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The Copyright Office
Library of Congress
101 Independence Avenue S.E.
Washington D.C. 20559-6000
UNITED STATES OF AMERICA

On-line submission at http://www.copyright.gov/docs/making_available/comments/

**Notice of Inquiry “*United States Copyright Office [Docket No. 2014–2] Study on the Right of Making Available; Comments and Public Roundtable*”
Submission by the International Association of Scientific Technical and Medical Publishers, STM**

Dear Sirs

Introduction

The International Association of Scientific, Technical and Medical Publishers (“STM”) is the leading global trade association for academic and professional publishers. It has over 120 members in 21 countries, including in the United States of America, who each year collectively publish nearly 66% of all journal articles and hundreds of thousands of monographs and reference works. STM members include learned societies, university presses, private companies, new starts and established players.

We welcome the opportunity to provide comments and to contribute to the Study on the “Right of Making Available”.

The copyright works produced by STM members are to the largest extent literary works, with pictorial and graphic works embedded in them, which are produced in print form and in electronic form. Increasingly STM publications also contain embedded video or animated images, as well as links to underlying research data and data sets. STM publishers have actively embraced the opportunities of the digital online environment in making their content available electronically.¹ In doing so, STM publishers not only make their scholarly journals available on-line, but, as appears more fully below, have actively participated in other ways under which their content can be made available, such as licensing institutional libraries to

¹ A useful catalogue of the digital changes in scholarly publishing can be found in the STM report (2012) “An Overview of Scientific and Scholarly Publishing” at http://www.stm-assoc.org/2012_12_11_STM_Report_2012.pdf.

deliver documents electronically and supporting the initiative in Europe facilitating the mass digitization of out-of-commerce works by institutional libraries.

STM's own submission will be limited to a global and international perspective. Many US members of STM are also members of the Association of American Publishers (AAP), whose submission STM also supports. STM also welcomes the opportunity to continue contributing to future deliberations after making this submission.

1. Existing Exclusive Rights under Title 17

- a. *How does the existing bundle of exclusive rights currently in Title 17 cover the making available and communication to the public rights in the context of digital on-demand transmissions such as peer-to-peer networks, streaming services, and downloads of copyrighted content, as well as more broadly in the digital environment?*

(i) *Qualification of activity under US copyright law*

STM defers to the extensive research and testimony of Professor David Nimmer (See *Statement of David Nimmer, Professor, UCLA School of Law, The Scope of Copyright Protection, and witness statements.*²

From an international perspective the WIPO Copyright Treaty (WCT) envisages that every contracting party is free how to implement at national level the obligations incurred and to decide how and under what heading it grants the agreed minimum exclusive rights of copyright. This flexibility and freedom of implementation, the well-known commentator Mihály Ficsor baptized the “umbrella solution” (*Mihály Ficsor: The Law of Copyright and the Internet, Chapter 7, C8.11, page 500, Oxford University Press, Oxford (UK), 2002.*).

In the context of this enquiry, these minimum rights comprise, firstly, the exclusive right of communication to the public, with its component right covering inter-active delivery rights known as the “making available right”, as well as a broader comprehensive communication to the public right, and, secondly, the exclusive right of distribution (with its sub-rights of rental right and right of importation). In terms of the WCT the distribution right must, as a minimum, comprise an offline distribution right of “fixed copies that can be put into circulation as tangible objects”; see agreed statement to Art. 6 WCT. The WCT does, however, not limit contracting parties to recognize a distribution right that is broader and also applies for instance to digital transmissions (*Mihály Ficsor: The Law of Copyright and the Internet, Chapter 7, C8.11, pages 485/486., Oxford University Press, Oxford (UK), 2002.*).

Nothing from the international drafting history would show that actual receipt of a copy in the hands of a recipient is required to infringe the right of communication to the public, the making available right or the exclusive distribution right. Some foreign copyright laws, for instance German law, clarify that the distribution right is infringed at the time tangible copies are offered in the market place (See Article 17 (1) German Copyright Act: “*The right of distribution is the right to offer the original or copies of the work to the public or to bring it to the market*”³.. Thus, the offering for sale is as much an infringement as the actual delivery of a tangible copy.

² David Nimmer's testimony is available is at:

<http://docs.house.gov/Committee/Calendar/ByEvent.aspx?EventID=101642>).

³ Official English translation available at: http://www.gesetze-im-internet.de/englisch_urhg/englisch_urhg.html#p0076).

What is important more generally in STM's view is that any national implementation does not artificially create "gaps" in the coverage of exclusive rights of copyright. The national decision under which exclusive right to recognize the "making available right" or any other exclusive right should not lead to an unintended lacuna where by some technological process it is argued that an act is a "legal nothing" and somehow falls into a copyright no-man's land.

(ii) Other factors: identity of infringers/co-infringers, time of infringement, place of infringement, applicable law

Apart from a correct interpretation of US law in terms of qualifying any conduct as implicating one or several exclusive rights, these qualifications may have implications for the "meta-data" of any infringement: Who caused/who is responsible for the conduct? When did the conduct take place? Where did the conduct take place? Which law applies?

Identity: In STM's view whoever caused an infringing activity to take place should be regarded as a co-infringer, irrespective of any available defense and irrespective of who pressed the button. In addition, ancillary liability may be available under national law in respect of contributory infringers or under a theory of vicarious liability or as a result of creating a structurally infringing scenario, device or business model.

Time: In any event, throughout the process, it should be clear that at least an exclusive right of copyright is being exercised and that there is no "gap" in time between the initiation of the first of these acts and the last. Moreover, STM does not believe that US case law requiring an actual receipt of a copy or download of an electronic reproduction should be required before the US exclusive right of distribution is to be considered infringed during the above process.

Place and applicable law: In STM's view a single electronic infringing activity may be relevant under more than one national law of copyright: Where the uploader is situated in country A and the hosting site is situated in country B and the intended download or display is perceptible from countries C and D, then all four national copyright laws are potentially applicable. From a US perspective, it is important to consider that a copyright-protected work made available through a site hosted abroad, may infringe the US distribution right, even in the absence of proof of download or display within the borders of the US.

Similarly, the exhaustion of an exclusive right in one jurisdiction should not automatically signify the exhaustion in all or some of the other jurisdictions. STM notes that a majority of the US Federal Supreme Court held that current US law leads to this conclusion in relation to academic textbooks destined for foreign markets. These lower priced editions are not intended for US students and a "national exhaustion principle", STM with all due respect believes, is what serves consumers and copyright owners best when it comes to academic textbooks.

2. Foreign Implementation and Interpretation of the WIPO Internet Treaties

- a. *How have foreign laws implemented the making available right (as found in WCT Article 8 and WPPT Articles 10 and 14)? Has such implementation provided more or less legal clarity in those countries in the context of digital distribution of copyrighted works?*

STM is advised that different countries have implemented the exclusive rights differently. Even within the European Union important distinctions remain. France, for example treats the exclusive right of distribution as a sub-category of the exclusive reproduction right (the same for the right of adaptation) and the right of "making available" as comprised in the right of

“representation”, akin to the display right in the US (*Pascal Kamina in: Copyright in the Information Society, A Guide to National Implementation of the European Directive, chapter 9 “France”, paras 1.2 and 1.3, page202), para 1.3, Edward Elgar Publishing, 2011, Cheltenham (UK), by Brigitte Lindner and Ted Shapiro Editors*). In practice, few if any controversies have arisen for STM publishers over the nature, scope and level of protection of these economic rights in France. These rights are generally broadly understood and courts interpret the rights in such a way that “gaps”, ie uses falling between one right and another into a void, rarely arise, if ever.

In Germany, as well as some other European countries, the approach to copyright means that the enumerated exclusive rights are seen as manifestations of a general exclusive economic right of the author. German law, explicitly states that the author must participate adequately economically in the exploitation of his or her work.⁴ The individually and statutorily recognized exclusive rights are merely practical manifestations of this general “*right of economic participation*” on which the author may rely, if a particular use is not covered by any specific right. As mentioned in response to Question 1.a. (i) above, the German Copyright Act defines distribution as the offering for sale, or bringing to market. These activities already engage the exclusive distribution right. The actual perfection of a contract of sale or purchase, or the delivery of a tangible copy is not required for the right to be infringed.

b. How have courts in foreign countries evaluated their national implementation of the making available right in these two WIPO treaties? Are there any specific case results or related legislative components that might present attractive options for possible congressional consideration?

As far as jurisprudence is concerned, non-US courts have had to consider a number of important questions to clarify the rights contained in the WIPO treaties, in particular in the European Union, where Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonization of certain aspects of copyright and related rights in the information society (the “Directive”⁵ also distinguishes between the distribution right in Article 4, the communication to the public right in Article 3.1, and the right of making- available a work to members of the public in Article 3.2. of the Directive.

In general, the jurisprudence of the European Court of Justice (ECJ) has harmonized these concepts even to a greater degree. Most recently the ECJ ruled on the implication of the making available right by the publication of a link to a copyright-protected work (the *Svensson* case⁶). The ECJ points out that for a specific act (i.e. the creation of a hyperlink) to be considered an act of communication to the public within the meaning of article 3.1 of the Directive, the communication must be directed at a new public. According to the Court, a new public is a public that was not taken into account by the copyright holders at the time the initial communication was authorized.

Also, several ECJ decisions have ruled on reaching a “new” or existing public in relation to sports broadcasts (*Premier League* case⁷) and *Catch-up TV* case⁸. None of these judgments

⁴ §§11, read with 15, available as an official English translation at: http://www.gesetze-im-internet.de/englisch_urhg/englisch_urhg.html#p0050.

⁵ The Directive is available in English at: <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=CELEX:32001L0029:EN:HTML>.

⁶ *Svensson* case, C466/12, available at: <http://curia.europa.eu/juris/document/document.jsf?text=&docid=147847&pageIndex=0&doclang=EN&mode=req&dir=&occ=first&part=1&cid=58394>.

⁷ *Premier League*, Joined cases C-403/08 and 429/08, available at: <http://curia.europa.eu/juris/liste.jsf?num=C-403/08&language=en>.

are particularly surprising and have on the whole confirmed the necessity to maintain a broad set of exclusive rights that is technology-neutral and does not create any loop-holes or artificial gaps “between” exclusive rights.

It may be fair to surmise that in Europe the distinction between exclusive rights is not relevant regarding the question of “whether or not” an activity is covered or implicates copyright, but regarding the question of the availability of an exception from copyright infringement. Thus, the above-referenced directive permits EU member states a finite list of exceptions and some of these may only be available with regard to the reproduction and “European” exclusive distribution right (*ie the off-line distribution of copies of copyrighted-works, as opposed to digital online dissemination*). Moreover, important ECJ rulings have concerned the definition of substantial part (*Infopaq I* and *Infopaq II*)⁹ and exceptions for so-called temporary and incidental copies with one important case referred by the UK Supreme Court still pending (*Meltwater* case¹⁰). There has been one judgment of the ECJ applicable to software (the *UsedSoft* case¹¹ that would be viewed as problematic by the rightsholder community, if it were also applied in the context of other literary and artistic works: the case concerns the exhaustion of the distribution right in the case of electronic distribution of a computer program.

3. a.-d Possible Changes to U.S. Law

STM defers to AAP and would be thankful for the opportunity to make comments at the appropriate time.

STM stands ready to supplement this submission or contribute in whatever way is appropriate as the Copyright Office’s consultations progress.

Yours faithfully,



Michael Mabe
Chief Executive Officer

⁸ ITV case C-607/11, see:

<http://curia.europa.eu/juris/document/document.jsf?text=&docid=134604&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=109555>

⁹See for *Infopaq I*, C-5/08, see http://www.bailii.org/eu/cases/EUECJ/2009/C508_J.html and *Infopaq II*, C302/10, see: <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=CELEX:62010CO0302:EN:HTML>

¹⁰ *Meltwater* case, see C-360/13

<http://curia.europa.eu/juris/document/document.jsf?text=&docid=140431&pageIndex=0&doclang=EN&mode=req&dir=&occ=first&part=1&cid=31396>

¹¹ *UsedSoft* case, C-128/11, see:

<http://curia.europa.eu/juris/document/document.jsf?text=&docid=124564&pageIndex=0&doclang=EN&mode=req&dir=&occ=first&part=1&cid=2558320>.