in ACTA, nor by <u>border</u> measures in ACTA;</li> <li>▶ ACTA leaves it <u>optional</u> for signatories to apply the <u>civil</u> remedies section to patents (« ... may ... »).</li> </ul> <p>Therefore, these measures, which include several layers of safeguards, should allay the concerns of those who fear that ACTA could adversely affect access to medicines in developing countries.</p>
<p>Criminal enforcement</p> <p>6. No EU <i>acquis</i> 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.</p>	<p>There is indeed no EU <i>acquis</i> on criminal measures.</p> <p>However, the Criminal Enforcement provisions of ACTA do not require additional legislation at EU level. A similar situation arises from the TRIPS Agreement, which has been in force since <u>1996</u>. The TRIPS Agreement also contains criminal enforcement provisions that bind EU Member States which had to comply, in their national laws, with TRIPS. In that case, no EU legislation was necessary to implement these aspects of the TRIPS Agreement concerning criminal sanctions.</p> <p>ACTA therefore does not require additional EU legislation.</p>
<p>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”.</p> <p>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.</p>	<p>We observe that the positions taken by the European Parliament in the context framework of discussions on a proposal for a Directive which was <u>not</u> adopted does <u>not</u> belong to the EU <i>acquis</i>. The comment set out in this regard in the Opinion seems therefore more of political nature than of a legal nature.</p> <p>Furthermore, Directive 2004/48/EC stipulates in its recital (14) that “Acts carried out on a commercial scale are those carried out for direct or indirect economic or commercial advantage...”. This definition is rather close to the definition used in ACTA, which focuses on commercial activities for an economic or commercial advantage, which is the opposite of a personal activity by a private user without profit motivations. Indeed, said recital also clarifies that “...this would normally exclude acts carried out by end-consumers acting in good faith.”</p> <p>Regarding the point made on fair use, the Commission fully agrees on the need to guarantee fair use of a protected work as declared by the EP. However, the Commission points out that the activities mentioned in the EP position are considered in the EU as <u>legitimate “exceptions”</u> and therefore do not fall under the scope of the criminal enforcement provisions of ACTA, since this applies only to certain <u>illegal activities</u> (piracy and counterfeiting), practiced wilfully and on a commercial scale. In fact, these exceptions are totally outside the scope of ACTA, which, as an enforcement agreement, only applies to infringing activities, not to legal ones.</p>

Opinion Of European Academics On Anti-Counterfeiting Trade Agreement	Commission Services' Comments
<p>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.</p>	<p>The criminal enforcement provisions of ACTA only apply to <u>counterfeiting</u> and <u>piracy</u> activities (the so-called “fake” goods, as opposed to goods lawfully marketed in the exporting country). Illegal parallel trade consists of the <i>unauthorised</i> import of <u>legitimate</u> goods, not of counterfeit or pirated ones. An express exclusion was therefore redundant.</p> <p>Therefore, parallel imports will not be hindered by ACTA.</p>
<p>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.</p>	<p>The so-called “camcording” criminal provisions are not to be found in many EU Member States’ legislations. Therefore, EU negotiators ensured that they are merely optional, as correctly pointed out in the Opinion, in order to reflect and respect the EU diversity.</p> <p>Regarding the second part of the statement, as already noted above, legally protected exceptions are not covered by the scope of ACTA (which only applies to certain illegal activities, which is not the case for legitimate exceptions). Consequently, fair use and private copy exceptions will not be affected by ACTA’s “camcording” provisions.</p>
<p>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.</p>	<p>As mentioned above, the ACTA Parties opted for a general provision on safeguards and procedural guarantees in Article 6.2, which is applicable to the entire Chapter II on criminal enforcement.</p> <p>This being said, nothing in ACTA repeals, reduces or otherwise modifies the specific safeguards foreseen in the legislations of the Parties. In the case of criminal enforcement, in the absence of existing EU legislation on the matter, this applies to all the safeguards foreseen in the laws of the EU Member States.</p> <p>Therefore, these safeguards (including the right to be heard) will remain fully applicable in the EU.</p>

Opinion Of European Academics On Anti-Counterfeiting Trade Agreement	Commission Services' Comments
<b>II. INTERNATIONAL LAW</b>	
<p><b>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.</b></p> <p>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:</p>	<p>We share the statement that ACTA introduces enforcement standards higher than those existing under current international law. This is precisely the purpose of ACTA: increasing the quality of enforcement.</p> <p>The statement concerning the lack of balance is, however, incorrect. ACTA contains the necessary safeguards to allow its Parties to strike an appropriate balance between all rights and interests involved. Obviously, not all ACTA parties share exactly the same view on how to set this balance in practice, which is why, rather than prescribing in detail how to set the balance, ACTA provides the Parties with the necessary flexibility to establish this balance, in line with their economic, political and social objectives, as well as with their legal traditions. That will mean improved international standards of Intellectual Property Rights enforcement, while fully respecting the rights of citizens and the concerns of important stakeholders such as consumers or internet providers.</p> <p>Some examples of ACTA provisions ensuring this balance are:</p> <ul style="list-style-type: none"> <li>▶ the reference in the Preamble and in article 13 to the need to avoid creating barriers to legitimate trade;</li> <li>▶ the reference in the Preamble to the need to balance the rights and interests of the relevant right holders, service providers, and users;</li> <li>▶ the reference in the Preamble to the principles set forth in the Doha Declaration on the TRIPS Agreement and Public Health;</li> <li>▶ Article 1 which ensures the full compliance with the TRIPS Agreement, including the TRIPS system of safeguards and guarantees which remains fully binding to all the ACTA Parties and, obviously, to any third countries members of the WTO;</li> <li>▶ Article 2.3 integrating the objectives and principles of articles 7 and 8 TRIPS (promotion of technical innovation and transfer of technology in a manner conducive to social and economic welfare, the protection of health and nutrition, the promotion of public interest in key sectors, etc.);</li> <li>▶ article 4, ensuring the respect for privacy and confidential information;</li> <li>▶ article 6.2 and 6.3 ensuring the necessary procedural safeguards and the principle of proportionality;</li> <li>▶ article 27.2 to 27.4, specifically ensuring the preservation of fundamental principles such as freedom of expression, fair process and privacy on matters relating to the internet.</li> </ul> <p>Therefore, safeguards existing under international law are not eliminated, but rather preserved.</p>

Opinion Of European Academics On Anti-Counterfeiting Trade Agreement	Commission Services' Comments
<p>Civil enforcement</p> <p>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).</p>	<p>All ACTA parties agreed on the importance of providing a right of information to its right-holders regarding the infringement of their rights. However, as explained above, ACTA does not eliminate any guarantees or safeguards provided under the national laws of its signatories, including the requirement of proportionality or measures against the misuse of acquired information.</p> <p>The general requirement of proportionality of article 6.2 ACTA applies also to the provisions of article 11 of ACTA concerning the right of information. Furthermore, the Opinion omits the very detailed and wide ranging provisions on privacy and disclosure of information stipulated in article 4 ACTA (which are expressly referred to in article 11), several of which are equivalent to those contained in article 8.3 of Directive 2004/48/EC.</p> <p>The reference to “alleged infringers” in article 11 ACTA is destined to foresee the frequent situations where such information regarding persons involved in the infringements, the means of production or channels of distribution, is sought by Courts in the context of an on-going procedure, at a stage where the infringer has not yet been condemned.</p> <p>In this particular case, the Opinion does not make reference to article 8.1 of Directive 2004/48/EC, which extends the right of information to a considerably broader level than ACTA, since it applies not only to infringers but also to <u>any other person</u> who was found in possession or using the infringing goods, providing services used in infringing activities or was indicated as being involved in the production, manufacture or distribution of the goods or the provision of the services. This is one example where the EU <i>acquis</i> is considerably more demanding than ACTA.</p>
<p>Border Measures</p> <p>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.</p>	<p>Please see comments on paragraph 5. above.</p>

Opinion Of European Academics On Anti-Counterfeiting Trade Agreement	Commission Services' Comments
<p>13. Safeguards: ACTA eliminates the following safeguards available under TRIPS. First, art.56 TRIPS contains a mandatory requirement that customs must have “<i>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</i>”. ACTA, however, has no directly equivalent provision for compensation in cases of wrongful detentions.</p> <p>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 “<i>in exceptional circumstances</i>” (art. 18, 4th sentence ACTA).</p> <p>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 “<i>within a reasonable period</i>”.</p>	<p>ACTA does not eliminate any safeguards available under TRIPS (cfr. article 1 ACTA). Therefore, the TRIPS safeguards (articles 55 and 56) will remain binding and applicable to all ACTA Parties.</p> <p>Furthermore, the general provision concerning the principles of fairness, equity and proportionality of article 6 ACTA equally implies basic safeguards such as compensation for undue injury.</p> <p>Regarding article 18 ACTA, it is fully in line with article 53.2 TRIPS, which foresees very detailed and narrowly defined circumstances for the possibility of the owner of the goods to provide securities to obtain possession of the goods. Note that the option mentioned in the Opinion for the goods owner/importer to provide a security under art. Article 53.2 (which remains fully applicable) applies <u>only</u> to patents, undisclosed information, designs and layout-designs and that the first two are <u>excluded</u> from the scope of application of ACTA’s customs enforcement section.</p> <p>As regards the comment on Article 55 TRIPS, this provision sets the mandatory limits to the duration of the <u>initial detention</u> of goods suspected of infringement (i.e. the time between the suspension of the goods and the initiation of the proceeding leading to a decision on the merits of the case. As mentioned in the first paragraph, this provision will remain applicable. We wish to note that the Opinion refers to Article 19 ACTA, but that this Article 19 concerns a very different time period: the time for a [judicial] authority <u>to take a decision on the merits of a case</u>, which must take place “<i>within a reasonable period</i>”.</p>
<p>Criminal enforcement</p> <p>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 and/or jurisprudence of the Parties. commercial scale adopted by the WTO Panel,</p> <p>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”<sup>5</sup>.</p>	<p>All 37 members of the WTO, which negotiated ACTA are confident that the definition of “commercial scale” as well as the remainder of the agreement are fully in line with their WTO rights and obligations, including with any applicable jurisprudence.</p> <p>We are not in a position to provide any substantial comment on the doubts mentioned in the Opinion as these are not spelled out. One can only note that both definitions are based on the concept of “commercial activity”, which can be subsequently further interpreted by the domestic legislation and/or jurisprudence of the Parties.</p>

Opinion Of European Academics On Anti-Counterfeiting Trade Agreement	Commission Services' Comments
<p>Digital chapter</p> <p>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.</p>	<p>The provisions on technological measures of ACTA reflect the EU <i>acquis</i> in this area, in particular Directive 2001/29. That Directive implements the obligations in Article 11 of the WIPO Copyright Treaty and Article 18 of the WIPO Performances and Phonograms Treaty, but also goes beyond both Treaties. This is another example where the <i>acquis</i> goes beyond existing international treaties.</p> <p>The chapter on <b>digital environment</b> is one of the most important contributions of ACTA. The common ground found between ACTA Parties on definitions of key concepts such as technical measures is a major element of this positive contribution.</p> <p>The Opinion reflects concerns on the lack of a mechanism to ensure the exercise and enforcement of exceptions and limitations. These are not justified for the following reasons:</p> <p>In its digital chapter ACTA defines key orientations and principles, in an area where the Parties have different national legislations with no common basis. This is in contrast with the other chapters of ACTA, where the domestic laws of all the Parties had as a common denominator the minimum standards of TRIPS (not all the ACTA Parties have ratified the WIPO internet treaties and they have widely different systems of exceptions and limitations). This is why ACTA opted for making a very precise reference to the compliance between the rules set in article 27.5 to 7 ACTA and “... <i>the rights, limitations, exceptions, or defences to copyright or related rights infringement under a Party’s law.</i>”.</p>
<p>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.</p> <p>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).</p>	<p>We wish to note that:</p> <ul style="list-style-type: none"> <li>▶ the ACTA provision on the disclosure of subscribers’ data (art.27.4 ACTA) is optional, like Art.47 TRIPS;</li> <li>▶ these two provisions deal with quite different matters: article 27.4 ACTA addresses the question of the role of internet service providers, a concept that is absent from TRIPS. Indeed, TRIPS was negotiated in the early 1990s, well before the expansion of internet and the introduction of concepts such as that of intermediary service providers.</li> <li>▶ provisions equivalent to article 27.4 ACTA, allowing for such intermediary service providers to be requested to provide information exist in the EU<sup>9</sup> (and the US, Japan and many ACTA Parties) for more than 10 years and have been transposed, and applied in EU Member States.</li> </ul> <p>It is not correct to state that ACTA lacks specific provisions about the preservation of fundamental principles “<i>such as freedom of expression, fair process, and privacy</i>”. As an international agreement, ACTA does define the key orientations and principles, in particular in an area where the Parties have different national legislations lacking a common basis, contrary to the other chapters of ACTA where the domestic laws of all the Parties had as a common denominator the minimum standards of TRIPS. However, ACTA opted to leave it to the domestic laws of each Party, to ensure how these key principles would be implemented, instead of trying to harmonise detailed implementing rules that expand well beyond the scope of IPR enforcement. As the Opinion points out, in the EU alone, these fundamental principles are ensured by several Directives, but also by different Constitutional provisions, which were not realistically possible to transpose into ACTA.</p>

Opinion Of European Academics On Anti-Counterfeiting Trade Agreement	Commission Services' Comments
<p>Taking above into account,</p> <p><b>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 <i>acquis</i> or serious concerns on fundamental rights, data protection, and a fair balance of interests are not properly addressed, to withhold consent.</b></p>	<p>As demonstrated above, ACTA does not introduce any deviations, significant or not, from the EU <i>Acquis</i>.</p> <p>ACTA also fully respects fundamental rights and data protection, as explained in detail above.</p> <p>Finally, we wish to refer to the positions adopted by the European Commission in its written answers to questions by Members of the European Parliament (<i>inter alia</i> P-9346/2010, P- 9026/10EN, P-5214/10EN, P-0683/10EN and E-4292/10EN) and in Commissioner De Gucht's presentations to the European Parliament plenary of 8 September 2010 and 20 October 2010 confirming that ACTA ensures a fair balance of interests between right-holders and other parties concerned by the enforcement of intellectual property rights.</p> <p>ACTA has been negotiated in full coordination with and – as regards the criminal chapter – with the participation of the competent authorities of all Member States.</p> <p>The Commission has also kept the European Parliament fully informed at all stages of the evolution of those negotiations. In addition to providing the negotiating documents, Commissioner De Gucht has participated in three plenary debates. The Commission has formally replied to several dozens of written and oral questions, to two Recommendations and one Declaration of the European Parliament. Commission services have provided several dedicated briefings to interested Members of the European Parliament on all aspects of the negotiations after the various negotiating rounds.</p> <p>One can therefore conclude that ACTA has been extensively debated, in a manner that should enable competent institutions to provide their informed consent to ACTA.</p> <p>The Commission services remain fully available to provide any additional clarification.</p>

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 China – Measures Affecting the Protection and Enforcement of Intellectual Property Rights (China – IPRs).

\* In September 2008 the Council, responding to a Commission Communication concerning a strategy for Industrial Property Rights, invited the Commission and the Member States to review Council Regulation (EC) 1383/2003 of 22 July 2003. One of the key areas of this review has to do with IPR infringements not covered by the current legislation, *inter alia*, trademark infringements other than counterfeit products. Public consultation available at: [http://ec.europa.eu/taxation\\_customs/common/consultations/customs/ipr\\_2010\\_03\\_en.htm](http://ec.europa.eu/taxation_customs/common/consultations/customs/ipr_2010_03_en.htm)

◇ Article 15.2 of Directive 2000/31 or article 8 of Directive 2004/48



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