



inDICES

# Measuring the Impact of Digital Culture

## Deliverable 2.1

# Mapping of the relevant European IP legal framework

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## D2.1 – Mapping of the relevant European IP legal framework

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# 1 Executive Summary

This deliverable describes the activities carried out during the first six months of the inDICEs project within Work Package 2 (WP2) by the different partners and summarizes the results achieved by this work package.

The goal of the inDICEs project is to empower policy-makers and decision-makers in the Cultural and Creative Industries (CCIs) to fully understand the social and economic impact of digitization in their sectors. Cultural heritage institutions (hereinafter 'CHIs') will be provided with a specific self-assessment tool to be able to make strategic decisions that will allow them to advance in the Digital Single Market.

To be able to make these strategic decisions, CHIs need to be fully aware of the impact of intellectual property (IP) rules, and in particular of copyright legislation on their activities of (promoting of) access, use and re-use of cultural content.

This deliverable will provide a detailed overview of the current and upcoming IP legal framework affecting the activities of the CHIs. It will raise awareness of the legal constraints and opportunities that result from the IP framework applicable at the EU level. Increasing their knowledge of IP laws will help CHIs to develop innovative business models and to overcome bottlenecks in the use and re-use of creative content under their collections.

In addition, this study will also describe other non-IP related rules that may have an impact on digitization and use and re-use of cultural content under the collections of CHIs and on access and promotion of culture and knowledge.

## 2 Introduction and Objectives

The protection of intellectual property rights (hereinafter 'IPRs') is explicitly included in the Universal Declaration of Human Rights under Article 27<sup>1</sup>:

1. Everyone has the right to freely participate in the cultural life of the community, to enjoy the arts and to share in scientific advancement and its benefits.
2. Everyone has the right to the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author.

This goal was reconfirmed in Article 15 of the International Covenant on Economic, Social and Cultural Rights, adopted in 1966 and in force since 1976<sup>2</sup>. The recognition of these rights is also established at the EU level<sup>3</sup> both in the Treaty of Functioning of the EU (TFEU) and at the EU Charter of fundamental rights under Article 17(2) Dissemination of culture and cultural heritage is also included under Article 167 TFEU.

The above-mentioned articles reveal the conflicting interests between, on the one hand, the protection of IPRs and the need of protecting the moral and economic interest of a creation and its author, which restricts distribution of the work, and, on the other hand, the public interest of sharing and getting access to culture or scientific inventions. This goal of promoting access to culture and cultural heritage for society is at the core of the mandate given to public CHIs in national legislations.

For digital cultural heritage, the same principles apply as is reflected in the UNESCO Charter on the Preservation of Digital Heritage<sup>4</sup> which explicitly refers to 'digital born' works and digitized works. In addition, this Charter 'seeks for a balance between the public interest to access to culture and the protection of creators and their rights'<sup>5</sup>.

### Relevance of IPR for CHIs

When one looks at the content of the collections of CHIs it immediately becomes clear that they cannot possibly ignore the rules on IPRs and in particular rules relating to use, access and management. With the development of new technologies, the importance of IPRs for the CHIs' activities has considerably increased as IP in the cultural institutions is considered a key factor in sharing knowledge, in the promotion of access to culture, in the preservation of their collections<sup>6</sup> and in the revenue-generating models for these institutions. In particular, digitization of cultural content has not only become a 'societal phenomenon'<sup>7</sup> but also raises new challenges in terms of IP.

Works that are kept in the collections of CHIs are extremely diverse in their type and/or form ranging from works of visual arts, audiovisual productions, sound recordings, documents or maps to scientific

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<sup>1</sup> UN General Assembly, Universal Declaration of Human Rights 1948.

<sup>2</sup> UN General Assembly, International Covenant on Economic, Social and Cultural Rights 1966.

<sup>3</sup> European Union, Consolidated version of the Treaty on the Functioning of the European Union, 13 December 2007, 2008/C 115/01 2007 art 118.

<sup>4</sup> UNESCO Charter on the Preservation of the Digital Heritage 2003.

<sup>5</sup> Rolf H Weber and Lennart Chrobak, 'Legal Implications of Digital Heritagization' [2016] RESET. Recherches en sciences sociales sur Internet 1 <<http://journals.openedition.org/reset/826>>.

<sup>6</sup> Rina Elster Pantalony, *Managing Intellectual Property for Museums: Guide* (2013 ed, WIPO 2013).

<sup>7</sup> Weber and Chrobak (n 5) 2.

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works, among others<sup>8</sup>. Due to their nature, most of these works are or have been protected by copyright law. Access to culture by the general public will almost always involve acts of reproduction and public communication of (copies of) the works that are contained in the collections of CHIs, which makes the study of copyright law of particular interest for the sector, as well as for the inDICEs project. In the past, many studies and research projects have been carried out in this field<sup>9</sup>. They will form the building blocks of the analysis conducted in the present deliverable.

The digital evolution has intensively changed, and sometimes disrupted, the world for CHIs. New technologies and the internet have forced CHIs to ‘consider digitizing and disseminating their collection via the Internet, if they wish to remain socially and culturally relevant in the 21st century’<sup>10</sup>. Yet, such acts of digitization and dissemination of cultural content require CHIs to perform copyright-relevant acts, including making reproductions of the content and making their collections available to the public. It is generally accepted that for CHIs, IPRs have gained in importance in the internet era as compared to previous decades. More in particular, production, distribution and access to digital content entail clear IPR-related challenges as most of digital content held by these institutions is based on pre-existing rights<sup>11</sup>. Furthermore, even if certain ‘assets’ may belong to the public domain, their digitization may create new IP and, thus, give rise to new IPRs (e.g. any repository of works in the form of a database could also be protected by copyright or by other kind of IPRs<sup>12</sup>). This somehow ‘omnipresence’ of copyright may frustrate both the CHIs and their users.

Thus, copyright protection is crucial for the protection of authors but also for the way cultural content is accessed, re-used and disseminated<sup>13</sup>. This dichotomy has been further enlarged in the digital era as distribution of copyrighted works raise new challenges. The development of the internet and new technologies has definitely changed the manner in which citizens access culture and make use and re-use of cultural content. At the same time, digital distribution has considerably changed the ways of dissemination of culture and has enlarged its impact. This new reality has also created huge concerns for rightholders as digital copies of a copyrighted work are similar to the original work and can be easily shared and accessed without their authorization on the internet<sup>14</sup>.

Nevertheless, in some cases also other IPRs may be relevant for CHIs such as trademarks or designs<sup>15</sup>. It should on the other hand be born in mind that, in the digital era, digital content – both digital native content and digitized content – has become an important commercial asset. It is therefore not surprising to observe how galleries, libraries, archives and museums (hereinafter ‘GLAM’) create their own brands to attract further revenues. They thereby strive for a lesser public-funding dependency

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<sup>8</sup> Weber and Chrobak (n 5).

<sup>9</sup> See references in further footnotes.

<sup>10</sup> Lucie Guibault and Jean-François Canat, ‘WIPO Study on Exceptions and Limitations in Museums’ 1.

<sup>11</sup> Elster Pantalony (n 6) 18.

<sup>12</sup> Vladia Borissova, ‘Cultural Heritage Digitization and Related Intellectual Property Issues’ (2018) 34 *Journal of Cultural Heritage* 145.

<sup>13</sup> Guibault and Canat (n 10).

<sup>14</sup> Andrea Stazi, ‘Digital Copyright and Consumer/User Protection: Moving toward a New Framework?’ (2012) 2 *Queen Mary Journal of Intellectual Property* 158.

<sup>15</sup> Elster Pantalony (n 6) 18.

and a higher level of sustainability<sup>16</sup>. Such brands can become valuable entities<sup>17</sup> and are normally based on works which may be protected by trademark or industrial designs, e.g. the corporate image of the Guggenheim Museum. Yet, there are also other types of works connected to the recording of intangible cultural heritage and traditional cultural expressions. The studies or reproductions of these cultural expressions can be also found in the archives of CHIs<sup>18</sup>.

In consequence, IPRs are a crucial factor that has to be taken account of in *management decisions* of cultural institutions. This explains the decision to devote special attention to IPRs in the inDICEs project. It is important to identify those IP legislative provisions that are hindering the development of CHIs in the digital environment as well as to determine those IP-related opportunities that could foster their potential in the digital world.

### **State of the art**

Literature on CHIs is often divided between sectors: museums or libraries. The goal of the inDICEs project is to follow a comprehensive approach of CHIs. This means that the research will also not be limited to partial problems, as is the case in some literature that only addresses the issues of exceptions and limitations for CHIs or particular categories of works (orphan works and out-of-commerce works). This deliverable will take a more comprehensive approach: all type of works and all relevant provisions in the EU acquis that are relevant for CHIs.

In consequence, each provision included in this deliverable has been identified as having an impact on the current situation of CHIs. Therefore, each section is accompanied by a sub-section on 'particular implications for CHIs' which aims at providing only initial indications of the actual relevance for CHIs of each legislative provision. A comparative analysis of these provisions among selected Member States and an evaluation of such provisions for CHIs will be further developed in the next deliverables of the inDICEs project. Yet, this deliverable provides a mapping of the current situation in the EU with a general overview of the impact for CHIs.

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<sup>16</sup> Massimo Guarino and others, 'Digital Transformation of Cultural Institutions: A Statistical Analysis of Italian and Campania GLAMs' [2019] *Quality & Quantity* <<http://link.springer.com/10.1007/s11135-019-00889-3>> accessed 20 March 2020.

<sup>17</sup> Niall G Caldwell, 'The Emergence of Museum Brands' (2000) 2 *International Journal of Arts Management* 28.

<sup>18</sup> CJ Nwabueze, 'The Role of Intellectual Property in Safeguarding Intangible Cultural Heritage in Museums.' (2013) 8 *International Journal of Intangible Heritage* 181.

## 3 Intellectual Property Rights

### 3.1 General overview of IPRs

#### 3.1.1 Brief overview of IPRs and the principle of territoriality

Given the importance of IPRs in the development of the CHIs' mandate with regard to the acquisition, storage, dissemination and use of information and knowledge<sup>19</sup>, it is key to identify those IPRs that have a major role in the activities of CHIs.

Due to the multiple variety of the works protected and the different types of protection under the concept of 'intellectual property rights' it is arduous to have a homogeneous definition. The TRIPS agreement has provided the following definition:

**Intellectual property rights are the rights given to persons over the creations of their minds. They usually give the creator an exclusive right over the use of his/her creation for a certain period of time<sup>20</sup>.**

In consequence, IPRs provide, exclusive rights to the creator of intellectual creations to prevent third parties from using such creation without the authorization of the creator. It is important, however, to bear in mind that the (sort of) monopolies provided under IPRs are in essence justified by the public benefits that they may yield for society. Another important characteristic of IPRs is their ingrained balancing mechanism: the benefits for granting IPRs must remain in proportion with the costs of granting such IPRs<sup>21</sup>. This explains why, for all IPRs the granting of exclusive rights is accompanied by a system of exceptions and limitations that aims at safeguarding the rights of users and/or consumers.

As regards the different types of IPRs a distinction is traditionally made between, on the one hand, the rights to literary and artistic works<sup>22</sup> and, on the other hand, industrial property rights. Literary and artistic works may be protected under copyright and related rights, such as works of visual arts, books, manuscripts, or sound recordings, among others. Within the area of industrial property, a distinction can further be made between (i) protection of distinctive signs – principally trademarks and geographical indicators – and (ii) protection of inventions – patents and industrial designs<sup>23</sup>.

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<sup>19</sup> Weber and Chrobak (n 5) 1.

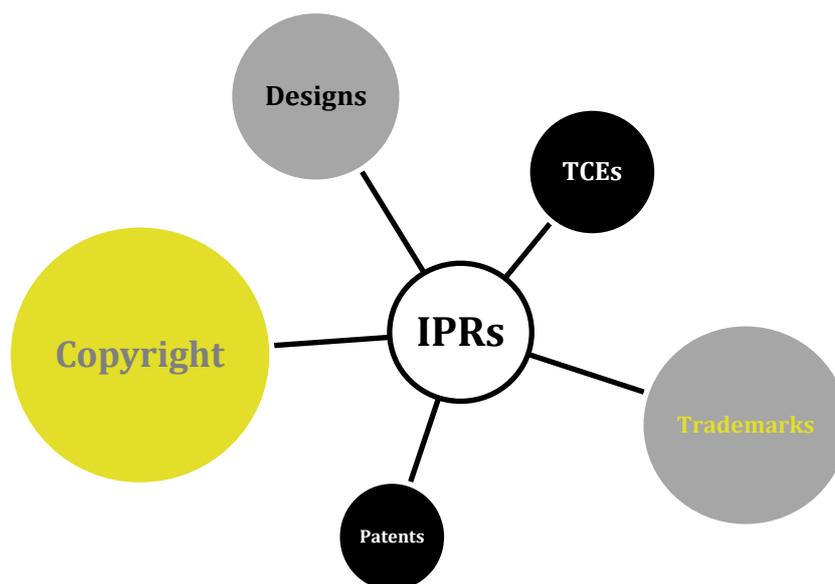
<sup>20</sup> Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299, 33 I.L.M. 1197 1994.

<sup>21</sup> Robert P Merges, *Justifying Intellectual Property* (Cambridge, Mass : Harvard University Press, 2011).

<sup>22</sup> Berne Convention for the Protection of Literary and Artistic Works, September 9, 1886, revised at Paris July 24, 1971 25 U.S.T. 1341; 1161 U.N.T.S. 3 (the Berne Convention).

<sup>23</sup> World Intellectual Property Organization, *WIPO Intellectual Property Handbook: Policy, Law and Use* (WIPO 2008) 3.

It is important to underline that all IPRs are characterized by the *principle of territoriality* which holds that a country has only competence to prescribe legal rules to govern activities that occur inside its national borders<sup>24</sup>. In other words, these rights are only protected within the means of national or regional legislation within defined borders<sup>25</sup>. This feature, that already constituted a problem in an analogue world, is highly topical with respect to uses of protected works in a digital networked environment where access to content is by definition ubiquitous. It undoubtedly is one of the major challenges that European CHIs are faced with in their endeavours of disseminating and promoting access to culture.



*\*Copyright protection plays an important role in the activities of CHIs. Trademarks and Designs have an increased relevance in large CHIs.*

**Copyright** provides ‘protection of the rights of authors in their literary and artistic works’<sup>26</sup> according to the definition of the Berne Convention. Due to its high relevance for CHIs and for the inDICES project, it will be the object of further study in the next Chapters.

### Patents

With regards to the protection under patent law, it seems evident that CHIs are less impacted by **patents**. Patents can be defined as exclusive rights granted for an invention<sup>27</sup> – a new product or process that provides new or inventive and industrially applicable technical solutions<sup>28</sup>. These exclusive rights are given to enable the public disclosure of that invention. In comparison to other IPRs, the duration of a patent is shorter and will normally not exceed 20 years. Patents provide incentives to inventors to innovate by allowing them to recuperate invested resources by limiting the

<sup>24</sup> Goldstein and Hugenholtz, *International Copyright. Principles, Law, and Practice* (Oxford: Oxford University Press, 2013), 97.

<sup>25</sup> Lionel Bently and Brad Sherman, *Intellectual Property Law* (4th ed., Oxford : Oxford university press 2014).

<sup>26</sup> The Berne Convention art 1.

<sup>27</sup> World Intellectual Property Organization (n 23) 17.

<sup>28</sup> Elster Pantalony (n 6).

‘freeriding’. These incentives encourage innovation and thus enhance technological development and state of science, which directly benefits society at large.<sup>29</sup>

It should be stressed that large CHIs, e.g. museums or libraries, increasingly invest in innovative techniques and technologies, such as ‘specialized collections management methods and technical applications’ or ‘scientific conservation techniques’<sup>30</sup> that could possibly constitute patentable subject matter. However, as the impact of patents within activities of CHIs is still relatively small and does not imply further challenges within the purposes of the inDICEs project, patent law will not be subject to this Study.

### Trademarks

Although this may seem less obvious at first sight, the trademark system may also be relevant to (some) CHIs.

According to the EU Trademark Directive, a trademark ‘may consist of any signs (...) provided that such signs are capable of (a) distinguishing the goods or services of one undertaking from those of other undertakings; and (b) being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor’<sup>31</sup>.

In general terms, besides identifying the company’s goods or services to consumers, they constitute a useful tool for creating meaningful competition as well as securing a competitive internal market.

The importance of trademarks for CHIs can be viewed from three angles. Firstly, GLAMs create brands under the name of the museum, logos or graphic signs linked to it (or even to the building) which may be protected by trademark law to monetize their activities and collections. Secondly, trademark rights can be ‘used as a vehicle to re-monopolize material, in respect of which other forms of intellectual property with a limited term of protection have already expired’<sup>32</sup>. Therefore, a new IPR protection could arise as works that have fallen in the public domain (in the sense that IPR on that work – normally copyright – has expired and therefore it should be free to use) could be ‘monopolized’ again, but this time by relying on trademark protection. If this is the case, certain uses by third parties could still be prohibited without the prior authorization by the trademark owner. Thirdly, certain works in CHIs’ collections could be protected by a trademark owned by a third party. This situation would require CHIs to obtain a license from the owner. For further details see Section 7.1.

### Industrial designs

Alike trademarks, **industrial designs** are very much linked to the commercial activities of CHIs and the need of generating further revenues. In the last years, large archives, libraries or museums have engaged in designing commercial products based on their collections or on their own brands (signs,

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<sup>29</sup> World Intellectual Property Organization (n 23) 6.

<sup>30</sup> Elster Pantalony (n 6).

<sup>31</sup> Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (the Trademark Directive) art 3.

<sup>32</sup> Martin Senftleben, ‘Trademark Law and the Public Domain’ in Dana Beldiman, *Access to Information and Knowledge* (Edward Elgar Publishing 2013) 1.

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names, logos) which are then commercialized (e.g. The British Museum). The creation of these products, if protected by IPRs, largely contributes to the revenue generation of the institution. According to the World Intellectual Property Organization (hereinafter the 'WIPO'), an 'industrial design refers to the right granted in many countries, pursuant to a registration system, to protect the original ornamental and non-functional features of an industrial article or product that result from design activity'<sup>33</sup>. The main aspect for the production of an industrial design is the visual appearance and the 'utility' factor, adding commercial value to the product.

An industrial design provides, therefore, the exclusive right to protect the design against copying without previous authorization as a matter of compensation for the investment and creativity in the new product. The current applicable legal framework for industrial designs, which is also to a large extent harmonised in the EU, is addressed in Chapter 7.2.

### Traditional Cultural Expressions

While not forming part of the family of IPRs, it is important to have a look at regulations relating to traditional cultural expressions as they may be relevant for intangible cultural heritage in the collections of CHIs. Lacking an international definition of traditional cultural expressions (hereinafter 'TCEs'), WIPO has proposed some working descriptions in an attempt to define them. Cultural expressions could be, thus, defined as those cultural expressions that are passed via generation to generation, either orally or by imitation. These creations are normally made by 'unknown authors' and belong to the community itself as they reflect a 'community's social and cultural identity' in constant evolution<sup>34</sup>.

As a rule, TCEs are considered to be works in the public domain. Nevertheless, a certain need is felt by indigenous communities to protect them against misappropriation or unauthorized use by third parties<sup>35</sup>. Due to its special nature, 'a protection regime based on individual property rights is not suitable for TCEs'<sup>36</sup>. For this reason, the WIPO has, in collaboration with Member States, set up in 2000, the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore in order to assess possible ways of protection for such expressions. Further work on the protection of such cultural expressions has also been undertaken by UNESCO through the adoption of international conventions like the Convention for the Safeguarding of the Intangible Cultural Heritage<sup>37</sup> and the Convention on the Protection and Promotion of the Diversity of Cultural Expressions<sup>38</sup>.

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<sup>33</sup> World Intellectual Property Organization (n 23) 112.

<sup>34</sup> Molly Torsen and Jane Anderson, 'Intellectual Property and the Safeguarding of Traditional Cultures: Legal Issues and Practical Options for Museums, Libraries and Archives' 2012.

<sup>35</sup> Lucie Guibault, 'Intellectual Property and Culture' in Anselm Kamperman-Sanders and others (eds), *Introduction to Intellectual Property and Knowledge Management* (University of Maastricht 2018) 8 <<https://papers.ssrn.com/abstract=3198967>>.

<sup>36</sup> *ibid* 11.

<sup>37</sup> UN Educational, Scientific and Cultural Organization (UNESCO), *Convention for the Safeguarding of the Intangible Cultural Heritage* 2003.

<sup>38</sup> UN Educational, Scientific and Cultural Organisation (UNESCO) *Convention for the Protection and Promotion of the Diversity of Cultural Expressions* 2005.

Some CHIs are in charge of the study, safeguarding and promotion of those artefacts, sound recordings, photographs or manuscripts, among others, documenting such cultural expressions of certain communities. This explains why CHIs have expressed their concern about the lack of regulation regarding TCEs and the relationship with copyright laws in the latest Europeana survey<sup>39</sup>. In addition, some authors consider that protection of the intangible cultural heritage could be made through its digitization within the collections of cultural institutions<sup>40</sup>. This aspect will be further considered under Chapter 6 on public domain works.

## 3.2 Copyright as essential IPR for CHIs<sup>41</sup>

### 3.2.1 The expanding scope of copyright

Copyright protection undoubtedly plays an important role in the protection and dissemination of cultural heritage and cultural content. The problem and challenge for many CHIs is to keep track of the many evolutions in this field of law. The scope of copyright law has indeed expanded considerably since its international acceptance in the first copyright Convention, i.e. the Berne Convention, in 1886. This Treaty essentially aims at protecting literary and artistic works<sup>42</sup>. Article 2 explains that the expression '*literary and artistic works*' includes 'every production in the literary, scientific and artistic domain, whatever may be the mode or form of its expression'. This statement is generally accepted to be broadly understood as it is demonstrated in the long catalogue of examples provided by way of illustration in Article 2 of the Berne Convention which itself is viewed as a floor rather than a ceiling<sup>43</sup>. Examples include books, maps, works of applied arts or three-dimensional works related to architecture or science, among others.

Hence, copyright can easily embrace works ranging from high-end art to applied and utilitarian creations, as long as they are not merely functional and comply with the standards for protection. As these standards imply a rather low threshold as well (see further below), copyright is capable of protecting a wide variety of works: from written works (books, articles, blog messages, music scores, etc.), visual art works (images, graphics, architecture, sculptures, geographical maps, technical drawings, posters, etc.), music works (music songs, etc.), audio and audiovisual works (movies, animations, podcasts, etc.), design (scale-model design, etc.), to databases and software. Also, other objects of human creativity such as common appliances and utensils, including coffee machines, baker's bicycles, industrial machinery and of course digital works such as website designs, news posts and user-generated YouTube files may benefit from copyright protection. There is finally no obstacle

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<sup>39</sup> 'Insights from the Europeana Copyright Community Survey' (*Europeana Pro*) <<https://pro.europeana.eu/post/insights-from-the-europeana-copyright-community-survey>>.

<sup>40</sup> Borissova (n 12) 146.

<sup>41</sup> Many parts in this section paraphrase the parts written by Marie-Christine Janssens in 'Intellectual Property Rights: Copyright and Trademark Issues' in Laurent Garzaniti and others (eds), *Electronic Communications, Audiovisual Services and the Internet. EU Competition Law & Regulation*. (Sweet & Maxwell; London 2020)

<sup>42</sup> The Berne Convention art 1.

<sup>43</sup> Paul Goldstein and Bernt Hugenholtz, *International Copyright : Principles, Law and Practice* (2nd ed., Oxford : Oxford university press, 2013) 190.

to protection for very short works (e.g. Twitter messages) or a mere combination of (known) individual elements that are not original in themselves but amount to a protected work as a whole.<sup>44</sup>

The **Berne Convention** for the Protection of Literary and Artistic Works<sup>45</sup> is the main international reference for copyright protection.

As was pointed out above, the scope of copyright protection has considerably expanded since the Berne Convention of 1886<sup>46</sup>. This first occurred through the protection for the creative contributions of the ‘auxiliaries’ persons, others than creators that contribute to the production of the works (e.g. performers, broadcasters or producers of phonograms), via the so-called neighbouring or related rights<sup>47,48</sup>. By the mid-1990s, two new international frameworks were put in place, namely the TRIPs agreement and the WIPO Internet Treaties<sup>49,50</sup>. They embraced new artefacts to be given copyright protection, in particular *computer programs*,<sup>51</sup> the introduction of effective *technological measures* and *electronic rights management information* that protect and/or accompany digital content.<sup>52</sup> The most recent expansion, albeit only in the EU, resulted in the adding of a distinct *sui generis* style protection scheme for non-original *databases*. These special protection schemes will be discussed further below in this deliverable. The end-result (thus far) is a vast protection scheme. Yet, and especially in an online world, this scheme continues to be challenged by the enormous changes to business models, creative practice and consumer behaviour.

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<sup>44</sup> Marie-Christine Janssens and Benoit Michaux, ‘Intellectual Property Rights: Copyright and Trademark Issues’ in Laurent Garzaniti and others (eds), *Electronic Communications, Audiovisual Services and the Internet. EU Competition Law & Regulation*. (Sweet & Maxwell; London 2020) 394.

<sup>46</sup> The Berne Convention has set the minimum requirements of protection together with a set of basic principles, including those rights granted under copyright protection. The Berne Convention itself has been revised several times until 1971 (the Paris revision) pursuing to adapt copyright protection to the needs of modern society.

<sup>47</sup> Janssens and Michaux (n 44) 391.

<sup>48</sup> As result of the technological development, several debates emerged in order to also grant copyright protection to producers of phonograms, performers and broadcasters compensating these actors for their investment and contribution to creative works. In 1961 the Rome Convention was adopted at international level providing these beneficiaries the so-called neighbouring or related rights.

<sup>49</sup> TRIPs stands for ‘Agreement on Trade-Related Aspects of Intellectual Property Rights’. It constitutes an annex to the WTO Treaty of 1994 and is binding on all the member nations of the WTO. TRIPs requires them to comply with the substantive Articles of the Berne Convention other than the provisions on moral rights. While it substantially enlarged the scope of copyright protection, it did not address the digital challenges.

<sup>50</sup> These include the WCT (WIPO Copyright Treaty) and the WPPT (WIPO Performers and Producers Treaty) which were both signed in December 1996. The principal aim of the WCT was to adjust the Berne protection scheme to the digital environment.

<sup>51</sup> The TRIPs Agreement art 10(1); World Intellectual Property Organization Copyright Treaty (1996 December 20) art 4.

<sup>52</sup> The WIPO Copyright Treaty art 11 and 12.

At the international level, mention should finally be made of the Beijing Treaty<sup>53</sup> from 2012 that provides economic rights to performers for performances fixed in audiovisual fixations and the Marrakesh Treaty<sup>54</sup> which creates mandatory exceptions and limitations for the blind, visually impaired, or otherwise print disabled. The main objective of the Treaty is that ‘authorized entities’ can provide copies in accessible format to the blind or visually impaired permitting cross-border exchange of those works between organizations.

### 3.2.2 Some basic copyright rules<sup>55</sup>

*Conditions for protection.* The realm of copyright may be vast, copyright protection has also its boundaries. First, it *does not protect ‘ideas’* but only an intellectual creation that has been expressed (which does not necessarily mean a fixation in a tangible form). It is generally accepted that the demarcation of the borderline between the original expressive elements of a work and its unprotected content is one of the least clarified issues that continues to stir lively debates in Europe and elsewhere.<sup>56</sup> Secondly, for a work to qualify for copyright protection, the expression needs to be ‘*original*’. Internationally, the level of originality varies considerably from one jurisdiction to another as this requirement has not been defined in the Berne Convention nor the TRIPs Agreement. At the EU level, the Court of Justice has imposed a uniform EU standard of originality in the sense that the work “is the author’s own intellectual creation”<sup>57,58</sup>. In other words, it has to be demonstrated that the work is the result of free and creative choices by the author and bears the personal stamp of this author’s personality<sup>59,60</sup>.

Copyright does not protect ideas but the **expression** of such ideas. Such expression must be ‘**original**’ to qualify for copyright protection.

*No formalities.* Copyright protection is automatic as the Berne Convention has outlawed any formal requirement—such as registration at an office or application of a © notice—as a precondition to enjoy copyright protection.<sup>61</sup>

<sup>53</sup> World Intellectual Property Organization Beijing Treaty on Audiovisual Performances (2012).

<sup>54</sup> World Intellectual Property Organization Marrakesh Treaty to Facilitate Access to Published Works for Persons Who Are Blind, Visually Impaired, or Otherwise Print Disabled (2013).

<sup>55</sup> Further basic rules will be discussed in subsequent sections.

<sup>56</sup> See e.g. Latreille, ‘From idea to fixation: a view of protected works’, in Research Handbook on the Future of EU Copyright, by Derclaye (ed.) (Cheltenham: Edward Elgar, 2009), 133; Strowel, *Droit d’auteur et Copyright* (Brussels: Bruylant, 1993), n° 312; Karnell, ‘The idea/expression dichotomy: a conceptual fallacy’, *Copyright World* (1989), n° 7, 16.

<sup>57</sup> *Infopaq International A/S v Danske Dagblades Forening* (C-5/08) EU:C:2009:465.

<sup>58</sup> For a detailed overview of this evolution, see Eleonora Rosati, *Originality in EU Copyright : Full Harmonization through Case Law* (Cheltenham : Edward Elgar 2013).

<sup>59</sup> *Football Dataco Ltd and Others v Yahoo! UK Ltd and Others* (C-604/10) EU:C:2012:115.

<sup>60</sup> Janssens and Michaux (n 44) 395.

<sup>61</sup> The Berne Convention art 5(2).

This lack of formal requirements is in particular problematic for CHIs in their mission of dissemination of culture as there is no national or international complete registry or database which could keep a trace of the copyrighted works and their authors.

*Territorial scope.* As with all IPRs, copyright law is characterized by the principle of territoriality (see also Sec. 3.1.1). Yet, because of the absence of formalities coupled with the obligation of national treatment imposed by international treaties, copyright law seems to be somehow more ‘universal’ than other forms of IP rights. Nonetheless, copyright law is still ultimately dependent on national law.<sup>62</sup> This feature, that already constituted a problem in an analogue world, is highly topical with respect to uses in a digital networked environment where access to content is by definition ubiquitous. Notwithstanding the harmonisation of many principles achieved by international and European norms, users seeking permission to use protected subject matter across the EU have to acquaint themselves with the copyright laws of many different jurisdictions. Differences remain pre-eminently apparent with respect to divergent judicial interpretations, exceptions and limitations to exclusive rights, ownership of copyright and contractual issues. The enforcement of copyright is also necessarily dependent on national courts whose jurisdiction is by definition territorial.<sup>63</sup>

Copyright protection is based on the principle of territoriality. It only confers protection within the boundaries of each national jurisdiction. Its enforcement depends on national laws through the national courts.

*Term of protection.* The Berne Conventions provides for a minimum duration of 50 years after the death of the author, but countries can impose a longer period. In the EU it is prescribed that Copyright “shall run for the life of the author and for 70 years after his death, irrespective of the date when the work is lawfully made available to the public”. In the case of a work of joint authorship, this term should be calculated from the death of the last surviving author. The term of protection of neighbouring rights amounts to 50 years after the date of performance, fixation (performers) or first transmission (broadcasters). For music performers and music producers, Directive 2011/77 has prolonged this term by 20 years<sup>64</sup>.

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<sup>62</sup> The territorial nature of copyright was confirmed by the CJEU in *Lagardère Active Broadcast v Société pour la perception de la rémunération équitable (SPRE) and Gesellschaft zur Verwertung von Leistungsschutzrechten mbH (GVL)* (Case C-192/04) EU:C:2005:475 para 46.

<sup>63</sup> David T Keeling, *Intellectual Property Rights in EU Law: Vol. 1: Free Movement and Competition Law* (Oxford : Oxford University Press, 2003) 266.

<sup>64</sup> Directive 2006/116/EC of the European Parliament and of the Council of 12 December 2006 on the term of protection of copyright and certain related rights art 1.

In the EU, copyright protection is granted for the **life of the author and 70 years post mortem**. For **neighbouring rights**, it lasts **50 years** after the date of first fixation, performance or transmission with the exception of **music** performers and producers, extended until **70 years**.

*Scope of protection.* Copyright confers upon the owner extensive rights to authorize use that can be made of protected material, and consequently, to prevent any use by third parties without prior authorization. Copyright is composed of a ‘bundle of rights’ comprising both *economic* and *moral rights*<sup>65</sup>.

*Economic rights* include the right to authorize or prohibit (i) the reproduction of the work; (ii) the distribution of the work; (iii) the communication of the work to the public including the making the work available to the public; and (iv) right of adaptation. With the exception of the latter right, a comprehensive harmonisation of the various economic rights was achieved through the Infosoc Directive. This is further discussed in section 4.1.1.

*Moral rights.* The minimum standards of **moral rights** are enshrined in Article 6bis of the Berne Convention – the right of attribution and the right of integrity – and, according to it, need to be provided at least until the expiry of the economic rights<sup>66</sup>. There is nevertheless a big divergence on the approach to moral rights in national jurisdictions<sup>67</sup>. Similarly, moral rights are not harmonized either at the EU level despite the increasing need for harmonization. As Janssens and Michaux explain, moral rights ‘should be given particular attention in the internet age as, in digital form, protected materials are very “vulnerable”’<sup>68</sup>. Moral rights will be the subject of further analysis in Chapter 5.2.

Copyright is a ‘bundle’ of rights which consists in **economic and moral rights**. Economic rights have been broadly harmonized at the EU level. On the contrary, moral rights have not been harmonized. The **lack of harmonization** creates problems, in particular, with regards to digital works.

*Ownership and contracts*<sup>69</sup>. The question of first ownership of copyright is one that is answered differently in the various copyright systems. In a nutshell, there exist two major systems. Countries either belong to the ‘copyright system’ (most notably the US and the UK) which allows one to legally vest all rights in an entity other than the author (*e.g.* the employer or the producer) or they have opted for the ‘*droit d’auteur* system’ (as in the majority of EU countries) where first ownership necessarily is vested in the natural person who has created the work. Legal persons—that CHIs often are—have to

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<sup>65</sup> Elster Pantalony (n 6).

<sup>66</sup> The Berne Convention art 6bis(2).

<sup>67</sup> JAL Sterling, *Sterling on World Copyright Law* (4th ed., London : Sweet & Maxwell 2015) 392.

<sup>68</sup> Janssens and Michaux (n 44) 396.

<sup>69</sup> Janssens and Michaux (n 44).

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subsequently 'acquire' the exploitation rights from the person who created the work. Such a first transfer can occur either through contractual provisions or through the mechanism of legal presumptions in certain situations, *e.g.* creations by employees or particular works such as audiovisual works, computer programs and databases.<sup>70</sup> Of course, further transfers of copyrights are allowed in all systems on the condition that they comply with the applicable rules of copyright contract law. This is an area which is far from being harmonised and requires a country-by-country analysis.<sup>71</sup> In the Copyright in the Digital Single Market Directive (hereinafter the 'CDSM Directive')<sup>72</sup>, the European legislator has for the first time imposed mandatory safeguards for authors and performers who license or transfer their exclusive rights for the exploitation of their works or other subject matter. They are subject of study in Section 4.5.6.

Consequently, as 'heritage organizations, particularly libraries, archives and museums, are the keepers of most cultural and scientific content'<sup>73</sup> they need to be aware of the permitted and non-permitted uses of works under copyright law and especially in the digital environment. New technologies provide opportunities for CHIs to disseminate their collections across the globe fostering access to culture among society. With this objective, CHIs engage in activities for the digitization and online dissemination of their collections. This, nevertheless, entails certain copyright-related risks which will be further studied in detail within the inDICEs project.

### 3.2.3 Copyright in the EU

One of the objectives of the European Union is the establishment of the single market where goods, persons, services and capital can move freely within the EU territory establishing, at the same time, certain rules to avoid distortion of competition<sup>74</sup>. Harmonization of copyright laws within Member States contributes to this objective where exploitation of copyrighted works, including in the digital environment, can take place with high level protection of rightholders avoiding fragmentation of the internal market. This explains why, since 1988, the EU legislator has made significant efforts to harmonise national legislations in the field of copyright.

Harmonization of copyright laws in the EU also contributes to innovation and stimulation of creativity, to the promotion of cultural diversity<sup>75</sup> and cultural heritage and to the production of new content<sup>76</sup>.

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<sup>70</sup> In the EU, Article 5 of the Enforcement Directive establishes a rebuttable presumption of ownership in favor of the person whose name appears on the work, which can be a legal entity.

<sup>71</sup> In *Soulier* the CJEU held that both the right of communication to the public and the reproduction right do not specify the way in which the prior consent of the author must be given. Since those provisions cannot be interpreted as requiring that such consent must necessarily be expressed explicitly, an implicit but certain consent must be admissible. *Marc Soulier and Sara Doke v Premier Ministre and Ministre de la Culture et de la Communication (C-301/15) EU:C:2016:878* [35].

<sup>72</sup> Directive (EU) 2019/790 of the European Parliament and of the Council of 17 April 2019 on copyright and related rights in the Digital Single Market and amending Directives 96/9/EC and 2001/29/EC 2019 arts 18-23.

<sup>73</sup> Karol J Borowiecki and Trilce Navarrete, 'Digitization of Heritage Collections as Indicator of Innovation' (2017) 26 *Economics of Innovation and New Technology* 227.

<sup>74</sup> Sterling (n 67) 937.

<sup>75</sup> European Union, Consolidated version of the Treaty on the Functioning of the European Union, 13 December 2007, 2008/C 115/01 art 167(4).

<sup>76</sup> The CDSM Directive.

It is, therefore, the ‘internal market – rather than copyright – that has driven the harmonization of EU copyright law to date’<sup>77</sup>.

Aiming at achieving a well-functioning internal market, EU legislator has thus far (2019) adopted 12 Directives and two Regulations that have become part of the copyright *acquis communautaire*:

- The 1991 Computer Programs Directive (codified by 2009/24/ EC)<sup>78</sup>;
- The 1992 Rental and Lending Directive (codified by 2006/115/E)<sup>79</sup>;
- The Satellite and Cable Directive (1993)<sup>80</sup>;
- The 1993 Term Directive (codified by 2006/116/EC, amended by 2011/77/EU)<sup>81</sup>;
- The Database Directive (1996)<sup>82</sup>
- The Resale Right Directive (2001)<sup>83</sup>;
- The Infosoc Directive (2001)<sup>84</sup>
- The Orphan Works Directive (2012)<sup>85</sup>;
- The Directive on collective management (2014)<sup>86</sup>;
- The Directive<sup>87</sup> and Regulation<sup>88</sup> implementing the Marrakesh Treaty (2017);
- The New Satellite and Cable Directive (2019)<sup>89</sup>;
- The Digital Copyright Single Market Directive (2019)<sup>90</sup>.

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<sup>77</sup> Thomas Margoni, ‘The Harmonisation of EU Copyright Law: The Originality Standard’, *Global Governance of Intellectual Property in the 21st Century: Reflecting Policy Through Change*. (Springer International 2016).

<sup>78</sup> Directive 2009/24/EC of the European Parliament and of the Council of 23 April 2009 on the legal protection of computer programs.

<sup>79</sup> Directive 2006/115/EC of the European Parliament and of the Council of 12 December 2006 on rental right and lending right and on certain rights related to copyright in the field of intellectual property.

<sup>80</sup> 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>81</sup> The Term Directive.

<sup>82</sup> Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases.

<sup>83</sup> Directive 2001/84/EC of the European Parliament and of the Council of 27 September 2001 on the resale right for the benefit of the author of an original work of art.

<sup>84</sup> *ibid.*

<sup>85</sup> Directive 2012/28/EU of the European Parliament and of the Council of 25 October 2012 on certain permitted uses of orphan works (2012) OJ L299/5.

<sup>86</sup> Directive 2014/26/EU of the European Parliament and of the Council of 26 February 2014 on collective management of copyright and related rights and multi-territorial licensing of rights in musical works for online use in the internal market.

<sup>87</sup> Directive on certain permitted uses of certain works and other subject matter protected by copyright and related rights for the benefit of persons who are blind, visually impaired or otherwise print-disabled (2017/1564/EU).

<sup>88</sup> Regulation on the cross-border exchange between the Union and third countries of accessible format copies of certain works and other subject matter protected by copyright and related rights for the benefit of persons who are blind, visually impaired or otherwise print-disabled (2017/1563/EU) Regulation on cross-border portability of online content services in the internal market (2017/1128/EU).

<sup>89</sup> Directive (EU) 2019/789 of the European Parliament and of the Council of 17 April 2019 laying down rules on the exercise of copyright and related rights applicable to certain online transmissions of broadcasting organisations and retransmissions of television and radio programmes, and amending Council Directive 93/83/EEC.

<sup>90</sup> The CDSM Directive.

For the purpose of the inDICEs project and its relevance to CHIs, this deliverable will henceforth mainly include an analysis of the Infosoc Directive, the Orphan Works Directive, the Term Directive, the Rental and Lending Directive and the Database Directive. In addition, the recently adopted CDSM Directive which needs to be implemented in June 2021 by Member States will also be included in our study as it introduces new provisions with a crucial impact on CHIs.

Despite the many harmonising directives that were enacted since 1991, copyright law is not fully harmonized within the EU. These non-harmonised aspects of copyright protection will, to the extent that they are relevant for the activities of CHIs like moral rights and the right of adaptation, be analysed in the separate Chapters 5.1 and 5.2.

In conclusion, IP is not only an essential aspect for CHIs with regard to their role as public-interest institutions aiming at contributing to the preservation and promotion of culture and knowledge but is also of particular relevance for their management and sustainable programming. Legal certainty with regard to the protection and management of IPRs can in turn lead to further revenues for cultural institutions and reduce the burden of rights clearance that CHIs must face. Given the importance of copyright for CHIs, most of this deliverable will be devoted to an analysis of the relevant aspects of copyright.

## 4 Relevant copyright rules in the EU acquis for CHIs

### 4.1 The Infosoc Directive

**Directive 2001/29/EC continues to define the copyright landscape of the European Union and indeed beyond'.<sup>91</sup>**

Since the 80s, the European legislator has made strong efforts to harmonize copyright laws within the EU<sup>92</sup>. Such efforts have, however, not always been made in a comprehensive manner but were rather aiming at selected issues. The EU legislator has construed a copyright law system within the EU touching some areas of copyright law but leaving other areas unharmonized<sup>93</sup>. In Ramalho's views, this is due to the lack of direct competence of the EU to legislate in the field of copyright law. Copyright legislation has always been linked to other areas or policies where the EU has legal competence to intervene, mainly related to the well-functioning of the internal market<sup>94</sup>. Besides, harmonization within the Member States has always been a challenge for EU legislators 'in view of the differences in

<sup>91</sup> Brigitte Lindner and Ted Shapiro, *Copyright in the Information Society: A Guide to National Implementation of the European Directive* (2nd ed., Cheltenham : Edward Elgar Publishing 2019).

<sup>92</sup> Janssens and Michaux (n 44) 392.

<sup>93</sup> Ana Ramalho, *The Competence of the European Union in Copyright Lawmaking* (Springer International Publishing 2016) <<http://link.springer.com/10.1007/978-3-319-28206-0>>.

<sup>94</sup> *ibid.*

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ideology between Member States (the so-called divide between copyright and *droit d'auteur* traditions)' that was already touched upon above<sup>95</sup>. Harmonizing copyright laws has been and continues to be a complex task due to the diversity of the copyright systems and doctrines. Additionally, due to the opposite interests of stakeholders, copyright directives have always been subject to a fierce lobby at the EU level<sup>96</sup>. The above findings do not want to detract from the meritorious achievements that together form the existing *acquis communautaire*.

In addition, it is important to highlight the fundamental role of the CJEU in interpreting concepts of copyright law and even in creating copyright law. It is undoubtedly thanks to the jurisprudence of the CJEU that copyright law has reached a high level of harmonisation nowadays<sup>97</sup>. For many years, the CJEU takes on an active involvement in contributing to the completion and deepening of the harmonisation process thereby filling gaps in the legislative *acquis*.<sup>98</sup> The Court thereby reasons that the need for uniform application of European law and the principle of equality require that the terms of a provision of a copyright directive, which makes no express reference to the law of the Member States for the purpose of determining its meaning and scope, must be regarded as autonomous concepts of EU law and interpreted uniformly throughout the EU<sup>99</sup>.

The Infosoc Directive of 2001 is the first comprehensive and horizontal harmonization instrument, all former directives being vertical in nature (i.e. focussing on particular rights or forms of exploitation). This Directive aimed, firstly, at adapting copyright and related rights to the new technological developments and to the new 'economic realities'<sup>100</sup> and, secondly, at transposing the provisions of the 1996 WIPO Treaties – the WCT<sup>101</sup> and the WPPT<sup>102</sup> into EU law.

Consequently, the Directive sought to achieve a comprehensive harmonization of certain economic rights 'requiring Member States to provide for exclusive rights for authors in relation to the reproduction, communication to the public and distribution of their works'<sup>103</sup>. In addition, the Directive aimed at harmonizing the exceptions and limitations to copyright protection within the Member States introducing a list of non-mandatory exceptions. At the same time, it incorporated certain provisions on technological protection measures (hereinafter 'TPM') and on rights management information (hereinafter 'RMI').

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<sup>95</sup> Janssens and Michaux (n 44) 392.

<sup>96</sup> Lindner and Shapiro (n 91) 47.

<sup>97</sup> Margoni (n 77).

<sup>98</sup> Jonathan Griffiths, 'The Role of the Court of Justice in the Development of European Union Copyright Law' in Irini Stamatoudi and Paul Torremans (eds), *EU Copyright law. A commentary* (Elgar 2014) 1098; Christophe Geiger, 'The Role of the Court of Justice of the European Union: Harmonizing, Creating and Sometimes Disrupting Copyright Law in the European Union' in Irini Stamatoudi (ed), *New Developments in EU and International Copyright Law* (Kluwer Law International 2016) 435 <<https://papers.ssrn.com/abstract=3007572>>.

<sup>99</sup> *Stichting ter Exploitatie van Naburige Rechten (SENA) v Nederlandse Omroep Stichting (NOS)* (Case C-245/00) EU:C:2003:68 para 31; *Sociedad General de Autores y Editores de España (SGAE) v Rafael Hoteles SA* (C-306/05) EU:C:2006:764 para 31.

<sup>100</sup> Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society.

<sup>101</sup> The WIPO Copyright Treaty.

<sup>102</sup> World Intellectual Property Organization Performances and Phonograms Treaty (1996 December 20).

<sup>103</sup> Janssens and Michaux (n 44) 397.



### 4.1.1 Relevant rights

The Infosc Directive has played a fundamental role in harmonizing the main economic rights, i.e. the rights of reproduction, communication to the public and distribution. These rights are exclusive rights providing rightholders control over the use of their work as well as the opportunity to participate in the benefits resulting therefrom<sup>104</sup>. Harmonization of these economic rights is without prejudice to other economic rights that may be recognized in certain countries that do not fall under the scope of this Directive. As mentioned before, these economic rights are to be given a uniform interpretation across the EU according to the case law of the CJEU. Yet, the CJEU has also reminded that, while copyright is a property right safeguarded by the Charter of Fundamental Rights of the European Union (hereinafter ‘CFR’), it does not exist in isolation. Hence, when enforcing exclusive copyrights, courts need to apply a balancing test and take into account other fundamental rights and principles of EU primary law in the CFR<sup>105</sup>. In particular the right of freedom of expression and information (Article 11), the protection of personal data (Article 8) and the right of undertakings to conduct their business (Article 16) will often merit special attention<sup>106,107</sup>.

The **right of reproduction** is considered to be the most basic right under copyright. In a broader context, it mainly concerns the right of the owner to prevent others from making reproductions of his works<sup>108</sup>.

At EU level, the right of reproduction is to be given a very broad scope. Article 2 of the Infosc Directive attributes to the author the exclusive right to authorise or prohibit any ‘direct or indirect, temporary or permanent reproduction by any means and in any form, in whole or in part’. The EU legislator thus mandates to bring even transient acts within the definition of reproduction, although an international consensus to secure a right embracing such types of electronic reproductions could not be reached at the international level (Diplomatic Conference that preceded the adoption of the 1996 WCT)<sup>109</sup>.

<sup>104</sup> Sterling (n 67) 429.

<sup>105</sup> *Promusicae v Telefónica de Espana (C–275/06) EU:C:2008:54 para 68.*

<sup>106</sup> *Scarlet Extended SA v Société belge des auteurs, compositeurs et éditeurs SCRL (SABAM) (C–70/10) EU:C:2011:771.*

<sup>107</sup> Janssens and Michaux (n 44) 398.

<sup>108</sup> World Intellectual Property Organization (n 23).

<sup>109</sup> Janssens and Michaux (n 44) 398.

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This broad definition of the right of reproduction responds to the need of ensuring legal certainty in the internal market<sup>110</sup> and to the need of adapting this right to the ‘use of works in the digital environment’<sup>111</sup>.

Certain attributes of the reproduction right, in particular the rights of adaptation and translation, have been left out of the European harmonisation process<sup>112</sup>. They have only been specifically mentioned in the Software and Database Directives addressing a targeted scope as will be explained in Chapter 5.1.

Secondly, **the right of distribution** is commonly understood as the exclusive right of the rightholder to ‘control the dissemination of the physical copies of his work’<sup>113</sup>. It is harmonized at EU level under Article 4 of the Infosoc Directive, in the sense that it covers ‘any form of distribution by sale or otherwise’<sup>114</sup> of tangible originals and copies.

Such right is in the EU inherently linked to the *exhaustion of rights* doctrine, meaning that within the EU/EEA) the author does not have the right to restrict further circulation of a specific copy after the first sale of the work or copies with the consent of the right owner<sup>115</sup>. This provision was included in the EU copyright acquis to align the territoriality principle with the EU principle of the free movement of goods in the internal market<sup>116</sup>. The many debates as to whether the rule of exhaustion also applies to the distribution of digital copies (e.g. second-hand books), have recently been ended by the decision of the CJEU in the case *Tom Kabinet* in which the court ruled that the exhaustion of copyright does not apply to the resale of e-books online. Hence, the offering of ‘second-hand’ digital works for sale qualifies in the EU as an act of communication to the public<sup>117</sup>.

The third economic right is the **right of communication to the public**. The general concept of ‘communication to the public’ refers to any form of exploitation of works through intangible means. In the EU, Article 3 of the Directive however only harmonizes part of this right, namely in relation to communication to a public which ‘is not present at the place where the communication originates’. Acts of communication at a place where the originally targeted public is present, remain outside the current EU Copyright acquis<sup>118</sup>, but are fully covered by Article 11(3) of the Berne Convention to which all EU Member States are party.

The EU concept covers ‘any kind of transmission or retransmission by wire or wireless, including broadcasting and making available in such a way that members of the public may access them from a place and at a time individually chosen by them’ (Article 3). This provision has led to an extensive case law at EU level. As the CJEU has determined, it involves two essential cumulative criteria, namely (i)

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<sup>110</sup> The Infosoc Directive rec 21.

<sup>111</sup> Lindner and Shapiro (n 91) 49.

<sup>112</sup> Janssens and Michaux (n 44) 398.

<sup>113</sup> Sterling (n 67) 432.

<sup>114</sup> The Infosoc Directive art 4(1).

<sup>115</sup> Lindner and Shapiro (n 91) 69.

<sup>116</sup> Giuseppe Mazziotti, *EU Digital Copyright Law and the End-User* (Springer Science & Business Media 2008).

<sup>117</sup> *Nederlands Uitgeversverbond and Groep Algemene Uitgevers v Tom Kabinet Internet BV* (C-263/18) ECLI:EU:C:2019:1111.

<sup>118</sup> *Circul Globus București (Circ & Variete Globus București) v Uniunea Compozitorilor și Muzicologilor din România - Asociația pentru Drepturi de Autor (UCMR - ADA)* (C-283/10) ECLI:EU:C:2011:772.

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an “act of communication” of a work and (ii) the communication of that work to a “public”<sup>119</sup>. Both criteria have led to a detailed interpretation by the Court<sup>120</sup>.

(i) The notion of *act of communication* has been broadly construed. It refers to any action by which access is given to the protected works. Such an access can take various forms<sup>121</sup>. The case law of the CJEU provides many examples of acts which may constitute an act of communication to the public. For instance, the transmission of broadcast works by the operator of a café-restaurant, a spa, or a revalidation centre, via television or radio sets, or speakers, to the customers present in their establishment<sup>122</sup>; (...) the indexing on an online sharing platform of torrent files which allows users of that platform to locate works and share them in the context of a peer-to-peer network<sup>123,124</sup>.

Importantly, to be considered as an act of communication, it is sufficient that the works are made available to the public<sup>125</sup>, meaning that the public do not need actually access to that work or even being aware of that opportunity<sup>126</sup>.

On the other hand, the mere provision of physical facilities or technical means to enable the communication does not constitute an act of communication. Still, if this provision of technical facilities distributes a signal and provides public access to works, it is considered an act of communication<sup>127</sup>.

Finally, in order to conclude that an act of communication has occurred, account must be taken of the indispensable role played by the user and the deliberate nature of his/her intervention<sup>128</sup>. Users make an act of communication when they intervene, in full knowledge of the consequences of their action, to give access to a work, particularly where, in the absence of that intervention, the members of the public would not be able to enjoy the work, or would be able to do so only with difficulty<sup>129</sup>.

(ii) Secondly, the act of communication should be directed ‘to a public’. The CJEU has broadly elaborated upon the concept of public and held that this requirement encompasses ‘an indeterminate number of potential recipients’ which should be constituted of a ‘fairly large number of persons’<sup>130</sup>. This concept thus entails a certain de minimis threshold, which excludes groups of persons which are too small, or insignificant. Yet, in order to determine that number, account has to be taken of the cumulative effects of making works available to potential audiences (i.e. not only the number of

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<sup>119</sup> *Stichting Brein v Ziggo (C-610/15) EU:C:2017:456*.

<sup>120</sup> *Janssens and Michaux (n 44) 401*.

<sup>121</sup> *ibid.*

<sup>122</sup> *Football Association Premier League v QC Leisure (C-403/08) EU:C:2011:631, para196*;; *Reha Training v Gema (C-117/15) EU:C:2016:379, paras 54 to 55*; *OSA v Léčebné lázně Mariánské Lázně a.s (C-351/12) EU:C:2014:110, para26*;; *SPA v Ministerio Publico (C-151/15) EU:C:2015:468, paras 14 to 15*;

<sup>123</sup> *Stichting Brein v Ziggo (C-610/15) EU:C:2017:456, (n 119)*.

<sup>124</sup> *Janssens and Michaux (n 44) 402*.

<sup>125</sup> *Lindner and Shapiro (n 91) 56*.

<sup>126</sup> *Stichting Brein v Filmspeler (C-527/ 15) EU:C:2017:300, para36*; *Lindner and Shapiro (n 72) 57*.

<sup>127</sup> *Sociedad General de Autores y Editores de España (SGAE) v Rafael Hoteles SA (C-306/05) EU:C:2006:764 para 46*.

<sup>128</sup> *Stichting Brein v Filmspeler (C-527/ 15) EU:C:2017:300, para.36 (n 127)*.

<sup>129</sup> *Stichting Brein v Ziggo (C-610/15) EU:C:2017:456, (n 87)*; *Stichting Brein v Filmspeler (C-527/ 15) EU:C:2017:300, para.31; (n 92)*.

<sup>130</sup> *Stichting Brein v Ziggo (C-610/15) EU:C:2017:456, (n 119)*.

persons who have access at the same time, but also the number of persons who have access to it successively).

A particular (and criticized) feature of the CJEU case law is that it has added an additional requirement in the sense that the communication should be directed either through the use of new/different technical means<sup>131</sup>, or to a ‘new public’, i.e. a public that has not already been taken into account by the copyright holders when they authorised the initial communication of their works to the public<sup>132</sup>.

In parallel to the cumulative conditions, the CJEU refers to other complementary conditions, either as a stand-alone third condition or as an integral part of a cumulative criteria. Those criteria – including economic benefit and knowledge of the infringing act – may, in different situations, be present to widely varying degrees and should be examined on a case by case basis<sup>133</sup>.

To be complete, it should be added that the right of communication to the public has been given a particular interpretation in the context of **linking and hyperlinking** to copyrighted works on the internet. Here, the notion of ‘new public’ plays a primary role. In this context, the CJEU held that hyperlinking to protected works constitutes an act of communication to the public and of making available to the public. However, there is no need to require authorization of the rightholder when the link refers to content that is already freely available on the internet and thus not addressed to a new public<sup>134</sup>. Yet, this conclusion will not apply where a link allows to circumvent restrictions put in place by the site on which the protected work appears in order to restrict public access to that work to the latter site’s subscribers only or where a link allows to access the work while it is no longer available to the public on the site on which it was initially communicated<sup>135</sup>. Also, where links are provided with the pursuit of financial gain by a person, the latter is presumed to know the possible illegal nature of the publication of those works on that other website, and will be held liable for copyright infringement<sup>136</sup>.

#### 4.1.2 Practical implications for CHIs

The right of reproduction, distribution and communication to the public have different implications for CHIs, as follows:

##### Right of reproduction

CHIs will regularly be forced to make reproductions in order to fulfil their duties of preservation and dissemination of cultural and historical heritage, including in digital format.

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<sup>131</sup> *ITV Broadcasting Ltd and Others v TVCatchUp Ltd*, (C-607/11), ECLI:EU:C:2013:147.

<sup>132</sup> *Sociedad General de Autores y Editores de España (SGAE) v Rafael Hoteles SA* (C-306/05) EU:C:2006:764 and in many subsequent cases.

<sup>133</sup> See e.g. *Reha Training v Gema* (C-117/15) EU:C:2016:379; *Stichting Brein v Ziggo* (C-610/15) EU:C:2017:456; *GS Media v Sanoma Media* (C-160/15) EU:C:2016:644.

<sup>134</sup> *Svensson v Retriever Sverige* (C-466/12) EU:C:2014:76.

<sup>135</sup> *ibid.*

<sup>136</sup> *GS Media v Sanoma Media* (C-160/15) EU:C:2016:644.

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For instance, CHIs make reproductions of original works because they ‘have been damaged, lost or stolen’<sup>137</sup> as Guibault says, or there is a risk to have their works damaged, lost or stolen. Nowadays, making digital copies of works in the collections of CHIs is a common practice within these institutions for preservation or archiving purposes. Yet, such digitization requires the making of reproductions and duplications of the content<sup>138</sup>. The relevance of the right of reproduction is especially prominent in mass-digitization processes as these processes require ‘a bulk copying of copyrighted works’<sup>139</sup>. In addition, making digital copies, and thus acts of reproduction will occur in libraries when deploying their collections online for downloading purposes<sup>140</sup>.

**Right of distribution**

In comparison to the two other exclusive rights, the right of distribution may be of less relevance to CHIs (and therefore it will not be further discussed) but should not be neglected either. Infringement of the right of distribution may occur in combination with the right of reproduction, e.g. when selling unauthorised copies of works of art. CHIs could also infringe the right of distribution if posters or postcards are sold without the authorization of the rightholder. The CHI could still infringe the right of distribution even if such objects were bought from a third party ignoring the circumstances of the lack of authorization from the rightholder.

**Right of communication to the public**

The right of communication to the public is of particular importance for CHIs that want to deploy their activities in an online environment, which is a general phenomenon today<sup>141</sup>.

**CHIs that intend to make protected works available to the public for which they do not own the copyright will need to seek the authorization of the relevant rightholders.**

The reproduction right and the act of communication to the public are inherently connected between themselves in the digital environment. For instance, both rights may be found within certain activities in which CHIs are involved: making their content available to the public generates automatically the reproduction of digital copies (except for digitally born content), whether they are temporary or permanent.

If the proper rights clearance has been secured, CHIs nor end-users will incur liability for the inherent reproduction that will – because of technical necessity – take place each time a work is accessed

<sup>137</sup> Lucie Guibault and Jean-François Canat, ‘WIPO Study on Exceptions and Limitations in Museums’ 18.

<sup>138</sup> Weber and Chrobak (n 5) 19.

<sup>139</sup> Maurizio Borghi and Karapapa Stavroula, *Copyright and Mass Digitization: A Cross-Jurisdictional Perspective* (Oxford, England : Oxford University Press, 2013).

<sup>140</sup> R Tryggvadottir, *European Libraries and the Internet: Copyright and Extended Collective Licences* (Mortsel : Intersentia 2018).

<sup>141</sup> Weber and Chrobak (n 5) 2.

(consultation and viewing/browsing)<sup>142</sup> (see Section 4.1.3.1). Linking to these legally-made available works by institutions such as Europeana or other CHIs would not require (an additional) authorization of the rightholder as it may be assumed that they have been made available on the internet with the consent of the rightholder<sup>143</sup>.

The right of communication to the public remains of course also applicable in the offline world, e.g. for the exhibition of works by cultural institutions. In this case, if the CHI is not the copyright owner, it will need the prior authorization of the rightholder as well<sup>144</sup>.

All the above situations for requesting permission will not apply in cases where a CHI can rely on one of the exceptions discussed in the following section. However, it must be pointed out already that there are not that many situations that could exempt a CHI from asking for consent for activities in an interactive digital online environment.

### 4.1.3 Exceptions and limitations

Restrictions to copyright in the form of exceptions and limitations to copyright system exist from the 'earliest times in the history of copyright'<sup>145</sup>. Furthermore, there is no practical difference between the term 'limitation' or 'exception' which will be used interchangeably in this deliverable. Due to the lack of an international definition<sup>146</sup>, the meaning and utilization of one or another term depends on the specific jurisdiction.

The copyright system has always sought to maintain an appropriate balance between, on the one hand, ensuring exclusive rights for rightholders and, on the other hand, the public interest (e.g. in relation to freedom of expression or the right to information). This balance is achieved by permitting legislators to introduce exceptions to the exclusive rights that allow, in certain circumstances, for the use of protected material without the prior authorisation of the owner of the copyright<sup>147</sup>.

This is recognized at the international level between the contracting parties in the WCT where, in its preamble, the Treaty 'recognizes the need to maintain a balance between the rights of authors and the larger public interest, particularly education, research and access to information, as reflected in the Berne Convention'<sup>148</sup>.

There are, nevertheless, only few exceptions and limitations that have been recognized at the international level. The Berne Convention envisages only six exceptions in its provisions which were the result of long compromises<sup>149</sup>. They include the exceptions for teaching activities, for quotation

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<sup>142</sup> *Public Relations Consultants Association Ltd v Newspaper Licensing Agency Ltd and Others (C-360/13)EU:C:2014.*

<sup>143</sup> Tryggvadottir (n 140).

<sup>144</sup> Guibault and Canat (n 10).

<sup>145</sup> Sterling (n 67) 518.

<sup>146</sup> *ibid.*

<sup>147</sup> Janssens and Michaux (n 44) 399.

<sup>148</sup> The WIPO Copyright Treaty Preamble.

<sup>149</sup> Guibault and Canat (n 10).

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and for public speeches. The quotation exception is the only mandatory exception in the Berne Convention. All the other exceptions have an optional character for the members of the Convention<sup>150</sup>.

Hence, it is in this context that the Infosoc Directive has become a cornerstone in the EU copyright legislation because it has addressed in a horizontal way a harmonised system of exceptions and limitations in the Member States. Even though the system has many imperfections, mainly due to its almost entirely optional nature, it has nevertheless been able to mitigate the high fragmentation of exceptions among EU countries that existed at that time.

The relevant **Article 5 of the Infosoc Directive** lays down a general framework in the form of a long *exhaustive list of mostly optional exceptions* that the Member States may provide in their national copyright acts. Adding or maintaining exceptions that are not included in Article 5 is not allowed, but Member States are given some leeway to decide whether and how to implement the different optional provisions as well as with regards to the organisation of a remuneration system in relation to all or to some exceptions<sup>151</sup>. Some of the exceptions add the obligation for Member States to introduce, in case such exception is implemented at national level, a fair compensation scheme for rightholders.

The choice of the legislator for a closed list of exceptions and limitations has been – and continues to be – heavily criticized. Most critics consider that this choice has constrained the development of new exceptions or the update of existing exceptions preventing them from adapting to needs entailed by new technologies. Furthermore, the choice of optional exceptions continues to lead to disparities in the implementation of exceptions within the Member States. This is particularly problematic for the cross-border dimension of their application, which is an inherent feature of internet use<sup>152</sup>. The lack of legal certainty about potential infringement in some Member States may frustrate end-users, service providers and other intermediaries and is therefore problematic for the development of new online platforms and services<sup>153</sup>.

When applying exceptions and limitations, the CJEU has repeatedly stated that they must be interpreted strictly<sup>154</sup> even though at some occasions this court also allowed for ‘a doctrine based on ensuring the effectiveness of exceptions (...) which seems to counter the restrictive interpretation of exceptions’<sup>155</sup>.

As a final point, it must be highlighted that the exceptions enumerated in Article 5 of the Infosoc Directive have not been conferred an imperative nature and, hence, can be overridden by contractual agreements unless the national legislator has precluded such a possibility<sup>156</sup>.

Article 5 presents a transparent structure with five different alineaas. They successively set out one mandatory exception (Article 5(1)), four optional exceptions to the reproduction right (Article 5(2)), fifteen optional exceptions to the rights of reproduction and/or public communication (Article 5(3))

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<sup>150</sup> The Berne Convention art. 10 and 11.

<sup>151</sup> Janssens and Michaux (n 44) 399.

<sup>152</sup> *ibid.*

<sup>153</sup> *ibid.* 400.

<sup>154</sup> *Infopaq International A/S v Danske Dagblades Forening (C-5/08) EU:C:2009:465* (n 57).

<sup>155</sup> Lindner and Shapiro (n 91) 81.

<sup>156</sup> Janssens and Michaux (n 44) 400.

and the possibility to apply all previously listed exceptions to the distribution right (Article 5(4)). Article 5(5) finally reiterates the general obligation that all exceptions should conform to the three-step test to determine their legitimacy.

All the exceptions will not be discussed in detail as this Study will only focus on the ones with relevance for the InDICES project.

#### 4.1.3.1 *Mandatory exception of temporary reproductions*

Article 5(1) of the Directive contains the **only mandatory exception**. It relates to the transient acts of reproduction carried out by internet service providers that occur when copyrighted content is transmitted by electronic means through a network<sup>157</sup>. To be exempted from the rightholder's authorization, these particular acts of reproduction must fulfil in a cumulative way, strict conditions. Rightholders cannot oppose the making of reproductions on the condition that they are (1) temporary, (2) as well as transient or incidental in nature, and (3) form an integral and essential part of a technological process, (4) the sole purpose being to enable either a transmission in a network between third parties by an intermediary, or a lawful use of a work or other subject-matter to be made, and (5) which have no independent economic significance. The CJEU has provided clarification on these different conditions which will not be summarized here because of its technical nature<sup>158</sup>.

It is important to understand that this exception aims at allowing network communication and consultation which inherently requires short-term reproductions that occur several times during the communication process onto the internal memory (so-called 'RAM') of a computer, in routers and proxy servers or comparable technical tools. The exception seeks to allow many of these transient reproductions which are essential for the working of the Internet. End-users are often not even aware that when they access content online, e.g. works made available by CHIs, they perform such technologically necessary – yet copyright relevant – acts of reproduction.

#### 4.1.3.2 *Non-mandatory exceptions and limitations applicable to CHIs*

From the list of exceptions in Articles 5(2) and 5(3) only those with a particular relevance for the activities of CHIs will be discussed below. A comparative analysis of the implementation of these exceptions in the Member States will be provided in the next deliverable.

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<sup>157</sup> Sterling (n 67) 1067.

<sup>158</sup> See cases *Infopaq International A/S v Danske Dagblades Forening* ("Infopaq I") (Case C-5/08) EU:C:2009:465; *Infopaq International A/S v Danske Dagblades Forening* ("Infopaq II") (Case C-302/10) EU:C:2012:16; *Football Association Premier League Ltd and Others v QC Leisure and Others and Karen Murphy v Media Protection Services Ltd* ("Premier League") (Joint Cases C-403/08 and C-429/08) EU:C:2011:631; and *Public Relations Consultants Association Ltd v Newspaper Licensing Agency Ltd and Others* ("PRC") (Case C-360/13) EU:C:2014:1195.

The most relevant exceptions for CHIs are the following:  
Use of protected content without prior authorisation is allowed

- ⇒ For preservation purposes;
- ⇒ For research or private study in dedicated terminals;
- ⇒ For advertising exhibition or sale of works.

A further analysis of the following exceptions is provided under Section 4.1.6:

- The **exception for reproduction for preservation purposes by CHIs**: ‘in respect of specific acts of reproduction made by publicly accessible libraries, educational establishments or museums, or by archives, which are not for direct or indirect economic or commercial advantage’<sup>159</sup>.
- The **exception for making available for research or private study by dedicated terminals**: ‘use by communication or making available, for the purpose of research or private study, to individual members of the public by dedicated terminals on the premises of establishments referred to in paragraph 2(c) of works and other subject-matter not subject to purchase or licensing terms which are contained in their collections’<sup>160</sup>.
- The exception **‘for the purpose of advertising the public exhibition or sale of artistic works**, to the extent necessary to promote the event, excluding any other commercial use’<sup>161</sup> under Article 5(3)(j).
- The exception for ‘uses, for the **benefit of people with a disability**, which are directly related to the disability and of a non-commercial nature, to the extent required by the specific disability’ (Article 5 (3)(b))<sup>162</sup>.

Some other exceptions may, in an indirect way, be of interest for uses by CHIs and/or their end-users:

➡ The exception for **reprographic uses** is included in Article 5 (2)(a) and allows for ‘reproductions on paper or any similar medium, effected by the use of any kind of photographic technique or by some other process having similar effects, with the exception of sheet music, provided that the rightholders receive fair compensation’<sup>163</sup>. This exception does not apply in the digital world as it only relates to reproductions on paper.

➡ The right of reproduction of rightholders may be also limited ‘in respect of **ephemeral recordings** of works made by broadcasting organisations by means of their own facilities and for their own broadcasts; the preservation of these recordings in official archives may, on the grounds of their exceptional documentary character, be permitted’<sup>164</sup>. This exception is mainly addressed to broadcasting organisations facilitating their work when broadcasting recordings without the

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<sup>159</sup> The Infosoc Directive art 5(2)(c).

<sup>160</sup> *ibid* art 5(3)(n).

<sup>161</sup> *ibid* art 5(3)(j).

<sup>162</sup> *ibid*.

<sup>163</sup> *ibid* art 5 (2)(a).

<sup>164</sup> *ibid* art 5 (2)(d).

rightholder's consent (e.g. under an exception) allowing them to make the reproductions needed. In this sense, CHIs are not that much affected by this exception. Nevertheless, the second part of the provision could have a certain impact on archives given that ephemeral recordings are allowed for preservation purposes without rightholders' consent as long as they have an 'exceptional documentary character'. These recordings can only be made by official archives. In principle, official archives are only operated by public broadcasting organizations and are not allowed to perform any further use with the recordings<sup>165</sup>.

➔ The **private copying exception** laid down in Article 5(2)(b) allows for the making of 'reproductions on any medium made by a natural person for private use and for ends that are neither directly nor indirectly commercial, on condition that the rightholders receive fair compensation which takes account of the application or non-application of technological measures referred to in Article 6 to the work or subject-matter concerned'<sup>166</sup>. It must be noted that this exception only affects the exclusive reproduction right. Similar to other exceptions, the private use exception is optional. Hence, it is for the Member States to decide whether to implement it at national level. If Member States decide to introduce this exception in their jurisdictions, a fair compensation system must be put in place respecting the guidelines given by the CJEU<sup>167</sup>.

Interestingly, in an online environment, this exception will be for the most part relevant for acts of downloading as the making available of materials on the internet, i.e. uploading, would trigger the application of the right of communication to the public that is not exempted under this exception<sup>168</sup>.

#### 4.1.4 Technical protection measures

Technical protection measures have been mainly envisaged to protect rightholders in their **fight against unauthorized uses** of protected content<sup>169</sup>.

The internet and the development of new technologies have led to new modes of exploitation of protected works in the digital environment in contradiction to traditional modes of exploitation, which are based on the manufacturing and the sale of duplicated copies monitored by the rightholder. In light of the new technological advancements, this situation provoked several concerns among rightholders who feared that digital reproduction would widespread the copying of their content without their consent, specially by private users<sup>170</sup>. In consequence, for the sake of protection of their works in the digital era, copyright owners have been searching and conceiving technological measures

<sup>165</sup> P Bernt Hugenholtz and Thomas Dreier (eds), *Concise European Copyright Law* (2nd ed., Alphen aan den Rijn : Kluwer law international, 2016).

<sup>166</sup> The Infosoc Directive art 5 (2)(b).

<sup>167</sup> *Padawan SL v Sociedad General de Autores y Editores de España (SGAE)* (C-467/08) EU:C:2010:620;

<sup>168</sup> Janssens and Michaux (n 44) 409.

<sup>169</sup> Sterling (n 67) 1071.

<sup>170</sup> Bently and Sherman (n 25) 272.

to have a higher degree of control over their uses of their works. Two types of tools should be distinguished.

### (1) Technical protection measures (TPMs)

Article 6 of the Infosoc Directive requires – in line with the above-mentioned WIPO Treaties<sup>171</sup> – that Member States provide adequate legal protection against the circumvention of any technological measure. Protected ‘technological protection measure’ are defined as ‘any technology, device or component that, in the normal course of its operation, is designed to prevent or restrict acts, in respect of works or other subject-matter, which are not authorized by the rightholder of any copyright or any right related to copyright as provided for by law or the sui generis right’<sup>172</sup>.

There is a high heterogeneity of TPMs. TPMs could entail techniques for preventing access to the works, like encryption or other access controls, in which only the legitimate person with a certain key or code could obtain access, or for blocking the possibility of coping the work(s). In this case scenario, the system allows the user to work accordingly but it prevents the user from making copies of the work<sup>173</sup>. The original expectations that rightholders would henceforth mainly make available ‘secured’ works, was however not fully realized in practice.

In brief, the system of protection established by the Directive provides a **two-tier protection for TPMs**<sup>174</sup>. Firstly, the Directive sets, under paragraph 1, a prohibition for the ‘act of circumvention’ as such. However, in order for a person to be liable for circumventing TPMs, the person must ‘have reasonable grounds to know that he or she is pursuing that objective’<sup>175</sup>. Hence, the Directive prohibits any act of circumvention by any person who knows that is actually committing an act of circumvention. Secondly, the Directive goes a step further and extends the legal protection to TPMs to a number of preparatory acts of circumvention<sup>176</sup> like the sale, rental or distribution of technical devices especially designed to circumvent TPMs. Further specifications are needed for these acts to be prohibited, according to the Directive. For example, these products or services need to be advertised for the purpose of the circumvention or must ‘have only a limited commercially significant purpose or use other than to circumvent’<sup>177</sup>.

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<sup>171</sup> The WIPO Copyright Treaty; World Intellectual Property Organization Performances and Phonograms Treaty (1996 December 20).

<sup>172</sup> The Infosoc Directive art 6 (3).

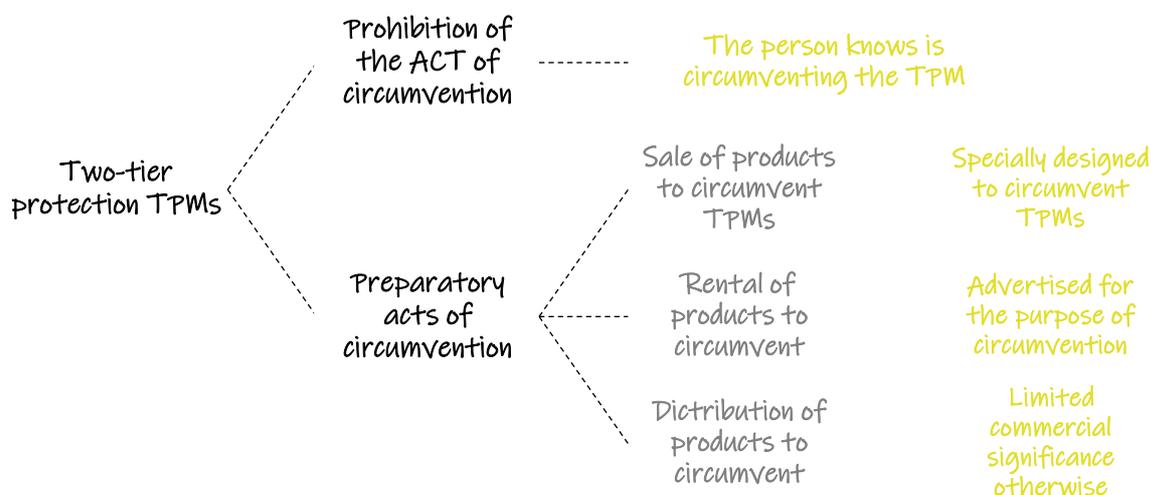
<sup>173</sup> Bently and Sherman (n 25) 318.

<sup>174</sup> Janssens and Michaux (n 44) 420.

<sup>175</sup> The Infosoc Directive art 6 (1).

<sup>176</sup> Lindner and Shapiro (n 91) 102.

<sup>177</sup> The Infosoc Directive art 6 (2).



To obtain the above-mentioned legal protection, TPMS must be ‘effective’. This means that the copyright owner needs to control the access or the protection processes of the TPMS through the technologies mentioned above. In addition, TPMS must be proportionate, which means that they may not go beyond the objective of preventing the acts not authorised by the right owner<sup>178</sup>.

It must be pointed out that the **relation between TPMS and the application of exceptions and limitations** has been complicated since the beginning<sup>179</sup>. More specifically, the application of TPMS may pose specific problems for uses of works that could be permitted under a certain exception without the rightholder authorization. Thus, beneficiaries that could rely on such exception to make use of a protected work, could have difficulties when there are TPMS in place preventing them from benefiting from such exception<sup>180</sup>. In order to solve the clash between TPMS and copyright exceptions, the Directive sets a complex mechanism. The European legislator has worked out a sophisticated construction in Article 6(4) which, however, made matters rather intricate for national legislators, copyright holders and users. Instead of the legislator, rightholders have been entrusted with the ‘task’ to provide the necessary measures to make material available if needed for the exercise of an exception<sup>181</sup>.

In this regard, application of TPMS in the works of CHIs and the use of exceptions entail also certain difficulties. On the one hand, the use of TPMS when CHIs deploy their collection online certainly increases the protection against unauthorized uses. For instance, some of CHIs create the so-called ‘master copies’ of their content, which are normally protected by TPMS as CHIs prefer to protect these files. This may also create a problem for digital preservation purposes.

On the other hand, the use of TPMS may render difficult for museums, libraries and archives to rely on exceptions to fulfil their promotion of culture and knowledge mandate. In the case of libraries, copyright owners could require libraries through contractual agreements to put TPMS in place to

<sup>178</sup> Janssens and Michaux (n 44) 420.

<sup>179</sup> Lindner and Shapiro (n 91) 110.

<sup>180</sup> Sterling (n 67) 1072.

<sup>181</sup> Janssens and Michaux (n 44) 420.

prevent unauthorized uses made by the end-users. In addition, the use of TPMs could prevent users to make use of the works that could be allowed under an exception, e.g. research and study or private use<sup>182</sup>.

## (2) Electronic rights management information (RMI)

Article 7 of the Directive sets an obligation for Member States to protect the electronic rights management information which is to be understood as all the information provided by the rightholder that determines certain characteristics of the work like the authors, the copyright owner or the terms and conditions for the uses of the work. This elementary information gives the user crucial information about the work and its permitted uses with respect to the licensed material<sup>183</sup>. The protection of RMI is also needed 'to prevent the removal of various identifying insignia from works'<sup>184</sup>.

### 4.1.5 The three-step test

The Infosoc Directive includes in Article 5(5) the so-called three-step test. This test emerged at international level for the first time in the Berne Convention (Article 9 (2)) and has been included in successive international conventions<sup>185</sup>.

The three-step test provides that all **exceptions and limitations** 'shall **only be applied** in (i) **certain special cases** (ii) which **do not conflict with a normal exploitation of the work** or other subject-matter and (iii) **do not unreasonably prejudice the legitimate interests** of the rights-holder'<sup>186</sup>.

The three-step test is a standard that ensures a balanced application of the exceptions, taking into account the interests of the rights-holders<sup>187</sup>. Such balance must 'reflect the increased economic impact that such exceptions and limitations may have in the context of the new electronic environment'<sup>188</sup> reflecting the legislator's reliance on economic considerations<sup>189</sup>.

<sup>182</sup> Mark Jordan, *Putting Content Online: A Practical Guide for Libraries* (Oxford : Chandos, 2006).

<sup>183</sup> Lucie Guibault, 'Evaluating Directive 2001/29/EC in the Light of the Digital Public Domain' in Melanie Dulong de Rosnay and Juan Carlos De Martin (eds), *The Digital Public Domain*, vol 2 (1st edn, Open Book Publishers 2012).

<sup>184</sup> Bently and Sherman (n 25) 328.

<sup>185</sup> The TRIPS Agreement; The WIPO Copyright Treaty; World Intellectual Property Organization Performances and Phonograms Treaty (1996 December 20); World Intellectual Property Organization Marrakesh Treaty to Facilitate Access to Published Works for Persons Who Are Blind, Visually Impaired, or Otherwise Print Disabled (2013).

<sup>186</sup> The Infosoc Directive art 5 (5).

<sup>187</sup> Janssens and Michaux (n 44) 401.

<sup>188</sup> The Infosoc Directive rec 44.

<sup>189</sup> Guido Westkamp, 'The "Three-Step Test" and Copyright Limitations in Europe: European Copyright Law between Approximation and National Decision Making' (2008) 56 *Journal of the Copyright Society of the U.S.A.* 1.

Given that there is no clear interpretation of the meaning of ‘a normal exploitation of the work or other subject-matter’ and of the concept of ‘unreasonably prejudice’, these three conditions have been subject to an extensive research at national and international level. Briefly, it could be said that an exception does not conflict with the normal exploitation of the work when it does not interfere with the ‘potential or actual uses or modes of extracting value from a work’<sup>190</sup>; and that it does not unreasonably prejudice the legitimate interests of the author when ‘the prejudice to the author’s interests is proportionate to the objectives underlying the limitation’<sup>191</sup>. In addition, when applying the three-step test, the three conditions of the test should be ‘considered together and as a whole in a comprehensive overall assessment’<sup>192</sup>.

Fearing that the three-step test would imply further restrictions on the application of exceptions and limitations, the CJEU understands the test as an enabling clause to counteract an excessive application of an exception<sup>193</sup>.

#### 4.1.6 Exceptions and limitations most relevant for CHIs and their practical implications

Exceptions and limitations to copyright applying to libraries, museums or archives is rooted in the **public interest of promoting access to culture and knowledge**<sup>194</sup>.

Exceptions in the Infosoc Directive in combination with other exceptions included in other EU legislative acts (the Orphan Works Directive (analysed in Chapter 4.3) and the new CDSM Directive, which will be subject of the Study in Chapter 4.5, among others, compose the European exceptions regime.

We will hereafter analyse the exceptions included in Article 5 of the Infosoc Directive that may be of particular importance for CHIs. Some other exceptions and limitations that could have certain relevance for CHIs and for users using the works in their collections are analysed in Section 4.1.3.2 above.

➔ The most relevant exception for CHIs included in the Infosoc Directive is the so-called **preservation exception** provided in Article 5(2)(c) which allows for ‘specific acts of

<sup>190</sup> Lucie Guibault, Guido Westkamp and Thomas Rieber-Mohn, ‘Study on the Implementation and Effect in Member States’ Laws of Directive 2001/29/EC on the Harmonisation of Certain Aspects of Copyright and Related Rights in the Information Society’ (Social Science Research Network 2012) SSRN Scholarly Paper ID 2006358 <<https://papers.ssrn.com/abstract=2006358>>.

<sup>191</sup> *ibid.*

<sup>192</sup> Christophe Geiger, ‘Towards a Balanced Interpretation of the “Three-Step Test” in Copyright Law’ (2008) 30 European Intellectual Property Review 489.

<sup>193</sup> Janssens and Michaux (n 44) 401.

<sup>194</sup> Guibault, Westkamp and Rieber-Mohn (n 190).

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reproduction made by publicly accessible libraries, educational establishments or museums, or by archives, which are not for direct or indirect economic or commercial advantage'<sup>195</sup>.

Although the Directive does not specify which 'specific acts' of reproduction are allowed, it is generally accepted that they relate to those acts for preserving and archiving collections, even if further uses cannot be automatically excluded<sup>196</sup>.

Clearly, reproduction acts needed to digitize works in the collections fall within the scope of this exception. On the other hand, by allowing only for 'specific acts' the exception cannot justify to digitize the whole collection<sup>197</sup> as the CJEU established in Darmstadt case<sup>198</sup>. Clearly, the current exception does not solve all legal issues concerning (mass)digitization of collections entailing legal uncertainty for CHIs.

Importantly, the enumeration of beneficiaries is to be understood in an exhaustive manner. They relevant institutions should also be publicly accessible, with the exception of archives. It is also generally agreed that the beneficiaries of the exception should be non-profit organizations, excluding from the exception company libraries or private initiatives. However, this does not mean that beneficiary institutions may not charge access fees.

Due to the optional character of this exception, its scope and conditions of application varies considerably amongst the different Member States. For instance, some Member States only allow reproductions in analogue form while other countries allow reproductions in digital form as well. Additionally, some Member States provide limitations to the type of works that could be reproduced or even to the type of beneficiaries of the exception<sup>199</sup>. These different approaches in the Member States with regard to acts of reproduction for preservation by CHIs hampers cross-border cooperation, the sharing of means of preservation and the establishment of cross-border preservation networks in the internal market by such institutions, leading to an inefficient use of resources<sup>200</sup>. Because of the resulting a negative impact on the preservation of cultural heritage, the European legislator has complemented this exception with a new mandatory exception in the new CDSM Directive which will be analyzed below in Section 4.5.

➔ Second, with respect to making content available, Article 5(3)(n) provides for an **exception for making available protected content for research or private study by dedicated terminals**: 'use by communication or making available, for the purpose of research or private study, to individual members of the public by dedicated terminals on the premises of establishments referred to in paragraph 2(c) of works and other subject-matter not subject to purchase or licensing terms which are contained in their collections'<sup>201</sup>. This exception is narrowly drafted,

<sup>195</sup> The Infosoc Directive art 5 (2)(c).

<sup>196</sup> Tryggvadottir (n 140).

<sup>197</sup> Guibault and Canat (n 10) 23.

<sup>198</sup> *Technische Universität Darmstadt v Eugen Ulmer KG (C-117/13) EU:C:2014:2196 para 49.*

<sup>199</sup> Guibault, 'Evaluating Directive 2001/29/EC in the Light of the Digital Public Domain' (n 183).

<sup>200</sup> The CDSM Directive rec 26.

<sup>201</sup> The Infosoc Directive art 5(3)(n).

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as access to works can only occur through dedicated terminals of ‘publicly accessible libraries, educational establishments or museums, or by archives’. Furthermore, it only covers those works that are not subject to a commercial license and only for research and private study purposes.

In the absence of a definition for ‘research and private study’, this condition needs to be interpreted narrower than the concept of ‘private use’<sup>202</sup>. Moreover, the fact that individuals of the public can only get access to content through dedicated terminals precludes that individuals access such content via electronic or other protected network connections<sup>203</sup>. Finally, application of this exception can be overridden by contract which further narrows down its scope in practice.

➔ Third, Article 5(3)(j) of the Infosoc Directive includes an exception to the right of reproduction and communication to the public **‘for the purpose of advertising the public exhibition or sale of artistic works**, to the extent necessary to promote the event, excluding any other commercial use’<sup>204</sup>. This exception, whose scope is not crystal clear<sup>205</sup>, allows beneficiaries to use copies of a work without the rightsholder’s authorization in order to advertise an exhibition or a sale of a work. For instance, taking a photograph of the work in question and including it in a catalogue would not infringe copyright if it is sold in connection with the exhibition. However, copyright infringement may occur if a photograph of the work would be sold in the ‘general book trade’<sup>206</sup>. Furthermore, subsequent uses, such as the sale of further copies, are not covered by this exception<sup>207</sup>.

➔ The Infosoc Directive permits Member States to introduce exceptions at national level for those ‘uses, for the **benefit of people with a disability**, which are directly related to the disability and of a non-commercial nature, to the extent required by the specific disability’ (Article 5 (3)(b))<sup>208</sup>.

This exception allows in a general manner that acts of reproduction and/or communication are performed with the aim to facilitate access to protected content to physically or mentally impaired persons in accessible formats.

In view of their public interest role, CHI, play an essential role in this area. This exception allows libraries, museums and archives to legally produce works in accessible format, such as material in braille or sound recordings for people that are not physically able to access a cultural institution or a work.

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<sup>202</sup> Tryggvadottir (n 140).

<sup>203</sup> Guibault, Westkamp and Rieber-Mohn (n 190).

<sup>204</sup> The Infosoc Directive art 5(3)(j).

<sup>205</sup> Guibault and Canat (n 10).

<sup>206</sup> Hugenholtz and Dreier (n 165).

<sup>207</sup> Bently and Sherman (n 25) 228.

<sup>208</sup> The Infosoc Directive art 5(3)(b).

According to Rosati, the Directive does not impose any limitation by category of disability or by any type of works<sup>209</sup>. Nevertheless, although all Member States have implemented this exception within their jurisdictions, considerable fragmentation remains. Divergences occur as regards the type of disability, the rights falling within the scope of the exception or the nature of the provision (fair compensation or gratuitous)<sup>210</sup>.

Reliance on these exceptions by cultural institutions means that CHIs do not need to seek authorization of the rightholder for the legal use of third-party works. Yet, the lack of harmonization has created a situation of legal uncertainty for CHIs, and especially for those ones that operate in a cross-border environment. This situation has thus created obstacles for CHIs to fully benefit from the Digital Single Market.

A comparative analysis of the implementation of exceptions and limitations in national jurisdictions – and the different scopes of application – will be analysed in the next deliverable.

## 4.2 The Database Directive

Although databases have existed in different forms for long time, digital technology has ‘transformed and revitalized databases’<sup>211</sup>. Now, digital databases provide access to huge collections of information whose creation entails high economic costs. However, databases can be easily copied. In order to protect this investment and to harmonize the different protection regimes existing within EU countries, the EU legislator decided to adopt a European instrument for their protection.

In consequence, next to the general legislative framework envisaged for copyright, the EU legislator adopted in 1996 Directive 96/9 on the legal protection of databases<sup>212</sup>.

In the EU databases may be protected by a **‘two-tier’ system**– a **copyright protection** and/or a **‘sui generis’ right**.

An understanding of the protection of databases is relevant for CHIs as they have a strong interest nowadays for building digital archives for the purposes of preservation in the long term and for further dissemination of their collections. Preservation and digitization of collections by CHIs normally imply the creation of databases containing information about each work included in the collections (which in itself may already constitute a database). In addition, the creation of databases for CHIs can also be

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<sup>209</sup> Eleonora Rosati, ‘Copyright in the EU: In Search of (in)Flexibilities’ (2014) 9 *Journal of Intellectual Property Law & Practice* 585, 19.

<sup>210</sup> Caterina Sganga, ‘Disability, Right to Culture and Copyright: Which Regulatory Option?’ (2015) 29 *International Review of Law, Computers & Technology* 88.

<sup>211</sup> Bently and Sherman (n 25) 310.

<sup>212</sup> The Database Directive.

used for the promotion of their cultural heritage and these uses may be subject to contractual agreements with copyright owners<sup>213</sup>.

### 4.2.1 Copyright protection

At international level, the TRIPs Agreement and the WCT provide that compilations of data (databases) which by reason of the selection or arrangement of their contents constitute intellectual creations, are protected as such by copyright. Both instruments add that this protection does not extend to the data or the material itself and is without prejudice to any copyright subsisting in the data or material contained in the compilation<sup>214</sup>. In other words, the copyright protection relates to the structure of the database, not the content thereof<sup>215</sup>.

A similar approach has been taken by the EU Database Directive which grants copyright protection to those databases that 'by reason of the selection or arrangement of their contents, constitute their author's own intellectual creation, against unauthorised reproduction, communication to the public and distribution'<sup>216</sup>. This protection does not extend to the individual elements of the database but only to the 'structure of the database'<sup>217</sup>. The (by now) fully harmonised originality criterion constitutes thus the threshold for protection, with the nuance that this criterion has to be assessed with respect to the selection and arrangement of the contents of the database (and not the contents as such). In *Football Dataco* the CJEU emphasized that the concepts of 'selection' and of 'arrangements' refer respectively to the selection and the arrangement of data, through which the author of the database gives the database its structure<sup>218</sup>.

Article 4 of the Directive states that the copyright initially belongs to the database author, being 'the natural person or group of natural persons who created the database'. This definition is rather open and leaves certain margin for Member States to designate another rightholder as the author of the database (e.g. in the case of employees). The Directive further includes an enumeration of the exclusive rights that can be exercised vis-à-vis original databases. Only economic rights are mentioned, as moral rights are excluded from the harmonization process in the EU (thus far). These exclusive rights – as provided in Article 5 – more or less mirror the general rights of reproduction, distribution and communication to the public that were discussed in relation with the Infosoc Directive.

The Directive also dictates certain **exceptions and limitations** to the exclusive rights which can be found in Article 6. There is one mandatory exception allowing the lawful user of a database to perform any restricted act which to the extent that it is necessary for the purposes of access to the content of the copyright-protected database and its normal use. Among the optional exceptions, mention should be made to the exceptions of reprography and uses for teaching and scientific research for non-commercial purposes which are explicitly listed. Yet (many) more exceptions may be applicable if they have been traditionally authorized in national copyright law.

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<sup>213</sup> Borissova (n 12).

<sup>214</sup> The WIPO Copyright Treaty art 5; The TRIPs Agreement art 10.

<sup>215</sup> Janssens and Michaux (n 44) 426.

<sup>216</sup> The Database Directive art 3.

<sup>217</sup> Hugenholtz and Dreier (n 165).

<sup>218</sup> Janssens and Michaux (n 44) 427.

It is therefore very likely that CHIs may benefit from the preservation exception (see above Section 4.1.6) to the extent it has been recognized in the copyright act of the Member State concerned.

### 4.2.2 Sui generis right

In Chapter III of the Directive, the EU legislator introduced a novel – there is indeed no international counterpart for it – protection scheme which is referred to as a ‘sui generis right’. First of all, it must be noted that this form of protection is autonomous and may be invoked by non-original as well as original databases<sup>219</sup>. Hence, depending on the type of database, this sui generis right can be cumulated with copyright.

This sui generis right belongs to the producer of a database for the creation of which substantial financial, technical and/or human resources have been invested<sup>220</sup>. The threshold for the sui generis right is that a qualitatively and/or quantitatively substantial investment has been made with regard to obtaining, verifying or presenting specific contents (Article 7). The notion of ‘investment’ refers to resources, regardless of the exact nature thereof, such as efforts, labour or expenses<sup>221</sup>.

Concerning the **term of protection**, the Database Directive establishes that protection under the sui generis right lasts for 15 years from the date of completion of the database. Nevertheless, each time a substantial new investment is made, a new term of protection could arise.

The sui generis right grants rightholders the possibility to oppose to the extraction and/or re-utilization of the whole or substantial part of a database. This particular formulation for the definition of the exclusive rights vested in the maker of the database was motivated by the concern to protect the investment and to allow the rightholder to prevent acts which conflict with a normal exploitation of that database or which unreasonably prejudice its legitimate interests<sup>222</sup>. According to Article 7(2), the notion of ‘extraction’ refers to the ‘permanent or temporary transfer of all or a substantial part of the contents of a database to another medium by any means or in any form’. The concept of “reutilisation” refers to ‘any form of making available to the public all or a substantial part of the contents of a database by the distribution of copies, by renting, by online or other forms of transmission’. The interpretation of what is considered a ‘substantial’ extraction or re-utilization is not defined. As general guidance, the term ‘substantial’ needs to be analysed in combination with the financial, human and technical investment made. Therefore, if the part used by a third party does not negatively affect such investments, there should normally not be an infringement of the sui generis right.

The above means that ‘unsubstantial parts’ – e.g. individual items – of the database can always be extracted and/or re-used by lawful users for any purpose.

Database rights **do not prevent the use of individual items** from a database.

<sup>219</sup> Margoni (n 77).

<sup>220</sup> Hugenholtz and Dreier (n 165).

<sup>221</sup> Janssens and Michaux (n 44) 427.

<sup>222</sup> *ibid* 428.

As a safeguard against misuses, Article 7(5), however adds that the repeated and systematic extraction and/or re-utilization of insubstantial parts of the contents of the database implying acts, may qualify as an infringement.

### 4.2.3 Practical implications of protection of databases for CHIs

Given that **digitization of collections** has become a priority for cultural institutions, the creation of databases of their collections have become an essential part of the digital strategy of CHIs nowadays<sup>223</sup>.

Databases clearly constitute a very important tool for CHIs. They may provide valuable information on the history of the institution and on each particular work of the collection and can be shared online contributing to the dissemination of culture. An essential matter of the creation of databases of cultural content is the heterogeneity of the works included: public domain works or copyrighted-protected content including the so-called orphan works and out-of-commerce works<sup>224</sup>. Orphan works will be studied in the next Chapter.

On the other hand, time passes by and those previously protected works fall in the public domain. Unfortunately, it happens more and more often nowadays that some exclusivity is searched on works that fall in the public domain or that were never qualified for protection. These exclusive rights are sometimes provided through the right on databases (or other IPR)<sup>225</sup>. In effect, copyright or sui generis protection of cultural values and intangible cultural heritage could be obtained through derivative ways such as through database protection.

Works considered as traditional cultural expressions and traditional knowledge have found a certain level of protection through database protection. This potential form of protection has been recognized by the WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore. Within this Committee, the creation of databases has been promoted as a useful tool for a 'defensive protection of traditional knowledge' which could also provide transparency and information on traditional cultural expressions<sup>226</sup>. Further analysis of this protection will follow under the Chapter on public domain works.

Therefore, CHIs should be fully aware of their rights concerning databases since a database may entail works protected by copyright owned by third parties. This situation may prevent CHIs from sharing and providing access to databases for the purposes of research to third parties, including for text and

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<sup>223</sup> Tula Giannini and Jonathan P Bowen (eds), *Museums and Digital Culture, New Perspectives and Research* (Springer Berlin Heidelberg 2019).

<sup>224</sup> Borissova (n 12) 149.

<sup>225</sup> Guibault, 'Intellectual Property and Culture' (n 35) 7.

<sup>226</sup> Mira Burri, 'Cultural Heritage and Intellectual Property' in Francesco Francioni and Ana Vrdoljak (eds), *Forthcoming in The Oxford Handbook of International Cultural Heritage Law* (Oxford : Oxford university press, 2019).

data mining. However, the new CDSM Directive attempts to clarify this situation by providing a mandatory exception for TDM purposes in its Article 3 (see Section 4.5.1.1).

### 4.3 The Orphan Works Directive

An awareness of the importance of the cultural heritage in the digital age has been at the heart of EU's policies for the Information Society since the beginning of this century<sup>227</sup>. The EU Commission has shown a particular interest in the issues of online access to cultural material and its digital preservation. This interest led to, among other things, the Digital Library Initiative in 2005<sup>228</sup>. Many more initiatives were taken, which will not be further discussed in this Section.

The issue of orphan works was identified as one of the key copyright challenges for digital libraries with regard to mass digitisation and online dissemination of the cultural heritage. The Commission therefore suggested to 'create mechanisms to facilitate the use of orphan works'<sup>229</sup> and to 'promote the availability of lists of known orphan works'. In the end, the Directive 2012/28/EU<sup>230</sup> (hereinafter the 'OWD') was published in October 2012 aiming at creating *a legally certain framework* to facilitate the digitisation and dissemination of orphan works in order to aid the large-scale digitization of collections or archives kept by various cultural heritage organisations<sup>231</sup>.

#### 4.3.1 Orphan works definition and scope

**Orphan works** are works such as books, newspaper and magazine articles and films that **are still protected by copyright** but **whose authors** or other rightholders are **not known or cannot be located**.

Different definitions of orphan works have been proposed but, in general, all of them are based 'on an owner-location approach'<sup>232</sup>. This corresponds to the situation in the EU where Article 2 of the OWD imposed the following definition: 'a work or a phonogram shall be considered an orphan work if none of the right holders in that work or phonogram is identified, or, even if one or more of them is

<sup>227</sup> Communication from the Commission to the European Parliament, the Council, the European Economic and Social Committee and the Committee of the Regions "Challenges for the European Information Society beyond 2005" (COM(2004) 575 final, 2004), 6.

<sup>228</sup> The i2010 European Libraries Initiative set out the strategy for the digitisation and preservation of Europe's cultural heritage in digital libraries, highlighting the importance to clarify the copyright status of works and the cost of such clarification, especially for orphan works, in September 2005, see (COM(2005) 465 final.

<sup>229</sup> Commission Recommendation 2006/585/EC of 24 August 2006 on the digitisation and online accessibility of cultural material and digital preservation (2006) OJ L 236.

<sup>230</sup> The Orphan Works Directive.

<sup>231</sup> Marie-Christine Janssens and Ran Tryggvadottir, 'Facilitating Access to Orphan and Out of Commerce Works to Make Europe's Cultural Resources Available to the Broader Public' [2014] SSRN Electronic Journal 6 <<http://www.ssrn.com/abstract=2538097>>.

<sup>232</sup> Giuseppe Colangelo and Irene Lincusso, 'Law versus Technology: Looking for a Solution to the Orphan Works Problem' (2012) 20 International Journal of Law and Information Technology 178.

identified, none is located despite a diligent search for the right holders having been carried out and recorded in accordance with article 3<sup>233</sup>.

Orphan works clearly create obstacles for their potential uses. As the owner cannot be found or located, there is no possibility to obtain the required authorization and most uses would therefore constitute a copyright infringement. As many CHIs have orphan works in their collections, this problem to 'clear rights' is of particular relevance for them.

One of the reasons why there are many 'orphans' in the archives of CHIs is the general principle of non-registration to get the copyright protection. Unlike other IPRs, copyright is based upon the principle of non-recording of the copyrighted works: given that there is no official information about their authors or owners nor of any property transfers of the right, the issue of identifying and locating the relevant owner(s) is often particularly difficult. In particular, the situation of subsequent property transfers regarding the economic rights may lead to an arduous situation when trying to find the right owner of the copyright. Moreover, the increase of the copyright term of protection to the life of the author plus seventy years involves that works are protected longer than in the past decades and therefore, works do not fall into the public domain for a longer period of time. This extended length of copyright protection has led to a more substantial number of protected works as well as an increase in the number of orphan works. With the OWD, the European legislator has put in place a unique solution for this problem – at least in respect of orphan works which are first published or (if unpublished) made publicly accessible<sup>234</sup> in a Member State.

According to Article 1, the OWD applies to: 'books, newspapers journals, magazines and other writings (...), cinematographic or audiovisual works and phonograms'. In addition, 'embedded works also fall under the scope of the Directive, 'i.e. works or other protected subject-matter that are embedded or incorporated in, or constitute an integral part of the three aforementioned types of works'<sup>235</sup>. About the first category of works, the reference to 'other writings' is not clear as no further reference is given. It is therefore uncertain if, for example, texts published online, computer programs or databases could be included in this category<sup>236</sup>. Regarding the second category, the Directive creates two subcategories of these works: the ones 'included in the collections' of the public institutions and the ones that must be 'produced by public-broadcasting organisations up to and including 31 December 2002'.

The Directive left outside of its scope certain categories of works, the most important being stand-alone photographs even though these are considered to constitute one of the most important categories of orphans<sup>237</sup>. Photographs will only benefit from the special rules in the OWD if they are embedded in other publications that fall under the scope of the Directive. The Commission has

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<sup>233</sup> The Orphan Works Directive art 2.

<sup>234</sup> In this latter case of unpublished works the rule also requires a general assumption of the rightholders' consent, which may constitute a difficult condition in practice.

<sup>235</sup> Janssens and Tryggvadottir (n 231) 10. Article 1 (4) OWD.

<sup>236</sup> Uma Suthersanen and Maria Mercedes Fraboni, 'The Orphan Works Directive', *EU Copyright Law* (Edward Elgar Publishing 2014).

<sup>237</sup> R Kerremans, 'A Critical View on the European Draft Directive for Orphan Works' (2012) 2 *Queen Mary Journal of Intellectual Property* 38.

promised to look into the possibility of including photographs in the future, but no initiatives have been announced (yet).

### 4.3.2 Beneficiary institutions

The Directive establishes the conditions under which orphan works may be used by selected institutions. These institutions include ‘publicly accessible libraries, educational establishments and museums, as well as archives, film or audio heritage institutions and public services broadcasting organizations’ in relation to uses ‘in order to achieve aims related to their public-interest missions’<sup>238</sup>.



However, these institutions are allowed to generate revenues in relation to their use of orphan works under this Directive in order to achieve aims related to their public-interest missions, including in the context of public-private partnership agreements<sup>239</sup>. The fact that only public institutions are allowed to use their orphan works for non-commercial purposes has been criticized as it does not incentivize enough private partners in joining public-private agreements with CHIs<sup>240</sup>. Despite the objective ‘to promote free movement of knowledge and innovation in the internal market’ (Recital 2), the Directive does not address the potential commercial uses of orphan works by private companies.

### 4.3.3 Diligent search and orphan works status

**The rights clearance issue**, which constitutes the major problem in respect of orphan works, can be replaced by performing a ‘diligent search’ that establishes an ‘orphan work status’.

Before declaring a work as orphan in a Member State, it needs to be ensured that the copyright owner cannot be traced; otherwise, the use of such a work would infringe his rights. Consequently, the first requisite to declare an orphan work as such is establishing that the author cannot be identified by way of performing a diligent search. This compulsory search must be prior to the use and must be done ‘in

<sup>238</sup> The Orphan Works Directive art 1.

<sup>239</sup> *ibid* rec 21.

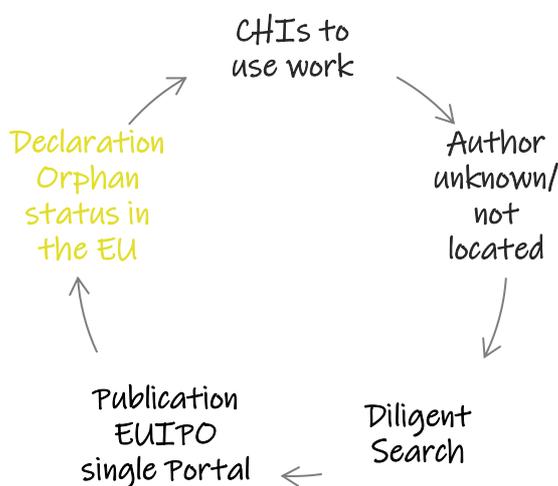
<sup>240</sup> Maria Lilla Montagnani and Laura Zoboli, ‘The Making of an orphan: Cultural Heritage Digitization in the EU’ (2017) 25 *International Journal of Law and Information Technology* 206. See also Eleonora Rosati, ‘The Orphan Works Directive, or Throwing a Stone and Hiding the Hand’ (2013) 8 *Journal of Intellectual Property Law & Practice* 303.

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the Member State of first publication or, in the absence of publication first broadcast<sup>241</sup>. It constitutes the most essential element of the EU system for orphan works. The results obtained from these searches must be registered in a 'single publicly accessible online database established and managed by the Office for Harmonization in the Internal Market'<sup>242</sup> (now the European Intellectual Property Office – EUIPO) aiming at avoiding useless and double searches.

This preliminary condition of carrying out a diligent search has been the subject of much criticism, inter alia, because of the fact that the standards of these searches differ considerably among Member States<sup>243</sup>. Searching and recording the searches of the works moreover involves a huge amount of workload for the entities in charge<sup>244</sup>. According to Kerremans, a diligent search may also be an arduous task to accomplish in view of the 'lack of metadata'<sup>245</sup>.

On the other hand, a very positive achievement of the Directive is the application of the 'principle of mutual recognition' according to which, once a work is considered as 'orphan' in a Member State, 'such status shall automatically be recognised without further conditions in the whole of the European Union'<sup>246</sup>. In other words, this principle will allow access to orphan works in all EU Member States.



#### 4.3.4 Permitted uses

Once a work is declared orphan, the work can be used by beneficiaries but only in the way as is envisaged in Article 6 of the Directive, i.e. 'by making the orphan work available to the public (...) and by acts of reproduction (...) for the purposes of digitisation, making available, indexing, cataloguing,

<sup>241</sup> The Orphan Works Directive art 1(2).

<sup>242</sup> *ibid* art 3(6).

<sup>243</sup> Marcella Favale and others, 'Copyright, and the Regulation of Orphan Works: A Comparative Review of Seven Jurisdictions and a Rights Clearance Simulation' [2015] SSRN Electronic Journal <<http://www.ssrn.com/abstract=2613498>>.

<sup>244</sup> Victoria Stobo and others, 'Current Best Practices among Cultural Heritage Institutions When Dealing with Copyright Orphan Works and Analysis of Crowdsourcing Options' (2018) <<http://diligentsearch.eu/wp-content/uploads/2018/05/EnDOW-Report-3.pdf>>.

<sup>245</sup> Kerremans (n 237).

<sup>246</sup> The Orphan Works Directive art 4.

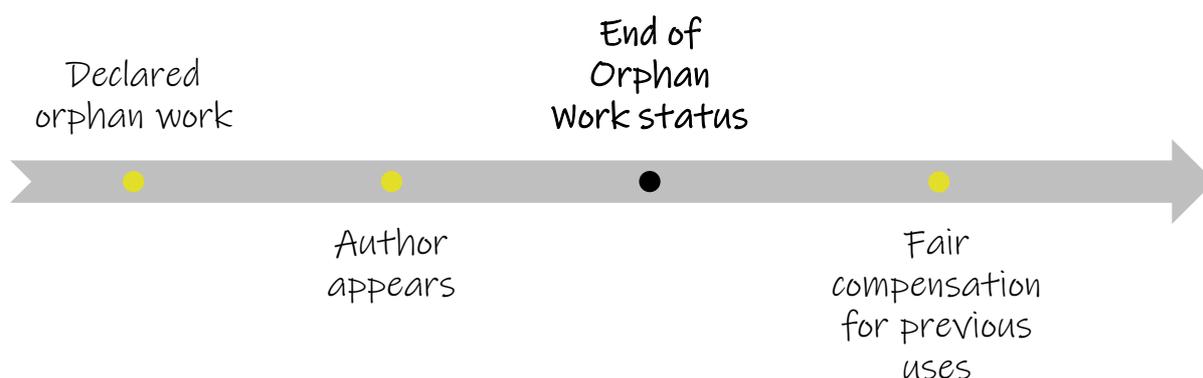
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preservation or restoration'. As this rule includes the two most essential exclusive rights, a wide range of uses seems authorized. Still, such uses must conform to the public-interest mission prescribed in Article 1. Recital 20 refers to activities such as 'the preservation of, the restoration of, and the provision of cultural and educational access to, their collections, including their digital collections' but these factors are clearly not exhaustive<sup>247</sup>. Public organizations could also enter into agreements with (private) partners in order to digitize orphan works and make them accessible. As Kerremans observes, it will not be easy for CHIs to determine what is considered public-interest missions or private-interest missions. For instance, in the case that an orphan work is used to create gifts such as umbrellas or mugs that are sold at the Museum/library shop, these activities will possibly not be considered to be included in the public-interest mission in the stricter terms of the words<sup>248</sup>.

Despite these minor concessions regarding the opportunities for CHIs to join agreements with private partners, it is on the other hand quite clear that the Directive only allows for uses of orphan works of a non-commercial nature. First of all, private companies are only allowed to use the orphan works when involved in agreements with the named beneficiaries, which will thereafter be the only ones that should control and audit the uses. Furthermore, the revenues that may be obtained should only be used for the costs that relate to preservation and digitization, meaning that private companies are not able to generate profits themselves. How revenues can be generated is anyhow an important issue which is not clarified in the Directive. Nothing is indeed said about whether the orphan work's uses may be priced or, on the other hand if they should be accessible for free<sup>249</sup>.

#### 4.3.5 End of orphan work status and fair compensation

The author of an orphan work can come forward and discover that his work has been used by the beneficiary organizations without his/her consent. For this kind of cases, and in order to respect the protection that copyright grants to rightholders, the Directive provides that rightholders are entitled to put an end to the orphan work status<sup>250</sup>.



<sup>247</sup> See also more, *infra*, 4.3.6. where it will also be shown that the OWD does not entirely close the door to public-private collaborations.

<sup>248</sup> Kerremans (n 237) 58.

<sup>249</sup> Stobo and others (n 244).

<sup>250</sup> The Orphan Works Directive art 5.

As copyright is an exclusive and fundamental right, the rightholder will have that possibility at any time. Moreover, when claiming his rights, the author is entitled to receive a fair compensation. The quantity and calculation system of such compensation is left to national legislation in the Member States, which may constitute a complicating factor in cases of cross-border uses.

#### 4.3.6 Current implementation of the Directive and practical implications for CHIs

**The Directive has worked out a legally certain solution for orphan works. However, the difficult application conditions reduce the usefulness for CHIs to use the system.**

There are thousands of orphan works in libraries, archives, museums or other organizations. Already in 2013, a UK impact assessment showed that the number of orphan works in the UK could reach almost 50 million<sup>251</sup>, most of which are truly valuable for researchers and academics as well as for the dissemination of the cultural heritage. Normally different kind of works ‘can fall into orphanage’<sup>252</sup> such as books, photographs or unpublished works and works with a low commercial value. These works, due to the low commercial interest that they display, do not usually offer any data related to the authors of the works, making the search of the author extremely difficult<sup>253</sup> and burdensome for the CHIs.

The orphan work dilemma is particularly accurate for ‘mass-digitization projects’, for which the Directive does not really offer a solution in practice. ‘Mass digitisation projects are engaged in the mission of transplanting the whole cultural heritage of humankind, as deposited in books and in other physical carriers, in the digital networked environment’<sup>254</sup> as Borghi explains. Yet it remains almost impossible today to carry out these projects in a legally certain manner. They require substantial technical, financial and organisational efforts that are often beyond the capabilities of individual organisations. The new obligation to carry out a diligent search also adds a burden for CHIs as such search is both costly and time-consuming. This conclusion might need some nuance in certain Member States (e.g. Scandinavian countries that apply extended collective licenses), which will be discussed later in the deliverable. For now, and as it is shown in the study carried out in the framework of the ENDOW project, digitization for CHIs remains ‘a paradox’<sup>255</sup>. Results from this project demonstrate that the Directive has failed in its mission of providing further digital access to Europe’s cultural heritage solving the issue of the orphan works. The current system is considered too complex and

<sup>251</sup> David R Hansen and others, ‘Solving the Orphan Works Problem for the United States’ (2013) 37 The Columbia Journal of Law & the Arts 55.

<sup>252</sup> Katharina de la Durantaye, ‘Finding a Home for Orphans: Google Book Search and Orphan Works Law in the United States and Europe’ (2011) 21 Fordham Intellectual Property, Media & Entertainment Law Journal 229.

<sup>253</sup> *ibid.*

<sup>254</sup> Maurizio Borghi, ‘Mass Digitisation and the Moral Right of Integrity’ Brunel University Law School.

<sup>255</sup> Stobo and others (n 244).

burdensome for CHIs. This is (painfully) reflected in the few orphan works that have been registered in the EUIPO database thus far<sup>256</sup>.

Nevertheless, the new CDSM Directive – discussed in the next Section - has proposed new rules, *inter alia* regarding out-of-commerce works and a more generalized manner to make use of extended collective licensing, that may improve the possibilities for CHIs to become more active in the digital single market.

## 4.4 Directive and Regulation implementing Marrakesh Treaty

### 4.4.1 Legal framework

In addition to the exception provided in the Infosoc Directive for people with disabilities (see *supra*, Section 4.1.6), other exceptions have been included in the *acquis communautaire* through the Directive 2017/1564/EU and Regulation 2017/1563/EU. Both instruments have been the response from the EU to the international obligations provided under the Marrakesh Treaty to facilitate access to published works for persons who are blind, visually impaired, or otherwise print disabled<sup>257</sup> (the ‘Marrakech Treaty’) administered by the WIPO.

This Treaty is considered to be the first treaty responding to the needs of user’s rights<sup>258</sup> and was adopted after heated debates between civil society advocating for supporting the right to culture for people with disabilities and copyright owners, especially publishers. The origin of this Treaty, ‘originated from the human rights arena’<sup>259</sup>. In consequence, this Treaty has undoubtedly a social dimension whose roots lay down in the need of facilitating access to knowledge for people with disabilities. This Treaty requires the contracting parties to introduce certain limitations and exceptions to copyright in order to permit the reproduction, distribution and the making available to accessible-format works for the visually impaired persons (hereinafter the ‘VIPs’) and to provide cross-border exchange of those works through specific organizations.

The Treaty includes a broad definition of the term VIP entailing all those disabilities that prevent these people from ‘holding and manipulating a book’<sup>260</sup>. As a result of the compromise between rightholders and civil society, the scope of works was reduced to those works ‘in the form of text, notation and/or related illustrations, whether published or otherwise made publicly available in any media’<sup>261</sup>. Although it is not expressly mentioned, it was agreed by the contracting parties that the scope of the

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<sup>256</sup> *ibid.*

<sup>257</sup> World Intellectual Property Organization Marrakesh Treaty to Facilitate Access to Published Works for Persons Who Are Blind, Visually Impaired, or Otherwise Print Disabled (2013).

<sup>258</sup> Margaret Ann Wilkinson, ‘International Copyright: Marrakesh and the Future of Users’ Rights Exceptions’ in Mark Perry (ed), *Global Governance of Intellectual Property in the 21st Century: Reflecting Policy Through Change* (Springer International Publishing 2016) <[https://doi.org/10.1007/978-3-319-31177-7\\_7](https://doi.org/10.1007/978-3-319-31177-7_7)>.

<sup>259</sup> Sganga (n 210) 30.

<sup>260</sup> World Intellectual Property Organization Marrakesh Treaty to Facilitate Access to Published Works for Persons Who Are Blind, Visually Impaired, or Otherwise Print Disabled (2013).

<sup>261</sup> *ibid.*

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exception also includes audiobooks. This works should freely circulate among the parties of the Treaty without other restrictions or obligations than those ones established in the Treaty for ‘authorized entities’.

The EU legislator has opted for **two legal instruments** to implement the Treaty. A Directive imposes a mandatory exception to copyright for certain uses to the benefit of VIP that Member States need to transpose, while a (directly applicable) Regulation provides that the exception permits the cross-border exchange of those works between EU Members and third countries.

Directive	Regulation
<ul style="list-style-type: none"> <li>● Exception to copyright</li> <li>● for making copies available to VIPs</li> <li>● or authorized entities to distribute, communicate, lend accessible copies to VIPs</li> </ul>	<ul style="list-style-type: none"> <li>● Allows for cross-border exchanges of works</li> <li>● between EU Member States and Third countries</li> </ul>

Following the same rationale as the Treaty, the EU instruments are both focusing on improving access to print material to VIPs. As in the Marrakech Treaty, the aim is to improve circulation of accessible format content in the internal market<sup>262</sup>.

The Directive introduces a new **exception to copyright** for ‘making an accessible format copy of the work for the beneficiary or a person acting on his behalf’ or ‘for an authorized entity to communicate, make available, distribute or lend an accessible format copy to a beneficiary person or another authorised entity on a non-profit basis for the purpose of exclusive use by a beneficiary person’<sup>263</sup>.

The scope in this exception is very broad and applies to all exclusive rights (the rights of reproduction, communication to the public, making available to the public, distribution and lending). Similarly, to the exceptions included under the Infosoc Directive, the three-step test must be taken into account when applying this exception, which may, according to Senftleben, possibly have the result to reduce the effect of the exception and the legal certainty of the permitted uses under the exception<sup>264</sup>.

Copies that are made under this exception should ‘respect the integrity of the work with due consideration given to the changes required to make the work or other subject matter accessible in the alternative format’<sup>265</sup>. In addition, this exception cannot be overridden by contract. It also allows Member States to introduce a compensation scheme for permitted uses.

<sup>262</sup> Directive on certain permitted uses of certain works and other subject matter protected by copyright and related rights for the benefit of persons who are blind, visually impaired or otherwise print-disabled (2017/1564/EU) art 3(1).

<sup>263</sup> *ibid.*

<sup>264</sup> Martin Senftleben, ‘A Copyright Limitations Treaty Based on the Marrakesh Model: Nightmare or Dream Come True?’ [2017] Available at SSRN 3064823.

<sup>265</sup> Directive on certain permitted uses of certain works and other subject matter protected by copyright and related rights for the benefit of persons who are blind, visually impaired or otherwise print-disabled (2017/1564/EU) art 3(2).

With regard to the type of works falling under the exception, the Directive follows the same approach as the Treaty but also expressly refers to audiobooks.

Concerning beneficiaries, both the Directive and the Regulation broaden the concept of ‘beneficiaries’ as compared to the Treaty. Not only people with physical disabilities preventing them from reading are mentioned, but also people with ‘reading disabilities’ such as dyslexia or other learning disability.

A crucial element in the system created by the Treaty and implemented by the EU instruments is the involvement of certain organizations, the so-called ‘authorised entities’, which are defined as ‘an entity that is authorised or recognised by a Member State to provide education, instructional training, adaptive reading or information access to beneficiary persons on a non-profit basis’<sup>266</sup>. Member States must provide information of such entities to the European Commission.

#### 4.4.2 Practical implications for CHIs

‘For people with disabilities, access to knowledge and participation in cultural life has always represented a tough challenge’<sup>267</sup>. As Sganga explains, ‘several studies reported a strikingly low number of worldwide books available in Braille (5%), a number depicting an unsustainable book famine, the size of which become even broader (1%) in developing countries (e.g. World Blind Union 2013)’<sup>268</sup>. Different causes for this situation have been identified. The most widespread is that generating accessible format copies can entail high costs and the accessible format market has a very limited number of consumers. This together with a lack of public funding for this kind of initiatives and the lack of incentive for private companies to engage in this kind of projects, lead to little availability of works in the market for people with disabilities.

Nevertheless, nowadays the digital shift has opened new opportunities to foster access to cultural content for people with disabilities with less costs. Accessible copies in digital format are cheaper to produce and to distribute, even across borders. This increases the possibilities of reaching a further audience. Furthermore, new technologies have ‘expanded the boundaries of accessibility far beyond the constraint of the Braille language’<sup>269</sup> to cultural content and knowledge.

Mass-digitization projects carried out by CHIs have the potential to make available all types of content included in their collections for every person in the world. This includes works ‘in accessible formats permitting e.g. visually impaired to enjoy cultural heritage, along with monuments and artistic pieces, with little or no disability barriers’<sup>270</sup>.

Libraries are considered to play a **key role** in the success of the implementation of the Treaty through the EU instruments<sup>271</sup> in **two ways**: first, they are the guardians and creators of most

<sup>266</sup> *ibid* art 2(4).

<sup>267</sup> Sganga (n 210) 4.

<sup>268</sup> *ibid*.

<sup>269</sup> *ibid*.

<sup>270</sup> *ibid*.

<sup>271</sup> International Federation of Library Associations, ‘EU Marrakesh Transposition Guide’.

accessible format works and, secondly, they play an important role in cross-border exchange of those works.

The exception discussed in this section certainly opens horizons for cultural institutions in their role of making cultural content available, including in accessible formats. It creates new possibilities for libraries to further invest in accessible format copies of their collections and to exchange those works across borders avoiding duplication of costs in a legal manner<sup>272</sup>. Digital inclusion is not unknown for libraries<sup>273</sup>, in the sense that libraries have been, already for years, facilitating access and use of information and new technologies to specific groups of persons.

It is true that problems may arise for local libraries. They may fear for an extra burden in terms of potential verification of the disability as well as verification that the work is not available commercially in accessible form<sup>274</sup>.

## 4.5 Directive on copyright in the Digital Single Market

With the aim to further harmonize copyright at the EU level and adapt current copyright rules to the digital environment, as new technological developments are transforming the way that works are produced, distributed and exploited<sup>275</sup>, the EU legislator decided to modernize the copyright legal framework. This occurred by Directive 2019/790 of 17 April 2019, published in the Official Journal on 17 May 2019.

In this deliverable, the long and difficult process of the adoption of the Directive, described as ‘one of the longest in the EU acquis’<sup>276</sup>, will not be discussed. Our focus relies on the provisions which may be of interest for CHIs. Our Study will be limited to such provisions as they still need to be transposed – only by June 2021 – in the national laws of the Member States. A more in-depth examination will be undertaken in the framework of the comparative analysis which is the subject of a future deliverable.

More in particular, the Directive consists of **five titles**, many of which entail some very interesting provisions for CHIs:

- Title I on *General provisions*: it sets the scope and the subject matter of the Directive. Of importance is Article 2 with a definition of ‘cultural heritage institutions’ (see hereafter Section 4.5.1.3).
- Title II on *Measures to adapt exceptions and limitations to the digital and cross-border environment*: this title introduces certain new – and mandatory – exceptions, two of which

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<sup>272</sup> *ibid.*

<sup>273</sup> Wondwossen M Beyene, ‘Digital Inclusion in Library Context: A Perspective from Users with Print Disability’ (2018) 12 *Journal of Web Librarianship* 121.

<sup>274</sup> Vincent Bonnet, ‘The Marrakesh Treaty for Visually Impaired People: A Focus on (Public) Libraries in Europe’ 10.

<sup>275</sup> The CDSM Directive rec 3.

<sup>276</sup> João Quintais, ‘The New Copyright in the Digital Single Market Directive: A Critical Look’ [2019] *SSRN Electronic Journal* 2 <<https://www.ssrn.com/abstract=3424770>>.

concern activities of CHIs (i.e. text and data mining and the preservation of cultural heritage (see below Section 4.5.1)).

- Title III on *Measures to improve licensing practices and ensure wider access to content*: in this yet another interesting part for CHIs, a new regime for (cross-border) uses of out-of-commerce works by heritage institutions is set up. This Title further establishes certain rules for facilitating the mechanism of extended collective licensing of works, and contains an interesting provision for works of visual arts in the public domain (see below Sections 4.5.3 and 4.5.4).
- Title IV on *Measures to achieve a well-functioning market place for copyright*: this title contains provisions that were very controversial (a new right for press publishers and the so-called value-gap provision with new obligations for online services providers) but which may be less relevant for the practice of CHIs. The last Section with rules related to certain mandatory conditions for exploitation contracts with authors, may on the other hand, be of relevance (see below Sections 4.5.5 and 4.5.6).
- Title V contains some *Final provisions* e.g. as regards amendments to the existing Directives and the application in time of the new provisions.

#### 4.5.1 New exceptions and limitations

Recital 4 of the Directive highlights the need of adding new exceptions and limitations into the EU *acquis* in the fields of research, innovation, education and *preservation of cultural heritage*, given that digital technologies allow new uses of works that are not covered in previous directives. The lack of regulation of these new uses of works in the digital environment created a high-level legal uncertainty for rightholders, service providers and end-users. Furthermore, the introduction of new exceptions and limitations are needed to enhance the cross-border uses of works.

As noted above, and unlike the exceptions included in the Infosoc Directive (see Section 4.1.3), the **new exceptions included in Title II are mandatory** for Member States. Yet, they remain subject to the three-step test, meaning that ‘they can be applied only in certain special cases that do not conflict with the normal exploitation of the works or other subject matter and do not unreasonably prejudice the legitimate interests of the rightholders’<sup>277</sup>.

##### 4.5.1.1 Exceptions for text and data mining

Text and data mining (hereinafter ‘TDM’) is defined in Article 2(2) as ‘any automated analytical technique aimed at analysing text and data in digital form in order to generate information which includes but is not limited to patterns, trends and correlations’.

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<sup>277</sup> The CDSM Directive art 7(2), rec 6.

'TDM refers to a **research technique to collect information** from large amounts of digital data through automated software tools'<sup>278</sup>.

TDM has today become an essential tool within the data economy as it gives the possibility to mine huge amounts of information. It would appear that in the data economy, the value of text and data is not considered in isolation but in the potential of extracting it with the purpose of analysing it and discovering trends and patterns<sup>279</sup>. Also, CHIs, possibly in partnership with private entities, have an interest in such activities. This tool is also of utmost importance for applications making use of artificial intelligence (AI), and its prominent discipline of machine learning, to help deliver new insights from big data.

The **process of TDM** is further explained by Geiger et al. in the following manner: TDM 'works by (1) identifying input materials to be analysed, such as works, or data individually collected or organised in a pre-existing database; (2) copying substantial quantities of materials—which encompasses (a) pre-processing materials by turning them into a machine-readable format compatible with the technology to be deployed for the TDM so that structured data can be extracted and (b) possibly, but not necessarily, uploading the preprocessed materials on a platform, depending on the TDM technique to be deployed; (3) extracting the data; and (4) recombining it to identify patterns into the final output'<sup>280</sup>.

Considering the nature of the TDM process, TDM techniques may entail certain **copyright-related issues** (use of protected works or extractions from protected databases) and thus give rise to a copyright infringement. TDM indeed normally involve the acts of making copies of the work, extracting data, and recombining it in order to identify patterns<sup>281</sup>. Such temporary or permanent copies of copyrighted subject matter<sup>282</sup> may qualify as an infringement of the right of reproduction<sup>283</sup> if such acts are not authorized by the rightholder. Whether such copies that have been made using TDM techniques may qualify as reproductions in the sense of the right of reproduction of the Infosoc Directive was subject to heated debates. However, for the sake of legal certainty, the EU legislator has put these discussions to an end by introducing the TDM exception in the new CDSM Directive.

It has to be considered that not all data and text are protected by copyright or any related rights. Evidently, text and data, not protected by IP, can be used without authorization. However, in practice TDM processes will quite often be based on both IP protected data and text and the ones that are in public domain. Thus, the issue of IP authorization is often inevitable. It is true that the research

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<sup>278</sup> Christophe Geiger, Giancarlo Frosio and Oleksandr Bulayenko, 'Text and Data Mining: Articles 3 and 4 of the Directive 2019/790/Eu' [2019] SSRN Electronic Journal 6 <<https://www.ssrn.com/abstract=3470653>>.

<sup>279</sup> Eleonora Rosati, 'Copyright as an Obstacle or an Enabler? A European Perspective on Text and Data Mining and Its Role in the Development of AI Creativity' (2019) 27 Asia Pacific Law Review 198, 200.

<sup>280</sup> Geiger, Frosio and Bulayenko (n 278) 6.

<sup>281</sup> Rosati, 'Copyright as an Obstacle or an Enabler? A European Perspective on Text and Data Mining and Its Role in the Development of AI Creativity' (n 279) 200.

<sup>282</sup> Sean Flynn and others, 'Implementing User Rights for Research in the Field of Artificial Intelligence: A Call for International Action' [2020] European Intellectual Property Review 4 <[https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=3578819&download=yes](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3578819&download=yes)>.

<sup>283</sup> Geiger, Frosio and Bulayenko (n 278) 7.

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exception contained in the Infosoc Directive has been used in some Member States to allow for TDM activities. The use of this exception, however, has clear shortcomings due to its narrow scope (e.g. for non-commercial purposes) and the legal uncertainty in cross-border uses<sup>284</sup>.

Therefore, to keep up with the latest technological developments and provide the necessary level of legal certainty to the relevant stakeholders, the (EU) legislators introduced two mandatory exceptions for TDM in respective Articles 3 and 4 of the CDSM Directive. Both exceptions apply to the right of reproduction of copyright and the sui generis right of extraction for databases as well as to the new press publisher's right. In particular, the first provision is interesting as CHIs are explicitly mentioned as beneficiaries.

Article 3 allows 'for **reproductions and extractions made by research organisations and cultural heritage institutions** in order to carry out, for the purposes of scientific research, text and data mining of works or other subject matter to which they have lawful access'.

Interestingly, this exception also applies to public-private partnerships which research and cultural heritage organizations are part of. Therefore, while research organisations and CHIs remain the only beneficiaries of the exception, the Directive expressly allows that such research activities may be carried out with the help of private partners<sup>285</sup>.

When making use of this exception, CHIs should respect certain obligations to make sure their acts will be considered lawful. In short, the TDM activities are solely<sup>286</sup> carried out within the framework of research activities and on works or other subject matter to which these institutions have lawful access<sup>287</sup>. The concept of 'lawful access' may clearly constitute an obstacle. Useful further clarification is provided in Recital 14, which states that 'lawful access should be understood as covering access to content based on an open access policy or through contractual arrangements between rightholders and research organisations or cultural heritage institutions, such as subscriptions, or through other lawful means. For instance, in the case of subscriptions taken by research organisations or cultural heritage institutions, the persons attached thereto and covered by those subscriptions should be deemed to have lawful access. Lawful access should also cover access to content that is freely available online'<sup>288</sup>.

Possible problems in conducting TDM may result from measures that rightholders may apply 'to ensure the security and integrity of the networks and databases where the works or other subject matter are hosted'<sup>289</sup>. Yet, these measures should be proportionate.

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<sup>284</sup> *ibid* 13.

<sup>285</sup> The CDSM Directive rec 12.

<sup>286</sup> For other purposes, use may possibly be made of the second TDM provision in Article 4 of the CDSM Directive.

<sup>287</sup> See comments by Geiger, Frosio and Bulayenko (n 278) 28.

<sup>288</sup> The CDSM Directive rec 14.

<sup>289</sup> *ibid* art 3 (3).

As Geiger highlights, ‘the TDM exception’s scope is very inclusive as it applies both to commercial and non-commercial uses and—very importantly—cannot be overridden by contract’<sup>290</sup>. Yet, as dictated by Article 7, both the three-step test and the possibility to include TPMs remain applicable to this exception.

This study briefly mentions the second TDM exception introduced by Article 4 which allows for similar activities as in Article 3 (discussed above), yet for any commercial or non-commercial purpose. In other words, the application of this exception is not limited to activities of research and is moreover not restricted to a limited circle of beneficiaries. Anyone can invoke this exception.

While at first sight the scope of this exception appears to be much broader than the one in Article 3, in practice its application may turn out to leave a lot less opportunities because of some accompanying conditions. Indeed, Article 4.3 provides for an opt-out mechanism for rightholders by stating that the exception is only applicable on condition that ‘the use of works and other subject matter referred to in that paragraph has not been expressly reserved by their rightholders in an appropriate manner, such as machine-readable means in the case of content made publicly available online’. This exception can also be overridden by contract. These reservations may hinder the potential application of this TDM exception<sup>291</sup>.

#### 4.5.1.2 *Exception for the preservation of cultural heritage*

Article 6 will certainly be welcomed by CHIs as it introduces a **mandatory exception** that allows for acts of reproduction for the preservation of cultural heritage, yet only in respect of works ‘that are permanently in their collections’.

In all Member States CHIs obtain a high degree of legal certainty in making reproductions for the preservation of works in their collections.

This exception affects the right of reproduction (including for computer programs), the sui generis right for databases and the press publishers’ rights (recently established by the new Directive).

CHIs should take care that such reproductions are only made of ‘works permanently in their collections’. This means, according to Recital 29, that ‘copies of such works or other subject matter are owned or permanently held by that institution, for example as a result of a transfer of ownership or a licence agreement, legal deposit obligations or permanent custody arrangements’.

The Directive is otherwise inclusive and does not impose any restriction on the manner or system through which such copies are made. On the contrary, the exception is notably broad as copies can be made ‘by the appropriate preservation tool, means or technology, in any format or medium, in the required number, at any point in the life of a work or other subject matter’<sup>292</sup>.

<sup>290</sup> Geiger, Frosio and Bulayenko (n 278) 28.

<sup>291</sup> Rosati, ‘Copyright as an Obstacle or an Enabler? A European Perspective on Text and Data Mining and Its Role in the Development of AI Creativity’ (n 279) 215.

<sup>292</sup> The CDSM Directive rec 27.

As regards the aim of ‘preservation’, two examples are given in Recital 27: copies may be made ‘to address technological obsolescence or the degradation of original supports or to insure such works and other subject matter’.

Furthermore, acknowledging the lack of resources and skills that some CHIs face, Recital 28 allows cooperation and assistance by other CHIs and third parties acting on their behalf for the making of copies.

#### ***4.5.1.3 Practical implications of the new exceptions for CHIs***

As already pointed out above, the TDM and preservation exceptions entail important opportunities for CHIs, some of which were briefly highlighted in the previous section. To benefit therefrom, it will be first of all important to check whether a heritage institution falls within the **definition** mandatorily imposed in Article 2.

Only ‘a publicly accessible library or museum, an archive or a film or audio heritage institution’ are listed and may thus benefit from the exceptions discussed in the previous section<sup>293</sup>. Further specification is provided in Recital 13 which states that CHIs, in the sense of the Directive, are those ‘publicly accessible libraries and museums regardless of the type of works or other subject matter that they hold in their permanent collections, as well as archives, film or audio heritage institutions’. Under this definition CHIs include national libraries and national archives. Furthermore, the Directive also considers as cultural institutions those educational establishments, research organisations and public sector broadcasting organisations ‘as far as their archives and publicly accessible libraries are concerned’.

Since the Directive does not provide any definition of a ‘library’, ‘museum’ or ‘archive’ neither imposes any requirement in terms of funding sources of these institutions or on the organizational structure of such institutions, the exact scope of application leaves some leeway to national laws<sup>294</sup>.

#### **TDM exceptions**

As regards the exception for ‘**text and data mining for the purposes of scientific research**’ in Article 3, some opportunities for CHIs when carrying out research activities and – very importantly - the legal certainty in this regard<sup>295</sup> were already hinted. As Geiger explains, ‘the major positive impacts of the Directive lie in its focus on harmonisation of Member States’ laws, through a mandatory solution’<sup>296</sup>. This mandatory character will likely enhance cooperation between CHIs across borders. TDM may also be carried out by external researchers who perform such research for the cultural institution.

We would finally like to draw attention to two other parts of this exception. Firstly, CHIs are allowed to store with an appropriate level of security the copies of works or other subject matter they have made during the TDM process and which they may for the purposes of scientific research, including

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<sup>293</sup> *ibid* art 2(3).

<sup>294</sup> Michal Koščík, ‘Exceptions for Cultural Heritage Institutions under the Copyright Directive in the Digital Single Market’ 16 *Grey Journal* (TGJ) 2020 Special Winter Issue, 80, 2.

<sup>295</sup> Paul Keller, ‘Explainer: What Will the DSM Directive Change for Cultural Heritage Institutions?’ [2019] *Europeana Foundation* 9, 8.

<sup>296</sup> Geiger, Frosio and Bulayenko (n 278) 29.

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for the verification of research results<sup>297</sup>. Rightholders have the possibility to apply certain measures to ensure the security and integrity of the networks and databases where the works are hosted. Secondly, the Directive expressly encourages research and cultural heritage organizations together with rightholders to define commonly agreed best practices concerning the application of the security measures for storage as well as the measures rightholders may apply<sup>298</sup>. In this regard, the establishment and implementation of data management plans will certainly contribute to secure the networks and databases, but this will be followed up in the future.

As regards the more general ‘**exception or limitation for text and data mining**’ in Article 4 it appears – at first sight – that its use may be problematical for CHIs in view of the continuing uncertainty as to whether or not a rightholder will make use of the opt-out right. Further circumstances that may compromise the usefulness of this exception for CHIs include the possibility that contracts may rule out this exception as well, the potential use of TPMs by rightholders, and some discretion left to Member States. Scholars rightly observe that the legislator missed an opportunity to avoid fragmentation of copyright law within the Member States as regards this important technology of TDM<sup>299</sup>.

### Exception for preservation for CHIs

With the new exception in Article 6, the European legislator has created a legally certain framework for CHIs in the EU<sup>300</sup> that will allow them to unlock much of the potential of digitization and preservation activities – the importance of which are undisputed<sup>301</sup>.

As seen above, the EU legal framework already included an exception for certain acts of reproduction for preservation of CHIs (see Section 4.1.6 above). Due to its optional character as well as its ambiguity as regards the manner and number of the copies allowed, this exception in the Infosoc Directive did not lead to the desired harmonization and, instead, gave rise to fragmentation of laws in the EU countries<sup>302</sup>. This is notably worrisome for CHIs that want to engage in cross-border activities and, in particular, in ‘sharing of means of preservation and the establishment of cross-border preservation networks in the internal market’.

We recall that the current new exception does not impose any requirement or restriction for CHIs as regards the manner of making copies of works (or even the number of copies) as they can be done in any medium or format. CHIs can now work legally across borders with the aim of preserving their collections, through ‘networks or the sharing of equipment’<sup>303</sup>. They can rely on third parties, such as external contractors or other cultural institutions to assist them in the digitization/reproduction process.

As regards to guidance with respect to the aim of ‘preservation purposes’ and the limitation to works ‘within the own collections’, see above. The opportunities offered by the new exception, should

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<sup>297</sup> The CDSM Directive art 3(2).

<sup>298</sup> *ibid* art 3(4).

<sup>299</sup> Quintais (n 276) 7.

<sup>301</sup> Koščík (n 294) 3.

<sup>302</sup> The CDSM Directive rec 26.

<sup>303</sup> Stephen Wyber, ‘Communia Guidelines for the Implementation of the DSM Directive. Article 6’ (2019).

however not make us forget important challenges. In Aplin's views, there are *financial challenges* which mainly relate to the costs of digitizing analogue collections and to the costs of long-term preservation; there are also *organizational challenges*, in terms of ensuring cooperation across Europe in order to not duplicate preservation efforts; *technical challenges* which mainly relate to the technological developments to improve digitisation and to the need to tackle the obsolescence of formats<sup>304</sup>.

#### 4.5.2 New provisions for out-of-commerce works

Out-of-commerce works (hereinafter 'OOCWs') are defined in Article 8(5) of the CDSM Directive as a work or other subject matter whereby 'it can be presumed in good faith that the whole work or other subject matter is not available to the public through customary channels of commerce, after a reasonable effort has been made to determine whether it is available to the public'. Different reasons for being out-of-commerce may exist, such as 'the age of the works or other subject matter, their limited commercial value or the fact that they were never intended for commercial use or that they have never been exploited commercially'<sup>305</sup>.

Alike orphan works, the existence of OOCWs in the collections of CHIs has traditionally given rise to difficulties with regards to their uses for digitization and making them available online or for preservation activities. Due to the nature of OOCWs, digitization activities turned complex (seeking for a licence can be costly) as any use would require CHIs to enter into several licensing agreements<sup>306</sup>.

However, unlike the orphan works, the problem with OOCWs was not given a statutory solution by the EU legislator until the CDSM Directive. Before the Directive, the actions taken at EU level aimed at fostering voluntary licensing agreements, e.g. Licenses for Europe Initiative. There was some improvement with the signature of the Memorandum of Understanding of Key Principles on the Digitisation and Making Available of Out-of-Commerce Works<sup>307</sup> (MoU) in 2011, but this instrument was not binding for the signatories and only addressed literary works.

The CDSM Directive is, therefore, to be welcomed for its putting in place – in Articles 8 to 11 – a clear legal framework addressing the legal and practical problems with OOCWs. This part of the Directive is entirely reserved to CHIs who are the only beneficiaries (for the definition of CHIs, see Section 4.5.1.3).

As it can be inferred from the definition cited above, the concept of OOCW is to be understood in a rather broad manner. The Directive includes works that have never been commercialised, or that were never meant to be commercially exploited, as well as those works that were commercially exploited but no longer are. For a correct understanding, regard should be in particular given to Recitals 37 and

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<sup>304</sup> Tanya Aplin and Estelle Derclaye, 'A Global Digital Register for the Preservation and Access to Cultural Heritage: Problems, Challenges and Possibilities', *Copyright and Cultural Heritage* (Edward Elgar Publishing 2010) 2.

<sup>305</sup> The CDSM Directive rec 30.

<sup>306</sup> Lucie Guibault and Simone Schroff, 'Extended Collective Licensing for the Use of Out-of-Commerce Works in Europe: A Matter of Legitimacy Vis-à-Vis Rights Holders' (2018) 49 IIC - International Review of Intellectual Property and Competition Law 916, 2.

<sup>307</sup> European Commission, Memorandum of Understanding: Key Principles on the Digitisation and Making Available of Out-of-Commerce Works (2011).

38 which provide examples of which works should be considered as being out-of-commerce. According to these recitals, on the one hand, a work should be still considered out-of-commerce in cases of adaptations of works that entail the creation of different works when these different works are still available in commerce. For instance, language versions of a work or audiovisual adaptations of a literary work could have different commercial availability. Translations of works may imply that one work can be not commercially available in one language but still be in another language<sup>308</sup>. On the other hand, a work should not be considered as being out-of-commerce when they can be seen as the same work in essence, e.g. subsequent editions of literary works or cinematographic works, or even works that still exist in digital or tangible form. In addition, a limited availability of a work, for instance, in a second-hand shop, or a 'theoretical possibility that a license for a work could be obtained'<sup>309</sup> does not mean that the work is available to the public in the customary channels of commerce.

It must be noted that analogously to the exception of preservation of works, both the exception and the licence only apply to works that are permanently in the collection of the institution (see Section 4.5.1.3).

#### **Requisites to declare a work out-of-commerce**

On the other hand, the Directive further establishes that a work can be presumed 'in good faith' to be out-of-commerce 'after a reasonable effort has been made to determine whether it is available to the public'<sup>310</sup>. Although the Directive leaves Member States the possibility to include requirements for considering that a reasonable effort has been made, it explicitly establishes that this effort does not need to be made repeatedly over time but it needs to take account of a potential upcoming availability of works in the regular channels of commerce. In general terms, a work-by-work assessment does not need to be made unless it is considered reasonable 'in view of the availability of relevant information, the likelihood of commercial availability and the expected transaction cost'<sup>311</sup>.

It is important to mention that any information about ongoing and future uses of OOCWs made under a license or under the exception should be adequately publicized, before starting the use of the work e.g. the type of uses, and during the use of works under a license or under the exception. According to the Directive, this is particularly relevant for uses across borders. As a result, the Directive opts for the creation of a European portal - managed by the EUIPO- where all the information regarding uses of OOCWS will be available<sup>312</sup> (in a similar mode as the Orphan works database, explained under Section 4.3).

According to Geiger, these publicity measures introduced by the Directive overcome some of the requisites under the CJEU *Soulier*<sup>313</sup> judgement. In this judgment, related to the publication of out-of-commerce books digitally, the CJEU held that French law did not comply with EU law as it did not provide for a mechanism to ensure that authors were individually informed (even if it provided for an

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<sup>308</sup> The CDSM Directive rec 37.

<sup>309</sup> *ibid* rec 38.

<sup>310</sup> *ibid* art 8(5).

<sup>311</sup> *ibid* rec 38.

<sup>312</sup> *ibid* art 10.

<sup>313</sup> *Marc Soulier and Sara Doke v Premier Ministre and Ministre de la Culture et de la Communication (C-301/15) EU:C:2016:878 (n 71).*

opt-out mechanism). Individual publicity measures are considered to hinder the actual application of extended collective licenses and may hamper the digitization of OOCWs<sup>314</sup>.

Finally, it must be mentioned that provisions under Article 8 do not apply to those set of works on which 'there is evidence that such sets predominantly consist of works of non-EU nationals, works, other than cinematographic or audiovisual works, that were first published or, in the absence of publication, first broadcast in a third country or with regards to cinematographic or audiovisual works, of which the producers have their headquarters or habitual residence in a third country'<sup>315</sup>.

Consequently, the Directive creates a bifold mechanism for the use of OOCWs by CHIs which mainly consists in a licensing mechanism in a first place and a mandatory exception in the second place. This regime is further detailed in the following sections.

#### **4.5.2.1 New licensing mechanism**

Article 8 establishes the dual regime stated for the use of OOCWs - a new licensing system and a mandatory exception. The first mechanism is established under Article 8(1) which provides that a collective management organization (hereinafter 'CMO'), 'may conclude a non-exclusive licence for non-commercial purposes with a cultural heritage institution for the reproduction, distribution, communication to the public or making available to the public of out-of-commerce works'<sup>316</sup>.

This license could include works of other rightholders that are not represented by the CMO subject to **two conditions**: a) the CMO is, 'on the basis of its mandates, sufficiently representative of rightholders in the relevant type of works or other subject matter and of the rights that are the subject of the licence; and b) all rightholders are guaranteed equal treatment in relation to the terms of the licence'<sup>317</sup>.

The first condition is the **representativeness of the CMO**. The fact whether a CMO is 'sufficiently representative' must be assessed at the place where the CHI is located. However, other criteria to assess the representativeness of the CMO is left to the choice of the Member States. However, it does illustrate certain criteria to assess such representativeness such as the 'category of rights managed by the organisation' or 'the ability of the organization to manage the rights effectively'<sup>318</sup> among others. In case that two or more CMOs are sufficiently representative for a type of work or rightholder, further rules must be specified by the Member States<sup>319</sup>.

The second condition for the CMOs to operate these licenses is the need to ensure **equal treatment among rightholders**, including the ones that are not represented by the CMO yet. Equal treatment

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<sup>314</sup> Christophe Geiger, Giancarlo Frosio and Oleksandr Bulayenko, 'Facilitating Wider Access to Europe's Cultural Heritage in the Digital Environment: Opinion of the CEIPI on the European Commission's Copyright Reform Proposal, with a Focus on Access to Out-of-Commerce Works' (Social Science Research Network 2018) SSRN Scholarly Paper ID 3287734 17 <<https://papers.ssrn.com/abstract=3287734>>.

<sup>315</sup> The CDSM Directive art 8(7).

<sup>316</sup> *ibid* art 8(1).

<sup>317</sup> *ibid* art 8(1).

<sup>318</sup> *ibid* rec 48.

<sup>319</sup> *ibid* rec 33.

should be also understood with regards to the ‘access to information on the licensing and the distribution of remuneration’<sup>320</sup>.

Although the Directive further clarifies that all Member States should have mechanisms in place to allow CMOs to issue this kind of licenses and that these licenses should have the possibility to also cover all Member States, it does not identify the specific type of mechanism for the licensing. As a result, Member States are free to choose such mechanism, that could be, for instance, through ‘extended collective licensing or presumptions of representation’, depending on their ‘legal traditions, practices or circumstances’<sup>321</sup>.

Moreover, it must be noted that the uses under these licenses need to be made only for non-commercial purposes. According to the Directive, this also includes the scenario when CHIs distribute copies of the work ‘such as in the case of promotional material about an exhibition’<sup>322</sup>. Licenses do not need to be necessarily provided on a free basis, especially given the high costs of digitizing the collections. For this reason, the Directive expressly allows CHIs to cover the costs of digitizing and disseminating the works under the license.

Finally, it must be noted that Article 9 provides that these licenses may allow the use of OOCWs by CHIs in any Member State. This Article is in line with one of the objectives of the Directive providing CHIs to promote their collections as widely as possible<sup>323</sup>.

#### 4.5.2.2 *Fall-back exception*

In case that there is no CMO that complies with the conditions set in the first paragraph of Article 8<sup>324</sup>, the exception provided under the second paragraph could apply, so-called ‘fall-back exception’.

This exception allows CHIs ‘to make available, for non-commercial purposes, out-of-commerce works or other subject matter that are permanently in their collections’. The fall-back exception can be exercised under two conditions. The first condition imposes the identification of the author or rightholder (unless it turns impossible). The second condition forbids the works at stake to be made available under commercial websites.

The rights limited under this exception are the right of reproduction and communication to the public, distribution, including for non-original databases and copyrighted databases, computer programs, (for which translation and adaption rights also fall under the exception) and the press-publisher’s rights newly introduced in the new Directive.

When CHIs rely on the exception, cross-border uses of OOCWs are permitted (like under the licensing mechanism). This is due to a legal fiction created by the Directive, according to which the uses of works are deemed to occur where the CHI is located<sup>325</sup>.

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<sup>320</sup> *ibid* rec 48.

<sup>321</sup> *ibid* rec 33.

<sup>322</sup> *ibid* rec 40.

<sup>323</sup> Geiger, Frosio and Bulayenko (n 314) 13.

<sup>324</sup> The CDSM Directive art 8(3).

<sup>325</sup> *ibid* art 9(2).

### 4.5.2.3 *Opt-out mechanism for rightholders*

Both for the licensing system and the ‘fall-back exception’ the Directive includes the possibility for rightholders to opt out. This provision relies on the protection of rightholders, given that, as a general rule, rightholders should have the right to control the uses of their works. As both mechanisms – the license and the exception – operate without the author’s consent, the Directive provides this opt-out mechanism as a safeguard for rightholders.

As a result, rightholders can prevent the application of both the license and the exception at any time ‘before or during the term of the license or before or during the use under the exception or limitation’<sup>326</sup>. This mechanism could even be exercised after the publication within the European portal. The fact of including the possibility for authors to opt out from the license but also for the exception is considered as an innovation within EU law<sup>327</sup> as exceptions do not normally include such possibility.

If the rightholder exercises this power, a certain reasonable period of time should still be provided for any ongoing use<sup>328</sup>. In addition, any remuneration due for the use of the works under the license shall still be made by the CMO.

### 4.5.2.4 *Practical implications of the new regime for CHIs*

CHIs, policymakers, and researchers have been actively searching for solutions to ‘the astronomical transaction costs related to the rights clearance for making these works available to the public’<sup>329</sup>. Even though other EU initiatives were put in place, only the CDSM Directive provided an EU-wide legislative solution. The system introduced by the Directive, explained in detail within previous sections, will certainly enhance the digitization of the works in the collections of CHIs. The digitization of works of non-commercially available works is clearly beneficial to the society at large. Guibault explains that ‘the right holders receive income not otherwise available; the CHIs are able to continue to fulfil their public interest mission; while the public gains access to previously unavailable works’<sup>330</sup>.

Until now, in order to digitize these works and make them available, CHIs had to obtain licenses for the uses of such works as they could not rely on copyright exceptions and limitations.

The new CDSM Directive, provides, on the contrary, a complex mechanism to enhance the digitization and use of OOCWs (including making them available) that entails different possibilities for CHIs and that should facilitate the rights clearance that CHIs must carry out for the uses of these works.

First of all, the Directive provides a system for all kind of OOCWs. The notion of OOCWs included under the Directive is notably broader than the one included under the MoU, which only covered literary works. Furthermore, some Member States may have already included certain schemes for OOCWs with different scopes, e.g. extended collective licensing schemes. For this reason, the broad concept

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<sup>326</sup> *ibid* rec 35.

<sup>327</sup> Quintais (n 276) 7.

<sup>328</sup> The CDSM Directive rec 35.

<sup>329</sup> Lucie Guibault, ‘Cultural Heritage Online? Settle It in the Country of Origin of the Work’ (2015) 6 *Journal of Intellectual Property, Information Technology and Electronic Commerce Law* 173, 3.

<sup>330</sup> Guibault and Schroff (n 306) 917.

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of the Directive is undoubtedly a positive step for CHIs which can see a variety of types of works being out of commerce. All type of works, including audiovisual works, literary works and phonograms, among others, fall under the scope of the Directive. Moreover, the Directive does not impose any restriction on the 'out-of-commerce' concept. Works that have never been commercialized fall under the scope of the Directive but works that were commercialized but no longer are also fall under the scope of the Directive.

Additionally, the Directive establishes certain publicity measures that CHIs (also CMOs or public authorities) need to comply with regarding the status of the OOCWs and their potential uses. As a result, information on the license - such as on the parties to the license agreement, as well as territories and uses covered under the license - need to be available within the European portal managed by the EUIPO at least six months before the uses are made<sup>331</sup>. This will provide the possibility for rightholders to opt out before such uses are actually made<sup>332</sup>.

To conclude, despite the big opportunities this system brings for CHIs to unlock the potential of OOCWs, it may also entail certain difficulties. According to Keller, the first difficulty could be envisaged in the complexity of the mechanism itself given that works can be presumed to be out of commerce after reasonable efforts have been made. According to the author, this could make sense for literary works but it may be much harder to ascertain this status on other kind of works such as audiovisual works or photographs<sup>333</sup>.

Additionally, a second difficulty of the system could be brought by the fact that the Directive provides the possibility of CMOs to engage in this kind of licenses. However, there is no obligation to put in place such licenses. As a result, a CMO could actually refuse to issue these licenses as these licenses may not be economically interesting for them. In such cases, the CHIs will not be able to rely on the exception as the Directive only provides such possibility when there are no CMOs sufficiently representative<sup>334</sup>.

Another important point of the Directive is the establishment of two types of stakeholder dialogues between CMOs, rightholders and CHIs. The first one relates to the need of establishing those conditions required to presume a work is out of commerce. The second one consists of having regular dialogues by sector in order to foster the uses of licensing mechanisms and to ensure safeguards to rightholders<sup>335</sup>. It is certainly crucial that CHIs engage in these dialogues with CMOs and rightholders in order to provide certain clarity and to ensure their interests are also heard.

Finally, the single European portal managed by the EUIPO will play a crucial role in facilitating that OOCWs are used in a legal certain manner. According to Keller, this portal should also serve as an information hub for CHIs aiming at digitizing OOCWs and therefore it should also support metadata formats commonly used by CHIs. Furthermore, in order to be useful for visual art works, it should also allow publication of thumbnails as part of the identifying information<sup>336</sup>.

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<sup>331</sup> The CDSM Directive art 10(1).

<sup>332</sup> Keller (n 295) 2.

<sup>333</sup> *ibid* 3.

<sup>334</sup> *ibid*.

<sup>335</sup> The CDSM Directive art 11.

<sup>336</sup> Keller (n 295) 4.

Consequently, even if the system entails certain difficulties, the possibility of having licenses or otherwise a fall-back exception, the broad notion of out of commerce together with the possibility for CHIs to engage in dialogues with public authorities, CMOs and rightholders and the Single European portal, could certainly bring the opportunity to unlock the bottleneck that exists nowadays with regards the uses of OOCWs. In addition, the OOC provisions under the Directive should improve the cross-border online access to cultural heritage in Europe<sup>337</sup>.

### 4.5.3 Collective licensing with an extended effect

Under Title III the EU legislator opted for the introduction of certain provisions to facilitate the use of collective licenses with an extended effect due to the need of providing **certain flexibility in the licensing practices** within the digital age<sup>338</sup>. Although some provisions with a reference to extended collective licenses can be found in specific copyright Directives<sup>339</sup>, this is the first general provision in the EU *acquis* of collective licenses with an extended effect<sup>340</sup>. Yet, these provisions are not mandatory for Member States hence their application in national legislations depend on the will of each Member State. Nevertheless, the use of extended collective licenses is commonly being used in the Scandinavian countries, where the system originated in the sixties<sup>341</sup>.

Aiming at enhancing a wider access to content, the Directive provides the possibility to Member States to introduce extended collective licenses (hereinafter 'ECL') schemes with a broader scope than the new licensing provisions for OOCWs (explained under Section 4.5.2) for their use in their territory.

Article 12(1) provides the possibility to introduce ECL based on three types of licensing regimes which are managed by a CMO: (i) through an extension of licensing agreements to rightholders that are not represented by that CMO; (ii) through a licensing agreement that is based in a legal mandate for those rightholders that are not represented by the CMO; (iii) though a legal presumption of representation.

This flexibility in the mechanisms used in the Member States responds to the need of respecting the different legal traditions and practices that are being used within the EU countries.

Consequently, Member States can choose the mechanism to provide ECL subject to two conditions: the first one is that these licenses are only applicable within their territory, and, the second condition is that the CMO entering into these licenses needs to comply with the rules under the Collective Rights Management Directive<sup>342</sup>. These rules will only be briefly mentioned in this deliverable but will be part of a further analysis within comparative analysis in a later deliverable.

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<sup>337</sup> Geiger, Frosio and Bulayenko (n 314) 22.

<sup>338</sup> The CDSM Directive rec 46.

<sup>339</sup> The Orphan Works Directive; The Infosoc Directive; The CRM Directive; The Satellite and Cable Directive.

<sup>340</sup> Quintais (n 276) 7.

<sup>341</sup> Alain Strowel, 'Towards A European Copyright Law : Four Issues To Consider' in Irini Stamatoudi and Paul Torremans (eds), *EU Copyright law: a commentary* (Elgar Commentaries 2014) 1141.

<sup>342</sup> The CDSM Directive rec 46.

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Furthermore, this type of licenses shall only apply in specific areas of use and only when obtaining authorizations from all rightholders is ‘onerous and impractical’ in the sense that it could make the ‘transaction unlikely’<sup>343</sup>.

Briefly, the Directive obliges Member States to introduce certain **safeguards for the legitimate interests of rightholders**. In particular, CMOs in the negotiated license agreements need to (i) be ‘sufficiently representative’ of rightholders for a specific type of work or other subject matter; (ii) guarantee equal treatment among rightholders; (iii) provide an opt-out mechanism for rightholders who have not authorized the license; (iv) take appropriate publicity measures the start of use of such works<sup>344</sup>.

Due to the optional character of these provisions, where Member States opt for the introduction of such ECL mechanisms, the Directive obliges Member States to communicate such arrangements to the European Commission. The Commission will publish such information to ensure transparency within the EU.

Finally, the Commission is obliged to submit a report on the use of this type of licensing mechanisms within the EU to the European Parliament and to the Council by April 2021. If considered appropriate, such report will be accompanied by a legislative proposal on the cross-border effect of these national mechanisms.

#### ***4.5.3.1 Practical implications of collective licensing for CHI***

The development of large digitization projects carried out by CHIs involve the need of obtaining a large amount of authorizations from rightholders in order to reproduce and communicate to the public the digitized works. Obtaining the required authorizations is not always an evident task since the possibility to obtain a license from each rightholder is at times complicated by a variety of factors e.g. the impossibility of locating or identifying the rightholder<sup>345</sup> in case of orphan works or the high transaction costs of rights clearance for digitization of the CHIs’ collections<sup>346</sup>, among others.

Therefore, the provisions introduced under Article 12 allowing the use of the ECL could also be an opportunity for CHIs to digitize their collections and make the works available to the public without negotiating multiple licenses. These new provisions may be applied for any type of work (as long as the requirements are complied with), since the use is not explicitly limited to any specific category of work. Unlike provisions targeting orphan works or OOCWs, Article 12 provides for a broad scope of licenses which may provide certain room for CHIs to engage in digitization of their collections and making them available without concluding different licenses determined by categories of work as long as Member States provide for this kind of schemes within their jurisdictions. While the new provisions are not specially targeting CHIs, they could certainly be a solution for CHIs to digitize a big amount of their collections under one single license, without distinguishing between orphans, OOCWs or still ‘in commerce works’<sup>347</sup>.

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<sup>343</sup> *ibid* art 12(2).

<sup>344</sup> *ibid* art 12(3).

<sup>345</sup> Strowel (n 341) 1141.

<sup>346</sup> Guibault, ‘Cultural Heritage Online? Settle It in the Country of Origin of the Work’ (n 329) 173.

<sup>347</sup> Keller (n 295)5.

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Despite the broad scope of the provision, the territoriality aspect inherent to copyright still plays an important role. The ECL are normally issued only for the territory where the CMO is located as the extension effect of the license is allowed 'by law'<sup>348</sup>.

As a result, the application of this type of licenses will not solve the problem of cross-border sharing of cultural content as these ECL are only allowed within the Member State where the CMO is located. Hence licensing across-borders is not allowed. In practice, this may lead to the undesirable situation of CHIs having to 'geo-block' collections that have been made available online to users that are not located within their territory, when they make them available by virtue of one of these licenses<sup>349</sup>.

Nevertheless, paragraph 6 of Article 12 establishes the need to further analyse and take account of the cross-border effects of these licenses by the Commission, and, if considered appropriate, to draft a legislative proposal that may contemplate introducing a licensing mechanism across borders. Given that this Directive is still being implemented, it remains to be seen how these provisions are included into national systems (if included at all) and whether the EU legislator will address this matter in the future. Meanwhile, this situation will only provide a partial solution for CHIs willing to share their collections as widely as possible.

In addition, the safeguards provided for rightholders under the Directive may not lead to the sought effect of enhancing a wider access to content. The obligation for the CMOs to be 'sufficiently representative' may hinder its application given that there may not be a CMO for all type of works in every Member State. For instance, there may be the case that there is no CMO that represents all rightholders in one jurisdiction, thus, there are 'gaps' in the system which can be due to different factors, e.g. 'there are sectors who have not developed a tradition of collective management. One major example is the film industry and therefore audiovisual works'<sup>350</sup>. Secondly, according to the author, there are also rightholders that did not have in mind commercial exploitation when they created their works, e.g. certain recordings such as recordings of folk music that may form part of CHI's collections. Thirdly, some works like OOCWs may be considered 'old' under this regime and may have suffered certain property transfer agreements during time, making the chain of copyright transfers complex to ascertain<sup>351</sup>. This situation may also have a counter effect for CHIs who may see that part of their collections are unlikely to be included in a license.

#### 4.5.4 New provision on works of visual arts in the public domain

Article 14 contains a remarkable and unexpected provision – it was included at the very last stage of the negotiation process - that may entail important consequences for CHIs as it deals with works in the public domain, many of which are part of the collections of such institutions.

Article 14 states that 'Member States shall provide that, when the term of protection of a work of visual art has expired, any material resulting from an act of reproduction of that work is not subject

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<sup>348</sup> Strowel (n 341) 1142.

<sup>349</sup> Keller (n 295) 6.

<sup>350</sup> Guibault and Schroff (n 306) 928.

<sup>351</sup> *ibid* 929.

to copyright or related rights, unless the material resulting from that act of reproduction is original in the sense that it is the author's own intellectual creation’.

This provision has been the response of the EU legislator to a widespread practice led by CHIs that claim exclusive rights in the digital reproductions of works after the expiry of copyright and/or related rights<sup>352</sup>. According to Recital 53, the cutting back of exclusive rights of so-called reproduction photographers is justified by two arguments. First, ‘in the field of visual arts, the circulation of faithful reproductions of works in the public domain contributes to the access to and promotion of culture, and the access to cultural heritage’. Second, ‘in the digital environment, the protection of such reproductions through copyright or related rights is inconsistent with the expiry of the copyright protection of works’. As result:

Once the copyright of a work of visual arts has expired, it may be reproduced, communicated or used without the author’s consent since it is in the public domain. In addition, **no exclusive rights shall attach to any copy of a public domain work of art, unless the reproduction constitutes its author’s own intellectual creation.**

Actually, this provision merely states the obvious: copyright protection only extends to works that are original. It thereafter reiterates the conditions – the author’s own intellectual creation – which the CJEU has declared to constitute uniform notions of EU law<sup>353</sup>. More precisely, the CJEU established that ‘in order for an intellectual creation to be regarded as an author’s own it must reflect the author’s personality, which is the case if the author was able to express his creative abilities in the production of the work by making free and creative choices’<sup>354</sup>.

Article 14 does not rule out that reproductions of public domain works qualify for copyright protection but only if they meet the threshold of originality. Member States are not allowed to apply different standards and e.g. grant protection to non-original reproductions<sup>355</sup>.

The **scope** of this provision is limited: only works of visual arts fall under the scope of the Directive. Nevertheless, the Directive does not provide a definition of ‘works of visual arts’ hence this will need to be defined in each jurisdiction. It is nevertheless generally understood that ‘works normally included within the category of visual arts include paintings, drawings, photographs, sculptures, architectural works, design works, ceramics, crafts, murals, graffiti, video, etc’<sup>356</sup>.

<sup>352</sup> Paul Keller, Teresa Nobre and Dimitar Dimitrov, ‘Communia Guidelines for the Implementation of the DSM Directive. Article 14’ (2019).

<sup>353</sup> See also Valérie-Laure Benabou and others, ‘Comment of the European Copyright Society on the Implementation of Art.14 of the Directive (EU) 2019/790 on Copyright in the Digital Single Market’ [2020] European Copyright Society 1  
<[https://europeancopyrightsocietydotorg.files.wordpress.com/2020/04/ecs\\_cdsm\\_implementation\\_article\\_14\\_final.pdf](https://europeancopyrightsocietydotorg.files.wordpress.com/2020/04/ecs_cdsm_implementation_article_14_final.pdf)>.

<sup>354</sup> Funke Medien NRW GmbH v Bundesrepublik Deutschland (C- 469/17)EU:C:2019:623 para 19; Eva-Maria Painer v Standard VerlagsGmbH and Others (C–145/10) EU:C:2013:138 paras 87–89.

<sup>355</sup> The CDSM Directive rec 53.

<sup>356</sup> Keller, Nobre and Dimitrov (n 352).

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A problematic issue, which is not discussed in the Directive, is the relationship between Article 14 and some provisions of the Term Directive. The latter allows to recognise a related right in non-original photographs – and eventually non-original film stills. Such a right has been provided in some Member States' national copyright laws (such as in the German Copyright Act). Moreover, copies of related rights for previously unpublished works as well as critical and scientific publications (Articles 4 and 5 of the Term Directive) are also affected by Article 14 of the CDSM Directive. In addition, according to its wording, Article 14 might also apply to other related rights granted by national laws, even if these rights are not (yet) harmonized by EU law, such as, e.g., the rights to non-original audiovisual recordings. Therefore, it is argued that such rights, when they exist, should be abrogated accordingly<sup>357</sup>

Finally, the Directive does not clarify when the material resulting from an act of reproduction of that work should not give rise to exclusive rights, as it only refers to 'when the term of protection of a work of visual art has expired'<sup>358</sup>. This reference could give rise to two different situations. The first situation could relate to those reproductions made after the work has entered in the public domain while the second situation refers to those reproductions made before the work entered in the public domain. These situations would result in legal uncertainty as end-users would need to know when the reproduction was made. However, further legal certainty would be provided if such reference to 'when' is understood as the point where the reproduction is actually used, 'irrespective of when the reproduction was made'<sup>359</sup>.

#### 4.5.4.1 Practical implications for CHIs

Several organizations such as Wikimedia Foundation, Europeana<sup>360</sup> or Communia<sup>361</sup> since long support protecting the public domain, in the sense that no exclusive rights should be granted in any way to such works. According to these organizations, works in the public domain should be free to use and re-use by any third party. Yet, it appears that a practice has been established amongst certain CHIs whereby exclusive rights are claimed on the digital reproductions they make of works in the public domain allowing them to generate further revenues<sup>362</sup>.

It should be stressed that for the first time a Directive provides 'a positive status to works belonging to the public domain, by prohibiting any regaining of exclusivity therein'<sup>363</sup>. Digital non-original reproductions of works of visual arts that are in the public domain must henceforth remain in the public domain.

However, there are certain **shortcomings** in the provision which mainly relate to the scope of Article 14. As was mentioned above, only 'works of visual arts' fall under the scope of Article 14. As no definition is given for this category of works, legal uncertainty and fragmentation may arise. According

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<sup>357</sup> Benabou and others (n 353).

<sup>358</sup> The CDSM Directive art 14.

<sup>359</sup> Benabou and others (n 353) 4.

<sup>360</sup> Europeana Foundation, 'The Europeana Public Domain Charter'.

<sup>361</sup> 'Communia Public Domain Manifesto'.

<sup>362</sup> Frederik Truyen and Charlotte Waelde, 'Copyright, Cultural Heritage and Photography: A Gordian Knot?' in Karol Jan Borowiecki, Neil Forbes and Antonella Fresa (eds), *Cultural Heritage in a Changing World* (Springer International Publishing 2016) 88 <[http://link.springer.com/10.1007/978-3-319-29544-2\\_5](http://link.springer.com/10.1007/978-3-319-29544-2_5)>.

<sup>363</sup> Benabou and others (n 353) 1.

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to the interpretation provided by the European Copyright Society, a definition of works of visual arts within the meaning of the Directive cannot be easily established<sup>364</sup>. For instance, design works or works of architecture and maps are considered works of visual arts in some Member States but not in others<sup>365</sup>. Looking at the Berne Convention, it seems that ‘works of visual arts’ should be understood in a broad sense (see Section 3.2). A too narrow interpretation of such concept should be avoided as it would leave certain works like photographic works or technical drawings out of the scope of Article 14. Excluding certain works could have the undesirable effect of hindering the access and promotion of culture which the provision aims at<sup>366</sup>. Additionally, literature specifies that three dimensional works also fall under the scope of this provisions<sup>367</sup>.

Finally, according to Recital 53 of the Directive, the fact that such reproductions shall not be protected by exclusive rights does not mean that CHIs should provide such reproductions for free. Hence, it seems acceptable for CHIs to sell such reproductions, for instance in the form of postcards<sup>368</sup>.

#### 4.5.5 New rules for online content-sharing service providers and their relevance for CHIs

Article 17 of the Directive regulates the ‘use of protected content by online content-sharing service providers’ (hereinafter ‘OCSSP’). Article 17 is part of the response from the EU legislator within the broader policy initiatives aiming at further increasing the responsibility of online platforms. It aims at tackling the so-called ‘value gap’, which could be defined as ‘the alleged mismatch between the value that online sharing platforms extract from creative content and the revenue returned to the copyright-holders’<sup>369</sup>.

For the purpose of this deliverable and of the inDICEs project, only a brief overview of these rules is provided below since in the majority of cases Article 17 will not have any impact for CHIs (as they do not fall under the definition of OCSSPs). However, there may be a few cases where Article 17 may have an impact on the activities of CHIs and therefore CHIs should be aware of the new rules. These cases are mentioned in the next section.

By way of background, Recital 61 explains how the development of new technologies and online-sharing platforms have, in the last decade, contributed to provide a wider access to e.g. cultural content, given that platforms enable the online access and the sharing of big volumes of cultural content. However, this situation has also generated several copyright-related concerns, especially when cultural content is shared on platforms without the rightholders’ consent, and consequently, without any remuneration to rightholders. As a consequence, ‘legal uncertainty exists as to whether the providers of such services engage in copyright-relevant acts, and need to obtain authorisation from rightholders for content uploaded by their users who do not hold the relevant rights in the

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<sup>364</sup> Benabou and others (n 353).

<sup>365</sup> *ibid* 2.

<sup>366</sup> *ibid*.

<sup>367</sup> Keller (n 295) 6.

<sup>368</sup> The CDSM Directive rec 53.

<sup>369</sup> Quintais (n 276) 10.

uploaded content, without prejudice to the application of exceptions and limitations provided for in Union law<sup>370</sup>.

The most striking novelty of Article 17 is the **special liability regime** that the Directive introduces for such online sharing platforms. In short, there is a shift from secondary liability to primary liability by way of a legal fiction which holds that the platforms concerned do ‘perform an act of communication to the public or an act of making available to the public for the purposes of this Directive when they give the public access to copyright-protected works or other protected subject matter uploaded by their users’<sup>371372</sup>. In other words, unless prior permission has been obtained, they are directly liable for copyright infringement.

As it was the most controversial provision of the Directive, it comes as little surprise that Article 17 is made up of many parts (10 subsections) which seek to address the concerns of the many actors and interests concerned. In this present deliverable, all these subsections will not be presented. Indeed, it seems unlikely that CHIs - if we take their position as a starting point - will qualify as OCSSPs for whom the entire scheme has been worked out.

An OCSSP is defined in Article 2(6) as “a provider of an information society service of which *the main or one of the main purposes* is to store and give the public access to a large amount of copyright-protected works or other protected subject matter *uploaded by its users*, which it *organises and promotes for profit-making purposes*”<sup>373</sup> The italics were added by us to indicate the different cumulative conditions. It appears that the European legislator had platforms as YouTube in mind and also Vimeo, Facebook or similar ones<sup>374</sup>.

Recital 62 further clarifies that only those OCSSPs that ‘play an important role on the online content market by competing with other online content services, such as online audio and video streaming services, for the same audiences’ fall under the scope of the Directive. Even though CHIs are more and more engaging into new ways of attracting and interacting with audiences, their main purpose is not providing access or sharing works that are uploaded by their users. Further, normally CHIs pursue public-interest objectives such as sharing knowledge and culture and certainly not for generating profit as such.

Moreover, Article 2(6) explicitly excludes certain services such as ‘not-for-profit online encyclopaedias, not-for-profit educational and scientific repositories, open source software-developing and-sharing platforms’ as well as ‘providers of electronic communications services as defined in Directive (EU) 2018/1972, online marketplaces, business-to-business cloud services and cloud services that allow users to upload content for their own use’. This exclusion for not-for-profit educational and scientific repositories has certainly been one of the battles of libraries, research and

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<sup>371</sup> The CDSM Directive art 17(1).

<sup>372</sup> See more details in Axel Metzger and others, ‘Selected Aspects of Implementing Article 17 of the Directive on Copyright in the Digital Single Market into National Law – Comment of the European Copyright Society’ (Social Science Research Network 2020) SSRN Scholarly Paper ID 3589323 4 <<https://papers.ssrn.com/abstract=3589323>>; Quintais (n 276) 10.

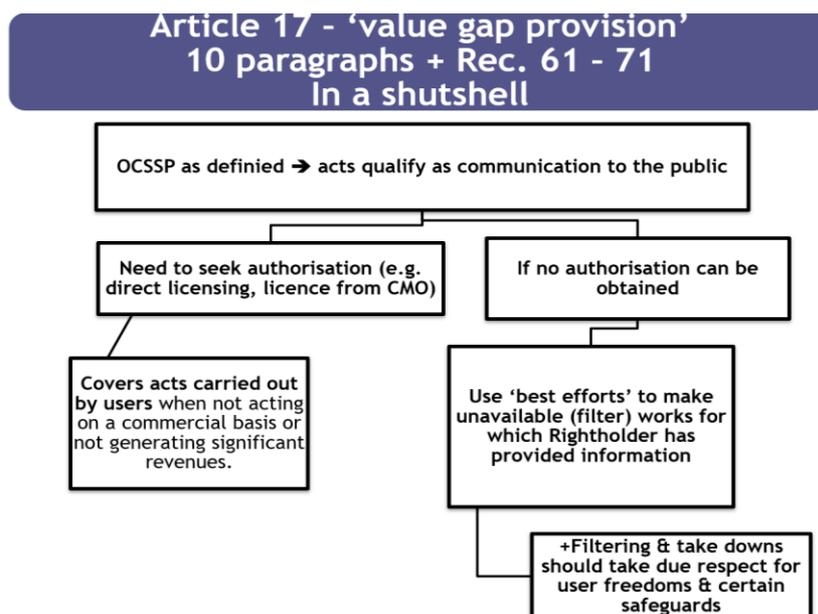
<sup>373</sup> The CDSM Directive art 2(6).

<sup>374</sup> Quintais (n 276) 10.

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open access associations during the legislative process<sup>375</sup>. In their views, research and CHIs share scientific and educational repositories aiming at supporting schools, researchers or libraries users and consequently, pursuing a public objective.

We therefore limit our analysis to the following schematic overview of the mechanism in Article 17.



There are a few elements in this Article 17-mechanism that nevertheless may be of particular relevance to CHIs.

Firstly, to the extent that **CHIs may be the rightholders of content uploaded by users**, OCSSPs would need to negotiate and obtain authorization from them. This situation could certainly lead to CHIs having the need to engage in licenses with OCSSPs in order to allow for such uses of UGC. This could lead to a further generation of revenues for CHIs.

A second rule of interest can be found in Article 17(2) which provides that – in the hypothesis that an authorization has been obtained from the relevant rightholder (see diagram above) - such authorisation shall also cover acts of communication to the public carried out by users of the services when these users are *not acting on a commercial basis or where their activity does not generate significant revenues*. CHIs could possibly benefit from this provision when they upload materials on platforms as YouTube for aims that can be justified by their mission.

Thirdly, it follows from Article 17(7) that, should an OCSSP decide to filter (notice & take/stay down), it must respect the rights of users, and in particular those conferred on them by copyright exceptions (e.g. the exception for OOCWs).

Fourthly, and in a more general manner, **the impact of Article 17 on user-generated-content** (hereinafter 'UGC') will need to be assessed. UGC has become a cornerstone in the new digital era for users engaging with cultural content. As Senftleben explains, 'with the opportunity to upload photos,

<sup>375</sup> IFLA and others, 'Article 13: Protecting the rightholders in online content sharing services without harming Europe's research institutions'.

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films, music and texts, the participative web 2.0 transformed formerly passive users into active contributors to an open, democratic exchange of views and ideas via online discussion and news fora, social media and content repositories<sup>376</sup>. Such UGC may be based on pre-existing works that are in the collections of CHIs. Such pre-existing works could be protected by copyright but could also be in the public domain. While no authorization is needed in the latter case, the ‘filtering’ provisions of Article 17 are for certain authors ‘worrisome’ as they will employ automated content recognition systems which could lead to a certain degree of ‘overblocking’ and even ‘censorship’<sup>377</sup>. The ex-ante control of works will most likely be led by algorithms and content recognition systems. In most cases, it is not clear that industry will provide high-level algorithms that could differentiate between blocking or removing works infringing copyright or works whose uses are permitted by relying in one of the exceptions or that are already in the public domain<sup>378</sup>. This carries the risk that OCSSPs, in order to avoid liability, block systematically content from their sites<sup>379</sup> diminishing opportunities for content creation and dissemination of works<sup>380</sup>. It must be noted that the CJEU prohibited in its ruling of *Netlog/Sabam* case, a general monitoring obligation (with regards to Article 15 of the e-commerce Directive) as it could entail an infringement of fundamental rights of the users<sup>381</sup>.

Finally, CHIs that do not fall under the definition of OCSSP but would still set up a platform on which they ‘host’ copyrighted material uploaded by their users, still remain subject to the liability rules of the E-commerce Directive. Possibly these institutions are able to invoke a limitation of their liability for copyright infringement (‘safe harbour’) under Article 14 of the latter Directive, but this should be examined on the basis of that text.

**This E-commerce Directive**<sup>382</sup> does not form part of the EU copyright *acquis* but contains important provisions with regards to the liability of service providers when hosting third party content in general. It actually includes an exemption of liability for certain intermediaries which was introduced in the early XXI century in order to boost the digital economy and the electronic commerce. Therefore, certain intermediaries were not considered liable for the acts carried out by their users (known as secondary liability). In this context, Articles 12, 13 and 14 of the Directive provide an exemption of liability for those service providers acting as ‘mere conduits’, catching or hosting content. Article 14

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<sup>376</sup> Martin Senftleben, ‘Bermuda Triangle – Licensing, Filtering and Privileging User-Generated Content Under the New Directive on Copyright in the Digital Single Market’ (Social Science Research Network 2019) SSRN Scholarly Paper ID 3367219 2 <<https://papers.ssrn.com/abstract=3367219>>.

<sup>377</sup> Martin Senftleben, ‘Institutionalized Algorithmic Enforcement – The Pros and Cons of the EU Approach to UGC Platform Liability’ (Social Science Research Network 2020) SSRN Scholarly Paper ID 3565175 21 <<https://papers.ssrn.com/abstract=3565175>>.

<sup>378</sup> Senftleben, ‘Bermuda Triangle – Licensing, Filtering and Privileging User-Generated Content Under the New Directive on Copyright in the Digital Single Market’ (n 376) 8.

<sup>379</sup> ‘ALAI Draft Opinion on Certain Aspects of the Implementation of Article 17 of Directive (EU) 2019/790 of 17 April 2019 on Copyright and Related Rights in the Digital Single Market’ 3 <[https://www.alai.org/en/assets/files/resolutions/200330-opinion-article-17-directive-2019\\_790-en.pdf](https://www.alai.org/en/assets/files/resolutions/200330-opinion-article-17-directive-2019_790-en.pdf)>.

<sup>380</sup> Senftleben, ‘Bermuda Triangle – Licensing, Filtering and Privileging User-Generated Content Under the New Directive on Copyright in the Digital Single Market’ (n 376) 5.

<sup>381</sup> *Belgische Vereniging van Auteurs, Componisten en Uitgevers CVBA (SABAM) v Netlog NV (C-36-10) EU:C:2012:85*.

<sup>382</sup> Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market’ The e-commerce Directive’.

provides the so-called 'safe harbour' which continues to apply to hosting platforms that do not qualify as OCSSP and are thus not subject to the stricter regime in Article 17 of the CDSM Directive.

Article 14 of the E-commerce Directive establishes an exemption of liability for those providers that store information provided by a recipient of the service, on condition that: 'the provider does not have actual knowledge of illegal activity or information and, as regards claims for damages, is not aware of facts or circumstances from which the illegal activity or information is apparent; or (b) the provider, upon obtaining such knowledge or awareness, acts expeditiously to remove or to disable access to the information'. It should be kept in mind that this Directive is currently under revision.

#### **4.5.6 New rules on fair remuneration in exploitation contracts for authors and performers**

Articles 18 to 22 of the CDSM Directive provide harmonized protection for authors and performers in their contractual relationship with parties to whom they have transferred or licensed their rights. The fundamental objectives of these Articles 18-22 are to entitle authors and performers to an appropriate and proportionate remuneration; to provide information about the exploitation of their work/performance and to ensure that mechanisms to complain about or revoke an unfair contract are in place.

Due to the little impact that these provisions may have on CHIs, only a brief overview of these articles is provided below.

These rules have a binding nature and cannot be contractually overridden, except if admitted by the Directive (e.g. for contracts concluded by a CMO). Unfortunately, many of these new obligations often leave options to Member States to take account of specific situations or to maintain or enact more protection. Besides a short summary of the new rules, this deliverable will therefore not yet be able to provide uniform guidance for the EU as a whole. It is moreover unlikely that a far-reaching harmonization will result from these provisions because of the importance given to (national) collective bargaining agreements, setting up sectorial codes of practices or model schemes.

For CHIs, it is important to know that some of the contracts that they conclude with authors may have to take these rules of copyright contract law into account. It will be thereby be important to distinguish the situation in which a CHI can be considered an end-user – in which case the rules are not applicable<sup>383</sup> - as opposed to the situation whereby the contract aims at an exploitation of a work or other protected subject matter.

In the latter case, the following new principles should deserve special attention:

- Authors and performers should be guaranteed an appropriate and proportionate remuneration (Article 18);
- Authors and performers are entitled to receive on a regular basis the relevant information necessary to ascertain the revenues derived from the exploitation of their works (Article 19);

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<sup>383</sup> The CDSM Directive rec 72.

- Authors and performers should be entitled to receive an additional, appropriate and fair remuneration if it appears that the originally agreed-upon remuneration is disproportionately low compared with all the subsequent relevant revenues derived from the exploitation of the works or performances (Article 20);  
Authors and performers have the right to claim back their licensed or transferred rights from their counterparty in case there was a lack of exploitation (Article 22).

## 4.6 The Rental and Lending Directive

The Rental and Lending Directive<sup>384</sup>, adopted in 1992, deals with two different matters of copyright law. Firstly, it harmonizes the rental and lending rights for authors and ‘auxiliaries’ like performers, phonogram producers and film producers. Secondly, it harmonizes related rights for performers, phonogram producers, film producers and broadcasting organizations<sup>385</sup>. For the purpose of the inDICEs project, only the first matter will be analysed.

The Rental and Lending Directive is the first and only ‘supranational law’ harmonizing the right of ‘lending’ given the fact that, at international level, only rental rights are included<sup>386</sup>.

As laid down in the Directive, Member States shall provide for ‘a right to authorise or prohibit the rental and lending of originals and copies of copyright works, and other subject matter’<sup>387</sup> to the authors, performers, phonogram producers and film producers. The rental and lending rights do not apply to buildings or works of applied arts.

The term ‘**rental**’ should be understood in the sense of the Directive as ‘the making available for use, for a limited period of time and for direct and economic or commercial advantage’ while the concept of ‘**lending**’ should be understood as the ‘making available for use, for a limited period of time and not for direct or indirect economic or commercial advantage, when it is made through establishments which are accessible to the public’<sup>388</sup>. The main difference between both notions is that the ‘*lending*’ activity must be carried out without generating a profit by public libraries and archives, school or research libraries<sup>389</sup>. On the contrary, the rental right under the Directive provides for an unwaivable right to remuneration for the rental. However, with regard to the lending right, the Directive provides for a derogation from the exclusive right of lending in respect of public lending. This derogation is further analysed in the next section.

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<sup>384</sup> The Rental and Lending Directive.

<sup>385</sup> Sterling (n 67) 995.

<sup>386</sup> Rental rights are not envisaged under the Berne Convention but within the TRIPS Agreement and the 1996 WIPO Treaties, the WPPT and the WCT.

<sup>387</sup> The Rental and Lending Directive art 1(1).

<sup>388</sup> *ibid* art 2(1)(b).

<sup>389</sup> Mireille van Eechoud and others, *Harmonizing European Copyright Law: The Challenges of Better Lawmaking* (Alphen aan den Rijn : Kluwer Law International, 2009) 78.

#### 4.6.1 The public lending derogation

Article 6(1) of the Directive establishes a derogation of the authors' exclusive right 'to authorise or prohibit the rental and lending of originals and copies of copyright works', commonly known as the 'public lending right'<sup>390</sup>. This derogation allows libraries to lend books without the copyright owners' consent as long as remuneration to the authors and other rightholders for such lending is provided.

Within this framework, Member States can freely determine such remuneration according to their 'cultural promotion objectives'<sup>391</sup>.

However, Member States may exempt certain establishments from the payment of such remuneration. In this context, the Directive leaves a high degree of manoeuvre to select the applicable remuneration schemes, even allowing Member States to keep their already-settled systems outside copyright laws. Member States that make the choice to include such derogation in their national systems, can choose the way these remuneration schemes are administered (through collecting societies, public administration etc.) and who is liable to pay such remuneration<sup>392</sup>.

All these optional provisions that are left to the choice of Member States, result in the lack of harmonization of the lending right within the EU. Consequently, the remuneration 'could take several forms: a right of remuneration granted to authors, a legal license with fair compensation, or with no compensation for exempted libraries'<sup>393</sup> as Dusollier explains.

#### E-lending

The advancement of new technologies entailed the commercialization of e-books in the market and therefore the possibility for libraries to also lend this kind of content. Hence, the public lending needs to be adapted to new realities. These new realities undoubtedly involve the extension to digital content. Public lending should reflect this shift in consumption habits.

However, both the exclusive right of lending and the derogation for public lending was meant for tangible works or copies of the work. Yet, the Directive does not explicitly exclude e-lending from its scope<sup>394</sup>.

Nevertheless, most Member States have not considered that the Directive provided the scope for e-lending without the authorization of the copyright holder<sup>395</sup>. As a result, libraries have been providing e-lending through licenses and commercial agreements with authors and other copyright owners<sup>396</sup> in the last years.

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<sup>390</sup> E Linklater-Sahm, 'The Libraries Strike Back: The "Right to e-Lend" under the Rental and Lending Rights Directive: Vereniging Openbare Bibliotheken' (2017) 54 Common Market Law Review 1555.

<sup>391</sup> The Rental and Lending Directive art 6.

<sup>392</sup> Silke von Lewinski, 'The EC Rental Rights Directive Chapter 24' (1996) 1 International Intellectual Property Law & Policy 203.

<sup>393</sup> Severine Dusollier, 'A Manifesto for an E-Lending Limitation in Copyright' (2014) 5 Journal of Intellectual Property, Information Technology and Electronic Commerce Law 213, 222.

<sup>394</sup> *ibid* 217.

<sup>395</sup> Linklater-Sahm (n 390).

<sup>396</sup> Dusollier (n 393) 214.

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E-lending practices have changed the legal position of libraries which enjoyed more autonomy in traditional lending practices. Through the new practices of lending digital content, libraries have lost part of their autonomy given that publishers and other intermediaries (which provide the acquisition of the content) have strongly appeared or their importance have even increased<sup>397</sup>.

This lack of clarity on whether e-lending falls under the scope of the Directive generated certain degree of uncertainty in practice. In consequence, one Dutch association of libraries, brought a case in the Netherlands against the Dutch Public Lending Right Office looking for a declaratory judgment affirming that the current law based on traditional lending models could also be applied to e-lending. The Court of the Hague, in search of further interpretation on whether making e-books available for download within public libraries could be considered as '*lending*' in the sense of the Directive, addressed this question to the CJEU.

The CJEU ruled in the VOB case<sup>398</sup> that the concept of 'lending' within the meaning of the Directive also applied to lending of copies of digital books under the model 'one copy, one user' ('carried out by placing it on the server of the public library and allowing the user concerned to reproduce that copy by downloading it onto his own computer, bearing in mind that only one copy may be downloaded during the lending period and that, after that period has expired, the downloaded copy can no longer be used by that user'<sup>399</sup>). According to the Court, these operations should be regarded as having the same characteristics as lending printed books<sup>400</sup>. Therefore, libraries could, under the public lending derogation, provide e-lending as long as authors are remunerated for the use of their works. This responds to the need of balancing the interests of authors with the objective of cultural promotion, which is a public interest objective underlying the public lending exception of the Directive<sup>401</sup>. Nevertheless, e-lending needs to be treated in the same way as the lending of traditional books.<sup>402</sup>

#### 4.6.2 Practical implications for CHIs

Libraries and other CHIs carry out different activities for preservation and dissemination of knowledge. 'As repositories for cultural artefacts produced by a society, libraries occupy a central place in the politics of access to culture, research and learning'<sup>403</sup> in words of Dusollier.

Given that libraries play a key role in providing **access to knowledge** and learning, lending their collections to the public is one of their main tools to fulfil such mandate.

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<sup>398</sup> *Vereniging Openbare Bibliotheken v Stichting Leenrecht (C-174/15) EU:C:2016:856.*

<sup>399</sup> *ibid* 52.

<sup>400</sup> *ibid* 53.

<sup>401</sup> *ibid* 60.

<sup>402</sup> Janssens and Michaux (n 44).

<sup>403</sup> Dusollier (n 393) 214.

The degree of importance of public lending for the different institutions differs considerably from one institution to another. In this context, public libraries are the institutions that are more involved in public lending<sup>404</sup>.

The public lending right has been introduced by most of the Member States. Yet, this derogation has been unequally implemented. Some Member States have exempted only public libraries from the remuneration scheme while others have broadly implemented this exception including museums or archives among these establishments that are exempted of paying remuneration<sup>405</sup>. Additionally, the categories of works included under the 'lending objects' vary among one jurisdiction to another: in some countries cinematographic works, videograms and phonograms can also be subject to lending<sup>406</sup>.

Undoubtedly the Directive has meant a step forward in the harmonization of the public lending right and has certainly improved the situation before the entrance into force of this Directive. However, the big leeway to the Member States have provoked great divergences among its implementation.

Within this framework, the above-mentioned Court case - the VOB case - has been crucial for those libraries that are operating in the digital environment as clarified the scope of the lending right. The Court ruled that the derogation for public lending could apply to digital content under certain conditions. Such interpretation entailed that libraries do no longer need to negotiate contracts with copyright owners (e.g. publishers) for lending digital books<sup>407</sup>. Moreover, at the public policy level, this judgement seems to recognize the crucial role that libraries play in providing access to culture and knowledge in both the online and offline world.

However, albeit this interpretation, nowadays the current system of e-lending must operate in accordance with the traditional system of lending and this creates certain limitations. For instance, the system of 'one copy, one user' can limit the spread of content, especially in the digital world. Due to this system a waiting list is created which could demotivate users to choose for e-lending instead of buying the e-book in online bookstores<sup>408</sup>. Hence, the potential of e-lending is not yet unlocked in the EU. Some authors claim that in order to have a proper e-lending system within EU libraries, further clarifications or even an exception or limitation would be needed<sup>409</sup>.

## 4.7 The Term Directive

Alike other copyright Directives, the Term Directive (adopted in 1993 and subsequently codified in 2006), aimed at harmonizing the term of copyright protection within the EU in order to remove

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<sup>404</sup> *ibid* 215.

<sup>405</sup> 'Report from the Commission to the Council, the European Parliament and the Economic and Social Committee on the Public Lending Right in the European Union, 12 September 2002, COM(2002) 502 Final.'

<sup>406</sup> *ibid*.

<sup>407</sup> Linklater-Sahm (n 390).

<sup>408</sup> Dusollier (n 393) 225.

<sup>409</sup> Dusollier (n 393).

barriers to the free movement of goods and services and to ensure competition in the single market (Recital 3)<sup>410</sup>.

At international level, both the Berne Convention and the Rome Convention laid down a minimum term of protection<sup>411</sup> allowing contracting parties to establish (if not already done) longer terms of protection<sup>412</sup>.

The Term Directive opts for a horizontal harmonization providing both a minimum and maximum harmonization that would not leave any 'room for national deviations from the European norm'<sup>413</sup>.

Due to the longer life span of individuals within the EU, the legislator considered that the protection should be enlarged in order to cover 'two generations'<sup>414</sup>. In addition, the EU legislator also highlighted the need for harmonizing the moment when the protection should arise.

In the EU, copyright protection of authors' rights is of **70 years after the death of the author**. Related rights for performers, film producers or broadcasters is 50 years after fixation. For performers of musical works and phonogram producers, the term of protection was extended to 70 years after publication or first communication to the public.

In brief, the Directive opts for a term of protection for authors' rights of 'the life of the author and for **70 years after his death**, irrespective of the date when the work is lawfully made available to the public'<sup>415</sup>. The Directive also includes certain rules for calculation of works of joint authorship, anonymous works or audiovisual works, among others. Similarly, the general term for related rights is 50 years after the date of the performance, the date of fixation of film productions or the first transmission of a broadcast.

However, it must be noted that an amendment to the Term Directive in 2011<sup>416</sup> introduced an **exception** extending the term of protection **for the musical sector**. Therefore, this Directive provides the exception according to which if the performance is fixed in a phonogram and is lawfully published or communicated to the public, the expiry of the exclusive rights will only be after 70 years from such publication or communication to the public. In consequence, this Directive creates a division of the term of protection. On the one hand performers of musical works or sounds fixed in a phonogram

<sup>410</sup> The Term Directive.

<sup>411</sup> The Berne Convention established a minimum term of protection for copyrighted works of 50 years after death of the author. .

<sup>412</sup> The TRIPS Agreement art 12 confirms the term of protection established under Berne and Rome Conventions with regards to copyright and related rights.

<sup>413</sup> Christina Angelopoulos, 'The Myth of European Term Harmonisation: 27 Public Domains for the 27 Member States' [2012] SSRN Electronic Journal 3 <<http://www.ssrn.com/abstract=2145862>> accessed 13 February 2020.

<sup>414</sup> The Term Directive rec 6.

<sup>415</sup> *ibid* art 1(1).

<sup>416</sup> Directive 2011/77/EU of the European Parliament and of the Council of 27 September 2011 amending Directive 2006/116/EC on the term of protection of copyright and certain related rights 2011 17.

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enjoy a protection of 70 years after fixation, and, on the other hand, protection of performers whose performances are not fixed in a phonogram or performers of other non-musical works (who keep the term of protection of 50 years after fixation). This is also extended by virtue of the Directive to producers of music recordings<sup>417</sup>.

The Directive only refers to the term of protection of economic rights and does not apply to the term of protection of moral rights. However, the Directive had certain impact on the protection of moral rights in those Member States where the term of protection of moral rights was the same as the one for economic rights, 'so that where the term of economic rights is extended, this will automatically increase the term of protection of moral rights'<sup>418</sup>.

In parallel, the Directive also establishes certain rules for the term of protection of special categories of works: the previously unpublished works, critical and scientific publications and photographs. Due to its relevance to the inDICEs project, the latter will be further analysed in the next section.

In relation to the protection of **previously unpublished works**, the Directive lays down a protection equivalent to the economic rights of the author. The protection extends during 25 years from the time when the work was first lawfully published or lawfully communicated to the public to 'any person who, after the expiry of copyright protection, for the first time lawfully publishes or lawfully communicates to the public a previously unpublished work'<sup>419</sup>. It must be noted that this right is not considered as an extension of the regular term of protection as the beneficiary is not the author but the potential publisher. This provision was introduced as an incentive to reward the efforts made when publishing or communicating to the public the unpublished works<sup>420</sup>.

Concerning **critical and scientific publications**, Article 5 of the Directive provides the possibility to Member States to provide protection to 'critical and scientific publications of works which have come into the public domain'<sup>421</sup>. In this case, the Directive establishes a maximum term of protection of 30 years from the time when the publication was first lawfully published. Nevertheless, the Directive does not provide a definition of 'critical and scientific publications' which needs to be determined by the Member States<sup>422</sup> in case they opt for introducing such provision in their national laws (as it is not a mandatory provision). What is clearly stated within the Directive is that these works must have fallen into the public domain<sup>423</sup>.

Additionally, the Directive includes an **exception of the harmonization of the term of protection**<sup>424</sup>. In particular, when a term of protection is longer in a specific Member State and was already in place on 1<sup>st</sup> July of 1995, 'the Directive does not shorten the term of protection'<sup>425</sup>. This longer term of

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<sup>417</sup> Gemma Minero, 'The Term Directive' in Irini Stamatoudi and Paul Torremans (eds), *EU Copyright law: a commentary* (Elgar Commentaries 2014) 269.

<sup>418</sup> Sterling (n 67) 1022.

<sup>419</sup> The Term Directive.

<sup>420</sup> Minero (n 417) 273.

<sup>421</sup> The Term Directive.

<sup>422</sup> Angelopoulos (n 413) 12.

<sup>423</sup> Minero (n 417) 275.

<sup>424</sup> The Term Directive art 10.

<sup>425</sup> Sterling (n 67) 1031.

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protection applies to all works protected by copyright and related rights that was protected in at least one Member State before that date. However, this longer term of protection only applies in that Member State where the longer term of protection was in place before the above-mentioned date<sup>426</sup>. This provision relies on the principle of EU law to respect the acquired rights. Therefore, the Directive did not aim at shortening the protection of already acquired rights by rightholders in the EU. In consequence, when there was already a longer term of protection running in one Member State before 1 July 1995, the Directive allows it to keep on running until its expiry<sup>427</sup>. Within this framework, there are certain Member States which have certain exceptions in their national laws in this regard. For instance, in the French IP Code there are certain provisions extending the term of protection for works that were protected under copyright between the First and the Second World War or for those authors that died for France. In the same context, Spain provided for an extension of the term of protection for those authors who died before 7 December 1987 of 80 years post mortem (e.g. Pablo Picasso)<sup>428</sup>.

#### 4.7.1 Protection of photographs

Protection of photographs within the Member States was (and still remains) particularly unharmonized in the EU as the protection provided for photographs vary considerably from one jurisdiction to another.

The Term Directive provides harmonization for **original photographs** that can be qualified for copyright protection. Protection of other **non-original photographs** is not harmonized at EU level.

At international level, the inclusion of photographic works within the list of ‘literary and artistic works’ of Article 2 of the Berne Convention was only made during the Brussels revision of the Convention, after several debates.<sup>429</sup>

In this context, the Term Directive not only harmonizes the term of protection within EU Member States but also the scope of an ‘artistic work’ in the sense of the Berne Convention with regards to photographs. Further, the Term Directive harmonizes its position at least for those original photographs that satisfy the criterion of originality<sup>430</sup>.

In consequence, Article 6 of the Directive provides the same term of copyright protection for ‘original photographs’ ‘in the sense that they are the author's own intellectual creation. No other criteria shall

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<sup>426</sup> Angelopoulos (n 413) 8.

<sup>427</sup> Minero (n 417) 287.

<sup>428</sup> Angelopoulos (n 413) 9.

<sup>429</sup> Thomas Margoni, ‘The Digitisation of Cultural Heritage: Originality, Derivative Works and (Non) Original Photographs’ [2014] SSRN Electronic Journal 26 <<http://www.ssrn.com/abstract=2573104>>.

<sup>430</sup> Sterling (n 67) 1026.

be applied to determine their eligibility for protection'<sup>431</sup>. This criterion is further emphasized in Recital 17 where it is established that a photograph is original if it is the author's intellectual creation, 'reflecting his personality'.

The CJEU further interpreted the criterion of originality in relation to photographic works in the judgement of *Painer*<sup>432</sup>. Here, the Court ruled that the photographer can indeed make several creative choices when taking a photograph and in different moments of the creative process<sup>433</sup>. According to the Court, it is in the manner of making various choices where 'the author of a portrait photograph can stamp the work created with his 'personal touch''<sup>434</sup>. This judgement also demonstrates that even a realistic photograph containing a portrait could achieve the originality requirement requested to be protected under copyright<sup>435</sup>.

### Non-original photographs

The Directive gives the possibility to Member States to provide 'for the protection of other photographs'<sup>436</sup>. The Directive refers to those photographs that are not original within the meaning of the Directive. Therefore, the protection of non-original photographs has completely been left to the discretion of the Member States<sup>437</sup> who may introduce a neighbouring or related right to protect these photographs. The Directive also remains silent on the duration of this potential protection<sup>438</sup>. Thus, this matter remains unharmonized.

Within this framework, some countries have implemented certain neighbouring rights to protect this kind of non-original photographs granting normally a shorter term of protection. According to Margoni, it is this aspect where there are the biggest divergences between Member States<sup>439</sup>.

Concerning the 'subjective element' of protection, in the sense of which criteria is necessary to determine certain level of protection for the photographic work, it needs to be below the one required for original photographs (which are granted copyright protection). Nevertheless, 'there needs to be a minimum element of craftsmanship, intellectual input of photographic activity involved. This minimum amount is necessary to "draw the line of demarcation between photography on the one hand and mere copying on the other" and is left to the discretion of Member States'<sup>440</sup>.

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<sup>431</sup> The Term Directive art 6.

<sup>432</sup> *Eva-Maria Painer v Standard VerlagsGmbH and Others (C-145/10) EU:C:2013:138*.

<sup>433</sup> First, 'in the preparation phase, the photographer can choose the background, the subject's pose and the lighting. When taking a portrait photograph, he can choose the framing, the angle of view and the atmosphere created. Finally, when selecting the snapshot, the photographer may choose from a variety of developing techniques the one he wishes to adopt or, where appropriate, use computer software'

<sup>434</sup> *Eva-Maria Painer v Standard VerlagsGmbH and Others (C-145/10) EU:C:2013:138*.

<sup>435</sup> Sunimal Mendis, *A Copyright Gambit: On the Need for Exclusive Rights in Digitised Versions of Public Domain Textual Materials in Europe* (1st ed. 2019., Berlin, Heidelberg : Springer Berlin Heidelberg : Imprint Springer, 2019) 139.

<sup>436</sup> The Term Directive art 6.

<sup>437</sup> Margoni (n 429) 12.

<sup>438</sup> Angelopoulos (n 413) 12.

<sup>439</sup> Margoni (n 429) 28.

<sup>440</sup> *ibid.*

This lack of harmonization may entail that some photographs are protected under copyright protection in one jurisdiction while they are only protected under another related protection in another jurisdiction<sup>441</sup>.

#### 4.7.2 Practical implications for CHIs

The protection of photographs and non-original photographs attracts a particular interest for CHIs in the context of digitization processes: first of all, with regards to copyright or related rights protection of photographs in their collections, and, secondly, with regards to the potential copyright protection of the digitized photographs<sup>442</sup> that could involve potential restriction to the re-use of works in the public domain. The latter will be analysed under Section 6 on digital reproductions of works of visual arts in the public domain

Concerning the first question, the **digitization of works** archived in collections of cultural institutions normally requires making a copy or a photograph of the work to be digitized in order to produce a copy in digital format. Digitization of works can be made through different technical processes requiring more or less human intervention<sup>443</sup>.

It is in this case where protection of photographic works of other works may entail copyright-related issues. As seen above, photographs in the EU can be protected by copyright as long as they are original. Nevertheless, non-original photographs could also be protected by a related right in some countries as their protection has been left to the choice of Member States. Given there is no uniform protection for this kind of photographs within the EU territory, their protection notably depends on the jurisdiction where the cultural institution keeping/making the photograph is located. Furthermore, protection of photographs within the digitization process mainly depends on their consideration as an original or non-original photograph. To determine their categorization and hence their protection, the level of human intervention needs to be assessed. For instance, whether the photographer is able to carry out creative choices when making the photograph or the level of human intervention in the post production process (e.g. images of low quality).

In addition, if the work is very fragile or damaged, a higher degree of human intervention may be required in order to modify or correct the image allowing for a correct visualization of the work<sup>444</sup>.

All these human interventions need to be carefully assessed for the purpose of classifying photographs as original and non-original. This classification is crucial to assess the copyright or related rights protection of a certain work. It must be noted that cultural institutions rely on these images of digitized content to obtain further revenues through the licensing of these images<sup>445</sup> by claiming exclusive rights on them.

The lack of harmonization of protection of non-original photographs (and also

<sup>441</sup> Angelopoulos (n 413) 12.

<sup>442</sup> Truyen and Waelde (n 362) 82.

<sup>443</sup> Margoni (n 429).  
State where the CHI is located.

<sup>444</sup> Mendis (n 435) 125.

<sup>445</sup> Truyen and Waelde (n 362) 84.

In addition, protection of photographs of works in the public domain raise also other copyright-related problems which are analysed under Section 6 and under Section 4.5.4 (Article 14 of the CDSM Directive).

Finally, the **term of protection** of specific works included in the Directive leads also to an unharmonization of the term of protection. For instance, in the case of unpublished works, the Directive provides the possibility for Member States to enlarge its copyright protection to any person who for the first time lawfully publishes or lawfully communicates it to the public. This provision has also created divergences in the implementation within the Member States. Further, some of Member States have extended copyright protection to works that were never protected under copyright<sup>446</sup>.

For those unpublished works that are not in the public domain, different rules may be also applied depending on the Member State. As Angelopoulos explain, 'although unlikely to affect the term of protection of well-known masterpieces, these provisions could be of great relevance for the digitisation efforts of archives, libraries and other cultural heritage institutions interested in making available online works of historical or scientific value, such as unpublished vintage photographs, personal diaries or academic theses'<sup>447</sup>. To conclude, the different term of protection for certain works entail divergences among the Member States. As a result, some works that in one Member State may have fallen in the public domain, in other countries may be still protected through copyright or another neighbouring right<sup>448</sup>.

## 5 Other non-harmonized matters

### 5.1 Derivative works: adaptation and translation rights

#### 5.1.1 General overview



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<sup>446</sup> Angelopoulos (n 413) 13.

<sup>447</sup> *ibid* 10.

<sup>448</sup> *ibid* 14.

Derivative works can be defined as those **works that are based on pre-existing works**<sup>449</sup>.

According to the Berne Convention, it is generally understood that derivative works may entail four types of works: translations, adaptations, musical arrangements and other alterations<sup>450</sup>.

The **adaptation right** is an exclusive economic right which provides the authors the right to control the transformation of his work, normally into another type or presentation of the work. For instance, transformation of a written novel into a film<sup>451</sup>.

The Berne Convention explicitly envisages the right of adaptation in its Article 12: ‘translations, adaptations, arrangements of music and other alterations of a literary or artistic work shall be protected as original works without prejudice to the copyright in the original work’<sup>452</sup>. Therefore, it is established that authors have the right of authorizing adaptations, arrangements and other alterations of their works, even if the alteration is minor. But because of the lack of an exact definition of what constitutes an adaptation the contracting parties dispose of much manoeuvring space<sup>453</sup>.

In some jurisdictions the right of adaptation is perceived as part of the right of reproduction as adaptation normally entails reproduction of the work<sup>454</sup>. Furthermore, and even though the Berne Convention establishes the translation right as a separate right in its Article 8, some national legislations conceived the **translation right** as part of the right of adaptation.<sup>455</sup> Yet, what exactly is to be considered a translation – some authors distinguish between ‘literal, elucidative and paraphrastic’ translations<sup>456</sup> – is again a matter to be entirely resolved under domestic law.

Adaptations of a work (in their broad meaning) that are original may confer copyright protection on the author of the new work, which is independent from the copyright that exists in the underlying work<sup>457</sup>. Consequently, there are two issues to distinguish: the first one is that in order to create an adaptation of the work, the authorization from the rightholder of the original work is needed. Otherwise it would constitute an infringement of the original work. Secondly, if the derivative work qualifies for copyright protection, its use is forbidden without the consent of the rightholder unless its use falls under an exception to copyright or the pre-existing work has fallen in the public domain<sup>458</sup>.

In the EU it is considered that the adaptation right (nor the translation right) has not been harmonized, but it remains **applicable** in all Member States as a consequence of the Berne Convention.

<sup>449</sup> Margoni (n 429) 18.

<sup>450</sup> Daniel Gervais, ‘The Derivative Right, or Why Copyright Law Protects Foxes Better than Hedgehogs’ (2013) 15 Vanderbilt Journal of Entertainment and Technology Law 820, 820.

<sup>451</sup> Sterling (n 67) 432.

<sup>452</sup> The Berne Convention.

<sup>453</sup> ; Gervais (n 485) 821

<sup>454</sup> Sterling (n 67) 785.

<sup>455</sup> *ibid* 1251.

<sup>456</sup> *ibid* 291.

<sup>457</sup> Hugenholtz and Dreier (n 165).

<sup>458</sup> Margoni (n 429) 19.

The majority opinion holds that the adaptation right is not included in the fully harmonised concept of the right of reproduction in Article 2 of the Infosoc Directive. The regulation of derivative works is therefore left to the discretion of Member States<sup>459</sup>. It may, however, not be excluded that the CJEU should come to a different conclusion in the future<sup>460</sup>.

An exception to our previous holding should be made in respect of computer programmes and databases. The relevant Directives explicitly mention ‘adaptation, translation, arrangement and any other alteration’ amongst the restricted acts (see Article 4 of the Software Directive and Article 5 of the Database Directive).

### 5.1.2 Practical implications for CHIs and the digitization of works

The adaptation right is recognised in all domestic copyright acts of Member States<sup>461</sup> and has become very relevant in the context of the internet.

The adaptation and translation rights and, in consequence, the creation of derivative works may be of significant importance to cultural institutions, in particular, in the context of digitization processes. Adaptation rights are also of particular relevance due to the emergence of the phenomena of the Culture 3.0<sup>462</sup> revolution, which fosters participation of users in the creation of cultural content, mostly based on pre-existing works.

There may, firstly, be a **rights clearance issue**. Digitized content based on pre-existing works – protected under copyright or not – may, as it was explained above, be considered as derivative works and, therefore, could enjoy IP protection on their own. Therefore, depending on whether the original work is copyright protected or not, clearance of rights of both the original and of the derivative work may be needed for further uses. This is an important factor that CHIs should take into account when having to organise their rights’ clearance policies.

Secondly, debates exist on to what extent **preserved or restored works** can be considered as derivative works giving rise to independent copyright protection. Obviously, the answer will depend on the ‘originality’ of the input as only works that are original in the sense that they are the result of an intellectual creation that shows the personality of an author, are copyrightable. Yet, this may not always be easy to determine in practice as this depends on the types of intervention which an act of reconstruction may entail, as well as on the characteristics of the pre-existing work. For instance, restoration of an artwork differs considerably from a restoration of a piece of music where certain

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<sup>459</sup> *ibid* 21.

<sup>460</sup> In an implicit way, the court hinted to such outcome in the case *Art & Allposters International BV v Stichting Pictoright (C-419/13)EU:C:2015:27*.

<sup>461</sup> Hugenholtz and Dreier (n 165).

<sup>462</sup> Pier Luigi Sacco, Guido Ferilli and Giorgio Tavano Blessi, ‘From Culture 1.0 to Culture 3.0: Three Socio-Technical Regimes of Social and Economic Value Creation through Culture, and Their Impact on European Cohesion Policies’ (2018) 10 Sustainability 3923, 6.

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parts are missing<sup>463</sup>. Ramahtian distinguished between the following different types of restorative interventions: (i) preservation and protection from decay; (ii) adding of missing parts in the spirit of the existing torso; (iii) combination of fragments to form the original whole ('puzzle'); (iv) 'creative' restorative intervention and creation of whole works in the spirit and style of the lost work; (v) creation of a new work in the spirit and style of an artist or/and an era; (vi) transformative uses of pre-existing (public domain) works<sup>464</sup>. Without entering into the details for each category, it can be said that pure technical tasks of conservation of works will obviously not meet the threshold of originality to be granted copyright protection. On the other hand, the more restorative intervention occurs, the more there is scope for independent creation deserving copyright protection<sup>465</sup>. Restoration activities, even though they are far from being 'novel', can indeed reflect the personality of the restorer. For this reason, most of the civil law countries do have the tendency of providing such copyright protection to the restorer<sup>466</sup>.

Unfortunately, due to the **lack of EU harmonisation** regarding the right of adaption, there remains much fragmentation and uncertainty. For example, in some countries the colouring of a black and white film has been given copyright protection. The completion of an unfinished work could also be protected under copyright irrespective of whether the pre-existing work has fallen in the public domain<sup>467</sup>. For instance, in a French case on a reconstruction of an old text<sup>468</sup>, the Court reminded that an assessment needs to be made as to whether the restorer could make creative choices in the restoration of a work as IPR protection does not aim to protect all scientific or intellectual work. Applying this rule to the case at hand, the Court refused to grant copyright protection to the reconstruction of the ancient texts considering that the restoration works were merely guided by the objective to restore the integrity and authenticity of the original works, without demonstrating any free choices and hence the personality of the restorer.

Thirdly, with the advancement of digital technologies and the change of consumption habits, especially of cultural content, the adaptation right poses certain challenges in relation with **the use and re-use of cultural content in the context** of UGC.

As previously mentioned, one of the roles of cultural institutions is the wide dissemination of their collections. However, in the information society, CHIs are not only searching for new ways of dissemination, but they also are 'redefining themselves as learning and experience environments'<sup>469</sup>. CHIs are hence encouraged to take advantage of new technologies in order to engage new audiences<sup>470</sup>. 'Within this context, some museums have become particularly participatory in nature

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<sup>463</sup> Andreas Rahmatian, 'Copyright Protection for the Restoration, Reconstruction and Digitisation of Public Domain Works' in Estelle Derclaye (ed), *Copyright and cultural heritage. Preservation and access to works in the digital world* (Edward Elgar Publishing 2010) 50.

<sup>464</sup> *ibid* 51.

<sup>465</sup> *ibid* 53.

<sup>466</sup> Estelle Derclaye (ed), *Copyright and Cultural Heritage: Preservation and Access to Works in a Digital World* (Elgar 2010) 64.

<sup>467</sup> *ibid* 66.

<sup>468</sup> *Librairie Droz c/ SARL Classiques Garnier et autres* [2014] Tribunal Grande Instance de Paris, 3e ch RG n°11/01444.

<sup>469</sup> Megan M Carpenter, 'Drawing a Line in the Sand: Copyright Law and New Museums' (2011) 13 *Vanderbilt Journal of Entertainment and Technology Law* 463, 478.

<sup>470</sup> *ibid* 479.

and create content experiences wherein visitors are content creators, collaborators, distributors, consumers, and critics<sup>471</sup>. In this Culture 3.0 scenario, it is complex to distinguish cultural producers and users themselves<sup>472</sup>.

Other museums, looking for alternatives for traditional exhibitions, are engaging in creative ways of displaying works, including certain ‘collaborative spaces’ with end-users, making use of derivative works of pre-existing works<sup>473</sup> and UGC. In many – if not most – of these cases, the application of the adaptation right should be carefully monitored. Where the CHIs own the copyright to the works, this problem is less acute (even though there might be moral rights concerns – see below Section 5.2). Yet in many cases, CHIs keep, preserve and display in-copyright works owned by third parties. It is in this case scenario, that CHIs need to be attentive to proper rights clearance before allowing consumers and/or end-users to ‘transform’ or interact with these works (unless a copyright exception would apply).

Finally, it must be mentioned that cultural institutions in their goal to generate further revenues through the gift shops (online and offline), **may offer a good number of derivative works** – mugs, puzzles, umbrellas etc. – based on pre-existing in-copyright works. In many cases CHIs may not themselves be the manufacturers of these objects, but they should at least be attentive to the possible application of the exclusive right of the author to authorize adaptations or alterations of the works.

To be noted, the right of adaptation may raise important moral rights issues that will be discussed in Section 5.2. Other relevant issues are also analysed in an earlier section dealing with photographs (original and non-original in the sense of the Term Directive) under Section 4.7 as well as in Section 6, dealing with works in the public domain.

## 5.2 Moral rights

### 5.2.1 General overview

Copyright is generally conceived as a ‘bundle of rights’ divided into two categories: economic rights and moral rights.

**‘Moral rights offer legal recognition to an author’s special relationship with his or her own work’<sup>474</sup>.**

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<sup>471</sup> *ibid* 480.

<sup>472</sup> Pier Luigi Sacco, Guido Ferilli and Giorgio Tavano Blessi (n 462).

<sup>473</sup> Carpenter (n 469) 495.

<sup>474</sup> Mira T Sundara Rajan, *Moral Rights: Principles, Practice and New Technology* (Oxford University Press 2011) 5 <<https://www.oxfordscholarship.com/10.1093/acprof:osobl/9780195390315.001.0001/acprof-9780195390315>>.

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Moral rights are those rights granted to authors of protected works which relate to the protection of the personality of the author and the integrity of his work<sup>475</sup>. As explained by Rajan, ‘the purpose of moral rights is to protect the author from suffering the consequences of moral, intellectual, or spiritual harm inflicted on him through the mistreatment of his work’<sup>476</sup>.

Moral rights, or at least two attributed thereof, are internationally anchored in the Berne Convention. ‘Enshrined in its Article 6bis, the right of attribution and the right of integrity together lay down a minimum standard that is by now adopted on a nearly worldwide basis’<sup>477</sup>. Besides these two rights and depending on the jurisdiction, also the right of divulgation and the right of retraction form part of the system of moral rights.

It is important to underline that the scope of these various moral rights varies significantly depending on the jurisdiction. This is also the case within the EU, as the issue of moral rights has thus so far not been subject of harmonisation at all<sup>478</sup>. This is regrettable as ‘one can easily understand that a (different) application of moral rights impacts on the free circulation of creative content across the EU in the modern digital context’<sup>479</sup>.

Nevertheless, there are some **common features** among the different moral rights.

Firstly, moral rights are **independent from economic rights** as it is expressly stated in the Berne Convention. Moral rights continue to ‘belong’ to the author irrespective of whether the author retains the economic rights or not.

Secondly, the **term of protection** may be different from the term of economic rights. The Berne Convention only provides that moral rights must be maintained at least until the expiry of economic rights<sup>480</sup>. In civil law countries, duration typically extends after the death of the author while for common law countries moral rights may cease with the author’s death. For Rajan, moral rights are strictly linked to the author whose reputation and honour stays after his death. It is after author’s death when moral rights become ‘an instrument of cultural policy’<sup>481</sup> and it is the public who has an interest in maintaining the cultural heritage.

Thirdly, moral rights are **inalienable** as a matter of principle. An author cannot deprive himself of his moral rights through a contract even if the author would want to do so<sup>482</sup>. However, they can be waived in certain jurisdictions and under certain conditions. As Janssens explains, ‘the general rule is that moral rights are inalienable but few countries apply this rule in such an extreme manner. While a blanket renunciation of the exercise of moral rights will often be held null and void, a waiver of a

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<sup>475</sup> Sterling (n 67) 392.

<sup>476</sup> Rajan (n 474) 7.

<sup>477</sup> Marie-Christine Janssens, ‘Invitation for a “Europeanification” of Moral Rights’, *Research Handbook on Copyright* (Edward Elgar Publishing 2017) 1.

<sup>478</sup> *ibid* 3.

<sup>479</sup> *ibid* 7.

<sup>480</sup> The Berne Convention art 6bis(2).

<sup>481</sup> Rajan (n 474) 15.

<sup>482</sup> *ibid* 68.

particular moral right (often the right of integrity) in relation to clearly defined creations is frequently admitted<sup>483</sup>.

### 5.2.2 The individual moral rights

**The right of attribution**, or ‘paternity right’ as it is also called, relates to the author’s right to be acknowledged as the creator of his work. The author has also the right of choosing to publish his work under a pseudonymous or even anonymously. In this context, the right of attribution may be infringed when a work is wrongly attributed to a person other than the author of the work. This right is particularly relevant in those cases where the author assigns all economic rights to another person, for instance a publisher<sup>484</sup>, as he must – mandatorily because of the recognition in the Berne Convention - maintain the right of being recognized as the author of the work.

**The right of integrity** is perceived as ‘the most important right of the moral rights’<sup>485</sup>. It guarantees that the author can shield his creative personality by giving him the right to oppose distortions or other derogatory action amounting to misrepresentation of his honour and reputation<sup>486</sup>.

**‘The author shall have the right to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honour or reputation’<sup>487</sup>.**

From this definition, it can be easily understood that the right of integrity is closely connected to the right of adaptation (as it refers to a modification or alteration of the work) but ‘it does not merge it’<sup>488</sup>. Modifying a work is only a condition (and not even necessary) for breaching the right of integrity. For instance, while making a translation of a work without the consent from the author may entail copyright infringement of the economic right of adaptation/translation, the realization of a bad translation could actually constitute a breach of the right of integrity even in case authorization for the translation has been given by the original author<sup>489</sup>. Thus, in practice, the right of integrity may have a broader scope than the right of adaptation as it may be infringed without there being a violation of the right of adaptation, e.g. in case the work is not modified but merely used in an inappropriate context<sup>490</sup>.

The Berne Convention only safeguards the right of the author to oppose distortions or other derogatory action amounting to misrepresentation of their honour and reputation, but many

<sup>483</sup> Janssens and Michaux (n 44) 397.

<sup>484</sup> Sterling (n 67) 396.

<sup>485</sup> *ibid.*

<sup>486</sup> Janssens and Michaux (n 44) 396.

<sup>487</sup> The Berne Convention art 6bis(1).

<sup>488</sup> Borghi (n 254) 95.

<sup>489</sup> *ibid* 96.

<sup>490</sup> *ibid.*

countries provide protection beyond this minimum level and allow authors to oppose other changes to their work (often) on the condition that the prejudice can be demonstrated.

Despite not being included in the Berne Convention, there are other two moral rights that are recognized in a number of jurisdictions: the right of disclosure and the right of retraction.

The **right of disclosure** or the divulgation right is the right of the author to determine when the work can be first divulged to the public and under which circumstances<sup>491</sup>. This right has a clear connection with the economic rights of reproduction and communication to the public. In many cases the decision to divulgate will coincide with the first exploitation of the work (e.g. the authorization for a first edition of a book) and it is not always easy to draw the line between the moral and the economic attributes<sup>492</sup>.

The **right of retraction** under which the artist can withdraw a work from circulation after it is published, constitutes an exceptional attribute that is only recognized in a limited number of civil law countries, including Germany, Spain, France, Italy, Portugal, Slovenia and Croatia<sup>493</sup>. The law often imposes the obligation on the author to compensate the harm suffered by third parties in case the author decides to exercise this right.

Finally, there may be other moral rights or *quasi* moral rights in some jurisdictions.

### 5.2.3 Moral rights in the digital age

In the opinion of Rajan, moral rights in the digital age face mainly three challenges: ‘first, copyright law has become the primary form of legal regulation governing new technologies. Second, new technologies and artistic creation can overlap and present conflicting issues. (...). Third, new technologies have also made it possible for members of the public to intervene in creative works in a new way, making seamless and imperceptible changes’<sup>494</sup>.

Internet users organize themselves, interact freely and participate in the creation, co-creation or re-use of copyright protected content. “Cyber-space” has been described ‘as dominated by large scale peer-production instead of centralised information production, re-mix or “read-and-write” culture instead of “read only” culture’<sup>495</sup>. The traditional relationship between authorship and content consumers is now blurred as traditional consumers can be considered as creators at the same time. Sacco rightly observes that ‘the Culture 3.0 “revolution” is characterized by the explosion of the pool of producers, making it increasingly difficult to draw a meaningful distinction between cultural producers and users themselves’<sup>496</sup>.

This matter presents profound challenges to copyright, including the moral rights of attribution and integrity. Both rights are actually more vulnerable online than offline<sup>497</sup>. Moral rights are also difficult

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<sup>491</sup> Sterling (n 67) 395.

<sup>492</sup> Janssens (n 477) 12.

<sup>493</sup> *ibid* 2.

<sup>494</sup> Rajan (n 474) 1.

<sup>495</sup> Borghi (n 254) 91.

<sup>496</sup> Pier Luigi Sacco, Guido Ferilli and Giorgio Tavano Blessi (n 462) 6.

<sup>497</sup> Janssens (n 477) 8.

to enforce in the online environment. The application of technical protection measures (see Section 4.1.4) can possibly help to solve the difficulties to monitor (infringing) uses and to enforce moral rights.

#### 5.2.4 Practical implications of moral rights for CHIs in the digital environment

Changes of cultural consumption habits and the rise of further technological developments make that moral rights are more relevant than ever.

On the one hand, the digital environment provides for a more vulnerable territory where it is easier to distort, destruct or misappropriate cultural works and therefore authors are left with a lesser degree of protection than in the offline environment.

On the other hand, moral rights deserve recognition to ‘turn social attention to the human side of culture—to help to maintain the connection between human beings and their creative work, whether it takes the form of art or software, and to encourage the use of technology as a means of connecting human beings with one another. Moral rights support human rights, and human values, in a technological society’<sup>498</sup>.

Relevance of moral rights for CHIs can take a variety of forms. For instance, compliance with moral rights in museums could range from ‘the way in which an artwork is presented; to separating an artwork from its intended whole; to painting a sculpture a different colour; to removing a sculpture from the spot for which it was commissioned and where the artist meant it to remain. As concerns TCEs, this could involve, for example, a sacred design being copied on a carpet, which people could walk on’<sup>499</sup>. Given its relevance for CHIs, other areas are analysed in further detailed below.

Concerning **the preservation of works**, moral rights can contribute to the objective of preserving the cultural heritage for the benefit of the society as it is in the interest of society that the integrity of works that form part of our cultural heritage is safeguarded<sup>500</sup>. As Rajan observes, ‘the right of integrity has an obvious connection with culture; its objective is the protection of cultural heritage, whether material or intangible, from damage’<sup>501</sup>. According to this scholar, for those moral rights that remain in force after the death of the author, they can definitely ‘enrich the protection of the cultural heritage’<sup>502</sup>. Similarly, in those (few) jurisdictions where the right of integrity continues to apply to works in the public domain, it contributes to preserving our cultural heritage through the time. Moral rights (and other types of protection) have therefore been seen by UNESCO as a possible legal mechanism to protect public domain material<sup>503</sup>.

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<sup>498</sup> Rajan (n 474) 535.

<sup>499</sup> Torsen and Anderson (n 34) 29.

<sup>500</sup> Borghi (n 254) 48.

<sup>501</sup> Rajan (n 474) 5.

<sup>502</sup> *ibid* 465.

<sup>503</sup> Draft recommendation to Member States on the safeguarding of works in the public domain, 1993, 27 C/40, General Conference, 27th Session; Report on Intellectual Works of universal value that have fallen into the public domain and are regarded as forming part of the common heritage of humanity, UNESCO General Conference, 1999, 30 C/56.

Consequently, CHIs, in their role of preserving and disseminating cultural heritage, should absolutely familiarize themselves and observe the rules relating to moral rights that are applicable under their domestic law (as no harmonised EU-norms exist in this respect).

**Moral rights** do not merely concern the interests of individual authors individually but also **play a key role in preserving the integrity of cultural heritage for the benefit of the society**<sup>504</sup>.

Another task of CHIs in which moral rights deserve attention concerns **the dissemination of works**. Indeed, certain attributes of moral rights (in particular the right of integrity) could entail extra restrictions to the manner in which access to works is organised whether it is for purely non-commercial purposes or for new creative projects.

Furthermore, moral rights should be considered in the context of **product development based on their collections**<sup>505</sup>. Museums shops and other CHIs often exploit derivative works, such as mugs or umbrellas, based on in-copyright works in their collections. CHIs should make sure that such items are only offered with full respect of the right of integrity and the right of attribution.

Obviously, **moral rights** should be given the same respect in relation with activities **in the online environment** (e.g. digitization projects<sup>506</sup>) which may be more complicated in practice<sup>507</sup>, in particular for exploitations on a large scale.

First of all, it must be noted that **digitized content is more vulnerable** and easier to be manipulated. Digital works can be easily divided, allowing uses of parts of the works in other derivative works, or including them as part of further compilations. For instance, just a fragment of a work can be now displayed in online platforms. The use of snippets and thumbnails by search engines also require certain transformation of format of the work which may not have economic significance per-se<sup>508</sup> but may pose problems to moral rights.

Secondly, CHIs may be engaged in **mass-digitization processes**. Borghi notes that ‘such processing inevitably modifies both the work itself and the context in which the work is displayed to the public’<sup>509</sup> which could qualify as an infringement of moral rights. Borghi identifies main activities that may impact the integrity of the work with regards to mass-digitization processes: ‘digitization, indexing, search and automatic association’<sup>510</sup>.

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<sup>504</sup> Borghi (n 254) 105.

<sup>505</sup> Elster Pantalony (n 6) 127.

<sup>506</sup> Digitization of works by CHIs entail similar issues to moral rights as the ones analysed in Section 5.1 with regard to derivative works and the right of adaptation.

<sup>507</sup> Sterling (n 67) 394.

<sup>508</sup> Borghi (n 254) 93.

<sup>509</sup> *ibid* 105.

<sup>510</sup> *ibid* 99.

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With regards to digitization *per se*, digitizing a work may entail loss of quality. Yet, it is still to be seen to what extent this loss affects the integrity of the work as reproduction of a work with a lower quality ‘per-se’, does not necessarily constitute an infringement of the right of integrity<sup>511</sup>. For instance, with regard to three-dimensional works, a ‘poor-quality photograph of a sculpture may misrepresent the work, and this could, indeed, be considered a violation of the sculptor’s right of integrity’<sup>512</sup>. In the case of Traditional Cultural Expressions, the ‘image quality may play an important role. It may be viewed as culturally offensive to display a TCE except as the most faithful reproduction or, conversely, except as a thumbnail so that certain spiritual symbols cannot be made out except upon an in-person visit or with permission of the relevant community’<sup>513</sup>.

Digitization does normally also involve *scanning and processing* the work through specific software. Activities relating to the indexation of the work may include adding metadata to a work allowing search engines to identify and retrieve the work. In most cases, these operations will not trigger copyright liability. The problem in this case scenario may come when the metadata is not comprehensive enough to properly identify the work or when the work is systematically identified in an improper way<sup>514</sup>.

After indexing, the works are ready to be *searched* in the online environment through search engines. While normally technologies that make this possible do not entail an infringement of the right of integrity, this could be different in case of mass-digitization projects where snippets are shown, and automatic associations are made. Here, a potential breach of the right of integrity may arise in case the work is associated with other information in a derogatory manner<sup>515</sup>.

As results from the foregoing, the right of integrity may be at stake when an author considers that his work is used in a context which he considers derogatory to his reputation. Actually, the way an artwork is presented changes how the artwork is perceived. This may have implications for ‘**virtual galleries**’ that museums and galleries are putting in place today. Normally, a virtual gallery does not reproduce the museum, but it creates original pathways and experiences for the visitors. Hence, displaying works in a virtual gallery does not per se infringe moral rights of authors. However, one should not entirely exclude that moral rights restrict to some extent the way such virtual galleries or participatory online exhibitions are designed<sup>516</sup>.

Finally, because moral rights are unalienable and unwaivable by definition (see *supra*, general overview), CHIs need to be aware that moral rights cannot be signed away by contractual agreement, including in the framework of licenses like CC. Domestic legislation may, however, allow for waivers but the conditions for their validity differ considerably per jurisdiction.

As a concluding note it should be reminded that **enforcement** of moral rights in the digital age is really complex and may entail high costs<sup>517</sup>. This is, of course, primarily a concern for the authors themselves

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<sup>511</sup> *ibid.*

<sup>512</sup> Rajan (n 474) 477.

<sup>513</sup> Torsen and Anderson (n 34) 29.

<sup>514</sup> Borghi (n 254) 100.

<sup>515</sup> *ibid* 103.

<sup>516</sup> Rajan (n 474) 481.

<sup>517</sup> Janssens (n 477) 9.

as they are the owner of these rights. Nevertheless, because of certain common interests – protecting the authenticity, integrity and attribution of these cultural expressions - also CHIs should develop their policies with due regard for moral rights.

## 6 Public domain works

### 6.1 General discussion

**The public domain is generally defined as encompassing intellectual elements that are not protected by copyright or whose protection has lapsed, due to the expiration of the duration for protection.**

The public domain is one of the most controversial matters in relation to IPRs nowadays<sup>518</sup>. It presents particular relevance to the inDICEs project and for CHIs as a significant number of works in the collections of CHIs are currently in the public domain.

Public domain material plays a crucial role in innovation and in further re-use of creative content which contributes to the production of artistic creation. It also provides educational and research material which can foster access to knowledge and culture in society<sup>519</sup>. The growing interest that public domain attracts can also be explained by the potential for economic growth, especially in the digital era. New technologies and the internet are reviving the public domain as it has reduced the production costs of reproduction and dissemination of public domain works. Within this framework, new business models are developed (e.g. Google Books project) and public cultural policies are also stimulating CHIs in digitization and online dissemination of their collections in order to provide freely available cultural resources (Europeana).

In addition, public domain works are being considered as a **central element of our cultural heritage**. This conception has attracted high attention at international level, as appreciated by the work of UNESCO<sup>520</sup>. In its work, the international organization calls Member States to grant certain protection to the public domain. According to the UNESCO protecting the integrity of the public domain as crucial part of the cultural heritage could be made through moral rights or any other form of legal protection.

The public domain is considered as a raw material that could be used for innovation and creation of new works and therefore is not subject to protection under copyright law or any other IPR. This lack of protection could be due to the fact that works do not qualify for protection under copyright or because the copyright protection has already expired. In the first case, it is commonly referred to the

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<sup>518</sup> Severine Dusollier, 'Scoping Study on Copyright and Related Rights and the Public Domain' (Social Science Research Network 2011) SSRN Scholarly Paper ID 2135208 3 <<https://papers.ssrn.com/abstract=2135208>> accessed 23 March 2020.

<sup>519</sup> *ibid* 13.

<sup>520</sup> Draft Recommendation of safeguarding works in the public domain.

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‘essential commons of information’<sup>521</sup>. The second case refers to works whose copyright has already expired. In the EU, the term of protection of copyright is extended to 70 years after the death of the longest living author (see Section 4.7 on the Term Directive for further explanations of the term of protection). This means in practice that almost all works created before the XX century should be in the public domain. Moreover, the low level of originality established by some countries in order to grant copyright protection, may lead to little amount of works that are in the public domain<sup>522</sup>.

Commonly referred as not protected by copyright, the public domain is thus not regulated by any IP law being left outside of any legislation<sup>523</sup>.

Hence it is generally understood as a material that is ‘free for use’ without anyone exercising any control on the work. However, the fact that it is not copyright-protected does not necessarily mean that it is completely accessible. As Dusollier explains, there are certain limitations to its use even if they are not IP-related, e.g. ‘material access’ to the work which is normally regulated by the property right in the work or the concept of public domain material does not mean that the access is granted to any third party free of charge.

One of the main characteristics of the public domain is its heterogeneity as works in the public domain may include ‘all knowledge and information – including books, pictures and audiovisual works’<sup>524</sup>. For instance, traditional cultural expressions are also normally considered to be in the public domain, despite the efforts made at international level to grant certain degree of IP protection.

### Public domain in the digital age

Works in the public domain have attracted a growing interest due to the new ways of cultural and participatory consumption of cultural content within the internet. The increase of re-use of content has made that further legal protection has been sought in order to protect public domain works by claiming certain rights in the digitized forms of public domain. For instance, through the extension of copyright or related rights protection in the digitized versions of these works, e.g. through photographs or databases.

As earlier analysed, not the protection of (non-original) photographs and derivative works not the right of adaptation neither the moral rights are a harmonized matter at EU level. This situation entails legal uncertainty for those users and cultural organizations willing to use and re-use digital reproductions of works that are in the public domain. As a result, a specific work could be in the public domain in one jurisdiction while it could be granted certain exclusive rights in another. Therefore, the situation of this digitized content is certainly unclear and may have an impact in cross-border activities and dissemination of works.

Due to the extension of protection of works in the public domain in some Member States, certain concerns from public organizations have risen in the recent years calling the EU legislator to intervene. The Europeana Foundation through its Europeana Public Domain Charter<sup>525</sup> or The Communia

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<sup>521</sup> Europeana Foundation (n 360) 3.

<sup>522</sup> Dusollier (n 518) 24.

<sup>523</sup> *ibid* 5.

<sup>524</sup> Europeana Foundation (n 360) 3.

<sup>525</sup> Europeana Foundation (n 360).

International Association on the public domain through its Public Domain Manifesto<sup>526</sup> have put some principles in place to ensure the understanding and the respect of the public domain and its functioning in the digital environment. Within this framework, both Communia and Europeana understand that works in the public domain should remain in the public domain in the digital environment. In consequence, no exclusive rights should be re-established through their technical reproductions<sup>527</sup> through copyright or related rights or any other IPR. In addition, lawful copies of works in the public domain should be free to use, re-use and modify. According to Europeana, there is no legal basis to restrict the use of such works through technical or contractual measures<sup>528</sup>.

In this line, in order to provide clarity on reproductions of works in the public domain, the EU legislator introduced a provision under Article 14 of the CDSM Directive. This provision is deeply analysed in Section 4.5.4.

Other national legislative acts aiming at protecting works in the public domain will be analysed in detail within the next deliverable of the inDICEs project which consists of a comparative analysis. However, it is still interesting to mention the '*domain public payante regime*' due to its pertinence to CHIs in the next section.

## 6.2 Practical implications for CHIs

CHIs, as guardians of our cultural heritage, are already widely recognized for their particular role in safeguarding and sharing our cultural and scientific knowledge. It is important to also **recognize the role of CHIs in promoting creative and cultural production** through the provision of certain cultural 'raw material'<sup>529</sup>.

As seen in earlier sections, the development of new technologies fostered the digitization of works carried out by CHIs which bring enormous challenges to cultural organizations. Since CHIs normally lack economic resources to carry out the expensive activities of digitizing collections, they have entered in contractual agreements with commercial partners in order to carry out mass-digitization projects. In order to compensate the investment made, cultural organizations want to keep control of such digital reproductions and digitized content, which can be based in pre-existing works both under copyright protection or in the public domain<sup>530</sup>.

### Issues related to copyright and related rights

When these reproductions are based on works in the public domain, copyright or related rights protection could be provided through EU or national laws. As discussed in earlier sections, exclusive

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<sup>526</sup> 'Communia Public Domain Manifesto' (n 361).

<sup>527</sup> Europeana Foundation (n 360).

<sup>528</sup> *ibid.*

<sup>529</sup> *ibid* 4.

<sup>530</sup> *ibid.*

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rights could be obtained through the protection of photographs, digital images or databases, among others. However, granting an exclusive right to these digital reproductions could certainly inhibit the interaction with these works.

As discussed above, mass-digitization projects entail high costs for cultural organizations. These high costs evidence the need of cultural organizations to retain control through the digitized images. First of all, since the digital reproductions of works are a source of further income through their licensing, and secondly, because they can impose further control on the uses and the integrity of such material. Such protection is normally generated through the **extension of copyright or related rights of the digitized images** from whom they become the copyright holders with all the implications that this entails.

As analysed in Sections 5.1, 5.2 and 4.7 (related to derivative works, moral rights and photographs), digitization of works, copyrighted or not, necessarily implies a photograph or a scanning of the work. Accordingly, this further protection of the public domain work is granted through the copyright or related right protecting the photograph which reproduces the work, depending on the jurisdiction. It is generally understood, as stated by some national courts, that a photograph reproducing the work as such does not qualify for copyright protection as it lacks the required degree of originality to qualify for copyright protection.

Here, the photographer does not have the freedom to make choices in the arrangement's and therefore his personality is not reflected in the digitized work. What is crucial to assess is whether a reproduction of a work in the public domain is protected by copyright or not: 'whether there is room for intellectual creativity allowing the author to stamp her own personal touch on the work'<sup>531</sup>. However, this can be protected through other related rights. For instance, the ones provided to non-original photographs, if any, which are not harmonized at EU level thus it depends on national laws.

In addition, cultural organizations argue that digitized images in high resolution formats entail a serious investment and effort and it results in another work with different properties, a new creation that is called the 'digital master'. Consequently, cultural organizations aim at obtaining copyright protection of these images which can therefore be commercially licensed.

Moreover, some photographs kept in the archives have been donated by families of the author to the institutions to promote and preserve the cultural heritage. Nevertheless, some of these photographs are donated through contractual agreements prohibiting commercial re-use of the photographs<sup>532</sup>

Exclusive rights could be also provided for the compilations assembled by the CHIs through the protection of **databases** (see Section 4.2). CHIs produce databases of their collections that could also involve works in the public domain and that entail similar issues than photographs.

Furthermore, as discussed in Section 5.2, public domain works in the EU may be also subject to **moral rights** that are perpetual in certain jurisdictions. The existence of moral rights in works of the public domain may undoubtedly limit further uses and re-uses of works. It has been described in earlier sections how derivative works could infringe the moral right of integrity which also extends to works

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<sup>531</sup> Truyen and Waelde (n 362) 84.

<sup>532</sup> *ibid* 88.

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in the public domain where the moral rights are perpetual. In addition, where the perpetuity extends to the right of divulgation, this could lead the author to 'prevent the making available of posthumous and unpublished works, thereby diminishing intellectual access to public domain works by the public'<sup>533</sup>. According to Dusollier, the introduction of perpetual moral rights in certain jurisdictions also responds to the provision of a control on the national cultural heritage by the states.

Finally, **the use of TPMs** preventing copying, re-use or downloading works may also entail certain issues with regard to works in the public domain. Problems may arise as TPMs do not differentiate between copyrighted or non-copyrighted works. For instance, a website that makes cultural content both protected or non-protected by copyright or related rights available, could prevent the use of works in the public domain in the same sense as to copyrighted works.

If the work in the public domain is also available through its digitized form, the owner of the digitized version could also impose TPMs preventing the access to unlawful users or the use to lawful users. In addition, both at international and EU level, circumvention of technological measures is prohibited. This prohibition could also affect the circulation of works in the public domain<sup>534</sup>.

### Other cultural policies related limitations

Some EU countries have introduced a '*domaine public payante regime*' which can be defined as 'a system by which a user of materials in the public domain is required to pay for a compulsory license in order to reproduce or publicly communicate the work, despite its status in the public domain'<sup>535</sup>. In conformity with these regimes, copies of reproductions of works in the public domain must be paid in order to contribute to 'state-controlled funds' that are destined to further enhance cultural creativity and production<sup>536</sup>.

Additionally, some countries have certain regulations that govern the re-use of the public domain from which the State is the custodian of the good<sup>537</sup>. This kind of policies are driven by the need of controlling the integrity and moral of the works that are kept in national collections<sup>538</sup>. These laws may also restrict the re-use of works in the public domain. The extent of the restriction, however, depends on each jurisdiction.

Further, the *domaine public payante* regimes only concern works where copyright has expired<sup>539</sup> (although some countries apply this kind of regime to works of traditional expressions).

Normally, the funds generated by this kind of regimes forms part of national cultural policies and are consequently allocated to funds for young artists, social benefits of creators or the promotion of cultural content. In views of Dusollier, these regimes seem an outdated model which enter in conflict with the need for re-use of works in the public domain. It could also demotivate publishers or

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<sup>533</sup> Dusollier (n 518) 36.

<sup>534</sup> Dusollier (n 393) 46.

<sup>535</sup> Dusollier (n 518) 39.

<sup>536</sup> Angelopoulos (n 413) 11.

<sup>537</sup> *ibid.*

<sup>538</sup> Truyen and Waelde (n 362) 89.

<sup>539</sup> Dusollier (n 518) 39.

entrepreneurs willing to make use of public domain works if the fees that need to be paid are of a high amount<sup>540</sup>.

### Trademark protection

Public domain works as an image, the form of an object or a visual character could even be registered as a trademark. Therefore, even if the copyright protection of an image expires, the owner could still exercise his rights based on trademark protection. Yet, there are still certain limitations to extend trademark protection on works where copyright protection has expired. This aspect will be further analysed in the next section.

## 7 Other IPRs with impact on CHIs

### 7.1 Trademarks

Besides copyright, trademarks, commonly known as ‘brands’, are also of particular importance for CHIs as they may be used to generate further revenues through the trademark protection of the image or products of the organization. In addition, trademark protection is the strongest and most common protection used for certain CHIs, for instance, those active in the fashion industry<sup>541</sup>. Thus, some works in the collections of CHIs could be protected by a trademark.

**Trademarks are symbols used to identify goods or services from a company.**

A trademark is a distinctive sign, which can be a logo, a word or a sentence that identifies such organization or products<sup>542</sup> and that differentiates the products or services of one undertaking from another. Moreover, trademarks are used to differentiate the commercial origin of a product or service. They also help consumers to make their choices as they entail a guarantee of quality of the product or service. Furthermore, trademarks ensure a well-functioning competition in the market. The most widely used trademarks are names or logos but trademark law opens more options than merely word or figurative marks. Depending on the jurisdiction, other non-traditional signs can be susceptible to trademark protection, such as three-dimensional shapes, colours, sounds, positions, patterns, motion, multimedia, holograms and sometimes also scents and tastes<sup>543</sup>.

Unlike copyright, trademark protection is an IP **that needs to be registered**<sup>544,545</sup> in order to provide the exclusive right of using such sign for commercial activities to the owner of the trademark. Registration of trademarks can be costly and time-consuming for the owners. However, it provides

<sup>540</sup> *ibid* 41.

<sup>541</sup> Roxanne Peters, ‘Fashion and Intellectual Property. “Best Practice” Guidelines, Europeana Fashion’ 19.

<sup>542</sup> Elster Pantalony (n 6) 13.

<sup>543</sup> Janssens and Michaux (n 44) 429.

<sup>544</sup> World Intellectual Property Organization (n 23).

<sup>545</sup> There are jurisdictions that could grant validity to trademark without being registered but for the mere use.

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the benefit of protecting the trademarks before placing them in the market providing the owner with an increased certainty<sup>546</sup>. Yet, once a trademark is registered, the owner has the exclusive right to use it only in the territory where the registration has been made. In this regard, the principle of territoriality of IPR plays an important role, as for any other IP, registered or not. The restricted effects of the principle of territoriality may be mitigated by the right of priority. The right of priority is an international obligation of the contracting parties of the Paris Convention<sup>547,548</sup>.

Due to the principle of territoriality, each country has its own system of registration. However, certain systems to facilitate the registration of trademarks in multiple jurisdictions simultaneously have been developed at international and EU levels.

There are mainly three registration systems for trademark protection in the EU, namely national, regional, and international.

**National** - First, on the national level the trademark application can be filed with the competent national governmental authority. In this case, the protection is sought only for the territory of a selected national jurisdiction, which is governed by the relevant national law.

**Regional** - Second, a trademark protection can also be obtained on a regional level. For instance, in the EU, the interested party can obtain the trademark protection for the whole EU territory through one single application filed with the EUIPO. This unitary trademark system was put in place in 1994<sup>549</sup> and has been recently reformed and codified by the Regulation 2017/1001<sup>550</sup>.

**International** - Finally, trademark applications can also be filed through the international route, called the Madrid system. This system facilitates the application of trademarks between the multiple states that form part of the Agreement<sup>551</sup>. Whereas it does not provide for a unitary trademark (unlike the EU trademark system), it allows to file one single application at the WIPO (including payment of one set of fees) for the registration of trademarks in different jurisdictions. The international filing enables the interested parties to decrease the administrative burden of filing trademark application at each relevant national competent government authority.

For the purpose of inDICEs project and, in particular, of this deliverable, the EU unitary trademark system will be used as a basis for the study.

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<sup>546</sup> Bently and Sherman (n 25) 781.

<sup>547</sup> Paris Convention for the Protection of Industrial Property (March 20, 1883; effective July 7, 1884, and amended June 2, 1934 and July 14, 1967).

<sup>548</sup> The right of priority is an international obligation of the contracting parties of the Paris Convention according to which, on the basis of a first application made in one country, the applicant enjoy a period of 6 months to apply for the registration of the same sign as trademark in the other countries that are also part of the Convention.

<sup>549</sup> First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks.

<sup>550</sup> Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark.

<sup>551</sup> Madrid Agreement Concerning the International Registration of Marks of 14 April 1981 (as amended in 1979).

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According to the EU Trademark Directive<sup>552</sup>, a trademark may consist of (a) a sign (b) that can be represented graphically and (c) that is capable of distinguishing the goods or services of one undertaking from those of other undertakings. There are certain requirements for a trademark to be considered valid. First of all, this sign needs to have a 'distinctive character' in the sense that it needs to be distinguishable among the products or services of other undertakings. This requirement excludes signs that are exclusively descriptive of characteristics of the goods or services for which they are used (e.g. mint taste for chewing gum) or have become generic (e.g. the sign "L" for driving schooling). However, inherently non-distinctive signs may still qualify for registration on the basis of evidence that the mark has acquired distinctiveness through use on the market<sup>553</sup>. Secondly, a sign cannot be registered as a trademark if it is contrary to morality or public order. Neither can it be registered when the sign is deceptive with regards to the nature, quality or any other characteristics of the goods or services such as their geographical origin or even that consist of flags of states or international organizations. Third, the sign should still be available in the sense that no third party can assert earlier rights through registration or use to the same or a similar sign<sup>554</sup>.

A trademark is only granted for those goods or services for which the protection is sought. In order to provide certainty for the classification of goods and services, there is an international agreement, the Nice Agreement<sup>555</sup>, that provides a unified classification system of goods or services.

A trademark provides its owner the **exclusive rights to** use the registered sign only in relation to the goods and services for which the protection is sought. The trademark prohibits the third parties to use such sign without the rightholder's authorization in relation to the goods or services. In consequence, trademarks prevent third parties to use the sign for those goods services and goods as it would create confusion in the market with regards to the origin of the goods or services.

The registration of the EU trademark will provide the owner the exclusive right to use the sign in relation to its goods or services and have the rights to prevent third parties from using such sign in the following situations (relative grounds for refusal): (a) the sign is identical with the EU trade mark and is used in relation to goods or services which are identical with those for which the EU trade mark is registered; (b) the sign is identical with, or similar to, the EU trade mark and is used in relation to goods or services which are identical with, or similar to, the goods or services for which the EU trade mark is registered, if there exists a likelihood of confusion on the part of the public; (c) the sign is identical with, or similar to, the EU trade mark irrespective of whether it is used in relation to goods or services which are identical with, similar to or not similar to those for which the EU trade mark is registered, where the latter has a reputation in the Union and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the EU trade mark<sup>556</sup>.

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<sup>552</sup> The Trademark Directive art.3.

<sup>553</sup> Janssens and Michaux (n 44) 436.

<sup>554</sup> *ibid.*

<sup>555</sup> Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (as amended on September 28, 1979).

<sup>556</sup> Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark art 9.2.

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In addition, a trademark could also be rejected on the basis of the so-called 'earlier rights'. The proprietor is not entitled to prohibit the use of signs or indications by third parties which are used fairly and thus in accordance with honest practices in industrial and commercial matters. Also use of a trademark by third parties for the purpose of artistic expression or use that can be justified by other fundamental rights and freedoms, and in particular the freedom of expression, should be considered as being fair as long as it is at the same time in accordance with honest practices<sup>557</sup>.

A unitary trademark is granted for a period of 10 years from the day of filling the application that can be renewed indefinitely upon paying of fees. Once the protection is granted, the owner has an obligation to use the sign in relations to the goods and services. Otherwise the owner will lose after 5 years the exclusive right and the trademark will be free for use.

Trademarks can also be licensed or sold to third parties which can generate further revenues. Furthermore, a trademark can also be abandoned due to a lack of use.

### 7.1.1 Practical implications of trademarks for CHIs

Trademark law has a particular relevance for CHIs nowadays, especially with regard to modern museums and libraries, which are seeking to increase their revenues through the creation of a 'brand', whose images and products could be licensed.

There are three main aspects in which CHIs and trademarks interrelate. First, CHIs need to protect the image of the institution, its logos and associated products (in connection with designs). Second, the cumulative protection of public domain works, which are part of CHIs' collections, could be protected through trademarks. Third, CHIs could have in their collections works protected by a trademark and therefore should be aware of the need of obtaining licenses for certain uses.

With regards to **trademarks owned by the CHI**, they can be used, for instance, to protect the museum name and identifying logo, packaging or colours of products sold in the gift shops. Even titles of exhibitions or programs could be protected by a trademark<sup>558</sup>. Not only the sales of tangible products of the institution but also the licensing of images of the museum brand itself could be a source of revenues for the institution<sup>559</sup>. Thus, trademarks provide consumers with an association of the product or service with its source of origin. It is important that CHIs protect their image through their websites or social media platforms with consistent representations of their name and trademark<sup>560</sup>. CHIs should also be aware of the practice of 'cybersquatting' which happens when 'a person has registered a domain name identical or similar to, for example, a museum's name and has either sought money for its 'return' or traded using the domain name in the hope of benefiting from the museum's goodwill in its name'<sup>561</sup>.

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<sup>557</sup> Janssens and Michaux (n 44) 432.

<sup>558</sup> Elster Pantalony (n 6) 58.

<sup>559</sup> *ibid* 43.

<sup>560</sup> Julia Courtney, *The Legal Guide for Museum Professionals* (Rowman & Littlefield 2015) 228.

<sup>561</sup> Simon Stokes, 'Art and Intellectual Property Rights Other than Copyright', *Art and Copyright* (1st edn, Hart Publishing 2012) 219 <<http://www.bloomsburycollections.com/book/art-and-copyright/ch8-art-and-intellectual-property-rights-other-than-copyright/>> accessed 7 November 2014.

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There can be a **cumulative protection of copyright and trademark** on public domain works. For instance, it is in principle possible to ‘acquire trademark rights to cultural heritage symbols once distinctive character is acquired through use in trade (Mona Lisa)’<sup>562</sup>. This gradual expansion of trademark protection over the public domain raises the question of the threshold of distinctiveness that a trademark needs to be valid<sup>563</sup>. There has been a concern among academic scholars, as well as practitioners, that protection of non-traditional trademarks could aggravate the problem of cumulative protection<sup>564</sup>. Multiple examples of this problem can be found in academic literature, as well as in practice. For instance, ‘a short melody may constitute a sound mark. A computer animation may qualify as a motion mark’<sup>565</sup>. For example, the case of Disney’s character, Mickey Mouse, has become a symbol of the company’s corporate identity and could therefore be protected under a trademark (apart from its copyright protection that may have expired). From the perspective of CHIs, this cumulative protection entails the risk of protecting public domain works with an additional term of protection under trademark law. Not to mention that trademarks can be renewed indefinitely which certainly could lead to ‘an undesirable re-appropriation of public domain material’<sup>566</sup>. For the CHIs to work efficiently the interests arising from the protection of IP and the public domain needs to be balanced<sup>567</sup>. According to Anemaet, ‘an outright exclusion of cultural signs without high symbolic value, descriptive signs and abstract colors that cannot be overcome through acquiring distinctiveness as a result of use in trade would in any case guarantee the preservation of these signs’<sup>568</sup>.

Third, some works in the collections of CHIs could be protected by a **trademark owned by a third party** and, under certain circumstances, CHIs may need to obtain the relevant license from the rightholders. For instance, such license may be required for works in collections of fashion museums or fashion heritage museums, as trademark is the most used IPR to protect fashion products. In most cases, displaying images of works that are protected by a trademark do not require permission of the trademark owner as inclusion in CHIs’ websites or platforms such as Europeana should not ‘create confusion within the public about the origin of goods and services’<sup>569</sup>. However, for certain audiovisual works of catwalk shows, it is essential to obtain permission from the creator who may have a trademark<sup>570</sup>. In addition, some authors’ names could be registered as a trademark<sup>571</sup> and thus obtaining a license for any use, e.g. production of merchandise, would be required for the cultural institution.

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<sup>562</sup> Martin Senftleben, ‘A Clash of Culture and Commerce – Non-Traditional Marks and the Impediment of Cyclic Cultural Innovation’ in Irene Calboli and Martin Senftleben (eds), *The Protection of Non-Traditional Marks: Critical Perspectives* (Oxford : Oxford university press 2018) 1.

<sup>563</sup> Lotte Anemaet, ‘The Public Domain Is Under Pressure -Why We Should Not Rely on Empirical Data When Assessing Trademark Distinctiveness’ (2016) 47 IIC - International Review of Intellectual Property and Competition Law 303, 304.

<sup>564</sup> Senftleben, ‘A Clash of Culture and Commerce – Non-Traditional Marks and the Impediment of Cyclic Cultural Innovation’ (n 562) 2.

<sup>565</sup> *ibid.*

<sup>566</sup> *ibid* 3.

<sup>567</sup> Anemaet (n 563) 304.

<sup>568</sup> *ibid.*

<sup>569</sup> Peters (n 541) 20.

<sup>570</sup> *ibid.*

<sup>571</sup> Stokes (n 561) 218.

## 7.2 Industrial designs

An industrial design refers to the **appearance of a whole or part of a product resulting from the features of the lines, shapes, colours or patterns.**

According to the EU Design Regulation a 'design' means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation<sup>572</sup>. There is a great variety of areas of industrial design ranging from fashion design, furniture, graphic design, product or packaging design, among others<sup>573</sup>. Designs can be protected through the registration of the design but also through a system of non-registration, and even by copyright<sup>574</sup>.

Designs can be registered through three levels of protections: national, regional and international levels. For the purpose of inDICEs project, the study is mainly focused on the EU regional system.

**National** - National protection systems are managed by the national IP offices. Therefore, design protection is only granted within the country in which the application was filed.

**International** - The international system, is managed by the WIPO and it is known as The Hague system. Alike trademarks, it also provides the possibility to register in the countries part of the system though the filing of one single application and one single set of fees.

**Regional** - Regional systems concern, for instance, the EU system of registered and unregistered designs. At the EU, there are currently two systems of protection of designs both introduced in 2003 by the Regulation 6/2002.

The first system consists of an EU system of registered design protection (Registered Community Design) upon filing an application to the EUIPO. Similar to the EU trademark system, the Community design provides a unified system for obtaining design protection within the whole EU territory. The registered design protection can last for 25 years, divided in five terms of five years (from the filing of the application), upon renewal and paying of fees.

The Registered Community Design protection is also supplemented by the Unregistered Community Design Right set up under the same Regulation. The unregistered protection for designs mainly aims at providing short-term protection for those industries for which registration would not be appropriate, mainly because the designs are only valuable for a short period of time<sup>575</sup>. The Unregistered Design is also intended to provide protection for the design during the period in which

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<sup>572</sup> Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (amended by Council Regulation (EC) No 1891/2006 of 18 December 2006) art. 3(a).

<sup>573</sup> Bently and Sherman (n 25) 607.

<sup>574</sup> *ibid.*

<sup>575</sup> *ibid* 612.

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the owner decides whether to register the design or not. For the unregistered designs, the protection lasts for a period of three years from the date the design was placed on the market<sup>576</sup>.

The Unregistered Community Design protection arises automatically, without registration, from the moment the design is made available within the EU territory. For the purpose of the Regulation, making a design available to the public should be understood as 'if it has been published, exhibited, used in trade or otherwise disclosed in such a way that, in the normal course of business, these events could reasonably have become known to the circles specialised in the sector concerned'<sup>577</sup>.

For a design to qualify for protection in the EU, must be new and have an individual character<sup>578</sup>. The concept of 'novelty' for EU designs refers to the situation when no identical design has been made available to the public, distinguishing from the registered design (date of filing the application for registration or the date of priority) and unregistered design (date in which the design was made available to the public)<sup>579</sup>. For unregistered designs, the requirements of novelty and individual character also needs to be met in order to get such protection. Within this context, the concept of 'individual character' needs to be assessed according to whether 'the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public'<sup>580</sup>.

The industrial design protection grants **exclusive rights** to the creators of the design mainly based on the original appearance and non-functional features of an industrial product<sup>581</sup>. The protection of designs provides the creator a commercial advantage in the market. Thus, the design protection grants exclusive rights to the owner to use the design and to prevent the unauthorized use of the design of a product. According to the EU Regulation, such uses refer to, in particular, 'the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes'<sup>582</sup>. However, for unregistered designs in the EU<sup>583</sup>, the protection is only granted against those uses resulting from a deliberate copy of the design<sup>584</sup>.

In addition, there are certain limitations to design protection. The EU Regulation explicitly excludes private and non-commercial uses, experimental purposes and reproduction for the purpose of teaching<sup>585</sup>.

Furthermore, the Regulation explicitly allows the cumulative effect of design and copyright protection<sup>586</sup>. Member states should not exclude copyright protection only because the work could

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<sup>576</sup> The Community Design Regulation art 11.

<sup>577</sup> *ibid* art 11.

<sup>578</sup> *ibid* art 4.

<sup>579</sup> *ibid* art 5.

<sup>580</sup> *ibid* art 6.

<sup>581</sup> World Intellectual Property Organization (n 23) 112.

<sup>582</sup> The Community Design Regulation art 19.

<sup>583</sup> See the next sub-section for more details.

<sup>584</sup> The Community Design Regulation art 19.

<sup>585</sup> *ibid* art 20.

<sup>586</sup> *ibid* rec 32.

be protected by design. However, if aesthetic creations of industrial applicability do not qualify for copyright protection, this should not be understood as contrary to the Design Regulation<sup>587</sup>.

Finally, designs, alike other IP, can be assigned or licensed to third parties.

### 7.2.1 Practical implications of designs for CHIs

CHIs can have design products in their collections. In addition, they can also create specifically designed products for commercial activities based on their collections or even based on the institution's image.

In the first scenario, when the CHI has in its collections any works protected as designs (exclusive rights for which are owned by a third party), the institution would need authorization through a license for their distribution or reproduction<sup>588</sup>, similar to the works protected by a trademark. Such licenses are of particular relevance to design or fashion museums. For instance, fashion garments and accessories may be protected by design rights (and even by copyright if they would qualify for protection). If design rights are owned by third party, these rights would be infringed when: the product replicas are made copying the protected original design or, by reproducing a design drawing which may enable others to copy the original design. However, design rights would not be infringed by taking a picture of the work<sup>589</sup>.

Furthermore, design protection could be an extra source of revenues, if the CHIs creates products for the commercial activities, which qualify for this type of IP protection. However, CHIs need to be aware of contracts for the ownership of the design when it concerns commissioned works. If an institution commissions a design of certain products to a third party, the specific terms of use and ownership of the design need to be agreed through a contract<sup>590</sup>.

Finally, design protection and copyright protection on a particular work could overlap (and it is explicitly allowed by the EU Design Regulation). In case of such dual IP protection, the authorization from both the copyright owner and the design right owner, must be obtained.

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<sup>587</sup> Christopher Heath, 'The Protection of Aesthetic Creations as ThreeDimensional Marks, Designs, Copyright or Under Unfair Competition' in Christopher Heath and Anselm Kamperman Sanders (eds), *New Frontiers of Intellectual Property Law : IP and Cultural Heritage – Geographical Indications – Enforcement – Overprotection* (1st edn, Hart Publishing 2005) 185 <<http://www.bloomsburycollections.com/book///>> accessed 14 November 2014.

<sup>588</sup> Elster Pantalony (n 6) 21.

<sup>589</sup> Peters (n 541) 14.

<sup>590</sup> Elster Pantalony (n 6) 21.

## 8 Other non-IP legislative acts relevant for CHIs

### 8.1 Open Data Directive

The new Directive 2019/1024<sup>591</sup> (hereinafter ‘the Open Data Directive’) incorporates the rules introduced by the previous Public Sector Information Directive<sup>592</sup>, adding further rules for the re-use of publicly funded information. It also aims at bringing the current legal framework up to date in light of the development of new technologies<sup>593</sup>. Member States have until 16 July of 2021 to implement the Directive into their national legislations.

The Directive, aiming at promoting the use of open data and stimulating innovation in products and services, **introduces minimum rules for the re-use of** (i) documents held by public sector bodies of the Member States; (ii) documents held by public undertakings; and (iii) research data subject to certain conditions<sup>594</sup> for commercial and non-commercial purposes.

Yet, not all documents held by public bodies are subject to the scope of the Directive. For instance, some of the documents explicitly excluded are those documents that fall outside the public task of public bodies or public undertakings, documents to those third parties hold IPR or documents concerning confidential information among others.

Importantly, the Directive expressly excludes from the scope ‘documents held by cultural establishments other than libraries, including university libraries, museums and archives’<sup>595</sup>. These provisions are further explained in the next section.

Concerning the **re-use of research data**, the Directive encourages Member States to introduce policies aiming at making ‘publicly funded research data openly available’. However, these policies need to take into account potential concerns, in particular, on IPR, protection of personal data or commercial interests. The publicly funded research data needs to be made available for re-use for commercial and non-commercial purposes as long as researchers or research organizations ‘have already made them publicly available through an institutional or subject-based repository’<sup>596</sup>. Yet, pre-existing IPR or knowledge transfer activities need to be also taken into account.

The Directive provides rules on processing the requests for re-use concerning time for handling the requests or redress mechanisms and also lays down the conditions for the re-use. Concerning the re-use, the Directive obliges Member States to make the documents available ‘in any pre-existing format or language and, where possible and appropriate, by electronic means, in formats that are open, machine-readable, accessible, findable and re-usable, together with their metadata’<sup>597</sup>.

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<sup>591</sup> The CDSM Directive.

<sup>592</sup> Directive 2013/37/EU of the European Parliament and of the Council of 26 June 2013 amending Directive 2003/98/EC on the re-use of public sector information.

<sup>593</sup> Directive (EU) 2019/1024 of the European Parliament and of the Council of 20 June 2019 on open data and the re-use of public sector information rec 3.

<sup>594</sup> *ibid* art. 1.1.

<sup>595</sup> *ibid* art 1.2(j).

<sup>596</sup> *ibid* art 10.

<sup>597</sup> *ibid* art 5.1.

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As a general rule, the re-use of documents should be made available free of charge although certain fees intended to recover the costs of the reproduction, provision and dissemination of documents can be imposed. However, as an exception to the rule, this provision does not apply to certain bodies, including libraries, museums and archives, which, therefore, do not need to provide the re-use free of charge (see next section for further details).

Furthermore, the conditions for the re-use shall not be discriminatory and includes cross-border uses. Importantly, Article 12 establishes that the re-use of documents shall be open to every interested third party in the market, even when there are already other parties exploiting any product based on the documents. Moreover, as a general rule, the Directive prohibits any arrangements granting exclusive rights. However, the Directive provides for an exception to these rules concerning digitisation of cultural resources (explained in the next section).

The Directive encourages the use of standard licenses for the re-use of public sector information<sup>598</sup>. These licenses should provide as ‘few restrictions as possible’ unless certain conditions are needed to ensure, in particular, the protection of personal data, the proper use of documents or liability matters. Recital 44 stimulates further the use of open licenses that allow the use and re-use of content and data and that would rely on open data formats<sup>599</sup>.

Finally, the Directive clarifies that the rights provided under the Database Directive should not be exercised to prevent or restrict the re-use of public sector information<sup>600</sup>.

### 8.1.1 Practical implications for CHIs

Although the previous Directive explicitly excluded resources held by cultural, scientific and educational institutions, the amended Directive in 2013 included museums, libraries, including university libraries, and archives within its scope. This introduction was seen by academics and experts as an ‘attempt for the first time to define a general framework for sharing cultural heritage information all around Europe’<sup>601</sup>.

The new Directive **maintains libraries, including university libraries, museums and archives within the scope**. While there are certain deviations for these institutions from the general rules, the rationale to keep these institutions is still the same as in the previous Directive: the amount of publicly valuable information resources that these CHIs may contain in their collections. This is particularly relevant since digitisation has multiplied the digital public domain material. All this information has an important value for the creation of digital products and services and has ‘a huge potential for innovative and re-use in sectors such as learning and tourism’<sup>602</sup>.

However, not all cultural institutions fall under the scope of the Directive. CHIs related to performing arts such as ‘orchestras, operas, ballets and theatres, including the archives that are part of those

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<sup>598</sup> *ibid* art 8.

<sup>599</sup> *ibid* rec 44.

<sup>600</sup> *ibid* art 1.6.

<sup>601</sup> Paul Keller and others, ‘Re-Use of Public Sector Information in Cultural Heritage Institutions’ (2014) 6 *International Free and Open Source Software Law Review* 1, 3.

<sup>602</sup> The Open Data Directive rec 65.

establishments'<sup>603</sup> are explicitly excluded from the scope of the Directive, due to the specificities of the sector.

In addition, as explained earlier, not all documents held by CHIs fall under the provisions of the Directive. Documents held by CHIs that are protected by IPRs- including copyright, related rights or sui generis rights<sup>604</sup>- and whose owner is a third party, will not fall under the scope of the Directive<sup>605</sup>. These documents should be considered as one for which third parties hold IPRs and thus there is no obligation for re-use. Furthermore, there is an absolute exclusion for documents covered by industrial property rights such as trademarks, patents or registered designs<sup>606</sup>.

In consequence, only documents that are in the public domain or for which the CHI holds the IPR fall under the obligations laid down by the Directive. However, different rules apply depending on the category of documents. If they are in the public domain and not protected by exclusive rights, their re-use should be the general rule (when they are generally accessible). On the contrary, for documents for the CHI holds IPR, the rule under Article 3(2) applies: the institution can choose if re-use is allowed or not. Yet, if the CHI decides to allow the re-use of such documents, it must be for commercial and non-commercial purposes<sup>607</sup>.

With regard to the **rules for processing the re-use, libraries, museums and archives deviate from the general rule** of providing them free of charge. CHIs are allowed to charge above marginal costs for the provision of documents for re-use. However, the Directive specifies that the total income for the provision of documents 'should not exceed the cost of collection, production, reproduction, dissemination, preservation and rights clearance, together with a reasonable return on investment'<sup>608</sup>. This mainly means that CHIs are allowed to generate profits for providing and allowing the re-use of their cultural resources<sup>609</sup>. However, this additional charging? requirements could undermine the public domain, limiting online access to cultural resources and damaging the cultural data ecosystem<sup>610</sup>.

The most controversial part of the Directive for CHIs is the provision established in Article 12 regarding **works in the public domain**. The digitization of public domain works has been an important driver for the nascent open data movement in the cultural heritage sector <sup>611</sup>. Yet, the new Directive deviates from the general rule of non-granting exclusive rights for the re-use of documents to third parties when digitization of CHI's cultural resources is concerned. Article 12.3 expressly addresses the situation of CHIs when digitising their cultural resources through agreements with private partners. As these private partners normally make an economic investment, the Directive grants a certain exclusivity period of time when there are exclusive rights granted in relation to the digitization of

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<sup>603</sup> *ibid* rec 65.

<sup>604</sup> *ibid* rec 54.

<sup>605</sup> *ibid* rec 55.

<sup>606</sup> *ibid* rec 54.

<sup>607</sup> Keller and others (n 601) 5.

<sup>608</sup> The Open Data Directive rec 38.

<sup>609</sup> Keller and others (n 601) 4.

<sup>610</sup> *ibid* 8.

<sup>611</sup> *ibid* 7.

cultural resources. According to the Article, the exclusivity period will allow the private partner to recover the investment made.

The exclusivity period should be up to 10 years with an obligation to be reviewed after the 11<sup>th</sup> year. This 'short' period of exclusivity is explained by 'the principle that public domain material should stay in the public domain once it is digitised'<sup>612</sup>. Furthermore, the arrangements between CHIs and the private partners granting exclusive rights should be made public. In addition, the institution which made such documents available should receive a copy of the digitised cultural resources which can be re-used at the end of the exclusivity period. This provision has not been welcomed by certain organizations that are working for a free public domain. This provision provides the possibility for private partners to control the access to re-use of works in the public domain.

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<sup>612</sup> The Open Data Directive rec 49.

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