

# Framing links and the prohibition of formalities

by **Maurice Schellekens\***

**Abstract:** The Berne Convention of 1886 prohibits subjecting foreign copyright holders to formalities that control the enjoyment and exercise of their rights. This has given an important impetus to the 'international' protection of copyrights. This century, there is increasing attention for the drawbacks of a prohibition of formalities. Formalities may make it more difficult to clear rights because they limit possibilities to make the registration of rights mandatory or to find solutions for the use of orphaned works. In its recent decision in *VG Bild-Kunst* case, the CJEU has arguably introduced a new formality. A copyright holder who wants to exercise control over hy-

perlinks and framing links to their work, has to use effective technological protection measures to clarify for which public they seek to make their work available on the internet. The reason for requiring technology is to make it easier for those making links to know what links are allowed and which ones are not. However, if foreign copyright holders can invoke the prohibition of formalities and can enforce their rights against makers of links, even if they did not use technology, the goal of more clarity on permitted uses would not be achieved. This article investigates how the old prohibition of formalities relates to the proposed new uses of technology.

**Keywords:** Berne Convention; prohibition of formalities; hyperlinks; framing links; implied consent; Communication to the Public

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## A. Introduction

1 The Berne Convention of 1886 contains a prohibition of formalities. The prohibition ensures that authors outside their country of origin can enjoy and exercise their copyright, without having to comply with formalities. This has given an important boost to copyright protection on an international scale. The TRIPs agreement and the WIPO Copyright Treaty have further extended the prohibition of formalities. Even at the time the Berne Convention was drafted and during its first revisions, it was known that formalities can have positive effects too. For example, registration of a work or a copyright notice can alert the public to the existence of a copyright and thus can create more clarity about the status of a work. Nowadays, the subject matter of copyright has expanded, and the informational function of formalities has not lost its relevance. In the *VG Bild-Kunst* case, the CJEU conditioned the right to forbid hyperlinks to a work on the use of effective technical protection measures by the

copyright holder.<sup>1</sup> The rationale is to create more certainty for those who seek to create hyperlinks to works. This article investigates how this new use of formalities relates to the old prohibition and how the decision sits within the field of tensions between unencumbered protection of copyrights outside the country of origin and the informational needs of

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1 CJEU 9 March 2021, Case C-392/19, ECLI:EU:C:2021:181, *VG Bild-Kunst v Stiftung Preußischer Kulturbesitz*, available at: <https://curia.europa.eu/juris/document/document.jsf?jsessionid=D63604B1A42C29CE0C30A-5996886F3E6?text=&docid=238661&pageIndex=0&dlang=EN&mode=lst&dir=&occ=first&part=1&cid=9602731> Nelisa de Bruin, 'Door middel van framing opnemen van werk op website is mededeling aan publiek wanneer er maatregelen tegen framing zijn getroffen' (IEPT20210309, HvJEU, *VG Bild-Kunst v SPK*, 17 March 2021) <https://www.boek9.nl/items/iept20210309-hvjeu-vg-bild-kunst-v-spk> > accessed 21 July 2021.

the public where it concerns information about the management of copyrights.

- 2 The first section after this introduction will briefly explain the VG Bild-Kunst case and place it in the context of the court's caselaw on hyperlinks. The second sections will address the question how the court's latest decision relates to the prohibition of formalities.

## B. The VG Bild-Kunst ruling

- 3 Collective management organization (hereinafter CMO) VG Bild-Kunst negotiated with Stiftung Preußischer Kulturbesitz (hereinafter SPK) which is the operator of the website of the Deutsche Digitale Bibliothek (hereinafter DDB) about a license allowing the latter to display on its website(s) works of authors that are represented by VG Bild-Kunst.<sup>2</sup> VG Bild-Kunst insisted that SPK take effective technical protection measures (hereinafter TPMs) to prevent third parties from framing the works displayed on DDB's website and wanted to see a condition to that effect included in the license agreement between the parties. SPK disagreed and demanded that the CMO grant a license without the disputed condition. Litigation before German courts reached the Federal Court of Justice. In order to properly assess whether VG Bild-Kunst's demand for TPMs was objectively justified, the Federal Court of Justice asked the CJEU the following question for preliminary assessment: "Does the embedding of a work – which is available on a freely accessible website with the consent of the right holder – in the website of a third party by way of framing constitute communication to the public of that work within the meaning of Article 3(1) of Directive 2001/29 where it circumvents protection measures against framing adopted or imposed by the right holder?"
- 4 In its earlier case law, the CJEU had already decided that a public hyperlink to a work is only a communication to the public if the link serves a new public.<sup>3</sup> This holds not just for clickable links, but also for so-called framing links where webcontent is shown inside the frame of another website.<sup>4</sup> A new public is a public not contemplated by the rightsholder when he gave permission for the website on which

the work is placed (and to which a link points). This is for example the case where a work is behind a paywall and the link circumvents the paywall. Hence, a new public can be a public that is not served by the original website, such as non-paying visitors in the example above. The facts of the VG Bild-Kunst case were particular in the sense that they concerned a situation where technology did not limit directly who could visit the original website, but the requested technology would only control what links could be made to the website. It only controlled who could see a work framed within a third party website. The technology left unaffected who can see the work directly on the original website of DDB (which might be anybody on the internet). The CJEU decided that also in this case the public excluded via the technology (i.e. the public that would have seen works framed in a third party website) counts as not contemplated by the copyright holder and therefore as a new public.<sup>5</sup> Hence, the CJEU answered the question of the Federal Court of Justice affirmatively.

- 5 With its ruling, the court gave a new dimension to how it conceives a new public. Apparently, a new public is not simply an issue of a nose-count or an analysis who could technically have had access to a work. The newness of a public may also be dependent on the context within which a member of the public has access to a work. A rightsholder may contemplate access via a certain website (for example Deutscher Digitaler Bibliothekenverband) and exclude access via framing links on other websites, even though anybody can directly access the work on the first mentioned website. This adds a new dimension to what the court decided in the Svensson case where it still found (at 26 and 27):

*26 The public targeted by the initial communication consisted of all potential visitors to the site concerned, since, given that access to the works on that site was not subject to any restrictive measures, all Internet users could therefore have free access to them.*

*27 In those circumstances, it must be held that, where all the users of another site to whom the works at issue have been communicated by means of a clickable link could access those works directly on the site on which they were initially communicated, without the involvement of the manager of that other site, the users of the site managed by the latter must be deemed to be potential recipients of the initial communication and, therefore, as being part of the public taken into account by the copyright holders when they authorised the initial communication.*

2 C-392/19, VG Bild-Kunst v Stiftung Preußischer Kulturbesitz, at 11.

3 CJEU 13 February 2014, C-466/12, ECLI:EU:C:2014:76, Nils Svensson, Sten Sjögren, Madelaine Sahlman, and Pia Gadd v Retriever Sverige AB, at 24-28.

4 CJEU 21 October 2014, C-348/13, BestWater International GmbH v Michael Mebes, and Stefan Potsch, at 17-19.

- 6 In case a copyright holder has taken measures to prevent framing however, the court finds that the nose-count-approach to a new public to 'be incompatible with his or her exclusive and inexhaustible right to authorise or prohibit any communication

5 C-392/19, VG Bild-Kunst v Stiftung Preußischer Kulturbesitz, at 41, 42.

to the public of his or her work'.<sup>6</sup> From the perspective that the right to communication to the public must not be hollowed out, the ruling is justified. It does however add yet another layer of complication to the application of copyright law to the phenomenon of hyperlinking.

- 7 To make the application of this part of copyright law easier in practice, the court decided that the copyright holder can only make known which public he contemplates through the use of effective technological protection measures (hereinafter TPMs). Hence, it is apparently not sufficient to put a provision in the Terms-of-Use of the website stating that framing is not permitted or words of similar meaning. They have to use effective technical protection measures to prevent framing.<sup>7</sup> In practice, this means either limiting access to the website or limiting the links that can be made. The court gives the following reasons for requiring effective TPMs:

46. *It must be made clear that, in order to ensure legal certainty and the smooth functioning of the internet, the copyright holder cannot be allowed to limit his or her consent by means other than effective technological measures, within the meaning of Article 6(1) and (3) of Directive 2001/29 (see, in that regard, judgment of 23 January 2014, Nintendo and Others, C-355/12, EU:C:2014:25, paragraphs 24, 25 and 27). In the absence of such measures, it might prove difficult, particularly for individual users, to ascertain whether that right holder intended to oppose the framing of his or her works. To do so might prove even more difficult when that work is subject to sub-licences (see, by analogy, judgment of 8 September 2016, GS Media, C-160/15, EU:C:2016:644, paragraph 46).*

49. *Admittedly, it cannot be forgotten that hyperlinks, whether they are used in connection with the technique of framing or not, contribute to the smooth operation of the Internet, which is of particular importance to freedom of expression and information, enshrined in Article 11 of the Charter, as well as to the exchange of opinions and information on the Internet, which is characterised by the availability of incalculable amounts of information (judgment of 29 July 2019, Spiegel Online, C-516/17, EU:C:2019:625, paragraph 81 and the case-law cited).*

- 8 From the perspective that makers of framing links need to know what public a copyright holder contemplated, the requirement to use TPMs can be applauded.

6 C-392/19, VG Bild-Kunst v Stiftung Preußischer Kulturbesitz, at 50.

7 Alexander Ross, 'VG Bild-Kunst v SPK - putting the illegality back into being framed, Case Comment', (2021) 32(5) Ent. L.R. 149, 150: 'It appears from the decision that (absent the introduction of such measures by the rights holder) a simple contractual bar on framing by the copyright owner would not be enough—it seems that the relevant licence would have to expressly require the licensee to introduce "effective technological measures" to prevent framing.'

- 9 On the basis of the court's ruling, one may wonder whether the technical measures are perhaps required in more situations: not just for controlling framing links, but for all hyperlinks. The reason to demand effective technological protection measures (legal certainty, smooth functioning of the internet) certainly points in that direction. The uncertainty faced by potential makers of links is the same, whether it concerns framing links or clickable links. The rationale (i.e., difficulty of ascertaining the rightsholder's intentions) also points in this direction. Moreover, the court seeks to hold the rules around linking technology neutral.<sup>8</sup>

- 10 At the same time, the desired clarity is achieved only with limitations. An internet user making a link cannot blindly trust the presence or absence of TPMs. Works can be and often are placed on the internet without permission of the rightsholder, and then the absence (or even presence) of TPMs obviously does not provide any information about the intentions of the rightsholder.

- 11 The ruling also does not make clear what counts as effective technical protection measures. Sometimes the TPM only consists of machine readable text that others respect on the basis of a broadly shared technical convention. For example, with a robots.txt file a website owner can indicate that a site may not be indexed by a search engine. Search engines usually respect the message conveyed by a robots.txt file. However, the text file does not physically prevent indexing. In that respect, it may not be effective.

- 12 Furthermore, the clarity of the intentions of the copyright holder may be compromised if a copyright holder's expression in words about their intentions deviate from the 'message' conveyed by technology. If the text of the ruling is taken by its literal meaning, it suggests that a copyright holder's clear expressions of their intentions in words should be ignored, if not backed up by TPMs. So, terms-of-use of a website that clearly address the copyrights in works present on the website and disallow links should thus be ignored, if no TPMs to that effect are in place. The same holds for provided licenses. That is at least remarkable, because the court also stresses a copyright holder's exclusive and inexhaustible right to authorize or prohibit any communication to the public.<sup>9</sup> It will be interesting to see whether this is going to be further qualified in future case law.

- 13 Foreign copyright holder's may find in the prohibition of formalities, both in the Berne Convention and in

8 C-466/12, Svensson, at 29.

9 C-392/19, VG Bild-Kunst v Stiftung Preußischer Kulturbesitz, at 50.

the WIPO Copyright Treaty, a first instrument to test this aspect of the court's ruling. The court did not address the compatibility of its decision with the prohibition of formalities.

## C. Prohibition of formalities

14 Under the Berne Convention, foreign authors may not be subjected to formalities that affect the existence and enforcement of rights. Formalities relating to the existence of rights refer to 'everything which must be complied with in order to ensure that the rights of the author with regard to their work may come into existence.'<sup>10</sup> Examples of this include registration, deposit of copies, payment of fees or the making of declarations. Likewise, formalities relating to the enforcement refer to everything that must be complied with to bring court proceedings to enforce the copyright. According to article 5(2) BC, the enjoyment and the exercise of the author's rights shall not be subject to any formality. The term 'exercise' of rights in the Berne Convention means enforcement.<sup>11</sup>

### I. Is requiring effective TPMs to limit the contemplated public a formality?

15 According to the decision in VG-Bild-Kunst, a rightsholder can only invoke their right to communication to the public against the maker of a hyperlink, if it serves a new public. A new public is defined as a public not contemplated by the copyright holder when they gave permission for the original communication of the work on the website to which the hyperlink points. To preserve the possibility to act against hyperlinks, the copyright holder must mark a potential public as not contemplated by them. Theoretically, a public can be excluded by using effective TPMs, by demanding that licensees take such technical measures or by excluding a public in words, for example in a contract, website terms-of-use or the like. The latter option has been whittled down by the latest decision of the court, as was mentioned in the previous section.

16 To see what exactly the formality is in a hyperlinking case, we have to revisit the observation made in the previous section that a rightsholder may delimit a public either by limiting the public of the original website or by specifically addressing hyperlinks (as in the VG Bild-Kunst case). In the first mentioned cases, a copyright holder may place their work on a website behind a paywall, because this is the way to exploit their work. It is now the responsibility of the maker of a hyperlink to this work to respect the paywall or to ask for permission for a hyperlink. The copyright holder does not need to do anything to ensure that that any non-paying audience is considered a new public, other than what they did to delimit the public of their original website. So in this case, the paywall is simply a decision of the copyright holder to exercise their right in a certain way.

17 However, if the copyright holder wants to set specific rules for hyperlinking (e.g. no hotlinking or framing forbidden, but other links are fine) then the copyright holder has to take measures specifically targeting hyperlinks. Given that the copyright holder has to do something to preserve their right, this raises the question whether the requirement to use TPMs amounts to a forbidden formality in the sense of article 5(2) BC. In some blogs, it is suggested that this is indeed so.<sup>12</sup>

18 First, a declaration, either in words or through the use of effective TPMs, is of the type of activities that are typically caught by the concept of formalities as meant in the BC and WCT.<sup>13</sup>

19 Second, we need to analyze whether the formality affects the existence or scope of the right ('enjoyment' in terms of the Berne Convention) or conditions its enforcement ('exercise' in terms of the Berne Convention). The requirement of TPMs does not affect the procedural means that a foreign copyright holder has at their disposal to enforce a right.

10 Federal Council programme, art. 2: Actes 1884, 43. See also S. Ricketson and J.C. Ginsburg, *International Copyright and Neighbouring Rights. The Berne Convention and beyond*, Volume I, (second edition OUP, 2006) 323.

11 S. Ricketson and J.C. Ginsburg, *International Copyright and Neighbouring Rights. The Berne Convention and beyond*, Volume I, (second edition OUP, 2006), 6-104, p. 325.

12 Eleonora Rosati, 'CJEU rules that linking can be restricted by contract, though only by using effective technological measures' (IPKat 2021) <<https://ipkitten.blogspot.com/2021/03/cjeu-rules-that-linking-can-be.html>> accessed 14 June 2021, under 'Comment' and Giulia Priora, 'The CJEU's take on unauthorized framing of online content: (only) if technologically precluded, then prohibited, Court of Justice of the European Union, 9 March 2021, Case C-392/19, VG Bild-Kunst v Stiftung Preußischer Kulturbesitz (VG Bild-Kunst)' (Medialaws 9 April 2021) <<https://www.medialaws.eu/the-cjeus-take-on-unauthorized-framing-of-online-content-only-if-technologically-precluded-then-prohibited/>> accessed 21 July 2021, at 5.2.

13 S. Ricketson and J.C. Ginsburg, *International Copyright and Neighbouring Rights. The Berne Convention and beyond*, Volume I, (second edition OUP, 2006), 1-19, p. 18.

Therefore, the analysis below focuses on formalities that condition the ‘enjoyment’ of a right.

- 20 Could the existence or scope of the right be affected by the formality? For the formality to affect existence or scope, this would mean that a hyperlink serving a contemplated public (i.e. a public the copyright holder failed to exclude) is outside the scope of the right of communication to the public. The following part of the ruling in VG Bild-Kunst supports this proposition. In rule 36 of its decision, the court states:

*[...] it is apparent from the Court’s case-law that, provided that the technical means used by the technique of framing are the same as those previously used to communicate the protected work to the public on the original website, namely the Internet, that communication does not satisfy the condition of being made to a new public and, since that communication accordingly does not fall within the scope of a communication ‘to the public’, within the meaning of Article 3(1) of Directive 2001/29, the authorisation of the copyright holders is not required for such a communication [...]*

- 21 Apparently, in the absence of a new public, the making of a hyperlink falls outside the scope of a communication to the public. This reading is further supported in rule 32 where the court holds:

*‘In order to be classified as a ‘communication to the public’, a protected work must further be communicated using specific technical means, different from those previously used or, failing that, to a new public, that is to say, to a public that was not already taken into account by the copyright holder when he or she authorised the initial communication of his or her work to the public (judgment of 19 December 2019, *Nederlands Uitgeversverbond and Groep Algemene Uitgevers*, C-263/18, EU:C:2019:1111, paragraph 70 and the case-law cited).’*

- 22 Hence, if the technical means are the same (hyperlink is the same means) and the public is contemplated and thus not new there is no communication to the public. It seems that the copyright holder is required to perform a formality, viz. to mark a public as not contemplated, in order to prevent that a hyperlink serving this public falls outside the scope of the right of communication to the public. Therein, it would affect the scope of the right.

## II. Is it a forbidden formality?

- 23 The BC gives foreign authors certain substantive minimum rights and it grants them protection under the assimilation principle. Does the requirement of TPMs take away minimum rights? In particular, one may ask whether the right of communication to the public as meant in the BC encompasses hyperlinking. If it wouldn’t, it may be possible to argue that formalities are allowed since they fall outside the framework of the BC. In order to analyze this, we

must look beyond the BC, in particular to the WIPO Copyright Treaty (hereinafter WCT). According to article 3 WCT, signatories must apply the articles 1 to 21 of the BC *mutatis mutandis* to the protection provided for in the WCT. This includes the prohibition of formalities of article 5(2) BC. Article 8 WCT brings the right of making a work available to the public explicitly under the right of communication to the public. The WCT prescribes that signatories must ensure that authors ‘enjoy the exclusive right of authorizing any communication to the public of their works, by wire or wireless means, including the making available to the public of their works in such a way that members of the public may access these works from a place and at a time individually chosen by them’. This does not yet explicitly say that hyperlinking is covered, but it brings the right of communication to the public at least within the digital realm. But even if it cannot be established with certainty whether hyperlinking falls within the right of making available to the public as mentioned in the WCT, it may still not be beyond the reach of the formalities prohibition. On the basis of a historic interpretation, Ginsburg rejects the view that the prohibition of formalities does not see to rights extending beyond Berne minima.<sup>14</sup> Strict adherence to well-established minimum rights would make the prohibition of formalities a toothless instrument. The whole idea of Berne+ rights is a misnomer according to Ginsburg.

- 24 However, the issue may be moot in light of the fact that a foreign author in an EU Member State may invoke the assimilation principle. Under this principle, they have a right of communication to the public that can be invoked against makers of hyperlinks, since foreign national copyright law of an EU Member State grants this right. The foreign author may not have taken technical measures against framing nor any other measures, such as a rejection of framing in the ToU of the website. Could they invoke the prohibition of formalities to enforce their right of communication to the public against the maker of a framing link? That would be unlikely if you interpret the assimilation principle purely as a non-discrimination principle. Then the foreign author would be able to invoke the right only on the same terms as a national author. However, this would take away the effect of the prohibition of formalities. For a foreign copyright holder, it is more difficult to comply with formalities than it is for a national author.<sup>15</sup> Given the rationale of the

14 Jane C. Ginsburg, ‘Berne-Forbidden Formalities and Mass Digitization’ (2016) 96 B. U. L. Rev. 745 <[https://scholarship.law.columbia.edu/faculty\\_scholarship/691/](https://scholarship.law.columbia.edu/faculty_scholarship/691/)> accessed 7 July 2021, p.763-764. This includes rights covering ground that could be subject to Berne-permissible exceptions.

15 See S. Ricketson and J.C. Ginsburg, *International Copyright*

BC to enable and facilitate copyright protection outside the country of origin, this approach must be rejected. Analyzing the issue from the perspective of the Vienna Convention on the law of treaties, van Gompel arrives at the same conclusion in his dissertation.<sup>16</sup> It is more convincing to interpret the assimilation principle as granting ‘the rights which their respective laws do now or may hereafter grant to their nationals’. The foreign copyright holder is able to invoke the right to communication to the public as a right granted to national authors and ignore the formalities on the basis of the prohibition. He would thus be able to demand action against the maker of a framing link.

- 25 The preliminary result is that foreign authors may invoke a right to Communication to the public in European Member States without having taken TPMs. This would undermine the certainty the CJEU seeks to create for makers of hyperlinks: every foreign author could invoke the right to communication to the public without TPMs. This gives reason to analyze whether there are ways to avoid this result. A first approach may be to see whether the Berne Convention and the WCT would arrive at a different result if hyperlinking in certain situations is seen as an exception to the right to communication to the public.

## 1. Hyperlinking as an exception to the right to Communication to the public

- 26 Article 10bis(1) BC may give a possibility to introduce a formality that also binds foreign copyright holders. The first sentence of the provision reads:

*‘(1) It shall be a matter for legislation in the countries of the Union to permit the reproduction by the press, the broadcasting or the communication to the public by wire of articles published in newspapers or periodicals on current economic, political or religious topics, and of broadcast works of the same character, in cases in which the reproduction, broadcasting or such communication thereof is not expressly reserved.’*

- 27 This provision gives the possibility to introduce an exception for the benefit of the press, however with a possibility for the copyright holder to expressly reserve the mentioned rights, in which case the exception obviously isn’t available. Possibly, the route

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and Neighbouring Rights. The Berne Convention and beyond, Volume I, (second edition OUP, 2006), section 6.85.

- 16 Stef van Gompel, Formalities in copyright law—an analysis of their history, rationales and possible future (Wolters Kluwer, Information Law Series, 2011) 179–93. Available at: <<https://dare.uva.nl/search?identifier=2f611291-951b-4781-9559-fc64158902d0>>, p. 150.

via an exception provides a model that can be used in other situations too, to introduce a formality that is not forbidden. The idea would be that national law introduces an exception, e.g. an exception to the right to communication to the public allowing beneficiaries of the exception to make framing links. The assimilation principle would give a foreign author only the right as reduced by the exception and in order to bar a claim of the foreign copyright holder grounded in minimum rights, the exception must be Berne and WCT compatible, i.e. it must pass the 3-step test. Therefore, the reasoning is that compliance with the formality – such as taking effective TPMs against framing – would broaden the rights of the foreign author beyond what he can claim on the basis of the Berne Convention and the WCT. Employing TPMs would allow the copyright holder to forbid framing links as communications to a new public. Because compliance with the formality would give supra-treaty rights and because the BC apparently sanctions such a construction in article 10bis(1), be it in a different context, the formality would be allowed and can be invoked against foreign authors.

- 28 This argumentation is however controversial. Ginsburg argues that article 10bis(1) BC is a *lex specialis* that does not lend itself for a generalization.<sup>17</sup> It has to be said that article 10bis(1) BC is a formality written directly in the Berne Convention. That is obviously not the case for any other exception, such as an exception for framing or hyperlinks. Van Gompel sees more room for the argumentation, but sees the first step of the three step test – only in special cases – as a bottleneck that strongly reduces practical usability.<sup>18</sup> Moreover, it is unclear how the third step in the three step test – not prejudicial to the justified interests of the author – should be applied. Can you argue that the copyright holder does not suffer prejudice because they can take any prejudice away by complying with the formality? Or is this creating a cloud of dust to hide that you make a minimum right subject to a formality? This route to arrive at a permitted formality is therefore far from sure.
- 29 Moreover, the CJEU does not think about hyperlinking in terms of an exception. Hyperlinking is in the view of the CJEU under circumstances possible without seeking prior permission from the copyright holder either because it falls outside the

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17 Jane C. Ginsburg, ‘Berne-Forbidden Formalities and Mass Digitization’ (2016) 96 B. U. L. Rev. 745, 759 <[https://scholarship.law.columbia.edu/faculty\\_scholarship/691/](https://scholarship.law.columbia.edu/faculty_scholarship/691/)> accessed 7 July 2021.

18 Stef van Gompel, Formalities in copyright law—an analysis of their history, rationales and possible future (Wolters Kluwer, Information Law Series, 2011) 172 <<https://dare.uva.nl/search?identifier=2f611291-951b-4781-9559-fc64158902d0>> accessed 21 July 2021.

right of communication to the public, or because permission is implied because of the way in which the copyright holder has allowed the work to be placed on the internet. The CJEU is not completely clear about this, but it did not create an exception for hyperlinking.

- 30 In conclusion, the route inspired by article 10bis(1) BC is uncertain for the time being. Given that the CJEU does not think about hyperlinking in terms of an exception, it is also not a plausible option.
- 31 If an EU court would deny enjoyment or exercise (i.e. enforcement) of the right on the ground that a limitation of the contemplated public was not rendered in effective TPMs, this has the appearance of a forbidden formality.

## 2. How the required use of TPMs may not be a forbidden formality

- 32 The CJEU leaves room to see a hyperlink to a contemplated public in two ways. As indicated above, such a hyperlink can be seen as something that ‘does not fall within the scope of a communication ‘to the public’ so that ‘authorisation of the copyright holders is not required for such a communication’ (at 36). However, in the same decision you can also read: ‘by making his or her work freely accessible to the public or by authorising the provision of such access, the right holder envisaged from the outset all internet users as the public and accordingly consented to third parties themselves undertaking acts of communication of that work.’ (at 37). At the end of the quotation the court does not say ‘communication to the public’ but merely speaks of ‘communication’. However, given that the court also speaks about consent it leaves open room for seeing the making of a link to a contemplated public as a communication to the public, or at least as being part of more encompassing communication to the public, such as the initial placement of the work on the public internet by the copyright holder or with their permission. It may be that the exact doctrinal categorization does not matter for the question the court sought to answer in its decision. With a view to the prohibition of formalities however, it does make a difference. In the view that a link to a contemplated public is outside the scope of the right, the formality (use of an effective TPM or demanding that a licensee uses such tech) controls the scope of the right. Then it becomes difficult to argue how it is not a forbidden formality.
- 33 If it is however seen as a communication to the public for which the author has given permission, then it is much easier to argue that TPMs are a permissible formality that can also be upheld

against foreign copyright holders. The prohibition of formalities does not see to the exercise of rights (the term ‘exercise’ here not being understood as enforcement). If a country requires that an exclusive license can only be given in writing for example, such is not a forbidden formality.

- 34 This solution to the problem of the forbidden formalities, is reminiscent of the decision the German Federal Supreme Court reached in a copyright case about Google’s use of thumbnails of images for its Image Search service.<sup>19</sup> Google’s use of the thumbnails could not be justified under statutory copyright exceptions. The Federal Supreme Court found a solution in the assumption of an implied consent. By placing the images on the public internet without TPMs the rightsholder consented to inclusion of the images’ thumbnails in image search services. Nonetheless the route of the implied consent raised questions that were resolved in sometimes less, sometimes more satisfactory ways.<sup>20</sup> By choosing the route of the implied consent instead of the implied license, the court avoided the mandatory interpretation of licenses that only those use rights are licensed that are specified explicitly. Implied consent merely takes away the unlawfulness of the use of the images. Furthermore, the route of the implied consent raises the question of how to deal with the situation that a rightsholder in words explicitly declares that they do not allow the works to be included in a search engine (or in framing links, as in the VG Bild-Kunst case), but fails to use technical means to that effect. Such a statement may be ignored if it is clearly a contradictory statement by the rightsholder.<sup>21</sup> This implies that there have to be strong reasons to view the consent as it emanates from the non-use of TPMs as the declaration that objectively may be understood as intended. These reasons can be found in an economic argumentation, viz. that the rightsholder using TPMs appears to be the cheapest-cost-avoider. Below an economic argumentation in the context of the mandatory use of TPMs to fend off

19 German Federal Supreme Court (Vorschaubilder) (I ZR 69/08) April 29, 2010 (BGH (Ger)). See also BERBERICH, “Die urheberrechtliche Zulässigkeit von Thumbnails bei der Suche nach Bildern im Internet”, 2005 MultiMedia und Recht (MMR) 145, at 147,148.

20 Matthias Leistner, ‘The German Federal Supreme Court’s judgment on Google’s Image Search - a topical example of the “limitations” of the European approach to exceptions and limitations’ (2011) IIC 42(4), 417-442. Spindler, “Bildersuchmaschinen, Schranken und konkludente Einwilligung im Urheberrecht - Besprechung der BGH-Entscheidung “Vorschaubilder””, 2010 GRUR 785.

21 Spindler, “Bildersuchmaschinen, Schranken und konkludente Einwilligung im Urheberrecht - Besprechung der BGH-Entscheidung “Vorschaubilder””, 2010 GRUR 785, 790.

framing links will be elaborated. Other issues have not been resolved or at least far from satisfactorily. These included situations where images have been placed on the internet by others than the rights-holder and without his consent.<sup>22</sup> In such case there cannot be an implicit consent to the benefit of Image Search Services. Furthermore, might there be situations in which a compensation to the rightsholder for the use of their images is justified, the route of the implied consent makes this extremely difficult.<sup>23</sup> It is clear that implied consent is far from ideal solution to lacking statutory exceptions (as in the Google Image Search case) or to a conflict with the prohibition of formalities in international copyright law. In the latter context, Samuelson raises the question whether seeing the failure to use TPMs as permission is not overly formalistic.<sup>24</sup> The result comes close to a situation in which the enjoyment of the right to communication to the public has been reduced.

- 35 Even though an implied license is not an ideal solution, there are good economic arguments to embrace it. Hyperlinks constitute a clear social added value as is recognized by the court:<sup>25</sup>

*[ ... ] it cannot be forgotten that hyperlinks, whether they are used in connection with the technique of framing or not, contribute to the smooth operation of the Internet, which is of particular importance to freedom of expression and information, enshrined in Article 11 of the Charter, as well as to the exchange of opinions and information on the Internet, which is characterised by the availability of incalculable amounts of information (judgment of 29 July 2019, Spiegel Online, C-516/17, EU:C:2019:625, paragraph 81 and the case-law cited).'*

- 36 In itself, this does not mean that hyperlinks could not be subjected to a right of communication to the public or that the copyright holder should be limited in the exercise of his right. The latter may only be justified if the transaction cost of exercising the right in the same way as with respect to other (non-

hyperlink) communications to the public is so high that it takes away for a substantial part the social benefit of hyperlinks. Apparently, the court thinks that this is the case:<sup>26</sup>

*'It must be made clear that, in order to ensure legal certainty and the smooth functioning of the internet, the copyright holder cannot be allowed to limit his or her consent by means other than effective technological measures, within the meaning of Article 6(1) and (3) of Directive 2001/29 (see, in that regard, judgment of 23 January 2014, Nintendo and Others, C-355/12, EU:C:2014:25, paragraphs 24, 25 and 27). In the absence of such measures, it might prove difficult, particularly for individual users, to ascertain whether that right holder intended to oppose the framing of his or her works. To do so might prove even more difficult when that work is subject to sub-licences (see, by analogy, judgment of 8 September 2016, GS Media, C-160/15, EU:C:2016:644, paragraph 46).'*

- 37 So, the 'formality' of using technical means serves to communicate how the copyright holder exercises their right. Already, in the discussion leading up to the BC and its revisions, it was understood that formalities have a valuable communicative function (be it that it was conceived of in terms of putting the public on notice about a copyright). Apparently, the holder of a copyright is here the cheapest cost avoider.

- 38 Copyright law and especial the law concerning the right to communication to the public as applied to hyperlinks has in the last few years become more complicated. At the same time, it is important that copyright law can at least in a basic form be applied by laymen. After all, with digital technology, copyright law has entered everybody's world. In that respect, it is helpful that a legal reality is not too far removed from the physical (or at least digital) reality. To make copyright more 'what you see is what you get'.

- 39 This also fits in with the idea to give formalities a bigger role in copyright, an idea that is at least in academic circles gaining traction, be it more in the context of solving the problem of the growing body of orphan works.<sup>27</sup>

22 Matthias Leistner, 'The German Federal Supreme Court's judgment on Google's Image Search - a topical example of the "limitations" of the European approach to exceptions and limitations' (2011) IIC 42(4), 417-442, at 433-434.

23 Matthias Leistner, 'The German Federal Supreme Court's judgment on Google's Image Search - a topical example of the "limitations" of the European approach to exceptions and limitations' (2011) IIC 42(4), 417-442, at 431-432.

24 Jane C. Ginsburg, 'Berne-Forbidden Formalities and Mass Digitization' (2016) 96 B. U. L. Rev. 745, 774 < [https://scholarship.law.columbia.edu/faculty\\_scholarship/691/](https://scholarship.law.columbia.edu/faculty_scholarship/691/) > accessed 7 July 2021. Ginsburg 2016 asks the same question in her article about her analogous solution for orphaned works.

25 VG Bild-Kunst at 49.

26 VG Bild-Kunst at 46.

27 Jane C. Ginsburg, 'Berne-Forbidden Formalities and Mass Digitization' (2016) 96 B. U. L. Rev. 745 < [https://scholarship.law.columbia.edu/faculty\\_scholarship/691/](https://scholarship.law.columbia.edu/faculty_scholarship/691/) > accessed 7 July 2021, Gompel, Stef van, 'Copyright Formalities in the Internet Age: Filters of Protection or Facilitators of Licensing' (2013) 28 Berkeley Technology Law Journal 1425 (2013) < <https://ssrn.com/abstract=2420312> > accessed 21 July 2021, M. R. F. Senftleben, 'How to Overcome the Normal Exploitation Obstacle: Opt-Out Formalities, Embargo Periods, and the International Three-Step Test', 2014(1) Berkeley Technology Law Journal 1-19 < <https://research.vu.nl/ws/files/1032636/Normal%20Exploitation%20>

- 40 All this does not take away that there are challenges. Technology may not allow for the formulation of such fine-grained conditions as those rendered in natural language. For the time being, it is for example difficult to have a machine distinguish between commercial and other websites. In this sense, the ruling of the court lays a burden on the shoulders of the holders of copyrights: not using TPMs implies consent, and to change this situation, only TPMs can be used.
- 41 Another challenge is that it makes copyright enforcement more complicated. Copyright holders from EU member states may get used to the idea that TPMs need to be used, if control over linking is desired. For copyright holders outside Europe, the requirement to use TPMs may come as a surprise if they want to enforce their right of communication to the public against a hyper- or framing link. However, technical measures against framing are uniform and can be taken from any country and they can also be introduced after a work has been brought online.

this result will not please everybody. However, in my view there are enough reasons to embrace this result.

## D. Conclusion

- 42 With its decision in the VG Bild-Kunst case, the CJEU reconfirmed that a copyright holder can only invoke their right to communication to the public against makers of hyperlinks that were not contemplated by them. The new element is that the copyright holder can only mark a public as not contemplated by using effective TPMs. This allows potential makers of links to ascertain easily whether the rightsholder allows linking. It is important that copyright law – which nowadays applies to almost anybody, not just professional parties – remains relatively simple in its daily application. That here technology is the prescribed means to express contemplated uses of the work contributes to this goal.
- 43 The analysis undertaken in this article shows that contrary to some comments an obligation to use TPMs can be compatible with the prohibition of formalities, as laid down in the Berne Convention and later extended in the WCT. Therefore, it is necessary that the CJEU brings more doctrinal clarity in the reason why a copyright holder cannot forbid hyperlinking to a contemplated public. If this reason is that a hyperlink is a contemplated part of the original publication on the internet for which already permission has been given, then formally the requirement to exclude a new public with TPMs is compliant with the prohibition of formalities. Maybe

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Obstacle.pdf > accessed 21 July 2021, Christopher Jon Sprigman, 'Berne's Vanishing Ban on Formalities' (2013) Vol. 28, No. 3 Berkeley Technology Law Journal, < <https://ssrn.com/abstract=2407015> > accessed 21 July 2021.